



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

Citation: 2011 TMOB 159
Date of Decision: 2011-09-08

**IN THE MATTER OF AN OPPOSITION
by Intime Solutions Inc. to application
No. 1,345,150 for the trade-mark
OPTIME in the name of Epic Systems
Corporation**

[1] On April 26, 2007, Epic Systems Corporation (the Applicant) filed an application to register the trade-mark OPTIME in association with “computer programs and accompanying manuals sold as a unit for a scheduling system” (the Original Wares) based on use and registration in the United States of America under registration No. 1532856.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 23, 2008.

[3] On June 23, 2008, Intime Solutions Inc. (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- Pursuant to s. 38(2)(a) and 30(a) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the application for the Mark does not contain a statement in ordinary commercial terms of the Original Wares as the specification does not clearly define the field of use and application of the computer software as required by the Canadian Intellectual Property Office (CIPO) Wares and Services Manual;
- Pursuant to s. 38(2)(a) and 30(i) of the Act, the Applicant could not have been satisfied that it is entitled to use the Mark in Canada because at all material dates the Mark was confusing with the Opponent’s Canadian trade-mark registrations in respect of their trade-marks INTIME VISUAL SCHEDULER (TMA546,669) and INTIME (TMA458,545) (the Opponent’s Marks) and the

Opponent's trade name, Intime Solutions Inc., all of which had been previously used and made known and none of which had been abandoned at all material dates.

- Pursuant to s. 38(2)(b) and 12(1)(d) of the Act, the Mark is not registrable due to confusion with the registrations for the Opponent's Marks.
- Pursuant to s. 38(2)(c) and 16(2)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because at all material dates, the Mark was confusing with the Opponent's Marks which are registered and have been previously used and made known consecutively in Canada by the Opponent, its predecessor in title and/or its licensees, at all material dates in association with "computer software which schedules personnel for use in the fields of private and public sector business, civil servants, associations and non-profit organizations" and "computer software" (the Opponent's Wares) and had not been abandoned.
- Pursuant to s. 38(2)(c) and 16(2)(c) of the Act, the Applicant is not the person entitled to registration of the Mark because at the date of filing the application for the Mark it was confusing and is likely to cause confusion, with the Opponent's trade name Intime Solutions Inc., which previously has been used and made known in Canada by the Opponent and which had not been abandoned.
- Pursuant to s. 38(2)(d) and 2 of the Act the Mark is not distinctive as defined in s. 2 of the Act because it does not actually distinguish the Wares nor is it adapted to distinguish the Wares from the wares and services of others in view of the Opponent's prior use and registration of the Opponent's Marks and trade name.

[4] The Applicant served and filed a counter statement in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[5] In support of its opposition, the Opponent filed affidavits of Donald Harrison Dollard, sworn February 27, 2009 with Exhibits A – F and Dulce Campos, sworn March 3, 2009 with Exhibits A – B as well as a second affidavit of Dulce Campos, sworn July 29, 2009 with Exhibits A – E pursuant to r. 43 of the *Trade-marks Regulations* SOR/96-195 (the Regulations). None of the Opponent's affiants was cross-examined.

[6] The Applicant filed affidavits of Dane Penney, sworn June 18, 2009, with Exhibits A – D and Peter Woods, sworn June 23, 2009 with Exhibit A. Neither affiant was cross-examined.

[7] Both parties filed written arguments and were represented at an oral hearing.

Preliminary Issue – Revised application

[8] On the eve of the oral hearing the Applicant filed an amended application in which the Original Wares were revised to read as follows: “computer programs and accompanying manuals sold as a unit for a scheduling system for health care and public health institutions” (the Wares).

[9] I note that the amended application was not brought to my attention until midway through the oral hearing after the Opponent had already made lengthy submissions on the s. 30(a) ground of opposition based on the Original Wares. The Opponent was provided with the opportunity to comment on the amended application at the oral hearing.

[10] The amendment to the application as set out in the applicant’s revised application dated July 18, 2011 has been accepted on behalf of the Registrar of Trade-marks.

Opponent’s Evidence

Affidavit of Donald Harrison Dollard

[11] Mr. Dollard is an Officer and Director, namely the President, of “Solutions Inc.” I assume, based on the remainder of the affidavit that Mr. Dollard meant to say “Intime Solutions Inc.”, in other words, the Opponent.

