

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 016

Date of Decision: 2022-01-31

IN THE MATTER OF FOUR OPPOSITIONS

Huawei Technologies Co., Ltd.

Opponent

and

Optiv Inc.

Applicant

1,722,065 for OPTIV

Applications

1,726,650 for OPTIV SECURITY

1,728,538 for OPTIV Design

1,728,539 for OPTIV SECURITY Design

[1] Huawei Technologies Co., Ltd. (the Opponent) opposes applications currently standing in the name Optiv Inc. (the Applicant) to register the trademarks OPTIV, OPTIV Design, OPTIV SECURITY, and OPTIV SECURITY Design (collectively, the Marks). OPTIV Design consists of the word OPTIV in plain capital lettering with the O partially reflected above and below, while OPTIV SECURITY Design is the same design with the word SECURITY added in smaller such lettering below the letters P T I V, as shown below:



OPTIV Design



OPTIV SECURITY Design



[2] The oppositions against these four trademark applications (collectively, the Applications) are based primarily on the Opponent’s allegation that the Marks, which are intended for use in association with computer hardware and cyber security software and various services in the cyber security and business sectors, are confusing with the Opponent’s trademark OPTIX Design (the Opponent’s Trademark) registered for use in association with computer hardware and communications software and apparatus. The Opponent’s Trademark consists of the word OPTIX in plain lettering with only the first and last letters capitalized, as shown below:



[3] For the reasons that follow, each of the oppositions is rejected.

THE RECORD

[4] The Applications were all filed in 2015 by 327 Holdings, LLC, which merged into the Applicant on Sept 19, 2016. The merger was recorded by the Registrar on February 13, 2017 and is not at issue in this proceeding. The Applications for the two word marks were filed first and claim priority to the date that corresponding applications were filed in the United States. The table below summarizes the four Applications’ serial numbers, filing dates, and priority filing dates:

Trademark	Application Number	Filing Date	Priority Filing Date	Corresponding U.S. App. No.
OPTIV	1,722,065	April 1, 2015	March 27, 2015	86/579,559
OPTIV SECURITY	1,726,650	May 4, 2015	March 27, 2015	86/579,587
OPTIV Design 	1,728,538	May 19, 2015	N/A	N/A
OPTIV SECURITY Design 	1,728,539	May 19, 2015	N/A	N/A

[5] The Applications are based on proposed use in Canada in association with the goods and services set out in Schedule A hereto. As noted in Schedule A, there is one difference in the statement of services for OPTIV: it refers to “24/7 service desk or help desk services” whereas the specifications in the remaining Applications refer to “24/7 service desk and help desk services” (emphasis added). This difference is of no consequence in the present proceeding.

[6] The Application for OPTIV was advertised for opposition in the *Trademarks Journal* on July 13, 2016 and opposed on September 13, 2016, when the Opponent filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The remaining Applications were advertised for opposition on August 24, 2016 and opposed on October 20, 2016. The specific grounds of opposition are the same in each case and are based on the following sections of the Act: 30(a), 30(e), and 30(i) (compliance with formal requirements); 12(1)(d) (registrability of the trademark); 16(3)(a) (entitlement to registration); and 2 (distinctiveness of the trademark). The scope of the entitlement ground in each case is limited by an interlocutory ruling issued on February 8, 2017. The Applicant filed counter statements denying each of the grounds of opposition on February 22, 2017.

[7] Numerous amendments to the Act came into force on June 17, 2019. Pursuant to the transitional provisions in section 70 of the Act for applications advertised before June 17, 2019, the grounds of opposition will be assessed based on the Act as it read immediately before amendment, an exception being that the definition of confusion in sections 6(2) to 6(4) of the Act as it currently reads will be applied.

[8] In support of each of its oppositions, the Opponent filed a certified copy of registration no. TMA711,498 for the Opponent’s Trademark (the Opponent’s Registration).

[9] In support of each of the Applications, the Applicant filed essentially identical affidavits of Jo-Anne McConnery, a legal assistant with the Applicant’s agent, which are dated December 22, 2017. In her affidavits, Ms. McConnery provides the results of various searches she performed that day on the Canadian Trademarks Database and NUANS name search websites and using the Google and Google Scholar Internet search engines. The search results include particulars of applications and registrations for trademarks and trade names containing the element OPTIV, OPTIX, or OPTICS, as well as lists of websites using these search terms,

and printouts of related definitions, scholarly articles, and encyclopaedic publications.
Ms. McConnery was not cross-examined on her affidavit.

