



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 033

Date of Decision: 2023-02-23

IN THE MATTER OF AN OPPOSITION

Opponent: BUREAU VERITAS, société anonyme

Applicant: Veritas Technologies LLC

Application: 1,697,454 for VERITAS

INTRODUCTION

[1] BUREAU VERITAS, société anonyme (the Opponent) opposes registration of the trademark VERITAS (the Mark), which is the subject of application No. 1,697,454 (the Application), presently standing in the name of Veritas Technologies LLC (the Applicant), on the basis of proposed use of the Mark in Canada in association with a long list of services in the computer services industry, as will be set out in greater detail below.

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

THE RECORD

[3] The Application was originally filed by Symantec Corporation on October 9, 2014 and later assigned to the Applicant. The Application was advertised for opposition purposes in the *Trademarks Journal* on August 23, 2017.

[4] The Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on July 20, 2018.

[5] All references herein are to the Act as amended on June 17, 2019, with the exception of references to the grounds of opposition which refer to the Act before it was amended (see section 70 of the Act which provides that section 38(2) of the Act, as it read prior to June 17, 2019, applies to applications advertised before that date).

[6] The statement of opposition originally raised two grounds of opposition. The Applicant requested an interlocutory ruling on the sufficiency of the second ground of opposition, pleaded in paragraphs 5(a) to (e) of the statement of opposition. In response, and with leave of the Registrar, the Opponent amended those paragraphs. The Registrar nevertheless found the second ground of opposition to be insufficiently pleaded and, by way of an interlocutory decision dated December 13, 2018, struck the impugned paragraphs.

[7] As a result, the sole remaining ground of opposition in this proceeding is based on non-compliance of the Application with section 30(a) of the Act in that some of the services in association with which the Mark is proposed to be used are not defined in sufficiently specific and ordinary commercial terms.

[8] On January 10, 2019, the Applicant filed and served a counter statement denying the ground of opposition. On September 10, 2019, the Applicant also amended certain terms in the statement of services; the amendments, which will be described in greater detail below, were accepted and recorded by the Registrar on September 26, 2019.

[9] In support of its opposition, the Opponent filed the affidavit of Diane Medeiros, Intellectual Property Assistant for the Opponent's agent, sworn May 9, 2019. The

Medeiros affidavit purports to introduce into evidence the results of Ms. Medeiros' searches conducted on May 9, 2019 on the Canadian Intellectual Property Office (CIPO)'s online Goods and Services Manual (the Goods and Services Manual) for various terms [Exhibit A].

[10] In support of its Application, the Applicant filed the affidavit of Michael Gardiner, articling student for the Applicant's agent, sworn September 9, 2019. The Gardiner affidavit purports to introduce into evidence the results of Mr. Gardiner's searches in the Goods and Services Manual [Exhibit MG-1] and in CIPO's Trademarks Database [Exhibit MG-2], on August 27 and 28, 2019. The Gardiner affidavit also includes "pdfs taken of webpages from searches performed using Google and Way Back Machine" conducted on August 27 and 28, and September 2 and 5, 2019 [Exhibit MG-3].

[11] Neither of the affiants were cross-examined.

[12] Only the Applicant filed written representations. Both parties were represented at a hearing. In this regard, I note that the Applicant submitted, as part of its list of authorities, alleged "dictionary-based authorities" and, a few moments before the hearing, a "plan of argument" in support of its oral submissions, the admissibility of which was objected to by the Opponent, as discussed below.

PRELIMINARY REMARKS

[13] At the start of the hearing, the Opponent raised three objections.

[14] First, the Opponent contests the admissibility of a set of webpage printouts provided along with the Applicant's list of authorities, and referred to by the Applicant as extracts from "dictionary-based authorities" from three online sources, namely "Gartner IT Glossary", "Techopedia" and "Webopedia". The Opponent argues that these alleged "authorities" are not dictionaries *per se*, or other recognized sources of information whose accuracy is beyond question. The Opponent also points out that many of the extracts are either dated after the material date to assess the section 30(a) ground of

opposition, or undated, such that their relevance at the material date cannot be assessed.

