

**IN THE MATTER OF AN OPPOSITION by COMPUSA INC.
to application No. 717,014 for the trade-mark COMPUBANK
filed by Multitech Electronics Inc.**

On November 16, 1992, the applicant, Multitech Electronics Inc., filed an application to register the trade-mark COMPUBANK based on proposed use in Canada in association with the “Operation of a business dealing in the retail sales, maintenance and installation of office equipment and business machines, software, peripherals and related parts and accessories thereof”.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of July 28, 1993 and the opponent, COMPUSA INC., filed a statement of opposition on January 28, 1994, a copy of which was forwarded to the applicant on May 5, 1994. The applicant served and filed a counter statement on May 24, 1994. The opponent submitted as its evidence the affidavit of Robert W. White and two affidavits of Mark R. Walker, dated December 16, 1994 and January 16, 1995. The applicant filed as its evidence the affidavits of Kendra Preston-Brooks, Donna Harris and three affidavits of Al-Kamir A. Chatur, two of which are dated February 7, 1997 and the third is dated February 6, 1996. The parties subsequently agreed that the Harris affidavit would not form part of the applicant’s evidence in this opposition and, as a result, the Harris affidavit was returned to the applicant by way of the Office letter of March 23, 1998. Kendra Preston-Brooks and Al-Kamir A. Chatur were cross-examined on their affidavits, the transcripts of the cross-examinations and the responses to undertakings given during the cross-examinations forming part of the opposition record. Both parties submitted written arguments and both were represented at an oral hearing.

The following are the grounds of opposition asserted by the opponent:

- a) The present application does not comply with Section 30 of the *Trade-marks Act* in that the applicant could not have been satisfied that it was entitled to use the trade-mark COMPUBANK in Canada in view of the opponent’s prior use and applications for registration of the trade-marks COMP USA and COMP USA THE COMPUTER SUPERSTORE;
- b) The present application does not comply with Subsection 16(2) [sic] of the *Trade-marks Act* in that the applicant is not the person entitled to registration in that, as of the applicant’s filing date, the trade-mark COMPUBANK was confusing with the trade-marks COMP USA, COMP USA THE COMPUTER SUPERSTORE and COMP USA THE COMPUTER SUPERSTORE & Design, previously used and made known in Canada by the opponent in association with retail store services relating to the sale of computer software and accessories;

c) The present application does not comply with Subsection 16(2) [sic] of the *Trade-marks Act* in that the applicant is not the person entitled to registration in that, as of the applicant's filing date, the trade-mark COMPUBANK was confusing with the trade-names COMP USA and COMP USA THE COMPUTER SUPERSTORE, previously used and made known in Canada by the opponent in association with retail store services relating to the sale of computer software and accessories;

d) The present application does not comply with Subsection 16(2) [sic] of the *Trade-marks Act* in that the applicant is not the person entitled to registration because, as of the applicant's filing date, the trade-mark COMPUBANK was confusing with the trade-marks COMP USA THE COMPUTER SUPERSTORE & Design and COMP USA THE COMPUTER SUPERSTORE, for which applications were previously filed in Canada under application Nos. 698,395 and 698,397 by the opponent;

e) The applicant's trade-mark is not distinctive and is not adapted to distinguish the services of the applicant from the services of others, in particular, the opponent.

The first ground of opposition is based on Subsection 30(i) of the *Trade-marks Act*, the opponent asserting that the applicant could not have been satisfied that it was entitled to use the trade-mark COMPUBANK in Canada in association with the services covered in its application in view of the opponent's prior use and applications for registration of the trade-marks COMP USA and COMP USA THE COMPUTER SUPERSTORE. With respect to its first ground, the legal burden or onus is on the applicant to show that its application complies with Section 30 of the *Trade-marks Act*. This includes both the question as to whether or not the applicant has filed an application which formally complies with the requirements of Section 30 and the question as to whether or not the statements contained in the application are correct. To the extent that the opponent relies on allegations of fact in support of its Section 30 ground, there is an initial burden on the opponent to prove those allegations [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330].

