



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 38

Date of Decision: 2024-02-29

IN THE MATTER OF AN OPPOSITION

Opponent: Victrix Conseil Inc. et Les Solutions Victrix Inc.

Applicant: Performance Designed Products LLC

Application: 1,892,204 for VICTRIX

INTRODUCTION

[1] Performance Designed Products LLC (the Applicant) has applied to register the trademark VICTRIX (the Mark) for use in association with video game controllers and headsets, as well as other electronic peripherals and accessories, primarily for video games.

[2] Victrix Conseil Inc. and Les Solutions Victrix Inc. (the Opponents) oppose the application, based primarily on an allegation that the Mark is confusing with their various trade names containing the word VICTRIX, used in association with information technology (IT) consulting services specializing in infrastructures, telecommunication networks, software development systems, and computer security systems.

[3] The opposition also contains grounds alleging that, when the Application was filed, the Applicant was not using, did not propose to use, and was not entitled to use the Mark in Canada.

[4] For the reasons that follow, I find that the Applicant has not satisfied its legal burden to show that there is no reasonable likelihood of confusion between the Mark and the trade name “VICTRIX” under which the Opponent Les Solutions Victrix Inc. (LSVI) carries on business. Accordingly, the Application is refused.

THE RECORD

[5] Application no. 1,892,204 for the Mark (the Application) was filed on April 6, 2018, on the basis of (i) use and application for registration of the same trademark in the United States of America and (ii) in respect of some of the goods, use in Canada since at least as early as March 7, 2018. The Application claims a priority filing date of October 17, 2017, based on U.S. application no. 87/648649 filed on that date for the same trademark in association with the same kind of goods. On November 29, 2022, the Application was amended to specify that none of the goods are “relating to cloud security and network consulting”. The full list of goods as amended (the Goods) is set out at Schedule 1 to this decision.

[6] The Application was advertised for opposition on February 17, 2021, and opposed on April 15, 2021, when the Opponents filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). In accordance with section 69.1 of the Act, since the Application was advertised after the Act was amended on June 17, 2019, the grounds of opposition will be assessed based on the Act as amended.

[7] The grounds of opposition allege that the Applicant is not entitled to registration under section 16(1)(c) of the Act; that the Mark is not distinctive within the meaning of section 2 of the Act; that the Applicant was not using and did not propose to use the Mark in Canada, pursuant to section 38(2)(e) of the Act; and that the Applicant was not entitled to use the Mark in Canada, pursuant to section 38(2)(f) of the Act. Portions of

the original grounds were struck in an interlocutory ruling issued by the Registrar on June 16, 2021, and an amended statement of opposition, filed on July 19, 2021, in response to the interlocutory ruling, is of record. The Applicant filed a counter statement denying the allegations in the statement of opposition.

[8] In support of their opposition, the Opponents filed the January 17, 2022, affidavit of their President and Chief Executive Officer, Stéphane Geriépy, who describes the Opponents' business and their use and promotion of their trademarks and trade names.

[9] In support of the Application, the Applicant filed the May 16, 2022, affidavit of its Chief Technology Officer, Tom Roberts, who describes the Applicant's business and its use and promotion of the Mark.

[10] In reply to Mr. Roberts' affidavit, the Opponents filed a second affidavit of Mr. Geriépy, dated July 18, 2022. In his second affidavit, Mr. Geriépy expresses his opinions regarding the distinctiveness of the Opponents' trade names and the likelihood of confusion with the Mark, as well as regarding the reliability and probative value of Mr. Roberts' evidence. In this last respect, Mr. Geriépy attaches as exhibits to his affidavit printouts from or about some of the websites featured in Mr. Roberts' affidavit.

[11] Neither of the affiants was cross-examined. Only the Opponent filed written representations, but both parties were represented at an oral hearing.

PRELIMINARY MATTER: ADMISSIBILITY OF THE APPLICANT'S EVIDENCE

[12] In their written representations, the Opponents objected to the admissibility of the exhibits to Mr. Roberts' affidavit on the basis that neither the cover pages nor the exhibits have been signed by the notary before whom the affidavit was sworn. In the Opponents' submission, although the Registrar has "waived this technicality" in the past, such decisions are not binding and notarization of the exhibits is nevertheless required, (i) because oppositions can be appealed to the Federal Court, or infringement proceedings can be brought in a court regarding the same subject matter, and thus court rules as to admissibility of evidence should be followed, and (ii) to verify that the exhibits as filed represent the versions that were truly intended by the affiant

[paras 8–10]. In the alternative, the Opponents requested that the Registrar indicate the exhibits have not been accepted for the purpose of any proceedings in court [para 11].

[13] In addition, and more specifically, the Opponents submitted that Exhibit TR-7 to Mr. Roberts' affidavit, comprising copies of trademark registration certificates from various jurisdictions, should be disregarded because the copies are not certified.

[14] First, the Registrar does not have jurisdiction to rule on the admissibility of evidence before the Federal Court.

[15] Second, although the rules of evidence applicable in the Federal Court are generally applicable in opposition proceedings, particularly in view of the parties' right of appeal to the Federal Court under section 56 of the Act, the Registrar, as an administrative tribunal, is the master of its own procedure, and is not strictly bound by the *Federal Court Rules* regarding evidence, including the rules regarding endorsement of exhibits to an affidavit [see *Tension 10 Inc v Tension Clothing Inc* (2004), 45 CPR (4th) 136 (TMOB); and *London Life Insurance Company v Liberty Mutual Insurance Company*, 2013 TMOB 217]. In particular, the Registrar has accepted exhibited evidence that is not properly endorsed where the exhibits are clearly identified and explained in the body of the affidavit [see, for example, *Borden & Elliot v Raphaël Inc* (2001), 16 CPR (4th) 96 (TMOB); and *Pro-Tech Seal Products Inc c PROTECH SAM*, 2018 TMOB 75]. Furthermore, the Registrar generally accepts affidavits sworn to in foreign jurisdictions, as long as they meet the requirements of that jurisdiction [see *Orion Corporation v Cross Vetpharm Group Limited*, 2018 TMOB 8]. In the present case, there is no indication that Mr. Roberts' affidavit does not meet the requirements of the state of California. Furthermore, in the absence of cross-examination, I have no reason to doubt that the exhibits attached to his affidavit are the intended exhibits as identified by number and described in his affidavit.

[16] Finally, there is no requirement that only certified records or certified true copies of materials be included in the exhibits to an affidavit.

[17] In view of the foregoing, I find Mr. Roberts' affidavit admissible in its entirety.

PRELIMINARY MATTER: ADMISSIBILITY OF THE OPPONENT'S REPLY EVIDENCE

[18] At the oral hearing, the Applicant submitted that Mr. Geriépy's second affidavit should be disregarded because it is not strictly confined to matters in reply. More specifically, the Applicant argued that Mr. Geriépy's second affidavit does not respond to Mr. Roberts' evidence but rather consists of irrelevant observations, speculation, and opinions on matters that are for the Registrar to decide.

[19] Proper reply evidence responds directly to points raised in an applicant's evidence that are unanticipated; it is not meant to correct or complete an opponent's earlier evidence and does not entitle a party to split its case [see *Halford v Seed Hawk Inc*, 2003 FCT 141]. Evidence that is simply contradictory, without being relevant to a matter at issue or to the determination of the case, will not be allowed as reply evidence [*Halford, supra*; see also *R v Krause*, [1986] 2 SCR 466]. Nor will evidence that is simply confirmatory of evidence that is already of record [*Halford, supra*].

[20] I agree with the Applicant that the majority of the information contained in Mr. Geriépy's second affidavit is not proper reply evidence. I find the following paragraphs to be inadmissible for this reason:

- Paragraphs 3 to 6, 8 to 11, and 16, which contain Mr. Geriépy's opinions on whether the Applicant's evidence is sufficient to show use of the Mark in Canada, on whether the parties' respective goods and services overlap, on the distinctive character of the Mark and of the Opponents' trademark and trade name VICTRIX, on the degree of resemblance between them, and on the likelihood of confusion. Mr. Geriépy has not qualified himself as an expert in trademark law and accordingly his opinions in this respect will be disregarded in both of this affidavits. (Paragraph 9 also contains a factual statement regarding the origin of certain exhibited photographs, which is excluded for reasons discussed below.)
- Paragraph 7, which contains Mr. Geriépy's opinions on the nature and future of the video game industry and of the Applicant's target market. Mr. Geriépy has not qualified himself as an expert on the video game industry in Canada; nor has he

established that he has knowledge of this industry by virtue of his position with the Opponents. Accordingly his opinions in this respect will be disregarded.

- Paragraph 9, where Mr. Geriépy comments on the location of the company whose name is displayed as a logo on certain photographs attached to Mr. Roberts' affidavit. Mr. Roberts states that the photographs are provided to "describe the types of goods" in association with which the Mark is used in Canada; he does not allege that the photographs were actually taken in Canada or purport to establish sales in Canada [see para 10 and Exhibit TR-3 of his affidavit]. Accordingly, I do not find that Mr. Geriépy's evidence concerning the photographs' origin responds to a point made by Mr. Roberts.
- Paragraph 12, in which Mr. Geriépy provides the location denoted by a postal code on the Amazon webpage attached as part of Exhibit TR-4 to Mr. Roberts' affidavit. According to Mr. Roberts, the web captures of gaming blogs and distributor and collaborator websites in this exhibit show the nature of the Applicant's goods sold in association with the Mark and how the goods are described by reviewers; he does not allege that any of the web captures show steps in the purchase of such goods from Canada or the availability of such goods in Canada [see paras 11–12 of his affidavit]. Accordingly, I find that Mr. Geriépy's information about the postal code denoting the United States is merely confirmatory of the existing evidence rather than responsive to a point made by Mr. Roberts.
- Paragraph 15 along with Exhibit TR-17, which introduce a Whois historical record showing that the domain name *victrixpro.com* was registered in 2017. Mr. Geriépy states that this record contradicts Mr. Roberts' statement that the Applicant has controlled its website for over ten years; however, as noted by the Opponent, Mr. Roberts' statement was made in respect of the Opponent's website at pdp.com. Given that the furnished Whois record concerns a different website address, it does not respond to Mr. Roberts' statement. Nor do I find it relevant to any other matters at issue in this case.

[21] However, I am prepared to admit the following paragraphs, which I find respond to points raised in Mr. Roberts' evidence that could not reasonably have been anticipated:

- Paragraph 13 along with Exhibit P-15, and paragraph 14 along with Exhibit P-16, which respectively introduce printouts from the Canadian versions of the GameStop and Newegg websites referenced by Mr. Roberts and captured at Exhibit TR-4 of his affidavit, which Mr. Geriépy states were from the United States. Mr. Geriépy's printouts directly respond to Mr. Roberts' evidence that the Applicant's VICTRIX-branded products were advertised for sale on these sites on May 5, 2022, by offering evidence that such products may not have been available for purchase in Canada through these channels until later (the Canadian sites indicate May 17, 2022, and July 7, 2022, respectively).

[22] Although the web captures at Exhibit TR-4 of Mr. Roberts' affidavit do not purport to establish the timing of the depicted goods' availability in Canada, or for that matter in the United States, I nevertheless find Mr. Geriépy's evidence responsive to any implicit suggestion that the Applicant's goods have been made available in both countries at the same time since at least as early as March 7, 2018. I find the issue relevant particularly given that none of the materials attached to Mr. Roberts' affidavit are identified as originating from Canada, despite his statements that VICTRIX products have been introduced and sold in Canada [see paras 9–10]. That being said, I do not find the webpages furnished by Mr. Geriépy to be particularly probative of the Mark's first use or length of use in Canada. Absent further context, advertised dates of availability for these products from only the two vendors in question are not determinative.

[23] I note that the evidence I have excluded would not have affected my decision in this case. The opinions Mr. Geriépy provides are essentially reflected in the Opponents' written and oral submissions and, for the reasons given above, I do not find the additional factual evidence to be particularly probative.

