



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 73

Date of Decision: 2021-04-19

IN THE MATTER OF AN OPPOSITION

Qualtrics, LLC

Opponent

and

Quantrics Enterprises Inc.

Applicant

**1,808,230 for QUANTRICS &
DESIGN**

Application

INTRODUCTION

[1] Qualtrics, LLC (the Opponent) opposes registration of the trademark QUANTRICS & DESIGN, depicted below (the Mark), which is the subject of application No. 1,808,230 (the Application) by Quantrics Enterprises Inc. (the Applicant).



[2] The Application for the Mark is based on proposed use in association with “telecommunication services, namely operation of business customer call centres” (the Services).

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent’s registered trademarks QUALTRICS and Q Design in association with services including providing temporary use of non-downloadable computer software as a service, accessed via the Internet, in the field of conducting business and market research surveys for others, namely, software for data feedback, data evaluation, and research surveys, data collection, data integration, data management, data analysis, and generating reports for use in consulting with respect thereto.

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

THE RECORD

[5] The Application for the Mark was filed on November 7, 2016, and was advertised for opposition purposes in the *Trademarks Journal* of November 29, 2017.

[6] On April 30, 2018, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act* (RSC 1985, c T-13) (the Act). The grounds of opposition pleaded by the Opponent include sections 12(1)(d), 16, 2 and 30(i) of the Act. As 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 (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 before this date).

[7] The Applicant denied all the grounds of opposition in a counter statement served on the Opponent on June 29, 2018.

[8] In support of its opposition, the Opponent filed the affidavit of Elenita Anastacio, a trademark searcher employed by the agent for the Opponent, sworn October 12, 2018. Ms. Anastacio obtained and printed the particulars of the Opponent’s registered trademarks, and the subject Application (Exhibits A and B, respectively).

[9] The Applicant elected not to file any evidence. Only the Opponent filed a written argument and was represented at a hearing.

LEGAL ONUS AND EVIDENTIAL BURDEN

[10] 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 12(1)(d) ground

[11] The Opponent has pleaded that the Mark is not registrable in view of section 12(1)(d) of the Act and the Opponent's registrations for the trademarks QUALTRICS (TMA969,382) and Q Design (TMA969,308) (collectively the QUALTRICS Registrations). I have exercised my discretion to check the Register and confirm that these registrations remain extant [*Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground.

[12] In considering the issue of confusion, I will focus on the Opponent's registered trademark QUALTRICS as in my view it represents the Opponent's strongest case. That is, if the Opponent is not successful with this mark, it would not achieve a more favorable result with the Q Design trademark. The services associated with the QUALTRICS registration are as follows:

Providing temporary use of non-downloadable computer software as a service, accessed via the Internet, in the field of conducting business and market research surveys for others, namely, software for data feedback, data evaluation, and research surveys, data collection, data integration, data management, data analysis, and generating reports for use in consulting with respect thereto

Test to determine confusion

[13] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold or leased by the same person, whether or not the goods or services are of the same general class or appear in the same Nice Class [*Obsidian Group Inc v Attorney General of Canada*, 2020 FC 586].

[14] In making such an assessment, I must consider all the relevant surrounding circumstances, including those listed in section 6(5): 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 and 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. In *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, [2006] 1 SCR 824 at para 20, the Supreme Court of Canada set out how the test is to be applied:

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] at a time when he or she has no more than an imperfect recollection of the [prior] trademarks and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[15] The criteria in section 6(5) 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, [2006] 1 SCR 772 (SCC) at para 54. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* 2011 SCC 27 at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

Inherent distinctiveness of the trademarks

[16] The Opponent's trademark QUALTRICS possesses a fair degree of inherent distinctiveness given that it is a coined term that is neither descriptive nor suggestive of its associated services.

