



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2011 TMOB 127
Date of Decision: 2011-07-27

**IN THE MATTER OF AN OPPOSITION
by Ogopogo Media Inc. to application
No. 1,307,870 for the trade-mark
BCJOBS.CA & Design in the name of
B.C. Jobs Online Inc.**

[1] On July 4, 2006, B.C. Jobs Online Inc. (the Applicant) filed an application to register the trade-mark BCJOBS.CA & Design (the Mark), shown below, based on use of the Mark by the Applicant and its predecessor-in-title in Canada since at least as early as February 2001 in association with providing information regarding careers and employment by way of a web-site on the Internet; provision of employment related electronic advertising services for others by way of an Internet web-site (the Services). The Applicant has disclaimed the right to the exclusive use of BC, JOBS and .CA apart from the Mark.



[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 22, 2007.

[3] On January 22, 2008, Ogopogo Media Inc. (the Opponent) filed a statement of opposition. The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[4] In support of its opposition, the Opponent filed an affidavit of Shaun Pilford. In support of its application, the Applicant filed an affidavit of Dulce Campos. No cross-examinations were conducted.

[5] Only the Applicant filed a written argument. No oral hearing was conducted.

Summary of Grounds of Opposition and Applicable Material Dates

[6] The Opponent's statement of opposition includes the grounds summarized below:

- (a) contrary to s. 30(a) of the *Trade-marks Act*, R.S.C. 1985, ch. T-13 (the Act), the application does not contain a statement in ordinary commercial terms of the specific services in association with which the Mark has been or is proposed to be used;
- (b) contrary to s. 30(b) of the Act, at the filing date of the application, the Applicant had not used the Mark in Canada or had subsequently abandoned the Mark;
- (c) contrary to s. 30(i) of the Act, at the filing date of the application, the Applicant could not have been properly satisfied that it was entitled to use the Mark in Canada because the Mark is confusingly similar with the trade-mark, trade name and domain name JOBS.ca in which the Opponent and/or its predecessor-in-title has prior rights;
- (d) contrary to s. 12(1)(b) of the Act, the Mark is not registrable because the words that make up the Mark are clearly descriptive or deceptively misdescriptive;
- (e) contrary to s. 16(1)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because, at the date on which the Applicant allegedly first used the Mark, it was confusing with the trade-mark and domain name JOBS.ca previously used or made known by the Opponent and/or its predecessor-in-title;
- (f) contrary to s. 16(1)(c) of the Act, the Applicant is not the person entitled to registration of the Mark because, at the date on which the Applicant allegedly

first used the Mark, it was confusing with the trade name and domain name JOBS.ca previously used or made known by the Opponent and/or its predecessor-in-title;

(g) contrary to s. 2 of the Act, the Mark is not distinctive of the Applicant because it is virtually identical to the Opponent's trade-mark, trade name and domain name CARTRADER.ca.

[7] The material dates with respect to the grounds of opposition are as follows:

- s. 38(2)(a)/30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];

- s. 38(2)(b)/ 12(b) - the filing date of the application [see *Fiesta Barbeques Ltd. v. General Housewares Corp.* (2003), 28 C.P.R. (4th) 60 at para. 26 (F.C.)];

- s. 38(2)(c)/16(1)(a) and 16(1)(c) – the date of first use alleged in the application [see s. 16(1) of the Act];

- s. 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 at para. 8 (F.C.)].

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[8] The Applicant bears the legal onus of establishing, on a balance of probabilities that its application complies with the requirements of the Act. However, 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 support each ground of opposition [see *John Labatt Ltd. v. Molson Companies Ltd.*, (1990) 30 C.P.R. (3d) 293 (F.C.T.D.)].

Section 30 Grounds of Opposition

[9] The Opponent has pleaded that the application is contrary to s. 30(a), 30(b) and 30(i) of the Act.

[10] There is no evidence that supports the grounds of opposition based on s. 30(a) and 30(b) of the Act. Consequently these grounds are dismissed on the basis that the Opponent has not satisfied its initial burden.

[11] The s. 30(i) ground alleges that the Applicant could not have been properly satisfied that it was entitled to use the trade-mark in Canada in association with the Services because the Mark is confusingly similar with the trade-mark, trade name and domain name JOBS.ca. Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. As the application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, the s. 30(i) ground is dismissed.

