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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 122

Date of Decision: 2020-10-31

IN THE MATTER OF AN OPPOSITION

Dimension Data (Pty) Ltd

Opponent

and

**AgData L.P., a Limited Partnership of
the State of Delaware**

Applicant

1,737,256 for DATA DIMENSIONS

Application

INTRODUCTION

[1] Dimension Data (Pty) Ltd (the Opponent) opposes registration of the trademark DATA DIMENSIONS (the Mark) filed by AgData L.P., a Limited Partnership of the State of Delaware (the Applicant).

[2] Filed on July 14, 2015, the application is based on proposed use of the Mark in Canada and use and registration of the Mark in the United States in association with the following services: Data management services for the agricultural industry, namely, collection, processing, storage and reporting of sales information received from retailers and distributors. The application was advertised in the *Trademarks Journal* of February 8, 2017.

[3] The Opponent alleges that (i) the application does not conform to section 30 of the *Trademarks Act*, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable under section

12(1)(b) or section 12(1)(d) of the Act; (iii) the Applicant is not the person entitled to the registration of the Mark under section 16 of the Act, and (iv) the Mark is not distinctive under section 2 of the Act. Many of the grounds of opposition are related to the Opponent's allegation that the Mark is confusing with the use and registration of its trademark DIMENSION DATA for a variety of computer related goods and services.

[4] At the outset of my decision, I note that the Act was amended on June 17, 2019. All references in this decision are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act as it read before it was amended (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised prior to that date).

[5] For the reasons that follow, I refuse the application.

THE RECORD

[6] The Opponent filed its statement of opposition on June 27, 2017. The Applicant filed and served its counter statement on September 12, 2017 denying all of the grounds of opposition.

[7] In support of its opposition, the Opponent filed the affidavit of Colin Lowe and certified copies of the Opponent's trademark registration for DIMENSION DATA, along with two of its other trademarks. Mr. Lowe was not cross-examined. The Applicant did not file any evidence. No written submissions were received, nor was a hearing held.

THE PARTIES' RESPECTIVE BURDEN OR ONUS

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities that the application complies with the requirements of the Act. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all of the evidence, then the issue must be decided against the Applicant. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

ANALYSIS

[9] I will now consider the grounds of opposition beginning with the section 12(1)(d) ground of opposition and the section 2 ground of opposition.

Section 12(1)(d) Ground

[10] In its statement of opposition, the Opponent alleges that the Mark is not registrable pursuant to section 12(1)(d) of the Act because it is confusing with the Opponent's registered trademarks: TMA833,255 for DIMENSION DATA, TMA847,092 for DIMENSION DATA & Design, and TMA833,256 for DIMENSION DATA Design. I have exercised the Registrar's discretion to confirm that these registrations are in good standing [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[11] The material date for considering this issue is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[12] Since the Opponent has satisfied its initial evidential burden for this ground of opposition, the issue becomes whether the Applicant has met its legal onus to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's registered trademarks. I consider that the Opponent's best case is registration No. TMA833,255 for the trademark DIMENSION DATA and will concentrate my analysis on it. This trademark is registered for use in association with:

Goods

(1) Computers and notebook computers; computer software for operating and managing networking and for e-commerce applications to allow users to perform electronic business transactions via a global computer network; electronic data processors, namely, computer hardware and software for the purpose of processing data; computer hardware; computer peripherals, namely, computer mouse, web cameras, computer speakers, microphones, computer monitors; modems; magnetically encoded phone cards, magnetically encoded hotel room key cards, magnetically encoded debit cards, magnetically encoded credit cards, magnetically encoded card readers; computer memory cards and keyboards; computer hardware and software for interconnecting, managing and operating local area networks, wide area networks and global computer networks; apparatus for recording, transmission or reproduction of sound or images, namely,

loudspeakers, headphones, record players, CD players, CD-ROMs containing music, CD-ROMs containing computer games, DVD's containing movie recordings, pre-recorded audio cassettes, pre-recorded video cassettes, sound mixers, home theatre surround sound systems, record players, video tape recorders.

