

IN THE MATTER OF AN OPPOSITION
by Hitachi Maxell, Ltd. to appli-
cation No. 531,133 for the trade-
mark XCELL & Design filed by
Saehan Media Corporation

On November 5, 1984, the applicant, Saehan Media Corporation, filed an application to register the trade-mark XCELL & Design (illustrated below) based on use and registration (No. 120,667) in the Republic of Korea for the following wares:

tape recorder, cassette tape, video tape,
sound recording apparatus, electric
phonograph, record player, public address
apparatus, tape recorder, video tape
recorder, original record.

The applicant claimed priority based on its corresponding Korean application and thus the effective filing date of the present application is October 2, 1984 in accordance with the provisions of Section 34 of the Trade-marks Act.

The application was advertised for opposition purposes on May 7, 1986. On October 16, 1989, a revised application was accepted in which the phrase "excluding automotive audio equipment" was added to the end of the statement of wares.

The opponent, Hitachi Maxell, Ltd., filed a statement of opposition on June 9, 1986, a copy of which was forwarded to the applicant on July 24, 1986. A revised statement of opposition effecting a minor clerical correction was filed on December 31, 1986. The grounds of opposition include, among others, that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the following two registered trade-marks of the opponent:

<u>Reg. No.</u>	<u>Trade-mark</u>	<u>Wares</u>
135,204		(1) Dry batteries, battery chargers, sound recording tapes, sound recorders and reproducers. (2) Video recording tapes. (3) Data recording tapes. (4) Magnetic recording discs.
256,144		Magnetic recording media namely tapes, cards, discs, sheets, and wires, all for sound and/or visual recordings, for data memory, or all bearing sound and/or visual and/or data

recordings.

The applicant filed and served a counterstatement. As its evidence, the opponent filed the affidavits of Shirley Jean McDonald and Shelagh Kinney. As its evidence, the applicant filed the affidavit of Kim Brule. As evidence in reply, the opponent filed the affidavit of Hollie Taite and a further affidavit of Shirley Jean McDonald. Both parties filed written arguments and an oral hearing was conducted at which both parties were represented.

As for the opponent's ground of opposition based on Section 12(1)(d) of the Act, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is as of the filing of the opposition. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion. Finally, 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.

The applicant's mark and both of the opponent's registered marks are dominated by coined words and are therefore inherently distinctive. The applicant submitted that the search results evidenced in the Brule affidavit suggest otherwise respecting the opponent's marks. I disagree.

Initially, it should be noted that the results of the Brule search of the trade-marks register must be given diminished weight as Ms. Brule has given no indication as to the parameters of her search and has not provided a copy of the original search results. Furthermore, the Brule search only revealed two registrations owned by one party for MAX-prefixed marks in the same area of commerce as the applicant and the opponent.

The balance of the search results were apparently submitted to establish the commonality of the letters EL as a suffix for trade-marks in the field. I am not sure that the Brule affidavit establishes such a finding but, even if it does, it is of little or no significance in assessing the inherent distinctiveness of the marks at issue. The applicant's position is not far from asserting some significance to the commonality, for example, of a single letter as the last letter in marks registered for a particular class of wares. Such a submission stretches state of the register evidence beyond the point of utility.

The applicant has not filed evidence of any use or advertising of its mark in Canada. I must therefore conclude that it had not become known at all in Canada as of the material time. The opponent has evidenced various advertisements for MAXELL design marks in several periodicals. However, none of the marks advertised are the two registered marks under consideration. Furthermore, there is no evidence pointing to the extent of circulation of the magazines in question in Canada. Finally, the ads all point to entities other than the opponent. Thus, I must also conclude that the opponent's marks had not become known at all in Canada as of the filing of the opposition.

In view of the absence of evidence of use from either party, the length of time the marks have been in use is not a material circumstance in the present case.

There is a significant overlap in the wares of the parties, particularly in respect of the opponent's first registration. Presumably there would also be a significant overlap in the natures of the trades. In fact, there is evidence from both parties confirming such a finding. Both the Brule and the Taite affidavits establish that cassette tapes of different manufacturers are sold proximate one another in tape and record stores. The Taite affidavit goes one step further since she points to two instances where she saw tapes of different manufacturers being sold in the same display bins. Although such evidence is after the material time, it would appear reasonable in this case to presume that it is reflective of the nature of the trade as of that earlier date.

As for Section 6(5) (e) of the Act, I consider there to be a fair degree of visual resemblance between the marks of the parties. This is particularly so with respect to the opponent's mark registered under No. 256,144. Furthermore, to the extent that consumers would perceive the initial design component of the applicant's mark to be the letter M, there is an even greater degree of resemblance.

Likewise, there is a fairly high degree of phonetic resemblance between the marks of the parties. The opponent's marks would be pronounced "maxell" and the applicant's mark would likely be sounded as "excell." Again, to the extent that consumers would perceive the design feature of the applicant's mark to be the letter M, there is an even greater degree of potential phonetic resemblance.

In applying the test for confusion, I have considered that the issue is to be assessed as a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the similarities in 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 is not confusing with either of the opponent's two registered marks. The ground of opposition based on those two registrations is therefore successful and the remaining grounds need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 31st DAY OF May, 1990.

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