

**IN THE MATTER OF AN OPPOSITION by
Omega S.A. (Omega AG) (Omega Ltd.) to
Application No. 849630 for the Trade-mark
OMEGA filed by Omega Engineering,
Inc.**

I The Pleadings

On June 30, 1997, Omega Engineering, Inc. (the “Applicant”) filed an application to register the trade-mark OMEGA (the “Mark”), application number 849630, in association with a long list of wares based on various dates of first use. However as it will appear hereinafter, the wares in issue in this opposition are clocks and timers (the “Wares”). The application, for the Wares, is based on use since 1992 in Canada.

The application was amended to respond to several office actions. I shall reproduce for ease of reference the relevant portion of paragraph 3 of the application of record:

“3. The trade-mark has been used in Canada by the applicant itself or through a licensee, or by itself and through a licensee, in association with all the wares listed hereafter, and the applicant request s registration in respect of such wares. The trade-mark has been so used in Canada in association with the general class of wares comprising the following specific wares:

Apparatus industrially and/or scientifically employed for measuring or controlling variable parameters such as temperature, pressure, force, load, vibration, electrical conductivity, liquid level, acidity, humidity, strain, time and flow as well as computer controlled measuring, timing and display apparatus all exclusively intended for science or industry, namely:

(...)

g) (...) clocks; (...) timers since at least as early as 1992”

The application was advertised on April 5, 2000 in the Trade-Marks Journal for opposition purposes.

Omega S.A. (Omega AG) (Omega Ltd.) (the “Opponent”) filed, on September 5, 2000, a statement of opposition raising the following grounds of opposition, limited to the Wares:

1. The application does not conform to the requirements of s. 30 of the *Trade-marks Act* R.S.C. 1985, c. T-13, (the “Act”) in that:
 - a) The Applicant did not use as stated the Wares as of the claimed date of first use alleged in the application;
 - b) The Applicant has not used as stated the Wares;
 - c) Alternatively or cumulatively, the Applicant has abandoned, in whole or in part, the Mark;
 - d) It is falsely that the Applicant has claimed to be satisfied to use the Mark in Canada in view of the facts hereinabove and hereinafter referred to.
2. The Mark is not registrable pursuant to the provisions of s. 38(2)(b) and 12(1)(d) as confusing with the Opponent’s registered trade-marks:
 - a) OMEGA & DESIGN TMDA005009
 - b) OMEGA & DESIGN TMA307956.
 - c) OMEGA ART TMA366065
 - d) OMEGA FLIGHTMASTER TMA112422.
3. Pursuant to s. 38(2)(c), the Applicant is not the person entitled to registration under s. 16(1)(a) and (c) of the Act, in that at the date of alleged first use in Canada, the Applicant’s Mark was confusing with the Opponent’s trade-marks:
 - a. OMEGA & DESIGN
 - b. OMEGA DESIGN
 - c. OMEGA SYMBOL (Ω)
 - d. OMEGA ART
 - e. OMEGA FLIGHTMASTERand the Opponent’s trade-names:
 - d. OMEGA S.A.
 - e. OMEGA AG
 - f. OMEGA LTD

previously used or made known in Canada by the Opponent or its licensees in association with the wares and services covered by the certificate of registrations listed above.

4. Pursuant to s. 38(2)(d), the Applicant’s Mark is not distinctive of the Applicant’s Wares having regard to s. 2 of the Act in that:
 - a. The Mark does not, and is not, adapted to distinguish the Applicant’s Wares from the wares of the Opponent in view of the Opponent’s famous registered trade-marks and that they were known and used and
 - b. Because of the transfer of the Mark, there were subsisting rights of use of the Mark into two or more entities and those rights were exercised by those entities concurrently, contrary to the provisions of s. 48(2) of the Act;
 - c. The Applicant allowed third parties to use the Mark in Canada outside the scope of protection governing license use of a trade-mark as defined at s. 50 of the Act.

I purposely omitted the ground of opposition based on the introductory paragraph of s. 16(1) of the Act in which the Opponent repeats its compliance and registrability allegations. Section 16 of the Act defines the non-entitlement ground of opposition and its introductory paragraph by itself does not define a ground of opposition by which non-compliance and registrability issues could be raised. Those grounds of opposition are covered specifically in other sections of the Act.

