

## TRADUCTION/TRANSLATION

IN THE MATTER OF THE OPPOSITION by Clic Import Export Inc.  
to application no. 1,039,291 for registration of the trade-mark CLIC filed by  
ClicNet Télécommunications Inc.

On December 15, 1999, ClicNet Télécommunications Inc. (the “Applicant”) filed an application for registration of the trade-mark CLIC (the “Mark”) based on use of the Mark in Canada in association with the services and since the dates identified hereafter:

(1) E-commerce, namely establishment for third parties of on-line transaction sites using computer networks, since at least as early as March 1999; (2) Web site design and integration, namely design and maintenance of Web sites, since at least as early as October 1995; (3) Web site connection and hosting, namely modem connection, permanent connection, Web site and server hosting, and reservation of Internet domain names, since at least as early as May 3, 1995; (4) consulting services, namely implementation of Internet marketing strategies for third parties and design and sale of Internet advertising campaigns, since at least as early as December 1996; (5) technical support for the creation and management of Internet sites and modem and permanent connections since at least as early as January 1997; (6) services to third parties on the Internet aimed at simplifying the creation and management of e-commerce stores, since at least as early as March 1999; (7) dispatch, namely the design, configuration and management of Internet serves, since at least as early as June 15, 1995; (8) distribution of advertising on the Internet for third parties, namely operation of a cooperative advertising distribution network, since at least as early as December 1996,

(hereinafter referred to collectively as “the Services”).

The application was advertised in the *Trade Marks Journal* of March 29, 2000. Clic Import Export Inc. (the “Opponent”) filed a statement of opposition on August 29, 2000.

The first ground of opposition is that the Mark is not registrable under the provisions of paragraph 12(1)(d) of the *Trade-marks Act* (the “Act”) since it is confusing with the Opponent’s trade-marks CLIC & Design (TMA493,690), CLIC MME COUSCOUS & Design (TMA492,573), CLIC MR. COUSCOUS & Design (TMA492,825) and CLIC EXCELLENCE & Design (TMA490,653) registered in association with a variety of food products.

The second ground of opposition is that the Applicant is not the person entitled to the registration of the Mark under the provisions of paragraph 16(1)(c) of the Act since, at the dates of first use claimed in the application, the Mark was confusing with the trade-names CLIC and CLIC Import Export Inc. previously used by the Opponent in association with a wide variety of food products, including beans, peas, lentils, rice, corn, flour, oil, dried beans and canned beans, carrots, mushrooms, tomatoes, artichokes and canned rice.

The third ground of opposition is that the Applicant is not the person entitled to the registration of the Mark under the provisions of paragraph 16(1)(a) of the Act since, at the dates of first use claimed in the application, the Mark was confusing with the trade-marks CLIC & Design (TMA493,690), CLIC MME COUSCOUS & Design (TMA492,573), CLIC MR. COUSCOUS & Design (TMA492,825) and CLIC EXCELLENCE & Design (TMA490,653) previously used by the Opponent in association with the various food products identified in the registrations.

The final ground of opposition is that the Mark is not distinctive of the Services because it does not distinguish and is not adapted to distinguish the Services from the wares associated with the Opponent's trade-names and trade-marks.

On October 5, 2000, the Applicant filed a counter-statement denying each and every one of the allegations made in the statement of opposition.

The evidence filed by the Opponent comprises affidavits from Timothy C. Bourne and Assad Abdelnour. The evidence filed by the Applicant comprises solemn declarations from Louis-Marius Gendreau and Annie Robinson. None of the affiants or declarants was cross-examined. Each party filed a written argument. No hearing was held.

