



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2013 TMOB 78**  
**Date of Decision: 2013-04-25**

**IN THE MATTER OF AN OPPOSITION  
by Carl Zeiss AG to application  
No. 1,505,763 for the trade-mark  
DATAFLOW in the name of IMRIS Inc.**

File Record

[1] On November 29, 2010 IMRIS Inc. (the Applicant) filed an application to register the trade-mark DATAFLOW (the Mark). The application was filed on the basis of proposed use in association with:

A modular, open architecture surgical suite information management system, namely, a data management and intraoperative system control platform integrating with hospital surgical, interventional and diagnostic video sources, permitting operators access to the system through a touch screen-based graphical user interface, to provide centralized control over video data routing and display, network video streaming and conferencing, digital recording and still image capture, and audio communications (the Wares).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of June 1, 2011. Carl Zeiss AG (the Opponent) filed a statement of opposition on July 19, 2011. It was amended twice with permission of the Registrar.

[3] The grounds of opposition as pleaded are the following:

1. The application does not comply with the requirements of section 30(e) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) in that the Applicant at the filing date of the application was already using the Mark in Canada;

2. The application does not comply with the requirements of section 30(e) and (h) of the Act in that the trade-mark proposed to be used in Canada is not the Mark but another, different from the one referred to in the application;
3. The application does not comply with the requirements of section 30(e) of the Act in that the Applicant at the filing date of the application never intended to use the Mark in Canada with each of the wares in that the wares to which the Applicant intends to associate the Mark are wares different from the Wares and furthermore, the Applicant does not intend to use the Mark as a trade-mark but only as a mere descriptive term of one of the possible functions of the ware for which the registration of the Mark has been requested;
4. The application does not comply with the requirements of section 30(e) of the Act in that the Mark is not a trade-mark since it is solely ornamental and decorative;
5. The statement that the Applicant is satisfied as to its entitlement to the use of the Mark in Canada is false in view of the content of the present opposition, including the knowledge of the Applicant of the rights of the Opponent as herein alleged and the unlawfulness of said use, if any, as:
  - a) such use would be, was and is unlawful in that such use is encroaching upon the proprietary rights, as alleged therein, of the Opponent;
  - b) such use would be, was and is unlawful in that such use is likely to have the effect of depreciating the value of the goodwill attaching to the trade-mark alleged by the Opponent, contrary to section 22 of the Act;
  - c) such use would be, was and is unlawful in that such use would direct public attention to Applicant's wares, services or business in such a way as to cause confusion in Canada between these wares, services or business and those of the Opponent contrary to section 7(b) of the Act;
6. The application does not contain, contrary to section 30(a) of the Act, a statement in ordinary commercial terms of the Wares, not having, in the context of the opposed application, the required degree of specificity required by the Act and being gibberish, not allowing third parties to ascertain the nature of the Wares;
7. The Mark is not registrable in view of section 12(1)(d) of the Act since the Mark is confusing with the Opponent's registered trade-mark FLOW, certificate of registration TMA773,365 in association with software used

during neurosurgery to visualize and interpret the circulation of blood and to analyze data from the operation;

8. The Mark is not registrable in view of section 12(1)(b) of the Act since the Mark is either clearly descriptive or deceptively misdescriptive in the English language of the character or quality of the Wares. The term “data” is defined as facts or figures to be processed; evidence, records, statistics, etc. from which conclusions can be inferred; the term “flow” is defined as “a continuous production”. Taken together, the Mark would be perceived by consumers as describing a feature of the purpose of the Wares- that is management system that allows the continuous production of information through video, digital recording, still image capture and audio communication. As applied to the Wares, the Mark, taken as a whole, merely refers to a system that allows the continuous production of information. Accordingly, the Mark is clearly descriptive (or if such is not the feature of the purpose of the Wares, deceptively misdescriptive);
9. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(3)(a) of the Act in that at the filing date of the application the Mark was confusing with the Opponent’s trade-mark FLOW which had been previously used by the Opponent or its predecessor in title in Canada in association with medical software, and more particularly in the surgical field;
10. The Applicant is not the person entitled to the registration of the Mark pursuant to the introductory paragraph of section 16(3) of the Act in that the application does not comply with the requirements of section 30 of the Act; the Mark is not a proposed one but rather an used one, in whole or in part; and the Mark is not registrable or does not function as a trade-mark, namely that the Mark does not or is not adapted to distinguish the wares of the Applicant from those of others, being merely decorative;
11. Pursuant to section 38(2)(d) of the Act, the Mark is not distinctive of the wares or services of the Applicant since:
  - a) The Mark does not actually distinguish the wares or services in association with which the Mark is used or proposed to be used by the Applicant from the wares or services of the Opponent, nor is adapted to so distinguish them;
  - b) The Mark is used outside the scope of licensed use provided for by section 50 of the Act, including by IMRIS, Inc, IMRIS (Europe) SPRL, IMRIS India Private Limited, IMRIS KK, NeuroArm Surgical Limited and IMRIS Germany GmbH;
  - c) As a result of the transfer of the Mark rights subsist in two or more persons, including IMRIS, Inc, IMRIS (Europe) SPRL,

