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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 73

Date of Decision: 2020-06-29

IN THE MATTER OF AN OPPOSITION

TekSavvy Solutions Inc.	**Opponent**
and	
CGI Inc.	**Applicant**
1,775,753 for CGI TestSavvy	**Application**

INTRODUCTION

[1] TekSavvy Solutions Inc. (the Opponent) opposes registration of the trademark CGI TestSavvy (the Mark), by CGI Group Inc. who subsequently changed its name to CGI Inc. (the Applicant or CGI).

[2] The application for the Mark is in association with the following Goods and Services and is based on proposed use.

Goods

(1) Computer software for testing and evaluating other computer software; Computer software for testing and evaluating server applications, application programs, computer operating systems; Computer software for test automation management for computer

software, mainframe terminal emulators, graphical user interface software, client server software applications, web services middleware, mobile device software and mobile web software applications; Computer software for use in accessing, transferring and handling of data namely, personal information, text messages, audio files, video files, multimedia files, music files, spreadsheets, graphics, still images, moving pictures, publications, journals and presentations consisting of text, graphics and video content for software testing; Computer software for software development lifecycle management, automated testing, test planning and design, test execution, defect analysis and test result tracking and reporting; computer software for running development programs and application programs in a common development environment; Computer software for evaluating the testing of other computer software and for use across phases of the computer software quality assurance process, namely, test planning and test result tracking and reporting.

Services

(1) Computer software consulting; Testing of computer software; Computer services in the field of computer software testing; Providing on-line non-downloadable computer software for testing and evaluating other computer software, computer software for testing and evaluating server applications, application programs, computer operating systems, computer software for test automation management for computer software, mainframe terminal emulators, graphical user interface software, client server software applications, web services middleware, mobile device software and mobile web software applications, computer software for use in accessing, transferring and handling of data namely, personal information, text messages, audio files, video files, multimedia files, music files, spreadsheets, graphics, still images, moving pictures, publications, journals and presentations consisting of text, graphics and video content for software testing, computer software for software development lifecycle management, automated testing, test planning and design, test execution, defect analysis and test result tracking and reporting, computer software for running development programs and application programs in a common development environment, computer software for evaluating the testing of other computer software and for use across phases of the computer software quality assurance process, namely, test planning and test result tracking and reporting; Software-as-a-Service services featuring computer software for testing and evaluating other computer software, computer software for testing and evaluating server applications, application programs, computer operating systems, computer software for test automation management for computer software, mainframe terminal emulators, graphical user interface software, client server software applications, web services middleware, mobile device software and mobile web software applications, computer software for use in accessing, transferring and handling of data namely, personal information, text messages, audio files, video files, multimedia files, music files, spreadsheets, graphics, still images, moving pictures, publications, journals and presentations consisting of text, graphics and video content for software testing, computer software for software development lifecycle management, automated testing, test planning and design, test execution, defect analysis and test result tracking and reporting, computer software for running development programs and application programs in a common development environment, computer software for evaluating the testing of other

computer software and for use across phases of the computer software quality assurance process, namely, test planning and test result tracking and reporting.

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent's prior use and registration of its TEKSAVVY trademarks and trade name.

[4] For the reasons that follow, the opposition is rejected.

THE RECORD

[5] The application for the Mark was filed on April 5, 2016.

[6] The application was advertised for opposition purposes in the *Trademarks Journal* of August 24, 2016.

[7] On October 24, 2016, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act* (RSC 1985, c T-13) (the Act). The grounds of opposition pleaded by the Opponent include sections 12(1)(d), 16(3)(a), 16(3)(b), 16(3)(c) and 2 of the Act, all of which turn on the issue of a likelihood of confusion between the Mark and the Opponent's TEKSAVVY trademarks and trade name. The Opponent has also pleaded grounds of opposition under sections 30(a), 30(e) and 30(i) of the Act. As the Act was amended on June 17, 2019, all references in this decision are to the Act as amended, with the exception of references to the grounds of opposition (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised before this date).

[8] The Applicant denied each of the grounds of opposition in its counter statement.

[9] The Opponent did not file any evidence in support of its opposition. In support of its application, the Applicant filed the affidavits of Michael J. Keating and Kimberly Sévigny. The Applicant alone filed a written argument. Neither party requested a hearing.

LEGAL ONUS AND EVIDENTIAL BURDEN

[10] Before considering the grounds of opposition, I will review the requirements of (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[11] With respect to (i) above, there is, in accordance with the usual rules of evidence, an evidential burden on an opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Limited v The Molson Companies Limited*, 1990 CanLII 11059 (FC), 30 CPR (3d) 293 at 298 (FCTD)]. The presence of an evidential burden on an opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent in the statement of opposition (for those allegations for which an opponent has met its evidential burden). The presence of a legal onus on an applicant means that if a determinate conclusion cannot be reached once all the evidence is in, on a balance of probabilities standard, then the issue must be decided against an applicant.