[10] The Applicant filed written arguments in support of its Applications for OTPIV and OPTIV Design. No other written arguments are of record. Only the Applicant was represented at an oral hearing, where all four cases were heard together.

EVIDENTIAL BURDEN AND LEGAL ONUS

[11] In an opposition proceeding, the legal onus is on the applicant to show that its application complies with the provisions of the Act. However, for each ground of opposition, 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 that ground of opposition exist. If this initial burden is met, then the applicant must satisfy the Registrar, on a balance of probabilities, that the ground of opposition should not prevent registration of the trademark at issue [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)].

GROUND OF OPPOSITION SUMMARILY DISMISSED

[12] Each of the opposition cases includes grounds that may be summarized as follows:

- The Application does not comply with section 30(a) of the Act because, in the context of the Application, the terms “computer hardware” and “computer software, namely cyber security software” in the statement of the goods do not have the required degree of specificity.
- The Application does not comply with section 30(e) of the Act because the Applicant (i) was already using the Mark in Canada in association with the listed goods and/or services at the time of filing and/or (ii) never intended to use the Mark in Canada the way it is presented in the Application or for each of the listed goods and services.
- The Application does not comply with section 30(i) of the Act because the Applicant’s statement that it is satisfied it is entitled to use the Mark was false and not made in good faith, essentially because (i) the Applicant was aware or was deemed aware of the Opponent’s Trademark and knew the Mark would create confusion with it and (ii) use of

the Mark was unlawful in that it was likely to depreciate the value of the goodwill attached to the Opponent's Trademark contrary to section 22 of the Act.

- The Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act because, at the material date, the Mark was confusing with the opponent's trademark OPTIX, previously used or made known in Canada by the Opponent or its predecessors in title (or for their benefit by licensees) for the goods and/or services in the Application and for the goods in the Opponent's Registration.
- The Mark is not distinctive within the meaning of section 2 of the Act because it does not actually distinguish the goods and/or services in the Application from the goods and/or services of the Opponent, nor is it adapted to distinguish them. In the absence of further particulars, the scope of this ground is limited to the relevant allegations contained in the statement of opposition as a whole, namely that the Mark is confusing with the Opponent's Trademark as pleaded.

[13] The Opponent has not furnished any evidence or made any written or oral representations in support of any of these allegations. Although the Opponent's Registration indicates that a declaration of use was filed on March 20, 2008, the Federal Court has cautioned against giving even *de minimis* weight to the dates of use claimed in a registration certificate [see *Tokai of Canada v Kingsford Products Company, LLC*, 2018 FC 951]. In any event, such claims in themselves are not evidence that the trademark has since been used continuously or become known to any significant extent [see *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)]. Accordingly, the foregoing grounds of opposition are each dismissed, as the Opponent has failed to meet its evidential burden.

GROUND OF OPPOSITION BASED ON REGISTRABILITY UNDER SECTION 12(1)(D) OF THE ACT

[14] The determinative issue in this proceeding is whether the Marks are registrable under section 12(1)(d) of the Act. The Opponent pleads that they are not, by reason of them being confusing with the Opponent's Trademark.

[15] The material date for this ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[16] Contrary to the Applicant's submissions at the hearing, it is well established that an opponent's initial burden is met if the registration for the trademark on which it relies is in good standing on the material date and the Registrar has discretion to check the Register in this respect [per *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Although the Applicant argued at the hearing that something more is required to shift the burden to the Applicant, no jurisprudence was provided in support of that contention.

[17] Having exercised the Registrar's discretion, I confirm that the Opponent's Registration is extant. On December 31, 2019, the Registrar issued a decision under section 45 of the Act striking certain goods from the registration; however, pending the outcome of an appeal of that decision to the Federal Court, the full list of goods remains of record. The specification of goods in the Opponent's Registration as it currently stands is reproduced at Schedule B hereto.

[18] The Opponent having met its evidential burden, the onus is now on the Applicant to satisfy the Registrar, on a balance of probabilities, that the Marks are not likely to cause confusion with the Opponent's Trademark.

[19] I will begin by considering the case with respect to Application no. 1,722,065, for the OPTIV Mark.

The test for confusion

[20] The test for confusion does not concern confusion of the trademarks themselves but rather confusion as to whether the goods and services associated with each party's trademark come from the same source. 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. The test is to be applied as a matter of first impression in the mind of a casual consumer somewhat in a hurry, who sees the applicant's trademark at a time

when he or she has no more than an imperfect recollection of the opponent's trademark and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the trademarks [*Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée*, 2006 SCC 23]. Regard must be had to all the surrounding circumstances, including those set out in sections 6(5)(a) to (e) of the Act, but these criteria are not exhaustive and the weight given to each factor will vary in a context-specific analysis [see *Veuve Clicquot, supra*; *Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22; *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27].