EVIDENTIAL BURDEN AND LEGAL ONUS

[24] In an opposition proceeding, the legal onus is on the applicant to show that its application complies with the provisions of the Act. However, for each ground of opposition, 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 that ground of opposition exist. If this initial burden is met, then the applicant must satisfy the Registrar, on a balance of probabilities, that the ground of opposition should not prevent registration of the trademark at issue [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)].

ENTITLEMENT UNDER SECTION 16(1)(C) OF THE ACT

[25] The Opponents plead that the Applicant is not the person entitled to registration of the Mark under section 16(1)(c) of the Act because (at the material date) it was confusing with the following trade names previously used by the Opponents in association with computer software applications: (i) VICTRIX.CA , VICTRIX, VICTRIX SOLUTIONS INC., and LES SOLUTIONS VICTRIX INC., used in Canada since at least September 2, 2003, by the Opponent LSVI, as well as SOLUTION VICTRIX GED and SOLUTION VICTRIX DIGITAL WORKSPACE; and (ii) VICTRIX, VICTRIX.CA, VICTRIX CONSEIL INC., and VICTRIX CONSULTING INC., used in Canada since at least October 4, 2012, by the Opponent Victrix Conseil Inc. (VCI).

[26] The material date to assess an applicant's entitlement to registration is the earlier of the application's filing date and the date of first use of the applied-for trademark. In the present case, there is no evidence of use of the Mark prior to the priority filing date of October 17, 2017. Indeed, Mr. Roberts states that the Applicant adopted the Mark in Canada only since at least as early as March 7, 2018. Accordingly, the material date is October 17, 2017.

Trade name use "in association with computer software applications"

[27] At the oral hearing, the Applicant submitted that the ground as pleaded is limited to allegations of prior use of the Opponents' trade names in association with the goods expressly listed in the statement of opposition, namely "computer software applications". In support, the Applicant cites *Premier Horticulture Ltée c Les Sols R Isabelle Inc*, 2022 TMOB 36, where a non-entitlement ground of opposition was held to be limited to use of the opponent's trademark in association with composts containing both peat and manure, as per the wording of the statement of opposition. Consequently, in that case, the opponent's initial burden could not be met through use with composts containing either peat or manure, but not both together.

[28] The Applicant further submitted that, since the pleading is limited to goods, the Opponents' trade name use must be in the normal course of *trade in goods*, whereas their evidence demonstrates only the provision of services.

[29] The Registrar has no jurisdiction to deal with a ground not found in the statement of opposition. Therefore, where an opponent pleads that an application fails to comply with a section of the Act based on a particular set of circumstances, the Application cannot be refused because it fails to comply with the Act for a different reason [see *Massif Inc v Station Touristique Massif du Sud (1993) Inc*, 2011 FC 118; and *Procter & Gamble Inc v Colgate-Palmolive Canada Inc*, 2010 FC 231]. Failure to adequately cite a specific ground, or to amend the statement of opposition to do so, precludes consideration of that ground [*Carling Breweries Ltd v Molson Companies Ltd* (1984), 1 CPR (3d) 191 (FCTD)]. However, once evidence is filed, the Registrar must take it into account in interpreting the pleadings and deciding whether the applicant knows the case to meet and is able to respond [*Novopharm Ltd v AstraZeneca AB*, 2002 FCA 387].

[30] In so doing, the Registrar "may show a degree of flexibility in allowing a party to raise an issue that is outside a literal reading of the pleadings, provided that no unfairness results" [*101217990 Saskatchewan Ltd (District Brewing Company) v Lost Craft Inc*, 2022 FC 1254 at para 9, aff'g, 2021 TMOB 151]. A ground of opposition is

defined mainly by reference to the provision of the Act relied upon and, where applicable, the confusing trademark or trade name; therefore, amendments arguably enlarging the scope of the alleged use of a trademark or trade name may not necessarily constitute a new ground of opposition [see *e.g. Lost Craft, supra* at 10–11, upholding the Registrar’s interpretation of use “in association with beer” to include use in association with “brewery services”].

[31] In the statement of opposition as amended, the Opponents allege that the Applicant is not entitled to registration because, at the material date, the Mark was confusing with trade names that had been previously used by the Opponents in association with “computer software applications”. However, section 2 of the Act defines a trade name as the name under which a business is carried on. A review of Mr. Geriépy’s affidavit makes it clear that the Opponents are relying primarily on trade name use in association with a business providing IT services, including consulting services and technical support. However, I find it equally clear that “computer software applications” are one of the subject matters of the Opponents’ IT services, and that the Opponent’s business, which includes the provision of consulting and technical support services, is carried on “in association with” such computer software applications.

[32] Moreover, although the Applicant maintains that the scope of the pleadings is restricted to trade name use in association with goods, the Applicant also made certain oral submissions in the alternative, strictly for the sake of argument, addressing the test for confusion *as if* the pleadings had alleged use in association with services. Accordingly, it would appear that the Applicant understood the case it would have to meet if the pleadings were to be interpreted to include *services* provided in association with computer software applications, and the Applicant was able to respond. In my view, the fact that the Applicant chose to raise the sufficiency of the pleadings as its primary position, and responded on the merits only in the alternative, is immaterial.

[33] I also disagree with the Applicant’s submissions to the extent that they suggest use of a trade name in the normal course of trade requires a transfer of the goods specified in the pleading, with a simultaneous notice of association between the trade

name and those goods, analogous to what would be required for a finding of trademark use under section 4(1) of the Act (see e.g. *Premier Horticulture*, above, with respect to such a requirement for trademark use).

[34] First, I do not consider paragraph 15 of the Opponents' written representations to constitute an admission that their trade name use must be in the normal course of trade in goods or follow the requirements of section 4(1) of the Act with respect to a notice of association at the time of transfer. This paragraph of their written representations contains an oft-quoted passage from *Mr. Goodwrench Inc v General Motors Corp* (1994), 55 CPR (3d) 508 at paras 12–13 (FCTD), which cites *Professional Publishing Associates Ltd v Toronto Parent Magazine Inc.* (1986), 9 CPR (3d) 207 (FCTD), in finding that “the principles in ss. 2 and 4(1) of the Act apply to trade name use” and that the test applicable to trade names is thus “use in the normal course of trade”. However, the issue in *Mr. Goodwrench* was not whether a notice of association was given between the trade name and goods at the time of transfer but rather whether a single sale of goods will suffice, when there is no evidence the Opponent has a functioning business. In *Toronto Parent*, the issue was whether referencing the trade name in private conversations will suffice, and it appears use was not found until the defendant's first business transaction, being an advertising contract.

[35] In the absence of a specific definition of “use” in the Act pertaining to trade names, the principles in sections 2 and 4 of the Act regarding trademark use have been held to apply, as noted above, so that use of a trade name must be in the normal course of a functioning business and also in relation to the class or classes of persons with whom such business is to be conducted [see *Mr Goodwrench*]. Furthermore, display of a trade name may serve as trademark and trade name use simultaneously; the two are not mutually exclusive and incorporation of a trade name into a composite trademark or logo does not prevent it from simultaneously being recognized as a trade name [*Consumers Distributing Co/Cie Distribution aux Consommateurs v Toy World Ltd*, 1990 CarswellNat 1398 (TMOB); *CEG License Inc v Joey Tomato's (Canada) Inc*, 2011 TMOB 221]. However, the two concepts are different in that a trademark is used to brand goods and services whereas a trade name is used to identify a legal entity or

business. As noted in A. Kelly Gill, *Fox on Canadian Law of Trade-Marks and Unfair Competition*, 4th ed, (Toronto: Thomson Reuters, 2002) (loose-leaf updated February 2024, release 2), ch 14 at § 14:3,

Trade names are terms or symbols used to distinguish and identify corporations, partnerships, businesses or individuals and the accompanying good-will. Trade names do not identify nor distinguish goods or services. The *Trade-marks Act* defines a “trade name” as “the name under which any business is carried on, whether or not it is the name of a corporation, a partnership or an individual.” [emphasis added]

[36] The difference between the use of a trademark and that of a trade name can also be observed in section 6(3) of the Act, which states,

the use of a trademark causes confusion with a trade name if the use of both the trademark and the trade name in the same area would be likely to lead to the inference that the goods and services associated with the trademark and those associated with the business carried on under the trade name are manufactured, sold, leased, hired or performed by the same person...” [emphasis added].

[37] Furthermore, section 6(5)(c) of the Act indicates that, in determining whether trademarks or trade names are confusing, the Registrar shall have regard to “the nature of the goods, services or business” [emphasis added].

[38] Thus, I find that what a pleading under section 16(1)(c) of the Act requires is that the nature of the business carried on under the trade name be specified, along with the goods or services associated with that business. Furthermore, in my view, identifying the nature of the business as being “in association with computer software applications” does not necessarily imply a sales business or require transfers in the normal course of trade of branded computer software applications. The description in itself is vague in that it may refer to any type of business that is carried on in association with computer software applications. However, on a fair reading of the pleadings in view of the evidence filed, I find it clear that the Opponents are relying on use of the listed trade names for a business providing IT consulting and technical support services in association with computer software applications.

[39] Accordingly, following the approach of the court in *Mr. Goodwrench*, I will assess whether the Opponents' trade names were used to identify such a business at the material date.

Trade name use "by the Opponents"

[40] I would also note that the pleading under this ground alleges trade name use in Canada by the Opponent LSVI since at least September 2, 2003, whereas Mr. Geriépy's evidence is that this entity was not incorporated until December 2010 [para 3, Exhibit P-3]. According to Mr. Geriépy and the extracts from the Quebec corporate register attached to his affidavit, a separate legal entity was registered in Quebec as "Les Solutions Victrix Inc." on September 2, 2003 (Former LSVI), and it transferred the name "Les Solutions Victrix Inc." to LSVI on February 1, 2011 [see paras 1–3, Exhibits P-1–P-3]. Although not confirmed by Mr. Geriépy, it appears from the register extracts that both companies have their head office at the same address and that Former LSVI, operating under a new name, has become a holding company and LSVI's majority shareholder [Exhibits P-2–P-3].

[41] On a fair reading of the statement of opposition in view of the evidence filed, I find it clear that the grounds referencing LSVI are meant to invoke not only use by LSVI itself but also use by its predecessor in title, Former LSVI. Throughout his affidavit, Mr. Geriépy refers to events involving LSVI that predate its incorporation, thus signalling that he considers LSVI to be continuing the original business and that references to LSVI include Former LSVI where applicable. Likewise, the materials attached to his affidavit do not appear to distinguish between LSVI and Former LSVI. For example, on the printout of the Opponents' homepage at Exhibit P-14, a link to a blog post dated September 14, 2018, indicates that "VICTRIX" is beginning to celebrate its 15-year anniversary with a new logo, which is consistent with a business that began operating in September 2003 and has continued under that name [see also link to February 18, 2019, news article re 15-year anniversary video]. I also note the correspondence from the City of Sherbrooke to "Solutions Victrix" dated August 3, 2012, renewing a contract from 2008, which pre-dates LSVI's incorporation [Exhibit P-6F].

[42] The Applicant's representations appear to accept that evidence of trade name use predating 2010 may be considered. Indeed, this interpretation was already foreshadowed by the statement of opposition as originally filed, which included as attachments both the corporate register extract evidencing LSVI's 2010 incorporation date—implying that any earlier use would have to be through a predecessor in title—and the website printout indicating that “VICTRIX” was 15 years old in September 2018—indicating that one of the Opponents is continuing the “VICTRIX” business of a predecessor in title that started in 2003. Although these attachments do not form part of the statement of opposition as amended, they are in evidence. (The pleading that the Opponent VCI has used the relied-upon trade names since October 4, 2012, is consistent with *its* corporate register extract, which is also attached to the original statement of opposition and is in evidence.)

[43] In these circumstances, I will address the non-entitlement ground in view of the Opponent's pleadings considered in conjunction with the evidence filed.

The Opponents' initial burden

[44] To meet its initial burden under this ground, the Opponent must evidence that its trade name was used prior to the material date [section 16(1) of the Act] and also that it had not been abandoned when the Application was advertised [section 16(3) of the Act]. Section 16 of the Act does not require an opponent to demonstrate any particular level of use or reputation; if an opponent shows that its trade name functions as such, then a single sale or event may suffice to demonstrate its use [*JC Penney Co v Gaberdine Clothing Co*, 2001 FCT 1333].

