



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2013 TMOB 53
Date of Decision: 2013-03-28

**IN THE MATTER OF AN OPPOSITION
by Invensys Systems, Inc. to application
No. 1,476,481 for the trade-mark
WONDERSHARE in the name of
Wondershare Software Co., Ltd.**

[1] On April 12, 2010, Wondershare Software Co., Ltd. (the Applicant) filed an application to register the trade-mark WONDERSHARE (the Mark) based on use in Canada since November 30, 2003 in association the following wares and services (the Wares and Services):

WARES:

Computers; computer software for word processing; computer software to automate data warehousing; computer utility file storage programs; computer utility virus protection programs; computer operating programs; computer keyboards; computer monitors; computer mouse; computer printers; computer scanners; blank floppy discs; blank compact discs; electronic books.

SERVICES:

Television broadcasting; news agency services; recording, storage and subsequent transmission of voice and text messages by telephone; cellular telephone services; video-on-demand transmission services; leasing of computers; local and long distance telephone services; providing multiple user access to a computer network; internet service provider (ISP) services. Computer programming; computer software design; computer disaster recovery planning; technical support services in the form of troubleshooting of computer hardware and software problems; computer systems monitoring services; duplication of computer programs; document data transfer and conversion from one media to another.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of September 22, 2010.

[3] On February 22, 2011, Invensys Systems, Inc. (the Opponent) filed a statement of opposition. On February 7, 2012 the Opponent was granted leave to file an amended statement of opposition dated November 7, 2011. The grounds of opposition can be summarized as follows:

- Pursuant to sections 38(2)(b) and 12(1)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the Mark is not registrable as it is confusing with the Opponent's WONDERWARE Marks, namely:
 - WONDERWARE (TMA443,492) registered on June 2, 1995 in association with "computer software for use in manufacturing and process control";
 - WONDERWARE & Design (TMA445,817), shown below, registered on August 4, 1995 in association with "computer software for use in manufacturing and process control"; and



- WONDERWARE INTOUCH (TMA441,497) registered on March 31, 1995 in association with "manufacturing and process control operator-machine interface software and related user manuals sold together as a unit".
- Pursuant to sections 38(2)(c) and 30(b) of the Act, the Application does not comply with the requirements of section 30(b) of the Act as the Mark had not been used in Canada in association with the Wares and Services as of the claimed date of first use in the application, namely November 30, 2003.
- Pursuant to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive of the Wares and Services nor was it adapted or is it adapted to distinguish the Wares and Services from the wares and services of others, including those of the Opponent.

[4] The Applicant served and filed a counter statement in which it denied the Opponent's allegations. In its counter statement the Applicant attempted to adduce evidence. I will not be considering the evidence included in the Applicant's counter statement as it was not adduced through the proper channels.

[5] In support of its opposition, the Opponent filed the affidavits of Nicole L. Linehan, the Assistant General Counsel, Global IP and Authorized Signatory for the Opponent; and Ellen Anastacio, a trade-mark searcher employed by the Opponent's agent, as well as a certified copy of Canadian trade-mark registration No. TMA443,492. The Applicant did not file any evidence.

[6] Only the Opponent filed a written argument. An oral hearing was not conducted.

Onus and Material Dates

[7] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the 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* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[8] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30 - the date of filing the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)].
- sections 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].
- sections 38(2)(c)/16(1) - the claimed date of first use [see section 16(1) of the Act].
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Non-compliance with Section 30 Ground – section 30(b) of the Act

[9] The initial burden on the Opponent is light respecting the issue of non-conformance with section 30(b) of the Act, because the facts regarding the Applicant's first use are particularly within the knowledge of the Applicant [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89].

[10] The Opponent has not filed any evidence in support of this ground of opposition. In its written argument the Opponent appears to submit that the fact that the Applicant did not file any evidence is sufficient to enable the Opponent to meet its evidential burden. To make such a finding I would in effect be drawing an adverse inference from the Applicant's failure to file evidence. I refuse to do so.

[11] Based on the foregoing, I find that the Opponent failed to meet its evidential burden and I dismiss this ground of opposition accordingly.

Non-registrability Ground – section 12(1)(d) of the Act

[12] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing as of the date of the opposition decision. The Registrar has discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I have exercised that discretion and confirm that the registration for the Opponent's WONDERWARE Marks (TMA443,492; TMA445,817 and TMA441,497) all remain valid and therefore the Opponent has satisfied its evidential burden. I must now assess whether the Applicant has met its legal burden.

[13] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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.

[14] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC).]

[15] I will assess the section 12(1)(d) ground of opposition based on confusion between the Mark and the Opponent's trade-mark WONDERWARE of registration No. TMA443,492 as I am of the view that the Opponent's case is strongest with respect to this trade-mark.