#### Opponent's evidence

##### Affidavit of Timothy C. Bourne

Mr. Bourne is a lawyer employed by the Opponent's agents. He entered in evidence the results of his searches of the Strategis database of Canadian trade-marks maintained by CIPO, which showed that the Opponent has four applications for registration and four registrations for trade-marks incorporating the word CLIC. The applications for registration, copies of which he attached, cover the trade-marks CLIC (application no. 1,039,569), CLIC GOURMET & Design (application no. 1,068,144), CLIC ROYAL

(application no. 1,097,905) and CLIC ORGANIC (application no. 1,111,929). I note that none of the applications for registration and none of the corresponding trade-marks was alleged in the grounds of opposition pleaded in the statement of opposition. Consequently, those applications and the corresponding trade-marks are not relevant [*Imperial Developments Ltd. v. Imperial Oil Limited* (1984), 79 C.P.R. (2d) 12 (F.C. Trial Division)]. The four registrations, copies of which he attached, correspond with the registrations alleged in support of the first ground of opposition. The details of those registrations are:

TMA493,690  
April 24,  
1998



The word clic is in black, the words “marque” and “brand” are in gold, the maple leaf is red edged in gold, the cedar inside is green, and the fleur de lys is white. The colours are claimed as a feature of the trade-mark.

Dried beans, peas, lentils, rice, corn, flour, oil, beans, carrots, mushrooms, tomatoes, artichokes, rice, all canned, excluding all chicken and meat products. Used in Canada since January 1985.

TMA490,653  
March 2,  
1998



The word clic is in black, the work “Excellence” is in black edged in gold, the five stripes are from left to right: red, gold, black, gold, red. The colours are claimed as a feature of the trade-mark.

Rice, beans, lentils, peas, corn, flour, barley, canned vegetables and grains, such as beans, peas, lentils, carrots, tomatoes, artichokes, nuts, excluding all chicken and meat products. Used in Canada since 1990.

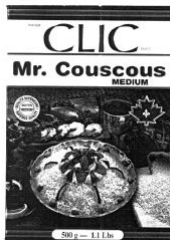
TMA492,573  
April 9, 1998



The colour is claimed as a feature of the trade-mark. White fleur de lys in a green cedar in a red maple leaf edged in gold

Couscous, couscous sauces. Used in Canada since January 1994.

TMA492,825  
April 14,  
1998



The colour is claimed as a feature of the trade-mark. White fleur de lys in a green cedar in a red maple leaf edged in gold

Couscous, couscous sauces. Used in Canada since January 1994.

### Affidavit of Assad Abdelnour

Mr. Abdelnour is president of the Opponent, a company incorporated in 1984. He described the Opponent's activities as being the manufacture, export, import, distribution and sale of ethnic and non-ethnic food products. He said that the Opponent is a leader in the Canadian food industry and attached a brochure on its activities (Exhibit A). Although Mr. Abdelnour did not state the date on which the brochure started to be used, I note that it contains photographs of containers of some of the Opponent's products. There is also an image of the North American continent identifying the Opponent's head office and a number of cities in Canada, namely Vancouver, Calgary, Winnipeg and Ottawa, and in the United States where there are distribution centres or agents. Mr. Abdelnour also attached copies of magazine articles about the Opponent. They appeared to be articles published in the May 1999 edition of *Food in Canada* (Exhibit B), the May-June 2000 edition of *Le Monde Alimentaire* (Exhibit C) and the April 1995 edition of *L'Alimentation* (Exhibit D). There is no information about the distribution of the magazines. The affiant said that *Food in Canada* has rated the Opponent one of the top ten food companies in Canada.

According to Mr. Abdelnour, since 1984 the Opponent has participated regularly in trade shows, although he did not identify them, and demonstrates its products in retail food stores like Loblaws, Costco, Provigo, SuperC, Sobey's, Metro and IGA at an average rate of three stores per week. He attached a copy of a folder (Exhibit E) that has been handed out at trade shows since 1995 at the rate of more than 30,000 copies a year and a brochure (Exhibit F) that is distributed during in-store demonstrations (again more than 30,000 copies a year). He also attached a copy of a pamphlet handed out since at least as early as 2000 at trade shows and mailed to food product suppliers (Exhibit G).

