



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

Reference: 2016 TMOB 196
Date of Decision: 2016-12-22
[UNREVISED ENGLISH
CERTIFIED TRANSLATION]

IN THE MATTER OF AN OPPOSITION

Druide informatique inc.	Opponent
and	
Éditions Québec-Amérique Inc.	Applicant
1,596,953 for LE VISUEL INTÉGRÉ	Application

Introduction

[1] Éditions Québec-Amérique Inc. (the Applicant) filed registration application No. 1,596,953 on October 4, 2012 for the LE VISUEL INTÉGRÉ trade-mark (the Mark).

[2] The application is based on the use of the Mark in Canada since October 20, 2009. The registration application was amended on June 9, 2014 so that it currently covers the following goods and services:

CD-ROMs containing word definitions and images in the form of illustrations and photographs, CD-ROM comprising educational software, DVD comprising word definitions and images in the form of

illustrations and photographs (hereinafter sometimes collectively referred to as the "Goods"); and
Production and manufacture of CD-ROMs containing word definitions and images in the form of illustrations and photographs; production and manufacture of educational software; production and manufacture of computer software intended for the manufacture, dissemination and use of dictionaries and encyclopedias; production and manufacture of DVDs containing word definitions and images in the form of illustrations and photographs.
Sale of educational software via global computer network (the Internet); distribution and sale of computer software permitting the use of dictionaries and encyclopedias (hereinafter sometimes collectively referred to as the "Services")...

[3] The registration application was published on October 23, 2013 in the *Trade-Marks Journal* for the purposes of opposition.

[4] Druide informatique inc. (the Opponent), on March 21, 2014, filed a statement of opposition, raising the same grounds of opposition based on sections 30(b), (h) and (i), and 2 of the *Trade-marks Act*, RSC (1985), c. T-13 (the Act).

[5] The Applicant filed a counter-statement denying each and every ground of opposition argued by the Opponent.

[6] In support of its opposition, the Opponent filed an affidavit by André d'Orsonnens dated October 9, 2014.

[7] The Opponent subsequently amended its statement of opposition to allege that [TRANSLATION] "the marketing of Le Visuel intégré" was contrary to an agreement between the parties.

[8] The Applicant filed a first affidavit by Caroline Fortin dated February 6, 2015, to which Exhibits A-1 to A-13 are attached. The Applicant, with the permission of the Registrar, also filed an additional affidavit by Ms. Fortin dated May 13, 2015, in order to attach an additional exhibit (Exhibit A-14), in particular.

[9] None of the deponents were cross-examined. Only the Applicant filed written arguments and the two parties were represented at the hearing.

[10] For the reasons more fully described hereinafter, the opposition is accepted.

Preliminary comments

[11] The deponents and the Applicant, in its written arguments, use the expressions "Visuel Intégré", "Visuel intégré" and "*Visuel intégré*", without really distinguishing or defining them, except for Mr. D'Orsonnens, who defines the expression "Visuel intégré" in his affidavit in the manner indicated hereinafter. Moreover, the deponents use the expressions "module Visuel Intégré" (Visuel Intégré module) and "logiciel Visuel Intégré" (Visuel Intégré software), once again without defining them. I will textually reproduce the expressions used when I refer to the evidence of record.

[12] Such as it will appear from the summary of the evidence of record, the parties are involved in court proceedings before the Quebec Superior Court concerning the nature of their business relationship. However, the purpose of these opposition proceedings is only to determine whether the Applicant is entitled to obtain registration of the Mark in association with the Goods and the Services, in view of the grounds of opposition argued and the evidence of record.

[13] Mr. D'Orsennens [sic], in his affidavit, defined several terms, and it is important to reproduce certain definitions to understand on what the parties collaborated:

[TRANSLATION] "Pont informatique" (Gateway) refers to the computer code developed by [the Opponent and the Applicant], which allowed one-click access by users of Antidote (editions 98 to RX) to *Le Visuel* (editions prior to *Le Visuel multimédia édition 4*) (most often on the *Le Visuel* image button) and, conversely, allowed one-click access by users of *Le Visuel* (editions prior to *Le Visuel multimédia édition 4*) to Antidote (editions 98 to RX) (most often on an Antidote image button).

