IN THE MATTER OF AN OPPOSITION by WordPerfect Corporation to application No. 579,531 for the trade-mark FORM PERFECT filed by Formulator Software Inc.

On March 9, 1987, the applicant, Formulator Software Inc., filed an application to register the trade-mark FORM PERFECT based upon proposed use of the trade-mark in Canada in association with "computer software". The applicant disclaimed the right to the exclusive use of the word PERFECT apart from its trade-mark.

The opponent, WordPerfect Corporation, filed a statement of opposition on April 8, 1988 in which it alleged that the applicant's application is not in compliance with s. 29(e) (now s. 30(e)) of the Trade-marks Act in that the applicant itself does not intend to use the trade-mark applied for but rather intends to license it to others. Further, the opponent alleged that the applicant's trade-mark FORM PERFECT is not registrable in that it is confusing with the opponent's registered trade-mark WORDPERFECT, registration No. 330,392 covering computer software. Also, the opponent alleged that the applicant is not the person entitled to registration of the trade-mark FORM PERFECT in that the applicant's trade-mark was confusing with the opponent's trade-mark WORDPERFECT and "with other members of the Opponent's family of marks namely, DATAPERFECT, LETTERPERFECT, PAGEPERFECT, PLANPERFECT and SPELLPERFECT for which applications were filed and which were used and made known in Canada prior to the date of the filing of the Applicant's application". Finally, the opponent alleged that the applicant's trade-mark is not distinctive in that it neither distinguishes nor is it adapted so as to distinguish the wares of the applicant in view of the continuous use in Canada by the opponent of its trade-marks since a date earlier than the applicant's filing date.

The applicant served and filed a counterstatement in which it denied the allegations of confusion set forth in the opponent's statement of opposition and further asserted that its application complies with s. 29 (now s. 30) of the Trade-marks Act. The applicant also submitted that the ground of opposition relating to the applicant's alleged non-entitlement to registration was contrary to s. 38(3)(a) of the Trade-marks Act in that the opponent failed to identify either the serial numbers or the filing dates of its trade-mark applications. Additionally, the applicant pointed out that the opponent had failed to indicate either the wares associated with the trade-marks DATAPERFECT, LETTERPERFECT, PAGEPERFECT, PLANPERFECT and SPELLPERFECT or the dates of first use and making known of the trade-marks in Canada.

The opponent requested and was granted leave pursuant to r.42 of the Trade-marks Regulations to amend its statement of opposition in order to allege that it had used and made known

the trade-marks LETTERPERFECT, SPELLPERFECT, DATAPERFECT, PLANPERFECT and PAGEPERFECT in Canada in association with computer software and computer software manuals since at least as early as September 1982.

The opponent filed as its evidence the affidavit of Jeffrey Thaw while the applicant submitted the affidavits of Beverley Mulvaney, Catherine E. Burnside and Marion Stewart. Further, both parties filed written arguments and both were represented at an oral hearing.

At the oral hearing, the opponent withdrew its ground of opposition based on s. 30 of the Trade-marks Act and that ground need not therefore be considered.

The opponent's next ground of opposition is based on s. 12(1)(d) of the Trade-marks Act, the opponent alleging that there would be a likelihood of confusion between the applicant's trade-mark FORM PERFECT and its registered trade-mark WORDPERFECT, registration No. 330,392 covering computer software. In determining whether there would be a reasonable likelihood of confusion between these trade-marks, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of opposition (April 8, 1988), the material date in respect of the s. 12(1)(d) ground of opposition.

With respect to the inherent distinctiveness of the trade-marks FORM PERFECT and WORDPERFECT, both trade-mark comprise a prefix which is descriptive of computer software used for form processing or word processing respectively and a suffix element which is laudatory. Nevertheless, I consider that both marks do possess some inherent distinctiveness when the descriptive and laudatory elements are used in combination and the respective trade-marks are considered in their entireties as a matter of immediate impression.

As to the extent to which the trade-marks had become known in Canada as of the date of opposition, the Stewart affidavit does establish that the applicant commenced use of the trade-mark FORMPERFECT Design in association with computer software in April of 1987. However, there is little evidence of use by the applicant of the trade-mark FORM PERFECT as two separate words apart from exhibit MS-10 to the Stewart affidavit and I do not agree with the applicant's agent that the more pronounced lettering of the word FORM relative to the lettering of the word PERFECT establishes use of the trade-mark FORM PERFECT as two separate words. However, to the extent

that use of the trade-mark FORMPERFECT Design constitutes use of a variant of the mark FORM PERFECT which the applicant is seeking to register, I am prepared to conclude that the applicant's trade-mark FORM PERFECT had become known in Canada to some extent as of the date of opposition. In any event, the applicant has not provided any clear indication as to the volume or dollar value of its sales or advertising prior to the date of opposition and I am therefore unable to determine the extent to which the applicant's trade-mark had become known in Canada prior to the date of opposition. Further, while the Stewart affidavit refers to the ordering of 60,000 brochures, there is no indication of the extent of distribution of the brochure prior to the material date.

