

IN THE MATTER OF AN OPPOSITION by athome.net to application No. 852,687 for the trade-mark @ INTERNET AT HOME and Design filed by Barrie Connex Inc.

On August 5, 1997, the applicant, Barrie Connex Inc., filed an application to register the trade-mark @ INTERNET AT HOME and Design for the following services: (1) Electronic data communication services and (2) Internet services. The application was based on use in Canada since July 31, 1995, on services marked as (1) and proposed use in Canada on services marked as (2). The application was advertised for opposition purposes on July 1st, 1998. The application was subsequently amended to disclaim the right to the exclusive use of the words INTERNET AT HOME apart from the trade-mark.

The opponent, athome.net, filed a statement of opposition on November 23, 1998. The grounds of opposition are as follows:

- a. Under Section 38(2)(b) of the Trade-Marks Act ("the Act"), the trade-mark is not registrable under Section 12(1)(d) of the Act because it is confusing with the trade-mark @HOME which is registered under No. 504,004 for use in association with electronic network and internetwork transmission services; cable television transmission services;
- b. Under Section 38(2)(d) of the Act, the trade-mark sought to be registered is not distinctive of the applicant because it does not distinguish nor is adapted to distinguish the services of the applicant from the services of others, and more particularly from the services of the opponent namely electronic network and internetwork transmission services with which the opponent has used and made known its trade-mark @HOME.
- c. Under the provisions of Section 38(2)(a) of the Act, application No. 852,687 does not comply with the provisions of Section 30(i) of the Act in that the applicant could not have been satisfied that it was entitled to use the trade-mark sought to be registered in Canada in view of the opponent's prior rights as set out in the foregoing paragraphs.

The applicant filed and served a counter statement on February 22, 1999, in which it generally denied the allegations asserted by the opponent in its statement of opposition. As its evidence, the opponent submitted the affidavit of Jennifer Leah Stecyk and the affidavit of Ruth

D'Souza. The affidavit of Dennis Simpson was submitted as the applicant's evidence. Only the opponent filed a written argument and an oral hearing was not conducted.

Opponent's Evidence

Ms. D'Souza identifies herself as Vice-President, Industry and Affiliate Relations of @Home Canada Inc., a joint venture owned by Rogers Cablesystems Limited ("Rogers") and Shaw Cablesystems G.P. ("Shaw"). She explains that Rogers, Shaw and Cogeco Cable Inc. ("Cogeco") (collectively, the "MSOs") are providers of internet services over the cable television infrastructure through the use of advanced network technology which enables connections that are hundreds of times faster than possible with traditional telephone modems. The MSOs have been granted a license by athome.net to use the trade-mark @HOME in Canada in association with electronic network and internetwork transmission services, cable television transmission services and related customer support and help desk services. She further states that the trade-mark @HOME is used, and has at all material times been used, by the MSOs in Canada in circumstances in which the character or quality of the @HOME services is directed and controlled by athome.net.

At paragraph 4 of her affidavit, Ms. D'Souza states that the @HOME services are currently available in B.C., Alberta, Manitoba, Ontario and Quebec. In the period since they were licensed by athome.net to use the trade-mark @HOME in Canada, the MSOs have signed up in excess of 220,000 subscribers of the @HOME services. Attached as Exhibit A to her affidavit are certain promotional/informational materials which are representative of those which have been distributed in Canada by the MSOs to customers and prospective customers of the @HOME services.

Ms. Stecyk states in her affidavit that she is a trade-mark searcher for the firm representing the opponent in this proceeding. Attached as Exhibit A to her affidavit is a certified copy of trade-mark registration no. 504,004, for the trade-mark @HOME owned by athome.net.

Ms. Stecyk states at paragraph 4 of her affidavit that she has been a subscriber of @HOME internet services provided by Rogers over the cable television infrastructure since approximately February, 1999. She asserts that she has seen the @HOME mark in promotional, informational, customer support and billing literature which she received prior to subscribing to the @HOME service and which she continues to receive from Rogers since subscribing to such services. She further maintains that the trade-mark @HOME is prominently displayed on the screen of her computer when she accesses the browser and begins to search or “surf” the internet using Rogers’ @HOME internet service. Attached as Exhibit B to her affidavit is a print out illustrating the “home” page of the @HOME browser which she downloaded and printed from Rogers’ internet web site.

