



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 169

Date of Decision: 2023-09-29

IN THE MATTER OF AN OPPOSITION

Opponent: OnePoint (Société par actions simplifiée)

Applicant: Pillar To Post, Inc.

Application: 1,932,058 for OnePoint Logo

INTRODUCTION

[1] OnePoint, a simplified joint-stock company, (the Opponent) opposes an application filed by Pillar To Post, Inc. (the Applicant) to register the trademark OnePoint Logo reproduced below (the Mark) for use in association with residential and commercial building evaluation and inspection services and related computer application software for home inspection professionals.



[2] The Mark consists of the compound word “OnePoint” following a geometric design comprising a circle framed on the right by an arc tapering upwards, with the circle and word “Point” being in a lighter shade.

[3] The opposition is based primarily on an allegation that the Mark is confusing with the Opponent's trademarks and trade names consisting of or containing the words "ONE POINT" or "ONEPOINT", used in association with an information technology and business management enterprise whose services include digital solutions for companies in the field of real estate. The Opponent also alleges that the Applicant was not using and did not propose to use the Mark in Canada in association with the goods and services listed in the application when the application was filed.

[4] For the reasons that follow, I find that the ground of opposition alleging a likelihood of confusion with the Opponent's registered trademark ONEPOINT succeeds and, consequently, I refuse the application.

THE RECORD

[5] Application no. 1,932,058 for the Mark (the Application) was filed on November 22, 2018, based on use in Canada since at least as early as August 2016 in association with the following goods and services:

Goods (Nice class & statement)

- 9 Computer application software for mobile phones, portable computers, tablet computers, and hand held computers, namely software allowing home inspection professionals to book home and building inspection appointments, access building and purchaser details, conduct home and building inspections, and to prepare home and building inspection reports including photographs and information outlining findings and potential concerns (the Goods).

Services (Nice class & statement)

- 38 Residential and commercial building evaluation and inspection services; Software as a service (SAAS) provider in the field of software for mobile phones, portable computers, tablet computers, and hand held computers, namely software allowing home inspection professionals to book home and building inspection appointments, access building and purchaser details, conduct home and building inspections, and to prepare home and building inspection reports including photographs and information outlining findings and potential concerns (the Services).

[6] The Application was advertised for opposition purposes in the *Trademarks Journal* on November 3, 2021, and opposed on December 16, 2021, when the

Opponent filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The Applicant filed a counter statement that it intends to respond to the opposition.

[7] The grounds of opposition allege that the Mark is not registrable under section 12(1)(d) of the Act; that the Applicant is not the person entitled to registration under sections 16(1)(a) and 16(1)(c) of the Act; that the Mark is not distinctive within the meaning of section 2 of the Act; that the Application was filed in bad faith, pursuant to section 38(2)(a.1) of the Act; that the Applicant was not using and did not propose to use the Mark in Canada, pursuant to section 38(2)(e) of the Act; and that the Applicant was not entitled to use the Mark in Canada, pursuant to section 38(2)(f) of the Act. In accordance with section 69.1 of the Act, since the Application was advertised after the Act was amended on June 17, 2019, the grounds of opposition will be assessed based on the Act as amended.

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

- A certified copy of its registration no. TMA929,231 (the Opponent's Registration) for the trademark ONEPOINT (the Opponent's Trademark), covering a wide variety of goods and services, which are set out at Schedule A to this decision.
- The May 11, 2022, affidavit of Pierre-Paul Melanson, who is the Vice-president and Secretary of the Opponent's wholly owned subsidiary, onepoint Canada Inc. (OnePoint Canada). Mr. Melanson describes use and promotion of the Opponent's trademarks and trade names by the Opponent and by OnePoint Canada. In this respect, Mr. Melanson notes that the Opponent's founder and president is also the president of OnePoint Canada, and he confirms that the Opponent, directly or indirectly, by way of licence and corporate structure, controls the activities of OnePoint Canada, including the character and quality of the services in association with which the Opponent's Trademark is used [para 3]. In the circumstances, I am satisfied that any use or promotion of the Opponent's Trademark by OnePoint Canada inures to the Opponent's benefit by virtue of the licensing provisions in section 50 of the Act.

[9] In support of the Application, the Applicant filed the September 8, 2022 affidavit of its Vice-President Finance and Internal Operations, Jeffrey Sholdice, who describes the Applicant's business and its use and promotion of the Mark.

[10] Neither affiant was cross-examined. Only the Applicant filed written representations, but both parties were represented at an oral hearing.

EVIDENTIAL BURDEN AND LEGAL ONUS

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

GROUND OF OPPOSITION SUMMARILY DISMISSED

[12] At the oral hearing, the Opponent conceded that the evidence of record is insufficient for the Opponent to meet its evidential burden with respect to the grounds of opposition based on bad faith pursuant to section 38(2)(a.1) of the Act and non-compliance pursuant to section 38(2)(f) of the Act. Accordingly, these grounds of opposition are rejected.

NON-COMPLIANCE UNDER SECTION 38(2)(E) OF THE ACT

[13] The Opponent pleads under section 38(2)(e) of the Act that, at the filing date of the Application and at any material time, neither the Applicant nor a predecessor in title was using or proposed to use the Mark in Canada (itself and/or through a licensee) in association with each of the Goods and Services, and that the Applicant never intended to do so, whether it be (i) in the form the Mark is applied for or (ii) for the Goods or

Services without a specific intention to use for each of them (“... *n’a jamais eu l’intention d’employer...que cela soit dans la forme dans laquelle la MARQUE est présentée à la demande ou que cela soit pour les produits ou services mentionnés dans la demande, sans intention spécifique d’emploi de la MARQUE pour chacun d’eux*”).

[14] The Applicant submits that this ground of opposition must be rejected because the Opponent filed no evidence in its support. However, the Opponent submits that the Applicant’s own evidence reveals that (i) the context of the Mark’s display does not fall within the legal definition of trademark “use” and (ii) the Applicant has no other intentions with respect to the Mark. More specifically, the Opponent submits that the Mark is only displayed in association with software used internally by the Applicant and its franchisees, which does not qualify as trademark “use” in association with any of the Goods or Services, and that, in all the years since the software’s launch, there has been no indication the situation is ever intended to change.

Sufficiency of pleadings

[15] Section 38(2)(e) of the Act provides as a ground of opposition that, at the filing date of the application, the applicant “was not using and did not propose to use the trademark in Canada in association with the goods or services specified in the application”. This ground reflects the application requirements set out in section 30(1) of the Act. To comply with section 38(3)(a) of the Act, the ground must be set out in sufficient detail to enable the applicant to reply to it. Further, where an opponent pleads that the application fails to comply with a section of the Act based on a particular set of circumstances, the Registrar does not have jurisdiction to refuse it on the basis that it fails to comply for different reasons [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]. However, once evidence is filed, the Registrar must take it into account in interpreting the ground and determining whether the applicant has been provided with sufficient detail to make an adequate reply; thus, the filed evidence may cure an inadequacy in the pleadings [*Novopharm Ltd v AstraZeneca AB*, 2002 FCA 387].

[16] In the present case, the ground of opposition as pleaded appears to allege two facts in support of the allegation that the Applicant was not using and did not propose to use the Mark in Canada in association with the Goods and Services: (1) there was no intention to use the Mark in the form applied for; and (2) there was no intention to use the Mark in association with the Goods and Services, either in general or specifically for each. However, the supporting allegation made at the hearing appears to be a different one, namely, that the Mark is only for software provided to the Applicant's own employees and franchisees, and thus only for display internally, which cannot qualify as trademark use within the meaning of the Act.

[17] In this respect, the Opponent submits that "use" of a trademark must be for the purpose of distinguishing the trademark owner's goods or services from those of others. As such, it does not include display on materials used by personnel internally, within the owner's organization, and not given to outside purchasers in the normal course of trade [citing *Nissan Canada Inc v BMW Canada Inc*, 2007 FCA 255, re internal product guides]. Nor does it include items that are displayed or provided publicly only for the owner's own promotion, rather than as objects of trade in themselves [see *CoreLogic, Inc v MLXjet Media Corp*, 2012 TMOB 67, re employee uniforms and pens for the use of seminar attendees]. Likewise, services provided in association with the trademark must be offered to a third party and not provided merely for the owner's own benefit [see e.g. *CoreLogic, Inc, supra*]. In the Opponent's submission, even when a service is provided to the public, display of a trademark on related internal documents cannot, in itself, demonstrate the trademark's use [citing *Thales v Shaw Satellite Services Inc*, 2012 TMOB 31, re printout of customer base; and *Math v Mainse*, 2015 TMOB 32, re planning documents].

