



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

**Citation: 2015 TMOB 78**  
**Date of Decision: 2015-04-22**

**IN THE MATTER OF AN OPPOSITION by  
9105-8503 Québec Inc. to application  
No. 1,309,759 for the trade-mark MAESTRO  
in the name of Touchtunes Music  
Corporation**

[1] 9105-8503 Québec Inc. (9105) opposes registration of the trade-mark MAESTRO (the Mark) that is the subject of application No. 1,309,759 by Touchtunes Music Corporation (the Applicant).

[2] The application was filed on July 19, 2006 (claiming priority from U.S. application No. 78/875,726 filed on May 3, 2006) and covers the following goods and services, as revised twice by the Applicant during the examination of the application:

Goods

Music selection systems comprising speakers, digital jukeboxes and touch screens/buttons for distributing, selecting and playing audio and video musical information; musical jukeboxes; music servers; and jukebox systems, namely, one or more musical jukeboxes connected electronically to select, download and play music contents and parts thereof.

Services

- (1) Providing service updates of musical sound recordings, music files, album artwork by electronic means from a computer database.
- (2) Advertising services, namely advertising of messages for others, preparing advertisements for others. Repair and installation of digital juke boxes and related accessories, namely, computer hardware and software, satellite, wire, cable or optical fiber telecommunication networks, disks, speakers, digital sound boards, touch screens, display monitors, mouse keyboards and computer cables. Telecommunication services, namely teleprocessing electronic data for the transfer of audio or video digital information,

maintenance information for remote maintenance, statistical information. Remote maintenance of computer software for others via a global computer network; monitoring services of digital jukeboxes; computer services, namely facilitating the downloading of songs, software and videos to be executed on the juke box or to any electronic device able to produce song or video by use of digital information; Providing and operating search engines for obtaining data on a global computer network and the Internet; Providing telecommunications connections to the Internet and databases; Providing computer databases in the nature of bulletin boards in the fields of music, video film, books, television, games and sports.

[3] The application is based on:

- use of the Mark in Canada since at least as early as November 2004 on goods and on services (1) ;
- proposed use of the Mark in Canada on services (2); and
- use and registration of the Mark in the United States of America on goods.

[4] 9105 alleges that the Mark is not registrable under section 12(1)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) and not distinctive under section 2 of the Act and that the Applicant is not the person entitled to registration of the Mark under sections 16(1)(a), (2)(a) and (3)(a) of the Act because the Mark is confusing with 9105's registered trade-mark SOL MAESTRO that has been previously used in Canada. 9105 further alleges that the Mark is not registrable under section 12(1)(b) of the Act because it is either clearly descriptive or deceptively misdescriptive in the English or French language, of the persons employed in the production of the Applicant's goods and services, and that the application for the Mark does not comply with the requirements of section 30 of the Act for a number of reasons.

[5] I find the main issue in this proceeding is whether the Mark is confusing with the trade-mark SOL MAESTRO as registered or used. As discussed later, the chain of title of the trade-mark SOL MAESTRO passed through several entities. Unless indicated otherwise, the term "Opponent" used throughout my decision refers to the owner of the trade-mark SOL MAESTRO at the relevant time.

[6] For the reasons explained below, I find that the application ought to be refused in part.

## The Record

[7] The statement of opposition was filed by the Opponent on October 29, 2012. The Applicant filed and served a counter statement on January 22, 2013 denying each of the grounds of opposition set out in the statement of opposition.

[8] As its evidence, the Opponent filed the solemn declaration of its founding president, secretary and principal shareholder Alain Charette, sworn May 21, 2013 (the Charette affidavit), and the solemn declarations of Caroline d'Amours and Sandro Romeo, trade-mark research-analysts employed by Thomson CompuMark, both sworn on April 29, 2013 (respectively the d'Amours solemn declaration and Romeo solemn declaration).

[9] In support of its application, the Applicant filed the affidavit of Jessica Rodrigues-Cerqueira, a paralegal employed by the agents for the Applicant, sworn September 18, 2013 (the Rodrigues-Cerqueira affidavit).

