

**IN THE MATTER OF AN OPPOSITION by
Myriad Innovative Designs Inc., trading as Mind Computer Products to
application No. 819,532 for the trade-mark MINDTECH filed by
Hasnain Akbar**

On July 31, 1996, the applicant, Hasnain Akbar, filed an application to register the trade-mark MINDTECH based upon proposed use of the trade-mark in Canada in association with educational software, manuals, books, catalogues, magazines, newsletters, educational toys and games, creative toys and games, models, computer games; stationery namely writing paper, envelopes, pencils, pens; mugs, glasses, cups, carrying cases, totebags, knapsacks, bags; men's, women's and children's clothing namely, T-shirts, shirts, pullovers, tops, sweatshirts, sweatpants, shorts; developing, designing, marketing and distribution of educational software, manuals, books, toys and games; tutoring children and adults on academic and personal development topics; counselling services relating to the education of children and adults; establishing training facilities for educating children and adults and operating a franchise operation in respect thereof.

The application was advertised for opposition purposes on February 19, 1997. The opponent, Myriad Innovative Designs Inc., trading as Mind Computer Products, filed a statement of opposition on April 18, 1997. The applicant filed and served a counter statement.

On May 10, 1999, the Registrar recorded Mindtech Schools Inc. as the owner of application No. 819,532, pursuant to an assignment dated June 15, 1997.

The opponent is the owner of registrations Nos. 376,741 and 380,291 for the trade-marks MIND and MIND COMPUTER PRODUCTS. The wares and services covered by those registrations as of the filing of the statement of opposition were:

accelerator cards; anti-glare screens; anti-static mats; anti-static pads for computers; anti-static sprays; bar code readers; buffers; cables; CD ROM readers; communication cards; computers; computer backplanes; computer books; computer furniture; computer key

boards; computer magazines; computer mother boards; computer mice; computer software; computer tape drives; crystals; digitizers; diskette cases; dust covers; electronic switches; emulation cards; floppy controller cards; floppy disk drives; floppy diskettes; font cartridges for printers; game ports; hard disk drive controller cards; hard disk drives; ink cartridges; interfaces; intergrated circuits; joy sticks for computers; laser printers; disk cleaning kits; monitor cleaning kits; magnetic computer tape; magnetic tape cartridges; memory cards; modems; monitors; mouse pads; multifunction cards; network cards; letter sized bond paper; continous sheet perforated edge tractor feed paper; paper trays for computers; parallel port cards; parallel serial converters; plotters; plotter accessories; power bars; power supplies; printer accessories; printer cut sheet feeders; printer mufflers; printer ribbons; printer tractor feeds; printers; ram intergrated circuits; scanners; serial port cards; signal amplifiers; signal splitters; monitor stands; systems stands; surge protectors; switch box manuals; tape controller cards; terminals; toner cartridges; uninterruptable power supplies; valet arms; video cards; worm drives; operation of a wholesale and retail business selling computer hardware, computer software and computer furniture; repairing computers; design of custom computer hardware; design of custom computer circuit boards; design of custom computer software; installation of custom designed computer software; training customers in the use of selected software packages.

Applications to extend the wares in registrations Nos. 376,741 and 380,291 were filed on March 18, 1997 pursuant to which both registrations were amended to include the following wares on April 18,

2000:

CD Rom drives for personal computers; multi media Kits for personal computers, consisting of CD Rom drives, sound cards, speakers, software, namely: off the shelf software of all kinds that is written for the general public, including: accounting software, data base programs software, dictionary software, drawing software, educational software, encyclopedia software, games software, home office applications software, integrated suites software, language translation software, operating systems software, small business applications software, spreadsheet software, thesaurus software, utilities software, word processing software; and computer mouse pads.

Sound cards for personal computers.

Notebook computers.

Original equipment manufacturer's (aka OEM) software bundles for personal computers, consisting of two or more software titles on a CD, namely: off the shelf software of all kinds that is written for the general public, including: accounting software, data base programs software, dictionary software, drawing software, educational software, encyclopedia software, games software, home office applications software, integrated suites software, language translation software, operating systems software, small business applications software, spreadsheet software, thesaurus software, utilities software, word processing software; and computer cases.

Basic input output systems (aka Bios) for computers.

Digital video disc (aka DVD) type CD Rom drives.