Section 6(5)(e): Degree of resemblance between the trademarks

[21] The degree of resemblance between the trademarks at issue is often the factor likely to have the greatest effect on the confusion analysis and thus is an appropriate starting point [*Masterpiece, supra* at para 49]. In assessing resemblance, each trademark must be considered as a whole and assessed for its effect on the average consumer as a matter of first impression; it is not the proper approach to set the trademarks side by side and carefully examine them to tease out similarities and differences. However, considering a trademark as a whole does not mean that a dominant component that would affect an average consumer's overall impression of the trademark should be ignored. The preferable approach is to begin by determining whether there is an aspect of each trademark that is "particularly striking or unique" [*Masterpiece, supra* at para 64].

[22] In the present case, the Opponent's Trademark features an unconventional spelling of the word OPTICS, in which the letters C and S are replaced by an X. I also note the unique capitalization pattern. Not only is the initial O capitalized, as one might expect, but also the X, which is the final letter and the one that generates the unconventional spelling.

[23] As for the Mark, it consists of the coined word OPTIV, which has no readily apparent meaning in connection with computers, telecommunications networks, or cyber security. While the OPTI portion brings to mind common dictionary words in both English and French beginning with those letters, such as "optic"/"optique", "optimum"/"optimum", and "option"/"option", the suffix IV appears unique in this context.

[24] Considering each trademark as a whole, there is necessarily a fair degree of resemblance between them in appearance as the only real difference is in the fifth and final letter. However, unlike the Opponent's Trademark, whose design features can be seen to divide the trademark visually into two parts—"Opti" and "X"—the Mark contains no such natural dividing line, at the letter V or otherwise. Moreover, although there is only a one letter difference between the parties' trademarks, that letter is visually emphasized by capitalization in the Opponent's Trademark.

[25] With respect to resemblance in sound, I accept that, especially in the context of goods relating to optical telecommunications apparatus and fiber optic networks, the Opponent's Trademark would readily be perceived as an intentional misspelling of the word OPTICS and would thus be sounded as the word OPTICS. Conversely, the coined word OPTIV, in my view, does not have a readily apparent pronunciation, and there is no evidence as to how consumers would be likely to sound it, for example, whether it would tend to rhyme with "relive" or "relieve" or "revive". In the circumstances, I consider there to be some resemblance in sound owing to the first portions of the trademarks being the same (particularly for unilingual francophone consumers, who would be likely to sound both final syllables with a long E). However, I find that the differing X and V sounds at the end of each trademark significantly reduce this degree of resemblance when sounded.

[26] Conceptually, I find that the ideas suggested by the parties' trademarks are different. The Opponent's Trademark suggests the English dictionary word OPTICS—which, in the context of the Opponent's goods, is in turn suggestive of optical telecommunications and fiber optic networks—and to unilingual francophone consumers may suggest the French equivalent OPTIQUE and the related notion of optical communications and fiber optics ("*fibres optiques*"). Conversely, I find that the Mark has no obvious meaning in either language and does not suggest any particular ideas in the context of the parties' goods and services.

[27] Furthermore, it is well established that, when a portion of a trademark is a common descriptive or suggestive word, its importance diminishes [see *Merial LLC v Novartis Animal Health Canada Inc.* (2001), 11 CPR (4th) 191 (FCTD)]. Accordingly, in my view, the tendency in the present case would be to discount somewhat the importance of the phonetic and

conceptual aspects of the Opponent's Trademark and to focus instead on the non-descriptive features, being the manner in which the word is presented, namely, with an intentional misspelling, capitalization on both ends, and emphasis on the letter X.

[28] In summary, although the two marks differ only by one letter, I find that this difference has a considerable impact on the degree of resemblance between the trademarks in ideas suggested and also to some extent visually and when sounded. Ultimately, the impression created by each trademark is different. On balance, I find that this factor slightly favours the Applicant.

Section 6(5)(a): Inherent distinctiveness of the trademarks and the extent to which they have become known

[29] The Applicant submits that Opponent's Trademark is not inherently distinctive because it is the phonetic equivalent of the word "optics", which is understood to be a common descriptive reference to, among other things, "fibre optics", "optics telecommunications", and "optics computer" [Applicant's written argument, para 33]. In support, the Applicant refers to the results of Ms. McConnery's searches using the Google search engine, which found definitions, encyclopaedic entries, and informational articles on optics as a branch of physics and on the related technology of fibre optics [paras 12-15, Exhibits 10-13]. The Applicant further references three scholarly articles located in the field of optical fibre communications, fibre optic networks, and fibre optics, using the Google Scholar search engine [paras 16-17, Exhibits 14-15].

