

LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2011 TMOB 243**

**Date of Decision: 2011-12-06**

**IN THE MATTER OF OPPOSITIONS by  
Bell ExpressVu Limited Partnership to  
Application Nos. 1,344,005 and 1,344,008 for  
the trade-marks xVu and xVu TV Care filed  
by Mariner Partners Inc.**

[1] On April 19, 2007, Mariner Partners Inc. (the Applicant) filed applications to register the trade-marks xVu and xVu TV Care (the Marks), based upon use of the Marks in Canada since at least October 16, 2006 in association with the following wares and services:

A software product that monitors the quality of video and audio television signals delivered over the internet and the performance of the equipment in which the software product is resident and operates. (the Wares)

Installation and maintenance of the software product that monitors the quality of video and audio television signals delivered over the internet and the performance of the equipment in which the software product is resident and operates, including the provision of upgrades. (the Services)

[2] The applications were advertised for opposition purposes in the *Trade-marks Journal* of May 28, 2008 (with respect to application No. 1,344,005) and June 25, 2008 (with respect to application No. 1,344,008).

[3] On December 24, 2008 and January 27, 2009 respectively, Bell ExpressVu Limited Partnership (the Opponent) filed a statement of opposition against each application. The Applicant filed and served a counter statement in each case in which it denied the Opponent's

allegations. On July 21, 2009, the Opponent requested leave to file an amended statement of opposition in each case. Leave was granted on December 8, 2009. The amended statements of opposition claim that the applications do not conform to the requirements of s. 30; 12(1)(d); 16(1)(a) and 38(2)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), in view of the fact that, among others, the Marks are confusing with the Opponent's trade-marks VU; VU!; VU! & Design; Vu! tv; Vu! tv & Design; and EXPRESSVU previously registered under Nos. TMA631,491; TMA628,748; TMA628,899; TMA564,165; TMA564,164; and TMA454,727 respectively (collectively the Opponent's VU Marks) and used in Canada by the Opponent in association with various telecommunication products and services. I am attaching as Schedule A to my decision the details of the Opponent's registrations, which all predate the Applicant's claimed date of first use of the Marks.

[4] In support of each of its oppositions, the Opponent filed certified copies of the aforementioned registrations as well as an affidavit of Bourke Marrison, Associate Director, Strategic Marketing at the Opponent, sworn September 18, 2009. I will use the singular form to refer to the two affidavits of Mr. Marrison, which are essentially identical. In support of each of its applications, the Applicant filed an affidavit of Marc Savoie, Vice-President of Product Management at the Applicant, sworn January 19, 2010. Unless indicated otherwise, I will also use the singular form to refer to the two affidavits of Mr. Savoie.

[5] Both parties filed written arguments and attended at an oral hearing.

### Onus

[6] The Applicant bears the legal onus of establishing, on a balance of probabilities, that each of its applications complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); and *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

Summary of the parties' evidence

The Opponent's evidence – the Marrison affidavit

[7] Mr. Marrison states that the Opponent was formed in 1999, as per copy of a CIDREQ report attached to his affidavit as Exhibit B. He further states that the Opponent has used and advertised the Opponent's VU Marks in association with all of the wares and services covered by the above-identified registrations.

[8] More particularly, Mr. Marrison states that the Opponent offers telecommunication services and products associated therewith, in association with the Opponent's VU Marks, and has done so since at least as early as 1994. I question the correctness of such date that predates the Opponent's incorporation date as well as all of the dates of first use or declarations of use alleged in the registrations listed in Schedule A, except for registration No. TMA454,727, which claims use of the EXPRESSVU mark since at least as early as 1994. That said, upon review of the Canadian Intellectual Property Office (CIPO) trade-mark database, I note that such registration was first owned by Bell ExpressVu Inc. and was assigned to the Opponent on December 1, 1999.

[9] Mr. Marrison further states that the telecommunication services offered by the Opponent are offered through satellite dishes and communication devices allowing customers to receive telecommunication signals in their homes. The Opponent's services include radio and TV broadcasting, direct to home broadcasting via satellite, pay-per-view television services and broadcasting and distribution of television programs to the global network. Those services are offered through telecommunication programs and devices also offered by the Opponent and bearing the Opponent's VU Marks.

[10] In support of such statements of use, Mr. Marrison attaches to his affidavit as Exhibits D and E respectively a brochure, published and distributed by the Opponent to the Opponent's subscribers throughout Canada between 2000 and 2003, providing more information about the products and services of the Opponent, and a random sampling of invoices evidencing sales made by the Opponent of some of the Opponent's products and services under the Opponent's

VU Marks between 1999 and 2006. Upon review of the brochure attached as Exhibit D, I note that it includes references to the Opponent's VU! (and VU! & Design) pay-per-view television services as well as to the Opponent's EXPRESSVU mark, which appears throughout the brochure, including in pictures of a satellite dish, a self installation kit and a HDTV (High-Definition Television) satellite receiver reproduced therein all displaying the EXPRESSVU mark. Likewise, I note that the Opponent's VU! and EXPRESSVU marks are referred to in many of the invoices attached as Exhibit E.

