



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

Citation: 2015 TMOB 44
Date of Decision: 2015-03-17

**IN THE MATTER OF OPPOSITIONS by
F5 Networks, Inc. to application
Nos. 1,509,733 and 1,509,734 for the
trade-marks F12 NETWORKS &
DESIGN and F12 & DESIGN in the name
of F12 Networks Inc.**

[1] F5 Networks, Inc. (the Opponent) opposes registration of the trade-marks F12 NETWORKS & Design and F12 & Design (the Marks), shown below, that are the subject of application Nos. 1,509,733 and 1,509,734 by F12 Networks Inc. (the Applicant).



No. 1,509,733



No. 1,509,734

[2] Each application is based on proposed use of the trade-mark in Canada in association with the following services (the Services):

- (1) Information Technology consulting services.
- (2) Managed Information Technology Services, namely the sales, installation and maintenance of computer networks.
- (3) Internet Service Provider, namely the design, installation, building and managing of wireless networks.
- (4) Facilitating business record keeping and paperless transactions between unrelated parties as an Application Service Provider, by providing data processing, transmission

and storage services, namely processing and transmitting electronic purchase orders and invoices for others, organizing and archiving historic data resulting from or relating to such transactions, and providing access to or reporting of such historic data.

(5) The operation, as an Application Services Provider, of an electronic commerce exchange which offers managed electronic critical content, namely systems software, application software, design files and manufacturing and automatic files exchanged over the Internet, by the means of providing secure hosting, receipt confirmation, data encryption, auditing and accounting, centralized content exchange policy storage and management.

(6) The operation of a Network Operations Center to provide remote computer network administration, maintenance and support to computer network users.

(7) The operation of a Network Information Center to provide information and assistance to computer network users.

(8) The operation of a Datacenter providing hosted server environments otherwise known as cloud services, to computer network users.

(9) The development of custom-made computer software for others.

(10) The Retail sale of computer hardware, computer software, printers, and photocopiers.

[3] In each case, the Opponent alleges that: (i) the trade-mark is not registrable under section 12(1)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the Applicant is not the person entitled to registration of the trade-mark under sections 16(3)(a) and 16(3)(c) of the Act; and (iii) the trade-mark is not distinctive under section 2 of the Act. The grounds of opposition all turn on the issue of confusion with the Opponent's trade-marks and trade-name.

[4] For the reasons that follow, I refuse the application in each case.

The Record

[5] In each case, the Opponent filed its statement of opposition on November 21, 2011 and the Applicant filed and served its counter statement on April 5, 2012 denying all of the grounds of opposition.

[6] In support of each opposition, the Opponent filed the identical affidavit of John Campa, Chief Intellectual Property Counsel of the Opponent, to which were attached certified copies of registration Nos. TMA564,226, TMA550,910 and TMA498,090. In support of each application, the Applicant filed the identical affidavit of Alex Webb, President of the Applicant. Both affidants were cross-examined; the transcripts and the exhibits of the cross-examinations, along with replies to undertakings, have been made of record.

[7] In each case, both parties filed a written argument. An oral hearing for both opposition proceedings was held at which both parties were represented.

The Parties' Respective Burden or Onus

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that each of its applications complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Is the Mark Confusing with the Opponent's Registered Trade-marks?

[9] The material date for considering this issue, which arises from the section 12(1)(d) ground of opposition, is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)]. For reasons that follow, I accept this ground of opposition and decide this issue in favour of the Opponent.

[10] Having exercised the Registrar's discretion to check the Register, I confirm that the Opponent's registration Nos. TMA564,226 for the trade-mark F5, TMA550,910 for the trade-mark F5 NETWORKS, and TMA498,090 for the trade-mark F5 & Design (shown below), are in good standing. The Opponent has therefore met its initial evidential burden in relation to this ground of opposition. I shall refer to the Opponent's registered trade-marks collectively as the "F5 Marks"; the particulars of the registrations are reproduced in Schedule "A" to this decision.



TMA498,090

The test for confusion

[11] Since the Opponent has satisfied its initial evidential burden, the issue becomes whether the Applicant has met its legal burden to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the Opponent's registered trade-marks.

