

**IN THE MATTER OF AN OPPOSITION by  
Alis Technologies Inc. to  
application No. 858,572  
for the trade-mark ALICE  
in the name of Alice Corporation Pty Ltd. (formerly Swychco Infrastructure Services Pty Ltd.)**

On October 14, 1997, Swychco Infrastructure Services Pty Ltd., the applicant, filed an application to register the trade-mark ALICE. The application claims a convention priority filing date of April 21, 1997 based upon an Australian application. The application is based upon proposed use of the trade-mark in Canada. Although the application originally covered both wares and services, the wares were deleted during the opposition proceedings and the services were revised. At present, the application covers only the following services:

**Business management services; financial services namely, risk management services, insurance services, financial and insurance information services; design and development of software for calculating risks and conducting commercial transactions in the field of financial applications and risk management.**

The application was advertised for opposition purposes in the Trade-marks Journal of October 27, 1999. The opponent, Alis Technologies Inc., filed a statement of opposition on November 17, 1999. The applicant filed and served a counter statement in which it denied the opponent's allegations.

The opponent filed as its evidence the affidavit of Louise Guerrette. As its evidence, the applicant filed the affidavit of Victoria Carrington and a certified copy of the Canadian Intellectual Property Office's file re trade-mark application No. 553,843 (which issued to registration as No. 350,508).

On August 23, 2001, the Canadian Intellectual Property Office recorded the change of name of the

**applicant from Swychco Infrastructure Services Pty Ltd. to Alice Corporation Pty Ltd.**

**Each party filed a written argument. An oral hearing was held at which both parties were represented.**

**In the statement of opposition, the opponent alleges that it owns Canadian trade-mark registrations for the trade-marks ALIS and ALIS TECHNOLOGIES...A WORLD OF LANGUAGE SOLUTIONS. It also claims that its trade-mark ALIS TECHNOLOGIES is about to be registered in Canada. The opponent states that these three trade-marks have been used in Canada since before October 14, 1997 in association with the same general class of wares and services as those specified in application No. 858,572 and have not been abandoned by the opponent. It further claims that its trade-mark ALIS and an unidentified trade-name (presumably Alis Technologies Inc.) have been used in Canada since February 1981 and that the ALIS mark was registered on March 9, 1982 under No. 272,358. It is the opponent's position that the applicant's mark is confusing with the opponent's three marks and trade-name. For this reason, the opponent pleads that the application is not registrable pursuant to section 12 of the *Trade-marks Act*, the applicant is not the person entitled to register the trade-mark pursuant to section 16 and the applicant's trade-mark is not distinctive.**

**The opponent also pleads that the applicant's mark is not registrable pursuant to paragraph 12(1)(e) because its adoption "is prohibited by Sections 9 and 11 of the Act, in view of the notice published on page 91 of the April 21, 1999 issue of the Trade-marks Journal".**

**The opponent further pleads that the application does not comply with section 30. The opponent has set out three paragraphs under this ground but they all amount to a claim that the applicant knew or ought to have known that its mark was likely to cause confusion with the opponent's marks. As there is no evidence to support the claim that the applicant was aware of the opponent's marks, the section 30 grounds fail.**

**The opponent has also pleaded that the applicant's mark is not a trade-mark as defined in section 2. This is not substantiated.**

**Although the statement of opposition is short of many details, for example the registration number with respect to the trade-mark ALIS TECHNOLOGIES... A WORLD OF LANGUAGE SOLUTIONS, the applicant has not pleaded that any of the grounds are insufficiently pleaded. Instead, the applicant has merely denied the grounds of opposition. In any event, the opponent's evidence does provide most of the missing information. [see *Novopharm Ltd. v. AstraZeneca AB et al.* (2002), 21 C.P.R. (4<sup>th</sup>) 289 (F.C.A.)]**

**There is a legal burden on the applicant to establish on a balance of probabilities that there would not be a likelihood of confusion between its mark and each of the marks and name pleaded by the opponent. [see *Dion Neckwear Ltd. v. Christian Dior, S.A.* (2002), 20 C.P.R. (4<sup>th</sup>) 155 (F.C.A.)] However, there is an evidential burden on the opponent to first adduce sufficient evidence to support the truth of its allegations. With respect to the entitlement grounds of opposition, the opponent must evidence use of its trade-marks and trade-name prior to the applicant's convention priority filing**

date and establish non-abandonment of its marks/name as of the date of advertisement of the applicant's application [subsections 16(5) and 17(1), *Trade-marks Act*].