[11] Mr. Marrison states that the Opponent regularly advertises its products and services in association with the Opponent's VU Marks in various media throughout Canada. The total advertising and promotion expenditures for the Opponent's products and services commercialized under the Opponent's VU Marks in Canada for the years 2004 to 2008 were as follows (Canadian million dollars): 2004: 18.7; 2005: 16.8; 2006: 23.8; 2007: 23.2; and 2008: 24.4. By way of example, Mr. Marrison attaches to his affidavit samples of the following advertising materials:

- Exhibits F-1 to F-3: printouts of the website *www.bell.ca* in 2004, 2007 and 2008, displaying the Opponent's VU!, VU! & Design and EXPRESSVU marks;
- Exhibits G-1 to G-4: printed advertisings displaying the Opponent's EXPRESSVU mark published through the years 2003 to 2006 in major Canadian newspapers such as *La Presse* and the *Toronto Sun* or distributed by the Opponent itself or retailers such as *Dumoulin* and *FutureShop*;
- Exhibits H-1 and H-2: Programming Guide published by the Opponent and distributed throughout Canada in 2005 and 2006 displaying the Opponent's VU! & Design and EXPRESSVU marks; and
- Exhibits I-1 to I-6: various advertising materials, including advertisements of i) the VU! & Design television programming services published and distributed by the Opponent throughout Canada in 2001; ii) the VU Magazine and excerpts thereof published and distributed by the Opponent throughout Canada in 2003 and 2004; and iii) the EXPRESSVU Newsletter distributed by the Opponent to its subscribing customers in 2007.

[12] Mr. Marrison states that between 1998 and 2008, the commercialization in Canada of the Opponent's VU Marks in association with the trade-marked products and services of the Opponent generated the following revenues (year ending December 31<sup>st</sup>) (Canadian million dollars): 1998: 37; 1999: 135.4; 2000: 304.6; 2001: 474.3; 2002: 638.2; 2003: 706.5; 2004: 873.8; 2005: 988.5; 2006: 1,191.7; 2007: 1,366.4; and 2008: 1,513.2. However, he does not provide a breakdown of annual sales for each of the Opponent's wares and services.

[13] Turning to the Applicant's Marks, Mr. Marrison states that he did some research on the website of the Applicant *www.marinerpartners.com* and he attaches as Exhibit K to his affidavit a printout that is a press release dated November 6, 2006 in which the Applicant announces the availability of its xVu / xVu TV Care "monitoring solution for IPTV [Internet Protocol Television] Service Assurance". I note that copies of such press release have also been filed by the Applicant through the Savoie affidavit. I will revert to that press release later on in my decision when assessing the s. 30 grounds of opposition.

[14] Mr. Marrison states that he further notes that "XVU" is a "file extension" as per copy of a printout attached to his affidavit as Exhibit L. He further states that "XVU" is also associated with a hemodynamic monitoring system offered by a third party, as per copy of a printout attached to his affidavit as Exhibit M.

[15] Mr. Marrison concludes his affidavit stating that based on the length of use, significant volume of sales, quantity of trade-marks encompassing the element "VU" in the Opponent's family of trade-marks, extensive expenditures on advertising and promotion, he believes that the Opponent's VU Marks have become well-known to consumers in Canada. Based on his experience and in light of the Opponent's VU Marks, he further believes that the average Canadian consumer would be likely to be confused when seeing the Applicant's Marks. I am not prepared to afford weight to these statements of Mr. Marrison, which involve questions of fact and law to be determined by the Registrar based on the evidence of record in the instant proceedings.

The Applicant's evidence – the Savoie affidavit

[16] Mr. Savoie states that the Applicant is a multidisciplinary firm doing business and specialising in the development and deployment of market-leading technologies for the IPTV industry, which include but are not limited to technologies that enable service providers the capability of monitoring the service they offer.

[17] Mr. Savoie states that the Applicant is not in the telecommunication business and neither in the delivery of telecommunication signals either through satellite dishes, communication devices or any other type of telecommunication delivery system.

[18] Mr. Savoie states that the applications for the Marks were filed on the basis of the Applicant's use of the Marks since at least October 16, 2006 with respect to the Applicant's Wares and Services, more particularly the selling and maintaining of a software product that monitors the quality of video and audio television signals over the Internet and the performance of the equipment in which the software product is resident and operates.

