



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

Citation: 2015 TMOB 220
Date of Decision: 2015-12-08

IN THE MATTER OF OPPOSITIONS

Harman International Industries, Inc. **Opponent**

and

AASTRA TECHNOLOGIES LIMITED **Applicant**

1,454,279 for HI-Q **Applications**

1,454,280 for HI-Q & Design

[1] AASTRA Technologies Limited (the Applicant) has applied-for registration of the trade-marks Hi-Q and Hi-Q & Design for use in association with goods and services in the field of audio and video conferencing including telephones, videophones, computers, and transmission and reception of voice for audio and video conferencing. The Applicant's applications are based on use of these trade-marks since September 1, 2009.

[2] Harman International Industries, Inc. (the Opponent) alleges that it has used the HIQNET trade-mark and a design version of this trade-mark in association with computer software for remote control of audio products and has sold products featuring HiQnet software in Canada since 2006. The Opponent has primarily opposed these applications on the basis that the Hi-Q

and Hi-Q & Design trade-marks are confusing with its previous use of the HIQNET trade-marks. The Opponent also raises two technical challenges: (i) that the application is not in ordinary commercial terms and (ii) that the HI-Q and HI-Q & Design trade-marks were not used in Canada since September 1, 2009 as alleged in the application.

[3] For the reasons that follow, I find that the oppositions should be rejected.

Application No. 1,454,279

[4] I will first consider the Opponent's opposition to application No. 1,454,279.

Background

[5] On September 24, 2009, the Applicant filed an application for the trade-mark Hi-Q (the Mark) based on its use of the Mark since September 1, 2009 in association with the goods and services, as amended, set out in Schedule A (Goods and Services).

[6] The application was advertised for opposition purposes in the *Trade-marks Journal* of October 20, 2010. The Opponent filed a statement of opposition on June 20, 2011. The grounds of opposition pleaded are as follows:

- (a) The application does not comply with section 30(a) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) in that the goods "and computer software for use therewith" and the services "telecommunications services" are not in ordinary commercial terms.
- (b) The application does not comply with section 30(b) of the Act since the Applicant had not used the Mark in Canada in association with each of the Goods and Services as of the claimed date of first use of September 1, 2009.
- (c) The Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(a) since it was confusing with the trade-marks HIQNET and HIQNET & Design (set out below) which had been previously used in Canada by the Opponent in association with "computer software for controlling one or more audio products, namely, microphones, mixers, amplifiers, signal

processors and loudspeakers that is used for controlling and configuring the audio products in networked system” and these trade-marks had not been abandoned as at the date of the advertisement of the application.



(d) The Mark is not distinctive having regard to section 2 of the Act in that it does not distinguish, nor is it adapted to distinguish the Goods and Services of the Applicant from those of other others including the goods of the Opponent.

[7] The Applicant filed and served a counter statement, in which it denies the Opponent’s allegations.

[8] The Opponent filed as its evidence the affidavit of Curtis Rex Reed. The Applicant filed as its evidence the affidavit of Steven D. Hawkins. Both parties filed a written argument. A hearing was held on October 2, 2015 at which the Applicant was represented.

Onus and Material Dates

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities that its application complies with the requirements of the Act. There is, however, 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 Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

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

- sections 38(2)(a)/30 - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- 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 at 422 (FCA)];
- sections 38(2)(c)/16(1) – the date of first use alleged in the application [section 16(1)], if however, an opponent successfully challenges the date of first use, the material date becomes the filing date of the application [*Everything for a Dollar Store (Canada) Inc v Dollar Plus Bargain Centre Ltd* (1998), 86 CPR (3d) 269 (TMOB)]; and
- 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 at 324 (FC)].

Grounds of Opposition

Section 30(a) Ground of Opposition

[11] The Opponent alleges that the application does not conform to the requirements of section 30(a) of the Act as the application does not contain a statement in ordinary commercial terms. The Opponent's initial evidential burden under section 30(a) is a light one and may be met through argument [*McDonald's Corp v M.A. Comacho-Saldana International Trading Ltd* (1984), 1 CPR (3d) 101 (TMOB) at 104]. The Opponent submits that the description in the goods "... computer software for use therewith" does not make the function of the Applicant's software sufficiently clear. The Opponent further submits that the statement that the telecommunication services are for "electronic transmission and reception of voice for audio and video conferencing" is unduly vague in that it fails to actually describe the services.

