



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 130

Date of Decision: 2019-11-29

IN THE MATTER OF AN OPPOSITION

NetSuite Inc.

Opponent

and

Infor (US), Inc.

Applicant

**1,655,881 for
INFOR CLOUDSUITE**

Application

INTRODUCTION

[1] Netsuite Inc. (the Opponent) opposes registration of the trademark INFOR CLOUDSUITE (the Mark), which is the subject of application No. 1,655,881 by Infor (US), Inc. (the Applicant).

[2] The Mark is applied for in association with the following services:

Software as a service (SAAS) services, namely, hosting software for use by others in the field of enterprise resource planning solutions, expense management, asset management, human resource administration and management, construction management, customer relationship management, human capital management, financial management, performance management, product lifecycle management, workforce management, public sector solutions, hospitality solutions, business solutions and supply chain management.

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent's prior use of the trademark SUITECLOUD in association with online software services.

[4] For the reasons that follow, the application is refused.

THE RECORD

[5] The application for the Mark was filed on December 11, 2013 and claims a priority filing date of December 10, 2013, based on U.S. application No. 86/139,507.

[6] The application was advertised for opposition purposes on October 22, 2014. Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13 (the Act) came into force on June 17, 2019. In the context of opposition proceedings, the date for identifying which version of the Act applies is the date on which the application being opposed was advertised. As the application was advertised prior to June 17, 2019, pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read immediately before June 17, 2019, an exception being that, with respect to confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[7] The Opponent opposed the application on December 8, 2014, by filing a statement of opposition under section 38 of the Act. The grounds of opposition are based on sections 30(b), 30(e), 30(i), 16(3)(a), 16(3)(b) and 2 of the Act (as it then was), discussed below.

[8] The Applicant filed a counter statement on April 15, 2015, denying each of the grounds of opposition.

[9] In support of its opposition, the Opponent filed the affidavit of Guilielmus Haarmans, sworn on August 13, 2015 (the Haarmans Affidavit) and, as reply evidence, the affidavit of Janet MacKenzie, sworn February 2, 2017 (the MacKenzie Affidavit).

[10] In support of its application, the Applicant filed the affidavit of Jane Buckingham, sworn June 24, 2016 (the Buckingham Affidavit) and the affidavit of Cole Meagher, sworn June 27, 2016 (the Meagher Affidavit).

[11] None of the affiants were cross-examined on their affidavits. Both parties filed written representations, but only the Opponent was represented at an oral hearing held on July 31, 2019.

[12] Before assessing the grounds of opposition, I will first provide an overview of the parties' evidence, the evidential burden on the Opponent, and the legal onus on the Applicant.

OVERVIEW OF THE OPPONENT'S EVIDENCE

Haarmans Affidavit

[13] The Haarmans Affidavit can be summarized as follows:

- Mr. Haarmans is a Senior Vice President with the Opponent [para 1].
- The Opponent is a provider of “cloud-based financials / Enterprise Resource Planning (“ERP”) and omni-channel commerce software suites to businesses” and offers “a broad suite of applications, including financial management, Customer Relationship Management (“CRM”), e-commerce and retail management, Professional Services Automation (“PSA”) and Human Capital Management (“HCM”) that enable companies to manage most of their core business operations in a single integrated software suite” [para 2].
- The Opponent also offers customer support and professional services “related to implementing and supporting its suite of software applications and delivers its suite of software applications over the Internet as a subscription service using the software-as-a-service (“SaaS”) mode” [para 2].
- The Opponent is “the world’s largest cloud enterprise resource planning (ERP) vendor [and] more than 24,000 organizations run [the Opponent’s] cloud-based business applications” [para 3].
- Among the many applications, platforms, and development tools developed and offered by the Opponent, SuiteCloud is “a comprehensive offering of cloud development tools, applications and infrastructure that enables customers and software developers to maximize the benefits of cloud computing”. SuiteCloud comprises “a multi-tenant cloud

platform that is offered as part of the NetSuite service to customers and partners as Software-as-a-Service (SaaS) technology that provides an integrated development environment and application programming interfaces (APIs) to build applications on the NetSuite platform” [para 4].

