



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 110

Date of Decision: 2022-05-31

IN THE MATTER OF AN OPPOSITION

Les Consultants Ttraffic inc

Opponent

and

Kapsch TrafficCom AG

Applicant

1,733,030 for ECOTRAFIX

Application

[1] Kapsch TrafficCom AG (the Applicant) seeks registration of the trademark ECOTRAFIX (the Mark) based on its use in Canada since at least as early as September 8, 2014 in association with the following goods, comprising various apparatus, instruments, hardware, and software for use in monitoring and managing traffic, including control of traffic signal systems (the Goods):

Electro-technical and electronic measuring, signaling, counting, recording, monitoring, controlling, regulating and commutating apparatus, namely, electronic measuring instruments, electronic controllers, data processors and computer software for use in monitoring and managing traffic and controlling traffic signal systems; electrical controlling instruments for input, processing, transmission, storage and output of data, namely, keyboards, interfaces, CPUs, memories, monitors and printers; electronic traffic control apparatus, namely, remote traffic signal controllers; traffic light apparatus signaling apparatus; electronic traffic guidance apparatus, namely, display monitors, computers, data processors (CPUs), electric controllers, and computer software to manage traffic; traffic control luminous instruments, namely, traffic lights; instruments for monitoring traffic, namely, display monitors, electronic sensors, computer hardware and computer software.

[2] Les Consultants Trafix inc (the Opponent) opposes this application, based primarily on allegations that the Mark is confusing with its trademark and trade name TRAFIX (respectively the “Opponent’s Mark” and the “Trade Name”), used in association with engineering, urban and city planning, environment, socio-economic and survey expert services in respect of various specialties in the field of traffic and transportation, including “design of mechanical, electromechanical and computerized traffic control systems” and “traffic surveillance systems, plans and specifications”. The full list of services with which the Opponent claims to have used its trademark and trade name is set out below (Opponent’s Services):

Engineering, urban and city planning, environment, socio-economic and survey expert services in respect of transportation and traffic engineering, transportation and traffic safety, markings, signs and traffic signals, parking, reconstruction of traffic accidents with respect to the road, the vehicle and the motorist, skid resistance studies, safety campaigns and education, road design, construction and maintenance policies, design of mechanical, electromechanical and computerized traffic control systems, research and development of road safety devices and equipment, design of road safety devices, design of traffic facilities and terminals, marketing studies, accessibility studies of shopping centers and of various developments including gas stations, traffic counts, bicycle and pedestrian facilities, traffic surveillance systems, plans and specifications, design of guardrails, posts and impact attenuating devices, studies of speeds, asphalt-mix design, pavement design.

[3] For the reasons that follow, I reject the opposition.

THE RECORD

[4] Application no. 1,733,030 for the Mark (the Application) was filed on June 16, 2015 by the Applicant’s predecessor in title Schneider Electric Industries SAS, and advertised for opposition purposes in the *Trademarks Journal* on December 28, 2016.

[5] On May 29, 2017, the Opponent filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act), on grounds alleging confusion with the Opponent’s trademark and trade name TRAFIX. 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, with respect to the definition of confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[6] On August 2, 2017, the Applicant filed and served a counter statement essentially denying each of the grounds of opposition and pleading certain allegations in response, namely that (i) the allegations of fact in paragraph 1 of the statement of opposition establish that the Opponent's Mark has never been used in Canada, which renders its registration invalid; and (ii) in approving the Application for advertisement, the Examiner agreed with the Applicant that there is no likelihood of confusion.

[7] Only the Opponent filed evidence, but both parties filed written submissions and participated at an oral hearing. In accordance with section 38(8) of the Act and section 49 of the *Trademarks Regulations*, SOR/2018-227 (the Regulations), to the extent that the parties' submissions allege facts not in evidence, I have not had regard to such allegations.

THE OPPONENT'S EVIDENTIAL BURDEN, THE APPLICANT'S LEGAL ONUS, AND THE TEST FOR CONFUSION

[8] In opposition proceedings, 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. For a ground of opposition to be considered at all, the opponent must meet its evidential burden [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB)].

[9] If this initial burden is met, then the applicant must satisfy the Registrar, on a balance of probabilities, that the ground of opposition pleaded should not prevent the registration of the mark at issue. The legal onus being on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)]. In the present case, the grounds of opposition are based on allegations of confusion and, accordingly, the Registrar would have to be satisfied, on a balance of probabilities, that there is no reasonable likelihood of confusion.

[10] I note at the outset that I reject the allegation in the Applicant's counter statement that Examiner approval of the Application means there is no likelihood of confusion. Examiners do

not have before them the evidence and arguments that are filed by the parties in an opposition proceeding. Moreover, the onus is different at the examination stage, where the Registrar cannot refuse the application under section 37 of the Act without being satisfied that the trademark is not registrable. Accordingly, a decision to advertise a trademark following examination is not a decision that confusion is unlikely; that determination must be made by the Registrar at the opposition stage, taking into consideration all of the evidence in the file and the arguments raised by both parties.

[11] The use of a trademark causes confusion with another trademark or trade name if the use of both in the same area would be likely to lead to the inference that the goods or services associated with the applicant's trademark and those associated with the opponent's trademark, or with the business carried on under the opponent's trade name, are manufactured, sold, leased, hired or performed by the same person [sections 6(2)-(4) of the Act]. Also, where it is likely the public will assume the applicant's goods or services are approved, licensed, or sponsored by the opponent, so that a state of doubt and uncertainty exists in the minds of the purchasing public, it follows that the applicant's trademark and the opponent's trademark or trade name are confusing [see *Glen-Warren Productions Ltd v Gertex Hosiery Ltd* (1990), 29 CPR (3d) 7 (FCTD)].

[12] Thus the test for confusion does not concern confusion of the trademarks and trade names themselves but rather confusion as to whether the goods and services associated with each party's trademark or trade name come from the same source. 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 or trade name and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the trademarks or between the trademark and trade name [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23].

[13] Regard must be had to all the surrounding circumstances, including those set out in section 6(5) of the Act: (a) the inherent distinctiveness of the trademarks or trade names and the extent to which they have become known; (b) the length of time the trademarks or trade names have been in use; (c) the nature of the goods, services and business; (d) the nature of the trade;

and (e) the degree of resemblance between the trademarks or trade names in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and the weight given to each factor will vary in a context-specific analysis [*Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22]. That said, the degree of resemblance between the trademarks or trade names is often the factor likely to have the greatest effect on the confusion analysis [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27]. In assessing resemblance, each trademark or trade name must be considered as a whole, but bearing in mind that a dominant component may affect an average consumer's overall impression; thus the preferable approach is to begin by determining whether there is any aspect of the trademark or trade name that is "particularly striking or unique" [*ibid.* at paras 64 and 84].

SCOPE OF THE OPPOSITION

[14] Before considering the specific grounds of opposition in this case, it is necessary to determine the scope of the pleadings. The Registrar has no jurisdiction to deal with a ground not found in the statement of opposition. Therefore, where an opponent pleads that an application fails to comply with a section of the Act based on a particular set of circumstances, the Application cannot be refused because it fails to comply with the Act for a different reason [see *Massif Inc v Station Touristique Massif du Sud (1993) Inc*, 2011 FC 118; and *Procter & Gamble Inc v Colgate-Palmolive Canada Inc*, 2010 FC 231]. Failure to adequately cite a specific ground, or to amend the statement of opposition to do so, precludes consideration of that ground [*Carling Breweries Ltd v Molson Companies Ltd* (1984), 1 CPR (3d) 191 (FCTD)].

[15] Once evidence is filed, the Registrar must consider it when interpreting the grounds of opposition [*Novopharm Ltd v AstraZeneca AB*, 2002 FCA 387]. I will therefore review the evidence filed in this case before addressing the scope of the opposition in light of both the pleadings and the evidence filed. I will begin by addressing several preliminary matters.

PRELIMINARY MATTER: TRADEMARK VERSUS TRADE NAME USE

[16] The pleadings and evidence in this case reference both the *trademark* TRAFIX and the *trade name* TRAFIX. Trademark and trade name usage are not necessarily mutually exclusive and a trademark may be incorporated into a trade name [*Consumers Distributing Co v Toy World*

Ltd, 1990 CarswellNat 1398 (TMOB)]. However, the concepts are different in that a trademark is used to brand goods and services whereas a trade name is used to identify a legal entity or business, and the use of a trade name will not necessarily meet the definition of trademark use in all cases.

[17] Section 2 of the Act defines a trademark as a mark used by a person to distinguish goods or services manufactured, sold, leased, hired, or performed by him or her from the goods or services of others. Section 4(2) of the Act deems a trademark to be “used” in association with services “if it is used or displayed in the performance or advertising of those services”. The display of a trademark on advertising is sufficient to meet this requirement when the trademark owner is offering and prepared to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[18] Section 2 defines a trade name as the name under which a business is carried on. Accordingly, an opponent relying on use of a trade name must demonstrate its use of the name in the normal course of a functioning business and in relation to the class or classes of persons with whom such business is to be conducted [see *Mr Goodwrench Inc v General Motors Corp* (1994), 55 CPR (3d) 508 (FCTD)]. The formation or registration of a company under a particular name does not, by itself, constitute use of that name, and the appearance of a name on documents not issued by the opponent does not qualify as use of that trade name by the opponent [*Tension 10 Inc c Tension Clothing Inc.* (2004), 45 CPR (4th) 136 (TMOB)]. Although there is no specific definition of “use” in the Act pertaining to trade names, the principles in sections 2 and 4 regarding trademark use have been held to apply, such that display of a trade name in the performance or advertising of services available in Canada will suffice to show use of the trade name in the course of business [see *Carbon Trust Inc v Pacific Carbon Trust*, 2013 FC 946].

[19] Such display of the trade name *may* be for the purpose of distinguishing or so as to distinguish the advertised services performed by the opponent from services performed by others and thus also constitute use of a “trademark” within the meaning of sections 2 and 4 of the Act. However, registering a trademark as a business name or corporate name does not, by itself, constitute “use” of that trademark. Nor does it create or confirm any rights to use the trademark;

such rights are governed by the Act, not by provincial legislation such as the *Loi sur les sociétés par actions* or by business registries such as Quebec's *Registre des entreprises*.

PRELIMINARY MATTER: DEVIATION

[20] Mr. Galella attaches as exhibits to his affidavit various documents distributed by or mentioning the Opponent. I note that, in these materials, the Opponent is variously identified as Trafix Inc., Les Consultants Trafix Inc., Les Consultants Trafix, Firme Trafix, Consultants Trafix, Consultants TRAFIX, Trafix Consultants Inc., Trafix Consultants, or Trafix.

[21] I would consider use of any of these variations to also constitute use of "TRAFIX" *per se*, since the additions of "Les Consultants", "Consultants", "Firme", and/or "Inc." are minor deviations that merely indicate the nature of the business (consultancy) or the form of business organization (firm or corporation). The Opponent's trademark and trade name TRAFIX stands out sufficiently from these additional, descriptive elements and corporate indicia to retain its identity and remain recognizable. Moreover, in the exhibited examples of the Opponent's advertising and stationery, discussed below, the word TRAFIX is typically presented in larger lettering and/or a contrasting shade to that of the surrounding word elements, such that the word TRAFIX stands out all the more. [Regarding use of trademarks with additional elements and acceptable deviation, see *Canada (Registrar of Trade Marks) v Cie Internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA); and *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB).]