[45] As noted above, the Opponent must demonstrate use of its trade name in the normal course of a functioning business and in relation to the class or classes of persons with whom such business is to be conducted. The principles in section 4 of the Act have been held to apply, such that display of a trade name in the performance or advertising of services available in Canada will suffice to show use of the trade name in the course of business [*Carbon Trust Inc v Pacific Carbon Trust*, 2013 FC 946; see also *Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB), re offering and

being prepared to perform the services in Canada]. Conversely, registration of a company under a particular name does not, by itself, constitute use of that trade name, and the appearance of a trade name on documents not issued by the opponent does not qualify as use of that trade name by the opponent [see *Opus Building Corp v Opus Corp* (1995), 60 CPR (3d) 100 (FCTD); *Pharmx Rexall Drug Stores Inc v Vitabrin Investments Inc* (1995), 62 CPR (3d) 108 (TMOB); and *Tension 10, supra*].

[46] The Opponents allege prior use of a number of different trade names and I will therefore begin by considering which of these trade names are in evidence and whether the Opponents are able to meet their initial burden for each of them. As the pleadings allege prior use by two different Opponents, my analysis will begin with an overview of the two Opponents and their respective businesses and trades.

The Opponents' corporations

[47] By way of background, Mr. Geriépy states that the Opponents are related companies operating in the area of IT consulting services, specializing in infrastructures, telecommunication networks, software development systems, and computer security systems (“œuvrent dans le domaine des services-conseils en technologie de l'information et se spécialisent dans les infrastructures, les réseaux de télécommunication, et les systèmes de développement et de sécurité informatique”) [paras 6–7].

[48] The Opponent LSVI was federally incorporated on December 20, 2010 [Exhibit P-3]. It acquired the corporate name Les Solutions Victrix Inc.—whose registered English version is Vitrix Solutions Inc.—on February 1, 2011, from Former LSVI, an IT consulting company federally incorporated under that name on August 29, 2003, and continued under that name through an amalgamation that took place in 2006 [paras 1–3, Exhibits P-1–P-3]. Mr. Geriépy states that LSVI, in addition to performing services for the general public, has contracts with several public bodies in Quebec for work relating to the integration and installation of computer, security, and technology infrastructure systems (“l'intégration et la mise en place des systèmes informatiques, de sécurité et des infrastructures technologiques”) [para 11].

[49] LSVI is also the majority shareholder of the Opponent VCI, a Quebec corporation originally named IPTEL Inc. that Former LSVI acquired in 2009 [paras 4–6, Exhibit P-4]. VCI was renamed Victrix Conseil Inc.—with the registered English version being Victrix Consulting Inc.—on October 4, 2012 [para 5, Exhibit P-4]. Mr. Geriépy does not specify the nature of VCI’s business, but the Quebec corporate register extracts attached to his affidavit list its sectors of activity as IT consulting and as computing and programming, which are the same as those listed for LSVI [Exhibits P-3, P-4].

The Opponents’ trade names

[50] Mr. Geriépy states that LSVI has used the English and French versions of its corporate name—as well as the trade names Victrix, Victrix.ca, Solutions Victrix GED, and Solutions Victrix Digital Workspace—in association with its business activities since at least as early as September 2, 2003, and that VCI has used the English and French versions of its corporate name—as well as the trade names Victrix and Victrix.ca—in association with its business activities since at least as early as October 4, 2012 [para 8]. He specifies that the trade name VICTRIX is used on documents and on work tools in the course of business activities both before and during the performance of services—for example, on advertising, on service offers and accompanying *curricula vitae* (CVs), on service contracts, and on invoicing and related work reports [paras 9, 13–14, Exhibits P-6B, P-8–P-9].

[51] I note from the supporting documentation he provides that the trade name VICTRIX it is occasionally displayed as one of the two logos reproduced below, featuring the word VICTRIX in a particular script with embellishment of the final letter(s):



Original LSVI Logo



New LSVI Logo

[52] The first logo (the Original LSVI Logo) is in italicized capitals with a lowercase “i”; a checkmark in a contrasting colour forms the “i” and part of the X. The second logo (the

New LSVI Logo)—which is only displayed on materials dated as of 2018—is in capital lettering with a lowercase “r”; a forward-pointing chevron in a contrasting colour forms part of the X. Mr. Geriépy does not explain the difference between the two logos, but the aforementioned blog post link on the Opponents’ homepage suggests the New LSVI Logo marks the company’s 15-year anniversary [see Exhibit P-14].

[53] I also note that the Original LSVI Logo is displayed on the exhibited materials dating from 2004 to 2007 with the words LES SOLUTIONS in small print above VICTRIX (the Les Solutions Variation) and on the exhibited materials dating from 2013 and 2014 with the slogan “*Récoltez le fruit de vos TI*” (Harvest the fruit of your IT) in small print below VICTRIX (the Slogan Variation), as reproduced below:



Les Solutions Variation



Slogan Variation

[54] It is well established that a word mark may generally be used in any stylized form and colour [see *AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 FCTD]. I find that the same principle applies here in respect of trade name use, such that use of either the Original LSVI Logo or the New LSVI Logo as a trade name would constitute use of the pleaded trade name VICTRIX. Applying the principles set out in *Canada (Registrar of Trade-marks) v Cie Internationale pour l’informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA); *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA); *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); and *Loro Piana SPA v Canadian Council of Professional Engineers*, 2009 FC 1096, I am also satisfied that use of either variation of the Original Logo constitutes use of the Opponents’ trade name VICTRIX. By virtue of its much larger size, relative position, and stylization, the name VICTRIX stands out from the additional descriptive words “LES SOLUTIONS” in the Les Solutions Variation and from the slogan in the Slogan Variation. Thus, I find that the Opponents’ trade name VICTRIX has not lost its identity and remains recognizable in these two variations of the Original LSVI Logo.

[55] I would also note that I disagree with the Applicant's suggestion at the oral hearing that, in the circumstances of this particular case, where the trade name LES SOLUTIONS VICTRIX INC. is often displayed close to the logo, it may be LES SOLUTIONS VICTRIX INC. that would be seen as the trade name whereas the logo would be seen as a *trademark*, and thus outside the scope of the pleadings. In my view, the logo is equally if not more likely to be seen as the short form of the company name, presented in a stylized or logo form.

Evidence of trade name use

[56] I note the following from the supporting documents attached to Mr. Geriépy's affidavit (those relating to contracts and invoicing being partially redacted):

- Six service contracts, dated between June 9, 2009 and January 7, 2013, and a rider dated March 17, 2017, extending a contract from 2014 [Exhibits P-6A–P-6I]. The agreements are all between various Quebec government entities and LSVI or Former LSVI, identified variously as Les Solutions Victrix Inc. (from 2010 to 2017) or Victrix (from 2009 to June 2012) The subject matter of the contracts involves IT development support, implementation, maintenance, modification, and upgrading services; installation of virtual infrastructure and security platforms; migration and deployment of IT, including servers; and technical support for technology infrastructures and security, including for firewall, Microsoft, and Netware environments. The copies in the exhibit do not necessarily all show the signatures of both parties; however, they still provide evidence of the Opponents' trade name use in arriving at the agreements.
- Offers of services dated May 12, 2009, and June 13, 2012, in connection with two of the above-noted contracts. The Original LSVI Logo is displayed on the cover and/or proposal pages and "Victrix" is referenced in the text [Exhibits P-6B, P-6E].
- Correspondence, meeting minutes, and an executive summary from the City of Sherbrooke, dating from 2012, 2013, and 2018, renewing its contracts with LSVI

dating from 2008 and 2013 for specialized professional services, including in the areas of computer security and of computer and telecommunication networks [Exhibits P-6F, P-6I]. However, the furnished documentation does not originate from the Opponents and does not demonstrate what names they used in conducting this business, and it is therefore not of assistance in meeting their initial burden. At best, the fact that the June and August 2012 documents name “Solutions Victrix” suggests that LSVI was known to the City by that name. However, it is not clear which Opponent is identified by the documents from 2013 and 2018, which identify only “Victrix”, since, according to Mr. Geriépy, VCI was also using “Victrix” trade names by then (starting as early as October 4, 2012).

- A selection of invoices issued by LSVI and Former LSVI from 2004 to 2016, addressed to one individual and eight entities—including government entities, utilities, and a union—in the Montreal area, Sherbrooke, and Quebec City [Exhibits P-7A–P-7I]. The Original LSVI Logo (being the Les Solutions Variation from 2004 to 2007 and the Slogan Variation from 2013 to 2014) is displayed in the header of each invoice. The trade name “Les Solutions Victrix inc.” is displayed above the company address and as the payee for cheques in the 2004 invoice and again, as of 2009, above the company address. In addition, website and/or e-mail addresses ending in VICTRIX.CA are at times displayed below the company address, namely “*www.victrix.ca • info@victrix.ca*” (2005 and 2007), “*Courriel : facturation@victrix.ca*” (2009), and “*Courriel : finance@victrix.ca*” (as of 2010). As of April 2013, “*www.victrix.ca*” is displayed in the footer.
- More detailed work reports corresponding to the 2005 and 2009–2016 invoices [Exhibits P-7A, P-7C–P-7G, P-7H] along with two additional work reports from 2005 [Exhibit P-8]. All display the Original LSVI Logo (being the Les Solutions Variation in 2005 and the Slogan Variation in 2013 and 2014). Those issued in the first part of 2005 also display the trade name “Les Solutions Victrix inc.” above the company address and as the payee for cheques; those issued from 2009 to 2012 display the trade name “Les Solutions Victrix” above the company

address. As of April 2013, the website address *www.victrix.ca* is included in the footer. The invoiced services include the planning and installation of security infrastructure; the installation, validation, configuration, testing, troubleshooting, provision of information on, and upgrading of security software; server migration, updates, and troubleshooting; troubleshooting and testing of software; IT infrastructure audit and analysis; and consulting in regards to infrastructures, telecommunication networks, server issues, and security, including in regards to planning, installation, updating, reconfiguration, optimization, and troubleshooting.

- Two examples of the type of professional's CV that accompanies service offers: one that is undated but which displays the Slogan Variation (which, as noted above, appears to date from 2013–2014) and which contains entries for current projects with start dates up to 2012; and one dated January 2018, which displays the New LSVI Logo as a footer and first-page header [Exhibit P-9]. The earlier CV displays the website address *www.victrix.ca* in the footer.
- Screen captures of the homepage of the Opponents' website at *victrix.ca*, which promotes their range of services for maximizing productivity to increase performance and competitiveness, expressly targeting large and medium-sized enterprises and the public sector [para 20, Exhibit P-14]. The screen captures are undated but the six news posts on the page run from September 18, 2017 to April 7, 2021. The New LSVI Logo is displayed at the top of the page and on cover images for resources such as eBooks and a Microsoft "client immersive experience". The company "Victrix" is referenced throughout. Although there is no explicit indication of whether the page is operated by LSVI, VCI, or both, the promoted services include menu listings for "Solution Victrix GED" and "Solution Victrix Digital Workspace", which Mr. Geriépy identifies as being trade names of LSVI. Also included are links for information on the company's work in cloud computing; Microsoft technologies and platforms; the design, development, and management of collaboration applications and solutions for organizational efficiency; computer and data security; technology infrastructures; and computer

networking and telecommunications. In addition, the May 11, 2018 news post announces the company having qualified for a project in migration and integration of cloud solutions.

[57] I am satisfied that the Opponents have met their initial burden to evidence use of the trade name **VICTRIX** by the Opponent LSVI in carrying on a business providing services in association with computer software applications. Mr. Geriépy's evidence contains multiple examples of the use of VICTRIX to identify the Opponent LSVI and to advertise its services of this nature in the normal course of business prior to the material date of October 17, 2017—including on contracts with clients, on service offers to potential clients, and on invoices. Furthermore I am satisfied from the Opponents' website, which includes news posts dating from September 18, 2017 to April 7, 2021, that the trade name had not been abandoned when the Application was advertised on February 17, 2021. Although the Opponents plead that they have both used this trade name, I am unable to find evidence of use by VCI, and I therefore find it unnecessary to consider any implications such use might have on the Opponents' case.