[TRANSLATION] "Visuel intégré" is a distinct software sold by download to Antidote users (HD and future editions), including all the illustrations and the terms in French (with their pronunciation and their definition) of the applicant's *Le Visuel multimédia édition 4* and developed by the opponent to be incorporated into the Antidote software (HD and future editions), such as it appears from the screenshot in Exhibit AD-2 [...]

[14] This case was heard jointly with case No. 1,596,952 for the LE VISUEL NANO mark, involving the same parties and the same grounds of opposition. The Opponent's evidence is identical in both cases, while the Applicant's evidence differs. These cases are the subject of separate decisions.

[15] Finally, I found that both the deponents in their affidavits and the parties during the hearing refer to "logiciel" (software), whereas we find the terms "CD-ROM" and "DVD" in the statement of Goods. I will return to this subject a little later in my decision.

Opponent's Evidence

[16] Mr. D'Orsonnens is Chairman of the Board and Chief Executive Officer of the Opponent, a position he has held since the founding of the Opponent in 1993.

[17] Mr. D'Orsonnens explains that the business relationship between the Opponent and the Applicant [TRANSLATION] "was established on May 13, 1998, when a first Gateway was launched" between the 2nd edition of Antidote (Antidote 98), the Opponent's French writing assistant software, and the first edition of Le Visuel (Le Visuel - Dictionnaire multimédia), The Applicant's illustration software. He explains that this Gateway [TRANSLATION] "has evolved considerably over the years and reached a certain ceiling with the last two products hosted, i.e. Antidote RX and Le Visuel 3 multimédia".

[18] At the time of the simultaneous launch of the Antidote RX and Le Visuel 3 multimédia versions on September 11, 2006, the Applicant, according to Mr. D'Orsonnens, [TRANSLATION] "undeniably was the most important strategic partner" of the Opponent.

[19] According to Mr. D'Orsonnens, at a meeting held on April 8, 2008, it was agreed to improve the existing Gateway by modifying *the Le Visuel Index* effective from the next edition of Antidote, then scheduled for fall 2009, so that it would take the form of a dictionary of illustrations accessible from the list of dictionaries contained in the Antidote software.

[20] According to Mr. D'Orsennens [sic], under its agreement with the Applicant, the Opponent alone assumed the costs for programming of *Le Visuel intégré*, i.e. [TRANSLATION] "a completely autonomous module designed to work only in Antidote and which only [the Opponent] could sell, as it has done continuously since its launch on October 20, 2009". He adds that the Opponent, under the agreement with the Applicant, pays it monthly [TRANSLATION] "50% of the sales of Le Visuel Intégré, the first sales occurring in October 2009".

[21] Mr. D'Orsennens [sic] affirms that the Applicant approved the content of "Le Visuel intégré", prior to its launch on October 20, 2009. The Applicant also approved the rate structure developed by the Opponent for the sale of "Le Visuel intégré".

[22] Mr. D'Orsennens [sic] affirms that, since October 2009, "Le Visuel intégré" has been sold primarily in a single-user version through the Opponent's virtual store, called Boutique Antidote, and he filed a relevant excerpt of this virtual store. He adds that since November 2010, "Le Visuel intégré" has also been sold in a multi-user version, and he filed various invoices (Exhibit AD-4) to prove its continuous marketing. All these invoices were issued by the Opponent.

[23] Mr. D'Orsennens [sic] affirms that the marketing of [TRANSLATION] "Le Visuel intégré relies primarily on [the Opponent's] website" and he attached excerpts from this website as Exhibit AD-5, including a window entitled: "LE VISUEL INTÉGRÉ - Conçu spécialement pour Antidote" (LE VISUEL INTÉGRÉ - Specially designed for Antidote")

[24] Mr. D'Orsennens [sic] also filed excerpts from the Antidote software user guide (Exhibit AD-6) where reference is made to "*Le Visuel intégré*".

[25] Finally, Mr. D'Orsennens [sic] filed as Exhibit AD-7 a copy of the press release published on October 20, 2009 regarding the launch of Le Visuel Intégré. According to Mr. D'Orsennens [sic], it was prepared by the Opponent and approved by Ms. Fortin, Vice-President of the Applicant. I note the following passages:

With the complicity of Éditions Québec Amérique, *Druide informatique* launched *Le Visuel intégré*, a new optional module expressly designed for its Antidote HD language suite. Based on Éditions Québec Amérique's celebrated dictionary, *Le Visuel intégré* adds to Antidote HD...

[...]