[22] In this respect, I disagree with the Applicant's submission that the Registrar "has tended to find that the mixing or juxtaposition of a mark with other words or features, does not establish use of the trademark, especially when the presentation(s) are inconsistent (as is the case here)" [Applicant's written argument para 48]. The jurisprudence cited in support is not on point: *AM Ford Sales Ltd v 7268769 Canada Inc*, 2010 TMOB 154, dealt with an alleged trademark within a domain name that merely redirected to a different URL and *Rab Design Lighting Inc v Rab Lighting Inc*, 2016 TMOB 171, dealt with an alleged trademark within alphanumeric product designations.

[23] I would also note that, in some of the attached journal and newspaper articles and notices, including those written in French, TRAFIX is spelled with two Fs—TRAFFIX—and in one article referencing the Opponent, TRAFIX is spelled with a C—“*la firme Trafic Consultants*”. As these misspellings appear to be made by third-party journalists, I do not consider it necessary to decide whether spelling TRAFIX with two Fs would be more than a minor variation and result in a different trademark or trade name if it were done by the Opponent. Given that TRAFFIX and TRAFIX are very close visually and phonetically and that “traffic” is an English dictionary word whose meaning is very close to that of the French dictionary word “*trafic*”, I am satisfied that a reference to the consulting firm “Traffix” in the media would be understood as a reference to the consulting firm “Trafix” and *could* thus contribute to the reputation of the Trade Name and the extent to which it has become known. I am not prepared to reach the same conclusion with respect to the misspelling “*Trafic Consultants*”, since, in my view, the coined word TRAFIX is not recognizable in this apparent combination of two ordinary dictionary words. Although “Trafic” is a misspelling in English, it is not a particularly striking or distinctive one. However, as I have only found this particular misspelling in a single article, it is of little consequence.

[24] For convenience, I will refer to display of TRAFIX INC. with TRAFIX in larger lettering, to LES CONSULTANTS TRAFIX INC. with TRAFIX in larger lettering (which in the more recent examples is also in a lighter shade), and to LES CONSULTANTS TRAFIX with TRAFIX in larger, bold lettering, as display of the Opponent’s corporate name as a “banner”.

PRELIMINARY MATTER: SIGNIFICANCE OF UNREGISTERED TRADE NAME

[25] At the oral hearing, the Applicant submitted that the statement of opposition is insufficient to invoke rights in the Trade Name because the Trade Name does not appear to have been registered. However, there is no evidence before me of a requirement to register a trade name in Quebec and, in any event, questions of compliance with provincial laws, including legislation governing the use of business names, are outside the Registrar’s jurisdiction. As no authority to the contrary has been brought to my attention, I find no basis to deny the Opponent the ability to rely on its unregistered trade name (for similar conclusions, see *2076631 Ontario Limited (Shoe Club) v 2169-5762 Quebec Inc*, 2011 TMOB 92; and *Wood v Cherish Arts International Inc*, 2009 CarswellNat 3272 (TMOB)).

PRELIMINARY MATTER: OPINION EVIDENCE

[26] In its written argument, the Applicant submits that paragraphs 17 and 21-23 of Mr. Galella's affidavit should be either struck or afforded no weight because he is not qualified to "testify as to the thoughts or opinions of others" or to give opinion evidence on the issues of mixed fact and law that are to be decided by the Registrar [para 31]. A similar objection is raised to paragraphs 6, 8, and 9 of Mr. Anéziris' affidavit.

[27] Indeed, neither Mr. Galella nor Mr. Anéziris has not been established as an expert in trademark law or human behaviour and neither is independent of the parties. I have therefore disregarded their personal opinions and conclusion on the reputation of the Opponent's Mark and Trade Name and the extent to which it has become known, which are questions to be decided on the factual evidence. However, I consider Mr. Galella's statement that the Opponent's expertise on traffic and transportation matters in Montreal is regularly sought by clients and the media to be a statement of fact concerning his firm's business activity and within his knowledge as president of the firm. I therefore find paragraph 23 of his affidavit to be admissible. Similarly, to the extent that Mr. Anéziris makes statements of fact regarding how he has personally heard the Opponent or its founder and president identified, I find that such statements are admissible.

THE OPPONENT'S EVIDENCE

[28] The evidence in this case consists of two affidavits filed by the Opponent, both dated December 1, 2017: that of its founder and president, Ottavio Galella, and that of a former employee, Aristomen Anéziris. Neither affiant was cross-examined.

[29] I note that some of the Opponent's evidence relates to Mr. Galella's activities in his personal capacity or otherwise without reference to the Opponent. The relevant evidence is that which shows "TRAFIX" displayed as a trademark or trade name on materials the Opponent distributed in Canada in the course of business and that which shows exposure or recognition of the trademark or trade name "TRAFIX" in Canada.

Affidavit of Ottavio Galella

[30] In his affidavit, Mr. Galella identifies himself as the founder and president, director, and sole shareholder of the Opponent, a firm specializing in the fields of road traffic, road planning, traffic signals and signage (“*signalisation*”), transportation, road safety, and parking [paras 1-2]. He states that the Opponent serves primarily government, institutional, and private clients, including Quebec towns and municipalities, government institutions, municipal and regional transportation companies, and real estate developers [paras 2-4].

[31] Mr. Galella claims that TRAFIX has always been the main element of his firm’s identity, and of the range of services it offers, which includes all of the Opponent’s Services [paras 8-9]. He claims the following specific rights:

- Trademark rights: Mr. Galella states that, since the company’s incorporation on April 24, 1975, its services have been offered in Canada under the word mark TRAFIX, a term he created in 1975 for use in connection with the Opponent’s business and professional activities [paras 5-6]. He attaches a printout of the registration particulars for the Opponent’s 2005 registration of this trademark [Exhibit D]; however, as discussed below, that registration was expunged for failure to renew on December 31, 2020.
- Trade name rights: Mr. Galella states that the Opponent first operated under the name “*Signalisation TRAFIX inc.*” before becoming “*Les Consultants TRAFIX inc.*” in 1983 [para 6]. However, I note that the business register extract he attaches as Exhibit A to his affidavit does not mention the name “Signalisation TRAFIX inc.”; nor is this name mentioned in any of the other exhibited materials. Rather, the corporate name used in earlier materials is “TRAFIX INC.”
- Copyright: Mr. Galella states that the Opponent is the owner of a registered copyright in the literary work “TRAFIX”, of which he is the author, and which was first published on April 24, 1975, *i.e.* the day of the Opponent’s incorporation [para 7, with copy of registration certificate at Exhibit C]. While Mr. Galella does not specify the nature of the literary work, it would appear from the Opponent’s written representations that the Opponent is attempting to claim copyright in the word TRAFIX itself, which is characterized in the written representations as the Opponent’s “registered trademark and

literary work” (“*marque déjà enregistrée et œuvre littéraire*”), “original trademark, protected by copyright” (“*marque originale, protégée par droit d’auteur*”), and “mark and literary work” (“*marque et œuvre littéraire*”) [see paras 31 and 43].

[32] Mr. Galella notes in particular that the Opponent’s Services involve, in a general manner, the design, development, and evaluation of traffic and transportation management measures and systems, which includes operating system software, computer optimization software, and control software (“*logiciels d’exploitation et d’optimisation informatique et de contrôle*”), and that the Opponent always performs these services under the trademark TRAFIX in carrying out its mandates for government, institutional, and private clients [para 11]. Consequently, manufacturers and distributors may be called on to submit bids for the manufacture or distribution of such software products that were researched, designed, developed and/or evaluated by the Opponent under the trademark TRAFIX [para 12].

[33] In support of his assertions, Mr. Galella attaches the following materials as exhibits to his affidavit.

Summaries

- Two documents summarizing the work performed by the Opponent [para 2, Exhibit B]:
 - Mr. Galella’s resumé, wherein he is identified as the president of “LES CONSULTANTS TRAFIX INC.” and “Trafiix”. However, no distinction is made between activities on the Opponent’s behalf and activities in his personal capacity.
 - A presentation sheet about the Opponent, provided upon request and in support of service offers to clients. It describes “TRAFIX” as a firm specialising in traffic and transportation solutions, with past projects including the design of roadways, signage and traffic signals; dynamic traffic-light management; a real-time monitoring and control centre for bridge traffic; plans for travel demand management and traffic calming; and a comprehensive research study into pedestrian safety.

Since there is no information as to where, when, to whom, or to what extent either document has been distributed, they are of little assistance in supporting a claim of either

trademark use or trade name use; however, they do provide some indication of the nature of the Opponent's activities.

Stationery and promotional items

- A sampling of stationery and promotional items, including business cards, envelopes, invoices, and a portfolio—Mr. Galella states that the Opponent's Mark and Trade Name are used on all such materials [para 10, Exhibit E]. Areas of expertise are typically listed next to or near the Trade Name. The following items are included, and illustrate different styles of displaying the Opponent's Mark and Trade Name:
 - A style of blank letterhead featuring the banner "TRAFIX INC." and a Boulevard Gouin address. I find it reasonable to infer that this and other materials featuring the Trafrix Inc. trade name pre-date the official adoption of the name "Les Consultants TRAFIX inc." in 1983—indeed, this general style of letterhead was used for the 1977 correspondence discussed below. The fields of activity listed next to the trade name are traffic-signals-and-signage, road safety, and expert reports ("*expertises*"), and the description "expert consultants" ("*experts-conseils*") appears immediately below it. The other materials displaying this version of the trade name provide the same or similar information, for example, omitting the description "expert consultants" or adding traffic to the list of fields, and the footer of one of the 1977 letters promotes the service of traffic engineering.
 - A second style of blank letterhead, featuring the banner "LES CONSULTANTS TRAFIX INC." and a Boulevard St-Laurent address, which appears to be from the mid-1980s [per the advertisements discussed below]. The fields of activity listed next to the trade name are traffic, road development ("*aménagements routiers*"), traffic-signals-and-signage, parking, transportation, and road safety; the same six fields are listed on other materials featuring this version of the trade name.
 - Photocopies of two smaller documents which are presumably the business cards and envelopes. One set is of the style featuring the banner "TRAFIX INC." On the card, the corporate name is displayed in uniform lettering, which may be a style that pre-dates 1977 (the evidenced correspondence shows a draft advertisement displaying

- “TRAFIX INC.” in uniform lettering being rejected in January 1977). The other set is in a style that features the current corporate name in a fanciful arrangement, with “LES” vertically below “CONSULTANTS”, “TRAFIX” in larger lettering of a lighter shade, and “INC.” vertically in fine print. The fields of activity are listed between “LES” and “CONSULTANTS TRAFIX INC.”, with two additional ones on the card: intelligent transportation and demand management. This style of presenting TRAFIX in a lighter shade appears to be more recent: the card includes a *trafixconsultants.com* e-mail address and both documents give the same Rue St-Paul physical address as the 2017 business register extract.
- Two styles of blank invoice form: one featuring the banner “TRAFIX INC.” and one featuring the name “TRAFIX” on its own, in a lighter shade, with the Rue St-Paul address and a *trafixconsultants.com* e-mail address, but no areas of expertise listed.
 - A cover page (presumably for the portfolio) titled “*Déploiement de solutions intégrées* [TRANSLATION: Deployment of integrated solutions] *Smart solutions to traffic and transportation engineering challenges*”. Three areas of expertise are listed: traffic, intelligent mass transportation, and travel demand management. “TRAFIX” in a lighter shade is displayed in large block letters above the Rue St-Paul address.