[30] Indeed, I note that the statement of goods in the Opponent's Registration itself refers to fibre optics and optical communications, namely in the following descriptions (my emphasis): "transmission apparatus (for communication purposes), namely, fiber optic connectors, transmitters, add/drop multiplexers, digital cross connectors for communication purposes" and "optical telecommunication apparatus, namely, lasers and receivers used for the transmission of voice, data and video, intelligent network apparatus, namely service creating environment points, service management points, service management access points, service control points, fixed network service switching points, mobile network service switching points, intelligent peripherals-all in the nature of routers for computer networks". The remaining goods covered by the registration appear to be in the nature of hardware, software, power supply, and other devices

and equipment for use in association with such fibre optic and optical transmission and telecommunication apparatus.

[31] Conversely, the Applicant submits that its own trademark is unique and therefore inherently distinctive. In support, the Applicant refers to the results of Ms. McConnery's search of the Canadian Trademarks Database, which found the Marks to be the only trademarks containing the word OPTIV on the Register in the Applicant's field [paras 7-8, Exhibits 3-4].

[32] The Applicant also cites the well established principle that an ordinary dictionary word is less inherently distinctive and thus given less protection than a rare, unique, or invented word. This is because, unlike everyday dictionary words, "a completely made-up word may strike the imagination and become more firmly rooted in the consumer's memory" [*G M Pfaff Aktiengesellschaft v Creative Appliance Corp Ltd* (1988), 22 CPR (3d) 340 (FCTD) at para 7].

[33] Although I agree with the Applicant that the Opponent's Trademark is an ordinary dictionary word and highly suggestive if not descriptive of the nature of the Opponent's goods, I find that its design aspect, which emphasizes the final letter of the word and the unconventional spelling, provides the Opponent's Trademark with at least a slight degree of inherent distinctiveness. I agree with the Applicant that the OPTIV Mark, being a coined word with no apparent connection to Applicant's goods, has a high degree of inherent distinctiveness.

[34] Distinctiveness can be enhanced through use and promotion [see *Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD); *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)]. However, in the present case, neither party filed evidence of its trademark's use or promotion. As noted above, even if I were to infer *de minimis* use from the certificate of registration, it would not support a conclusion that the Opponent's trademark has been used continuously from the date claimed or become known to any significant extent.

[35] Overall, this factor favours the Applicant.

Section 6(5)(b): Length of time the trademarks have been in use

[36] Since the Registrar can at best infer only a *de minimis* use from a certificate of registration and since neither party filed any evidence of use of its trademark, this factor does not favour either party.

Sections 6(5)(c) and (d): Nature of the parties' goods, services, businesses and trades

[37] When considering the nature of the parties' goods, services, businesses, and trades under this ground, it is the statement of goods and services in the applicant's application and the statement of goods and services in the opponent's registration that must be assessed, having regard to the channels of trade that would normally be associated with such goods and services [*Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export* (1986), 12 CPR (3d) 110 (FCA)]. Each statement must be interpreted in a holistic manner and read with a view to determining the probable type of business or trade intended rather than all possible trades that might be encompassed by the wording [*Triangle Tyre Co, Ltd v Gestion André Touchette inc*, 2019 FC 220; *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)].

[38] The goods listed in the Opponent's Registration are primarily in the nature of communication apparatus and related equipment, but also include "computer hardware" as a general term and computer software for accessing communications networks.

[39] The identical good "computer hardware" is listed in the Application. In addition, the Application lists "computer software, namely cyber security software" and "computer software for computer security, computer network security, information security, data security and firewall security purposes". In my view, such software either overlaps with or is directly related to the Opponent's "computer software in the field of communications and telecommunications for accessing public and private networks, global computer networks, the Internet or interactive computer network", to the extent that clients purchasing software for network access would generally seek to make such access secure.

[40] I also find a strong connection between the Opponent's hardware and software goods and certain of the Applicant's services relating to computer and network hardware and cyber security

software, namely the services directed to such goods' provision, distribution, installation, integration, implementation, optimization, maintenance, and support, as well as to technical consultation and training in respect of such hardware and software, to the planning and design of network architectures, and to the provision of software-as-a-service.

