

**IN THE MATTER OF AN OPPOSITION  
by WebEx Communications, Inc. to application  
no. 1217815 for the trade-mark IWEBX.COM  
filed by Iwebx Inc.**

-----

THE RECORD

[1] On May 25, 2004, Iwebx Inc. filed an application to register the trade-mark IWEBX.COM based on use of the mark since June 7, 2003 in association with

*wares*  
software for editing and managing the content of web pages,

*services*  
creating, installing and selling of software; computer  
programming services.

The application disclaims the exclusive right to the use of the term .COM apart from the mark as a whole. The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated May 11, 2005 and was opposed by WebEx Communications, Inc. on October 11, 2005. The Registrar forwarded a copy of the statement of opposition to the applicant on December 7, 2005 as required by s. 38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition. I note in passing that the counter statement also consists of submissions appropriate for the written argument stage.

[2] The opponent's evidence consists of the affidavit of David Farrington and certified copies of the opponent's three trade-mark registrations for WEBEX, covering the following wares and services:

TMA569,008

*services*

computer services, namely, web-based multi-media teleconferencing and telecommunication services which enable real-time sharing of documents and software applications through a global computer network.

TMA514,109

*wares*

computer software for use in conjunction with software for browsing of a global computer network to control and automate the browser software.

TMA583,338

*wares*

computer software to facilitate the electronic transmission of information, data, documents and images over a global computer information network.

*services*

telecommunication services namely, transmission of information, data, documents, images and software applications via a global computer information network; and web-based multimedia teleconferencing services.

The applicant's evidence consists of the solemn declaration of Tamara Scullion. Only the opponent filed a written argument, however, both parties were represented at an oral hearing held on March 9, 2010. The opponent was represented by counsel while Ms. Scullion appeared for the applicant.

#### STATEMENT OF OPPOSITION

[3] The first ground of opposition alleges that the application contravenes s. 30(i) of the *Trade-marks Act* because the applicant "could not have been unaware of the opponent's prior rights in and to the WEBEX trade-mark." The opponent further alleges that the applicant seeks to take advantage of the opponent's reputation in the mark WEBEX.

[4] The second ground, pursuant to s. 12(1)(d) of the *Act*, alleges that the applied for mark IWEBX.COM is unregistrable because it is confusing with the opponent's above mentioned

registered marks.

[5] The third ground, pursuant to s. 16(1), alleges that the applicant is not entitled to registration because, at the claimed date of first (June 7, 2003) and at the filing date (May 25, 2004), the applied for mark IWEBX.COM was confusing with the opponent's business name WebEx Communications, Inc. and with the opponent's mark WEBEX.

[6] The fourth and final ground, pursuant to s. 2, alleges that the applied for mark IWEBX.COM does not distinguish the applicant's wares and services from those of the opponent in view of the opponent's prior use of its trade-mark WEBEX and trade-name WebEx Communications, Inc.

#### OPPONENT'S EVIDENCE

*David Farrington*

[7] Mr. Farrington identifies himself as General Counsel for the opponent company. The opponent is based in Santa Clara, California and has customers in countries around the world including Canada. The opponent was founded in 1996 and has since become a leader in online meeting applications, with 64% of the market share. The opponent's software and services enable customers to engage in web based teleconferencing with the benefits of full motion video and integrated audio. Products and services are available through the opponent's website, however, customers are not required or expected to have any technical know how or computer programming skills. The opponent began to offer its wares and services under the trade-mark WEBEX in Canada in 1999. Between January and October of 2006, the opponent served about 900 Canadian customers. The opponent's clients are involved in a number of industries and typically use the opponent's services on a periodic and ongoing basis. In particular, the opponent identifies thirteen Canadian customers that are involved in the real estate field. Canadians are exposed to the opponent's mark WEBEX on each page of the opponent's website and on marketing and promotional materials distributed to potential and current customers. Sales of WEBEX products and services in Canada amounted to \$600,000 US in the year 2000 steadily

increasing to about \$11.5 million US in the year 2006. Total sales in Canada to November 2006 totalled about \$26.5 million US.