[18] In the absence of written arguments or evidence on point *from the Opponent*, I find it questionable whether the Applicant in the present case was provided with sufficient detail, prior to the hearing, to be informed that this was the case it would be asked to meet. If, after the Applicant's evidence was filed, the Opponent wished to add to its case an allegation that the Mark was intended only for internal use or for a use not falling within the definitions of sections 2 or 4 of the Act, then the Opponent should have

sought leave to amend its statement of opposition. That said, the Opponent also took the position at the hearing that the Goods and Services, namely the services of providing “residential and commercial building evaluation and inspection services” and “software as a service (SAAS)” and the good “computer application software”, as they are all defined in the Application, are implicitly ones that must be sold to unrelated third parties—customers or members of the public. The Opponent argues that the Goods and Services thus differ from any “franchising” services the Applicant might provide in association with the Mark. Accordingly, it is at least arguable that the Opponent’s submissions fall within the scope of the portion of the pleading alleging that there was never any intention to use the Mark in association with the specific goods and services set out in the Application (as opposed to some different goods or services).

[19] However, it is not necessary to decide this question. As discussed below, I find the Opponent does not meet its initial burden, even if the pleading is interpreted generously.

Opponent’s initial burden

[20] An opponent’s initial burden for a ground of opposition alleging that the applicant was not using and did not propose to use its trademark as required can be met by reference not only to the opponent’s own evidence but also to the applicant’s evidence, given that the relevant facts are more readily available to or particularly within the knowledge of the applicant. To meet its burden by relying on the applicant’s evidence, an opponent must show that the applicant’s evidence is “clearly inconsistent” with or “casts doubt” on the applicant’s use or proposed use, so as to put whether the applicant “was not using and did not propose to use” into issue [re meeting initial burden by reference to applicant’s evidence see *Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply Co* (1999), 2 CPR (4th) 562 (TMOB), aff’d 2001 FCT 252; *Bacardi & Co v Corporativo de Marcas GJB, SA de CV*, 2014 FC 323 at 33, 50 and 54; and *Divert, Inc v Resource Recovery Fund Board Inc*, 2022 FC 1650].

Applicant's evidence

[21] In the present case, Mr. Sholdice explains that the Applicant was founded in 1994 to provide consistency and excellence in home inspection services through a formal technical training program for home inspectors, standards for conducting home inspections, and standard templates for producing consistent inspection reports [para 2]. At the date of Mr. Sholdice's affidavit, the Applicant was operating according to a franchise model in eight Canadian provinces, providing all of its franchise locations with ongoing training, operations support, and support from fellow franchisees [paras 4–5]. In 2021, the Applicant had in Canada 10 employee inspectors, 44 corporate staff, and 62 franchisees [para 5].

[22] All of the Applicant's inspections are conducted using its software branded with the Mark [para 6]. Although the Applicant began software development and implementation planning using the Mark in 2015, the application was actually launched for use by inspectors in 2016 [para 7]. An internal tool marketed only to employees, franchisees, and their staff, the Applicant's software allows inspectors who have created an account to schedule, conduct, record all details of, and report on home inspections [paras 8–10]. The Mark is displayed at the top of the log-in page and of the application's opening page, which includes tabs for Scheduling, Inspections, Dashboards, and Reports, as well as tabs for Accounts, Contacts, Franchisee Email Drafts, and others [Exhibits A–B]. I note that the opening pages' menu also offers Business Tools that include inspection kits, templates, an events calendar, marketing materials, and a learning academy, as well as links to Key Suppliers, including for credit card processing, insurance programs, marketing campaigns, apparel, promotional items, and signage.

[23] The Mark is also displayed at the top of notifications regularly forwarded to all of the Applicant's employees and franchisees to promote the most effective use of the software by advising of new releases, modifications, maintenance windows etc., as shown in three representative examples, one dated July 7, 2022, and two undated [para 11, Exhibit C]. In addition, Mr. Sholdice states that the software is promoted with

the Mark during conferences attended by the Applicant's franchisees for continuing training on the functionality and continuous improvements to the software [para 12].

[24] Mr. Sholdice emphasizes that the software associated with the Mark is produced for and used only by the Applicant's employees and franchisees, and is not marketed to the public or to anyone other than the Applicant's employees and franchisees and their staff [paras 8, 14].

Findings and conclusion regarding use and proposed use

[25] I find nothing in the evidence that puts into issue whether the Applicant was using or proposed to use the Mark in Canada in association with each of the Goods and Services when the Application was filed.

[26] In this respect, a trademark may be considered to be used in association with goods that are not distributed merely to promote other products or services but as an object of trade in themselves, leading to some kind of payment or exchange for the goods. Such distribution may include good faith sales of goods directly to employees, even if the goods are not in the trademark owner's primary line of business activity, as long as they form a pattern of genuine commercial transactions [*Riches, McKenzie & Herbert LLP v Cosmetic Warriors Limited*, 2017 TMOB 36, aff'd 2019 FCA 48, rev'g 2018 FC 63; see also *Canada Post Corp v H & K Horizons Inc* (1997), 84 CPR (3d) 232 (TMOB)]. In addition, sales of branded goods to one's franchisees for the franchisees' use—unlike the distribution of promotional items to franchisees free of charge—may qualify as trademark use [see *SMK Speedy International Inc v Petro-Canada*, 2006 CarswellNat 2125 (TMOB)].

[27] Similarly, with respect to services, some third party, a consumer or purchaser, must receive a tangible and meaningful benefit from the activity associated with the trademark in order for there to be trademark use in association with that service [*Live! Holdings, LLC v Oyen Wiggs Green & Mutala LLP*, 2019 FC 1042; see also *Ralston Purina Co v Effem Foods Ltd* (1997), 81 CPR (3d) 528 (TMOB); and *Carling O'Keefe Breweries of Canada Ltd-Brasseries Carling O'Keefe du Canada Ltee v Anheuser-*

Busch Inc (1985), 4 CPR (3d) 216 (TMOB)]. Again, the third party to benefit from the service may be a licensed franchisee [see e.g. *GMAX World Realty Inc v RE/MAX, LLC*, 2015 TMOB 147, re the provision of online tools and other materials for real estate brokers]. Indeed, the *Goods and Services Manual*, published by the Canadian Intellectual Property Office as a representative listing of acceptable terms for identifying goods and services, includes a number of entries for services provided to franchisees, including “business management assistance services in the running of establishments as franchises”; “offering technical assistance in the establishment and operation of real estate brokerage franchises”; “offering technical assistance in the establishment and operation of franchises providing building maintenance and repair”; and “providing assistance in the field of business management within the framework of a franchise contract”; among others.

[28] In the present case, the Applicant was founded, in part, to provide standards for conducting home inspections and templates for producing consistent inspection reports [para 2]. Although the Application does not refer explicitly to such technical assistance being *for franchises*, or to business management assistance *for franchises*, nothing in the Application excludes the provision of specialized software to assist with the technical aspects of inspections, or to assist with the management of an inspector’s practice, within the framework of a franchise contract. In this respect, I disagree with the Opponent that the franchisees are to be considered merely an extension of the Applicant and not its customers; there is nothing in the evidence to suggest that the franchisees are not independent companies contracting with the Applicant at arm’s length to receive the benefit of its software (among other assistance and advisory services) for the conduct and management of their home inspection business.

[29] Since use of the software application requires the creation of a “OnePoint Software account” [para 10], I find it reasonable to infer that the software is provided as a service, with display of the Mark on the log-in and opening screens constituting use of the Mark in association with this service. However, nothing precludes the possibility of the Applicant having provided in the past, or having intended to provide in the future, the software on a physical medium, or otherwise, branded with the Mark. Regardless of

whether the cost of providing any such software and continuous updates is charged as part of the initial franchise fee or as a recurring expense, I would find such a situation consistent with an arrangement whereby sales of the Applicant's branded software to franchisees form part of a larger dealing for the purpose of acquiring goodwill and profits from the branded software as an object of trade. In this respect, I accept the Applicant's submission at the hearing that the software could be promoted as one of the advantages the Opponent offers as a franchisor. Although Mr. Sholdice states that the software "is not marketed to the public or to anyone other than Pillar to Post employees or franchisees and their staff" [para 8] and "is not marketed to or used by anyone outside the Pillar to Post organization" [para 14], he does not mention at what point marketing to franchisees begins. It may well be that the software, identified by the Mark, is promoted to potential franchisees as part of descriptions and disclosures made in the course of negotiating the sale of a franchise. In the absence of cross-examination on this point, I am not prepared to construe Mr. Sholdice's statements so narrowly as to exclude such a possibility.

[30] Finally, I find that nothing in the Application precludes the Applicant's inspector employees from displaying the Mark in the performance or advertising of residential or commercial building evaluation and inspection services—for example, at the top of reports generated by the Applicant's software or in advertising the "consistency and excellency" achieved through the use of the Applicant's software in conducting inspections and generating reports. There is nothing to suggest that this type of display or promotion was not one of the Applicant's intended uses for the Mark when the Application was filed. In such a case, the software would not be marketed for sale to the client receiving the inspection but the Mark would be displayed in the performance or advertising of the evaluation or inspection service.

[31] In view of the foregoing, the ground of opposition based on non-compliance pursuant to section 38(2)(e) of the Act is dismissed, for the Opponent's failure to meet the initial burden.