[58] The Opponents have also shown use of **LES SOLUTIONS VICTRIX INC.** as a trade name on contracts and invoicing; however, the evidence is less clear as to whether LES SOLUTIONS VICTRIX INC. remained in use as a trade name on February 17, 2021, or merely remained the name under which the company was registered in Quebec. I note the display of SOLUTION VICTRIX GED and SOLUTION VICTRIX DIGITAL WORKSPACE in a list of services on the Opponents' homepage; however, these are characterized as separate trade names in the statement of opposition and, in the absence of any further context, it is difficult to assess whether the "SOLUTION VICTRIX" portion might also constitute a variation of LES SOLUTIONS VICTRIX INC. In any event, it is not necessary to decide the issue, since I consider the trade name VICTRIX to provide the Opponents with a stronger case, given its greater resemblance to the Mark and the greater evidence of its use and promotion. If the Mark is not confusing with the trade name VICTRIX, then it will not be confusing with the trade name LES SOLUTIONS VICTRIX INC. Therefore, I do not find it necessary to

decide whether the Opponents have also met their initial burden with respect to LES SOLUTIONS VICTRIX INC.

[59] For similar reasons, I find it unnecessary to decide whether display of the website and email addresses *www.victrix.ca*, *info@victrix.ca*, *facturation@victrix.ca*, and *finance@victrix.ca*, as shown in the evidence, also constitutes use of **VICTRIX.CA** as a separate trade name. That said, I would note that I consider display of these addresses in the contexts described above as reinforcing the message that the company issuing the documents in question is conducting business under the trade name VICTRIX.

[60] The Opponents have not drawn my attention to any portion of the evidence showing their use or display of **VICTRIX SOLUTIONS INC.**, **VICTRIX CONSEIL INC.**, **OR VICTRIX CONSULTING INC.** As for **SOLUTION VICTRIX GED** and **SOLUTION VICTRIX DIGITAL WORKSPACE**, the evidence only shows these names displayed in a list of services on the Opponents' website. In the absence of any indication that these names were already displayed on the website prior to October 17, 2017, and in the absence of any information on the nature of the services and on how these names relate to those services, this evidence is inconclusive. Accordingly, the Opponents have not met their initial burden in respect of these five remaining trade names.

Conclusion with respect to the initial burden

[61] Based on the foregoing, I am only satisfied that the Opponents have met their initial burden under section 16(1)(c) of the Act to show prior use and non-abandonment of the trade name VICTRIX in carrying on a business in association with computer software applications, as described above.

[62] I note that, to the extent the Opponents' exhibited homepage advertises services beyond those listed in the exhibited contracts and invoices, the Opponents have not established trade name use with such additional aspects of LSVI's business prior to the material date. However, to the extent that the exhibited homepage suggests limitations to the nature and scope of the business, I find it relevant. Although the nature and scope of a business and its clientele may evolve over time from the date the business

began operations, nothing in the evidence suggests that LSVI's business was broader at the material date than at the date the homepage was captured.

[63] The Opponents having met their initial burden, the onus is on the Applicant to establish, on a balance of probabilities, that the Mark was not likely to cause confusion with the Opponent LSVI's trade name VICTRIX (LSVI's Trade Name) at the material date of October 17, 2017.

The test for confusion

[64] The use of a trademark causes confusion with a trade name if the use of both in the same area would be likely to lead to the inference that the goods and services associated with the trademark and those associated with the business carried on under the trade name are manufactured, sold, leased, hired, or performed by the same person, whether or not the goods or services are of the same general class or in the same class of the Nice Classification system [section 6(3) of the Act].

[65] Thus, the test for confusion does not concern confusion of the trademark and trade name themselves but rather confusion as to whether the goods and services associated with the trademark come from the same source as those associated with the business identified by the trade name. Where it is likely to be assumed that the applicant's goods or services either come from the opponent or are approved, licensed, or sponsored by the opponent, it follows that the trademark and trade name are confusing [see *Glen-Warren Productions Ltd v Gertex Hosiery Ltd* (1990), 29 CPR (3d) 7 (FCTD)].

[66] The test is to be applied as a matter of first impression in the mind of a casual consumer somewhat in a hurry, who sees the applicant's trademark at a time when he or she has no more than an imperfect recollection of the opponent's trade name and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the trademark and trade name [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23]. Regard must be had to all the surrounding circumstances, including those set out in sections 6(5)(a) to (e) of the

Act, but these criteria are not exhaustive and the weight given to each factor will vary in a context-specific analysis [*Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22].

Section 6(5)(e): Degree of resemblance between the trademarks or trade names, including in appearance or sound or in the ideas suggested by them

[67] The degree of resemblance between the trademarks or trade names at issue is often the factor likely to have the greatest effect on the confusion analysis and, thus, is an appropriate starting point. Each trademark or trade name must be considered as a whole and assessed for its effect on the average consumer as a matter of first impression [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27].

[68] In the present case, the Mark is identical to LSVI's Trade Name in appearance, sound, and ideas suggested. Although the evidence shows that both the Mark and LSVI's Trade Name are often displayed in the form of a logo, the Application is for a word mark, so that its registration would permit use of the Mark in any style of lettering, color or design—including styles that are closer in appearance to the Original LSVI Logo, which was in use at the material date. There is no reason to expect any difference in the way the Mark and LSVI's Trade Name are sounded. As for ideas suggested, both parties take the position that VICTRIX is simply a coined word, that does not suggest any particular ideas (laudatory or otherwise) as a matter of first impression.

[69] Accordingly, this important factor favours the Opponents.

Section 6(5)(a): Inherent distinctiveness of the trademarks or trade names and the extent to which they have become known

[70] Consideration of the section 6(5)(a) factor involves assessing the strength of a trademark or trade name as a combination of both inherent and acquired distinctiveness.

[71] An invented, unique, or non-descriptive word is generally considered to be more inherently distinctive than an everyday expression or words of a descriptive, suggestive, or laudatory character [see *Mattel, supra*; and *Puma SE v Caterpillar Inc*, 2023 FCA 4]. Inherently distinctive trademarks or trade names “strike the imagination and become

more firmly rooted in the consumer's memory"; as such, they are generally accorded a greater degree of protection [see *G M Pfaff Aktiengesellschaft v Creative Appliance Corp Ltd* (1988), 22 CPR (3d) 340 (FCTD) at para 7].

[72] Inherent distinctiveness must be assessed from the perspective of the ordinary, everyday purchaser or user of the particular goods or services in question [see *Wool Bureau of Canada Ltd v Registrar of Trade-Marks* (1978), 40 CPR (2d) 25 (FCTD)]. One should attempt to ascertain the first or immediate impression created by the trademark or trade name in its full context, in conjunction with the goods or services [*Ontario Teachers Pension Plan Board v Canada (Attorney General)*, 2012 FCA 60]. In the present case, LSVI's Trade Name is used in association with information technology services aimed at increasing performance and competitiveness, while the Mark is for use in association with products for esports gamers. However, since the parties agree that no particular meaning would be apparent from the coined word VICTRIX in these contexts as a matter of first or immediate impression on the average consumer, I accept that both the Mark and LSVI's Trade Name are inherently strong.

[73] In their written representations, the Opponents submit that, when the parties' respective trademarks feature the same inherently distinctive component, the inherent distinctiveness factor is not counterbalanced or negated but rather is intended to favour the senior party [paras 45–46]. In support, the Opponents cite the legal texts *Fox on Canadian Law of Trade-marks and Unfair Competition*, 4th ed (loose-leaf, 2012-Rel 2), (Toronto: Carswell) at sect. 8.2(a), for the proposition that "the weight and emphasis is placed on the senior mark with respect to inherent distinctiveness", and *Hughes on Trade Marks*, 2nd ed (loose-leaf, 4/2015 Rel 43), (Markham: LexisNexis) at §70, for the proposition that the degree of inherent distinctiveness affects the "scope of protection" extended to a mark. Indeed, the Federal Court recently expressed a similar notion in *Novartis AG v Biogen Inc*, 2024 FC 52, in finding that the distinctiveness of the opponent's coined and inherently distinctive trademark was a factor that favoured the opponent. Justice Pallotta explained, "I do not accept that distinctiveness under 6(5)(a) should be a neutral factor in this case because the applicant's mark is also a coined

word. To do so would undermine the principle that coined words are typically afforded a wider ambit of protection” [para 62].

[74] In my view, the guiding principles are those laid out by the Supreme Court of Canada in *Matte*: “Each situation must be judged in its full factual context” [at para 72] and “The totality of the circumstances will dictate how each consideration should be treated” [at para 63, citing *United Artists Pictures Inc v Pink Panther Beauty Corp*, [1998] 3 FC 534 (FCA) at para 33]. With respect to section 6(5)(a), the Act pairs a consideration of a trademark’s inherent distinctiveness with a consideration of the extent to which it has become known. Thus, this factor involves “a determination of the strength of a mark in terms of its inherent and/or acquired distinctiveness” [*Novartis* at para 59, citing *Pink Panther*, *ibid.* at para 23]. The Act treats relative seniority as a separate factor, set out in section 6(5)(b), which addresses the length of time the parties’ trademarks or trade names have been in use. In some cases, aspects of factors 6(5)(a) and 6(5)(b) may well work together in the opponent’s favour. However, ultimately, all of the surrounding circumstances and all of the considerations within each factor must be taken into account and balanced in a context-specific analysis.

[75] With respect to acquired distinctiveness, the distinctiveness of a trademark or trade name can be enhanced if the mark or name becomes known through use and promotion. Both parties filed evidence in this regard.

Use and promotion of LSVI’s Trade Name

[76] In addition to providing the foregoing evidence of use and promotion of LSVI’s Trade Name by LSVI and its predecessor Former LSVI, Mr. Geriépy provides evidence of the size and success of the business, including evidence of industry recognition and media coverage.

[77] With respect to industry recognition, Mr. Geriépy introduces excerpts from the following rankings:

- Braham Group Inc.’s Braham300 listings of the “Top 250 Canadian ICT Companies” and “Top 10 Canadian ICT Security Companies”, which Mr. Geriépy

attests are financial performance-based rankings used by information and communication technology (ICT) companies to measure their success [para 16, Exhibit P-10]. The printouts show “Victrix” made the “Top 250” list for 2011 (and also the “Top 10” list for that year), 2012, 2013, 2014, and 2015. (The printouts also show “Victrix” ranking 80th for 2018 and Mr. Geriépy attests to a ranking of 81st in 2019; however, those rankings would be after the material date.)

- The newspaper *Les Affaires*’ list of the top 300 small to medium-sized enterprises in Quebec [para 17, Exhibit P-11]. The printouts show “Solutions Victrix (Les)” was 135th in the list published in 2011, which appears to be based on the total number of employees in 2010.
- CRN’s listing of “Solution Provider 500” companies, which Mr. Geriépy attests is an annual ranking of the best IT technology integrators, service providers, and consultants in North America [para 17, Exhibit P-12]. The printouts show “Victrix” made the list in 2018 and 2019—which is after the material date—and in two other years that are not specified. (Given the issues with the timing of the lists, this particular exhibit is of little relevance, except perhaps to the extent that it tends to corroborate the previous rankings.)

[78] The Applicant submits that industry awards do not necessarily equate with recognition by the general public. However, the Opponent submits that inferences regarding the public’s knowledge may be drawn from the nature of the rankings. In view of Mr. Geriépy’s confirmation that at least the Braham300 ranking is used in the industry as a measure of success, I am satisfied that the evidence is relevant with respect to recognition in the Opponents’ primary market.

[79] With respect to media coverage, Mr. Geriépy introduces excerpts from various Quebec newspapers and websites as examples of media interest in the Opponents’ growth [para 18, Exhibit P-13]. I note the following:

- Two articles that Mr. Geriépy identifies as being from *Le Devoir* (from 2006 and 2010) report “Victrix” having acquired multiple IT companies. In addition, the

2006 article reports a hundred or so clients in Quebec, Canada, and elsewhere, and mentions the company having two original security products: a load balancer for network stability offered by its subsidiary Elfiq and an email firewall still under development but being tested by two Canadian clients. The 2010 article reports over 350 active private- and public-sector clients in Quebec—including Astral Media, Bombardier, Bell, several cities (“*plusieurs villes*”), the Montreal school board, Loto-Québec, and Radio-Canada—with several clients said to have offices in Ontario. The article also mentions the company’s two subsidiaries respectively offering the load balancer (in 60 countries) and IT outsourcing for small and medium-sized enterprises.

