

**IN THE MATTER OF AN OPPOSITION
by Myriad Innovative Designs Inc to
Application No. 892940 for the Trade-
mark MIND CHARGER filed by
Juravsky & Associates Inc**

On October 9, 1998, Juravsky & Associates Inc (the “Applicant”) filed an application to register the trade-mark MIND CHARGER (the “Mark”), based on proposed use in association with educational services namely conducting conferences, workshops, skills upgrading courses and retraining and career development courses in the field of computers; programming services such as development of software, component development and user interface development; and computer consulting services and mentoring (such as Object Oriented Design services) (the “Services”). The application was subsequently advertised in the Trade-marks Journal on July 14, 1999, for opposition purposes.

Myriad Innovative Designs Inc (the “Opponent”) filed on September 13, 1999 a statement of opposition that can be summarized as follow:

- 1) The application does not conform to the requirements of section 30 (a) of the Trade-marks Act (the “Act”) in that it does not contain a statement in ordinary commercial terms of the Services in association with which the Mark is proposed to be used;
- 2) The application does not conform to the requirements of section 30 (e) of the Act in that the Applicant cannot use and does not intend, by itself or through a licensee, to use the Mark in Canada in association with all the Services;
- 3) The application does not conform to the requirements of section 30 (i) of the Act in that the Applicant is not the person entitled to use the Mark in association with the Services as the Opponent is the owner of the following registered trade-marks or applications for which registration is sought:
 - a) MIND, registration number 376741
 - b) MIND COMPUTER PRODUCTS, registration number 380291

- c) MIND, application number 628021
- d) MIND COMPUTER PRODUCTS, application number 628020
- e) MIND COMPUTER PRODUCTS, application number 839773
- f) MIND, application number 839774

(collectively referred to as the “Opponent’s trade-marks”) all of them being used by the Opponent in association with a variety of different computer software and hardware products, and for the provision of many services similar to the Services;

- 4) The Mark is not registrable as Section 7(b) of the Act prohibits its registration because the use of the Mark in association with the Services will direct public attention to the services or business of the Applicant in such a way as to cause or likely to cause confusion in Canada between the Services and the business and services or wares of the Opponent;
- 5) The Mark is not registrable as Section 7(d) of the Act prohibits its registration because the use of the Mark in association with the Services is a description that is false in a material respect and is likely to mislead the public as to the character of the Services and/or as to its geographical origin;
- 6) The Mark is not registrable as Section 12(1)(b) of the Act prohibits its registration because the Mark, whether it is depicted, written or sounded, is clearly descriptive or deceptively misdescriptive in the English language, and/or is either descriptive or deceptively misdescriptive in the French language, of the character or quality of the Services in association with which it is proposed to be used or of the conditions of the persons employed in their production or of the place of origin, because the public will believe that the Opponent must be the source of the Services if they are marketed under the Mark;

- 7) The Mark is not registrable as Section 12(1)(d) of the Act prohibits its registration because the Mark is confusing with the Opponent's registered trade-marks;
- 8) The Applicant is not the person entitled to the registration of the Mark pursuant to Section 16(3)(a) of the Act, as at the date of filing of the application, it was confusing with the Opponent's trade-marks MIND and MIND COMPUTER PRODUCTS, previously used or made known in Canada by the Opponent;
- 9) The Applicant is not the person entitled to the registration of the Mark pursuant to Section 16(3)(b) of the Act, as at the date of filing of the application, it was confusing with previously filed applications by the Opponent for the registration of the trade-marks listed above;
- 10) The Applicant is not the person entitled to the registration of the Mark pursuant to Section 16(3)(c) of the Act, as at the date of filing of the application, it was confusing with the Opponent's trade names MIND and MIND COMPUTER PRODUCTS previously used in Canada;
- 11) The Mark is not registrable as it is not distinctive of the Services in view of the prior use in Canada by the Opponent of the trade-marks MIND and MIND COMPUTER PRODUCTS and the Opponent's prior registrations and approved applications listed above.

