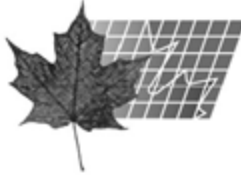


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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 143

Date of Decision: 2021-07-15

IN THE MATTER OF AN OPPOSITION

**Symantec Corporation and Veritas
Technologies LLC**

Opponents

and

Det Norske Veritas AS

Applicant

1,418,863 for DET NORSKE

Application

VERITAS

INTRODUCTION

[1] Det Norske Veritas AS (the Applicant) has applied for registration of the trademark DET NORSKE VERITAS (the Mark) based on use and registration in Norway and on proposed use in Canada in association with a variety of goods and services, including among others, goods classified under Nice class 9. It is unnecessary to reproduce the statement of goods and services covered by the application for the Mark in its entirety as only the following goods are at issue in this proceeding:

computer software for designing, testing and standards certification of ports; computer software for administration of port arrivals, port clearance and sailing through controlled passages, vessel operation, vessel operator training, port construction, strength assessment of vessels, risk and information management and analysis, database

management, web hosting; computer software for providing technical business support, namely software for troubleshooting, diagnosis and resolution of problems with port arrivals, port clearance and sailing through controlled passages, vessel operation and port construction

(the Relevant Goods)

[2] Symantec Corporation and Veritas Technologies LLC (collectively, the Opponent) oppose registration of the Mark in association with the Relevant Goods mainly on the basis that the Mark is confusing with the trademarks VERITAS (TMA804,307) and VERITAS & Design (TMA568,853 and TMA611,903) (collectively, the Opponent's Registered Trademarks or the VERITAS Marks, the particulars of which are included in Schedule A below).

[3] For the reasons that follow, the opposition is rejected.

FILE RECORD

[4] The application for the Mark was filed on November 19, 2008 and advertised for opposition purposes in the *Trademarks Journal* on November 26, 2014. On January 26, 2016, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). All references in this decision are to the Act as amended on June 17, 2019, with the exception of references to the grounds of opposition which refer to the Act before it was amended.

[5] The statement of opposition (as last amended by the Opponent with leave from the Registrar granted on September 18, 2018) raises grounds of opposition based upon non-compliance with section 30; non-registrability under section 12; non-entitlement under section 16; and non-distinctiveness under section 2 of the Act, as reproduced in full in Schedule A below.

[6] The Applicant filed and served a counter statement denying the grounds of opposition.

[7] In support of its opposition, the Opponent filed:

- The affidavit of Bonnie Roy, a Trademarks Assistant employed by the agents representing the Opponent, dated September 27, 2016 along with Exhibits BR-1 and

BR-2 thereto (the Roy affidavit). Ms. Roy introduces into evidence certified copies of trademark registration Nos. TMA568,853; TMA611,903 and TMA804,307.

- The affidavit of Scott Minden, Senior Director, Legal for Veritas Technologies LLC, dated September 28, 2016 along with Exhibits SM-1 to SM-3 thereto (the Minden affidavit). Mr. Minden provides information with respect to the chain of title for the VERITAS Marks and to an agreement entered into between the parties in 2010 (the Agreement) pertaining to the Applicant's DET NORSKE VERITAS trademark. I will come back to this Agreement later in my decision as a disagreement in respect of its interpretation is at the root of the instant proceeding.
- The affidavit of Jennifer Fryhling, Senior Corporate Counsel for Veritas Technologies LLC, dated September 29, 2016 along with Exhibits JF-1 and JF-2 thereto (the Fryhling affidavit). Ms. Fryhling provides information with respect to the Opponent's use of the VERITAS Marks in Canada.
- The affidavit of Julia Soroko, a Law Student employed by the agents representing the Opponent, dated September 29, 2016 along with Exhibits JS-1 and JS-2 thereto (the Soroko affidavit). Ms. Soroko conducted online searches and introduces into evidence printouts of three webpages that she visited, as well as a sampling of archived versions of the following URLs between 2004-2016: *http://veritas.com* and *http://veritas.com/en/ca*.

[8] The Opponent's affiants were not cross-examined.

[9] The Applicant elected not to file any evidence. Both parties filed written arguments and only the Opponent attended the hearing.

ONUS AND MATERIAL DATES

[10] 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)]. If this burden is met, the Applicant then bears the legal onus of

establishing, on a balance of probabilities, that its application complies with the requirements of the Act.