No evidence has been furnished by the opponent to show that the applicant was aware of the opponent's trade-marks or trade-names prior to filing the present application. Moreover, even were the applicant to have had constructive notice of the opponent's trade-mark applications prior to filing the present application, no evidence has been furnished to show that the applicant could not have been satisfied that it was entitled to use its trade-mark COMPUBANK in Canada in association with the services covered in the present application on the basis *inter alia* that its trade-mark is not confusing with the opponent's trade-marks. Thus, the success of the Subsection 30(i) ground is

contingent upon a finding that the applicant's trade-mark is confusing with one or more of the opponent's trade-marks or trade-names as alleged in the remaining grounds of opposition [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at p. 195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152, at p. 155]. I will therefore consider the remaining grounds of opposition relied upon by the opponent.

The second ground of opposition is based on Paragraph 16 of the *Trade-marks Act*, the opponent alleging that the applicant is not the person entitled to registration of the trade-mark COMPUBANK in that, as of the applicant's filing date, the applied for trade-mark was confusing with the trade-marks COMP USA, COMP USA THE COMPUTER SUPERSTORE and COMP USA THE COMPUTER SUPERSTORE & Design which had been previously used and made known in Canada by the opponent in association with retail store services relating to the sale of computer software and accessories. I would note that the applicant objected to the opponent's Section 16 grounds as not identifying the correct subsection of Section 16 of the *Act*. However, the facts alleged by the opponent properly support grounds of opposition under Subsection 16(3) of the *Act* and the applicant certainly has not been misled by the opponent's error. In this regard, I would note that the applicant in its written argument identified the correct subsections of Section 16 in its summary of the opponent's grounds of opposition. I have therefore dismissed the applicant's technical objection to the non-entitlement grounds of opposition.

The opponent has adduced two affidavits of Mark R. Walker, Vice-President, General Counsel and Secretary of the opponent. In his first affidavit dated December 19, 1994, Mr. Walker states that Soft Warehouse, Inc. opened its first retail store in Dallas, Texas in 1985 under the name SOFT WAREHOUSE and, on April 12, 1991, Soft Warehouse, Inc. changed its name to Comp USA Inc. which, in turn, changed its name to CompUSA Inc. on October 18, 1991. According to Mr. Walker, there were 76 COMPUSA stores in the United States as of June 25, 1994, three of which were located in Michigan and a fourth in the state of Washington. Further, from Exhibit "O" to the first Walker affidavit, it would appear that there were only 20 COMPUSA store locations in the United States as of December of 1991, only one of which was located in Michigan. However, the opponent's evidence does not indicate the number of stores in operation in the United States as

of the applicant's filing date or the number which were in close proximity to the Canadian border as of that date.

Mr. Walker also states in his first affidavit that the opponent's COMPUSA stores have sold computer hardware, software and related accessories to the general public including Canadian businesses and individuals since April, 1991. Further, according to the affiant, the sales to Canadian businesses and individuals "originated from advertisements placed in newspapers and magazines which circulate in Canada, catalogues and from Canadians travelling in the United States". Mr. Walker has annexed as Exhibit "L" to his first affidavit "a bundle of invoices for products shipped from COMPUSA stores in the United States to Canadian addresses, including addresses in Alberta and Ontario". Seven of the invoices and accompanying shipping documents relate to transactions where shipments were made by the applicant to Canadian addresses prior to the applicant's filing date, the material date in relation to the second ground of opposition.

In paragraph 12 of his first affidavit, Mr. Walker refers to the Fall 1994 Business Buyer's Guide which is a catalogue of products available at all COMPUSA stores in the United States. In his second affidavit, Mr. Walker states that the Buyer's Guides are frequently requested and provided to Canadian residents. However, Mr. Walker does not indicate when such guides were first available to its customers, that is, whether such guides were available prior to the applicant's filing date [November 16, 1992] or prior to the date of opposition [January 28, 1994], the material dates in this proceeding. Further, in paragraph 16, the affiant notes that since 1991 the opponent has advertised in print publications including computer journals such as PC Magazine, PC/Computing and Computer Shopper, as well as in other publications such as USA Today, The Wall Street Journal, Fortune and The Washington Post.