The content of *Le Visuel intégré* is based on the French content of the new *Visuel multimédia 4*, obtained under licence from Éditions Québec Amérique. 'For the past twelve years, *Druide* and Québec Amérique have nurtured a very fruitful technical and commercial partnership,' Caroline Fortin declares...

[...]

Le Visuel intégré exists in Windows, Mac and Linux versions. It is offered by download to Antidote HD owners at a price of \$19.95. Up to December 31, 2009, the owners of a

previous edition of Antidote may benefit from an upgrade offer including Antidote HD, Le Visuel intégré and the Le Corps humain CD-ROM at a price of \$88.95.

[26] It appears fairly clear to me from the assertions contained in Mr. D'Orsennens' [sic] affidavit that the Mark has been used effective from October 20, 2009 in association with software. It remains to be known whether this is a use of the Mark in association with the Goods and Services as describe in this application and, in the affirmative, who benefits from it?

Applicant's Evidence

[27] Ms. Fortin has been employed by the Applicant since 1991 and has held different positions with the Applicant. She affirms that, in 2009, she held the position of Vice-President, International with the Applicant. She explains that the Applicant has operated since 1974 in the field of book publishing, software and digital applications. Thus, the Applicant designs, develops and markets original and innovative reference content.

[28] Ms. Fortin affirms that the Mark is derived from the name and trade-mark of the LE VISUEL dictionary and filed as Exhibit A-1 a brief history of the Applicant, conceived in 2011 on the occasion of [TRANSLATION] "the 25th anniversary of this product family". Exhibit A-1 refers to different versions of dictionaries, some titles of which are composed of the word "visuel".

[29] Thus, Ms. Fortin explains that the Applicant produced, in a paper version, a multilingual dictionary entitled LE VISUEL, the first edition of which was published in 1986. According to Ms. Fortin, this was the first visual dictionary. Today, the Applicant's dictionary is in its 4th edition and is translated into more than 35 languages.

[30] Ms. Fortin affirms that the Applicant is the registered owner of the LE VISUEL registered trade-mark. She filed a certified true copy of this registration as Exhibit A-3. She affirms that the LE VISUEL mark is used in association with the goods and services enumerated in the registration certificate, including "CD-ROM comprising educational software, DVD comprising word definitions and images in the form of illustrations and photographs; sale of educational software via global computer network (the Internet)..."

[31] Ms. Fortin explains that the LE VISUEL dictionary was available from 2009 to 2013 in an electronic version, delivered in the form of a download link and marketed under the LE VISUEL MULTIMÉDIA EDITION 4 mark. This is an interactive version of the LE VISUEL (3rd edition) dictionary in paper format, containing over 6000 colour illustrations, organized by theme, on 2300 screens, for more than 32000 terms.

[32] Ms. Fortin affirms that from 1998 to 2009, the Applicant, together with the Opponent, designed and developed a Gateway between the first edition (1996) of the Applicant's LE VISUEL MULTIMÉDIA software and the second edition of the Opponent's software named Antidote (French writing assistant software), [TRANSLATION] "in view of their common use by the users and customers". She affirms that this Gateway was maintained until 2009, when it linked the Antidote RX and LE VISUEL MULTIMÉDIA 3 software.

[33] Ms. Fortin submits that the Applicant holds and has always held all the rights, titles and interests regarding the LE VISUEL dictionary, as well as all the content declensions of this dictionary developed over the years, and particularly the illustrated dictionaries in the form of software, called LE VISUEL MULTIMÉDIA. She affirms that the Applicant has never transferred its rights to their content, nor to the [TRANSLATION] "related trade-marks".

[34] Ms. Fortin affirms that the Mark is part of a diversification dynamic by which the Applicant expands [TRANSLATION] "its *mark family* and explores new modes of distribution of its goods on the market to offer the public new experiences".

[35] Ms. Fortin affirms that [TRANSLATION] "The LE VISUEL INTÉGRÉ software is sold by download to the users of the Antidote software...".

[36] Ms. Fortin points out that [TRANSLATION] "the LE VISUEL INTÉGRÉ software is therefore a distinct product offered in the form of a downloadable module that integrates into Antidote. The illustrations, terminology, definitions and pronunciations of the LE VISUEL INTÉGRÉ software come entirely from the VISUEL MULTIMEDIA ÉDITION 4 dictionary of [Québec Amérique]...".