REGISTRABILITY UNDER SECTION 12(1)(D) OF THE ACT

[32] The Opponent also pleads that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act, because the Mark is confusing with the Opponent's Trademark as registered.

[33] The material date for this ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)]. An opponent's initial burden is met if the registration relied upon is in good standing on the material date and the Registrar has discretion to check the Register in this respect [per *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised this discretion, I confirm that the Opponent's Registration is in good standing.

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

The test for confusion

[35] Two trademarks will be considered confusing if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or in the same class of the international Nice Classification system [section 6(2) of the Act]. Thus, the test for confusion does not concern confusion of the trademarks themselves but rather confusion as to whether the goods and services associated with each party's trademark come from the same source. Where it is likely to be assumed that the applicant's goods or services either come from the opponent or are approved, licensed, or sponsored by the opponent, it follows that the trademarks are confusing [see *Glen-Warren Productions Ltd v Gertex Hosiery Ltd* (1990), 29 CPR (3d) 7 (FCTD)].

[36] The test is to be applied as a matter of first impression in the mind of a casual consumer somewhat in a hurry, who sees the applicant's trademark at a time when he or she has no more than an imperfect recollection of the opponent's trademark and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the trademarks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23]. Regard must be had to all the surrounding circumstances, including those set out in sections 6(5)(a) to (e) of the Act, but these criteria are not exhaustive and the weight given to each factor will vary in a context-specific analysis [*Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22].

Section 6(5)(e): Degree of resemblance between the trademarks, including in appearance or sound or in the ideas suggested by them

[37] The degree of resemblance between the trademarks at issue is often the factor likely to have the greatest effect on the confusion analysis and, thus, is an appropriate starting point [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27]. Each trademark must be considered as a whole and assessed for its effect on the average consumer as a matter of first impression; it is not the proper approach to set the trademarks side by side and carefully examine them to tease out similarities and differences [*Masterpiece; Veuve Clicquot*]. However, it is still possible to focus on particular features of each trademark that may have a determinative influence on the public's perception of it [per *United Artists Pictures Inc v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 (FCA)]. In this respect, the first element of a trademark is generally considered to be important for the purpose of distinction [see *Conde Nast Publications Inc v Union des Éditions Modernes* (1979), 46 CPR (2d) 183 (FCTD)]. However, the preferable approach is to begin by determining whether there is an aspect of each trademark that is "particularly striking or unique" [*Masterpiece* at para 64].

[38] The Opponent's Trademark consists of a single word element: ONEPOINT. Although it is a coined word, I find that its derivation from the two words "ONE" and "POINT" is evident as a matter of immediate impression, particularly when the trademark is sounded. I would also note that registration of a word mark grants its owner the right to use the mark using any style of lettering, colour, design or other

features [*Masterpiece, supra*; see also *Advance Magazine Publishers, Inc v Banff Lake Louise Tourism Bureau*, 2018 FC 108]. Thus it is open to the Opponent to use its trademark in a way that creates contrast between the words “ONE” and “POINT”.

[39] The Applicant submits that the design elements of the Mark are “quite dominant” and serve to distinguish it from the Opponent’s Trademark [written representations at page 8]. However, even though the design portion is the first and taller element of the Mark, it is a combination of two relatively simple geometric shapes. In my view, the more striking aspect of the Mark is the compound word “OnePoint”, a considerably longer element that appears to be an arbitrary coined term. I would also note that, to the extent the lighter-coloured circle in the design could be considered a dot or “point”, it reinforces the idea conveyed by the also lighter-coloured word “Point”, and by the full expression “one point”.

[40] I find there to be a high degree of resemblance between the trademarks. They are identical in sound and highly similar in ideas suggested, since the Opponent’s Trademark, even when presented in a uniform lettering style, can readily be understood as the combination “one point”. As noted above, I find that the Mark’s design element, in the context of the Mark as a whole, reinforces the idea of a single “point”. Furthermore, although the presence of this design element creates a point of distinction, the Mark’s most striking feature reproduces the Opponent’s Trademark in its entirety. Thus the trademarks also resemble each other in appearance. I do not find that the Mark’s simple lettering style, capitalization pattern, or lighter shading of “Point” decreases the degree of visual resemblance to any significant degree, since, as noted above, such styling is within the scope of the Opponent’s Registration.

[41] Thus, this important factor favours the Opponent.

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

[42] Inherently distinctive trademarks “strike the imagination and become more firmly rooted in the consumer’s memory”; as such, they are generally accorded a greater

degree of protection [see *G M Pfaff Aktiengesellschaft v Creative Appliance Corp Ltd* (1988), 22 CPR (3d) 340 (FCTD) at para 7]. A trademark's distinctiveness can also be enhanced through use and promotion; both parties filed evidence in this respect.

Inherent distinctiveness

[43] Trademarks comprising arbitrary or invented words are generally considered to be more inherently distinctive than trademarks consisting of everyday expressions or words of a descriptive or suggestive character [see *Joseph E Seagram & Sons Ltd v Canada (Registrar of Trade Marks)* (1990), 33 CPR (3d) 454 (FCTD); and *YM Inc v Jacques Vert Group Ltd*, 2014 FC 1242]. A design comprising only simple line patterns or geometric shapes is generally not considered to be inherently distinctive [see e.g. *Levi Strauss & Co v Vivant Holdings Ltd* (2003), 34 CPR (4th) 53 (TMOB)].

[44] I find that the Opponent's Trademark possesses a fairly high level of inherent distinctiveness. Although comprising ordinary dictionary words, the combination of "one" and "point" is presented as a single coined word and has no readily apparent meaning in connection with the Opponent's goods and services.

[45] I find the Mark to have a similar level of inherent distinctiveness; however, its most striking inherently distinctive feature is shared with the Opponent's Trademark as a point of resemblance. In my view, the relatively simple geometric design, which somewhat reinforces the idea conveyed by the word element, contributes only very slightly to the Mark's overall level of inherent distinctiveness.

Opponent's evidence of use and promotion

[46] Mr. Melanson states that the Opponent has been offering and performing services in Canada in association with the Opponent's Trademark in the field of information technology and business management since at least 2005, including the marketing of computer programs in this area since at least 2016 [paras 7, 11]. The Opponent provides its services for modernizing administrative, strategic, and technological infrastructures to several institutions and companies in Canada in diverse fields, including the telecommunication, private banking & wealth management, retail

banking, market finance, distribution, public service, and media sectors, as well as smart land management, platformization, and information technology [paras 6, 9].

[47] Since at least 2015, the Opponent has advertised the availability of services in the real estate sector—including digital solutions related to buildings—on its real estate sector webpage at *groupeonepoint.com/fr/secteurs/immobilier* [paras 5 &15, with representative screen capture at Exhibit A-1]. This webpage promotes the Opponent’s knowledge and expertise in technologies relating to innovation in the real estate ecosystem, digital models for real estate business plans, user experience design for buildings, and competition for public sector urbanization projects. The Opponent advertises having performed such work for clients (not necessarily in Canada) that include the real estate subsidiary of a distribution group, a real estate group answering calls for proposals, and a company acting in real estate promotion.

[48] Mr. Melanson provides annual sales figures for services performed in Canada under the Opponent’s Trademark for the years 2014 to 2021, showing a rise in revenue from over \$8 million in 2014 to over \$18 million in 2021 [para 12]. He also provides 10 representative invoices for such services for the period 2015 to 2022 [Exhibit A-3]. Each is addressed to a company in Quebec with a total charge in the thousands of dollars. Specific service descriptions have been redacted, but the listed projects appear to relate primarily to consulting and development services in the field of information technology and business processes for clients in fields ranging from entertainment to insurance. Mr. Melanson states that, since 2018, the Opponent has had over 20 active clients in Canada for consulting services and implementation of technology solutions [para 12]. However, there is no mention of any of the work in Canada being related to buildings or real estate.

[49] The invoices show the Opponent’s Trademark displayed as two different logos:



(Groupe OnePoint Logo)



(Onepoint Logo)

[50] The Groupe OnePoint Logo, displayed on the 2015 invoice, consists of a stacked arrangement of the words GROUPE and ONEPOINT in stylized lettering above the word UNLIMITED in fine print. The Onepoint Logo displayed on the remaining invoices consists of the word ONEPOINT in a simple, lowercase, bold font followed by a period in a contrasting colour. Applying the principles set out in *Canada (Registrar of Trade-marks) v Cie Internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA); *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA); *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); and *Loro Piana SPA v Canadian Council of Professional Engineers*, 2009 FC 1096, I am satisfied that use of each of these logos constitutes use of the Opponent's Trademark as registered. In the Groupe OnePoint Logo, the Opponent's Trademark stands out from the other words by virtue of its relative size, position, and stylization—which includes the element ONE in boldface with a capital “O” formed from multiple arcs. As for the Onepoint Logo, I find the contrasting period somewhat ambiguous to the extent that it might also be seen as a fanciful repositioning of the dot that is notably missing from the top of the letter “i”. Regardless, I find that the Opponent's Trademark has not lost its identity and remains recognizable in the Onepoint Logo.