Services

(1) Web site construction services; computer repair services; computer hardware and software installation services; installation, maintenance and repair of computer hardware. Providing multiple user access to a global computer information network; providing telecommunications connections to a global computer network; providing hosting services and interconnection tools in order to provide access to databases belonging to others; information about telecommunication services, namely telecommunications consulting and information pertaining to the actual provision of access to networks, namely, LANS, WANS and VPN's that enable voice and data communications across such networks, namely, telephony, cellular services, voice over IP, video conferencing, telepresence and unified communications; electronic mail; communications by computer terminals, namely, LANS, WANS and VPN's that enable voice and data communications across such networks, namely, telephony, cellular services, voice over IP, video conferencing, personal communication services (PCS), and telepresence and unified communications; rental of telecommunication equipment and apparatus, namely, telephones, facsimile machines, radios, mobile phones; computer aided transmission of messages and images. Computer network services, namely, network integration; hosting the websites of others on a computer server for a global computer network; creating and maintaining computer websites for others; designing and implementing computer websites for others; computer software development design for others; design, development, customization, integration, installation, maintenance and updating of software; programming of computers, engineering of computer hardware; design and writing of computer software for others; specialist advisory services relating to computers, computer services and the computer industry.

[13] For the reasons that follow, this ground of opposition succeeds.

[14] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that 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.

[15] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b)

the length of time each has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks, including in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al*, 2006 SCC 23; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27].

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

the inherent distinctiveness of the trademarks and the extent known

[17] The parties' trademarks have a similar degree of inherent distinctiveness as they both consist of the same two words; DATA which is descriptive of the associated goods and services and DIMENSION(S) which has a less clear meaning when considered in light of the parties' goods and services.

[18] While the statement of opposition includes the allegation that the trademark is clearly descriptive, as there is no evidence that either DATA DIMENSIONS or DIMENSION DATA are understood to have any particular meaning, I consider each of the parties' marks to have some degree of inherent distinctiveness.

[19] The strength of a trademark may be increased by means of it becoming known in Canada through promotion or use. In the present case, no evidence was filed with respect to the extent that the Mark has become known. In contrast, the Opponent filed evidence of use and promotion of its trademark DIMENSION DATA in the affidavit of Mr. Lowe, the Area Operations Director of Dimension Data Canada Inc. Mr. Lowe's evidence provides the following:

- Dimension Data Canada Inc. (Dimension Data Canada) is the Canadian arm of the Opponent (para 1). Dimension Data Canada is licensed by the Opponent to use the DIMENSION DATA trademark in Canada in association with its information technology goods and/or services, including the Opponent's registered goods and services (para 10). The Opponent has direct or indirect

control of the character or quality of the registered goods and services (para 10).

- The Opponent's trademark DIMENSION DATA appears on proposals, network assessments, reports, invoices, presentations provided to Canadian clients, advertisements appearing on webinars given in Canada, invitations to cybersecurity events, video case studies filmed in Canada, posted to Youtube and viewed by Canadians, and invoices (Exhibits CL-3-CL-12; Exhibit CL-15).
- On an annual basis the sales figures relating to the performance of Dimension Data Canada's operations in Canada under the DIMENSION DATA trademarks and trade name exceeded \$36M CAD in each of what Mr. Lowe refers to as Financial Years 12-17 (para 15) which I infer to correspond to the years 2012-2017.

[20] In the end, while both parties' trademarks have a similar degree of inherent distinctiveness, in view of the Opponent's evidence of use and promotion of its trademark DIMENSION DATA and in the absence of any evidence from the Applicant, this factor favours the Opponent.

length of time the trademarks have been in use

[21] This factor favours the Opponent as only it has evidenced that its trademark DIMENSION DATA has been used in Canada since at least 2008. Specifically, Mr. Lowe's affidavit includes evidence of the trademark DIMENSION DATA on a proposal dated December 18, 2008 related to the migration of approximately 1000 users from one telephone platform to another.

the nature of the goods, business and trade

[22] When considering sections 6(5)(c) and (d) of the Act, the statements of goods and services as defined in the application for the Mark and in the Opponent's registration govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel*

Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[23] The Mark is applied-for use in association with data management services for the agricultural industry, namely, collection, processing, storage and reporting of sales information received from retailers and distributors.