IMRIS India Private Limited, IMRIS KK, NeuroArm Surgical Limited and IMRIS Germany GmbH, to the use of trade-marks confusing with the Mark and those rights were exercised by those persons, contrary to section 48(2) of the Act;

- d) The Mark does not or is not adapted to distinguish the wares or services of the Applicant from those of others, being merely decorative.

[4] In a counter statement filed on August 24, 2011 the Applicant essentially denied all grounds of opposition.

[5] The Opponent filed as its evidence the affidavit of Gontran Paquette Barrette and a certified copy of registration TMA773,365 for the trade-mark FLOW while the Applicant filed the affidavits of Michael Robbie and Jameson Ade.

[6] Both parties filed a written argument but the Opponent's written argument does not contain any substantive argumentation. No hearing was held.

#### Legal Onus and Burden of Proof

[7] The legal onus is upon the Applicant to show that the application complies with the provisions of the Act, but there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) and *Wrangler Apparel Corp v The Timberland Company* [2005] FC 722].

#### Grounds of Opposition Summarily Dismissed

[8] The Opponent has not filed any evidence to meet its initial factual burden in so far as grounds of opposition 1, 2, 4, 5b) and c) (on the assumption that they are both valid grounds of opposition, a question that I obviously do not need to address), 6, 9, and 11.

[9] As for the tenth ground of opposition, it is not a valid ground of opposition. The introductory paragraph of section 16 of the Act does not constitute the basis of a ground of opposition. In any event, the Opponent already included in its statement of opposition grounds of opposition based on compliance to the provisions of section 30 of the Act and distinctiveness.

[10] With respect to the third ground of opposition, the Opponent claims that the Applicant never had the intention to use the Mark in association with the Wares. However, no evidence has been filed to support this portion of this ground of opposition. It is therefore dismissed. I note that the Opponent pleads that the Applicant did not intend to use the Mark as a trade-mark but only as a mere descriptive term of one of the possible functions of the Wares. This issue shall be dealt with section 12(1)(b) ground of opposition (the eighth ground of opposition).

[11] Ground of opposition 5a) is vague and ambiguous. If the Opponent intended to rely on its certificate of registration TMA773,365 as its proprietary rights, the ground of opposition based on section 12(1)(d) of the Act already covers such situation. If it intended to rely on prior use of its trade-mark FLOW, ground of opposition based on section 16(3) of the Act covers that situation. Consequently ground of opposition 5a) is redundant with what has been already pleaded by the Opponent.

[12] All that remains to be disposed of are grounds of opposition 7 and 8.

#### Ground of Opposition based on Section 12(1)(b) of the Act

[13] The registrability of the Mark under section 12(1)(b) of the Act must be assessed as of the filing date of the application (November 29, 2010) [see *Dic Dac Holdings (Canada) Ltd v Yao Tsai Co* (1999), 1 CPR (4th) 263 (TMOB), *Zorti Investments Inc v Party City Corporation* (2004), 36 CPR (4th) 90 (TMOB); *Havana Club Holdings SA v Bacardi & Company Limited*, (2004) 35 CPR (4th) 541 (TMOB)].

[14] The issue as to whether the Mark is clearly descriptive or deceptively misdescriptive of the character or quality of the wares must be considered from the point of view of the average purchaser of the wares. Further, “character” means a feature, trait or characteristic of the wares and “clearly” means “easy to understand, self-evident or plain” [see *Drackett Co of Canada Ltd v*

*American Home Products Corp* (1968), 55 CPR 29 (Ex. Ct.) at 34]. The Mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD) at 27-8; *Atlantic Promotions Inc v Registrar of Trade Marks* (1984), 2 CPR (3d) 183 (FCTD) at 186]. Finally, the purpose of the prohibition in s. 12(1)(b) is to prevent any single trader from monopolizing a term that is clearly descriptive or common to the trade, thereby placing legitimate traders at a disadvantage [see *Canadian Parking Equipment Ltd v Canada (Registrar of Trade-marks)* (1990), 34 CPR (3d) 154 (FCTD) at para. 15].

