



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

**Reference: 2016 TMOB 195
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
1,596,952 for LE VISUEL NANO	Application

Introduction

[1] Éditions Québec-Amérique Inc. (the Applicant) filed registration application No. 1,596,952 on October 4, 2012 for the LE VISUEL NANO 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 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 the affidavit by André d'Orsonnens dated October 9, 2014 and Exhibits AD-1 to AD-7.

[7] The Opponent then amended its statement of opposition to include the use of [TRANSLATION] "the Visuel nano mission".

[8] The Applicant filed the affidavit by Caroline Fortin dated February 6, 2015, to which Exhibits A-1 to A-10 are attached.

[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] Mr. D'Orsonnens uses the terms "Visuel nano" and "*Le Visuel nano*" in his affidavit. "Visuel nano" is a term defined in his affidavit and I reproduce its definition below. Ms. Fortin

uses the expressions "LE VISUEL NANO" and [TRANSLATION] "the LE VISUEL NANO software" in her affidavit. The Applicant uses the term "the Mark" in its written arguments to refer to the LE VISUEL NANO trade-mark. In the absence of explanations of the distinctions between these different expressions, I presume they all refer to the Mark used in association with software.

[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'Orsonnens, in his affidavit, defined several terms, and it is important to reproduce some of these 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] "Le Visuel": is illustration software (with terminology and pronunciation) developed by the [A]pplicant, the 4th edition of which, delivered in the form of a download, is marketed under the name *Le Visuel multimédia édition 4* and the previous editions of which, delivered in the form of a CD-ROM, were successively named *Le Visuel-Dictionnaire multimédia*, *Le Nouveau Dictionnaire Visuel multimédia* and *Le Visuel 3 multimédia*.

[TRANSLATION] "Visuel Nano": a window developed by the [O]pponent, including all the illustrations in reduced format and all the terms in French (without their pronunciation or definition) from the [A]pplicant's *Visuel multimédia édition 4*.

[TRANSLATION] "Index du Visuel" (Le Visuel Index): is a window introduced by *Druide* in *Antidote Prisme* (a previous edition of *Antidote*) reproducing all the contents of the alphabetical and thematic index of the [A]pplicant's *Le Visuel 3 multimédia*, including all the illustrations in reduced format and all the terms in French (without their pronunciation or definition).

[TRANSLATION] "Index sémantique" (Semantic Index): refers to a computer file containing a list of words, each giving access to a series of terms (all illustrated in *Le*

Visuel multimédia édition 4), classified semantically, from the most general meaning to the most specific meaning. The *Semantic Index*, developed by the [O]pponent, has been implemented in *Le Visuel nano* and in *Le Visuel intégré*, rendering navigation in them different from that of the [A]pplicant's *Le Visuel multimédia édition 4*.

[14] This case was heard jointly with case No. 1,596,953 for the LE VISUEL INTÉGRÉ 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] Mr. D'Orsonnens affirms that on January 10, 2008, during a meeting to discuss, in particular, the [TRANSLATION] "Gateway at the time between Antidote RX and Le Visuel 3", the Applicant wanted to eliminate the Gateway and asked the Opponent if it [TRANSLATION]

"would accept to go even farther by integrating into Antidote not only the vignettes of the Le Visuel Index, but also all the French content of Le Visuel".

[20] The Opponent's response, according to Mr. D'Orsonnens, in view of the technical and commercial difficulties inherent in such a project, was that it [TRANSLATION] "was more worthwhile to concentrate first on the evaluation of the Le Visuel Index necessary both for improvement of the Gateway and for a possible integration of the content of Le Visuel into Antidote".

[21] 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. In order to take the form of an Antidote dictionary, the Le Visuel Index had to be replaced with a brand-new Semantic Index developed by the Opponent at its expense. At that time, the vignettes (illustrations of reduced size) were going to remain the same as those used until then in the Le Visuel Index.

[22] Thus, according to Mr. M. D'Orsonnens, on May 15, 2008, the Opponent [TRANSLATION] "started the work to produce the *Semantic Index*, and thereby the dictionary of illustrations that eventually would be known as *Le Visuel Nano*, (a name imagined by [the Opponent] and approved by Ms. Caroline Fortin, Vice-President of [the Applicant], in the course of a meeting held on August 17, 2009)".