#### APPLICANT'S EVIDENCE

*Tamara Scullion*

[8] Ms. Scullion does not identify her position with the applicant company, however, she appears to be the directing mind of the applicant and its sole service provider. The applicant is a web-based website design company and content management system provider. More specifically, the applicant company designs computer programs that allow real estate agents and small business owners, who do not have knowledge of computer programming, to edit the content of their own web pages. The applicant has offered services on the Internet under its mark IWEBX.COM since 2003. The applicant does not offer any products or services related to web meetings or web based communications services. Ms. Scullion notes, at paragraph 24 of her affidavit, that many companies offering wares and services on the Internet “use the combinations of the words I WEB X in their names. Webex [the opponent] does not use I or .COM.” The applicant conducts its business on the Internet at the address iWebx.com. Ms. Scullion notes that two other registered trade-marks namely, WEBXREP.COM and XWEB are used in association with Internet related products and services. I note in passing that Ms. Scullion’s evidence also consists of submissions appropriate for the written argument stage.

#### LEGAL ONUS AND EVIDENTIAL BURDEN

[9] The legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition. The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant. However, there is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298. The presence of an evidential burden on the opponent with respect to a particular issue means that in

order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

#### SECTION 30(I) GROUND OF OPPOSITION

[10] The first ground of opposition is based on Section 30(i) of the *Trade-marks Act*, the opponent alleging that the applicant could not have been satisfied that it was entitled to use the trade-mark IWEBX.COM in Canada (in association with the wares and services covered in the present application) having regard to the opponent's use of its mark WEBEX.

[11] No evidence has been filed by the opponent in support of its allegation that the applicant could not have been satisfied that it was entitled to use the trade-mark IWEBX.COM in Canada. The opponent has therefore failed to meet its evidential burden to put the first ground into issue. Even if the evidence had shown that the applicant had been aware of the opponent's trade-mark prior to filing the present application, such a fact is not inconsistent with the statement in the application that the applicant was satisfied that it was entitled to use the trade-mark IWEBX.COM on the basis *inter alia* that its mark is not confusing with the opponent's trade-mark. Thus, the success of the first ground is in any event contingent on a finding that the trade-marks in issue are confusing: 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.

#### MAIN ISSUE & MATERIAL DATES

[12] The main issue with respect to the remaining grounds of opposition is whether the applied for mark IWEBX.COM is confusing with the opponent's mark WEBEX. The material dates to assess the issue of confusion are (i) the date of decision, with respect to the ground of opposition alleging non-registrability: see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A.); (ii) the claimed date of first use of the mark, in this case June 7, 2003, with respect to the ground of opposition alleging non-entitlement: see s.16(1)(a) of the *Trade-marks Act*; (iii) the date of opposition, in this case, October 11, 2005, in

respect of the ground alleging non-distinctiveness: see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and *Clarco Communications Ltd. v. Sassy Publishers Inc.* (1994), 54 C.P.R.(3d) 418 (F.C.T.D.). In the circumstances of the instant case, nothing turns on whether the issue of confusion is assessed at a particular material date.

[13] The legal onus on the applicant is to show that there would be no reasonable likelihood of confusion, within the meaning of s.6(2) of the *Act*, shown below, between the applied for mark IWEBX.COM and the opponent's mark WEBEX:

The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured . . . or performed by the same person, whether or not the wares or services are of the same general class.

#### *Test for Confusion*

[14] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in s. 6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

#### *Consideration of Section 6(5) Factors*

[15] The opponent's mark WEBEX is a coined word and possesses some degree of inherent distinctiveness. However, the dominant component of the mark is the term WEB, and therefore the inherent distinctiveness of the mark is diminished to the extent that the mark WEBEX suggests services which are related to the Internet. Of course, the opponent's wares and services