Advertising

- Examples of advertising from 1977 to 1987 promoting the Opponent in various industry publications [para 19, Exhibit J]. Typed or handwritten annotations to these materials indicate print runs in the order of 1200 for the publications *Routes et transports* and *Informations* and 3000 for *Recherches Transport*; however, Mr. Galella does not indicate the source of these figures and thus I am not able to confirm whether they are within his personal knowledge or constitute inadmissible hearsay. The following items are included:
 - Two letters on “TRAFIX INC.” letterhead from the Opponent to insurance guide publisher *Le Guide d’Assurances du Québec*, concerning an advertisement to be published in the latter’s 1977 directory. The accepted advertisement has the same header as the letterhead and in addition advertises expert witness testimony, technical assessment (“*expertises techniques*”), and reconstruction of road accidents.

- A 1982 issue of the Opponent’s periodic bulletin on road safety, *Sécuridées*. The first page indicates that *Sécuridées* is offered by “Les consultants TRAFIX”; the third page displays the banner “Les consultants TRAFIX inc.” to identify the Opponent as the publisher and lists the six fields of activity associated with this style of letterhead.
- A list of 15 issues of the scientific journal on roads and transportation *Routes et transports* in which the Opponent’s advertisements were published from 1983 to 1987. The five attached examples feature the banner “Les consultants TRAFIX inc.” (1983-1984) or “LES CONSULTANTS TRAFIX” (1986-1987). The usual six areas of expertise are listed, but the earlier advertisements add “traffic lights”.
- Four announcements of the annual scholarship “*Bourse d’excellence A.Q.T.R.–Trafix en sécurité routière*”— offered to Quebec university students by “LES CONSULTANTS TRAFIX INC.” in collaboration with the *Association Québécoise du transport et des routes* (AQTR)—published in *Routes et transports* (1986), AQTR’s bulletin *Informations* (1986), and the Quebec transportation ministry’s bulletin *Recherches Transport* (1987). I note that one of the *Informations* listings is on a page announcing that AQTR’s 1987 conference will include technical sessions co-organized by Mr. Galella on themes including artificial intelligence, coordination of automatic traffic lights, use of software and electronic equipment, implementation of micro processing, and data gathering by commercial microcomputers; however, there is no indication that he was co-organizing the sessions as a service provided by the Opponent or that the Opponent’s Mark or Trade Name would be displayed in association with the sessions.

Reference works and reports

- Introductory pages from a 1982 reference work on Canadian geometric road design standards for university and professional circles [para 13, Exhibit F]. Contrary to Mr. Galella’s assertion, these pages do not reference the trademark TRAFIX. Rather, they credit the committees that translated the first (1976) and second (1982) editions of the work from English and list “Ottavio Galella – Les Consultants Trafix Inc.” as a member of both.

- The results of a search on the keyword “trafix” in the CUBIQ online catalogue of Quebec government libraries, listing several reports signed or co-signed by the Opponent that are available in print and/or online from the libraries and from Quebec’s transportation ministry [para 15, Exhibit H]. Included are 11 reports (two published in both official languages) dating from 1982 to 1995, relating to studies, research, forecasts, and plans on topics such as pedestrian safety, traffic, road design, public transportation, and an Ontario-Quebec high-speed rail project. The search is undated but the copyright notice on the page is from 2014. Contrary to Mr. Galella’s assertion, this list does not demonstrate how the trademark TRAFIX has been publicized in the reports. Rather, the report descriptions name “Consultants Trafrix Inc.” (and in one case also “TRAFIX”) as an author and three of them also identify the Opponent as a publisher or co-publisher.

Print media coverage

- A sampling of newspaper articles and the like which, according to Mr. Galella, demonstrate how the trademark TRAFIX has been used and referenced in such materials in association with the Opponent’s Services [para 14, Exhibit G]. I note that journalists’ references to the Opponent do not constitute trademark or trade name use pursuant to section 4 of the Act; however, they may still contribute to the extent to which the Opponent’s Mark or Trade Name has become known. That said, not all of the materials clearly indicate the nature of the Opponent’s services or business and, in some cases, it appears the Opponent is only referenced as Mr. Galella’s credential for being interviewed or quoted. This is consistent with Mr. Galella statement that clients and the media seek out the Opponent’s expertise *and/or his own* [para 23]. This exhibit contains mostly French-language publications from the Montreal area and, indeed, Mr. Galella specifies that the expertise sought is in the context of large metropolitan projects *in Montreal*. Circulation figures are not provided; however, I can take judicial notice that at least *Le Devoir*, *La Presse*, *The Gazette*, and *Le Journal de Montréal*, being major newspapers in a major Canadian city, have fairly substantial circulation in Montreal [see *Northern Telecom Ltd v Nortel Communications* (1987), 15 CPR (3d) 540 (TMOB); and *Carling O’Keefe Breweries of Canada Ltd. v Anheuser-Busch, Inc* (1985), 4 CPR (3d) 216 (TMOB)]. Included in the exhibit are the following:

- Newspaper articles from 1972 to 1976; however, they make no mention of the trademark or trade name TRAFIX.
- Newspaper articles from 1980 to 1988, including from the major newspapers noted above and from what appear to be local papers. Most of the articles concern situations or events happening in Montreal, but some concern other towns in Quebec. The Opponent is identified by a version of its corporate or trade name, and some of the articles mention that the Opponent is a consulting firm, or in one case a traffic survey company. One article specifies that the Opponent is co-retained by various levels of government to advise on road projects and carry out traffic studies; another mentions recommendations to a parliamentary commission.

A number of the articles mention studies conducted and/or reports and recommendations prepared by the Opponent, on topics that include a road marking experiment (1982); road safety problems and recommendations, including new lights for pedestrians (1986, 1987); safety measures for bridges, including electronic signalling, electronic variable message signage, illuminated signage, and surveillance cameras (1986, 1987); bus lane safety, including traffic lights (1987); a proposed interchange (1988); and a multilevel parking design plan (1988). One article provides a full feature on the Opponent, describing its focus on traffic problem solving, planning, surveys, and studies, on topics such as bridge safety, road and interchange design, parking zone planning, and closed-circuit television monitoring (*Montreal Daily News*, 1988). I also note that *Le Devoir* and *Le Journal de Montréal* refer to the report on bridge safety measures as a “Trafix report” (“*le rapport Trafix*”), which tends to suggest that the Opponent was using TRAFIX not only as a trade name but also as a trademark to brand its reports at the time.

However, other articles simply reference Mr. Galella as the source of an opinion or information, typically describing him as being from, or the president of, the Opponent. The topics on which he comments in these articles include measures to encourage ridesharing (1980); a new signage system for public parking (1985); speed limits (1985); his study on traffic circle lanes (1986); safe road design (1987); lane closure and signage at construction sites (1988); solutions for road congestion and

- traffic jams (1988); his expert witness accident reconstruction (1987); his recommendations to a coroner, including on surveillance cameras and lit signage (1988); and his advice on proposals for interchange design and location (1988).
- Two notices, each published in two newspapers, regarding an information meeting and public consultation on the proposed joining of two municipal road networks in 1982. One notice mentions a report prepared by the engineering firm “Les Consultants Trafix” being available for consultation at the local registrar’s office; the other notice is from Mr. Galella as a consultant with “*Firme Trafix*” and outlines the key aspects of this report.
 - An article published in the university journal *Les Diplômés* in 1982, in which Mr. Galella, as president of the company “Trafix” and a consultant on traffic and road safety problems, provides information and opinions on this topic.
 - Articles published mostly online from 2006 to 2016 by *La Presse* and other sources, such as *Le Devoir* and *TVA.ca*, with some indicating that they were printed in 2017. The articles feature interviews with or opinions from Mr. Galella, typically describing him as an engineer or expert from the Opponent, which is in turn identified by a version of its corporate or trade name. The articles typically mention that the Opponent is a firm or consulting firm specializing in traffic management or that Mr. Galella’s expertise is in traffic and/or transportation. (Articles published in 2002 and 2017 are also attached, but they contain no mention of the word “TRAFIX”.) The topics addressed by Mr. Galella include his personal views on traffic and transportation reform in Montreal, including a proposal for a bridge based on calculations performed by “Trafix” (2006), centralized traffic management (2008), traffic congestion (2010, 2011), traffic calming (2011, 2016), tolls (2012, 2013, 2014), bus lanes (2013), photo radar (2013), the dimensions of an interchange (2013), alternative modes of transportation (2013), mobile bridges and other measures for pedestrians and cyclists (2013, 2015), traffic levels (2016), and intersection safety (2016). I note in particular two 2013 articles: one specifically mentions that Trafix is an *independent* firm and another references public consultations at which Mr. Galella proposed a mobile bridge based on calculations by “Trafix”, emphasizing that his

company *would not profit in any way from the investment*. The significance of the Opponent's emphasis on such independence will be discussed below.

Television and radio coverage

- Sample transcripts and the like which, according to Mr. Galella demonstrate how the trademark TRAFIX has been used and referenced on national television and on the radio, in association with the Opponent's Services, namely an online transcript of a television program aired in 2003 and what appears to be an online transcript from Radio-Canada published in 2006 [para 14, Exhibit G]. However, the former does not mention the trademark or trade name TRAFIX and the latter—at least as it appears in the exhibit—identifies the Opponent as “Tra x” [*sic*] and Mr. Galella does not specify whether this error also appears on screen.
- A webpage listing the particulars of Mr. Galella's interview on the television show *Scully: The World Show*, broadcast in Canada from March 22, 2010, on PBS television stations and also available online [Exhibit I]. A description of the show's guest indicates that “Entrepreneur Ottavio Galella has an aptly-named company: Trafix” and “is now one of the world's greatest specialists in traffic management and safety”. In his affidavit, Mr. Galella states that the interview highlighted the Opponent's expertise and services in association with the trademark TRAFIX and that he has likewise been interviewed by journalists from various Quebec television networks [para 16]. However, he does not provide a transcript or video of any of these interviews to show how this association would be made.