Ms. Guerrette is the Secretary and Director of Legal Affairs of the opponent. She states that the opponent is a major player in the Canadian and international world of telecommunications and computers, including research, creation, distribution and the sale of software for many purposes. In particular, the opponent is a leader with respect to technology that provides linguistic translation. Ms. Guerrette claims that as a result of the opponent's reputation as a leader and innovator in high technology and because of its business relationships with many other businesses, it would be a natural evolution for the opponent to develop wares and services similar to those set out in application No. 858,572. On this point however, I note that there is no evidence that the opponent has taken any steps toward ventures of the type set out in the applicant's present statement of services and Ms. Guerrette's statement appears to me to mere speculation [see *United Artists Corp. v. Pink Panther Beauty Corp.*, 80 C.P.R. (3d) 247 (F.C.A.)].

Ms. Guerrette lists various companies with which the opponent has worked over the years, including Microsoft, IBM, AT&T and Toshiba. The opponent's wares and services are distributed in more than 25 countries and, according to Ms. Guerrette, the opponent's clients could also use services of the type set out in the applicant's application.

Ms. Guerrette provides some promotional materials (Christmas card, t-shirt, clock) that bear one or more of the opponent's trade-marks but she does not indicate when these items were distributed or

the extent of their distribution. As Exhibit 9, she provides an example of a promotional kit sent to clients in Canada and elsewhere. These materials display the trade-mark ALIS and/or ALIS TECHNOLOGIES but the only date associated with these materials is a 1999 copyright notice on one of the pieces. She also provides a copy of a “Founder’s Log”, which essentially is a corporate scrapbook. Most of the materials therein do not assist the opponent’s case. However, there are copies of some articles, which discuss the opponent, that appeared in well-known publications, in particular clippings from Le Devoir dated March 23, 1998, the Financial Post dated September 23, 1998, and La Presse dated December 11, 1996. While these clippings may show that the opponent has acquired a reputation, they are not use of the opponent’s trade-mark pursuant to section 4 of the Act. There are also clippings from newspapers dated 1988 but I cannot take judicial notice of the circulation of these earlier ones because they are not from major Canadian newspapers [see *Northern Telecom Ltd. v. Nortel Communications Inc.* (1987), 15 C.P.R. (3d) 540 (T.M.O.B.)]. There is also a copy of a press release from Microsoft dated October 15, 1987 concerning the joint development with the opponent of Arabic MS-DOS but there is no evidence that this was distributed in Canada and in fact it appears that it may have been released in the United Arab Emirates.

Ms. Guerrette states that the opponent has used ALIS TECHNOLOGIES since June 1982 « pour la consultation et la conception personnalisée de produits multilingues, de sites web, de systèmes Internet et intranet. » She states that use of ALIS TECHNOLOGIES... A WORLD OF LANGUAGE SOLUTIONS began December 2, 1997. As Exhibits 1, 2 and 3, Ms. Guerrette provides copies of trade-mark registrations Nos. 272,358, 519,729, and 506,548. She states that since well before October 14, 1997, the opponent used ALIS, ALIS TECHNOLOGIES INC and ALIS TECHNOLOGIES... A

**WORLD OF LANGUAGE SOLUTIONS** in association with the wares and services covered by their respective trade-mark registrations. However, the registration for **ALIS** only claims use in association with some of the services since December 2, 1997, December 5, 1997 and December 1998. In addition, I note that the second registered trade-mark is **ALIS TECHNOLOGIES**, not **ALIS TECHNOLOGIES INC.**

Although Ms. Guerrette makes many claims concerning use of the opponent's marks/name, she has not provided any evidence of actual sales, *e.g.* invoices. She does provide a number of items that bear one or more of the trade-marks but there is no evidence when exactly many of these items were in the marketplace. As Exhibit 8, she provides envelopes, letterhead and the like which she states "sont continuellement utilisés par l'opposante dans le cours normal de ces opérations." These show use of the trade-marks **ALIS** and **ALIS TECHNOLOGIES**, as well as the trade-name **Alis Technologies Inc.** However, it is not clear to me when use of these materials commenced and I am not prepared to interpret any ambiguity in Ms. Guerrette's statement in her favour.

