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

Citation: 2017 TMOB 179

Date of Decision: 2017-12-19

IN THE MATTER OF AN OPPOSITION

Brilliant Inc.

Opponent

and

Digiflare Inc.

Applicant

1,669,583 for VIDEA

Application

INTRODUCTION

[1] Brilliant Inc. (the Opponent) opposes registration of the trade-mark VIDEA (the Mark), filed by Digiflare Inc. (the Applicant).

[2] For the reasons that follow, I refuse the application.

THE RECORD

[3] On March 25, 2014 the Applicant filed the application bearing serial No. 1,669,583. The application has been amended and now covers:

Computer software for the streaming of audio and video via the Internet to mobile telephones, computer tablets, laptop computers, and other mobile devices (the Goods).

[4] The application is based on use in Canada since at least as early as February 2013 and was published on December 17, 2014 in the *Trade-marks Journal* for the purposes of opposition.

[5] On February 3, 2015 the Opponent filed a statement of opposition. It was amended on a couple of occasions. In fact, on February 18, 2016, the Registrar granted leave to the Opponent to further amend its statement of opposition to add a ground of opposition based on section 12(1)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) subsequent to the Opponent obtaining the registration of its trade-mark VIDEA (registration No. TMA920,266).

[6] Therefore the Opponent is now raising the following grounds of opposition: non-compliance with sections 30(a), (b) and (i), section 12(1)(d) (registrability), section 16(1)(a) (entitlement) and 2 (distinctiveness) of the Act.

[7] The Applicant filed a counter statement on April 4, 2015 denying each ground of opposition originally pleaded. I note that the Applicant did not file an amended counter statement to deny the additional ground of opposition (registrability under section 12(1)(d) of the Act). This omission will not have an impact on the outcome of this opposition as it will appear from a reading of my decision.

[8] I also note that the original application was filed to cover “services”. The Applicant, after the advertisement of its application and after the filing of the Opponent’s statement of opposition, amended its application stating that the description of the “services” was a clerical error as the “services” should have been identified as “goods”. It was changed accordingly.

[9] The Opponent filed as its evidence the Affidavit of Ellen Zabitsky, sworn July 14, 2015 together with Appendices A to S as well as a certified copy of registration TMA920,266 for the trade-mark VIDEA.

[10] The Applicant filed as its evidence the affidavits of Sandro Romero, sworn November 18, 2015 together with Exhibit SR-1. It also filed the affidavits of Arun Kirupanathan, David George and Manotharan Kulasingam.

[11] The Registrar issued an order for the cross-examination of Arun Kirupanathan, David George and Manotharan Kulasingam on April 12, 2016. On October 24, 2016 the Registrar

declared those affidavits no longer of record and returned them to the Applicant for failure by those deponents to attend their cross-examination as ordered.

[12] Only the Opponent filed written arguments and no hearing was held.

EVIDENTIARY BURDEN

[13] The legal onus is on the applicant to show that the application complies with the provisions 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. Once this initial burden is met, the applicant has to prove, on a balance of probabilities, that the particular ground of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB), *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD), and *Wrangler Apparel Corp v The Timberland Company* [2005] FCJ No 899, (FC)].

PRELIMINARY REMARKS

[14] In reaching my decision I have considered all the evidence in the file. However, I shall refer only to those portions of the evidence which are directly relevant to the issues discussed in the body of my decision.

GROUND OF OPPOSITION SUMMARILY DISMISSED

[15] The Opponent pleads that:

- the services described in the original application were not described in ordinary commercial terms (section 30(a) of the Act);
- the Applicant did not use the Mark in Canada as of the claimed date of first use in association with the services listed in the original application (section 30(b) of the Act).

[16] These grounds of opposition are dismissed as the Opponent did not file any evidence to meet its initial burden with respect to them.

[17] As for the ground of opposition that the correction entered on the trade-marks register was made in error, the Opponent argues that the Applicant's request to amend its application was defective as "(...) the Applicant in its April 10, 2015 request for a correction failed to describe what the so-called clerical error was...".

[18] However, in its aforesaid request, the Applicant stated:

A revision to application #1669583 for trademark "VIDEA" has been made to address a clerical error that caused the statement of wares to appear in the services section.

[19] The Registrar was satisfied with such explanation and accepted the amendment accordingly. There is no reason for me to reconsider such decision by the Registrar.