Section 12(1)(b)

[12] The Opponent has pleaded that the Mark is not registrable pursuant to s. 12(1)(b) and alleges:

The Mark is composed of the three words “BC”, “JOBS”, and “.CA”, all of which have been disclaimed apart from the Mark by the Applicant as clear recognition that such words are not inherently registrable. As such and as a matter of first impression, the Mark is clearly descriptive when considered in its totality and in association with the statement of services.

[13] I find that this allegation is sufficient to meet the Opponent’s burden since the Applicant’s disclaimers may constitute an admission that the components BC, JOBS, and .CA are clearly descriptive of the Services [see *Insurance Co. of Prince Edward Island v. Prince Edward Island Mutual Insurance Co.* (1999), 2 C.P.R. (4th) 103 (T.M.O.B.) at para. 6].

[14] The issue as to whether the Mark is clearly descriptive or deceptively misdescriptive of the character or quality of the Services must be considered from the point of view of the average purchaser of those services. Further, “character” means a feature, trait or characteristic of the services and “clearly” means “easy to understand, self-evident or plain” [see *Drackett Co. of Canada Ltd v. American Home Products Corp.* (1968), 55 C.P.R. 29 at 34]. The Mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Registrar of Trade-marks* (1978), 40 C.P.R. (2d) 25 (F.C.T.D.) at 27-8; *Atlantic Promotions Inc. v. Registrar of Trade-marks* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.) at 186]. Finally, the purpose of the prohibition in s. 12(1)(b) of the Act is to prevent any single trader from monopolizing a term that

is clearly descriptive or common to the trade, thereby placing legitimate traders at a disadvantage [see *Canadian Parking Equipment Ltd. v. Canada (Registrar of Trade-marks)* (1990), 34 C.P.R. (3d) 154 (F.C.T.D.) at para. 15].

[15] Where a mark is a created word one can consider the dictionary meanings of its components [see *Oshawa Group Ltd. v. Canada (Registrar of Trade-marks)* (1980), 46 C.P.R. (2d) 145 (F.C.T.D.) at 149]. I am entitled to take judicial notice of dictionary definitions [see *Yahoo! Inc. v. audible.ca inc.* (2009), 76 C.P.R. (4th) 222 (T.M.O.B.) at para. 16]. The first edition of the Oxford Canadian Dictionary (Toronto: Oxford University Press, 1998) includes the following definitions:

BC	<i>abbr.</i> British Columbia
BC	<i>abbr.</i> (of a date before) Christ.
job	<i>n. & v. • n.</i> 1 a piece of work, esp. one done for hire or profit. 2 a paid position of employment. 3 a anything one has to do. b responsibility (<i>it's your job to do the dishes</i>). c a specified operation or other matter, esp. an operation involving plastic surgery (<i>a nose job; a paint job</i>). 4 a <i>informal</i> a difficult task (<i>had a job to find them</i>). b performance; carrying out of a task (<i>did a poor job on the exam</i>). 5 <i>slang</i> an example of its type (<i>that car's a neat little job</i>). 6 <i>Computing</i> an item of work regarded separately. 7 <i>slang</i> a crime, esp. a robbery. 8 a transaction in which private advantage prevails over duty or public interest. 9 <i>informal</i> a state of affairs or set of circumstances (<i>is a bad job</i>).

[16] Finally, I am also entitled to take judicial notice of the fact that .ca is recognized as the country code designating Canada [see CIPO Practice Notice, *Descriptiveness and Terms Such as .com, .ca, .fr, .uk & .us* (September 1, 1999) and *London Drugs Ltd. v. Purepharm Inc.* (2006), 54 C.P.R. (4th) 87 (T.M.O.B.) at 92].

[17] The evidence of the Applicant's affiant, Ms. Dulce Campos, a trade-marks researcher and assistant employed by the Applicant's agent, includes a search of the Canadian Trade-marks Register for marks including the components "job" or "jobs" and ".com" or ".ca". The Applicant argues that the descriptive term "Jobs.ca" and its phonetic equivalents have previously been considered registrable. This evidence does not assist the Applicant since state of the Register evidence is generally irrelevant to establish that, because registrations for similar marks were

granted previously, one more should not be refused [see *Thomas J. Lipton Ltd. v. Salada Foods Ltd.* (No. 3) (1979), 45 C.P.R. (2d) 157 at 163].