[12] While the Opponent's submissions meet its light evidential burden, the Applicant meets its legal burden for the reasons that follow.

[13] There are two issues to be determined under a section 30(a) ground of opposition, first, whether the statement of goods or services is in ordinary commercial

terms and, second, whether it adequately identifies the specific goods and services [Whirlpool SA v Eurotherm Holdings Ltd; 2010 TMOB 171 at para 39].

[14] The Trade-marks Office's *Goods and Services Manual* includes a representative list of acceptable goods and services. The Trade-marks Office's *Examination Manual* at II.5.4 explains:

For goods or services not found in the *Goods and Services Manual* the acceptable listings in the *Goods and Services Manual* can be used to indicate by analogy the kind of statements that would also be acceptable to describe similar goods or services. A statement of goods or services is acceptable if it [is] as specific, or more specific than, a related or similar listing.

Opponent's Objection to "Computer Software for Use Therewith"

[15] With respect to "computer software" the *Examination Manual* at II.5.4.9 notes that the specific function of the computer software must be provided and if the area of use is not obvious, the specific area of use.

[16] In view of this, I find that the Applicant meets its legal onus with respect to its statement of goods since, when the statement of goods is read as a whole, the specific function of the software (video and audio conferencing) and the area of use (for telephones, handsets, speakers ...) is set out. Further, I note that the *Goods and Services Manual* finds the following analogous terms to be acceptable:

- software to control and improve audio equipment and sound quality
- computer software for creating computer games
- computer software for image processing

Opponent's Objection to Telecommunications Services

[17] The *Examination Manual* at II.5.4.14 indicates that if the essential nature of the services involves providing the ability to communicate (ie) transmission services, then an applicant should set out the specific means of communication and the general nature of the data transmitted.

[18] In view of this, I find that the Applicant meets its legal onus with respect to its statement of services since the specific means of communication, for example, telephones, smartphones and computers using wideband audio technology and the nature of the data transmitted, voice for audio and videoconferencing, is provided.

[19] As I have found that the statement of goods and services to be in ordinary commercial terms and to adequately identify the specific goods and services at issue, I reject this ground of opposition.

Section 30(b) Ground of Opposition

[20] The Opponent alleges that the application does not comply with section 30(b) of the Act as the Mark was not being used as of the date claimed in the application. The evidential burden on an opponent respecting the issue of an applicant's non-compliance with this section of the Act is a light one and can be met by reference not only to its evidence, but also to the applicant's evidence [*Labatt Brewing Co Ltd v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230; *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at paras 33-38]. To meet its burden, an opponent must show that an applicant's evidence is clearly inconsistent with the claimed date of first use or raises doubt as to the veracity of the claimed date of first use [*Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply Co* (1999), 2 CPR (4th) 562 (TMOB), at 565 -6, aff'd (2001), 11 CPR (4th) 489 (FCTD); *Corporativo de Marcas, supra*; *Reitmans (Canada) Limited v Atlantic Engraving Ltd*, 2005 CanLII 78234 (TMOB)]. If an opponent meets its evidential burden, an applicant must prove that it has used the Mark as of the date claimed. Further, an applicant ought to be aware that if it is unable to prove a claimed date of first use with documentary evidence, it may be better off claiming a later, provable date, rather than risk having its application refused under section 30(b) [*Guevin v Tall Dark & Handy Handyman Services Ltd* (2011), 97 CPR (4th) 444 at para 19 (TMOB)].

[21] Mr. Hawkins, the Canadian Director of Marketing of the Applicant, states at paragraph 8 of his affidavit that:

The Applicant is the owner of the Applicant's Marks, which are well known. The Applicant's Marks have been used by the Applicant in Canada since at least as early as September, 2009.

At Exhibit F to his affidavit there is an article excerpted from Telecom Reseller which states the following:

- "Aastra has announced the introduction of its Aastra Hi-Q technology, delivering significantly enhanced audio performance..."
- "Aastra's Hi-Q audio incorporates sophisticated audio tuning software ... The software upgrade is available as a free download from Aastra".
- "...Aastra will be demonstrating its Hi-Q audio at ITEXPO in Los Angeles, Sept 1-3, booth 212".

