

**IN THE MATTER OF AN OPPOSITION by
VDO Road Digital Inc. to
application No. 1,016,863
for the trade-mark @ROAD
in the name of @Road, Inc.**

On May 26, 1999, Vectorlink, Inc. filed an application to register the trade-mark @ROAD based upon proposed use of the trade-mark in Canada. The application has a convention priority filing date of April 2, 1999 and its statement of services reads “telecommunication services, namely locating, tracking, managing, and dispatching individuals and fleet vehicles and to provide users with information relevant to particular geographic locations, such services rendered via a global computer network”.

On May 27, 1999, Vectorlink Inc. changed its name to @Road, Inc. (hereinafter the applicant).

The application was advertised for opposition purposes in the Trade-marks Journal of October 25, 2000. The opponent, VDO Road Digital Inc., filed a statement of opposition on March 26, 2001. The applicant filed and served a counter statement in which it denied the opponent's allegations.

The opponent elected to not file any evidence. As its evidence, the applicant filed the statutory declaration of Krish Panu and affidavits of Claire Gordon and Eileen Castellano.

Mr. Panu declares, “I am the Chairman and Chief Executive Officer of Applicant At Road, Inc.”

Although I recognize that someone might misspell @Road, Inc. as At Road, Inc., the applicant’s

agent has not alleged that this is the case and I will not assume that At Road, Inc. is the same legal entity as @Road, Inc. Accordingly, I have disregarded all of the evidence concerning use of @ROAD by At Road, Inc. I have however considered Mr. Panu's evidence of the opponent's website and its contents.

Ms. Castellano, a trade-marks searcher, provides the results of a search that she conducted on February 19, 2002 to locate active trade-mark registrations and applications on the Canadian Trade-marks Register containing the word "Road" in association with computer related wares/services and telecommunication wares/services. She provides certain particulars concerning 72 marks, but does not provide full registration pages for any of them.

Ms. Gordon, a law clerk, provides the results of searches directed to the word ROAD that she conducted in July 2002 of Canadian business telephone directory databases (1377 hits), Industry Canada's NUANS database (6264 business and trade-mark names), and the Internet using the Google Canada search engine (235,000 hits for the words ROAD and COMPUTER; 25,000 hits for the words ROAD and TELECOMMUNICATIONS).

Only the applicant filed a written argument. An oral hearing was not held.

The applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*. However, there is an initial evidential burden on the opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John*

Labatt Limited v. The Molson Companies Limited, 30 C.P.R. (3d) 293 at 298].

The opponent has not met its initial burden in respect of three of the four pleaded grounds of opposition. In support of its section 30 ground, the opponent was required to point to some evidence of the applicant having used its mark in Canada before its filing date or its lack of intention to use its mark. With respect to the paragraph 16(3)(a) grounds, the opponent had to evidence use of its trade-marks prior to the applicant's priority filing date and establish non-abandonment of its marks as of the date of advertisement of the applicant's application [subsections 16(5) and 17(1), *Trade-marks Act*]. With respect to the paragraph 16(3)(b) grounds, the opponent had to evidence that its applications were still pending as of October 25, 2000 [subsection 16(4), *Trade-marks Act*]. With respect to the grounds of opposition based on non-distinctiveness, the opponent had to show that as of March 26, 2001, one or more of its trade-marks had become known sufficiently to negate the distinctiveness of the applied-for mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.)]. Accordingly, the subsection 30(e), paragraph 16(3)(a), paragraph 16(3)(b) and distinctiveness grounds of opposition fail.

Although the opponent has not filed evidence of the registrations on which it relies in support of its paragraph 12(1)(d) grounds of opposition, I have exercised the Registrar's discretion to check the Register to confirm their existence [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.*, 11 C.P.R. (3d) 410 (T.M.O.B.)]. The opponent is the owner of TMA496,393 for ROAD & Design, TMA496,287 for ROADHOUSE, TMA496,296 for ROADTEL and TMA496,154 for ROADWARE. It alleges that the applicant's trade-mark @ROAD is confusing with each of these registered trade-marks. The material date with respect to paragraph

12(1)(d) is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)].

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the *Act*. Those factors specifically set out in subsection 6(5) are: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time each has 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 in appearance or sound or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

Each of the trade-marks at issue has some inherent distinctiveness.

A consideration of the extent to which each mark has become known in Canada does not favour either party.

The length of time each mark has been used in Canada would favour the opponent if we accepted the claim of use of its marks made in its registrations.

The opponent's wares and services are set out in each of its registrations as:

computer products, namely hardware and software to access the information highway; multimedia products namely: CD-ROMs to support access to telecommunication services, digital video discs, visual peripherals, namely, cameras and speakers.

services of development of hardware and software to access the information highway offered and rendered according to the specifications of the clients; services of development of web pages offered and rendered according to the specifications of the clients; computer services, namely leasing access time to computer databases developed and managed for the benefit of third parties; computer training and consultation services both on-line and on site; data conversion and translation services.

It does not appear to me that the parties' wares/services overlap. While it is true that they are both computer-related, the computer field is very broad. The opponent's website includes the statement, "VDO Road Digital provides mobile users with the most convenient, secure and entertaining Broadband public access to the Internet." This statement supports a conclusion that the nature of the opponent's business is different from that of the applicant, who appears to be involved with the tracking and dispatching of vehicles.

Based on the information that we have been provided from the opponent's web site, it appears that the opponent provides Internet access to individuals "on the road". The website compares one of the opponent's products to a telephone booth, ATM machine or vending machine and suggests the following locations as appropriate sites: coffee shops, malls, airports, train/bus stations, hotels/motels, hospitals/clinics, school campuses, sports centers, trade centers, health clubs, restaurants, arcades, resorts, casinos, mail/copy centers, supermarkets, sports bars, night clubs, and hair salons. It seems rather unlikely that the applicant's services would be offered in any of the locations suggested by the opponent's website.

The trade-mark @ROAD only resembles ROAD & Design, ROADHOUSE, ROADTEL and ROADWARE to the extent that each contains the word ROAD, a common dictionary word. It is also noted that the first part of each parties' marks, the portion typically considered the most relevant for purposes of distinction, are not the same. [see *K-Tel International Ltd. v. Interwood Marketing Ltd.* (1997), 77 C.P.R. (3d) 523 (F.C.T.D.) at 527]

As a further surrounding circumstance, we have some evidence of the common adoption of the suggestive word ROAD by others in the general field of computers or telecommunications.

The issue is whether a consumer who has a general and not precise recollection of the opponent's mark, will, upon seeing the applicant's mark, be likely to think that the two products share a common source. I find that a consideration of all the surrounding circumstances leads me to conclude that, on a balance of probabilities, there is not a reasonable likelihood of confusion between the mark @ROAD as applied to "telecommunication services, namely locating, tracking, managing, and dispatching individuals and fleet vehicles and to provide users with information relevant to particular geographic locations, such services rendered via a global computer network" and any of the opponent's marks as applied to its registered wares and services. My conclusion is based primarily on the differences between the nature of the parties' wares and services and the lack of evidence of the opponent's registered marks having acquired any reputation. In the circumstances, it would be inappropriate for the opponent's scope of protection with respect to the suggestive word ROAD to succeed in preventing the registration of the applicant's mark, especially given the opponent's decision to not file either evidence or argument.

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, I reject the opposition pursuant to subsection 38(8) of the *Act*.

DATED AT TORONTO, ONTARIO, THIS 20TH DAY OF JULY 2004.

**Jill W. Bradbury
Member
Trade-marks Opposition Board**