

## TRADUCTION/TRANSLATION

IN THE MATTER OF AN OPPOSITION by  
Fernand Claisse and Fernand Claisse inc. to  
application No. 1,204,632 for the trade-mark  
CLAISSE filed by Claisse Scientific Corporation  
Inc.

---

[1]. On January 29, 2004, Claisse Scientific Corporation Inc. (the Applicant) filed an application for the registration of the trade-mark CLAISSE (the Mark) used in Canada in association with the following wares and services:

### Wares:

- (1) Fusion instruments, namely: automatic apparatus, also called fluxers, used to produce, through fusion, glass discs for analysis by X-ray fluorescence (XRF) as well as solutions for analysis by atomic absorption (AA) spectrometry or inductively coupled plasma (ICP) spectrometry and related parts, namely heating units made up of heating elements making it possible to perform fusion, control units consisting of a box with a keyboard making it possible to control and modify the actions required by the heating units, electronic interface cards used as a communication link among the various functions of the fluxers and their computer programming and the computer software specific to each fusion instruments making it possible to vary the level and order of execution of the various functions connected with the fusion procedure. (Used in Canada since October 21, 1976)
- (2) Fluxes, namely: solvents, also called fluxes, comprised of lithium borate, or sodium borate used in inorganic sample preparation by fusion of inorganic samples X-ray fluorescence (XRF) analysis, as well as solutions for atomic absorption (AA) spectrometry or (ICP) plasma emission spectrometry. (Used in Canada since April 1988)
- (3) Platinum- related accessories, namely: moulds and crucibles composed of an alloy of platinum and gold and used in the fusion process. (Used in Canada since May 1980)
- (4) Chemical products, also known as nonwetting agents and additives, used in melting, namely lithium carbonate, potassium iodide, lithium bromide, lithium iodide, lithium fluoride, lithium nitrate and sodium nitrate. (Used in Canada since April 1988)

### Services:

- (1) Service related to training and assistance for clients relating to the use of fusion instruments and the various aspects of analysis operations involving X-ray fluorescence (XRF), atomic absorption spectroscopy, inductive coupling plasma -

- optical emission spectroscopy or wet chemistry. (Used in Canada since September 1998)
- (2) Service related to assistance in the development of procedures for the preparation of inorganic samples by fusion for customers for conducting analyses involving X-ray fluorescence (XRF), atomic absorption spectroscopy, inductive coupling plasma - optical emission spectroscopy and wet chemistry. (Used in Canada since January 1991)
  - (3) Support service for the installation and start-up of fusion instruments. (Used in Canada since January 1991)
  - (4) Follow-up service, namely periodic laboratory visits to ensure that the clients' fusion instruments are functioning properly and to keep clients informed of the latest discoveries related to their activities in the field of fusion. (Used in Canada since April 1999)

(the Wares and Services)

[2]. The application was advertised in the *Trade-marks Journal* on December 8, 2004.

[3]. On January 17, 2005, Fernand Claisse and Fernand Claisse inc. (hereinafter the Opponent Individual and the Opponent Corporation, also collectively referred to as the Opponents) filed a statement of opposition to that application. The grounds of opposition may be summarized as follows:

1. The application does not meet the requirements of sections 30(a), (b) et (i) of the *Trade-marks Act* (R.S.C. 1985, c. T-13) (the Act);
2. The Mark is not registrable within the meaning of section 12(1)(a) of the Act, since it is a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years;
3. The Applicant is not the person entitled to secure registration of the Mark within the meaning of section 16(1) of the Act because the Mark is a word that is primarily merely the surname of the Opponent Individual. Furthermore, the Applicant is not the true owner of the Mark, which it only used with the Opponent Individual's permission and consent, as will be discussed at greater length below. Furthermore, at the date on which the Applicant alleges to have first used the Mark in relation to each of the Wares and each of the Services, the Mark was confusing with a "Claisse"

trade-mark owned and used by either of the Opponents, without any admission whatsoever; and

4. The Mark is not “distinctive” within the meaning of section 2 of the Act.

[4]. On May 31, 2005, the Applicant filed a counter statement denying all of the grounds of opposition and requesting that the decision to be made in this case take into account the Opponents’ admission in their statement of opposition that [TRANSLATION] “. . . the Applicant is not the true owner of the ‘Claisse’ Mark, which it only *used* with the permission and consent of the Opponent, Fernand Claisse, who, by his position as executive officer of the Applicant, had control of the character and quality of the Wares and Services in association with which the Mark was *used*, and the use, advertisement and display of the Mark”, notwithstanding the fact that the Opponents state that these allegations are made “without any admission whatsoever”.

[5]. In support of their objection, the Opponents filed Fernand Claisse’s first affidavit, dated December 14, 2005. The Applicant filed an affidavit of Lucie Simard, dated July 13, 2006. Ms. Simard was cross-examined on her affidavit, and the transcription of her cross-examination and the undertakings given during that cross-examination were entered in the record. The Opponents also filed Mr. Claisse’s second affidavit, dated May 22, 2007, in reply evidence. Where one of the parties’ evidence arises from arguments rather than facts that are relevant to this matter, I focussed my analysis on those relevant facts.

[6]. Both parties filed written arguments and took part in an oral hearing.

## *Analysis*

### *General principles and relevant dates*

[7]. The Applicant has the onus of showing that its application complies with the requirements of the Act. However, the Opponents have the onus of ensuring that each of their grounds of opposition is duly argued and of discharging their initial evidentiary burden by establishing the facts supporting their grounds of opposition, failing which a ground of opposition may not be taken into consideration. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that none of the grounds of opposition impedes the registration of the Mark [see *Massimo De Berardinis v. Decaria Hair Studio* (1984), 2 C.P.R. (3d) 319 (T.M.O.B.); *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.); *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, (1984) 3 C.P.R. (3d) 325; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.*, (2002), 20 C.P.R. (4th) 155 (F.C.A.); and *Wrangler Apparel Corp. v. The Timberland Company*, 2005 FC 722].

