

**IN THE MATTER OF AN OPPOSITION
by Ridout & Maybee LLP to application No.
1,195,291 for the trade-mark THE IP RENEWALS
COMPANY filed by Corsonnel Corp.**

On November 6, 2003, the applicant, Corsonnel Corp., filed an application to register the trade-mark THE IP RENEWALS COMPANY based on proposed use in Canada for the following wares:

Business transaction software for product, service and order management, service provisioning, customer relations, billings and accounts receivable, collection and processing of event records, and business intelligence

and for the following services:

Application service provider, namely providing access, hosting, integration, installation, project and customization of business transaction software for product, service and order management, service provisioning, customer relations, billings and accounts receivable, collection and processing of event records, and business intelligence. Licensing of business transaction software for product, service and order management, service provisioning, customer relations, billings and accounts receivable, collection and processing of event records, and business intelligence.

The application was advertised for opposition purposes on July 14, 2004.

The opponent, Ridout & Maybee LLP, filed a statement of opposition on November 24, 2004, a copy of which was forwarded to the applicant on January 4, 2005. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(b) of the Trade-marks Act because it is clearly descriptive of the character of the applied for wares and services. The opponent alleges that the applicant's wares and services all relate to the management of renewals for intellectual property registrations.

The second ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(c) of the Act because it is the name of the proposed service, namely the renewal of intellectual property registrations. The third ground is that the applied for trade-mark is not distinctive of the applicant's wares and services.

The fourth ground of opposition is that the applicant's application does not conform to the requirements of Section 30(a) of the Act because the statements of wares and services do not describe in ordinary commercial terms the specific area of use and function of the applicant's software and related services. The fifth ground is that the applicant's application does not conform to the requirements of Section 30(i) because the applicant could not have been satisfied that it was entitled to use the applied for mark in Canada in view of the allegations in the previous grounds.

The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavit of Janet M. Fuhrer and two affidavits of Khadija Mahmood. As its evidence, the applicant submitted the affidavits of Sharon Gomes and John Philip Koopmann. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

THE OPPONENT'S EVIDENCE

In her affidavit, Ms. Fuhrer identifies herself as a partner with the law firm Ridout &

Maybee LLP which is the opponent in this proceeding. Ms. Fuhrer states that she has practised in the field of intellectual property or IP law for 17 years and that her firm provides various services to its clients to secure, maintain and enforce their IP rights including the renewal of registrations. Ms. Fuhrer states that her firm therefore performs IP renewals for their clients.

The first Mahmood affidavit serves to introduce into evidence a copy of issue eight of a U.K. publication entitled “IP Review” published on behalf of Computer Patent Annuities Limited Partnership. There are numerous references throughout the publication to the acronym IP used as an abbreviation for “intellectual property” as well as references to the word “renewals” and, in at least one instance, the phrase “IP renewals.”

The second Mahmood affidavit evidences the results of Ms. Mahmood’s search of the records of the Trade-marks Office for marks of record which include the abbreviation IP and cover legal or intellectual property services. Ms. Mahmood located five registrations and two pending applications for such marks. She also located one trade-mark which is registered for business services and includes the word RENEWALS.

THE APPLICANT’S EVIDENCE

The Gomes affidavit serves to introduce into evidence an excerpt from “The Canadian Dictionary of Abbreviations” showing one entry for the abbreviation IP, namely “intermediate

pressure.”

The Koopman affidavit details the results of Mr. Koopman’s research regarding the meaning of the abbreviation IP. Appended as exhibits to his affidavit are excerpts from various dictionaries and articles showing different meanings for the abbreviation IP including the phrase “intellectual property.” Mr. Koopman also researched the records of the Trade-marks Office regarding applications and registrations that include words or phrases that appear in the applicant’s statements of wares and services such as “transaction software” and “application service provider.”

Mr. Koopman also researched the web site for the Canadian Intellectual Property Office (“CIPO”) and, in particular, practise notices and publications in English relating to “The Wares and Services Manual” of the Trade-marks Office. The most recent version of that manual on CIPO’s web site includes the following guidelines:

If the wares and services do not appear in the Manual and there are no similar descriptions of wares/services in the Manual, research will be conducted by a trade-mark examiner to determine if the wares and services are described as they normally would be in the trade (e.g., does an Internet search reveal numerous uses of the description of wares and services in question?)

Please note that even though research shows that the wares and services in question are in ordinary commercial terms, they must be “specific.” This becomes especially important in cases where a trade term can have two completely meanings depending on the field.....

The following three-part test will be considered in this determination:

1. Are the wares/services sufficiently specific so that it is possible to assess

whether paragraph 12(1)(b) of the Trade-marks Act applies? A mark that clearly describes a character or quality of the wares or services is not registrable.

2. Are the wares/services sufficiently specific so that it is possible to assess confusion? A mark that is confusingly similar to a registered trade-mark or a pending trade-mark is not registrable.

3. Are the wares/services sufficiently specific so as to ensure that the applicant will not have an unreasonably wide ambit of protection? For example, wares described as computer software, without further specification, would give that applicant an unreasonably wide ambit of protection.

If the answer is “yes” to all three of these questions, the Trade-marks Office will accept the statement of wares/services as being sufficiently specific. If the answer to any one of those questions is “no”, the wares/services are considered insufficiently specific and the Trade-marks Office will ask for further specification and, where possible, will provide suggestions.