The Applicant filed on April 3, 2000, a counter statement denying all grounds of opposition and did argue that the allegations of prohibition based on Section 7 of the Act do not constitute valid grounds of opposition.

The Opponent's evidence consists of the affidavits of Brad Enns, Robert Holmes, Brad Fry and certified copies of trade-mark registrations 376741, 525934, 380291 and 527243. The Applicant filed the affidavits of Lyle Juravsky, Alain Leduc, Rod Card, Janice Retterath and John Trimble. None of the affiants were cross-examined. Neither party filed written arguments nor requested an oral hearing.

The Opponent's evidence

Mr Holmes is the Opponent's manager and has been working for the Opponent since 1989. The Opponent sells computers that bear the trade-mark MIND. A sticker that is placed on the front of the computers sold by the Opponent was filed as Exhibit A to his affidavit. The Opponent's computers have been sold to the Federal and Provincial government departments and offices, crown corporations and the Canadian Military. A list of Government departments and offices using the Opponent's computers bearing the trade-mark MIND was filed as Exhibit B to his affidavit. Since the early 1990's it has manufactured tens of thousands of computers in association with the Mark.

Mr. Enns has been the Opponent's Educational Account Manager since 1994. The Opponent has sold 125,000 computers and has provided related services such as software design and training in the usage of computers and software. All of the Opponent's products and services are sold in association with the trade-mark MIND. A large number of schools in Manitoba purchased the Opponent's MIND computers. A list of those schools was filed as Exhibit B to his affidavit. He estimates that approximately 145,000 students from grades 1 to 12 have access to these computers. He does not explain how he arrived at such number and I shall disregard such evidence. He alleges that MIND computers are also used in other Canadian schools outside Manitoba without providing any details except to recognize that "[they] are not large enough in any single geographic area to have caused the [Opponent] to develop a specific data base...".

Mr Fry has been, since 1981, the Opponent's president. The Opponent is engaged in all aspects of modern computing including the sale of the wares and services covered by certificate of registration TMA376741 issued on December 7, 1990, for the trade-mark MIND and by certificate of registration TMA380291 issued on February 22, 1991, for the trade-mark MIND COMPUTER PRODUCTS (the relevant wares and services being enumerated hereinafter). Since its inception, the Opponent manufactures computer hardware and designs custom made software for its clients. The Opponent also provides consultation services in trying to solve their clients' problems arising from the use of the Opponent's computers. An article published in the Winnipeg Free Press in

1987 describing the Opponent's business was filed as Exhibit B to his affidavit. The Opponent's trade-mark MIND consists of the first letter of the first word of its trade name together with the first two letters of the second word of its trade name and the first letter of the last word of its trade name.

The Opponent's current annual sales are approximately fifty-five (55) million dollars. Mr. Fry alleges that the Opponent is the largest manufacturer of computers in Western Canada. Filed as Exhibit A to his affidavit were copies of web pages of the Opponent's website. There is however no indication as to when those pages appeared for the first time on the Opponent's website. He alleges that, as appears from the application, the Applicant intends to offer "educational services...in the field of computers". Such services would include the training of customers in the use of selected software packages.

Since the last half of the 1990's the Opponent has spent approximately \$1,100,000 each year in advertising and sponsorships. Mr. Fry filed samples of such advertising as Exhibits C to M to his affidavit, which include pictures of billboard advertising, flyers, adds in baseball programs and newspapers. There is however very little information as to the circulation figures of these newspapers and the date of publication of these advertisements (except for an ad placed in the Winnipeg Sun issue of September 6, 1997). The Opponent sponsored the Winnipeg Blue Bombers Football team and the Winnipeg Goldeyes Professional Baseball team by having large billboards prominently displayed in their respective home grounds.