[15] I agree with the Opponent that there are insufficient details about the date and provenance of the information conveyed in the extracts for me to accept them as uncontested dictionary definitions which existed as of the material date. Moreover, it is apparent that at least some of the extracts, such as Q&A articles and comments authored by individuals, do not contain the kind of clear and uncontested facts of which kind I can take judicial notice. Accordingly, these alleged “dictionary-based authorities” will not be considered.

[16] Second, the Opponent objects to the plan of argument, as it was provided by the Applicant only moments before the hearing, not giving the Opponent sufficient time to assess its content. In response, the Applicant explained that the plan was merely a summary of its written representations and contemplated oral submissions, and was provided only to facilitate the correlation between the evidence and its argument. Ultimately, the parties were in agreement that only the pinpoint references to the evidence provided on the last page of this plan could be considered for the purpose of my decision.

[17] Third, the Opponent objects to the admissibility of the Gardiner affidavit and, in particular, the materials provided by Mr. Gardiner as Exhibit MG-3. The portion of the affidavit introducing Exhibit MG-3 is reproduced below:

On August 27th, August 28th, September 2nd and September 5th, 2019 I performed a series of searches on www.google.com (hereinafter “Google”), as well as <https://archive.org/web/> (hereinafter “Way Back Machine”).

- Attached hereto at Exhibit MG-3 are pdfs taken of webpages from searches performed using Google and Way Back Machine.

[18] The Exhibit MG-3 documents are webpage printouts and documents from websites located at www.canada.ca, www.journalofaccountancy.com, www.techopedia.com, www.statcan.gc.ca, livingstoneadvisory.com, www.deloitte.ca, and www.wikipedia.org, among others. Terms highlighted in yellow in the exhibited

documents are essentially those contested by the Opponent, such as: “electronic data files”, “data availability”, “data visibility”, “data insights”, “data continuity”, “data discovery”, and “data conversion services”.

[19] Some of the highlighted terms are part of purported definitions, such as:

- “[d]ata conversion is the conversion of one data format into another” [www.techopedia.com],
- “[d]ata availability is the process of ensuring that data is available to end users and applications- when and where they need it” [www.techopedia.com],
- “... insights are relatively rare. Insights here are defined as actionable, data-driven findings that create business value” [www.hbr.org],
- “[d]igital continuity is the ability to maintain the digital information of a creator in such a way that the information will continue to be available, as needed, despite changes in digital storage technology” [www.wikipedia.org], and
- “data discovery is the process of collecting data from your various databases and silos, and consolidating it into a single source that can be easily and instantly evaluated” [www.phocassoftware.com].

[20] Other highlighted terms are part of promotional or informational materials referencing those terms in a manner that assumes knowledge of their meanings, such as:

Data Discovery tools have revolutionized Business Intelligence (BI) and are the vital link in the facilitation of self-service BI, which is part of the larger movement towards the simplification of Business Intelligence. More than any other technology, these tools empower the business user to take advantage of data as it is needed, effectively reducing time to insight. [www.dataversity.net]

Datalink’s data continuity assessment services help you align key business functions with information systems, so you are able to assign the proper amount of protection to all data. Using both quantitative and qualitative analysis, we define and identify linkages and dependencies among processes, applications, and infrastructure. [www.datalink.com]

[21] In its oral submissions, the Opponent argued that the Gardiner affidavit provides no information regarding the instructions given to Mr. Gardiner nor the parameters he used when he conducted his searches and how he selected the search results attached to his affidavit. The Opponent also submitted that Mr. Gardiner is an articling student for the Applicant's agent and submitted that, in the absence of a more detailed description of the search parameters, the credibility of the search results cannot be assessed because the exhibited materials could be the result of cherry-picking and not actually representative of the results obtained by Mr. Gardiner. The Opponent therefore contends that the evidence lacks objectivity and that, even if the evidence is found to be admissible, it should be accorded very little weight.

[22] While the parameters of Mr. Gardiner's search having led to Exhibit MG-3 are not expressly stated, I see no reason to exclude from the evidence the materials attached as Exhibit MG-3 as these materials merely consist of various printouts of and/or excerpts from webpages retrieved using the Google search engine or the Internet Wayback Machine archive, in which have been highlighted in yellow each of the particular search terms seemingly used by Mr. Gardiner. While the exhibited materials do not establish the truth of their contents, I am nonetheless prepared to give Exhibit MG-3 limited weight, insofar as the Applicant relies on this evidence to establish that the highlighted terms were included in online third-party publications which existed on the disclosed search date.