Annexed to the first Walker affidavit are *inter alia* copies of advertisements which appeared in The Wall Street Journal in November of 1991 and in Fortune magazine on December 16, 1991 and annexed to his second affidavit are copies of ads from The Detroit News (December 25, 1994) and The Seattle Times (December 25, 1994) bearing the trade-mark COMPUSA which the affiant states are representative of those which have been placed since 1991. Also annexed to the second

Walker affidavit are copies of four of the opponent's magazine advertisements dated between December of 1994 and February of 1995. According to Mr. Walker, these advertisements are also representative of ads placed in magazines which have circulated in Canada since 1991.

As no reliable evidence has been furnished by the opponent relating to the circulation of The Detroit News, USA Today, The Washington Post, The Seattle Times or any of the computer-related magazines in Canada, I am not prepared to accord much weight to this evidence. On the other hand, the opponent submitted the affidavit of Robert W. White, Senior Vice-President, Canada of the Audit Bureau of Circulations, with respect to the circulation of Fortune magazine and The Wall Street Journal in Canada. Mr. White states that the Canadian circulation of The Wall Street Journal for the twelve months ending March 31, 1992 was 7,603, based on the distribution of the March 31, 1992 issue while the Canadian circulation for Fortune magazine for the six months ending December 31, 1991 was 43,989 based on the distribution of the August 26, 1991 issue. While the applicant challenged the accuracy of the figures relied upon by Mr. White, I am satisfied from his evidence that there was at least some minor exposure of the opponent's marks in printed publications which circulated in Canada prior to the applicant's filing date.

Mr. Walker also refers to radio advertisements which he claims were available over the air to Canadians although the affiant does not state when such advertising commenced. In this regard, the only specific advertisements identified by Mr. Walker are dated in October and November of 1994 and therefore subsequent to the applicant's filing date and the date of opposition. Also, the affiant makes reference to spillover television advertising into Canada featuring the trade-mark COMPUSA from cities such as New York, Detroit, Seattle, Los Angeles, San Francisco, Chicago, Dallas, Washington and Atlanta. Mr. Walker states that he is informed and verily believes that many of these stations are regularly viewed in Canada as a result of over the air or cable broadcasting into Canada. However, this evidence is clearly hearsay and I am therefore not prepared to accord any weight to it.

Considering initially the opponent's claim that it has made its trade-marks known in Canada, Section 5 of the *Trade-marks Act* provides as follows:

5. A trade-mark is deemed to be made known in Canada by a person only if it is used by that person in a country of the Union, other than Canada, in association with wares or services, and
- (a) the wares are distributed in association with it in Canada, or
 - (b) the wares or services are advertised in association with it in
 - (i) any printed publication circulated in Canada in the ordinary course of commerce among potential dealers in or users of the wares or services, or
 - (ii) radio broadcasts ordinarily received in Canada by potential dealers in or users of the wares or services,
- and it has become well known in Canada by reason of the distribution or advertising.

The opponent's evidence certainly does not establish that its trade-marks were "well known in Canada" as of the applicant's filing date by reason of the advertisement of its services in printed publication which have circulated in Canada. As a result, the second ground remains to be determined on the basis of the opponent's alleged prior use of its trade-marks in Canada.

The opponent claims that it has used its trade-marks in Canada prior to November 16, 1992 in association with its retail store services. The opponent does not operate any retail stores in Canada and does not pursue any sales to the Canadian government or to educational institutions in Canada [see paragraph 5, second Walker affidavit]. However, the opponent has relied upon its evidence relating to the shipment of goods to Canadian customers, print advertising relating to its COMPUSA stores appearing in magazines and newspapers which have circulated in Canada, as well as spillover television and radio advertising into Canada, to show that it has used its trade-marks in Canada in association with its retail store services.

The opponent's shipment of its computer software and computer accessories to Canada prior to the applicant's filing date can, in my view, be characterized as the performance of one aspect of the opponent's retail store services relating to the sale of computer software and accessories. Further, this aspect of the opponent's services is provided to the opponent's customers in Canada. As a result, I find that the opponent has arguably used its trade-marks COMPUSA, COMP USA THE COMPUTER SUPERSTORE and COMP USA THE COMPUTER SUPERSTORE & Design in Canada in association with its services prior to the applicant's filing date. Moreover, I am satisfied that the opponent had not abandoned its trade-mark as of the date of advertisement of the present application in the *Trade-marks Journal*. The opponent has therefore met its burden under Subsections 16(5) and 17(1) of the *Act* in relation to the second ground.

