

IN THE MATTER OF AN OPPOSITION by Comstock Limited to
application No. 719,063 for the trade-mark COMSTOCK filed by
Commodity Quotations Inc. (now S&P ComStock, Inc.)

On December 17, 1992, the applicant, Commodity Quotations Inc., filed an application to register the trade-mark COMSTOCK based on use in Canada since at least as early as January 1, 1985 on services. The application covers the following services:

“Computerized business and financial information services.”

The application was advertised for opposition purposes in the Trade-Marks Journal of March 9, 1994. The agent for the applicant subsequently filed a copy of a Certificate of Amendment of the Certificate of Incorporation showing the change of name of the applicant company to S&P ComStock, Inc. on October 16, 1995.

The opponent, Comstock Limited, filed a statement of opposition on May 2, 1994. The opponent was subsequently granted leave to amend its statement of opposition on January 15, 1996. The first ground of opposition is based on Section 30(b) of the Trade-Marks Act, R.S.C. 1985 c.T-13 (hereinafter the Act), the opponent asserting that the trade-mark has not been continuously used since January 1, 1985. As its second ground of opposition, the opponent maintains that the applied for mark is not registrable pursuant to s.12(1)(d) of the Act as it is confusing with the opponent’s registered marks COMSTOCK, Regn. No. 352,131 and COMSTOCK & Design, Regn. No. 352,387 for use in association with the following services:

“Electrical, hydro-electric, atomic and fossil fuel power plants, plumbing and heating, process piping, instrumentation, mechanical, mill weighting and rigging, sheet metal and ventilation, refrigeration services, high voltage transmission, and civil construction”

(hereinafter “construction and building services”). The opponent alleges as its third ground of opposition that the applicant is not the person entitled to registration of the mark pursuant to s.16(1)(a) and s.16(1)(c) of the Act because at the date of first use, the trade-mark was confusing with the trade-mark COMSTOCK and the trade-name COMSTOCK which had been previously used by the opponent. The fourth ground of opposition is that the trade-mark is not distinctive pursuant to s.38(2)(d) and s.2 of the Act as it does not distinguish the wares used by the applicant from those of others, including the opponent.

The applicant filed and served a counter statement on August 5, 1994, in which it denied the allegations asserted by the opponent in its statement of opposition. The applicant requested leave to file an amended counter statement on February 29, 1996. The Office inadvertently failed to advise the applicant that its amended counter statement was accepted. The amended counter statement is hereby accepted pursuant to Rule 40 of the Trade-Marks Regulations.

As its evidence, the opponent filed the affidavit of Frank Loewen, Secretary of Comstock Limited. The affidavits of Shirley McDonald, trade-mark searcher for the applicant's agent and Daniel J. Connell, President of S&P ComStock, Inc. (formerly Commodity Quotations, Inc.) were submitted as the applicant's evidence. Both the opponent and the applicant filed written arguments and both were represented at an oral hearing.

I have noted that Mr. Loewen deposed to matters in his affidavit which occurred prior to his company acquiring title to the COMSTOCK trade-mark. In his affidavit at paragraph 2, Mr. Loewen states the following:

“...On October 10, 1968 Rathgeb Contractors Limited purchased the undertaking and business and substantially all of the assets including the trade marks of Canadian Comstock Company Limited. Rathgeb Contractors Limited changed its name to **Canadian International Comstock Company Limited** by Supplementary Letters Patent dated January 29, 1969. Canadian International Comstock Company Limited changed its name to Comstock **International Limited** by Supplementary Letters Patent dated September 30, 1971. On December 2, 1985 by Articles of Amalgamation Comstock International Limited amalgamated with several affiliated companies to form a new amalgamated company named Comstock International **Ltd.** On November 30, 1987 most of the assets of Comstock International Ltd. (*but excluding the trade-mark COMSTOCK*) were sold to Comstock **Canada**, a Limited Partnership in which the General Partner was Lundrigans-Comstock Limited. On December 1, 1987 by Articles of Amalgamation Comstock International Ltd. amalgamated with several different companies to form a new amalgamated company namely **Lundrigans-Comstock Limited**. On 18 February, 1991 Lundrigans-Comstock Limited *assigned* its interests in the trade-mark COMSTOCK to **923451 Ontario Limited** and, subsequently, that numbered company changed its name to Comstock **Limited**. As a result, Comstock Limited is the present owner of Trademark Registration Nos. 352,131 for the mark COMSTOCK and 352,387 for the mark COMSTOCK design...” (emphasis mine).