ANALYSIS OF THE SECTION 30(a) GROUND OF OPPOSITION

[23] As noted above, the sole ground of opposition in this proceeding is based on section 30(a) of the Act which reads as follows:

An applicant for the registration of a trademark shall file with the Registrar an application containing... a statement in ordinary commercial terms of the specific goods or services in association with which the mark has been or is proposed to be used.

[24] The Opponent pleads that the Application "does not contain a sufficiently specific statement in ordinary commercial terms" of the services listed in the Application. In particular, the Opponent alleges that the services in association with which the Mark is

proposed to be used are insufficiently described, “including but not limited to” the terms underlined below (underline in original):

Electronic general storage services for archiving databases, images and other electronic data files; Electronic storage of data files for clients to store and retrieve data via a global computer network; electronic document archiving services; email archiving services; computer services featuring software as a service for use in data storage and information management solutions, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis; cloud computing services for data storage and information management, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis; computer software installation services; design, development, updating and maintenance of software in the field of database management; application service provider services featuring software as a service for use in data storage and information management solutions, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis; provision of information and online database regarding computers, computer hardware, computer software, computer networks, computer-related data storage and information management services, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis, data storage management, enterprise information management, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis and online analytical processing (OLAP); computer consultation in the fields of data storage and information management, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis; software consultation; technical support services in the form of troubleshooting of computer hardware and software problems; computer support services, namely, provision of technical assistance and technical support in the form of troubleshooting of computer hardware and software problems; computer software design for others; remote or on-site monitoring of computer systems; monitoring the computer systems of others and providing back-up computer programs and facilities; providing data conversion services of computer program data or information; internet, software and computer application hosting services; providing temporary use of on-line non-downloadable cloud computing software featuring software as a service for use in data storage and information management solutions, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis; cloud hosting provider services in the fields of data storage and information management, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis; cloud computing featuring software for use in data capture, data recovery and data management; platform as a service (PAAS) featuring computer software platforms for cloud-based services in the fields of data storage and information management, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis; Software as a service (SAAS) featuring computer software for cloud-based services in the fields of data storage and information management, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis; computer disaster recovery planning and services

[25] Generally, the relevant date to assess a ground of opposition based on section 30(a) of the Act is the date the application was filed [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB)]. However, when the application has been amended, as in the present case, the material date is the date of the amendment [*Eaton Williams (Millibank) Ltd v Nortec Air Conditioning Industries Ltd* (1982), 73 CPR (2d) 70 (TMOB)]. As such, the relevant date for considering the section 30(a) ground in this case is September 10, 2019.

[26] The Opponent has the initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support the ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the ground of opposition should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd*, 1990 CanLII 11059, 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29].

[27] The initial burden on an opponent under a section 30(a) ground is a light one and can in some cases be met through argumentation alone [see *McDonald's Corp v MA Comacho-Saldana International Trading Ltd* (1984), 1 CPR (3d) 101 (TMOB) and *Pro Image Sportswear Inc v Pro Image Inc* (1992), 42 CPR (3d) 566 (TMOB)].

[28] In this case, the Opponent relies on the Medeiros affidavit to establish that the following terms searched by Ms. Medeiros are either not included in the Goods and Services Manual or, if included, they are described more specifically than in the Application: “Electronic data files”, “Other electronic data files”, “Availability”, “Visibility”, “Insight”, “Continuity”, “Discovery”, “Data conversion”, and “Providing data conversion services of computer program data or information”.

[29] In response, the Applicant submits that its evidence shows that terms similar to those listed in the Application are commonly used in the industry, and are included in the Goods and Services Manual, and in the statements of goods and services of trademarks registered in Canada.

[30] Before proceeding with the analysis of those arguments, I note that the statement of opposition indicates that the ground of opposition targets certain underlined terms, but is not limited to those terms. In this respect, the Applicant submits that, despite the non-restrictive wording used in the statement of opposition, the ground of opposition should be considered as limited to the specific terms which were underlined therein. I agree.