[41] In my view, the remainder of the Applicant's services are also at least somewhat related to the Opponent's communication apparatus, computer hardware, and network access software, in that the services relate to cyber security, including computer security, network security, and data security. Such services include, for example, specific consultation, education, information, training, and staffing services, as well as services in the nature of research and development, planning, risk assessment, testing, analysis, audit, and regulatory compliance services, and also more specific services directly related to ensuring cyber security, in the nature of network and access management, monitoring, threat detection, investigation, mitigation, remediation, and data recovery services. Bearing in mind that, as noted above, the statement of goods and services must be read holistically and with a view to determining the probable type of business intended, I also find a strong potential in this case for the audit, assessment, and risk management services in respect of businesses and physical locations and environments to relate to cyber security.

[42] Neither party furnished evidence regarding the nature of its business or trade. However, the Opponent's Registration itself limits the Opponent's channels of trade by specifying that "all of the aforesaid products [are] not for sale to the general public at retail outlets". The Applicant's services generally appear on their face to target businesses and, in some cases, target business explicitly, for example, "providing security assessments ... for businesses and governmental agencies" and "providing an on-line interactive website for information security personnel and experts ...". Given the related nature of the goods and services at issue, and in the absence of evidence to the contrary, I consider it reasonable to infer that the channels of trade for the parties' goods and services would likely be the same or similar.

[43] The Applicant submits that the nature of the parties' respective goods and services and the way they are provided militates against any likelihood of confusion. In particular, the Applicant submits that both parties' goods and services, given their relative cost and importance

are of the type that are purchased by sophisticated clients with care and consideration, which reduces the likelihood of confusion.

[44] Indeed, the degree of care of the relevant consumer approaching a purchasing decision may vary with the circumstances [*Mattel, supra*; *Clorox Company of Canada, Ltd v Chloretec SEC*, 2020 FCA 76]. The test for confusion remains one of both first impression and imperfect recollection, even when the goods and services are expensive or important and likely to be researched by consumers; however, cost is not irrelevant to the extent that it affects the initial encounter [*Masterpiece, supra*]. In the present case, I accept that purchasers of sophisticated telecommunications network architecture or enterprise security solutions are likely to be more alert and attentive to the trademarks encountered than a casual consumer making minor purchases. This attitude decreases the likelihood of an error being made, even upon first impression and with imperfect recollection.

[45] In summary, the parties' respective businesses may have a different focus, and the relative cost and importance of such goods and services may decrease the likelihood of confusion in this particular market. Nevertheless, the goods and services are generally either overlapping or related and, on their face, appear to target the same purchasers. In the absence of evidence regarding the actual nature of the goods and services and the probable channels of trade, I find that the considerations under sections 6(5)(c) and (d) of the Act, concerning the nature of the goods, services, businesses, and trades, favour the Opponent.

Additional circumstance: The scope of protection afforded to descriptive or suggestive terms

[46] The Applicant submits that the Opponent's Trademark, when sounded, is descriptive of the associated goods and therefore entitled to only a limited ambit of protection, which has not been enhanced by any evidence of acquired distinctiveness.

[47] It is well established that trademarks comprised of descriptive or suggestive words are only entitled to a narrow ambit of protection. A greater degree of discrimination may fairly be expected from the public where a trademark consists wholly or in part of words describing the articles to be sold, such that even relatively small differences may suffice to avert confusion

[*General Motors Corp v Bellows*, [1949] SCR 678, citing *Office Cleaning Services Ltd v Westminster Window & General Cleaners, Ltd* (1946), 63 RPC 39 at 41 (HL)].

[48] In the present case, I agree with the Applicant that the word OPTIX is descriptive of the Opponent's goods, as discussed above. Moreover, there is no evidence of use or promotion of the Opponent's Trademark to increase its distinctiveness. Accordingly, the Opponent's Trademark would not be entitled to a particularly wide ambit of protection, and relatively small differences may suffice to avert confusion.

[49] This consideration favors the Applicant.

Additional circumstance: The state of the register and marketplace

[50] The Applicant also furnished evidence on the state of the register and the state of the marketplace in an effort to establish that trademarks featuring the word OPTIX are common in the relevant market and that the phonetic equivalent OPTICS is commonly used by third parties to describe the Opponent's goods as well as goods in other fields.

[51] The common occurrence of a certain element tends to cause purchasers to pay more attention to the other features of the trademarks and to distinguish between them by those other features [see *Polo Ralph Lauren Corp v United States Polo Assn* (2000), 9 CPR (4th) 51 (FCA); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)]. Where a large number of relevant trademarks is identified on the register, the Registrar can infer that the element they all have in common is used in the marketplace; however, where the number of trademarks identified is not large, evidence of such use needs to be furnished [see *Maximum Nutrition, supra*; *McDowell v Laverana GmbH & Co KG*, 2017 FC 327; and *Canada Bread Company, Limited v Dr Smood APS*, 2019 FC 306].