[12] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[13] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion.]

[14] In my opinion, comparing the Marks and the trade-marks F5 and F5 & Design of registration Nos. TMA564,226 and TMA498,090 will effectively decide the section 12(1)(d) ground of opposition. In other words, if confusion is not likely between the Marks and these two trade-marks, then it would not be likely between the Mark and F5 NETWORKS of registration No. TMA550,910. Furthermore, I am of the view that any evidence of use of F5 & Design would also qualify as use of the word mark F5 as the Opponent is not under any restriction to use the word mark in any particular format.

[15] I will now turn to the assessment of the section 6(5) factors.

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[16] The overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness of the parties' trade-marks, favours the Opponent.

[17] I assess the inherent distinctiveness of both parties' trade-marks to be equal in that none of them is inherently strong given that letters of the alphabet and numbers are inherently weak [see for example *GSW Ltd v Great West Steel Industries Ltd et al* (1975), 22 CPR (2d) 154 (FCTD) and *Noxzema Chemical Co of Canada Ltd v Estee Lauder Cosmetics Ltd* (1975), 23 CPR (2d) 214 (TMOB)]. The addition of figurative elements contributes somewhat to the inherent distinctiveness of the parties' design marks even though the term NETWORKS in the Applicant's F12 NETWORKS & Design trade-mark is not inherently distinctive given its descriptive nature in the context of the goods and services.

[18] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. Both parties provide some evidence of promotion and use of their respective trade-marks. I shall begin with a review of the Opponent's evidence.

Acquired Distinctiveness – F5 and F5 & Design

[19] In his affidavit, Mr. Campa states that the Opponent is a world renowned provider of network related products and services, delivering world-class performance, security, cloud solutions and support for top global websites, enterprises and services providers. First established in the United States in 1996, the Opponent is a publicly traded company with product development, marketing and sales offices throughout the world.

[20] According to Mr. Campa, the Opponent first used the trade-mark F5 in the United States in 1996; sales associated with the trade-mark F5 are said to have commenced as early as July 1997 in the United States. Mr. Campa adds that in 1997, the trade-mark F5 was stylized to give it a three dimensional effect resulting in the trade-mark F5 & Design (TMA498,090).

[21] In terms of the Opponent's presence in Canada, Mr. Campa provides that the Opponent has sold thousands of its product units to 185 customers across Canada from 2006 to 2012, representing over \$25 million USD in product sales revenue. During cross-examination, Mr. Campa explained that one aspect of the Opponent's business deals with application delivery controllers (ADC), which are computer software, with or without a hardware component, that handle network traffic [Qs 33 and 48 of the Campa cross-examination]. In his affidavit, Mr. Campa highlights two of the Opponent's products: (1) BIG-IP which is an ADC with additional functions and add-on modules such as access control, application security, network traffic optimization, protocol security manager, message security manager and advanced client authentication [Qs 91 to 96 of the Campa cross-examination]; and (2) VIPRION which is a chassis based ADC that also manages network traffic while allowing for the addition or the removal of other processing computers without disruption [Qs 123 to 125 of the Campa cross-examination]. According to Mr. Campa, price point depends on the model, the processing power, the memory, and the throughput limits. Units are sized to meet the needs of the different types of organizations. Mr. Campa further states that the Opponent has sold a number of other products in Canada, including FirePass, ARX, and Enterprise Manager. No additional details with respect to these other products were provided.

[22] In terms of the manner in which the trade-marks are used with the Opponent's products, Mr. Campa states that included with BIG-IP and VIPRION products are instruction manuals, which display at least one of the F5 Marks. Attached as Exhibits 14 and 17 are sample instruction manuals that are provided to Canadian operators of BIG-IP and VIRPRION products. Mr. Campa further states that instruction manuals with a cover page bearing one of the F5 Marks are included with all BIG-IP and VIPRION products sold in Canada. I note that the trade-mark F5 & Design appears on the cover page of both instructional manuals.

