

IN THE MATTER OF AN OPPOSITION by KOM Inc. to  
application No. 548,794 for the trade-mark KOM filed by Kom  
International Inc., and presently standing in the name of Levitan, Kohl  
& Associates Limited

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On September 6, 1985, the applicant, Kom International Inc., filed an application to register the trade-mark KOM based upon use of the trade-mark in Canada since at least as early as 1963 by the applicant or its predecessor-in-title, Sydney Kom & Associés Ltée, in association with "logistical engineering services" and since at least as early as 1983 in association with "software".

Subsequent to the filing of its application, the applicant advised the Trade-marks Office that the application ought to have been filed in the name of Levitan, Kohl & Associates Limited which, as of the filing date of the application, was carrying on business under the corporate name Kom International Inc. Having regard to the applicant's submissions and the accompanying affidavit of Susie Lalonde, the identity of the applicant in the present application was amended to Levitan, Kohl & Associates Limited. Further, the applicant amended its application by deleting "software".

The opponent, KOM Inc., filed a statement of opposition, and subsequently an amended statement of opposition, in which it alleged that the applicant's application is not in compliance with Section 29 (Now Section 30) of the Trade-marks Act in that the applicant or its predecessor-in-title has not used the trade-mark KOM in Canada since the date alleged with the services covered in the application and further that the services are not defined in ordinary commercial terms. The opponent also alleged that the applicant's trade-mark is not distinctive in that the applicant or its predecessor has not used the alleged mark in association with the services covered in the application and, if the mark has been used, such use has been "by persons other than the applicant or its predecessor in title outside of the registered user provisions of the Trade Marks Act or indicated to the public someone other than the applicant for registration".

The applicant served and filed a counterstatement in which it asserted that its application complies with Section 29 (now Section 30) and that its trade-mark is distinctive of the wares covered in its application. While the applicant asserts that its trade-mark is distinctive of its wares as opposed to referring to the services covered in its amended application, I consider this to have been merely an oversight on its part and, in any event, the applicant in its counterstatement has generally denied the opponent's grounds of opposition.

The opponent filed as its evidence the affidavit of Marwan Zayed while the applicant filed the affidavit of Gérard Paris.

Both parties filed written arguments and both were represented at an oral hearing.

While the legal burden is upon the applicant to establish that its application is in compliance with Section 30 of the Act, there is an initial evidentiary burden on the opponent in respect of the Section 30 ground, as pointed out by the hearing officer in Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd., 3 C.P.R. (3d) 325, at pp. 329-330, as follows:

Having regard to the above, 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. In the recent decision of the Federal Court, Trial Division in John Labatt Limited v. The Molson Companies Limited, 30 C.P.R. (3d) 293, at pg. 298, Mr. Justice McNair characterised the evidential burden on an opponent as follows:

"The evidential burden is the burden of adducing sufficient evidence to persuade the trier of fact that the alleged facts are true: see Sopinka and Lederman, *The Law of Evidence in Civil Cases* [Butterworths], 6th ed., pp. 107-08; Phipson *On Evidence*, 13th ed., para. 44-03; McCormick *On Evidence* [Hornbook Series, West Publishing Co.], 3rd. ed., pp. 946-48; and Thayer, *Preliminary Treatise On Evidence at the Common Law* (1898), ch. 9."

The amount of evidence necessary to discharge an evidential burden on an opponent will vary depending upon the issue to be decided. It has been pointed out, for example, that the evidential

burden will be less where, in the case of a Section 30(b) ground of opposition, the relevant facts are more readily available to the applicant (see Tune Masters v. Mr. P's Mastertune, 10 C.P.R. (3d) 84, at pg. 89).