The opponent filed as its evidence the affidavits of Brad Fry, Brad Enns, Robert Holmes, Alan Castell, and Arona F. B. Olfman, and certified copies of the following: Canadian trade-mark registrations Nos. 376,741 and 380,291; two revised applications to extend the statement of wares in such registrations; and Canadian trade-mark applications Nos. 839,773 and 839,774. As its evidence, the applicant filed the affidavits of Hasnain Akbar, Joel Alan Guralnick and Joanne Koren Smartt. No cross-examinations were conducted. Both parties filed a written argument. An oral hearing was held at which only the applicant was represented.

As a preliminary matter, the opponent argued that the application should be refused because in its counter statement the applicant did not deny the allegations in the statement of opposition. Instead, the applicant stated that it did not admit any of the allegations in the statement of opposition. In addition, the applicant pleaded that its application is in compliance with Section 30, its trade-mark is registrable, it is the person entitled to registration, its trade-mark is distinctive, its application does not offend Sections 2, 6, 7, 12, or 16 and that the allegations of fact set out in its application are true. I think the applicant has made it amply clear that it is contesting everything set out in the statement of opposition.

The opponent has pleaded numerous grounds of opposition. I shall begin by considering the following grounds:

pursuant to Paragraph 12(1)(d) of the *Trade-marks Act*, the mark is not registrable because the applied for mark is confusing with either or both of the marks MIND and MIND COMPUTER PRODUCTS, which are the subject of registrations Nos. 376,741 and 380,291;

pursuant to Paragraph 16(3)(a) of the *Trade-marks Act*, the applicant is not the person entitled to register the mark because at the date of filing of the application, the applied for mark was confusing with the marks MIND and MIND COMPUTER PRODUCTS, previously used by the opponent on coasters, clocks, clothing, cups/coffee mugs, flashlights, key chains, lapel pins, note pads, watches and those items covered by registrations Nos. 376,741 and 380,291;

the applied for mark is not distinctive for the reasons set out above.

Each of these three grounds of opposition is based on the likelihood of confusion between the trade-mark MINDTECH and the trade-marks MIND and MIND COMPUTER PRODUCTS. The material dates with respect to each ground of opposition are as follows: Paragraph 12(1)(d) - 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 (FCA)]; Paragraph 16(3)(a) - the date of filing of the application; non-distinctiveness - the date of filing of the opposition [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.)].

It is not clear to me that the opponent has used MIND COMPUTER PRODUCTS as a trade-mark, as opposed to as a trade-name. After all, the opponent refers to itself as trading as Mind Computer Products and it has not evidenced that MIND COMPUTER PRODUCTS is associated with its products, the way MIND is. In any event, my decision on the likelihood of confusion between MIND and MINDTECH will decide the issue of confusion. If MIND and MINDTECH are not confusing, then it follows that even if MIND COMPUTER PRODUCTS was being used as a trade-mark, MIND COMPUTER PRODUCTS and MINDTECH would not be confusing.

With respect to the Section 16 ground of opposition, there is an initial burden on the opponent to evidence use of its trade-marks prior to the applicant's filing date by it or a licensee whose use satisfies the requirements of Section 50 of the *Act*. I am prepared to accept that the opponent used the trade-mark MIND in association with computers prior to July 31, 1996 (see for example paragraph 3, Holmes affidavit) but the opponent has not evidenced use of its trade-mark with the remaining registered wares, or with most of its services, prior to July 31, 1996, or at any other time. Regarding the additional wares pleaded in the statement of opposition, the opponent's evidence is contradictory

concerning the date of first use. On the one hand, the trade-mark application filed in 1997 to register MIND was based on proposed use for all of those wares, except cups. On the other hand, Mr. Fry attests at paragraphs 6 and 7 of his affidavit that all of those wares were being sold prior to July 31, 1996 and photographs showing the cups and T-shirts dated 1994 are attached as exhibits. Given that the Fry affidavit is a sworn document whereas the trade-mark application is not, I will accept Mr. Fry's sworn statement. Accordingly, I hold that the opponent has met its evidential burden with respect to its Paragraph 16(3)(a) ground with respect to computers, coasters, clocks, clothing, cups/coffee mugs, flashlights, key chains, lapel pins, note pads, watches, and operation of a wholesale and retail business selling computer hardware, computer software and computer furniture.