The Opponent has appointed authorized resellers of its products and services sold in association with its trade-marks MIND and MIND COMPUTER PRODUCTS. A list of such authorized resellers located in Alberta, Saskatchewan, Manitoba, Ontario and Nunavut is annexed as Exhibit N to his affidavit. Filed as Exhibit P to his affidavit is a picture of a compact disc bearing the trade mark MIND which contains custom designed software and educational (training) manuals written in 1998 and 1999 for use with the Opponent's computers and software.

He alleges that the “computer consulting services and mentoring (such as Object Oriented Design services)” are not clear as to what type of software they relate to, or of what type of components they relate to.

Mr. Fry is of the opinion that the use of the Mark by the Applicant in association with the Services will cause confusion with the Opponent’s trade-marks. I shall disregard such allegation as being self-serving evidence. It is the Registrar’s duty to determine, on the basis of the evidence filed in the record, if there exists a likelihood of confusion between the Mark and the Opponent’s trade-marks.

Certificates of registration TMA380291 for the trade-mark MIND COMPUTER PRODUCTS and TMA376741 for the trade-mark MIND were filed, covering a long list of computer hardware and software, accessories and computer related services including, inter alia:

computer books, computer magazines, computer software and the services of operation of a wholesale and retail business selling computer hardware, computer software and computer furniture; repairing computers; design of custom computer hardware; design of custom computer circuit boards; design of custom computer software; installation of custom designed computer software; training customers in the use of selected software packages.

Certificates of registration TMA527243 and TMA525934 cover wares unrelated to computer hardware and software but that could be used as promotional items such as cups, caps, license plates etc... were also filed in the record. There is however no evidence of use of the trade-mark MIND and MIND COMPUTER PRODUCTS in association with any of the wares listed in those certificates of registration.

The Applicant’s evidence

Mr. Juravsky is the Applicant’s president. The Applicant has been writing, selling and delivering specialized programmer training courses and custom software solutions for almost 13 years, and since May 1998 in association with the Mark. He filed, as Exhibit A1 to his affidavit, a copy of a

web page listing the courses offered by the Applicant. There is no reference to the Mark on this exhibit and no mention in the allegation of the date it first appeared on the Applicant's web site.

The Applicant's Services are provided either at its premises or at its clients' premises. The price of the courses offered by the Applicant ranges from \$1900 to \$2500. A price list that has the trade name Mind Charger Technologies was filed as Exhibit A3 to his affidavit. He alleges that the typical client who enrolls in one of the courses offered by the Applicant would be working within the computer industry and knowledgeable of the computer programming languages and would have developer skills. A list of courses offered by the Applicant was filed as Exhibit A4. There is no reference to the Applicant's Mark on such document. A copy of one of the web pages of the Applicant's web site, which contains information on job opportunities with the Applicant, does bear the Mark but we have no indication as to when this page first appeared on the Applicant's web site.

Mr Juravsky alleges that the Applicant does not offer training programs for the use and understanding of "off-the-shelf" or pre-packaged software of the type normally associated with the purchase of a new personal computer. The Applicant does not sell, service, repair or maintain personal computers nor does it sell, service, repair or maintain personal computer related hardware or off-the-self software. A brochure of the courses offered during the spring/summer 2001 by the Applicant and bearing the Mark, was filed as Exhibit A7. Paragraph 11 of his affidavit, on the likelihood of confusion between the Mark and the Opponent's trade-marks, is inadmissible hearsay evidence.

He filed, as Exhibit A8 to his affidavit, a page of the Opponent's web site in order to argue that the parties respective businesses are different as the Applicant is in the business of providing advanced computer software courses while the Opponent is in the business of selling hardware and off-the-self software.

Mr. Leduc works as a broadcast development engineer at Industry Canada. He is responsible, since April 1980, for choosing vendors to supply information technology ("IT") services including

programmer training. The Applicant first contacted Industry Canada in March of 1999. He does confirm that Industry Canada bought some equipment from the Opponent but failed to specify which equipment it purchased. He did visit each party's web site and states the reasons why he would not be confused by the Applicant's Mark in association with the Services.