[52] The Applicant's evidence consists of the results of the following searches performed by Ms. McConnery as presented through her affidavit:

- An online search of the Canadian Trademarks Database maintained by the Registrar, for active trademarks containing the word OPTIX [paras 3-6, Exhibits 1-2]. The Applicant does not draw attention to any particular hits and many are in unrelated fields, for

example, imaging equipment or contact lenses. A quick review of the trademarks that have been allowed or registered reveals only one trademark containing the word OPTIX for use in association with goods in the computer network and telecommunications industry: PCI OPTIX & Design, featuring an image of what appears to be rays of light emerging from a fibre optic cable below the words PCI OPTIX. However, the Applicant has furnished no evidence regarding the use or promotion of this trademark in Canada.

- An online search of the Canadian Trademarks Database for active trademarks containing the word OPTICS [paras 9-10, Exhibits 5-6]. The search results include a number of hits for such trademarks; however, I do not consider these references to be particularly relevant, given the differences between the trademarks located and the trademarks at issue in the present case. In particular, a key point of resemblance between the parties' trademarks in the present case is that they both consist of a single, five-letter word beginning in OPTI. The only OPTICS trademark Ms. McConnery located that is at least arguably composed of a single word is V-OPTICS; however, being registered for use in association with goods in the nature of binoculars, telescopes, cameras and range finders, it is not in a related field.
- A search for corporate names in the Canadian government's NUANS database through the website at *nuans.com*, for corporate names containing the word "Optix" or "Optics" [paras 18-19, Exhibits 16-17, 19]. The search results include 12 active names incorporating the word OPTIX and 15 active names incorporating the word OPTICS. However, only two of the hits (DR. OPTIX and OHANA OPTICS) provide the corporation's areas of activity, and they are in the health care field. Furthermore, none of the corporate names on their face suggest a connection to the field of communications equipment. In the absence of any indication as to whether the businesses located are in the Opponent's area of activity—as opposed to an unrelated field such as eye care, for example—I do not find the NUANS search results to be relevant.
- A search using the Google Internet search engine at *google.ca* for the terms "optix computer", "optix fibre optics", and "optix software", namely the first two pages of each list of hits [para 11, Exhibits 7-9]. Many of the hits appear on their face to relate to computers, fibre optics, or software. However, in the absence of evidence regarding the

contents of the identified websites and the extent to which they have been visited by consumers in Canada, I am unable to draw any meaningful conclusions from these search results.

[53] At the hearing, the Applicant submitted that the descriptiveness of the Opponent's Trademark when sounded serves to increase the significance of the state of the register evidence, despite the low number of relevant hits. However, no jurisprudence was provided in support of this contention.

[54] Given the absence of significant marketplace evidence and the small number of relevant references on the evidenced registers, the state of the register and marketplace is not a significant surrounding circumstance in the present case.

Conclusion with respect to confusion for the OPTIV Mark

[55] For the Applicant to meet its legal burden, the Registrar must be reasonably satisfied that, on a balance of probabilities, the registration sought is unlikely to create confusion; the Registrar need not be satisfied beyond doubt that confusion is unlikely [see *Christian Dior SA v Dion Neckwear Ltd*, 2002 FCA 29].

[56] Following my analysis of all the relevant factors, I am satisfied that, on a balance of probabilities, the Applicant has satisfied its legal burden with respect to the likelihood of confusion between the parties' trademarks. I find that the differences between the two trademarks are sufficient to avoid a likelihood of confusion as to the source of the parties' respective goods and services, as a matter of first impression and imperfect recollection, despite the overlap in the parties' goods and services and the potential overlap in the nature of the parties' businesses and trades.

[57] I reach this conclusion bearing in mind that the Opponent's Trademark is highly suggestive if not descriptive of the associated goods and there is no evidence of its use or promotion in Canada. As such, the Opponent's Trademark is not entitled to a particularly wide ambit of protection. The inherent distinctiveness it does have is derived primarily from the emphasized letter X—a feature absent from the Mark.

[58] In view of the foregoing, the ground of opposition based on confusion with the Opponent's Trademark is rejected.

Conclusion with respect to confusion for the remaining Applications

[59] The issues for decision, material dates, and the evidence of record are essentially the same in the three remaining oppositions as in the opposition concerning application no. 1,722,065 for the OPTIV Mark.

[60] I find that the Applicant's case in respect of OPTIV Design (application no. 1,728,538), OPTIV SECURITY (application no. 1,726,650), and OPTIV SECURITY Design (application no. 1,728,539) is even stronger than its case in respect of the OPTIV, because of the lesser degree of resemblance between the Opponent's Trademark and each of these three Marks.

