

**IN THE MATTER OF AN OPPOSITION  
by Accupro Trademark Services Ltd. to  
application no. 1,051,529 for the trade-mark  
ACCULEX filed by Robert H. Barrigar**  
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On March 20, 2000 the applicant Robert H. Barrigar filed an application to register the trade-mark ACCULEX based on proposed use in Canada in association with

“legal services and patent and trademark agency services.”

The subject application was advertised in the *Trade-marks Journal* issue dated July 25, 2001 and was opposed by Accupro Trademark Services Ltd. on December 21, 2001. The Registrar forwarded a copy of the statement of opposition to the applicant on January 22, 2002. The applicant responded by filing and serving a counter statement.

The first ground of opposition relies on Sections 16(3)(a), 16(3)(c) and 16(5) of the *Trade-marks Act* to allege that the applicant is not entitled to register the applied for mark. In this respect, the opponent pleads that the applied for mark ACCULEX is confusing with its mark ACCUPRO TRADEMARK SERVICES and its trade-name Accupro Trademark Services Ltd. which the opponent had previously used and made known in respect of all aspects of trade-mark agency services since at least February 1, 1999.

The second ground of opposition, pursuant to Section 30(i) of the *Act*, alleges that the applicant could not be satisfied that he is entitled to use the mark ACCULEX because the applicant was aware, or should have been aware, of the opponent’s prior use of its mark

ACCUPRO TRADEMARK SERVICES. The final ground alleges that the applied for mark is not distinctive of the applicant's services in view of the opponent's prior use of its mark

ACCUPRO TRADEMARK SERVICES.

The counter statement filed by the applicant generally denies the opponent's allegations and further pleads that:

The opponent's evidence consists of the affidavits Sandra Wright, President of the opponent company and Karin Binder, trade-marks researcher. The applicant's evidence consists of the affidavit of Erin Frith, legal assistant. Both parties filed a written argument and both were represented at an oral hearing.

Ms. Wright's evidence may be summarized as follows. The opponent company was incorporated under the name Accupro Trademark Services Ltd. in December 1998. Before starting the business, Ms. Wright satisfied herself that the trade-mark ACCUPRO was unique to the intellectual property profession. The opponent has been advertising its services to members of the legal profession, predominantly in British Columbia. Advertising costs are in excess of \$20,000 since 1999. The opponent has a customer base in excess of 250 clients in Canada, the United States and internationally. A trade-mark registration (no. 560,965) for ACCUPRO TRADEMARK SERVICES issued to the opponent in April 2002.

Ms. Binder performed a search of the trade-marks register to capture marks which incorporate the prefix ACCU or ACU for marks used in association with wares or services relating to "patent," or "trade-mark," or "legal," or "intellectual property." No significant third party marks were located by the search under the above mentioned search parameters. As noted by the applicant at paragraph 27 of its written argument, the search did not include parameters such as "attorney," "law," "professional," "invention," "computer" or "software" which might be pertinent in the field of intellectual property.

Ms. Frith's evidence, filed on behalf of the applicant, also pertains, *inter alia*, to searches of the trade-marks register. One search located 338 extant registrations having the prefix ACCU; another search located 203 trade-marks of record having the prefix ACU.

The determinative issue in this proceeding is whether the applied for mark ACCULEX is

confusing with the opponent's mark ACCUPRO TRADEMARK SERVICES either at the material date March 20, 2000 with respect to the ground of opposition alleging non-entitlement (see Section 16(3) of the *Trade-marks Act*) or at the material date December 21, 2001 with respect to the ground of opposition alleging non-distinctiveness: see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and *Clarco Communications Ltd. v. Sassy Publishers Inc.* (1994), 54 C.P.R.(3d) 418 (F.C.T.D.). I agree with the applicant that the second ground, as pleaded, does not contain sufficient particulars. Further, in the circumstances of this case nothing turns on whether the issue of confusion is assessed at a particular material date. For the purposes of assessing confusion, I consider that use of the opponent's trade-name is equivalent to use of the opponent's mark in view of the slight difference between them.

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark ACCULEX and the opponent's mark ACCUPRO TRADEMARK SERVICES. The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them.

This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

The applied for mark ACCULEX does not possess a high degree of inherent distinctiveness in relation to the services associated with the mark. In this regard, the prefix ACCU is suggestive of the word “accurate” and the suffix LEX would be recognised by the applicant’s target clientele as a reference to the word “law.” The mark as a whole is suggestive of “accurate legal” services and therefore has a laudatory connotation. The applied for mark is a relatively weak mark.

Similarly, the prefix portion ACCU comprising the first component of the opponent’s mark is suggestive of the word “accurate” while the suffix portion PRO, in relation to the services associated with the mark, is suggestive of the word “professional.” The mark as a whole suggests “accurate professional” services to the opponent’s target clientele. The opponent’s mark is also a weak mark deriving its inherent distinctiveness from the first component of the mark, that is, ACCUPRO. In this regard, the components TRADEMARK and SERVICES are clearly descriptive of the opponent’s services and do not contribute to the inherent distinctiveness of the mark. The opponent’s mark would have acquired some reputation by use and advertising (including the trade-name) beginning in February 1999 through to the material dates March 20, 2000 and December 21, 2001. The applied for mark ACCULEX did not acquire any reputation at

either material date. The length of time that the marks had been in use favours the applicant but only to a limited extent.

The parties' services overlap in that the applicant's services encompass the opponent's trade-mark services as well as providing for further services in the area of intellectual property. Similarly, there would be an overlap in the parties' target clientele as the applicant would provide services additional to those provided by the opponent.

The marks in issue resemble each other to the extent that they share the same prefix ACCU. However, the marks are distinct visually, aurally and in ideas suggested when the marks are considered in their entireties. In this regard, the opponent's mark ACCUPRO TRADEMARK SERVICES has a different visual and aural impact than the applied for mark ACCULEX. As discussed earlier, the idea suggested by the opponent's mark is "accurate professional trade-mark services" while the idea suggested by the applied for mark is "accurate law."

As a surrounding circumstance, the applicant points to the evidence presented in the Frith affidavit and argues that the public has been inundated with the prefix ACCU and ACU for a plethora of trade-marks for a variety of wares and services, so that consumers have become accustomed to distinguishing between such marks. Further, the parties' services are highly specialized and prospective clients may be expected to investigate carefully when choosing between trade-mark agency services. I agree with the applicant that the notion of the shopper in a hurry making a hasty purchase with imperfect recollection of the earlier mark is not a concept

that applies to the present fact situation involving specialized and costly professional services.

Having regard to the above, and keeping in mind that weak marks are not entitled to a broad scope of protection, and that small differences suffice to distinguish between weak marks, I find that the applicant has satisfied the onus on it to show that, on a balance of probabilities, the marks in issue were not confusing at the material dates.

Accordingly, the opponent's opposition is rejected.

I would add that the opponent might have amended its statement of opposition to rely on registration no. 560,965 for its mark ACCUPRO TRADEMARK SERVICES which issued during the course of this proceeding. The material time to consider the issue of confusion would then have included the date of decision. However, extrapolating from the evidence of use and advertising of the mark (and trade-name) presented by the opponent, the potential additional ground of opposition pursuant to Section 12(1)(d) would also have been rejected.

DATED AT GATINEAU, QUEBEC, THIS 6th DAY OF APRIL, 2005.

Myer Herzig,  
Member,  
Trade-marks Opposition Board