[31] The Opponent adduced no evidence to suggest that it objects to terms which are not underlined in the statement of opposition [see *Novopharm Ltd v AstraZeneca AB*, 2002 FCA 387 for the principle that once evidence is filed, the Registrar must take it into account when interpreting the pleadings]. Moreover, the Opponent's submissions at the hearing were only directed to the sufficiency of the underlined terms. Consequently, I consider that the ground of opposition is limited to the services as described by these underlined terms.

[32] Each of the contested services will be addressed in turn below.

Electronic general storage services for archiving databases, images and other electronic data files

[33] The statement of services "Electronic general storage services for archiving databases, images and other electronic data files" was amended by the Applicant to delete the word "other". The amended statement of services now reads: "Electronic general storage services for archiving databases, images and electronic data files".

[34] The Opponent indicated at the hearing that it maintains its objection in respect of these services despite the amendment. Nevertheless, the Opponent chose not to submit any arguments in support of its objection and to rely only on the evidence.

[35] The search results provided in the Opponent's evidence show that the terms "Electronic data files" and "Other electronic data files" are not included in the Goods and Services Manual. However, as indicated on CIPO's website, the Goods and Services Manual is a "representative listing of terms" that have been pre-approved by the Registrar and will be accepted without the need for further specification. Nevertheless, it

is well-established that as a representative listing, the absence of an entry in itself does not meet an opponent's initial evidential burden with respect to a ground based on section 30(a) of the Act [see, e.g., *Chicago Mercantile Exchange Inc v Canadian Mortgage Experts Inc*, 2021 TMOB 203 at para 34; *Browns Social House Ltd v Aware Beverages Inc*, 2021 TMOB 57 at para 18].

[36] In light of the above, and in the absence of submissions from the Opponent regarding "Electronic general storage services for archiving databases, images and electronic data files", I find that the Opponent has failed to satisfy its evidential burden in respect of these services and the ground of opposition is rejected in respect thereof.

Computer disaster recovery planning and services

[37] The statement of services "computer disaster recovery planning and services" was amended such that "services" are further specified as "*computer disaster recovery services*" (my emphasis). The amended statement of services now reads: "computer disaster recovery planning and computer disaster recovery services".

[38] Again, the Opponent indicated at the hearing that it maintains its objection in respect of these services, but chose not to make submissions. There is no reference to these services in the Opponent's evidence.

[39] Furthermore, having exercised my discretion to check the Goods and Services Manual [*Johnson & Johnson v Integra Lifesciences Corp* (2011), 98 CPR (4th) 429 (TMOB)], I note that the descriptions "computer disaster recovery planning" and "computer disaster recovery services" have been listed in the Manual since October 6, 2009 and October 20, 2022, respectively [see *Trademarks Examination Manual* (the Examination Manual), at section 2.4.5 indicating that a statement of services is acceptable if it is as specific, or more specific than, a related or similar listing; see also *Ansell v Industria De Diseno Textil, SA*, 2013 TMOB 169].

[40] While one of these terms was added to the Goods and Services Manual after the material date, its absence as of that date is not in itself an indication that the term was previously unacceptable. Quite the contrary, the fact that it was added to the Manual

indicates that the description is sufficiently specific and, given the relatively short time elapsed between the material date and the addition, suggests that it was also acceptable at the material date [see *BioSyent Pharma Inc v Shield TX (UK) Limited*, 2022 TMOB 162 at para 26 where the Registrar considered listings that became effective after the material date; see also *Mumusokr Co, Ltd v Guangdong Saiman Investment Co Ltd*, 2022 TMOB 28 at para 12].

[41] In any event, as the Opponent did not put forward any evidence or argument in support of its pleading, I find that it has failed to meet its initial evidential burden in respect of the services “computer disaster recovery planning and computer disaster recovery services” and the ground of opposition is also rejected in respect thereof.

Providing data conversion services of computer program data or information

[42] The statement of services “providing data conversion services of computer program data or information” was amended to replace the word “or” with the word “and”. The amended statement of services now reads: “providing data conversion services of computer program data and information”.

[43] At the hearing, the Opponent argued that “data conversion” is insufficiently specific because it fails to specify the type of conversion and the specific nature of the data being converted. In support, the Opponent pointed to the search results provided in the Medeiros affidavit showing that the services “Providing data conversion services of computer program data or information” are not included in the Goods and Services Manual, and that the term “data conversion” is more specifically described to identify the nature of such conversion, namely “conversion of data or documents *from physical to electronic media*” and “document data transfer and conversion *from one media to another*” (my emphases).