[23] Later, according to Mr. D'Orsonnens, the parties [TRANSLATION] "came to wish that Le Visuel nano could convince Antidote users of the usefulness of acquiring Le Visuel and that it could subsequently be transformed into a module programmed by [the Opponent] displaying all the French content of Le Visuel directly in Antidote". This would lead to the development of the LE VISUEL INTÉGRÉ software, which is the object of another registration application by the Applicant, also opposed by the Opponent.

[24] Mr. D'Orsonnens affirms [TRANSLATION] "that under the agreement between the parties....Le Visuel nano is part of Antidote (it has been included in the purchase of Antidote

since edition HD) and generates no revenue for the Applicant because it is intended to promote the sale of *Le Visuel Intégré*".

[25] Finally, Mr. D'Orsonnens filed as Exhibit AD-6 excerpts from the user guide of the Opponent's Antidote HD software. I retain the following passage from this excerpt under the heading:

[TRANSLATION] The approximately 6000 illustrations that constitute this dictionary are simplified reduced versions of the original images of *Le Visuel*, the celebrated reference work published by Éditions Québec Amérique. Together, these illustrations form *Le Visuel nano*. The dictionary of illustrations provides all the known illustrations from *Le Visuel nano* regarding the featured word, ordered according to the various meanings of the word.

[26] Mr. D'Orsonnens' other allegations concern the LE VISUEL INTÉGRÉ software and are thus not relevant for the purposes of this case.

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. Although she refers to a copy filed as Exhibit A-2, I told the parties there was no copy on the record. However, there is a copy that was

filed in case No. 1,596,953 for the LE VISUEL INTÉGRÉ mark. During the hearing, the Opponent accepted that reference be made to it without having to file a copy for the present case.

[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 declares that the Mark is being registered in a process of continuity and diversification of the Applicant's offering of services to deal with a constantly changing market.

[33] Ms. Fortin explains that the Applicant has made considerable investments over the years to design, develop and market the interactive versions LE VISUEL MULTIMÉDIA ÉDITIONS 1, 2, 3 and 4, always reusing the content of the different versions of the LE VISUEL dictionary, paper format.

[34] 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.

[35] 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".

[36] Ms. Fortin explains that the Mark refers to [TRANSLATION] "a window integrated into the Antidote software, containing all the illustrations in reduced format and all the French terms of the LE VISUEL MULTIMÉDIA 4 software". She filed as Exhibit A-5 a screenshot of the Opponent's Antidote software; the Mark and the following note are found on this page: [TRANSLATION] "Reduced images of Le Visuel. Rights reserved © 2009, Éditions Québec-Amérique».

[37] Ms. Fortin alleges that by [TRANSLATION] "entering a word in the search tab, the user of the Antidote software obtains in the form of vignettes (LE VISUEL NANO) all the illustrations pertaining to this word, displayed in rows and classified by meaning". She filed an excerpt from the user guide of the Antidote software (editions HD and 8) as Exhibit A-6 (Exhibit A-6 is identical to Exhibit AD-6 in Mr. D'Orsennens' [sic] affidavit, an excerpt of which is cited above). Ms. Fortin refers to these vignettes as LE VISUEL NANO.

[38] We find the following passage in the user guide of Antidote edition 8:

Dictionnaire Visuel nano™

[TRANSLATION] The approximately 6,000 illustrations that constitute this dictionary are simplified reduced versions of the original images of *Visuel*™, the celebrated reference work published by Éditions Québec Amérique. The Visuel nano™ dictionary provides the illustrations pertaining to the featured word, ordered according to the various meanings of the word.

[39] Ms. Fortin affirms that on October 20, 2009, the Opponent began to market the seventh edition of its Antidote French writing assistant software, called Antidote HD (the current edition, Antidote 8, was launched on November 8, 2012), of which the LE VISUEL NANO dictionary of illustrations is an integral part. To this effect, she filed a copy of the press release disseminated on October 20, 2009 as Exhibit A-8 (exhibit identical to Exhibit AD-7 to Mr. D'Orsonnens' affidavit).

