



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

Citation: 2010 TMOB 61
Date of Decision: 2010-05-06

**IN THE MATTER OF AN OPPOSITION
by Solo Branding Inc./Solo Stratégie de
Marque Inc. to application No. 1,081,998
for the trade-mark GOSOLO in the name
of Go Solo Technologies, Inc.**

The Pleadings

[1] On November 9, 2000 Go Solo Technologies, Inc. (the Applicant) filed an application to register the trade-mark GOSOLO, application number 1,081,998 (the Mark), based on proposed use in Canada in association with :

telecommunication services provided through a proprietary network-based platform, namely, electronic transmission of voice and audio data, facsimile, electronic mail, voice mail, cross-media messaging, video teleconferencing and broadcasting and customized user information via computer and telephonic interfaces and gateway services; news analysis and feature distribution and customized user information retrieval and delivery services over local and global computer networks (the “Services”)

[2] The application was advertised on July 20, 2005 in the *Trade-marks Journal* for opposition purposes. Solo Branding Inc./Solo Stratégie de Marque Inc. (Solo) filed a statement of opposition on October 7, 2005 which was forwarded by the Registrar on November 8, 2005 to the Applicant. The Applicant filed a counter statement on December 6, 2005 denying in essence all grounds of opposition listed below. The Opponent sought leave twice to amend its statement of opposition to reflect the change in ownership of the registered trade-marks referred in the

statement of opposition. Following those amendments the opponent is presently Bell Mobility Inc./Bell Mobilité Inc. (Bell). I shall refer to Solo and/or Bell and/or their predecessors in title indistinctively as the Opponent.

[3] The Opponent filed as its evidence certificates of authenticity for the registrations TMA328791 for the trade-mark SOLO and TMA561274 for the trade-mark SOLO and the affidavits of Josiane Bouinot and Floyd Rocha while the Applicant filed the affidavit of Frederick A. Burris. None of the deponents were cross-examined.

[4] Both parties filed written arguments and were represented at an oral hearing.

The Grounds of Opposition

[5] The grounds of opposition pleaded are:

1. The Application does not comply with the requirements of s. 30 of the Trade-marks Act, R.S.C. 1985 c. T-13 (the Act) in that the Applicant has already used the Mark or alternatively or cumulatively the Applicant never had the intention to use the Mark in Canada;

2. The Application does not comply with the requirements of s. 30 of the Act in that it is falsely that the Applicant declared itself satisfied that it was entitled to use the Mark in Canada in view of the foregoing including its knowledge of the Opponent's rights and the unlawfulness of said use;

3. The Application does not comply with the requirements of s. 30(a) of the Act as it does not contain a statement in ordinary commercial terms of the specific wares and services in association with which the Mark would be proposed to be used, the terms "cross-media messaging" and "news analysis and feature distribution" not having, in the context of the opposed application, the degree of specificity required by the Act;

4. The Mark is not registrable under s. 12(1)(d) of the Act as it is confusing with the Opponent's registered trade-marks:

SOLO, registration TMA328,791 for telephone sets;
SOLO, registration TMA561,274 for prepaid calling cards and wireless telecommunication services.

5. The Applicant is not the person entitled to registration of the Mark pursuant to the provisions of s. 38(2)(c) and 16(3)(a) of the Act because at the filing date of the

application, the Mark was confusing with the trade-mark SOLO previously used or made known in Canada by the Opponent or its predecessors in title in association with telecommunication apparatus;

6. The Applicant is not the person entitled to registration of the Mark pursuant to the provisions of s. 38(2)(c) and 16(3)(b) of the Act because at the filing date of the application, the Mark was confusing with the trade-mark SOLO for which an application, number 1,026,518, had been previously filed in Canada;

7. For the reasons above stated, the Applicant is not the person entitled to the registration of the Mark since the opposed application does not comply with the requirements of the s. 30 of the Act and that the Mark is not registrable, accordingly the application should be refused pursuant to the introductory paragraph of s. 16(3) of the Act;

8. Pursuant to s. 38(2)(d) and s. 2 of the Act, the Mark is not distinctive of the Services nor is it adapted to distinguish them from those of others , including the Opponent since:

i) In view of the Opponent's use by itself or by its predecessors, or for their benefit by their respective licensees of the trade-mark SOLO in the telecommunication field;

ii) The Mark is used outside the scope of the licensed use provided for by s. 50 of the Act;

iii) As a result of the transfer of the Mark rights subsist in two or more persons to the use of trade-marks confusing with the Mark and those rights were exercised by those persons, contrary to s. 48(2) of the Act.

Burden of Proof in Trade-marks Opposition Proceedings

[6] The legal burden is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential onus 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. Once this initial onus is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325; *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company* [2005] F.C. 722].