[19] Mr. Savoie explains that the platform xVu / xVu TV Care was developed by the Applicant and designed for telephone companies that offer digital television service through telephone lines (Internet Protocol Television). The software identifies any issues that may affect the quality of the audio or video television signals of the customer and therefore enables the service provider to address any problems before it becomes a customer issue.

[20] Mr. Savoie states that "[t]he platform became available several months before its official launching". He attaches as Exhibit B to his affidavit a copy of the announcement of the official launching of the monitoring software xVu / xVu TV Care on November 6, 2006. Upon review of each Exhibit B attached to the affidavits of Mr. Savoie, I note that while their formats slightly differ, their contents are the same and both correspond to the press release entitled "Mariner Partners Announces Availability of Industry's First Proactive Monitoring Solution for IPTV Service Assurance" filed as Exhibit K to the Marrison affidavit discussed above. As indicated

above, I will revert to that press release later on in my decision when assessing the s. 30 grounds of opposition.

[21] Mr. Savoie states that the Applicant has advertised the platform xVu / xVu TV Care in the IPTV industry and has participated in a number of showcasing events and online forums to promote and present the product and its benefits. By way of example, he attaches to his affidavit as Exhibit C various items outlining those events and presentations. Upon review of Exhibit C filed in file No. 1,344,005, I note that it consists of undated photographs of what appears to be a kiosk of the Applicant set up at an unidentified trade-show. The kiosk includes posters depicting the xVu trade-mark with underneath the phrase “proactive service assurance”. Also included in that exhibit are copies of what appears to be a presentation entitled “xVu For Mediaroom, Solution Overview” dated November, 2009 describing the xVu suite of IPTV service monitoring tools, the manner and extent of distribution of which has not been specified by Mr. Savoie. Upon review of Exhibit C filed in file No. 1,344,008, I note that it consists of printouts from what appears to be various third party websites, such as *Internet Telephony Magazine*, *TelecomEngine* *Telecommunications MediaGroup*, etc., which either refer to the Applicant’s press release mentioned above, or report news pertaining to the Applicant. I will revert to these exhibits later on in my decision when assessing the s. 12(1)(d) ground of opposition. Suffice it to say for the moment that, except for the November 2009 presentation, I agree with the Opponent that such Exhibits C do not amount to acceptable specimens of use of the Marks pursuant to s. 4 of the Act. They do not show how the Marks are used in association with the Wares at the time of the transfer of the property in or possession of the Wares in the normal course of trade. Furthermore, they do not qualify as advertising *per se* of the Services considering the lack of information provided as to the exact nature of the services available to be performed or else, the nature of the documents so attached, which do not consist of advertising material but rather consist of various articles merely reporting news about the Applicant.

[22] Mr. Savoie states that the advertisements of the Applicant’s Wares and Services aim at the IPTV industry since the platform xVu / xVu TV Care is a complex and sophisticated product designed specifically for service providers like the Opponent; the platform would be useless for telecommunication customers in general including the Opponent’s clientele. He attaches as

Exhibit D to his affidavit advertisements for the Marks. Upon review of Exhibit D filed in file No. 1,344,005, I note that it consists of an undated brochure displaying the xVu trade-mark, the manner and extent of distribution of which has not been specified by Mr. Savoie. As for Exhibit D filed in file No. 1,344,008, it consists of a printout from the Applicant's website dated 04/04/2007 and an undated one-page leaflet displaying the xVu TV Care trade-mark. Again, the manner and extent of distribution of this leaflet has not been specified by Mr. Savoie.

[23] Mr. Savoie states that the Applicant has been successful over the years targeting the IPTV service providers by outlining the benefits of the xVu platform and its success and has developed a great reputation in the industry. He attaches as Exhibit E to his affidavit in file No. 1,344,005 a copy of a press release dated January 12, 2009 with respect to an announcement of a contract between the Applicant and one of its clients.

[24] Mr. Savoie states that the xVu / xVu TV Care trade-mark is shown on various screens of the software, as per pictures of some screens attached to his affidavit. Upon review of Exhibit F filed in file No. 1,344,005 and Exhibit E filed in file No. 1,344,008, I note that the screens pictured therein do display the Marks. The xVu TV Care trade-mark appears to be related to the Applicant's "HomeVu Customer Self-Care application", which is describes as follows:

[An] intuitive troubleshooting application [that] enables viewers to use self-help diagnostic tools to independently investigate and resolve video service delivery issues through the TV screen. Access is immediate, and does not require any assistance from the provider.

