

Federal Court



Cour fédérale

Date: 20230614

Docket: T-1794-22

Citation: 2023 FC 840

[ENGLISH TRANSLATION]

Ottawa, Ontario, June 14, 2023

PRESENT: Associate Chief Justice Gagné

BETWEEN:

JEAN-LOUIS VILL

Appellant

and

BELL CANADA

Respondent

JUDGMENT AND REASONS

[1] This is an appeal of a decision of the Trademarks Opposition Board, in which it rejected applicant Jean-Louis Vill's opposition to the registration of the trademark EBOX TV, in association with services providing Internet access, Internet telephony, web hosting, and assistance and troubleshooting in the event of network failure.

[2] The Board concluded that Mr. Vill had not discharged his initial burden of proof to show that he had used the IBOX TV mark in association with his goods and services prior to the day he filed his application for registration of the EBOX TV trademark, and that he had not abandoned that mark or trade name upon publication of the mark in the Trademarks Journal; it therefore did not have to rule on Mr. Vill's argument that the EBOX TV mark was confusing with his IBOX TV mark.

[3] Before the Court, Mr. Vill argued that the new evidence he has adduced warrants a *de novo* review of the issue, but that in any event, the Court is justified in intervening, regardless of the applicable standard.

I. Facts

[4] On March 27, 2017, Ebox Inc. filed an application for registration (No. 1,829,437) for the EBOX TV trademark, which was published in the *Trademarks Journal* on January 2, 2019.

[5] On January 11, 2019, Mr. Vill filed his statement of opposition, citing the following grounds of opposition:

Pursuant to section 38(2)(c) of the Act, the Applicant is not the person entitled to registration of the Applicant's Mark in connection with the Applicant's Services in view of the provisions of section 16(3)(a) of the Act, since at the date of filing of the Application, the Applicant's Mark created, and still creates, confusion with the Opponent's IBOX TV TM trademark that was previously used in Canada, and is still in use, in association with the Opponent's Goods and Services; and

Pursuant to section 38(2)(c) of the Act, the Applicant is not the person entitled to registration of the Applicant's Mark in association with the Applicant's Services in view of the provisions

of section 16(3)(c) of the Act as at the filing date of the Application, the Applicant's Mark created, and still creates, confusion with the Opponent's trade name IBOX TV TM that was previously used in Canada, and is still in use, in association with the Opponent's Products and Services.

(Note that in his notice of opposition, Mr. Vill referred to the Trademarks Act, RSC 1985, c T-13 as it read prior to June 17, 2019; the Board's decision refers to the current version of the Act, with the exception of the comments that address the grounds for opposition).

[6] On March 28, 2019, Ebox Inc. filed a revised application (to specifically exclude video games), which was allowed by the Registrar. The following day, it filed its counter-statement of opposition.

[7] On November 1, 2019, Mr. Vill was cross-examined on his affidavit and entered into a number of undertakings.

[8] The Board held a hearing on May 24, 2022 and dismissed the opposition on July 5, 2022 (decision reported in 2022 TMOB 128).

[9] Following the filing of Mr. Vill's Notice of Appeal, Bell Canada became the owner of all legal rights in the application for registration of the EBOX TV mark and obtained leave from the Court to substitute itself for Ebox Inc. as Respondent.

II. Impugned decision

[10] After summarizing the evidence presented to it, the Board first ruled on the two preliminary issues raised by the Respondent concerning the admissibility of Mr. Vill's affidavit and his late response to the undertakings entered into on cross-examination.

[11] The Board determined that Mr. Vill's affidavit was not admissible given that, when questioned as to whether he was in the presence of the Commissioner of Oaths when he signed, he replied that he did not remember whether he was alone or whether he had the documents to which he referred in his possession.

[12] Notwithstanding the inadmissibility of the affidavit, the Board made summary comments on it and determined that, even if it had been admissible, Mr. Vill would not have discharged his initial burden of proof to show that he had used, in Canada, in the normal course of trade, the IBOX TV trademark or trade name in association with his goods and services, prior to the filing date of the application for registration of the mark EBOX TV.

[13] The Board was of the opinion that Mr. Vill's evidence contained a number of imprecise assertions that were otherwise not corroborated by the documentary evidence. It also noted that Mr. Vill had conceded at the hearing that the evidence showed that the IBOX TV trademark had been used only in regard to his services, not his products.

[14] The Board noted a significant difference between the description of Mr. Vill's goods and services in his statement of opposition and that contained in his affidavit. Mr. Vill alleged in his affidavit that he has used the trademark and trade name with more extensive services than those listed in his statement of opposition.

