

**IN THE MATTER OF AN OPPOSITION  
by Corporation Métricom du Canada Inc.  
to application no. 813,267 for the mark  
METRICOM filed by Metricom Inc.**

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On May 23, 1996, the applicant, Metricom Inc., filed an application to register the mark METRICOM, based on use of the mark in Canada since at least as early as November 1990 in association with the wares

wireless data communications equipment namely, digital packet radios and modems and computer hardware and software therefor

and with the services

wireless data communications services namely, communication services provided through wide area network radio systems.

The subject mark was advertised for opposition purposes in the *Trade-marks Journal* issue dated January 1, 1997 and was opposed by Corporation Métricom du Canada Inc. on February 6, 1997. A copy of the statement of opposition was forwarded to the applicant on March 4, 1997. The applicant responded by filing and serving a counter statement generally denying each of the grounds of opposition.

The first ground of opposition, pursuant to Section 30(i) of the *Trade-marks Act*, alleges that the applicant could not have been satisfied as to its entitlement to use the applied for mark as the applicant was aware of the opponent's use of its trade-marks and trade-name.

The second ground of opposition, pursuant to Section 16(1)(a) of the *Act*, alleges that the applicant is not the person entitled to register the applied for mark because, at the date of filing[sic] of the application, the applied for mark was confusing with the opponent's marks MÉTRICOM and CORPORATION MÉTRICOM DU CANADA INC. used by the opponent since at least as early as 1988 in association with communication and telecommunication equipment, and electronic thermostats; communication and telecommunication services and research and development in these fields.

The third ground of opposition, pursuant to Section 16(1)(c) of the *Act*, alleges that the applicant is not the person entitled to register the applied for mark METRICOM because, at the date of filing[sic] of the application, the applied for mark was confusing with the opponent's trade-name Corporation Métricom du Canada Inc. used in Canada in association with its services since at least as early as 1988.

The second and third grounds of opposition incorrectly assert the material time for assessing the issue of confusion. In this regard Section 16(1), shown below, clearly indicates that the relevant time, in respect of the issue of confusion, is the date of first use claimed in the subject application, not the date of filing of the application:

16(1) Any applicant who has filed an application in accordance with section 30 for registration of a trade-mark that is registrable and that he or his predecessor in title has used in Canada or made known in Canada in association with wares or services is entitled, subject to section 38, to secure its registration in respect of those wares or services, unless **at the date on which he . . . first so used it** or made it known it was confusing with

- (a) a trade-mark that had been previously used in Canada or made known in Canada by any other person;
- (b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or
- (c) a trade-name that had been previously used in Canada by any other person. (emphasis added)

In any event, I regard the mistake in the opponent's pleadings as a minor inconsequential error.

The opponent was granted a retroactive extension of time to submit its evidence which consists of the affidavit (dated August 15, 1997) of Serge Mathieu, President of the opponent company. Mr. Mathieu was cross-examined on his affidavit and the transcript thereof forms part of the evidence of record. The applicant's evidence consists of a certified copy of trade-mark application no. 826,980 for the mark MÉTRICOM standing in the name of the opponent.

Application no. 826,980 was filed on October 29, 1996 and is based on proposed use in Canada in association with the wares

circuits intégrés de communication par courant porteur et sur paire de fils torsadés, et matériel connexe, des circuits intégrés de thermostats électroniques et des thermostats électroniques, des circuits intégrés de thermostats électroniques communicants et des thermostats électroniques communicants, des circuits intégrés d'interrupteurs d'éclairage commandés par courant porteur et des interrupteurs d'éclairage commandés par courant

porteur, des circuits intégrés de relais et d'actuateurs commandés par courant porteur et des relais et actuateurs commandés par courant porteur

and in association with the services

conception sur mesure de circuiterie et de puces électroniques.

The opponent submitted evidence in reply on April 6, 1999, consisting of a second affidavit of Mr. Mathieu, dated April 1, 1999. The applicant objected to such evidence by a letter to the Board dated on April 12, 1999:

We respectfully submit that the opponent's reply evidence does not *inter alia* constitute proper evidence under rule 43 of the *Trade-marks Regulations*. Thus, such reply evidence should be rejected in its entirety and returned to the opponent immediately.