[34] With respect to the Opponent's reputation, Mr. Galella emphasizes that the trademark TRAFIX is associated with large-scale and high-profile research projects and studies in the field of traffic and transportation [para 20]. He lists the following eleven examples of projects (one in the national capital region, eight in Montreal, and two in nearby Longueuil), completed for the federal government in the first case and otherwise for municipal authorities, agencies, and transportation societies: (a) new system of traffic management comprising dynamic lit signage, video monitoring, and a control centre, for the two busiest bridges in Canada; (b) design and initial study of integrated traffic demand management through smart tolls on bridges receiving

over a million vehicles per day; (c) study on the creation of a mobile bridge; (d) participation in multidisciplinary study aimed at replacing Canada's largest interchange; (e) conceptual study for modernizing a road layout; (f) design of first network of dedicated bus and taxi lanes in Quebec; (g) design of the first North American dynamic traffic management project using reversible lanes and lighting in an urban artery; (h) feasibility study and design of the first on-demand traffic light system for bus priority, deployed at approximately 1000 busy intersections; (i) design of first box junction markings downstream of stop lines for truck and bus safety; (k) design of first standard street layout for bidirectional bicycle lanes in North America, piloted in Longueuil and then applied in other Quebec cities and cities like Vancouver; and (l) in association with equipment manufacturing companies in Longueuil, experimental application of an improved traffic signal patented by Mr. Galella, featuring lights shaped and coloured for better perception [copy of U.S. patent at Exhibit K]. However, Mr. Galella does not specify when each project was carried out or how the trademark or trade name TRAFIX was associated with any of the projects.

[35] Finally, Mr. Galella notes that, since 2015, he has been working on a book regarding traffic management aimed at professional, academic, political, governmental, and citizen communities, to be published by 2020, covering both past and upcoming projects associated with the trademark TRAFIX, including upcoming innovations in the field of traffic signals, some of which could become patented [paras 24-25]. However, even if the Opponent's Mark or Trade Name were to be associated with this book, there is no evidence that it was published prior to any of the materials dates in this case, and therefore it does not assist the Opponent.

Affidavit of Aristomen Anéziri

[36] In his affidavit, Mr. Anéziris confirms having been employed by the Opponent from 1986 to 2017 as an engineer, working on matters of traffic and transportation, traffic signals and signage, and road development [paras 1-2]. He notes in particular being in charge of impact statements and the preparation of plans and estimates for the acquisition, implementation, and evaluation of traffic control equipment for dozens of town and municipalities in Quebec [para 5]. He also notes having worked on a large dynamic traffic management project in Sherbrooke towards the end of the 1980s that involved the linkage and control of traffic lights, and their remote synchronisation in real time, from a personal computer—to his knowledge it was the first

of its kind in Quebec, if not Canada [paras 3-4]. With respect to more recent activity, Mr. Anéziris notes that, despite no longer being employed by the Opponent, he is collaborating with Mr. Galella on the book regarding traffic management [para 10].

[37] With respect to use of the trademark and trade name TRAFIX, he states the following:

- The Opponent is commonly called “TRAFIX” OR “*firme TRAFIX*” by its clients throughout Quebec and the entire governmental and municipal community served, with whom he met regularly [para 6].
- At all meetings, conferences, symposiums, conventions, and gatherings in which he participated, he always identified himself as being from “TRAFIX”, an independent firm with an excellent reputation and considerable influence across Quebec [para 8].
- In this milieu, he witnessed the Opponent’s president and founder being called “*Monsieur Trafix*” [TRANSLATION: Mister Trafix] on numerous occasions [para 9].
- The abbreviation TRAFIX is displayed on the front page and, as needed, in the footer of all reports [para 7].
- Publication of the aforementioned book on traffic management will be associated with TRAFIX.

[38] I note that Mr. Anéziris provides no examples of the manner in which the abbreviation “TRAFIX” has been displayed on reports and no details regarding the content, timing, or distribution of any such reports. Nor does he explain *how* the new book will be associated with the Opponent, the Opponent’s Mark, or the Trade Name.

THE GROUNDS OF OPPOSITION

[39] Pursuant to sections 38(2) and 38(3) of the Act, a statement of opposition may be based on any of the following four grounds, which must be set out in sufficient detail to enable the applicant to reply thereto:

- (a) That the application does not conform to the formal requirements of section 30 of the Act. One of these requirements, set out at section 30(i), is that an applicant be satisfied it is entitled to use the trademark it is applying to register.

- (b) That the trademark is not registrable. According to section 12(1)(d) of the Act, a trademark is registrable if it is not confusing with a registered trademark.
- (c) That the applicant is not entitled to register the trademark. Entitlement to registration is governed by section 16 of the Act, which provides that an applicant who has used a trademark in Canada is not entitled to secure its registration if, at the time when such use began, the trademark was confusing with another person's previously used trademark or trade name.
- (d) That the trademark is not distinctive. A distinctive trademark is defined in section 2 of the Act as one that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others, or is adapted so to distinguish them.

[40] In the present case, the statement of opposition appears to contain two grounds, numbered accordingly. The pleadings may be summarized as follows:

1. That the Mark is not registrable within the meaning of section 12(1)(d) of the Act because it is confusing with the Opponent's Mark, registered under number TMA641,413 (Opponent's Registration) in association with the Opponent's Services. Under this ground, the Opponent further pleads essentially the following (my bullets):
 - The Opponent's Mark has been used in Canada since at least as early as April 24, 1975, and registered on June 6, 2005, in association with the Opponent's Services.
 - The Goods are in direct conflict with the services that have been or may be offered by the Opponent under the Opponent's Mark.
 - The Opponent's Mark has a reputation specifically tied to the Opponent's Services and is regularly referenced in Canadian and U.S. media, particularly in connection with questions of traffic management, planning, and control.
 - The television interviewer Robert Scully publicly underscored that "Entrepreneur Ottavio Galella has an aptly-named company: TRAFIX. Traffic management and safety are in his blood", in the *Scully The World Show*, broadcast in Canada on March 22, 2010.

- TRAFIX is frequently referenced in the media across Canada and the United States owing to a recognized, forward-thinking expertise, sought after in academic, government, and business circles. The Opponent plans to apply for further intellectual property rights and to publish a book on traffic and transportation management by 2020.
 - The Mark and the Opponent's Mark are not only for use in similar fields but also resemble each other, including in sound and in ideas suggested.
2. That the Mark is not distinctive and is not adapted to distinguish the Applicant's goods and/or services from those of the Opponent. Under this ground, the Opponent further pleads that the Mark could potentially give rise to serious conflicts of interest for the Opponent, because it designs, develops, and evaluates measures and management systems for traffic and transportation, for which manufacturers and distributors may submit bids to government institutions and the private sector, including bids with respect to operating system software, computer optimization software, and control software.

SUMMARY DISMISSAL OF THE FIRST GROUND, BASED ON REGISTRABILITY UNDER SECTION 12 OF THE ACT

[41] It is clear that the statement of opposition includes a first ground of opposition under section 38(2)(b) of the Act, pleading that the Mark is not registrable under section 12(1)(d) because it is confusing with the Opponent's Mark. However, it is equally clear that the Opponent is unable to meet its evidential burden for this ground, which requires that the registration relied upon be in good standing at the date of the Registrar's decision. The Registrar has discretion to check the Register in this respect [*Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised that discretion, I can confirm that the Opponent's Registration was expunged for failure to renew on December 31, 2020.

[42] I wish to note, however, that had the Opponent's Registration not been expunged, I would not have found it to be invalid for the reason pleaded in the Applicant's counter statement, namely that the facts alleged in paragraph 1 of the statement of opposition establish the trademark has never been used. First, the validity of an opponent's registration is not at issue in opposition proceedings. Second, I disagree with the Applicant that the pleadings refer to a

trademark that has never been used. Presumably, the Applicant is referring to the Opponent's allegation of conflict with services that have been and/or may be offered (*“d  j   offerts et/ou   ventuellement offerts”*). I do not consider this statement to negate the specific allegation of use of the Opponent's Mark since at least as early as April 24, 1975, in association with the full list of Opponent's Services. On a fair reading, the Opponent alleges *both* use *and* registration of its trademark in association with the full list. The subsequent reference to services that “may be offered” merely expands the allegation of conflict to encompass any future extension of the Opponent's service offerings.

[43] I would also note that I disagree with the Applicant's contention at the oral hearing that failure to file a timely renewal request displays a lack of interest in use of the Opponent's Mark. Any such conclusion would be speculative.

[44] In any event, given that the Opponent has failed to meet its initial burden, the ground of opposition based on registrability of the Mark under section 12(1)(d) is summarily dismissed.

SCOPE OF THE SECOND GROUND, BASED ON DISTINCTIVENESS AS DEFINED IN SECTION 2 OF THE ACT

[45] It is equally clear that the statement of opposition includes a second ground of opposition, under section 38(2)(d) of the Act, pleading that the Mark is not distinctive within the meaning of section 2. The further pleading under this ground raises the specific allegation that the Mark is not adapted to distinguish the Applicant's measures and management systems for traffic and transportation—including operating system software, computer optimization software, and control software—from the Opponent's Services relating to the design, development, and evaluation of such measures and management systems for traffic and transportation.

[46] In the absence of evidence to the contrary, I consider the entire statement of goods in the Application to consist of measures and management systems for traffic and transportation; given the wording of the pleading, I do not consider the three types of software singled out to form an exhaustive list. Accordingly, I find that the pleading covers the Goods in their entirety.

[47] Furthermore, reading the statement of opposition as a whole and in the context of the Opponent's evidence, I find the pleading to be that the Mark's distinctiveness is so negated by the Opponent's Mark and Trade Name as referenced in the specific pleadings under the first

ground of opposition (including the mentions of the apt company name “TRAFIX” and of the Opponent being identified as “TRAFIX” in the media).

[48] The outcome of this ground will be discussed below.

REFUSAL OF A POTENTIAL THIRD GROUND BASED ON COMPLIANCE WITH SECTION 30(I) OF THE ACT

[49] In its written argument, the Opponent confirms its pleadings that (i) the Mark is not registrable because it is confusing with the Opponent’s Mark and (ii) the Mark is not distinctive [written argument paras 2 and 9]. The Opponent further confirms that it filed its evidence after having made these two pleadings [para 10]. However, the Opponent then goes on to argue that, in addition, the Mark does not comply with section 30(i) of the Act because it violates the *Copyright Act*, RSC 1985, c C-42, and the Opponent’s copyright [paras 3 and 11]. The Opponent argues that it invented the expression “TRAFIX” and that the Mark was very clearly borrowed, inspired, and/or derived from this literary work [paras 21, 31].

[50] Section 30(i) requires an applicant to state that it is satisfied it is entitled to use its trademark in Canada in association with the goods and services listed in the application, and the Registrar has held that this statement cannot properly be made where an applicant’s use is in *prima facie* violation of a federal statute [see *Interactiv Design Pty Ltd v Grafton-Fraser Inc* (1998), 87 CPR (3d) 537 (TMOB); *Interprovincial Lottery Corp v Western Gaming Systems Inc* (2002), 25 CPR (4th) 572 (TMOB)]. However, in the present case, the statement of opposition contains no indication that the Opponent intends to rely on non-compliance with the formal requirements of section 30 of the Act as a ground of opposition. Furthermore, it contains no allegations to the effect that the Applicant could not have been satisfied it was entitled to use the Mark in Canada or that use of the Mark violates the Opponent’s copyright.