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in Subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Subsection 6(5) of the *Act*. Those factors specifically set out in Subsection 6(5) are: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; and the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

There is a legal burden on the applicant to establish that there would be no reasonable likelihood of confusion between the marks in issue. This means that if a determinate conclusion cannot be reached, the issue must be decided against the applicant [see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293].

Inherent Distinctiveness

Both MIND and MINDTECH have a considerable degree of inherent distinctiveness but the applicant's mark is slightly less distinctive to the extent that the word "mind" is suggestive of educational wares and services.

Extent to Which Marks have Become Known

The opponent has provided much broad evidence concerning its allegedly extensive use of its trade-marks. Unfortunately such evidence has not been detailed enough or broken down in such a way as to make it as meaningful as possible to the matters to be decided here. For example, it has not been broken down either by product or by material dates. Nevertheless, as of each of the material dates, I can find that this factor favours the opponent.

The opponent has been advertising its MIND trade-mark since the late 1980s, with close to \$400,000 being spent annually during the three fiscal years preceding December 1997. The MIND mark is advertised through television, print and radio advertisements. In addition, the MIND trade-mark is promoted through the sponsorship of professional sporting teams [see paragraphs 4, 5, and 9, Fry affidavit]. The applicant has also advertised its mark [see exhibits "C", "D" and "E", Akbar affidavit] but the volume or value of such advertising has not been provided.

Neither party has provided annual sales figures for the wares/services associated with its mark. The applicant has stated that as of July 30, 1998, approximately 60 students were enrolled in its programs [paragraph 10, Akbar affidavit]. As of December 30, 1997, Mr. Fry attests that, "MIND has grown to a company whose sales reached \$40,000,000.00 last year, and... currently close to 70,000 MIND computers have been sold..." In addition he attests that, "over the past fifteen years MIND has also sold many hundreds of thousands of other items across Canada, from computer related products, to cups, to T-shirts; and all of them have been and continue to be sold by MIND with the "MIND" trademark on them." [see paragraphs 4 and 6, Fry affidavit]

We therefore have no exact understanding of the volume of the opponent's sales as of the two earlier material dates. Nevertheless, it appears that the opponent's sales exceeded those of the applicant as of each material date.

The opponent has also argued that its MIND mark has become known to a much larger number of people than those who have purchased their computers because their computers, bearing their trade-mark, are typically located in places like schools and government offices where many individuals have occasion to see them.

Length of Time the Marks Have Been in Use

This factor favours the opponent, use of the MIND mark having commenced in 1982 [see certified copy of registration No. 376,741] while use of MINDTECH commenced in December 1996 [see paragraph 12, Akbar affidavit].

Nature of the Wares, Services, Business and Trade

The opponent's core business is the design, manufacture and sale of computers. Its computers, computer systems and other products are sold in all areas of Canada [paragraph 3, Enns affidavit]. Its clientele includes schools and educational institutions, as well as government departments, offices and crown corporations. Although it sells various non-computer wares, such as cups and T-shirts bearing its trade-mark, those wares are also used to promote its core business [see paragraph 7, Fry affidavit].

The applicant operates an educational centre in the Toronto area that provides children with academic programs, computer application programs, and technology programs. The applicant does not sell computer hardware or computer furniture [see paragraph 13, Akbar affidavit].

It is not clear how the applicant's wares would be sold. It is possible that they would be sold only to students at its educational centres but, as the

statement of wares does not restrict its channels of distribution in any way, I will assume that its wares could travel through the standard channels of trade such as computer stores, department stores, toy stores, and clothing stores.

Degree of Resemblance between the Marks

There is a fair degree of resemblance between MIND and MINDTECH both visually and when sounded. The idea suggested by each mark differs somewhat as a result of the word TECH. However, the opponent submits that the addition of TECH actually makes the makes more similar as its company is known for its technology and TECH is an accepted and known short form of the word “technology” [see paragraph 11, Fry affidavit].

Regarding the fact that the applicant’s mark incorporates the opponent’s mark MIND in its entirety, I note the following comments from page 188 of the Federal Court’s decision in *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.):

“It has appropriated the appellant’s mark in its entirety and added thereto as a suffix the words ‘age tendre’. It is axiomatic that the first word or the first syllable in a trade mark is far the more important for the purpose of distinction. Here the first and most important word in the mark which the respondent seeks to register is identical to the mark registered by the appellant.

