IN THE MATTER OF AN OPPOSITION by Her Majesty the Queen in the Right of Canada, as represented by the Minister of Environment to application No. 661,505 for the trade-mark COMPUTOX filed by Bayer Diagnostic GmbH

On July 5, 1990, the applicant, Bayer Diagnostic GmbH, filed an application to register the trade-mark COMPUTOX based on use and registration of the trade-mark in the Federal Republic of Germany in association with "*gas analytic measuring and testing apparatus*". The applicant amended its application prior to advertisement to change the basis for registration to proposed use of the trade-mark in Canada. Also, the statement of wares was amended to cover "*measuring and testing apparatus, namely gas analyzers*".

The application was advertised for opposition purposes in the ***Trade-marks Journal*** of March 4, 1992 and the opponent, Her Majesty the Queen in the Right of Canada, as represented by the Minister of Environment, filed a statement of opposition on May 1, 1992. The first ground of opposition is that the applicant's application does not comply with Section 30(i) of the ***Trade-marks Act*** in that the applicant could not have been satisfied as of the filing date that it was entitled to use the trade-mark COMPUTOX in Canada in view of the opponent's official mark COMPUTOX. As its second ground, the opponent alleged that the applicant's trade-mark is not registrable pursuant to Sections 9(1)(n)(iii), 11 and 12(1)(e) of the ***Trade-marks Act*** in that it consists of the opponent's official mark COMPUTOX in respect of which the Registrar gave public notice of its adoption and use in the ***Trade-marks Journal*** of November 21, 1984. The third and fourth grounds are that the applicant is not the person entitled to registration and the applicant's trade-mark COMPUTOX is not distinctive in view of the facts set forth in the second ground.

The applicant filed and served a counter statement and was subsequently granted leave to submit an amended counter statement in which it asserted *inter alia* that adoption and use of the official mark COMPUTOX by Canadian Patents and Development Limited (CPDL) was improper since CPDL had not adopted and used the mark COMPUTOX in association with computer programs as of the date of the Section 9 notice or, in the alternative, if CPDL had adopted and used the mark, such use was not within the mandate of CPDL.

As its evidence, the opponent filed a certified copy of extracts from the Trade-marks Office file No. 900,309 which included the following: (i) publication of the Section 9(1)(n)(iii) in the ***Trade-marks Journal*** of the official mark COMPUTOX; (ii) the transfer of administration and control of the official mark COMPUTOX dated January 2, 1992 in favour of the opponent, Her Majesty the Queen in the Right of Canada, as represented by the Minister of Environment; and (iii) a letter from the Trade-marks Office confirming that the transfer has been placed on file. The applicant filed as its evidence the affidavit of Brian P. Isaac, an associate with the trade-mark agents for the applicant. The opponent alone filed a written argument and no oral hearing was conducted in respect of this opposition. There may be some question as to the effect of the document filed with the Trade-marks Office and identified as a "TRANSFER OF ADMINISTRATION AND CONTROL OF OFFICIAL MARK", considering that the parties to the transfer were Her Majesty the Queen in right of Canada and CPDL, an agent of Her Majesty the Queen in right of Canada. However, I consider it unnecessary to decide this issue as the opponent would have been free to rely upon the official mark COMPUTOX in challenging the registrability of the applicant's trade-mark under Sections 9(1)(n)(iii) and 12(1)(e) of the ***Trade-marks Act*** even if the mark stood in the name of CPDL.

Mr. Isaac has annexed to his affidavit photocopies of an order in council and various corporate records relating to Canadian Patents and Development Limited. In the absence of a written argument from the applicant, I have assumed that these documents were adduced in support of the allegation in the amended counter statement that any use of the official mark by Canadian Patents and Development Limited was not within its mandate. However, the evidence of record does not establish that computer programs are not within the mandate of CPDL. Indeed, having regard to the order in council and paragraphs (h) and (i) of Section 10 of ***The Research Council Act***, it would appear that the development of computer programs for licensing, sale or the like might well fall within the CPDL's mandate. Further, the telephone enquiries made by Mr. Isaac to Environment Canada are of no relevance to the adoption and use of the official mark COMPUTOX by Canadian Patents and Development Limited.

The most relevant of the opponent's grounds is the second ground of opposition based on

Sections 9(1)(n)(iii), 11 and 12(1)(e) of the ***Trade-marks Act***. The material time for considering the circumstances respecting this ground is the date of my decision [see ***Allied Corporation v. Canadian Olympic Association***, 28 C.P.R.(3d) 161 (F.C.A.); and ***Olympus Optical Company Limited v. Canadian Olympic Association***, 38 C.P.R. (3d) 1 (F.C.A.)]. Furthermore, the opponent is not required to evidence use and adoption of its official mark [see ***Allied Corporation v. Canadian Olympic Association***, 28 C.P.R.(3d) 161, at pg.166]. While the applicant in its amended counter statement asserted that its wares differ from those covered in the public notice relating to the official mark COMPUTOX, I would note that the test under Section 9(1)(n)(iii) is one of straight comparison of the marks at issue without regard to such marketplace considerations as the wares, services or trades involved [see ***Allied Corporation*** decision, *supra*, at page 166; and ***Canadian Olympic Association v. Konica Canada Inc.***, 30 C.P.R.(3d) 60, at pg. 65].

In the present case, the applicant's trade-mark COMPUTOX is identical to the official mark COMPUTOX and therefore the applicant's trade-mark consists of the official mark relied upon by the opponent. As a result, the applicant's trade-mark is contrary to Section 9(1)(n)(iii) of the ***Trade-marks Act*** and therefore is not registrable in view of Sections 10 and 12(1)(e) of the ***Trade-marks Act.***

Having been delegated by the Registrar of Trade-marks pursuant to Section 63(3) of the ***Trade-marks Act***, I refuse the applicant's application pursuant to Section 38(8) of the Act.

DATED AT HULL, QUEBEC, THIS 20th DAY OF DECEMBER, 1996.

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