[10] None of the affiants was cross-examined.

[11] Only the Applicant filed a written argument. Only the Opponent was represented at a hearing.

## The parties' respective burden or onus

[12] The Opponent has the initial evidentiary burden to establish the facts alleged to support each ground of opposition. Once that burden is met, the legal burden or onus that the Mark is registrable remains on the Applicant, on a balance of probabilities [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

## Analysis

### Grounds of opposition summarily dismissed

[13] The Opponent conceded at the hearing that it has not met its evidentiary burden in respect of the sections 30(a), (b), (d), (e) and (i) grounds of opposition. Accordingly, I do not consider it

necessary to address these grounds of opposition and they are all summarily dismissed.

[14] The section 12(1)(b) ground of opposition is also summarily dismissed as a result of the Opponent's failure to meet its evidentiary burden. No evidence has been filed to support this ground of opposition and the Opponent made no representations with respect to this ground at the hearing.

#### Remaining grounds of opposition

##### The non-registrability ground of opposition

[15] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act in that it is confusing with the Opponent's trade-mark SOL MAESTRO registered under No. TMA584,000 in association with: [TRANSLATION] "pre-selected and updated music software intended for businesses."

[16] I have exercised the Registrar's discretion to confirm that this registration is in good standing as of today's date, which is the material date for assessing a section 12(1)(d) ground of opposition [see *Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[17] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's registered trade-mark.

##### The test for confusion

[18] 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.

[19] In applying the test for confusion, the Registrar must have regard to all the surrounding

circumstances, including those listed at 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 the trade-marks have 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. This list is not exhaustive and all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (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].

#### Consideration of the section 6(5) factors

##### The inherent distinctiveness of the trade-marks and the extent to which they have become known

[20] I assess the inherent distinctiveness of the parties' marks as about the same and relatively weak. The dictionary word "MAESTRO" (in both English and French) in the context of the parties' goods and/or services suggests a link with music as it refers to a distinguished musician, especially a conductor or performer. The same comment applies to the French dictionary word "SOL" which refers to the fifth note in the diatonic scale of C (in French "DO") major.

[21] The strength of a trade-mark may be increased by means of it becoming known through promotion or use.

[22] The Rodrigues-Cerqueira affidavit purports to provide evidence only with respect to the nature of the Applicant's goods and their corresponding channels of trade. I will return to that affidavit when assessing the sections 6(5)(c) and (d) factors. Suffice it to note at this point that the Rodrigues-Cerqueira affidavit is insufficient by itself to establish use of the Mark in Canada pursuant to section 4 of the Act and that the Mark has become known to any extent in Canada.

[23] In contrast, the Charette affidavit evidences that the Opponent's trade-mark SOL MAESTRO has been used in Canada by the Opponent and become known to some extent at

least, as per my review below of the salient points of this affidavit.

#### The Charette affidavit

[24] For the purpose of summarising the evidence contained in the Charette affidavit, I adopt most of the translation found in the Applicant's written argument.

[25] 9105 was founded on June 28, 2001 and has as its principal activity, the distribution of mood music, digital billboards and the dissemination of odors (olfactory) [paras 4 and 9 of the affidavit; Exhibit P-4].

[26] 9105 owns the SOL MAESTRO software for the broadcast of mood music. The trade-mark was duly registered on June 18, 2003, and is currently owned by 9105 [para 5 of the affidavit].

[27] Prior to becoming owned by 9105, the chain of title of the trade-mark SOL MAESTRO passed through several of Mr. Charette's companies. The history of these companies is explained in detail by Mr. Charette. Suffice it to say that Mr. Charette attests that the mergers of companies described by him were carried out for the purposes of a tax restructuring and to facilitate the management of different activities for each of his companies, namely the sale of telephone equipment for Solist Inc. (Solist) on the one hand, and the SOL MAESTRO software and ancillary services on the other hand [paras 6 to 8 of the affidavit; Exhibits P-1 to P-3].

