

**IN THE MATTER OF AN OPPOSITION by
Alcohol Countermeasure Systems Corp.
to application No. 850,237
for the trade-mark PARENT'S ALERT
in the name of Parent's Alert, Inc.**

On July 9, 1997, the applicant, Parent's Alert, Inc., filed an application to register the trade-mark PARENT'S ALERT. The application is based upon use and registration of the trade-mark in the United States of America in association with

WARES:

(1) Drug and alcohol test kits for; namely, urine collection cup with temperature strip, urine transport bottle, lid, tamper-proof plastic bag, pre-labelled mailer, alcohol screen strips, preprinted laboratory requisition form and information booklet.

SERVICES:

(1) Referral services, namely reporting results of drug and alcohol test and referring parents/children to support services.

The applicant claimed the benefit of section 14 of the *Trade-marks Act* when it filed its application and disclaimed the right to the exclusive use of the word PARENT'S apart from the trade-mark in response to a request from the examiner.

The application was advertised for opposition purposes in the Trade-marks Journal of May 10, 2000. On October 5, 2000, the opponent, Alcohol Countermeasure Systems Corp., filed a statement of opposition. The applicant filed and served a counter statement.

The opponent filed rule 41 evidence, namely the affidavit of Felix J.E. Comeau. As rule 42 evidence,

the applicant filed the affidavits of Carl Gauthier, Chantal Meessen and Evelyne Thomassian.

Each party filed a written argument and was represented at an oral hearing.

Grounds of Opposition

There are six grounds of opposition, which are summarized below:

1. The application does not comply with subsection 30(d) of the Act because the applicant has not used and registered the trade-mark in the United States of America as claimed.
2. The application does not comply with subsection 30(i) because the applicant was at the time of the application aware of the opponent's registered trade-mark ALERT registration No. 227,362 and could not therefore have been satisfied as to its entitlement to use the trade-mark PARENT'S ALERT.
3. The trade-mark is not registrable by virtue of paragraph 12(1)(d) because it is confusing with the opponent's trade-mark ALERT registered for breath alcohol analysers and disposable components.
4. The applicant is not the person entitled to registration of the trade-mark by virtue of paragraph 16(2)(a) because the trade-mark was, at the date the application was filed, and is confusing with the trade-mark ALERT of the opponent which has been used extensively in Canada.
5. The applicant is not the person entitled to registration of the trade-mark by virtue of paragraph 16(2)(b) because the trade-mark was, at the date the application was filed, and is confusing with the trade-mark ALERT of the opponent in respect of which the opponent had previously filed an application for registration.
6. The applicant's trade-mark is not, and cannot be, distinctive of the applicant for the foregoing reasons.

Rule 41 Evidence

Comeau Affidavit

Mr. Comeau, the opponent's President and owner, attests that the opponent designs and manufactures breath alcohol testing devices and systems in Canada and distributes these products

both in Canada and throughout the world. He states that there are only a few companies in Canada that manufacture and produce alcohol testing devices.

According to Mr. Comeau, the ALERT trade-mark was first used in Canada in association with breath analysers or testers and disposable components in August of 1976. He states that ALERT products have been extensively sold and used in Canada in the 25 years since, but the sales figures that he has provided indicate that in each of the years 1997 through 2001 less than 30 units were sold on average, with annual sales averaging about \$10,000.

Mr. Comeau has provided a brochure showing his company's ALERT J4X model of breath tester, which displays a photograph of the product bearing the ALERT trade-mark. He also provides sample labels.

At paragraph 5, Mr. Comeau states, "ALERT breath testers come in a variety of models intended for different operations and purposes. Breath testers bearing the ALERT trade-mark have been distributed to industries, police forces, hospitals and schools in Canada."

Rule 42 Evidence

Gauthier Affidavit

Mr. Gauthier, a trade-mark research-analyst, provides the results of searches that he conducted of the Canadian trade-mark register for trade-marks "composed of the element 'ALERT'" as well as the results of a search that he conducted for domain names including the element "ALERT". 141 trade-marks and "several" domain names were located.

Meessen Affidavit

Ms. Meessen, a common law and online research-analyst, provides the results of “a dilution search” that she conducted for the mark ALERT.

Thomassian Affidavit

Ms. Thomassian, a trade-mark research-analyst, provides the results of a common law search that she performed on April 17, 2002 directed to ALERT.

Evidential Burden

While the ultimate legal burden is always upon the applicant, there is an initial evidential burden on the opponent to establish the facts relied upon by it in support of each of its grounds of opposition [see *Joseph E. Seagram & Sons Ltd. et al. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.) at 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

The opponent has not met its initial burden with respect to the grounds of opposition under subsections 30(d) and 30(i) because there is no evidence supporting its claim that the applicant did not use or register its mark in the United States or that the applicant was aware of the opponent’s mark when it filed its application. Accordingly, the first and second grounds of opposition are dismissed.

With respect to the third ground of opposition, the Registrar has discretion to check the Register to confirm the existence of a registration relied upon in an opposition [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. I have exercised this discretion to confirm that registration No. 227,362 is in good standing. The opponent's initial burden with respect to the third ground is thereby met.