[20] In summary, I dismiss the grounds of opposition described in paragraphs 3(a)(i), 3(a)(ii)(A) and (C) of the Further Amended Statement of Opposition.

GROUND OF OPPOSITION BASED ON SECTION 12(1)(D) OF THE ACT (REGISTRABILITY)

[21] The material date to analyze this ground of opposition is the date of the Registrar's decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA)].

[22] As mentioned previously, the Opponent filed, as part of its evidence, a certified copy of registration TMA920,266 for the trade-mark VIDEA. I checked the register and that registration is still extant. It covers film production namely video animation production services for others (the Opponent's services). Therefore, the Opponent has met its initial burden with respect to this ground of opposition.

[23] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks or trade names have been in use; the nature of the goods, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each

one of them equal weight [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC), *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC)].

[24] The test under section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether a consumer, with an imperfect recollection of the Opponent's trade-mark VIDEA, who sees the Applicant's Goods in association with the Mark, would think they emanate from, or are sponsored by, or approved by the Opponent.

The degree of resemblance

[25] As indicated by the Supreme Court of Canada in *Masterpiece*, in most instances, the degree of resemblance between the marks in issue is the most important relevant factor. In this case the marks are identical.

[26] This factor clearly favours the Opponent.

The nature of the goods and services

[27] Under a section 12(1)(d) ground of opposition, I must compare the goods as described in the application with the Opponent's services as listed in its registration [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 at 10-11 (FCA); *Henkel Kommanditgesellschaft v Super Dragon* (1986), 12 CPR (3d) 110 at 112 (FCA); *Miss Universe Inc v Dale Bohna* (1994), 58 CPR (3d) 381 at 390-392 (FCA)]. However, those statements must be read with a view to determine 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 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[28] Ms. Zabitsky is the Opponent's President. She states that the Opponent is involved, amongst other, in film production namely video animation production in association with the trade-mark VIDEA.

[29] Ms. Zabitsky explains that the Opponent's VIDEA animations are produced for digital and mobile media, meaning that upon completion they can immediately be streamed to or distributed on or in almost any digital media vehicle or any digital media device (such as mobile devices, a smart phone, digital notebooks, or the like), or they can immediately be uploaded to social media sites (such as Facebook, Twitter, YouTube, Google+, Instagram).

[30] Ms. Zabitsky further states that every single VIDEA animated video that the Opponent produces for its clients is output in multiple digital versions, and as a result, the Opponent's clients are able to execute/distribute the VIDEA animated videos on any screen, anywhere.

[31] As for the Opponent's clientele, Ms. Zabitsky affirms that they include large blue chip companies in any field of activity, small to medium businesses in any field of activity, advertising agencies who seek its expertise in producing animated videos on behalf of their own clients, consultants and professional firms who wish to explain unique or other aspects of their professional practice, multimedia companies, not for profits/non-governmental organizations, digital content agencies and charitable organizations.

[32] To support such contention, Ms. Zabitsky filed, as Appendixes E to M to her affidavit, invoices issued to Opponent's clients for the production of animated videos in association with the trade-mark VIDEA. Together with some of these invoices, there are screenshots of the videos produced on which appear the trade-mark VIDEA. The first Canadian client was DealerMine Inc., of Saint John, New Brunswick. The Opponent's invoice issued to such client is dated January 7, 2011.

[33] From this description of the Opponent's services in association with its trade-mark VIDEA and the description of the Goods, I conclude that there could be a relationship between the parties' goods and services as it is possible that the Applicant's software could be used in the production of the Opponent's videos.

[34] As for the parties' respective businesses, there is no evidence of the nature of the Applicant's business. Ms. Zabitsky filed as Appendix S to her affidavit what she alleges to be pages from the Applicant's website. From such exhibit, and without any further explanation, it is difficult to determine what the Applicant's business is in fact. The extracts filed refer to "kids' content", "parental control", Windows' environment and the Mark.

[35] Given the nature of the Opponent's services as described in Mr. Zabitsky's affidavit and the absence of evidence on the Applicant's nature of its business it is difficult to determine whether there is an overlap or not in the parties' businesses. However, as mentioned previously, the burden is on the Applicant to show, through the analysis of these relevant factors, that there is no likelihood of confusion between these identical marks.

Length of time the trade-marks have been in use

[36] The evidence shows that the Opponent has been using its trade-mark VIDEA in association with the Opponent's services since at least January 7, 2011 [see invoice filed as Appendix E to Ms. Zabitsky's affidavit] while there is no evidence of use of the Mark in Canada.