[51] As noted above, once evidence is filed, the Registrar must consider it when interpreting the grounds of opposition. However, in the absence of any allusion to section 30(i), its requirements, or copyright infringement, this is not a case where the copyright registration certificate filed in evidence can assist the Applicant by clarifying a broad or ambiguous pleading. Indeed, the Opponent’s written argument treats non-compliance with section 30(i) as an allegation absent from the statement of opposition. If, after the statement of opposition was filed,

the Opponent wished to add allegations based on non-compliance with section 30 or the *Copyright Act*, then the Opponent was required to seek and obtain leave to file an amended statement of opposition setting out the ground in compliance with section 38(3)(a) of the Act.

[52] As a final note, in view of the Opponent's comments at the hearing that it did not think amending the statement of opposition was necessary when the copyright registration is in evidence and a public document, I wish to add that I am not satisfied granting leave to amend at the hearing stage would have been in the interests of justice in the circumstances of this case.

[53] The proposed ground in question could have been included in the statement of opposition at the outset and there is no indication that failure to do so was merely an oversight. Rather, Mr. Galella's evidence with respect to the copyright registration appears intended to support his statements regarding the length of use and distinctiveness of the Opponent's Mark, and not to introduce an entirely new ground of opposition. In this respect, I note that he cites the copyright registration and the work's April 24, 1975 date of first publication right after the trademark's April 24, 1975 date of first use and in the context of mentioning that the expression "Trafix" he created has always been the central and distinctive element of his firm's identity and range of services [paras 5-8]. Furthermore, a copyright registration merely identifies the *category* and *title* of the work in which copyright is claimed—in this case a literary work titled "TRAFIX". It does not include a specimen of the work or otherwise identify or describe the specific work involved, which would be important information for an applicant facing an allegation of copyright infringement to know the case it has to meet. In this case, reference to the requirements of section 30(i) and to a claim that the trademark itself is protected by copyright are made for the first time in the Opponent's written argument, which seems to represent a change in the Applicant's strategic direction.

[54] In view of the foregoing, although an amendment to the pleadings would be important to the extent that the Registrar may not address a ground not pleaded, I do not find the prejudice to the Opponent in this case outweighs the prejudice the Applicant would suffer if an entirely new ground of opposition were to be added at the very advanced hearing stage of the proceeding. Such an addition would require giving the Applicant an opportunity to file evidence in response to the allegations implicit in the new ground (evidence that might then be subjected to cross-

examination) as well as written and oral arguments addressing the validity and merits of the new ground. I do not consider the apparent change in the Opponent's case strategy to be a sufficient justification for returning this case from the hearing to the evidence stage.

[55] Accordingly, I find that the present opposition does not involve a ground based on non-compliance with section 30(i) of the Act.

REFUSAL OR SUMMARY DISMISSAL OF A POTENTIAL FOURTH GROUND BASED ON ENTITLEMENT TO REGISTRATION UNDER SECTION 16 OF THE ACT

[56] The possibility of a different additional ground of opposition is raised by the Applicant, namely one based on lack of entitlement to registration under section 16 of the Act.

[57] In its written argument, the Applicant appears to accept that such a ground is invoked by the Opponent's allegation that its trademark has been used in Canada since at least as early as April 24, 1975 in association with the Opponent's Services [paras 5(b) and 70-74]. Alleged use of a confusing trademark prior to an applicant's date of first use typically forms the basis of a ground of opposition based on non-entitlement to registration under section 16(1)(a) of the Act. However, the Applicant further submits that the Opponent has not met its evidential burden for this ground [paras 71-72]. To meet its initial burden, the Opponent would have to evidence use of TRAFIX as a trademark prior to the Application's date of first use, being September 8, 2014, in accordance with section 16(1)(a) of the Act, and that the TRAFIX trademark had not been abandoned at the date of advertisement of the Application, being December 28, 2016, as stipulated in section 16(5) of the Act.

[58] The Applicant also maintains that a ground based on prior use of a confusing *trade name*, under section 16(1)(c) of the Act, has not been raised [para 73]. Although the statement of opposition contains allegations relating to publicity of the Trade Name, the Applicant submits that confusion with a trade name has not been alleged.

[59] I would first note that prior use of the Opponent's Mark is referenced in the statement of opposition under the section 12(1)(d) ground based on confusion with a registered trademark. The series of pleadings under this ground appears to address the test for confusion set out at section 6(5) of the Act. Each of the paragraphs in the series addresses an aspect of the factors set

out at section 6(5): length of use (Opponent's use since April 24, 1975); nature of the services (directly conflicting); extent known (reputation from regular media references); inherent distinctiveness and nature of the business (TRAFIX being apt for a traffic management and safety company); nature of the trade (targeting academic, government, and business circles); and resemblance of the trademarks (including in sound and ideas suggested).

[60] I do not consider referencing the length of use of the Opponent's Mark in Canada within a section 12 registrability ground of opposition—in what appears to be a summary of the Opponent's case under section 6(5)—sufficient to invoke a separate, non-entitlement ground under section 16(1)(a). I reach this conclusion bearing in mind that the registrability and distinctiveness grounds in the statement of opposition (i) are numbered, (ii) explicitly mention registrability and distinctiveness, and (iii) are acknowledged as grounds in the Opponent's written argument. Conversely, the pleading with respect to use of the Opponent's Mark (i) is not numbered, (ii) does not explicitly reference section 16 or entitlement to registration, and (iii) is not acknowledged as a ground in the Opponent's written argument.

[61] Nevertheless, given that the Applicant, in its written argument, appears to have accepted that this ground was validly pleaded and to have been aware of the case to meet, and bearing in mind that the ground would involve confusion with the same trademark as the registrability and distinctiveness grounds, I will address why I also find the evidence insufficient for the Opponent to meet its initial burden under the proposed entitlement ground. I note that these findings are also relevant to the distinctiveness ground of opposition.

[62] Conversely, I do not find it necessary to consider whether the initial burden for a ground of opposition based on prior trade name use under section 16(1)(c) would be met, since I agree with the Applicant that the statement of opposition does not, explicitly or implicitly, plead such a ground. Although the pleadings mention media references to a company named "TRAFIX", references by journalists do not constitute trade name use by the Opponent. Furthermore, although regard must be had to the evidence in assessing the sufficiency of the pleadings, and the evidence includes the Opponent's advertising and notices appearing in the media, I find that this evidence falls outside the scope of the pleadings. The statement of opposition specifies that TRAFIX is frequently referenced in the media owing to a recognized, forward-thinking, and

sought-after expertise (“*dû à une expertise reconnue, avant-gardiste et recherchée...*”), thus implying that the media references are not the Opponent’s own advertisements but rather references by journalists who recognize the Opponent’s expertise on the topics being reported. In my view, the meaning and scope of the pleading is clear in this regard, and it is therefore not a case where the evidence can be factored in to complete an insufficient pleading.

[63] As for the Opponent’s initial burden under a section 16(1)(a) ground based on prior trademark use, I agree with the Applicant that it would not be met. First, in the absence of evidence as to when, where, to whom, and in what context the Opponent’s stationery items have been sent, it is not possible to determine whether the items bearing the current address were in use before the material date of September 8, 2014, and whether items like the letterhead, invoices, or portfolio covers were used for content that advertised any particular Opponent’s Services. Although certain *areas of expertise* are identified on the letterhead and stationery themselves, the specific services available to be performed in these fields are only identified to a very limited extent. The same is true of the Opponent’s advertisements.

[64] At best, the advertisement published in the *Guide d’Assurances du Québec* directory may be considered to have advertised, in 1977, expert services in respect of transportation and traffic safety and reconstruction of traffic accidents, while the 1986-1987 advertisements in *Routes et transports* featuring the banner “LES CONSULTANTS TRAFIX” may be considered to have advertised, in those years, expert services in respect of transportation and traffic safety, markings, signs and traffic signals, parking, and road design. I am satisfied that these displays of the Opponent’s corporate name also constitute displays of the Opponent’s Mark in advertising the referenced services, given how the word TRAFIX is emphasized within the corporate name banners. I am satisfied that the word TRAFIX stands out sufficiently from the remainder of the corporate name to also identify and distinguish the source of the services listed in the advertisements.

[65] However, even if I accept these advertisements as evidence of use of the Opponent’s Mark, I find that the evidence on record does not allow me to conclude that use of the Opponent’s Mark had not been abandoned at the date of advertisement of the Application, namely December 28, 2016.

[66] Although abandonment requires both an absence of use and an intention to abandon use, a mere intention to preserve the trademark is insufficient to avoid a finding of abandonment [*Labatt Brewing Co v Formosa Spring Brewery Ltd* (1992), 42 CPR (3d) 481 (FCTD); *Marineland Inc v Marine Wonderland and Animal Park Ltd* (1974), 16 CPR (2d) 97 (FCTD)]. Moreover, in the absence of other evidence, an intention to abandon can be inferred from a lengthy absence of use [*Marineland, ibid.*; *Hortilux Schreder BV v Iwasaki Electric Co Ltd*, 2012 FCA 321, affirming 2011 FC 967]. While a conclusion of abandonment may be avoided by showing even minimal use of the trademark—or other evidence regarding the trademark owner’s intentions—the intention must be to continue using the trademark in association with the goods or services, on more than a token basis [see *Hortilux, supra*; *Philip Morris Inc v Imperial Tobacco Ltd (No 1)* (1987), 17 CPR (3d) 289 (FCA)].

[67] In the present case, the evidence does not permit me to conclude that there remained, as at December 28, 2016, an intention to use “TRAFIX” as a trademark in association with the advertising or performance of any particular services, for the following reasons:

- Although Mr. Galella provides examples of stationery featuring the Opponent’s current address, he does not provide any indication as to what specific services such materials have been used to advertise, or when and to whom such promotional materials were sent. Even if I were to accept that each of the exhibited materials had received at least *de minimis* distribution, and to interpret the business card and the blank letterhead themselves as advertising expert consulting services in the listed fields, or the portfolio cover page to advertise engineering expert services, there is no indication of when the Opponent switched from the Boulevard St-Laurent address of the mid-1980s to the current Rue St-Paul address, and therefore no indication of when the most recent distribution of these particular styles of stationery occurred relative to the material date.
- The only examples of advertising provided are from 1977 to 1987. It is curious that the Opponent would not provide more recent examples if the Opponent’s Mark remained in use in the advertisement of the Opponent's Services.
- The fact that the Opponent is identified as an author or publisher of reports published from 1976 to 1993 on a website accessible in or after 2014 does not constitute evidence that the Opponent’s Mark remained in use in or after 2014. The fact that the works

authored by the Opponent decades earlier remain accessible through libraries does not mean that the Opponent is continuing to use the Opponent's Mark.

