IN THE MATTER OF AN OPPOSITION by Hyperion Software Corporation (formerly IMRS Operations Inc.), now Hyperion Software Operations Inc. to application No. 768,020 for the trade-mark ON TRACK: TRACKING STUDENT OUTCOMES & Design filed by North York Board of Education

On November 7, 1994, the applicant, North York Board of Education, filed an application to register the trade-mark ON TRACK: TRACKING STUDENT OUTCOMES & Design, a representation of which appears below, based upon proposed use of the trade-mark in Canada in association with:

> "Computer software and hardware; printed publications, namely user manuals and teachers' manuals; and novelty items, namely mugs, buttons, pens and pencils."

The present application was advertised for opposition purposes in the ***Trade-marks Journal*** of July 5, 1995 and the opponent, Hyperion Software Corporation (formerly IMRS Operations Inc.), filed a statement of opposition on September 5, 1995, a copy of which was forwarded to the applicant on November 3, 1995. The applicant served and filed a counter statement in which it effectively denied the opponent's grounds of opposition. The opponent filed as its evidence a certified copy of registration No. 403,158 for the trade-mark IMRS ON TRACK & Design, a representation of which appears below, covering "computer programs for financial reporting".

The applicant elected not to file any evidence. The opponent alone filed a written argument and neither party requested an oral hearing. Further, during the opposition, the opponent changed its

name to Hyperion Software Operations Inc.

The opponent raised a number of grounds of opposition in its statement of opposition. However, as noted by the opponent in its written argument, the main issue to be decided is the issue of confusion in relation to the Paragraph 12(1)(d) ground of opposition. With respect to the ground of opposition based on Paragraph 12(1)(d) of the ***Trade-marks Act***, the material date is the date of my decision [see ***Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks***, 37 C.P.R. (3d) 413 (F.C.A.)]. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Subsection 6(5) of the ***Trade-marks Act***. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue.

Both the applicant's trade-mark ON TRACK: TRACKING STUDENT OUTCOMES & Design as applied to the wares covered in the present application and the opponent's registered trade-mark IMRS ON TRACK & Design as applied to "computer programs for financial reporting" are inherently distinctive. As neither party submitted evidence relating to their use or to the extent to which their trade-marks have become known, I have concluded that neither of the trade-marks at issue have become known to any extent in Canada. Likewise, the length of time the trade-marks have been in use is not a relevant surrounding circumstance in the present case.

The applicant's computer software and hardware, as well as its user manuals and teachers' manuals, are related to the opponent's computer programs for financial reporting. In this regard, the applicant's wares are not limited in any manner as to the specific application of its software and hardware, or its manuals which could therefore be used in relation to financial reporting. Further, I consider that there could be a potential overlap in the channels of trade associated with the opponent's computer programs and the applicant's computer software and hardware, and its user manuals and teachers' manuals. On the other hand, I do not consider there to be any similarity between the applicant's "novelty items, namely mugs, buttons, pens and pencils" and the opponent's

computer programs. Moreover, I would not expect there to be any potential overlap in the channels of trade associated with these wares.

As for the degree of resemblance between the trade-marks at issue, the applicant's trade-mark ON TRACK: TRACKING STUDENT OUTCOMES & Design and the opponent's registered trade-mark IMRS ON TRACK & Design are somewhat similar in appearance and fairly similar in sounding and in the ideas suggested by them, both marks being dominated by the words ON TRACK.

In view of the above, and bearing in mind that there is no similarity between the applicant's mugs, buttons, pens and pencils and the opponent's computer programs and no overlap in the channels of trade associated with these wares, I have concluded that there would be no reasonable likelihood of confusion between the applicant's trade-mark ON TRACK: TRACKING STUDENT OUTCOMES & Design as applied to "novelty items, namely mugs, buttons, pens and pencils" and the opponent's registered trade-mark covering "computer programs for financial reporting". I have therefore dismissed the Paragraph 12(1)(d) ground of opposition relating to these wares. On the other hand, I have concluded that the applicant has failed to meet the legal burden upon it in respect of the issue of confusion as applied to its software, hardware and manuals. In particular, these wares are related to the opponent's computer programs and there could be a potential overlap in the channels of trade associated with these wares. Further, the applicant's trade-mark ON TRACK: TRACKING STUDENT OUTCOMES & Design and the opponent's registered trade-mark IMRS ON TRACK & Design are fairly similar in sounding and in the ideas suggested by them. Moreover, I am mindful of the fact that the applicant took no active steps in this opposition subsequent to the filing of its counter statement. As a result, I refuse the present application as applied to "Computer software and hardware; printed publications, namely user manuals and teachers' manuals" and otherwise reject the opponent's opposition to registration of the trade-mark ON TRACK: TRACKING STUDENT OUTCOMES & Design as applied to "novelty items, namely mugs, buttons, pens and pencils." In this regard, I would note the decision of the Federal Court, Trial Division in ***Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH***, 10 C.P.R. (3d) 492 in respect of there being authority to render a split decision in a case such as the present.

DATED AT HULL, QUEBEC, THIS DAY 29th OF SEPTEMBER, 1997.

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