[15] Common sense must also be taken into consideration. Mr. Justice Mandamin of the Federal Court of Appeal stated:

*Common Sense*

48 In *Neptune S.A. c. Canada (Procureur général)*, 2003 FCT 715 (Fed. T.D.) (*Neptune S.A.*), Justice Martineau stated that the decision maker must not only consider the evidence at his or her disposal but also common sense in the assessment of the facts. Therefore, in assessing the validity of a proposed trade-mark, one must consider not only the evidence but have regard to common sense. Moreover, the decision that the trade-mark is clearly descriptive is to be based on the initial impression having regard to the wares or services in question: *Neptune S.A.* [see *Ontario Teachers' Pension Plan Board v Canada (Attorney General)* (2010), 89 CPR (4th) 301 (FC); aff'd (2012), 99 CPR (4th) 213 (FCA)].

[16] It is with these principles in mind that I shall now review what I consider to be relevant evidence to this ground of opposition.

[17] Without any detailed written argument or oral representations at a hearing it is difficult for the undersigned to speculate on the position taken by the Opponent with respect to this ground of opposition. The Opponent's evidence on this issue is limited to the affidavit of Mr. Paquette Barrette, a student working for the Opponent's agent firm. His affidavit includes as an exhibit a copy of the corresponding application filed in the United States as well as a copy of the USPTO office action refusing that application on the basis of section 2(e)(1) of the Trademark Act.

[18] There is no evidence in the record of the foreign law. It may well be that the wording of section 2(e)(1) of the Trademark Act differs from section 12(1)(b) of the Act. The interpretation of the former in the United States might be different than the interpretation of section 12(1)(b) in Canada as outlined above. Consequently I do not see the decision of the USPTO to be relevant to this case.

[19] I acknowledge that the Mark is a coined word. However it is formed by the combination of two common English words: “data” and “flow”. I have the discretion to consult dictionaries to obtain the definition of words [see *National Laser Products Limited* (1976), 28 CPR (2d) 59 (FCTD)]. I consulted the *Canadian Oxford Dictionary*, 2d and those words are defined in these terms:

Data: 1. Quantities or characters operated on by a computer. 2. A body or series of facts; information. 3. Facts, statistics.

Flow: (...) 4. (of people or things) move freely and continuously.

[20] To the average Canadian consumer, using common sense, the Mark means “a flow of data”. The Wares are used or integrated in a surgical environment as appears from the Applicant’s literature filed by Mr. Robbie, the Applicant’s Director. In the same documentation describing that environment there is the following statement: “Unique applications assist workflow and streamline communication and information flow”. The Wares bearing the Mark are also described in the documentation filed as “Real-time flow of information to enhance communication and assist surgical decision-making.”

[21] The Wares are defined in quite technical terms but even that wording includes terms such as “information” and “data routing and display”.

[22] I conclude from the evidence in the record, based on the plain language of the words comprising the Mark and common sense, that it is clearly descriptive of the character of the Wares. The Wares namely a modular, open architecture surgical suite information management system will transmit information and/or data to its user. This information or data may then take the form of videos, images and the like, but still one of the characteristic of this product is the

transmission of data and information. Consequently the Mark is not registrable under section 12(1)(b) of the Act.

[23] The seventh ground of opposition is maintained.

#### Ground of Opposition Based on Section 12(1)(d) of the Act

[24] The relevant date for this ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA)].

[25] The Opponent filed a certified copy of Canadian registration TMA773,365 for the trade-mark FLOW for software used during neurosurgery to visualize and interpret the circulation of blood and to analyze data from the operation. I checked the register and such registration is extant [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats Ltée v Manu Foods Ltd*, 11 CPR (3d) 410 (FCTD)]; consequently the Opponent has met its initial burden.

[26] The test for confusion is outlined in section 6(2) of the Act. It does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source.

[27] Some of the surrounding circumstances to be taken into consideration are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [See *Clorox Co v Sears Canada Inc* (1992), 41 CPR (3d) 483 (FCTD) and *Gainers Inc v Marchildon* (1996), 66 CPR (3d) 308 (FCTD)]. I also refer to the judgments of the Supreme Court of Canada in *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 and *Mattel Inc v 3894207 Canada inc* (2006), 49 CPR (4th) 321 where Mr. Justice Binnie commented on the assessment of the criteria enumerated under section 6(5) to determine if there is a likelihood of confusion between two trade-marks.