The Applicant filed on January 19, 2001 a counter statement denying the grounds of opposition raised in the Opponent's statement of opposition. The Opponent's evidence consists of the affidavit of Catherine Bergeron as well as certificates of registration TMA307956, TMA366065, TMA112422 and TMDA005009 while the Applicant filed the affidavit of Ralph S. Michel. The Opponent filed the affidavit of Catherine Geci as reply evidence. The Applicant requested leave to file, as additional evidence, the affidavit of Janice Stevenson and Peter W. Peterson. Permission was granted. Both parties filed written submissions and an oral hearing took place during which both parties were represented.

II The Legal Issues and the Relevant Evidence

The legal onus is upon the Applicant to show that its application complies with the provisions of s. 30 of the Act, but there is however an initial evidential burden on the Opponent to establish the facts relied upon by it in support of its grounds of opposition. Once this initial onus is met, the burden shifts to the Applicant who must prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the mark applied for. [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293, *Christian Dior, S.A. and Dion Neckwear Ltd* (2002), 20 C.P.R. (4th) 155]

With respect to grounds of opposition based on s. 30 of the Act, even though the Opponent has an evidential onus, it is a light one [See *Tune Masters c. Mr. P's Mastertune Ignition Services Ltd.* (1986) 10 C.P.R. (3d) 84 (T.M.O.B.), *Labatt Brewing Co. v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.) and *Williams Telecommunications Corp. v. William Tell*

Ltd., (1999) 4 C.P.R. (4th) 107 (T.M.O.B)]. Reference to the evidence adduced by the Applicant can be made to meet such initial onus. [See *Dic Dac Holdings (Canada) Ltd v. Yao Tsai Co.* (1999), 1 C.P.R. (4th) 263]. However, the Applicant's evidence must be clearly inconsistent with the allegations contained in the application.

The material time for considering the issue of non-entitlement to the registration of the Mark is the date of first use alleged in the application [See s. 16(1) of the Act]. The critical date for assessing the issue of non-compliance with the provisions of s. 30 of the Act is the filing date of the application [See *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (TMOB) and *Dic Dac Holdings (Canada) Ltd, supra*]. The relevant date to determine the registrability of the Mark is the date of the Registrar's decision. [See *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A)] Finally it is generally accepted that the filing date of the statement of opposition is the critical date to assess the distinctiveness of the Mark as a ground of opposition. [See *Andres Wines Ltd. and E&J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.), *Park Avenue Furniture Corporation, op. cit* and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)]

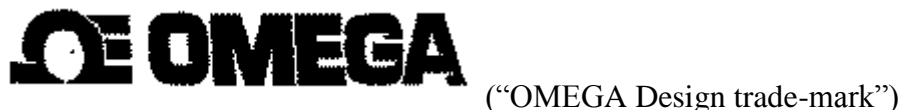
I will describe hereinafter the relevant evidence filed by both parties in the context of each ground of opposition raised.

The Opponent filed no evidence of use of the Opponent's trade-marks or trade-names in Canada prior to the claimed date of first use of the Mark alleged in the application. Neither in its written argument nor during the oral hearing did the Opponent discuss the merit of its third ground of opposition. From the evidence in the record, I conclude that the Opponent failed to meet its initial onus with respect to its third ground of opposition and it is therefore dismissed.

Ms. Bergeron introduces in her affidavit extracts of the *Webster's Ninth New Collegiate Dictionary* containing the definitions of the words "clock", "parameter", "time" and "timer". Ms. Geci did a search on the Applicant's website at www.omega.ca and annexed to her affidavit were the relevant pages of such website located when entering the word "clock" in the search engine

available on such website. It should be noted that her search was conducted on August 13, 2002, after the relevant date used to assess the first, third and fourth grounds of opposition.

At the oral hearing the Opponent's agent argued that the Applicant's evidence shows that it never used the Mark in association with "clocks" and "timers". Moreover if there was use of a trade-mark in association with such wares it was not the Mark but the trade-mark that is the subject of application number 849631 as hereinafter illustrated:



The Applicant objected to the latter as being a ground of opposition not raised in the statement of opposition filed in this proceeding.

I agree with the Applicant. As drafted, the Opponent's first ground of opposition is only referring to the Applicant's use of the Wares (“la requérante n'a pas employé comme il est dit ses produits”). The Opponent argued in reply at the oral hearing that the words “comme il est dit” appearing in the statement of opposition refer to the use described in the application. I disagree. The Opponent did not allege that the Applicant never used the Mark as applied for in association with the Wares as of the claimed date of first use. There is no reference to s. 30(b) of the Act in the Opponent's statement of opposition. The term “use”, in the context of trade-mark law, is related to a trade-mark and not a product or service. The definition of “use” in the Act and the provisions of s. 4 support such contention. The Opponent chose not to file evidence that could have enlightened the Applicant as to what it would be arguing at the oral hearing. The Applicant is therefore left with the plain meaning of those words. To let the Opponent argue, at this late stage, that the Applicant never used the Mark in association with the Wares as of the claimed date of first use would be tantamount to approve trial by ambush. Any ambiguity in its proceeding should be interpreted against the Opponent. I conclude that paragraphs 1a) and b) of the Opponent's statement of opposition, as drafted, are not proper grounds of opposition and are dismissed.

