IN THE MATTER OF AN OPPOSITION by International Business Machines Corporation and IBM Canada Limited to application No. 510,306 for the trade-mark FAMILY COMPUTER Design filed by Nintendo Co., Ltd.

On October 4, 1983, the applicant, Nintendo Co., Ltd., filed an application to register the trade-mark FAMILY COMPUTER Design, a representation of which appears below, based upon use and registration of the trade-mark in Japan in association with "toys, dolls and recreation equipment" and based upon proposed use of the trade-mark in Canada in association with:

> "Coin-operated electronic amusement apparatus, coin-operated pinball machines, computer apparatus, program cartridges for computers, program cassettes for computers, electronic amusement apparatus, electronic video games, video displays, pinball machines, games and playthings"

The applicant claimed priority on the basis of its application for registration of the trade-mark FAMILY COMPUTER Design filed in Japan on April 7, 1983. Further, during the prosecution of its application, the applicant disclaimed the right to the exclusive use of the word COMPUTER apart from its trade-mark and amended its application to be based solely upon proposed use of the trade-mark in Canada in association with:

> "Electronic toys; dolls; coin-operated video games; coin-operated pinball machines; computer apparatus, namely; personal computers, home computers, ROM cartridges, cassettes, diskettes, magnetic tapes, input units, keyboards, output units, output displays and printers; program cartridges for computers; program cassettes for computers; electronic amusement apparatus, namely; consoles for home video game systems; electronic video games, video displays and pinball machines"

The opponents, International Business Machines Corporation and IBM Canada Limited, initially requested an extension of time to oppose the applicant's application on September 26, 1984 and subsequently submitted a statement of opposition which was accepted by the Opposition Board on July 31, 1985. In their statement of opposition, the opponents alleged that the applicant's trade-mark is not registrable in view of Sections 12(1)(b) and 12(1)(c) of the Trade-marks Act in that the applicant's trade-mark is composed of a two word phrase, the first word of which clearly describes a characteristic of the wares with which the trade-mark is proposed to be used while the second is the name of the wares. Additionally, the opponents claimed that others in the industry, and in particular the opponents, have used the word FAMILY and the phrases FAMILY COMPUTER and COMPUTER FAMILY in a descriptive and generic sense in association with the sale and leasing of computer products. Finally, the opponents asserted that the applicant's trade-mark is not adapted so as to distinguish the applicant's wares from those of others and particularly from the wares of the opponents which have used the terms FAMILY, FAMILY COMPUTER, COMPUTER FAMILY

and the like in association with the promotion of their own computer hardware and software in Canada from a point in time prior to the applicant's filing date of October 4, 1983.

The applicant served and filed a counterstatement in which it denied the opponents' grounds of opposition.

The opponents filed as their evidence the affidavit of Steve J. Tenai while the applicant elected not to file evidence. The applicant alone submitted a written argument while both parties were represented at an oral hearing.

During the opposition proceeding, the applicant submitted an amended application in which its statement of wares was amended to cover:

> "Electronic toys; dolls; coin-operated video games; pinball machines; and computer apparatus in the manner of electronic amusement apparatus, namely: video games and ROM cartridges, cassettes and diskettes for use therewith, consoles for home video games and video displays"

The first two grounds of opposition are based on Sections 12(1)(b) and (c) of the Trade-marks Act, the opponents alleging that the applicant's trade-mark is clearly descriptive of the character of the applicant's wares and further that the trade-mark FAMILY COMPUTER Design is the name of the applicant's wares. The material date for considering both of these grounds of opposition is as of the filing date of the applicant's application which, in the present case, is the applicant's priority filing date of April 7, 1983. Further, while the legal burden is on the applicant to establish the registrability of its trade-mark, there is an evidentiary burden on the opponents to adduce sufficient evidence which, if believed, would support the truth of the allegations set forth in their statement of opposition. Likewise, while the legal burden is on the applicant, there is an evidentiary burden on the opponents in respect of the non-distinctiveness ground of opposition, the material date in respect of which is the date of the opponents' opposition. It is therefore necessary to consider the opponents' evidence in order to determine whether they have met the evidentiary burden upon them in respect of their grounds of opposition.

I do not consider that the opponents have established that the trade-mark FAMILY COMPUTER Design is the name of any of the wares covered in the applicant's application. Further, the opponents have not filed any evidence relating to the trade-mark FAMILY COMPUTER Design being either clearly descriptive or non-distinctive in relation to "electronic toys; dolls; coin-operated video games; pinball machines". The evidence adduced by the opponents appears to be intended to show that the words "family computer" refer to a computer which is designed or adapted for family

use. In this regard, the exhibits to the Tenai affidavit do include reference to the following: "PCjr, the new family and personal computer from IBM[R],..."; "BANK STREET'S *Family Computer* Book"; "Family Computers Under $200"; "The First family Computer Book"; and "ADDITIONAL INSIGHT INTO "THE FAMILY COMPUTER" CONCEPT". The issue arises, however, as to whether the applicant's wares do in fact comprise computers as these wares were deleted from the applicant's application during the opposition proceeding. At the examination stage, the applicant disclaimed the right to the exclusive use of the word COMPUTER apart from its trade-mark and did not seek to withdraw the disclaimer statement subsequent to its deletion of "personal computers, home computers" from its statement of wares. Further, in its correspondence to the Opposition Board of November 4, 1987, the applicant submitted that "home video games are essentially mini-computers programmed for the purpose of reading video game cartridges, cassettes or diskettes ...". Also, Exhibit "N" to the Tenai affidavit does include an advertisement for an INTELLIVISION "family video entertainment system" in which the following description appears:

> Approachable: Turn Intellivision into a friendly computer. With our computer adapter and keyboard, you learn the basics of computing in an easy, understandable way. They also allow you to program your own video games, and to play a new generation of super arcade quality games.

Having regard to the above, I have concluded that the opponents have established that the term "family computer" is clearly descriptive of the character of personal and home computers, and video systems which are adapted for use as a computer, as well as being non-distinctive in relation to these wares. As a result, the legal burden is on the applicant to establish that its trade-mark FAMILY COMPUTER Design is not clearly descriptive of the wares covered in its application. In this regard, no evidence has been adduced by the applicant and I therefore must conclude that the applicant's video games and ROM cartridges, cassettes and diskettes for use with video games, consoles for home video game systems and video displays might well be for use in association with a video system which can be adapted for use as a computer. Further, there are essentially no design features associated with the applicant's trade-mark apart from the words FAMILY COMPUTER which might otherwise render the applicant's trade-mark registrable. As a result, the applicant has failed to meet the legal burden upon it with respect to the registrability of its trade-mark in relation to these wares. On the other hand, I do not consider that the opponents have met the evidentiary burden upon them in respect of their grounds of opposition relating to the applicant's "electronic toys; dolls; coin-operated video games; pinball machines". In this regard, I would note the finding of the Federal Court, Trial Division in respect of there being authority to render a split decision in Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH, 10 C.P.R. (3d) 492.

In view of the above, I refuse the applicant's application in respect of the wares defined in the applicant's application as "and computer apparatus in the manner of electronic amusement apparatus, namely: video games and ROM cartridges, cassettes and diskettes for use therewith, consoles for home video game systems and video displays" and otherwise reject the opponents' opposition to registration of the applicant's application in view of the provisions of Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 28th DAY OF FEBRUARY 1990.

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