[44] In further support, the Opponent referred to section 2.4.5.15 of the Examination Manual, titled “Services related to the electronic transmission of data”. This section of the Manual indicates that services which contain the word “data” such as “data transmission services” and “electronic transmission of data”, are not acceptable without

further specification since “data” in this context can include any information in numerical form that can be digitally transmitted or processed (including audio, video, voice, or any other form of data).

[45] Given the technical nature of the services listed in the Application, and as I may refer myself to dictionaries to determine the meaning of a word, I have consulted dictionaries in the field of information technology [see *SoftLayer Technologies, Inc v Groupe iWeb Inc*, 2015 TMOB 131 for a similar approach]. I have identified the following relevant definitions:

Data conversion: Changing from one type of file format to another.

The Computer Desktop Encyclopedia, 2nd ed., Alan Freedman, AMACOM, New York, 1999

Data conversion: The process of changing data from one form of representation to another.

Dictionnaire d'informatique anglais-français : grande informatique, micro-informatique, télécommunications, bureautique et terminologie IBM / Original English edition by John Wood and George McDaniel; Bilingual edition by Bao Pham and Marc Drapeau, 1994; and

Data processing glossary, International Business Machines, White Plains, New York, 1969

Conversion: In programming languages, the transformation between values that represent the same data element but belong to different types.

Information Technology Vocabulary, Canadian Standards Association, Rexdale, Ontario, 1992

[46] The above definitions support the Applicant’s position that such services are defined in sufficiently specific ordinary commercial terms. Besides, these definitions are also corroborated by the purported definition of “data conversion” taken from Exhibit MG-3 of the Gardiner affidavit reproduced above [*Mövenpick-Holding AG v Sobeys Capital Incorporated*, 2010 TMOB 41 at para 38; see also *Fox on Canadian Law of Trade-marks and Unfair Competition*, 4th Edition, § 2.4.5.1 “Ordinary commercial

terms” for the principle that an ordinary commercial term is a term proven to be used by others in the same field to describe the same services.]

[47] In addition, as indicated in the Examination Manual, where a single term such as “data” could fail the test of paragraph 30(a), such term can be acceptable when it is understood within the context of an entire statement [Examination Manual at section 2.4.5.3]. On this point, the Federal Court confirmed in *Les Marques Metro / Metro Brands SENC v 1161396 Ontario Inc*, 2017 FC 806 at paras 47-48, that context can be used to specify generic terms and unacceptable statement of goods or services [see also *ROBIC Canadian Trademarks Act Annotated*, § 5.3.1.7 “Use of Context to Interpret Goods and Services”].

[48] The terms at issue are therefore not to be considered in isolation but in the context of the description “Providing data conversion services of computer program data and information”, specifying that the conversion services relate to not just any data, but to *computer program* data and information.

[49] In light of the above, I find that the Opponent has failed to satisfy its evidential burden in respect of the services “providing data conversion services of computer program data and information” and the ground of opposition is rejected in respect thereof.

Data availability, visibility, insight, continuity and discovery

[50] The remaining contested services are those which contain the words “availability”, “visibility”, “insight”, “continuity” and “discovery”. There are ten instances of each of those words, as set out in the excerpt of the statement of services reproduced below. The grey highlighting identifies the root terms describing each of the contested services; the root terms will later be discussed in greater detail.

computer services featuring software as a service for use in data storage and information management solutions, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis;

cloud computing services for data storage and information management, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis;

application service provider services featuring software as a service for use in data storage and information management solutions, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis;

provision of information and online database regarding computers, computer hardware, computer software, computer networks, computer-related data storage and information management services, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis, data storage management, enterprise information management, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis and online analytical processing (OLAP);

computer consultation in the fields of data storage and information management, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis;

providing temporary use of on-line non-downloadable cloud computing software featuring software as a service for use in data storage and information management solutions, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis;

cloud hosting provider services in the fields of data storage and information management, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis;

platform as a service (PAAS) featuring computer software platforms for cloud-based services in the fields of data storage and information management, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis;

Software as a service (SAAS) featuring computer software for cloud-based services in the fields of data storage and information management, namely data retention, backup, recovery, availability, visibility, insight, continuity, archiving, discovery, and analysis;

[51] At the hearing, both parties agreed that, when read in context, the underlined words are properly understood as “*data availability*”, “*data visibility*”, “*data insight*”, “*data continuity*” and “*data discovery*”. Both parties also agreed that those terms describe “functionalities” (or “features”).

