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

Citation: 2010 TMOB 72
Date of Decision: 2010-06-02

IN THE MATTER OF AN OPPOSITION by Bosch Sicherheitssysteme GMBH to application No. 1,280,324 for the trade-mark DIBOSS in the name of Diboss Canada Inc.

[1] On November 21, 2005, Diboss Canada Inc. [the Applicant] filed an application to register the trade-mark DIBOSS based upon proposed use of the trade-mark in Canada. The applied for wares, as revised, are as follows: Consumer electronic appliances, namely LCD TVs; IT products, namely computer monitors.

[2] The application was advertised for opposition purposes in the Trade-marks Journal of November 8, 2006.

[3] On April 5, 2007, Bosch Sicherheitssysteme GMBH [the Opponent] filed a statement of opposition. The grounds of opposition are based on s. 30(e), s. 16(3)(a), and s.38(2)(d) of the *Trade-Marks Act*, R.S.C. 1985, c. T-13 [the Act]. The Applicant filed and served a counter statement in which it denied the Opponent’s allegations.

[4] The Opponent filed as its evidence the affidavit of Dr. Gerhard Holfelder. The Applicant filed a document entitled “affidavit” of Young Jin Jeong. No cross-examinations were conducted.

[5] Only the Opponent filed a written argument. An oral hearing was not requested.

Onus and Material Dates

[6] 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].

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

- s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];

- s. 16(3) - the filing date of the application [see s. 16(3)];

- Non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Preliminary Issue

[8] The Opponent has objected to the admissibility of the document identified by the Applicant as the affidavit of Young Jin Jeong. The Opponent submits that the document should not be part of the record because it does not appear to be a sworn document.

[9] The decision in *Dobrinsky* v. *Kubara*, [1950], 1 W.W.R. 65 (K.B.), is authority for the proposition that the failure of an affiant to specify that the statements contained in the affidavit were made under oath renders the affidavit inadmissible. In the present case, while Mr. Jeung swears that the statements and figures in his affidavit are "absolutely true", there is no jurat or other indication that the document was sworn in front of a notary public or commissioner to make it a proper affidavit or statutory declaration as required by the *Canada Evidence Act*, R.S.C. 1985, c. C-5. All that appears at the bottom of the document is the name and signature of Mr. Jeung. I therefore conclude that the document identified by the Applicant as the affidavit of Young Jin Jeong is inadmissible as evidence in this proceeding.

Section 30(e) Ground of Opposition

[10] The Opponent presented no evidence or argument in support of this ground of opposition. It is therefore dismissed.

Section 38(2) (d) Ground of Opposition

[11] As its s. 38(2) (d) ground of opposition, the Opponent pleads that the Applicant's mark is not capable of distinguishing the wares of the Applicant from the wares of the Opponent sold in Canada under its trade-mark DIBOS, nor is adapted to distinguish them.

[12] In order to meet its evidential burden with respect to this ground, the Opponent must show that as of the filing of the opposition its trade-mark DIBOS had become known sufficiently in Canada 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 at 58 (F.C.T.D.); *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.); and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)].

[13] Dr. Holfelder identifies himself as an authorized corporate officer with the Opponent. He states that the Opponent has been selling an audio and visual digital recording device in Canada under the brand DIBOS since at least as early as May, 2003. He also provides Canadian sales figures for said recording devices, ranging between $8,689 in 2003 to $571,154 in 2007. Attached as Exhibit A to his affidavit is a promotional brochure of the DIBOS product which he states has been distributed in Canada.

[14] Dr. Holfelder does not indicate how the Opponent's mark is used in association with the wares pursuant to s. 4(1). In this regard, he has not indicated if the mark appears on the wares or on their packaging or is in some other way associated with the wares so that notice of the association is given to the person to whom the product is transferred to. While the brochure attached to his affidavit may refer to Bosch DIBOS Digital Video Recorders, this does not qualify as use pursuant to s. 4(1) of the Act as use of the mark in advertising is not in itself sufficient to constitute use in association with wares [see *BMW Canada Inc. v. Nissan Canada*

Inc. (2007), 60 C.P.R. (4th) 181 (F.C.A.)]. Further, there is no indication regarding what quantities this brochure has been distributed in Canada or to whom.

[15] From the evidence furnished, I am unable to determine how or if the Opponent's mark has acquired any reputation in Canada in association with audio and visual digital recording devices. Although Dr. Holfelder has provided sales figures for such product, he has not sufficiently explained how the mark was brought to the attention of the public at the time of sale. Further, while he may state that the Opponent has been "selling in Canada since at least as early as May 2003 an audio and visual digital recording device under the brand DIBOS", use is a question of law and the Opponent has not provided me with any evidence from which I can conclude that the mark was in use in Canada in accordance with s. 4(1) of the Act. Therefore, although the Opponent need only show that the mark it relies on has become known sufficiently to negate the distinctiveness of the applied for mark, in my view the Opponent's evidence in the present case is far from sufficient to show that the reputation of its DIBOS mark negates the distinctiveness of the applied for mark. As I am not satisfied that the Opponent has met its burden under this ground, this ground is unsuccessful.

<u>Opponent's s. 16(3) Ground of Opposition</u>

[16] The Opponent's s. 16(3) ground of opposition was pleaded as follows:

> "Pursuant to s. 38(2)(c), the Applicant is not entitled to registration of the mark DIBOSS since, having regard to s. 16(3)(a) of the Act, the date of filing in Canada of application 1280324, being November 21, 2005, the material date, is subsequent to the date of first use in Canada of the Opponent's trade-mark DIBOS filed under application serial number 1,295,276, namely, May 2003, which trade-mark has not been abandoned by the Opponent."

[17] In my view, the wording used by the Opponent in its pleading of its s. 16(3) ground is somewhat garbled. Further, the Opponent did not even plead that the Applicant was not entitled to registration of its mark because the mark was confusing with the Opponent's mark. However, in view of the decision in *Novopharm* v. *Astrazeneca* (2002), 21 C.P.R. (4th) 289 (F.C.A.), I am directed to consider the evidence in conjunction with the pleadings when assessing the case the Applicant has to meet. In view of the evidence filed, and the fact that the Opponent in its pleading specifically cited s. 16(3)(a), referred to the date of first use if its DIBOS trade-mark,

and stated that such mark had not been abandoned by the Opponent, I will interpret this ground as relying on an allegation of confusion between the Opponent's mark and the Applicant's mark pursuant to s. 16(3)(a) of the Act.

[18] Sections 16(5) and 17(1) of the Act place a burden on the Opponent to establish its use of its DIBOS mark prior to November 21, 2005 (the Applicant's date of filing) and non-abandonment of such mark as of the date of advertisement of the present application (i.e. November 8, 2006). From the evidence of Dr. Holfelder, and for the reasons discussed above, I find that the Opponent has not shown use of its DIBOS mark prior to November 21, 2005, and I therefore reject the s. 16(3)(a) ground.

Disposition

[19] Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

____
Cindy Folz
Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office