[28] The SOL MAESTRO software was created in April 2001 under Mr. Charette's company which was Solist Solutions Technologiques Inc. (Solist Solutions) at the time. Sales of the SOL MAESTRO software began in 2001. The software functions by providing customers with access to blocks of mood music and monthly updates thereof. It permits customers to broadcast the mood music in their physical establishments and to manage such broadcasting [para 10 of the affidavit].

[29] In 2003, Solist Solutions also began offering services for the creation of an auditory environment and sound equipment, advertisements and waiting messages. The SOL MAESTRO software also permits the broadcast of advertisements and waiting messages and the management of such broadcast [para 11 of the affidavit].

[30] The trade-mark SOL MAESTRO was registered in the name of Solist Solutions. On July 8, 2004, the trade-mark was transferred to another of Mr. Charette's companies, namely Norwes Télécom Inc. (Norwes) but the copyright on the software remained with Solist Solutions. Following the merger of Norwes with Solist, both the trade-mark and the copyright on the software were transferred on November 1, 2008 to the resulting entity, Solist, which is currently Mr. Charette's main company [para 12 of the affidavit].

[31] Since the creation of the SOL MAESTRO software, sales have continued to grow steadily, so much so that Mr. Charette decided to split the revenues from telephony and those from the SOL MAESTRO software and ancillary services. Mr. Charette explains that it seemed to him necessary to distinguish between Solist and 9105 as the activities carried on by the two companies differ. Mr. Charette goes on to explain that he wanted to make a gradual transition from Solist to 9105, to enjoy the good reputation and the trust already established for Solist. Having established the trust of his clients, he transferred the trade-mark to 9105 on November 1, 2008 [paras 13 and 14 of the affidavit].

[32] However, the copyright on the software remained with Solist. Mr. Charette explains that this is the reason why some of the exhibits attached to his affidavit bear a copyright notice referring to either one of the trading styles of Solist, namely Technologies Solist and Solist Technologies or the mention "*un produit Solist Technologies*" [paras 6 and 14 of the affidavit].

[33] I shall indicate at this point of my analysis that, contrary to the Applicant's contention, the fact that one company owns the copyright in the software and another in the trade-mark is not in itself problematic. Mr. Charette attests that the necessary cross-licenses have always been in place. Concerning more particularly the use under licence of the trade-mark SOL MAESTRO, Mr. Charette expressly attests that as president and sole shareholder of both Solist and 9105, he has always controlled the character and quality of the goods offered for sale and ancillary services performed in association with the mark by Solist. The same attestation is made with respect to the use of the trade-mark SOL MAESTRO by Solist Solutions as former licensee of Norwes during the years 2004 to 2008 [paras 15, 42 and 43 of the affidavit]. Under the circumstances, I am satisfied that the licenced use of the trade-mark SOL MAESTRO has always benefited the Opponent, the whole as per the provisions of section 50 of the Act [see *Petro-*

*Canada v 2946661 Canada Inc* 1998 CanLII 9107 (FC)].

[34] Since the creation of the software, the Opponent achieved net sales of slightly more than \$110,000 at October 31, 2003, the end of its fiscal year, to exceed half a million since 2007 [para 16 of the affidavit]. Mr. Charette attests that the software and ancillary services associated with the trade-mark SOL MAESTRO have been the subject of regular sales since at least June 4, 2003, as per the random sampling of invoices attached as Exhibit P-14 [paras 40 to 46]. Upon review of these invoices, I note that they were mostly issued to customers located in the province of Quebec, except for a few customers located in Toronto, Ontario. In addition to showing sales of the Opponent's software, they also show sales of the ancillary services associated with the trade-mark SOL MAESTRO dating back to 2003 until 2013.

