



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

Citation: 2014 TMOB 132
Date of Decision: 2014-06-25

**IN THE MATTER OF AN OPPOSITION
by Yahoo! Inc. to application
No. 1,478,915 for the trade-mark
YAHMOBILE in the name of Alpha Base
Inc.**

[1] Alpha Base Inc. has applied to register the trade-mark YAHMOBILE based upon proposed use of the trade-mark in Canada in association with, among other things, mobile telephone communication and paging services, printed and electronic publications and promotional wares.

[2] Yahoo! Inc. has opposed the application primarily on the basis that there is a reasonable likelihood of confusion between this trade-mark and the Opponent's YAHOO! registered marks and other YAHOO! formative marks used in association with mobile phone related services, including its mark YAHOO! MOBILE.

[3] For the reasons that follow, I have found that this application should be refused.

Background

[4] On April 28, 2010, Alpha Base Inc. (the Applicant) filed application No 1,478,915 for the registration of the applied-for mark YAHMOBILE based on use in association with the following wares and services:

Wares:

Printed and electronic publications, namely, newsletters, bulletins, brochures, flyers, and manuals.

(2) Printed matter, namely, posters, signs, calendars, postcards, and directories.

(3) Promotional items, namely, hats, stickers, bumper stickers, mouse pads, key chains, novelty flags, banners, balloons, novelty buttons, greeting cards, note cards, writing pencils, pens, coffee mugs, and fridge magnets.

Services:

(1) Mobile telephone communication services; Paging services.

(2) Operating a website providing information in the field of mobile telephone services.

[5] The application was advertised on October 13, 2010, and Yahoo! Inc. (the Opponent) filed a statement of opposition on March 14, 2011. The grounds of opposition are set out in the attached Schedule A. In its statement of opposition, the Opponent refers to the YAHOO! Registered Marks (set out in the attached Schedule B), the YAHOO! Family of Marks (which appear to be the same as the YAHOO! Registered Marks) and the YAHOO! Mobile Marks which include the Opponent's trade-mark YAHOO! MOBILE as well as other YAH and YAHOO! formative trade-marks used in association with mobile phone related services.

[6] In support of its opposition, the Opponent filed the affidavits of Erin Creber, articling student with the Opponent's agent and Asha Gosein, Senior Legal Director of Yahoo! Canada Co. (a subsidiary of Yahoo! Inc.). The Opponent was also granted leave under section 44 of the *Trade-marks Regulations* to file a certified copy of an Examiner's Report dated May 1, 2012, in respect of the Opponent's trade-mark application No. 1,549,991 for the trade-mark YAHOO! MOBILE. As its evidence, the Applicant filed the affidavits of Brendan Holness, articling student with the Applicant's agent and Leo Maroussi, Chief Executive Officer of the Applicant. Both Mr. Holness and Mr. Maroussi were cross-examined on their affidavits.

[7] Only the Opponent filed a written argument and a hearing was held at which only the Opponent was represented.

Preliminary Issue

[8] The affidavit of Mr. Maroussi was not sworn.

[9] The decision in *Dobrinsky v Kubara* (1949), [1950] 1 WWR 65 (Man KB), is authority for the proposition that the failure of an affiant to specify that the statements contained in the affidavit were made under oath renders the affidavit inadmissible. In the present case, while Mr. Maroussi “makes oath” at the beginning of the affidavit, there is no jurat or other indication that the document was sworn in front of a notary public or commissioner to make it a proper affidavit or statutory declaration as required by the *Canada Evidence Act*, RSC 1985, c C-5. All that appears at the bottom of the document is the name and signature of Mr. Maroussi. Further, although Mr. Maroussi was cross-examined on his affidavit, he did not confirm on cross-examination that the contents of his affidavit were true. I therefore conclude that both the document identified by the Applicant as the affidavit of Mr. Maroussi and his cross-examination transcript are inadmissible as evidence in this proceeding [see *Bosch Sicherheitssysteme GmbH v Diboss Canada Inc* 2010 CarswellNat 1990]. Even if this evidence was admissible, it would have been of little or no assistance to the Applicant for the reasons provided by the Opponent (eg. Mr. Maroussi does not provide any information regarding use of the Mark).

Onus

[10] 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*, RSC 1985 c T-13 (the Act). There is however an initial 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 Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

Summary of the Opponent’s Evidence

[11] As noted, Ms. Gosein identifies herself as Sr. Legal Director of Yahoo! Canada Co. which is a subsidiary of Yahoo! Inc. She explains that Yahoo! Canada Co. has, at all relevant times, had a license from Yahoo! Inc. to use the Yahoo! trade-marks. Pursuant to the license, Yahoo! Inc. has exercised direct control over the quality and character of the wares and services in association with which the trade-marks are used. For example, Yahoo! Inc. has the right to inspect and does inspect the wares or services in association with which the trade-marks are

used. Prior to launching a new product or service in association with the YAHOO! trade-marks, Yahoo! Canada Co. must first seek the approval of Yahoo, Inc. As Ms. Gosein collectively refers to both companies as Yahoo!, I will do the same.