- SuiteCloud enables “customers and partners to rapidly extend, customize, and configure NetSuite’s business applications, including but not limited to enterprise resource planning (ERP), customer relationship management (CRM), human capital management (HCM), ecommerce, omnichannel commerce, and more, in order to build deep industry and vertical specific cloud functionality” [para 4].
- More than 300 independent software vendors (ISVs) globally, including Canada, use SuiteCloud services “to build applications on top of NetSuite’s business applications or to integrate with the ISVs own solutions that they sell to NetSuite customers to be used in conjunction with NetSuite’s business applications” [para 5].
- The Applicant began using the SUITECLOUD mark in the United States at least as early as March 2009 in association with various online, software development, software support, and software-as-a-service (SAAS) services, collectively defined as the “SuiteCloud Services” as follows [para 6]:
 - Providing temporary use of online non-downloadable software applications, development platforms and development tools that enable software developers to program and build developer software applications that work in conjunction with such non-downloadable software applications and platforms to transfer, share, format, manipulate and integrate data, information and such developer software applications working in conjunction with and between such non-downloadable software applications and platforms and third party services;
 - Software as a service (SAAS) services, namely, hosting software for use by others for use in business management;
 - Debugging, maintenance and updating of computer software;
 - Providing a website featuring technical information relating to computer software provided;

- Providing computer software support and consulting services, architectural design of software applications, technical support services, troubleshooting in the nature of diagnosing and repairing computer software problems.
- The SUITECLOUD trademark has been used by the Opponent in association with the advertising and performance of such services by displaying the SUITECLOUD mark on the Opponent's website (*www.netsuite.com*) and in various promotional materials distributed to customers and potential customers [para 7, Exhibits A and B].
- Revenue generated from the sale and performance of SuiteCloud Services in association with the SUITECLOUD trademark since 2009 has been over USD\$2 billion [para 9].
- With respect to Canada, the Opponent began advertising its SuiteCloud Services in association with the SUITECLOUD mark in Canada since at least as early as March 2009, via the Opponent's aforementioned website and promotional materials [para 10, Exhibits A and B].
- As of October 2014, the Opponent's customer base included over 400 business customers throughout Canada, spanning a wide range of industries [para 11]. Attached as Exhibit D to the Haarmans Affidavit are a sampling of order forms pertaining to SuiteCloud Services provided by the Applicant in association with the SUITECLOUD trademark to customers in Canada from 2010 to 2014 [para 12].
- Since 2009, the Opponent's annual revenue generated from the sale and performance of SuiteCloud Services in association with the SUITECLOUD trademark in Canada is "in the millions of dollars" [para 13].
- As of 2015, the Opponent has three offices in Canada, employing approximately 300 people, making the Opponent "one of the largest SaaS companies and one of the fastest growing companies in Canada" [para 14].
- Since the fall of 2009, the Opponent has held an annual SuiteCloud Developer Network exposition in Toronto, which "brings together NetSuite's business partners using the SuiteCloud Services with NetSuite sales representatives". Over 30 business partners attend the exposition annually. Attached as Exhibit E to the Haarmans affidavit is a

sampling of printed material relating to the exposition for the years 2010 to 2014 [para 15].

- Using the SuiteCloud Services, the Opponent’s business partners have developed over 300 software applications and integrations [para 15].
- The Opponent and its SUITECLOUD trademark have been the subject of online and print media coverage. Attached as Exhibit F to the Haarmans Affidavit is a sampling of media coverage relating to the SUITECLOUD trademark appearing in Canadian media such as The Globe and Mail, Yahoo Finance Canada, IT World Canada, IT in Canada online, and Computer Dealer News [para 16].
- The Opponent and its SuiteCloud Services have garnered various industry awards [para 18].
- The Opponent’s annual advertising expenditures relating to the SUITECLOUD trademark worldwide “is in the millions of dollars”; however, as the Opponent’s advertising is conducted globally, it is not possible to provide advertising expenditures specific to Canada [para 17].
- Based on his review of the statement of services set out in the subject application as well as information available on the Applicant’s website (*www.infor.com/cloud*), Mr. Haarmans considers that “the services associated with [the Mark] and the services associated with [the Opponent’s] SuiteCloud trademark are overlapping or closely related” [para 19]. In particular, at paragraph 19 of his affidavit, Mr. Haarmans attests that:
 - both parties target the same markets with similar products and services;
 - both parties target enterprise businesses globally with subscription based offerings;
 - both parties’ offerings are “vertical, or industry specific business management applications”;