Mr. Abdelnour said that the Opponent started at least as early as 1985 distributing its products throughout Canada to well-known retail food stores like Loblaws, Costco, Provigo, SuperC, Sobey's, Metro and IGA and others with the trade-mark CLIC displayed prominently on the product packaging. He attached copies of invoices confirming the sale of the Opponent's food products (Exhibit H). I note that one invoice is dated May 1998 and another is dated December 1999, and that both are addressed to stores in the Province of Quebec.

I must point out at this time that, except in his reference to the mark covered by registration TMA493,690, a copy of which he attached, Mr. Abdelnour referred to the trade-mark CLIC throughout his affidavit. He attached a copy of application for registration no. 1,039,569 for the mark CLIC. Mr. Abdelnour claimed that the Opponent has used its mark CLIC in Canada extensively in association

with the food products listed in the registration and the application for registration. He attached to his affidavit seven black-and-white copies of labels which in his opinion demonstrate that use (Exhibit L). I reiterate my comment that I cannot take into consideration allegations relating to the trade-mark CLIC because it was not alleged in the grounds of opposition. However, even though Mr. Abdelnour discussed labels by referring to the mark CLIC, I find that the last six labels show use of the trade-mark CLIC & Design of registration No. TMA493,690. I realize that there are differences between the trade-mark as registered and as used, but insofar as those differences are primarily the result of the position of the maple leaf, I take the view that they are not significant enough to conclude that the labels do not show use of the registered trade-mark [*Registrar of Trade Marks v. Compagnie Internationale pour l'Informatique CII Honeywell Bull, Société Anonyme et al.* (1985), 4 C.P.R. (3d) 523 (F.A.C.)]. I also realize that it is impossible to determine from the labels whether the mark CLIC & Design is used with the colours claimed in the registration. I do not believe, however, that it is a problem in this case, as the colours have no bearing, to my mind, on whether there is a risk of confusion.

Mr. Abdelnour reported the Opponent's annual sales from October 1998 to April 8, 2002 – a total of approximately \$28,633,000 – and the amount spent annually between 1995 to 2001 – a total of approximately \$417,000 – to promote its products through brochures, pamphlets, business cards, newspaper and magazine advertisements, inserts, bag, folders and others.

In concluding my analysis of Mr. Abdelnour's affidavit, I note that there is no specific reference to use of the trade-names CLIC and CLIC Import Export Inc. alleged by the Opponent. For the reasons stated below, I find that the evidence shows use of the trade-name CLIC Import Export Inc. in association with food products, but not of the trade-name CLIC.

In *Mr. Goodwrench Inc. v. General Motors Corp.*, (1994), 55 C.P.R. (3d) 508 (F.C. Trial Division) Simpson J. wrote at pages 511-512:

*“Sections 2 and 4(1) of the Act define and describe situations in which a trade mark (not a trade name) is deemed to be used in association with wares.*

*[...]*

*There are no provisions in the Act which define and describe the use of a trade name. However, in his decision in Professional Publishing Associates Ltd. v. Toronto Parent Magazine Inc. (1986), 9 C.P.R. (3d) 207 at p. 217, 39 A.C.W.S. (2d) 440 (F.C.T.D.), Mr. Justice Strayer considered the problem and held that the principles in ss. 2 and 4(1) of the Act apply to trade name use. In this regard, His Lordship said:*

*While there is no definition in the Trade Marks Act of "use" in relation to trade names, I am satisfied that consistent with the purposes of the Act such "use" would have to be in the normal course of trade and in relation to the class or classes of persons with whom such trade is to be conducted.*

*Accordingly, use in the normal course of trade will be the test applied in these reasons."*

In my opinion, the labels (Exhibit L) show use of the trade-name CLIC Import Export Inc. in association with food products. The issue of whether CLIC can be used as a trade-mark and a trade-name at the same time depends on the circumstances [*Road Runner Trailer Mfg. Ltd. v. Road Runner Trailer Co. Ltd.* (1984), 1 C.P.R. (3d) 443 (F.C. Trial Division)]. It is true that some specimens show that "Clic" is in upper-case letters when it appears in combination with "Import Export Inc.". However, that is not the case on the labels. Further, in most cases where this distinction appears, it does not necessarily put real emphasis on the word "Clic". I see that the cover page of the brochure (Exhibit A) and the article in the magazine *L'Alimentation* (Exhibit D) differentiate "Clic" from "Import Export Inc." in a more substantial way, but that use does not constitute use in association with wares.