With respect to the ground of opposition that the applicant's services are not defined in ordinary commercial terms, contrary to Section 30(a) of the Act, the opponent has relied upon the Zayed affidavit and, in particular, paragraphs 3 to 6 thereof which provide as follows:

3. I have caused enquiries to be made about the type of business conducted by Levitan, Kohl & Associates Limited Inc. since the description "logistical engineering services" is a very broad term and does not specifically define a particular service. The only information I could obtain is that the organization is involved in business consulting.
4. Accompanying the Affidavit and marked Exhibit "A" is an envelope containing photocopies from the Funk & Wagnalls Standard College Dictionary Canadian Edition and from The Houghton Mifflin Canadian Dictionary of the English Language showing definitions of "logistic", "logistical" and "logistics".
5. From looking at the dictionary definitions, logistical engineering services could refer to the procurement, distribution, maintenance and replacement of personnel in various engineering fields. The description is so broad that it could extend to all engineering fields.
6. My enquiries of the applicant disclose that it does not now nor has it in the past performed logistical engineering services extending to all engineering fields. Moreover, my enquiries disclose that the services performed by the applicant's predecessor, Sydney Kom & Associates Ltee, were in the nature of warehouse consulting. I am not able to find any use of the trade mark KOM by the said applicant's predecessor in title even in association with warehouse consulting services and certainly not with logistical engineering services.

From the dictionary definitions adduced by the opponent, the word "logistical" is defined as meaning "of or pertaining to logistics" and "logistics" is defined as "the procurement, distribution, maintenance, and replacement of materiel and personnel". However, logistics does not appear to be a known branch of engineering, such as mechanical, chemical, electrical, industrial or civil engineering, nor does it appear as an area of specialization for engineers, as is apparent from Exhibit "H" to the Zayed affidavit and, in particular, the copies of the Yellow Pages listings for Engineering Services and Engineers. Also, I would not consider either engineering services or logistics services themselves to be statements of "specific" services, as contemplated by s. 30(a) of the Act. Further, the inclusion of the word "logistical" in the description "logistical engineering services" does not appear to clarify the nature of the service being rendered by the applicant, be it an engineering service or some kind of service associated with logistics. In any event, the opponent has in my view met the evidentiary burden upon it in respect of the s. 30(a) ground of opposition. Accordingly, the legal burden is upon the applicant to establish that its application is in compliance with s. 30(a) of the Act.

The applicant has relied upon the Paris affidavit of which paragraph 3 and the first sentence of paragraph 4 appear to address the s. 30(a) ground of opposition. In these paragraphs, the affiant states the following:

3. Je suis ingénieur et ma compagnie emploie des ingénieurs pour rendre ses services de logistique. Nous offrons des services de logistique dans le sens non-militaire du terme. Une copie des pages 1011 et 1012 du Larousse de la Langue Française Lexis, Édition 1977, sont jointes à la présente pour en faire partie comme Annexe "A". Les clients retenant les services de logistique offerts par notre compagnie oeuvrent dans une multitude de secteurs dans lesquels la distribution et/ou entreposage de marchandises sont une composante des activités de telle sorte qu'il n'est ni possible ni souhaitable de restreindre les clients de ma compagnie à des domaines spécifiques.
4. Une copie d'un dépliant promotionnel utilisé pour expliquer les services de logistique rendus par ma compagnie est jointe à la présente comme Annexe "B".

The applicant's evidence establishes that it intentionally adopted the broad description "logistical engineering services" for its statement of services in its application in order to cover the varied types of services rendered by the applicant for its clients. However, while the applicant is free to identify broadly the general classes of service associated with its trade-mark, to meet the requirements of s. 30(a) of the Trade-marks Act, the applicant must also identify the specific services falling within each of the general classes. In the present case, the applicant's evidence fails to establish that the description "logistical engineering services" is known in the trade or would be recognized by potential customers as identifying either a specific service or even a general class of services. Accordingly, the applicant has failed to meet the legal burden upon it and I have therefore concluded that the applicant's application is contrary to s. 30(a) of the Trade-marks Act. As a result, I have not considered the opponent's remaining grounds of opposition.

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

DATED AT HULL, QUEBEC THIS 31<sup>st</sup> DAY OF JANUARY 1990.

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