[25] Concerning more particularly the xVu TV Care platform, Mr. Savoie states that the Applicant offers installation and maintenance services with respect to the software. To this end, he attaches as Exhibit F to his affidavit in file No. 1,344,008 a printout of a task summary of an Applicant's employee. Mr. Savoie further states that the Applicant, through its website and brochures, provides details and descriptions of its products and services including xVu and he attaches as Exhibit G to his affidavit in file No. 1,344,005 printouts from the Applicant's website and various brochures. Among the brochures attached as Exhibit G, is one entitled "Keep your viewers happy, Service Assurance by xVu" wherein the xVu platform is described as including "a home self-service application [that] provides the viewer with the ability to: interact with the



provider for problem reporting, self-diagnose TV service issues, and receive service-related messages or interactive marketing initiatives”. I will revert to this point later on in my decision when assessing the nature of the parties’ wares and services and the nature of the trade under the test for confusion.

[26] Turning to the Opponent’s marks, Mr. Savoie states that “[t]he Applicant was aware of the Opponent’s marks when the application[s] for the [Marks were] filed with [CIPO], but believes that both parties are pursuing distinct businesses not designated for the same clientele whatsoever and not operating in the same trade channels”. He adds that the deployment of the software xVu / xVu TV Care and any related technologies are ultimately distinct from the Opponent’s marks and products.

[27] Mr. Savoie concludes his affidavit stating that over the past several years the Applicant has been able to build a solid reputation among the IPTV service providers both nationally and internationally and he believes that there is no confusion between the Applicant’s Marks and the Opponent’s marks and that the likelihood of confusion is inexistent. He further believes that ordinary consumers having seen the Wares and Services developed and offered by the Applicant are unlikely to conclude that such wares and services are associated with the Opponent. I am not prepared to afford weight to these statements of Mr. Savoie, which involve questions of fact and law to be determined by the Registrar based on the evidence of record in the instant proceedings.

#### Analysis of the grounds of opposition

[28] The s. 12(1)(d), 16(1)(a) and 38(2)(d) grounds of opposition turn on the issue of the likelihood of confusion between the Marks and the Opponent’s VU Marks. As I consider the s. 12(1)(d) ground of opposition in each case to present the Opponent’s strongest case, I will assess the likelihood of confusion under that ground first.

#### Section 12(1)(d) grounds of opposition

[29] The Opponent has pleaded that the Marks are not registrable having regard to the

provisions of s. 12(1)(d) of the Act in that they are confusing with the Opponent's registered VU Marks identified above.

[30] The material date to assess a ground of opposition based on s. 12(1)(d) is the date of my decision [see *Park Avenue Furniture Corp. v. Wickers/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

[31] As indicated above, the Opponent has provided certified copies of the aforementioned registrations. I have exercised the Registrar's discretion to confirm that they are in good standing as of today's date. As the Opponent's registrations are extant, the Opponent's initial burden with respect to this ground of opposition in each case has been satisfied.

[32] The Applicant must therefore establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Marks and any or all of the Opponent's VU Marks.

[33] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[34] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive and different weight will be attributed to different factors according to the context [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401 (S.C.C.) for a thorough discussion of the general principles that govern the test

for confusion].

(a) the inherent distinctiveness of the trade-marks and the extent to which they have become known

[35] The Applicant submits that the Marks have their own degree of inherent distinctiveness and have become known in their own distinct area of business. More particularly, the Applicant submits that while the Marks do not possess much inherent distinctiveness, they have become known through use and direct promotion to service providers of Internet Protocol Television across Canada and find their distinctiveness in the fact that the Marks are now well recognized in this specialized industry. Turning to the Opponent's VU Marks, the Applicant acknowledges (both indirectly in Mr. Savoie's affidavit and as per the representations made at the oral hearing) that they have been used, generally speaking, for several years in association with television services and more particularly the delivery of television signals and television programming, and as such, there is some goodwill attached to the Opponent's marks. However, the Applicant submits that the Opponent's VU Marks do not amount to famous marks that would deserve protection beyond the specific wares and services for which they have been registered.

[36] The Opponent submits for its part that while the element "VU" forming part of all of the parties' marks may be considered to be suggestive in the context of television products and services, it is not as suggestive as the words "vision" or "view". As such, the parties' marks possess some degree of inherent distinctiveness. Furthermore, the Opponent submits that the extent to which the Opponent's VU Marks have become known in Canada (with sales in this country amounting to billions of dollars) when considered in light of the Applicant's evidence of use of the Marks, unequivocally favours the Opponent in the overall consideration of this first factor. I partly agree with the Opponent.

[37] I assess the inherent distinctiveness of the parties' marks in the context of their associated wares and services as relatively moderate and about the same. However, my review above of the evidence of record leads me to conclude that the Opponent's VU Marks (except for the marks Vu! tv and Vu! tv & Design discussed below) have deeper roots and have become known significantly in Canada in association with television products and services.