Regarding the fourth ground of opposition, the opponent must put forth evidence from which I can conclude that it was using its mark in Canada in accordance with section 4 prior to July 9, 1997. No such evidence has been provided. Moreover, I note that while sales figures have been provided for 1997, there is no indication that any such sales occurred before July 9 of that year. Accordingly, I dismiss the fourth ground of opposition on the basis that the opponent has not met its initial evidential burden.

The fifth ground is also dismissed. This is because subsection 17(1) requires the application relied upon to have been pending as of the date of advertisement. As the opponent's application issued to registration on April 21, 1978, it was not pending on May 10, 2000.

The opponent has an initial burden with respect to its sixth ground to establish that its mark had become known sufficiently as of October 5, 2000 to negate the distinctiveness of the applicant's mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.) at 58]. I find that the opponent has satisfied this burden.

Likelihood of Confusion

The two surviving grounds of opposition both turn on the issue of the likelihood of confusion between ALERT and PARENT'S ALERT. The material date for assessing this issue with respect to registrability under paragraph 12(1)(d) is 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.)]. With respect to distinctiveness, the material date is the date of filing of the statement of opposition [see *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.) at 324].

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the Act. Those factors specifically set out in subsection 6(5) are: the inherent distinctiveness of the trade-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; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. All factors to be considered under subsection 6(5) 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* (1966), 66 C.P.R. (3d) 308 (F.C.T.D.)].

Each of the trade-marks is inherently weak since each suggests an aspect of the role of the associated products and services.

The applicant's mark has not become known to any extent whereas the opponent's mark has acquired some distinctiveness as a result of its use and promotion.

The length of time that either mark has been used in Canada clearly favours the opponent given that the applicant appears to have not used its mark to date while the opponent claims use for more than 25 years.

The parties' wares serve a similar purpose. Although the opponent appears to market its wares to institutional or corporate clients, such a restriction does not appear in the statement of wares in its registration, with the result that its exclusive right is not restricted to any particular market. The inclusion of the word "parent" in the applicant's mark suggests that it intends to market its wares and services to individuals, but again there is no such restriction stated in its statement of wares and services. I therefore conclude that there is a potential overlap in the channels of trade.

Although there are differences between the marks when viewed and sounded, the idea suggested by each is similar, namely that the products will "alert" one. Given the nature of the wares/services, the impression is that the products/services will alert one to the presence of alcohol. Although the first component of a mark is often considered more important for the purpose of distinction, when a word is a common, descriptive or suggestive word, the significance of the first component decreases [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4th) 109 (T.M.O.B.)]. Although the word PARENT'S may serve to distinguish the applicant's mark somewhat from the

opponent's mark, the addition of that word may also be easily interpreted as indicating that this is a different version of the opponent's ALERT product, specifically one for parents. Such a conclusion may be supported by the fact that the opponent does offer more than one model of its ALERT product, for example ALERT J4X.

A further surrounding circumstance to be considered is the evidence of the state of the register and marketplace. Although the opponent has introduced considerable evidence of the word ALERT in trade-marks or trade-names owned by third parties, I only conclude from this evidence that the opponent's trade-mark is not entitled to a broad scope of protection. However, in the absence of evidence that the word ALERT has been commonly adopted by others for the specific wares at issue here (alcohol testing devices), I conclude that the opponent's trade-mark is entitled to a scope of protection that is broad enough to prevent the registration of a similar mark for wares of the same nature. (On this point, I would mention that I do not accept the applicant's argument that there are sufficient differences between the parties' wares to make confusion unlikely.)

Finally, I would comment that I consider the case relied upon by the applicant at the oral hearing, *Brick Warehouse Corp. v. Nefco Furniture Ltd.* (2003), 26 C.P.R. (4th) 348 (F.C.T.D.), to be fully distinguishable simply on the basis that the opponent in that case had not used the mark that it relied upon for seven years.

Having considered all of the surrounding circumstances, I conclude that the applicant has not satisfied its legal onus to show that, on a balance of probabilities, there is not a reasonable likelihood of confusion between ALERT and PARENT'S ALERT as applied to the wares and

services at issue either as of October 5, 2000 or today's date. After all, the applicant has taken the opponent's mark in its entirety and applied it to wares that are very similar to those of the opponent. Although the applicant has added a word in front of the opponent's mark, this addition is not particularly distinctive and is more likely to suggest a different model of the opponent's wares than to distinguish the applicant's wares from those of the opponent. A consumer, who has an imperfect recollection of the opponent's ALERT mark, might reasonably infer that the PARENT'S ALERT wares share the same source.

I note that the application as originally filed indicated that the PARENT'S ALERT wares are "for home use". Although this restriction disappeared during the prosecution of the application, its inclusion would not have changed the outcome of these proceedings for two reasons. First, the opponent's registration is not restricted to any particular market. Second, a consumer might simply think that the PARENT'S ALERT product is the home version of the ALERT product.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, I refuse the application pursuant to the provisions of subsection 38(8) of the Act.

DATED AT TORONTO, ONTARIO THIS 21st DAY OF DECEMBER, 2004.

**Jill W. Bradbury
Member
Trade-marks Opposition Board**