[11] The material dates with respect to the grounds of opposition are set out below:

- Sections 38(2)(a) and 30 of the Act – the filing date of the application, namely: November 19, 2008 [*Tower Conference Management Co v Canadian Exhibition Management Inc*, (1990) 28 CPR (3d) 428 at 432-433 (TMOB)].
- Sections 38(2)(b) and 12(1)(d) of the Act– the date of the Registrar’s decision [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c) and 16 of the Act – the filing date of the application, namely: November 19, 2008 [sections 16(2) and (3) of the Act].
- Sections 38(2)(d) and 2 of the Act – the filing date of the opposition, namely: January 26, 2016 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

ANALYSIS

Section 12(1)(d) ground of opposition

[12] The Roy affidavit includes certified copies of registration Nos. TMA568,853; TMA611,903 and TMA804,307 and, having exercised the Registrar’s discretion to check the register, I confirm that they are extant.

[13] The Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and each of the Opponent’s Registered Trademarks.

Test for confusion

[14] The test to determine the issue of confusion is set out in section 6(2) of the Act which stipulates 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 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. Therefore, section 6(2) of the Act does not concern confusion of the trademarks themselves, but confusion of the goods or services from one source as being from another.

[15] In applying the test for confusion, I must take into consideration all the relevant surrounding circumstances, including those listed 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 they have been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks including in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context-specific assessment [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, where the Supreme Court of Canada, at para 49, states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

Inherent distinctiveness and extent known

[16] In my view, to the extent that the trademarks at hand are neither descriptive nor suggestive of the goods and services in association with which they are used or proposed to be used, they all possess some measure of inherent distinctiveness. The stylization and design in the trademark VERITAS & Design somewhat add in this regard, although not in a significant way. As provided by the Applicant in its application, DET NORSKE VERITAS translates to THE NORWEGIAN TRUTH. However, there is no evidence that the average English or French-speaking consumer in Canada would be aware of this meaning or would view the Mark as anything other than merely having a foreign connotation.

[17] With respect to the extent to which the respective parties' trademarks have become known, the Applicant has not presented any evidence that the Mark has been used or become known to any extent in Canada. With respect to the Opponent's VERITAS Marks, I find that the Opponent's evidence falls short of establishing the extent to which each of these trademarks has been promoted and used in Canada.

[18] The Opponent submits that its marks are highly distinctive, that they are entitled to a wide ambit of protection given their long and extensive history of use and promotion in Canada and that it has provided evidence of numerous years of consistent and substantial use and advertisement of the VERITAS Marks in Canada [Opponent's written argument, paras 69, 77 and 92]. The Opponent's evidence in this regard consists of the Fryhling and Soroko affidavits.

[19] Ms. Fryhling's evidence is comprised of:

- Representative invoices for "VERITAS goods and services sold or provided to Canadians from March 2, 2008 to April 13, 2016" [para 2, Exhibit JF-1]; and
- User manuals "bearing the VERITAS mark" for each year between 2008-2015, which she states "were provided to Canadian consumers in conjunction with the VERITAS goods and services during the period of March 2008 to October 2015" [para 4, Exhibit JF-2].

[20] With respect to the trademark VERITAS & Design, Ms. Fryhling's evidence is silent. With respect to the trademark VERITAS, I note that it is displayed in the "user manuals" which are actually "Administrator's Guides", "Installation Guides", a "Problem Management and Escalation Process Reference Guide" and an FAQ document. I also note that most of the invoices from July 2015-October 2015 contain the VERITAS moniker in the body of the invoices (for example, in descriptions such as "VERITAS NETBACKUP CLIENT APPLICATION AND DATABASE PACK 7.7 [...]", "VERITAS NETBACKUP PLATFORM BASE COMPLETE EDITION 7.7 [...]" or "VERITAS NETBACKUP OPTION LIBRARY BASED TAPE DRIVE 7.7 [...]"), while a number of the earlier invoices from January 2008-March 2014 contain the abbreviation VRTS also in the body of the invoices (for example, in descriptions such as "VRTS NETBACKUP OPTION LIBRARY BASED TAPE DRIVE 6.5 [...]"). Ms. Fryhling asserts that

the abbreviation VRTS that appears in some of the invoices “refers to the trademark VERITAS” [para 3]. I also note that, starting in December 2015, the body of the invoices no longer shows any such references, though VERITAS starts being displayed in red stylized font with a TM symbol in their top left corner next to the trade name Veritas Technologies LLC and to the Opponent’s contact information.