Mr Card is responsible, at Clarica Life Insurance Company, for selecting vendors to supply IT services while Ms. Retterath has the same responsibilities at PeerGroup, a "provider of software solution of manufacturing applications". Mr. Trimble is the manager of dealer development at Honda Canada and as such is also responsible for the selection of vendors to supply IT services. Except for their functions the content of their affidavit is almost identical, namely:

- a) That they have no knowledge of the Opponent;
- b) They know the Applicant as a supplier of programmer training and programming related services;
- c) The Applicant has provided to their companies training and an invoice bearing the Mark, the earliest one dated August 19, 1999 attached to Mr. Trimble's affidavit, is annexed to each of their affidavits;
- d) They visited the parties' respective web sites and draw conclusions on the differences between the parties' services and wares and concluded that they would not be confused as to the origin of their respective wares and services. None of those affiants filed a copy of the web pages that serve as the basis of their opinion. Therefore I shall give little weight to such conclusion.

The Legal Issues

The material time for considering the issues of non-compliance with Section 30 of the Act is the filing date of the application (October 9, 1998) [See *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469, at p. 475] as well as the issue of non-entitlement based on Section 16(3) of the Act [Section 16 of the Act]. The material date for assessing the issue of distinctiveness is generally accepted to be the date of filing of the opposition (September 13, 1999) [see *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) 413 at 424 (F.C.A)]. The

material date with respect to Section 12(1)(d) ground of opposition is the date of my decision. (*See Park Avenue Furniture Corp., op. cit.*).

The legal burden is upon the Applicant to show that its application complies with the provisions of Section 30 of the Act, but there is however an initial evidential onus on the Opponent to establish the facts relied upon by it in support of such grounds of opposition. Once this initial onus is satisfied, the Applicant has the burden to prove that the particular grounds of opposition should not prevent registration of the Mark. [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293]

As for the first ground of opposition based on Section 30(a) of the Act, the former Chair of the Opposition Board, Mr. Gary Partington, in *Everything for a Dollar Store (Canada) Inc v. Dollar Plus Bargain Centre Ltd*, 86 C.P.R. (3d) 269 stated:

“As for the test to be applied under section 30(a) of the Act, the former Registrar of Trade-marks stated in *Dubiner v. Heede International Ltd. (1975)*, 23 C.P.R. (2d) 128 (T.M.O.B.), that an applicant in its application "must clearly set forth wares or services as they are customarily referred to in the trade" (emphasis added). In *McDonald's Corp. v. M.A. Comacho-Saldana International Trading Ltd. (1984)*, 1 C.P.R. (3d) 101 (T.M.O.B.) at p. 104, the Hearing Officer concluded that it was only necessary for the opponents to present sufficient argument in order to meet the initial burden on the opponents in respect of a section 30(a) ground of opposition.

While a statement of services may be more difficult to define in terms of the specific services as contrasted to a statement of wares, section 30(a) of the Trade-marks Act does require a measure of specificity in respect of the services covered in a trade-mark application where it is reasonable to expect that a specific statement of services in ordinary commercial terms can be provided by an applicant (see *Sentinal Aluminium Products Co. v. Sentinel Pacific Equities Ltd. (1983)*, 80 C.P.R. (2d) 201 (T.M.O.B.)). Thus, in *Stanhope Inc. v. Les Encheres Stanley Inc. (1983)*, 82 C.P.R. (2d) 20 (T.M.O.B.), it was found that the applicant's statement of services of "operating a business specializing in the retail sale of classes of household and commercial wares" sufficiently defines the nature of the services being rendered without the necessity of the applicant delimiting the products being sold either in specific terms or by way of general categories. Likewise, in *S.C. Johnson and Son, Inc. v. Peerless Carpet Corp.*, a yet unreported Opposition Board decision dated September 25, 1997 [now reported 79 C.P.R. (3d) 558], it was