[51] I would also note that the 2015 invoice is from “Groupe Onepoint unlimited” whereas the invoices from 2016 to 2022 are from “onepoint Canada” or “onepoint Canada inc.” Furthermore, the 2015 and 2016 invoices indicate GST and QST sales tax numbers for “Groupe ONEPOINT Inc.” Mr. Melanson does not explain the relationship between the Opponent and Groupe Onepoint unlimited or Groupe ONEPOINT Inc. However, the certified copy of the Opponent's Registration furnished in evidence shows that the Opponent's name was “GROUPE ONEPOINT” prior to December 21, 2016, and the statement of opposition pleads “Groupe onepoint” as a trade name used by the Opponent, its predecessors in title, or their licensees. I also note that the invoices from 2015 to 2017 all have the same return address in Montreal (changing to a different Montreal address from 2018 to 2022) and that all of the invoices provide the same GST and QST numbers. In the circumstances, I am prepared to accept that all of the exhibited invoices were issued by the same entity, OnePoint Canada. As discussed

above in my review of the record, I am satisfied that use of the Opponent's Trademark by OnePoint Canada enures to the benefit of the Opponent.

[52] According to Mr. Melanson, during the same 2014 to 2021 period, the Opponent spent an average of \$10,000 per year for various advertising campaigns on social networks and in schools to promote its services associated with the Opponent's Trademark in Canada, including publishing expenses of over \$7,000 in 2020 and over \$28,000 in 2021 [para 13]. However, the Opponent's main promotional channel is its website [paras 14]. The Canadian versions of the site at *groupeonepoint.com/ca/* and *groupeonepoint.com/fr-ca/* have received over 12,000 unique visits from Canada since 2018, including over 2,000 unique views in 2020 and over 9,000 unique views in 2021 [para 15].

[53] Printouts representative of how the Opponent's website has appeared since at least 2015 show the Onepoint Logo displayed with a slogan at the top of webpages promoting the Opponent's services [para 15, Exhibit A-4]. (I note that the logo is presented with white lettering and a blue period. As such, the lettering portion is visible only on the printouts where the background colour under the logo has been retained; otherwise, only the period is visible.) Target markets include the real estate sector, as discussed above, and also a "Smart cities & places" sector, which involves leveraging technology and data in the management of cities, land, places, and spaces in a manner that is innovative, respectful of the environment, and sustainable. In this sector, the Opponent offers its services in the design of new experiences and innovative modes of management for buildings and major urban infrastructures.

[54] I note that, with the exception of a job postings webpage for Montreal, the representative printouts attached to Mr. Melanson's affidavit do not appear to have been made from the Canadian version of the website but rather from a version specific to France, at *groupeonepoint.com/fr/*. Mr. Melanson does not explain why all of the printouts were not simply made from the Canadian version of the site. However, the one webpage that is from the Canadian version displays the Onepoint Logo at the top clearly and in its entirety and, in the absence of cross-examination, I have no reason to

doubt that both versions of the site would be accessible in Canada. That said, Mr. Melanson only provides visitor statistics for the Canadian versions of the site, without confirming whether they generally display the same content as the French versions. In this respect, I note that at least the language of the slogan under the Opponent's Trademark is different on the webpage for Montreal (where it is displayed in French) than on the webpages for France (where it is displayed in English).

[55] Considering the levels of advertising and sales in Canada and the representative examples, I am satisfied that the Opponent's Trademark has become known in Canada to at least some extent in association with consulting on and implementation of information technology solutions for business management in general. However, in the absence of more detailed information specific to Canada, the Opponent has not established the extent to which its trademark would be known in Canada in the real estate sector or in association with any technology solutions similar to the Applicant's software application. Furthermore, Mr. Melanson attests to the marketing of computer programs in the area of information technology and business management since 2016 and, indeed, some of the invoiced projects appear from their cursory descriptions to involve computer programming. I would also note that the exhibited job postings appear from their titles to include positions in software development. However, the evidence falls short of establishing that the Opponent's Trademark has become known in Canada in association with any specific type of computer programs.

Applicant's evidence of use and promotion

[56] As noted above, since 2016, the Mark has been used in association with the Applicant's software for scheduling, conducting, and documenting home inspections, being displayed on the log-in screen, on the home screen, and in electronic notifications in respect of updates, maintenance, and the like [paras 6–11, Exhibits A–C]. The software is used internally by the Applicant's employees, franchisees, and their staff [paras 8–9]. Although Mr. Sholdice provides the date the software was launched, he does not specify how many Canadian employees, franchisees, or staff would have used the software that year or how many in total have used it since then. However, he does

provide some recent figures: in 2021, the Applicant had 10 employee inspectors, 44 corporate employees, and 62 franchisees in Canada, and it was operating, at least as of September 8, 2022, in eight Canadian provinces [para 5].

[57] The Applicant has completed millions of home inspections in Canada and the United States [para 3]. Mr. Sholdice states that, in 2021, the value of home inspections conducted in Canada using the software was over \$8 million [para 13]; however, he does not specify whether this total represents inspections conducted since the application was launched or only inspections conducted in 2021. In any event, since Mr. Sholdice does not specify whether the Mark is displayed to the customers receiving the home inspections, I am not satisfied that the number of inspections conducted would necessarily reflect the extent to which the Mark has become known.

[58] Although Mr. Sholdice also states that the software is “promoted” with the Mark during conferences attended by the Applicant’s franchisees, he does not provide any examples or explanations of how the Mark is displayed in the course of such promotion or specify the frequency of the conferences [para 12]. In any event, it would appear that such promotion is restricted to franchisees who are already using the software and are thus already familiar with the Mark.

[59] In view of the foregoing, I am satisfied that the Mark has become known in Canada in association with the provision of software as a service that allows home inspection professionals to book, conduct, record, and report on building inspections, but only to a small extent, within the Applicant’s own network of employee inspectors, corporate staff, and franchisees. There is no evidence that the Mark has also become known in association with the actual conduct of inspections or with any other building evaluation and inspection services.

Conclusion on inherent and acquired distinctiveness

[60] On balance, I find that the overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness, favours the

Opponent's Trademark, owing to its inherent distinctiveness and the greater evidence of its use and promotion.

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

[61] Although Mr. Melanson attests to use of the Opponent's Trademark in Canada since 2005, the sales and advertising figures provided in support date back to 2014 and representative examples of use are provided as of 2015.

[62] Mr. Sholdice attests to software under the Mark being launched in 2016; however, he does so in the context of describing the Applicant's activities in North America in general, including both the United States and Canada. He does not confirm whether the Applicant was active in Canada in 2016 and, if so, whether its operations at the time included franchisees—such information is only provided as of 2021.

[63] In any event, the Opponent's evidence of use pre-dates 2016 and thus this factor also favours the Opponent.

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

[64] Under a registrability ground of opposition, the statements of goods and services in the applicant's application and in the opponent's registration must be assessed having regard to the channels of trade that would normally be associated with such goods and services [*Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export* (1986), 12 CPR (3d) 110 (FCA)]. Each statement must be read with a view to determining the probable type of business or trade intended rather than all possible trades that might be encompassed by the wording; evidence of the parties' actual trades is useful in this respect, particularly where there is an ambiguity as to the goods or services covered by the application or registration [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)]. That said, although evidence of a party's actual trade may provide valuable context when interpreting its statement of goods and services, caution should be taken not to restrict the scope of protection based on actual

use [*Absolute Software Corporation v Valt.X Technologies Inc.*, 2015 FC 1203]. Actual use is not irrelevant, but it should not be considered to the exclusion of potential uses within the registration [*Masterpiece, supra*].

Nature of the goods, services, and businesses

[65] The Applicant submits that, in this case, there is no evidence that any of the goods or services of the Opponent's business relate to or overlap in any way with the Applicant's home inspection field of business. The Applicant submits in particular that the main focus of the Opponent's business is the modernization of the administrative, strategic, and technological infrastructures of businesses, and that the Opponent's computer programs are restricted to the fields of telecommunications, private banking, wealth management, public service, and the media, all of which differs from the Applicant's home inspection focus. The Applicant adds that the parties' goods are neither interchangeable nor complementary. Even though Mr. Melanson states that the Opponent offers "building-related" digital solutions, he does not specify what such building-related services entail or draw any connection to the home inspection field.

[66] In this last respect, I find that, at best, the advertising attached to Mr. Melanson's affidavit suggests the Opponent offers expertise in the area of user experience design for buildings, including how to integrate technologies. He does not specify whether the Opponent's expertise extends to the building inspection aspect of the "real estate ecosystem" or whether any of the Opponent's clients in the real estate field engage in building evaluation or inspection, for their own benefit or for others.