[8]. The relevant dates for assessing the circumstances of each of the grounds of opposition in this case are the following:

- Grounds based on section 30 of the Act: the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)];
- Ground based on section 12(1)(a) of the Act: the filing date of the application [see *Calvin Klein Trademark Trust v. Wertex Hosiery Inc.* (2004), 41 C.P.R. (4th) 552 and *Jurak Holdings Ltd. v. Matol Biotech Laboratories Ltd.* (2006), 50 C.P.R. (4th) 337 (T.M.O.B.)];
- Ground based on section 16(1) of the Act: dates of first use claimed in the application; and
- Ground based on non-distinctiveness of the Mark: generally accepted as being the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

## *Summary of evidence*

### *Opponents' evidence*

[9]. The Opponent Individual, Fernand Claisse, is an internationally renowned researcher in the field of chemical analysis of various materials by X-ray fluorescence and holds a doctorate in physics and metallurgy. In his first affidavit, Mr. Claisse states that he developed, among other things, the borate bead (fusion) technique in 1955 and personally designed various scientific apparatuses and instruments, including the first mechanical fusion apparatus to make fusion beads, which was named "Fluxer" ("Fluxeur" in French), in 1971. This type of apparatus is used in industrial analysis laboratories of cement plants, aluminum smelters and petroleum and mining corporations, among others.

[10]. These fusion apparatuses were originally manufactured and sold on the market by the former Fernand Claisse inc. (a company which is not the Opponent Corporation and was dissolved in 1985 [according to Ms. Simard, it was in fact dissolved in April 1987]). In his first affidavit, Mr. Claisse states that he incorporated the Applicant in 1976 for the sole purpose of marketing the instruments and apparatuses manufactured by the former Fernand Claisse inc. and that, when the former Fernand Claisse inc. was dissolved, its operations were taken over by the Applicant.

[11]. In that regard, Mr. Claisse states that he was president of the Applicant from 1976 to 2000 and employed by the Applicant from 1976 to 2002 (according to Ms. Simard, he was in fact employed by the Applicant from 1984 to 2002). Mr. Claisse states that because of his positions, responsibilities and duties at the Applicant, he was personally aware that from 1976 to 1997, the names and commercial designations which the Applicant could use never included the word "CLAISSE" used alone. Mr. Claisse adds that the word "CLAISSE" does not and never did appear on the heating units (Wares, no. 1), alone or in combination with any other word(s) or logo(s) whatsoever.

[12]. To prove his world renown in the field of fusion for X-ray analysis, Mr. Claisse attached, to his first affidavit, a list of the conferences, meetings and scientific activities in which

he participated, personally or as the Applicant's representative, a list of the articles and books he has published, a list of the workshops he has held and of the presentations he has given, and a list of the honours and decorations he has received.

[13]. Mr. Claisse also attached to his affidavit four pieces of correspondence that he received from four scientists, including one Canadian, to show that the name "CLAISSE" is directly associated with his person. What is more, he asserts that he has always used the name "CLAISSE", under which he was baptized, in all aspects of his life.

[14]. Mr. Claisse also attached to his affidavit a list of names and contact details to show that in the province of Quebec alone, there are at least 29 persons by the name of "CLAISSE". I note that this list matches the names and contact details of eight of the persons appearing on the Web site "Canada411.ca" listed by Ms. Simard (see below). As for the others, Mr. Claisse's research methodology leaves something to be desired and is largely based on hearsay. I also note that some of the persons on this list seem to belong to the same family, given that they have the same residential address. Moreover, Mr. Claisse states that a search performed on the Web site "Google.ca" produces 121,000 entries for persons by the name of "CLAISSE" all over the world and 590 entries pertaining to him. This search also produces 540 entries from Canada using the word "CLAISSE" and 40 entries using the expression "Fernand-Claisse". I am not prepared to give weight to the various search results obtained by means of "Google.ca" given, among other things, the vagueness surrounding the search parameters used and the fact that the same entry may be listed more than once.

[15]. Still with regard to the word "CLAISSE", Mr. Claisse states that the former Fernand Claisse inc. had had to disclaim the right to the exclusive use of the word "CLAISSE" apart from the trade-mark "CLAISSE FLUXER" to secure the registration of this trade-mark in Canada. In support of his assertions, Mr. Claisse attached to his first affidavit a copy of a statement from the Canadian Intellectual Property Office (CIPO) database regarding the registration of the trade-mark secured on April 11, 1980, for this mark, showing the disclaimer provided and the expungement of this registration on March 8, 1996, because it was not renewed. I am not prepared to give weight to the fact that the examiner responsible for examining this application for registration required such a disclaimer because, among other things, I am not bound by the

conclusions which may be drawn at the examination stage of an application for registration [see *Now Communications Inc. v. CHUM Ltd.* (2003), 32 C.P.R. (4th) 68 (T.M.O.B.); *Interdoc Corporation v. Xerox Corporation* (November 25, 1998, T.M.O.B. (not reported), application no. 786,491); *Thomas J. Lipton Inc. v. Boyd Coffee Co.* (1991), 40 C.P.R. (3d) 272, and *Procter & Gamble Inc. v. Morlee Corp.* (1993), 48 C.P.R. (3d) 377], especially since, in this particular case, it is conceivable that the applicant's name may have influenced the examiner.

[16]. In addition, Mr. Claisse states that on several occasions since the end of his employment with the Applicant, customers have addressed themselves to him during conference-expositions, at meetings or in e-mails, believing that they were dealing with a person in charge of the Applicant.

[17]. With regard to the Opponent Corporation, Fernand Claisse inc., Mr. Claisse states that it is a legal person incorporated in March 2004 and specializing in increasing the potential of borate fusion technology, the development of new products related to borate fusion and the development of new versions of various products he created in the past. Mr. Claisse is the founder, majority shareholder, sole director and president and secretary of the Opponent Corporation.

[18]. In his second affidavit, Mr. Claisse reviewed the operations of the former Fernand Claisse inc. He states that as early as February 1974, this company used the "CLAISSE FLUXER" mark, the subject of the registration discussed above, in association with wares described as [TRANSLATION] "laboratory apparatuses for transforming rocks, cements and other industrial materials into liquid solutions or glass". To that effect, Mr. Claisse attached a copy of an advertisement of the former Fernand Claisse inc., on which the year 1975 is written by hand, showing photographs of these machines on which the "CLAISSE-FLUXER" mark clearly appears.

[19]. Between February 1974 and fall 1976, the former Fernand Claisse inc. designed, built and marketed machines using the "CLAISSE FLUXER" mark. The Applicant only began marketing "CLAISSE FLUXER" apparatuses in fall 1976. More specifically, Mr. Claisse states

in his second affidavit that from fall 1976 to spring 1986, the former Fernand Claisse inc. continued to manufacture the “CLAISSE FLUXER” mark machines that were marketed by the Applicant. Therefore, it was not until the time when the former Fernand Claisse inc. was dissolved that the Applicant began manufacturing “CLAISSE FLUXER” mark machines itself. The “CLAISSE FLUXER” trade-mark was transferred to the Applicant in June 1984, as reported in the CIPO statement discussed above, and its registration was expunged in March 1996, also as discussed above.

