



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2020 TMOB 118**

**Date of Decision: 2020-10-28**

**IN THE MATTER OF AN OPPOSITION**

**Famic Technologies Inc.**

**Opponent**

**and**

**Bluebeam, Inc.**

**Applicant**

**1,733,035 for STUDIO GO & DESIGN**

**Application**

[1] Famic Technologies Inc. (the Opponent) opposes registration of the trademark STUDIO GO & DESIGN (the Mark), reproduced below, which is the subject of application No. 1,733,035 in the name of Bluebeam, Inc. (the Applicant).



FILE RECORD

[2] The application for the Mark was filed on June 16, 2015 on the basis of use in Canada since at least as early as February 2015 in association with:

Computer server software to provide hosting of multiple collaborative users for page recognition and rendering for use in viewing, printing, editing, organizing, annotating and indexing electronic comments, and transferring and storing electronic documents and files, including in PDF (Portable Document Format)

(the Goods)

[3] The application also claimed a priority filing date of December 18, 2014 based on United States of America application No. 86/484,749.

[4] The Mark was advertised for opposition purposes in the *Trademarks Journal* on March 30, 2016 and on May 17, 2016, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). All references in this decision are to the Act as amended on June 17, 2019, with the exception of references to the grounds of opposition which refer to the Act before it was amended [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 that date].

[5] The Opponent raises grounds of opposition based upon sections 30 (non-compliance); 12 (non-registrability); 16 (non-entitlement); and 2 (non-distinctiveness) of the Act, as detailed in Schedule A herein.

[6] On July 19, 2016, the Applicant filed and served a counter statement denying the grounds of opposition pleaded in the statement of opposition.

[7] In support of its opposition, the Opponent filed:

- Certified copies of its trademark registration Nos. TMA463,461 for AUTOMATION STUDIO and TMA835,102 for AUTOMATION STUDIO PLC; and
- The affidavit of Charbel Nasr, President of the Opponent, sworn October 7, 2016 (the Nasr affidavit). The Nasr affidavit provides some information with respect to the Opponent's business, including the promotion and use of the trademark AUTOMATION STUDIO in Canada. Mr. Nasr was cross-examined on his affidavit and the transcript of his cross-examination forms part of the record.

[8] In support of its application, the Applicant filed two affidavits in the name of Diane Montreuil, an administrative assistant employed by the law firm representing the Applicant, both sworn September 12, 2017 (the first Montreuil affidavit and the second Montreuil affidavit, respectively). The first Montreuil affidavit introduces state of the register evidence in the form of a search of the Canadian Trademarks Database. The second Montreuil affidavit introduces into evidence excerpts from the same database concerning the Applicant's trademark registration Nos. TMA975,152 for STUDIO and TMA849,926 for STUDIO Logo, which cover the same goods as those listed in the application for the Mark. Ms. Montreuil was not cross-examined on her affidavits. The Applicant subsequently requested and was denied leave to file additional evidence on July 3, 2020.

[9] Only the Applicant filed a written argument. While a hearing was scheduled at the request of both parties, it was ultimately cancelled when they decided not to attend.

#### ONUS AND MATERIAL DATES

[10] 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD)]. If this burden is met, the Applicant then bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act.

[11] The material dates with respect to the grounds of opposition are as follows:

- Sections 38(2)(a) and 30 of the Act – the filing date of the application, namely, June 16, 2015 [*Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 at 296 (FCTD); *Tower Conference Management Co v Canadian Exhibition Management Inc*, (1990) 28 CPR (3d) 428 at 432-433 (TMOB)];
- Sections 38(2)(b) and 12(1)(d) of the Act – the date of my decision [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)];

- Sections 38(2)(c) and 16 of the Act – the date of first use claimed in the application (as the date of first use in the application is February 2015, it is interpreted as February 28, 2015) [Section 16(1) of the Act]; and
- Sections 38(2)(d) and 2 of the Act – the filing date of the opposition, namely, May 17, 2016 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

## ANALYSIS

### **Section 30(b)**

[12] The Opponent did not file any evidence or make any submissions in support of this ground of opposition. Accordingly, the section 30(b) ground of opposition is rejected for the Opponent's failure to meet its evidential burden.