[17] Similarly, the QUANTRICS element of Mark is neither descriptive nor suggestive of the Services. The Q in this word as it appears in the Mark is highly stylized which slightly increases the overall inherent distinctiveness of the Mark. The Mark also contains the words “people powered”, however as these words could be considered to hold a suggestive connotation, they do not materially affect the overall inherent distinctiveness of the Mark.

[18] Overall, this factor slightly favours the Applicant.

Extent known and length of time in use

[19] The strength of a trademark may be increased by means of it becoming known through promotion or use.

[20] The Opponent has filed no evidence of use of its QUALTRICS trademark. As noted above, only a printout of the particulars of the QUALTRICS registration from the Canadian Trademarks Database was provided (Anastacio affidavit, Exhibit A). While this registration claims use in Canada since at least as early as March 11, 2010, the Opponent has provided no evidence showing use of the trademark. Further, even if I was to assume *de minimis* use, it is well established that *de minimis* use does not support a conclusion that a trademark has become known to any significant extent, nor that a trademark has necessarily been used continuously since the date stated [*Krauss-Maffei Wegmann GmbH & Co KG v Rheinmetall Defence Electronics GmbH*, 2017 TMOB 50].

[21] The Application is based on proposed use and there is no evidence the Applicant has used the Mark in Canada. Accordingly, these factors favour neither party.

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

[22] It is the wording of an applicant’s statement of goods and services in the application that governs the confusion analysis. That statement must be read with a view to determining the probable type of business or trade intended by the applicant rather than all possible trades that might be encompassed by the description of goods and services. In this regard, evidence of the actual trade of the applicant can be useful. [*McDonald’s Corporation v Coffee Hut Stores Ltd*

(1996), 68 CPR (3d) 168 (FCA) at 169; *London Life Insurance Co v Nesbitt Thomson Inc* (1997), 75 CPR (3d) 114 (TMOB)].

[23] The Services in the Application are described as “telecommunication services, namely operation of business customer call centres”. The services associated with the Opponent’s registration are listed above at paragraph 12.

[24] Part of the Opponent’s submissions regarding the nature of the parties’ services is found at paragraph 45 of its written argument, reproduced below:

Given the nature of the parties’ respective services, there is a significant indirect overlap between the services of the Applicant and the Opponent, and the services fall within the same or similar general category of services. For example, the Opponent’s Services cover software as a service used for conducting business and market surveys. The Applicant’s Services cover telecommunications services for operating call centres. Said call centres are likely to be used for conducting business and market research. As such, both the Applicant’s and Opponent’s target market would or could include consumers who wish to collect business and market research data.

[25] At the hearing, the Opponent submitted that a potential for overlap exists considering the way in which the Applicant’s Services are described. The Opponent noted that the Applicant’s customer call centres could be used for incoming or outgoing calls (as there is no restriction in the statement of Services). The Opponent suggested that the Applicant’s customer call centres could make calls, on behalf of their business clients, to conduct market research, business and market surveys, resulting in a clear overlap with the services of the Opponent.

[26] While I do not consider there to be a significant overlap between the services of the parties, I agree that given the broad description of the Services, that there is potential for a similarity or overlap between the services of the parties in the manner suggested by the Opponent. Whether there is similarity or overlap in the nature of the parties’ corresponding channels of trade is difficult to assess in the absence of any evidence of use filed by the parties.

Degree of resemblance

[27] The preferable approach when comparing trademarks is to begin by determining whether there is an aspect of the marks that is particularly striking or unique [*Masterpiece* at para 64]. In

the present case, I find the coined word QUANTRICS and the stylized Q to constitute the striking elements of the Mark; I do not consider the words “people powered” to be striking since they appear in a smaller font and in a less prominent position relative to the word QUANTRICS.

[28] I consider the entirety of the Opponent’s trademark QUALTRICS to be striking.

[29] I find there to be a significant degree of resemblance between the marks when sounded, given that the QUANTRICS and QUALTRICS elements of the Applicant’s and Opponent’s marks, respectively, are near phonetic equivalents. Similarly, I find there to be a considerable degree of visual resemblance between the parties’ marks.