[23] During cross-examination, when asked whether an instruction manual accompanies a BIG-IP unit, Mr. Campa took issue with the term "accompany" and answered instead that the customer would be able to access electronically the password-protected instruction manual for a particular device on the Opponent's website [Qs 103 to 111 of the Campa cross-examination]. When Mr. Campa's statements are read in conjunction with the responses he provided during

cross-examination, it is unclear if a paper copy of the instructional manual physically accompanies the Opponent's units at the time of transfer.

[24] Even so, Mr. Campa did indicate during cross-examination that the trade-mark F5 & Design appears on the physical BIG-IP units, on the LED display, on the logon page of the user interface for network administrators, and on the shipping boxes [Qs 87 and 88 of the Campa cross-examination]. This is consistent with the photos found in the VIPRION instruction manual attached as Exhibit 17; the trade-mark F5 & Design can be seen apposed on the chassis and USB LCD modules of the VIPRION 2000 series units, and marked on the shipping box for the VIPRION 2400 chassis [see also Qs 133 to 135 of the Campa cross-examination].

[25] In his affidavit, Mr. Campa states that the Opponent has offered various training courses in every major city across Canada including Vancouver, Calgary, Toronto and Ottawa, for their F5 product lines since 2006, generating hundreds of thousands of dollars (USD) in revenue. Mr. Campa further states that as part of these training courses, the Opponent distributes training materials that display at least one of the F5 Marks. No evidence of sample use is provided in this regard.

[26] Mr. Campa explains that since 1996, the Opponent has been operating numerous authorized product return locations across Canada, where authorized representatives offer onsite services to Canadian customers. The affiant states that at least one of the F5 Marks is shown on the shipping box or on the product itself. No sample evidence of use of the Opponent's trade-marks is provided in this context.

[27] Finally, Mr. Campa states that the Opponent has published a number of case studies, accessible for free on its website [Qs 161 and 163 of the Campa cross-examination] that discuss the results of various projects that involve the implementation of the Opponent's products in different organizations, including Canadian companies. Attached as Exhibits 24 to 32 are copies of case studies, said to be published between 2005 and 2012, that involve Canadian companies in various sectors including banking, telecommunication, internet, insurance, education, and travel. I note that the trade-mark F5 & Design appears on the upper right hand corner of the first page of each case study.

[28] In terms of the promotion of the F5 Marks, Mr. Campa states that the Opponent advertises its products and services through trade shows, marketing events, and online advertising through trade magazines and websites. According to the affiant, the Opponent's advertising expenditures in Canada varied between \$29,000 USD (in 2008) to \$289,750 USD (in 2009), totaling over \$920,000 USD between 2007 and 2012. In this regard, Mr. Campa provides the following:

- The Opponent sponsored Comdex Canada 2002, a trade show for the IT community that was held in or about July 2002, in Toronto. The trade-mark F5 & Design can be seen in a prominent manner at the entrance of the Metro Toronto Convention Centre building in photos of the event attached as Exhibit 34;
- The Opponent also sponsored and attended other trade show events in Canada throughout the years, including the Vancouver VMUG User Conference in 2011 and 2012 [Exhibits 35 and 36], the IEEE International Conference on Communications held in Ottawa in 2012 [Exhibit 37], the Canada's Government Technology Event held in Ottawa in 2012 [Exhibit 38], and the EMC Forum held in Toronto in 2012 [Exhibit 39]. The trade-mark F5 & Design can be seen on most of the printouts extracted from the websites of these events;
- Mr. Campa also sets out a list of 25 additional conferences and forums that took place across Canada between 2011 and 2012, which the Opponent is said to have sponsored. The affiant states that at least one of the F5 Marks were displayed at these events; and
- The Opponent is said to have advertised extensively on websites, magazines, e-newsletters, and promotional emails ran by Penton Media, Inc., a mass media corporation that publishes and produces 113 magazines and 145 websites, with over six million subscribers around the world, including Canada [Q204 of the Campa cross-examination]. According to Mr. Campa, at least one of the F5 Marks would be displayed in these ads. No sample evidence or additional information regarding this particular advertising medium is provided.

