

**IN THE MATTER OF AN OPPOSITION
by Fisher Controls International, Inc. to
application No. 825,810 for the trade-mark
FIELDVIEW filed by Merak Products Ltd.**

On October 15, 1996, the applicant, Merak Products Ltd., filed an application to register the trade-mark FIELDVIEW based on proposed use in Canada for the following wares:

software application and data acquisition and integration software in the natural resources industry and manuals in respect thereof.

The application was advertised for opposition purposes on October 29, 1997.

The opponent, Fisher Controls International, Inc., filed a statement of opposition on September 11, 1998, a copy of which was forwarded to the applicant on September 24, 1998. On September 29, 1998, the opponent sought leave to amend its statement of opposition to correct a typographical error. Apparently that request was overlooked. Consequently, at the oral hearing conducted for this case, I granted leave to the opponent pursuant to Rule 40 of the Trade-marks Regulations to amend its statement of opposition.

The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the opponent's trade-mark FIELDVUE registered under No. 430,462 for the following wares:

Automatic process control systems, including: control valves; actuators; digital valve controllers, positioners, transmitters, and transducers: and operator software.

The second ground of opposition is that the applicant is not the person entitled to

registration pursuant to Section 16(3) of the Act because, as of the applicant's filing date, the applied for mark was confusing with the trade-mark FIELDVUE previously used and made known in Canada by the opponent. The third ground is that the applied for trade-mark is not distinctive of the applicant's wares because it is confusing with the opponent's trade-mark.

The fourth ground of opposition is that the applicant's application does not conform to the requirements of Section 30(i) of the Trade-marks Act. The opponent has alleged that the applicant could not have been satisfied that it was the person entitled to use the applied for trade-mark in Canada because it was aware of the opponent's trade-mark FIELDVUE.

As its evidence, the opponent submitted the affidavits of John Evens and Michael Rauber. As its evidence, the applicant submitted the affidavits of Rick Charland, Richard Matte, Robert W. White and Glen Pezzani. Both parties filed a written argument. Subsequent to the exchange of the written arguments, the opponent was granted leave to file and serve a certified copy of its registration No. 430,462 as additional evidence in this proceeding. An oral hearing was conducted at which both parties were represented.

The Opponent's Evidence

In his affidavit, Mr. Rauber identifies himself as the FIELDVUE Product Manager of the opponent. Mr. Evens identifies himself as an employee with Spartan Controls, Ltd. which he states is the Canadian sales representative for the opponent's products including its FIELDVUE products for the Alberta territory.

The opponent's FIELDVUE product is a valve controller used in plants such as oil and gas refineries and pulp and paper mills to remotely control a valve's position, characteristics and performance when controlling the flow of a particular liquid (e.g. - oil, gas, water). The product is used in conjunction with the opponent's diagnostic operator software which is also identified by the trade-mark VALVELINK.

According to Mr. Rauber, Canadian sales of the FIELDVUE instrumentation and the related computer software totalled almost \$10 million (US) for the period 1994-1999. Mr. Rauber also attests to promotional expenditures in Canada for that same period which were almost \$300,000 (US). He lists various trade shows at which his company's product was displayed. Mr. Rauber also provides Canadian circulation figures for publications that carried FIELDVUE advertisements. However, since he acquired those figures from a third party identified as SRDS, they are hearsay and inadmissible in this proceeding.

Mr. Evens states that his company has sold FIELDVUE products in Alberta since 1994. Canadian customers of such products include petroleum companies such as Amoco, Petro Canada, Mobil, Suncor, Imperial Oil and Gulf Canada.

The Applicant's Evidence

In his affidavit, Mr. Pezzani identifies himself as a former employee of the applicant where he was the senior software developer for the FIELDVUE software. Mr. Pezzani states that the applicant develops and markets software for the energy market and that FIELDVUE software simplifies field data collection and analysis for both oil batteries and gas facilities.

Clients of the FIELDVIEW software include Gulf Canada, Suncor, Husky Oil, Dominion Energy and Talisman Energy. The applicant's revenues from its FIELDVIEW product for the period 1998-2000 were in excess of \$3.7 million. Advertising expenditures for the period 1996-2000 totalled more than \$300,000.

Mr. Pezzani describes the applicant's promotional activities at different trade shows. He also details various advertisements and articles that appeared in various publications. The White, Matte and Charland affidavits evidence the Canadian circulation figures for those various publications.

The Grounds of Opposition

As for the first ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Furthermore, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

As for Section 6(5)(a) of the Act, both marks are inherently distinctive. However, both marks are at least somewhat suggestive of devices and computer software that can give users a "field view" of a plant or oilfield operation. Thus, neither mark is inherently strong. Given

the sales and advertising attested to by Mr. Rauber, I am able to conclude that the opponent's trade-mark FIELDVUE has become known to some extent in Canada within the industries that have plants that use fluid control valves such as the pulp and paper industry, the chemical industry and the oil and gas industry. In view of the sales and advertising of the applicant's product, I am able to conclude that it has become known to some extent in Canada, particularly within the oil and gas industry in Alberta.

