

IN THE MATTER OF AN OPPOSITION by BFE, Inc. to application
No. 558,690 for the trade-mark SOUNDTECH filed by Broadcast
Designs Limited

On March 7, 1986, Broadcast Designs Limited filed an application to register the trade-mark SOUNDTECH based upon proposed use and use and registration in England of the trade-mark in association with:

"Electrical and electronic apparatus and instruments, all for recording, reproducing, receiving, amplifying, transmitting, measuring, modifying, processing or mixing audio signals and acoustic vibrations; soundproofing and equipment for controlling acoustic reverberations; parts and fittings included in Class 9 for all the aforesaid goods".

The applicant also claimed and was accorded a priority filing date of September 9, 1985 based on its trade-mark application filed in Great Britain.

During the examination of its application, the applicant submitted an amended application in which its claim to registration of the trade-mark SOUNDTECH was based solely on proposed use of the trade-mark in Canada. Further, the applicant amended its statement of wares to cover the following:

"Equipment for use in professional audio recording studios and broadcast facilities, namely: mixing consoles, amplifiers, talk-back systems, sound processors, sound controllers, sound measuring equipment, and acoustic (sic.) sound proofing (sic.)".

For some unexplained reason, the paragraph of the applicant's amended application which relates to the applicant's priority claim appears to have been deleted as it is marked with a diagonal pencil line. Further, there is no indication that the applicant ever advised the Trade-marks Office that it was withdrawing its priority claim. It might well be that the applicant's trade-mark agent deleted the paragraph prior to filing the amended application or otherwise advised the Trade-marks Office by telephone to make the deletion. On the other hand, it might also be that Trade-marks Office unilaterally withdrew the applicant's priority date when the applicant amended its application by deleting its Section 16(2) basis for registration as the letter accompanying the applicant's amended application advised the Registrar as follows:

"You will note that all references to British application bearing no 124 9870 have been deleted, applicant therefore bases its application solely on proposed use in Canada."

If the deletion was made by the examiner based on the removal of the Section 16(2) claim from the application, this would clearly have been an error on the part of the Trade-marks Office and the advertisement of the applicant's application in the Journal without the accompanying priority date

would have been a nullity. Unfortunately, the applicant did not submit a written argument nor did it request an oral hearing where this matter could possibly have been clarified. In any event, I am proceeding on the basis that the deletion of the priority claim was made by the applicant or by the Trade-marks Office based on oral instructions received from the applicant's trade-mark agents. In this regard, I would also note that the applicant's counter statement does include a photocopy of the advertisement of the applicant's trade-mark in the Trade-marks Journal which did not include the applicant's priority claim.

The opponent, BFE, Inc., filed a statement of opposition on January 10, 1989 in which it alleged that the applicant's application is not in compliance with Section 29(i) (now Section 30(i)) of the Trade-marks Act as the applicant could not have been satisfied that it was entitled to use the trade-mark SOUNDTECH in Canada in that it was or should have been aware of the opponent's trade-mark as of the filing date of its application. The second ground of opposition is that the applicant is not the person entitled to registration in that, as of the applicant's filing date, the applicant's trade-mark was confusing with the opponent's trade-mark SOUNDTECH previously used and made known in Canada by the opponent in association with "professional mixing consoles, powered mixers, powered amplifiers, signal processing, and speaker systems". The final ground is that the applicant's trade-mark is not distinctive in that it does not actually distinguish the wares in association with which it is intended to be used by the applicant from the wares of others, including the wares of the opponent offered for sale and sold in association with the opponent's trade-mark SOUNDTECH.

The applicant served and filed a counter statement in which it asserted that its application complies with Section 29 (now Section 30) of the Trade-marks Act, that it is the person entitled to registration and that its trade-mark SOUNDTECH is distinctive of its wares.

The opponent submitted as its evidence the affidavits of Martin Howard Kelman, Ronald Leonard, Brian T. Majeski, George Ullmann and Rudolph Schlacher. Messrs. Ullmann and Schlacher were cross-examined on their affidavits and the transcripts of the cross-examinations and the undertakings furnished by the opponent form part of the record in this opposition. The applicant did not file any evidence in support of its application.