As for paragraphs 1c) and d) as described above, there is no evidence adduced by the Opponent to support those grounds of opposition. The evidence filed by the Applicant does not raise serious

doubts as to the possibility of the abandonment of the Mark by the Applicant. Moreover there is no evidence that the statement made by the Applicant that it was satisfied to use the Mark in Canada was made in bad faith. [See *Sapodilla Co. Ltd. v. Bristol-Meyer Co.* (1974), 15 C.P.R. (2d) 152] Therefore they are also dismissed.

Should I be wrong in my interpretation of paragraphs 1a) and b) of the Opponent's statement of opposition I would still dismiss those grounds of opposition for the reasons hereinafter detailed.

In order to be successful under those grounds as drafted, there would have to be evidence that enable me to conclude that the Applicant never sold the Wares. If that would be the case, *a fortiori* the Applicant could not have sold those wares in association with the Mark as of the claimed date of first use.

The Opponent contends that the Applicant's evidence shows that it sells devices that may serve, as an incidental function, as a clock but the devices themselves are not clocks. To support its position, the Opponent is relying on the following extract of Mr. Justice Noël judgment in *Sharp Kabushikai Kaisha c. 88766 Canada Inc.* (1997), 72 C.P.R. (3d) 195 :

By virtue of Section 45, the Appellant was required to demonstrate use of its trademark in the normal course of trade at any time during the two years preceding the date of the Notice (i.e. January 20, 1991 to January 20, 1993). In the event that such use could not be demonstrated, Section 45 required the Appellant to establish the date of last usage and the reason for the absence of use since that date.

In its statutory declaration, the Appellant did allege that it has "for many years" sold a range of products which have, as a primary or secondary function the display of time, including clock radios. However, as was pointed out by the Registrar in his decision, the only items for which evidence of use for the period contemplated by Section 45 was produced were electronic calculators with clock function, electronic organizers with clock function, personal palmtop computers, facsimile machines, CD stereo systems, camcorders, video cassette recorders and microwave ovens, all with clock and/or time keeping function.

There is no doubt in my view that the Registrar correctly held that these items could not be labelled as "clocks or watches" on the basis of their time keeping function as it is clearly incidental to the distinct prime use which they each have.

The Opponent refers to the *Webster's Dictionary* that defines the word "clock" as: " a device other than a watch for indicating or measuring time commonly by means of hands moving on a dial". However the Registrar is entitled to look in other dictionaries. [See *Molson Breweries, A partnership v. John Labatt Ltd*, 3 C.P.R.(4th) 543 and *Insurance Co. of Prince Edward Island v. Prince Edward Island Insurance Co.* (1999) 2 C.P.R.(4th) 103] In the *Oxford Canadian Dictionary* the word "clock" is defined as: "an instrument for measuring time, indicating hours, minutes, etc, by hands on a dial or by displayed figures" (my underlines). Such definition does cover devices wherein the time is displayed by using numerical digits, as in this case per the illustration of the Applicant's clock appearing on page M-33 of its catalogue entitled "21st century 2nd Edition", under the heading "High Performance Process Timer/Controller". The aforesaid device is described on the same page in the following words:

"The PTC41 multifunctional panel meter is designed to be set up as a clock/timer controller or stopwatch.The clock time base is derived from the 50 or 60 Hz power line...."

The clock function of the apparatus illustrated on page M-33 is not incidental. It cannot be compared to a microwave oven or camcorders, for example, as it was in the case of *Sharp Kabushikai Kaisha*. Moreover we must not lose sight of the qualification of the Wares appearing at the beginning of paragraph 3 of the application and reproduced hereinabove ("qualifying paragraph"). Those clocks are meant to be industrial and scientific apparatus as illustrated in the Applicant's catalogues.

The Opponent argues that a timer cannot be an apparatus that measures or controls a variable as stated in the qualifying paragraph. To support its contention the Opponent is relying on the definition of "timer" in the *Webster's Dictionary*: " one that times". Therefore it would serve a purpose of "timing" and not "measuring". Moreover time would not be a variable and thus could not be measured. Without commenting on the merit of this reasoning, I can dispose of it by simply referring to the *Oxford Dictionary* where "timer" is defined in those terms: "device that measures elapsed time, esp. one that sounds to indicate that a certain amount of time has passed". (my underlines).

