

IN THE MATTER OF AN OPPOSITION by Thomson Technology Inc. to application No. 614,497 for the trade-mark TTI Design filed by Transelectrix Technology Inc.

On August 30, 1988, Transelectrix Technology Inc. filed an application to register the trade-mark TTI Design, a representation of which appears below, based upon use of the trade-mark in Canada since January 1, 1987 in association with "transformers" and "reactors" and since April 21, 1987 in association with "bushings" and "gas detector relays".

The opponent, Thomson Technology Inc., filed a statement of opposition on March 8, 1989 in which it alleged that the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act in that the applicant's trade-mark is confusing with the opponent's registered trade-mark TTI THOMSON TECHNOLOGY INC. & Design, registration No.343,363, registered August 5, 1988.

The opponent further alleged that the applicant is not the person entitled to registration in that the applicant's trade-mark is confusing with the opponent's trade-mark TTI THOMSON TECHNOLOGY INC. & Design and the opponent's trade-names TTI and TTI Thomson Technology Inc. which had been used in Canada prior to the applicant's filing date in association with "electrical apparatus for switching, storing, transferring, converting, inverting and regulating electrical power, electrical apparatus for controlling and monitoring electrical systems and equipment, electrical apparatus for testing and measuring electrical systems and equipment, and electrical devices for controlling, monitoring, data acquisition, recording, measuring, performing logic functions and annunciating".

As its final ground, the opponent alleged that the applicant's trade-mark is not distinctive of, nor is it capable of distinguishing the applicant's wares from the wares or services of others, and particularly those of the opponent.

The applicant filed a counter statement in which it denied the allegations of confusion set

forth in the statement of opposition.

The opponent filed as its evidence the affidavit of Robert Thomson while the applicant failed to file either evidence or a statement in accordance with Rule 44 of the Trade-marks Regulations that it did not intend to file evidence in this opposition.

The opponent alone submitted a written argument and neither party requested an oral hearing.

With respect to the non-entitlement grounds of opposition, there is a burden on the opponent in view of the provisions of Sections 16(5) and 17(1) of the Trade-marks Act to establish its prior use of its trade-mark and trade-names prior to the applicant's claimed dates of first use (January 1, 1987 and April 21, 1987), as well as non-abandonment of its trade-mark and trade-names as of the date of advertisement for opposition purposes of the applicant's application in the Trade-marks Journal (February 8, 1989).

In support of its grounds of opposition, the opponent has filed as its evidence the affidavit of Robert Thomson dated November 16, 1989. In paragraph 5 of his affidavit, Mr. Thomson states:

"5. That attached hereto as Exhibit "C" is a true copy of the Affidavit sworn by me on September 29, 1989 in opposition to the application of the applicant Transelectrix Technology Inc. for the Trade Mark TTI under number 610312. I rely on the matters deposed to therein in support of the opposition to the application herein."

No objection was raised by the applicant to the opponent's evidence and I accept that Mr. Thomson has adopted the contents of his affidavit of September 29, 1989 as evidence in this opposition. In paragraph 6 of the September 29 affidavit, Mr. Thomson states that the opponent adopted the trade-name TTI in January of 1986. Exhibit "C" to his affidavit, a copy of an advertisement which appeared in Electrical Equipment News in September of 1986, confirms that the opponent was identifying itself as T.T.I. and was therefore using a variant of the trade-name TTI as a name under which it was carrying on business in Canada. Further, both Exhibit "C" and Exhibit "D", the latter being a copy of an advertisement published in October of 1986, include the opponent's trade-mark TTI THOMSON TECHNOLOGY INC. & Design in which the opponent's trade-name TTI in stylized lettering is associated with the opponent's corporate name.