In view of the above, the legal burden is on the applicant to satisfy the Registrar that there would be no reasonable likelihood of confusion between its trade-mark and the opponent's trade-marks COMPUSA, COMP USA THE COMPUTER SUPERSTORE and COMP USA THE COMPUTER SUPERSTORE & Design. In assessing whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances including, but not limited to, the criteria which are specifically enumerated in Subsection 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks of the parties as of the applicant's filing date.

Considering initially the inherent distinctiveness of the trade-marks at issue [Para. 6(5)(a)] and the extent to which the marks have become known [Para. 6(5)(a)], the applicant's trade-mark COMPUBANK possesses a fair degree of inherent distinctiveness when considered in its entirety despite the fact that the prefix COMP would be perceived as an abbreviation for the word "computer" when the mark is applied to the applicant's services. However, the applicant's mark has not become known to any extent in Canada. The opponent's trade-mark COMPUSA possesses somewhat less inherent distinctiveness than does the applicant's mark in that it comprises the suggestive prefix COMP while the suffix USA identifies the geographic location of the opponent. Further, the opponent's trade-marks COMPUSA THE COMPUTER SUPERSTORE and COMPUSA THE COMPUTER SUPERSTORE & Design possess some measure of inherent distinctiveness when considered in their entireties although the words COMPUTER SUPERSTORE are descriptive when applied to the opponent's services. The opponent's evidence establishes that its marks have become known to a very minor extent in Canada as of the applicant's filing date. As a result, the extent to which the trade-marks at issue have become known [Para. 6(5)(a)] and the length of time the trade-marks have been in use [Para. 6(5)(b)] both weigh in the opponent's favour but not to any significant extent.

As for the nature of the services [Para. 6(5)(c)] and the nature of the trade of the parties [Para. 6(5)(d)], the applicant's services as covered in the present application are defined as the operation of a business dealing in the retail sales, maintenance and installation of office equipment and

business machines, software, peripherals and related parts and accessories thereof. These services appear to overlap the opponent's retail store services relating to the sale of computer software and accessories. Further, while the applicant in its evidence has sought to distinguish its services from those of the opponent, it is the services covered in the applicant's application which must be considered in assessing the likelihood of confusion in relation to the Section 16 ground and not the services which the applicant contemplates rendering in association with its trade-mark COMPUBANK. Moreover, in view of the overlap in the services of the parties, I would expect that there could be a potential overlap in the channels of trade of the parties.

Considering next the degree of resemblance between the trade-marks at issue [Para. 6(5)(e)], the trade-marks COMPUBANK and COMPUSA bear some similarity in appearance, sounding and in the ideas suggested. However, there is relatively little similarity in appearance, sounding or in the ideas suggested between the applicant's mark and the opponent's trade-marks COMPUSA THE COMPUTER SUPERSTORE and COMPUSA THE COMPUTER SUPERSTORE & Design when these marks are considered in their entirety as a matter of immediate impression and imperfect recollection.

The applicant submitted that an additional surrounding circumstance in the present case is the state of the register evidence introduced by the affidavit of Kendra Preston-Brooks. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [see *Ports International Ltd. v. Dunlop Ltd.*, 41 C.P.R.(3d) 432; and *Del Monte Corporation v. Welch Foods Inc.*, 44 C.P.R.(3d) 205 (F.C.T.D.)]. Also, the decision in *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.*, 43 C.P.R.(3d) 349 (F.C.A.) supports the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

In the present opposition, the affidavit of Ms. Preston-Brooks establishes that there are more than sixty third party registrations for trade-marks which include the prefix COMP as applied to computers, computer software and related services. Moreover, there are more than twenty-five additional third party registrations including the prefix COMP covering the sale of computers or

computer software, services relating to training or to the servicing of computers. I have concluded therefore that a number of these marks would be in use in the marketplace and that consumers would therefore be more likely to differentiate such marks based on their other components.