If there is doubt whether the registration of a trade mark would cause confusion with a prior mark the doubt must be resolved against the newcomer. In this instance the result is that the doubt must be resolved in favour of the appellant.”

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State of the Register Evidence

Another surrounding circumstance to be considered is the evidence of the state of the Canadian Trade-marks Register introduced by the applicant through the Guralnick and Smartt affidavits.

State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.)].

Inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located [see *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

Six marks were located on the Register that incorporate the word MIND and relate to computer products. These are MASTERMIND for the operation of a retail store selling, *inter alia*, computer software and hardware, MINDSET for computers and peripheral apparatus and computer software, MIND F/X & Design for training services and work shops for general computer application to any educational environment namely corporate training and school usage, MINDFLIGHT for computer software and hardware and related consulting services, MINDSHARE for consulting, education and training services in the field of computers and MACROMIND for computer software programs. I note that all of the above marks are the subject of registrations that issued based on use of the marks in Canada and that each has a different owner. However, I do not consider six to be a large number and therefore I cannot draw an inference about the state of the marketplace from this state of the register evidence.

Conclusion re Likelihood of Confusion

Having considered all of the surrounding circumstances, I conclude that the Paragraph 12(1)(d) ground of opposition succeeds with respect to the following wares and services: educational software, books, magazines, computer games, writing paper and developing, designing, marketing and distribution of educational software, manuals, books, toys and games. These wares and services overlap with those covered by the opponent's registration and, despite the differences in the marks, the applicant has not satisfied me that there is not a reasonable likelihood of confusion given the adoption of the opponent's entire MIND mark as the first component of the applicant's mark. Concerning the remaining wares and services, I find that they are sufficiently removed from those of the opponent that the differences in the marks would suffice to make confusion unlikely. In reaching my decision, I have born in mind that the test of confusion is whether the average Canadian, with an imperfect recollection of the opponent's mark, would be likely to conclude that the MINDTECH wares/services share the same source as the MIND wares/services. In particular, I do not consider it likely that there would be confusion between the opponent's mark and the applicant's mark with respect to the applicant's core services, namely its tutoring and counseling services, despite the opponent's evidence that a large number of its MIND computers are in schools. Just because a product is used in a school does not mean that the public will assume that an educational centre operating under a similar name has the same source as the product, particularly where the common word is an ordinary dictionary word.

For similar reasons, the Paragraph 16(3)(a) ground of opposition succeeds with respect to educational software, computer games, writing paper, mugs, glasses, cups, men's, women's and children's clothing namely T-shirts, shirts, pullovers, tops, sweatshirts, sweatpants, shorts; developing, designing, marketing and distribution of educational software, manuals, books, toys and games. These wares and services are very similar to those that the opponent has evidenced as having been sold by it in association with its MIND mark as of the material date and

the applicant has not met its onus to show that confusion is not reasonably likely.

With respect to the ground of non-distinctiveness, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares 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.)]. I conclude that the applicant has failed to satisfy the burden on it to show that confusion is not reasonably likely with respect to the wares and services set out in the preceding paragraph as of April 18, 1997 and therefore this ground of opposition also succeeds with respect to those wares and services.

Paragraph 12(1)(b) Ground

The opponent has also pleaded that the applicant's mark is not registrable pursuant to Paragraph 12(1)(b) of the *Act*. It alleges that because MINDTECH means "mind technology", it is deceptively misdescriptive of the character or quality of the wares and/or services in association with which it is proposed to be used or of the conditions of or the persons employed in their production or of their place of origin. As I understand it, the opponent's argument is that most Canadians would believe that MINDTECH is merely a short way of referring to technology that comes from the opponent (because the opponent is known as MIND and TECH is an abbreviation for technology), with the result that the mark is deceptively misdescriptive in the hands of the applicant.

The material date for considering a ground of opposition based on Paragraph 12(1)(b) is as of the date of decision [see *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers*, 41 C.P.R. (3d) 243 (FCA)]. There is an initial evidential burden on the opponent to adduce sufficient evidence that would support the truth of its allegations. The issue as to whether the applicant's mark is deceptively misdescriptive must be considered from the point of view of the average purchaser of those wares. Furthermore, the mark must not

be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks*, 40 C.P.R. (2d) 25, at pp. 27-8; *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183 at p. 186].