[22] I do not find that the Opponent has met its evidential burden as the Applicant's evidence is not clearly inconsistent with and does not cast doubt on the September 1, 2009 claimed date of first use. Contrary to the Opponent's submissions, I do not find that Exhibit F supports an inference that the goods were launched or introduced in the United States on September 1, 2009 at the ITEXPO show held in Los Angeles. The Telecom Reseller excerpt indicates that the Applicant "has announced the introduction of its ... Hi-Q technology" and that "the software upgrade is available as a free download" which suggests that the goods and services bearing the HI-Q trade-mark were already available and were not being introduced at ITEXPO. While it may have been preferable for the Applicant to provide evidence of use and details pertaining to use of the Mark dating back to September 1, 2009, it was not under any obligation to do so and the fact that it did not does not amount to an inconsistency or otherwise cast doubt on the Applicant's compliance with section 30(b) sufficient to meet the Opponent's burden. As the Opponent has failed to meet its evidential burden, this ground of opposition is rejected.

Section 16(1)(a) Ground of Opposition

[23] With respect to the section 16(1)(a) ground of opposition, the Opponent has an initial evidential burden of establishing that one or both of the trade-marks HIQNET or HIQNET & Design was used prior to the date of first use alleged in the application (September 1, 2009) in association with "computer software for controlling one or more audio products, namely,

microphones, mixers, amplifiers, signal processors and loudspeakers that is used for controlling and configuring the audio products in a networked system” and that these trade-marks were not abandoned at the date of advertisement (October 20, 2010) [section 16(5) of the Act].

[24] The word "use" is a legal term which is specifically defined in the Act and one must look at the evidence filed in order to determine, if in fact, there has been use of a trade-mark in association with goods within the meaning of section 4(1):

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

[25] In *Syntex Inc v Apotex Inc* (1984), 1 CPR (3d) 145 at 151 (FCA), the Federal Court of Appeal held that a mark must come to the attention of a purchaser at the time of transfer in order to satisfy section 4 of the Act:

Use of a trade-mark is deemed to have occurred if at the time property in or possession of the wares is transferred, in the normal course of trade, it is “marked on the wares themselves or on the packages in which they are distributed”. **The mark must thus come to the attention of the transferee in a direct way at the time of transfer which is the critical time.** [emphasis added]

[26] In its written argument and at the hearing, the Applicant submitted that the Opponent has not shown any “use” of its trade-marks prior to September 1, 2009. Mr. Reed, the Business Segment Directory for the Harman Signal Processing Business Unit of the Opponent, states that the Opponent uses the trade-marks HIQNET and HIQNET & Design in Canada in association with computer software for remote control of one or more audio products (Reed affidavit, para 7). For example, through the use of HiQnet protocol and software a user can be responsible for programming individual signal processors, speaker controllers, wireless microphone systems and mixing controls (Reed affidavit, para 7). Mr. Reed further notes that the HiQnet software is not normally sold on its own. It is usually advertised as a feature of hardware products which run on the software (Reed affidavit, para 8). As documentary evidence, Mr. Reed provides the following exhibits:

- Exhibit A – the website for one of the Opponent’s brands, BSS Audio, showing telephone and video conferencing products available in Canada including a link to download updates to HiQnet London Architect for use with these products (Reed affidavit, para 10). While this home page does feature the trade-mark HiQnet London Architect, there is no evidence on which I can make an inference that the trade-mark was displayed in this manner at the material date and, further, that this link was used at the material date for the transfer of computer software.
- Exhibit B – press release specification sheets and marketing materials for BSS Audio products which run on HiQnet software and which include the trade-marks HIQNET and HIQNET Design. While these appear to be from 2009, there is no evidence on which I can draw an inference that any of these materials accompanied the software at the time of transfer as is required by section 4 of the Act.
- Mr. Reed explains that “attached as Exhibit “C” are representative samples of promotional and point of sale materials demonstrating how the HiQnet trade-marks are seen by consumers in Canada, on products, on packaging, in catalogues and online where updates to software can be downloaded (Reed affidavit, para 15). However, Mr. Reed’s evidence is silent as to whether such materials were seen by consumers at the time of transfer at the *material date*.