[30] As for the ideas suggested, as QUALTRICS is a not an ordinary word of the English or French language, it does not suggest any idea in particular, aside from that of a coined term. Similarly, the QUANTRICS element of the Mark does not suggest any idea in particular, although the words “people powered” could be seen as somewhat suggestive of the character of the Services (in that the call centres would be operated by people). I find that when all three aspects of resemblance are considered, the marks in issue are more alike than different. Accordingly, this factor favours the Opponent.

Conclusion

[31] Having considered all of the surrounding circumstances, in particular the degree of resemblance between the trademarks, and the fact that there is at least some potential for overlap in the Services of the parties, I find that at best for the Applicant, the probability of confusion is evenly balanced between a finding of confusion and no confusion. As the onus is on the Applicant to demonstrate on a balance of probabilities that there is no reasonable likelihood of confusion between the marks, I must therefore find against the Applicant. Accordingly, this ground of opposition is successful.

Grounds of opposition summarily dismissed

Sections 16(1)(a), 16(1)(c) and 2 grounds

[32] These three grounds of opposition all turn on the issue of confusion between the Mark and one of more of the Opponent's trademarks or trade names.

[33] At the outset, I note that as the subject Application is based on proposed use in Canada, the non-entitlement grounds of opposition pleaded by the Opponent should have been pleaded under sections 16(3)(a) and (c) of the Act instead of 16(1)(a) and (c). However, since these grounds were otherwise set out in sufficient detail for the Applicant to reply, I am prepared to treat this as a typographical error and consider the grounds as if they had been properly pleaded.

[34] An opponent meets its evidentiary burden under sections 16(3)(a) and 16(3)(c) of the Act if it shows that as of the date of filing of the application for the mark in Canada, the opponent's trademark or trade name had been previously used or made known in Canada and had not been abandoned as of the date of advertisement of the applicant's application [section 16(5) of the Act]. In this case, the Opponent has simply provided the particulars of the two trademark registrations on which it intends to rely (Anastacio affidavit, Exhibit A); this is insufficient to establish prior use of the Opponent's trademarks or its trade name. The Opponent has therefore not met its burden under either of these grounds.

[35] For the ground of opposition pleaded under section 2, there is an initial burden on the Opponent to establish that as of the filing of the opposition, its trademarks were known to a sufficient extent that could negate the distinctiveness of the applied-for Mark [*Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. To do so, the Opponent must establish that its trademarks are either known to some extent in Canada or are well known in a specific area of Canada [*Bojangles* at paras 33-34]. In this case, the Opponent has filed no evidence demonstrating the extent to which either of its trademarks have become known in Canada.

[36] As the Opponent has failed to meet its initial evidentiary burden, these grounds of opposition are summarily dismissed.

Section 30(i) ground

[37] The Opponent has pleaded that contrary to section 30(i) of the Act, any use by the Applicant of the Mark will damage and depreciate the goodwill of the marks which are the subject of the QUALTRICS Registrations contrary to section 22 of the Act and, therefore, the Applicant could not be entitled to, or be satisfied that it is entitled to, registration of the Mark, in view of the length of use and notoriety of the Opponent's QUALTRICS Registrations.

[38] Where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Application for the Mark contains the requisite statement and there is no evidence that this is an exceptional case.

[39] Further, the Opponent has failed to adduce any evidence of a depreciation of goodwill of any of the Opponent's registrations as required to show a violation of section 22 of the Act [*Veuve Clicquot* at para 46].

[40] Accordingly, this ground of opposition is summarily dismissed.

DISPOSITION

[41] In view of the above, 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.

Jennifer Galeano
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2021-02-25

APPEARANCES

Kenneth McKay

FOR THE OPPONENT

No one appearing

FOR THE APPLICANT

AGENT OF RECORD

Marks & Clerk

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FOR THE APPLICANT