[16] If there is no likelihood of confusion between the Mark and registration No. TMA443,492 then there would be no likelihood of confusion with respect to the other registrations. As a result, my determination of a likelihood of confusion as between the Mark and the Opponent's registration No. TMA443,492 will be determinative of the section 12(1)(d) ground of opposition.

[17] In *Masterpiece*, the Supreme Court of Canada discussed the importance of the section 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with section 6 of the Act (see para 49):

...the degree of resemblance, although the last factor listed in section 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar. As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

[18] Under the circumstances of the present case, I consider it appropriate to analyse the degree of resemblance between the Mark and the Opponent's WONDERWARE mark first.

6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[19] The only difference between the Mark and the Opponent's WONDERWARE mark is the first letters of the suffixes for each of the marks (WONDERSSHARE vs. WONDERWARE). As a result, the marks, while not identical, share a great deal of similarity in sound and appearance.

[20] The marks also share similarities in idea suggested by virtue of the inclusion of the word WONDER.

[21] Having found that the Mark and the Opponent's WONDERWARE mark share a significant degree of similarity in appearance and sound and some similarity in ideas suggested, I must now assess the remaining relevant surrounding circumstances in order to determine whether any of these other factors are significant enough to shift the balance of probabilities in favour of the Applicant [see *Masterpiece*, *supra* at para 49].

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[22] Both the Mark and the Opponent’s WONDERWARE mark are made up of the merging of two dictionary words into one. Both marks share the prefix WONDER, with the Mark featuring the suffix SHARE and the Opponent’s mark the suffix WARE. This creates coined words which have no particular meaning in association with the parties’ wares and services. I disagree with the Opponent that the Mark is suggestive of the Wares and Services.

[23] Based on the foregoing, I assess the degree of inherent distinctiveness of the Mark and the Opponent’s WONDERWARE mark as being the same.

[24] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. I will now turn to the extent to which the trade-marks have become known in Canada.

[25] The Applicant has not provided any evidence regarding the extent to which the Mark has become known and thus I can only conclude that it has not become known to any extent.

[26] The Opponent has provided evidence of use and reputation for the WONDERWARE mark. Specifically, in her affidavit Ms. Linehan makes the sworn statement that the Opponent, and its predecessors in title, have used the WONDERWARE mark in Canada since at least as early as March 30, 1990 in association with “computer software for use in manufacturing and process control”. Ms. Linehan establishes the chain of title from the Opponent’s first predecessor in title, Wonderware Software Development Corporation, to the Opponent (paragraph 6, Exhibits A and B). Ms. Linehan explains that the WONDERWARE mark has also been used in Canada by the Opponent’s distributors. Ms. Linehan confirms that any such use is under license from and under the control of the Opponent.

[27] Ms. Linehan provides sales figures and advertising expenditures for the Opponent’s WONDERWARE software. Specifically, she states that from 2001 – 2011 sales exceeded \$30,000,000 and advertising expenditures exceeded \$100,000.

[28] I note that the documentary evidence largely displays the WONDERWARE & Design mark. I am satisfied that use of the design mark constitutes use of the word mark WONDERWARE.

[29] Ms. Linehan provides sample packaging for the Opponent's software which clearly displays the WONDERWARE mark (Exhibit D). Ms. Linehan also provides sample advertisements from 2004 and 2006 displaying the WONDERWARE mark which appeared in the magazine *Advanced Manufacturing*, a publication which she states is distributed across North America (Exhibit E). Ms. Linehan also attaches to her affidavit photographs of promotional items (a pen, a screwdriver and a mug) which bear the WONDERWARE mark and which were distributed in Canada to promote and advertise the Opponent's WONDERWARE software (Exhibit F). Finally, Ms. Linehan attaches to her affidavit a printout from the website www.wonderwarecaneast.ca which displays the WONDERWARE mark and serves to advertise the Opponent's WONDERWARE software (Exhibit G).

[30] Based on a review of the evidence as a whole, I am satisfied that the Opponent has established that its WONDERWARE mark has become known to some extent in Canada.

Section 6(5)(b) – the length of time each has been in use

[31] The Applicant claims use of the Mark since November 30, 2003 in its application. However, no evidence of use has been adduced in support of this claim.

[32] As discussed further above in the analysis of the section 6(5)(a) factor, I am satisfied that the Opponent has evidenced use of the Opponent's trade-mark WONDERWARE in Canada since at least 2001.

Sections 6(5)(c) and (d) – the nature of the wares, services or business and trade

[33] There is a direct overlap between the parties' wares as both include computer software which appears to be used for similar purposes. Specifically, there is direct overlap with respect to the following wares: "computer software for word processing; computer software to automate data warehousing; computer utility file storage programs; computer utility virus protection

programs; computer operating programs” (the Overlapping Wares). The remaining wares are distinct from the Opponent’s computer software.

[34] With respect to the Services, I find that the only area of similarity is with respect to the services “computer software design” with the remaining services being entirely distinct from the Opponent’s computer software.