The opponent alone submitted a written argument and neither party requested an oral hearing.

The material date with respect to the Section 30(i) ground of opposition is as of the filing date

of the applicant's application. Further, 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 in respect of the Section 30 ground (see Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd., 3 C.P.R. (3d) 325, at pages 329-330). To meet the evidential burden upon it in relation of a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. None of the opponent's evidence supports its allegation that the applicant was or should have been aware of the opponent's trade-mark. As a result, the opponent has failed to meet the evidential burden upon it in respect of this ground which I have therefore rejected.

The second ground is that the applicant is not the person entitled to registration in view of the opponent's prior use and prior making known of its alleged confusing trade-mark SOUNDTECH in Canada. Under Sections 16(5) and 17(1) of the Trade-marks Act, there is a burden on the opponent to establish its alleged use and making known of its trade-mark SOUNDTECH in Canada prior to the applicant's filing date (March 7, 1986), as well as non-abandonment of the trade-mark in this country as of the date of advertisement of the applicant's application in the Trade-mark Journal (September 14, 1988).

In paragraph 4 of his affidavit, Mr. Schlacher, owner and President of the opponent, states the following:

"In February 1986, a shipment of SOUNDTECH equipment was shipped to B&H. Now produced and shown to me and marked as Exhibit "B" to this my affidavit is a copy of the invoice dated February 5, 1986 sending the SOUNDTECH equipment to B&H. The prices have been blocked out for confidentiality."

According to Mr. Schlacher, the entity identified by him as B&H is Boosey & Hawkes (Canada) Limited, Canadian agents for Washburn International Inc., the latter being related to the opponent through common ownership.

In his affidavit, George Ullmann, President of Boosey & Hawkes (Canada) Limited, states that two representatives of his company attended a trade show in Anaheim, California in January 1986 where his company was first introduced to a line of equipment sold under the trade-mark SOUNDTECH by the opponent. In paragraph 4 of his affidavit, Mr. Ullmann states:

"After the trade show, a shipment of SOUNDTECH equipment was sent to us and this equipment, in turn, was sold to two retail dealers in Ontario and one in Manitoba. Now produced and shown to me and marked as Exhibit "A" to this my affidavit is a copy of an invoice dated February 5, 1986 showing the products shipped to my company. The prices have been blocked out for confidentiality."

The transcripts of the Ullmann and Schlacher cross-examinations reveal that the equipment

shipped by the opponent to B&H in Canada comprised three sets of speakers which were sent as samples for evaluation. Further, the following from the transcript of the Schlacher cross-examination establishes that this transaction was in the normal course of trade:

146. Q. --- in February of 1986, that those products were sent as samples for evaluation.

A. Correct.

147. Q. Is that something which occurs generally in the business, or was that ---

A. I think it's ---

Q. --- an exception?

A. No. This is a fairly common practice in our industry. A customer, in order to gain confidence, and especially in Canada, to get CSA approval, that is a very common thing that a product is dissected and looked at, and a decision on buying the product is made thereafter.

In view of the above, I have concluded that there was a transfer of possession in Canada in the normal course of trade of the opponent's speakers in association with the trade-mark SOUNDTECH in February 1986. Further, the opponent's evidence established that it had not abandoned the trade-mark SOUNDTECH in Canada as of the date of advertisement of the applicant's application. As the opponent has met the onus upon it under Sections 16(5) and 17(1) of the Trade-marks Act, the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between its trade-mark SOUNDTECH as applied to the wares covered in its application and the opponent's trade-mark SOUNDTECH as applied to speakers.

As the trade-marks of the parties are identical and both are applied to audio-related equipment, and bearing in mind that the applicant filed neither evidence nor written argument in support of its application, I have concluded that the applicant has failed to meet the legal burden on it in respect of the issue of confusion. Accordingly, the applicant is not the person entitled to registration of the trade-mark SOUNDTECH.

I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 31st DAY OF March, 1993.

G.W. Partington,
Chairman,
Trade Marks Opposition Board.