The applicant also sought to rely upon telephone directory and other searches conducted by Mr. Chatur, as well as his evidence relating to the use of third party trade-marks in the Edmonton area. However, the results of the searches conducted by Mr. Chatur are of little relevance as they were conducted long after the material date for considering the Section 16 grounds. Further, while Mr. Chatur in his affidavit of February 7, 1996 states that he is aware of a computer store in Edmonton trading under the name CompuSmart and that it has been in operation for over two years, this evidence covers a period commencing more than a year after the material date. Likewise, Mr. Chatur's comments concerning the existence of a computer retail business in Edmonton known as Compu-ware which provides computer hardware, computer software and related services is of little assistance to the applicant insofar as establishing the state of the marketplace as of November of 1992.

Having regard to the foregoing and, in particular, to the inherent weakness of the opponent's marks and the fact that there has been almost common adoption of the prefix COMP in the computer area, I have concluded that the differences between the trade-marks at issue are such that there would be no reasonable likelihood of confusion between them. I have therefore rejected the second ground of opposition.

The third ground also relates to the applicant's entitlement to registration, the opponent alleging that the trade-mark COMPUBANK was confusing with the trade-names COMP USA and COMP USA THE COMPUTER SUPERSTORE which had been previously used and made known in Canada by the opponent in association with retail store services relating to the sale of computer software and accessories. As Paragraph 16(3)(c) of the *Trade-marks Act* does not contemplate a ground of opposition based on prior making known of a trade-name, I have dismissed this aspect of the third ground. Further, and having regard to my comments concerning the likelihood of confusion between the applicant's mark and the opponent's trade-marks, and even assuming that the opponent

has met its burden under Subsections 16(5) and 17(1) in relation to this ground, I find that there would be no reasonable likelihood of confusion between the applicant's trade-mark COMPUBANK and the opponent's trade-names, bearing in mind the inherent weakness of the opponent's names and the fact that there has been almost common adoption of the prefix COMP in the computer area and considering the differences between the applicant's trade-mark and the opponent's trade-names. I have therefore dismissed the third ground of opposition.

As its fourth ground, the opponent has alleged that the applicant is not the person entitled to registration because, as of the applicant's filing date, the trade-mark COMPUBANK was confusing with the trade-marks COMP USA THE COMPUTER SUPERSTORE & Design and COMP USA THE COMPUTER SUPERSTORE, for which applications were previously filed in Canada by the opponent under application Nos. 698,395 and 698,397. The applicant has questioned the admissibility of the copies of the opponent's pending applications submitted by the opponent as evidence in this opposition. As noted in *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.*, 11 C.P.R. (3d) 410, the Registrar does have the discretion, in view of the public interest to maintain the purity of the register, to check the register in order to confirm the existence of registrations relied upon by the opponent in support of its Paragraph 12(1)(d) ground. Likewise, having regard to the potential public interest in assessing a Paragraph 16(1)(b), 16(2)(b) or 16(3)(b) ground, the Registrar will exercise his discretion to check the Trade-marks Office records to confirm the existence of a pending application or pending applications being relied upon in support of such a ground [see *Royal Appliance Mfg. Co. v. Iona Appliances Inc.*, 32 C.P.R. (3d) 525, at p. 529]. In doing so, I noted that the opponent's applications for registration of the trade-marks COMP USA THE COMPUTER SUPERSTORE & Design [application No. 698,395] and COMP USA THE COMPUTER SUPERSTORE [application No. 698,397] were both filed February 5, 1992 and were still pending as of the date of advertisement of the present application [July 28, 1993]. The opponent has therefore met its burden under Subsection 16(4) in relation to this ground.

In view of the above, the legal burden is on the applicant to satisfy the Registrar that there would be no reasonable likelihood of confusion between its trade-mark COMPUBANK and the

opponent's trade-marks COMP USA THE COMPUTER SUPERSTORE & Design and COMP USA THE COMPUTER SUPERSTORE. In assessing whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances including, but not limited to, the criteria which are specifically enumerated in Subsection 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks of the parties as of the applicant's filing date.

