

**IN THE MATTER OF AN OPPOSITION
by InterServe, Inc. to application No. 1,062,944
for the trade-mark WEBNAMES filed by UBC
Research Enterprises Inc. and subsequently
assigned to Webnames.ca Inc.**

On June 12, 2000, UBC Research Enterprises Inc. filed an application to register the trade-mark WEBNAMES based on use in Canada since June 5, 2000 with the services of “domain name development and registration” and on proposed use in Canada with the following services:

- (1) Internet access provider services;
- (2) providing telecommunication network connectivity; integrating telecommunications hardware and network operating systems; providing access to high-speed fibre-optic telecommunications networks;
- (3) providing the production and design of electronic media and multimedia services, namely web site hosting, creation of web sites, web page design, web page content development, design and management services; computer software development, design and installation; computer technical support services; electronic mail and voice mail services;
- (4) marketing services, namely promoting other parties and their businesses through a network, an electronic site situated on or accessed by a network, or by electronic messages and mail delivered over a network;
- (5) dissemination of advertising for others via an electronic site situated on or accessed through a network, or by electronic messages and mail delivered over a network; distribution and rental of third party computer software, hardware and accessories.

The application was assigned to Webnames.ca Inc. on September 30, 2000 and the assignment was recorded on February 8, 2001. The application was subsequently advertised for opposition purposes on February 12, 2003.

The opponent, InterServe, Inc. (“InterServe”), filed a statement of opposition on July

14, 2003, a copy of which was forwarded to the applicant on September 30, 2003. The opponent was subsequently granted leave on April 6, 2004 to amend its statement of opposition pursuant to Rule 40 of the Trade-marks Regulations.

The first ground of opposition is that the applicant is not the person entitled to registration pursuant to the provisions of Sections 16(1) and 16(3) of the Trade-marks Act because, as of the applicant's claimed date of first use and its filing date, the applied for trade-mark was confusing with the trade-marks and trade-names WEBNAMES and WEBNAMES.COM previously used and made known in Canada by the opponent with "domain name registration services, website and web page design services and website hosting services." The second ground is that the applicant's trade-mark is not distinctive because it is confusing with the opponent's trade-marks and trade-names used in Canada. The third ground is that the applicant's application does not conform to the requirements of Section 30(b) of the Act because the applicant did not use the trade-mark WEBNAMES in Canada since June 5, 2000 with "domain name development and registration services" as claimed.

The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavits of Jennifer Leah Stecyk, Sandra Lett and Wayne MacLaurin. As its evidence, the applicant submitted the affidavits of Stephen Smith, John Demco and Melissa Lyn Heywood. The applicant was subsequently granted leave pursuant to Rule 44 of the Regulations to file a certified copy of registration No. 1,182,112 for its trade-mark WEBNAMES.CA. Only the applicant filed a written argument and an oral hearing was conducted at which only the applicant was represented.

THE OPPONENT'S EVIDENCE

The Lett affidavit serves to introduce into evidence a printout from the Strategis website maintained by Industry Canada showing that the applicant, Webnames.ca Inc., was incorporated on September 21, 2000.

In her affidavit, Ms. Stecyk identifies herself as a trade-mark searcher and details the results of an Internet search she conducted on August 11, 2004 using the Google search engine for websites containing the term WEBNAMES. Exhibit B to her affidavit lists the first fifty hits revealed by her search and Exhibit C comprises copies of the web pages from the fifty sites that she visited. The only sites she located that indicated Canadian origin or activity refer to the applicant, Webnames.ca Inc. The remaining sites do not evidence any use of the term WEBNAMES by the opponent or any third parties in Canada at the time of the search or prior to the applicant's filing date and claimed date of first use.

Exhibits D and E to the Stecyk affidavit are photocopied excerpts from speciality dictionaries which include definitions for the term WEB. Exhibit F is a copy of the initial prosecution history for the applicant's application and Exhibit G is a copy of the initial prosecution history for the corresponding U. S. application for the applicant's trade-mark WEBNAMES.