### **Section 30(i)**

[13] Section 30(i) of the Act requires that an applicant include a statement in its application that it is satisfied that it is entitled to use its trademark. Where this statement has been provided, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith [*Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. Mere knowledge of the existence of the Opponent's trademarks or trade names does not in and of itself support the allegation that the Applicant could not have been satisfied of its entitlement to use its Mark [*Woot, Inc v WootRestaruants Inc Les Restaurants Woot Inc*, 2012 TMOB 197]. The application for the Mark contains the required statement and there is no evidence that this is an exceptional case.

[14] Further, the Opponent has failed to meet its initial evidential burden with respect to its allegation that the Applicant could not be satisfied it was entitled to use the Mark in view of a combination of section 30(i) with section 7(b) or 22 of the Act. The Opponent did not file any evidence in support of the three requisite elements of a section 7(b) violation [as set out in *Ciba-Geigy Canada Ltd v Apotex Inc*, 1992 CanLII 33 (SCC), [1992] 3 SCR 120 at para 33] nor did it file any evidence in support of a likelihood of depreciation of goodwill to establish a section 22

violation [as set out in *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at paras 46, 63-68].

[15] Accordingly, the section 30(i) ground of opposition is rejected for the Opponent's failure to meet its evidential burden.

### **Section 12(1)(d)**

[16] An opponent meets its initial onus with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing. In this regard, the Registrar has the discretion to check the register in order to confirm the existence of the registration relied upon by an opponent [*Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised my discretion, I confirm that registration Nos. TMA463,461 and TMA835,102 are in good standing.

[17] The Applicant must now establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's registered trademarks.

### The test for confusion

[18] 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 the trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods and services are of the same general class or appear in the same class of the Nice Classification.

[19] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which the trademarks 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. These criteria are not exhaustive and different weight will be given to each one in a context-specific assessment [*Veuve Clicquot; Mattel, Inc v 3894207 Canada Inc*,

2006 SCC 22 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 the resemblance between the marks will often have the greatest effect on the confusion analysis.

*Inherent distinctiveness*

[20] The trademarks at hand possess a similarly low degree of inherent distinctiveness, in association with the goods that they respectively cover. Both parties' marks are composed of ordinary dictionary words. The term AUTOMATION is descriptive of the Opponent's software function (confirmed by the disclaimer contained in its trademark registration No. TMA463,461) and, to the extent that the Opponent's software has a design feature, the combination AUTOMATION STUDIO is arguably suggestive of the virtual workshop in which designing happens and automation simulations are made. The acronym PLC (which the Opponent has not defined) in the Opponent's trademark AUTOMATION STUDIO PLC adds little to the inherent distinctiveness of this mark as a whole. Similarly, to the extent that the Applicant's software encompasses a rendering function in connection with document editing, the combination STUDIO GO is arguably suggestive of the virtual workshop in which document editing occurs. The added stylization and design feature in the Mark add little to its inherent distinctiveness. That said, the Applicant's Mark is slightly more distinctive in view of its inclusion of the word GO, which is neither suggestive nor descriptive of the related goods.

*Extent known and length of time in use*

[21] These factors do not significantly favour either party. Regarding the extent to which the respective parties' trademarks have become known, the Applicant has not presented any evidence that its Mark has been used or become known to any extent in Canada. With respect to the Opponent's registered trademarks AUTOMATION STUDIO and AUTOMATION STUDIO PLC, I am not satisfied that the Opponent's evidence demonstrates that its marks are known to any significant extent in Canada or have had much more than *de minimis* use.

[22] Mr. Nasr's evidence is that:

- The Opponent (also known as “Famic” and “Automation Studio” [para 1]) is in the business of offering software engineering and industrial automation products and services [para 4].
- Since 1986, the Opponent commercializes a system design and simulation software under the trademark AUTOMATION STUDIO, which was originally meant for education and training on hydraulic power systems, and is since used on a large scale in the industry sector in system design, engineering, maintenance and service in addition to training [para 5]. Specifically, the software manages technical machine knowledge. It covers hydraulic, pneumatic, electrotechnical, electrical, controls and communication (machine) technologies that can be used to design, test and document systems and includes interactive customizable interfaces. [para 6, Nasr transcript, pp 7-11]
- The AUTOMATION STUDIO software comes in a professional and an educational edition as well as in a “Live Manifold” edition used for hydraulic block manifold design, quoting and prototyping [para 7, Exhibit NS-1].
- Between 2005-2016, the Opponent’s total sales in Canada for the AUTOMATION STUDIO “program” have exceeded \$4M and the Opponent has spent over \$185,000 promoting this “computer program” [paras 12-13].
- Since 2005, the Opponent publicizes its AUTOMATION STUDIO software through its websites at <http://www.famictech.com/fr/> and [http://www.automationstudio.com/index\\_fr.html](http://www.automationstudio.com/index_fr.html) and through the distribution of its brochure [paras 8-11, Exhibits NS-1-NS-3]. The Opponent’s software has also been promoted through participation at trade shows, through what appears to be print advertising, and through third party article features [Exhibit NS-4].

