

IN THE MATTER OF AN OPPOSITION by INTEL CORPORATION to application No. 728,348 for the trade-mark ICOM filed by ICOM INCORPORATED, A JAPANESE CORPORATION

On May 6, 1993, the applicant, ICOM INCORPORATED, A JAPANESE CORPORATION, filed an application to register the trade-mark ICOM based upon use of the trade-mark in Canada by the applicant (formerly known as INOUE COMMUNICATIONS EQUIPMENT CORPORATION) in association with the following wares since as least as early as 1971:

“Communications equipment, namely transceivers, communications receivers, radiotelephones, mobile transceivers, marine transceivers and amateur radio transceivers; and components of the foregoing and accessories therefor, namely microphones, speakers, headphones, power packs, remote controllers, rechargers, antennae, antennae tuners, headsets, handsets, switches, alarms, connectors, brackets and straps”

use of the trade-mark in Canada by the applicant in association with the following wares since as least as early as 1990:

“Navigation equipment, namely video sounders, plotters, radar, GPS receivers and sonar”

use of the trade-mark in Canada by the applicant in association with the following wares since as least as early as 1984:

“Transceiver computer interface terminals”

use of the trade-mark in Canada by the applicant or its predecessor-in-title, ICOM AMERICA INC., in association with the following wares since as least as early as 1988:

“Promotional products, namely: knives, hand tools, watches, clocks, jewellery, tote bags, screwdrivers, cups, mugs, plates, bowls, desk flags, banners, table covers, lamps, imitation radios, letter openers, pins, license plate holders, license frames, display stands, sign boards, sport bags, money clips, key chains, key holders and key rings; stationery, namely writing paper, notebooks, note pads, memo pads, pens and pencils; clothing, namely shirts, t-shirts, hats, jackets, sweaters and patches for clothing; printed matter, namely instructional leaflets and information booklets”

use of the trade-mark in Canada by the applicant or its predecessor-in-title, ICOM AMERICA INC., in association with the following services since as least as early as 1986:

“Repair of communications equipment”

use of the trade-mark in Canada by the applicant or its predecessor-in-title, ICOM AMERICA INC., in association with the following services since as least as early as 1991:

“Repair of navigation equipment”

and use of the trade-mark in Canada by the applicant or its predecessor-in-title, ICOM AMERICA INC., in association with the following services since as least as early as 1987:

“Providing instruction in the operation of communications equipment and in particular the operation of amateur radios.”

Further, during the opposition, the applicant amended its application in relation to the fourth grouping of wares to cover the following:

“Printed matter, namely - instructional leaflets and information booklets”.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of December 29, 1993 and the opponent, INTEL CORPORATION, filed a statement of opposition on December 20, 1994, a copy of which was forwarded to the applicant on March 16, 1995. In its statement of opposition, the opponent alleged the following grounds:

(a) The application does not conform to the requirements of Section 30 of the *Trade-marks Act* in that the application does not contain a correct date of first use that the applicant has so used the trade-mark in association with each of the general classes of wares and services described in the application. The opponent states and the fact is that the applicant has not used the subject trade-mark in association with all of the wares and services as set forth in the application since the dates of first use cited therein;

(b) The application does not conform to the requirements of Section 30 of the *Trade-marks Act* in that the application does not contain a statement in ordinary commercial terms of the specific wares or services in association with which the mark has allegedly been used since the dates recited in the application. Without limiting the generality of the foregoing, the opponent states and the fact is that the applicant has not recited in its application the specific wares set forth in group (4) with specific reference to information booklets, instructions leaflets and catalogues and other printed matter referred to therein.

Since the present application covers seven separate groupings of wares and services, the opponent's general allegation in its second ground that the present application does not contain a statement in ordinary commercial terms of the specific wares or services in association with which the mark has allegedly been used is contrary to paragraph 38(3)(a) of the *Trade-marks Act*. As a result, paragraph (b) of the statement of opposition only raises a proper ground in relation to its allegation that the applicant has not recited the specific wares set forth in group (4) with specific reference to information booklets, instructions leaflets and catalogues and other printed matter referred to therein.

The applicant served and filed a counter statement on June 7, 1995 in which it asserted that it has used its trade-mark ICOM in association with the wares and services set forth in its application since at least as early as the respective dates set out therein. Further, the applicant asserted that paragraph 6 of its application (identified as wares in group (4) in the statement of opposition) contains a statement in ordinary commercial terms of the specific wares in association with which the mark has been used and that since the statement of opposition sets out no details of any wares or services, other than the wares of paragraph 6 of the application, it does not enable the applicant to prepare a counter statement in relation to any other wares or services contained in the application.