[37] This factor also favours the Opponent.

Inherent distinctiveness of the marks and the extent to which they have become known

[38] The marks in issue being identical, their degree of inherent distinctiveness is the same.

[39] The degree of distinctiveness of a trade-mark can be enhanced through its use and promotion in Canada. The Applicant filed no evidence of use of the Mark in Canada.

[40] As for the Opponent's use of its trade-mark VIDEA, in addition to the evidence described above, Ms. Zabitsky has provided details of promotional activities carried on by the Opponent in association with its trade-mark VIDEA, including:

- The existence of a website (see Appendix N);
- Social media presence on YouTube, LinkedIn, Twitter, Facebook, Instagram and Google+ (see Appendix P);
- Email campaign in Canada;
- Google Adwords campaign (see Appendix Q);

- Attendance at conferences offered by the Canadian Marketing Association.

[41] Moreover, Ms. Zabitsky has provided the Opponent's yearly revenues earned from its Canadian clients through services rendered in association with its trade-mark VIDEA in Canada for the years 2011 to 2015 inclusive. They total more than \$130,000.

[42] Again, this factor favours the Opponent.

State of the register evidence

[43] In its written argument, the Opponent states that, in view of the return of the affidavits of Arun Kirupananthan, David George and Manotharan Kulasingam, the Applicant has no evidence in the record. The Opponent is omitting the affidavit of Sandro Romero. His affidavit is still part of the record as there was no order issued by the Registrar concerning his cross-examination.

[44] Mr. Romero is a trade-mark research-analyst working for Thomson CompuMark, an intellectual property research firm. He explains that on November 17, 2015 Thomson CompuMark received from the Applicant's agent a request for a Thomson CompuMark Canada Trademark Register Dilution (How Common) search for the prefix term "VID-" but not including the term "VIDEO" for all wares and services.

[45] On November 17, 2015, Mr. Romero conducted such search and filed as Exhibit SR-1 a report. It contains at least 156 citations.

[46] There is no analysis in the report of those citations. The Applicant chose not to file a written argument and did not request a hearing. Given that the marks in issue are identical and there could be a relationship between the parties' goods and services, in the absence of a detailed analysis of those citations, I failed to see how such evidence would outweigh all the other relevant factors favouring the Opponent.

Conclusion

[47] Subsequent to the analysis of all the relevant criteria listed under section 6(5) of the Act, I conclude that the Applicant has failed to discharge its burden to prove, on a balance of

probability, that there is no likelihood of confusion between the Mark and the Opponent's trade-mark VIDEA when the former is used in association with the Goods.

[48] I reach this conclusion as the marks in issue are identical; the Opponent's mark is more known than the Mark; the Opponent's mark has been used since January 7, 2011 while there is no evidence of use of the Mark; and the Applicant failed to prove that the parties' businesses do not overlap.

[49] Consequently, this ground of opposition is maintained.

GROUND OF OPPOSITION BASED ON SECTION 16(1) OF THE ACT

[50] In order to succeed under this ground of opposition, the Opponent must establish first that it has used its trade-mark VIDEA prior to the claimed date of first use of the Mark (February, 2013) and that it had not abandoned such use at the advertisement date of the present application (December 17, 2014) [see section 16(5) of the Act].

[51] The Opponent's evidence described under the previous ground of opposition is sufficient to conclude that the Opponent has met its initial burden of proof. Therefore, the Applicant had to demonstrate, on a balance of probabilities, that the Mark was not likely to cause confusion with the Opponent's trade-mark VIDEA on February 28, 2013, being the last day of the month [see *Khan v Turban Brand Products ltd* (1984), 1 CPR (3d) 388 (TMOB)].

[52] The difference in the material date with the previous ground of opposition has very little effect on the analysis of the relevant criteria detailed above.

[53] Accordingly, for similar reasons described under the ground of registrability, I also maintain this ground of opposition.

OTHER GROUNDS OF OPPOSITION

[54] Given that the Opponent has been successful under two separate grounds of opposition, I do not see the necessity to assess the remaining grounds of opposition.

DISPOSITION

[55] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application, the whole pursuant to section 38(8) of the Act.

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

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

No Hearing Held

AGENT(S) OF RECORD

No agent

FOR THE OPPONENT

Julie MacDonald

FOR THE APPLICANT