Disposition of Certain Grounds of Opposition

[7] There is no evidence in the file to support the fact that the Applicant would have used the Mark prior to the filing date of the application or alternatively or cumulatively that the Applicant never had the intention to use the Mark. Consequently the first ground of opposition is dismissed.

[8] All that is required from an applicant under s. 30(i) of the Act is to provide a statement that it is satisfied that it is entitled to use the trade-mark applied for in Canada in association with the wares and services described in the application. The application filed does contain such statement. A s. 30(i) ground of opposition should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 at 155]. Therefore the second ground of opposition is dismissed.

[9] There is also no evidence in the file to support the contention that the terms “cross-media messaging” and “news analysis and feature distribution” do not have the degree of specificity required by the Act. Therefore the third ground of opposition is dismissed.

[10] In order to be successful under the sixth ground of opposition, the Opponent had to establish that it was the owner of application 1,026,518 and such application was pending at the date when the present application was advertised, namely on July 20, 2005. The certificate of authenticity filed for registration TMA561274 for the trade-mark SOLO shows that it corresponds to application number 1,026,518, filed on August 23, 1999. Such application matured to registration on May 2, 2002 and therefore it was no longer pending at the advertisement date, as required by s. 16(4) of the Act. Consequently the sixth ground of opposition is also dismissed [see *Hudson's Bay Co. v. Kmart Canada Ltd./Kmart Canada Limitée* (1997), 76 C.P.R. (3d)526].

[11] As for the seventh ground of opposition the Opponent repeats its compliance and registrability grounds of opposition. Section 16 of the Act defines what is known as the non-entitlement ground of opposition. Its introductory paragraph by itself does not define a ground of opposition by which non-compliance and registrability could be raised. Those grounds of

opposition are covered specifically in other sections of the Act. The seventh ground of opposition is dismissed.

Registrability of the Mark under s. 12(1)(d)

[12] The relevant date for the analysis of a ground of opposition based on s. 12(1)(d) of the Act is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424].

[13] The Opponent has met its initial burden by filing certificates of authenticity for its registrations TMA328791 for the trade-mark SOLO covering telephone sets and TMA561274 for the trade-mark SOLO covering prepaid calling cards and wireless telecommunication services namely prepaid wireless telecommunications, voice and data communications by prepaid calling cards, by cellular telephones, by digital telephones, by facsimile transmission, by cable television transmission, by telegram transmission, electronic transmission of data and documents via terminals, namely electronic mail services, recordal, storage and subsequent delivery of voice messages by telephone (the Opponent's services). Those registrations are still in good standing. Therefore I must determine if there is, on a balance of probabilities, a likelihood of confusion between the Mark and the Opponent's registered trade-marks SOLO. If the answer is affirmative then the Mark cannot be registered.

[14] The Opponent's strongest case under this ground of opposition is with registration TMA561274. The Opponent's registrations are for the same trade-mark but the services covered by registration TMA561274 are more relevant than the wares covered by the other registration. Therefore if the Opponent is not successful under this ground of opposition with registration TMA561274, it would not achieve a better result with registration TMA328791.

[15] The test to decide if there is a likelihood of confusion is set out in s. 6(2) of the Act wherein it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would likely lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. In making such assessment I must take into consideration all the relevant surrounding circumstances,

including those listed in s. 6(5) of the Act: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have 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 or trade-names in appearance, or sound or in the ideas suggested by them. I refer to the decision of the Supreme Court of Canada in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 for an analysis of those criteria.

[16] The Applicant did not address the issue of inherent distinctiveness in its written argument nor during the oral hearing. The Opponent takes the position in its written argument that the parties' trade-marks have about the same degree of inherent distinctiveness in light of the "great similarity" between them. I will discuss later on the similarities between the marks but at this stage I am inclined to say that the Mark, being a coined word, is more inherently distinctive than the Opponent's trade-mark SOLO.

[17] I must determine if one trade-mark was more known than the other at the relevant date (date of my decision). A trade-mark will become known in Canada through use or extensive promotion.

[18] The Applicant's application is based on proposed use. However there is some evidence of use in Canada since the filing date of the application that can be summarized as follows. Mr. Burris is the Chief Financial Officer of GoSolutions Inc and its wholly owned subsidiaries, the Applicant and GoSolutions Canada, Inc. In his affidavit he is referring to them collectively as "the Company". Any ambiguities resulting from the use of that term should be interpreted against the Applicant.

[19] He alleges that the Applicant has provided the Services in Canada since September 2001 through its interactive website located at www.gosolo.com.

[20] To support such allegation the deponent has filed the following exhibits:

A completed order form from a Canadian subscriber dated September 4, 2001;

Extracts of the website describing the various services offered in association with the Mark;

Various sample forms available online (exhibit C to his affidavit).