[23] However, I note that Mr. Nasr provides no examples of actual use of the Opponent’s trademarks within the meaning of section 4 of the Act. Mr. Nasr provides no labels, packages, invoices or clear examples of how the Opponent displays any of its trademarks in connection with its software products at the time of sale. He makes no statements regarding specific transactions or the Opponent’s normal course of trade.

[24] With respect to the trademark AUTOMATION STUDIO PLC, Mr. Nasr is completely silent. With respect to the trademark AUTOMATION STUDIO, Mr. Nasr provides no documentation in support of his statements asserting the Opponent's commercialization of the software since 1986. Even were I to accept from his statements that sales of the AUTOMATION STUDIO software were made between 2005-2016 and even were I to infer from the sheer size of the sales figures provided that said sales were made in the Opponent's normal course of trade, Mr. Nasr's evidence offers little insight with respect to how this trademark was actually associated with the Opponent's software at the time of transfer.

[25] I note what may be images of packaging of the software product showing the AUTOMATION STUDIO trademark depicted in some of the Opponent's website excerpts [Exhibit NS-1] and in its brochure for the software's educational version [Exhibit NS-3]. However, these images are not all very clear and I am troubled by the fact that Mr. Nasr fails to indicate if, when or how product packaging displaying any of its trademarks may have been used. I also note that the Opponent's websites seem to allow consumers to request online demonstrations of the product. However, Mr. Nasr makes no statements regarding product demonstrations and, in particular, that any such demonstrations were ever actually requested by or provided to Canadian consumers. There is also no indication of the number of Canadian visitors to the Opponent's websites at any time, no indication if Canadian consumers have used the Opponent's promotional brochure or websites to order its software products or if promotional brochures accompany such products at the time of transfer, nor an indication as to the quantity of advertising and potential circulation in Canada of the Opponent's brochure or of any of the third-party articles.

[26] The Opponent's registration for the trademark AUTOMATION STUDIO shows that a declaration of use was filed on June 11, 1996. The Opponent's registration for the trademark AUTOMATION STUDIO PLC shows that a declaration of use was filed on October 26, 2012. In the absence of evidence clearly establishing use pursuant to section 4 of the Act, I can only infer *de minimis* use of the Opponent's trademarks from the certificates of registration [*Tokai of Canada v Kingsford Products Company, LLC*, 2018 FC 951 at para 37; *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. An inference of *de minimis* use does not support the finding that the Opponent's trademarks were known to any



significant extent, or that they have necessarily been continuously used since the dates respectively declared [*Krauss-Maffei Wegmann GmbH & Co KG v Rheinmetall Defence Electronics GmbH*, 2017 TMOB 50 at para 20].

*Goods, services or business and nature of the trade*

[27] When considering the nature of the goods and services and the nature of the trade, I must compare the Applicant's statement of goods and services with those contained in the registrations relied upon by the Opponent [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, these statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. Evidence of the parties' actual trades is useful in this respect [*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); *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[28] This factor favours the Opponent to the extent that the trademarks at hand all cover software. I agree with the Applicant's submissions that the function and field of use of the software are to be considered. However, while the main function and field of use of the parties' respective software products in the case at hand are admittedly different, I find that there is overlap or at least a connection between the parties' goods to the extent that the Opponent's AUTOMATION STUDIO software also contains a collaborative feature and allows for document management, including document viewing, organizing and storage (including in PDF (Portable Document Format)) [Nasr transcript, pp 17-19, 21]. In the absence of evidence or submissions regarding the consumers targeted by the Applicant's product or the nature of its trade, there is no reason to conclude that the parties' channels of trade could not potentially overlap.