[18] In the present case, I find on a balance of probabilities that, as a matter of first impression and common sense, as of July 4, 2006, the ordinary consumer would consider the Mark to be clearly descriptive of an intrinsic characteristic of the Services. Specifically, that the Mark indicates that the Applicant's web-site provides information about jobs available in British Columbia and that the advertising services are available on a web-site providing information about jobs in British Columbia. I also consider that other traders might wish to use "BC jobs" or "BCjobs" to describe their own services providing career and employment information and advertising services by way of a web-site.

[19] Having found that BCJOBS.CA, when sounded, is clearly descriptive of the Services, the question is whether the Mark is still registrable in view of the design components [see *Best Canadian Motor Inns Ltd. v. Best Western International, Inc.* (2002), 23 C.P.R. (4th) 110 (T.M.O.B.) aff'd (2004), 30 C.P.R. (4th) 481 (F.C.)]. The design components of the Mark include (i) two stylized human figures consisting of a circle and a half circle appearing before BCJOBS.CA; (ii) the acronym BC in a dark shade of grey; and (iii) the component JOBS.CA in smaller font and a lighter shade of grey. The stylized human figures element is similar in size to BC and is shaded so that one figure is the same shade as BC and the other is the same shade as JOBS.CA.

[20] Given the relative size, shading and lack of prominence of the human figures design element, BCJOBS.CA is the dominant portion of the Mark. Applying the clearly descriptive test as set out in *Best Canadian Motor Inns op. cit.*, I find that the Mark as a whole, and as a matter of immediate impression, is clearly descriptive, when sounded, of the Services in Canada. If the Applicant's Services do not feature jobs in British Columbia, then the Mark would be unregistrable on the basis that it is deceptively misdescriptive. This ground of opposition is therefore successful.

Section 16(1)(a) and 16(1)(c) Grounds

[21] The Opponent has pleaded that the Applicant is not the person entitled to registration because the Mark is confusing with the Opponent's trade-mark, trade name and domain name JOBS.ca pursuant to s. 16(1)(a) and 16(1)(c) of the Act. I note that these sections do not preclude the registration of a trade-mark which is confusingly similar with a domain name. As such, I will only be considering the use of JOBS.CA as a trade-mark and/or a trade name and will not be considering the use of the *jobs.ca* domain name.

[22] In order to consider grounds of opposition based on s. 16(1)(a) and 16(1)(c) of the Act, the Opponent has an initial evidential burden to prove that its JOBS.ca trade-mark [s. 16(1)(a)] or its JOBS.ca trade name [s. 16(1)(c)] had been used or made known in Canada prior to the claimed date of first use of the Mark, February, 2001, in Canada by the Opponent or its predecessor-in-title. The Opponent will also have to demonstrate that it had not abandoned the JOBS.ca trade-mark or trade name at the date of advertisement of the Mark.

[23] The evidence of the Opponent's affiant, Mr. Shaun Pilfold, President and Co-Founder of the Opponent, provides the following:

- (a) A Purchase and Transfer Agreement between Domed Technologies Inc. (Domed Technologies) and the Opponent assigning Domed Technologies' "right, title, and interest in and to the Domain Name including all the goodwill and reputation associated with the Domain Name" to the Opponent (Pilfold Affidavit, Exhibit D).
- (b) A copy of a print-out of the *jobs.ca* web-site dated October 9, 1999 obtained from the Internet Archive Way Back Machine (*www.archive.org*) which states that "TEAM Jobs.ca is working over zealously to bring you the job-site you have been waiting for" and asking consumers "to expedite this processing by sending us your CV". The print-out also states that "something big is going to hit Canada soon and TEAM Jobs.ca will be launching it" (Pilfold Affidavit, Exhibit F). However, there is no use of the JOBS.ca trade-mark or trade name

on this print-out. There are however two “X” designs about which Mr. Pilfold states at para. 9 of his Affidavit:

To the best of my knowledge and based on information available to me, which I verily believe to be true, there was a graphics or picture file on the top left corner of Exhibit “F” which currently displays an ‘x’ in a box, and such graphics or picture file depicted and prominently displayed the Domain Name JOBS.ca as a trade-mark, trade-name or domain name.