The length of time the marks have been in use favors the opponent in the present case. As for the wares and trades of the parties, it is the applicant's statement of wares and the opponent's statement of wares in registration No. 430,462 that govern: see Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.), Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and Miss Universe, Inc. v. Dale Bohna (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see the decision in McDonald's Corporation v. Coffee Hut Stores Ltd. (1996), 68 C.P.R.(3d) 168 at 169 (F.C.A.).

The opponent's FIELDVUE product is used in plants such as oil and gas refineries to remotely monitor control valves. The evidence indicates that the applicant's FIELDVIEW product is used to monitor, collect and assess data from remote well sites in oil and gas fields. The evidence establishes that both parties have a number of common customers who are in the oil and gas industry. Thus, the trades of the parties overlap.

The applicant submits that the trades of the parties are disparate since it sells to what it describes as the “upstream” component of the oil and gas industry - i.e. - the component that deals with the exploration, drilling and production of oil and gas. The applicant submits that the opponent sells to the “downstream” component of the industry - i.e. - the component that deals with the refining, marketing and retailing of oil and gas. The applicant contends that these two components are distinct and do not overlap or interact. However, the applicant failed to file evidence on point.

Even if the applicant had evidenced disparate components of the oil and gas industry and their lack of overlap or interconnection, that would not have assisted the applicant greatly in this case. Although the evidence indicates that the applicant’s FIELDVIEW software is used specifically for oil batteries and gas fields, the applicant’s statement of wares contains no such restriction. It covers software applications for “the natural resources industry” which not only covers all aspects of the oil and gas industry but also includes the other customer bases exploited by the opponent such as the pulp and paper industry and the chemical industry. Unlike the opponent’s registered statement of wares in Coffee Hut *supra*, there is no ambiguity or inconsistency in the present applicant’s broad statement of wares necessitating or suggesting a restrictive reading. Thus, I must find that the wares as claimed overlap.

The applicant contends that the wares are distinguishable on the basis that the opponent’s software is sold under the trade-mark VALVELINK. However, the software is marketed and sold in conjunction with the valve controls and the FIELDVUE trade-mark is

prominently featured in all, or most, of these activities. Thus, customers would associate the opponent's trade-mark FIELDVUE not only with the valve controls but also with the related software.

As for Section 6(5)(e) of the Act, the marks at issue are phonetically identical and suggest the same idea. Visually, the marks are very similar. Thus, there is a very high degree of resemblance between the two marks.

The applicant submitted that the absence of evidence of actual mistake or confusion between the marks at issue supports a finding of no confusion. However, given that only a portion of the opponent's sales took place in the oil and gas industry and given that the applicant has only shown a relatively brief period of use of its mark, the absence of actual confusion is not a significant factor in this case. That is particularly so when one considers that the applicant's statement of wares is far broader than the scope of its actual use to date.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the high degree of resemblance between the marks at issue and the similarities in the wares and trades as claimed, I find that the applicant has failed to satisfy the onus on it to show that there is no reasonable likelihood of confusion between its mark FIELDVIEW and the opponent's registered mark FIELDVUE. Thus, the first ground of opposition is successful.

As for the second ground of opposition, the opponent has evidenced use of its trade-

mark FIELDVIEW prior to the applicant's filing date and non-abandonment of that mark as of the applicant's advertisement date. The second ground therefore remains to be decided on the issue of confusion between the marks of the parties as of the applicant's filing date. The onus or legal burden is on the applicant to show no reasonable likelihood of confusion. As before, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

My conclusions respecting the first ground of opposition are, for the most part, also applicable to the second ground. The only difference of note is that, as of the applicant's filing date, the opponent's mark had only acquired a limited reputation and the applicant's mark had not become known at all. In view of the similarities between the wares, trades and marks of the parties, I find that the applicant has failed to satisfy the onus on it to show that its mark FIELDVIEW is not confusing with the opponent's previously used mark FIELDVUE. Thus, the second ground is also 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 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. - September 11, 1998): 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.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

The third ground essentially turns on the issue of confusion between the marks of the parties. My conclusions respecting the first ground are generally applicable to this ground as well. Thus, I find that the applicant's mark FIELDVIEW is confusing with the opponent's mark FIELDVUE as of the filing of the present opposition. The third ground is therefore also successful.

As for the fourth ground of opposition, it does not raise a proper ground of opposition. The fact that the applicant may have been aware of the opponent's trade-mark as of the filing of the present application is not, by itself, sufficient to support a ground of non-conformance with the provisions of Section 30(i) of the Act. Thus, the fourth ground is unsuccessful.

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 12th DAY OF NOVEMBER, 2003.

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