[12] Mr. Dollard states that the Opponent was incorporated in British Columbia on May 21, 1996 under BC-0000520276. Mr. Dollard states that the Opponent has its main place of business in British Columbia with offices in Bellingham, Washington, U.S.A. (Exhibit A).

[13] Mr. Dollard makes statements regarding the trade-mark VISUAL SCHEDULER. Based on a review of Mr. Dollard’s affidavit as a whole I am satisfied that these are in fact references to the Opponent’s trade-mark INTIME VISUAL SCHEDULER. Specifically, Mr. Dollard states that in early 1995 the Opponent’s predecessor, MCS Micro Computer Services Ltd. adopted the trade-mark INTIME VISUAL SCHEDULER to be used in identifying its scheduling software products. Mr. Dollard states that in early 1995 the Opponent’s predecessor instructed its agent to file an application for this trade-mark (application No. 775,284, issued to registration on May 31, 1996 under TMA458,545). Mr. Dollard attaches to his affidavit a certified copy of the

registration for the trade-mark INTIME VISUAL SCHEDULER (Exhibit B). Mr. Dollard states that registration No. TMA458,545 was assigned to the Opponent in June 1996 and subsequently recorded with CIPO on September 27, 1996. I note that none of the documentary exhibits to Mr. Dollard's affidavit feature use of the INTIME VISUAL SCHEDULER trade-mark.

[14] Mr. Dollard then made statements about another trade-mark without identifying the trade-mark. Based on a review of the Dollard affidavit as a whole I am satisfied that Mr. Dollard was referring to the Opponent's other trade-mark, INTIME. Mr. Dollard states that in August 1998 the Opponent instructed its agent to register in Canada the trade-mark INTIME for "computer software which schedules personnel for use in the fields of private and public sector businesses, civil servants, association and non-profit organizations" under application No. 886,611, which subsequently matured to registration under No. TMA546,669 on June 18, 2001. Mr. Dollard attaches a certified copy of registration No. TMA546,669 as an exhibit to his affidavit (Exhibit C).

[15] Mr. Dollard states that the Opponent employs eight full time employees with two of these employees devoted to sales and marketing. Mr. Dollard states that the Opponent "maintains a portion of a shipping and distribution warehouses in Bellingham, Washington".

[16] The remainder of Mr. Dollard's affidavit will be discussed below in the analysis of the confusion-based grounds of opposition.

First Affidavit of Dulce Campos

[17] Ms. Campos is employed by the Opponent's agent as a trade-mark searcher.

[18] Ms. Campos states that on the instruction of the Opponent's agent, she reviewed the "About Epic" section of the website *www.epicsystems.com* (the Applicant's website) to determine the Applicant's location. Ms. Campos attaches to her affidavit a printout from the Applicant's website which details the Applicant's locations as being in Wisconsin and the Netherlands (Exhibit A).

[19] Ms. Campos states that on the instruction of the Opponent's agent she conducted a dictionary search using the *Routledge Dutch Dictionary* for the term "OP". Ms. Campos attaches

to her affidavit printouts from this website which confirm that “OP” translates in English to “as, upon, at and in” (Exhibit B).

Applicant’s Evidence

Affidavit of Dane Penney

[20] Ms. Penney states that she is a searcher employed by the Applicant’s agents.

[21] Ms. Penney states that on June 18-19, 2009 at the request of the Applicant’s agent, she located the following documents using the USPTO website:

- U.S. Trade-mark registration No. 2619241 for INTIME (Exhibit A);
- U.S. Trade-mark registration No. 1532856 for OPTIME using (Exhibit B); and
- a copy of the Office Action Response dated September 29, 1999 filed by counsel for the Applicant in association with the U.S. application for INTIME (Exhibit C).

[22] Ms. Penney states that on June 18, 2009 at the request of the Applicant’s agent she located particulars of 12 Canadian trade-mark registrations, namely UP.TIME, SAMETIME, JUST-IN-TIME, UPTIME INTEGRITY MANAGEMENT & DESIGN, ON TIME EVERY TIME, SPIN TIME, GEOTIME, ACCU-TIME, QUICKTIME, PRO-TIME, ON TIME & DESIGN, BOOK IN TIME (Exhibit D) using the CIPO Trade-marks Database.