[20]. Mr. Claisse concluded his second affidavit by attaching a copy of a printout from the Quebec Enterprise Register, according to which the Applicant itself stated that it had only used the word “CLAISSE” as of January 21, 2004.

[21]. The Applicant did not object the filing of this second affidavit of Mr. Claisse as reply evidence. Pursuant to section 43 of the *Trade-marks Regulations*, SOR/96-195, such evidence must be strictly confined to matters in reply. As stated above, Mr. Claisse’s second affidavit mainly revisits certain aspects dealt with in his first affidavit. I consider that, with the exception of the printout from the Quebec Enterprise Register, Mr. Claisse’s second affidavit is redundant and unnecessary and therefore inadmissible. As for the printout from the Enterprise Register, its purpose is to contradict Ms. Simard’s testimony with regard to the use of the word “CLAISSE” as a trade-mark or trade-name. For that reason, I consider this part of the evidence in reply to be admissible. I will return to this aspect of the record later on in my decision.

#### *Applicant’s evidence*

[22]. Lucie Simard has been president of the Applicant since February 17, 2000, and has been one of its directors since April 1, 1983. Ms. Simard states in her affidavit that she held the positions of administrative assistant from 1978 to 1983 and of secretary-treasurer of the Applicant from 1983 to 2000.



[23]. Ms. Simard states that the Applicant is a world leader and a pioneer in the development of analytical fusion techniques, instrumentation and fine chemistry science, and has gained an international reputation for its achievements.

[24]. Ms. Simard states that she is personally aware of the fact that the Mark was used by the Applicant in association with all of the Wares and Services as of the dates of first use claimed in this application for registration. In support of her statements, Ms. Simard attached to her affidavit a disorganized pile of sample invoices, purchase orders, delivery orders, certificates of origin, export declarations, service or visit reports, advertisements published in specialized journals, pages from the Applicant's Web site and the Applicant's corporate brochure.

[25]. Ms. Simard states that the Mark has gained some renown within the scientific community and among the Applicant's client base, and that it truly distinguishes the Applicant's Wares and Services from those of its competitors. In that respect, she states that from 2000 to 2006, both in Canada and abroad, the Applicant achieved sales of over \$25,000,000 for wares and services in association with which the Mark was used. Over the same period, the Applicant allocated over \$1,400,000 to advertising and promoting those same wares and services.

[26]. Ms. Simard states in that regard that the Applicant took part in dozens of events, both in Canada and abroad, during which the Applicant had the use of a display booth where it could put up posters and distribute corporate brochures on which the Mark clearly appears. To that effect, Ms. Simard attached, as examples, a list of the scientific presentations, publications and papers by the Applicant's employees from 1992 through 2002.

[27]. Ms. Simard states that the Applicant has a Web site that was brought online in 1988 under the "claisse.com" domain name and that the Applicant also owns the "claisse.ca" and "claisse.net" domain names.

[28]. On the matter of the Opponent Individual, Fernand Claisse, Ms. Simard asserts that Mr. Claisse, as an employee of the Applicant from 1984 to 2002 and as its president from 1976 to 2000, never contested or challenged the Applicant's right to use the Mark in association with

the Wares and Services. Ms. Simard further submits that the renown which the Opponent Individual claims to have is not greater than that of any scientist who publishes writings and gives conference talks in his or her field of interest. In that respect, she states that the Opponent Individual is confusing [TRANSLATION] “his pseudo-renown” with that of the Applicant. As evidence, Ms. Simard states that the Opponent Individual’s departure in January 2002 did not affect the Applicant’s normal course of operations. The Applicant’s good reputation and sales have continued to progress since the Opponent Individual’s departure.

[29]. Ms. Simard is convinced that the Opponents’ opposition is only motivated by the rancour and spite that have gripped the Opponent Individual since the Applicant dismissed him in 2002. I am not prepared to give weight to this statement by Ms. Simard, which seems derogatory to me, to say the least.

[30]. On the matter of the Opponents’ operations, Ms. Simard states that they have never used a trade-mark with which the Mark is likely to be confusing. She supported her statements with a copy of the Opponent Corporation’s Web site. Ms. Simard also states that, in addition, the Opponents never secured registration of such a trade-mark. As mentioned above, I am not prepared to give weight to these statements by Ms. Simard to the extent that they are arguments. It is up to the Registrar to determine the likelihood of confusion between the marks at issue in this case.

[31]. In terms of the frequency of the name “Claisse”, Ms. Simard attached to her affidavit a printout from the “Canada411.ca” Web site, according to which only 11 entries were listed in Canadian directories.

[32]. I will now analyze the grounds of opposition in regard to the evidence filed in this case, without necessarily following the order in which they were raised in the statement of opposition.

*Grounds of opposition*

(i) *Ground based on section 12(1)(a) of the Act*

[33]. Pursuant to section 12(1)(a) of the Act, a trade-mark is registrable if it is not a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years.

[34]. The Opponents met their initial burden of proof by establishing that the word “CLAISSE” is the surname of an individual who is living in Canada. Furthermore, the Applicant readily admits this fact. The dispute between the parties concerns the interpretation to be given to section 12(1)(a) of the Act, particularly with regard to the applicable test to determine whether the Mark is “primarily” merely the surname of an individual who is living.

[35]. The Opponents submit that the word “CLAISSE” has no meaning other than that of a surname. The word “CLAISSE” is not, in either of Canada’s official languages, a common name, a geographical location, an invented word, an acronym, etc. Since it is the surname of an individual who is living and has no secondary connotation besides that of a surname, the average Canadian cannot consider the Mark to be anything other than a surname.

