

**IN THE MATTER OF AN OPPOSITION
by Maratek Incorporated to application No.
698,720 for the trade-mark INFORMATION
WAREHOUSE filed by International
Business Machines Incorporated**

On February 11, 1992, the applicant, International Business Machines Incorporated, filed an application based on proposed use in Canada to register the trade-mark INFORMATION WAREHOUSE for “computer software for databases, publications, namely user guides and technical manuals for use therewith.” The application was amended to include a disclaimer to the word INFORMATION and was subsequently advertised for opposition purposes on November 25, 1992.

The opponent, Maratek Incorporated, filed a statement of opposition on April 23, 1993, a copy of which was forwarded to the applicant on June 15, 1993. The first ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3)(a) of the Trade-marks Act because, as of the applicant’s filing date, the applied for trade-mark was confusing with the trade-mark INFORMATION WAREHOUSE previously used or made known in Canada since March, 1990 with “computer software” by the opponent “and/or its predecessors in title.” The second ground is that the applicant’s application does not comply with the provisions of Section 30(i) of the Act because the applicant could not have been satisfied that it was entitled to use its applied for mark. The third ground is that the applied for mark does not distinguish the wares of the applicant from those of the opponent used in association with its trade-mark INFORMATION WAREHOUSE.

The applicant filed and served a counter statement. As its evidence, the opponent filed an affidavit of its President, Rainer Kossman. The applicant did not file evidence. Both parties filed a written argument and no oral hearing was conducted.

As for the first ground of opposition, the opponent did not identify its predecessors in title and, to that extent, the ground is not in compliance with Section 38(3)(a) of the Act and is unsuccessful. As for the remaining aspects of the first ground, there was an initial burden on the opponent to evidence use or making known of its mark prior to the applicant’s filing

date. Mr. Kossman states in paragraph 10 of his affidavit that he formed the opponent company between February 4, 1992 and April 4, 1992. In the absence of further particulars, I must conclude that the date of incorporation of the opponent was on or about April 4, 1992. Thus, the opponent was not in existence as of the applicant's filing date and therefore could not have used or made known the trade-mark INFORMATION WAREHOUSE prior to the applicant's filing date of February 11, 1992. Thus, the remaining aspects of the first ground are also unsuccessful.

Although it is not entirely clear from Mr. Kossman's affidavit, it would appear that he claims to be one of the unidentified predecessors in title respecting the opponent's mark INFORMATION WAREHOUSE. However, even if he is a predecessor in title and was properly identified as such in the statement of opposition, the first ground would still have been unsuccessful. Prior to February 4, 1992, Mr. Kossman was an employee of Atomic Energy Canada Limited ("AECL") and he developed an in-house computer program which he called the Information Warehouse program. Mr. Kossman referred to this program in papers he presented before three technical conferences between 1989 and 1991. However, there is no evidence that Mr. Kossman or AECL used the words INFORMATION WAREHOUSE as a trade-mark at any time.

As for prior making known of the opponent's trade-mark, Section 5 of the Act requires that there be use of the mark in a country of the Union other than Canada. The opponent has failed to show any such use of its trade-mark by a predecessor in title. In any event, the opponent has failed to evidence any Section 5 activities by a predecessor in title that would have resulted in the trade-mark INFORMATION WAREHOUSE having become well known as of the applicant's filing date. Thus, the opponent has failed to show use or making known of its mark by a predecessor in title prior to the applicant's filing date and thus the first ground of opposition would have been unsuccessful, in any event.

The second ground of opposition does not comply with the provisions of Section 38(3)(a) of the Act and is therefore unsuccessful. The opponent failed to set forth any allegations of

fact to support its ground that the applicant's application did not comply with Section 30(i) of the Act. In its written argument, the opponent submitted that the applicant's application did not comply with Section 30(i) because there were employees of the applicant present at one or more of the conferences at which Mr. Kossman presented papers. However, no such allegations were included in the opponent's second ground of opposition. Even if they had been, it is not clear that the applicant was aware of Mr. Kossman's use of the term Information Warehouse when the applicant adopted its mark. Even if it had been aware of his use of the term, that would not necessarily have precluded it from adopting it as a trade-mark since neither Mr. Kossman nor AECL had used the term as a trade-mark. Thus, even if properly pleaded, the second ground would have been unsuccessful.

As for the third ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its services from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - April 23, 1993): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Finally, there is an evidential burden on the opponent to prove the allegations of fact supporting its ground of non-distinctiveness.

The short answer to the third ground is that the opponent has evidenced no use of its trade-mark INFORMATION WAREHOUSE in association with wares. Mr. Kossman states, in his affidavit, that the opponent has continued to develop its software product but there is no evidence of any sales of that product. Thus, the third ground as pleaded is unsuccessful.

There was some minor use of the words "information warehouse" by the opponent's possible predecessor in title, Rainer Kossman, when he presented papers at two conferences in Ottawa in 1990 and 1991. However, the opponent did not rely on such activities in its statement of opposition. Even if it had, however, those activities were of such a minor nature

that they would not have had any effect on the distinctiveness of the applicant's mark as of the filing of the present opposition. Thus, the third ground would have been unsuccessful, in any event.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 12th DAY OF NOVEMBER, 1996.

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