#### Applicant's evidence

##### Solemn declaration of Louis-Marius Gendreau

Mr. Gendreau is president of the Applicant, which he describes as a company that provides services in all sectors of the Internet available in Canada through the Internet and also worldwide. His description of the services provided by the Applicant corresponds with the Services.

According to Mr. Gendreau, in addition to the mark CLIC used since 1994 by the Applicant or its predecessors in title on the Applicant's Web site, on promotional material and elsewhere, the Applicant or its predecessors in title have since 1994 used the trade-name Clicnet Télécommunications and other trade-marks in association with some of the Services, including the marks CLICNET, CLIN.NET and CLICSHOP. Mr. Gendreau claims that the Applicant has developed a family of trade-marks with the prefix "clic" for the Services. Given that the information provided by Mr. Gendreau regarding each mark in the alleged family was limited to identifying the applications for registration (marks CLIC.COM, CLICSHOP, CLICSTOP, ClicCatalogue, ClicWeb, ClicRépertoire and CLICMARKET) and the registrations (marks CLISHOP, CLICNET and CLIC.NET), I do not plan to grant significance to the Applicant's allegations regarding a family of marks. Inasmuch as the trade-mark covered by the application is CLIC, I also do not plan to grant significance to the use of the trade-name Clicnet Télécommunications alleged by Mr. Gendreau.

Mr. Gendreau reported annual sales under the Mark from January 1, 1995 to December 31, 2001, a total of approximately \$6,402,300. He said that he provided minimum figures for reasons of confidentiality. To demonstrate use of the Mark, he attached as Exhibit LMG-2 (and not LMG-1 as claimed) a sample of invoices and contracts for services sold under the Mark. On the subject of these specimens, I note that (a) the invoices cover the years 1995 to 1997, 2000 and 2001; (b) although the dates of the contracts are difficult to read, they appear to cover the years 1995 and 1996; (c) except for one invoice from 2001 addressed to a client living in the Province of Alberta, the other invoices on which there are full addresses are addressed to clients living in the Province of Quebec; and (d) I see that the Applicant's name appears on the invoices and contracts, but I do not see any reference to the Mark.

Mr. Gendreau attached to his declaration as Exhibit LMG-1 (and not LMG-2 as claimed) a sample of promotional material used by the Applicant in association with the Services. He stated that the advertisements, which ran throughout Canada, were only partly representative of the type of advertising done by the Applicant. I must note that the quality of the copies of several of the documents attached as exhibits is poor, and I am unable to find any mention of the Mark.

Finally, Mr. Gendreau stated that he has not been made aware of any cases of confusion.

In concluding my analysis of Mr. Gendreau's declaration, I note that even though he referred to use of the Mark by predecessors in title, the application for registration does not mention any predecessors in title. I also note that other than in his description of the Services, Mr. Gendreau did not differentiate among the services specifically identified in the application, for which, I repeat, different dates of first use are claimed. Further, the exhibits accompanying the declaration do not really make it clear to me that the Mark was used in association with any or all of the Services. However, my decision will not question the claims of use of the Mark in association with the Services since the dates identified in the application, as none of the grounds of opposition challenged the Applicant's use of the Mark at any time.

#### Solemn declaration of Annie Robinson

Ms. Robinson, a paralegal employed by the Applicant's agents, filed in evidence the results of her screening search for the term CLIC in the Strategis database (Exhibit AR-1). State of the register evidence is only relevant insofar as inferences can be made from it about the state of the marketplace [*Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (TMOB); *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C. Trial Division)]. Moreover, inferences about the state of the marketplace cannot be made from such evidence unless a large number of relevant registrations is located.