are in fact sourced from the Internet and are provided to customers over the Internet as well. Thus, the inherent distinctiveness of the opponent's mark, in relation to the wares and services offered by the opponent, is relatively low. Similarly, the inherent distinctiveness of the applied for mark IWEBX.COM is relatively low. The opponent's mark WEBEX had acquired some distinctiveness by the earliest material date (June 7, 2003) through use and promotion of its mark beginning in 1999. The opponent's mark continued to acquire additional reputation through to the later material dates. On the other hand, the applied for mark IWEBX.COM cannot claim any reputation at the earliest material date. Further, the applicant's evidence is too incomplete for me to assign any more than a minimal reputation to the applied for mark IWEBX.COM at the later material dates. Thus, the acquired distinctiveness of the marks in issue favours the opponent. The length of time that the marks in issue have been in use also favours the opponent, to some extent, as use of the mark WEBEX commenced about three and a half years before the applicant began to use its mark IWEBX.COM.

[16] The nature of the parties' wares and services are different as the applicant focuses essentially on web page design while the opponent focuses on web based teleconferencing. The difference in the parties' wares and services favours the applicant, however, s.6(2) the *Act* stipulates that the issue of confusion must be considered whether or not the parties' wares and services are of the same general class: see para. [13] above. The wares and services of both parties are accessed over the Internet and both parties are involved in offering services directly related to business conducted on the Internet. This overlap in the nature of the parties' trades favours the opponent to some extent.

[17] Lastly, with respect to the resemblance between the marks IWEBX.COM and WEBEX in appearance, sound and ideas suggested, in my view the parties' marks are more alike than they are different owing to the term WEB which is the dominant component of each mark. In this regard, the prefix I in the applied for mark is readily recognised as a reference to oneself, while the suffix COM is readily recognised as a domain identifier for Internet addresses. In other words, the components I and COM do little to differentiate the applied for mark IWEBX.COM

from the opponent's mark WEBEX. Further, the applied for mark incorporates the whole of the opponent's mark when sounded (as "web-x") and the parties' marks suggest the same idea, that is, the world-wide web. Thus, the resemblance between the marks in issue favours the opponent.

#### DISPOSITION

[18] In view of the foregoing and pursuant to the authority delegated to me under s.63(3) of the *Act*, I find that the applicant has not established, on a balance of probabilities, that there is no reasonable likelihood of confusion between its mark IWEBX.COM and the opponent's mark WEBEX at any of the material dates. Accordingly, the subject application must be refused.

[19] I would reiterate that Ms. Scullion stated in her affidavit that many companies who offer services over the Internet include the components I, WEB and X as part of their company name. Had more detailed and comprehensive information been provided regarding use of the component WEB in company names, and the services that were being offered, then it is possible that I might have concluded that the acquired distinctiveness of the opponent's mark WEBEX was effectively negated by widespread use of the component WEB. In such case, the outcome of this opposition might have favoured the applicant. Further, had the applicant evidenced (for example, by a search of the trade-marks register) numerous trade-marks comprised of the component WEB used in association with Internet based wares and services, then the outcome of this opposition might similarly have favoured the applicant.

[20] I would also mention that during the course of the oral hearing it became apparent that Ms. Scullion had intended to amend the wares and services but was under the mistaken belief that the opponent's consent was required to do so. As a matter of procedure, I advised Ms. Scullion that an applicant may unilaterally amend an application. Ms. Scullion then proposed the following amendments:

*amended wares*

proprietary software for uploading and managing property listings  
on web pages, domain names, computer server space and web sites

*amended services*



off-line and on-line retail services namely, web site design services for others, domain name registration services for others, installation of content management software specifically for managing the content of web pages and hosting of web sites.

[21] In my view the proposed amendments constituted a re-statement of the wares and services rather than merely a narrowing of the wares and services as contemplated by r.32(e) of the *Trade-marks Regulations* SOR/96-195. For that reason I refused to accept the proposed amendments. In any event, even if the proposed amendments had been accepted, it is doubtful that the disposition of the opposition would have changed. In this respect, as alluded to in para. [19] above, the evidence filed by the opponent is generally more supportive of its case than the applicant's evidence is supportive of the applicant's case.

[22] The subject application is refused.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 24th DAY OF MARCH, 2010.

Myer Herzig,  
Member,  
Trade-marks Opposition Board