

IN THE MATTER OF AN OPPOSITION by Raymond Gorsy to Application
No. 1,012,170 for the trade-mark STARTEAM in the name of Starbase
Corporation

On April 15, 1999, Starbase Corporation (the “Applicant”) filed an application to register the trade-mark STARTEAM (the “Mark”) in association with “computer programs for management of group projects, specifically group workflow management, text coverage analysis, threaded conversations, text retrieval and defect tracking” on the dual basis of use in Canada since at least as early as May 30, 1997 and registration and use in the United States of America.

The application was advertised for opposition purposes in the *Trade-marks Journal* of June 21 2000. Raymond Gorsy (the “Opponent”) filed a statement of opposition on November 21, 2000.

As an introduction to his grounds of opposition, the Opponent alleges ownership of the trade-marks STARCLUB of Application No. 754,630 filed on May 17, 1994, TEAMCLUB of Application No. 756,721 filed on June 15, 1994 and STARTEAM of Application No. 878,219 filed on May 14, 1998, all for proposed use in association with, *inter alia*, “logiciels d’ordinateurs, programmes d’ordinateurs, progiciels et logiciels”.

The Opponent bases his first ground of opposition on Section 38(2)(a) alleging that the application does not conform to the requirements of Section 30 of the *Trade-marks Act* (the “Act”) in that (a) the Applicant’s statement that it intended to use the Mark was false at the time of filing the application and is still false, contrary to the provisions of Section 30(e); and (b) the statement referred to at Section 30(i) regarding the right to use the Mark was false at the time of filing the application and is still false.

The Opponent, relying on Section 38(2)(b), also alleges that the Mark was not registrable at the time of filing the application and is still not registrable pursuant to the provisions of Section 12(1)(d) since it is confusing with his previously identified trade-marks.

The Opponent relies on Section 38(2)(c) to allege that the Applicant at the time of filing the application was not, and is still not, the person entitled to registration of the Mark in that the application does not conform to the requirements of Section 30, contrary to Section 16(3). The Opponent further alleges that the Applicant at the time of filing the application was not, and is still not, the person entitled to registration of the Mark since it was, and still is, confusing with the trade-marks previously filed by the Opponent in association with the aforementioned wares, contrary to Section 16(3)(a), and with the trade-names previously filed by the Opponent for identical wares, contrary to Section 16(3)(c).

Finally, the Opponent relies on Section 38(2)(d) alleging that the Mark is not distinctive and is not adapted to distinguish the Applicant's wares from the Opponent's proposed wares.

The Applicant filed and served a counter statement on February 21, 2001. Both parties filed evidence. Only the Applicant filed a written argument and was represented at the oral hearing.

From the outset, I note that the Applicant submitted that each ground of opposition should be rejected either because it is improperly pleaded or because the Opponent did not discharge his initial burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support the ground of opposition exist. Since the Opponent did not retain the services of registered trade-mark agents to present his case, I presume the Opponent himself drafted the statement of opposition. As M. Herzig, member of this Board, did in *Yves Saint-Laurent International B.V. v. Comité Saint-Laurent des Joailliers Créateurs* (2001), 13 C.P.R. (4th) 435, I approach the instant case being mindful of the following comments of G. W. Partington, former Chairman of this Board, in *Guess?, Inc. v. Roy* (1994), 57 C.P.R. (32) 556 at page 560:

"In view of the legal complexity of opposition proceedings, it is advisable that a party involved in an opposition be represented by a registered trade mark agent. Further, in view of the adversarial nature of such proceedings, the Opposition Board must treat both parties equally, regardless of whether they are represented by a trade mark agent or not. As a result, the board cannot overlook deficiencies in the handling of a case by an unrepresented party as to do so would be to give preferential treatment to one of the parties to the opposition."

Before addressing the grounds of opposition raised, I will review the evidence.

Opponent's evidence

The evidence consists of an affidavit of the Opponent who identifies himself as the owner of Application No. 754,630, No. 756,721 and No. 878,219 referred to in the statement of opposition. He attaches as exhibits copies of these applications and of the application under opposition, all of which were downloaded from the website of the Canadian Intellectual Property Office on September 21, 2001.