[21] He alleges that the Applicant has approximately 8,480 subscribers in Canada who use the Services in association with the Mark. Those services can be best described as offering a virtual office space. The subscriber will have access to amongst other, a telephone line, voicemail, email, faxes, audio and web conferencing.

[22] This evidence does not enable me to measure to what extent, if any, the Mark is known in Canada. The number of Canadian's subscribers since 2001, compared to the entire Canadian population, appears to be quite low. We have no information on the number of Canadians who visited the Applicant's website. We have no information if the documentation filed as exhibit C has been available on the Applicant's website since 2001 and if so how many Canadians saw those forms.

[23] Mr. Rocha is the Associate Director-Youth Segment- for Bell and has been employed by Bell since April 2000. He states that Solo granted to Bell a license to use the SOLO trade-marks and he filed pertinent extracts of the License Agreement effective July 1, 2005. As stated above, Bell is the current registered owner of the trade-mark SOLO, certificate of registration TMA561274.

[24] In paragraphs 10 and 11 of his affidavit, Mr. Rocha alleges use of the trade-mark SOLO in association with the Opponent's services. To substantiate such allegation Mr. Rocha has filed: a folded card used to package the prepaid calling cards sold in association with the trade-mark SOLO (exhibit D-1); various pamphlets advertising prepaid wireless telecommunication services by way of prepaid cellular phones (exhibit D-3) distributed in ESPACE BELL and BELL WORLD stores; an advertisement illustrating the packaging used to sell wireless telecommunication services in association with the trade-mark SOLO that includes a cellular phone and a prepaid calling card (exhibit D-2); samples of advertisements (exhibit F) also distributed in ESPACE BELL and BELL WORLD stores to promote the sale of the Opponent's services in association with the trade-mark SOLO. He also filed samples of brochures, pamphlets, prepaid card holders and other promotional and advertising material (exhibit G) used by the Opponent as far back as late 2000, and in 2001, 2002, 2003, 2004 and 2005 to advertise the Opponent's services in association with the trade-mark SOLO. We do not know the extent of

their distribution but I accept the fact that some of the material was used by the Opponent in its ESPACE BELL and BELL WORLD stores between December 2000 (as some of the material filed as exhibit D does refer to such date) and 2005.

[25] Mr. Rocha also filed samples of invoices and contracts (exhibit H) showing payment for the Opponent's services in association with the trade-mark SOLO. He provides an approximation of the sales figures for the year 2005 in the amount of \$6 million for products and services in association with the trade-mark SOLO. He provides an estimate of \$69 million for the sales figures for the year 2006. These figures have not been challenged through cross-examination. He also gives the yearly advertising and promotion expenditures for the Opponent's products and services for the period between 2000 and 2005 that total more than \$38 million.

[26] The Applicant has emphasized in its written argument and at the oral hearing that the material filed illustrates cellular phones and not telephone sets. They also bear third party's trade-marks. As stated earlier I am focusing my analysis on the Opponent's services and not the wares listed under registration TMA328791. In any event it is obvious from a reading of the promotional material filed that the Opponent is offering a package that includes a cellular phone (bearing a third party trade-mark) to be used for wireless telecommunications services offered by the Opponent in association with the trade-mark SOLO.

[27] From this evidence I conclude that the Opponent's trade-mark SOLO was known in Canada in association with the Opponent's services as of the relevant date. Overall the first factor enumerated under s. 6(5) of the Act favours the Opponent.

[28] As for the length of time the trade-marks have been in use, as it appears from the evidence detailed above, this factor also favours the Opponent. It has used the trade-mark SOLO since at least December 2000 in association with the Opponent's services while the Applicant began using the Mark in September 2001.

[29] A good portion of the Applicant's argument focuses on the nature of the Services versus the Opponent's wares. As noted above, I have chosen to consider the issue of confusion under this ground between the Opponent's SOLO registration No. TMA561,274 and the Applicant's Mark. The comparison therefore is between the Services as described in the Applicant's

application and the services listed in the Opponent's certificate of registration TMA561274 [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 at 10-11; *Henkel Kommadnitgellschaft v. Super Dragon* (1986), 12 C.P.R. (3d) 110 at 112 and *Miss Universe Inc. v. Dale Bohna* (1994), 58 C.P.R. (3d) 381 at 390-392].

[30] At the oral hearing the Applicant's agent characterized the Services as a virtual office. This does not avoid the fact that the Services, as defined in the application, are telecommunication services via telephonic interfaces amongst others. The Opponent's registration covers wireless telecommunications. Both parties are carrying on business in the same general industry. Consequently the third and fourth relevant factors listed under s. 6(5) of the Act favour the Opponent.