Therefore, the evidence in the record does not enable me to conclude that the Applicant never sold the Wares.

Should I be wrong in my conclusion that the Opponent was precluded from arguing that the Applicant never used the Mark in association with the Wares as of the claimed date of first use but instead used the OMEGA Design trade-mark, I would still dismiss such ground of opposition. The use of the word OMEGA beside the design portion of the trade-mark OMEGA Design can be considered as use of the Mark in light of the reasoning adopted in *Nightingale Interlock Ltd. v. Prodesign Ltd. (1984)*, 2 C.P.R. (3d) 535. The consumer who has some vague recollection of the Mark and would see a clock or a timer bearing the OMEGA Design trade-mark would not think that those wares originate from a different source.

For all the above reasons, the first ground of opposition is therefore dismissed in its totality.

The main issue with respect to the last two grounds of opposition (registrability and distinctiveness) is the likelihood of confusion with the Opponent's registered trade-marks. For ease of reference I shall reproduce the Opponent's registered design trade-marks:

TMDA 005009



TMA 307956



The Affidavit of Ms. Stevensen, a legal assistant, deals mainly with the status of the Opponent's registered trade-marks as they were the subject of s. 45 proceedings. The date of the Registrar's decision being the relevant date to determine the registrability of the Mark, it is important to bring up to date the state of the register. The Opponent admitted at the oral hearing that the trade-marks OMEGA ART, certificate of registration TMA366065 and OMEGA FLIGHTMASTER, certificate

of registration TMA112422 have been expunged from the register. They are no longer relevant in determining the registrability of the Mark. As for the trade-mark OMEGA and design, certificate of registration TMDA005009, it now covers the following wares:

« (1) Montres et boîtes pour montres; (2) Chaînes de montres, outils et accessoires ainsi que toutes fournitures et parties détachées employées dans l'horlogerie et la bijouterie y soient inclus; (3) Étuis et emballages, nommément: contenants sous forme de housses en tissus et boîte; compteurs et chronographes qui servent au chronométrage sportif; et appareils techniques et scientifiques pour l'électricité, l'optique, la télégraphie, le cinéma, la radio, la téléphonie, la télégraphie, nommément: la cellules photo-électriques, portails à contact, compteurs enregistreurs sur bande de papier, pistolets de start à contacts électriques. » Date of first use in CANADA of 1895 in association with wares (1). Date of first use in CANADA of 1939 in association with wares (2). Date of first use in Canada of 1950 in association with wares (3).

while certificate of registration TMA307956 for the trade-mark OMEGA and design has been amended to comprise the following wares and services:

« Appareils relatifs aux activités sportives, nommément: chronomètres, tableaux de pointage et tableaux indicateurs, pour le pointage, le contrôle et la mesure du temps, des distances, des scores, des heures et des dates. »

« Services de conseil relativement à la planification et installation d'appareils de pointage, de contrôle et de mesure de temps et de distances, destinées principalement au domaine sportif. »

Therefore the content of Ms. Stevenson's affidavit adds little to the remaining issues to be decided.

The Opponent has met its initial onus with respect to the second ground of opposition by filing the certificates of registration of the trade-marks it cited in its statement of opposition. Two of them are still on the register. Therefore the legal burden shifts to the Applicant who must prove on the balance of probabilities that the Mark is not confusing with the Opponent's registered trade-marks OMEGA and design. [See *Christian Dior, S.A. v. Dion Neckwear Ltd* (2002), 20 C.P.R. (4th) 155].

The test for confusion is set forth in s. 6(2) of the Act and I must have regard to all the surrounding circumstances, including those listed in s. 6(5): the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is

not necessary to give each one of them equal weight [See *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.) and *Gainers Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

The trade-marks in issue are inherently distinctive. I have however evidence of use of the Applicant's trade-mark since at least 1996. (Invoices combined with the reference number of the apparatus appearing in the catalogue and on the invoice) There is no evidence of use of the Opponent's trade-marks. Therefore, as it appears from the evidence in the record, the Applicant's Mark is more known than the Opponents' trade-marks. This factor favours the Applicant.

In *Cartier Men's Shop Ltd. v. Cartier Inc.* (1981), 58 C.P.R. (2d) 68 it was ruled that for the purpose of assessing the criteria described in s. 6(5)(b) we could refer to the date of first use alleged in the certificate of registration of the cited marks of the Opponent. As mentioned above according to the certificates of registration the OMEGA and design trade-mark has been in use in Canada by the Opponent since 1895 in association with watches and since 1950 in association with "compteurs et chronographes qui servent au chronométrage sportif; et appareils techniques et scientifiques pour l'électricité". This factor favours the Opponent.