[15] The statement of opposition reads as follows:

[TRANSLATION]

the following products: television set-top boxes and the following services: Streaming of audiovisual and multimedia content via the Internet, namely television programs, music and films; transmission and broadcasting of audiovisual and multimedia content via the Internet, namely television programs, music and films; supply of access by telecommunication to films and television programs; television services via the Internet; subscription television broadcasting; broadcasting of television programs via the Internet; pay-per-view television services; transmission of television programs online; sale of television set-top boxes; television entertainment service, namely entertainment in the form of television programs (the "Opponent's Products and Services").

[16] In his 2019 affidavit, Mr. Vill stated that, since 2016, he had personally used the trademark in association with the following additional services:

[TRANSLATION]

. . . Internet access services, Internet telephony service, Internet telephony services allowing a choice of different options naming local calls, long-distance calls, international calls, voicemail, call display, call waiting, call forwarding, conditional call forwarding, conference call services, cellular phone service.

[17] Given that the statement of opposition was not amended to include the additional services, the Board concluded that it could not take them into account in its analysis. This was particularly problematic, given that Mr. Vill's allegations all related to the additional services.

[18] The Board added that the registration of the iboxtv.ca domain name in 2016—even if it had been demonstrated that it belonged to Mr. Vill, which is not the case—did not in itself demonstrate use of the IBOX TV trademark or trade name.

[19] Lastly, and in addition to the fact that it did not have to rule on the confusion argument, the Board also found it unnecessary to consider the Respondent's argument that Mr. Vill did not hold the necessary authorizations to sell his products and services.

III. Issues and standard of review

[20] It is not disputed that the issue as to whether the new evidence adduced by Mr. Vill would have had a significant impact on the Board's decision, determines the standard of review applicable to this appeal. However, the answer to this issue is the subject of some disagreement.

[21] The Appellant maintained that the new evidence was relevant and would have had a considerable impact on the Board's decision. Accordingly, he argued that the Court should proceed with a *de novo* appeal.

[22] For its part, the Respondent argued that the new evidence was irrelevant and would have had no impact on the decision, and that the applicable standard of review in this case was that set out by the Supreme Court of Canada in *Housen v Nikolaisen*, 2002 SCC 33. Given that only an error of mixed fact and law was raised by the Appellant, the applicable standard of review established in *Housen* is that of the palpable and overriding error (*Clorox Company of Canada Ltd v Chlorotec S.E.C.*, 2020 FCA 76 at paragraph 23).

[23] The determination of the applicable standard therefore begins with an analysis of the relevance and impact of the additional evidence.

[24] Consequently, this appeal raises the following issues:

- A. *Preliminary issue – what is the purpose of the appeal?*
- B. *What is the relevance and impact of the Appellant’s new evidence, and what is the applicable standard of review?*
- C. *Did the Board commit an error of fact or law requiring the Court’s intervention?*

IV. Analysis

- A. *Preliminary issue – what is the purpose of the appeal?*

[25] The Respondent submits that this appeal concerns only the alleged confusion between the EBOX TV trademark and the IBOX TV trademark, and not with the IBOX TV trade name.

[26] Indeed, the Appellant’s Notice of Appeal Application refers only to the alleged confusion between the trademarks. Accordingly, the Respondent submits that this appeal relates only to the dismissal of the ground of opposition under subsection 38(2) and paragraph 16(3)(a) of the *Trademarks Act*, prior to the 2019 amendment. The Board’s findings on the ground of objection based on subsection 38(2) and paragraph 16(3)(c) would therefore be outside the scope of the present appeal. The Court should therefore disregard any reference made to the IBOX TV trade name in the Appellant’s memorandum of fact and law.

[27] The Appellant did not directly address the issue, but he made no real distinction between a trade name and a trademark in his submissions.

[28] I agree with the Respondent; the absence of any allegation of confusion with the IBOX TV trade name in the Appellant's notice of appeal limits the scope of this appeal, which deals only with the potential confusion between the IBOX TV Mark and the proposed EBOX TV mark. The mere reference to paragraph 16(1)(c) of the *Trademarks Act* is not sufficient to extend the scope of this appeal to the trade name, without any specific allegation to that effect.

[29] Subsection 59(1) of the *Trademarks Act* states that the notice of appeal must include the "full particulars of the grounds on which relief is sought".

[30] In addition, Rule 300(d) of the *Federal Courts Rules*, SOR/98-106 specifies that "appeals" under section 56 of the *Trademarks Act* must be made by application to the Federal Court. However, Rule 301, applicable to applications, requires that the application contain a precise statement of the relief sought and a complete and concise statement of the grounds intended to be argued. An applicant cannot therefore make an argument or seek a remedy not raised in the notice of application (*Apotex Inc v Canada (Minister of Health)*, 2019 FCA 97; *Spagnuolo v Re/Max Hallmark Realty Ltd*, 2022 FC 416, at paragraph 52).