The Board answered the applicant's objections as follows:

. . . in general, rulings on evidentiary matters will only be made at the decision stage and not during the course of an opposition proceeding.

As a preliminary matter, I agree with the applicant that the opponent's purported reply evidence is not admissible. Mr. Mathieu's second affidavit is not responding to any evidence filed by the applicant. Accordingly, Mr. Mathieu's second affidavit does not constitute evidence confined to matter in reply as required by Rule 43(a) of the *Trade-marks Regulations*. Rather, that evidence should have been introduced as part of the opponent's evidence in chief or the opponent could have sought leave, prior to the oral hearing, to introduce that evidence as additional evidence pursuant to Rule 44(1). Rule 43(a) is not a vehicle to correct deficiencies in the opponent's evidence in chief.

With respect to the first ground of opposition, there is no evidence that the applicant was aware of the opponent's trade-marks or trade-name prior to filing the present application. In any event, even had the applicant been aware of the opponent's marks or trade-name prior to filing the present application, such a fact is not inconsistent with the statement in the application that the applicant is entitled the use its mark METRICOM in Canada: see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191 at 195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152 at 155. Thus, the opponent has not pleaded sufficient facts to raise a ground

of opposition based on Section 30(i) of the *Act*. It may be that the opponent also intended to allege that the applicant could not have been satisfied that it was entitled to use the applied for mark because it was confusing with the opponent's marks or trade-name. However, even if that allegation had been pleaded, the success of the first ground would still be contingent on a finding of confusion.

With respect to the two remaining grounds of opposition, Sections 16(5) and 17(1) of the *Act* impose requirements on the opponent to establish that (i) the opponent has used the trade-marks and/or trade-name it is relying on prior to the applicant's claimed date of use of its mark and (ii) the opponent did not abandon its trade-marks and/or trade-mark at the date of advertisement of the opposed mark in the *Trade-marks Journal*, in this case the relevant date being January 1, 1997.

The applicant's submissions regarding the opponent's evidence is found, in part, at paragraphs 12-14 of the applicant's written argument, reproduced below:

I agree entirely with the characterization of the opponent's evidence as noted in paragraph 12 above and I agree substantially with the characterization of the opponent's evidence as noted in paragraphs 13 - 14 above. Simply put, it is not possible to conclude from the opponent's evidence, including Mr. Mathieu's testimony on cross-examination, that the opponent actually

sold any wares or provided any services under its trade-marks or trade-name as alleged in the opponent's pleadings. This is not to say that the opponent company was not in existence or not operating within the relevant time periods. It was. However, the evidence is insufficient to establish that the opponent was using its marks and trade-name as alleged in its pleadings. Rather, the evidence indicates that the opponent was in the preparatory stages of organizing itself to use its mark MÉTRICOM, but the evidence is entirely deficient to establish that the potential for use of the mark was realized prior to November 30, 1990. Further, I am unable to conclude that, as of January 1, 1997, the opponent had not abandoned use of its marks and trade-name in association with the wares and services alleged in its pleadings.

As noted earlier, the applicant has introduced into evidence the opponent's trade-mark application no. 826,980 for the mark MÉTRICOM, based on proposed use in Canada, covering various electronic devices. That application was filed on October 29, 1996 and is, of course, inconsistent with the intent of Mr. Mathieu's evidence which was to establish continuous use of the opponent's mark beginning some time prior to November 30, 1990. The opponent has not come forward with any evidence to explain application no. 826,980. Thus, the applicant has put the opponent's alleged use of its mark prior to November 30, 1990, in issue and the opponent has done nothing to respond to the doubts raised by the applicant.

In view of the above, I find that the opponent has failed to meet the statutory requirements imposed by Sections 16(5) and 17(1). Accordingly, the second and third grounds of opposition must

be rejected.

Consequently, the opponent's opposition is rejected.

DATED AT HULL, QUEBEC, THIS 25th DAY OF MAY, 2001.

Myer Herzig,  
Member,  
Trade-marks Opposition Board