[35] The Opponent retained the services of marketing experts to develop advertising tools for the software SOL MAESTRO. These include the Opponent's website at *www.solmaestro.ca*, a presentation and a presentation folder, teasers, price lists, outdoor signage, etc. Since the creation of the software, this advertising has also been made through Solist, which has more than 1,500 business customers. Furthermore, the Opponent hired salespeople in order to accelerate the growth of the Opponent's clientele [paras 17 to 23 of the affidavit; Exhibits P-5 to P-7]. Upon review of the material attached under Exhibits P-5 to P-7, I note that in addition to promoting and advertising the Opponent's software, they also describe the ancillary services associated with the trade-mark SOL MAESTRO.

[36] For the years 2009 and 2010, the Opponent spent at least \$50,000 per year in advertising the trade-mark SOL MAESTRO, which amount corresponds to the annual salary paid for the years 2008 to 2010 to the Opponent's former marketing director. Thereafter, the Opponent's marketing expenses focused on updating and bringing some changes to the work done by its former marketing director [para 25 of the affidavit].

[37] The Opponent has a varied clientele composed of private companies [para 26 of the affidavit]. I will return to that point when assessing the nature of the goods and services, and their corresponding channels of trade under the section 6(5)(c) and (d) factors.

[38] The Opponent's clients can obtain the software by buying it or renting it. I will also



return to that point when assessing the nature of the goods and services, and their corresponding channels of trade under the section 6(5)(c) and (d) factors.

[39] The trade-mark SOL MAESTRO is clearly displayed on the computer within which the software is installed, and which is remitted to the client [para 32 of the affidavit; Exhibit P-10]. It is also displayed on the computer screen when opening the software, on the setting page and on the wallpaper page that appear on the computer [paras 33 and 37 of the affidavit; Exhibits P-11 to P-13].

[40] The trade-mark SOL MAESTRO has been used consistently and has evolved over the years. At the beginning and until 2006, the trade-mark was depicted as follows [para 28 of the affidavit; Exhibit P-8]:



[41] Since the year 2006, the trade-mark SOL MAESTRO has been depicted as follows [para 29 of the affidavit, Exhibit P-9]:



[42] I shall indicate at this point of my analysis that, contrary to the Applicant's contention, I find that the manners in which the trade-mark is depicted above constitute use of the word mark SOL MAESTRO. The phrases "*L'ambiance musicale sur mesure*" and "*L'ambiance sensorielle*" are inconsequential. The trade-mark SOL MAESTRO has not lost its identity and remains recognizable [see *Canada (Registrar of Trade-marks) v Cie Internationale pour l'informatique CII Honeywell Bull, SA* (1985), CPR (3d) 523 (FCA)]. The phrases "*L'ambiance musicale sur mesure*" and "*L'ambiance sensorielle*" can both be perceived as descriptive matter or perhaps as slogans [see *Stikeman Elliott LLP v 9105-8503 Québec Inc* (2014) TMOB 95].

[43] To sum up, I am satisfied from my review of the Charette affidavit that the SOL MAESTRO trade-mark has become known to a certain extent in Canada, particularly in the province of Quebec where most of the Opponent's sales have been made.

[44] The overall consideration of this first factor, which is a combination of inherent distinctiveness and acquired distinctiveness, thus favours the Opponent.

The length of time the trade-marks have been in use

[45] As per my comments above, this factor also favours the Opponent.

The nature of the goods, services or business; and the nature of the trade

[46] When considering the nature of the goods and the nature of the trade, I must compare the Applicant's statement of goods and services with the statement of goods in the registration referred to by the Opponent [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)]. However, 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. The evidence of the parties' actual trades is useful in this respect [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); and *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[47] This brings me to consider the parties' evidence on this issue.

#### The Rodrigues-Cerqueira affidavit

[48] As indicated above, the Rodrigues-Cerqueira affidavit purports to provide evidence with respect to the nature of some of the Applicant's goods and their corresponding channels of trade.