[31] To make an argument not contained in its notice of application, an applicant must file a motion to amend and an amended notice of application (*Republic of Cyprus (Commerce and*

Industry) v International Cheese Council of Canada, 2011 FCA 201, at paragraph 15), which the Appellant did not do.

[32] The following analysis will therefore focus solely on the IBOX TV trademark.

B. *What is the relevance and impact of the Appellant's new evidence, and what is the applicable standard of review?*

[33] Before the Board, the Appellant produced an affidavit that he had signed on May 13, 2019, and exhibits JLV-1–JLV-3 in support thereof. As stated above, the Board found that evidence to be inadmissible given that the Appellant was unable to confirm that he had been in the presence of the Commissioner of Oaths at the time of signing. The Board nevertheless summarized the Appellant's evidence and analyzed its content, in case its decision on admissibility was erroneous. It concluded that even if the evidence had been found to be admissible, this would not have changed the fate of the Appellant's opposition. It found that the Appellant's evidence contained a number of imprecise assertions that were otherwise unsupported by the documentary evidence, and proceeded with a summary analysis of that evidence.

[34] First, the Board noted the Appellant's admission that his evidence did not demonstrate use of the IBOX TV trademark in connection with his products; the analysis was therefore conducted only with regard to the services provided by the Appellant.

[35] It further noted that the affidavit contained allegations concerning services more extensive than those listed in the statement of opposition, and that given that the latter had not been amended, the additional services would not be considered..

[36] In addition to these preliminary remarks, the Board was of the opinion that:

- The approximate sales figures put forward by the Appellant are not broken down by date or by product and service, and they do not specify whether they relate to the trademark or the trade name; a portion even represents commissions collected on the sale of third-party services;
- The documents provided do not contain any information on the Appellant's service consumers, or even on the nature of the services;
- The Appellant did not provide convincing evidence that the IBOX TV domain name belongs to him, and even if it did, this does not demonstrate use of the trademark in association with the Appellant's services.

[37] In support of his appeal, the Appellant submitted an affidavit signed on September 1, 2022, accompanied by exhibits DA-1–DA-19.

[38] The appellant maintained that the new evidence would have had a determinative impact on the Board's decision. The issue, he added, was not whether that evidence would necessarily have led to a different decision, but rather whether it would have had a material effect on the decision (*Arterra Wines Canada Inc. v Diageo North America Inc.*, 2020 FC 508 at paragraphs 29 and 30).

[39] The Appellant pointed out that the Board had rejected his first affidavit and that, in principle, its decision was based on a total absence of evidence. His second affidavit therefore necessarily constituted new evidence that would certainly have had a considerable impact on the decision.

[40] First, I am of the opinion is that the Board did not rule in the absence of any evidence. Even though it found the affidavit to be inadmissible, it nevertheless analyzed its content and the exhibits produced in support of it, in the event of a potential challenge and overturning of its decision. It also considered the Appellant's cross-examination and undertakings.

[41] The issue, in my view, is therefore to determine what were the truly new elements contained in his second affidavit, and were they relevant?

[42] In *Caterpillar Inc v Puma SE*, 2021 FC 974, Justice Janet Fuhrer summed up the analysis of this issue as follows:

[33] To be considered "material," the new evidence must be sufficiently substantial and significant, and of probative value: *Clorox*, above at para 21, citing respectively *Vivat Holdings Ltd v Levi Strauss & Co*, 2005 FC 707 at para 27 and *Tradition Fine Foods Ltd. v. Groupe Tradition 'l Inc.*, 2006 FC 858 at para 58. "[E]vidence that merely supplements or repeats existing evidence will not surpass this threshold": *Scott Paper Limited v Georgia-Pacific Consumer Products LP*, 2010 FC 478 [*Scott Paper*] at paras 48-49. The test is not whether the new evidence would have changed the Registrar's mind, but rather whether it would have a material effect on the decision: *Scott Paper*, above, at para 49. In that regard, quality, not quantity, is key: *Vivat Holdings Ltd v Levi Strauss & Co*, 2005 FC 707 at para 27.

[43] However, when the quality of the new evidence is analyzed, one cannot help but note that several elements are irrelevant, since they concern services not covered by the statement of opposition. An opponent cannot invoke grounds of opposition that were not initially raised in the statement of opposition (*Parmalat Canada Inc v Sysco Corporation*, 2008 FC 1104, at paragraphs 23–27 and *Monster Cable Product Inc v Monster Daddy LLC*, 2012 FC 1260, at paragraphs 11 and 12).