[52] The Opponent however argued that the words “availability”, “visibility”, “insight”, “continuity” and “discovery” are not in ordinary commercial terms, and are overly broad and generic because they describe every type of software application rather than the Applicant’s software in particular.

[53] In support of its position, the Opponent relied on the search results provided in the Medeiros affidavit showing that the terms “visibility”, “insight” and “discovery” are not included in the Goods and Services Manual, and that the terms “availability” and “continuity” are only included as part of unrelated goods, namely “firmware for controlling paper availability”, “continuity testers” and “sheet-continuity sequencing machines”. The Opponent also submitted that only very few examples of registered trademarks including the contested words in their statements of services were identified in the Applicant’s evidence.

[54] The Opponent also referred to purported definitions in the Applicant’s evidence, namely the Exhibit MG-3 materials of the Gardiner affidavit. For example, with respect to “availability”, the Opponent argued that “ensuring that data is available to end users and applications” is a feature of every software application and, therefore, that “computer services featuring software as a service for use in data storage and information management solutions, namely data... availability” is insufficiently specific.

[55] In response, the Applicant essentially argued that the Opponent has not met its evidential burden and, in any event, that the contested services or analogous descriptions thereof are included in the Goods and Services Manual, covered by other registrations and used by other traders in the industry.

[56] Both parties submitted evidence relating to the contested words. However, these words are not to be considered in isolation—they must be considered in the context of the entire statement of services, including the root terms highlighted above. The root terms describe the contested services as seven types of software-based tools for data storage and information management, and two related services, namely computer consultation, and provision of information and online databases, both in the fields of data storage and information management.

[57] Before considering the contested words, I find it appropriate to comment on each of the root terms.

Root terms

[58] There is no evidence nor has the Opponent made any concrete submissions purporting to establish that each or some of the root terms are insufficiently specific or not in ordinary commercial terms. In this regard, I note that in the case of each contested service, the root term describes both the *type of service*, such as cloud computing services, computer services featuring software as a service, and consulting services, as well as the *field of use*, namely data storage and information management. Such descriptions are consistent with related or similar listings in the Goods and Services Manual, as further set out below.

[59] One striking example is the series of acceptable services listed in the Manual as “platform as a service” and “software as a service”. Based on my review of the numerous recent listings for such services, these descriptions are acceptable when combined with their field of use or purpose, *e.g.*:

“platform as a service (paas) featuring computer software platforms for use in the field of financial services for trading derivatives” [2012-10-17];

“software as a service (SAAS) provider in the field of software for small business accounting” [2011-11-24]; “software as a service (SAAS) featuring software for the operation of a grocery delivery service [2022-11-10]”.

[60] The same goes for the services of “cloud computing”, “application service provider” and “providing temporary use of online non-downloadable computer software”, which are acceptable when combined with a description of their field of use or purpose, *e.g.*:

“cloud computing featuring software for use in enterprise content management, enterprise content integration and business records management”, see also “cloud computing provider services for general storage of data” [2022-11-24];

“application service provider (ASP) services featuring software for use in enterprise content management, enterprise content integration and business records management” [2022-11-24];

“providing temporary use of online non-downloadable cloud-based software for use by travelers to make travel arrangements” [2022-02-03].

[61] Likewise, the Manual contains mostly recent listings for “computer services” which are more specifically described on the basis of their purpose or function, e.g.:

“computer services, namely, hosting an interactive web site that allows users to upload, store and maintain automotive repair records” [2023-01-12]; and

“computer services in the form of filtering unwanted e-mails” [2009-10-06].

[62] I also note that « cloud hosting provider services », without further specification, have been in the Manual since 2021.