[49] Ms. Rodrigues-Cerqueira attaches to her affidavit as Exhibits JRC-2 and JRC-3 respectively, copies of the "Parts and Service Manual" and "Quick Start Guide" for the Applicant's jukebox device that is allegedly sold in association with the Mark in Canada. She further attaches as Exhibit JRC-4 copies of the printouts resulting from a search that she conducted on September 11, 2013 using the search engine Google to locate web sites allegedly selling the Applicant's jukebox device and other accessories in association with the Mark.

[50] According to these exhibits, the Applicant's digital jukeboxes and related equipment would consist of stand-alone machines which allow end-users to choose individual songs "on-demand" from a playlist of songs upon payment of a fee.

#### The Charette affidavit

[51] For the purpose of summarising the evidence contained in the Charette affidavit, I adopt again most of the translation found in the Applicant's written argument.

[52] The Opponent's clients can obtain the SOL MAESTRO software by buying it or renting it [para 31 of the affidavit].

[53] When a client buys the software, he must obtain a computer that will be exclusively dedicated for the use of the software and which he sends to the Opponent for installation of the software, following which the computer is returned to the client. When a client rents the software, the software is pre-installed on a computer that is rented to the client for the duration of the contract [para 31 of the affidavit].

[54] The sale/renting of the software is conducted through the issuance of a contract with a determined duration for accessing the music. The contract provides for the purchase or rental of the SOL MAESTRO software and its installation, following which the customer has access to blocks of music through the use of an encrypted key. In general, customers subscribe for a 36-month period and are billed on a monthly or annual basis. At the end of the rental, the customer must return the computer and its contents to the Opponent. If the software has been purchased, the client can continue to use the software for the broadcast of messages [para 34 of the affidavit].

[55] The blocks of music are updated on a monthly basis and customers automatically have access to these updates [para 35 of the affidavit].

[56] In addition to permitting access to music, the software permits customers to access different functions to manage the broadcasting of the music according to a calendar, to select the music and the broadcast order, make adjustments and generate reports [para 36 of the affidavit; Exhibit P-12].

[57] The software is a separate product that the customer must procure to access the music and to manage its broadcasting. Without the software, the customer would be incapable of accessing blocks of music, to broadcast same and to manage such broadcasting [para 38 of the affidavit].

[58] The Opponent's clientele includes financial institutions, sport centers, retail stores, shopping centers, spas, entertainment and/or amusement centers (pool halls and bowling centers), hotels, residences, clinics, restaurants, bars and auto dealers [para 26 of the affidavit].

#### The parties' submissions

[59] The Applicant submits that nothing in the Opponent's evidence demonstrates that the

goods and services of the Opponent are identical or sufficiently similar to those of the Applicant so as to create a likelihood of confusion between each party's respective marks.

[60] The Applicant submits that it is clear from the Opponent's evidence that it is providing in association with its trade-mark SOL MAESTRO a subscription-based service for a software that is designed to play continuous background music in relevant settings. The purpose of this software and service is to create an auditory ambiance in a given setting. The end user never selects the music that is playing; rather it is controlled by the establishment operating the software. Moreover, the establishment chooses a genre of music to be played and not individual music or set lists.

[61] The Applicant submits that the goods and services sold in association with the Mark relate to digital jukeboxes and related equipment that are stand-alone machines which are sold as individual units rather than on a subscription basis like the Opponent's offerings. Furthermore, it submits that the function and operation of its products are entirely different from those of the Opponent in that the Applicant's digital jukebox and related equipment is designed to serve an entertainment function and is operated by end users who select through the jukebox itself individual songs on a per song basis whereas the Opponent's system plays pre-recorded continuous background mood music.

[62] Turning to the nature of the trade, the Applicant's submits that establishments subscribing to the Opponent's system require mood music to create a mood within the establishment. It submits that, as a result, such establishments require continuous preselected music to be played without much, if any, intervention from the establishment. The establishments pay a monthly subscription for this service.

[63] The Applicant submits that its digital jukeboxes and related equipment are intended for establishments that wish to have their customers select individual songs from a list of songs on an "on demand" basis whereby the customers will pay money for each song selected. There is no monthly subscription to be paid.