Although the opponent has introduced evidence that it is known as MIND and that TECH is an abbreviation for technology, I find that it would be necessary for the mark to be dissected into its component elements and carefully analyzed in order for it to be viewed as deceptively misdescriptive. I therefore reject the Paragraph 12(1)(b) ground of opposition.

Other “Registrability” Grounds

The opponent has also pleaded a number of grounds of opposition that claim that the applied for mark is not registrable because it is prohibited pursuant to various subsections of Section 7 of the *Trade-marks Act*.

As stated in Paragraph 38(2)(b) of the *Act*, a statement of opposition may be based on the ground that the trade-mark is not registrable. The circumstances under which a trade-mark is not registrable are set out in Section 12. They do not include prohibition under Section 7 as a circumstance that makes a trade-mark not registrable. As stated by the Registrar in *Cuprinol Ltd. v. J.S. Tait & Co. Ltd.*, 19 C.P.R. (2d) 176 at p. 180:

“Objections based on s. 7 of the Trade Marks Act are not grounds for opposition pursuant to s. 37(2) of the Trade Marks Act. A breach of s. 7 of the Trade Marks Act may be made the subject of other proceedings before a Court of competent jurisdiction but it is not proper grounds for opposition.”

Accordingly, I have not considered any of the grounds of opposition that are based on Section 7.

Section 30 Grounds

The opponent has also pleaded that the application does not conform to Section 30 of the *Act* for several reasons.

The opponent alleges that the applicant did not intend to use its mark in association with each of the applied for wares and services, contrary to Subsection 30(e). Although the legal burden is on the applicant to show its compliance with Section 30, there is an initial evidential burden on the opponent to evidence its supporting allegations of fact. Since the opponent failed to submit evidence on point and since the applicant's evidence is not inconsistent with its stated intention to use the mark for the applied for wares and services, this ground of opposition is unsuccessful. For similar reasons, I reach the same conclusion regarding the ground of opposition based on Subsection 30(e) that alleges that the applicant does not intend to "make use, as use is interpreted and defined in and by Canadian Trademark Law, of the trademark MINDTECH" in association with each of the applied for wares and services.

The opponent has also pleaded that the application does not conform to Subsection 30(a) in that it does not contain a statement in ordinary commercial terms of the specific wares or services in association with which the mark is proposed to be used. No evidence or argument was filed to meet the opponent's initial burden with respect to this claim. Accordingly, this ground of opposition is rejected.

The opponent has also pleaded that the application does not conform to the requirements of Subsection 30(i) because the applicant is not the person entitled to use the applied for mark. No evidence has been furnished by the opponent to show that the applicant was aware of the opponent's prior use of its trade-marks when it filed its application or that the applicant could not have been satisfied that it was entitled to use the applied for mark. The Subsection 30(i) ground of opposition is therefore unsuccessful.

Paragraph 16(3)(b) Ground

The opponent has also relied on Paragraph 16(3)(b) of the *Act* as a ground of opposition. In its particulars, it refers to “a trademark in respect of which an application for registration had been previously filed in Canada by another person/corporation, specifically, either or both of the following registered trademarks, which are owned and used by the Opponent: MIND, registration No.: 376, 741; and MIND COMPUTER PRODUCTS, Registration No.: 380,291.” This ground of opposition will be disregarded because the applications relied on were not in fact pending at the date of advertisement of the applicant's application, having already issued to registration [see *Governor and Co. of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Co. v. Kmart Canada Ltd.*, 76 C.P.R. (3d) 526 at p. 528].

If the opponent intended the Paragraph 16(3)(b) ground of opposition to be based on any of the applications which it introduced into evidence by way of certified copies, then the ground would have failed because the filing dates of those applications post-dated the applicant's filing date.

For the reasons set out above, I am issuing a split decision, under the authority set out in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 492 (F.C.T.D.). Having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, pursuant to Subsection 38(8) of the *Act*, I refuse the applicant's application with respect to educational software, books, magazines, computer games, writing paper, mugs, glasses, cups, men's, women's and children's clothing namely, T-shirts, shirts, pullovers, tops, sweatshirts, sweatpants, shorts; developing, designing, marketing and distribution of educational software, manuals, books, toys and games and reject the opposition with respect to the remaining wares and services.

DATED AT TORONTO, ONTARIO, THIS 25th DAY OF
SEPTEMBER, 2000.

**Jill W. Bradbury
Hearing Officer
Trade-marks Opposition Board**