[67] However, even if the Opponent's focus is not on residential and commercial building evaluation and inspection, both parties appear to produce software that assists business managers (in the Applicant's case, those managing a franchise) in applying technology in the conduct and management of their business. I agree with the Applicant that the Opponent's Registration does not appear to reference home inspection, or real estate, or buildings. Moreover, the nature of the Applicant's Goods and Services appears to be highly specialized. Nevertheless, given the breadth of services covered by the Opponent's Registration and the diversity of sectors in which the Opponent

operates, I find that an average purchaser of home inspection management software or services may well assume that such software is within the Opponent's product offerings, or that the Opponent licenses building evaluation and inspection service providers to use software that it has custom-developed for them or assisted them in developing.

[68] I appreciate that Mr. Sholdice, having reviewed Mr. Melanson's affidavit, states that the Applicant's software "as produced for and utilized by our Pillar to Post employees and franchisees does not compete or conflict in any way with any of the goods or services provided by the opponent" [para 14]. However, the goods and services covered by the Opponent's Registration go beyond the limited examples provided in Mr. Melanson's affidavit. Likewise, the Application is not restricted to software as currently produced for the Applicant's employees and its franchisees.

[69] At the hearing, the Opponent relied primarily on the following service set out in the Opponent's Registration (my emphasis):

aide à la direction d'entreprises industrielles et commerciales opérant notamment dans les secteurs bancaire, financier, industriel, administratif, de l'assurance et des télécommunications

[70] The Opponent submitted that, contrary to the Applicant's interpretation, these services are not limited to the examples of sectors listed after the word "*notamment*". In this respect, I note that the unofficial English translation appearing for convenience in the *Trademarks Journal* refers to "assistance for the direction of industrial and commercial businesses operating, namely in the ... sectors" (my emphasis). However, the *Trademarks Examination Manual*—published by the Canadian Intellectual Property Office as a reference guide on how examiners will interpret and apply legislation—explains that "*notamment*" is an indefinite term, equivalent to "featuring", which provides further specification that is "not essential to determining the specific nature" of the good or service [section 2.4.5.4, and see in particular the French language version re translation of "featuring" as "*notamment*" or "*contenant*" depending on the context]. As explained in the Manual, the term "*notamment*" or "featuring" follows goods or services that have already been specifically defined, to indicate possible examples [*ibid.*], and stands in contrast to definite terms like "*nommément*"—equivalent to "namely"—used to

limit an otherwise overly broad statement of goods or services to a specific list [see section 2.4.5.5]. Accordingly, a more appropriate interpretation of the statement of services relied upon by the Opponent would seem to be as follows:

[LIBERAL TRANSLATION] assistance given to management of industrial and commercial businesses, featuring [or notably] those operating in the banking, financial, industrial, administrative, insurance, and telecommunications sectors

[71] In any event, I agree with the Opponent that business management assistance provided to industrial and commercial businesses could include services relating to the evaluation or inspection of buildings connected to that business. I also agree that management assistance provided to commercial businesses in the field of building evaluation and inspection could include the provision of software tools for the management of inspection bookings, procedures, documentation, and reports. Furthermore, in my view, the real estate and building management sectors would represent a natural extension of the Opponent's areas of expertise for its management assistance services as defined in its registration.

[72] I also wish to note the following goods, which I consider to be the most relevant ones set out in the Opponent's Registration (my emphasis):

logiciels pour accéder à, créer, éditer et gérer des bases de données d'utilisation générale et transférer des données vers et à partir de bases de données

[JOURNAL TRANSLATION] computer software used to access, create, edit, and manage general-use databases and transfer data to and from databases

logiciels destinés à la gestion de groupes de travail, de projets, de clientèle, à la planification commerciale, au publipostage, et à la gestion commerciale et financière, notamment logiciels relatifs à la gestion financière et à l'administration des affaires

[JOURNAL TRANSLATION] computer software intended for the management of work groups, projects, customers, for business planning, direct mail advertising, and commercial and financial management, namely computer software related to financial management and business administration

[73] In my view, the Applicant's software as specified in the Application and described by Mr. Sholdice could include the functionality of accessing and transferring data to and from databases of information relating to building inspection appointments and results. It could also include the functionality of managing home inspection projects and

customers. Thus there is a potential overlap in nature between the software goods and services in the Application and those in the Opponent's Registration.

Cost of the goods and services

[74] The Applicant cites *Innovatek Medical v Physio Control*, 2022 TMOB 22, in proposing that the relative cost of the parties' goods in the present case is an indication of the largely divergent markets of the parties' respective products [written argument at page 8]. As noted above, each of the sample invoices furnished on behalf of the Opponent is for a total charge in the thousands of dollars [see Exhibit A-3]. However, the Applicant, for its part, has not produced any evidence of how or how much its clients are charged for residential and commercial building evaluation and inspection services or for access to its software. In the absence of invoices or other evidence indicating the specific nature and price point of the Applicant's building evaluation and inspection services, and how access to the Applicant's software fits within its franchise model—and within the cost of a franchise—I am not prepared to infer that there is a large or meaningful divergence in the cost of the parties' respective products and services.

Channels of the trade

[75] As regards the parties' channels of trade, the Applicant submits that they are "diametrically opposed", primarily because the Applicant's software is not marketed to or used by anyone outside of the Applicant's "organization" and the Opponent does not market its products or services to the Applicant [written argument at page 8, citing Mr. Sholdice's affidavit at para 14]. In this respect, the Applicant seeks to draw an analogy with two recent Federal Court cases.

[76] First, in *Loblaws Inc v Columbia Insurance Company*, 2019 FC 961, the Federal Court found that a customer visiting the Pampered Chef direct selling / multilevel marketing website would be aware from its branding that they are at Pampered Chef, and would therefore not likely be confused into thinking that the products offered on that site come from the traditional retailer Loblaws. In making this finding, the court referenced *A & W Food Services of Canada Inc v McDonald's Restaurants of Canada*

Ltd., 2005 FC 406, where it was held that, owing to the competitive nature of the fast food industry, an average consumer would easily know whether it is in a McDonald's or A & W chain, be unlikely to assume a connection between them, and be very unlikely to purchase a product at one chain thinking it comes from the other.

[77] However, each case must be decided on its own merits, and the conclusions in those cases appear to have been based on facts specific to certain retail industries. In the present case, on one hand, the Opponent helps commercial clients modernize their infrastructures through consulting and implementation of technology. The exhibited invoices reference the development of software and digital platforms, modelling business processes, and advisory support for technological infrastructure, while the goods listed in the Opponent's Registration include various types of software. On the other hand, it appears from the Applicant's notifications regarding software maintenance that at least one third party supplier, Skedulo, may be involved in providing functionality to the software. Specifically, the notifications mention that "scheduling within OnePoint" will not be available during maintenance to be conducted by "[o]ur OnePoint Scheduling development partner, Skedulo". In the circumstances, to the extent that the Opponent's customers use software the Opponent has helped to develop, and in the absence of further details on what information the Applicant's employees, franchisees, and clients are given regarding the source of the Applicant's software, I am not prepared to find that the source of the Applicant's software applications will be as readily apparent as the source of the goods in the *Loblaws* and *A & W* examples.

[78] Second, in *Mainstreet Equity Corp v Canadian Mortgage Capital Corporation*, 2022 FC 20, the court drew a distinction between the parties' respective markets. Although it could fairly be said that both parties were involved in real estate, the court found a significant difference between individuals seeking affordable rental accommodations on one hand and large real estate development companies or wealthy investors in mortgages on the other. However, in the present case, it would appear that the Applicant's customers include not only individual home buyers but also commercial clients seeking to buy a franchise. Furthermore, even if the Opponent does not currently serve the building evaluation and home inspection sector in Canada, it would appear to

be an area of natural expansion, given that the Opponent already has a presence in the real estate and smart land management sectors generally.

[79] In view of the foregoing, I find there is a potential for overlap in the parties' channels of trade.

Sophistication of the purchasers

[80] Finally, the Applicant submits that the average consumer in the present case is highly sophisticated and therefore unlikely to be confused by the use of suggestive trademarks for fundamentally different goods and services, citing *Innovatek* in support. In that case, the parties channels of trade were found to represent a very broad field or industry, and, by analogy, the Applicant cautions against finding overlap when goods and services are described in broad terms in an opponent's registration but are actually used under very different circumstances than those of the applicant. However, unlike *Innovatek*, the present case does not involve suggestive trademarks: the term "one point" does not appear to hold any obvious meaning in connection with the parties' goods and services. Furthermore, in *Innovatek*, an opponent whose registered goods and services were limited to the good "medical diagnostic test kits" was attempting to define a broad field of operation that would also encompass the applicant's goods and services relating primarily to electrodes and cables for medical use. In the present case, the goods and services in the Opponent's Registration are not so limited.