[21] That being said, there is no evidence of the manner, timing or extent of distribution of the Opponent’s exhibited manuals. Further, Ms. Fryhling does not provide annual or total sales figures, the number of units sold throughout the years or quantify the Opponent’s Canadian consumers. What is more, Ms. Fryhling does not qualify what she means when she refers to “VERITAS goods and services”. Ms. Fryhling does not correlate any of the invoices with specific registered goods or services, she does not refer to any of the Opponent’s software goods or services individually, nor otherwise provide insight in this regard. There are many invoices and multiple user guides as well as various goods and services covered by the Opponent’s relied-upon registrations. For the Registrar to determine which of the Opponent’s goods or services are represented in the evidence would require an exercise in conjecture and it is not up to the Registrar to speculate on these documents. Therefore, notwithstanding the Opponent’s submissions at the hearing that the invoices on record total approximately \$3.7 million in sales value, given the ambiguity surrounding the nature of the goods and services sold, I have to agree with the Applicant that the representative invoices “for VERITAS goods and services” and manuals provided “in conjunction with the VERITAS goods and services” which are attached to Ms. Fryhling’s affidavit are of limited assistance.

[22] Ms. Fryhling provides no other evidence with respect to the Opponent’s use or the promotion and advertising of its marks. Instead, some such information purports to be included via the Soroko affidavit.

[23] As mentioned above, Ms. Soroko’s evidence is comprised of:

- Printouts from the following webpages she visited:
 - (i) <http://www.prnewswire.com/news-releases/veritas-software-invites-it-professionals-to-get-serious-about-storage-75763052.html> - this page depicts a

September 2002 article showcasing storage management seminars to be offered across Canada and the United States by Veritas Software Corporation;

- (ii) <http://www.itworldcanada.com/article/veritas-rolls-client-support-into-netbackup/22146> - this page depicts a November 2003 article announcing the launch of a variety of updates as well as new software products by Veritas Software Corporation; and
- (iii) <https://www.veritas.com/customer-success/canadian-financial-institution.html> - this is a printout of the “Customer Success” page from the Opponent’s website showcasing that a “Canadian Financial Institution” “used” the Opponent’s “Veritas eDiscovery Platform”.

[paras 2-3, Exhibit JS-1]

- A sampling of archived versions of the websites <http://www.veritas.com> and <http://www.veritas.com/en/CA/> from 2004-2016. [paras 4-6, Exhibit JS-2]

[24] Notwithstanding the question of its admissibility, I do not find Ms. Soroko’s evidence to be of much assistance to the Opponent here as it contains little relevant or reliable information as to whether the VERITAS Marks had been used in Canada or were known to Canadians. At best, the excerpts under Exhibits JS-1 and JS-2 to her affidavit establish that the various webpages existed at the time Ms. Soroko performed her searches. The webpages do not speak to the truth of their contents and there is no evidence showing if any of them were accessed by consumers in Canada, nor to what extent if they were. In this respect, the Opponent’s submission at the hearing that it is unlikely that Canadians have not ventured on or used the Opponent’s website is not helpful in determining the extent to which this might have occurred. Similarly, I cannot subscribe to the proposal that Ms. Soroko’s evidence shows media recognition for any of the VERITAS Marks in Canada.

[25] Accordingly, I find that the overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness of the parties’ trademarks, does not significantly favour either party.

Length of time in use

[26] As mentioned above, the Applicant has not demonstrated any use of its Mark which is based on proposed use in Canada as well as use and registration in Norway.

[27] With respect to the Opponent's relied-upon marks, the particulars for registration No. TMA804,307 show a claim of use in Canada since at least as early as December 1995 and those for registration Nos. TMA568,853 and TMA611,903 indicate that declarations of use were respectively filed on October 8, 2002 and May 6, 2004. However, as discussed above, the Opponent's evidence does not demonstrate actual use of the VERITAS Marks in association with the registered goods and services, let alone use since 1995, 2002 or 2004.

[28] Absent further evidence, I can only infer *de minimis* use of the Opponent's trademarks from the certificates of registration filed [*Tokai of Canada v Kingsford Products Company, LLC*, 2018 FC 951 at para 37; *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. Such an inference, however, does not support the finding that the Opponent's VERITAS Marks were known to any significant extent or that they have necessarily been used continuously since the dates respectively claimed or declared [*Krauss-Maffei Wegmann GmbH & Co KG v Rheinmetall Defence Electronics GmbH*, 2017 TMOB 50 at para 20].

[29] Accordingly, I find that this factor also does not favour either party.