[12] Ms. Gosein explains that Yahoo! is a leading global Internet communications, commerce and media company that offers a comprehensive network of services to more than 345 million individuals each month worldwide (Gosein, para 6). The YAHOO! branded websites are some of the most trafficked Internet destinations worldwide. For example, in November 2010 the YAHOO! branded websites attracted more than 630 million unique visitors, reaching 48% of the global online population and accounting for 4.5% of all time spent online globally. Since at least as early as the beginning of 2008, the YAHOO! brand has routinely been recognized as one of the top two Internet brands globally in terms of worldwide audience reached (Gosein, para 7).

[13] The Opponent has extensively registered, advertised and used the YAHOO! trade-marks in Canada in association with a wide variety of wares and services since at least as early as June 1994. Attached to this decision as Schedule B is a list of the Opponent's registered YAHOO! trade-marks (the YAHOO! Registered Marks).

[14] With respect to Canada, the Opponent has generated income through advertisement sales, including those placed by Canadian companies and in respect of services provided to Canadian users. Ms. Gosein provides the following information with respect to users of its services in Canada:

- over 20 million registered users (users with an account with Yahoo!) identified Canada as their country of residence in at least each of 2003, 2004 and 2005;
- in each month between October 2003 to October 2005, the entire Yahoo! network provided over 2 billion page views to users in Canada, rising to almost 3 billion by October 2005;
- from March 2003 to October 2005, there was a monthly average of over 9 million recorded visits growing to over 11 million by October 2005;

- during the same March 2003 to October 2005 timeframe, the Yahoo! Canada website at ca.yahoo.com recorded increasing numbers of page views from Canada averaging in excess of 300 million per month and reaching over 850 million by October 2005, with an excess of over 2 million users, reaching over 4.6 million users by October 2005; and
- the French version of the Yahoo! Canada web site at cf.yahoo.com during the same time frame on a monthly basis recorded over 28 million page views from Canada in March 2003 rising to over 55 million by October 2005 and over 320,000 users from Canada increasing to well over 400,000 by October 2005.

[15] Ms. Gosein further states that since as early as 2001, Yahoo! has offered mobile messaging and Internet services in association with the trade-mark YAHOO! MOBILE to Canadians. Attached as Exhibit 8 to her affidavit is a print-out of relevant excerpts from archived copies of the website ca.mobile.yahoo.com from 2001 obtained using the Wayback machine relating to the YAHOO! MOBILE services. As shown in Tab A of Exhibit 8, YAHOO! MOBILE services provided users with the ability to use a variety of Yahoo!'s services through mobile phone and downloads to PDA devices as well as two-way paging services. Ms. Gosein goes on to state that since at least as early as 2006, YAHOO! MOBILE services have been provided to Canadian customers via mobile devices such as cell phones, smart phones and tablets. Customers use the Internet browser on their mobile device or download the YAHOO! MOBILE software from the Internet browser to their mobile device which permits the user to access a broad range of Yahoo!'s services, including YAHOO! MESSENGER, YAHOO! MAIL, YAHOO! SEARCH, YAHOO! SPORTS, YAHOO! NEWS and YAHOO! FINANCE. Tab B of Exhibit 8 contains relevant excerpts from Yahoo!'s website which describe these services.

[16] Yahoo! has also had arrangements with mobile phone service providers in Canada including Bell Mobility, Telus and Rogers Wireless, whereby links to Yahoo!'s services are preloaded on mobile phones sold by the service provider, since 2002 (Gosein, para 26 and Exhibit 9).

[17] Yahoo! has also distributed, marketed and sold to Canadians a wide variety of wares in association with one or more of its YAHOO! trade-marks through online stores and at its retail location in California. Wares sold or distributed by Yahoo! in Canada include hats, journals,

notebooks, plastic children's toys, stickers, mouse pads, key chains, magnets, posters, magazines, signs, cups and mugs, computer software, books and pens. (Gosein, paras 30 and 32, Exhibits 13 and 14).

