Date: 20061218

Docket: T-1000-06

Citation: 2006 FC 1492

BETWEEN:

VIDÉOTRON LTÉE,

Applicant

and

ONTARIO EDUCATIONAL COMMUNICATIONS AUTHORITY,
and
REGISTRAR OF TRADE-MARKS,

Respondents

REASONS FOR JUDGMENT

Mr. Justice Pinard

[1] This is an appeal by Vidéotron Ltée (the Applicant), under section 56 of the *Trade-marks Act*, R.S.C. (1985), c. T-13 (the Act), from a decision of Jean Carrière, Member of the Trade-Marks Opposition Board (the Board), dated March 28, 2006, denying the Applicant's application for registration of the trade-mark CANAL VOX (the trade-mark).

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[2] A predecessor corporation of the Applicant filed application no. 1,025,997 on August 16, 1999 to register the trade-mark CANAL VOX in association with services related to the production of television programming for broadcast or recording and community news and services programming via television.

[3] The Ontario Educational Communications Authority (the Respondent) filed its statement of opposition to that application on January 30, 2001, alleging that:

a) under sections 38(2)(*b*) and 12(1)(*e*) of the *Trade-marks Act*, R.S.C. 1985, c. T-13, the trade-mark is not registrable because it is prohibited by section 9(1)(*n*)(iii) of the Act, as the Opponent is the owner of the VOX official mark in respect of which the Registrar gave public notice of adoption on August 23, 2000;

b) under sections 38(2)(*d*) and 2 of the Act, the trade-mark is not distinctive of the Applicant because it does not distinguish the Applicant's services from the services and wares of the Opponent, including the services related to the production of television programming for broadcast or recording produced in association with the VOX trade-mark and official mark.

[4] In its counter-statement, the Applicant denied the allegations contained in the Respondent's statement of opposition. The parties did not request a hearing.

[5] In his decision dated March 28, 2006 and sent on April 19, 2006, Jean Carrière, Member of the Trade-Marks Opposition Board, allowed the Respondent's opposition. He found that the Applicant had not met its burden of proving on a balance of probabilities that the trade-mark was capable of distinguishing the Applicant's services from those offered by the Respondent in association with its trade-mark VOX.

[6] In addition, he rejected the appeal based on the official mark, specifically on subparagraph 9(1)(*n*)(iii) of the Act.

* * * * * * * * * *

[7] The relevant provisions of the Act are as follows:

2. "distinctive", in relation to a trade-mark, means a trade-mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is adapted so to distinguish them;	**2.** « distinctive » Relativement à une marque de commerce, celle qui distingue véritablement les marchandises ou services en liaison avec lesquels elle est employée par son propriétaire, des marchandises ou services d'autres propriétaires, ou qui est adaptée à les distinguer ainsi.
"trade-mark" means (*a*) a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others,	« marque de commerce » Selon le cas : *a*) marque employée par une personne pour distinguer, ou de façon à distinguer, les marchandises fabriquées, vendues, données à bail ou louées ou les services loués ou exécutés, par elle, des marchandises fabriquées, vendues, données à bail ou louées ou des services

	loués ou exécutés, par d'autres;
(*b*) a certification mark,	*b*) marque de certification;
(*c*) a distinguishing guise, or	*c*) signe distinctif;
(*d*) a proposed trade-mark;	*d*) marque de commerce projetée.
38. (2) A statement of opposition may be based on any of the following grounds:	**38.** (2) Cette opposition peut être fondée sur l'un des motifs suivants :
[…]	[…]
(*d*) that the trade-mark is not distinctive.	*d*) la marque de commerce n'est pas distinctive.
(8) After considering the evidence and representations of the opponent and the applicant, the Registrar shall refuse the application or reject the opposition and notify the parties of the decision and the reasons for the decision.	(8) Après avoir examiné la preuve et les observations des parties, le registraire repousse la demande ou rejette l'opposition et notifie aux parties sa décision ainsi que ses motifs.
56. (1) An appeal lies to the Federal Court from any decision of the Registrar under this Act within two months from the date on which notice of the decision was dispatched by the Registrar or within such further time as the Court may allow, either before or after the expiration of the two months.	**56.** (1) Appel de toute décision rendue par le registraire, sous le régime de la présente loi, peut être interjeté à la Cour fédérale dans les deux mois qui suivent la date où le registraire a expédié l'avis de la décision ou dans tel délai supplémentaire accordé par le tribunal, soit avant, soit après l'expiration des deux mois.
[…]	[…]
(5) On appeal under subsection (1), evidence in addition to that adduced before the Registrar may be adduced and the Federal Court may exercise any discretion	(5) Lors de l'appel, il peut être apporté une preuve en plus de celle qui a été fournie devant le registraire, et le tribunal peut

vested in the Registrar.	exercer toute discrétion dont le registraire est investi.