Nature of the goods, services, businesses and trade

[30] The Opponent, submits that both the application for the Mark and the VERITAS Marks are in association with IT related goods and services and that the Opponent's IT goods and services could be used by the same consumers, and in the same vicinities, as Applicant's [Opponent's written argument, paras 71-79]. At the hearing, the Opponent further submitted that there is a point of overlap between the Relevant Goods and a number of its registered goods and services, selected examples of which I reproduce below:

computer software for use in data storage, server, and service management and storage area networks; [...] computer software for use in the field of enterprise information management; computer software for use in the field of online analytical processing (OLAP); computer software for generating reports from databases;

[registration No. TMA804,307]

providing computer consulting, computer support and computer software design services;
[registration No. TMA611,903]

[31] The Applicant submits that although the goods and services associated with both parties' trademarks cover computer software, computer programs are ubiquitous in today's society and may cover various topics in different fields without any connection whatsoever and which would not lead to a likelihood of confusion. Considering the area of use and the specific function of the goods or services associated to each trademark, the Applicant submits that confusion is unlikely to occur. In particular, the Applicant submits that its software is designed to be used in the maritime industry, particularly in connection with vessels and ports related functions, while the goods or services covered by the Opponent's VERITAS Marks have a close connection with data protection and storage management software. [Applicant's written argument, paras 38-46]

[32] First, when considering the nature of the goods and services and the nature of the trade, it is ultimately the statements of goods or services in the parties' trademark application or registration that govern. These statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. I don't believe that it is relevant in this respect to discuss the Agreement.

[33] That being said, there is clearly overlap between the parties' general category of goods and services to the extent that the trademarks all cover software. There is also overlap or at the very least a connection with respect to the specific functions of some of the software covered. For example, the Relevant Goods list "computer software for [...] information management and analysis, database management, web hosting". Absent further specification, such software could arguably include data protection or information storage management functions or capabilities. Also, these goods list no restrictions as to their areas of use.

[34] Lastly, absent any information provided in this respect, it is difficult to assess if there is similarity or overlap in the nature of the parties' channels of trade.

Degree of resemblance

[35] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. The appropriate test is not a side-by-side comparison but an imperfect recollection in the mind of a consumer of an opponent's trademark [*Veuve Clicquot* at

para 20]. The preferable approach is to begin the confusion analysis by determining whether there is an aspect of each trademark that is particularly striking or unique [*Masterpiece* at para 64].

[36] The striking aspect of the Opponent's Registered Trademarks is the word VERITAS. It follows that there is resemblance between the marks to the extent that this element forms part of the Mark and, in as much as consumers are aware that VERITAS means truth, that all trademarks at issue therefore suggest the idea of truth.

[37] The Opponent submits that the striking aspect of the Mark is also VERITAS. The Opponent argues that the word NORSKE is highly similar to the English dictionary word NORSE which means according to the Oxford Dictionary of English "Norwegians or Scandinavians in ancient or medieval times". The Opponent further refers to the fact that DET NORSKE in the Mark translates to THE NORWEGIAN. The Opponent is therefore of the view that the first impression of the average consumer would likely be that this component denotes a geographical origin thus making it a weak, non-dominant component. [Opponent's written argument, paras 61-66]

[38] I disagree. The Mark does not strike me as having one dominant aspect over another. In other words, the striking aspect of the Mark is the phrase DET NORSKE VERITAS as a whole. As mentioned above, no evidence has been adduced to show that the average consumer would be aware of the Mark's meaning or would necessarily perceive it as containing a reference to a geographical location. In my view, the Mark will therefore likely be viewed as a unitary term, a foreign one at that. I further note that the parties' trademarks are not similarly structured (given the presence of two additional words in the Mark) which makes them visually and aurally different. There is also a conceptual distinction in that the Mark as a whole could arguably suggest a coined phrase or foreign connotation in the mind of consumers.

[39] All in all, when considered as a whole, I find that the parties' trademarks are more different than alike. Accordingly, I find that this factor favours the Applicant.

Surrounding circumstances – Estoppel by convention

[40] The Opponent submits that the Applicant is estopped by convention from alleging and pleading the absence of a likelihood of confusion due to the Applicant's default to comply with the Agreement and as such this is a surrounding circumstance which significantly favours it.

[41] Veritas Technologies LLC is the successor in interest of Symantec Corporation and Symantec Operating Corporation with respect to certain worldwide trademark rights, including the VERITAS Marks. In 2010, the Applicant and Symantec Operating Corporation (a subsidiary of Symantec Corporation) entered into the Agreement, which provided among other things that the Applicant was to amend its Nice class 9 description of goods contained in the application for the Mark to remove "computer programs and software, downloadable software, recorded software, computer databases" and replace such terms with the following description for computer software ("or a substantially similar description"):

Computer software and computer databases for testing, certification, qualification, inspection, operation, safety management of equipment, design, construction, strength assessment, qualitative and quantitative risk assessment, all for use in process industry (the industrial processing of raw materials), chemical industry, petrochemical industry, offshore industry, maritime industry, aerospace, automotive, finance, food and beverage, healthcare, IT & Telecom, oil, gas and energy, biorisk, climate change, corporate responsibility, hospital accreditation, IT software and systems, operational excellence, quality management, risk management, railroads.