[61] In the case of OPTIV SECURITY and OPTIV SECURITY Design, the word SECURITY is an additional distinguishing feature visually, phonetically, and in ideas suggested. Moreover, although the word SECURITY is not inherently distinctive in the cyber security field, I do not find that it detracts from the inherent distinctiveness of the OPTIV element.

[62] In the case of OPTIV Design and OPTIV SECURITY Design, the design feature partially reflecting the O above and below, reminiscent of a scroll wheel, is likewise a further distinguishing feature. As such, it also serves to visually distinguish the parties' trademarks.

[63] Following my analysis of all the relevant factors, for the reasons discussed above in respect of application no. 1,722,065 for the OPTIV Mark, I am satisfied that, on a balance of probabilities, the Marks are not likely to create confusion with the Opponent's Trademark. The Applicant has thus met its legal burden.

[64] Accordingly, the ground of opposition based on confusion with the Opponent's Trademark is rejected for the remaining applications as well.

DISPOSITION

[65] In view of all the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject each of the oppositions pursuant to section 38(12) of the Act.

Oksana Osadchuk
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Applicant's Goods:

(1) Computer software, namely cyber security software; computer software for computer security, computer network security, information security, data security and firewall security purposes; computer hardware.

Applicant's Services: (my emphasis*)

** NOTE: The goods and services are reproduced as they appear in the application for the trademark OPTIV. In the applications for the trademarks OPTIV Design, OPTIV SECURITY, and OPTIV SECURITY Design, the word "and" replaces the word "or" in the Services (4) description "product support services in the nature of 24/7 service desk or help desk services for IT infrastructure, operating systems, database systems, and web applications"— see my emphasis at Services (4).*

(1) Value-added re-seller services, namely distributorship services of software and computer hardware used for the purpose of cyber security, computer security, network security, and data security; employment staffing, namely, providing on-site and remote staffing to train on and manage security processes and procedures, all in the fields of cyber security, computer security, network security, application security, data security, and information security; conducting business audits; business risk assessment services, business risk management services, and consultation related thereto; business consulting services in the field of cyber security program strategy, namely, helping businesses define metrics, prioritize and schedule initiatives, and align activities with business departments.

(2) Installation and maintenance of computers, computer hardware and related peripheral devices in the fields of cyber security, computer security, data security, information security, application security, and network security.

(3) Security awareness training, namely, training in the fields of cyber security planning and awareness; product training, namely, training in the use and operation of software and computer hardware used for the purpose of cyber security, computer security, network security, and electronic data security; software security training, namely, training others in maintaining software security in the field of cyber threats and warfare; training services in the field of information security compliance, information risk management, and computer network security; educational services, namely conducting courses, workshops, and seminars in the fields of cyber security, computer security, data security, information security, application security, and network security; providing a website featuring blogs and non-downloadable publications in the nature of articles in the field of cyber security.

(4) Research in the field of cyber security, data and information security, and network security; product research and development in the field of cyber security; binary analysis services for computer security purposes and cyber security purposes; planning and design of network architectures; technical consulting services in the field of cyber security, namely, consulting regarding security architecture, information architecture, enterprise architecture, public and