- the Applicant’s descriptions of its offering – “Clouduite provides beautiful software with deep industry functionality and a flexible, subscription-based delivery model that significantly reduces upfront IT expenditure” and “Each industry suite within Infor CloudSuite is built by unifying multiple applications that historically were deployed independently to holistically support core business functions by industry” – also fit the Opponent’s SuiteCloud Services.

MacKenzie Affidavit

[14] The MacKenzie Affidavit, submitted as reply evidence, can be summarized as follows:

- Ms. MacKenzie is employed by the Opponent’s trademark agent [para 1].
- Ms. MacKenzie conducted a Google search of the World Wide Web for the term SUITECLOUD; the first ten pages of the search results are attached as Exhibit A to the MacKenzie Affidavit [para 2].
- Ms. MacKenzie made photocopies of the CIPO file wrappers for Canadian trademark application Nos. 1,533,662 for CLOUDSUITE and 1,533,663 for INFOR CLOUDSUITE, both in the name of Infor Global Solutions (Michigan) Inc.; copies are attached as Exhibits B and C to the MacKenzie Affidavit, respectively [paras 3 and 4]. Both applications appear to have been abandoned without substantive response following an examiner’s report in each case that referenced the Opponent’s “co-pending and confusing application no. 1,488,488” for the trademark SUITECLOUD.
- Exhibit D to the MacKenzie Affidavit is a copy of the three-page affidavit of Guilielmus Haarmans, sworn December 14, 2016 [the 2016 Haarmans Affidavit] and filed with CIPO in connection with application No. 1,488,488 for the trademark SUITECLOUD. The 2016 Haarmans Affidavit appears to be in partial response to an examiner’s report, “in support of a claim that the trademark SUITECLOUD is not without distinctive character in Canada, in relation to all of the SUITECLOUD Services” [para 6 of the 2016 Haarmans Affidavit]. This affidavit includes a table breaking down “the total annual revenue generated from the sale and performance of [the Opponent’s] SaaS offering and

the SUITECLOUD Services in Canada in association with the SUITECLOUD trademark, for the years 2009-2016” [para 5 of the 2016 Haarmans Affidavit]; the total revenue for that period appears to have been in excess of USD\$100 million.

I note at this point that, in its written representations, the Applicant submits that this exhibit ought to be struck or afforded no weight as it is hearsay; especially given that Mr. Haarmans swore the earlier Haarmans Affidavit, the Opponent provides no explanation as to why the evidence found in the 2016 Haarmans Affidavit was filed through the McKenzie Affidavit rather than through Mr. Haarmans directly. While I agree that the 2016 Haarmans Affidavit should be afforded little weight, I note that its content is generally consistent with the earlier Haarmans Affidavit.

OVERVIEW OF THE APPLICANT’S EVIDENCE

Buckingham Affidavit

[15] The Buckingham Affidavit can be summarized as follows:

- Ms. Buckingham is employed as a trademark searcher by the Applicant’s trademark agent [para 1].
- On June 24, 2016, Ms. Buckingham conducted a database search “of all active trademark applications or registrations in the name of [the applicant] composed of or containing the element “INFOR” as the prefix of the mark” [para 2]. The search results are attached as Exhibit A to the Buckingham Affidavit.
- Attached as Exhibit B to the Buckingham Affidavit is a copy of the CIPO file wrapper for trademark application No. 1,488,488 for the mark SUITECLOUD in the name of the Opponent, obtained on June 6, 2016.

Meagher Affidavit

[16] The Meagher Affidavit can be summarized as follows:

- Mr. Meagher is employed as a student by the Applicant’s trademark agent [para 1].