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 12(1)(d) ground of opposition is rejected

[12] I will first begin with a consideration of the section 12(1)(d) ground of opposition. The Opponent has pleaded that the Mark is not registrable under section 12(1)(d) of the Act as it is confusing with the Opponent's registrations set out below.

Registration No.	Trademark	Services
TMA893,334	TEKSAVVY	(1) Local and long distance telephone services. (2) Internet service provider (ISP) service. (3) Website development. (4) Web hosting.
TMA893,333	TekSavvy	(1) Local and long distance telephone services. (2) Internet service provider (ISP)

		service. (3) Website development. (4) Web hosting.

[13] The material date for considering this ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 1991 CanLII 11769 (FCA), 37 CPR (3d) 413 (FCA)].

[14] I have exercised my discretion and checked the Register to confirm that these registrations are extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground.

Test to determine confusion

[15] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold or leased by the same person, whether or not the goods or services are of the same general class or appear in the same Nice Class. In making such an assessment, I must consider all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them. In *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 (CanLII), [2006] 1 SCR 824 at para 20, the Supreme Court of Canada set out how the test is to be applied:

> The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [mark] at a time when he or she has no more than an imperfect recollection of the [prior] trade-marks and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks

[16] The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 (CanLII),

[2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* 2011 SCC 27 at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

[17] Importantly, section 6(2) 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 purchasers of the Applicant's Goods and Services, provided under the trademark CGI TestSavvy, would believe that those Goods and Services were being provided by the Opponent, or that the Applicant was authorized or licensed by the Opponent who offers services under the TEKSAVVY trademarks.

Inherent distinctiveness of the trademarks

[18] The Mark consists of the initials CGI and a coined word consisting of two ordinary dictionary words TEST and SAVVY. The Opponent's TEKSAVVY trademarks consist of a coined word in which a misspelling of TECH and SAVVY are combined. While the Opponent's design trademark includes stylization, I do not find that this stylization impacts the inherent distinctiveness of the TEKSAVVY Design trademark as it is quite simple.

[19] I find that the Opponent's trademarks and the Mark all have a relatively low degree of inherent distinctiveness as the trademarks are suggestive of goods and services in the technology or testing fields which are offered by or purchased by those that are experienced, knowledgeable, and well-informed [see *Tradall SA v Devil's Martini Inc,* 2011 TMOB 65 at para 29 which provides that the Registrar can take judicial notice of dictionary definitions and the definitions of test, tech and savvy from *dictionary.com* set out below]. Further, with respect to the prefix CGI, combinations of letters are generally viewed as weak elements [*GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD) at 163-164].

Test	the means by which the presence, quality, or genuineness of anything is determined; a means of trial. the trial of the quality of something:
Tech	technical: technology:
Savvy	experienced, knowledgable, and well-informed;

	shrewd (often used in combination)

Extent known and the length of time the trademarks have been in use

[20] The Opponent has not filed any evidence. The Applicant's evidence of use of the Mark is minimal with only a few examples being provided in the affidavit of Mr. Keating, its Senior Vice President of Global Marketing and Intellectual Property Strategy (paras 1, 59-62; Exhibit 54). Given the minimal nature of the Applicant's evidence of use of the Mark, I find that this factor does not favour either party.

Nature of the goods, services, or business, and trade

[21] The nature of the parties' goods and services are similar to the extent that the parties operate in the field of computer services. It is, however, clear from the evidence that the Goods and Services are different than the Opponent's registered services which appear to be in the nature of telecommunication services including telephone services, internet provider services, website development and hosting. In contrast, the Goods and Services are focused on testing and evaluating of computer systems and software. The Applicant's evidence is that the Goods and Services can be summarized as software, framework and methodology related to software application quality assurance testing and target large enterprises and government entities including those in banking, insurance, health, communications, automotive and sales and government sectors (Keating affidavit, paras 57-58). These Goods and Services allow the automation of test activities and testing earlier in customers' timelines and provide logical test architecture that eliminates repetitive and redundant activities in testing (para 59; Exhibit 54).

Degree of resemblance

[22] The degree of resemblance between the trademarks will often have the greatest effect on the confusion analysis. When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. The appropriate test is not a side by side comparison but an imperfect recollection in the mind of a consumer of an opponent's trademark [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, *supra* at para 20].