[40] Ms. Fortin affirms that it was through the integration process described previously that the LE VISUEL NANO dictionary of illustrations (resulting from the LE VISUEL

MULTIMÉDIA ÉDITION 4 software) was distributed through the Opponent's Antidote HD software. Thus, according to Ms. Fortin, the Applicant benefited from the Opponent's goodwill and distribution network to promote the different products of the Applicant's LE VISUEL mark family.

[41] 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".

[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 as Exhibit A-9. She refers to the clauses concerning: marketing (clause 6.1); distribution by the Opponent of the software bearing the LE VISUEL INTÉGRÉ 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] Once Antidote HD software, LE VISUEL INTÉGRÉ 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 before the Quebec Superior Court.

[44] Ms. Fortin declares, although the parties are in litigation, that the contract filed as Exhibit A-9 proves that the Opponent itself considered the relationship between the parties to be [TRANSLATION] "a distribution business relationship" regarding the software in association with the Mark. She affirms that clauses 6.1, 6.2 and 9.1 of this draft contract prepared by the Opponent support her position. However, these clauses refer to the LE VISUEL INTÉGRÉ software. Moreover, this contract was not signed by the parties and therefore does not bind them.

[45] Ms. Fortin concludes by alleging that the Opponent, [TRANSLATION], "through its Antidote software into which the LE VISUEL NANO dictionary of illustrations is incorporated,

resells the goods and services related to the [Mark] to the end consumer". She filed invoices jointly to this effect as Exhibit A-10. However, these invoices were issued by the Opponent, not by the Applicant, and they all refer to the LE VISUEL INTÉGRÉ mark and not to the Mark.

My understanding of the Evidence

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

- Le Visuel nano was an integral part of the Opponent's Antidote HD software;
- Le Visuel nano was not a product or service the consumer could procure independently of any other product or service;
- The Applicant has not proved the existence of a sales control mechanism for the Opponent's Antidote HD software into which its illustrations forming what is called Le Visuel nano would be integrated;
- The use of a previous version of the Applicant's product, Visuel multimédia 4, by the Opponent, was under licence, whereas for Le Visuel nano, the Applicant has not alleged and proved the existence of such a licence [see the text of the press release reproduced above, Exhibit AD-7 to Mr. D'Orsonnens' affidavit];
- a business relationship 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'Orsonnens' [sic] affidavit);
- for the next steps, the parties agreed to establish a new business relationship concerning the creation of the Le Visuel nano software, integrated as an option into a new version of the Opponent's Antidote software;
- this new business relationship between the parties was based on a "partnership" and "complicity", "synergy", "merger" and/or "collaboration".

Evidentiary burden

[47] 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

[48] 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];

[49] 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.

[50] 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.

[51] 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

[52] 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 (...)

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

[54] 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.

[55] 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)].

[56] 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.

[57] 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.

[58] This ground of opposition is therefore rejected.

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

[59] 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

[60] 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.

[61] 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.

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

False date of first use

[63] 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. Thus, the date of October 20, 2009 as date of first use of the Mark seems to be accurate.

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

[65] 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

[66] 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].

[67] 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].

[68] 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.

[69] 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.

[70] I retain from the evidence that:

- It was the Opponent who developed the Le Visuel nano dictionary from the Applicant's illustrations;
- The Le Visuel nano dictionary was an integral part of the Opponent's Antidote HD software;
- It was the Opponent who offered its Antidote HD software, into which the Le Visuel nano dictionary was integrated, for sale and sold it on its website;
- The consumer could not procure Le Visuel nano without purchasing the Opponent's Antidote HD software;
- In the past, the Applicant has sold CD-ROMs containing other dictionaries in association with other trade-marks.

[71] In my opinion, a certain connection exists between Le Visuel nano 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.

[72] Thus, was the Mark used by the Applicant in association with the Goods and Services, within the meaning of section 4 of the Act?

Use in association with the Services

[73] I understand from the evidence of record that *Le Visuel nano* is [TRANSLATION] "a window integrated into the Antidote software, containing all the illustrations in reduced format and all the French terms of the LE VISUEL MULTIMÉDIA 4 software" (see paragraph 19 of Ms. Fortin's affidavit) of the Applicant. Ms. Fortin concludes by alleging that [TRANSLATION], "[the Opponent], through its Antidote software into which the LE VISUEL NANO dictionary of illustrations is incorporated, resells the goods and services related to the [Mark] to the end consumer" (see paragraph 29 of Ms. Fortin's affidavit).