[37] Ms. Fortin filed as Exhibit A-5 an archived screenshot dated January 15, 2010 of the Applicant's website. I note the following mention:

[TRANSLATION] Le Visuel intégré is a downloadable module, the content of which is accessible only via the Antidote HD interface. Visit the Antidote store for more information or to purchase it online.

[38] Ms. Fortin affirms that on October 20, 2009, the Opponent began to market the seventh edition of its Antidote software, called Antidote HD (the current edition, Antidote 8, having been launched on November 8, 2012). She filed a copy of a press release disseminated on October 20, 2009 as Exhibit A-8, identical to Exhibit AD-7 to Mr. D'Orsennens' [sic] affidavit.

[39] Thus, according to Ms. Fortin, [TRANSLATION] "[the] integration of the LE VISUEL INTÉGRÉ software as an optional component of [the Opponent's] Antidote software constitutes a strategic positioning, allowing [the Applicant] to benefit from [the Opponent's] goodwill and distribution network, thus assuring marketing and promotion of the LE VISUEL INTÉGRÉ software and its content...". In support of this assertion, she filed an advertisement taken from the Antidote user guide and invoices related to this advertisement, attached jointly as Exhibit A-9.

[40] Ms. Fortin claims that since 2009, the parties have tried to agree contractually so that the Opponent distributes its new edition of Antidote while separately distributing and selling [TRANSLATION] "the LE VISUEL INTÉGRÉ module". She affirms that the Applicant tacitly tolerated that the Opponent [TRANSLATION] "begin marketing these products on October 20, 2009 under the promise of reaching a mutual written agreement on the essential conditions of a contract to be negotiated".

[41] Ms. Fortin affirms that [TRANSLATION] "prior to the launch by [the Opponent] of its Antidote HD software on October 20, 2009, with which the LE VISUEL INTÉGRÉ is integrated, and in the months that followed, [the Applicant] sold [the Opponent] many copies of the LE VISUEL INTÉGRÉ software". She filed invoices as Exhibit A-11.

[42] Ms. Fortin affirms that the parties exchanged draft contracts that pertain to a commercial distribution relationship. She filed a draft contract transmitted by the Opponent in 2011 (Exhibit A-10 to her affidavit). She refers to the clauses concerning: marketing (clause 6.1); distribution by the Opponent of the software bearing the Mark in order to generate sales (clause 6.2); the resale price and remittance to the Applicant of a monthly report of the sales of this software (clauses 6.2 and 6.3).

[43] Since the project originated from the Opponent, Ms. Fortin claims that the Opponent itself considered the relationship between the parties to be a software [TRANSLATION] "distribution business relationship" in association with the Mark.

[44] Once Antidote HD software and the software bearing the Mark were put on the market, Ms. Fortin claims that the Opponent refused the Applicant's repeated requests to make a written agreement. She affirms that [TRANSLATION] "the business relationship between the parties" is the subject of a dispute between the parties before the Quebec Superior Court.

[45] Ms. Fortin concludes her affidavit by alleging that the Opponent is acting as an intermediary in the distribution chain through its Antidote software by reselling the software bearing the Mark through the online [TRANSLATION] "Antidote Store", where this software bearing the Mark is offered by paid download (single-user version) and in CD-ROM and DVD-ROM versions. She filed a screenshot of the Opponent's website as Exhibit A-12. She adds that the multi-user version of the software bearing the Mark is also distributed by the Opponent to the end consumer. She filed invoices to this effect as Exhibit A-13. However, I note that the screenshot (Exhibit A-12) makes no reference to a CD-ROM version. However, the possibility is mentioned of procuring a DVD-ROM containing Antidote 8 and Le Visuel intégré.

[46] Ms. Fortin's additional affidavit refers to an invoice filed as Exhibit A-14, issued by the Opponent to the Applicant, representing the sharing of the costs related to production of an advertising clip aimed at supporting [TRANSLATION] "THE SALE OF THE goods and services used in association with the [Mark] to customers of the [O]pponent's Antidote HD software.

[47] According to Ms. Fortin, when Mr. D'Orsonnens refers to this advertising in paragraph 25 of his affidavit, he omits to mention that half the costs were assumed by the Applicant in accordance with the wording of clause 6.7 of the draft contract proposed by the Opponent, filed as Exhibit A-10 in support of Ms. Fortin's affidavit.