- On June 24, 2016, Mr. Meagher conducted a search of the United States Patent and Trademark Office (USPTO) database for the trademark “suitecloud” [para 3]. The search results are attached as Exhibits A1 through A10 to the Meagher Affidavit, along with corresponding particulars, documents and file wrappers of each trademark.
- On June 24, 2016, Mr. Meagher conducted online searches for the meaning of the terms “cloud” and “suite” in the field of computing or technology [para 4]. The search results, including printouts from online dictionaries and articles, are attached as Exhibits B1 through B13 to the Meagher Affidavit.

EVIDENTIAL BURDEN AND LEGAL ONUS

[17] Before considering the grounds of opposition, it is necessary to review the basic requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[18] With respect to (i), in accordance with the usual rules of evidence, there is an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd*, 1990 CarswellNat 1053, 30 CPR (3d) 293 (FCTD) at para 11]. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

[19] With respect to (ii), the legal onus is on the applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent in the statement of opposition (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on an applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against the applicant.

GROUND OF OPPOSITION WITHDRAWN

[20] At the oral hearing, the Opponent withdrew its grounds of opposition based on sections 30(b), 30(e), and 30(i) of the Act as set out in the statement of opposition. Accordingly, I will not

consider these grounds any further. This leaves the grounds based on entitlement and distinctiveness to consider, both of which turn on the issue of confusion in relation to the Opponent's SUITECLOUD trademark.

MATERIAL DATES

[21] The material dates that apply to the remaining grounds of opposition are as follows:

- sections 38(2)(c)/16 with respect to entitlement – the priority filing date of the application, namely December 10, 2013 in this case [section 16 of the Act];
- sections 38(2)(d)/2 with respect to non-distinctiveness – the filing date of the opposition, namely, December 8, 2014 in this case [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317 at para 25].

ANALYSIS

Grounds of Opposition based on Section 16 - Entitlement

[22] In its statement of opposition, the Opponent pleads that, pursuant to sections 38(2)(c) and 16(3)(a) of the Act, the Applicant is not the party entitled to registration of the Mark in that at the date of filing of the subject application (on the basis of proposed use in Canada), the Mark was confusing with the Opponent's trademark SUITECLOUD that had previously been used in Canada by the Opponent.

[23] Similarly, the Opponent pleads that, pursuant to sections 38(2)(c) and 16(3)(b) of the Act, the Applicant is not the party entitled to registration of the Mark in that at the date of filing of the subject application, the Mark was confusing with the Opponent's trademark SUITECLOUD, an application for the registration of which had previously been filed in Canada by the Opponent and was pending at the date of advertisement of the subject application.

[24] The Opponent meets its burden with respect to each of these grounds. With respect to 16(3)(a) of the Act, the Opponent has evidenced use of its SUITECLOUD trademark prior to the (priority) date of filing of the subject application (December 10, 2013) and that it was not abandoned as of the date of advertisement of the subject application.

[25] With respect to 16(3)(b) of the Act, the Opponent has evidenced that its application for the trademark SUITECLOUD was filed on July 13, 2010 (with a priority filing date of January 14, 2010) – prior to the filing date of the subject application – and was pending as of the date of advertisement of the Mark [pursuant to section 16(4) of the Act]. I note that the Opponent’s SUITECLOUD trademark was subsequently registered on August 31, 2017, though nothing below ultimately turns on this status.

[26] As the material dates and evidence with respect to these two grounds based on entitlement are the same, I note that the test for confusion is also the same.

Test to determine confusion

[27] The test to determine the issue of confusion is set out in section 6(2) of the Act which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[28] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods, services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[29] The criteria in section 6(5) of the Act are not exhaustive and different weight will be given to each one in a context-specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 1 SCR 772 at para 54]. In *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 (SCC) at para 49, the Supreme Court of Canada stated that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

Distinctiveness – Inherent Distinctiveness and the Extent Known

[30] In its written representations, the Applicant submits that the Opponent's SUITECLOUD trademark "is entirely lacking in inherent distinctiveness", arguing that SUITECLOUD "is clearly descriptive of the Opponent's services in that the mark describes that the services relate to a suite of cloud-based software services" [para 37]. This argument is supported by the evidenced definitions of "suite" and "cloud" [Meagher Affidavit, Exhibits B-1, B-2]; the descriptive references to such terms in the Haarmans Affidavit and exhibited promotional materials regarding the Opponent's business and its SuiteCloud platform [Haarmans Affidavit, paras 2 and 4, Exhibit B]; and the basis of registration of the SUITECLOUD trademark in Canada (pursuant to section 14 of the Act) [2016 Haarmans Affidavit] and in the U.S. (on the Supplemental Register) [Meagher Affidavit, Exhibits A-7 through A-10].