[35] In the absence of evidence regarding the Applicant’s trade and in light of the overlap in the nature of the parties’ wares, I am prepared to infer that the parties’ channels of trade could also overlap, however, only with respect to the Overlapping Wares.

Conclusion

[36] As discussed above, in *Masterpiece* the Supreme Court of Canada highlighted the importance of the section 6(5)(e) factor in the analysis of the likelihood of confusion. In the present case, I have found significant similarity between the Mark and the Opponent’s WONDERWARE mark. I am of the view that with respect to the Overlapping Wares and the services “computer software design” none of the other factors assist the Applicant in overcoming this significant similarity between the marks in terms of appearance, sound and ideas suggested. As a result, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the marks at issue with respect to the Overlapping Wares and the services “computer software design”.

[37] With respect to the remaining wares and services, I find that the difference in the nature of the parties’ wares and services is sufficient to shift the balance of probabilities in the Applicant’s favour and the ground of opposition is dismissed with respect to the remaining wares and services.

[38] Having regard to the foregoing, the ground of opposition based on section 12(1)(d) of the Act is successful with respect to the Overlapping Wares and the services “computer software design” but dismissed with respect to the remaining wares and services.

Non-entitlement Ground – section 16(1) of the Act

[39] As discussed more fully in the analysis of the section 12(1)(d) ground of opposition, I am satisfied that the Opponent's evidence supports a finding that the Opponent's WONDERWARE mark had been used in Canada as of the material date and had not been abandoned at the date of advertisement thus the Opponent has met its evidential burden. As with the registrability ground of opposition, I am of the view that the Opponent's case is strongest with respect to the trade-mark WONDERWARE and thus the non-entitlement ground of opposition will be assessed on the basis of this mark.

[40] I must now assess whether the Applicant has met its legal burden. Specifically, the onus is on the Applicant to establish on a balance of probabilities that there is no likelihood of confusion between the Mark and the Opponent's WONDERWARE mark.

[41] The difference in material dates is not significant and as a result my findings under the ground of opposition based on section 12(1)(d) of the Act are equally applicable here. As a result, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the marks at issue with respect to the Overlapping Wares and the services "computer software design"; but I am so satisfied with respect to the remaining wares and services. Having regard to the foregoing, I accept the ground of opposition based on section 16(1) of the Act with respect to the Overlapping Wares and the services "computer software design" and reject it with respect to the remaining wares and services.

Non-distinctiveness Ground – section 38(2)(d) of the Act

[42] As with the registrability and non-entitlement grounds of opposition, I am of the view that the Opponent's case is strongest with respect to the trade-mark WONDERWARE and thus the non-distinctiveness ground of opposition will be assessed on the basis of this mark. In order to meet its initial burden with respect to this ground, the Opponent must establish that the Opponent's WONDERWARE mark was known to some extent at least in Canada as of February 22, 2011 [see *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]

and *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)]. As stated in *Bojangles* at para 34:

A mark must be known to some extent at least to negate the established significance of another mark, and its reputation in Canada should be substantial, significant or sufficient.

[43] As discussed more fully in the analysis of the section 12(1)(d) ground of opposition, I am satisfied that the Opponent's evidence supports a finding that the Opponent's WONDERWARE mark had developed a reputation in Canada as of the material date and thus the Opponent has met its evidential burden.

[44] I must now assess whether the Applicant has met its legal burden. Specifically, the onus is on the Applicant to establish on a balance of probabilities that there was no likelihood of confusion between the Mark and the Opponent's WONDERWARE mark as of the material date.

[45] The difference in material dates is not significant and as a result my findings under the ground of opposition based on section 12(1)(d) of the Act are equally applicable here. As a result, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the marks at issue with respect to the Overlapping Wares and the services "computer software design"; but I am so satisfied with respect to the remaining wares and services. Having regard to the foregoing, I accept the ground of opposition based on non-distinctiveness for the Overlapping Wares and the services "computer software design" but reject it for the remaining wares and services.

Disposition

[46] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application for the Mark with respect "computer software for word processing; computer software to automate data warehousing; computer utility file storage programs; computer utility virus protection programs; computer operating programs" and "computer software design" and I reject the opposition with respect to "computers; ...; computer keyboards; computer monitors; computer mouse; computer printers; computer scanners; blank floppy discs; blank compact discs; electronic books" and "television broadcasting; news agency services; recording, storage and subsequent transmission of voice and text messages by telephone; cellular telephone

services; video-on-demand transmission services; leasing of computers; local and long distance telephone services; providing multiple user access to a computer network; internet service provider (ISP) services. Computer programming; ...; computer disaster recovery planning; technical support services in the form of troubleshooting of computer hardware and software problems; computer systems monitoring services; duplication of computer programs; document data transfer and conversion from one media to another” pursuant to section 38(8) of the Act [see *Produits Menagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (FCTD) as authority for a split decision].

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office