It was established in *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.) that statements made in an affidavit based on information and belief are prima facie inadmissible hearsay evidence unless they satisfy the criteria of necessity and reliability as set out in *R. v. Khan*, [1990] 2 S.C.R. 531. As Mr. Pilfold’s statement is ambiguous as to what is in his personal knowledge and he has not provided the grounds for such a belief, nor why it is necessary that he provide this information, I have disregarded this paragraph of the Affidavit [see *Trade-mark Reflections Ltd. v. Morgan Crucible Co. plc* (1997), 78 C.P.R. (3d) 519 at para. 11 (T.M.O.B.)].

- (c) A copy of a print-out of the *jobs.ca* web-site dated March 1, 2000 obtained from the Internet Archive Way Back Machine which includes the JOBS.ca trade-mark and the following copyright notice “Copyright © 1999 Jobs.ca, Inc.” (Pilfold Affidavit, Exhibit G). Jobs.ca, Inc. is the only entity referenced on the print-out. Without further information regarding Jobs.ca, Inc., I cannot conclude that the use of the JOBS.ca trade-mark on this page accrues to the Opponent’s predecessor-in-title Domed Technologies.

[24] The evidence before me does not allow me to conclude that use of the JOBS.ca trade-mark and/or trade name at or before the material date accrues to the Opponent or its predecessor-in-title. As such, the Opponent has not met its burden with respect to the s. 16(1)(a) and 16(1)(c) grounds of opposition which are therefore dismissed.

Distinctiveness Ground of Opposition

[25] The Opponent pleaded that the Mark is not distinctive because the Mark is virtually identical to the Opponent's trade-mark, trade name and domain name CARTRADER.ca. This ground of opposition is set out below:

The Mark applied for is not distinctive, having regard to the provision of Sections 38(2)(d) and 2 of the Trade-marks Act, because it is not capable of distinguishing the Applicant's wares or services from the wares or services of others, particularly the Opponent's, nor is it adapted to so distinguish them. Because the Mark is virtually identical to the Opponent's trade-mark, trade name and domain name CARTRADER.ca which the Opponent has been using and continuously using in Canada since at least as early as November 2002 and prior to the filing date of the Application, the Mark lacks the distinctive quality required to set apart the wares and services of the Applicant from those of other producers of similar wares and services, namely the Opponent. The Mark is incapable of indicating the Applicant as the source of its wares and services and the Mark fails to distinguish the Applicant's wares and services from the Opponent's services.

[26] It appears to me that the reliance on the use of CARTRADER.ca may be an error. The Applicant drew the Opponent's attention to this pleading in its Written Argument served on the Opponent on May 6, 2010 at para. 15:

Finally, the Opponent alleges in its statement of opposition under sections 38(2)(d) and Section 2 ground of opposition alleging that the Applicant's trade-mark does not distinguish it and is not adapted to distinguish the services of the Applicant from the services of others, specifically those of the Opponent, given the Opponent's alleged prior use in Canada of its alleged domain name, trade-name and trade-mark "CARTRADER.CA" since at least "November, 2002". The Applicant points out that this ground of opposition has been plead incorrectly and as such should be rejected as a whole and not a part of these proceedings.

[27] In view of the fact that the Applicant has raised the issue that this ground of opposition may have been pleaded incorrectly, if the Opponent had intended to rely on the use of the JOBS.ca trade-mark, trade name and domain name it should have requested leave to amend this ground of opposition. It is the Opponent's responsibility to ensure that each ground of opposition is properly pleaded [see *Procter & Gamble Inc. v. Colgate-Palmolive Canada Inc.* (2010), 81 C.P.R. (4th) 343 at para. 47 (F.C.)]. As the Opponent has not requested leave, I must assess this ground of opposition as drafted. As there is no evidence of prior use of the

CARTRADER.CA trade-mark, trade name or domain name, the Opponent has not met its initial burden and I am dismissing this ground of opposition.

Disposition

[28] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office