

**IN THE MATTER OF AN OPPOSITION by  
Interdoc Corporation/La Corporation Interdoc  
to application no. 786,491 for the trade-mark  
INTERDOC filed by Xerox Corporation**

On June 30, 1995, the applicant, Xerox Corporation, filed an application to register the mark INTERDOC, based on proposed use in Canada. The application as originally filed related to wares and services, however, the application was amended during the course of these proceedings and now covers only the following wares:

computer program for use in transmission of  
jobs to a commercial printer over a network.

The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated December 20, 1995 and was opposed by Interdoc Corporation/La Corporation Interdoc on March 1, 1996. A copy of the statement of opposition was forwarded to the applicant on March 20, 1996. The applicant responded by filing and serving a counter statement. The statement of opposition was subsequently amended to reflect the above-mentioned amendments to the subject application.

The statement of opposition alleges that the opponent Interdoc Corporation is the owner of the trade-mark INTERDOC used in Canada since at least as early as May 11, 1995 in association with consulting services in document management, and the organization of conferences and seminars (in the field of document management). The opponent further states that it filed a trade-mark application on January 11, 1996, under serial number 801,684 for its above-mentioned mark.

The first ground of opposition, pursuant to Section 30(i) of the *Trade-marks Act*, alleges that at the date of filing the application the applicant could not have been satisfied as to its entitlement to use the applied for mark in view of the opponent's established rights in the mark INTERDOC. The second ground of opposition, pursuant to Section 16(3) of the *Act*, alleges that the applicant is not the person entitled to registration because, at the date of filing the application, the applicant's mark was confusing with (i) the opponent's mark INTERDOC previously used in

Canada and with (ii) the opponent's trade-name previously used in Canada. The third ground alleges that the applied for mark is not distinctive of the applicant's wares and is not adapted to distinguish the applicant's wares from the services of the opponent. The fourth and final ground alleges that this Office pronounced on the issue of confusion between the marks in issue by a report issued on November 20, 1995 by the examination section of the Trade-marks Office in respect of application serial no. 786,711.

The opponent's evidence consists of the statutory declaration of Danny Boulanger, the founder, President and General Manager of the opponent company. Mr. Boulanger was cross-examined on his affidavit and the transcript thereof, and undertakings thereto, form part of the evidence herein. The applicant elected not to file any evidence but advised that it intended to "rely on the transcript of cross-examination of Danny Boulanger . . ."

Mr. Boulanger's testimony on cross-examination is consistent with and explains in greater detail the evidence presented in his statutory declaration. Prior to founding the opponent company, Mr. Boulanger was an employee of the applicant Xerox, or more precisely, of the X Soft division of Xerox where he was involved in "advanced solutions" for "print on demand:" see pp 10-11 of Mr. Boulanger's transcript of cross-examination. Mr. Boulanger effected a corporate name search for the name Interdoc Corporation/La Corporation Interdoc on April 20, 1995, which company was incorporated under the *Canada Business Corporations Act* on May 11, 1995.

On July 5, 1995, the opponent company filed a trade-mark application (no. 786,711, referred to in the fourth ground of opposition ) for the mark INTERDOC based on proposed use in Canada in association with consulting services in document management, and the organization of conferences and seminars. That application was met with an objection at the examination stage in view of application no. 786,491 for INTERDOC filed by Xerox, that is, the application which is the subject of this proceeding. The opponent subsequently filed another application, no. 801,684 for the mark INTERDOC covering the same services as in its previous application, however, the second application is based on use of the mark INTERDOC since May 11, 1995

(the date of incorporation of the opponent company).

Mr. Boulanger testifies that the opponent engages in two separate but related businesses. One business is consulting services in the area of document management while the other business involves organizing conferences and seminars on the subject of document management. The seminars are an effective tool for promoting the opponent's consulting services. Mr. Boulanger also makes a distinction between the printing business, which is Xerox' core business, and the document management business: see pp. 13-14 of the transcript. However, as explained by Mr. Boulanger, the printing business and the document management business have become linked by evolving technology: see, for example, p. 17 of the transcript of cross-examination.

In view of the above, and in the absence of evidence from the applicant, I accept the opponent's submission that there is real potential for overlap between the wares specified in application no. 786,491 and the opponent's services of document management.

The "opponent" used the trade-mark INTERDOC and the corporate name Interdoc Corporation in communications to clients and in negotiating contracts with clients prior to the incorporation of the opponent on May 11, 1995: see exhibits P-5 (dated April 23, 1998) and P-6 (dated May 10, 1998) of Mr. Boulanger's statutory declaration. The opponent presented or participated in seminars on the subject of document management shortly after incorporation, on June 22, 1995 in Montreal, November 13-15, 1995 in Quebec City and later in Toronto on

November 11-14, 1996. A promotional brochure distributed to clients in the fall of 1995, containing the following material, serves to illustrate the usual appearance of the opponent's mark and trade-name.