[36]. In contrast, the Applicant, referring to the practice notice entitled “Paragraph 12(1)(a) of the Act – Name or Surname” published by CIPO on August 16, 2000, submits that no objection can be made under section 12(1)(a) of the Act since there are not at least 25 entries of this surname in Canadian telephone directories. The Applicant adds that for a Canadian of ordinary intelligence and of ordinary education in English or French, the primary meaning of “CLAISSE” does not in any way connote the surname of an individual who is living or who has died within the preceding thirty years. Given the rarity of this surname, the average Canadian is more likely to react to the word “CLAISSE” by thinking of it as a coined, fanciful or invented word used as a company’s trade-mark, rather than as a surname. Alternatively, the Applicant submits that if the trade-mark is not registrable under section 12(1)(a) of the Act, it may nonetheless be registrable under section 12(2) of the Act [TRANSLATION] “because it has been so

used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing of this application for registration”. Lastly, the Applicant submits that the Mark cannot be considered to be the surname of a [TRANSLATION] “famous” individual.

[37]. Considering first of all the frequency of the word “CLAISSE” used as a surname, there is no doubt in my mind that this is a rare surname in Canada. However, neither the figure of 11 entries listed in Canadian telephone directories, as adduced into evidence by the affidavit of Ms. Simard, nor the allegation in Mr. Claisse’s affidavit that there are 29 persons by the name of “CLAISSE” in Quebec is, by itself, determinative in this case. The practice notice stating that an objection under section 12(1)(a) of the Act will only be taken into consideration if there are at least 25 entries of the name or the surname in Canadian telephone directories is only provided as an indication and does not reduce the applicable test on the matter to mere mathematical considerations.

[38]. Since it is a rare surname that, furthermore, does not correspond to any word defined in French or English dictionaries, the question is whether the average Canadian is more likely to associate the word “CLAISSE” with a family name or whether this word is primarily or equally perceived as an invented word that may be used as a trade-mark [see *Registrar of Trade-marks v. Coles Book Stores Limited*, [1974] S.C.R. 438; *Standard Oil Co. v. The Registrar of Trade-marks*, [1968] 2 Ex. C.R. 523; *Galanos v. Canada (Registrar of Trade-marks)* (1982), 69 C.P.R. (2d) 144 (F.C.T.)]. To me, the second scenario seems the most probable.

[39]. Although the word “CLAISSE” does in fact correspond to a surname, the rarity of this surname, in conjunction with the fact that the word “CLAISSE” has no particular connotation, leads me to conclude that the two characteristics (surname and invented name) are equally important. Therefore, the word “CLAISSE” cannot be said to be “primarily” merely a surname.

[40]. I would add on this point that the mere fact that the Opponent Individual is renowned internationally in the highly specialized field of chemical analysis by X-ray does not lead to the conclusion that the word “CLAISSE” is recognized as a surname by the average Canadian

consumer pursuant to section 12(1)(a) of the Act, particularly because it seems to me that it is difficult to attribute this renown solely to the Opponent Individual, and not also partly to the Applicant.

[41]. Having found that the Mark does not contravene the provisions of section 12(1)(a) of the Act, there is no need to consider the parties' submissions regarding the registrability of the Mark under section 12(2) of the Act. The ground of opposition based on the Mark not being registrable under section 12(1)(a) of the Act is dismissed.

(ii) *Grounds based on section 30 of the Act*

*Ground based on section 30(b) of the Act*

[42]. The Opponents submit that the application does not meet the requirements of section 30(b) of the Act in that the Applicant falsely declared having used the Mark in Canada in association with the Wares and Services as of the dates of first use claimed in the application.

[43]. The Opponents can discharge their initial burden of proof with regard to section 30 by relying on both the evidence they filed and the evidence filed by the Applicant [see *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.)].

[44]. To the extent that the Applicant has easier access to the facts, the Opponents' burden of proof in relation to the ground of opposition based on non-compliance with section 30(b) is less onerous [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.)].

[45]. First, with regard to the evidence submitted by the Opponents, after analyzing Mr. Claisse's first affidavit, I accept that the former Fernand Claisse inc. is the corporation that designed, manufactured and marketed the first fusion apparatuses and instruments of the kind that are the subject of this application for registration. For that marketing purpose, the former Fernand Claisse inc. used the "CLAISSE FLUXER" mark, which is registered as a trade-mark with CIPO. In the registration, the date of first use of the mark is 1974.

[46]. The Applicant was incorporated by the Opponent Individual in 1976 for the sole purpose of marketing the fusion apparatuses and instruments manufactured by the former Fernand Claisse inc. Far from refuting that fact, Ms. Simard explained at pages 9 and 10 of her cross-examination that the instruments and apparatuses sold by the Applicant when its operations first began were [TRANSLATION] “Claisse Fluxers that had been developed and manufactured by [Fernand Claisse]”.

[47]. Moreover, Ms. Simard added on that subject that in their early days, the former Fernand Claisse inc. and the Applicant were small businesses that were in fact the [TRANSLATION] “alter egos” or [TRANSLATION] “mirror images of one another” [pages 12 and 25 of her cross-examination].

[48]. Between 1974 and 1982, six new models of apparatuses were designed and marketed (“Fluxer I” to “VI” inclusively [paragraph 17 of Mr. Claisse’s first affidavit]). Ms. Simard did not refute that fact. At page 15 of her cross-examination, Ms. Simard explained that when she arrived at the Applicant, the Applicant had [TRANSLATION] “only one apparatus called the ‘Fluxor [*sic*] VI” and stated, later on at page 38, [TRANSLATION] “at the time, in 1983, Claisse Scientific Corporation still had only one fusion instrument, the ‘Fluxer VI””.

[49]. The Applicant’s business evolved over the years. It is clear from Mr. Claisse’s affidavit and pages 120 and 121 of Ms. Simard’s cross-examination that the Opponent Individual designed new apparatuses, instruments and techniques collaboratively with other persons with whom he worked at the Applicant. That is how the “Fluxer VI” model was replaced around 1983–1984 by the “BIS” model, around 1987–1989 by the “FLUXY” model, around 1990 by the “M4” model, etc.

[50]. Second, upon giving more careful consideration to the evidence submitted by the Applicant, the evolution of the Applicant’s business came about not only in terms of the development of various models of fusion apparatuses, but also in terms of the addition of new products and services, such as the following:

- The platinum-related accessories (moulds and crucibles) that are the subject of category of wares no. 3 of this application, introduced in 1980 [page 124 of Ms. Simard’s cross-examination]
- The fluxes and chemical products that are the subjects of categories of wares nos. 2 and 4 of this application, introduced in 1987 [pages 129 and 141–142 of Ms. Simard’s cross-examination]
- The consulting services that are the subject of categories of services nos. 1 and 4 of this application [page 155 of Ms. Simard’s cross-examination]

[51]. This evolution in the Applicant’s range of products and services was also accompanied by an evolution in the Applicant’s corporate logo. Over the years, the Applicant placed greater emphasis on the word “CLAISSE”. Furthermore, at page 36 of her cross-examination, Ms. Simard explained that from the early days of the Applicant’s operations, she [TRANSLATION] “had gotten clients into the habit of always putting ‘CLAISSE FLUXER’ [on their purchase orders] so as to position the word ‘CLAISSE’”.