My understanding of the Evidence

[48] From the evidence of record, I understand that:

- a business relationship has existed between the parties since 1998 and has taken the form of a licensing agreement relationship for LE VISUEL MULTIMÉDIA 4 (see Exhibit AD-7 to Mr. D'Orsennens' [sic] affidavit);
- for the next steps, the parties agreed to establish a new business relationship concerning the creation of the Le Visuel intégré software, integrated as an option into a new version of the Opponent's Antidote software;
- the Le Visuel intégré software is closely associated with the Opponent's Antidote software;
- the Le Visuel intégré software only works with the Opponent's Antidote product (paragraphs 17 and 21 of Mr. D'Orsennens' [sic] affidavit);
- to procure the Le Visuel intégré software, the consumer must visit the Opponent's website where the Antidote product is offered (with or without the Applicant's assistant);
- the Opponent "controls" the Le Visuel intégré software (paragraph 22 of Mr. D'Orsennens' [sic] affidavit);
- there is no clear notice addressed to consumers to the effect that the LE VISUEL INTÉGRÉ software or module is a product of the Applicant. We find the following notice in the user guide of Antidote version 8, the Opponent's software (Exhibit A-9 to Ms. Fortin's affidavit):

[TRANSLATION] Le **Visuel Intégré**TM is a distinct product, offered in the form of a downloadable module, which integrates with your Antidote. Acquire it inexpensively on:

www.druide.com/boutique

- this new business relationship between the parties was based on a "partnership" and "complicity", "synergy", "merger" and/or "collaboration".

Evidentiary burden

[49] The legal onus is on the Applicant to show that the registration application does not contravene the provisions of the Act. However, the Opponent must discharge the initial burden of proving the facts on which it bases its allegations. The fact that an initial evidentiary burden is imposed on the Opponent means that a ground of opposition will be taken into consideration only if sufficient evidence exists to allow a reasonable conclusion of the existence of the facts alleged in support of this ground of opposition [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* 2002 FCA, 29,

20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* 2005 FC 722, 41, CPR (4th) 223].

Ground of opposition based on the combination of sections 30(b) and (h) of the Act

[50] For the purpose of the following analysis, it is relevant to reproduce the wording of this ground of opposition:

[TRANSLATION] The trade-mark allegedly used is not THE MARK for which the registration was requested, but another mark than the one mentioned in the application under opposition [contrary to sections 30(b) and 30 (h) of the Act];

[51] I pointed out to the Opponent during the hearing that there did not seem to be any evidence of record supporting a ground of opposition based on the combination of sections 30 (b) and (h) of the Act, as was argued in the statement of opposition. The Opponent then answered me that it had no comment on this ground of opposition.

[52] Moreover, I note that there is no evidence of record supporting the argument that the trade-mark used in association with the Goods and Services is not the Mark, but rather another trade-mark.

[53] Accordingly, I reject this ground of opposition described above, since the Opponent has not discharged its initial burden of proof.

Ground of opposition based on section 30(i) of the Act

[54] The wording of the ground of opposition according to section 30(i) reads as follows:

[TRANSLATION] The [A]pplicant falsely declared that it was satisfied it was entitled to use [the Mark] in Canada, because such use would be contrary to an agreement made between the [A]pplicant and the [O]pponent regarding the use of [the Mark] and/or the marketing of Le Visuel intégré (...)

[55] The relevant date for the analysis of this ground of opposition is the filing date of the registration application (October 4, 2012) [see *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 (TMOB)].

[56] Section 30(i) of the Act requires only that the Applicant declares it is satisfied it has the right to use the Mark in Canada in association with the Goods and Services. This statement is included in the present application for registration.

[57] This section of the Act may be invoked in support of a ground of opposition and in very specific cases, such as when the Applicant's statement was made in bad faith [see *Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)].

[58] I find the Opponent did not discharge its initial burden of proving the Applicant's bad faith. Indeed, nothing in the evidence described above leads me to conclude that, on the filing date of this application, the Applicant was in bad faith in declaring that it was satisfied it had the right to use the Mark.

[59] The fact that the parties differ in interpretation regarding the nature of their business relationship or the terms and conditions of the agreement made between them regarding the use of the Mark cannot lead to a conclusion of the Applicant's bad faith in the case at bar.

[60] This ground of opposition is therefore rejected.