[38] While no breakdown of annual sales for each of the Opponent's products and services is provided by Mr. Marrison, I am satisfied from my review of the Marrison affidavit and exhibits attached thereto that there has been extensive use and advertising of the Opponent's EXPRESSVU, VU! and VU! & Design marks in association with most, if not all, of the wares and services covered by Registration Nos. TMA454,727, TMA628,748 and TMA628,899 since at least as early as 1999 with respect to the EXPRESSVU mark and 2000-2001 with respect to the VU! and VU! & Design marks. The revenues generated for the years 1998 to 2008 amounting to in excess of 8 billion dollars, coupled with the total advertising and promotion expenditures for the Opponent's products and services in Canada for the years 2004 to 2008 amounting to in excess of 106 million dollars, lead me to conclude that the said marks of the Opponent, and particularly the Opponent's EXPRESSVU mark, have become known significantly in Canada, if not well-known.

[39] That said, I am not prepared to conclude that the Opponent's Vu! tv and Vu! tv & Design marks registered under Nos. TMA564,165 and TMA564,164 enjoy the same level of recognition given that the Opponent has not evidenced use and advertising of these marks in Canada. As per my review of the Marrison affidavit above, none of the exhibits of record pertain to these two marks. The mere existence of these two registrations can establish no more than *de minimis* use of the Opponent's trade-marks [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)].

[40] By comparison, the Savoie affidavit does not provide much information as to the extent to which the Applicant's Marks have been used and become known in Canada. While Mr. Savoie baldly states that the Applicant has been able to build a solid reputation among the IPTV service providers both nationally and internationally, no sales or marketing figures are provided. Neither are any copies of invoices provided or any information provided as to the manner and extent of distribution of the various specimens of brochures that were filed by Mr. Savoie. While I am prepared to infer from these brochures (which include pictures of screens displaying the xVu / xVu TV Care software) and announcements discussed above that there has been use of the Marks in association with the applied-for Wares and Services since arguably November 2006, I

can hardly ascribe any reputation of note to the Marks.

[41] To sum up, the overall consideration of this first factor favours the Opponent with respect to the Opponent's EXPRESSVU, VU! and VU! & Design marks by reason of their acquired distinctiveness.

(b) the length of time the trade-marks have been in use

[42] For the reasons given above, this factor also favours the Opponent.

(c) the nature of the wares, services or business; and (d) the nature of the trade

[43] Considering the type of wares and services and the nature of the trade, I must compare the Applicant's statement of Wares and Services with the statement of wares and services in the Opponent's registrations [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); and *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R. (4th) 266 (T.M.O.B.); and *American Optional Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

[44] The Applicant submits that the evidence of record clearly establishes that the Applicant and the Opponent are pursuing different businesses which are not connected whatsoever. More particularly, the Applicant submits that the wares and services associated with the Opponent's VU Marks are the delivery of TV signals and television programming which are not businesses pursued by the Applicant. The product offered by the Applicant is designed not for the Opponent's clientele but for companies, such as the Opponent, who deliver television signals over the Internet.

[45] The Opponent submits for its part that it is not necessary that the parties' wares and services compete with each other. As stated in s. 6(5) of the Act, confusion may occur "whether or not the wares or services are of the same general class". This is particularly true in the cases of strong marks, where the distinction between the wares and services and the nature of the trade of competing marks becomes less important. The Opponent further submits that the parties' businesses are not as disconnected as the Applicant contends. The Opponent's wares and services include computer software for satellite broadcasting and the distribution of a television signal. The Opponent submits that it does not matter whether such distribution is made by means of a satellite or via the Internet. The Opponent emphasizes in this regard that registration No. TMA454,727 includes "all manner of voice, image, text and full motion video communication services and combinations thereof using satellite signals *and other technologies*" and "[b]roadcasting and distribution of television programs through the *Global network (Internet)*". Registration Nos. TMA564,164 and 564,165 further pertain to "[b]usiness television services" intended for companies.

[46] Concerning more particularly the parties' channels of trade, the Opponent points out that Exhibit E attached to the Savoie affidavit in file No. 1,344,008, describes the xVu TV Care platform as featuring "[i]nteractive tools [that] allow the viewer to use the TV to report or query service issues [...]." The features empower the viewer to "[i]nteract with the provider through the TV to monitor issue resolution status and scheduling for service calls". As per my review above of Exhibit G to the Savoie affidavit in file No. 1,344,005, the xVu platform is also described as encompassing "a home self-service application that provides the viewer with the ability to: interact with the provider for problem reporting, self-diagnose TV service issues, and receive service-related messages or interactive marketing initiatives". As pointed out by the Opponent, the viewer (or end user) of the Applicant's xVu / xVu TV Care platform is exposed to the Marks, which are displayed on the end user's TV screen. The Opponent further submits that there is a connection between the parties' businesses in that the Applicant's Wares and Services are designed for television services providers like the Opponent.