*Degree of resemblance*

[29] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality and not dissected into their component parts. 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* at para 20]. Nevertheless, in some cases, the first portion of a trademark may prove the most important for the purpose of distinction [*Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)]. With this in mind, this factor favours the Applicant.

[30] When considered in their entirety, I find that the parties' trademarks are more different than alike. The marks resemble each other to the extent that they share the word STUDIO and therefore all evoke a virtual space where the parties' respective software functions are executed. However, aside from this common word and the idea it suggests, the Mark does not resemble either of the Opponent's trademarks in appearance or in sound. The marks comprise different additional elements and begin and end with different components, which also results in different structures. Further, as mentioned above, the term AUTOMATION is descriptive in the context of the Opponent's goods, while the word GO does not appear to have any clear meaning in the context of the Applicant's goods and, as such, the ideas suggested by the parties' marks as a whole also differ. All in all, when viewed in their totality, the degree of resemblance between the trademarks is low.

#### *Surrounding circumstances – coexistence*

[31] The second Montreuil affidavit contains particulars of the Applicant's trademark registration Nos. TMA975,152 for STUDIO and TMA849,926 for STUDIO Logo, which the Applicant argues already coexist both on the register and in the marketplace with the registered trademarks relied upon by the Opponent.

[32] I do not find the existence of the Applicant's trademark registrations to be dispositive [*Coronet-Werke Heinrich Schlerf GmbH v Produits Ménagers Coronet Inc* (1984), 4 CPR (3d) 108 at 115 (TMOB); *Groupe Lavo Inc v Proctor & Gamble Inc* (1990), 32 CPR (3d) 533 at 538 (TMOB); *American Cyanamid Co v Stanley Pharmaceuticals Ltd* (1996), 74 CPR (3d) 571 (TMOB); *385229 Ontario Limited v ServiceMaster Company*, 2012 TMOB 59 at para 47] especially as the Applicant has not adduced any evidence of marketplace coexistence.

*Surrounding circumstances – state of the register*

[33] State of the register evidence is introduced to show the commonality or lack of distinctiveness of a trademark or, as in this case, of a portion of a trademark. It is established that where trademarks contain a common element that is also contained in a number of other trademarks in the same market, this tends to cause consumers to pay more attention to the marks' other non-common features to distinguish them [*K-Tel International Ltd v Interwood Marketing Ltd* (1997), 77 CPR (3d) 523 (FCTD)]. That said, such evidence is relevant only insofar as it allows for inferences concerning the state of the marketplace, which can only be drawn when a significant number of relevant registrations are located [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[34] In the first Montreuil affidavit, Ms. Montreuil states that she has searched the Canadian Trademarks Database for active trademarks comprising the term STUDIO in the trademark and that are either applied for or registered for use in association with software or software as a service (SaaS). Attached in bulk to her affidavit are copies of printouts showing the full particulars of the 112 trademarks yielded through her search [Exhibit DM-1].

[35] In its written argument, the Applicant submits that “it is clear from the 112 [trademarks] reproduced in Exhibit DM-1 [...] that the word ‘studio’ is adopted by many different [trademark] owners in the field of software”. It is unclear if the Applicant’s position here is that the state of the register evidence adduced is relevant regardless of whether the field and function of the software goods/services covered by the yielded results are similar or not. In any event, I note that Ms. Montreuil’s rather lengthy search results are not paginated, nor summarized in any way and do not seem to be organised in any particular order (for instance alphabetically by trademark or by status, or numerically by application or registration number). I further note that Ms. Montreuil has not limited her search to allowed or registered trademarks and so her evidence also includes irrelevant results in the form of marks that are formalized, in default, searched/in examination and even opposed. As the Applicant made no efforts to specifically identify the relevant results or at least present them in a clearly identifiable manner, I do not believe that I should be

expected to review the details of each and every register excerpt included in Ms. Montreuil's evidence to perform what essentially constitutes the meaningful part of the search in the Applicant's stead and assist it in making its case on this point.