Having considered all of the opponent's evidence, I conclude that the opponent has not met its initial burden to show use of its marks or trade-name in Canada prior to April 21, 1997, because Ms. Guerrette's bald statement has not been substantiated by evidence showing use as of the material date. I am therefore dismissing the section 16 grounds. In the event that I am incorrect about the satisfaction of the initial burden, I note that the outcome of the section 16 ground would likely be the same as the outcome of the paragraph 12(1)(d) ground because in the circumstances of this case, not much turns on the material date.

**With respect to the grounds of opposition based on non-distinctiveness, the opponent need only show that as of November 17, 1999 its trade-marks/trade-name had become known sufficiently to negate the distinctiveness of the applied-for mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.), *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)]. However, once again, the outcome of the distinctiveness ground of opposition would be the same as the paragraph 12(1)(d) ground because the circumstances do not change significantly between November 17, 1999 and today's date.**

**Before proceeding with a discussion of the paragraph 12(1)(d) grounds of opposition, I will summarize the applicant's evidence.**

**Ms. Carrington, an associate in the trade-mark firm representing the applicant, provides copies of the web sites of the applicant and the opponent as located on the Internet in July 2001. She also provides the particulars of trade-mark registrations that the applicant has secured for ALICE in various foreign countries.**

**I have some comments concerning the extent to which the applicant may rely on the information set out in the applicant's web site as introduced by Ms. Carrington. The information therein cannot be relied upon as if it were introduced by a knowledgeable affiant who could be cross-examined on the veracity of the information. I am therefore only prepared to accept that such a web site existed at the**

time that Ms. Carrington indicated. I am not prepared to accept the statements made within the applicant's web site as evidence, especially to any degree that they may support the applicant's case.

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the *Act*. Those factors specifically set out in subsection 6(5) are: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)]. The material date for considering the likelihood of confusion under paragraph 12(1)(d) is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.); *Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers* (1991), 37 C.P.R. (3d) 538 (T.M.O.B.)].

I will first focus the discussion on the opponent's trade-mark ALIS. To the extent that the opponent's marks are all associated with the same wares and services, it is clear that if the applicant's mark is not confusing with ALIS, then it is also not confusing with ALIS TECHNOLOGIES or ALIS TECHNOLOGIES... A WORLD OF LANGUAGE SOLUTIONS.



**ALIS is an acronym for Arabic-Latin Information Services. To the extent that such origin is known, it would diminish the inherent distinctiveness of the mark. ALICE is of course a common female name. Although it has no connection to the applicant's services, it is an inherently weak mark by nature.**

**The only evidence of the applicant's trade-mark having been advertised or otherwise promoted is the existence of the applicant's web site in 2001. There is of course also evidence that the opponent's trade-mark was advertised or otherwise promoted by means of the opponent's web site that same year. In addition, there is evidence of the opponent's trade-mark being referred to in articles appearing in major Canadian publications. Overall, the evidence supports a conclusion that the opponent's ALIS trade-mark has acquired more distinctiveness in Canada than has the applicant's ALICE trade-mark.**

**According to its registration, the opponent's ALIS mark has been used in Canada since February 1981. Moreover, in addition to general allegations of use, Ms. Guerrette swore on June 21, 2000 that stationery bearing the ALIS trade-mark, attached as Exhibit 8, was being used in the opponent's business. In contrast, the only evidence of use of the applicant's mark is a web site that existed in 2001. Therefore, the length of time each mark has been used favours the opponent.**

**When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application or registration that governs in respect of the issue of confusion**

arising under paragraph 12(1)(d) [*Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Dale Bohna* (1984), 58 C.P.R. (3d) 381 (F.C.A.)]. The wares and services covered by the opponent's registration for ALIS are as follows:

**Wares:** Computer software and hardware used in Arabic information processing systems.

**Services:** (1) Development, manufacturing and marketing of Arabic-Latin micro-computer systems to customer specifications and consulting and training services with regard to Arabic information processing.

(2) Consulting and custom design services for creating multilingual products, websites, internet systems and providing software for translation of websites, e-mail, documents, multilingual browsers for internet or intranet and for translation and language engineering.

(3) Providing software users with access to the Internet in a multiplicity of languages and allowing browsing through the Internet including the World Wide Web in the language of the user's choice.