[page274] concluded that the "operation of a business dealing in the manufacture, marketing, distribution and sale of floor coverings, carpets, adhesives and carpet installation systems . . ." by itself sufficiently defines the nature of the services being rendered without the necessity of the applicant delimiting the "floor covering" in specific terms. Also, in *Pro Image Sportswear Inc. v. Pro Image, Inc. (1992), 42 C.P.R. (3d) 566 (T.M.O.B.)*, it was concluded that the applicant is not required to identify in its application the nature of the "sporting goods" associated with its services in order to meet the requirements of section 30(a) of the Trade-marks Act." (My underlines)

Mr. Fry, in paragraph 6 of his affidavit, is arguing that the services described as "component development and user interface development; and computer consulting services and mentoring (such as Object Oriented Design services)" are not clear as to what type of software they relate to, or what type of components they relate to. It is interesting to note however that the affiant went on to state:

"... however, they at least partially fall within the field of " training customers in the use of selected software packages" and/or " design custom computer software" because interface development is the design and learning how to use custom software for the purpose of interfacing."

In light of the principles enunciated in *Everything for a Dollar Store (Canada) Inc above*, I conclude that the services are sufficiently described to meet the requirements of Section 30(a) of the Act. As such, I dismiss the first ground of opposition described above.

A review of the evidence filed in the record leads me to conclude that the Opponent did not discharge its initial onus with respect to portion of the second and sixth ground of opposition described above as it failed to file any evidence to support its contention that the Applicant does not intend to use the Mark in Canada in association with the Services and that the Mark would be clearly descriptive or deceptively misdescriptive in the English language of the Services. Therefore such portions of those grounds of opposition are dismissed.

The remainder of the second ground of opposition which deals with the issue that the Applicant cannot use the Mark in Canada in association with the Services and of the sixth ground of opposition which states that the Mark is clearly descriptive or deceptively misdescriptive of the

place of origin of the Services, because the public would believe that the Opponent must be the source of the Services if they are marketed under the Mark, shall have the same fate as the grounds of opposition that will be decided hereinafter on the issue of confusion between the Mark and the Opponent's trade-marks and trade names.

The Opponent has not provided any evidence to support its third ground of opposition. Therefore, such ground of opposition is dismissed.

With respect to grounds of opposition four and five (4 and 5) described above, the Registrar in *Cuprinol Ltd. v. J. S. Tait & Co. (1974), 19 C.P.R. (2d) 176 (T.M.O.B.)* at p. 181 stated:

“Objections based on s. 7 of the Trade Marks Act are not grounds for opposition pursuant to s. 37(2) of the Trade Marks Act. A breach of s. 7 of the Trade Marks Act may be made the subject of other proceedings before a Court of competent jurisdiction but it is not proper grounds for opposition.”

Accordingly, I dismiss those two grounds of opposition.

The remaining grounds of opposition (third, seven, eight, ninth, tenth and eleventh) will be decided on the issue of the likelihood of confusion between the Mark and the Opponent's trade-marks. Subsections 6(1) to 6(4) of the Act set out the test to determine if a mark is likely to cause confusion with another trade-mark or trade name. Such Subsections read as follow:

6. (1) For the purposes of this Act, a trade-mark or trade-name is confusing with another trade-mark or trade-name if the use of the first mentioned trade-mark or trade-name would cause confusion with the last mentioned trade-mark or trade-name in the manner and circumstances described in this section.