[64] Accordingly, the Applicant submits that it is clear that the nature of the trade through which the goods and services associated with each party's mark is sold or proposed to be sold is

also extremely different and distinct from one another such that there is no overlap between the two.

[65] The Opponent submits for its part that there is an obvious overlap between the Applicant's statement of goods and services and that of the Opponent. In all cases, it consists of a means for a business to play music.

[66] The Opponent further submits that as pointed out by Mr. Charette at paragraph 27 of his affidavit, many of the Opponent's customers could very well be target customers for the Applicant's jukeboxes. This is particularly so for resto-bars, resto-pubs, breweries, sport centers, pool halls and bowling centers, and other entertainment and/or amusement centers. I agree.

[67] In the absence of evidence to the contrary, there is no reason to conclude that the parties' goods and/or services would not travel through the same channels of trade and be directed to the same types of clientele.

[68] Also, while I agree with the Applicant that the parties' goods differ in their exact nature, I find that there is a relationship between them to the extent that the parties' goods both relate to a means for a business to play music.

[69] Likewise, I find that there is a relationship between the Applicant's services (1) and the Opponent's software. As indicated above, the SOL MAESTRO software provides its customers with monthly updates.

[70] To the extent that the services (2) relate to the Applicant's jukeboxes and related equipment, I find it reasonable to conclude that there is a relationship between them and the Opponent's software. Accordingly, I find it may reasonably be concluded to a relationship between the following services listed in the application for the Mark and the Opponent's software:

Repair and installation of digital juke boxes and related accessories, namely, computer hardware and software, satellite, wire, cable or optical fiber telecommunication networks, disks, speakers, digital sound boards, touch screens, display monitors, mouse keyboards and computer cables. [...] monitoring services of digital jukeboxes; computer services, namely facilitating the downloading of songs, software and videos to be executed on the juke box or to any electronic device able to produce song or video by use of digital

information; Providing computer databases in the nature of bulletin boards in the field of music.

[71] However, I conclude that the following services listed in the application for the Mark differ substantially from the Opponent's software, as described in the Opponent's registration:

Advertising services, namely advertising of messages for others, preparing advertisements for others. Telecommunication services, namely teleprocessing electronic data for the transfer of audio or video digital information, maintenance information for remote maintenance, statistical information. Remote maintenance of computer software for others via a global computer network; Providing and operating search engines for obtaining data on a global computer network and the Internet; Providing telecommunications connections to the Internet and databases; Providing computer databases in the nature of bulletin boards in the fields of video film, books, television, games and sports.

The degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[72] There is a fair degree of resemblance between the parties' marks in appearance, sound and in the ideas suggested by them. The Mark is included in its entirety in the Opponent's trade-mark SOL MAESTRO. Their only difference consists of the first portion of the Opponent's trade-mark, namely the word "SOL" that is missing in the Mark.

[73] While it is true that the first word or portion of a trade-mark is generally the most important for the purpose of distinction, the preferable approach is to first consider whether any aspect of the trade-mark is particularly striking or unique [see *Masterpiece*, above, at paragraph 64]. In the present case, I do not believe that the French word "SOL" dominates the Opponent's trade-mark given that the word "MAESTRO" evokes a more complex idea than that of a music note. At the utmost, it is equally dominant with the word "MAESTRO". Still, the idea conveyed by each of the parties' marks in the context of their associated goods and/or services is that of musical direction.

Additional surrounding circumstances

[74] The Opponent filed, through the solemn declarations of Ms. d'Amours and Mr. Romeo, the results of a "dilution search" that each of them conducted for the mark "MAESTRO".

[75] Neither the Applicant nor the Opponent made any submissions with respect to this evidence. Moreover, after I specifically asked the Opponent at the hearing what it was trying to establish through this evidence, the Opponent indicated that the d'Amours and Romeo solemn declarations could simply be disregarded. It indicated that this evidence was irrelevant and had no effect on the outcome of the present case.