The opponent submitted as its evidence the affidavit of Jeffrey Pervanas while the applicant filed as its evidence the affidavit of Gloria Rasmussen. Ms. Rasmussen was cross-examined on her affidavit, the transcript of the cross-examination and the responses to certain of the undertakings given during the cross-examination forming part of the opposition record. The opponent also submitted the affidavit of Ray M. Daniels as evidence in reply. Mr. Daniels, whose evidence has not been challenged by way of cross-examination, has qualified himself as being an expert in the wireless communication field and, in his affidavit, Mr. Daniels defines how the terms “owner’s manual”, “service manual”, “information booklet” and “instructional leaflet” are used in Canada by others in the communication field. While the applicant has objected to the admissibility of the Daniels affidavit, I consider Mr. Daniels affidavit to be proper reply evidence in that it is strictly confined to matter in reply to Ms. Rasmussen’s evidence concerning the applicant’s instructional leaflets and information booklets which she has identified in her affidavit as being appropriate descriptions for the applicant’s owner’s manuals and service manuals.

The opponent’s grounds of opposition are based on Subsections 30(a) and 30(b) of the *Trade-marks Act*. While the legal burden is upon the applicant to show that its application complies with Section 30 of the *Trade-marks Act*, there is an initial evidential burden on the opponent to establish the facts relied upon by it in support of its Section 30 grounds [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]. The material time for considering the circumstances respecting the issues of non-compliance with Section 30 of the *Act* is the filing date

of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R.(3d) 469, at p. 475].

Considering initially the Subsection 30(a) ground, the opponent has alleged that the present application does not contain a statement in ordinary commercial terms of the specific wares set forth in group (4) with specific reference to information booklets, instructions leaflets and catalogues and other printed matter referred to therein. With respect to the test to be applied under Subsection 30(a) of the *Act*, the former Registrar of Trade-marks stated in *Dubiner and National Yo-Yo and Bo-Lo Ltd. v. Heede Int'l Ltd.*, 23 C.P.R. (2d) 128 that an applicant in its application “must clearly set forth wares or services as they are *customarily referred to in the trade* (emphasis added).” The applicant amended the fourth grouping of wares during the present proceeding, this grouping of wares now covering: “*Printed matter, namely - instructional leaflets and information booklets*”. Having considered the Rasmussen affidavit and the exhibits thereto and the transcript of Ms. Rasmussen’s cross-examination, as well as the affidavit of Ray M. Daniels, I have concluded that instructional leaflets and information booklets do not constitute a statement in ordinary commercial terms of the specific wares which the applicant has sold in Canada in association with its trade-mark ICOM. Rather, the evidence of record establishes that the applicant sells ‘owner’s manuals’ and ‘service manuals’ and that these wares might also be identified in ordinary commercial terms as ‘instructional manuals’ and ‘maintenance manuals’ respectively. However, owner’s manuals and service manuals would not normally be identified by the average consumer of such wares as either instructional leaflets or information booklets. Thus, the Subsection 30(a) ground of opposition in relation to “instructional leaflets and information booklets” is successful.

The second Section 30 ground is based on Subsection 30(b) of the *Trade-marks Act*, the opponent alleging that the applicant has not used the subject trade-mark in association with all of the wares and services set forth in the application since the claimed dates of first use. While the legal burden is upon the applicant to show that its application complies with Subsection 30(b), there is as noted above an initial evidential burden on the opponent to establish the facts relied upon by it in support of this ground. The evidential burden on the opponent respecting the issue of the applicant’s non-compliance with Subsection 30(b) of the *Act* is a light one [see *Tune Masters v. Mr. P’s Mastertune*, 10 C.P.R.(3d) 84, at p. 89]. Moreover, the opponent’s evidential burden can be met by

reference not only to the opponent's evidence, but also to the applicant's evidence [see, in this regard, *Labatt Brewing Company Limited v. Molson Breweries, a Partnership*, 68 C.P.R.(3d) 216, at p. 230], as well as any transcripts of cross-examinations which are of record and responses to undertakings given during such cross-examinations.