Applicant’s Evidence

Mr. Simpson identifies himself in his affidavit as President of Barrie Connex Inc., the applicant company. He states at paragraph 2 of his affidavit that the applicant has been using the trade-mark @INTERNET AT HOME and Design continuously since July 31, 1995. He explains that the mark appears on a web page maintained by his company on the internet and has been featured in his company’s marketing brochures. He states that his company has approximately 10,000 subscribers to its internet services, with 7,500 of those subscribers using his company’s Internet Home Services.

Mr. Simpson states at paragraph 5 of his affidavit that his company is a small business

and he is personally aware that there has never been confusion of his trade-mark with any other trade-mark. At paragraph 6, he gives his opinion that there is sufficient distinctiveness between the mark as registered and the opposing mark.

Grounds of Opposition

The third ground of opposition is based on Section 30(i) of the Act, the opponent alleging that, as of the filing date of the present application, the applicant was aware of the opponent's trade-mark and therefore could not have been satisfied that it was the person entitled to use the trade-mark in Canada in association with the applied for services. While the legal burden is upon the applicant to show that its application complies with Section 30 of the Act there is an initial evidential burden on the opponent to establish the facts relied upon by it in support of its Section 30 ground (see **Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.**, 3 C.P.R. (3d) 325, at pp. 329-330; and **John Labatt Ltd. v. Molson Companies Ltd.**, 30 C.P.R. (3d) 293).

In the present case, the opponent alleges that the applicant could not have been satisfied that it was entitled to use the applied for trade-mark in view of the opponent's prior trade-mark rights. However, even if the applicant had been aware of the opponent's trade-mark prior to filing the present application, no evidence has been adduced to show that the applicant could not properly have been satisfied that it was entitled to use its trade-mark in Canada in association with the applied for services on the basis, *inter alia*, that its trade-mark is not confusing with the opponent's mark. Thus, the success of this ground is contingent upon a finding that the applicant's trade-mark is confusing with the opponent's trade-mark, such that the applicant's trade-mark is not registrable or not distinctive, as alleged in those grounds (see **Consumer Distributing Co. Ltd. v. Toy World Ltd.**, 30 C.P.R. (3d) 191 at 195; and **Sapodilla Co. Ltd.** v.

Bristol-Myers Co., 15 C.P.R. (2d) 152 at 155).

Both of the remaining grounds of opposition turn on the issue of confusion between the applicant's mark INTERNET AT HOME and Design and the opponent's mark @HOME, as registered and previously used and made known in Canada in association with electronic network and internetwork transmission services and cable television transmission services. The legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the material date. With respect to the ground of opposition based on s.12(1)(d) of the Act, the material date is the date of my decision (see **Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.** (1991), 37 C.P.R. (3d) 413 (F.C.A.), while the material date for assessing the non-distinctiveness ground is the date of opposition (i.e. November 23, 1998). In the circumstances of this case, nothing turns on which material date is chosen to assess the issue of confusion.

In applying the test for confusion set forth in s.6(2) of the Act, consideration is to be given to all of the surrounding circumstances, including, but not limited to, the following specifically set forth in s.6(5) of the Act: (a) the inherent distinctiveness of the trade-marks and the extent to which the trade-marks have become known; (b) the length of time the trade-marks have been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances (**Clorox Co. v. Sears Canada Inc.** (1992), 41 C.P.R. (3d) 483 (F.C.T.D.); **Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-Marks** (1996), 66 C.P.R. (3d) 308 (F.C.T.D.).