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[8] In this appeal, the Applicant filed additional evidence pursuant to subsection 56(5) of the Act, namely, the affidavit of Yvan Gingras, of which paragraphs 11 and 12 are of specific interest and, accordingly, are quoted below:

> [TRANSLATION]
>
> 1. After Vidéotron's written arguments were filed, the Applicant and the Respondent negotiated an agreement for the purpose of terminating the opposition proceedings. A copy of that agreement was sent to Vidéotron in June 2004. For reasons unknown to me, the agreement was not approved by Vidéotron until October 2005. A final version of the agreement was sent to Vidéotron on November 23, 2005 by the Respondent's lawyers and it was not until April 2006 that the agreement was signed by the undersigned and by Robert Dépatie, President and Chief Executive Officer of Vidéotron Ltée.
>
> 2. In the end, it was not until April 26, 2006 that the representative of the Ontario Educational Communications Authority, Mr. Chapelle signed the agreement on behalf of the Respondent. A copy of the agreement is appended hereto as YG-4.

[9] That evidence is not contradicted in any way. Indeed, on July 10, 2006, counsel for the Respondent sent the Administrator of the Court a letter informing him that the Respondent was not taking any position on the appeal and did not intend to litigate in any way in respect of the conduct and hearing of the appeal.

[10] As this is a commercial matter, it would be correct to infer from this additional evidence that the agreement of the parties was entered into on November 23, 2005, namely, before the formal signature of the agreement on April 26, 2006, and before the impugned Board decision dated March 28, 2006. If the Board had seen this evidence, it would not have been able to allow an opposition that the Respondent was intending to withdraw.

[11] Furthermore, I am of the view that the Board erred in finding that the Respondent's trade-mark VOX was inherently distinctive since it consists of a word that is neither English nor French. It is not an invented word. It is a Latin word the meaning of which is well known. I agree with the Applicant that a word of Latin origin that is defined in the dictionary does not have the inherent distinctiveness attributed to it by the Board (see *Illico Communication Inc. v. Vidéotron Ltée*, [2004] R.J.Q. 2579).

[12] Thus, VOX is a weak trade-mark that should not receive a large measure of protection. In *Compulife Software Inc. v. CompuOffice Software Inc.*, 2001 FCTD 559, my colleague Muldoon J. wrote as follows at paragraph 20 :

> … on the other hand, a trade-mark lacking such qualities is inherently less distinctive, and is a weaker mark. The ambit of protection afforded to a weak mark is much less than for a strong mark, and registration of other marks containing comparatively small differences may be permitted. [*Man and His Home Ltd.* v. *Mansoor Electronics Ltd.* (1999), 87 C.P.R. (3d) 218 at 224 (F.C.T.D.)].

[13] In the circumstances, I am of the opinion that even though the addition of the word "CANAL" is suggestive of the Applicant's services, the fact remains that this word, of which the Applicant disclaimed exclusive use apart from the trade-mark, is capable of distinguishing the Applicant's services from those offered by the Respondent under the VOX mark.

[14] The Board was in error, therefore, when it determined that the addition of the word "CANAL" was not capable of distinguishing the Applicant's services from the Respondent's services.

[15] In that context, the fact that the Applicant began using its trade-mark on or about September 10, 1999, whereas the Respondent began using its trade-mark on or around June 2000, as noted by the Board itself, points more strongly in favour of the Applicant, in my view.

[16] For all of these reasons, the Applicant's appeal is allowed; the Board's decision dated March 28, 2006, upholding the Applicant's opposition, is set aside; and the Registrar of Trade-Marks is ordered not to deny application for registration no. 1,025,997 on the basis of that opposition.

[17] There is no award of costs, as the Applicant is not seeking costs in the absence of any litigation.

Judge

Ottawa, Ontario
December 18, 2006

Certified true translation
François Brunet, LLB, BCL

FEDERAL COURT

SOLICITORS OF RECORD

DOCKET:	T-1000-06
STYLE OF CAUSE:	VID ⁄ OTRON LT ⁄ E v. ONTARIO EDUCATIONAL COMMUNICATIONS AUTHORITY and REGISTRAR OF TRADE-MARKS
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APPEARANCE:

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