[29] Moreover, attached as Exhibit 45 are two sample press releases by the Opponent between 2009 and 2010, the trade-mark F5 & Design can be seen on the upper left hand corner on the webpage printouts. Attached as Exhibit 47 is a sample media report dated July 2012 that is extracted from the website *channelbuzz.ca*, said to be a Canadian technology blog, regarding the Opponent's partnership with another company. I note that the Opponent is referred to as "F5 Networks" and "F5" in the article. Attached as Exhibit 48 are said to be sample advertisements from third parties who have participated in offering the Opponent's products for sale in Canada. I note that the exhibit consists of a listing of products described as "F5 BIG-IP" and "F5 VIPRION", accompanied by photos and pricing information, extracted from websites identified as *MicroAge* and *CDW Canada*.

[30] When Mr. Campa's affidavit is viewed in its entirety in conjunction with his cross-examination, I am satisfied that the Opponent has shown extensive promotion and use of the trade-marks F5 and F5 & Design in association with computer hardware and software designed to enhance performance of servers on a network, and to a smaller extent, related services thereof, since at least 2006.

Acquired Distinctiveness – The Marks

[31] As a preliminary matter, I am of the view that any evidence of use of F12 Networks & Design (No. 1,509,733) would also qualify as use of F12 & Design (No. 1,509,734) as the public would perceive the component F12 & Design in each case as use of a trade-mark *per se* [see *Registrar of Trade-marks v Compagnie Internationale pour l'Informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltee v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[32] Moreover, I am disregarding portions of the affidavit where Mr. Webb opines on the likelihood of confusion between the Opponent's trade-marks and the Marks, along with his confusion analysis, as these are issues to be decided by the Registrar from the evidence filed in the present proceedings.

[33] In his affidavit, Mr. Webb states that the Applicant is a privately incorporated business in the information technology industry, operating primarily in Alberta, under its previous name,

System Systems Inc., since 1995. On March 15, 2011, the corporation changed its name to F12 Networks Inc. According to Mr. Webb, he first thought to use the F12 key as a simple way for its users to get technical support in August 2010; he then decided to match the Applicant's name to the use of the key [p.14 of the Webb cross-examination]. I note that the subject applications were filed on December 21, 2010, based on proposed use of the Marks in Canada.

[34] Mr. Webb states that the Applicant provides day-to-day help desk support and network management to small and medium businesses, mainly in Western Canada. More particularly, the Applicant provides support to end users and conducts installations and upgrades on PC related hardware and software [p.11 of the Webb cross-examination]. The Applicant's customers are said to generally have 10 to 100 desktop devices on their networks with no information technology staff of their own, with the exception of the Applicant's largest customer, a retailer of windshields with 350 desktop users and its own IT department [p.40 of the Webb cross-examination].

[35] The Applicant's customer base includes non-governmental medical clinics, professional firms, auto retailers, and oil and gas support businesses. Attached as Exhibit 4 are printouts extracted from the Applicant's website dated March 1, 2013; the trade-mark F12 Networks & Design appears on the upper left hand corner of each webpage. The printouts discuss providing IT support for issues such as computer glitches, software updates, email account setup, and difficulties with printers. The printouts also advertise services for business that already have an "IT team".

[36] According to Mr. Webb, the Applicant provides end to end IT solutions from hardware such as servers, desktops, monitors and small switches, to software licensing, as well as support and consulting services including network management, hardware specifications, testing and installations [p. 20 to 23 and Exhibit D of the Webb cross-examination]. The Applicant is said to operate as a small business' information technology department, though at arm's length, for a monthly payment. Users can press the "F12" key on their keyboards to launch the Applicant's portal where they could request support, equipment and licence change, repairs, warranty management, the addition and the removal of users, etc. [p.11 and 20 of the Webb cross-examination]. Attached as Exhibit 5 is a printout of a webpage dated March 1, 2013 that a

registered user would see when he/she accesses the Applicant's services by clicking on a "F12 Web Connect" button that appears on the Applicant's website. The trade-mark F12 Networks & Design appears prominently on the printout. Mr. Webb adds that the Applicant does not build or sell application delivery network related products and does not supply anything to Fortune 50 companies.

[37] During cross-examination, Mr. Webb stated that the Applicant's annual revenue for the fiscal year ending October 2013 was nearly \$8 million, increasing a little every year from revenues of approximately \$6.5 million in 2011, prior to becoming F12 Networks Inc. Accordingly to Mr. Webb, "hardware as a service" represents 65% of the revenues while product sales and other types of services represent 35% of that figure [p.47 and 48 of the Webb cross-examination].