private cloud computing solutions; technology consultation services in the field of cyber security, namely, identification and selection of appropriate technologies that meet business and technical requirements; implementation and integration of technology solutions in the field of cyber security; integration of computer systems and networks; optimization of computer systems, computer networks, and related equipment, namely, consultation regarding desired performance levels and reasons for optimization, evaluating the health of the system, providing upgrades to the system, updating software, applying patches, and changing configurations; product support services in the nature of **24/7 service desk or help desk services** for IT infrastructure, operating systems, database systems, and web applications; computer technology support services, namely, help desk services; managed computer security services, namely, providing security analysis, security consulting, security assessment, security program assessment, and vulnerability assessment; managed computer security services, namely, malware mitigation in the nature of detection, blocking, and remediation of malware; managed security services in the nature of security information event management (SIEM), namely, gathering and analyzing real-time network information to manage and respond to security vulnerabilities and external threats; computer security services in the nature of incident mitigation and response, namely, analyzing, mitigating, and resolving cyber incidents and security breach incidents; networks and communications network security services in the nature of intrusion protection, security threat analysis, vulnerability management and assessment, endpoint security management, threat analysis, incident response, and forensics and penetration testing; security breach response services, namely analyzing and resolving security breaches in relation to computer networks, cyber security, electronic data and identity theft; computer security consulting services in the field of critical incident response to information, computer, and internet security breaches; identity access management in the nature of consulting and advisory services relating to identity, access, and authentication in the field of cyber security; cloud security advisory services, namely, consultation regarding cloud storage, cloud collaboration platforms, and cloud hosted enterprise applications; vulnerability assessment services, namely, assessing network information security vulnerability and risk; computer security consultancy in the field of scanning and penetration tests of computers and networks to assess information security vulnerability; information technology system security breach investigation and remediation services; computer services, namely, providing forensic services to recover lost and deleted data; software as a service (SAAS) services featuring cyber security software; providing online, non-downloadable network infrastructure and application software for facilitating the compatibility and scalability of multiple computer software programs; installation and maintenance of computer software relating to computer security, cyber security, software security, and prevention of computer risks; technology consultation and research in the fields of cyber security, computer software security, network security, digital devices, networked devices, and mobile device security; technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems; providing technical consultation in connection with computer software, computer network design, electronic storage design, network security, and cloud security; conducting tests on computer software and computer networks to assess information security vulnerability; design and development of electronic data security systems and computer network security systems; design and development of contingency plans for addressing threats to electronic data and computer network security systems; computer monitoring services, namely, monitoring of computer security systems of others to assess information security vulnerability; computer services, namely, remote and on-site management of computer networks, firewalls,

virtual private networks and networked devices of others for the purpose of assessing and preventing information security vulnerability; managed computer security services, namely, design, development and implementation of firewalls, virtual private networks, and intrusion detection systems; computer services, namely, on-line scanning, detecting, quarantining and eliminating of viruses, worms, trojans, spyware, adware, malware and unauthorized data and programs on computers, digital devices, networked devices, mobile devices, and electronic devices; computer security service, namely, restricting access to and by computer networks to and of undesired web sites, media and individuals and facilities.

(5) Compliance services, namely, regulatory compliance consulting in the field of cyber security, information security, and data security; reviewing standards and practices and developing and implementing policies, procedure and standards, to assure compliance with information security laws and regulations; security services, namely, providing security assessments and security risk assessments of physical locations, information systems, and working environments and infrastructure, namely, desktops, servers, routers, networked devices, digital devices, mobile devices, databases, and applications; security audits of physical locations, information systems, working environments and infrastructure, namely, desktops, servers, routers, networked devices, digital devices, mobile devices, databases and applications; security services, namely, providing information security risk assessments and audits; providing security assessments of physical locations, data security, software security, work environments, computer network security for businesses and governmental agencies; security consulting services in the fields of computer and network security, data security, identity theft and information technology security; cyber security consultancy services; providing an on-line interactive website for information security personnel and experts to exchange ideas to establish best practices for secure information technology infrastructures by sharing updates, news, blogs, white papers, and information regarding events in the field of secure information technology; analyzing and resolving cyber incidents and security breach incidents; intrusion detection management, namely, providing onsite and remote monitoring of network infrastructure and network activity for security purposes.

SCHEDULE B

Opponent's Goods:

(1) Telecommunication equipment, namely, answering and caller display machines, radios, satellite dishes, cable set, top receivers, sit-top boxes and decoders, stored program controlled switching system, namely, stored program controlled switch, radio apparatus for telecommunication, namely, cellular base station, cellular control center, hand set, wireless terminal, mobile telephone, mobile station; data communication apparatus, namely telephones, cellular phones, communication servers, routers, hubs, modems, access servers, ATM switches, ethernet switches, and LAN switches, transmission apparatus (for communication purposes), namely, fiber optic connectors, transmitters, add/drop multiplexers, digital cross connectors for communication purposes; optical telecommunication apparatus, namely, lasers and receivers used for the transmission of voice, data and video, intelligent network apparatus, namely service creating environment points, service management points, service management access points, service control points, fixed network service switching points, mobile network service switching points, intelligent peripherals-all in the nature of routers for computer networks; power supply system for telecommunication, namely, voltage regulators for electric power, regulated power supply, high- frequency switched-mode power supply, uninterruptible power supply, electric accumulators, battery chargers, rectifiers, switched- mode power supply for power system, transducers, integrated circuit, computer software in the field of communications and telecommunications for accessing public and private networks, global computer networks, the Internet or interactive computer network, computer hardware, all of the aforesaid products not for sale to the general public at retail outlets.

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

HEARING DATE 2021-03-08

APPEARANCES

No one appearing	For the Opponent
Heidi Jensen	For the Applicant

AGENTS OF RECORD

ROBIC	For the Opponent
Jensen IP	For the Applicant