[81] The Applicant also draws attention to the Federal Court's decision in *Mainstreet*, where it was held that the nature of the trade factor involves a consideration of the type of purchasing decision that will be made and, to provide examples at either end of the spectrum, the court contrasted "a business involving a hurried purchase of an item at a grocery store" with "an expensive purchase of highly specialized industrial equipment by professional purchasers who will spend considerable time studying the options" [at para 134]. In reaching its decision against a likelihood of confusion, the court found that "the 'casual consumer' in the rental or investment market is likely to spend more time considering the commitment or investment they are making" and that such purchasing decisions will "involve more thought, time and consideration than the purchase of a

typical consumer item at a store” [paras 132, 135]. At the hearing, the Applicant submitted that purchases in the present case would likewise not be made hurriedly but rather given more thought and consideration.

[82] I would first note that the care or attention of a consumer approaching an important or costly purchase must relate to the consumer’s attitude when he or she encounters the trademark, not to the research or inquiries or care that may subsequently be taken [*Mattel, supra; Masterpiece, supra*]. Furthermore, to the extent that the Applicant is relying on *Mainstreet* for the proposition that the appropriate test in the case of sophisticated purchasers is not that of a casual consumer somewhat in a hurry, this type of approach was rejected by the Supreme Court in *Masterpiece*:

[71] It is not relevant that, as the trial judge found, consumers are “unlikely to make choices based on first impressions” or that they “will generally take considerable time to inform themselves about the source of expensive goods and services” (para. 43). Both of these — subsequent research or consequent purchase — occur after the consumer encounters a mark in the marketplace.

[72] This distinction is important because even with this increased attentiveness, it may still be likely that a consumer shopping for expensive goods and services will be confused by the trade-marks they encounter. Careful research and deliberation may dispel any trade-mark confusion that may have arisen. However, that cannot mean that consumers of expensive goods, through their own caution and wariness, should lose the benefit of trade-mark protection....

[83] Applying these principles to the present case, I accept that purchasers of residential real estate, commercial building evaluations, business franchises, business management assistance, and the like would be more alert and attentive to the trademarks encountered than a consumer making inexpensive minor purchases. This attitude decreases the likelihood of an error being made, even upon first impression and with imperfect recollection. Even so, the Supreme Court has held that, in circumstances where a strong resemblance suggests a likelihood of confusion, and the other statutory factors do not point strongly against a likelihood of confusion, cost is unlikely to lead to a different conclusion [*Masterpiece, supra*]. Accordingly, I am only prepared to accord this aspect of the analysis moderate weight.

Conclusion with respect to the nature of the goods, services, businesses, and trades

[84] In the Applicant's submission, the nature of the goods, services, businesses, and trades is the key factor to consider where, as here, the parties' trademarks are very similar.

[85] Indeed, the parties' respective businesses in this case have a different focus, and the relative cost and importance of the parties' respective goods and services may decrease the likelihood of confusion in their particular markets. Nevertheless, the key goods and services at issue are generally either overlapping to some degree or somewhat related and, on their face, appear to potentially target some of the same purchasers. In the absence of more evidence regarding the actual nature of the goods and services and the probable channels of trade, overall, I find that the considerations under sections 6(5)(c) and (d) of the Act slightly favour the Opponent.

Surrounding circumstance: No evidence of actual confusion

[86] The Applicant submits that the Opponent has failed to adduce any evidence of actual confusion in the marketplace, whereas Mr. Sholdice's evidence, which remains uncontroverted in the absence of cross-examination, confirms that there has been no actual confusion [written representations at page 10].

[87] First, I disagree that Mr. Sholdice's evidence confirms an absence of actual confusion. Mr. Sholdice states that the Opponent does not market its products or services to the Applicant and that the Opponent's goods and services do not conflict with the Applicant's software. But he does not explain how, in his position as Vice-President Finance and Internal Operations, he would be made aware of marketing received by the Applicant's franchisees or their staff, or of any instances of actual confusion on the part of employee or franchisee inspectors otherwise encountering the Opponent's Trademark in the marketplace.

[88] I would also note that an opponent is under no obligation to submit evidence of instances of actual confusion; the burden is on the applicant to demonstrate that confusion is not likely. If the evidence shows extensive concurrent use of both

trademarks in the same area over many years, then an adverse inference *may* be drawn from a lack of evidence of actual confusion, in cases where such evidence would readily be available if the allegation of a likelihood of confusion were justified [see *Mattel, supra*]. However, in the present case, both parties adduced only relatively limited evidence of use, and there is no clear indication of the extent to which their respective trademarks have coexisted in the same markets. It is therefore not possible to draw any meaningful conclusions from the absence of evidence of actual confusion in this case.

[89] Accordingly, this circumstance does not assist the Applicant.

Conclusion with respect to registrability under section 12(1)(d)

[90] In an opposition proceeding, the onus is not on the Opponent to show that confusion is likely but rather on the Applicant to satisfy the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion. The presence of a legal onus on the applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against the applicant.

[91] Having considered all the surrounding circumstances, I find that, at best for the Applicant, the probabilities are evenly balanced between a finding of confusion with the Opponent's Trademark and a finding of no confusion. I reach this conclusion owing primarily to the high degree of resemblance between the parties' trademarks, the inherent distinctiveness of the Opponent's Trademark and the greater extent to which it has become known, and the potential for overlap in the nature of the goods and trades, and notwithstanding the relative cost of the goods and services and sophistication of the purchasers. I am mindful that the evidence shows the Applicant's current use of the Mark and trade channels to be highly specialized; however, given the scope of the Goods and Services as defined in the Application, and the relatively limited evidence regarding the Applicant's franchising model, I do not find this factor to be determinative.

[92] Based on all the foregoing, I find that the Applicant has not met its legal onus to demonstrate, on a balance of probabilities, that there is no reasonable likelihood of

confusion between the Mark and the Opponent's Trademark. The registrability ground of opposition under section 12(1)(d) of the Act is therefore successful.

ENTITLEMENT UNDER SECTIONS 16(1)(A) AND 16(1)(C) OF THE ACT

The Opponent pleads that the Applicant is not entitled to registration having regard to the provisions of section 16(1)(a) and (c) of the Act because, at the Application's filing date or at the date of first use the Mark, or at any material date, the Mark was confusing with (i) the trademark ONE POINT (or a trademark containing this term, including ONEPOINT), and (ii) the trade name "Onepoint" (or a trade name containing this term, including "Groupe onepoint" or "onepoint"). The Opponent pleads that these trademarks and trade names have been previously used in Canada by the Opponent, its predecessors in title, or, for their benefit, by licensees, in association with the goods and services covered by the Opponent's Registration, the Opponent's other digital transformation goods and services, and the goods and services covered by the Application, or ones that are similar or of the same nature.

[93] The material date to assess an applicant's entitlement to registration is the earlier of the application's filing date and the date of first use of the applied-for trademark. In the present case, as discussed above, Mr. Sholdice attests to software under the Mark being launched in 2016; however, he describes the Applicant's activities in North America without confirming whether and how the Applicant was active in Canada in 2016. The precise date of first use of the Mark in Canada is therefore difficult to determine on the evidence; however, I do not find it necessary to decide the issue, since the outcome of this ground of opposition will be the same regardless of whether it is assessed as of the software's launch in 2016 or as of the Application's November 22, 2018 filing date.

[94] Section 16 of the Act does not require an opponent to demonstrate any particular level of use or reputation. If the opponent demonstrates that its trademark or trade name functions as such, that its use meets the requirements of section 4 of the Act, that such use occurred prior to the material date, and that the trademark or trade name was not abandoned at the date of advertisement of the application, then the opponent will

meet its burden under sections 16(1)(a) and (c) of the Act [*JC Penney Co v Gaberdine Clothing Co*, 2001 FCT 1333; see also *Olive Me Inc, et al v 1887150 Ontario Inc*, 2020 TMOB 26].

[95] The Opponent's evidence discussed under the registrability ground of opposition is sufficient to establish that the Opponent's Trademark was used in Canada since at least as early as 2015 and had not been abandoned when the Application was advertised on November 3, 2021. Thus the Opponent has met its evidential burden in respect of the Opponent's Trademark.

[96] Mr. Melanson states that the Opponent also carries on business under the trade names OnePoint and OnePoint Technology and has, since at least 2005, offered and performed services in Canada in association with the trademark ONEPOINT TECHNOLOGY [paras 6, 7, 9]. Indeed, the trade name Onepoint is used to identify the Opponent on the exhibited webpages, and I also note references to GROUPE Onepoint UNLIMITED, Groupe ONEPOINT Inc., onepoint., and onepoint Canada on the exhibited invoices [Exhibits A-1, A-3, A-4]. However, as the Opponent's case in respect of these trademarks and trade names would be no stronger than its case in respect of the Opponent's Trademark, it is not necessary to consider whether the Opponent has met its evidential burden for them.