[Minden affidavit, paras 4-12, Exhibits SM-1 to SM-3; Opponent's written argument, paras 28-36 and 80-81]

[42] According to the Opponent, the Applicant then failed to amend the application for the Mark, contrary to the undertaking it took in the Agreement. The Opponent submits that the Agreement should be interpreted and held against Applicant, that the Registrar cannot ignore the Agreement and must take it into consideration and give it considerable weight in the context of the analysis of the likelihood of confusion. As such, the Opponent submits that the Agreement is determinative of the issue of confusion and that not only should the Agreement be treated as an admission by the Applicant as to the likelihood of confusion, but that the Registrar should conclude that considering the Agreement, the Applicant is estopped by convention from alleging

and pleading the absence of a likelihood of confusion between the parties' respective trademarks. [Opponent's written argument, paras 82-87]

[43] The Opponent refers to the decision in *Ryan v Moore*, 2005 SCC 38 at paras 54, 59 and 73 in which the Supreme Court provides guidance as to the applicable criteria of estoppel by convention, and submits that by signing the Agreement, the Applicant implicitly agreed that the use of its trademark would lead to confusion in the marketplace, unless the Applicant proceeded to amend its application and limit its use to what is described in the application as amended. The Opponent also argues that it would be unfair and unjust to allow the Applicant to act as if it had never signed the Agreement. [Opponent's written argument, paras 88-90]

[44] Lastly, the Opponent submitted at the hearing that disregarding an agreement such as the one entered into between the parties to this proceeding would convey an unfortunate message as to enforceability and may dissuade other parties from entering into similar agreements. What is more, the Opponent submitted that a way for the Registrar to positively contribute and "enforce" such agreements would be to treat them as (implicit) admissions of confusion.

[45] According to the Applicant, the Relevant Goods are substantially similar to the description provided in the Agreement and so the Applicant has not failed to fulfill its obligations. Additionally, the Applicant submits that the existence of an Agreement between the parties and of the mutual obligations contained therein should not be taken into consideration by the Registrar as a surrounding circumstance with respect to the issue of confusion between the marks. In this regard, the Applicant argues that no weight should be given to the presence of the Agreement in the determination of a likelihood of confusion between the trademarks at issue and that the Opponent's allegation to the effect that the Applicant has failed to comply with its obligations arising from the Agreement should simply be disregarded. [Applicant's written argument, paras 44-49]

[46] Although the Registrar has been consistently reluctant to permit claims for estoppel, I note that the applicability of the doctrine in opposition proceedings (especially outside the *res judicata* context) has not been outright rejected. However, owing to the public interest in maintaining the purity of the register, a very high bar must be met for estoppel to be permitted in an opposition context. More than once, have estoppel arguments been considered on their merits

in cases before the Registrar; often, though claims for estoppel were rejected, prior statements or actions by parties suggesting waiver of rights or contradictory positions have instead been considered as surrounding circumstances [see for example *Asset Inc v Park It & Sell It of Canada Ltd*, 2007 CanLII 80801 (TMOB), which also suggests that an agreement between parties – opposed to mere correspondence or negotiations – may be sufficient to meet the high bar required by jurisprudence].

[47] That being said, I am not satisfied that the Agreement in the instant case raises to this bar.