[76] In the circumstances, I conclude that there are no additional circumstances to consider.

#### Conclusion regarding the likelihood of confusion

[77] In view of my analysis above, and except for the services described below in paragraph 79, I arrive at the conclusion that the probabilities of confusion between the marks at issue are evenly balanced between a finding of confusion and of no confusion. In reaching this conclusion, I have had special regard to the following facts: i) the Mark is included in its entirety in the Opponent's trade-mark and there is a fair degree of resemblance between the marks in appearance and sound and in the ideas suggested by them; ii) only the Opponent's mark has been used or acquired any reputation; iii) despite the differences existing in the exact nature of the parties' goods and/or services, both marks are for use with goods and/or services that relate to a means for a business to play music and could be directed to the same types of clientele.

[78] As the legal burden is on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion, the section 12(1)(d) ground of opposition succeeds, except for the services described below in paragraph 79.

[79] However, I am satisfied that the Applicant has discharged its legal onus of establishing that there is no reasonable likelihood of confusion between the Mark in association with the following services and the Opponent's software, as these services differ substantially from the Opponent's software, as described in the Opponent's registration:

Advertising services, namely advertising of messages for others, preparing advertisements for others. Telecommunication services, namely teleprocessing electronic data for the transfer of audio or video digital information, maintenance information for remote maintenance, statistical information. Remote maintenance of computer software for others via a global computer network; Providing and operating search engines for obtaining data on a global computer network and the Internet; Providing telecommunications connections



to the Internet and databases; Providing computer databases in the nature of bulletin boards in the fields of video film, books, television, games and sports.

[80] Accordingly, the section 12(1)(d) ground of opposition succeeds partially.

The non-entitlement grounds of opposition

[81] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark within the meaning of sections 16(1)(a), (2)(a) and (3)(a) of the Act in that at the claimed date of first use of the Mark and the date of filing of the Applicant's application (in this case, the priority date of May 3, 2006), as the case may be, the Mark was confusing with the trade-mark SOL MAESTRO that had been previously used by the Opponent and/or its predecessors in title in Canada, since at least as early as June 4, 2003 in association with the goods covered by registration No. TMA 584,000 as well as the following services:

- creating sound atmosphere and sound system, namely: design services of sound spaces, identifying strategic locations where to install the speakers to create sound atmosphere; installation of speakers according to plans drawn up by the Opponent or according to customer specifications;
- advertising, namely: creation of audio messages according to customer specifications; audio messages recording services according to customer specifications; commercials broadcast services according to customer specifications; and
- waiting messages, namely: waiting messages design services according to customer specifications; waiting messages recording services according to customer specifications; waiting messages broadcast services according to customer specifications.

[82] An opponent meets its evidentiary burden with respect to a section 16(1)(a), (2)(a) or (3)(a) ground if it shows that as of the date of first use claimed in the applicant's application or the date of filing of the applicant's application, as the case may be, its trade-mark had been previously used in Canada and had not been abandoned as of the date of advertisement of the applicant's application. As per my review above of the Charette affidavit, the Opponent has met its evidentiary burden.

[83] The difference in relevant dates does not substantially affect my analysis above under the section 12(1)(d) ground of opposition. However, the evidence of use of the trade-mark SOL MAESTRO with the Opponent's above-described services, in addition to that with the registered goods, does.

[84] Indeed, I find it may reasonably be concluded that there is a relationship between the Applicant's applied for services described as "Advertising services, namely advertising of messages for others, preparing advertisements for others" and the Opponent's advertising services.

[85] The non-entitlement grounds of opposition therefore succeed partially with respect to the following goods and services:

Goods

Music selection systems comprising speakers, digital jukeboxes and touch screens/buttons for distributing, selecting and playing audio and video musical information; musical jukeboxes; music servers; and jukebox systems, namely, one or more musical jukeboxes connected electronically to select, download and play music contents and parts thereof.