[52]. More specifically, the Applicant’s corporate logo was amended for the first time in 1983. Originally, the logo was formed of a rectangle containing the letters “CSC” with the words “Claisse Scientific Corporation” below. The logo was amended to remove the letters “CSC” and the rectangle and to add a stylized design of six burner heads to the left of the name Claisse Scientific Corporation. Around the late 1990s, the logo was again amended to position the word “CLAISSE” prominently, with the words “The First and Finest in Fusion” and the stylized design of the six burner heads placed below it. Then, around 2003, the words “The First and Finest in Fusion” were removed, and from then on, the logo consisted of the word “CLAISSE” with the stylized design of the six burner heads to its left.

[53]. Returning to the Wares and Services and the dates of first use claimed in this application for registration, the following should be noted:

- With regard to the category of merchandise designated as “Fusion instruments”, the earliest invoice filed by Ms. Simard dates from September 15, 1977, (exhibit LS-1 in Ms. Simard’s cross-examination) (in contrast, the date of first use

claimed in the application is October 21, 1976) and is for a [TRANSLATION] “loose parts kit for Claisse Fluxer”. With regard to these parts and accessories, Ms. Simard explained at pages 30 and 118 of her cross-examination that a fusion apparatus had to have been previously sold to the same client prior to September 15, 1977. The earliest sample advertisements filed by Ms. Simard were designed in 1980 (exhibit LS-4), 1984 (exhibit LS-5), 1987 (exhibit LS-6) and 1996 (exhibit LS-10). These advertisements are essentially photographs of fusion apparatuses displaying the “CLAISSE FLUXER IV”, “CLAISSE FLUXER BIS” or “CLAISSE FLUXY” marks. Depending on the year, one of the first three versions of the Applicant’s corporate logo also appears on these advertisements and on the labels or stickers on the apparatuses.

- With regard to the category of Wares designated as “Fluxes”, the earliest invoices filed by Ms. Simard date from February 13 and 19, 1986, and are for, among other things, lithium tetraborate (undertaking no. 1 filed following Ms. Simard’s cross-examination) (in contrast, the date of first use claimed in the application is April 1988). These invoices do not mention that they are for “CLAISSE” fluxes. Ms. Simard attached, to the document filed as undertaking no. 1, a sample advertisement dated November 15, 1989, advertising “CLAISSE FLUXES (Borates and Phosphates)”. Moreover, I note that sample advertisements LS-9 and LS-10, which were allegedly designed in 1996, show photographs of a box of lithium borate flux displaying the CLAISSE Mark. Ms. Simard explained at page 129 of her cross-examination that in 1987, another company manufactured the fluxes marketed by the Applicant for the Applicant. Only in 1995 did the Applicant start manufacturing its fluxes itself. Ms. Simard also explained in her cross-examination that she no longer has samples of the earliest advertisements in her possession since those samples, in addition to a number of others, were filed in a court case between the Opponent Individual and the Applicant.
- With regard to the category of wares designated as “Platinum-related accessories”, the earliest invoices filed by Ms. Simard date from October 28, 1983, (invoice 596-83, Appendix 1 to Ms. Simard’s affidavit) and from November 30, 1987 (undertaking no. 4) (in contrast, the date of first use claimed



in the application is May 1980). The invoice from October 28, 1983, does not mention that the moulds and crucibles are of the “CLAISSE” mark, while the invoice dated November 30, 1987, mentions [TRANSLATION] “Claisse BIS Crucibles”. The earliest sample advertisement filed by Ms. Simard is the abovementioned sample LS-4. This sample advertisement, entitled “The Wining [sic] Combination”, refers to moulds and crucibles manufactured by “Engelhard” as follows: “It’s no wonder Corporation Scientific Claisse the manufacturer of the CLAISSE FLUXER suggests Engelhard Platinum 5% Gold Alloy Crucibles and Molds made to their specifications as YOUR BEST CHOICE to use with their instruments”. Ms. Simard explained at page 124 of her cross-examination that in 1980, the Applicant entered into an agreement with the Engelhard corporation. It is not possible to make out the CLAISSE Mark on the photographs of the moulds and crucibles reproduced in advertisement LS-4. I will add on this point that it is not clear from this advertisement whether the moulds and crucibles are in fact sold as “Engelhard” moulds and crucibles, given the technical drawing of the crucible reproduced on this advertisement, showing what appears to be Engelhard’s corporate logo with the title “CRUCIBLES & MOLDS FOR ‘CLAISSE FLUXER’” below. In addition, I note that in the advertisement portfolio (undertaking no. 6 filed by Ms. Simard), the photographs of moulds and crucibles show the Mark engraved on the moulds. This portfolio is not dated. From the corporate logo on the advertisements, I believe that these advertisements date back to the late 1990s.

- With regard to the category of wares designated as “Chemical products”, the agent for the Applicant stated that the earliest invoice dates back to January 27, 1988 (invoice no. 7170-88, Appendix 1 to Ms. Simard’s affidavit) (in contrast, the date of first use claimed in the application is April 1988). However, I note that this invoice pertains to fluxes (category of wares no. 2) rather than the chemical products in category of wares no. 3. For my part, I managed to find, in the pile of documents filed as Appendix 1 to Ms. Simard’s affidavit, an invoice dated March 31, 1993, for potassium iodide, among other things. This invoice does not state that it is for “CLAISSE” mark potassium iodide. The earliest sample

advertisement filed by Ms. Simard is sample LS-9, as discussed above. This sample refers to fluxes and nonwetting agents. Ms. Simard explained at pages 141 and 142 of her cross-examination that the Applicant only began manufacturing these chemical products itself as of 1995–1996. Before then, these products were manufactured for the Applicant by another company. In addition, I note that in the abovementioned advertisement portfolio (undertaking no. 6), the photographs of chemical products show the Mark marked on the bottles, just as it is on the fluxes.