- *La Presse* in 2007 refers to “Solutions Victrix” and “Victrix” and discusses the company’s acquisition of other IT enterprises.
- *The Gazette* in 2013 reports that “Victrix” is “one of the fastest-growing IT consultants in Quebec, gobbling up several other players”, and that it has over 400 private- and public-sector clients in Quebec. The article also references the company being named “Partner of the Year” in Canada by Microsoft in 2011 and notes the launch of the company’s SharePoint broadcast system for internal information sharing.
- An article published at *directioninformatique.com* in 2013 also references “Victrix” marketing its broadcasting system based on Microsoft’s SharePoint Web app environment.
- Articles at *securitequebec.com* in 2015 and at *directioninformatique.com* in 2016 respectively discuss “Victrix” acquiring an information security and risk management company and another IT consulting business.
- In addition to the aforementioned trade name references, the Original LSVI Logo is displayed in the 2010 *Le Devoir* article (in a photograph of interior signage), in the 2013 *Direction informatique* article, and in the 2015 *Sécurité Québec* article.

[80] Although circulation figures are not provided, I can take judicial notice that *Le Devoir*, *La Presse*, and *The Gazette*, being major newspapers in a major Canadian city, have fairly substantial circulation at least in Montreal [see *Northern Telecom Ltd v Nortel Communications* (1987), 15 CPR (3d) 540 (TMOB); and *Carling O’Keefe Breweries of Canada Ltd. v Anheuser-Busch, Inc* (1985), 4 CPR (3d) 216 (TMOB), with respect to taking judicial notice of newspaper circulation]. That said, two of these newspapers’ articles are taken from the Internet and there is no indication of the extent to which those articles have been accessed online or made available in print.

[81] Mr. Geriépy states that it is apparent from the above press articles that the Opponents are jointly referred to as “Victrix” [para 19]. However, I do not find any such indications. The articles and listings published after IPTEL Inc. was renamed “Victrix Conseil Inc.” do not distinguish between LSVI and VCI. Moreover, based on the date they give for when “Victrix” was founded, they appear to be referring to LSVI. The 2010 article from *Le Devoir* mentions that the company “IPtel” was acquired and integrated into the parent, and the 2013 article from *The Gazette* mentions the acquisition of “IPTEL” giving Victrix a presence in the Quebec City market, but otherwise, VCI does not appear to be referenced. Thus, I am satisfied that the articles’ references to “Victrix” are to LSVI’s Trade Name.

[82] On balance, I find the recurring publication of features on “Victrix” in the major daily newspapers of Montreal over the years, reporting on the growth and success of the business—combined with its selection by several rankings publishers over the years as a top company in terms of size and revenues—to be an indication that the trade name “Victrix” has become known at least to a small extent in the Montreal area. However, given the limited number of such articles and rankings lists, this evidence is not particularly strong.

[83] Finally, Mr. Geriépy provides an excerpt from Former LSVI’s 2004 financial statements, showing revenues of nearly \$3.5 million in the first 15 months of the company’s existence [para 10, Exhibit P-5]. However, the only evidence of subsequent financial results consists of several annual revenue figures mentioned in the

aforementioned industry rankings and media coverage, including *La Presse* (approaching \$10 million in 2006); *Le Devoir* (in the order of \$25 million in 2009); *Les Affaires* (exceeding \$27 million in 2010); *The Gazette* (\$22 million in 2013); and *Braham300* (over \$61 million in 2017 and over \$75 million in 2018, as “Company approved” figures) [Exhibits P-10, P-11, P-13].

[84] Such evidence constitutes hearsay and, in the absence of information on these reports’ reliability or of any indication that such an indirect method of introducing revenue figures was necessary, I am not prepared to admit the individual reports for the truth of their contents. Moreover, even if these specific figures were admissible as such, neither Mr. Geriépy nor the media reports specify what portion of the revenues was generated in Canada or break the revenues down by province. That said, I find the fact that such relatively consistent figures have been reported by different sources over the years—combined with Mr. Geriépy’s confirmation that the Opponents have been growing rapidly [at para 18]—to be evidence of the general order of magnitude of business carried on under LSVI’s Trade Name, and of the nature of its reputation, after 2004. Moreover, based on the contracts identified in Mr. Geriépy’s evidence, I find it reasonable to conclude that a significant portion of the revenues come from business conducted in Quebec. (Such a finding is consistent with the media coverage, some of which reports clients being in Quebec or mainly in Quebec.)

[85] In sum, Mr. Geriépy’s evidence shows that, by the material date, LSVI’s Trade Name had become known to a certain extent at least in the Montreal area and Quebec City, through service offers and contracts, invoicing, and media coverage dating back to at least 2004. (Although the evidence also includes advertising from the Opponents’ website, including a blog post from September 2017, Mr. Geriépy does not state whether the exhibited printout, made after the material date, is representative of how the site appeared before the material date. I also note the City of Sherbrooke has long been a client, but there does not appear to be any additional evidence with respect to that city.) The press articles and industry rankings portray “Victrix” as a successful IT consulting company whose business model includes the acquisition of other IT companies and the occasional product offering, such as the load balancer, the test-

phase firewall, and the SharePoint broadcast system. In the absence of cross-examination or evidence to the contrary, I am prepared to accept that the business has become known as such at least to a limited extent.

Use and promotion of the Mark

[86] Evidence of the Applicant's use and promotion of the Mark is provided by Mr. Roberts. However, the portions of his evidence addressing Canada are somewhat vague.

[87] By way of background, Mr. Roberts states that the Applicant is a videogame accessory company founded in California in 1997 [paras 5–6]. It is involved in the engineering, design, development, and manufacturing of video game electronic peripherals and accessories, which are commercialised and sold worldwide, including in Canada [para 6]. As can be seen from the Applicant's homepage at *pdp.com*, examples of such videogame accessories include headsets and controllers, along with chargers, replacement parts, and protective cases, especially designed to be compatible with Xbox, Nintendo, and PlayStation products, [para 7, Exhibit TR-1]. Notably, the homepage's header menu begins with the Applicant's PDP logo (an acronym of its corporate name) and ends with a logo consisting of the Mark in a wide font, with a slightly larger X composed of stacked chevrons, as reproduced below:



[88] Mr. Roberts specifies that the Mark is used in association with a line of products the Applicant created in 2017 “for esports athletes and their specific needs in tournaments”, such as “professional video game controllers, headsets, fight sticks, and audio controllers” [para 8]. He states that the Mark has been displayed “[o]n a continuing basis” on the goods themselves; on their packaging, labels, or accompanying documentation; and on various marketing materials used to advertise and promote the goods [para 10]. Representative photographs of “the types of goods used in association with the [Mark] in Canada” variously depict (i) headsets with their packaging, which is

shown to include a protective case and what appears to be accompanying documentation; (ii) audio controllers; and (iii) other packaging and documentation, for unidentified products [para 10, Exhibit TR-3]. The Mark is displayed on the back of the headset in one image, on the side and underside of the audio controllers, and on the packaging and documentation. (In some images, “PRO AF” or “TEAMAMP” is displayed in close proximity to the Mark; however, the positioning is such that the Mark stands apart as a separate trademark.) I note that the TEAMAMP audio controller is labelled “for PS4”, while a headset box and an unidentified box are labelled as being for the Xbox and PlayStation platforms, respectively.

[89] Mr. Roberts also provides web captures from *victrixpro.com*, which he identifies as “PDP’s VICTRIX blog and official website pages, showcasing and advertising its products”, as well as “explaining the inspiration, engineering, and design behind the products” and “illustrative of what has been done by PDP since the introduction of the VICTRIX products in Canada” [para 9]. I note the following evidence with respect to use and promotion of the Mark from these web captures [at Exhibit TR-2 unless otherwise indicated] and from the related Twitter account for “Victrix Pro” [at Exhibit TR-5]:

- The Mark is displayed as the Applicant’s VICTRIX logo at the beginning of the header menu on each of the exhibited webpages, which together depict video game controllers, fight sticks, headsets, and audio controllers.
- A webpage for the Victrix Gambit Dual Core Tournament Controller for Xbox shows the Mark displayed on the lefthand side of the controller (the GAMBIT trademark is displayed on the righthand side and the Xbox “X” logo is displayed in the centre). The controller is also advertised bundled with a Victrix Pro AF headset (the same bundle is advertised for Xbox and Windows 10 at *pdp.com*). The controller is described as having 14 swappable components, a carrying case, a subscription to Dolby Atmos simulated surround sound, and customizability using the Victrix Control Hub app (for re-mapping buttons, creating audio profiles, running diagnostics, etc.).

- The blogs/media page lists promotional blog entries and third-party media articles primarily regarding the headsets and fight stick, dating from June 7, 2018 (nine posts), July 16, 2019 (ten posts), and November 8, 2019 to November 13, 2020 (four posts)—with thumbnail images of the products. The titles of some of the June 7, 2018 posts suggest that the Victrix Pro AF ANC headset and the fight stick were being introduced at that time.
- The November 8, 2019 blog entry “welcom[es] the Pro AF Headset to the Victrix family”. The text indicates that this headset, which is like the Pro AF ANC headset but without the active noise cancellation feature, is available for purchase for PlayStation and Xbox systems on *victrixpro.com* and *amazon.com*. The Mark is displayed on the depicted packaging.
- The June 1, 2020 blog entry [Exhibit TR-4] announces that the Victrix Pro FS Arcade Fight Stick, officially licensed by PlayStation, is “back and better than ever”, now with a touch pad, and available for sale at *victrixpro.com*, along with parts and accessories for customizing the electronics inside. One image shows a label inside the device, but the resolution is too low to confirm whether it bears the Mark.
- The November 13, 2020 blog entry announces that “Victrix headsets and fight sticks are forward compatible with Xbox Series X/S and PlayStation 5”. It also advertises the “Street Fighter Edition” of the Pro FS Arcade Fight Stick, and I note a depiction of the “Bison Limited Edition Pro FS Arcade Fight Stick” in the thumbnail image for the May 5, 2020 blog post.
- The Twitter account page indicates that Victrix Pro joined the platform in September 2017 and, as of May 4, 2022, had over 45 thousand followers, but does not specify whether any of them are from Canada. The feed advertises “Best in class equipment for esports pros, streamers and core gamers”. An October 4, 2021 post announces the launch of “the Gambit line starting with the Gambit Dual Core™ controller”, while posts dating from March 16 to April 28,

2022, variously promote the controller, its Victrix Control Hub app, downloadable for free from the Microsoft Store, and the Victrix Pro AF Headset.

[90] As noted above, Mr. Roberts also provides web captures of third parties advertising, selling, and reviewing products branded with the Mark [Exhibit TR-4]. Three of the exhibited websites advertise products for sale: *Amazon.com* offers the Victrix Pro FS Arcade Fight Stick; *Newegg.com* (U.S. version) offers the Victrix Pro AF Headset (with connectors, cables, and a cleaning cloth) and the Street Fighter-inspired “Sagat Limited Edition” of the FS Arcade Fight Stick, advertised as being officially licensed by Capcom and featuring a design by one of its “most famous artists”; and *Gamestop.com* offers the Victrix Gambit Dual Core Tournament Wired Controller. The website at *Dolby.com* also advertises the controller, but the exhibited extract does not provide any sales information. Although the screen capture from *Amazon.com* is undated, it appears to feature the pre-June 1, 2020 version of the fight stick, judging from the lack of touchpad. Otherwise, the screens in this exhibit were captured May 5, 2022. However, as noted above, Canadian versions of the Newegg and GameStop websites attached as exhibits to Mr. Geriépy’s second affidavit indicate that at least the controller and noise-cancelling headset may not have been introduced in Canada until later in 2022.