(2) The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

(3) The use of a trade-mark causes confusion with a trade-name if the use of both the trade-mark and trade-name in the same area would be likely to lead to the inference that the wares or services associated with the trade-mark and those associated with the business carried on under the trade-name are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

(4) The use of a trade-name causes confusion with a trade-mark if the use of both the trade-name and trade-mark in the same area would be likely to lead to the inference that the wares or services associated with the business carried on under the trade-name and those associated with the trade-mark are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

In order to determine whether the parties' trade-marks or trade names are confusing, Subsection 6(5) of the Act directs that the Registrar is to have regard to all of the surrounding circumstances, including: i) The inherent distinctiveness of the trade-marks or trade names and the extent to which they have become known; ii) the length of time the trade-marks or trade names have been in use; iii) the nature of the wares, services, or business; iv) the nature of the trade; and v) the degree of resemblance between the trade-marks or trade names in appearance or sound or in the ideas suggested by them.

The burden of proof lies on the Applicant who must convince the Registrar, on the balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's trade-marks at the abovementioned relevant dates [see *Sunshine Biscuits Inc. c. Corporate Foods Ltd. (1982)*, 61 C.P.R. (2d) 53].

Mr Justice Décary of the Federal Court of Appeal stated in the case of *Christian Dior, S.A. et Dion Neckwear Ltd [2002] 3 C.F.405*:

«...the Court is to put itself in the position of an average person who is familiar with the earlier mark but has an imperfect recollection of it; the question is whether the ordinary consumer will, on seeing the later mark, infer as a matter of first impression that the wares with which the second mark is used are in some way associated with the wares of the earlier...
The Registrar must therefore be reasonably satisfied that, on a balance of probabilities, the registration is unlikely to create confusion; he need not be satisfied beyond doubt that confusion is unlikely. Should the "beyond doubt" standard be applied, applicants would, in most cases, face an unsurmountable burden because certainty in matters of likelihood of confusion is a rare commodity. At best, it is only where the probabilities are equal that a form of doubt may be said to arise, which is to be resolved in favour of the opponent. But the concept of doubt is a treacherous and confusing one in civil proceedings and a registrar should avoid resorting to it.»

In order to succeed under the various grounds of opposition based on Section 16 of the Act, the Opponent has to prove that the Opponent's trade-marks were previously used in Canada (Section 16(3)(a)) or in respect of which an application had been previously filed in Canada (Section 16(3)(b)) or that the trade names MIND and MIND COMPUTER PRODUCTS had been previously used in Canada (Section 16(3)(c) of the Act). Moreover the Opponent must demonstrate that it had not abandoned the use of its trade-marks and trade names at the date of publication of the application for the registration of the Mark (July 14,1999). I am satisfied that the Opponent has met such onus with respect to the trade-marks MIND and MIND COMPUTER PRODUCTS in association with the services of selling computers and related equipment, and with respect to the trade-mark MIND in association with computers (see Exhibits D2, H, I, J, L O, and P to Mr. Fry's affidavit).

The difference in the relevant dates of the remaining grounds of opposition will not have an impact on the outcome of my analysis of the surrounding circumstances to determine if there exists, on a balance of probability, any likelihood of confusion between the Mark and the Opponent's trade-marks and trade names.

As the Opponent's strongest case is the likelihood of confusion with the trade-mark and trade name MIND, if the Applicant's Mark is not confusing with the Opponent's trade-mark MIND, then it will not be confusing with the Opponent's trade-mark MIND COMPUTER PRODUCTS. I shall therefore focus my analysis of the surrounding circumstances by comparing the Mark with the Opponent's trade-mark MIND.

- i) The inherent distinctiveness of the trade-marks or trade names and the extent to which they have become known;

Both MIND and MIND CHARGER have a considerable degree of inherent distinctiveness but the applicant's Mark is slightly less distinctive as the word "mind" has already been considered suggestive of educational services. [See *Myriad Innovative Design Inc v. Akbar (2000) 9 C.P.R. (4th) 265*]

The Opponent failed to break down either by product or by material dates its sales. Mr Fry alleges however the sale of more than 125,000 computers bearing the trade-mark MIND since 1981. The trade-mark MIND has been advertised in Canada since at least 1995 in association with computers and with the services of selling computers and related equipment. The Opponent has spent approximately \$700,000 annually during the last half of the 1990's in advertisements through television, print and radio advertisements, and sponsorship of professional sporting teams (See Exhibits C to M to Mr Fry's affidavit). The Opponent's annual sales as of 2000 were 55 million dollars.