Because this screening search was too broad for the purposes of this opposition, I looked at the details of the 61 trade-marks that were apparently found. I note that the 61 marks are associated with all kinds of wares and services. In addition, the 61 marks include 27 applications for registration, 12 of which have been abandoned, and 34 registrations, 4 of which have been expunged. Minus the abandoned applications and expunged registrations, there are 15 applications and 30 registrations. At the date of the search, the Registrar had accepted only 4 of the 15 applications including one from the Applicant. The Applicant also owns 1 of the 30 registrations, whereas the Opponent owns 5. It therefore appears that of the 61 marks found, 27 owned by entities other than the parties may be relevant. That being said, those 27 marks are mostly associated with wares or services that are not similar or related to the wares and services in this opposition. Accordingly, I cannot consider the state of the register evidence to be of any significance.

Ms. Robinson also filed in evidence a summary of a search she did for the word CLIC using the *Internet search engine Google.ca for Canadian pages only* (Exhibit AR-2). I note that Ms. Robinson offered no explanation of the search tool she used, its contents or the reliability of the information it contains. Even though I am inclined to acknowledge in light of the exhibit that the search was an Internet search, I cannot consider this evidence to be of any significance. To support my opinion, I note the comment made by Campbell J in *StaRite Industries Inc. v. GSW Inc.* (1999), 87 C.P.R. (3d) 300 at pages 305-306 [upheld by 12 C.P.R. (4<sup>th</sup>) 24 (F.C.A.)] in ruling on the results of an Internet search:

*“While I accept that the evidence contained in paragraphs 5 and 6 of the affidavit quoted above is admissible, it only proves that pages found on the World Wide Web exist as mentioned, and, as stated in paragraph 6, none of them describe pumps. I find, however, that these facts do not prove the proposition that there is no competition in the marketplace for the words STA-DRY with respect to pumps.*

*I find that for this proposition to be proved by such a search, a much more detailed and complete body of evidence must be established. For example, if the World Wide Web is to be taken as the source of such information, which might be an erroneous conclusion, at the very least it would be necessary to know how professionally conducted and extensive the web search was. This information was not provided. Therefore, I give this search evidence no weight.”*

Even if I were wrong in not granting any significance to the results of the Internet search, I believe that the search was far too broad to draw any conclusions [*Venator Group Canada Inc. v. Upstein’s Ltd.* (2000), 7 C.P.R. (4th) 142 (TMOB)].

In light of the above, I now turn my attention to the grounds of opposition.

For the purposes of the first ground of opposition, I will compare the Mark with the trade-mark CLIC & Design (registration no. TMA493,690) because, according to the evidence on file, it appears to be the case



in which the Opponent has the greatest chance of succeeding, particularly since the graphic elements and words in the other three marks, aside from the word CLIC, have nothing in common with the Mark.

The Applicant has the burden of showing, on a balance of probabilities, that there is no risk of confusion between the Mark and the Opponent's mark CLIC & Design [*Dion Neckwear Ltd. v. Christian Dior, S.A.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]. The relevant date for assessing the risk of confusion between the Mark and the Opponent's mark CLIC & Design under the provisions of paragraph 12(1)(d) is the date of my decision [*Park Avenue Furniture Corp v. Wickers/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

The first-impression test must be used in determining the risk of confusion between the marks at issue. More specifically, the question to be asked is whether a consumer with an imperfect recollection of the Opponent's mark CLIC & Design might mistakenly think that the services associated with the Mark come from or are authorized by the Opponent. To that end, all of the circumstances have to be taken into account, including the criteria set out in subsection 6(5) of the Act, namely (a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; (b) the length of time the trade-marks or trade-names have been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them. These criteria do not necessarily all carry the same weight; one criterion may be considered more significant than one or more of the others [*Classic Door & Millwork Ltd. c. Oakwood Lumber & Millwork Co.* (1995), 63 C.P.R. (3d) 337 (F.C. Trial Division)].