[36] The Applicant further submits that "many of the 'studio' formative" trademarks located by Ms. Montreuil "are for software described as having a collaborative feature", but this time specifically directs my attention to the following 5 registrations:

- ADOBE STUDIO (TMA627,300) for "Computer software for use in the field of graphic design and desktop publishing, namely, software for digital publishing and electronic publishing, printing, imaging, graphics, typesetting and archiving; computer software for use in layout, editing and collaborative asset management in the production of electronic and printed publications; [...]";
- STUDIO (TMA949,000) for "Computer collaboration software for enhancing productivity, usability and knowledge management in the field of oil and gas exploration that allows registered users to search, store, transfer, annotate, collaborate and share project information via instant messaging, electronic mail, phone, video conferencing and computer application sharing";
- MimioStudio (TMA844,214) for "Computer hardware, computer software, computer peripherals namely, wireless mice, wireless voting/response calculators, and whiteboards, camera and devices namely camera mounts, camera lenses all of the foregoing being for interactive teaching and learning not specific to any particular fields, for creating interactive whiteboards, for connecting whiteboards to computers, for converting handwritten notes into text, for sharing of documents, for scoring and record keeping, for assessments and grading of skills/students; for capture of photos and video and their insertion into documents/presentations";
- PRACTICE STUDIO (TMA946,969) for "Computer software and downloadable computer software for accounting systems namely for use in keeping personal, small to medium business and corporate financial records and for preparation of personal, small to medium business and corporate financial statements, for use in database management, for collaboration between accountants and clients, for preparing quotations, for recording time sheets, for workflow management, for work in progress management, for invoice creation and management, for document management; computer software for online training in computer software for accounting systems for use in keeping personal, small to medium business and corporate financial records"; and
- MYDOMA STUDIO Design (TMA990,833) for "Project management computer software for managing and organizing design data and design projects in the field of commercial and residential interior design; computer software, and downloadable computer software, that enables users to develop, provide and customize and use computer software applications and computer software application user interfaces to store, manage, track, analyze, and report data in the field of interior design, and computer software to facilitate communicating among peer professionals in the interior design,

furniture and décor manufacturing fields, and for customizing computer application user interfaces; computer software for use in developing, hosting and accessing web and Internet portals; computer program for integrating other computer programs and applications with the project management computer software program for commercial and residential interior design; Software for use in task and project management, for electronic communications, namely chats, email and discussions, for facilitating the exchange of information via the internet featuring collaboration tools and for use in sharing information for the facilitation of collaborative working and interactive discussions, in the field of interior design”.

[37] Registration No. TMA627,300 is irrelevant as it has since been expunged from the register for failure to renew. The remainder of these registrations support the Applicant’s contention to a certain extent. However, given the low number of relevant registrations specifically identified by the Applicant and absent any evidence of actual use, I am not prepared to make any inferences regarding the state of the marketplace with respect to software goods/services comprising collaboration and document management features.

[38] That said, in the instant case, I do not consider it necessary to rely on Ms. Montreuil’s evidence to conclude in favour of the Applicant.

#### Conclusion regarding the likelihood of confusion

[39] In view of the foregoing, I find that the Applicant has met its onus to establish, on a balance of probabilities, that the Mark is not likely to cause confusion with the trademarks AUTOMATION STUDIO and AUTOMATION STUDIO PLC relied upon by the Opponent. I reach this conclusion mainly as I find that the lack of resemblance between the trademarks at hand in terms of appearance and sound, outweighs whatever overlap there may be with respect to the parties’ goods and the potential for overlap in their channels of trade. Accordingly, the section 12(1)(d) ground of opposition is rejected.

#### **Sections 16(1)(a) and 16(1)(c)**

[40] I am not satisfied that the evidence adduced demonstrates that the Opponent has used any of its trademarks or trade names incorporating the word STUDIO in Canada, as of the alleged date of first use of the Mark [see section 16(5) of the Act], and an inference of *de minimis* use based on certified copies of an opponent’s registrations does not meet the requirements of

section 16 of the Act [*Roxxs, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB)]. Accordingly, the sections 16(1)(a) and 16(1)(c) grounds of opposition are rejected for the Opponent's failure to meet its evidential burden.

[41] I would add that the overall outcome of these grounds would be the same even if the Opponent had met its evidential burden, as I find that the Mark was not confusing with either the marks or the names relied upon by the Opponent as of the date of first use claimed in the application (mainly in view of the insufficient degree of resemblance between them, as discussed above).