I would also note that Exhibit "E" and "F" to the September 29 affidavit are copies of advertisements which were published in Electrical Equipment News in March of 1987 and Electrical Business in April 1988 in which it is stated: "At TTI we can offer you the world!". Even if these

advertisements are excluded as being subsequent to the applicant's earliest claimed date of first use, they are of relevance to the issue of the distinctiveness of the applicant's trade-mark. Likewise, Exhibits "H" and "I" are of relevance to the non-distinctiveness ground of opposition.

Having regard to the uncontested evidence of the opponent, I am satisfied that the opponent has established its prior use and non-abandonment of the trade-name TTI in association with the opponent's business of selling generator electrical systems. Accordingly, the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between its trade-mark TTI Design as applied to the wares covered in its application and the opponent's trade-name TTI.

In determining whether there would be a reasonable likelihood of confusion between the trade-mark and trade-name at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-mark TTI Design and the trade-name TTI.

With respect to the inherent distinctiveness of the trade-mark and trade-name at issue, the trade-mark TTI Design and the trade-name TTI are marks comprising initials and therefore possess little inherent distinctiveness.

No evidence has been adduced by the applicant and its trade-mark TTI Design must be considered as not having become known to any extent in Canada as of the applicant's claimed dates of first use. On the other hand, the Thomson affidavit establishes that the opponent had adopted the trade-name prior to applicant's claimed dates of first use and was carrying on business in Canada under its trade-name TTI as of those dates. As a result, both the extent to which the trade-mark and trade-name at issue have become known and the length of time they have been in use weighs in the opponent's favour in this opposition.

As the trade-mark TTI Design and the trade-name TTI are very similar in appearance and identical in sounding and in ideas suggested, the only remaining criteria of those enumerated in Section 6(5) of the Act are the nature of the wares and business of the parties and their respective channels of trade. In this regard, the uncontested evidence of Mr. Thomson supports the conclusion that the applicant's wares and the wares associated with the opponent's business are overlapping and

that both parties would be dealing with the same potential consumers. In this regard, I would note the following paragraphs of Mr. Thomson's affidavit of September 29, 1989:

14. Admittedly, the Company does not find itself directly competing with Transelectrix Technology Inc. as the Company does not consider itself to be in the business, regularly, of supplying heavy transformers and the Company does not manufacture power transformers.

15. The Company does, however, regularly supply switching gear for use with heavy transformers of the type supplied by Transelectrix Technology Inc. Such switching gear would be directly connected to the heavy transformers. Panels and switchboards bearing the "T.T.I." trade name would be installed in immediate physical proximity to the transformers. I know of no actual occurrence, however, there is a distinct probability that a Thomson Technology switchboard could be installed next to a Transelectrix transformer, each supplied under the trade name "TTI."

16. The Company occasionally supplies heavy transformers when supplying larger projects where heavy transformers are called for in the tender documents. The following are examples of projects to which the Company has supplied power transformers along with switch gear and other electrical apparatus: ...

Apart from the above, in paragraph 13 of the Thomson affidavit of September 29, 1989, the opponent has adduced uncontested evidence of instances of actual confusion between the opponent carrying on business under the trade-name TTI and the applicant. This evidence confirms that there was a reasonable likelihood of confusion between the trade-mark and trade-name at issue as of the applicant's claimed dates of first use.

Having regard to the above, I have concluded that the applicant has failed to meet the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark TTI Design and the opponent's trade-name TTI. As a result, the applicant is not the person entitled to registration of the trade-mark TTI Design as applied to the wares covered in the present application.

The opponent has also alleged that the applicant's trade-mark is not distinctive and is not capable of distinguishing the applicant's wares or services from those of the opponent. In this regard, the opponent's evidence confirms that it had been using its trade-name TTI for more than two and one-half years in Canada as of March 8, 1989, the material date for assessing this ground of opposition. As a result, the applicant's trade-mark TTI Design was not distinctive of its wares as of the date of opposition.

I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 27th DAY OF August, 1992.

G.W.Partington,  
Chairman,  
Trade Marks Opposition Board.