Affidavit of Peter Woods

[23] Mr. Woods is a law student employed by Applicant’s agent.

[24] Mr. Woods states that on June 23, 2009 he viewed the website located at *www.epicsystems.com* and printed out the home page as well as pages entitled “About”, “Recognition”, “Software”, “Software: Specialties/Departments/Ancillaries and Services” (Exhibit A).

Opponent's Evidence in Reply

Second Affidavit of Dulce Campos

[25] Ms. Campos reviewed the Practice Notices section of the CIPO website. Ms. Campos attaches to her affidavit printouts taken from “Practice Notice: Compliance with Section 30(a) – Programs – Data Transmission Services” publication date April 14, 1999” (Exhibit A).

[26] Ms. Campos conducted a search of the CIPO Wares and Services Manual for wares including “computer software” (Exhibit B) and “systems” (Exhibit C).

[27] Ms. Campos conducted an online search of the Merriam Webster dictionary using <http://www.merriam-webster.com/> for the word “scheduling” (Exhibit D).

[28] Ms. Campos conducted a search of the CIPO Trade-marks Database to review all marks containing the word OPTIME. Ms. Campos attaches to her affidavit a printout of the particulars of OPTIME, registration No. TMA677,407 in the name of Cabot Safety Intermediate LLC (Exhibit E).

[29] The Applicant has submitted that the Second Campos affidavit does not constitute proper reply evidence since it is not confined to matters in reply as required by r. 43(a) of the Regulations [see *Coca-Cola Ltd. v. Compagnie Francaise De Commerce International Cofci, S.A.* (1991), 35 C.P.R. (3d) 406 (T.M.O.B.)]. The Applicant's evidence which covers the parties' U.S. registrations, state of the register evidence regarding the word “TIME” and printouts from the Applicant's website, does not relate to s. 30(a) of the Act, or to the Wares and Services manual. As a result, the only portion of the Second Campos affidavit which may be considered to constitute proper reply is the particulars of the third party registration for OPTIME (TMA677,407) attached as Exhibit E.

[30] Based on the foregoing, I shall disregard the content of the Second Campos affidavit, with the exception of Exhibit E, on the basis that it does not constitute proper reply.

Onus and Material Dates

[31] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, 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 [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[32] The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(a)/30(a), (i) - the date the application was filed [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 at 475 (T.M.O.B.) and *Tower Conference Management Co. v. Canadian Exhibition Management Inc.* (1990), 28 C.P.R. (3d) 428 at 432 (T.M.O.B.)].
- s. 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].
- s. 38(2)(c)/16(2)(a), (c) - the date the application was filed [see s. 16(2) of the Act].
- s. 38(2)(d)/2 – the date of filing the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Section 30 Grounds

Section 30(a)

[33] The Opponent's initial evidential burden under s. 30(a) is a light one. In fact, the Opponent may need only to present sufficient argument in order to meet its initial burden [see *McDonald's Corporation and McDonald's Restaurants of Canada Ltd. v. M.A. Comacho-Saldana International Trading Ltd. carrying on business as Macs International* (1984), 1 C.P.R. (3d) 101 at 104 (T.M.O.B.)].

[34] The Opponent submits that the application for the Mark does not comply with the requirements of s. 30(a) of the Act on the basis that the application does not contain a statement in ordinary commercial terms of the Original Wares as the computer software does not clearly

define the field of use and application of the computer software as provided for in the CIPO Wares and Services Manual.

[35] The Opponent's submissions, both in its written argument and at the oral hearing focused on the fact that the Opponent was of the view that the Original Wares provided only the function of the Applicant's software but not the area of use.

[36] I am satisfied that the revised application filed on the eve of the oral hearing successfully overcomes the Opponent's objections. The addition of "for health care and public health institutions" clearly specifies the area of use of the Applicant's software.

[37] As a result, I will not discuss any of the Opponent's lengthy submissions regarding the s. 30(a) ground of opposition as I do not find them persuasive in light of the revised application. At the oral hearing, the Opponent submitted that it wished to maintain its objection to the application pursuant to s. 30(a) on the basis that the amendments were not sufficient to overcome the original objection. I do not agree. I am satisfied that the Wares are now defined specifically and in ordinary commercial terms.