Having regard to my findings in relation to the Subsection 30(a) ground, and bearing in mind Mr. Daniels' evidence that instructional leaflets and information booklets normally constitute printed materials which are distributed without charge to the public, I have concluded that the opponent has met its evidential burden in relation to the Subsection 30(b) ground as applied to the applicant's "printed matter, namely instructional leaflets and information booklets". Furthermore, since the applicant has not met its legal burden in relation to this issue, the second ground is successful as applied to these wares.

In its written argument, the opponent also submitted that it has met its evidential burden in relation to this ground as applied to the applicant's transceiver computer interface terminals and communication equipment, as well as its services of providing instruction in the operation of communications equipment and in particular the operation of amateur radios. In particular, the opponent has noted that, during the Rasmussen cross-examination, the applicant undertook to advise the opponent as to the dates when the applicant first sold "transceiver computer interface terminals" and communications equipment in general in Canada in association with the trade-mark ICOM [see pg. 14, lines 14 - 18 and lines 20 - 27, transcript of Rasmussen cross-examination]. As the applicant failed to fulfil either of these undertakings, the opponent submitted that negative inferences should be drawn by the Registrar. On the other hand, the applicant submitted that a number of the questions asked by the opponent's agent exceeded the scope of a proper cross-examination of Ms. Rasmussen on her affidavit. As to the scope of cross-examination of an affiant on an affidavit submitted as evidence in an opposition proceeding, I would note the decision of the Opposition Board in *Coca-Cola Ltd. v. Compagnie française de Commerce International COFCI, S.A.*, 35 C.P.R. (3d) 406, at pages 412 - 413:

"In the present case, I consider that the opponent has met its evidential burden as a consequence of its cross-examination of the applicant's affiant Jean-Pierre Grivory. Mr. Grivory identifies himself as the chairman of the applicant and, as noted above, describes

how and where his company's trade mark is used. On cross-examination, the opponent's agent sought to elicit some additional information from Mr. Grivory regarding the use of his company's trade mark both in Canada and in France. She also questioned him regarding the extent of sales. However, the applicant's agent thwarted the opponent's agent and repeatedly directed Mr. Grivory not to answer such questions.

It was the position of the applicant's agent that the issue of the applicant's claimed date of first use was no longer relevant since the opponent had not independently adduced any evidence directed to the ground of non-compliance with s. 30(b) of the Act. I disagree. The Grivory affidavit dealt with the use of the applicant's mark and the opponent was entitled to question Mr. Grivory on this matter with a view to eliciting evidence respecting the first ground of opposition. The opponent need not only rely on its own evidence but can also rely on any admissions obtained from the applicant's affiants in support of its grounds. This is particularly so in the case of a ground of non-compliance with s. 30(b) of the Act where the relevant facts regarding the date of first use are more readily available to the applicant and its officers.

The applicant also submitted that the scope of cross-examination precluded the opponent from asking questions beyond the issues in respect of which the Grivory affidavit was filed: see the decision in *Weight Watchers Int'l Inc. v. Weight Watchers of Ontario Ltd.* (No. 2) (1972), 6 C.P.R. (2d) 169 at pp. 171-2 (F.C.T.D.). The applicant submitted that the Grivory affidavit dealt only with the nature of the applicant's wares and trade and therefore questions relating to the applicant's claimed date of first use and the extent and manner of the applicant's use were not permissible. Again, I do not agree. The Grivory affidavit dealt with the issue of the use of the applicant's mark and, once that issue had been addressed, it was open to the opponent to ask Mr. Grivory relevant questions on any aspect of the applicant's use of its mark.

If I am wrong in my interpretation of the Grivory affidavit, I consider that the opponent's questions were proper in any event in view of the fact that the scope of cross-examination in opposition proceedings is somewhat broader than as described in the *Weight Watchers* case noted above. Although the scope of cross-examination is certainly not as broad as that allowed in an examination for discovery in a civil action, it may extend beyond the particular issue for which the affidavit in question was submitted. This follows, in my view, from the fact that an opposition is not simply an inter partes proceeding but also involves a consideration of the public interest. For example, it is in the public interest to allow an officer of an applicant to be questioned as to the accuracy of a date of first use to ensure the legitimacy of an applicant's claimed basis for registration. The extended scope of cross-examination in opposition proceedings also follows (at least in the case of a ground of non-compliance with s. 30(b) of the Act) from the fact that the facts relating to that ground are, in most cases, only within the knowledge of the applicant. Thus, if the Grivory affidavit is found to be limited solely to the issue of the nature of the applicant's wares and trade, I consider that the opponent was nevertheless entitled to an extended scope to its cross-examination to cover the related issue of the applicant's date of first use of its trade mark.