[31] The degree of resemblance between two trade-marks is one of the most important criteria when assessing the likelihood of confusion between them [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145]. One must look at the marks in their totalities and should not dissect each one of them into its components.

[32] The Applicant argues that the marks are distinguishable because of the inclusion of the word "go" as the first syllable of the Mark. However the Mark does include the entirety of the Opponent's trade-mark SOLO. The marks do resemble each other visually and orally. The addition of the word "go" puts the emphasis on the word "solo". It encourages the switch to "solo" or to act alone. Therefore I do not think that there is a major difference in the ideas suggested by the marks in issue.

[33] As an additional surrounding circumstance Mr. Buris alleges that, to his knowledge and belief, there has been no issue raised relative to confusion in the Canadian marketplace between the use of the Mark by the Applicant in association with the Services and the use of the trade-mark SOLO by the Opponent. In *Mattel* supra the Supreme Court of Canada has clearly indicated that the absence of instances of confusion is a relevant factor to be considered.

[34] Mr. Buris does not provide any information as to the actions he took before making such statement. Has he given any instructions to his staff to report to him any complaint from a Canadian customer? Has he made inquiries within his staff? Moreover despite the concurrent use

of the parties' trade-marks over a nine year period, the absence of clear evidence of instances of confusion can be easily explained by the fact that according to the evidence filed there has been very limited use of the Mark in Canada by the Applicant.

[35] There have been no other relevant factors raised by either side. I review the affidavit of Josianne Bouinot, a trade-mark agent that was involved in the management of Solo's trade-marks and domain names. She filed extracts of the Applicant's website dated June 20, 2006 but I failed to see how those extracts would enhance the Opponent's case. Finally neither in its written argument nor during the oral hearing did the Opponent refer to the content of this affidavit.

[36] From this analysis I conclude that the Applicant failed to discharge its burden to prove, on a balance of probabilities, that the Mark is not likely to cause confusion with the Opponent's registered trade-mark SOLO. I reach this conclusion based on the fact that the parties' services are in the same general class, the Opponent's trade-mark SOLO is known in Canada in association with telecommunication services and the trade-marks do resemble one another. The fourth ground of opposition is maintained.

Entitlement Ground of Opposition Based on s. 16(3)(a) of the Act

[37] The relevant date associated with this ground of opposition, when the application is based on proposed use, is the filing date of the application (November 9, 2000) [see s. 16(3) of the Act]. Moreover the Opponent must show that it had not abandoned such use at the advertisement date of the application (July 20, 2005) [see 16(5) of the Act]. Therefore the Opponent has an initial evidential burden to prove that it has used its trade-mark(s) prior to November 9, 2000.

[38] In his affidavit Mr. Rocha does state that the trade-mark SOLO has been used in association with the Opponent's Services since late 1999 and 2000 by one of the Opponent's predecessors in title. However the only documents filed to substantiate that assertion are advertisements with no date, except for one of them where reference is made to an offer expiring on December 31, 2000. We have no information that this offer was available to Canadian consumers prior to November 9, 2000.

[39] I conclude that the Opponent failed to meet its initial onus and therefore the fifth ground of opposition is dismissed.

Distinctiveness

[40] The relevant date with respect to this ground of opposition is the filing date of the statement of opposition (October 7, 2005) [see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317]. As for the first portion of the eighth ground of opposition the Opponent had to prove that its trade-mark SOLO had become sufficiently known at the relevant date to negate any distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58]. Once this burden is met, the Applicant has a legal onus to show, on a balance of probabilities, that the Mark is not likely to create confusion with the Opponent's trade-mark SOLO such that it is adapted to distinguish or actually distinguishes the Services from the Opponent's wares and services throughout Canada [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272].

[41] The evidence described in paragraphs 24 and 25 above enables me to conclude that the Opponent's trade-mark SOLO was sufficiently known in Canada at the relevant date. Therefore the Applicant has the burden to prove, on a balance of probabilities, that the Mark is adapted to distinguish the Services from the Opponent's services.

[42] This ground of opposition essentially turns on the issue of likelihood of confusion between the parties' trade-marks as of the filing date of the statement of opposition. The difference in the relevant date with the registrability ground of opposition would not be a determining factor in this case as most of the evidence filed relates to the use of the Opponent's trade-mark SOLO prior to the filing date of the statement of opposition. Under these circumstances I find that the Applicant's Mark does not distinguish the Applicant's Services from the Opponent's services nor is it apt to distinguish them as it is confusing with the Opponent's trade-mark SOLO. Thus, the first portion of the last ground is also maintained.

[43] The Opponent having been successful under two separate grounds of opposition, it is not necessary to rule on the remaining grounds of opposition.

Conclusion

[44] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office