[18] With respect to advertising, Mr. Gosein states that Yahoo! spent on average in excess of \$4 million annually on advertising in Canada, with more than \$5 million being spend in each of the years 2008 and 2009. These advertisements, which prominently display one or more of the Yahoo! trade-marks, include online ads, e-mail newsletters, event sponsorship, radio ads, billboards, magazine ads, TV and movie theatre ads, ads in sports stadiums, mail ads, and in-store ads (Gosein, para 33; Exhibit 15). In addition, since 2008, Yahoo! has spent on average over \$40,000 per year on advertisements specifically directed to the services provided in association with the YAHOO! MOBILE trade-mark, with \$50,000 being spent in each of the years 2009 and 2010 and in approximately the first six months of 2011(Gosein, para 34, Exh. 15).

Grounds of Opposition

Non-distinctiveness ground – sections 38(2)(d) and 2

[19] The Opponent pleads that the Mark does not actually distinguish nor is adapted to distinguish the wares and services of the Applicant from the wares and services of the Opponent, having regard to the adoption, use making known and/or registration of the YAHOO! Registered Marks, the YAHOO! Family of Marks and the YAHOO! Mobile Marks. This ground turns on the issue of the likelihood of confusion between the Mark and each of the Opponent's marks.

[20] I consider the Opponent's case to be strongest with respect to its YAHOO! MOBILE mark because this mark is arguably closer in resemblance to the Mark than the Opponent's other trade-marks. However, in view of the Opponent's extensive evidence of use and reputation of its YAHOO! mark which is the subject of seven registrations and used in association with a wide variety of wares and services, I will focus my analysis on the likelihood of confusion between the Opponent's YAHOO! and YAHOO! MOBILE marks and the Mark. If the Opponent is not successful based on these marks, then it will not be successful based on any of its other marks.

[21] In order to meet its initial burden with respect to this ground of opposition, the Opponent has to show that its trade-marks had become known sufficiently in Canada as of the filing date of the statement of opposition, i.e. March 14, 2011, to negate the distinctiveness of the Mark [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC); *Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC and Bojangles Restaurants Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. The Opponent's evidence need not necessarily show trade-mark use within the scope of section 4(1) or 4(2) of the Act in order to be relied upon in challenging the distinctiveness of the Mark [see *Mutual Investco Inc v Knowledge Is Power Inc* (2001), 14 CPR (4th) 117 (TMOB) at p 123]. It may be based on any evidence of knowledge or reputation of the Opponent's trade-mark in Canada.

[22] I am satisfied from the evidence of Ms. Gosein that the Opponent has shown that its YAHOO! and YAHOO! MOBILE marks had become known sufficiently in Canada as of the filing date of the statement of opposition. In view that the Opponent has met its initial burden, I must now determine whether the Applicant has satisfied the Registrar that its Mark was adapted to distinguish its wares and services throughout Canada as of March 14, 2011. In considering whether the Mark was able to do so, I will determine on a balance of probabilities, if the Mark was likely to cause confusion with the Opponent's YAHOO! and/or YAHOO! MOBILE trade-marks at the material date.

[23] At the oral hearing, the Opponent's agent provided me with a useful summary of the specific wares and services associated with each of its marks. For ease of reference, I reproduce below the wares and services for those marks that I consider the most relevant to this proceeding.

YAHOO! MOBILE

Wares: Downloadable software for allowing wireless handheld devices to access the applicant's internet portal, electronic mail, internet search engine, real-time chat, instant messaging, electronic calendaring, electronic address book and internet directory services, and to access the applicant's on-line telephone directory, finance, weather, news, movie, sport, restaurant, entertainment and driving direction information services.

Services: Providing an internet portal for wireless handheld devices offering information in the fields of telephone directory, finance, weather, news, movies, sports, restaurants, entertainment and driving directions; providing electronic mail, internet search engine, real-time chat, instant

messaging, electronic calendaring, electronic address book and internet directory services for wireless handheld devices; providing on-line access to telephone directory, finance, weather, news, movies, sports, restaurants, entertainment and driving directions information via wireless handheld devices.

YAHOO!, registration No. TMA568,690

Services: (1)...telephony services, electronic mail services; providing multiple-user access to computer networks for the transfer and dissemination of a wide range of information; electronic transmission of data, messages, images, and documents; providing telephone communication via computer terminals and networks; paging services; electronic storage of messages and data; electronic store-and-forward messaging services; chat services, namely, providing online facilities for real-time interaction with other computer users concerning topics of general interest; and providing electronic bulletin boards and message boards for transmission of messages among computer users concerning topics of general interest and for playing games.

YAHOO!, registration No. TMA536,693

(1) Sunglasses and prerecorded videotapes; luggage tags, watches, key chains, and magnets; tattoos, signs.

(2) Magazines regarding computer networks and searching and retrieving information, sites, and other resources on computer networks.