[38] Based on the foregoing, I dismiss the ground of opposition based on s. 30(a) of the Act.

Section 30(i)

[39] Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case; the s. 30(i) ground is accordingly dismissed.

Non-registrability Ground of Opposition – s. 12(1)(d) of the Act

[40] The Opponent filed certified copies of the registration certificates for the Opponent's registered trade-marks relied upon. I have exercised the Registrar's discretion to confirm whether the registrations for the Opponent's Marks remain in good standing as of today's date. My review of the register reveals that registration No. TMA458,545 for the trade-mark INTIME

VISUAL SCHEDULER, has been expunged. As a result, the Opponent has not met its evidential burden with respect to this registration.

[41] By contrast, registration No. TMA546,669 remains in good standing and as a result, the Opponent has met its evidential burden with respect to this registration. As a result, the remainder of the s. 12(1)(d) ground of opposition will be assessed based on only the Opponent's registration for the trade-mark INTIME.

[42] Since the Opponent has discharged its initial burden with respect to this ground of opposition in relation to the registration for INTIME (TMA546,669), the burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's INTIME trade-mark.

[43] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[44] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.).]

s. 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[45] Both parties' marks share the suffix "TIME" which, given the scheduling functions of the parties' wares, is suggestive of the parties' wares.

[46] The Applicant submits, and I agree, that the trade-mark INTIME, “comprising of the common words ‘IN’ and ‘TIME’, [does] not have a high degree of inherent distinctiveness and therefore [is] not entitled to a wide scope of protection.” Furthermore, I am of the view that the words IN and TIME in association with the Opponent’s Wares are highly suggestive of the scheduling aspect of the Opponent’s Wares.

[47] In its written argument, the Applicant submits that the Mark:

...is enhanced by a distinct pre-fix ‘OP’ which, when paired with the word ‘TIME’, comprises an invented word that has a remote connection to the [Wares]. The pre-fix ‘OP’ could have a variety of meanings or connotations, including but not limited to, ‘operation’, ‘opportunity’, or ‘optimal productivity’. Therefore, the [Mark] is distinctive and should be accorded a broad scope of protection.

I agree with the Applicant’s submissions on this point.

[48] The Opponent submits that the presence of the OPTIME trade-mark, registered by Cabot Safety Intermediate LLC (TMA677,407) in association with “communications headsets; hearing protection devices, namely, earplugs, earmuffs, noise reduction headsets and active noise reduction headsets”, decreases the distinctiveness of the Mark. I do not agree. I am not willing to find that the existence of one other OPTIME trade-mark, registered for wares entirely distinct from the Wares, and for which no evidence of use has been provided, is sufficient to decrease the distinctiveness of the Mark.

[49] As the strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use, I will now turn to the extent to which the trade-marks have become known in Canada.

[50] The Applicant did not file any evidence directed to the use of the Mark subsequent to the filing of the application and as a result I am unable to conclude as to the extent to which the Mark has become known.

[51] The Opponent’s registration for INTIME subject to registration No. TMA546,669 was registered on June 18, 2001 based on use in Canada since at least September 1995. I do not accept the Opponent’s erroneous submission that “...if a trade-mark has been on the register for many years, it is probable that it has been used for a comparable period of time and that it will

have acquired reputation and goodwill.” Mere existence of a registration can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use of a trade-mark [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.)].

[52] In any event, the Opponent filed the affidavit of Mr. Dollard which provides some evidence of use and reputation for the Opponent’s INTIME trade-mark. Mr. Dollard states that the average product contract value for the Opponent’s wares and services amounts to \$60,000 for software licensing and \$40,000 for services which include implementation, configuration, installation, training and 1-2 years of technical support. Mr. Dollard states that in the fiscal year current to the date he swore his affidavit, the Opponent expected to engage in approximately 13 such contracts. Mr. Dollard stated that as of the date of swearing his affidavit, the Opponent’s largest single contract was approximately \$500,000.

[53] Mr. Dollard attaches to his affidavit a representative sampling of invoices from the years 1998 to 2008 (Exhibit D).

