IN THE MATTER OF AN OPPOSITION by Italtel, Societa Italiana to application No. 650,051 for the trade-mark SIT Design filed by Strategic Information Technology Limited

On February 1, 1990, the applicant, Strategic Information Technology Limited, filed an application to register the trade-mark SIT Design, a representation of which appears below, based upon use of the trade-mark in Canada by the applicant since at least as early as December, 1988 in association with "consulting and educational services relating to the application and use of computer software".

The applicant's application was advertised for opposition purposes in the Trade-marks Journal on April 3, 1991 and the opponent, Italtel, Societa Italiana, filed a statement of opposition on May 3, 1991. In its statement of opposition, the opponent alleged the following grounds of opposition:

(a) That the applicant's application does not comply with Section 30 of the Trade-marks Act in that:
(i) the applicant has not used its trade-mark in association with its services;
(ii) the applicant has abandoned its mark;
(iii) it is false that the applicant has said that it is satisfied that it is entitled to use the mark in Canada;

(b) 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 trade-mark SIT Design is confusing with the following registered trade-mark of the opponent:

Trade-mark	Registration No.
SIT	151,704

(c) That the applicant is not the person entitled to registration of the trade-mark in that, as of the claimed date of first use, the applicant's trade-mark was confusing with the trade-mark SIT previously used and made known in Canada by the opponent and its predecessors-in-title in association with "Electrotechnic devices for telephone and switchboard engineering, systems combining these devices and parts of the aforementioned devices and systems; electric signalling devices, measuring devices and control devices for telephone and switchboard engineering and parts therefore (sic)" and various services related to computers;

(d) That the applicant's trade-mark is not distinctive of the services of the applicant in that :
(i) the applicant's trade-mark is confusing with the trade-mark previously adopted, used, made known and registered by the opponent;
(ii) as a result of its transfer, two or more persons acquired rights to the use of the mark and these rights were exercised by these persons concurrently;
(iii) the applicant permitted third parties to use the mark in Canada outside the registered user provisions of the Trade-marks Act.

The applicant served and filed a counter statement in which it asserted that its application complies with Section 30 of the Trade-marks Act, that its trade-mark SIT Design is registrable and

distinctive, and that it is the person entitled to its registration.

The opponent filed as its evidence a certified copy of registration No. 151,704 for the trade-mark SIT standing in the name of the opponent. The applicant elected not to file any evidence.

Both parties submitted written arguments and neither party requested an oral hearing.

The opponent's first ground of opposition is based on Section 30 of the Trade-marks Act. While the legal burden is upon the applicant to show that its application complies with Section 30 of the Trade-marks Act, there is an initial evidential burden on the opponent in respect of its Section 30 ground (see Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd., 3 C.P.R. (3d) 325, at pp. 329-330). As no evidence has been filed by the opponent in respect of this ground, it has failed to meet the evidential burden upon it in respect of the Section 30 ground which I have therefore rejected.

Likewise, no evidence has been adduced by the opponent relating to its alleged prior use or prior making known of its trade-mark SIT in Canada. As a result, the opponent has not met the burden upon it under Sections 16(5) and 17(1) of the Trade-marks Act of showing its prior use or prior making known of its trade-mark SIT in this country, as well as establishing non-abandonment of its mark as of the date of advertisement of the applicant's application in the Trade-marks Journal (April 3, 1991). I have therefore rejected the third ground of opposition. Additionally, the opponent has not met the evidential burden upon it in respect of its ground relating to the non-distinctiveness of the applicant's mark which I have also dismissed.

The only remaining ground of opposition is based on Section 12(1)(d) of the Trade-marks Act, the opponent asserting that there would be a reasonable likelihood of confusion between the applicant's trade-mark SIT Design and its registered trade-mark SIT. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue within the scope of Section 6(2) of the Trade-marks Act, the Registrar must have regard to all the surrounding circumstances, including those which are specifically enumerated in Section 6(5) of the Act. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks of the parties as of the date of my decision, the material date in relation to the Section 12(1)(d) ground (see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, 37 C.P.R. (3d) 413 (FCA) and Conde Nast Publications, Inc. v. The Canadian Federation of

Independent Grocers, 37 C.P.R. (3d) 538 (TMOB)).

With respect to the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark SIT Design and the opponent's registered trade-mark SIT are inherently distinctive. As no evidence has been adduced by either party relating to use of their respective trade-marks, neither the extent to which the trade-marks have become known nor the length of use of the trade-marks at issue are relevant considerations in assessing the issue of confusion in this opposition.

The trade-marks SIT Design and SIT are identical in appearance, sounding and ideas suggested. As a result, the only remaining criteria under Section 6(5) are the nature of the wares and services of the parties and their respective channels of trade. In this regard, the applicant's consulting and educational services relating to the application and use of software are completely unrelated to either the opponent's electrotechnic devices and systems combining these devices or the opponent's electric signalling, measuring and control devices for telephone and switchboard engineering and their parts. Further, I do not consider that there would be any potential overlap between the applicant's services and the opponent's wares.

In view of the above, and having regard in particular to the differences between the applicant's services and the opponent's wares and the absence of any potential overlap in the channels of trade associated with these wares and services, I have concluded that there would be no reasonable likelihood of confusion between the applicant's trade-mark SIT Design and the registered trade-mark SIT.

I reject the opponent's opposition in view of the provisions of Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 31ST DAY OF JANUARY 1994.

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