[31] With respect to the extent the Opponent's SUITECLOUD trademark has become known in Canada, the Applicant submits that the evidence filed by the Opponent regarding use of the SUITECLOUD trademark specific to Canada is vague and generally unsupported by any documents, "making it virtually impossible to determine the extent to which the SUITECLOUD mark might be known in Canada" [para 45]. For example, the Applicant argues that, with respect to sales in Canada, the only evidence is the "vague and unsupported" general statement that annual sales are "in the millions of dollars" [para 47]. Citing the lack of invoices or accounting statements regarding the Opponent's SuiteCloud Services, the lack of information regarding distribution figures for referenced promotional material, and the lack of Canadian advertising expenditure specifics, the Applicant submits that "it is impossible to determine the number of people in Canada that were exposed to the Opponent's SUITECLOUD mark, either online or otherwise at any time" [paras 48 and 49]. In this respect, the Applicant further notes that while Mr. Haarmans attests that the Opponent had over 400 customers in Canada as of October 22, 2014, this date is after the material date for the alleged entitlement grounds of opposition (namely, December 10, 2013).

[32] Nevertheless, the Opponent has provided evidence of use and reputation of its SUITECLOUD trademark in Canada since 2009. While this evidence could have been clearer especially in relation to the aforementioned material date, I accept that the SUITECLOUD mark

had at least somewhat become known in Canada from its promotion and advertisement through the Opponent's website (Haarmans Affidavit, para 7), annual exposition in Toronto (para 15) and media coverage (para 16). Furthermore, even if I were to disregard the 2016 Haarmans Affidavit attached to the McKenzie Affidavit, given the Canadian presence and customer base attested to by Mr. Haarmans, I would be prepared to infer that at least some portion of the "in the millions of dollars" revenue [Haarmans Affidavit, para 13] is attributable to the period between 2009 and the material date.

[33] With respect to the Mark, the Applicant concedes that the second element of the Mark – CLOUDSUITE – lacks distinctiveness, but argues that the Mark as a whole is inherently distinctive as the term INFOR "is a coined term with no dictionary or common understanding and which bears no connection to the Applicant's Services" [Applicant's Written Representations, para 43]. In contrast, at the hearing, the Opponent submitted that INFOR could be perceived as a contraction for "information", thus diminishing the inherent distinctiveness of the Mark as a whole.

[34] In any event, while the Mark may have somewhat greater inherent distinctiveness than the Opponent's SUITECLOUD mark, the evidence supports a finding that the SUITECLOUD mark has become known to a greater extent than the Mark in Canada. Therefore, I find that this factor favours the Opponent.

Length of Time in Use

[35] In its written representations, the Applicant notes the Opponent's allegation that it has used the SUITECLOUD trademark in Canada since 2009 [para 45] but, as detailed above, questions to what extent it can be determined that the SUITECLOUD trademark has become known in Canada [paras 45 to 50].

[36] Regardless, the uncontroverted evidence in this case is that the Opponent's SUITECLOUD mark has been in use in Canada since March 2009. As the application for the Mark is based on proposed use and the Applicant has not evidenced subsequent use of the Mark, this factor clearly favours the Opponent.

Nature of the Services or Business / Nature of the Trade

[37] In its written representations, the Applicant attempts to distinguish its services from those of the Opponent. In this respect, it quotes the Haarmans Affidavit, emphasizing that the SuiteCloud Services are made up of a platform that provides “an integrated development environment and application programming interfaces (APIs) to build applications on the NetSuite platform” [para 52, quoting Haarmans Affidavit at para 6]. The Applicant submits that, in contrast, the applied-for services “are expressly limited to the hosting of software for use by others in the field of business” and therefore “would be generally targeted towards businesses and not explicitly targeted to software developers as is the case for the Opponent’s services” [para 52].