The Applicant has used the Mark in association with customer software development since August 1999 as appears from a copy of the invoice filed as Exhibit A1 to Mr Trimble's affidavit. The

Applicant has not provided any annual sales figures in association with the Mark. Taking in consideration all these facts I conclude the Opponent's trade-mark MIND has become known in Canada to some extent since at least 1995. This factor favours the Opponent.

- ii) The length of time the trade-marks or trade names have been in use;

As appears from the evidence summarized above, this factor also favours the Opponent.

- iii) The nature of the wares, services, or business and nature of the trade

The Opponent is in the business of the design, manufacture and sale of computers. Its computers, computer systems and other products are sold in all areas of Canada (see Exhibit B to Mr Holmes' affidavit). Its clientele includes schools and educational institutions, as well as government departments, offices and crown corporations. The Applicant is offering the following services: computer courses, training programs and development of software. There is clearly an overlap between the wares, businesses and services of the parties, especially with respect to the development of software and training programs. Moreover there exists a close relationship between computers on one hand and computer courses, on the other hand.

The Applicant argues that there is a clear distinction in the nature of the business of the parties as the Applicant is offering advanced computer courses and that its clientele is well versed in computer science. The price of its course would support the allegation that its courses are not aimed at those who purchased off-the-shelf software. The overlap in the parties' services is evidenced however by the allegations of Mr. Alain Leduc when he states that Industry Canada will be buying training courses from the Applicant while it has already purchased some computer equipment from the Opponent.

One must remember that the likelihood of confusion must be addressed from the perspective of an average consumer, not an expert in the field of computers and related items. This circumstance also favours the Opponent

- iv) The degree of resemblance between the trade-marks or trade names in appearance or sound or in the ideas suggested by them.

There is some degree of resemblance between MIND and MIND CHARGER both visually and when sounded. The idea suggested by each mark differs somewhat as a result of the addition of the word CHARGER. The Applicant's Mark incorporates the opponent's mark MIND in its entirety. On this issue, I note the following comments from page 188 of the Federal Court's decision in *Conde Nast Publications Inc. v. Union des Editions Modernes (1979)*, 46 C.P.R. (2d) 183 (F.C.T.D.):

“It has appropriated the appellant's mark in its entirety and added thereto as a suffix the words "age tendre". It is axiomatic that the first word or the first syllable in a trade mark is far the more important for the purpose of distinction. Here the first and most important word in the mark which the respondent seeks to register is identical to the mark registered by the appellant.”

Conclusion

The appropriate test to determine the likelihood of confusion is: Would an average consumer with an imperfect recollection of the Opponent's trade-mark MIND used in association with computer hardware and software as well as in association with the services of selling computer hardware and software, think that the training and development programs offered by the Applicant in association with the Mark, have the same source? On a balance of probabilities, I answer the question in the affirmative.

I conclude that the Applicant has not discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's trade-mark and trade name MIND when used in association with the Services. I reach this conclusion on the basis that the analysis of all the relevant surrounding circumstances favours the Opponent. The grounds of opposition 7, 8, 9, 10 and 11 described above are maintained as well as the remainder of grounds of opposition 2 and 6.

Having been delegated authority by the Registrar of Trade-marks by virtue of Section 63(3) of the Act, I refuse the Applicant's application for the registration of the Mark in association with the Services, the whole pursuant to Subsection 38(8) of the Act.

DATED, IN MONTREAL, QUEBEC, THIS 16th DAY OF MARCH 2004.

Jean Carrière,
Member,
Trade-mark Opposition Board