[54] Mr. Dollard further states that for the fiscal years 1997 to 2007, the Opponent’s total revenues amounted to “just over \$10 million, with over 1200 customers sold in North America and 24 countries worldwide”.

[55] The Applicant submits that the Opponent has failed to state and show what portion of these revenues was derived from Canadian operations. At the oral hearing the Opponent pointed to the Opponent’s main place of business address in Vancouver B.C. as well as to information on the Opponent’s website pointing to Canada (telephone contact number with a B.C. area code, director of sales located in Burnaby B.C., etc.) (Exhibit F to Dollard affidavit). The Opponent appeared to be suggesting that its sales to U.S. customers would qualify as use in Canada as per s. 4(3) of the Act (“...a trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares”).

[56] While I accept that the Opponent is a Canadian operation and that it has made some sales in Canada, I do have some concerns about the Opponent’s evidence, as set out in the following

paragraphs. In particular, I am not convinced that the evidenced sales to U.S. customers would satisfy s. 4(3) of the Act.

[57] At the oral hearing the Opponent submitted that it maintains only a billing address/postal box in Washington, U.S.A. but that all sales are made through the Canadian location. This is, however, inconsistent with Mr. Dollard's statement in his affidavit that the Opponent has "offices in Bellingham Washington" (Dollard affidavit para 3, Exhibit D) and with the fact that the invoices for U.S. customers feature an address in Bellingham, Washington at the top left hand corner, under the Opponent's name suggesting that the Opponent conducts business with its U.S. customers out of its U.S. offices. Given that the evidence suggests that the Opponent is doing business with its U.S. customers out of its U.S. offices, I am not satisfied that the Opponent has established that it is exporting its wares from Canada to customers outside of Canada in accordance with s. 4(3) of the Act.

[58] When the above evidence is taken in combination with Mr. Dollard's use of "North America and 24 countries worldwide" it becomes difficult to determine what portion of the Opponent's claimed sales generally amount to sales in Canada. Furthermore, I note that, of the sampling of invoices attached to Mr. Dollard's affidavit, only three are to Canadian addresses (Exhibit D). The Applicant submits that three invoices are insufficient to show use in Canada [see *Redsand Inc. v. Thrifty Riding and Sports Shop Ltd.* (1995), 66 C.P.R. (3d) 250 at 253-4].

[59] Mr. Dollard states that in the 2008 fiscal year, the Opponent's expenses relating to sales and marketing, excluding salaries and commissions amounted to just over \$225,000. The Applicant submits that the Opponent failed to file any evidence showing that the expenditures went towards sales and marketing *in Canada*. While this may be true, I am willing to infer that a portion of these expenditures would relate to the Canadian marketplace.

[60] Mr. Dollard attaches to his affidavit a representative sampling of actual labels and software discs which he states prominently display the Opponent's Marks and which he states the Opponent uses on packaging for its products (Exhibit E). At the oral hearing the Applicant submitted that the evidence suggested that the Opponent was merely using INTIME as a trade name in these labels/packaging. Specifically, the Applicant submitted that the presence of the words "ISE Scheduling Software" on the labels suggested that the trade-mark for the software

itself was ISE with INTIME merely being a reference to the Opponent's trade name. In response, the Opponent submitted that INTIME operates as a "house mark" with the other trade-marks operating as "sub brands". The Opponent submitted, and I agree, that the presence of the trade-mark INTIME, followed by an ® on the labels and software discs is sufficient to support a finding that the trade-mark INTIME is operating as a trade-mark for the Opponent's software. As a result, I do not accept the Applicant's submissions on this point. I take this opportunity to note that, despite Mr. Dollard's statement that the Opponent's Marks are displayed on the packaging, suggesting that the INTIME VISUAL SCHEDULER trade-mark is also displayed on the packaging, the sample labels and discs attached as Exhibit E do not feature the INTIME VISUAL SCHEDULER trade-mark.