(4) Providing software for identification of language and character encoding, character set conversion, line breaking, hyphenation, word extraction and language sorting, and selling, providing, marketing and developing internet-based and network based human and machine translation services and brokerage services.

(5) Providing consultation, tools and systems in the fields of language engineering and information technology, human and computerized language handling and translation systems and World Wide Web and Intranet publishing, World Wide Web browsing, e-mail communications and the conception and design of equipment and software for these purposes.

(6) Providing consultation, tools and systems in the fields of language engineering and information technology, human and computerized language-handling and translation systems, World Wide Web and Intranet publishing.

(7) Providing hyper text markup language editors and providing software which reaccentuates documents generated in an electronic format.

It is clear from the registration that the opponent's wares and services focus on language translation, and this distinguishes the opponent's services from those of the applicant. While it is true that both are involved in the computer world, that is a very broad field.

**The channels of trade associated with each party's services are not particularly clear.**

**ALIS and ALICE are visually and aurally very similar. The degree of resemblance between the ideas suggested by each mark is less.**

**Other surrounding circumstances include a consideration of other marks that coexist with the opponent's mark and the parties' coexisting foreign registrations. On the first point, the applicant points to the now expunged registration No. TMA350,508 for the trade-mark ALIS & Design, which coexisted on the Canadian Trade-mark Register with the opponent's registration for ALICE from 1989 to 1999. Registration No. TMA350,508 issued based, in part, on use of the mark in Canada since June 7, 1985 in association with computer software recorded on magnetic media and printed publications relating to office automation. It was expunged on April 9, 1999 for failure to show use of the mark during the period between January 27, 1996 and January 27, 1999. During the prosecution of the application that issued to registration as TMA350,508, the Examiner cited the opponent's registration for ALIS but the citation was overcome by an argument that distinguished the two parties' wares. I am not bound by the Examiner's decision but do think that the differences in the wares might be significant. Nevertheless, in the absence of evidence that the ALIS & Design mark coexisted with the ALIS mark in the same marketplace, as opposed to simply on the Register, without confusion, I do not consider this surrounding circumstance to assist the applicant.**

**On the second point, there is evidence that each party has registered its trade-mark in the United States of America, the applicant in 2001 and the opponent in 1999. The applicant relies on *Kellogg***

*Canada Inc. v. Weetabix of Canada Ltd.* (2002), 20 C.P.R. (4<sup>th</sup>) 17 (F.C.T.D.) in support of its position that coexistence in the United States is an indication of the lack of possible confusion. I note however that the present fact situation differs significantly from the case relied upon in that there the parties' marks were said to have coexisted in the United States for many years, whereas here there is no evidence that the applicant has ever used its mark in the United States. In any event, given that there may be other factors that justify the co-registration of marks in a foreign jurisdiction that do not exist in Canada (*e.g.* differences in the law or a different state of the register), I prefer the line of cases that have held that coexistence on foreign trade-mark registers is to be accorded little weight [see for example, *Quantum Instruments, Inc. v. Elinca S.A.*, 60 C.P.R. (3d) 264 at pp. 268-9 (T.M.O.B.)].

I find that a consideration of all the surrounding circumstances leads me to conclude that the applicant has satisfied the onus on it to show that, on a balance of probabilities, there is not a reasonable likelihood of confusion between the mark ALIS as applied to the wares and services registered by the opponent and the mark ALICE as applied to the applicant's services. The applicant need only show that the absence of confusion is more probable than its existence. My conclusion is based primarily on the lack of inherent distinctiveness with respect to both parties' marks, the differences between the fields of interest of the two parties and the shortage of evidence of use of the opponent's mark in Canada. Most of all, it is the differences between the parties' services which leads me to conclude that a consumer with a general and not precise recollection of the opponent's mark, upon seeing the applicant's mark, will not be likely to think that the services share a common source.