## **Section 2**

[42] With respect to the first prong of this ground, once the partial figures for 2016 where no monthly breakdown was provided have been discounted, the Opponent's has provided evidence that its sales for the AUTOMATION STUDIO "program" amounted to almost \$4M and that it has spent close to \$180,000 promoting it [Nasr affidavit, paras 12-13]. However, the evidence does not allow for an assessment (be it a general one) of the number of the Opponent's Canadian consumers or of the quantity of software products sold in Canada at any time. There is also no evidence of the manner or extent of distribution of the Opponent's exhibited brochures, of visits to or users of its websites or of the number of Canadians that may have been exposed to any of the advertising or promotion of its software products. Therefore, I find myself unable to draw any meaningful conclusion regarding the extent of use, advertising or reputation of any of the relied upon trademarks or trade names in Canada [for a discussion on what an opponent is required to provide in order to meet its burden with respect to distinctiveness see *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657 at paras 25-34; *Scott Paper Ltd v Georgia-Pacific Consumer Products LP*, 2010 FC 478; and *1648074 Ontario Inc v Akbar Brothers (PVT) Ltd*, 2019 FC 1305].

[43] Accordingly, the first prong of the section 2 ground of opposition is rejected for the Opponent's failure to meet its initial evidential burden.

[44] The second prong of this ground (alleging unlicensed use of the Mark by third parties in violation of section 50 of the Act) is also rejected as the Opponent did not file any evidence or make any submissions in its support.

[45] Accordingly, the section 2 ground of opposition is rejected in its entirety.

DISPOSITION

[46] 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.

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Iana Alexova  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

## SCHEDULE A

### Excerpts from the statement of opposition

[...]

### CONFORMITÉ

1. L'opposante fonde son opposition sur l'alinéa 38(2)(a) de la Loi, savoir que la demande d'enregistrement sous opposition ne satisfait pas aux exigences de l'article 30 de la Loi, notamment:
  - 1.1 la requérante, contrairement à l'alinéa 30(b) de la Loi,
    - n'a pas employé, comme il est dit dans la demande sous opposition, la MARQUE en liaison avec chacun des produits y mentionnés;
    - la date de premier emploi revendiquée est fautive, en tout ou en partie;
    - les prédécesseurs en titre de la requérante, le cas échéant, n'ont pas tous été nommés;
    - tout tel emploi (lequel est nié) des produits ne l'a pas été dans le cours normal du commerce;
  - 1.2 alternativement ou cumulativement, l'emploi allégué (lequel est nié) de la MARQUE en liaison avec chacun des produits mentionnés dans la demande sous opposition est discontinu, pour tout ou partie des produits y mentionnés et ce, contrairement à l'alinéa 30(b) de la Loi;
  - 1.3 c'est faussement que la requérante s'est dite convaincue d'avoir le droit à l'emploi au Canada de la MARQUE et ce, eu égard à ce qu'aux présentes mentionné, dont la connaissance de la requérante des droits de l'opposante et l'illégalité de tout tel emploi car, contrairement à l'alinéa 30(i) de la Loi,
    - 1.3.1 la requérante avait connaissance, réelle ou présumée, de(s) marque(s) ou nom(s) de l'opposante aux présentes allégués et sachant, lors de la production de la demande sous opposition, que la MARQUE créerait de la confusion avec ces marque(s) ou nom(s), la requérante ne pouvait souscrire que faussement la déclaration du droit à l'emploi requise par l'alinéa 30(i) de la Loi;
    - 1.3.2 tout tel emploi aurait, à la connaissance de la requérante, pour effet d'entraîner la diminution de la valeur de l'achalandage attaché à la ou aux marque(s) de commerce enregistrée(s) aux présentes alléguées par l'opposante et ce, contrairement à l'article 22 de la Loi;
    - 1.3.3 tout tel emploi serait, à la connaissance de la requérante, de nature à appeler l'attention du public sur ses produits ou entreprises, de manière à causer ou à vraisemblablement causer de la confusion au Canada entre ses produits ou



- entreprises et les produits, services ou entreprises de l'opposante et ce, contrairement aux dispositions de l'alinéa 7(b) de la Loi;
- 1.3.4 la requérante ne pouvait pas faire de bonne foi la déclaration prescrite par l'alinéa 30(i) de la Loi, parce qu'elle connaissait les marques ou noms de l'opposante aux présentes allégués et la confusion qui résulterait de l'emploi de la MARQUE avec ces marques ou noms de l'opposante;
- 1.4 la marque de commerce dont l'emploi est allégué n'est pas la MARQUE, mais une autre que celle mentionnée à la demande sous opposition, savoir BLUEBEAM STUDIO, STUDIO et STUDIO (& dessin) selon le graphisme visé par l'enregistrement 849926 et ce, contrairement à l'alinéa 30(b) de la Loi.