[91] The remaining third-party webpages, captured May 4, 2022, offer reviews of the above-noted products. Twitter posts indicate that Tom’s Guide, which Mr. Roberts describes as a well-renowned product review blog in the technology field, gave the fight stick its award for best peripheral product of the 2018 Electronic Entertainment Expo, which Mr. Roberts describes as “one of the biggest video gaming events”, attended by “major companies” such as Xbox, Nintendo, and Sega, as well as visitors from all over the world [para 15, Exhibit TR-6]. The fight stick was also reviewed on *Pcgamer.com* (U.S. Edition) on February 7, 2019; the headset was reviewed on *Gamesradar.com* (U.S. Edition) on April 21, 2020; and the controller was reviewed on both *Theboxhub.com*, on October 24, 2021, and *Pcmag.com*, on December 6, 2021—earning the latter’s Editor’s Choice award for wired controllers [Exhibit TR-4]. I note that most of these sites mention the availability of the products for purchase on Amazon and/or from Victrix directly.

[92] The abovementioned advertising and reviews generally indicate that the fight stick and headset are for the PlayStation platform, but compatible with Windows or PCs, with one advertisement also indicating that the headset is compatible with Xbox One and Nintendo Switch. The controller is generally described as being for the Xbox platform, but also compatible with Windows, and as having interchangeable parts (a back paddle panel displaying the Mark is shown by PCMag), a carrying case, a licence for Dolby Atmos surround sound, and the ability to customize the controller with the downloadable Victrix Control Hub app.

[93] However, none of the exhibited webpages, be it from the Applicant or from a third party, specifies whether it targets Canada. Indeed, three of the webpages indicate in their header that the U.S. version of the site is being displayed, and one webpage appears to target the United Kingdom, with an advertisement for *amazon.co.uk* and pricing in pounds. Mr. Roberts does not specify whether Canadian versions of these sites were available and, if so, why they were not included. In any event, even if the same or similar pages were accessible from Canada on the indicated dates, this fact in itself would not establish the extent to which Canadians actually accessed the sites or that any of the subject goods were actually sold in Canada at any relevant time.

[94] Mr. Roberts states the Applicant has “adopted” the Mark in Canada in association with the above-described product line since at least as early as March 7, 2018, and he also refers to the Applicant’s activities “since the introduction of the VICTRIX products in Canada” [para 9]. However, he does not specify whether the Mark being “adopted” or “introduced” was by the Applicant actually commencing to use it in Canada, by the Applicant commencing to make it known in Canada through advertising, or in some other sense [see section 3 of the Act for the statutory definition of “adopted”]. The Application itself claims *use* of the Mark in Canada since at least as early as March 7, 2018; however, the claims in the Application are not evidence. At best, Mr. Roberts states that the Mark has been displayed on a “continuing” basis on documentation accompanying “goods that have been sold in Canada” [para 10]. However, in the absence of any information on the start date, regularity, or volume of sales in Canada, this statement does not assist in determining the extent to which the

Mark had become known in Canada at the material date, whether as a result of earlier sales or because the Mark had been made known or simply promoted in Canada prior to the claimed date of first use. Mr. Roberts attests to the product line's *creation* in 2017; however, given that the blogs/media page at *victrixpro.com* suggests the products' public introduction was around June 7, 2018, it may well be that the Mark had not become known in Canada at the material date to any extent.

Conclusion regarding inherent and acquired distinctiveness

[95] In view of the foregoing, I find that the overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness, favours the Opponent, owing to the inherent distinctiveness of the word VICTRIX and to LSVI's Trade Name having become known at least to a certain extent in parts of Quebec. The Mark does not have any inherently distinctive features other than the word VICTRIX and the evidence does not establish that the Mark had become known in Canada to any extent at the material date.

Section 6(5)(b): Length of time the trademark and trade name have been in use

[96] As noted by the Federal Court of Appeal, a trademark or trade name "that has been in use a long time, versus one newly arrived on the scene, is presumed to have made a certain impression which must be given some weight" [*Pink Panther, supra*].

[97] In the present case, I am satisfied that the Opponents have established use of LSVI's Trade Name in Quebec since at least as early as 2004 in association with a business providing IT consulting and technical support services, including services in association with software. Conversely, although the Application claims use of the Mark since at least as early as March 7, 2018, the Applicant has not established use of the Mark in Canada. Accordingly, this factor also favours the Opponents.

[98] The Applicant submits that, since the Opponents have provided no sales figures and only a few redacted contracts and invoices, the sections 6(5)(a) and (b) factors should not be decisive. I agree that the Opponents' evidence in these respects is not particularly strong, there being only one global revenue figure provided from the

Opponents' financial statements, long before the material date, and subsequent references to revenue figures in the media constituting hearsay. In the end, however, I am satisfied that the Opponents' evidence tends to show an established and successful business that has garnered some media attention and attracted several large and institutional clients by the material date. This evidence has not been contradicted, and stands in contrast to the lack of evidence of any significant reputation for the Mark in Canada, and none for the Mark in Canada at the material date.

Sections 6(5)(c) & (d): Nature of the goods, services, businesses, and trades

[99] When considering the nature of the goods, services, businesses, and trades under this ground of opposition, the analysis is governed by the statement of goods as defined in the application, having regard to the channels of trade that would normally be associated with such goods, versus the goods and services for which the opponent has shown actual use [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export* (1986), 12 CPR (3d) 110 (FCA)]. The statement of goods in the application must be read with a view to determining the probable type of business or trade intended, rather than all possible trades that might be encompassed by the wording; evidence of the applicant's actual trade is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)].

The Goods as defined in the Application

[100] In the present case, the Application covers various electronic devices and accessories, which are mostly identified as being for video games. As described by Mr. Roberts, the products are "mainly intended for professional esports gamers, to be used in tournaments and esports competitions", but are sold to "both professional competitive esports gamers as well as amateur everyday gamers for mainstream video games, that are willing to pay a certain premium for top-quality gaming accessories" [paras 12, 16].

[101] Notably, the Goods also include software: “computer software and software applications for use with video game controllers, video game consoles and video game equipment for customizing and adjusting settings, layout and functionality”; “computer software and applications that allow for customization and modification of input controls, lighting, audio and communication signals associated with video game controllers and audio headsets”; and “video game computer software and software applications for playing video games”. I find these descriptions to be consistent with the Victrix Control Hub app referenced in the Applicant’s evidence.

[102] As indicated in the marketing materials and reviews and summarised by Mr. Roberts, the products “were designed to enhance the gamers’ experience with noise cancelling technology, better communication in loud environments, increased comfort with cooling mechanisms, with highly adjustable and customisable features” [para 17, Exhibits TR-2, TR-4, TR-5]. Each of the fight stick, headset, and video game controller are identified in at least one advertisement or review as being “high-end”, in the “premium” tier or category, or at a higher price point. Indeed, Dolby and The Xbox Hub promote the controller’s dual core technology as making it the “world’s fastest” licensed Xbox controller (although such assessments constitute hearsay, I find their publication admissible and relevant as concerns the nature of the product’s marketing and reputation). Mr. Roberts attests that prices “range anywhere from 3.99\$ for simple silicone dust caps for headsets, to around 1600\$ for the most premium arcade fight stick” [para 17]. The advertisements at Exhibits TR-2 and TR-4 show prices generally ranging from \$99.99 for the controller to \$350 for the fight stick—the exception being the limited edition, collector’s version of the fight stick with laser-etched artwork being offered on *Newegg.com* for \$1628.99.

[103] However, I note that not all of the Goods are restricted to the field of video games, as the Application also includes the following Goods in Class 9 (my emphasis):

(1) ... audio headsets, none of the foregoing goods relating to cloud security and network consulting; audio headset ear pads, none of the foregoing goods relating to cloud security and network consulting; computer peripherals, namely, headsets and headphones, none of the foregoing goods relating to cloud security and network consulting; ... headphones, none of the foregoing goods relating to cloud security and

network consulting; microphones, none of the foregoing goods relating to cloud security and network consulting; audio network systems comprising audio speakers, audio amplifiers, audio receivers, audio mixers, none of the foregoing goods relating to cloud security and network consulting.

(2) ... audio headset stands, none of the foregoing goods relating to cloud security and network consulting; audio cables, none of the foregoing goods relating to cloud security and network consulting; high definition multimedia interface cables, none of the foregoing goods relating to cloud security and network consulting; keyboards, none of the foregoing goods relating to cloud security and network consulting; computer mouse, none of the foregoing goods relating to cloud security and network consulting; trackballs and computer mouse in the nature of a trackpad, none of the foregoing goods relating to cloud security and network consulting; biometric sensors, namely, motion sensors, distance sensors, proximity sensors, none of the foregoing goods relating to cloud security and network consulting; cameras, none of the foregoing goods relating to cloud security and network consulting; computer network adapters, computer network hubs, computer network servers, computer networking hardware, none of the foregoing goods relating to cloud security and network consulting;

[104] Mr. Roberts confirms that the Applicant does not offer any services to businesses in the information technology field and asserts that the Applicant's channels of trade do not intersect with those of companies like the Opponents, that offer infrastructure optimization and digitalisation of internal tools and processes to increase business productivity, through the implementation of tools such as cloud computing, virtualization, information security, mobile solutions, or employee and client collaboration solutions [paras 17–19]. Furthermore, it has been held that the assessment of potential future uses within a registration is preferably based on the registrant's actual trade channels, and should not include speculation about possible new ventures [*Alticor Inc v Nutravite Pharmaceuticals Inc*, 2005 FCA 269]. However, in the present case, the Application explicitly specifies some of the Goods as being for video games and other, similar Goods as not being so restricted. Moreover, I find that the Goods set out above, in the nature of headsets, microphones, audio network systems, cables, input devices, sensors, cameras, and computer networking hardware, are ones that may be sold to businesses, including large and medium-sized businesses, and public bodies, to form part of their IT infrastructure and to increase productivity.

The goods and services associated with the Opponents' business

[105] In their written representations, the Opponents submit that they have demonstrated trade name use in association with “technological consulting, migration and implementation and the sale of IT products and services” as well as “among other things, the implementation, management, and sale of IT goods and services, including but not limited to the sale and installation of computer software and optimization, digitization of internal programs, cloud computing and such other related and ancillary services” [paras 19, 53–54].

[106] With the exception of “sale of IT goods” (and “sale of IT products”, taken in that sense), I accept the Opponents' description. By way of specific example, the contracted services include the following:

- Starting May 2009: Migration of Novell NDS/ GroupeWise to Microsoft Active Directory 2008 / Exchange 2007; installation of BlackBerry Enterprise Server; and installation of the virtualization infrastructure Vmware VI3 [Exhibits P-6A].
- Starting April 2010: Migration of the servers Merlin, Arthur, and Zen; and migration and deployment of the services DNS, DHCP, IPRINT, Netstorage, Fichiers, FTP, CIFS, NGS, BNTP, and Groupwise [Exhibit P-6C].
- Starting June 2010: Installation of the CheckPoint UTM security system and post-installation technical support including configuration and modification, installation of security patches and updates, and advisory and training services [Exhibit P-6D].
- Starting January 1, 2013: High-level technical support for firewall, Microsoft, and Netware environments [Exhibit P-6G].
- Starting March 1, 2014 and extended in 2017: support for the development, maintenance and evolution of technology infrastructure [Exhibit P-6H].

[107] It is not clear from the exhibited service offers, contracts, and invoices whether services such as “migration”, “installation”, or “implementation” may include sales of the subject software, or whether LSVI works only with software already purchased through a third party. However, as noted above, I am satisfied that the business carried on under LSVI’s Trade Name includes services performed “in association with” computer software, for example, configuration, modification, patching, and updating services. Furthermore, although the homepage’s advertisement of application design and development services was printed after the material date, I find this evidence relevant in demonstrating a relationship between software design and development services and technical support services in the nature of software configuration, modification, patching, and updating.