At the oral hearing, the agent for the opponent maintained that all of the companies referred to by Mr. Loewen were related companies and that consequently, Mr. Loewen would have personal knowledge of the use of the mark dating back to 1930 (the alleged date of first use of the mark). Although I acknowledge that each of the companies who owned the mark **prior to** 1991 were related in some aspect because of amalgamations or name changes, the same relationship does

not exist in my view between an assignor of a mark and an assignee, such as was the case between Lundrigans-Comstock Limited and Comstock Limited (formerly 923451 Ontario Limited). Therefore, it is not clear to me how Mr. Loewen would have personal knowledge of the records of Lundrigans-Comstock Limited who assigned the COMSTOCK trade-mark to his company in 1991. Consequently, I am not prepared to give full weight to the matters deposed by Mr. Loewen that occurred prior to 1991.

As for the opponent's first ground of opposition, the onus or legal burden is on the applicant to show its compliance with the provisions of Section 30(b) of the Act: see the opposition decision in **Joseph Seagram & Sons v. Seagram Real Estate** (1984), 3 C.P.R.(3d) 325 at 329-330 and the decision in **John Labatt Ltd. v. Molson Companies Ltd.** (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). There is, however, an evidential burden on the opponent respecting its allegations of fact in support of that ground. That burden is lighter respecting the issue of non-compliance with Section 30(b) of the Act: see the opposition decision in **Tune Masters v. Mr. P's Mastertune** (1986), 10 C.P.R.(3d) 84 at 89. Furthermore, Section 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed: see **Labatt Brewing Company Limited v. Benson & Hedges (Canada) Limited and Molson Breweries, a Partnership** (1996), 67 C.P.R.(3d) 258 at 262 (F.C.T.D.). Finally, the opponent's evidential burden can be met by reference to the applicant's own evidence: see **Labatt Brewing Company Limited v. Molson Breweries, a Partnership** (1996), 68 C.P.R.(3d) 216 at 230 (F.C.T.D.).

The opponent submits that the applicant's application does not conform to the requirements of Section 30(b) because the application falsely states that the trade-mark COMSTOCK has been continuously used by the applicant since January 1, 1985. Relying on exhibits C,E,F,G,H, and I attached to the Connell affidavit, the opponent asserts that the applicant discontinued use of the mark COMSTOCK in 1991 and began to use the composite mark S&P COMSTOCK instead. In this regard, the opponent's agent relied on the Trade-Marks Opposition Board decision in **Nightingale Interloc Ltd. v. Prodesign Ltd.** (1984), 2 C.P.R. (3d) 535 (hereinafter **Nightingale**). In the **Nightingale** case, the Opposition Board concluded that the opponent's use of the term "Nightingale Interloc" on its label did not constitute use of the trade-mark INTERLOC *per se*. Further, there was no evidence that the word "Interloc" had ever been used by the opponent.

I agree with the opponent that some of the exhibits attached to the Connell affidavit do not show use of the trade-mark COMSTOCK. For example, on the page entitled “An Inexpensive Source of Unreliable Quotes” included as part of Exhibit H to the Connell affidavit, the word ComStock is used as a trade-name and not as a trade-mark. Further, the representative invoices attached as Exhibit F to the Connell affidavit display the name of the applicant company as “Commodity Quotations” in 1985, “ComStock” in 1988, 1989 and 1990 and “S&P ComStock” in 1991, 1992 and 1993, and do not show use of the trade-mark COMSTOCK.

I respectfully disagree with the opponent, however, that the Nightingale case is applicable to the present case. In the present case, the characterization S&P appears to be the applicant’s house mark and trade-name as the evidence shows that it appears on the promotional brochures along with other trade-marks. As the agent for the applicant pointed out, Exhibit C to the Connell affidavit shows use of the letters “S&P” as a separate trade-mark to identify other services offered under the McGraw-Hill group of companies, such as “S&P MarketScope”, “S&P MarketScope Europe”, “S&P Equity Fundamental Data”, etc. Consequently, I consider that the designation S&P COMSTOCK is the use of two different marks, not the use of a composite mark as in Registrar of Trade-Marks v. Compagnie Internationale pour l’Informatique CII Honeywell Bull S.A. (1985), 4 C.P.R. (3d) 523 (F.C.A.) which was referenced to in the Nightingale decision. In arriving at this conclusion, I had regard to the Section 45 decision in Mantha & Associates v. Old Time Stove Co. Inc. (1990), 30 C.P.R. (3d) 574 at 575.