The opponent's promotional and advertising expenses amounted to about \$134,000 for the six month period ending November 1995 and the opponent generated about \$1 million in revenues since inception to the end of 1996.

At paragraph 12 of his statutory declaration, Mr. Boulanger gives evidence of confusion between the opponent's mark and trade-name and the applicant's mark INTERDOC related by a certain Raymond Blain. Mr. Blain's statements are hearsay coming from Mr. Boulanger. Furthermore, they do not qualify as admissible hearsay because they do not satisfy the test of necessity. In other words, no indication was given as to why Mr. Blain could not have given his own evidence. I would also mention that, in the circumstances of this case, there is no prejudice to the opponent for having filed a second trade-mark application based on use in Canada. The opponent's first application, based on proposed use, was clearly in error. Further, the opponent's use of its trade-name shortly prior to incorporation was a reasonable business practice. I find that

the opponent began to use its trade-name as of the date of its incorporation and began to use its trade-mark shortly thereafter, at least by June 22, 1995: in regard to the latter, see the undertakings provided by Mr. Boulanger.

The first ground of opposition alleges that the applicant could not have been satisfied that it was entitled to use the trade-mark INTERDOC in Canada in association with the wares covered in the present application. Presumably, the opponent is alleging that, as of the applicant's filing date, the applicant was or should have been aware of the use by the opponent of its trade-mark INTERDOC and trade-name Interdoc Incorporation/La Corporation Interdoc. While the legal onus is on the applicant to show that its application complies with Section 30(i) of the *Trade-marks Act*, there is an initial evidentiary 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 support of its allegations that the applicant could not have been satisfied that it was entitled to use the trade-mark INTERDOC in Canada, the opponent has failed to meet the evidentiary burden upon it in respect of this ground. In any event, even had the applicant been aware of the opponent's mark and trade-name prior to filing the present application, such a fact is not inconsistent with the statement in the application that the applicant was satisfied that it was entitled to use the trade-mark INTERDOC in Canada on the basis *inter alia* that its mark is not confusing with the opponent's mark or trade-name.

The fourth ground of opposition assumes that a finding of confusion between two marks by the examination section of the Trade-marks Office is binding on this Board, or has precedential value for this Board. That is not the case. This Board is not in a position to explain findings by the examination section of the Trade-marks Office. Further, the examination section does not have before it evidence that is filed by parties in an opposition proceedings: see the Board decisions in *Thomas J. Lipton Inc. V. Boyd Coffee Co.* (1991), 40 C.P.R.(3d) 272 at 277 and *Proctor & Gamble Inc. v. Morlee Corp.* (1993), 48 C.P.R.(3d) 377 at 386. Thus, the allegations based on the examiner's report in file no. 786,711 do not raise a proper ground of opposition.

With respect to the third ground of opposition, the legal onus is on the applicant to show that its mark INTERDOC is adapted to distinguish or actually distinguishes its wares from the services of the opponent, throughout Canada: see *Muffin Houses Inc. v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R.(3d) 272 (TMOB). The presence of a legal onus means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant. The material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the opposition, in this case March 1, 1996: see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Further, I am permitted to take into account evidence of all the surrounding circumstances including, for example, the parties' sales and advertising under their respective marks up to the material date: see *Castle & Cooke, Inc. v. Popsicle Industries Ltd.* (1990), 30 C.P.R.(3d) 158 (TMOB).

At the material date, the opponent had been incorporated for about 10 months, had negotiated contracts in its corporate name, had organized and participated in seminars on document management and had distributed promotional material displaying its trade-mark INTERDOC and trade-name Interdoc Corporation. The mark and trade-name adopted by the opponent possess fairly high degrees of inherent distinctiveness in that INTERDOC is a coined word, although the inherent distinctiveness of the mark and trade-name are lessened to the extent that the phrase "interdoc" is suggestive of an "*interactive document*." Considering the inherent distinctiveness of the opponent's mark and trade-name, the reputation acquired by the mark and trade-name at the material date, the overlap in the opponent's services and the applicant's wares, and the identity of the marks in issue, I find that the applicant has not met the onus on it to show, on a balance of probabilities, that its mark is adapted to distinguish the applicant's wares. The opponent therefore succeeds on the third ground of opposition.

The determinative issue with respect to the second ground of opposition, pursuant to Section 16(3) of the *Act*, is whether the applied for mark was confusing with the opponent's mark or trade-name at the material date June 30, 1995. The same considerations as discussed

above in relation to the issue of distinctiveness apply, except that the opponent's mark and trade-name would have acquired less reputation at the earlier material date. Nevertheless, I arrive at a similar conclusion namely, that the applicant has not met the onus on it to show that, on a balance of probabilities, there would be no reasonable likelihood of confusion.

In view of the above, the applicant's application is refused.

DATED AT HULL, QUEBEC, THIS 25<sup>th</sup> DAY OF NOVEMBER, 1998.

Myer Herzig,  
Member,  
Trade-marks Opposition Board