Ground of opposition based on section 30(b) of the Act

[61] The Opponent also argues that:

[TRANSLATION] The [A]pplicant has not used [the Mark], within the meaning of section 4 of the Act, in association with each of the goods and each of the services mentioned in the application under opposition, and the date of first use claimed is false (...).

Alternatively or cumulatively, the alleged use (which is denied) of THE MARK in association with each of the goods or each of the services mentioned in the application under opposition is non-continuous, for all or part of the goods or services mentioned in the application under opposition [contrary to section 30 (b) of the Act].

Non-continuous use of the Mark

[62] Regarding the second paragraph of this ground of opposition, there is no evidence of record to the effect that the use of the Mark in association with the Goods and Services was non-continuous.

[63] I must point out that I consider a distinction must be made between "non-continuous use" and "non-use" of a trade-mark. "Non-continuous" use presumes that the trade-mark was used but that this use ceased over time.

[64] Considering that the Opponent has not discharged its initial burden, this ground of opposition is also rejected.

False date of first use

[65] My review of the affidavits of Ms. Fortin and Mr. D'Orsennens [sic] shows that they both agree on the fact that the Mark was used for the first time on October 20, 2009, when the Opponent launched its new version of Antidote, namely Antidote HD. Thus, the date of October 20, 2009 as date of first use of the Mark seems to be accurate.

[66] This part of the ground of opposition reproduced above is therefore rejected.

[67] It remains to be determined whether the Applicant has used the Mark since that date.

Non-use of the Mark by the Applicant since the date of first use

[68] This ground of opposition must be analyzed as of the filing date of the registration application, namely October 4, 2012 [see *Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)] and in light of the evidence of record [see *Novopharm v AstraZeneca AB*, 2002 FCA 387, 21 CPR (4th) 289].

[69] To the extent that an applicant has easier access to the facts, the initial burden incumbent on an opponent regarding the ground of opposition based on non-compliance with section 30(b) of the Act is less heavy [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. An opponent may rely on the applicant's evidence to discharge this

burden, in which case the opponent must show that the applicant's evidence involves the date of first use claimed in the registration application [see *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323, paragr. 30 to 38].

[70] From the wording of the first part of the ground of opposition, the evidence of record and the Opponent's arguments during the hearing, I understand that the Opponent claims that it, and not the Applicant, has used the Mark effective from October 20, 2009. Thus, if this is true, the Applicant would not have used the Mark since October 20, 2009, such as it is alleged in this application.

[71] Although the Applicant was not obliged to establish its date of first use of the Mark in association with the Goods and Services, it chose to file evidence, elements of which can be used by the Opponent to allow it to discharge its initial burden.

[72] I retain from the evidence that:

- It was the Opponent that developed the Le Visuel intégré software;
- It is the Opponent that offers software for sale and sells it on its website in association with the Le Visuel intégré mark;
- A consumer who wishes to procure the Le Visuel intégré software must visit the Opponent's website;
- The Le Visuel intégré software is closely associated with the Opponent's Antidote software;
- In the past, the Applicant has sold CD-ROMs containing other dictionaries in association with other trade-marks.

[73] In my opinion, a certain connection exists between the Le Visuel intégré software and the statement of Goods and Services, and the evidence summarized above is sufficient to conclude that the Opponent has discharged its initial burden to prove that it and not the Applicant has used the Mark since October 20, 2009. Thus, the Applicant had to prove, according to the balance of probabilities, that it has used the Mark since October 20, 2009 in association with the Goods and Services, within the meaning of section 4 of the Act.

[74] It appears from the detailed description of the evidence that the parties refer only to "software" or a "module" to describe the goods sold in association with the Mark. For the

purposes of the following analysis, it is relevant to reproduce the definition of the Goods and Services:

CD-ROMs containing word definitions and images in the form of illustrations and photographs, CD-ROM comprising educational software, DVD comprising word definitions and images in the form of illustrations and photographs.(hereinafter sometimes collectively referred to as the "Goods"); and

Production and manufacture of CD-ROMs containing word definitions and images in the form of illustrations and photographs; production and manufacture of educational software; production and manufacture of computer software intended for the manufacture, dissemination and use of dictionaries and encyclopedias; production and manufacture of DVDs containing word definitions and images in the form of illustrations and photographs.

Sale of educational software via global computer network (the Internet); distribution and sale of computer software permitting the use of dictionaries and encyclopedias (hereinafter collectively referred to as the "Services").