[38] In terms of the manner in which the trade-marks are used, Mr. Webb explained during cross-examination that for customers who opt for hardware as a service, the Applicant would put a barcode identifying itself on its equipment [p.23 -24 of the Webb cross-examination]. In response to Undertaking nos. 5 and 6 of the Webb cross-examination, two photos of computer hardware were provided. The trade-mark F12 & Design can be seen clearly on labels apposed on the equipment.

[39] In terms of advertising, Mr. Webb states that the Applicant's staff members are not likely to attend or sponsor the same trade shows as the Opponent such as Comdex Canada, given that the Applicant targets small business owners. During cross-examination, Mr. Webb did confirm that he has personally attended Comdex Canada. Moreover, the affiant stated that he has attended other trade shows such as Venture Tech Network, Exchange, WatchGuard, Microsoft Partner Conference, HP Partner Conference, on a regular basis [p.42 of the Webb cross-examination]. Mr. Webb further states in his affidavit that the Applicant does not advertise in any of the media mentioned in the Campa affidavit. The Applicant does however have its own website and that it has advertised in the *West Edmonton Business Magazine*. In response to Undertaking no. 6, Mr. Webb also provided a copy of a print ad that was going to be published in the *Red Deer Express*, a community newspaper from Central Alberta. The trade-mark F12 Networks & Design appears prominently at the bottom of an ad for "all-inclusive business IT services".

[40] When Mr. Webb's affidavit is viewed in its entirety in conjunction with his cross-examination, I am satisfied that the Applicant has shown considerable promotion and use of the Marks in 2013, in association with various computer and network related services including help desk, software and hardware installations, licensing and upgrades, network and server maintenance, and cloud services.

[41] When I consider both parties' evidence of promotion and use of their respective trade-marks, I am of the view that the Opponent's trade-marks F5 and F5 & Design have become known in Canada to a greater extent than the Marks.

[42] Accordingly, the section 6(5)(a) factor favours the Opponent.

Section 6(5)(b) – the length of time the trade-marks have been in use

[43] The overall consideration of the section 6(5)(b) factor clearly favours the Opponent.

[44] In addition to the evidence of use of the Opponent's trade-marks F5 and F5 & Design since at least 2006, the Opponent's registration Nos. TMA564,226 and TMA498,090 indicate used of the trade-marks in Canada since at least as early as 1997 on goods and 1999 on services. In comparison, while the applications for the Marks are based on proposed use in Canada, Mr. Webb has provided evidence of use and promotion of the Marks in 2013.

Sections 6(5)(c) and (d) – the nature of the goods, services, trade and business

[45] The sections 6(5)(c) and (d) factors, which involve the nature of the goods, services, trade and business of the parties, favour the Opponent.

[46] When considering sections 6(5)(c) and 6(5)(d) of the Act, it is the statements of goods and services as defined in the applications for the Marks and in the Opponent's registration Nos. TMA564,226 and TMA498,090 that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. Those statements must be read with a view to

determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[47] The Opponent and the Applicant are both in the business of putting together and managing computer networks for businesses. There is direct overlap between some of the parties' services and a close connection between the remaining goods and services. In this regard, both parties' trade-marks are associated with consulting services in the field of information technology, which includes computers, as well as goods and services related to computer networks, including the sale and technical support of hardware and software components for businesses.

[48] During his cross-examination, Mr. Campa explained that the Opponent's F5 products are designed to handle network traffic on behalf of servers and to provide support to its partners' cloud solutions, such as an online back-up service and software as a service [Qs 33, 37 to 39 of the Campa cross-examination]. Similarly, Mr. Webb explained during cross-examination that the Applicant installs and maintains computer networks, and operates a data center with numerous servers where it hosts its clients' cloud services for their network users [p.32 of the Webb cross-examination]. Moreover, Mr. Campa stated that while the Opponent does not sell switches and routers, its products are used in association with switches and routers [Q75 of the Campa cross-examination]. On this matter, Mr. Webb mentioned that as part of the Applicant's hardware as a service business, it provides desktops, servers and small switches to its customers [p.20 of the Webb cross-examination].