The Applicant pointed out, and rightly so, that although the commissioner of oaths indicated the month of September 2001 as the date of execution of the affidavit and of endorsement of the exhibits, the day of the month is not indicated. Generally speaking, when no objection is raised to an affidavit when it is originally filed and served, the Registrar will not allow the opposite party to take advantage of a technical objection, more particularly if the opposition has reached a stage where there is no opportunity to correct the situation. The Applicant elected to forgo cross-examination, which could have clarified this issue. In any event, I see no reason to find that the affidavit is deficient and should be rejected. In the event that I

am wrong in so concluding, I consider appropriate to exercise my discretion to check the Registrar's records with respect to the three applications alleged by the Opponent in the statement of opposition [see *Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.); *Royal Appliance Mfg. Co. v. Iona Appliance Inc.* (1990), 32 C.P.R. (3d) 525 (T.M.O.B)]. I have checked the register and can confirm that the applications were pending in the Opponent's name at the date of the statement of opposition. As an aside, I note that both Application No. 754,630 for STARCLUB and No. 756,721 for TEAMCLUB were abandoned on March 8, 2005, pursuant to Section 40(3) of the Act.

Applicant's evidence

The Applicant's evidence consists of the affidavits of Manon Goudreau and of Doug Norman. The Opponent requested the cross-examination of Mr. Norman but he did not conduct the cross-examination within the initial deadline. Furthermore, this Board refused the Opponent's request for a further extension of time for cross-examining Mr. Norman.

Affidavit of Manon Goudreau

Ms. Goudreau identifies herself as an employee of the "secteur marques" of the Applicant's trade-mark agents. She enters in evidence the results of searches that she conducted, on April 25, 2002, through the database CDName Search of CDNameSearch Corp. for determining the number of active trade-marks, registered or applied for registration, that include either the terms CLUB, TEAM or the prefix STAR in class 9, which includes scientific apparatus and apparatus for recording, transmission or reproduction of sound or images, data processing equipment and computers.

Ms. Goudreau indicates having located 330 trade-marks with respect to the term CLUB, 268 trade-marks with respect to the term TEAM and 394 trade-marks with respect to the term STAR. She provides the listing of these trade-marks (Exhibits MG-3 to MG-5). Ms. Goudreau states having analyzed each of the located trade-marks to retain only those in the field of computer and more particularly, but without any limitation, those associated with computer software. She retained 66 pending or registered trade-marks for the term CLUB, 84 pending or registered trade-marks for the term TEAM and 101 pending or registered trade-marks for the prefix STAR. Complete computerized copies of the trade-marks retained by Ms. Goudreau are attached (Exhibits MG-6 to MG-8). In its written argument, the Applicant noted that 29 of the registered trade-marks involving the term CLUB (Exhibit MG-6), 45 of the registered trade-marks involving the term TEAM (Exhibit MG-7) and 55 of the registered trade-marks involving the prefix STAR (Exhibit MG-8) are associated with computer related services and wares. At the oral hearing, the Applicant noted that 20 of the registrations for trade-marks involving the term TEAM and 24 of the

registrations for trade-marks involving the prefix STAR had been issued prior to the date of first use claimed in the application.

The evidence concerning the state of the register is relevant only to the extent that inferences can be drawn from it concerning the state of the market [*Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.)]. Moreover, inferences concerning the state of the market cannot be drawn from this evidence unless a large number of relevant registrations are found [*Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

Affidavit of Doug Norman

Mr. Norman, who signed his affidavit on May 1, 1992, has been the Chief Financial Officer of the Applicant since 1999.

According to Mr. Norman, the Applicant has been a leading provider of collaboration solutions for e-business application management since 1994. He further states that the Applicant offers a family of user-friendly software products that enable teams of people to collaborate in the development and management of web sites, e-commerce and e-business critical applications. He files extracts from the Applicant's website providing an historic and general information about the Applicant.

Mr. Norman attaches random copies of "purchase orders" placed with the Applicant by various Canadian clients (Exhibit DN-2) stating that they show that the Applicant sold products under the Mark in Canada and that these items have been shipped by the Applicant to Canadian clients since May 30, 1997 in association with "computer programs for management of group projects, specifically group workflow management, text coverage analysis, threaded conversations, text retrieval and defect tracking". I note that Exhibit DN-2 includes 6 invoices issued between April 22, 1997 and February 6, 1998 to businesses located in Canada. The invoices contain product codes followed by descriptions, some of them referring to the Mark. Mr. Norman states that the Mark is affixed directly on the wares sold by the Applicant. Samples of packaging are attached as Exhibit DN-3. He further states that the wares associated with the Mark are advertised through the Applicant's website and he provides an extract of the Applicant's website as Exhibit DN-4. As there is no evidence that the Applicant's website has been accessed by Canadians, I cannot give significant weight to advertising on the Applicant's website.

Finally, Mr. Norman states that the products associated with the Mark are well known and deployed through a broad cross-section of industries, including e-commerce, .com, manufacturing, retail, financial,

banking, insurance, high tech, education, telecommunications, entertainment, integrators, consulting organizations, health care, pharmaceuticals, aerospace and government agencies.

