

IN THE MATTER OF AN OPPOSITION  
by Data Accessories Corporation  
to application No. 646,859 for  
the trade-mark DATA-MATE filed  
by Dainolite Ltd.

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On December 13, 1989, the applicant, Dainolite Ltd., filed an application to register the trade-mark DATA-MATE for "copy holder" based on proposed use in Canada. The application was advertised for opposition purposes on July 25, 1990.

The opponent, Data Accessories Corporation, filed a statement of opposition on August 24, 1990, a copy of which was forwarded to the applicant on October 15, 1990. On March 18, 1991, leave was granted to amend the statement of opposition to correct the identification of the opponent.

The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1) (d) of the Trade-marks Act because it is confusing with the opponent's trade-mark COPYMATE registered under No. 289,015 for the following wares:

computer or typewriter accessories, namely  
adjustable document holders for elevating  
typists' copy to eye level beside a computer  
screen or typewriter.

The second ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the trade-mark COPYMATE and the trade-name Data Accessories Corporation previously used in Canada by the opponent and its predecessors in title. The third ground is that the applicant's trade-mark is not distinctive in view of the foregoing.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavit of its President, Sidney S. Deutch. As its evidence, the applicant filed the affidavit of an articling student, William R. Barber. Both parties filed a written argument but no oral hearing was conducted.

As for the first ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R. (3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The applicant's proposed mark DATA-MATE is to be used with copy holders which are designed to hold the printed material or data being typed by a typist, computer operator or word processor operator. Thus, the applicant's mark is somewhat suggestive of such items and the mark is not inherently strong. There is no evidence that the applicant's mark has been used or advertised and I must therefore conclude that it has not become known at all in Canada.

The opponent's registered mark COPYMATE is also used with copy holders. Thus, it,

too, is not an inherently strong mark. However, the opponent has evidenced fairly extensive sales and advertising in association with its mark since 1982. Thus, I am able to conclude that the opponent's mark has become known to some extent in Canada.

The length of time the marks have been in use clearly favors the opponent. The wares of the parties are the same and presumably the trades would also be the same.

As for Section 6(5)(e) of the Act, I find there is a fairly high degree of resemblance between the two marks both visually and phonetically. Both marks are comprised of three syllables and eight letters and both end with the word "mate." The ideas suggested by the two marks are similar in that both suggest a mate or companion for one's "copy" or data.

The applicant contends that a surrounding circumstance in the present case which lessens the effect of any degree of resemblance between the marks is the state of the register evidence introduced by the Barber affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R. (3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R. (3d) 205 (F.C.T.D.). Also of note is the recent decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R. (3d) 349 (F.C.A.) which is support for 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.

Initially, I would note that Mr. Barber simply appended copies of eighteen trade-mark registrations to his affidavit with no indication as to how those copies were obtained. There is no indication that Mr. Barber personally examined the trade-marks register and made the photocopies. Thus, I must give diminished weight to the copies provided by Mr. Barber although the opponent has not questioned their validity.

Even if the copies provided by Mr. Barber are completely reliable, the registrations evidenced do little to advance the applicant's case. They cover a wide range of goods including office equipment and supplies, office furniture and computer software. None of the registrations appears to cover copy holders. Eleven of the registered marks commence with the word "data" and eight end with the word "mate." One registration falls into both categories, namely the trade-mark DATA-MATE registered for computer programs.

Based on that evidence alone, it is difficult to assume that any of those marks are in active and widespread use in Canada. However, Mr. Barber also appended to his affidavit an office products catalogue which includes a number of items offered for sale in association with trade-marks ending with the word "mate." Apart from the opponent's COPYMATE product appearing on page 24 of that catalogue, none of those items is a copy holder. On page 104 of the catalogue, however, there are several desk accessory items offered for sale under such trade-marks as PENCIL-MATE, CLIP-MATE and DESK-MATE, all of those items identified as coming from a company called Esselte Pendaflex Canada Inc. The catalogue also contains some additional third party MATE-suffixed marks although they tend to be associated with less related wares.

Although the state of the register evidence alone would not have assisted the applicant's case, that evidence together with the product catalogue does allow me to conclude that there are at least some MATE-suffixed trade-marks being used in the office supplies field. However, there is no evidence that any such marks are being used in association with the particular wares sold under the opponent's mark COPYMATE and for which the applicant seeks registration. Thus, although the applicant's evidence does show at least some third party adoption of MATE-suffixed marks for wares in the nature of office equipment and supplies, it does not show any such adoption for copy holders. The evidence therefore shows that, to a limited extent, consumers have become accustomed to seeing MATE-suffixed marks in the office equipment and supplies field but not specifically for the wares at issue.

The opponent contends that an additional surrounding circumstance in the present case is the use of its trade-name Data Accessories Corporation by itself and its predecessors in title. I agree. The opponent's evidence shows that its COPYMATE sales have been effected in association with its trade-name, the trade-name having appeared on the product packaging. The trade-mark and the trade-name also appear together in the opponent's advertising brochures and at page 24 of the retailer's catalogue introduced as part of the applicant's evidence.

Also of note is the fact that page 24 of the catalogue appended to Mr. Barber's affidavit illustrates not only the opponent's COPYMATE copy holder but also a different model copy holder of the opponent sold under the trade-mark SUPERHOLDER. Thus, the fact that the opponent commonly associates its trade-name (which commences with the word "data") and its trade-mark COPYMATE and the further fact that the opponent has used a different trade-mark for a different model of copy holder suggests that consumers might assume that a DATA-MATE copy holder was a new model of copy holder offered for sale by Data Accessories Corporation.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the identity between the wares and trades of the parties, the reputation associated with the opponent's trade-mark, the degree of resemblance between the marks and the fact that the opponent has associated its "data"-prefixed trade-name with its trade-mark, I find that the applicant has failed to satisfy the onus on it to show that its proposed trade-mark is not confusing with the opponent's registered mark. The first ground of opposition is therefore successful and the remaining grounds need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 30th DAY OF November, 1993.

David J. Martin,  
Member,  
Trade Marks Opposition Board.