[47] While I appreciate the Applicant's argument made at the oral hearing that the xVu / xVu TV Care platform is not offered for sale in retail stores and consists of a very sophisticated

product that can only be installed by service providers like the Opponent, I am inclined to agree with the submissions put forward by the Opponent and to find that the parties' wares and services overlap to some extent. The Applicant's Wares and Services are aimed at monitoring the quality of video and audio television signals whereas the Opponent's wares and services include computer software for satellite broadcasting and radio and television broadcasting services. While the Applicant's Wares and Services are meant for the IPTV industry as opposed to traditional TV (satellite and cable), the fact is that such wares and services are aimed at service providers like the Opponent and further benefit the same ultimate end users, which are exposed to the Marks when using the xVu / xVu TV Care home self-service application.

(e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[48] The Applicant submits that despite the fact that both the Applicant and the Opponent are using the word "VU" in their respective trade-marks, the Marks and the Opponent's VU Marks are not generating the same ideas. More particularly, the Applicant relies on *Mattel, supra*, where it was stated that "we owe the average consumer a certain amount of credit", meaning that there are some common words that are generally known to Canadians. The Applicant submits that in the instant cases, not only is there no relation between the Wares and Services with the Opponent's wares and services but the marks have distinct specificities like the size of the letters and the name of the marks.

[49] I wish to remark that the above quote from *Mattel* was made in the context of determining what is the perspective from which the likelihood of a "mistaken inference" is to be measured as opposed to determining what words are generally known to Canadians. I also wish to remark that except for the Opponent's design marks of registration Nos. TMA628,899 and TMA564,164, the size of the letters of the parties' marks "should not be considered to the exclusion of potential uses within the registration[s]" [see *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011) 92 C.P.R. (4th) 361 (SCC) at para. 59]. The applied-for Marks and the Opponent's marks covered by registration Nos. TMA631,491, TMA628,748, TMA564,165 and TMA454,727 consist of word marks, therefore permitting use of the marks in any size and with any style of lettering, color or design. As reminded in *Masterpiece*, "a subsequent use that is

within the scope of a registration, and is the same or very similar to an existing mark will show how that registered mark may be used in a way that is confusing with an existing mark”.

[50] The Applicant submits for its part that the words “TV Care” add nothing to the inherent distinctiveness of the xVu TV Care applied-for mark. Their only effect, if any, is to bring closer the xVu TV Care trade-mark to the Opponent’s VU Marks and associated wares and services, given the descriptive character of the words “TV Care” in the context of the Wares and Services. The Opponent further submits that the word “xVu” forming part of the applied-for mark xVu TV Care and the whole of the applied-for mark xVu is similar when sounded to the Opponent’s EXPRESSVU mark. The Opponent submits in this regard that the “VU” element forming part of each of the parties’ marks is the dominant element in all of these marks.

[51] I agree with the Opponent that “VU” is the dominant element in all of the parties’ marks. As such, I find there is a fair degree of resemblance between each of the applied-for Marks and each of the Opponent’s VU Marks. It is to be noted that at the oral hearing, the Applicant did acknowledge that there are similarities between the parties’ marks while at the same time emphasising the fact that they are not identical. Concerning more particularly the applied-for mark xVu TV Care, I find the degree of resemblance is stronger when compared to the Opponent’s word marks Vu! tv and EXPRESSVU. As for the applied-for mark xVu, I find the degree of resemblance is stronger when compared to the Opponent’s word marks VU; VU! and EXPRESSVU.

[52] Concerning more particularly the degree of resemblance between each of the applied-for Marks and the Opponent’s EXPRESSVU mark, I agree with the Opponent that the letter “X” found at the beginning of each of the applied-for Marks and the letters “EX” forming the first portion of the word EXPRESS in the Opponent’s mark sound the same. I further find that the idea suggested by each of the applied-for Marks in the context of the Wares and Services is that of a product or service that improves TV image quality as the combination of the letter “X” with the French word “VU” somewhat evokes “extra vu”. As such, I find there is a fair resemblance with the idea suggested by the Opponent’s EXPRESSVU mark, which suggests, in the context of the Opponent’s wares and services, the delivery of an unimpaired TV signal and image.



### Additional surrounding circumstances

[53] As a surrounding circumstance, the Opponent submits that where there is a family of marks, there is greater likelihood that the public would consider another word in the family as another product or service manufactured or performed by the same person who produced the wares and services in association with the family of marks.

[54] There can be no presumption of the existence of a family of marks in opposition proceedings. A party seeking to establish a family of marks must establish that it is using more than one or two trade-marks within the alleged family (a registration or application does not establish use) [see *Techniquip Ltd. v. Canadian Olympic Assn* (1998), 145 F.T.R. 59 (F.C.T.D.), aff'd 250 N.R. 302 (F.C.A.); and *Now Communications Inc. v. CHUM Ltd* (2003), 32 C.P.R. (4th) 168 (T.M.O.B.)].