I shall now deal with the grounds of opposition.

Section 30

The material date for considering the circumstances with respect to the grounds of opposition based upon non-compliance with Section 30 is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)]. While the legal burden is on the Applicant to show that its application complies with Section 30, there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the Section 30 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 Limited v. Seagram Real Estate Ltd.* (1984) 3 C.P.R. (3d) 325 (T.M.O.B.); *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R. (3d) 293 (F.C.T.D.)].

The application has been filed on the basis of use of the Mark in Canada and on the basis of registration and use in the United States. Since Section 30(e) specifically refers to an application based on proposed use, the ground of opposition based upon non-conformity to Section 30(e) has been improperly pleaded and is therefore dismissed.

Insofar as the ground of opposition based upon non-conformity to Section 30(i) is concerned, the Opponent has essentially alleged that the Applicant falsely made the statement that it was entitled to use the Mark. There is no allegation that the Applicant adopted the Mark knowing it to be confusing with the Opponent's alleged trade-marks. Even if I assume that it could be inferred that this is what the Opponent meant to allege, there is no evidence that the Applicant was aware of any trade-marks identified in the statement of opposition. Furthermore, the mere fact that the Applicant may have been aware of any of the Opponent's trade-marks does not preclude it from truthfully making the statement required by Section 30(i) of the Act. I therefore dismiss the ground of opposition based on non-conformity to Section 30(i).

Section 12(1)(d)

Pursuant to Section 12(1)(d) of the Act, a trade-mark is not registrable if it is confusing with a registered trade-mark. The Opponent did not allege any registered trade-marks in support of his ground of opposition nor did he evidence that any of his alleged applications has matured to registration. Accordingly, that ground of opposition has been improperly pleaded and is therefore dismissed.

Non-entitlement

Since the application has been filed on the dual basis of use in Canada and registration and use in the United States, I find that the grounds of opposition based upon Section 16(3)(a) and Section 16(3)(c) have been improperly pleaded as they relate to a proposed use trade-mark. I therefore dismiss both grounds of opposition. For the same reasons, I reject the pleading that the application does not conform to the requirements of Section 30, contrary to Section 16(3). Accordingly, all the grounds of opposition based upon Section 38(2)(c) are dismissed.

For all intents and purposes, I should add that I do not believe that the Opponent's references to Section 16(3)(a) and 16(3)(c) are clerical errors when considering the pleadings of the statement of opposition. In any event, in view of the Opponent's evidence, I would have dismissed a ground of opposition based upon Section 16(1)(a) for failure to discharge his initial onus of evidencing use of his trade-marks at the date of first use claimed in the application. I would also have dismissed a ground of opposition based upon Section 16(1)(c) as in addition to failing to plead specific trade-names, the Opponent failed to evidence use of any trade-names at the claimed date of first use. I would further note that if the Opponent meant to rely on his three trade-mark applications pursuant to Section 16(1)(b), he would have been precluded from alleging Application No. 878,219 since it had not been filed prior to the claimed date of first use, but he could have relied on his Application No. 754,630 and No. 756,721, which had not been abandoned at the date of advertisement. However, extrapolating from the evidence of record and considering the factors set out at Section 6(5), including all surrounding circumstances, I would have been satisfied that the Applicant had discharged its burden of evidencing, on a balance of probabilities, that there were no risk of confusion between the Mark and the trade-marks of Application No. 754,630 and No. 756,721. Finally, even if the Opponent had been able to successfully defeat the Section 16(2) basis, the application could still have proceeded on the Section 16(1) basis for the identical wares.

Distinctiveness

While there is a legal onus is on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its wares 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.)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness. The material date for considering the issue of distinctiveness of the Mark is generally accepted to be the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

It should be noted that the Opponent did not refer to any trade-marks or trade-names nor did he specify any wares. After having considered the evidence and the statement of opposition, I find that the ground of opposition has been insufficiently pleaded and should be dismissed. Even if one argues that it could be inferred that the Opponent's wares consist of computer software and computer programs associated with the trade-marks identified in the statement of opposition, I would find that the Opponent did not discharge his initial evidential burden to show that his trade-marks had acquired some distinctiveness that would render the Mark non-distinctive. The last ground of opposition is therefore dismissed.

Conclusion

Accordingly, and with the authority delegated to me under Section 63(3) of the Act, I reject the Opponent's opposition pursuant to Section 38(2) of the Act.

DATED AT BOUCHERVILLE, QUEBEC, THIS 11th DAY OF JULY 2005.

Céline Tremblay
Member
Trade-marks Opposition Board