Considering initially the inherent distinctiveness of the trade-marks at issue, and as noted above, the applicant's trade-mark COMPUBANK possesses a fair degree of inherent distinctiveness when considered in its entirety while the opponent's trade-marks COMPUSA THE COMPUTER SUPERSTORE and COMPUSA THE COMPUTER SUPERSTORE & Design possess some measure of inherent distinctiveness when considered in their entireties although the words COMPUTER SUPERSTORE are descriptive when applied to the opponent's services. As for the extent to which the marks have become known, the applicant's trade-mark has not become known to any extent as of the applicant's filing date while the opponent's evidence establishes that its marks had become known to a very minor extent in Canada as of that date. As a result, the extent to which the trade-marks at issue have become known and the length of time the trade-marks have been in use both weigh somewhat in the opponent's favour.

As also noted above, the applicant's "operation of a business dealing in the retail sales, maintenance and installation of office equipment and business machines, software, peripherals and related parts and accessories thereof" overlaps the opponent's retail store services relating to the sale of computer software and accessories. Further, in view of the overlap in the services of the parties, I would expect that there could be a potential overlap in the channels of trade of the parties. There is relatively little similarity in appearance, sounding or in the ideas suggested between the applicant's mark and the opponent's trade-marks COMPUSA THE COMPUTER SUPERSTORE and COMPUSA THE COMPUTER SUPERSTORE & Design. Additionally, the affidavit of Ms. Preston-Brooks establishes that there are a large number of third party registrations for trade-marks which include the prefix COMP as applied to computers, computer software and related services,

as well as a significant number of third party COMP mark covering the sale of computers or computer software, services relating to training or to the servicing of computers. I have concluded therefore that a number of these marks would be in use in the marketplace and that consumers would therefore be more likely to differentiate such marks based on their other components.

Considering the inherent weakness of the opponent's marks and the fact that there has been almost common adoption of the prefix COMP in the computer area, and bearing in mind that there is relatively little similarity in appearance, sounding or in the ideas suggested between the applicant's mark and the opponent's trade-marks COMP USA THE COMPUTER SUPERSTORE & Design and COMP USA THE COMPUTER SUPERSTORE, I find that there would be no reasonable likelihood of confusion between them and have rejected the fourth ground of opposition.

With respect to the final ground relating to the alleged non-distinctiveness of the applicant's trade-mark., the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares and services from those of others throughout Canada [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.*, 4 C.P.R.(3d) 272 (T.M.O.B.)]. Furthermore, the material time for considering the circumstances respecting this issue is as of the filing date of the statement of opposition [see *Re Andres Wines Ltd. and E. & J. Gallo Winery*, 25 C.P.R.(2d) 126, at p. 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.*, 37 C.P.R.(3d) 412, at p. 424 (F.C.A.)]. Finally, there is an evidential burden on the opponent to prove the allegations of fact supporting its ground of non-distinctiveness. However, in the present case, the opponent has not recited any facts in paragraph 1 (e) of its statement of opposition which would support its non-distinctiveness ground of opposition and the ground is therefore arguably contrary to Paragraph 38(3)(a) of the *Trade-marks Act* [see *Benson & Hedges (Canada) Ltd. v. Imasco Ltd.*, 25 C.P.R. (2d) 269, at p. 272].

Even assuming that the opponent is relying upon the facts alleged in its other grounds as supporting its non-distinctiveness ground, the other grounds of opposition have been rejected on the basis that there would be no reasonable likelihood of confusion between the applicant's trade-mark and the opponent's trade-marks and trade-names. While the material date for considering the final

ground is the date of opposition, my conclusion concerning the likelihood of confusion between the applicant's mark and the opponent's trade-marks and trade-names would be the same as of that date. Moreover, the opponent has not shown that its marks have become known sufficiently in Canada to negate the distinctiveness of the applicant's proposed mark, even bearing in mind that it is not necessary for the opponent to show that its trade-marks are well known in Canada or that they have been made known solely by the restricted means set forth in Section 5 of the Act [see *Motel 6, Inc. v. No. 6 Motel Ltd.*, 56 C.P.R.(2d) 44, at p. 55 (F.C.T.D.)]. As a result, the final ground is unsuccessful.

Having been delegated by the Registrar of Trade-marks pursuant to Section 63(3) of the *Trade-marks Act*, I reject the opponent's opposition pursuant to Section 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS 18th DAY OF NOVEMBER, 1999.

G.W. Partington
Chairperson
Trade-marks Opposition Board.