In his affidavit, Mr. MacLaurin identifies himself as the former principal shareholder of Cyberus Online Inc. from 1995 to 1999. In 1999, he sold that company and then joined Momentous.ca Corporation which he states performed consulting services for the opponent,

InterServe, since the fall of 2002. From 1995 on, Mr. MacLaurin was involved in all aspects of domain name registration with a particular interest in the registration of .CA domain names. As part of his work for the opponent, Mr. MacLaurin states that he assisted the opponent in obtaining the domain name “webnames.com” from Infoback Corporation (“Infoback”). Appended as Exhibit B to his affidavit is the purported assignment dated December 18, 2002 of that domain name from Infoback to InterServe. However, the assignment was not executed by the purported assignor, Infoback, and it is unclear in what capacity the individual purportedly signing for InterServe was acting since Mr. MacLaurin states in paragraph six of his affidavit that InterServe has no employees.

According to Mr. MacLaurin, the opponent was using the domain name “webnames.com” on its website as of April of 2003 and, in the fall of that year, began offering .CA domain name registrations. He states that the opponent sold its first .CA registration on December 4, 2003 to an individual in Sorrento, B. C. and subsequently stopped selling .CA domain names in July of 2004. However, none of this information evidences any use of the opponent’s trade-marks and trade-names WEBNAMES and WEBNAMES.COM in Canada prior to the applicant’s filing date or claimed date of first use nor does it evidence any Canadian reputation for those marks and names at any time.

Mr. MacLaurin conducted website archive searches using the Way Back Machine search engine for sites with the term “webnames” in the URL. He visited the sites located and copies of the pages he viewed are appended as exhibits to his affidavit. However, none of those exhibits evidences use of the term “webnames” originating in Canada by the opponent or

others at any time and certainly not prior to the applicant's filing date or claimed date of first use.

Finally, Mr. MacLaurin details his understanding of the history of the .CA name registry. According to Mr. MacLaurin, until 2000, .CA names were registered on a volunteer basis by John Demco of the University of British Columbia ("UBC") with the assistance of the CA Domain Committee comprised of Mr. Demco and representatives from Canadian networks. Due to the growth of .CA domain names, the Canadian Internet Registration Authority ("CIRA") was formed and it entered into an agreement with UBC on May 9, 2000 to transition the .CA domain registry from UBC to CIRA.

According to Mr. MacLaurin, in the fall of 2000, CIRA took over the operation of the .CA registry. The function of operating as a domain name registrar then became an independent business available to others. Mr. MacLaurin recognizes Webnames.ca Inc. as a CIRA-certified registrar. Using the Way Back Machine search engine, the earliest web pages he could locate for the applicant dated back to October 18, 2000 which is well after the claimed date of first use of June 5, 2000. Mr. MacLaurin contends that the only .CA domain name registrar in Canada as of that date was CDNnet or the CA Domain Committee.

THE APPLICANT'S EVIDENCE

In his affidavit, Mr. Smith identifies himself as the President of the applicant, Webnames.ca, Inc. He details the history of the .CA domain name registry in Canada. In May of 1987, John Demco, the manager of the CDNnet computer network, was delegated the .CA

top level domain name by the Internet Assigned Numbers Authority (“IANA”). In the year 2000, the U. S. government withdrew support for IANA and supported a non-governmental organization called Internet Corporation for Assigned Names and Numbers (“ICANN”).

According to Mr. Smith, for the period 1988 to 2000, John Demco and UBC were involved in the control, management and operation of the .CA domain name registry through UBC’s CDNnet computer network. Mr. Demco was the registrar for .CA domain names.

In the year 2000, there was a transfer of control of the .CA domain name registry from UBC to CIRA. The full transfer occurred in the fall of that year. From that point on, CIRA only operated and maintained the .CA name registry. Thus, a process was needed to appoint registrars or so-called “order takers.” In May of 2000, UBC Research Enterprises Inc. (“UBC Research”) was incorporated as a wholly-owned subsidiary of UBC and it initiated development of a web site for domain name registration. On May 17, 2000, UBC Research applied for the domain name “webnames.ca” which was granted on May 24, 2000.

On June 5, 2000, UBC Research commenced business as WEBNAMES and launched the web site www.webnames.ca which took over the registrar duties previously performed by John Demco and UBC. On that same date, Mr. Demco redirected all incoming e-mails for CDNnet to Webnames. Exhibits E to H to the Smith affidavit are examples of such redirected e-mails and Exhibit I is a photocopy of a credit card transaction record for a Webnames transaction dated June 14, 2000. Exhibit J shows monthly transaction payments for the period June to September of 2000.