- In the absence of any indication that the Opponent continues to advertise and perform services under the trademark TRAFIX, I do not find the fact that journalists identify Mr. Galella as being from the consulting firm "Trafix", and that fact that this corporation remains in good standing, sufficient evidence from which to infer the continued performance of services under the trademark TRAFIX or the continued advertising of services available to be performed. At best, one of the articles from 2013 mentions calculations performed by "Trafix" regarding travel times on a proposed bridge system; however, they appear to be the same calculations in respect of the same bridge system as were referenced in the 2006 article. There is no indication as to when the calculations were performed or for what customer.
- Although Mr. Galella's affidavit was signed in December 2017, his resumé indicates that his most recent activities, on behalf of the Opponent or otherwise, took place in 2012 and 2013: a visit of tolls in Stockholm, membership on a local travel committee in Anjou, and six opinions provided to journalists. Moreover, there is no indication as to whether the activities in the years leading up to 2013 fell within the ambit of the Opponent's Services. For example, although participation in various committees and conferences is listed, there is no indication as to whether any of these committees or conferences hired the Opponent to provide expert services or simply invited Mr. Galella to sit on the committee or speak at the conference in his personal capacity. In a similar vein, no client is associated with the last two research activities listed (in 2010 and 2007-2009 respectively), making it unclear whether Mr. Galella performed the research in the context of providing the Opponent's expert services or in a different context, for example, in the course of writing his upcoming book, which would fall outside the scope of the Opponent's Services. While a few media references after 2013 suggest Mr. Galella remains available to be interviewed by the press, there is no indication of a continued intention by the Opponent to provide any of the Opponent's Services.
- Although Mr. Galella and Mr. Anéziris often speak in the present tense, for example, stating that the Opponent's Mark is used in association with the Opponent's Services or

that all reports display the abbreviation TRAFIX, mere assertions of use are insufficient to demonstrate use within the meaning of section 4 of the Act [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Parties must present detailed and specific evidence showing *how* the requirements of section 4 of the Act have been met [*Domaines Pinnacle Inc v Les Vergers de la Colline*, 2016 FC 188 at para 36; *Kamsut Inc v Jaymei Entreprises Inc*, 2009 FC 627 at paras 34-36; *JC Penney Co Inc v Gaberdine Clothing Co Ltd*, 2001 FCT 1333 at para 82]. A mere assertion that a trademark is displayed in a particular context, without any supporting documentation contemporaneous with the relevant date, lacks probative value.

[68] I therefore find that the Opponent would not have met its evidential burden with respect to a ground of opposition based on non-entitlement. Accordingly, even if I were to accept this ground of opposition, it would be dismissed for the Opponent's failure to meet its initial burden.

ANALYSIS OF THE GROUND OF OPPOSITION BASED ON DISTINCTIVENESS OF THE MARK UNDER SECTION 2

[69] Returning to the ground of opposition alleging that the Mark is not distinctive within the meaning of section 2 of the Act, this final ground of opposition essentially pleads that the Mark is not adapted to distinguish the Goods from the Opponent's Services relating to the design, development, and evaluation of measures and management systems for traffic and transportation, because the Opponent's trademark and trade name "TRAFIX" negates the Mark's distinctiveness in this respect.

[70] The material date for assessing distinctiveness is the date the statement of opposition was filed, which in the present case is May 29, 2017 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185]. To meet its initial burden, an opponent relying on confusion with its own trademark or trade name must establish that, as of the material date, its mark or name had become known in Canada to such an extent that it could negate the distinctiveness of the applicant's mark [*Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657]. In this respect, an opponent must show that its trademark was known in Canada to some extent at least, *i.e.* that its reputation was "substantial, significant or sufficient" to negate another trademark's distinctiveness, or else that it

was well known in a specific area of Canada [*Bojangles, supra; CEG License Inc v Joey Tomato's (Canada) Inc*, 2012 FC 1541]. In either case, the opponent's mark or name must be known to consumers, and have a reputation among consumers as an indicator of source [*1648074 Ontario Inc v Akbar Brothers (PVT) Ltd*, 2019 FC 1305].

[71] If this initial burden is met, then the applicant will have the legal onus to show, on a balance of probabilities, that its own trademark was adapted to distinguish or actually distinguished its goods and services from those of the opponent; in this respect, the applicant must establish that its trademark was not likely to create confusion with the opponent's trademark or trade name at the material date [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[72] In the present case, the evidence contains very little mention of the Opponent's projects or media references outside the Montreal area. In addition, although Mr. Galella's resumé does not distinguish between work performed on behalf of the Opponent and work performed in his personal capacity, I find it probative that the section on work assignments outside Quebec lists predominantly international projects and that only four are in Canada, dating from 1989 to 1994. This list suggests that, in either capacity, only limited work was performed in areas of Canada outside Quebec, with nothing noteworthy in Canada outside Quebec after 1994. In addition, Mr. Anéziris refers in his affidavit to regularly meeting clients across *Quebec* and to the Opponent's reputation and influence across *Quebec*.

[73] At the oral hearing, in support of its reputation across Canada, the Opponent drew attention to its contribution to the 1982 reference work on Canadian geometric road design standards at Exhibit F to Mr. Galella's affidavit. However, there is no evidence of the extent to which this edition of the work continued to be accessed closer to 2017, or evidence as to whether and how the Opponent's Mark or Trade Name is displayed either on subsequent editions of the work or on the English version. On a related note, it may well be that the Opponent's new book also targets audiences across Canada; however, there is no evidence of the new book having been published before the material date.

[74] Consequently, I find the evidence in this case does not establish that the Opponent's Mark and Trade Name was known to any particular extent in Canada at the material date. Since

there also appears to be limited evidence addressing the Opponent's reputation in Quebec outside the Montreal area, I find that, at best for the Opponent, it must show that its trademark or trade name TRAFIX was well known in the Montreal area at the material date, with a reputation sufficient to negate the distinctiveness of the Mark.

[75] Neither use within the meaning of section 4 of the Act nor being made known within the meaning of section 5 of the Act is strictly necessary to satisfy an opponent's evidential burden under a distinctiveness ground of opposition; an opponent may demonstrate that its trademark or trade name has become well known by any means, including evidence of knowledge spread by word of mouth or through newspaper or magazine articles [*Motel 6, supra; Bojangles, supra*]. However, there must be clear evidence of the extent to which it was known at the material date [*Bojangles, supra; CEG License, supra*].

[76] Having reviewed the evidence in this case, I find that it falls short of demonstrating that the Opponent's Mark and/or Trade Name had become well known in the Montreal area at the material date of May 29, 2017, or had a reputation among consumers sufficient to negate the distinctiveness of the Mark.

[77] The Opponent submits that, since 1976, its trademark and trade name TRAFIX has been and continues to be cited in the media and in reference works, as described above; thus, in the Opponent's submission, the Opponent's Mark and Trade Name has become known to the public over the years and is now synonymous with the Opponent's expertise and experience in its areas of practice [paras 28-29]. In this respect, the Opponent submits that the studies associated with the Opponent's Mark listed by Mr. Galella at paragraph 20 of his affidavit are among the most high-profile and large-scale traffic and transportation studies in Quebec and Canada [para 49]. The Opponent also notes that its trademark and trade name TRAFIX is displayed on all stationery and promotional items used by the Opponent, as well as advertising in various guides, industry journals, and other bulletins [para 30]. At the oral hearing, the Opponent added that it has a sizeable client base and has extended its reputation through attendance at conferences.

[78] However, as noted above, there is no evidence of the extent to which the Opponent's stationery items have been distributed and, even if I were to admit the circulation figures provided by the Opponent for some of its advertising, the evidence would show at best only

limited circulation in the 1970s and 1980s. Furthermore, there is no evidence of the extent to which the reference works and reports to which the Opponent has contributed have been accessed through libraries or otherwise, of the extent to which television or radio programming mentioning the Opponent has been viewed from Canada, or of the extent to which online articles mentioning the Opponent have been accessed from Canada. One is left to speculate on these points, which the Federal Court has indicated should be resisted [*Akbar Brothers, supra*].

[79] As noted above, I am prepared to take judicial notice of the fairly substantial circulation of certain newspapers in which the Opponent has been mentioned, and a number of articles in these newspapers mention studies conducted and/or reports and recommendations prepared by the Opponent. However, the exhibited articles in which the Opponent's studies, reports and recommendations are mentioned end with the year 1988. The evidence of press coverage for the Opponent does not resume until 2006, and most of these later articles are from online sources, with no evidence of their reach or the extent to which they have been accessed by potential customers or clients in Canada. Moreover, the exhibited articles from 2006 to 2016 contain only interviews with or opinions from Mr. Galella. Although he is typically described in these articles as an engineer or expert from the Opponent, which is then sometimes described as a firm or consulting firm specializing in traffic management, the articles do not provide any details on the specific nature of the services performed by the Opponent or associated with the Opponent's business. In particular, they do not mention the design, development, or evaluation of products for traffic or transportation management.

[80] Even if I accept that potential clients in Montreal were exposed to the Opponent's advertising in the 1970s and 1980s, and that the general public in Montreal—which may include potential clients of the Opponent or purchasers of the Applicant's goods—was exposed to the Opponent's Trade Mark and Trade Name in the press during the same time period, I am not satisfied that the printouts of the approximately two dozen articles over the ten-year period from 2006 to 2016 would suffice to show that the Opponent's Trade Mark and Trade Name remained known as a source of design, development, or evaluation services in respect of traffic and transportation management products at the material date.

[81] With respect to the studies and projects listed by Mr. Galella at paragraph 20 of his affidavit, there is no indication of when they were conducted or performed, of how they were associated with the Opponent's Mark or Trade Name, or of how they were promoted. Mr. Galella does not cross-reference any of the eleven examples provided in his affidavit with any of the studies, reports, or recommendations mentioned in the press. It may be that a majority of the projects date back to the 1980s and early 1990s, which is when the exhibited press coverage and reports available through CUBIQ were published. Mr. Galella's interviews with the media from 2006 to 2016 do not appear to promote any contemporaneous studies or projects being performed by the Opponent; at best, there is mention of the Opponent having calculated travel times associated with the mobile bridge proposal in or before 2006.

[82] It may well be that certain projects are more recent; indeed, Mr. Anéziris attests to having worked on large-scale projects for the Opponent and to being employed by the Opponent full time until mid-January 2017. However, the only specific project he mentions is a dynamic traffic management project in Sherbrooke towards the end of the 1980s. In terms of more recent activity, he mentions only his collaboration on the upcoming traffic management book, which at the material date had not yet been published.

[83] Similarly, there are no concrete figures in evidence regarding the size of the Opponent's client base at the material date; the number, location, and timing of conferences at which the Opponent's Mark or Trade Name had been promoted; or the manner in which the Opponent's Mark or Trade Name had been displayed at such conferences. At best, Mr. Anéziris mentions having been in charge of impact statements, plans, and estimates for the acquisition, implementation, and evaluation of traffic control equipment for dozens of towns and municipalities in Quebec, but he does not specify when such work was performed. Mr. Anéziris also states in his affidavit that he has always identified himself at conferences and the like as being from the firm "TRAFIX", that the Opponent is known as and commonly called "TRAFIX" by its clients throughout Quebec, and that he has heard Mr. Galella being called "*Monsieur Trafix*" on numerous occasions. However, as explained in *Bojangles*, a trademark owner cannot simply assert that its trademark or trade name is known in Canada; there must be clear evidence of the extent to which it is known.