[44] The evidence concerning the Appellant’s products must also be disregarded, since he admitted before the Board that his evidence did not demonstrate the use of the IBOX TV trademark in association with his products.

[45] Finally, in response to one of the undertakings entered into on cross-examination, the Appellant confirmed the following:

- He ceased providing satellite television services on August 1, 2017;
- He ceased providing IPTV subscription services on September 28, 2017; and
- He stopped selling set-top boxes on August 25, 2018.

[46] However, those dates were all prior to the publication of the EBOX TV trademark application in January 2019.

[47] Consequently, although the Appellant’s evidence before the Court was more voluminous than that submitted to the Board, it suffers from the same shortcomings; the Appellant persists in asserting grounds of opposition that were not raised in his statement of opposition, and for the

services that had been raised therein, he has acknowledged having ceased to provide them before the date of publication of the Respondent's trademark application.

[48] I am therefore of the opinion that the new evidence, which will be discussed in the next section, would not have affected the Board's decision.

C. *Did the Board commit an error of fact or law requiring the Court's intervention?*

[49] As stated above, the statement of opposition applies only to Internet television content transmission services, to the exclusion of Internet services and IP telephony, for which the Appellant acted only as a reseller for a company called ACN. The Appellant therefore had to show that he had supplied set-top boxes and a streaming service, in association with the IBOX TV trademark, prior to March 27, 2017, and that he had not ceased doing so.

[50] Under subsection 4(2) of the *Trademarks Act*, a trademark is deemed to have been used in association with services if it has been used or displayed in the performance or advertisement of those services.

[51] A large part of the documentary evidence (DA-1–DA-6) concerns the IBOX TV domain name and invoices from the *GoDaddy* hosting company. It contains no evidence of the use of the mark in association with television streaming services.

[52] The Appellant has not produced any invoices on which the trademark would be apparent to the consumer. The only evidence of income appears on screenshots of his Paypal account or in

the “administrator” section of his website. And again, there is no breakdown by day or service, and the information dates back to 2016 (DA-7, DA-10 and DA-11).

[53] The only evidence of advertising the Appellant was able to produce was a private exchange between himself and a Facebook contact (DA-8), and the result of a Google search on the name IBOX TV (DA-9), again in 2016.

[54] The only exhibits subsequent to March 2017 are screenshots of the iboxtv.ca website (DA-12 and DA-14) showing a drawing of a set-top box (not a photo) under which the following can be read:

[TRANSLATION]
IPTV WITH TV BOX

IPTV provides an exceptional choice of TV channels. By using the iBox TV you'll have in your hands an IPTV set-top box compatible with most IPTV services on the market, in addition to having access to an Android system.

[55] This confirms the Appellant's admission that he has ceased to provide IPTV subscription services himself, and that he is merely selling set-top boxes that provide access to services offered by third parties. The applicant's admission that he is not selling a product in association with the trademark is confirmed by the documentary evidence; the set-top box itself is not identified with the trademark and there is no evidence that it would be shipped in a package that would itself be identified with the trademark. In any event, he admitted that he had ceased selling his set-top boxes in August 2018.

[56] Consequently, even if the Court had conducted a *de novo* analysis of the evidence submitted, it would have concluded, as the Board did, that the Appellant had not met his initial burden of proving that he had used, in Canada and in the normal course of trade, the IBOX TV trademark in association with his goods and services, and was continuing to do so at the time of publication of the Respondent's application for registration.

V. Conclusion

[57] For these reasons, the Court sees no reason to vary the Board's decision, and the Appellant's appeal is dismissed.

[58] At the close of the hearing, the Court asked the parties to make brief submissions on the award of costs, which they made. The Appellant provided the Court with his draft bill of costs, in which he claimed, in the event of a successful outcome, the sum of \$5,048, including fees, taxes and disbursements. Following a similar exercise, the Respondent argued that it was entitled to costs totalling \$6,000.

[59] In the exercise of its discretion, and taking into account the small size of the Appellant's company, the Court awards the Respondent \$3,000 in costs.

JUDGMENT in T-1794-22

THIS COURT'S JUDGMENT is as follows:

1. The Appellant's appeal is dismissed.
2. Costs in the amount of \$3,000 are awarded to the Respondent.

"Jocelyne Gagné"
Associate Chief Justice

Certified true translation
Sebastian Desbarats

FEDERAL COURT
SOLICITORS OF RECORD

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