On August 16, 2000, Webnames was certified by CIRA as an official .CA domain name registrar. On September 21, 2000, Webnames.ca, Inc. was incorporated and UBC Research then assigned the trade-mark WEBNAMES to Webnames.ca, Inc. CIRA then transferred the registrar accreditation of UBC Research to Webnames.ca, Inc. According to Mr. Smith, gross sales from June of 2000 to the date of his affidavit (March 21, 2005) were in excess of \$10 million.

In his affidavit, Mr. Demco states that he is a director and co-founder of the applicant, Webnames.ca, Inc. He confirms much of the history of the .CA domain name as set out in Mr. Smith's affidavit including the two-stage transfer of the registry from UBC to CIRA in May and in the fall of 2000.

Mr. Demco states that in April of 2000, UBC agreed that UBC Research would continue its registrar function regarding .CA domain names. He confirms that UBC Research was granted the domain name webnames.ca on May 24, 2000. He further confirms that on June 5, 2000, UBC ceased its CDNnet registrar role and advised customers that Webnames was open for business. On that same date, UBC Research launched the web site www.webnames.ca and it subsequently assigned the trade-mark WEBNAMES to Webnames.ca, Inc.

The Heywood affidavit details the results of Mr. Heywood's search using the Google search engine for web sites containing the terms Webnames and Canada. Ms. Heywood visited the first fifty sites located and all but three referred to Webnames.ca, Inc. and/or its web site address. The remaining three sites were not Canadian. Ms. Heywood also researched

dictionaries and found no entries for Webnames, Web Names or the like. Her search of the Canadian trade-marks register revealed only four relevant trade-marks of record comprising the words Webname or Webnames, all of which are owned by the applicant.

THE GROUNDS OF OPPOSITION

As for the first ground of opposition, there was an initial burden on the opponent to evidence prior use or making known of its trade-marks and trade-names WEBNAMES and WEBNAMES.COM prior to the applicant's filing date and its claimed date of first use. As noted, the opponent's evidence fails to evidence any use or reputation for its marks and names in Canada at any time, much less prior to the applicant's priority dates. Thus, the first ground of opposition is unsuccessful.

As for the second ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its services from the wares and services of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - July 14, 2003): see Re 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) 412 at 424 (F.C.A.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

As noted, the opponent failed to evidence any use or reputation of note in Canada for

its marks and names at any time. Thus, the opponent has failed to meet its evidential burden and the second ground is also unsuccessful.

As for the opponent's third ground of opposition, the onus or legal burden is on the applicant to show that its application conforms to the requirements of Section 30(b) of the Act: see the opposition decision in Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R.(3d) 325 at 329-330 and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). There is, however, an evidential burden on the opponent respecting its allegations of fact in support of that ground. That burden is lighter respecting the issue of non-conformance with Section 30(b) of the Act: see the opposition decision in Tune Masters v. Mr. P's Mastertune (1986), 10 C.P.R.(3d) 84 at 89. Furthermore, Section 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed: see Labatt Brewing Company Limited v. Benson & Hedges (Canada) Limited and Molson Breweries, a Partnership (1996), 67 C.P.R.(3d) 258 at 262 (F.C.T.D.). Finally, the opponent's evidential burden can be met by reference to the applicant's own evidence: see Labatt Brewing Company Limited v. Molson Breweries, a Partnership (1996), 68 C.P.R.(3d) 216 at 230 (F.C.T.D.).

As noted, Mr. MacLaurin states that, as of the applicant's claimed date of first use, the only .CA domain name registrar in Canada was CDNnet or the CA Domain Committee. He also states that the earliest web page he could locate for www.webnames.ca was dated October 18, 2000. Given the light evidential burden on the opponent, I consider that Mr. MacLaurin's affidavit suffices to meet that burden.

In view of the above, it was incumbent on the applicant to evidence its claimed date of first use. This it has done by means of the Smith and Demco affidavits. They establish the applicant's predecessor-in-title, UBC Research, used the trade-mark WEBNAMES on June 5, 2000 for the services of domain name development and registration and that there has been continuous use of the mark since that date. Thus, the applicant has satisfied the legal burden on it and the third ground of opposition is also unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's opposition.

DATED AT GATINEAU, QUEBEC, THIS 21st DAY OF MARCH, 2007.

**David J. Martin,
Member,
Trade Marks Opposition Board.**