[49] There is also potential for overlap between the parties' channels of trade. In this regard, neither the Opponent's registrations nor the subject applications contain any restriction on the parties' channels of trade. During cross-examination, Mr. Campa stated that the Opponent's customer base includes large corporations, as well as small and medium-sized businesses, with some of the Opponent's products geared towards small entities specifically [Qs 68, 146 and 150 of the Campa cross-examination]. In his affidavit, Mr. Campa also states that the Opponent

offers services such as training and authorized product return locations across Canada, including Calgary and Edmonton. In comparison, Mr. Webb stated that the Applicant operates primarily in Alberta, targeting small and medium businesses mainly in Western Canada, with no information technology staff of their own. However, the Applicant also provides services to larger entities, such as a retailer of windshields with 350 desktop users with its own IT department.

Section 6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[50] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality. It is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trade-marks. While the first component of a trade-mark is often considered more important for the purpose of distinction [*Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD) and *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)], the preferable approach is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique [see *Masterpiece* at para 64].

[51] When the marks are viewed in their entirety, there are both similarities and differences between the parties' trade-marks in appearance and sound. I find the expression "F5" to be the striking aspect of the Opponent's trade-marks, and the expression "F12" to be the striking aspect of the Applicant's Marks. As discussed in the 6(5)(a) analysis, letters of the alphabet and numbers are inherently weak, while the term NETWORKS of the Applicant's trade-mark F12 NETOWRKS & Design is descriptive of the associated goods and services. Moreover, I do not consider the figurative elements of either party's trade-marks to be particularly striking or unique.

[52] Both parties' trade-marks evoke the idea of function keys found on a computer keyboard, an idea closely connected to the associated goods and services. In this regard, even though Mr. Campa states in his affidavit that the Opponent's name "F5" came from the abbreviation of "force 5 winds" taken as a rating for tornado readings, there is no evidence to suggest that an average consumer of an application delivery controller used to manage network traffic would associate the F5 Marks with a distant reference to violent storms with strong circular winds. In

comparison, Mr. Webb explained during cross-examination that the Applicant first thought to use the F12 key as a simple way for its users to get support and then decided to match its name to the use of the key.

[53] In view of the foregoing, the section 6(5)(e) factor only slightly favours the Opponent.

Additional surrounding circumstances – State of the Register

[54] Attached as Exhibit 6 to Mr. Webb’s affidavit are partial printouts of the results of four distinct searches conducted on the Canadian Intellectual Property Office’s trade-marks database for trade-marks that contain the letter “F”, the number “5”, the term “NETWORKS”, and the number “12”. The searches were done without any restrictions on the status of the trade-marks or the types of goods or services. No additional details with respect to any of the trade-marks identified in the partial search results were provided.

[55] State of the register evidence is purported to show the commonality or distinctiveness of a trade-mark or portion of a trade-mark in relation to the register as a whole. It is only relevant insofar as inferences may be made with respect to the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[56] In the present case, I am unable to draw any meaningful inferences concerning the state of the marketplace from Mr. Webb’s affidavit. In this regard, the Applicant omitted to provide the particulars of the applications/registrations identified in the partial search results, which in any case appear to be mostly abandoned, cancelled, or expunged trade-marks. Moreover, the mere fact that the Applicant was able to find trade-marks that include the letter “F” or the number “5” or “12” on the register, associated with any goods or services, does not allow me to draw any conclusions regarding the commonality or the distinctiveness of trade-marks with dominant features similar to those of the Opponent and of the Applicant for computer network related goods and services in the marketplace.

[57] In view of the foregoing, the state of the register evidence provided in Mr. Webb's affidavit is of no assistance to the Applicant in terms of the likelihood of confusion between the Opponent's trade-marks and the Marks.

Additional surrounding circumstances – Instances of Actual Confusion

[58] In his affidavit, Mr. Webb states that neither the Applicant's corporate officers nor its customer service staff has knowledge of any instances where a prospective customer thought that the Applicant has any connection with the Opponent.