The Thaw affidavit establishes that the opponent's trade-mark WORDPERFECT had become relatively well known in Canada in association with computer software as of the date of opposition, having regard to the evidence of wholesale sales figures, the granting of site licenses, as well as the evidence of advertising and promotion associated with the trade-mark WORDPERFECT. Likewise, the length of time that the trade-marks have been in use in this country is a further factor weighing in the opponent's favour.

The wares covered in the applicant's application and the opponent's registration are both computer software and are therefore identical. As there is no restriction as to the channels of trade through which the applicant's wares would be made available to the public, I must conclude for the purposes of deciding this opposition that the channels of trade associated with the wares of the parties would, or could, be identical. In this regard, and in assessing the likelihood of confusion between trade-marks, the Registrar must consider the channels of trade which would normally be associated with the wares as set forth in the applicant's application since it is the statement of wares as covered in the application rather than the applicant's actual trade to date which determines the scope of the monopoly to be accorded to an applicant should its trade-mark proceed to registration (see Mr. Submarine Ltd. v. Amandista Investments Ltd., 19 C.P.R. (3d) 3, at pp. 10-12 (F.C.A.)). Thus, the fact that an applicant may be selling its wares through a particular type of retail outlet or through a particular channel of trade is irrelevant when considering the issue of confusion (see Henkel Kommanditgesellschaft Auf Aktien v. Super Dragon Import Export Inc., 2 C.P.R. (3d) 361, at pg. 372 (F.C.T.D.), 12 C.P.R. (3d) 110, at pg. 112 (F.C.A.)).

As to the degree of resemblance between the trade-marks at issue, I consider there to be at least some similarity in both sounding and appearance between the trade-marks WORDPERFECT and FORM PERFECT while there appears to be a greater degree of similarity in ideas suggested by the marks. In particular, the mark WORDPERFECT suggests that the opponent's software is

intended to provide high quality word processing while the mark FORM PERFECT suggests that the applicant's software provides an equally high quality of form processing. In both instances, the trade-marks comprise the suffix PERFECT in combination with a prefix which is descriptive of the function of the software.

At page 15 of its written argument, the applicant pointed out that the whole of the design or get-up must be looked at when considering the degree of resemblance between the trade-marks at issue. While such considerations as design or get-up are certainly relevant in a passing off action, such is not the case where an opponent is relying upon a trade-mark registration in opposing an applicant's trade-mark application. In such a case, it is the trade-mark sought to be registered and not the mark as used by the applicant which must be considered when determining whether there is any degree of resemblance between the trade-marks of the parties. The following comments of the learned trial judge in Cartem Inc. v. Souhaits Renaissance Inc., 60 C.P.R. (2d) 1, at page 3, are of relevance even though that case dealt with an expungement proceeding:

> "Although the respondent has always included its corporate name Souhaits Renaissance Inc. when using the word "Cartem", this is not, in my view, a material fact to be taken into consideration as there is nothing to prevent it at any time from using the mark CARTEM without mentioning its corporate name, should CARTEM be held to be a valid mark. The respondent also established that it did always use the word "Cartem" in script form and never in block letters. I do not accept this either as one of the general circumstances to be taken into account in the case at bar because, in the first place, the registration of the word was requested and granted with block letters and not script, in the second place, this is not a case pertaining to a design or figure and, finally, it is not a question of passing off where similarity of design might be of considerable importance."

As a further surrounding circumstance, the opponent relied upon evidence of the state of the register and evidence allegedly supporting use in the marketplace of similar trade-marks to the marks of the applicant and the opponent. As to the state of the register evidence, the applicant has relied upon the affidavit of Catherine E. Burnside. However, apart from the trade-marks of the applicant and opponent, the only trade-mark including the suffix PERFECT covering computer software disclosed by the search is a pending trade-mark application for the trade-mark PRACTICE PERFECT which, from exhibit CB-3 to the Burnside affidavit, appears to have been in opposition. In this regard, the opponent has indicated in its written argument that it had opposed the application for the trade-mark PRACTICE PERFECT. I would also note the registration No. 287,055 for the trade-mark LETTER PERFECT covers wares unrelated to computer software.