**I turn now briefly to the registrability ground of opposition that relies on the opponent's trade-mark ALIS TECHNOLOGIES...A WORLD OF LANGUAGE SOLUTIONS. The registration for that mark covers the following services: providing consultation, tools and systems in the fields of language engineering and information technology, human and computerized language-handling and translation systems, World Wide Web and Intranet publishing, World Wide Web browsing, E-MAIL communications and the conception and design of equipment and software for these purposes.**

**The differences between this mark and the mark ALICE are greater than that between ALIS and ALICE while the associated services are no more similar to those associated with ALICE than were those associated with the opponent's ALIS mark. Overall, a consideration of all the subsection 6(5) factors leads to the conclusion that confusion is not likely, with the result that this ground of opposition fails.**

**I do not consider the opponent to have pleaded a section 12(1)(d) ground of opposition based on its registration for ALIS TECHNOLOGIES, for the simple reason that such registration had not issued at the point of time that the opposition was filed. If the opponent wished to include such a ground of opposition, the proper way to do so would have been to seek leave to amend its statement of opposition once its registration had issued.**

**I will briefly touch on the ground of distinctiveness. This ground of opposition fails primarily because I consider the differences between the parties' fields to be sufficient to enable the applicant's mark to distinguish the applicant's services from the opponent's wares and services. To the extent that the**

subsection 6(5) factors apply to this ground, my comments above are pertinent, in so far as the facts existed as of the date material to distinctiveness, namely the filing date of the opposition. [see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)].

The paragraph 12(1)(e) ground of opposition is based on the official mark ALIS, which was published in the Trade-marks Journal April 21, 1999. Ms. Guerrette has provided a copy of the publication as Exhibit 13 to her affidavit.

The relevant parts of section 9 of the *Act* are reproduced below:

9. (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for...

(n) any badge, crest, emblem or mark...

(iii) adopted and used by any public authority, in Canada as an official mark for wares or services,

in respect of which the Registrar has, at the request of Her Majesty or of the university or public authority, as the case may be, given public notice of its adoption and use;

In *Canadian Council of Professional Engineers v. John Brooks Company Limited* (2001), 21 C.P.R.

(4<sup>th</sup>) 397, Board Member summarized certain aspects concerning paragraph 12(1)(e) grounds of opposition at p. 406-7 as follows:

The material time for considering the circumstances respecting the fourth ground of opposition is the date of my decision: see the decisions in Allied Corporation v. Canadian Olympic Association (1989), 28 C.P.R. (3d) 161 (F.C.A.) and Olympus Optical Company Limited v. Canadian Olympic Association (1991), 38 C.P.R. (3d) 1 (F.C.A.). Furthermore, the opponent is not required to evidence use and adoption of the official marks it is relying

on, at least not in the absence of evidence suggesting that the marks were not used: see page 166 of the Allied decision.

In *WWF-World Wide Fund for Nature v. 615334 Alberta Limited* (2000), 6 C.P.R. (4<sup>th</sup>) 247 (T.M.O.B.) at 253, Board Member Martin discussed the test to be applied under paragraph 9(1)(n)(iii) with reference to the court decisions in *Big Sisters Association of Ontario v. Big Brothers of Canada* (1999), 86 C.P.R. (3d) 504 (F.C.A.); affg. (1997), 75 C.P.R. (3d) 177 (F.C.T.D.), as follows:

As stated in Section 9(1)(n)(iii) of the Act, the test to be applied is whether or not the applicant's mark consists of, or so nearly resembles as to be likely to be mistaken for, the official mark. In other words, is the applicant's mark identical to, or almost the same as, any of the opponent's official marks?: see page 217 of the trial level decision in the Big Sisters case noted above. At page pages 218-219 of the trial level decision, Mr. Justice Gibson confirmed that in assessing the resemblance between the marks at issue, regard may be had to the factors set out in Section 6(5)(e) of the Act. Further, at page 218, Mr. Justice Gibson indicated that the test was to be applied as a matter of first impression and imperfect recollection: see also pages 8-9 of the unreported decision of the Federal Court of Appeal in Canadian Olympic Association v. Techniquip Limited (Court No. A-266-98; November 10, 1999).

Having regard to the factors set out in paragraph 6(5)(e), I note that ALIS and ALICE are visually and aurally very similar. While the degree of resemblance between the ideas suggested by each mark is less, I conclude that the overall resemblance between the official mark ALIS and the opponent's mark ALICE is sufficiently high that ALICE is likely to be mistaken for ALIS as a matter of first impression and imperfect recollection. Accordingly, the paragraph 12(1)(e) ground of opposition succeeds.

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, I refuse the application pursuant to subsection 38(8) of the *Act*.

**DATED AT TORONTO, ONTARIO, THIS 5<sup>TH</sup> DAY OF FEBUARY 2004.**

**Jill W. Bradbury  
Member  
Trade-marks Opposition Board**