Even if I had not been satisfied that the use of the designation S&P COMSTOCK was the use of two different marks and not the use of a composite mark, I would still be able to conclude, based on the evidence as a whole, that the applicant’s COMSTOCK mark had been used continuously in association with services (as set out in Section 4(2) of the Act) by the applicant since the alleged date of first use (i.e. January, 1985). In his affidavit at paragraph 6, Mr. Connell states that his company has continuously used the COMSTOCK trade-mark in Canada since at least as early as January 1985 in association with computerized business and financial services. Sales figures for the services provided to the applicant’s clients in Canada under the COMSTOCK trade-mark for each year from 1988 to 1995 were provided by Mr. Connell at paragraph 9 of his affidavit. Included as part of Exhibit H to the Connell affidavit was a promotional brochure entitled “A Real-Time Data System Should Be Able to Run Every Application You Can Think Of. And Some You Haven’t” wherein use of the COMSTOCK

trade-mark is shown. For example, the brochure refers to “connect[ing] ComStock to any host or operating system”, “ComStock’s digital data feed” and “ways to use ComStock”.

In view of the above, the first ground of opposition is unsuccessful.

With respect to the second ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark pursuant to s.12(1)(d) of the Act is the date of my decision (**Park Avenue Furniture Corporation v. Wickes/ Simmons Bedding Ltd.** (1991), 37 C.P.R. (3d) 413 (F.C.A.)). Further, 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 the following specifically set forth in s.6(5) of the Act: a) the inherent distinctiveness of the trade-marks and the extent to which the trade-marks have become known; b) the length of time the trade-marks have 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. I will review the evidence in light of these criteria and any other surrounding circumstances.

As for Section 6(5)(a) of the Act, I consider that the applicant’s mark possesses some degree of inherent distinctiveness in that the mark COMSTOCK is a coined word. The distinctiveness of the applicant’s mark is lessened, however, by the fact that COMSTOCK is somewhat suggestive of the applicant’s services. In its written submissions, the applicant states that the mark was created by the combination of the prefix COM from the word “commodities” and the word STOCK. Further, exhibits attached to the Connell affidavit show that the applicant provides, *inter alia*, computerized business and financial information that include information on stocks, bonds and the like.

I am satisfied that the applicant’s trade-mark has become known to some extent in Canada. Sales figures provided by Mr. Connell at paragraph 9 of his affidavit show that sales for the services provided to the applicant’s clients in Canada under the COMSTOCK trade-mark have been increasing for each year from 1988 to the date of Mr. Connell’s affidavit (October 2 , 1995) and were in excess of \$200,000 at the date of his affidavit. Mr. Connell also states at

paragraph 8 of his affidavit that consumers are made aware of the applicant's services through advertisements in financial trade journals and calls by sales representatives with the assistance of brochures that are mailed to the potential end user by the representative (Connell affidavit, paragraph 8 & Exhibits C and E).

The opponent's marks COMSTOCK and COMSTOCK & Design possess a higher degree of inherent distinctiveness than the applicant's mark because they are coined words and they are not suggestive of the opponent's construction and building services. Regarding the extent to which these marks have become known, the opponent's evidence shows that these trade-marks have become very well known across Canada in the industrial and business sectors. Mr. Loewen provides significant sales figures for services provided in association with the trade-mark COMSTOCK in Canada between 1930 and 1994 at paragraph 13 of his affidavit. The evidence also shows that the opponent's mark has been advertised in Canada since 1930 by various means including the prominent display of COMSTOCK on the business vehicles of the opponent's companies as they travel Canadian roads, by signage displaying the mark COMSTOCK at project sites which have been located throughout Canada, and by the distribution of 30,000 promotional brochures by the opponent's licensee between 1986 and the date of Mr. Loewen's affidavit (March 2, 1995) (Loewen affidavit, para. 14 & Exhibit N).

Regarding Section 6(5)(b) of the Act, the length of time the marks have been in use clearly favours the opponent. Mr. Loewen states at paragraph 3 of his affidavit that his company's said predecessors and Comstock Canada have used the trade-mark COMSTOCK in Canada since 1930. The applicant, on the other hand, has used its mark since January, 1985 (Connell affidavit, paragraph 6).