[97] As for the Opponent's Trademark, although the Opponent's evidence is sufficient to meet its initial burden, the Opponent has not established use of its trademark in Canada for the breadth of goods and services covered by the Opponent's Registration. Only three of the exhibited invoices predate November 22, 2018: those dated December 31, 2015 and December 31, 2016 do not specify any particular services and the one dated December 31, 2017 is for developing a platform for an entertainment company. Although additional services are advertised on the exhibited webpages, the Opponent has not established which of these webpages have been viewed in Canada, nor the extent to which any webpages were viewed in Canada prior to 2018. Mr. Melanson also mentions additional customers, revenues, and other forms of advertising as of 2014, but does not furnish any details regarding the additional work

performed or any examples of the additional advertising, or otherwise indicate the specific goods or services involved.

[98] I am not prepared to find that the service of developing a digital platform for an entertainment company, or the resulting software, overlaps in any meaningful way with any of the Goods or Services described in the Application, including the Applicant's specialized software—whether in the nature of the goods and services or in the nature of the business and trade. Moreover, even if I were to factor in the exhibited excerpts from the Opponent's website, I would not find that they provide any clear indication of overlap with the Goods and Services at the material date. Thus, under the entitlement ground of opposition, the sections 6(5)(c) and (d) factors favour the Applicant. Furthermore, the Opponent's case in respect of the other factors in the test for confusion is no stronger under this entitlement ground than under the registrability ground. In the end, I find that the difference in the outcome of the sections 6(5)(c) and (d) factors is sufficient to tip the balance in favour of the Applicant under the entitlement ground of opposition.

[99] Accordingly, the entitlement grounds of opposition are rejected.

DISTINCTIVENESS UNDER SECTION 2 OF THE ACT

[100] The Opponent pleads that, having regard to the provisions of section 2 of the Act, and the allegations set out in the statement of opposition, the Mark is not and cannot be distinctive of the Applicant's goods or services for the following reasons:

1. The Mark does not distinguish the goods or services in association with which the Applicant allegedly used or intended to use it from the goods and services of others, namely from those of its operators ("*opérateurs*").
2. The Mark does not distinguish the goods or services in association with which the Applicant allegedly used or intended to use it from the goods and services of the Opponent. (In the absence of further particulars, this branch of the pleading is limited to the allegations of confusion and misrepresentation otherwise pleaded in the statement of opposition.)

3. The Applicant has allowed third parties, including its operators, to use the Mark in Canada—and the third parties have in fact used it—outside the legislative provisions governing licensed trademark use set out at section 50 of the Act.

[101] The Opponent furnished no evidence or argument in respect of the first and third prongs of this ground of opposition. The Opponent having thus failed to meet its evidential burden, they are summarily rejected.

[102] As for the second prong, the material date for this ground of opposition is December 16, 2021, the date the statement of opposition was filed [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185]. To succeed, an opponent relying on its own mark or name must establish that, as of this date, its mark or name was known in Canada to some extent at least, *i.e.* that its reputation was “substantial, significant or sufficient” to negate the established distinctiveness of another party’s trademark, or else that it was well known in a specific area of Canada [*Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles’ International LLC v Bojangles Café Ltd*, 2006 FC 657; *1648074 Ontario Inc v Akbar Brothers (PVT) Ltd*, 2019 FC 1305]. In either case, an opponent cannot simply assert that its trademark was known; there must be clear evidence of the extent to which it was known [*Bojangles, supra*; *Sadhu Singh Hamdard Trust v Navsun Holdings Ltd*, 2019 FCA 10].

[103] It is not necessary to discuss this ground in detail. To the extent that the Opponent may meet its evidential burden, I find that the Applicant would meet its legal onus to establish that, on a balance of probabilities, that there was no reasonable likelihood of confusion. I reach this conclusion for the same reasons as discussed above in respect of the entitlement ground of opposition. The later material date for the distinctiveness ground would allow additional invoices to be considered, but given the lack of detail they provide on the nature of the invoiced goods or services, factoring them in would not significantly alter the results of my analysis.

[104] Accordingly, the distinctiveness grounds of opposition are rejected.

DISPOSITION

[105] In view of all the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the Application pursuant to section 38(12) of the Act.

Oksana Osadchuk
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Opponent's Goods (TMA929,231)

(1) Programmes informatiques pour contrôler l'affichage des programmes télévisés, multimédia et vidéo, nommément pour contrôler la mise en onde et l'affichage visuel de programmes télévisés pour télévision et de programmes multimédia et vidéo pour le réseau internet; logiciels pour accéder à, créer, éditer et gérer des bases de données d'utilisation générale et transférer des données vers et à partir de bases de données ; logiciels pour la conception, la création, l'entretien, le stockage, et l'accès à des systèmes de gestion, nommément systèmes de gestion de bases de données informatiques, systèmes de gestion de profils utilisateurs du réseau internet, systèmes de gestion de statistiques, systèmes de gestion de l'accès à un réseau informatique, systèmes de gestion de sécurité électronique ; logiciels pour le contrôle d'accès et la sécurité, nommément logiciels pour le contrôle d'accès et la sécurité de réseaux informatiques; logiciels destinés à la publication assistée par ordinateur, à la conception et au dessin assistés par ordinateur, à la création de présentations multimédias ; logiciels destinés à la gestion de groupes de travail, de projets, de clientèle, à la planification commerciale, au publipostage, et à la gestion commerciale et financière, nommément logiciels relatifs à la gestion financière et à l'administration des affaires ; logiciels pour la conception, la création, l'entretien et l'accès à des sites de réseaux internes personnalisés et à des sites de l'Internet ; programmes informatiques à utiliser sur et avec des réseaux informatiques et l'Internet, nommément programmes d'identification, d'enregistrement et d'autorisation de l'utilisateur dans le domaine de la sécurité informatique; programmes d'automatisation des procédures de connexion pour l'accès à des sites de l'Internet et des réseaux internes ; programmes pour l'entretien de profils de serveurs ; programmes informatiques destinés au commerce électronique, nommément dans le domaine de l'administration des affaires et pour le faciliter et au transfert sécurisé d'informations financières ; compilateurs, programmes débogueurs et programmes utilitaires pour la création d'applications de réseaux internes et d'applications sur l'Internet ; programmes de sécurité et de cryptage ; logiciels de développement de programmes informatiques et d'assistance aux développeurs en matière de création de codes de programmes destinés aux réseaux informatiques internes et à l'Internet ; programmes informatiques permettant le fonctionnement de programmes de développement et de programmes d'applications dans un environnement de développement commun.

[JOURNAL TRANSLATION] (1) Computer programs to monitor television, multimedia, and video program display, namely to monitor the broadcasting and visual display of television programs and multimedia and video programs for the Internet network; computer software used to access, create, edit, and manage general-use databases and transfer data to and from databases; computer software to design, create, maintain, store, and access management systems, namely computer database management systems, Internet network user profile management systems, statistics management systems, computer network access management systems, electronic security management systems; computer software for access control and security, namely computer software for computer network access control and security; computer software for computer-assisted publishing, computer-assisted creation and design, multimedia presentation creation; computer software intended for the management of work groups, projects, customers, for business planning, direct mail advertising, and commercial and financial management, namely computer software related to financial management and business administration; computer software for the design, creation, maintenance, and accessing of personalized internal network sites and Internet sites; computer programs for use on and with computer networks and

the Internet, namely user identification, registration, and authorization programs in the field of computer security; automation programs for connection procedures for access to the Internet and for internal network sites; programs for the maintenance of server profiles; computer programs for e-commerce, namely in the field of business administration, and used to facilitate secure financial data transfers; compilers, debugging programs, and utility programs for the creation of internal network applications and Internet applications; security and encryption programs; computer software for the development of computer programs and developer support programs related to the creation of code for programs intended for internal computer networks and the Internet; computer programs enabling development programs and application programs to run in a common development environment.

(2) Ordinateurs ; périphériques d'ordinateurs, composants d'ordinateurs, nommément écrans d'ordinateurs, claviers d'ordinateurs, souris d'ordinateurs, imprimantes d'ordinateurs ; lecteurs de disques numériques et optiques, nommément lecteurs de CD, lecteurs de disques optiques, lecteurs de disques optonumériques ; disques optiques et magnétiques, nommément disques optiques et magnétiques vierges, et disques optiques et magnétiques contenant des programmes et logiciels informatiques, nommément logiciels pour le contrôle d'accès et la sécurité d'un site électronique ; écrans vidéo.

[JOURNAL TRANSLATION] (2) Computers; computer peripherals, computer components, namely computer monitors, computer keyboards, computer mice, computer printers; digital and optical disc readers, namely CD players, optical disc players, optical digital disc readers; optical and magnetic discs, namely blank optical and magnetic discs, and optical and magnetic discs containing computer software and programs, namely computer software for access control and security of electronic sites; video screens.]