[61] Mr. Dollard states that in 1998, the Opponent launched a comprehensive website for its customers featuring detailed listings, photos, descriptions and examples of its goods. Mr. Dollard attaches to his affidavit printouts of excerpts from the Opponent's website (Exhibit F). The Applicant submits that the Opponent has failed to adduce any evidence showing that the website was visited by Canadians. As a result, I am not willing to rely on the website printouts as evidence of the truth of their contents [see *Candrug Health Solutions Inc. v. Thorkelson* (2007), 60 C.P.R. (4th) 35 (F.C.T.D.), reversed (2008), 64 C.P.R. (4th) 431 (F.C.A.)].

[62] Mr. Dollard states that the Opponent participates in trade shows throughout Canada and the USA and has done so for over 12 years. Mr. Dollard states that the Opponent's budget for trade show appearances for the fiscal year current to the date of swearing his affidavit amounted to approximately \$113,000. Mr. Dollard included in his affidavit a list of trade shows attended by the Opponent either in the year current to the swearing of his affidavit or for which the Opponent had reserved attendance for 2009. The list includes a number of U.S. cities plus Montreal, Victoria, Sudbury and Charlottetown in Canada. The Applicant submits that the Opponent did not adduce any evidence to show that the trade-mark INTIME was used during any trade show event.

[63] Mr. Dollard expresses his opinion that the Opponent's promotion and sale of wares in association with the Opponent's Marks since 1995 have resulted in the Opponent's Marks having developed a substantial reputation.

[64] Despite the obvious deficiencies with the Dollard affidavit as pointed out by the Applicant, I am willing to accept that the Opponent's INTIME trade-mark has acquired some reputation in Canada.

s. 6(5)(b) – the length of time each has been in use

[65] The Mark was applied for on April 26, 2007 on the basis of use and registration in the U.S.A. The Applicant has not filed any evidence which is directed to the use of the Mark subsequent to the filing of the application.

[66] As set out above in the analysis of the s. 6(5)(a) factor, the Opponent has established that its INTIME trade-mark has been used since approximately 2005 (the date of the first invoice to a Canadian customer).

s. 6(5)(c) and (d) – the nature of the wares, trade and business

[67] It is the Applicant's statement of wares as defined in its application versus the Opponent's registered wares that govern my determination of this factor [see *Esprit International v. Alcohol Countermeasure Systems Corp.* (1997), 84 C.P.R. (3d) 89 (T.M.O.B.)].

[68] The Wares cover computer programs and manuals "sold as a unit for a scheduling system for health care and public health institutions"; the Opponent's wares cover computer software "which schedules personnel for use in the fields of private and public sector businesses, civil servants, associations and non-profit organizations".

[69] The parties' wares are therefore similar, both covering software with a scheduling function. While the parties have further specified their software to indicate the areas of use, I consider that the Opponent's areas of use are quite broad and could include health care or public health institutions. I therefore consider that the channels of trade associated with the Mark and the Opponent's INTIME mark could also overlap.

s. 6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[70] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)]. I also refer to *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 96 C.P.R. (4th) 361 (S.C.C.) at para. 49 [*Masterpiece*], where the Supreme Court of Canada states that s. 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

[71] The Opponent attempts to rely on a definition from a Dutch-English dictionary which provides that “OP” translates into English as “on, upon; at; in” [see Exhibit B to First Campos affidavit]. The Opponent submits that this supports a finding that the prefix “OP” translates directly from Dutch to English as “IN” such that the parties’ marks share the same prefix. Based on this, the Opponent submits that the Mark is thus essentially identical to the Opponent’s INTIME trade-mark.

[72] The Applicant submits that the Opponent has not provided any evidence to support a finding that the ordinary Canadian consumer of the Wares would have any knowledge of the Dutch language and as a result no weight should be placed on the Opponent’s evidence and submissions regarding the Dutch-English translation [see *Registrar of Trade Marks v. Coles Book Stores Ltd.* (1972), 4 C.P.R. (2d) 1 (S.C.C.)]. I agree with the Applicant’s submissions and a result, I am not placing any weight on the Opponent’s submissions regarding the meaning of the prefix “OP”.

[73] The Opponent also submits that the parties’ marks share the following similarities:

- both are made up of one word;
- both comprise the same number of letters;
- both prefixes contain two letters; and
- both comprise the same suffix.