- With regard to the categories of services designated as “Service related to training and assistance for clients” and “Follow-up service”, the earliest sample advertisement filed by Ms. Simard is sample LS-3, an undated brochure advertising “CLAISSE CONSULTATION A New Service!” which was allegedly designed in 1998, describing, among other things, the “general assistance” and “follow-up” services (in contrast, the dates of first use claimed in the application are September 1998 and April 1999, respectively).
- With regard to the categories of services designated as “Service related to assistance in the development of procedures for the preparation of inorganic samples by fusion” and “Support service”, the earliest sample advertisements filed by Ms. Simard are the abovementioned sample LS-10, namely an undated brochure advertising “Claisse . . . directly involved in the development of analytical techniques in industrial laboratories and research centers”, allegedly designed in 1995–1996, and sample advertisements published in the “Laboratory Technology International 1996” and “LAB Guide 1999-2000” journals (Appendix 1 to Ms. Simard’s affidavit) (in contrast, the dates of first use claimed in the application for both of these categories of services is January 1991).

[54]. Considering, more specifically, the category of wares designated as “Fusion instruments”, it should be noted that the date of first use of the Mark claimed by the Applicant is the same as the date of the Applicant’s incorporation. It seems surprising to me, to say the least, that the Applicant made its first sale of those wares on the very date of its incorporation.

[55]. As mentioned above, the Applicant itself states in its written submissions that if the Mark is not registrable under section 12(1)(a) of the Act, it may nonetheless be registered under section 12(2) of the Act because [TRANSLATION] “it has been so used in Canada by the applicant or his *predecessor in title* as to have become distinctive at the date of filing of this application for registration”. The Applicant’s reliance on the use by a “predecessor in title” is not, in itself, surprising, considering the background of trade relations between the former Fernand Claisse inc. and the Applicant. However, I note that this application for registration makes no reference to any predecessor in title of the Applicant.

[56]. What is more, since, at the time, the Applicant was only incorporated to market the apparatuses and instruments of the former Fernand Claisse inc. which displayed the “CLAISSE FLUXER” mark, as discussed earlier, it follows that the Applicant could not allege having begun using just the CLAISSE Mark at the time of the Applicant’s incorporation.

[57]. In that respect, the Applicant points out that such use of the “CLAISSE FLUXER” mark could also amount to the use of the “CLAISSE” Mark for the reason that the word “FLUXER” is to be understood in the generic sense of the word or else that the “CLAISSE” mark is a minor deviation from the “CLAISSE FLUXER” mark. The Applicant did not file any evidence to establish the generic nature of the word “FLUXER” (or its equivalent in French, “FLUXEUR”). It should be mentioned that the Applicant made the argument regarding the generic nature of the word “FLUXER” only at the hearing, and the Opponents objected to it. The word does not seem to be defined in any general English or French language dictionary. However, I did find the following definitions of the French word “fluxeur” in the electronic version of the *Grand dictionnaire terminologique de la langue française* and in the *Termium Plus* database:

*Grand dictionnaire:*

[TRANSLATION]

“Fluxeur”: Element on a welding machine that produces the heat the machine requires to function. Note: Not current. English equivalents: “burner”. Quasi-synonym: “fluxer”.

*Termium Plus:*

“Fluxeur”: Apparatus used to apply a welding flux. Subject Field(s) Joining Elements (Mechanical). English equivalent: “burner”, “fluxer”. Definition from the *Dictionnaire de termes nouveaux des sciences et techniques* (Paris: Conseil international de la langue française, c. 1983).

[58]. I have difficulty relating these definitions to the Applicant’s apparatuses. The fact that the Applicant’s apparatuses include “heating units” used to produce glass disks through fusion for analysis by X-ray fluorescence and solutions for analysis by atomic absorption spectrometry or plasma emission spectrometry does not seem to me sufficient, in itself, to conclude that the word “FLUXER” used in the context of the Applicant’s apparatuses is generic.

[59]. Returning to the sample advertisements designed in the 1980s and the fusion apparatus models marketed when the Applicant first began operating, I cannot conclude, as the Applicant submits, that the use of the “CLAISSE FLUXER” mark amounts to the use of the “CLAISSE” Mark. As stated above, Mr. Claisse designed the first mechanical fusion apparatus. This apparatus was marketed in association with the “CLAISSE FLUXER” mark. At that time, equal emphasis was placed on the words “CLAISSE” and “FLUXER”, used together as a distinctive trade-mark. The use of the “CLAISSE” Mark alone seems to me to have begun in the 1990s as the Applicant’s operations evolved, which, in itself, may explain the abandonment of the “CLAISSE FLUXER” mark’s registration. The parallel evolution of the Applicant’s corporate logo over the years to emphasize the word “CLAISSE” is in line with that development.

[60]. In summary, the evidence in the record does not allow me to conclude that the Applicant did in fact use the Mark starting as early as the alleged date of first use, October 21, 1976. To the contrary, the evidence seems to me to be inconsistent with that date. Accordingly, I believe that the Opponents have met their initial burden of proof in support of their ground of opposition based on section 30(b) of the Act with regard to the first category of wares that are the subject of this application, while the Applicant has failed to meet the legal burden upon it. The ground of opposition based on section 30(b) is allowed with regard to those wares.

[61]. With regard to the other categories of wares and all of the services that are the subject of the application for registration, the Applicant's evidence clearly shows the use of the Mark since at least the late 1990s. Mr. Claisse does not contradict this at paragraph 46 of his first affidavit when he states [TRANSLATION] “. . . I know that from 1976 to 1997, the names and trade-names [that the Applicant] could use never contained the name ‘Claisse’ used alone on the wares or in respect of the services and that the dates of first use appearing on the Applicant's application for registration are therefore erroneous”. It should be reiterated in this respect that Mr. Claisse was president of the Applicant from 1976 to 2000 and continued to be employed by the Applicant until 2002. On that point, I will add that Mr. Claisse's assertion is, in itself, consistent with the allegations in the Opponents' statement of opposition to the effect that the Applicant only used the “CLAISSE” Mark with Mr. Claisse's permission and consent and that Mr. Claisse, in his position as executive officer of the Applicant, had control of the character and quality of the Wares and Services in association with which the Mark was used.

[62]. In light of the foregoing, I am of the opinion that the Opponents have failed to meet their initial burden of proof as regards all of the services that are the subject of this application (for which the dates of first use claimed are, respectively, September 1988, January 1991 and April 1999). The Applicant's evidence regarding the dates of first use of the Services is not inconsistent with the dates of first use claimed in this application for registration. Rather, it supports those dates.