[38] I note that the Applicant’s submission is somewhat qualified on its face and, as the Applicant has not evidenced use of – or advertisement in relation to—the Mark, I am not prepared to infer any particular limitations including regarding the target market for the Applicant’s services.

[39] In any event, when considering the nature of the services of the parties in respect of the issue of confusion, it is the statements of services in the subject application that govern [*Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CarswellNat 749, 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA) at paras 24-25]. In this case, I note the wide range of fields referenced in the applied-for services and that the uncontroverted evidence found in the Haarmans Affidavit indicates that the parties operate in the same field and that there is overlap in the nature of the services as well as the parties’ businesses and potential customers. At a minimum, both parties’ trademarks relate to SaaS services, offering cloud-based software services to businesses.

[40] As the Opponent submitted at the hearing, the Applicant is “attempting to slice the onion too thinly” by suggesting there is no overlap in the parties’ offerings. The evidence in the Haarmans Affidavit is that both the Opponent’s SuiteCloud services and the Applicant’s services are offered in the same channels of trade to the same potential customers [para 19].

[41] Accordingly, I find that these factors favour the Opponent.

Degree of Resemblance

[42] As mentioned above, the degree of resemblance between the parties' marks is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion. This is particularly the case where the parties' services and the parties' channels of trade, are the same or overlapping, as in this case [see *Reynolds Consumer Products Inc v PRS Mediterranean Ltd*, 2013 FCA 119, 111 CPR (4th) 155 at paras 26-30].

[43] In its written representations, the Applicant submits that the most striking or unique part of the Mark is the first portion, INFOR, and notes that this element has no visual, phonetic or conceptual equivalent in the Opponent's SUITECLOUD trademark. As noted above, it submits that INFOR is a coined term [para 56].

[44] With respect to resemblance in the ideas suggested, the Applicant further submits the somewhat tautological argument that, given the presence of the INFOR element, "the idea suggested by the Mark is that the services provided thereunder are associated with the Applicant" [para 56].

[45] In contrast, in its written representations, the Opponent submits that the Mark "comprises the whole of the Opponent's distinctive mark SUITECLOUD, reversing the order of the words forming the mark and adding the corporate name INFOR". The Opponent submits that "where an applicant has adopted the entirety of [an opponent's] mark, with very minor modifications, it is not enough to avoid confusion to simply add a corporate identifier" [para 57].

[46] Although the first portion of the Mark is INFOR – and whether I consider it to be a coined term or a contraction of "information" – I find there to be some resemblance between the Mark and the Opponent's SUITECLOUD mark, given the presence of the SUITE and CLOUD elements in both marks. In this respect, the Mark essentially incorporates the Opponent's mark in its entirety, albeit with an inversion of the two elements. However, I do not consider this inversion of the words SUITE and CLOUD to significantly diminish the degree of resemblance in appearance, when sounded or in the idea suggested between the marks [for a similar conclusion, see *The Clorox Company of Canada, Ltd v Escola de Natação E Ginastica Bioswin Ltda*, 2017 TMOB 173 at para 36 with respect to SMART FIT versus FITSMART].

[47] Accordingly, this factor favours the Opponent.

Additional Surrounding Circumstance: INFOR family of trademarks

[48] In its written representations, as an additional surrounding circumstance, the Applicant notes that it “is already the owner of a significant number of trademark registrations or pending applications in Canada (18) each of which is prefixed by or composed solely of the element INFOR”.

[49] Where there exists a family of trademarks, there may be a greater likelihood that the public would consider a similar trademark to be another trademark in the family and, consequently, to assume that the service that is associated with that trademark is performed by the owner of the family of marks. There is, however, no presumption of the existence of a family of trademarks in opposition proceedings. A party seeking to establish a family of trademarks must establish that it is using more than one or two trademarks within the alleged family [*Techniquip Ltd v Canadian Olympic Assn* (1998), 145 FTR 59 (FCTD), aff’d (1999), 3 CPR (4th) 298 (FCA); *Now Communications Inc v CHUM Ltd* (2003), 32 CPR (4th) 168 (TMOB) at para 35].