[74] I find there is no claim by Ms. Fortin pertaining to the use of the Mark in association with the Goods and Services, as defined in this application.

[75] I remind the parties that Mr. D'Orsonnens affirms that *Le Visuel nano* was part of Antidote HD, because it was included in the purchase of Antidote since the Antidote HD edition and generated no revenue for the Applicant because it was intended to promote the sale of other software, namely *Le Visuel Intégré*.

[76] The Mark appears in the screenshot of the Opponent's Antidote HD software (Exhibit A-5 to Ms. Fortin's affidavit), but the Antidote HD software is sold by the Opponent and not by the Applicant. I have no proof of sales by the Applicant of Goods as defined above, effective from October 20, 2009, in association with the Mark.

[77] In any event, even if I had evidence that consumers ordered the Antidote HD 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 between the parties is one in which the Opponent acts as a mere distributor of the Applicant. Thus, the sales of the Antidote HD software, which includes *Le Visuel nano*, 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 cannot subscribe to such an argument.

[79] From the evidence of record, I understand this new business relationship concerning the creation of the Le Visuel nano software was based on a "partenariat" (partnership) and a "complicité" (complicity), "synergie" (synergy), "fusion" (merger) and/or "collaboration" between the parties. We find these words in the press release, Exhibit AD-7 to Mr. D'Orsennens' [sic] affidavit and in the affidavits of Mr. D'Orsonnens and Ms. Fortin. 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 nano dictionary.

[80] 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 Le Visuel nano. In clause 2.1 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 the use of the Applicant's illustrations grouped under Le Visuel nano. This is a mere draft contract, the contents of which is the subject of a dispute between the parties.

[81] 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 when it was selling its Antidote HD software into which Le Visuel nano was integrated [see section 50 of the Act].

[82] I would add that the fact the copyright to the illustrations belongs to the Applicant does not necessarily imply, in light of the facts described above, that it used the Mark in association with the Goods on the date of first use alleged in its registration application, when the Opponent sold its Antidote HD software into which Le Visuel nano was integrated.

[83] For all these grounds, I cannot conclude that the Opponent was acting as a distributor or a licensee of the Applicant when it sold its Antidote HD software to consumers, beginning on October 20, 2009.

[84] I have no evidence that the Applicant sold CD-ROMs and DVDs in association with the Mark. I remind the parties that the statement of goods does not include "educational software" among the goods, but rather "CD-ROM comprising educational software".

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

Use in association with the Services

[86] Mr. D'Orsonnens alleges that it was the Opponent who started [TRANSLATION] "the work to produce the *Semantic Index* and thereby the dictionary of illustrations that eventually would be known as *Le Visuel nano*" (see paragraph 12 of Mr. D'Orsonnens' affidavit). Also, it was the Opponent who integrated illustrations into its Antidote HD software.

[87] 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.

[88] I have no evidence of advertising of the Services in association with the Mark originating from the Applicant. I have no invoice issued by the Applicant for provision of the Services. I have no evidence of record that the Applicant, since the alleged date of first use, has offered the Services for the benefit of third parties in association with the Mark.

[89] Thus, 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 nano.

[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 and 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] I remind the parties that the evidence proves that:

- The Mark has been associated with the Opponent's Antidote HD product;
- Le Visuel nano has been associated into the Opponent's Antidote HD product;
- It was the Opponent who controlled Le Visuel nano;
- 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 a dictionary of illustrations integrated into its Antidote HD software. This dictionary of illustrations constituted a product related to the Goods and Services described in this application. 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 that the Le Visuel nano dictionary of illustrations was integrated into the Opponent's Antidote HD 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 nano mark used by the Opponent to designate a dictionary of illustrations 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 Le Visuel nano dictionary of illustrations constituted a product related to the Goods and Services described in the legislation application.

[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 nano dictionary of illustrations was only integrated into the Opponent's Antidote HD software. Thus, at best, 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.

[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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