Exhibit J to the Koopman affidavit comprises photocopies of extracts from the initial prosecution of this application before the Examination Section including an Examiner’s report requiring a disclaimer to the component IP and a response stating that IP in this case stands for “intangible property.”

THE GROUNDS OF OPPOSITION

In accordance with the usual rules of evidence, there is an evidential burden on the opponent to prove the facts inherent in respect of the allegations pertaining to each ground of opposition. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist: see Joseph E. Seagram & Sons v. Seagram Real Estate Ltd. (1984), 3 C.P.R.(3d) 325 at329-30

(T.M.O.B.) and John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 at 297-300 (F.C.T.D.).

As for the first ground of opposition, in view of the decision in Fiesta Barbeques Limited v. General Housewares Corporation (2003), 28 C.P.R.(4th) 254 (F.C.T.D.) which relies on the decision of the Supreme Court of Canada in Lightning Fastener Co. v. Canadian Goodrich Co. [1932] S.C.R. 189, it appears that the material time for assessing a ground based on Section 12(1)(b) of the Act is, and always was, the filing date of the application. Furthermore, the issue under Section 12(1)(b) of the Act is to be determined from the point of view of an everyday user of the wares or services. Finally, the trade-mark in question must not be carefully analyzed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression: see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks (1978), 40 C.P.R.(2d) 25 at 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks (1984), 2 C.P.R.(3d) 183 at 186.

In the present case, the opponent has evidenced that one meaning for the abbreviation IP is “intellectual property.” Ms. Fuhrer states that her law firm has been performing renewals of intellectual property rights for clients for many years. Presumably many other firms have been performing IP renewals as well. Furthermore, the U. K. publication submitted in evidence confirms that the abbreviation IP can mean “intellectual property” and that “IP renewals” is a known expression in the English language, at least within the intellectual

property community. The registrations and applications evidenced by Ms. Mahmood in her second affidavit provide further support for the contention that IP means “intellectual property.” Finally, a number of the exhibits appended to the Koopman affidavit filed by the applicant include the acronym CIPO as the English language abbreviation for the Canadian Intellectual Property Office, the federal government agency which includes the Trade-marks Office.

The applicant contends that there are other meanings for the abbreviation IP. The evidence establishes that there are but none of the other meanings makes sense in the context of the applicant’s trade-mark and its statements of wares and services. As a matter of first impression, a user of those wares and services would assume that the mark THE IP RENEWALS COMPANY means “a company dealing in intellectual property renewals.” The applicant’s admission during the initial prosecution of this application that IP in the context of the present mark means “intangible property” supports such a conclusion, “intangible property” being a synonym for “intellectual property.”

The applicant contends that it is not apparent from the statements of wares and services that the phrase IP RENEWALS would mean “intellectual property renewals.” However, those statements are so vague and general as to be applicable to virtually any business. Thus, they would encompass a business engaged in the renewal of intellectual property rights or the provision or licensing of software to perform such a function. Since the applicant has the same

address as the intellectual property firm acting as its trade-mark agent in this proceeding, this suggests that this is likely the very business which the applicant intends to carry on. If not, it would have been a simple matter for the applicant to evidence otherwise and to restrict its statements of wares and services to exclude intellectual property renewals.

In view of the above, I find that the applicant's statements of wares and services cover intellectual property renewals. On the balance of probabilities and as a matter of first impression, I find that the average user of such wares and services would view the trade-mark THE IP RENEWALS COMPANY as meaning "a company dealing in intellectual property renewals." Since such an expression clearly describes the character of those wares and services, I find that the first ground of opposition is therefore successful.

As for the third ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares and services from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - November 24, 2004): see Re 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) 412 at 424 (F.C.A.).

The third ground essentially turns on the issue of whether or not the applied for mark is clearly descriptive, albeit at a later material time. However, for the most part, my conclusions respecting the first ground are also applicable to the third ground. Therefore, the applicant's proposed mark was not distinctive as of the filing of the opposition and the third ground is also successful.

As for the fourth ground of opposition based on Section 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. (1975), 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." In this regard, reference may also be made to the opposition decision in Pro Image Sportswear, Inc. v. Pro Image, Inc. (1992), 42 C.P.R.(3d) 566 at 573.

In the present case, the opponent contends that the wares and services described as or in terms of "business transaction software" are too broad, too vague and unspecific and therefore not in ordinary commercial terms. I agree. Although the applicant has provided some additional wording in its statements of wares and services to describe the type of software it intends to provide, it is not apparent from that wording the commercial area of use for which the software is designed. In order for the descriptions to be meaningful, it is necessary to provide more specifics regarding the type of software claimed and/or the particular commercial area of use. Given the present opposition and the opportunity available to the

applicant to amend its statements of wares and services, presumably it did not do so because its area of intended business is the renewal of intellectual property rights, either directly or through licensed software. Thus, the fourth ground of opposition is also successful.

In view of the above, it is unnecessary to consider the remaining two grounds of opposition. However, it is unlikely that either of those two additional grounds would have been successful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT GATINEAU, QUEBEC THIS 30th DAY OF JANUARY, 2007.

**David J. Martin,
Member,
Trade-Marks Opposition Board.**