[23] I find that there is a fair degree of resemblance in appearance and sound between the Mark and each of the Opponent's trademarks. I make this finding even though I consider that the component TESTSAVVY is not the most striking element of the Mark by virtue of the fact that (i) it suggests that the focus of the associated services is testing and (ii) its suffix position in the Mark [*Conde Nast Publications Inc v Union Des Editions Modernes* (1979), 26 CPR (2d) 183 at 188 (FCTD)]. The parties' marks also resemble each other in ideas suggested to the extent that all suggest the idea of services that are or may be offered or purchased by someone who is experienced, knowledgeable, and well-informed. However, the Mark clearly signals goods and services emanating from or associated with the Applicant as discussed further below.

Surrounding circumstance – renown of the trademark CGI

[24] The Applicant's evidence shows that the reputation of the first portion of the Mark CGI would assist consumers in distinguishing the source of the Goods and Services associated with the Mark. The Applicant's evidence demonstrates that the trademark CGI is known to a significant extent in Canada in association with information technology and business process services which include a comprehensive portfolio of services including high-end business and IT consulting, systems integration, application development and maintenance, infrastructure management (Keating affidavit, para 6). In particular, Mr. Keating's evidence is that:

- CGI is the fifth largest independent information technology and business process services company in the world with approximately 70,000 professionals serving thousands of global clients (para 6).

- CGI has over 10,000 employees in Canada and has delivery centres in Ottawa, Toronto, Montreal, Quebec City, Vancouver, Victoria, Calgary, Edmonton, Halifax, Moncton and Regina (para 7).

- CGI's annual revenue for its services in Canada from 2010 to 2016 ranged between $2.112 M and $1.507 M (para 10).

- The CGI trademark appears on many of the buildings where CGI operates (para 40), on its website which feature a number of different CGI business lines including CGI FUNDS360, CGI TRAFFIC 360, and CGI GATEWAY360 (paras 42-53, Exhibits 17-29), on user guides (para 54, Exhibit 30), on annual reports (Exhibits 2-3) and promotional literature (Exhibits 1, 54).

Surrounding circumstance – state of the Register evidence

[25] Ms. Sévigny, a paralegal with the Applicant's agent (paras 1-2), attaches to her affidavit the particulars of various Canadian trademark applications and registrations containing TEK or TECH (but not TECHNOLOGY or TECHNOLOGIES) and the word SAVVY in classes 9 or 42.

[26] Evidence concerning the state of the Register is relevant only to the extent that inferences may be drawn concerning the state of the marketplace [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FC)]. Furthermore, inferences concerning the state of the market may be drawn from this evidence only if a large number of relevant registrations are located [*Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA); *McDowell v Laverana GmbH & Co KG*, 2017 FC 327 at paras 41-46]. If sufficient state of the Register evidence is provided, the Registrar may infer that the likelihood of confusion is reduced by following the well-recognized principle that where two trademarks contain a common element that is also contained in a number of other marks in the same market, this tends to cause consumers to pay more attention to the other non-common features to distinguish them [*K-Tel International Ltd v Interwood Marketing Ltd* 1997 CanLII 5754 (FC), 77 CPR (3d) 523 (FCTD)].

[27] The Applicant's evidence is not sufficient for me to find that consumers can more readily distinguish between trademarks beginning with TE and ending with SAVVY. Relevant trademarks include those that (i) are registered or are allowed and based on use; (ii) are for similar goods and services as the marks at issue and (iii) that include the component at issue in a material way [*Sobeys West Inc v Schwan's IP*, LLC, 2015 TMOB 197]. While Ms. Sévigny's search located several trademarks including the TECH, TEK or SAVVY components, she did not locate any other registered trademarks incorporating an element beginning with TE and ending with SAVVY. I note that the one trademark located in the search TECH SAVVY INTERIORS had only been advertised. Accordingly, I find that this factor does not assist the Applicant.

Conclusion

[28] Having regard to the foregoing, I find that that the balance of probabilities with respect to the issue of confusion weighs in favour of the Applicant. While there is a fair degree of resemblance between the Mark and each of the Opponent's TEKSAVVY trademarks, I find that the nature of the parties' goods and services is different and the inclusion of the prefix CGI in the Mark significantly impacts the ideas suggested by the Mark in that it would clearly signal to the average consumer that the source of the Goods and Services is the Applicant. Accordingly, this ground of opposition is rejected.

Section 16(3)(b) ground of opposition

[29] The Opponent pleads that the Applicant is not the person entitled to registration of the trademark pursuant to section 16(3)(b) of the Act as the Mark is confusing with the Opponent's trademark applications set out below:

Application No.	Trademark	Services
1,708,768	TekSavvy TV	(1) Broadcasting of radio and television programmes. (2) Broadcasting of cable television programmes.
1,708,772	TekSavvy.TV	(1) Broadcasting of radio and television programmes. (2) Broadcasting of cable television programmes.