[108] I also note the references on the Opponents’ homepage to cloud computing; Microsoft technologies and platforms, including proof of concept for Microsoft enterprise mobility and security (EMS), migration to Microsoft Office 365, deploying SharePoint/ Office 365, and a Microsoft “client immersive experience” (CIE); collaboration solutions (including design, development, and management of applications); and virtual networking. Although the homepage was printed after the material date, I also find it relevant at least as regards the Opponents’ natural areas of expansion, which will be discussed below.

[109] I would also note the exhibited press articles from before the material date, portraying “Victrix” as an IT consulting company whose business model also includes some product development, for example, in respect of a networking load balancer, a firewall, and a SharePoint broadcast system.

[110] As regards their customer base, the Opponents submit that, although Mr. Geriépy’s evidence focusses on public bodies, he nevertheless mentions the availability of services to the general public, and that an invoice to an individual confirms it. However, this invoice, which is for an IT infrastructure audit and analysis report, does not specify whether the customer is a sole proprietor making a business purchase or a direct consumer purchasing in his or her personal capacity. In any event, in the absence

of details regarding the nature and extent of the Opponent's trade directed towards the general public, and bearing in mind the age of that invoice (dated January 1, 2004), I am not prepared to conclude that the general public was a significant market for the Opponents at the material date.

The Opponents' position

[111] In their written representations, the Opponents submit that there is significant overlap in the parties' businesses and target markets, since both parties "conduct business in the field of computer technologies and services" and "rely on their websites to promote their business", as they "focus on the technological industries with a customer base who are heavily reliant on the internet to conduct their searches to purchase the goods and services" [paras 57–60]. The Opponents further submit that "many people who purchase video game accessories require services in the field of information technology", and *vice versa* [para 58]. Moreover, in the Opponent's submission, excluding goods "relating to cloud security and network consulting" from the Application does not limit the risk of confusion, since the Opponents' goods and services extend "far beyond" that field [para 55].

[112] At the oral hearing, the Opponents made more specific arguments with respect to the Applicant's evidence showing a certain relatedness, complementarity, or connection between the parties' respective goods and services that can lead to the inference of a common source.

[113] First, the Opponents drew attention to a portion of the evidence showing that the Xbox video game console—for which the Applicant makes some of its headsets and controllers—is made by a company that is also in the cybersecurity and software fields, namely Microsoft. In this respect, the Opponents pointed to the title of an article on Microsoft promising recyclability for Xbox consoles, among the links at the end of a product review for the Applicant's video game controller [Exhibit TR-4, *PCMag* at pp. 10–11]. The Opponents invited the Registrar to take judicial notice that Microsoft also markets software, cybersecurity services, and video games, citing *Bell Mobility Inc v Validas LLC*, 2017 TMOB 26, for the Registrar's authority to do so. In that case, the

Registrar had accepted the reliability of an applicant's sales receipt from Apple "especially in view of the Opponent's position that [the Registrar] can take judicial notice of the fact that there would be many hundreds of mobile applications available on the Apple App Store" [at para 61]. The Opponents also cited a trademark application of theirs and two trademark registrations owned by Microsoft, as evidence that a single business may cover video game controllers on one hand and IT services and software or security consulting and software on the other. However, I do not read the reference to the opponent's position in *Bell Mobility* to mean that the Registrar was actually taking judicial notice of the nature and scope of Apple's business, and I am not prepared to take that level of judicial notice in the present case. Nor am I prepared to exercise the Registrar's discretion to assist a party by consulting the register for the particulars of trademarks not pleaded in the statement of opposition. In any event, evidence of a later-filed application by the Opponent would be self-serving and evidence of the scope of a single third party's business would carry limited weight.

[114] The Opponents also drew attention to pages of the Applicant's evidence where its products are displayed for review next to advertising for cybersecurity software from Bitdefender and Avast [Exhibit TR-4, *PCMag* at pp. 1 & 5]. In the Opponents' submission, the Applicant's technology being targeted by cybersecurity product advertisers illustrates how the same public may be served by both video game accessories and cybersecurity services, particularly given that downloading video games to one's computer may involve passwords, banking information, and other cybersecurity concerns.

[115] In this respect, the Opponents sought to draw analogies with *CBS Broadcasting Inc v Raymond*, 2002 CanLII 61242, 23 CPR (4th) 384 (TMOB), and *U Box It Inc v U-Haul International, Inc*, 2014 TMOB 208. In *CBS*, the Registrar considered as a surrounding circumstance the opponent's evidence concerning the convergence of video, cable, computer and Internet technologies, resulting in an expanding field of competing services. In *U-Haul*, the Registrar found it conceivable that consumers looking to move or store their possessions might be involved in a clean-up or renovation project generating large volumes of garbage, and thus see moving and storage services

as being complementary to garbage disposal and waste management services. I do not find *CBS* to be on point, since the opponent television broadcaster in that case was already established on the Internet as a provider of computer-related goods and services in various fields, whereas in the present case, the Opponent has not demonstrated an existing presence in the video game industry. I find the scenario in *U-Haul* to be closer to the present case, where, in the absence of direct evidence, the Opponents invite the Registrar to find it conceivable that video game players will require IT advice or support, in particular relating to computer security.

[116] Finally, with respect to the exclusion of goods “relating to cloud security and network consulting”, the Opponents argued that the parties’ respective goods and services remain in each other’s natural zone of expansion. In this respect, the Opponents cited *Dimension Data (Pty) Ltd c AgData LP*, 2020 TMOB 122, wherein it was held that the a company providing retailer and distributor data management services to the agricultural industry may target the customers of a company providing access to databases, software development and maintenance, and specialist advisory services relating to computers—and *vice versa*.

The Applicant’s position

[117] The Applicant, for its part, submitted at the oral hearing that its market—which is restricted to esports athletes and players—is distinct and completely different from the Opponents’ market, the latter being limited to public organizations, with no evidence of services offered to the general public at the material date. The Applicant emphasized the Supreme Court of Canada’s remark in *Mattel* that the nature and kind of customer who would be likely to buy the goods and services has long been considered a relevant circumstance, because when parties operate in different and distinct niche markets, within which their respective goods and services do not intermingle, “the increased potential for confusion that might arise through intermingling in a single channel of trade does not present a serious problem” [at paras 86–87].

[118] With respect to the concept of a natural zone of expansion, the Applicant submitted that it does not apply in a case like the present, where the opponent relies on

the actual use it has made of a trade name rather than on the monopoly provided by the list of goods and services in a registration.

Conclusion regarding the nature of the goods, services, businesses, and trades

[119] On balance, I find that the Opponents' IT consulting and technical support services have a different focus than the Applicant's electronics, the Opponents' services being promoted for organizational efficiency and maximizing productivity, whereas the Applicant's products are for gaming. The Opponents work with enterprise systems and their target market appears to consist primarily of business and government professionals; the Applicants work with video game systems and their target market consists primarily of esports professionals, such as professional athletes or streamers. However, although the Opponents' business appears to target primarily large and medium-sized enterprises and the public sector, there is no evidence as to the relative size of businesses involved in various aspects of the esports industry, such as tournaments, outfitting, training, or other aspects where the Applicant's goods might be applied. Nor is there any evidence that a business targeting large and medium-sized enterprises would be unlikely to develop any lines for smaller enterprises.

[120] I also note the Opponents' evidence that the business identified under LSVI's Trade Name performs IT outsourcing services; is reported to grow by acquiring other IT companies; and is reported to have occasionally offered products, including a load balancer, a firewall (that is at least reported to have been tested by clients), and a SharePoint broadcast system. Such evidence raises the possibility of VICTRIX-branded audio and gaming equipment for use on computer networks being assumed to be a new line of business or product offering for LSVI, whether from an acquisition or through natural extension. In this respect, I disagree with the Applicant that the concept of a natural zone of expansion does not apply when an opponent relies on unregistered rights. The issue is not whether an applicant's goods or services come within the monopoly provided by a prior registration but whether prospective purchasers are likely to assume that the applicant's goods or services come from the same source as those of the opponent, whether or not the goods or services are of the same general class.

[121] Furthermore, in the absence of evidence to the contrary, I find there to be a sufficient connection between the Opponent's IT services associated with Microsoft technologies and productivity platforms on one hand, and the development of customization software and/or firmware for peripherals used with Microsoft gaming platforms on the other, for the Applicant's Goods to be considered within the Opponents' natural zone of expansion. Moreover, although the Application excludes goods relating to cloud security and network consulting, it does not necessarily exclude goods that are merely secure or networkable as ancillary features, nor goods developed by or in collaboration with an IT consulting business.

[122] There is already at least some evidence of the Applicant's products involving collaborations; for example, the headsets are advertised as having of a microphone filter design "originally created for the Cobra attack helicopter" (see Exhibit TR-2); the video game controller is advertised as coming with a subscription to Dolby Atmos simulated surround sound; the special edition of the fight stick is promoted as featuring a "Sanwa joystick and 8 Sanwa buttons" or "Sanwa Denshi parts [that] complement our custom electronics", as well as a design by a Capcom artist (see PC Gamer and Newegg screen captures at Exhibit TR-4); and the Victrix Control Hub app is advertised as being downloadable from the Microsoft Store.

[123] I do not find the Opponents' offerings with respect to security infrastructures, as referenced in the evidence, to be comparable to the consumer cybersecurity products advertised on the webpages reviewing the Applicant's products. Nor am I satisfied that video game players purchasing the Applicant's accessories for personal use might see the Opponents' enterprise solutions as complementary services. Nevertheless, I find it conceivable that business or government professionals acquiring assistance for their organization's IT systems may also play video games and see certain parallels, for example, as regards audio systems or tools for collaborating on activities over a network.

[124] Finally, I am mindful that the degree of care and attention with which the relevant consumer approaches a purchasing decision will reflect the context and importance of

the purchase [*Mattel, supra; Clorox Company of Canada, Ltd v Chloretec SEC, 2020 FCA 76*]. Thus, the casual consumer somewhat in a hurry will differ depending on the situation, and an analysis of the likelihood of confusion must account for the relevant consumer's attitude when he or she encounters a trademark in approaching a particularly important or costly purchase. Nevertheless, the test for confusion remains one of both first impression and imperfect recollection, even when the goods and services are expensive or important, and thus also more likely to be researched prior to purchase. Consumers do not lose the benefit of trademark protection through their own caution and wariness [*Masterpiece, supra*].

[125] In the present case, I accept that purchasers of sophisticated enterprise-level IT and digital security systems and related advisory and support services, or even of sophisticated and relatively expensive professional-level gaming equipment intended to provide an important competitive edge, are likely to be somewhat less “hurried”, and more alert and attentive to the trademarks and trade names encountered, than the ordinary consumer making minor purchases. This attitude decreases the likelihood of an error being made, even upon first impression and with imperfect recollection. Nevertheless, I find a sufficient nexus between the Goods set out in the Application and those associated with LSVI’s business to create at least a potential for confusion.

[126] In summary, the parties’ respective businesses appear to have a different focus, and their distinct trade channels as well as the relative cost and importance of the associated goods and services may work to decrease the likelihood of confusion. However, I am unable to conclude that an average purchaser, as a matter of first impression and imperfect recollection, would be unlikely to perceive a potential link between the Opponent LSVI’s business and the source of the Applicant’s Goods.

[127] On balance, I find that the sections 6(5)(c) and (d) factors do not favour either party.

Additional surrounding circumstance: Contextual factors

[128] As noted above, in certain years, LSVI's Trade Name was displayed as a logo that included the words LES SOLUTIONS in small print or the slogan *Récoltez le fruit de vos TI* (Harvest the fruit of your IT). However, I do not find that displaying LSVI's Trade Name in these contexts decreases the likelihood of confusion to any significant extent. I find that the additions to the Original LSVI Logo are merely in the nature of marketing puffery. Both parties operate in the field of information technology and, in my view, the notions of providing solutions or yielding results do not point towards one party more than the other.