[55] As per my findings made above under the s. 6(5)(a) factor, there is no evidence of record pertaining to the Opponent's Vu! tv and Vu! tv & Design marks registered under Nos. TMA564,165 and TMA564,164. However, the Marrison affidavit does show use of the Opponent's VU mark registered under No. TMA631,491, as well as extensive use of the Opponent's VU! and VU! Design marks registered under Nos. TMA628,748 and TMA628,899, and most importantly, of the Opponent's EXPRESSVU mark registered under No. TMA454,727. That being so, I agree with the Opponent that it has established the existence of a small family of VU Marks, which is a surrounding circumstance favouring the Opponent in the instant cases.

[56] The Applicant submits for its part that another surrounding circumstance to consider in the present cases is the fact that the Opponent has not presented any evidence of confusion and that the absence of any evidence of confusion over a period of time may entitle a negative inference about the likelihood of confusion. Transposing the comments of Board Member Tremblay in *Aspen Custom v. Chrysler Group LLC*, 2011 TMOB 48 at para. 70, it has often been said that an opponent does not need to prove instances of confusion. The burden is on an applicant to demonstrate the absence of a likelihood of confusion. I further note that the Savoie

affidavit is silent on this particular point in that Mr. Savoie does not state that he is not aware of any instances of confusion between the parties' marks. Furthermore, and as per my findings made above, the Savoie affidavit does not provide much information as to the extent to which the Applicant's Marks have been used and become known in Canada, thus rendering a determination as to the coexistence of the parties' marks difficult to assess. In the circumstances, I am not prepared to accord weight to this surrounding circumstance.

#### Conclusion regarding the likelihood of confusion

[57] As indicated above, the Applicant bears the legal onus of establishing, on a balance of probabilities, that each of its applications complies with the requirements of the Act. The presence of a legal onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant [see *John Labatt, supra*].

[58] In view of my analysis above, I find that the balance of probabilities is evenly balanced between finding that (i) there is no reasonable likelihood of confusion as to the source of the parties' wares and services in view of the differences existing in the exact nature of the parties' wares and services and their associated channels of trade, and (ii) there is a reasonable likelihood of confusion as to the source of the parties' wares and services particularly in view of the fact that there is a fair degree of resemblance between each of the Marks and the Opponent's VU Marks (particularly when the applied-for mark xVu TV Care is compared to the Opponent's word marks Vu! tv and EXPRESSVU and when the applied-for mark xVu is compared to the Opponent's word marks VU; VU! and EXPRESSVU), that the Opponent's VU!, VU! & Design and EXPRESSVU marks have been used and become known significantly in Canada over the last decade, that the Opponent has evidenced use of a family of VU Marks, and that the parties' respective wares and services are not as disconnected as the Applicant contends. As the onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion, I must find against the Applicant.

[59] Accordingly, the s. 12(1)(d) ground of opposition succeeds in each case.

[60] I wish to add that my conclusion might have been different had the Applicant substantiated Mr. Savoie's bald statement pertaining to the Applicant's "solid reputation among the IPTV service providers" in Canada as this would have likely affected my findings made above concerning the s. 6(5)(a) factor and the inferences to be drawn from the coexistence of the parties' marks in the Canadian marketplace.

#### Section 30 grounds of opposition

[61] The Opponent has pleaded various grounds of opposition pursuant to s. 30 of the Act. One of these grounds is that "the Applicant never used, as alleged in the opposed application[s], [the Marks] in association with each of the wares or services referred to in said application[s] and the alleged date of first use is false". I will assess this particular ground first.

[62] The material date that applies to such a ground of opposition is the filing date of the applications [see *Georgia-Pacific Corp. c. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)]. To the extent that the relevant facts pertaining to a ground of opposition based upon s. 30(b) of the Act are more readily available to the Applicant, the evidentiary burden on the Opponent with respect to such a ground of opposition is lower [see *Tune Masters v. Mr. P.'s Mastertune Ignition Services Ltd.*, (1986), 10 C.P.R. (3d) 84 (T.M.O.B.)]. Also, the Opponent may rely upon the Applicant's evidence provided however that such evidence is clearly inconsistent with the Applicant's claim [see *York Barbell Holdings Ltd. v. ICON Health & Fitness, Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)]. In this regard, s. 30(b) of the Act requires that there be continuous use of the applied-for Marks since the date claimed [see *Labatt Brewing Co. v. Benson & Hedges (Canada) Ltd.* (1996), 67 C.P.R. (3d) 258 (F.C.T.D.)].

[63] This brings me to comment in further detail upon the Opponent's evidence on this point in light of the Applicant's evidence.