[63]. However, the Applicant's evidence is problematic with regard to the use of the Mark in association with the platinum-related accessories, fluxes and chemical products prior to the late 1990s.

[64]. Although I understand that it may be difficult for the Applicant to locate, in its archives, samples of use of the Mark dating back to the dates of first use claimed in the application, that is, May 1980 for the platinum-related accessories and April 1988 for the fluxes and chemical products, the fact remains that the evidence filed in this case for the period dating back from the late 1990s to these dates of first use is, for all practical purposes, nonexistent.

[65]. Indeed, the invoices provided for this period do not specifically mention that they are for “CLAISSE” mark moulds, crucibles, fluxes or chemical products. The only sample provided for this period that refers to the Mark is the advertisement dated November 15, 1989, filed as the abovementioned undertaking no. 1, which advertises “CLAISSE FLUXES (Borates and Phosphates)”. However, this advertisement does not contain any reproduction showing the Mark as marked on the fluxes as is the case for sample advertisements LS-9 and LS-10 dating from 1996. In and of itself, this advertisement is insufficient to show the use of the Mark in association with the fluxes within the meaning of section 4 of the Act. I add that the fact that during this time, the Applicant relied on external suppliers (such as Engelhard, as mentioned above) adds to the uncertainty surrounding the use of the Mark at that time, although I do acknowledge that reliance on external suppliers does not, in and of itself, preclude there having been use of the Mark.

[66]. Returning to the Applicant’s difficulty in locating samples of use of the Mark prior to the 1990s, I note that Ms. Simard stated at page 30 of her cross-examination that it would have been necessary to [TRANSLATION] “go through many boxes” of archive documents. In addition, as stated above, the Applicant apparently no longer has many of these samples in its possession because they were filed as part of litigation in court between the Applicant and the Opponent. In my opinion, the Applicant could have kept or obtained copies of all or part of the material filed in the course of that trial or continued its review of archive boxes in order to shore up its evidence in this case and meet its legal burden with regard to this ground of opposition, in light of the evidence adduced by the Opponents.

[67]. In fact, I believe that the Opponents have satisfied their initial burden of proof in relation to the second, third and fourth categories of wares that are the subject of this application and that the Applicant’s evidence is in itself incompatible with the dates of first use claimed in this application for registration. It is curious to note that the only acceptable samples of use of the Mark with regard to these three categories of wares all date from the 1990s and 2000s, that is, the period when the Applicant put greater emphasis on the word “CLAISSE” in its corporate identity. Moreover, starting in 2004, the Applicant eventually came to use just the word “CLAISSE” as its trade-name as evidenced by the abovementioned printout from the Enterprise

Register of Quebec. Since the Applicant has failed to meet its legal burden, in my opinion the ground of opposition based on section 30(b) of the Act should be allowed in relation to the second, third and fourth categories of wares that are the subject of this application.

[68]. To conclude, the ground of opposition based on section 30(b) is allowed with regard to all of the Wares. However, it is dismissed with regard to all of the Services.

*Ground based on section 30(a) of the Act*

[69]. The Opponents submit that the application does not fulfill the requirements of section 30(a) of the Act in that the Applicant falsely stated having used the Mark in Canada in association with each of the Wares and Services and, in the alternative or cumulatively, the Applicant abandoned the Mark, in whole or in part, by discontinuous use.

[70]. As argued, these allegations are not a valid ground of opposition within the meaning of section 30(a) of the Act, which pertains to the accuracy of the statement in ordinary commercial terms of the specific wares or services described in the application for registration. Inconsistencies in the application for registration with regard to the accuracy of the dates of first use or the mark used in this file relate to the ground of opposition based on section 30(b) discussed above.

[71]. Accordingly, I am of the opinion that the ground of opposition based on section 30(a) of the Act must be dismissed.

*Ground based on section 30(i) of the Act*

[72]. The Opponents submit that the application does not fulfill the requirements of section 30(i) of the Act, in that the Applicant falsely stated being satisfied that it is entitled to use the trade-mark in Canada in association with the Wares and Services; on the filing date of the application, the Applicant had to have known that the Mark is a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years;

that the Mark was not used in association with each of the Wares and Services on the claimed dates of first use; and that the Mark was abandoned by discontinuous use.

[73]. As argued, the ground of opposition based on 30(i) is not admissible. It is a mixture of the grounds of opposition based on sections 12(1)(a) and 30(b) of the Act discussed above.

[74]. In addition, I would add that there is no evidence on record supporting the conclusion that the Applicant could not be satisfied that it was entitled to use the Mark on the date of filing this application.

[75]. Accordingly, I am of the opinion that the ground of opposition based on section 30(i) must be dismissed.

(iii) *Grounds based on section 16 of the Act*

[76]. The Opponents submit the following:

[TRANSLATION]

1. . . . the Applicant is not the person entitled to registration of the Mark since the Mark is a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years, that is, the surname of Fernand Claisse. Furthermore, the Opponents base their opposition on the ground set forth at section 38(2)(c) of the Act, in that the Applicant is not the true owner of the “Claisse” Mark. It used the Mark only with the permission and consent of the Opponent Individual, Fernand Claisse, who, through his position as executive officer of the Applicant, had control of the character and quality of the wares and services in association with which the Mark was used and the use, advertisement and display of the Mark, without any admission whatsoever;
2. . . . the Applicant is not the person entitled to registration of the Mark within the meaning of section 16(1)(c) of the Act since, at the date on which the Applicant alleges to have first used the Mark in relation to each of the wares and services, it was confusing with a “Claisse” trade-mark owned and used by the Opponent Individual or the Opponent Corporation, without any admission whatsoever; and
3. . . . the Applicant is not the person entitled to registration of the Mark within the meaning of section 16(1) of the Act because the application being opposed fails to comply with the provisions of section 30 of the Act; the Mark was not used in Canada in association with each of the specific services and wares described in application no. 1 204 632, the Mark



was not first used in Canada in association with said services and wares on the dates of first use stated in said application, the Mark was abandoned in whole or in part owing to discontinuous use, and the Mark is a word that is primarily merely the name or the surname of an individual [*sic*] within the preceding thirty years.