In view of Mr. Grivory's failure to answer appropriate questions regarding his company's activities in Canada, I must infer that his company's claimed date of first use in Canada is incorrect. Since the applicant did not file evidence directed to positively establishing that date, I find that the application does not comply with s. 30(b) of the Act.”

Unlike the situation in the *Coca-Cola* case, Ms. Rasmussen was, at the time of her cross-examination, the accounting manager of ICOM America, Inc., a wholly owned subsidiary of the applicant, and therefore does not appear to have been an officer of either the applicant or its wholly-owned subsidiary, ICOM America, Inc., or even an employee of the applicant. Further, having regard to the statement of opposition submitted by the opponent, it is clear that the Rasmussen affidavit was intended solely to address the sale in Canada by ICOM Canada, a Division of ICOM America, Inc., of printed matter, namely, instructional leaflets and information booklets under the

trade-mark ICOM since 1988.

In view of the foregoing, it would appear that the opponent exceeded what was proper cross-examination of Ms. Rasmussen on her affidavit in covering issues which were not covered in her affidavit and were otherwise beyond Ms. Rasmussen's knowledge or expertise. However, the applicant's agent was free to object to questions put to Ms. Rasmussen during her cross-examination or to otherwise take matters under advisement rather than giving undertakings to provide information to the opponent. As a result, I am prepared to accord at least some weight to the negative inferences flowing from the failure of the applicant to fulfil certain of the undertakings given during the Rasmussen cross-examination.

Paragraph 5 of the Pervanas affidavit and Exhibits B-1 and B-2 thereto, combined with the failure of the applicant to fulfil the specific undertaking given by the applicant to advise the opponent as to the dates when the applicant first sold "transceiver computer interface terminals" in Canada in association with the trade-mark ICOM, is sufficient to meet the opponent's evidential burden in relation to the Subsection 30(b) ground as applied to "transceiver computer interface terminals". Further, since the applicant's evidence does not show that it has used its trade-mark ICOM in Canada since at least 1984 in association with "transceiver computer interface terminals", the second ground is successful in relation to these wares.

As noted previously, an undertaking was given during the Rasmussen cross-examination to provide the opponent with the first dates the applicant started selling communications equipment in Canada. Given the general nature of the request for information concerning communications equipment, and the fact that the applicant sold products in Canada before ICOM Canada was formed and that ICOM America, Inc. only came into existence in September of 1979, subsequent to the applicant's claimed date of first use of 1971 for communications equipment, I am not prepared to accord much weight to the failure of the applicant to fulfil this undertaking. I find therefore that the opponent has not met its evidential burden in relation to this aspect of the Subsection 30(b) ground which I have rejected.

The opponent also submitted that it has met its evidential burden in relation to the Subsection 30(b) ground as applied to the applicant's "providing instruction in the operation of communications equipment and in particular the operation of amateur radios". However, the only reference to these services during the Rasmussen cross-examination appears at pages 14 to 15 of the transcript; and the responses given by Ms. Rasmussen are not inconsistent with the applicant's claim that it or its predecessor-in-title, ICOM America, Inc., has provided these services in Canada since at least as early as 1987. I have therefore dismissed this aspect of the second ground.

In view of the above, and having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, I refuse the present application pursuant to Subsection 38(8) of the *Trade-marks Act* as applied to "*Printed matter, namely - instructional leaflets and information booklet*" and "*Transceiver computer interface terminals*" and otherwise reject the opponent's opposition to registration of the trade-mark ICOM as applied to the following wares:

"Communications equipment, namely transceivers, communications receivers, radiotelephones, mobile transceivers, marine transceivers and amateur radio transceivers; and components of the foregoing and accessories therefor, namely microphones, speakers, headphones, power packs, remote controllers, rechargers, antennae, antennae tuners, headsets, handsets, switches, alarms, connectors, brackets and straps. Navigation equipment, namely video sounders, plotters, radar, GPS receivers and sonar".

and the following services:

"Repair of communications equipment. Repair of navigation equipment. Providing instruction in the operation of communications equipment and in particular the operation of amateur radios."

In this regard, I would note the decision of the Federal Court, Trial Division in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 492 in respect of there being authority to render a split decision in a case such as the present.

DATED AT HULL, QUEBEC, THIS 25th DAY OF FEBRUARY, 1999.

G.W. Partington,
Chairperson,

Trade-marks Opposition Board