[75] I find there is no allegation in Ms. Fortin's affidavits pertaining to the use of the Mark in association with the Goods and Services, as defined in this application, except for an allegation to the effect that the Le Visuel intégré software was available in CD-ROM and DVD versions. However, I have no evidence of the sale of CD-ROMs or DVDs containing educational software in association with the Mark.

[76] There is the screenshot of the Opponent's website (Exhibit A-7), which proves that the Le Visuel intégré software was offered by the Opponent in a DVD version (Exhibit AD-12), but I have no evidence that DVDs containing education software were sold by the Applicant in association with the Mark.

[77] In any event, even if I had evidence that consumers ordered the Le Visuel intégré software from the Opponent in a CD-ROM version, this sale would not constitute a use of the Mark by the Applicant within the meaning of section 4(1) of the Act, for the reasons described hereinafter.

[78] The Applicant would like me to conclude that the new business relationship is one in which the Opponent acts as a mere distributor of the Applicant. Thus, the sales of the Le Visuel intégré software by the Opponent would benefit the Applicant [see *Lin Trading Co v CBM*

Kabushiki Kaisha (1988) 21 CPR (3d) 417, [1989] 1 FC 620 (FCA)]. I am not convinced this is the case. From the evidence of record, I understand this new business relationship concerning the creation of the Le Visuel intégré software was based on a "partnership" and a "complicity", "synergy", "merger" and/or "collaboration" between the parties. Thus, this new business relationship appears, in my opinion, to go beyond a mere distribution relationship, in view of the role played by the Opponent in the creation of the Le Visuel intégré software.

[79] The evidence proves the sale of "Visuel intégré Antidote" software by the Applicant to the Opponent (see the invoices filed as Exhibit A-11 to Ms. Fortin's affidavit), an expression appearing on the invoices under the "description" heading of the goods sold to the Opponent. However, for the following reasons, I do not consider these sales as sales of Goods or Services, as described in this application.

[80] First of all, Ms. Fortin does not provide any explanation of what the expression "Visuel intégré Antidote" represents.

[81] Moreover, I notice that these invoices mention sales of other software on CD. For the "Visuel intégré Antidote" product, we find the expression "URL" in the description of the goods sold. The Larousse French dictionary defines this term as follows:

[TRANSLATION] acronym of the English term uniform resource locator, (localisateur universel de ressources).

Electronic address that allows a site or a document to be located on the Internet, and that indicates the method for accessing it, the access path and the filename.

[82] This therefore concerned the sale of software by download, and not on CD-ROM or DVD.

[83] In view of the evidence of record, I cannot further conclude that a licence exists between the parties for the use of the Mark. Although the press release (Exhibit AD-7) mentioned that the Opponent used the content of Le Visuel multimédia 4 [TRANSLATION] "under licence", such "licence" is not alleged by Ms. Fortin concerning the Le Visuel intégré software. In clause 2.2 of the draft agreement, Exhibit A-10 to Ms. Fortin's affidavit, I found the mention of a licence granted by the Applicant to the Opponent for Le Visuel intégré. This is a mere draft contract, the contents of which is the subject of a dispute between the parties.

[84] Also, even if I concluded that the Opponent was a licensee, there is no evidence of record of the existence of control mechanisms on the part of the Applicant regarding the use of the Mark by the Opponent concerning the Le Visuel intégré software [see section 50 of the Act] when it is sold as an option during the sale of the Opponent's Antidote HD software.

[85] For all these grounds, I cannot conclude that the Opponent was acting as a distributor or a licensee of the Applicant when it sold the Le Visuel intégré software by download on its website.

[86] Consequently, the Applicant has not used the Mark since October 20, 2009 in association with the Goods.

Use in association with the Services

[87] I remind the parties that the evidence proves that it was the Opponent who proceeded with the creation of the Le Visuel intégré software and its integration as an optional product with the Opponent's Antidote software. Thus, if there was any use the Mark in association with any service whatsoever, this was a use by the Opponent.

[88] In my opinion, a certain connection exists between this work and the statement of Goods and Services, and the evidence summarized above is sufficient to conclude that the Opponent has discharged its initial burden to prove that it and not the Applicant has used the Mark since October 20, 2009 in association with the Services. Thus, the Applicant had to prove that it has used the Mark since October 20, 2009 in association with the Goods and Services, within the meaning of section 4 of the Act.