[84] The Opponent argued at the oral hearing that the Applicant could have cross-examined Mr. Galella or Mr. Anéziris and asked for undertakings to provide any additional information it wished to see. However, it is up to the Opponent to meet its initial evidential burden and the Applicant is under no obligation to assist it with doing so.

[85] Accordingly, I find that the Opponent has failed to meet its initial burden.

[86] I would note that, even had I found the evidence sufficient to meet the Opponent's evidential burden, I would have found the Applicant's legal onus to be met, for the following reasons.

Degree of resemblance—section 6(5)(e)

[87] There is necessarily a degree of resemblance between ECOTRAFIX and TRAFIX owing to the shared element TRAFIX. Indeed, the Mark incorporates the entirety of the Opponent's Mark and Trade Name. However, the Mark differs visually and phonetically because it is longer and begins with the element ECO, which also creates a difference in ideas suggested.

[88] The Opponent's trademark TRAFIX is readily recognizable as being derived from the English word "TRAFFIC" and the French word "*TRAFIC*", each of which describes the subject matter of the Opponent's Services. I find the most striking aspect of the Mark to be the substitution of the C at the end of the dictionary word with an X. I do not find the omission of one of the Fs from the English word TRAFFIC to be particularly striking, since it does not change the word's pronunciation and I do not find it to significantly alter the impression created, even for a unilingual anglophone consumer. I find the overall impression created by the trademark and trade name TRAFIX to be that of a fanciful misspelling of the common dictionary word TRAFFIC or *TRAFIC*.

[89] At the oral hearing, the Opponent submitted that TRAFIX cleverly alludes to the Opponent's services, experience, and expertise in that it connotes the concept of "fixing" traffic and transportation, in the sense of providing solutions to problems or in the sense of making traffic and transportation orderly. The Opponent further submitted that the TRA portion could stand for a number of words, for example, "transportation", "*transport*", or the French word "*travail*", meaning "work", which would connote work performed to fix things.

[90] In the absence of evidence from the parties on this point, I note the following relevant definitions from the French dictionary *Larousse* available online at *larousse.fr* and from the English *Canadian Oxford Dictionary* (2 ed.) available online at *www.oxfordreference.com* [see *Tradall SA v Devil's Martini Inc*, 2011 TMOB 65, which provides that the Registrar may take judicial notice of dictionary definitions]:

Trafic:

Ensemble des transports de marchandises ou de voyageurs, ou des circulations de véhicules ou de bâtiments, qui s'effectuent, pendant une durée définie (jour, mois, année), sur une voie de communication ou sur l'ensemble des voies d'un territoire : *Trafic portuaire, ferroviaire.*

Fixe:

1. Qui ne remue pas, ne change pas de place, qui est arrêté dans une position déterminée : *Châssis fixe d'une fenêtre.*
2. Qui a été déterminé et ne varie plus, qui a été réglé de façon durable : *Avoir un domicile fixe. Prix fixe.*
3. Qui est régulier, stable, constant : *Un revenu fixe.*

Traffic:

1. vehicles moving on a public road or highway, esp. of a specified kind, density, etc.: *heavy traffic on the 401 / traffic sign.*
 - such movement in the air, at sea, or by rail.
 - people moving, esp. on foot: a carpet worn by heavy traffic.
3. the transportation of goods, the coming and going of people or goods by road, rail, air, sea, etc.
 - the persons or goods so transported.

Fix:

1. mend, repair.
2. put in order, adjust: *fix your tie.*
3. make firm or stable; fasten, secure: *fixed a picture to the wall.*
4. decide, settle, specify (a price, date, etc.).

[91] However, in the absence of evidence as to how the word TRAFIX is marketed or perceived, I am not satisfied that it would necessarily, as a matter of first impression, be understood to denote the concept of “fixing” traffic or transportation problems or of setting

traffic or transportation to be orderly, regular, or stable—regardless of whether the question is considered from the perspective of a unilingual anglophone, unilingual francophone, or bilingual consumer. In my view, the immediate impression created by the word TRAFIX in the context of traffic-related consultation services is that of a fanciful spelling of the descriptive word TRAFFIC or *TRAFIC*.

[92] As for the Mark, I find its most striking aspect to be that it is a coined word suggesting the idea of both “ecology” and “traffic”. In my view, the Mark as a whole would convey, as a matter of immediate impression, the idea that the associated traffic-related goods respect and preserve the environment, whether it be in the way they are manufactured, in the way they are deployed, or in the effects they have on the volume and flow of traffic. I find the X at the end of the Mark to be less striking than in the Opponent’s Mark, because the Mark is a longer word—the substitution effect occurs on the last letter in a string of nine—and attention is drawn to the ECO element, being the first element of the word. Perhaps more importantly, ECOTRAFIC or ECOTRAFFIC would not be an ordinary dictionary word and thus, in my view, when the Mark is considered as a whole, the X at the end would not immediately be perceived as a fanciful misspelling of a dictionary word but rather simply as one of the letters in a coined word.

[93] Although the parties submitted that the ECO prefix might also suggest the concept of goods or services that are “economical”, I am not satisfied that this idea would be conveyed to consumers as a matter of immediate impression. In the absence of evidence on this point from either party, I am left with the dictionary definitions for this prefix, which ascribe to it the meaning of “ecology” or respect for the environment in both English and French, as shown below. In French, *Larousse* contains a number of ÉCO-prefixed words relating to the environment (as per the examples below), but none to the economy. I would also note that, in English, the *Canadian Oxford* indicates that “Econo-” is instead the combining form for “economy” and “economical” and “Econ.” the abbreviation for “economics” and “economic”.

Eco-:

combining form *ecology, ecological*

Eco-:

informal ecology: [also *attributive*] : *eco freak*.

Écoconception :

Prise en compte des critères environnementaux dans la phase de conception d'un produit.

Écoconstruction:

Procédé architectural visant à réduire, voire à supprimer, tout impact négatif d'une construction sur l'environnement ; cette construction elle-même.

Écoproduit :

Produit conçu et fabriqué de façon à respecter l'environnement.

Écoquartier :

Partie de ville ou ensemble de bâtiments qui intègre les exigences du développement durable, en ce qui concerne notamment l'énergie, l'environnement, la vie sociale.

Écocitoyenneté :

Comportement individuel ou collectif consistant à observer les principes et les règles destinés à préserver l'environnement.

[94] The first portion of a trademark is generally considered to be the most important for the purpose of distinction [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)]. However, it is also 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)]. In the present case, while I accept that ECO is descriptive of eco-friendly goods, I find that the phonetic element TRAFFIC is descriptive of traffic-related goods, such that the first element of the Mark remains important.

[95] The Opponent cites *Sparkles Cleaning Services Ltd v Ecosparkle Cleaning Services Inc.*, 2019 TMOB 88, in support of its position that the significance of the ECO prefix should be diminished; in that case, a high degree of resemblance was found between the opponent's trademark SPARKLES and the applicant's trademark ECOSPARKLE, both for use in association with housekeeping/cleaning or maid services. However, I find *Sparkles* to be distinguishable because, in that case, it was found that the shared element SPARKLE did not directly describe the nature of the services but at most vaguely suggested a degree of cleanliness

as their outcome. In the present case, I find the phonetic element TRAFFIC directly descriptive of the parties' respective goods and services, which are directed at traffic management.

[96] For its part, the Applicant submits that the significance of the shared unconventional spelling of “traffic” or “trafic” as TRAFIX should be discounted, because “there is no likelihood of confusion where the [misspelled] element (or its grammatically correct phonetic equivalent) is inherently suggestive” [para 65]. In support, the Applicant cites two related decisions of the Federal Court wherein the trademarks NUTS “R” US and TOYS “R” US were considered to be “not similar”, in part because the element “R” US was found to be the phonetic equivalent of the phrase “are us” and thus descriptive [*Toys R Us (Canada) Ltd v Manjel Inc*, 2003 FCT 282, 2003 FCT 283]. However, I find these cases to be distinguishable as well, since the Court also found significant differences in lettering style (balloon versus script fonts and, in TOYS “R” US, a backwards “R”) as well as in ideas suggested (a business specializing in nuts versus a business specializing in toys). In the present case, there is no evidence of a difference in lettering styles and the ideas suggested by the trademarks as a whole are not unrelated, in that both suggest a relation to traffic.

[97] Overall, while I find that there is necessarily a degree of resemblance between ECOTRAFIX and TRAFIX owing to the shared element TRAFIX, there are also significant differences between the trademarks visually, phonetically, and in ideas suggested.

[98] Moreover, the degree of resemblance is not the only factor to be considered in assessing the likelihood of confusion and, in this case, I find that a consideration of all the remaining circumstances tips the balance in favour of the Applicant.

Inherent distinctiveness and extent known—section 6(5)(a)

[99] 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)].

[100] In its written representations, the Opponent submits that its trademark TRAFIX, which is also the main and distinctive element of its corporate or trade name, is an invented word and thus possesses a high degree of inherent distinctiveness [paras 20, 22]. Conversely, the Applicant submits that TRAFIX is inherently weak, given that it is “a mis-spelling and phonetic corruption of the word ‘traffic’” or a homonym of the plural of the word “traffic”, and thus “highly suggestive, if not descriptive, of consultancy services pertaining to traffic management” [para 43 and oral argument]. The Applicant submits that the Mark is more inherently distinctive because it is a coined word having no clear or immediate connection to the Goods [para 50].

[101] I find that the word TRAFIX is highly suggestive if not descriptive of the nature of the Opponent’s Services and that the minor variations from the conventional spellings of TRAFFIC and TRAFIC add only a slight degree of distinctiveness. As mentioned above, in the absence of evidence as to how the word TRAFIX is marketed or perceived, I am not satisfied that it would necessarily be understood to denote the concept of “fixing” traffic as a matter of first impression. I find the Mark to be slightly more inherently distinctive, given that it is coined from two words and adds the notion of an ecological connection whose precise nature may not be immediately obvious in the context of traffic management electronics and software. That said, I still find the Mark’s inherent distinctiveness to be limited, given the clear suggestion that the associated traffic management goods are either eco-friendly or make traffic more eco-friendly.

[102] Distinctiveness can be enhanced through use and promotion in Canada and only the Opponent filed evidence in this respect. However, for the reasons discussed above, I find the evidence insufficient to establish that the Opponent’s Mark and Trade Name had become known at the material date to such an extent as to significantly enhance its distinctiveness.

Length of use—section 6(5)(b)

[103] A trademark that has been used for a long time is presumed to have made a certain impression among consumers as compared to a newly emerging trademark, thus contributing to the likelihood of confusion [*United Artists Pictures Inc v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 (FCA); *Toys "R" Us, supra*].