With respect to Section 6(5)(a) of the Act, neither party's mark possesses a great deal of

inherent distinctiveness. In this regard, the roof design that appears above the “@” symbol and the words INTERNET AT HOME, is almost descriptive of the applicant’s internet services which are accessible from home. Similarly, the opponent’s @HOME mark is suggestive of the opponent’s electronic network and internetwork transmission services which are also accessible from home. As for the extent to which these marks have become known, the opponent’s evidence is that its licensees have over 220,000 subscribers to its services across Canada. The applicant’s evidence, on the other hand, is that it has only 10,000 subscribers to internet services with 7,500 using the applicant company’s internet home services. This factor therefore favours the opponent.

With respect to s.6(5)(b) of the Act, Mr. Simpson’s uncontradicted evidence is that his company’s mark has been in use in Canada since 1995, while the only evidence of use of the opponent’s mark is Ms. Stecyk’s statement in her affidavit that she has been subscribing to the opponent’s services through one of the opponent’s licensees since February, 1999. While the opponent has relied on the fact that its registration for the mark @HOME was based on a declaration of use which claims that its mark has been used since November 12, 1998, it should be noted that the Board normally considers such a declaration to be nothing more than evidence of de minimus use. In any event, whichever date I consider the opponent’s mark to have been in use is of no consequence to this issue as the applicant’s mark has been in use for a longer period of time.

As for Section 6(5)(c) of the Act, the applicant’s @INTERNET AT HOME service is described on the web page of the applicant company as follows:

Internet At Home was created to provide the kind of Internet connectivity services that individuals require. The Internet At Home service is a very simple, straightforward service. It is a flat rate service, meaning there are no hourly charges ever. As a basic service, it offers full IP connectivity via PPP, and includes a

mailbox for email on our servers. It does include web publishing and is designed for the home user, who wants e-mail, news, gopher, web, etc. access, but is looking to consume services, not provide them.”

The opponent’s services, on the other hand, are provided over the cable television infrastructure through the use of advanced network technology which, according to Ms. D’Souza, enables connections that are hundreds of times faster than possible with traditional telephone modems. Given that both parties provide internet services at home, the parties’ services are similar, although the manner in which the services are currently provided are different. However, as the applicant’s statement of services is not restricted in this fashion, I must conclude that the trades could overlap: see the decisions in **Mr. Submarine Ltd. v. Amandista Investments Ltd.** (1987), 19 C.P.R. (3d) 3 at 10-11 (F.C.A.), and **Henkel Kommanditgesellschaft v. Super Dragon** (1986), 12 C.P.R. (3d) 110 at 112 (F.C.A.).

With respect to Section 6(5)(e) of the Act, although the marks do not bear a high degree of visual resemblance, I consider them to be very similar when sounded and in ideas suggested. In this regard, I agree with the opponent that the applicant’s services would be identified aurally by the average consumer as “INTERNET AT HOME” while the opponent’s mark would be sounded as “AT HOME”. With respect to ideas suggested, the applicant’s mark clearly depicts the idea of internet services at home while the opponent’s mark also suggests the idea of some type of computer technology at home.

As a further surrounding circumstance, I have considered Mr. Simpson’s testimony that he is aware that there has never been confusion of his company’s trade-mark with any other trade-mark. However, given that the opponent did not commence use of its mark until November, 1998, at the earliest, and in view of the relatively limited number of subscribers to the applicant’s home internet services, I do not consider the absence of evidence of instances of actual confusion to be a particularly relevant circumstance in this proceeding.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. I have also considered that the applicable standard of proof is the balance of probabilities. In view of my conclusions above, and even bearing in mind the lack of inherent distinctiveness of the marks at issue, and the low degree of visual resemblance between the marks at issue, I consider the probabilities in the present case to be equal in view of the extent to which the opponent's mark has become known in Canada and the resemblance between the marks in sound and ideas suggested. When the probabilities are equal, the applicant has not discharged the legal burden upon it with respect to the issue of confusion. The remaining grounds of opposition are therefore successful.

Accordingly, and with the authority delegated to me under s. 63(3) of the Act, I refuse the applicant's application pursuant to s.38(8) of the Act.

DATED AT HULL, QUEBEC, THIS 10th DAY OF September, 2002.

C. R. Folz
Member,
Trade-Marks Opposition Board