Regarding the inherent distinctiveness of the trade-marks at issue, it must be noted that "clic!" is recognized as an onomatopoeic representation of a light, dry crack. Consequently, the marks at issue cannot benefit from an important distinctive character as in the case of an invented word. The word CLIC is in no way suggestive of the food products associated with the Opponent's mark. However, since the Services associated with the Mark are related to the Internet, it strikes me that "clic" suggests the action of pushing ("clicking") on a computer mouse with light pressure. I conclude that the Opponent's mark is known in Canada, but the evidence filed by the Applicant does not really allow me to say whether that is true of the Mark.

The period of use of the trade-marks favours the Opponent. Even though the Opponent's mark includes a figurative element, the criterion based on the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them also favours the Opponent.

There is no resemblance or overlap between the services associated with the Mark and the wares associated with the Opponent's mark or between the nature of the parties' trade. In fact, there is no link at all between the services and wares or between the nature of the parties' trade.

I note the comment made by Marceau J in *Playboy Enterprises Inc. v. Germain* (1978) 39 C.P.R. (2d) 32 at page 38:

*"The question whether a mark is likely to be confusing with another mark in the minds of the public and within the meaning of the law, is a question of fact, or more precisely a question of opinion as to probabilities based on the surrounding circumstances and the particular facts of the case..."*

In the matter at hand, it strikes me as appropriate to lend the most weight to the criteria based on the nature of the wares and services and the nature of the trade [*A Lassonde & Fils Inc. v. Imperial Tobacco Ltd* (1987), 17 C.P.R. (3d) 8 (F.C. Trial Division)].

In consideration of the above and in particular because of the significant differences between the nature of the wares and services and the nature of the trade, I find that the Applicant has discharged its burden of showing that the Mark is not confusing with the Opponent's trade-mark CLIC & Design. My conclusion would be the same if I had compared the Mark to each of the three other trade-marks registered by the Opponent. Consequently, I reject the first ground of opposition.

The relevant dates for assessing the risk of confusion between the Mark and the trade-names and trade-marks alleged by the Opponent in support of its second and third grounds of opposition are the dates of first use claimed in the application for registration. Despite the Applicant's burden of showing, on a balance of probabilities, that there is no risk of confusion, the Opponent has the initial burden of proving that it was using its trade-names and trade-marks prior to the dates of use claimed in the application [subsection 16(1)] and that their use had not been abandoned at the date the application was published [subsection 16(5)]. I conclude that the Opponent discharged its burden of proof with respect to its mark CLIC & Design and its trade-name Clic Import Export Inc.

The difference between the relevant dates for the ground of opposition based on paragraph 12(1)(d) and the grounds based on section 16 has no real bearing on the analysis of the relevant criteria, from which I concluded that there is no confusion between the Mark and the Opponent's mark CLIC & Design. Consequently, I reject the third ground of opposition.

Inasmuch as I believe that the Mark does not create confusion with the mark CLIC & Design, I believe for the same reasons that it cannot create confusion with the trade-name CLIC Import Export Inc.,

particularly since the presence of the words "Import Export Inc." results in differences in appearance, sound and the ideas suggested by the Mark and the trade-name when they are considered as a whole. Consequently, I reject the second ground of opposition.

Although the Applicant has a burden to show that the Mark is distinctive throughout Canada [*Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (TMOB)], the Opponent has the initial burden of adducing evidence proving the existence of the facts alleged in support of its fourth ground of opposition. That ground is also based on the question of confusion between the Mark and the Opponent's trade-names and marks; the relevant date for that ground is normally considered the date on which the statement of opposition is filed [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4<sup>th</sup>) 317 (F.C. Trial Division)]. Once again, the difference between the relevant dates has no real bearing on my earlier conclusions. Consequently, the fourth ground of opposition is also rejected.

In accordance with the powers delegated to me by the Registrar of Trade-marks under the provisions of subsection 63(3) of the Act, I therefore reject the Opponent's opposition under the provisions of subsection 38(8) of the Act.

DATED AT MONTREAL, QUEBEC, THE 8<sup>th</sup> DAY OF FEBRUARY 2005.

Céline Tremblay

Member

Trade-marks Opposition Board