[77]. As argued, the first and third grounds are not valid grounds of opposition within the meaning of section 16 of the Act, which aims to identify the persons eligible for registration of trade-marks with regard to these trade-marks being confusing with a trade-mark that had been previously used in Canada or made known in Canada, or a trade-mark in respect of which an application for registration had been previously filed, or else with a trade-name that had been previously used in Canada by any other person.

[78]. The only valid ground of opposition under section 16 argued by the Opponents is the part of the second ground which alleges that the Mark is confusing with the “Claisse” trade-mark owned and used by the Opponent Individual or the Opponent Corporation.

[79]. The Opponents can meet their initial burden of proof with regard to section 16(1)(a) of the Act by showing that their “Claisse” trade-mark was used or made known in Canada prior to the dates of first use claimed in the application and that they had not abandoned the use thereof at the date of advertisement of the application [section 16(5)].

[80]. As stated above, the Opponent Corporation, Fernand Claisse inc., was incorporated in March 2004, after the relevant dates, therefore rendering this ground of opposition invalid as regards the Opponent Corporation.

[81]. As for the Opponent Individual, Fernand Claisse, no evidence was filed in the record regarding the use of a so-called “CLAISSE” trade-mark owned by the Opponent Individual used prior to the relevant dates and not having been abandoned at the date of advertisement of this application. Consequently, the Opponent has failed to meet its initial burden of proof. Therefore, this ground of opposition is also dismissed as regards the Opponent Individual.

(iv) *Ground based on the non-distinctiveness of the Mark*

[82]. The Opponents submit the following:

[TRANSLATION]

1. . . . the Mark is not distinctive within the meaning of section 2 of the Act, since it does not distinguish the wares and services of the Applicant in association with which it is allegedly used from the wares and services of other persons. Furthermore, the Mark is confusing with the trade-name(s) or trade-marks(s) owned and used by the Opponent Individual or the Opponent Corporation at the relevant periods, without any admission whatsoever; and
2. . . . the Mark is not distinctive within the meaning of section 2 of the Act because it is a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years.

[83]. As stated above, the relevant date for the assessment of this ground of opposition, which is also partly based on the matter of confusion between the Mark and the Opponents' trade-marks or trade-names, is generally accepted to be the date of filing of the statement of opposition.

[84]. The Opponents may meet their initial burden of proof with regard to the lack of distinctiveness of the Mark by demonstrating that their trade-marks or trade-names had become sufficiently known in Canada at the date of the statement of opposition so as to deny the distinctiveness of the Mark [see *Motel 6, Inc. v. No.6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.)].

[85]. The Opponent Individual, Fernand Claisse, in his personal capacity, did not provide any evidence of use of a supposed "CLAISSE" "trade-mark" or "trade-name". Mr. Claisse states at paragraphs 3 to 7 of his first affidavit that the Opponent Corporation specializes in increasing the potential of borate fusion technology, the development of new products related to borate fusion and the development of new versions of various products he created in the past.

[86]. To reach these objectives, Mr. Claisse states that the Opponent Corporation (i) distributes a book written by himself and another author entitled *Physics and Chemistry of*

*Borate Fusion*; (ii) developed and distributes a CD-ROM containing over 110,000 absorption coefficients; (iii) developed and distributes a new Fluo-X software program called “XRFDirect”; and (iv) provides an online consultation service for fusion bead users. Mr. Claisse also states that the Opponent Corporation is currently developing a fusion apparatus and new fluxes to be marketed in 2006. Mr. Claisse states that in carrying out its operations, the Opponent Corporation uses its corporate name, and will use it in future.

[87]. It should be noted here that this evidence of the Opponent Corporation does not in any way establish the use of a supposed “Claisse” mark by the Opponent Corporation. At the most, this evidence alleges the use of the Opponent Corporation’s corporate name. Yet, I have no information on this point allowing me to assess the extent to which this corporate name was used in Canada and the goodwill attached thereto.

[88]. On the matter of the confusion, Mr. Claisse states at paragraph 48 of his first affidavit that on several occasions, customers, possibly misled by the use of his name, addressed themselves to him during conference-expositions, at meetings or in e-mails, believing that they were dealing with a person in charge of the Applicant, and were surprised to learn that he had not been with that company for four years. The only pieces of correspondence filed by Mr. Claisse are those which he received from four scientists, including one Canadian, in order to show that the name “CLAISSE” is associated directly with his person.

[89]. More specifically, in one of those pieces of correspondence, the author expresses surprise at learning that the Opponent Individual was dismissed from the Applicant and wishes him good luck in his legal proceedings against the Applicant. This piece of correspondence seems to be part of an exchange of e-mails, which, however, were not included in the copy filed.

[90]. Another piece of correspondence is an e-mail dated October 12, 2004, addressed to the Opponent Individual at what seems to be a personal e-mail address (fclaisse@videotron.ca), inviting him to participate, as a speaker, in a conference to take place in China in October 2005. The e-mail states, “We have known [*sic*] that your company has 50 years of fusion experience”.

[91]. The two other pieces of correspondence begin with the salutation “To Whom It May Concern” and are intended to praise Mr. Claisse for his contributions to scientific research and to the Applicant’s success.

[92]. To me, the Opponents’ evidence seems insufficient to establish that the Opponent Corporation’s trade-name had become sufficiently known in Canada at the date of the statement of opposition so as to disprove the distinctiveness of the Mark. In that regard, I believe that the Opponents have failed to meet their initial burden of proof.

[93]. As for the ground of opposition based on the lack of distinctiveness of the Mark for the reason that it is primarily a surname, my earlier comments pertaining to the ground of opposition based on section 12(1)(a) of the Act apply. I would add on this point that the Opponent Individual’s apparent international renown in the field of chemical analysis by X-ray is not, in itself, sufficient to disprove the distinctiveness of the Mark in Canada, given that it seems to me to be difficult, as mentioned above, to attribute this renown solely to the Opponent Individual and not also, in part, to the Applicant.

[94]. In summary, the grounds of opposition based on the lack of distinctiveness of the Mark must be dismissed.

*Disposition*

[95]. Considering the foregoing and in the exercise of the powers delegated to me under the provisions of section 63(3) of the Act, I refuse the application for registration with regard to all of the Wares and I reject the opposition with regard to all of the Services under section 38(8) of the Act [see *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 482 (F.C.T.) as the authority on divided outcomes].

DATED AT MONTRÉAL, QUEBEC, ON OCTOBER 28, 2009.

Annie Robitaille  
Member  
Trade-marks Opposition Board

Certified true translation  
Sarah Burns