Opponent's Services (TMA929,231)

Services de conseils, d'aide et de gestion administrative dans le domaine de la direction des affaires, notamment dans les secteurs bancaire, financier, industriel, administratif, de l'assurance et des télécommunications, nommément gestion financière, administration des affaires, planification financière ; conseils en organisation des affaires, nommément conseils en organisation, audit et contrôle internes des entreprises opérant notamment dans les secteurs bancaire, financier, industriel, administratif, de l'assurance et des télécommunications ; aide à la direction d'entreprises industrielles et commerciales opérant notamment dans les secteurs bancaire, financier, industriel, administratif, de l'assurance et des télécommunications ; informations, recherches et renseignements d'affaires, nommément diffusion d'informations financières via une base de données informatiques ; services de création et de développement de stratégies de communications publicitaires et commerciales (marketing), nommément établissement de stratégies de commercialisation pour des tiers ; services de publicité et de marketing, à savoir promotion de biens et services de tiers via des réseaux informatiques, réseaux sans fil et réseaux de communication mondiaux; services de conseils commerciaux aux consommateurs, nommément informations commerciales et conseils commerciaux dans le domaine des réseaux informatiques internes, de l'Internet et des réseaux de communication mondiaux, des sites de l'Internet, des logiciels, des télécommunications, des technologies de pointe et dans le domaine du développement de programmes et de systèmes informatiques ; informations commerciales et conseils commerciaux aux consommateurs dans les domaines des affaires, de la communication commerciale et du commerce sur des réseaux informatiques internes, de l'Internet et des réseaux mondiaux de communication administration commerciale de licences de logiciels pour des tiers ;services de présentation de produits sur tout moyen de

communication pour la vente au détail nommément de matériel informatique y compris serveurs, périphériques d'ordinateurs, composants d'ordinateurs, nommément claviers d'ordinateurs, dispositifs de contrôle vidéo d'ordinateurs, à savoir souris d'ordinateurs, boules de commande, manettes de jeu et claviers de jeu; service de vente au détail et en ligne de base de données contenant des informations personnelles et commerciales nommément dans le domaine de l'identification personnes physiques et des personnes morales; études et recherches de marché, nommément services d'analyse de marchés ; études qualitatives et quantitatives dans le cadre d'études de marché, nommément services de commercialisation consistant en l'évaluation des marchés pour les marchandises et services de tiers; gestion de fichiers informatiques, nommément gestion de bases de données informatiques contenant des fichiers textuels, sonores et audiovisuels pour le bénéfice de tiers ; gestion de bases de données, nommément gestion de base de données informatiques; services de télécommunications, nommément service de routage et de jonctions en télécommunication ; services de communication au public par voie électronique, nommément fourniture d'accès à des utilisateurs multiples à un réseau informatique; transmission, réception et livraison de messages, documents, images photographiques, informations, programmes de télévision, multimédia et vidéo , nommément programmes télévisés et multimédia et vidéo dans le domaine de l'informatique, de la sécurité informatique, des affaires et de la finance, par transmission électronique, numérique et câblée, nommément par téléphone fixe et cellulaire, par ondes radiophoniques, par câble, par satellite et par fibre optique; Fourniture d'accès à des bases de données, nommément bases de données contenant des fichiers textuels, sonores et audiovisuels dans les domaines de l'informatique, de la sécurité informatique, des affaires et de la finance. Informations en matière de télécommunications, nommément informations fournies à des tiers relativement à la mise en place de systèmes de télécommunications par Internet, par réseaux informatiques, par téléphone fixe et cellulaire, par messagerie électronique, par ondes radiophoniques, par câble, par satellite et par fibre optique. Enseignement et formation dans le domaine informatique, des réseaux informatiques internes, de l'Internet, et des réseaux de communication mondiaux, des sites de l'Internet, des logiciels, des télécommunications, et des technologies de pointe et dans le domaine du développement de programmes et de systèmes informatiques ; organisation et conduite d'ateliers de formation, colloques, conférences, congrès, séminaires et symposiums autres que publicitaires, notamment dans les secteurs bancaire, financier, industriel, administratif, de l'assurance et des télécommunications. Services informatiques à savoir consultation en matière d'ordinateurs et de logiciels ; services de programmation informatique ; services d'élaboration (conception), de création, de développement, d'installation, de mise en service, de mise à jour, de maintenance et d'utilisation de programmes informatiques, des sites de l'Internet, de réseaux informatiques internes et mondiaux, de bases de données ; consultations et conseils informatiques, et services de support technique concernant la conception, la création, le développement de programmes informatiques, de sites de l'Internet, de réseaux informatiques internes et de l'Internet, de gestion de documents, de bases de données, d'ordinateurs, de matériel informatique et de systèmes informatiques, de produits électroniques, nommément bulletins électroniques de télécommunications, nommément de messagerie électronique par Internet, de la sécurité et de l'authentification, de conversion de données ou de documents d'un support physique vers un support électronique ou numérique ; consultations et conseils informatiques, services de support technique (conseil informatique) concernant l'installation, la mise en service, la maintenance de programmes informatiques, de sites de l'Internet, de réseaux informatiques internes et de l'Internet, de gestion de documents, de bases de données, de conversion de données ou de documents d'un support physique vers un support électronique ou numérique ; création de base de données contenant des informations personnelles et commerciales nommément informations personnelles relatives à des tiers, nommément des personnes physiques et morales, collectées au travers de réseaux informatiques, de réseaux

internet sans fil et de l'Internet pour le bénéfice de tiers; hébergement de sites informatiques (sites Web), nommément hébergement web.

[JOURNAL TRANSLATION] Consulting, assistance, and administrative management services in the field of business management, namely in the banking, financial, industrial, administrative, insurance, and telecommunications sectors, namely financial management, business administration, financial planning; business organization advice, namely organization consultancy, internal audit and control for businesses operating, namely in the banking, financial, industrial, administrative, insurance, and telecommunications sectors; assistance for the direction of industrial and commercial businesses operating, namely in the banking, financial, industrial, administrative, insurance, and telecommunications sectors; information, research, and business information, namely dissemination of financial information via computer database; creation and development services for advertising and commercial communications strategies (marketing), namely establishment of marketing strategies for others; advertising and marketing services, namely promoting the goods and services of others via computer networks, wireless networks, and global communications networks; business consulting services for consumers, namely commercial information and business consulting in the fields of internal computer networks, the Internet and global communication networks, Internet sites, computer software, telecommunications, advanced technologies, and in the field of development of computer programs and systems; commercial information and business consulting for consumers in the fields of business, sales and trading communications via internal computer networks, the Internet and global communications networks, business administration of computer software licences for others; product presentation services via all means of communication for retail, namely for computer hardware including servers, computer peripherals, computer components, namely computer keyboards, video control devices for computers, namely computer mice, trackballs, game controllers and game keyboards; retail and online sales services for databases containing personal and commercial information, namely in the field of the identification of legal persons and legal entities; market studies and research, namely market analysis services; qualitative and quantitative studies in the context of market studies, namely marketing services consisting of evaluating markets for the goods and services of others; management of computer files, namely management of computer databases containing files which are text, sound, and audio-visual for the benefit of others; management of databases, namely computer database management; telecommunications services, namely telecommunications routing and connection services; public communications services by electronic means, namely, provision of multiple-user access to a computer network; transmission, reception, and delivery of messages, documents, photographic images, information, television programs, multimedia and video, namely televised and multimedia and video programs in the fields of computers, computer security, business and finance, via electronic, digital, and cable transmission, namely stationary and cellular telephones, via radio waves, via cable, via satellite and fiber optics; provision of access to databases, namely databases containing files which are text, sound, and audio-visual in the fields of computers, computer security, business and finance. Information related to telecommunications, namely information provided to others related to the implementation of telecommunications systems via Internet, via computer networks, via stationary and cellular telephones, via email, via radio waves, via cable, via satellite and fiber optics. Teaching and training in the fields of computers, internal computer networks, the Internet and global communication networks, Internet sites, computer software, telecommunications, and advanced technologies, and in the field of computer program and system development; organization and conducting workshops for training, colloquia, conferences, conventions, seminars and symposia other than those for advertising, namely in the banking, financial, industrial, administrative, insurance and telecommunications sectors. Computer services, namely consulting related to computers and

computer software; computer programming services; development (design), creation, design, installation, implementation, updating, maintenance, and usage services for computer programs, Internet sites, internal computer networks and global computer networks, databases; computer consulting and consultations, and technical support services related to the design, creation, development of computer programs, Internet sites, internal computer networks, and the Internet, the management of documents, databases, computers, computer hardware, and computer systems, to electronic products, namely to electronic telecommunications newsletters, namely electronic messaging via Internet, to security and authentication, to the conversion of data or documents from physical media to electronic or digital media; computer consulting and consultations, technical support services (computer consultations) related to the installation, implementation, maintenance of computer programs, Internet sites, internal computer networks and the Internet, management of documents, databases, the conversion of data or documents from physical media to electronic or digital media; creation of databases containing personal and commercial information, namely personal information related to others, namely legal persons and legal entities, collected from computer networks, wireless Internet networks and the Internet for the benefit of others; hosting of computer sites (websites), namely web hosting.

Appearances and Agents of Record

HEARING DATE: 2023-06-06

APPEARANCES

For the Opponent: Barry Gamache

For the Applicant: Nancy Miller

AGENTS OF RECORD

For the Opponent: ROBIC

For the Applicant: Miller IP Law