Clocks and timers are of the same general class of wares as watches and "chronographes qui servent au chronométrage sportif" as their main function is to measure time. This factor favours the Opponent.

The Opponent argued that if the opposition is dismissed the Applicant will be at liberty to sell clocks and timers in association with the Mark. This position does not take into consideration the qualifying paragraph. If the registration issued in favor of the Applicant the qualifying paragraph would be included in the list of wares covered by the registration. The evidence clearly shows that the Wares are used for scientific and industrial purposes. Whatever use of the Mark the Applicant decides to make after the registration is not a factor to be taken into consideration in these proceedings.

The Opponent's watches are most likely sold to the general public and "chronographes qui servent au chronométrage sportif" are most probably sold to sports clubs or organizers of sporting events. However it would appear that there could be some overlap in the channels of trade between the Applicant's Wares to be employed for measuring time, all exclusively intended for scientific or industrial purposes, and the Opponent's "appareils techniques et scientifiques pour l'électricité" covered by certificate of registration TMDA005009.

The Applicant argued that the evidence filed by Peter W. Peterson shows that the Opponent never sold its timers for scientific or industrial use. Mr. Peterson is an attorney in the United States presenting certain facts related to legal proceedings in the United States between the same parties, including the transcript of a deposition of a representative of Swatch Group, Ltd, the holding company of the Opponent, Ms. Sauser Rupp. Without deciding on the admissibility of a deposition made in the context of foreign legal proceedings, the answers referred to by the Applicant dealt only with timers. The sale of "appareils techniques et scientifiques pour l'électricité" as described in the Opponent's certificate of registration TMDA005009 was not investigated during such deposition. They are still included in the registration despite recent s. 45 proceedings. The Registrar was satisfied that there was evidence of use of the OMEGA and design trade-mark in association with such class of wares. [See *Omega SA v. Ridout & Maybee LLP* (2005), 43 C.P.R. (4th) 18,]. This factor also favours the Opponent in so far as certificate of registration TMDA005009 is concerned. I do not see any overlap between the channels of trade for the wares and services covered by certificate of registration TMA307956 and the Applicant's Wares.

The degree of resemblance is often viewed as the most important factor to be considered. [See *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145 at 149 (F.C.T.D.)] The common feature between the marks in issue is the word OMEGA. The Mark is phonetically identical to the Opponent's word portion of its OMEGA and design trade-marks. The idea suggested by the marks in issue is the same, namely that it refers the Greek language. Moreover the word OMEGA is an English word that means last in any series, or the end. Therefore, the marks of the parties, when viewed in their totalities, do resemble to one another.

I have to determine on the basis of first impression and imperfect recollection if a person familiar with the Opponent's trade-mark OMEGA and design used in association with "appareils techniques et scientifiques pour l'électricité" (as these wares represent the best case scenario for the Opponent) would be confused as to the source of origin of the Wares bearing the Mark. Taking into consideration all the relevant factors reviewed above, I conclude in the affirmative. I reach this conclusion on the basis that there is a potential overlap in the channel of trade of the Wares and "appareils techniques et scientifiques pour l'électricité" covered by certificate of registration TMDA005009, and the resemblance between the Mark and the OMEGA and design trade-mark.

The Applicant has not discharged its burden to prove, on a balance of probabilities, that the Mark would not be confusing with the Opponent's trade-mark OMEGA and design, certificate of registration TMDA005009. The second ground of opposition is therefore maintained in so far as certificate of registration TMDA005009 is concerned but dismissed when considering certificate of registration TMA307956 in view of the differences in the Wares and their channels of trade.

The Opponent failed to meet its initial onus with respect to grounds of opposition 4 b) and c). There is no evidence in the record to support them. They are therefore dismissed. As for ground of opposition 4a), the Opponent failed to file any evidence of use of its trade-marks or trade-names that would establish that they were known in Canada to such an extent that it would negate the distinctiveness of the Applicant's Mark. Such ground of opposition is also dismissed.

III Conclusion

Having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the Applicant's application, only in so far as "clocks and timers" are concerned in paragraph 3 (g) of the application, the whole pursuant to s. 38(8) of the Act.

DATED IN BOUCHERVILLE, QUEBEC, THIS 24th DAY OF APRIL 2006.

Jean Carrière
Member
Trade-marks Opposition Board