[74] The Applicant, by contrast submits that the parties’ marks are not similar in appearance, sound or ideas suggested. Specifically, the Applicant submits that the Mark begins with the letters

OP which are significantly different both visually and aurally from the word IN found in the Opponent's mark. The Applicant submits that where marks have different prefixes there will be less likelihood of confusion [see *Tonka Corp. v. Toronto Sun Publishing Corp.* (1990), 34 (3d) 310 at 319 (F.C.T.D.); *Sum-Spec Canada Ltd. v. Imasco Retail Inc.* (1990), 30 C.P.R. (3d) 7 at 13 (F.C.T.D.); *Molson Canada v. Labatt Brewing Co.* (2003), 33 C.P.R. (4th) 359 at 364 (T.M.O.B.)].

[75] It is a well-accepted principle that the first portion of a trade-mark is the most relevant for the purposes of distinction [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at 188]. In the present case, the first portions of the parties' marks are entirely distinct.

[76] The parties' marks all feature the word "time". However, the word "time" is a common dictionary word, which as will be further discussed below in the analysis of the state of the register evidence, is arguably common to the software trade, thus decreasing the importance of the fact that the parties' marks share this element.

[77] As noted in *United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247 at 263 (F.C.A.),

While the marks [in issue] must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public's perception of it.

[78] In light of the low inherent distinctiveness of the word "time", the OP and IN elements of the parties' marks are more likely to have a determinative influence on the public's perceptions of the marks.

[79] There is no similarity between the OP element of the Mark and the IN element of the Opponent's INTIME trade-mark.

[80] Confusion will be unlikely in situations where marks share common features but also feature dominant differences [see *Foodcorp Ltd. v. Chalet Bar B Q (Canada) Inc.* (1982), 66 C.P.R. (2d) 56 at 73 (F.C.A.)].

[81] The Applicant submits that the parties' marks differ in ideas suggested. Specifically, the Applicant submits that the Mark could suggest a variety of meanings but the Opponent's INTIME trade-mark is highly suggestive of the Opponent's wares, namely scheduling personnel to be on time. I find that aside from the inclusion of the common word "time" there is no similarity in the ideas suggested by the Mark and the Opponent's INTIME trade-mark.

[82] I refer again to the Supreme Court's recent comments on the importance of the s. 6(5)(e) factor in a confusion analysis. Specifically, in *Masterpiece*, Rothstein J. stated that:

... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar...

[83] The fact that the parties' marks share very little similarities in terms of sound, appearance or ideas suggested is thus particularly important and supports the Applicant's position that the marks are not confusing.

Additional Surrounding Circumstance – "Co-existence" in United States

[84] The Applicant has filed particulars of the Opponent's registration for the INTIME trade-mark in the United States as well as the Applicant's U.S. registration for the Mark (see Exhibits A and B, respectively to the affidavit of Dane Penney). Based on this evidence, the Applicant submits that the parties' marks are registered and co-exist in the United States. The Applicant submits that Mr. Penney's affidavit supports a finding that the Mark has been in use in the U.S. since September 1986 and the Opponent's INTIME mark since 1995 or 1996 without any evidence of confusion.

[85] I note that the Applicant has provided no evidence of use of the Mark in the United States having merely filed printouts from the USPTO website. In the absence of any evidence of use of the Mark in the United States, no findings can be made regarding the existence or absence of confusion in the marketplace.

[86] Based on the foregoing, I am not satisfied that this qualifies as a surrounding circumstance supporting the Applicant's position.

Additional Surrounding Circumstance – State of the Register

[87] The Applicant filed, as part of the Penney affidavit, copies of particulars of twelve registrations for trade-marks including the word “TIME” registered for use in association with wares including “computer software”.

[88] When analyzing the relevance of state of the register evidence, it must be noted that such evidence will only be relevant insofar as one can make inferences from it about the state of the marketplace. Inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[89] The Opponent submitted, both in its written argument and at the oral hearing, that the fact that the registrations in the Penney affidavit cover software in general rather than “scheduling software” specifically renders the state of the register evidence irrelevant. I do not agree.