[24] The Opponent's trademark is registered for use in association with a number of different computer related goods and services, including many relating to networking, which are not restricted to any particular sector. In its press release announcing the appointment of a Western Regional Sales Director on February 3, 2015 (Exhibit CL-14), Dimension Data Canada explains that it can assist Canadian organizations "meet in-country data requirements, reduce latency through proximity and address data sovereignty concerns by enabling global enterprises to locate data inside Canada." The press release further explains that "Dimension Data's global [Managed Cloud Platforms] deliver public and private Compute-as-a-Service solutions that provide high-performance, self-service, compute, storage and networking resources."

[25] In the absence of evidence from the Applicant, I infer that there is the potential for overlap between the Opponent's registered services set out below and the applied-for Services.

providing hosting services and interconnection tools in order to provide access to databases belonging to others; computer software development design for others; design, development, customization, integration, installation, maintenance and updating of software; programming of computers, engineering of computer hardware; design and writing of computer software for others; specialist advisory services relating to computers, computer services and the computer industry

While the Applicant's targets may be exclusively in the field of agriculture, given the breadth of services offered by the Opponent, I find that it may also target customers in this area or that customers in this area would be in the Opponent's natural zone of expansion. Accordingly, these two factors favour the Opponent.

the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested

[26] When the marks are assessed in their totality, as a matter of first impression and imperfect recollection, I consider the parties' marks to have significant similarities in appearance, sound, and ideas suggested. Both parties' trademarks include the word DATA and the word DIMENSION or DIMENSIONS and both appear to suggest the idea of managing or assisting with the management of DATA. The trademarks differ only by the fact that they transpose the terms within. As such, this factor favours the Opponent.

conclusion on the likelihood of confusion

[27] In *Masterpiece*, the Supreme Court of Canada indicates that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the parties' trademarks [see also *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstering Ltd* (1980), 47 CPR (2d) 145 (FC) at 149, affirmed (1982), 60 CPR (2d) 70 (FCA)]. Specifically, the Supreme Court notes that the degree of resemblance is the statutory factor that is often likely to have the greatest effect on the confusion analysis; the other factors become significant only once the trademarks are found to be identical or very similar [at para 49].

[28] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, in view of the Opponent's use of its trademark DIMENSION DATA, the potential for overlap in the parties' channels of trade and the nature of the parties' goods and services, as well as the strong similarities of the parties' marks in appearance, sound, and in ideas suggested, I find that the Applicant has not discharged its legal onus to prove, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's registered trademark No. TMA833,255 for DIMENSION DATA. As such, the 12(1)(d) ground of opposition succeeds.

Section 2 Ground

[29] The Opponent alleges that the Mark does not actually distinguish the services in association with which the Mark is used or proposed to be used by the Applicant from the goods and/or services of the Opponent, nor is it adapted to distinguish them.

[30] The material date for assessing distinctiveness is the date of filing of the opposition, which is June 27, 2017 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

[31] In order to meet its initial evidential burden with respect to the non-distinctiveness ground of opposition, the Opponent is required to show that its trademark had become known sufficiently in Canada, as of the filing date of the statement of opposition, to negate the distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. To do so, the Opponent must establish that its trademark is either known to some extent in Canada or is well known in a specific area of Canada [*Bojangles*, supra at paras 33-34].

[32] Mr. Lowe's evidence satisfies the Opponent's initial evidential burden. Although the material date for distinctiveness is approximately three years earlier than today's date, the difference in dates does not result in a different outcome. The section 2 ground succeeds on the basis that the Applicant fails to meet its legal onus of proving no reasonable likelihood of confusion between the Mark and the Opponent's trademark DIMENSION DATA, on a balance of probabilities, for the same reasons as those set out under the section 12(1)(d) ground.

Remaining Grounds of Opposition

[33] Having already refused the application under two grounds, I will not discuss the remaining grounds of opposition.

DISPOSITION

[34] 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.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: No hearing held

AGENTS OF RECORD

ROBIC

FOR THE OPPONENT

RIDOUT & MAYBEE LLP

FOR THE APPLICANT