### **ENREGISTRABILITÉ**

2. L'opposante fonde son opposition sur l'alinéa 38(2)(b) de la Loi, savoir qu'eu égard aux dispositions du paragraphe 12(1) de la Loi, la MARQUE n'est pas enregistrable, parce qu'elle crée de la confusion avec une marque de commerce déposée, savoir :
- AUTOMATION STUDIO PLC, objet de l'enregistrement 835102;
  - AUTOMATION STUDIO, objet de l'enregistrement 463461;
- et ce, contrairement aux dispositions de l'alinéa 12(1)(d) de la Loi.

### **DROIT À L'ENREGISTREMENT**

3. L'opposante fonde son opposition sur l'alinéa 38(2)(c) de la Loi, savoir qu'eu égard aux dispositions de l'article 16 de la Loi, la requérante n'est pas la personne ayant droit à l'enregistrement
- 3.1 car à la date de premier emploi alléguée (la réalité duquel est autrement niée), de même qu'à toute date pertinente (incluant celle, le cas échéant, de la date de production de la demande sous opposition vu la fausseté de la date de premier emploi revendiquée ou de la date de priorité conventionnelle réclamée, le cas échéant), la MARQUE créait de la confusion avec des marques de commerce antérieurement employées ou révélées au Canada par l'opposante, ses prédécesseurs en titre ou, pour leur bénéfice, par des licenciés, savoir AUTOMATION STUDIO [ou comprenant ce terme, tel AUTOMATION STUDIO PLC] en liaison avec
- les produits ou services couverts par les enregistrements mentionnés au paragraphe 2 *supra*;
  - les produits mentionnés à la demande sous opposition, de même nature ou similaires;
- et ce, contrairement aux dispositions de l'alinéa 16(1)(a) de la Loi;
- 3.2 car à la date de premier emploi alléguée (la réalité duquel est autrement niée), de même qu'à toute date pertinente (incluant celle, le cas échéant, de la date de production de la demande sous opposition vu la fausseté de la date de premier emploi

revendiquée ou de la date de priorité conventionnelle réclamée, le cas échéant), la MARQUE créait de la confusion avec un nom commercial antérieurement employé au Canada par l'opposante, ses prédécesseurs en titre ou, pour leur bénéfice, par des licenciés, savoir AUTOMATION STUDIO [ou comprenant ce terme, tel AUTOMATION STUDIO PLC] en liaison avec

- les produits ou services couverts par les enregistrements mentionnés au paragraphe 2 *supra*;
- les produits mentionnés à la demande sous opposition, de même nature ou similaires;

et ce, contrairement aux dispositions de l'alinéa 16(1)(c) de la Loi.

### **DISTINCTIVITÉ**

4. L'opposante fonde son opposition sur l'alinéa 38(2)(d) de la Loi, savoir qu'eu égard aux dispositions de l'article 2 de la Loi (définition de « distinctive »), la MARQUE dont la requérante demande l'enregistrement n'est pas distinctive des produits de la requérante, ni ne peut l'être, car
  - 4.1 la MARQUE ne distingue pas les produits en liaison avec lesquels la MARQUE aurait été employée ou qu'il serait projeté de l'employer par la requérante des produits ou services de l'opposante et ce, eu égard à ce qu'aux présentes mentionné;
  - 4.2 la requérante a permis à des tiers, dont Nemetschek Group, QBS Software, AST Technologies et Mindsystems, d'employer au Canada la MARQUE - et de fait, ces tiers l'ont employée - hors du cadre des dispositions législatives régissant l'emploi sous licence d'une marque et ce, contrairement aux dispositions de l'article 50 de la Loi.

[...]

SCHEDULE B

**Statement of goods covered by registration No. TMA463,461**

Logiciel de formation et de conception utilisé dans le domaine des technologies de l'automatisation.

**Statement of goods covered by registration No. TMA835,102**

Computer software for use in programming and configuring controllers for industrial automation and for training on automation technology.

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

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No Hearing Held

**AGENTS OF RECORD**

ROBIC

For the Opponent

GOWLING WLG (CANADA) LLP

For the Applicant