[104] The Federal Court has cautioned against giving even *de minimis* weight to the dates of first use claimed in a registration, and these claims are not in themselves evidence that the registered trademark has been used continuously since the claimed date [see *Tokai of Canada v Kingsford Products Company, LLC*, 2018 FC 951; and *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)]. Therefore, even had the Opponent's Registration not been expunged, it would not have established use of the Opponent's Mark since the claimed date of April 24, 1975. As discussed above, I am prepared to find that the 1977 advertisement of expert services in respect of transportation and traffic safety constitutes trademark use, and I would be prepared to find that this advertisement, as well as the related February 7, 1977 covering letter advertising "traffic engineering" in the footer, constitute both trademark and trade name use. However, as also discussed above, in the absence of evidence establishing distribution of any specific materials bearing the Opponent's Mark by the Opponent in the more recent decades, the Opponent has not established continuous use of its trademark up to the material date. Similarly, the Opponent has failed to establish continuous trade name use. References to the Opponent by third parties such as journalists do not constitute trade name use.

[105] In the circumstances, even though there is no evidence whatsoever of the Mark's use in Canada, I cannot find that this factor carries much weight.

Nature of the goods, services or business and nature of the trade—sections 6(5)(c) and (d)

[106] The Opponent submits that there are significant similarities between the Goods and the Opponent's Services, because both relate to measuring instruments, apparatus, software, and/or other technological tools for managing traffic, traffic volumes, and traffic signals and signage, such that the nature of the Opponent's Services is intrinsically linked to and/or overlaps with the nature of the Goods [paras 35-37].

[107] The Opponent notes in particular Mr. Galella's evidence that the Opponent is called on to design, develop, and/or evaluate measures and systems for managing traffic and transportation, including software, for government, institutional, and private clients. In the Opponent's submission, the Applicant may be called on to submit bids for the manufacture and/or distribution of such products, for the same clients, and thus the parties' goods and services are of

the same nature and complementary, falling in the same field and targeting the same clientele [paras 38-40].

[108] The Applicant admits that some of its Goods could be components of systems that may be studied, designed, or evaluated by the Opponent; however, the Applicant argues that the purchasers and end users are highly sophisticated and that any purchases would be “carried out with some care, likely using a tender process” [para 39]. In the Applicant’s submission, where care and deliberation are inherent to the purchasing process, confusion is unlikely, especially where the purchasers are sophisticated, the goods and services are different, and the trademarks are different [para 60, citing *Mattel*]. At the oral hearing, the Applicant emphasized the importance of the parties’ goods and services in protecting peoples’ lives.

[109] The Applicant further submits that, because the Opponent is not a manufacturer, any goods or system components employed in the provision of the Opponent's Services—such as computers for example— would necessarily be third-party manufactured and branded and would not become associated with the Opponent, for trademark purposes, simply because the Opponent uses them or because its founder and president has a patent for a good of that type [para 19].

[110] 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, who do not lose the benefit of trademark protection through their own caution and wariness; however, factors that affect the initial encounter are not irrelevant [*Masterpiece, supra*]. In the present case, I accept that purchasers of sophisticated traffic management and safety infrastructure are likely to be more alert and attentive to the trademarks and trade names 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.

[111] Nevertheless, I find that the Goods are sufficiently related to the Opponent’s Services to create an apparent nexus and potential for overlap, to the extent that official endorsement, sponsorship, or licensing of certain Goods may be perceived as a natural extension of or complement to the Opponent’s Services. Furthermore, the evidence indicates more than mere

operational use of branded equipment in providing the Opponent's Services. Mr. Galella, Mr. Anéziris, and the Opponent's documentation and press coverage mention the following studies and projects whose subject matter includes electronics for monitoring and managing traffic and controlling traffic signal systems: design of signage and traffic signals; recommendations regarding lights for pedestrians; a feasibility study and design of the first on-demand traffic light system for bus priority, deployed at approximately 1000 busy intersections; design of the first North American dynamic traffic management project using reversible lanes and lighting; a new traffic management system for bridge safety, including electronic signalling, electronic variable message signage, dynamic lit signage, real-time video monitoring, and a control centre; linkage and control of traffic lights and their remote synchronisation in real time; design and initial study of smart tolls on bridges; and experimental application of an improved traffic signal patented by Mr. Galella. Mr. Anéziris notes in particular impact statements and the preparation of plans and estimates for the acquisition, implementation, and evaluation of traffic control equipment for dozens of town and municipalities in Quebec.

[112] However, Mr. Galella's and Mr. Anéziris' lack of precision regarding the number of projects or clients involved, their locations, and the dates projects were deployed or services provided makes it impossible to determine to what extent the Opponent had provided these services or become known for their provision at the material date. In the circumstances, I am unable to conclude that the nature of the Opponent's trade at the material date was such that its customers and clients would likely perceive Goods branded with the Mark as being eco-friendly products originating from the Opponent, based on a patent or design of the Opponent, or sponsored or licensed by the Opponent.

[113] I would also note that the evidence suggests the Opponent is promoted as an independent firm that does not profit from sales of the products it recommends. For example, Mr. Anéziris specifically states that at all meetings, conferences, symposiums, conventions, and gatherings in which he participated, he always identified "TRAFIX" as an independent firm. I also note the two aforementioned 2013 articles, one specifically mentioning that Trafrix is an *independent* firm and another mentioning Mr. Galella's emphasis at a public consultation that "Trafrix" would not profit in any way from his proposal to invest in a mobile bridge that Trafrix had studied. In my view, such publicity would reduce the likelihood of a perceived connection in the present case.

[114] In summary, the parties' respective businesses appear to have a different focus, and in the absence of further information regarding the nature and extent of the Opponent's trade and reputation at the material date, I am unable to conclude that they were such that consumers would perceive a link between the Opponent and the source of Goods branded with the Mark.

Additional surrounding circumstance: Potential for family of marks

[115] In its written argument, the Opponent submits that the trademark TRAFIX may be associated with a whole host of designations if the Opponent so desires, such as "Publications TRAFIX" or "PubliTRAFIX", "Innovations TRAFIX" or "InnoTRAFIX", "Information TRAFIX" or "InfoTRAFIX", "Sécurité TRAFIX" or "SécuTRAFIX", "iTrafix", "eTRAFIX", "TRAFIXControl", "TRAFIXCom", "TRAFIXEnvironnement", "TRAFIXTranspo", "TRAFIXAlternatif", "TRAFIXMobilité", "TRAFIXBus", "TRAFIXCovoiturage" [TRANSLATION: TRAFIXRideshare], "TRAFIXGuide", "TRAFIXEconomie" [para 23].

[116] At the oral hearing, the Opponent added "Clinique TRAFIX" and "Gestion TRAFIX" [TRANSLATION: "TRAFIX Clinic" and "TRAFIX Management"] as possibilities, and submitted that there are many aspects to the Opponent's business that could give rise to such variations on the distinctive TRAFIX motif. In the Opponent's submission, its field is so broad that adding a prefix such as ECO to reference "ecology" or "economy" is insufficient to distinguish and would be perceived simply as creating a version of the Opponent's distinctive trademark TRAFIX.

[117] However, there is no indication anywhere in the evidence to suggest that the Opponent, at any time from the 1970s to 2016, has used the trademark or trade name TRAFIX with any generic elements other than "Consultants". Although the Opponent claims use of the trade name *Signalisation TRAFIX Inc.* prior to 1983, the documentary evidence indicates that the trade name in use prior to 1983 was simply TRAFIX Inc. Accordingly, I am not satisfied that the average consumer of the Opponent's services would necessarily expect any coined word ending in TRAFIX to come from the Opponent. Even if there were documentary support for the early use of the trade name *Signalisation TRAFIX Inc.*, the Opponent has not established that the average consumer at the material date would be familiar with versions of the Opponent's corporate name used some 35 years earlier. In any event, I am not satisfied that the average consumer would be

likely to infer from such past use of a different generic element in the Opponent's corporate name that a new coined word such as ECOTRAFIX would necessarily belong to the Opponent.

Additional surrounding circumstance: Contextual factors

[118] In its written argument, the Applicant submits that the lack of resemblance between the parties' trademarks is "underscored to the extent that [the Opponent] mixes or juxtaposes other words ('Les', 'Consultants', 'Inc.')

 in combination with the word 'trafix'" [para 66]. In this respect, although the Opponent's Mark and Trade Name is TRAFIX alone, I accept that the specific context in which it is displayed may affect how it becomes known, which may in turn affect the likelihood of confusion.

[119] In particular, much of the Opponent's stationery and advertising and many of the newspaper articles in evidence identify the Opponent by a version of its trade name that includes the word "Consultants", such as "Les Consultants Trafix" or "Trafix Consultants". Approximately twice as many articles omit the "Consultants" element from the Opponent's name as include it; however, approximately half of those that omit it specify that the Opponent is a consulting firm. To the extent that publicized variations of the Trade Name include the word "Consultants" or that TRAFIX tends to be qualified as being the name of a consulting firm, I find that the Opponent's trademark and trade name TRAFIX would tend to become known as the name of a consulting business. Conversely, neither the trademark ECOTRAFIX nor the Goods are intrinsically linked to the notion of a consultancy business.

[120] I find that this circumstance decreases the likelihood of consumers perceiving a connection between the Mark, used in association with the Goods, and the source of services offered by "Les Consultants TRAFIX inc." or "the consulting firm TRAFIX".

Additional surrounding circumstance: Appearance of conflict of interest

[121] The Opponent submits that the coexistence of the parties' trademarks and trade names could create the appearance of conflicts of interest for the Opponent, if the Opponent is perceived as also manufacturing and selling the types of products that it designs and proposes and for which it prepares purchase plans and performance estimates. At the oral hearing, the

Opponent emphasized how and why it must maintain the appearance of independence to have its estimates and opinions accepted by government agencies and the public. However, the impact that use of the Mark might have on the Opponent's reputation is beyond the scope of the present proceeding. The issue to be decided under this ground of opposition is whether the Mark actually distinguished or was adapted to distinguish the Goods at the material date, not whether use of the Mark could ultimately damage the distinctiveness of the Opponent's Mark and Trade Name.

Conclusion with respect to likelihood of confusion

[122] 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].

[123] In the present case, having considered all the surrounding circumstances, I am satisfied that, on a balance of probabilities, the Applicant's legal burden would be met. I come to this conclusion bearing in mind that the Opponent's Mark and Trade Name is highly suggestive if not descriptive of the associated services and that there is very limited evidence regarding its use or promotion in Canada leading up to the material date. Thus the evidence does not allow me to conclude that the Opponent's Mark and Trade Name would be entitled to a particularly wide ambit of protection. In the circumstances, I find that the differences between the Mark and the Opponent's Mark and Trade Name 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' fields. In my view, based on the evidence of record, purchasers at the material date would not be likely to infer, as a matter of first impression upon seeing the Mark, that the Goods are from the same source as the Opponent's Services or have been approved, licensed or sponsored by the Opponent.

[124] In view of the foregoing, the ground of opposition based on non-distinctiveness is rejected.

DISPOSITION

[125] In view of all the foregoing and 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.

Oksana Osadchuk
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2021-07-26

APPEARANCES

M. Ottavio Galella

FOR THE OPPONENT

Adele Finlayson

FOR THE APPLICANT

AGENTS OF RECORD

No agent appointed

FOR THE OPPONENT

Moffat & Co.

FOR THE APPLICANT