Under Section 6(5)(c) of the Act, consideration must be given to the nature of the services of the parties. In my view, the applicant's computerized business and financial information services are considerably different than the opponent's construction and building services. The applicant's evidence shows that its services include, *inter alia*, developing software to collect extensive and comprehensive financial information covering equities, futures, options, foreign exchange and fixed income (Connell affidavit, paragraph 6, Exhibit A). The applicant's evidence also shows that services are billed on a monthly basis costing on average anywhere from \$200.00 to \$1,000.00 (see Exhibit F to the Connell affidavit).

The opponent's construction and building services, on the other hand, specifically include "Electrical, hydro-electric, atomic and fossil fuel power plants, plumbing and heating, process piping, instrumentation, mechanical, millwrighting and rigging, sheet metal and ventilation, refrigeration services, high voltage transmission, and civil construction". These services have been provided by the opponent for, *inter alia*, commercial building complexes, refitting warships, building airport facilities, building electrical facilities, constructing pipelines, electrical-mechanical work conducted at Ford Canada, and the construction of the Toronto Subway System (see Loewen affidavit, paras. 3,5,10,15 & Exhibits A-I & L-N). The representative invoices attached as Exhibit L to the Loewen affidavit show that the opponent's services cost anywhere from \$696.00 to over \$4 million dollars. Most importantly, the opponent has not shown use of its mark in association with any type of computerized business and financial service.

With respect to Section 6(5)(d) of the Act, I agree with the opponent's agent that there is some potential for overlap in the parties' channels of trade. In his affidavit at paragraph 6, Mr. Connell states that the applicant's COMSTOCK subscribers include private investors, brokers, banks and money managers. Attached as Exhibit B to the Connell affidavit is a list of the applicant's customers in Canada who subscribe to the applicant's COMSTOCK services. The opponent's agent submits that many of the subscribers to the applicant's services are industrial companies which are the types of companies that the opponent directs its services to (see Loewen affidavit, para.8). For example, both the applicant's and the opponent's evidence show that Redpath Sugars is a customer to whom each party has provided its COMSTOCK services (see Loewen affidavit, para. 10 and Exhibit B to the Connell affidavit).

The opponent's agent also submits that the opposition decisions **Bell-Northern Research Limited v. Telesis (Sarl)** (1989), 25 C.P.R. (3d) 379 (hereinafter **Telesis**) and **Diversey Wyandotte Inc. v. Clorox Co.** (1990), 31 C.P.R. (3d) 110 (hereinafter **Clorox**) are of note to the present case because both involve an application for a mark that is identical to a registered mark. In each case, the trade-mark application was refused because of, *inter alia*, a potential overlap in the trades of the parties and the identity between the marks. It is my respectful opinion, however, that each of the above noted cases can be distinguished from the present case. In each case, the opponent had shown involvement with the sale of wares or the performance of services almost identical to the applicant's wares or services. For example, in **Telesis**, the opponent had shown

involvement in “**consultation services** in the fields of telecommunications and integrated office systems” while the application was for “business **consulting services** of a national and international nature; conducting research and advising government and public authorities on industrial and economic policies”. In the Clorox case, the opponent had shown its involvement in the manufacture and sale of products in the nature of “disinfectants and **bleaches**” while the applicant’s application was for “household laundry **bleach**”. In the present case, however, the opponent has not shown use of its mark in association with the applicant’s services (i.e. computerized business and financial services). Therefore, I do not consider the Telesis and Clorox cases to be of much relevance to the present case.

Relying on the Supreme Court decision in General Motors Corp. v. Bellows (1949), 10 C.P.R. 101, it is the submission of the applicant’s agent that because of the expensive nature of the opponent’s construction and building services, the potential customer would be well aware of the services offered by the opponent company and would be very discerning of its requirements before retaining such services. Although the evidence does not show that all of the opponent’s construction and building services cost millions of dollars (*eg.* the representative invoices attached as Exhibit L to the Loewen affidavit show that the opponent’s services cost anywhere from \$696.00 to over \$4 million dollars), I consider that because of the nature of the opponent’s services, a prospective purchaser would not likely purchase the opponent’s services in a hurried manner without due consideration prior to making the purchase. Consequently, although the channels of trades of the parties may overlap, I do not consider that they are likely to overlap to such an extent that confusion would result.

As for Section 6(5)(e) of the Act, it is conceded by the applicant’s agent that the respective trade-marks are the same in sound and appearance, consisting primarily of the word COMSTOCK. The marks are also the same in the ideas suggested.

