

**IN THE MATTER OF AN OPPOSITION by  
Yahoo! Inc. to application No. 1231591 for the  
trade-mark audible.ca filed by audible.ca inc.**

On September 27, 2004, audible.ca inc. (the “Applicant”) filed an application to register the trade-mark audible.ca (the “Mark”).

The application was based upon proposed use of the Mark in Canada in association with the following wares and services:

wares

computers, mobile telephones, remote media players, communication devices capable of connecting to the Internet, and mobile, portable playback players, including, but not limited to, personal digital assistants, compressed digitised audio players, portable media players or any device capable of playing or displaying recorded information and/or content, that receives and/or stores and/or plays digitally coded audio recordings, and for computer software that enables the transmission, storage and payback or display of data and/or audio on devices such as computers, mobile telephones, remote media players, Internet-connected devices, and mobile, portable playback players, including, but not limited to, personal digital assistants, compressed digitised audio players, portable media players or any device capable of playing or displaying recorded information and/or content

services

licensing of musical works, literary works, broadcast programs, news, commentary, and a wide variety of information sources from electronic storage to computers, mobile telephones, remote media players, Internet-connected devices, and mobile, portable playback players, including, but not limited to, personal digital assistants, compressed digitised audio players, portable media players or any device capable of playing or displaying recorded information and/or content, and distributorship services in the field of musical works, literary works, broadcast programs, news, commentary, and a wide variety of information sources from electronic storage to computers, mobile telephones, remote media players, Internet-connected devices, and mobile, portable playback players, including, but not limited to, personal digital assistants, compressed digitised audio players, portable media players or any device capable of playing or displaying recorded information and/or content.

The application was also based upon use of the Mark in Canada since August 29, 2004 in association with the following services:

services

providing a web site located at the address audible.ca and developing capabilities to feature entertainment in the nature of audio copies of musical works, literary works, broadcast

programs, and a wide variety of original audio content, and other audio information sources, with said web site also including features which permit the sampling, distribution and licensing of said audio copies from an online interactive menu which may be downloaded from electronic storage to personal computers and media players, mobile telephones, remote media players, Internet-connected devices and mobile, portable playback players, including, but not limited to personal digital assistants, compressed digitized audio players, portable media players or any device capable of playing or displaying recorded information and/or content.

The Applicant disclaimed the right to the exclusive use of .CA apart from the trade-mark.

The application was advertised for opposition purposes in the Trade-marks Journal of August 9, 2006. On October 10, 2006, Yahoo! Inc. (the “Opponent”) filed a statement of opposition.

The Applicant filed and served a counter statement in which it denied the Opponent’s allegations.

The Opponent filed the affidavits of Molly Bragg and Aaron Edgar in support of its opposition.

The Applicant chose to not file any evidence in support of its application. It also did not seek to cross-examine the Opponent’s affiants.

By letter dated August 10, 2007, the Applicant deleted the use-based services from its application.

Each party filed a written argument. An oral hearing was not requested.

### Onus

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (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 to support each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

### Section 30(b) Ground of Opposition

This ground of opposition is now moot as it relates solely to the claims of use set out in the application, which have now been removed.

### Section 12(1)(b) Ground of Opposition

The Opponent has pleaded that the Mark is not registrable pursuant to s. 12(1)(b) because it is (i) clearly descriptive or deceptively misdescriptive of a character of the associated wares and services or (ii) it is clearly descriptive or deceptively misdescriptive of a character of the associated wares and services and of the place of origin of the wares and services.

The issue as to whether the Applicant's Mark is clearly descriptive must be considered from the point of view of the average purchaser of the associated wares/services. Furthermore, 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*, 40 C.P.R. (2d) 25 (F.C.T.D.) at 27-8; *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183 (F.C.T.D.) at 186]. Character means a feature, trait or characteristic of the product and "clearly" means "easy to understand, self-evident or plain" [*Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 (Ex. Ct.) at 34].

The material date that applies to this ground of opposition is the filing date of the application, September 27, 2004 [see *Shell Canada Limited v. P.T. Sari Incofood Corporation* (2005), 41 C.P.R. (4th) 250 (F.C.T.D.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)].

As set out in the Opponent's written argument, the evidence that it filed was directed solely to its s. 30(b) ground of opposition. Accordingly, no evidence was filed in support of the present ground. However, I am entitled to take judicial notice of dictionary definitions [*Envirodrive Inc. v. 836442 Canada Inc.* 2005 ABQB 446] and the second edition of the Paperback Oxford

Canadian Dictionary defines audible as “● *adj.* capable of being heard. ● *n.* *Football* a play called by the quarterback at the line of scrimmage to replace one previously agreed on.” I also note that in its written argument the Opponent provided two dictionary definitions for “audible”, which it obtained online at dictionary.com, namely, “heard or capable of being heard” and “capable of being heard; loud enough to be heard; actually heard.”

Based on the definition of “audible”, it could reasonably be concluded that such word is clearly descriptive of a feature or characteristic of the Applicant’s wares. To the extent that any of the wares do not encompass an audible function, then it could reasonably be concluded that “audible” deceptively misdescribes them. The same logic appears to apply to the services since they seem to relate primarily to the licensing and distribution of audible works.

Regarding the “.ca” component of the Mark, the Opponent has made the following submissions in its written argument:

- the Applicant disclaimed the right to the exclusive use of .ca, which the Opponent submits is equivalent to an admission by the Applicant that .ca is either clearly descriptive or is common to the trade;
- the Trade-marks Opposition Board has previously taken judicial notice that “.ca” is recognized as the country code designating Canada [*London Drugs Ltd. v. Purepharm Inc.* (2006), 54 C.P.R. (4th) 87 at 92];
- top-level domain name codes, such as “.com” and “.ca” are not sufficient to distinguish a trade-mark that is otherwise clearly descriptive [*Candrug Health Solutions Inc. v. Thorkelson*, 2007 FC 411 at para. 40];
- the Trade-marks Opposition Board has previously taken the position that “.ca” was not sufficiently distinctive to render registrable an otherwise clearly descriptive trade-mark [*London Drugs, supra*, at 101-102].

I will add that the 1999-09-01 Trade-mark Practice Notice entitled “Descriptiveness and Terms Such as .com, .ca, .fr, .uk & .us” supports the Opponent’s view that the addition of .ca to a clearly descriptive word does not make the combination registrable.

The Applicant has submitted in its written argument that the Opponent has not met its initial burden with respect to the s. 12(1)(b) ground of opposition because it did not file any evidence directed to this ground. However, such argument overlooks the fact that dictionary definitions need not be introduced as evidence.

The Applicant has made no submissions directed to the substantive issue of whether its Mark is unregistrable under s. 12(1)(b), choosing instead to simply submit that such ground should be dismissed on the basis that the Opponent did not meet its evidential burden. As I find that the evidential burden has been met, I also find that the Applicant has done nothing to meet its legal burden. The s. 12(1)(b) ground therefore succeeds.

#### Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 1st DAY OF MAY 2009.

Jill W. Bradbury  
Member  
Trade-marks Opposition Board