[63] The two remaining contested services are the “related services” referenced above, namely computer consultation, and provision of information and online databases, both in the fields of data storage and information management. In this regard, I note that the Manual contains as acceptable descriptions (i) a “computer consultation” service; (ii) information-providing services described as “provision of information in the field of...” and “provision of information relating to...”; as well as (iii) the terms “electronic databases” and “online databases” in various forms:

(i) “computer consultation in the field of computer security” [2021-06-10];

(ii) “provision of information in the field of cancer prevention, screening, diagnosis and treatment” [2018-01-09]; “provision of information relating to garden or flower bed care” [2018-01-09]; and

(iii) “electronic databases in the field of financial planning recorded on computer media” [2009-10-06]; “providing information on respondents for opinion polling and market research polling purposes via an online database” [2022-12-22].

[64] As for the field of data storage and information management, I note that data storage devices (“cassettes”, “floppy disks”, and “magnetic tapes” [2021-09-23]) and electronic data storage services (e.g. “electronic data storage for archiving business records” [2022-10-20]) are listed in the Manual. Other listings also refer to information management systems (e.g. “provision of advisory services in the design, development and implementation of information management systems” [2022-12-01]), and

information management-related services (e.g. “business information management” [2021-12-02]; “financial information management in the field of insurance and reinsurance” [2022-08-25]).

[65] Having considered the root terms, I turn now to the specifically contested words “availability”, “visibility”, “insight”, “continuity” and “discovery”.

Contested words

[66] First, in view of the Opponent’s evidence and arguments, it is worth repeating that the mere fact that a word or phrase is not found in the Goods and Services Manual does not necessarily lead to a finding that such word or phrase is not defined in ordinary commercial terms. Moreover, I agree with the Applicant that software-related services, generally, and the particular services covered by the Application, fall within a relatively new industry and a rapidly developing one. This is notably reflected in the numerous relevant listings recently added to the Goods and Services Manual.

[67] In this regard, in response to both parties’ representations, I find the state of the register evidence introduced through Exhibit MG-2 of the Gardiner affidavit to be of no assistance. The rarity of trademark registrations covering services in the field of data storage and information management which are described by the contested words does not necessarily mean that such services are not defined specifically in ordinary commercial terms. Conversely, the mere existence of these registrations does not necessarily establish that the services are defined specifically in ordinary commercial terms.

[68] Second, all of the listed features of data storage and information management, including the contested words, are described using common dictionary words. For example, the word “insight” is defined in the *Canadian Oxford Dictionary* as “the capacity of understanding hidden truths etc., esp. of character or situations”. The word “discovery” is defined as “the act or process of discovering or being discovered”, and to “discover” is defined as “to find out or become aware of, whether by research or searching or by chance”. As such, “data discovery” and “data insight” features in the context of data storage and information management are reasonably understood to

mean that data and information are stored and managed such that hidden truths are understood, revealed or discovered.

[69] In this regard, I note that the references to these terms in the Exhibit MG-3 materials, such as a webpage located at *www.dataversity.net* which describes “data discovery tools” as tools empowering the user to “take advantage of data as it is needed, effectively reducing time to insight”, are consistent with the above interpretations of the listed features.

[70] The listed “data availability” feature can be similarly interpreted. The *Canadian Oxford Dictionary* provides that “availability” is a derivative noun of the adjective “available”, meaning to be “capable of being used; at one’s disposal; obtainable”. The feature of “data availability” is therefore reasonably understood to mean that the data and information will be “available to end users and applications- when and where they need it” [see Exhibit MG-3 webpage printout from *www.techopedia.com*, referenced above].

[71] Lastly, I will address the Opponent’s argument that the contested words are overly broad because they describe features which are allegedly common to every software application. As stressed by the Applicant, the Opponent did not explain why it did not object to other presumably common features listed in the Application such as data “retention” and “archiving”. In any event, I am not convinced that listing features, as common as they may be, necessarily renders the description of the contested services insufficiently specific. Indeed, the features in question are merely those of the field of data storage and information management. As discussed above, the contested services are in fact software-based tools in that field, and related consulting and information-providing services.

[72] To sum up, I find that the Opponent has failed to meet its initial evidential burden in respect of each of the ten instances of the contested words “availability, visibility, insight, continuity” and “discovery” and the ground of opposition is rejected in respect thereof.

[73] In view of all of the above, the section 30(a) ground of opposition is rejected in its entirety.

DISPOSITION

[74] 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.

Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2022-11-01

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