The applicant submitted that a further surrounding circumstance for the Registrar to consider are the trade-marks which include the word COMSTOCK which co-exist on the Registrar as evidenced by the McDonald affidavit. My review of McDonald affidavit reveals only 6 third-party registrations for trade-marks incorporating the word COMSTOCK, as well as reference to a type of seed variety registered under the Seeds Act which incorporates the word COMSTOCK. I do not consider a mark registered under the Seeds Act to be of any relevance

whatsoever. Further, in the absence of evidence of use of the registered trade-marks, the existence of only 6 third-party registrations is insufficient evidence to allow me to conclude that there has been common adoption and use of COMSTOCK in the marketplace.

As a further surrounding circumstance, I have considered Mr. Connell's statement in his affidavit at paragraph 12 that he is not aware of any instances of actual confusion between the applicant's COMSTOCK trade-mark and the opponent's COMSTOCK trade-mark despite the concurrent use of the marks in the marketplace for over 10 years. The opponent's agent submitted that the applicant's sales are not so significant that the absence of evidence of instances of actual confusion is a particularly relevant surrounding circumstance in this proceeding. I respectfully disagree. Given the nature of the applicant's services (eg. the fact that they cost on average less than \$1,000 per month), I consider that sales in excess of \$200,000 is of relevance to this proceeding. Although this factor is not determinative of the issue of the likelihood of confusion between the trade-marks, it does nevertheless constitute a surrounding circumstance which weighs in the applicant's favour in this opposition.

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 differences in the services of the parties, and the absence of evidence of actual confusion despite the co-existence of the marks for over 10 years, I find that the applicant has satisfied the onus on it to show that there would be no reasonable likelihood of confusion between the applicant's COMSTOCK mark for computerized business and financial information services and the opponent's COMSTOCK and COMSTOCK and Design marks for building and construction services. Consequently, this ground of opposition is unsuccessful.

The third and fourth grounds of opposition also turn on the determination of the issue of the likelihood of confusion between the applicant's trade-mark COMSTOCK and the opponent's COMSTOCK trade-mark. The material dates for assessing the likelihood of confusion in respect of the non-entitlement ground and non-distinctiveness ground are, respectively, January 1, 1985, and May 2, 1994. The difference in the material dates between the s.12(1)(d) ground and the non-distinctiveness ground does not have any significant impact on the determination of the issue of confusion between the trade-marks of the parties. The difference in the material dates between the s.12(1)(d) ground and the non-entitlement ground is of some significance since there had

been no concurrent use of the marks in the marketplace as of January 1, 1985. Despite this factor however, I still consider that the applicant's services are so different from the opponent's services that it is not likely that a consumer would confuse the applicant's mark with the opponent's trade-marks or trade-name. Therefore, the remaining grounds of opposition are also unsuccessful.

Accordingly, and with the authority delegated to me under s. 63(3) of the Act, I reject the opponent's opposition pursuant to s.38(8) of the Act

DATED AT HULL, QUEBEC, THIS 18th DAY OF AUGUST 1997.

C. R. Vandenakker
Hearing Officer
Trade-Marks Opposition Board

The opponent did not allege that its trade-marks were “famous” in Canada. Even if this argument had been raised, however, I would not have considered that the opponent’s marks were so famous that they should be accorded a broad ambit of protection. In the recent unreported decision **Jaguar Cars Limited and The Jaguar Collection Limited v. Manufacture des Montres Jaguar S.A.** (Application No. 693,313; July 31, 1997) (T.M.O.B.), the Chairman of the Trade-Marks Opposition Board stated the following at page 5:

“To be considered a ‘famous’ trade-mark, I would expect that a mark must be generally recognized throughout Canada, as well as by most, if not all, segments of the population. In the present instance, I have my doubts as to whether the opponents’ JAGUAR trade-mark would be generally recognized by most segments of the population, and especially those having little, if any, knowledge of automobiles. I am therefore not prepared to conclude that the opponents’ mark qualifies as a ‘famous’ trade-mark in Canada.”

In the present case, the opponent’s evidence shows that its marks have become well known in Canadian **industrial and business** sectors. I do not consider, however, that the opponent’s COMSTOCK marks are recognized throughout Canada by **most** segments of the population and especially those outside of the industrial and business sector. Consequently, I would not have been prepared to conclude that the opponent’s marks should be accorded a broad ambit of protection.