[48] In order for estoppel to be created as set out in *Ryan v Moore* as submitted by the Opponent, there must be a common assumption shared by both parties. I am not satisfied that the evidence actually establishes that the assumption mutually relied upon by the parties here was a “serious risk of confusion” as alleged by the Opponent and I cannot subscribe to the Opponent’s contention that the mere existence of the Agreement, as drafted, presupposes an admission of confusion on the part of the Applicant. The Agreement’s preamble is brief and contains no detailed statements of intent or acknowledgments beyond those pertaining to respective trademark ownership. There is also a lack of specifics on record regarding the parties’ negotiations or the cause of their need for agreement(s) and, while confusion may factor in, I note that there are various other considerations which can motivate parties to enter into worldwide agreements pertaining to their trademarks. Absent further evidence on this point, the proposition that confusion would necessarily be the sole reason for the Agreement (or for any agreement such as the one entered into between the parties for that matter) is at the very least an oversimplification of party relationships. In addition, the fact that the parties have alternate views with respect to Agreement terms raises questions as to the nature of their “shared” assumption(s), not to mention the fact that the Agreement is governed by Norwegian law which also raises questions with respect to its interpretation [for an analogous finding see *Valint NV v Mario Valentino SpA* (1997), 79 CPR (3d) 164 at 179-180 (TMOB); this decision was affirmed by the Federal Court in 4 CPR (4th) 1 wherein the Court, stating that the oppositions filed by the opponent may be contrary to the terms of an agreement between the parties, also noted that the Act does not provide a forum in which to compel the enforcement of such terms]. Based on the foregoing, comparing the agreed upon goods with the Relevant Goods or discussing whether or not “the maritime industry” and “ports” are substantially similar areas of use is unnecessary.

[49] Accordingly, I am not inclined in the circumstances to draw any negative inferences from the Agreement against the Applicant and I do not consider the Agreement to be a surrounding circumstance favouring the Opponent.

Conclusion on the likelihood of confusion

[50] Having considered all of the surrounding circumstances, I find that the Applicant has met its onus to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and each of the Opponent's Registered Trademarks. I reach this conclusion mainly as I find that the differences between the trademarks at hand outweigh the overlap which exists with respect to the parties' goods and services.

[51] Accordingly, the section 12(1)(d) ground of opposition is rejected.

Sections 16 and 2 grounds of opposition

[52] Because of the later material date, the Opponent's case with respect to confusion is strongest under the section 12(1)(d) ground of opposition. Given that the Opponent was not successful under this ground, it will also not succeed under the section 16 and section 2 grounds of opposition as they rely on the same trademarks and a very similar name. Specifically, these grounds of opposition fail for reasons analogous to those discussed under the section 12(1)(d) ground either because the Opponent has not discharged its evidential burden or as I find, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's relied upon trademarks and trade name as of the application filing date (mainly in view of the insufficient degree of resemblance between them).

Section 30(i) ground of opposition

[53] Alleging that the Mark is confusing with the VERITAS Marks and relying on the Fryhling and Soroko affidavits, the Opponent submits that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada considering the Opponent's extensive use of the VERITAS Marks prior to the date of filing of the application. Further, considering its important prior use and goodwill, the Opponent submits that the Applicant was unable to assert that its use would not be in breach of both sections 7(b) and 22(1) of the Act. Relying on the

Minden affidavit, the Opponent also submits that the Applicant's failure to comply with the Agreement should be taken into consideration in the analysis of this ground. In this respect, the Opponent argues: that the Agreement constitutes an admission of likelihood of confusion flowing from the wording included in the Application, as well as evidence of the Applicant's awareness of the existence of such risks; that the Applicant's default to comply with the Agreement should be interpreted and held against Applicant; and that said default should also lead to the Applicant being estopped by convention from pleading the absence of a likelihood of confusion between the parties' marks. [Opponent's written argument, paras 95-119]

[54] At the hearing, the Opponent also submitted that an earlier agreement entered into between the parties in 2004 (referred to in section 6 of the Agreement) should be construed as evidence of the Applicant's bad faith.

[55] While the Applicant likely knew of the Opponent and of its relied-upon trademarks, mere awareness of the existence of the Opponent's trademarks or confusion with the Opponent's VERITAS Marks alone, does not support the allegation that the Applicant could not have been satisfied of its entitlement to use the Mark. Section 30(i) of the Act requires that an applicant include a statement in its application that it is satisfied that it is entitled to use of its trademark. Where this statement has been provided, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith. The application for the Mark contains the required statement and the Opponent's pleadings under this ground do not include an allegation of bad faith. Besides, the evidence at hand would not have substantiated such allegation. The relevant date for section 30(i) is the date of filing of the application and there is no evidence regarding the parties' dealings prior to 2010. The reference to a 2004 agreement contained in Mr. Minden's evidence, without more, would not have sufficed to meet the Opponent's evidential burden with respect to bad faith.

[56] Further, the Opponent has failed to meet its initial evidential burden with respect to its allegation that the Applicant could not be satisfied it was entitled to use the Mark in view of a combination of section 30(i) with section 7(b) or 22 of the Act. As per my review above, I am not satisfied that the Opponent's evidence supports any of the requisite components of a passing off action [as set out in *Ciba-Geigy Canada Ltd v Apotex Inc*, [1992] 3 SCR 120 at 132 cited by

Pharmacommunications Holdings Inc v Avencia International Inc, 2008 FC 828 at para 41] nor does it support a likelihood of depreciation of goodwill which would establish a section 22 violation [as set out in *Veuve Clicquot* at paras 46, 63-68].