[50] Given that the Applicant’s evidence in this respect is limited to search results from the trademark register, there is little basis upon which I can find that the Applicant has a family of trademarks [see *7-Eleven, Inc v BitBite Foods Inc*, 2014 TMOB 16 at para 41, citing *Techniquip Ltd v Canadian Olympic Assn, supra*].

[51] Accordingly, this is not a surrounding circumstance assisting the Applicant.

Additional Surrounding Circumstance: previous applications for the subject trademarks

[52] At the hearing, the Opponent submitted that an additional surrounding circumstance is that, with respect to previous applications for CLOUDSUITE and INFOR CLOUDSUITE, the Opponent’s pending SUITECLOUD application was cited by the trademarks examination section and those applications were subsequently abandoned [MacKenzie Affidavit, paras 3 and 4, Exhibits B and C].

[53] However, it has previously been noted that the trademarks examination section does not have before it evidence that is filed by the parties in an opposition proceeding and the burden is different in examination [see *Thomas J Lipton Inc v Boyd Coffee co* (1991), 40 CPR (3d) 272 at 277; *Proctor & Gamble Inc v Morlee Corp* (1993), 48 CPR (3d) 377 at 386; *ISTOCKPHOTO IP v Istockhomes Marketing Ltd*, 2018 TMOB 49 at para 62]. Decisions by examination section are not binding and have no precedential value in determining the registrability of a trademark in an opposition proceeding [see *Worldwide Diamond Trademarks Limited v De Trung Vo*, 2016 TMOB 20 at para 32; *Thinklab Consulting Inc v Combustion Creativity Inc*, 2018 TMOB 14 at para 85].

[54] As such, while the finding below is consistent with the aforementioned objections raised by examination section, I do not find the disposition of the previous applications for CLOUDSUITE and INFOR CLOUDSUITE to be a relevant surrounding circumstance that materially favours either party in this case.

[55] Similarly, I do not consider the dispositions of the Opponent's applications for the SUITECLOUD trademark in Canada and the U.S. to significantly assist either party in this case. As noted above, notwithstanding the minimal inherent distinctiveness of the SUITECLOUD trademark, it has the benefit of acquired distinctiveness through use and promotion in Canada.

Conclusion

[56] The test to be applied is a matter of first impression in the mind of a casual consumer "somewhat in a hurry" who sees the Mark in association with the applied-for services at a time when they have no more than an imperfect recollection of the Opponent's SUITECLOUD trademark and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[57] Having considered all of the surrounding circumstances, I find that the Applicant has not met its legal burden with respect to the applied-for services. At best for the Applicant, I find the balance of probabilities regarding the likelihood of confusion as to the source of the parties' services to be evenly balanced. I reach this conclusion due to the resemblance between the

trademarks, especially in view of the overlap in the nature of the parties' services, businesses and trades and the evidence of acquired distinctiveness of the Opponent's SUITECLOUD trademark.

[58] As the onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion, I must find against the Applicant. Accordingly, the section 16 grounds of opposition based on entitlement are successful.

Ground of Opposition based on Section 2 – Non-Distinctiveness

[59] The Opponent pleads that the Mark is not distinctive in that it does not actually distinguish and is not adapted to distinguish the associated services from the goods or services of others including the Opponent's services, since the Mark is confusing with the Opponent's trademark SUITECLOUD, previously used and filed in Canada by the Opponent.

[60] As this ground of opposition also turns on the issue of confusion as between the Mark and the Opponent's trademark SUITECLOUD, for essentially the same reasons above with respect to the grounds based on entitlement, I find that this ground of opposition based on non-distinctiveness of the Mark also succeeds.

[61] In this respect, the later material date for this ground (namely, December 8, 2014) further favours the Opponent, given the evidenced continued use and promotion of the SUITECLOUD trademark in Canada. In contrast, the later material date does not assist the Applicant, given that the application for the Mark is based on proposed use and the Applicant has not evidenced use or promotion of the subject Mark in relation to either material date.

DISPOSITION

[62] In view of all of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: 2019-07-31

APPEARANCES

Christopher Dejardin	For the Opponent
No one attending	For the Applicant

AGENTS OF RECORD

Cassan MacLean IP Agency Inc.	For the Opponent
Gowlings WLG (Canada) LLP	For the Applicant