[89] From my understanding of the evidence, it is clear that the Applicant has not offered any of the Services to third parties in association with the Mark since October 20, 2009.

[90] In the circumstances, I conclude that the Applicant has not discharged its burden to prove it has used the Mark in association with the Services since October 20, 2009.

Conclusion

[91] I therefore accept the ground of opposition based on section 30(b) of the Act for all of the Goods and Services.

Ground of opposition based on non-distinctiveness of the Mark

[92] This ground of opposition is worded as follows:

The Opponent bases its opposition on section 38(2)(d) of the Act, namely that with regard to the provisions of section 2 of the Act (definition of "distinctive"), [the Mark] for which the applicant is applying for registration is not distinctive of the goods and services referred to by this registration application nor can it be adapted to distinguish them due to the agreement made between the Applicant and the Opponent regarding the use of [the Mark] and/or the marketing of Le Visuel intégré.

[93] This ground of opposition must be analyzed as of the filing date of the statement of opposition (March 21, 2014) [see *Andres Wines Ltd v E&J Gallo Winery* (1975), 25 CPR (2d) 126 (FCA) and *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

[94] From My understanding of the evidence, I retain that:

- the Le Visuel intégré software is closely associated with the Opponent's Antidote software;
- the Le Visuel intégré software only works with the Opponent's Antidote product (paragraphs 17 and 21 of Mr. D'Orsennens' [sic] affidavit);
- to procure the Le Visuel intégré software, the consumer must visit the Opponent's website where the Antidote product is offered (with or without the Applicant's assistant);
- the Opponent "controls" the Le Visuel intégré software (paragraph 22 of Mr. D'Orsennens' [sic] affidavit);
- this new business relationship between the parties was based on a "partnership" and "complicity", "synergy", "merger" and/or "collaboration".

[95] This evidence proves that the Opponent used the Mark in association with software, a product related to the Goods and Services described in this application, for the reasons expressed in my analysis of the previous ground of opposition. This is sufficient to allow the Opponent to discharge its initial burden under this ground of opposition. Consequently, the Applicant had to prove that, due to its use, the Mark had become distinctive of its Goods and Services as at March 21, 2014.

[96] However, as I concluded on the previous ground of opposition, I have no evidence of use of the Mark by the Applicant in association with the Goods and Services. Although the previous ground of opposition was analyzed as at a previous date, I have no evidence of use of the Mark by the Applicant between October 20, 2009 and March 21, 2014.

[97] The evidence of record proves the sale of the Le Visuel intégré software by the Opponent in concert with the sale of its Antidote software. I have already determined that the Applicant could not benefit from this use, on the one hand, because I am not convinced that the Opponent acted as a mere distributor of the Applicant, and on the other hand, because I am also not convinced that the Opponent acted as a licensee of the Applicant. In any event, the Applicant has not established that it exercised control over the character or the quality of the Goods and Services, within the meaning of section 50 of the Act.

[98] Did this use of the Mark by the Opponent in the context described above render the Mark non-distinctive within the meaning of section 2 of the Act? To answer this question, I must refer to the criteria enumerated in section 6(5) of the Act.

[99] The parties did not address this question during the hearing. Yet the Le Visuel intégré mark used by the Opponent in association with software is identical to the Mark. The degree of resemblance between the marks involved is the most important criterion of those described in section 6(5) of the Act [see *Masterpiece Inc v Alavida Lifestyles Inc* [2011] 2 SCR 387, 92 CPR (4th) 361], especially when there is an overlap between the goods and services of the parties, as was the case on March 21, 2014 (sections 6(5)(c) and (d)). Indeed, the sale by download of the Le Visuel intégré software was related to what is described in the registration application as the sale of CD-ROMs or DVDs containing software.

[100] I must point out that, at best for the Applicant, the evidence of record proves that the Mark was associated not only with the Applicant but also with the Opponent, because the Le Visuel intégré software was sold through the Opponent's Antidote software. Thus, the Applicant could claim to be co-holder of the Mark. However, in this case, this co-holding has not been alleged in support of this application.

[101] In the circumstances, as at March 21, 2014, the Mark was not distinctive of the Applicant's Goods and Services due to the sale by the Opponent in Canada of the Le Visuel intégré software.

[102] I therefore also accept this ground of opposition.

Disposal

[103] In exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, I refuse the registration application according to the provisions of section 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Arnold Bennett

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: 2016-10-28

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