With respect to the evidence of common use by third parties of trade-marks including the word PERFECT, the Mulvaney affidavit contains hearsay evidence and therefore cannot be given much weight as to use by third parties of trade-marks including the word PERFECT. Additionally,

only one of the trade-marks identified by Ms. Mulvaney included the suffix PERFECT as applied to software. The Stewart affidavit also refers to third parties adoption of marks including the word PERFECT. However, none of the evidence relates to use by third parties of their marks prior to the date of opposition, the material date in respect of the s. 12(1)(d) ground of opposition. Again, only one of the third party marks identified by Ms. Stewart included the word PERFECT as a suffix in the same manner as the trade-marks at issue. Accordingly, there is no evidence that any third party trade-marks including the suffix PERFECT were in use in Canada prior to the date of opposition and therefore little weight can be given to the applicant's evidence of common adoption or common use of such marks in the marketplace.

At page 7 of its written argument, the applicant submits that the name SSI Softwares appears at the bottom of many advertisements annexed as exhibit K-1 to the Thaw affidavit. At the oral hearing, the agent for the opponent sought to introduce photocopies of documents from the Trade-marks Office file relating to the trade-mark WORDPERFECT to establish that Satellite Software International (Utah Corporation) was the previous name of WordPerfect Corporation and that the change of name was effective as of June 27, 1986. Further, the opponent submitted that the reference to SSI Softwares was in fact a reference to Satellite Software International and I would note from the documents filed by the opponent's agent that the photocopy of United States Registration No. 1,394,667 for the trade-mark WORDPERFECT does identify the registrant as SATELLITE SOFTWARE INTERNATIONAL (SSI) (UTAH CORPORATION). The agent for the applicant indicated that she had no objection to the introduction of these documents. Accordingly, I do not accept the applicant's submission that the opponent's evidence points to use by a third party of the trade-mark WORDPERFECT such as to dilute the distinctiveness thereof.

As a further surrounding circumstance, the opponent submitted that since the introduction of WORDPERFECT software in 1982, it has established a pattern whereby new software products are given a name which includes the suffix PERFECT, with each new product being designed to fulfil a need not met by other WORDPERFECT software so that the complete family of products serves the wide range of customers' software needs (see paragraph 16 to the Thaw affidavit). The opponent also referred to exhibit MS-32 to the Stewart affidavit, a portion of which is set out below, which points to FORM PERFECT software as filling the missing link in office automation. According to the opponent, the applicant's FORM PERFECT software for form processing fits as a logical extension of the opponent's group of products and thereby fills a need not met by the opponent's WORDPERFECT word processing software, its DATAPERFECT database software or its PLANPERFECT spreadsheet software. As applications for registration of both the trade-marks

DATAPERFECT and PLANPERFECT were filed in Canada prior to the date of opposition, I consider that some weight ought to be accorded to the opponent's submission although less weight than would have been the case had the opponent's applications been filed well prior to the filing date of the applicant's application rather than within one week of the applicant's filing date or had the opponent's evidence clearly established some measure of use of its two trade-marks in this country prior to the date of opposition.

The opponent also sought to rely on an alleged family or series of trade-marks including the suffix PERFECT. While the opponent's evidence does establish that it has obtained registrations in Canada for the trade-marks PLANPERFECT AND DATAPERFECT, both marks were registered subsequent to the date of opposition while the applications for the trade-marks were filed March 9, 1987 and March 5, 1987 respectively. However, absent any measurable evidence of use of these marks prior to the date of opposition, I do not consider that the opponent's evidence establishes anything more than that it was, as of the material date, in the process of establishing what might be characterized as a series of marks including the suffix PERFECT in combination with a prefix description of the function of the software to which the trade-mark is applied.

Having regard to the above, and bearing in mind that the legal burden is on the applicant in respect of the issue of confusion, I have concluded that, in view of the degree of resemblance between the trade-marks WORDPERFECT and FORM PERFECT both of which are applied to identical wares travelling through the same channels of trade and considering the extent to which the opponent's registered trade-mark WORDPERFECT had become known in Canada as of the material date, the applicant has failed to meet the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between the trade-marks at issue. Accordingly, the applicant's trade-mark is not registrable in view of s. 12(1)(d) of the Trade-marks Act and I have therefore refused the applicant's application pursuant to s. 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS _30th_____ DAY OF __November_____, 1990.

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