[57] Accordingly, the section 30(i) ground of opposition is also rejected.

DISPOSITION

[58] Having regard to the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Iana Alexova
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A



Excerpts from the re-amended statement of opposition

[...]

The grounds of opposition are as follows:

1. The Opponents rely upon section 38(2)(a) of the Trade-Marks Act (the « Act ») and state that the application does not conform to section 30 of the Act, more specifically that:
 - a) the Applicant was not, and could not have been satisfied, at the time the Application was filed, that it was entitled to use and/or register the Subject Mark in Canada in association with « computer software for designing, testing and standards certification of ports; computer software for administration of port arrivals, port clearance and sailing through controlled passages, vessel operation, vessel operator training, port construction, strength assessment of vessels, risk and information management and analysis, database management, web hosting; computer software for providing technical business support, namely software for troubleshooting, diagnosis and resolution of problems with port arrivals, port clearance and sailing through controlled passages, vessel operation and port construction » (the « Relevant Goods ») in view of the Applicant's knowledge, at the time of the filing of the Application, of the lack of distinctiveness of the Subject Mark in association with the Relevant Goods due to the Opponent Symantec's and Opponent Symantec's predecessors in title prior use of the following trade-marks and breach of section 7(b) of the Act with respect to the Relevant Goods due to the Opponents' prior use of the following trade-marks, contrary to section 30(i) of the Act :

Reg. No.	Trade-Mark	Wares/Services
TMA804,307	VERITAS	(1) Computer software for use in file, disk and systems management; computer software for use in data storage, server, and service management and storage area networks; computer software for backing up and restoring computer data; computer software for use in disaster recovery; computer software for use in removable storage media management; computer software for monitoring, identifying, and rectifying file, disk, system, and computer network problems and errors; computer software for use in the field of enterprise information management; computer software for use in the field of online analytical processing (OLAP); computer software for generating reports from databases; computer software for scheduling automated processes; computer software for use in the central management of computers attached to a computer network; computer software for replicating and archiving files from one data store to another; computer software for metering the use of other computer software; computer software for use in

		developing data analysis applications and other computer software; computer software for accessing, managing and setting up storage networks, computers, and operating systems; computer software for monitoring, analyzing, reporting, and solving performance issues of application software, databases, network, storage, and other computer components and programs; instruction manuals supplied in electronic form; electronic publications.
TMA611,903	 VERITAS	(1) Providing access to text, graphics, audiovisual content, databases, and on-line information services pertaining to computers, computer software, computer hardware, computer networks and computer-related services, to computer users via computer and communication networks, including the Internet; provision of information regarding computers, computer software, computer hardware, computer networks, computer-related services, data storage management, enterprise information management and on-line analytical processing (OLAP); providing on-line electronic bulletin boards for the posting and exchange of messages among computer users; providing on-line chat rooms for the transmission of messages, data, motion video among computer users; computer programming for others; providing computer consulting, computer support and computer software design services; remote or on-site monitoring of computer systems; monitoring the computer systems of others and providing back-up computer programs and facilities.
TMA568,853	 VERITAS	(1) Computer utility software; computer software for use in file, disk and systems management; computer software for use in data storage management and storage area networks; computer software for backing up and restoring computer data; computer software for use in disaster recovery; computer software for defining, evaluating, safeguarding, collecting, distributing, organizing, storing, manipulating, controlling, and sharing data in the field of enterprise information management; computer software for defining, evaluating, safeguarding, collecting, distributing, organizing, storing, manipulating, controlling, and sharing data in the field of online analytical processing (OLAP); computer software for generating reports from databases; computer software for scheduling automated processes; computer software for use in the central management of computers attached to a computer network; computer software for replicating and archiving files from one data store to another; computer software for metering the use of other computer software books, magazines, newsletters, work books, quick reference guides, technical reference manuals and conference

		<p>materials; computer software for use in developing data analysis applications and other computer software; computer software for use in deploying and updating operating system and application software over computer networks; computer software for use in management and administration of local, wide, and storage area networks; instruction manuals supplied as a unit with the foregoing; computer user manuals; printed matter and publications, namely books, magazines, newsletters, work books, quick reference guides, technical reference manuals, computer user manuals and conference materials in the field of computers, computer software, computer peripherals, and computer networks; computers; computer hardware; computer peripherals; disk drives; tape drives; flash memory devices.</p>
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hereinafter collectively referred to as the « VERITAS Marks ».