Additional surrounding circumstance: Registrations abroad

[129] Finally, I note that Mr. Roberts also provides a listing of registrations for the Mark obtained in other jurisdictions, as well as copies of the corresponding registration certificates, and he asserts that the Mark is known by consumers all over the world [para 14, Exhibit TR-7]. I find such foreign registrations to be irrelevant in the absence of evidence regarding the state of the marketplace and of the law governing trademark registration in these jurisdictions. While evidence of significant, co-extensive use of two trademarks in another jurisdiction without any actual confusion arising may sometimes be a relevant consideration, the mere existence of trademarks on foreign registers is not [Vivat Holdings Ltd v Levi Strauss & Co, 2005 FC 707]. Even if the registration certificates from the United States indicate use of the Mark in commerce in that jurisdiction, the certificates in themselves do not support an assertion that the Mark had become known to any significant extent as a result, at the relevant date or otherwise. Moreover, the Applicant provides no evidence to suggest that Canadians have at any point become aware of the Mark in view of its registrations abroad.

Conclusion with respect to the entitlement ground of opposition confusion

[130] In an opposition proceeding, the onus is not on the opponent to show that confusion is likely but rather on the applicant to satisfy the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion. The presence of a legal onus on the applicant means that, if a determinate conclusion cannot be reached once

all the evidence has been considered, then the issue must be decided against the applicant.

[131] Following my analysis of all the surrounding circumstances, and particularly in view of the important fact that the Mark is identical to LSVI's coined and inherently distinctive trade name, and the fact that this trade name, having been used for over a decade in Quebec's technology sector, appears to have become known at least to a certain extent in Montreal and Quebec City, I find that I am left in a state of doubt as to whether use of the Mark in the same area, in association with the applied-for Goods, which are also in the technology sector, would be likely to cause confusion. I reach this conclusion bearing in mind that the parties' respective businesses appear to have a different focus, and there are significant differences in the nature of their respective goods and services. I have also borne in mind the relative cost and importance of the goods and services. Nevertheless, for the reasons set out above, I find there to be a sufficient nexus to raise the possibility of confusion in the particular circumstances of this case, as a matter of first impression and imperfect recollection.

[132] In the end, I find that the probabilities are evenly balanced between a finding of confusion and a finding of no confusion. Since the onus is on the applicant, I must resolve the resulting doubt against it. I am not satisfied that the Applicant has met its legal burden to show that, on a balance of probabilities, that there would not be a reasonable likelihood of confusion between the Mark and LSVI's Trade Name.

[133] If the Applicant had demonstrated that the Mark was already known in Canada at the material date, and had been used contemporaneously with LSVI's Trade Name in the same area to a significant extent without actual confusion, then my conclusion might perhaps have been different. It should also be noted that my conclusion is limited to a finding that the Applicant has not met its legal onus to establish its entitlement to registration in the context of this particular proceeding.

[134] In view of the foregoing, the ground of opposition based on entitlement to registration under section 16(1)(c) of the Act is successful.

DISTINCTIVENESS UNDER SECTION 2 OF THE ACT

[135] The Opponents also plead that the Mark is not distinctive within the meaning of section 2 of the Act, because the Mark does not possess sufficient inherent distinctiveness to actually distinguish the Applicant's goods from those of the Opponents, and is not adapted to actually distinguish them at the date of the statement of opposition, particularly in view of the Opponents' marks and names.

[136] In the absence of further particulars, this ground must be read in conjunction with the statement of opposition as a whole, and is thus limited to the allegations of confusion with the trademarks and trade names pleaded under the previous ground. Although that ground, as amended, identifies only trade names, I find that, on a fair reading of the statement of opposition as a whole, the distinctiveness ground pleads their use as both trademarks and trade names. As noted above, trademark and trade name use are not mutually exclusive.

[137] The material date for this ground of opposition is April 15, 2021, the date the statement of opposition was filed [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185]. To succeed, an opponent relying on its own trademark or trade name must establish that the trademark or trade name had become sufficiently known in Canada as of this date to negate the distinctiveness of an applicant's trademark. In this respect, an opponent has the initial burden to show that its trademark was known in Canada to some extent at least, *i.e.* that its reputation was "substantial, significant or sufficient", or else that it was well known in a specific area of Canada [*Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657; *CEG License, supra*].

[138] The later material date for this ground of opposition allows additional evidence to be considered; notably, promotion of the Opponents' trade names on their homepage, the second CV used for service offers, and the rankings published in 2018 and 2019 . In addition, for this ground, the Opponents rely not only on use of the trade names listed in the previous ground as trade names but also on their use as trademarks. Nevertheless, I find the evidence falls short of meeting the Opponents' initial burden.

[139] With respect to *trademark* use, I note at the outset that I generally find use of the Opponents' various VICTRIX logos described under the previous ground to qualify as use of both a trade name and a trademark, such that factoring in evidence of trademark use does not increase the Opponents' reputation to any meaningful extent.

[140] The evidence with respect to the Opponents' trade names becoming known in Canada (whether as trade names or trademarks) is summarized above under the section 16(1)(c) ground of opposition—including the evidence that postdates the material date for the entitlement ground but that can be considered at the later material date of the distinctiveness ground. Having reviewed this evidence, I find that it falls short of demonstrating that the Opponents' marks and names were well known in a specific area of Canada at the material date of April 15, 2021, or that their reputation in Canada at that date was “substantial, significant or sufficient” to negate the distinctiveness of an applicant's trademark.

[141] As noted above, it would appear from the Opponents' evidence that their VICTRIX mark and name is an established brand that has become known at least to a certain extent in Montreal and Quebec City. However, given the limited number of clients identified, the limited amount of press coverage demonstrated, the limited evidence of activity in the years approaching the material date, and the hearsay nature of much of the revenue figures—which are not broken down by city or even by country—I am unable to conclude that the Opponents' VICTRIX mark and name and/or any of the pleaded VICTRIX-formative marks and names had become *well* known in either area at the material date.

[142] Nor does the evidence show a more general reputation in Canada that is “substantial, significant or sufficient” to negate the distinctiveness of the applicant's trademark. In this respect, I would also note that the Opponents provide no evidence of the extent to which their advertising and promotion has been distributed, for example, by way of circulation or reach figures for their press coverage or for their website. The printouts of media coverage and web captures in evidence demonstrate the existence of

such advertising and promotion, but not the extent to which Canadians have been exposed to it.

[143] As explained in *Bojangles*, an opponent cannot simply assert that its trademark or trade name is known in Canada; there must be clear evidence of the extent to which it is known. Speculation as to whether its reputation at the material date was sufficient to negate distinctiveness should be resisted [*1648074 Ontario Inc v Akbar Brothers (Pvt) Ltd*, 2019 FC 1305].

[144] In view of the foregoing, the non-distinctiveness ground of opposition is rejected, as the Opponents have failed to meet their evidential burden.

NON-COMPLIANCE UNDER SECTION 38(2)(E) AND 38(2)(F) OF THE ACT

[145] Finally, the Opponents plead two grounds of opposition that concern the Applicant's compliance with section 30(1) of the Act, which states that a person may apply to register a trademark in respect of goods or services "if they are using or propose to use, and are entitled to use, the trademark in Canada in association with those goods or services".

[146] Under section 38(2)(e) of the Act, the Opponents plead that, at the filing date of the Application, the Applicant was not using and did not propose to use the Mark in Canada in association with the Goods, because the Applicant was using a different trademark, namely VICTRIXPRO.

[147] Under section 38(2)(f) of the Act, the Opponents plead that, at the filing date of the Application, the Applicant was not entitled to use the Mark in association with the Goods in Canada, given the assignment of the Applicant's corresponding application for the Mark in the United States.

[148] The Opponents have not furnished any evidence or made any written or oral representations in support of either of these allegations. With respect to the section 38(2)(e) ground, I would also note that using the trademark VICTRIXPRO would not preclude the Applicant from also having a *bone fide* intention to use the trademark

VICTRIX. Indeed, the Applicant's evidence shows the trademark VICTRIX displayed on several Goods, as discussed above.

[149] Accordingly, the foregoing grounds of opposition are each rejected, as the Opponents have failed to meet their evidential burden.

DISPOSITION

[150] In view of all the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the Application pursuant to section 38(12) of the Act.

Oksana Osadchuk
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Goods (categorized by Nice Class)

- 9 (1) Video game equipment, namely video games, video game cartridges, audio headsets for use with gaming consoles, audio headsets for use with video game systems, audio headsets for use with computers and audio headsets for virtual reality games, gaming audio controllers, gaming audio mixers, gaming audio amplifiers, gaming audio speakers, gaming audio receivers, Electronic controllers for video game systems that connect voice and audio for multiple players, namely audio amplifiers and audio mixers for video game systems, gaming computer hardware, electronic controllers for networking multiple players over gaming systems to enable players to interact with other players while playing video games namely audio amplifiers and audio mixers, computer hardware, namely computer video game hardware, none of the foregoing goods relating to cloud security and network consulting; audio headsets, none of the foregoing goods relating to cloud security and network consulting; audio headset ear pads, none of the foregoing goods relating to cloud security and network consulting; computer peripherals, namely, headsets and headphones, none of the foregoing goods relating to cloud security and network consulting; computers and personal audio devices, namely audio headsets for playing video games, none of the foregoing goods relating to cloud security and network consulting; headphones, none of the foregoing goods relating to cloud security and network consulting; microphones, none of the foregoing goods relating to cloud security and network consulting; audio network systems comprising audio speakers, audio amplifiers, audio receivers, audio mixers, none of the foregoing goods relating to cloud security and network consulting.
- 9 (2) Video game interactive remote control units, none of the foregoing goods relating to cloud security and network consulting; batteries for use with video game systems, none of the foregoing goods relating to cloud security and network consulting; battery chargers for use with video game systems, none of the foregoing goods relating to cloud security and network consulting; audio headset stands, none of the foregoing goods relating to cloud security and network consulting; audio cables, none of the foregoing goods relating to cloud security and network consulting; high definition multimedia interface cables, none of the foregoing goods relating to cloud security and network consulting; keyboards, none of the foregoing goods relating to cloud security and network consulting; computer mouse, none of the foregoing goods relating to cloud security and network consulting; trackballs and computer mouse in the nature of a trackpad, none of the foregoing goods relating to cloud security and network consulting; biometric sensors, namely, motion sensors, distance sensors, proximity sensors, none of the foregoing goods relating to cloud security and network consulting; cameras, none of the foregoing goods relating to cloud security and network consulting; computer network adapters, computer network hubs, computer network servers, computer networking hardware, none of the foregoing goods relating to cloud security and network consulting; computer software and software applications for use with video game controllers, video game consoles and video game equipment for customizing and adjusting settings, layout and functionality, none of the foregoing goods relating to cloud security and network

consulting; computer software and applications that allow for customization and modification of input controls, lighting, audio and communication signals associated with video game controllers and audio headsets, none of the foregoing goods relating to cloud security and network consulting; video game computer software and software applications for playing video games, none of the foregoing goods relating to cloud security and network consulting.

- 28 (3) Video game audio controllers, none of the foregoing goods relating to cloud security and network consulting; gaming headsets adapted for use in playing video games, none of the foregoing goods relating to cloud security and network consulting; headsets for use with game consoles, none of the foregoing goods relating to cloud security and network consulting; headsets for use with controllers for game consoles, none of the foregoing goods relating to cloud security and network consulting; headsets for use with video gaming systems, none of the foregoing goods relating to cloud security and network consulting; headsets for use with hand-held units for playing video games other than those adapted for use with an external display screen or monitor, none of the foregoing goods relating to cloud security and network consulting.
- 28 (4) Video game controllers, none of the foregoing goods relating to cloud security and network consulting; controllers for game consoles, none of the foregoing goods relating to cloud security and network consulting; video game joy sticks, none of the foregoing goods relating to cloud security and network consulting; arcade sticks, namely computer game joysticks, cover plates for game controllers, none of the foregoing goods relating to cloud security and network consulting; game steering wheels, none of the foregoing goods relating to cloud security and network consulting; video game accessory carrying cases, namely protective cases specially for video game headsets, none of the foregoing goods relating to cloud security and network consulting; Video game systems, namely, video game consoles, none of the foregoing goods relating to cloud security and network consulting.

Appearances and Agents of Record

HEARING DATE: 2023-10-17

APPEARANCES

For the Opponent: Ismaël Coulibaly

For the Applicant: Barry Gamache

AGENTS OF RECORD

For the Opponent: Benoît & Côté Inc.

For the Applicant: ROBIC