[27] The ambiguities above do not allow me to determine that the Mark was in use in Canada pursuant to section 4 of the Act at the material date. In this regard, even though the Applicant may have requested cross-examination of Mr. Reed to clear up these ambiguities, it was under no obligation to do so as the Registrar has consistently held that such ambiguities are to be resolved against the party putting forward the evidence in an opposition case [see, for example, *Power Budd, LLP v Beaudry*, 2006 CanLII 80342 (TMOB); *Ben Sherman Group Limited v Knautz*, 2013 TMOB 122 (CanLII); *Hunter Douglas Inc v Blinds To Go Inc*, 2007 CanLII 80854 (TMOB)]. It was the responsibility of the Opponent to file evidence enabling me to conclude that it had *in fact* used the trade-marks HIQNET and HIQNET & Design before September 1, 2009 pursuant to section 4 of the Act. The Opponent failed to do so and has therefore not

discharged its evidential burden in support of this ground of opposition. Accordingly, this ground of opposition is rejected.

Section 2 Ground of Opposition

[28] Regarding the ground of opposition based on lack of distinctiveness pursuant to section 2 of the Act, the Opponent needs to have shown that as of the date of filing the statement of opposition its trade-mark(s) has become known sufficiently to negate the distinctiveness of the applied-for mark [*Bojangles' International, LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FCTD)]. To do so, the Opponent must establish that its trade-mark(s) is either known to some extent in Canada or is well known in a specific area of Canada as of the material date [*Bojangles, supra* at paras 33-34].

[29] Mr. Reed's evidence is insufficient to show that either of the Opponent's trade-marks is sufficiently known to meet its evidential burden as of the material date as of June 20, 2011. Mr. Reed only provides evidence of one Canadian customer who appears to currently use the Opponent's products for audio and video conferencing which include HiQnet software (Reed affidavit, para 12). While Mr. Reed states that the Opponent has been selling products featuring the HiQnet software in Canada since at least as early as 2006 (Reed affidavit, para 9), he does not provide sales information for years after 2008 (Reed affidavit, para 14). Further, while Mr. Reed has provided the home page for the BSS Audio website including a software link featuring the HIQNET trade-mark, marketing materials for BSS Audio products which run on HiQnet Software, and promotional and point of sale materials (including a depiction of packaging), featuring the HIQNET trade-mark or the HIQNET & Design trade-mark (Reed affidavit, paras 10,11 and 15, Exhibits A-C), there is no information which would allow me to find that a sufficient number of Canadians (whether or not these Canadians were purchasers of the Opponent's products including HiQnet software in 2006-2008) had been exposed to the trade-marks HIQNET and HIQNET & Design such that the reputation of one or both of these trade-marks was sufficient to negate the distinctiveness of the Mark. Accordingly, the Opponent has failed to meet its evidential burden and this ground of opposition is rejected.

Application No. 1,454,280 for HI-Q & Design

[30] Application No. 1,454,280 for the trade-mark Hi-Q & Design set out below was also filed on September 24, 2009, and is based on use in Canada since September 1, 2009 in association with the Goods and Services.



[31] The issues, material dates and evidence are entirely analogous to those discussed with respect to application No.1,454,279. Accordingly, I make the same findings with respect to the first application, and the same conclusion follows, namely, each ground of opposition is rejected.

Disposition

[32] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition to both applications.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Hearing Date: 2015-10-02

Appearances

No one appearing

For the Opponent

Ian K. Bies

For the Applicant

Agents of Record

Low Murchison Radnoff LLP

For the Opponent

McCarthy Tétrault LLP

For the Applicant

Schedule A

Goods	Telecommunications hardware and software used for video and audio conferencing, namely, telephones, handsets, speakers, IP phones, SIP phones, videophones, cellular phones, smartphones, computers, call servers, gateways, PBXes, employing wideband audio technology for high quality audio, and computer software for use therewith.
Services	Telecommunication services, namely, electronic transmission and reception of voice for audio and video conferencing via telephones, handsets, speakers, IP phones, SIP phones, videophones, cellular phones, smartphones, computers, call servers, gateways, PBXes using wideband audio technology for high quality audio.