- b) The Applicant could not, at the date of filing of the Application, have been satisfied that it was entitled to use the Subject Mark in Canada in association with the Relevant Goods since such use would be unlawful in that at the date of filing the Application, the Applicant was aware of the confusingly similar VERITAS Marks of the Opponents, of the extensive use and advertising of those trade-marks in Canada by Opponent Symantec and Opponent Symantec’s predecessors [*sic*] in title, and that its use in association with the Relevant Goods was and is likely to have the effect of depreciating the value of the goodwill attaching to Opponents’ VERITAS Marks, contrary to section 22(1) of the Act.
2. Pursuant to paragraph 38(2)(b) of the Act, the Subject Mark is not registrable in association with the Relevant Goods having regard to the provisions of paragraph 12(1)(d) of the Act in that the Subject Mark is confusing with Opponent Veritas’ above-identified registered trade-marks (TMA804,307, TMA611,903 and TMA568,853) which are and have been widely used and made known in Canada by Opponents and their predecessors in title and in association with the goods and services listed in said registrations.

Moreover, Applicant and Opponent Symantec entered into an Agreement in April 2010 (the « Settlement Agreement ») pursuant to which Applicant undertook to amend the Application with respect to the Relevant Goods to avoid confusion, which Applicant failed to comply with.

3. Pursuant to paragraph 38(2)(c) of the Act, the Applicant is not the person entitled to registration of the Subject Mark in association with the Relevant Goods having regard to paragraph 16(3)(a) of the Act in that, at the date of filing of the Application, the Subject Mark was confusing with Opponent Symantec’s VERITAS Marks, which are and had been widely used, and made known in Canada, by the Opponent Symantec (including its predecessor-in-title) in association with the goods and services set out above prior to the filing date of the Application, which VERITAS Marks were subsequently assigned to and used by Opponent Veritas.

4. Pursuant to paragraph 38(2)(c) of the Act, the Applicant is not the person entitled to registration of the Subject Mark in association with the Relevant Goods having regard to paragraph 16(3)(c) of the Act in that, at the date of filing of the Application, the Subject Mark was confusing with Opponent Symantec's VERITAS trade-name, which was and had been widely used, and made known in Canada, by the Opponent Symantec (including by its predecessors in title) in association with its business in the field of information technology prior to the filing date of the Application, which trade-name was subsequently assigned to and used by Opponent Veritas.
 - 4.1 Pursuant to paragraph 38(2)(c) of the Act, the Applicant is not the person entitled to registration of the Subject Mark in association with the Relevant Goods having regard to paragraph 16(2)(a) of the Act in that, at the date of filing of the Application, the Subject Mark was confusing with Opponent Symantec's VERITAS Marks, which are and had been widely used, and made known in Canada, by the Opponent Symantec (including its predecessor-in-title) in association with the goods and services set out above prior to the filing date of the Application, which VERITAS Marks were subsequently assigned to and used by Opponent Veritas.
 - 4.2 Pursuant to paragraph 38(2)(c) of the Act, the Applicant is not the person entitled to registration of the Subject Mark in association with the Relevant Goods having regard to paragraph 16(2)(c) of the Act in that, at the date of filing of the Application, the Subject Mark was confusing with Opponent Symantec's VERITAS trade-name, which was and had been widely used, and made known in Canada, by the Opponent Symantec (including by its predecessors in title) in association with its business in the field of information technology prior to the filing date of the Application, which trade-name was subsequently assigned to and used by Opponent Veritas.
5. The Subject Mark is not distinctive of the Relevant Goods, within the meaning of section 2 of the Act, since the trade-mark does not actually distinguish nor is it adapted to distinguish such goods in association with which it was proposed to be used by the Applicant from the goods of those of the Opponents contrary to section 38(2)(d) of the Act. Specifically, the Subject Mark is not distinctive considering the prior and continuing use and/or making known of certain trade-names and trade-marks including without limitation, those previously referred to in paragraphs 3 and 4.

Moreover, as mentioned previously, Applicant and Opponent Symantec entered into a Settlement Agreement in April 2010 pursuant to which Applicant undertook to amend the Application with respect to the Relevant Wares to avoid confusion, which Applicant has failed to comply with.

[...]

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

HEARING DATE 2021-03-04

APPEARANCES

Michael Shortt	For the Opponents
No one appearing	For the Applicant

AGENTS OF RECORD

All the trademark agents at FASKEN MARTINEAU DUMOULIN LLP	For the Opponents
All the trademark agents at ROBIC	For the Applicant