[64] As indicated above, Mr. Marrison states that he did some research on the website of the Applicant and he attaches as Exhibit K to his affidavit a printout that is a press release dated November 6, 2006, that is after the Applicant's claimed date of first use of October 16, 2006, in which the Applicant announces, as of "today", the "availability" of its xVu / xVu TV Care "monitoring solution for IPTV [Internet Protocol Television] Service Assurance". More particularly, the press release begins as follows:

SAINT JOHN, New Brunswick – November 6, 2006 – Mariner Partners, Inc., leaders in IPTV development, today announced the availability of xVu TV Care, the industry's first proactive monitoring solution for IPTV Service Assurance solution.

Mariner xVu continuously monitors the customer's actual IPTV viewing experience and provides service providers with unparalleled visibility into the quality and reliability of the service delivered to each TV in the home.

[65] The Opponent submits that the only element of evidence filed by the Applicant purporting to evidence continuous use of the Marks since the claimed date of first use of October 16, 2006, consists of Mr. Savoie's unsubstantiated statement that "the [xVu / xVu TV Care ] platform *became available* several months before its official launching" (emphasis added). As stressed by the Opponent, Mr. Savoie does not state that there have been sales *per se* of the Wares and Services before their official launching on November 6, 2006. It is also unclear whether there has been advertising of the Services prior to November 6, 2006 amounting to use of the Marks pursuant to s. 4 of the Act.

[66] The Applicant has submitted at the oral hearing that the date of first use claimed in the applications had been verified with the Applicant at the time of filing of the applications. However, there is no evidence of record to this effect. I do not question the good faith of the Applicant at the time of filing the instant applications. That said, the fact is that the applications claim October 16, 2006 as the date of first use of the Marks by the Applicant in Canada, which date has been put into issue by the Opponent. If Mr. Marrison's affidavit is not sufficient in itself to satisfy the Opponent's evidential burden, I find that the Applicant's own evidence of use of the Marks raises more questions than it provides evidence of continuous use of the Marks in the

normal course of trade pursuant to s. 4 of the Act to the date of filing of the applications. Thus, I find the Opponent has satisfied the light evidential burden upon it.

[67] In view of the foregoing, I conclude that the s. 30(b) ground of opposition in each case succeeds on the basis that the Applicant has not met its burden.

#### Remaining grounds of opposition

[68] As I have already found in favour of the Opponent under more than one ground, I do not consider it necessary to address the remaining grounds of opposition, especially since the Opponent did not make any submission in respect thereof at the oral hearing.


#### Disposition


[69] In view of the foregoing and pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse each application pursuant to s. 38(8) of the Act.

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Annie Robitaille  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Schedule A

Trade-mark	Registration No. & Date	Wares/Services & Dates of first use
VU	TMA631,491 January 28, 2005	Printed publications, namely magazines that contain program listing schedules with respect to satellite television systems, together with editorial features, articles and advertising. Declaration of use filed January 10, 2005
VU!	TMA628,748 December 20, 2004	Pay-per-view television services. Used in Canada since at least as early as October 28, 1999
	TMA628,899 December 22, 2004	Television programming services namely, pay per view television services. Used in Canada since at least as early as October 24, 1999
Vu! tv	TMA564,165 June 28, 2002	Business television services, namely providing limited access to a DTH system to a provider for purposes of distributing a signal containing the private business, educational or commercial programming content of such provider, which is intended specifically for a limited audience and which is not intended for distribution to a general audience. Used in Canada since at least as early as August 01, 2000

	<p>TMA564,164 June 28, 2002</p>	<p>Business television services, namely providing limited access to a DTH system to a provider for purposes of distributing a signal containing the private business, educational or commercial programming content of such provider, which is intended specifically for a limited audience and which is not intended for distribution to a general audience. Used in Canada since at least as early as August 01, 2000</p>
<p>EXPRESSVU</p>	<p>TMA454,727 February 23, 1996</p>	<p>(1) Telecommunication products namely satellite dishes, antennas, cables, satellite television receivers, decoder and converter boxes, set top receivers, remote controls, actuators, modulators, encryption devices for residential collective and commercial receiver systems; electronic parts and fittings for the aforesaid products, wires, wire connectors, Computer software for satellite broadcasting, audio speakers, remote extenders, metal hardware namely mounting brackets and tripods; Printed publications, namely magazines that contain program-listing schedules with respect to satellite television systems and pay-per-view television services; Instruction manuals. (1) Communication services, namely: radio and TV broadcasting, and broadcasting distribution; non-programming information and interactive services using satellite signals, namely: all manner of voice, image, text and full motion video communication services and combinations thereof using satellite signals and other technologies. (2) Direct to home broadcasting by satellite. (3) Pay-per-view television services. (4) Broadcasting and distribution of television programs through the</p>

		<p>Global network (Internet). Used in CANADA since at least as early as December 15, 1994 on services (1). Used in CANADA since at least as early as 1994 on wares and on services (2). Used in CANADA since at least as early as 1999 on services (3), (4).</p>
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