Services

(1) Providing service updates of musical sound recordings, music files, album artwork by electronic means from a computer database.

(2) Advertising services, namely advertising of messages for others, preparing advertisements for others. Repair and installation of digital juke boxes and related accessories, namely, computer hardware and software, satellite, wire, cable or optical fiber telecommunication networks, disks, speakers, digital sound boards, touch screens, display monitors, mouse keyboards and computer cables. [...] monitoring services of digital jukeboxes; computer services, namely facilitating the downloading of songs, software and videos to be executed on the juke box or to any electronic device able to produce song or video by use of digital information; Providing computer databases in the nature of bulletin boards in the field of music.

The non-distinctiveness ground of opposition

[86] The Opponent has pleaded that the Mark is not distinctive, within the meaning of section 2 of the Act, in that it does not distinguish, nor is it adapted to distinguish the goods and services of the Applicant from the goods and services of the Opponent.

[87] An opponent meets its evidentiary burden with respect to a distinctiveness ground if it

shows that as of the filing date of the opposition (in this case October 29, 2012) its trade-mark had become known to some extent at least to negate the distinctiveness of the applied-for mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)]. As per my review above of the Charette affidavit, the Opponent has met its evidentiary burden.

[88] The difference in relevant dates does not substantially affect my analysis above under the non-entitlement grounds of opposition.

[89] The non-distinctiveness ground of opposition therefore succeeds partially with respect to the following goods and services:

#### Goods

Music selection systems comprising speakers, digital jukeboxes and touch screens/buttons for distributing, selecting and playing audio and video musical information; musical jukeboxes; music servers; and jukebox systems, namely, one or more musical jukeboxes connected electronically to select, download and play music contents and parts thereof.

#### Services

(1) Providing service updates of musical sound recordings, music files, album artwork by electronic means from a computer database.

(2) Advertising services, namely advertising of messages for others, preparing advertisements for others. Repair and installation of digital juke boxes and related accessories, namely, computer hardware and software, satellite, wire, cable or optical fiber telecommunication networks, disks, speakers, digital sound boards, touch screens, display monitors, mouse keyboards and computer cables. [...] monitoring services of digital jukeboxes; computer services, namely facilitating the downloading of songs, software and videos to be executed on the juke box or to any electronic device able to produce song or video by use of digital information; Providing computer databases in the nature of bulletin boards in the field of music.

#### Disposition

[90] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application under section 38(8) of the Act for the following goods and services:

#### Goods

Music selection systems comprising speakers, digital jukeboxes and touch screens/buttons for distributing, selecting and playing audio and video musical information; musical jukeboxes; music servers; and jukebox systems, namely, one or more musical jukeboxes connected electronically to select, download and play music contents and parts thereof.

### Services

(1) Providing service updates of musical sound recordings, music files, album artwork by electronic means from a computer database.

(2) Advertising services, namely advertising of messages for others, preparing advertisements for others. Repair and installation of digital juke boxes and related accessories, namely, computer hardware and software, satellite, wire, cable or optical fiber telecommunication networks, disks, speakers, digital sound boards, touch screens, display monitors, mouse keyboards and computer cables. [...] monitoring services of digital jukeboxes; computer services, namely facilitating the downloading of songs, software and videos to be executed on the juke box or to any electronic device able to produce song or video by use of digital information; Providing computer databases in the nature of bulletin boards in the field of music.

[91] However, I reject the opposition under section 38(8) of the Act for the following services:

(2) Telecommunication services, namely teleprocessing electronic data for the transfer of audio or video digital information, maintenance information for remote maintenance, statistical information. Remote maintenance of computer software for others via a global computer network; Providing and operating search engines for obtaining data on a global computer network and the Internet; Providing telecommunications connections to the Internet and databases; Providing computer databases in the nature of bulletin boards in the fields of video film, books, television, games and sports.

[See *Produits Menager Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (FCTD) as authority for a split decision].

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Annie Robitaille  
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Trade-marks Opposition Board  
Canadian Intellectual Property Office