[59] Absence of evidence of actual confusion over a relevant period of time, despite an overlap in the parties' goods, services and channels of trade, may entitle the Registrar to draw a negative inference about the likelihood of confusion [see *Mattel, supra* at p 347.] Nevertheless, the Opponent is under no obligation to submit evidence of instances of actual confusion. Moreover, the absence of such evidence does not necessarily raise any presumptions unfavourable to the Opponent for the burden is on the Applicant to demonstrate the absence of likelihood of confusion.

[60] In the present case, given the limited geographical area in which the Applicant has provided its services thus far in association with the Marks and the relatively short period of co-existence of the parties' trade-marks, I am not prepared to draw any negative inference regarding the likelihood of confusion from the lack of evidence of actual confusion.

Conclusion in the likelihood of confusion

[61] Section 6(2) of the Act is not concerned with the confusion of the trade-marks themselves, but of the goods or services from one source as being from another.

[62] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, including the low inherent distinctiveness of the parties' trade-marks with both similarities and differences between their respective dominant features, similarities between their ideas suggested, the considerable promotion and use of the Opponent's trade-marks which leads to significant reputation of its trade-marks F5 and F5& Design, the direct overlap and the close connection that

exists between the parties' goods and services, as well as potential for overlap between their respective channels of trade, I arrive at the conclusion that the probabilities of confusion between the Marks and the Opponent's trade-marks F5 and F5 & Design are evenly balanced between a finding of confusion and of no confusion.

[63] While I acknowledged that comparatively small differences will generally suffice to distinguish between trade-marks of relatively low inherent distinctiveness, the degree of distinctiveness attributed to a weak mark may be enhanced through extensive use [see *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD) and *Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 at para 6 (FCTD)]; such is the case of the Opponent's trade-marks in the present proceedings.

[64] Moreover, despite the fact that Applicant appears to be currently targeting businesses with generally less sophisticated information technology requirements than those of the Opponent, the parties are nevertheless operating in overlapping markets with no restrictions on their respective channels of trade. In fact, both parties acknowledged having provided computer network related goods and services designed for/to small to medium-sized businesses and the Applicant also confirmed that its largest customer has its own IT department, as is the case of the Opponent's customers.

[65] The Applicant has therefore not met the legal onus on it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Marks and the trade-marks F5 and F5 & Design.

[66] I would add that had the Applicant been able to provide reliable state of the register and/or state of the marketplace evidence showing extensive third party use of trade-marks with similar dominant features for computer network related goods and services, my conclusion might have been different.

[67] In view of the foregoing, I accept the section 12(1)(d) ground of opposition.

Section 16(3)(a) Non-Entitlement and Section 2 Non-Distinctiveness Grounds of Opposition

[68] Even though the material dates for the section 16(3)(a) and distinctiveness grounds of opposition fall earlier than today's date, on the filing date of the subject applications December 21, 2010 and the filing date of the statements of opposition of November 21, 2011 respectively, the different dates do not result in a different outcome.

[69] The evidence summarized above is sufficient to meet the Opponent's burden. I will not discuss these grounds of opposition in detail as they do not favour the Applicant any more than the section 12(1)(d) ground despite the earlier material dates. As such, these grounds of opposition are also successful.

Section 16(3)(c) Non-Entitlement Ground of Opposition


[70] Given that I have already found the Opponent successful with respect to three grounds of opposition, I will not discuss this ground of opposition.

Disposition

[71] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse application Nos. 1,509,733 and 1,509,734 under section 38(8) of the Act.

Pik-Ki Fung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule “A”

Opponent’s Registered Trade-mark	Reg. No.	Goods and Services
F5	TMA564,226	<u>Goods:</u> (1) Computer hardware and software for enhancing the performance of a plurality of servers connected together by a network. <u>Services:</u> (1) Computer consulting services.
F5 NETWORKS	TMA550,910	<u>Goods:</u> (1) Computer hardware and software for enhancing the performance of a plurality of servers connected together by a network. <u>Services:</u> (1) Computer consulting services.
	TMA498,090	<u>Goods:</u> (1) Switches and routers and associated computer software for providing or enhancing the performance of a cluster of servers on a computer network. <u>Services:</u> (1) Computer consulting services.