[90] In both its written argument and at the oral hearing, the Opponent relied on *Quebec Maple Products Inc. v. Stafford Foods Ltd.* (1988), 20 C.P.R. (3d) 404 (T.M.O.B.) to support its submission that, while the state of the register evidence may show third party trade-marks for computer software, only the Opponent has registrations for scheduling software specifically and that this lessens the value of the state of the register evidence. I am not convinced that in order for the state of the register evidence to be relevant it must cover exactly the wares at issue, namely scheduling software.

[91] I find that the existence of twelve registrations, owned by twelve different owners, all registered for “computer software” enables me to infer that some of the cited marks are in use in the Canadian marketplace, despite the fact that I have not been provided with any evidence of use thereof [see *Old Spaghetti Factory Canada Ltd. v. Spaghetti House Restaurants Ltd.* (1999), 2 C.P.R. (4th) 398 at 407]. Under the circumstances, I find that I am able to presume that consumers have become accustomed to seeing such marks and that the word “TIME” has become common to the computer software trade.

[92] As a result, I find that this serves as a relevant surrounding circumstance in support of the Applicant's position. As a result, I find that small differences between the parties' marks will thus serve to distinguish them.

Conclusion re s. 12(1)(d) of the Act

[93] Having considered all of the surrounding circumstances, in particular the differences between the parties' marks in terms of appearance, sound and ideas suggested and state of the register evidence supporting a finding that the word TIME (the only common element as between the parties' marks) is common to the trade, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the parties' marks.

[94] Having regard to the foregoing, I dismiss the ground of opposition based on s. 12(1)(d) of the Act.

Non-entitlement Grounds

Section 16(2)(a) and (c) of the Act

[95] The s. 16(3)(a) ground of opposition is based upon the previous use and making known in Canada by the Opponent of the Opponent's Marks and trade name (Intime Solutions Inc.).

[96] Despite the burden of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-marks and trade name, the Opponent has the initial onus of proving that the trade-marks and trade name alleged in support of its ground of opposition based on s. 16(2)(a) and (c) of the Act were used or made known in Canada prior to the filing date for the Applicant's application (April 26, 2007) and had not been abandoned at the date of advertisement of the application for the Mark (April 23, 2008) [s. 16(5) of the Act].

[97] As set out above in the discussion of the Opponent's evidence, I find that the Opponent has not provided any evidence of use of the trade-mark INTIME VISUAL SCHEDULER and thus I am dismissing the ground of opposition based on this trade-mark on the basis that the

Opponent has failed to meet its evidential burden. The same is true for the Opponent's allegations regarding making known of the INTIME trade-mark and trade name. The Opponent has not provided any evidence of making known, and as a result the grounds of opposition based on making known are dismissed on the basis that the Opponent has failed to meet its evidential burden. However, I find that the Opponent has succeeded in establishing use of the INTIME trade-mark and trade name prior to April 26, 2007 and non-abandonment as at April 23, 2008.

[98] The difference in material dates is not significant and as a result my findings under the ground of opposition based on s. 12(1)(d) of the Act are equally applicable here. As a result, I find that the Applicant has succeeded in meeting its burden of establishing no likelihood of confusion between the Mark and the INTIME trade-mark and trade name and as a result, the non-entitlement grounds of opposition are dismissed.

Non-distinctiveness Ground – s. 38(2)(d) of the Act

[99] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Wares from those of others throughout Canada [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[100] Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing of the statement of opposition, one or more of its trade-marks or trade name had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v. Bojangles Café Ltd.* (2004), 40 C.P.R. (4th) 553, affirmed (2006), 48 C.P.R. (4th) 427 (F.C.T.D.)].

[101] As set out above in the discussion of the Opponent's evidence, I find that the Opponent has not provided any evidence of a reputation for the trade-mark INTIME VISUAL SCHEDULER and as a result the non-distinctiveness ground of opposition is dismissed with respect to this trade-mark. By contrast, the Opponent has succeeded in establishing that the INTIME trade-mark and trade name had become known in Canada prior to June 23, 2008.

[102] The difference in material dates is not significant and as a result my findings under the ground of opposition based on s. 12(1)(d) of the Act are equally applicable here. As a result, I find that the Applicant has succeeded in meeting its burden of establishing no likelihood of confusion between the Mark and the Opponent's INTIME trade-mark and trade name.

Disposition

[103] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition to the Mark pursuant to s. 38(8) of the Act.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office