[30] The Opponent has the initial onus of proving that the trademark applications for TekSavvy TV and TekSavvy.TV were filed prior to April 5, 2016, the date of filing of the

Applicant's application, and remained pending at the date of advertisement of the Applicant's application, namely August 24, 2016 [section 16(4) of the Act].

[31] I have exercised my discretion to check the status of the applications cited by the Opponent [*Royal Appliance Mfg Co v IONA Appliances Inc* (1990), 32 CPR (3d) 525 (TMOB)] and am satisfied that these applications were filed prior to the application for the Mark and remained pending at its advertisement. Accordingly, the Opponent has met its initial evidential burden.

[32] However, as in the case of the section 12(1)(d) ground of opposition, the Applicant has met its legal onus of proving on a balance of probabilities that there was no reasonable likelihood of confusion as of the material date. The Mark and the Opponent's trademarks TekSavvy TV and TekSavvy.TV have a limited degree of inherent distinctiveness for the same reasons set out in the section 12(1)(d) ground of opposition as the component TV does not add any inherent distinctiveness due to its descriptive nature. Further, there is no evidence of these trademarks or the Mark having acquired any distinctiveness. With respect to the nature of the goods and services and trade of the parties, I do not find there to be overlap. Broadcasting of television, radio and cable programs on their face appear to be targeted at consumers interested in watching television and listening to the radio. In contrast, the Goods and Services are targeted at institutional customers wishing to purchase goods and services related to computer systems testing. My findings on the surrounding circumstances, namely, the reputation of CGI and the lack of relevance of the state of the Register evidence discussed in the section 12(1)(d) ground of opposition also apply to this ground of opposition.

[33] In finding there is no reasonable likelihood of confusion, I find that while there is a fair degree of resemblance between the Mark and each of the Opponent's trademarks TekSavvy TV and TekSavvy.TV as both begin with TE and incorporate the component SAVVY, I find that the nature of the parties' goods and services is different. Further, the inclusion of the prefix CGI in the Mark significantly impacts the idea suggested by the Mark in that it would clearly signal to the average consumer that the source of the Goods and Services is the Applicant. Accordingly, this ground of opposition is rejected.

Section 30 grounds of opposition – summarily rejected

[34] The Opponent has not met its initial burden with respect to the grounds of opposition based on sections 30(a), 30(e), and 30(i) of the Act.

[35] The material date for considering a ground of opposition under section 30 of the Act is the date of filing of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475].

[36] The Opponent has pleaded that contrary to section 30(a) of the Act, the application does not contain a statement in ordinary commercial terms of the Goods and Services. However, no evidence or argument was filed in support of this ground of opposition [*McDonald's Corporation v MA Comacho-Saldana International Trading Ltd c/o/b/a Macs International* (1984), 1 CPR (3d) 101 (TMOB) at 104].

[37] The Opponent has pleaded that contrary to section 30(e) of the Act, the Applicant, by itself or through a licensee, or by itself and through a licensee, could not have intended to use the Mark in Canada in association with the Goods and Services. However, no evidence or argument was filed in support of these grounds of opposition.

[38] The Opponent has pleaded that contrary to section 30(i) of the Act, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Goods and Services in view of confusion with the Opponent's TEKSAVVY trademark registrations, applications and trade name.

[39] Where an applicant has provided the statement required by section 30(i) of the Act, a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of an applicant [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. Even assuming that the Applicant was aware of the TEKSAVVY registrations, applications and trade name, the mere knowledge of their existence does not in and of itself support an allegation that the Applicant could not have been satisfied of its entitlement to use the Mark [*Woot Inc v Woot Restaurants Inc/Les Restaurants Woot Inc*, 2012 TMOB 197 (CanLII)]. In this case, the Applicant has provided the necessary statement and this is not an exceptional case.

[40] Accordingly, each of these grounds of opposition is rejected.

Sections 16(3)(a), 16(3)(c) and 2 grounds of opposition – summarily rejected

[41] The sections 16(3)(a), 16(3)(c) and 2 grounds of opposition are rejected because the Opponent has not met its initial burden. The Opponent has not evidenced that its TEKSAVVY trademarks or trade name were used, made known or had a reputation in Canada as of the applicable material dates. Although the Opponent's registrations for its trademarks refer to use, that is not sufficient for the Opponent to meet its burden for these grounds of opposition [*Rooxs, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB) at 268].

DISPOSITION

[42] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD

HEARING DATE No Hearing Held

AGENT(S) OF RECORD

FINLAYSON & SINGLEHURST	FOR THE OPPONENT
BCF S.E.N.C.R.L./BCF LLP	FOR THE APPLICANT