*Inherent distinctiveness of the trade-marks and the extent to which they have become known*

[28] As mentioned earlier, the Mark is composed of two common English words and as such is not inherently distinctive. The same is true with respect to the Opponent's trade-mark FLOW. The degree of distinctiveness of a trade-mark may be enhanced through use or promotion in Canada. There is no evidence of use of the Mark in Canada in association with the Ware. The documentation filed by the Applicant does not establish use of the Mark within the meaning of section 4(1) of the Act. In fact in paragraph 6 of his affidavit Mr. Robbie states that "It is intended that the trade-mark DATAFLOW will be shown..." Such language confirms that the Mark had not been used as of the date of execution of his affidavit, namely February 6, 2012.

[29] There is no evidence of use or promotion of the trade-mark FLOW by the Opponent in Canada. The registration was obtained on the basis of use in Germany, the Opponent's country of origin.

[30] This factor does not favour either parties.

*The length of time the trade-marks or trade-names have been in use*

[31] In the absence of evidence of use of the respective parties' trade-marks, this factor does not favour either parties.

*The nature of the wares, services, or business; the nature of the trade*

[32] There is definitively an overlap in the parties' wares. On the one hand we have the Opponent's software which is used during neurosurgery and on the other hand we have the Applicant's information management system which is also used in a surgical room environment. Both products are aimed to the same clientele, namely hospitals. Consequently these factors favour the Opponent.

*The degree of resemblance*

[33] In its judgment in *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC), the Supreme Court of Canada has clearly indicated that the most important factor

amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

[34] The first component of a mark is often considered more important for the purpose of distinction [*Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD) and *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd.* (1991), 37 CPR (3d) 413 (FCA)]. Moreover any descriptive word is entitled to a narrower ambit of protection than a unique or coined word.

[35] The common feature between the marks in issue is the word “flow” which is an English word. The first component of the Mark is also a common English word “data”. The combination of “data” and “flow” makes the Mark different than the Opponent’s trade-mark FLOW visually, aurally and in the ideas suggested by the Mark. It is a case where the differences between the marks are more significant than their similarities given that the marks are common English words.

[36] This most important factor favours the Applicant.

#### *Other surrounding circumstances*

[37] The Applicant filed state of the register evidence through the affidavit of Ms. Ade, a trade-mark agent trainee employed by the Applicant’s agent firm. She conducted her search on January 20, 2012 and therefore such evidence is pertinent.

[38] She first tried to locate any trade-marks on the Canadian register of trade-marks comprising the word “flow” and having the word “surgery” in the field of “Wares and Services”. She located 6 trade-marks that are either registered or allowed applications: INSUFLOW, FLOW+, S-D-FLO, MICROFLOW PLUS, FLOSEAL and MICROFLOW (exhibit A to her affidavit). I consider that number of citations to be insufficient to draw inferences that “flow” is widely used in the marketplace as part of trade-marks such that the average Canadian consumer is accustomed in distinguishing them.

[39] She performed a second search in order to locate any trade-marks on the Canadian register of trade-marks comprising the word “flow” and having the word “surgical” in the field

of “Wares and Services”. This time she located an additional 7 citations, excluding those mentioned in the first search, an application at the search stage and the Mark (exhibit B to her affidavit).

[40] Consequently there are 13 relevant trade-marks owned by 10 different entities. In the absence of any evidence of use of these trade-marks, I do not consider these numbers to be sufficient to infer that there is a wide use of trade-marks in Canada incorporating the word “flow” in association with wares and services in the surgical field. Thus the state of the register evidence is not a determinative factor.

[41] Overall I conclude that the Applicant has discharged its onus to prove, on a balance of probabilities, that the Mark is registrable under section 12(1)(d) of the Act in that: the Opponent’s trade-mark is not inherently distinctive, there exists differences in the parties’ respective trade-marks both visually, aurally and in the ideas suggested by them. Since the Opponent’s trade-mark is a common English word, any small differences will be sufficient to enable a Canadian consumer to distinguish it from the Mark.

[42] The seventh ground of opposition is therefore dismissed.

#### Disposition

[43] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application to register the Mark pursuant to section 38(8) of the Act.

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office