(3) Mouse pads; computer software for use as a screen saver; sunglasses; pre-recorded videotapes; luggage tags; watches; key chains; magnets; posters; magazines regarding computer networks and searching and retrieving information, sites, resources on computer networks, and other resources on computer networks; tattoos; signs; backpacks; housewares, namely cups, mugs, water bottles; sweatshirts; shorts; jackets; visors; toys; stickers; balls; beach toys; blocks; board games; coloring books, bubbles; markers; puzzles.

YAHOO!, registration No. TMA615,851

Wares: ... (2)... Computer software and instructional manuals sold therewith, namely, computer software for the transmission of electronic mail; computer software for providing multiple-user access to computer networks for the transfer and dissemination of a wide range and variety of information; computer software for use in creating and designing web sites; mouse pads; magnets; keyboards.

YAHOO!, registration No. TMA654,433

Services: (1)...ongoing entertainment programs broadcast via radio, cellular, and wireless communication, the Internet, electronic communications networks, and computer networks in the fields of news, weather, sports, travel, current events, reference information, career information, computing, technology, shopping, auctions, movies, theater, music, health, education, science, finance, and investing; providing sports information via telephone, cellular telephone, wireless communication devices, and the Internet;...

YAHOO!, registration No. TMA556,622

Wares: (1) Hats and shirts. (2) Computer software for searching and retrieving information, sites, and other resources on computer networks; computer software, namely, a directory of information, sites, and resources available on computer networks; books regarding computer networks and searching and retrieving information, sites, and other resources on computer networks.

test for confusion

[24] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time each has 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.

[25] This list of enumerated factors is not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361, (SCC)]. Further, when dealing with famous or well-known marks, it may be more difficult to demonstrate that there is no likelihood of confusion, especially if the nature of the wares or services are similar [*Polo Ralph Lauren, LP v United States Polo Assn* (2000), 9 CPR (4th) 51 (FCA) at 58-59].

[26] In *Masterpiece*, the Supreme Court began its consideration of the section 6(5) factors by considering the degree of resemblance between the marks and I shall follow its approach.

section 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[27] At paragraph 64 of *Masterpiece*, in his analysis of the degree of resemblance between the marks MASTERPIECE LIVING and MASTERPIECE THE ART OF LIVING, Rothstein J. stated:

While the first word may, for purposes of distinctiveness, be the most important in some cases, I think a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique.

[28] Following Justice Rothstein's approach, I find that the component YAH is the most striking or unique component of the Mark, given that the word MOBILE is descriptive of the Applicant's services. With respect to the Opponent's marks, I note that the term YAHOO! is either the only element or the predominant first element. In view that the word YAHOO! is either used alone or is accompanied by an element that is descriptive or suggestive such as the word MOBILE, I agree with the Opponent that the prefix YAHOO! is the most important element of the Opponent's marks for purposes of distinction.

[29] At paragraph 104 of *Masterpiece* 416 N.R. 307, Rothstein J. stated:

Without repeating the findings above, there is no doubt that there is a strong resemblance between Masterpiece Inc.'s trade-mark, "Masterpiece the Art of Living" and Alavida's trade-mark, "Masterpiece Living". In my opinion, a casual consumer observing the Alavida trade-mark and having no more than an imperfect recollection of Masterpiece Inc.'s trade-mark would likely be confused into thinking that the source of the services associated with the Alavida trade-mark was one and the same as the source of the services associated with the Masterpiece Inc. trade-mark. The question now is whether any of the other circumstances reduce this likelihood of confusion to the point that confusion is not likely to occur.

[30] I have similarly concluded that there is a considerable amount of resemblance in appearance and sound between YAHMOBILE and the Opponent's YAHOO! MOBILE mark, and at least some resemblance between the Mark and the Opponent's YAHOO! mark. I also find that on such basis a casual consumer observing the Mark and having no more than an imperfect recollection of the Opponent's marks would likely be confused into thinking that the source of

the mobile telephone communication and related services associated with the Mark was the same as the source of the wares and services associated with the Opponent's marks. Therefore, according to the Supreme Court, the question now is whether any of the other circumstances reduce this likelihood of confusion to the point that confusion is not likely to occur.

section 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[31] I agree with the Opponent that the Mark is distinctive only to the extent that it includes the prefix YAH as its first component. Its second component is clearly descriptive of the character or quality of its applied for services. The Opponent's YAHOO! mark, on the other hand, possesses a high degree of inherent distinctiveness. The Opponent's YAHOO! MOBILE mark possesses about the same degree of inherent distinctiveness as the Mark because of its descriptive second component.

[32] The strength of a trade-mark may be increased by means of it becoming known through promotion or use, which is often referred to as its acquired distinctiveness. Given the significant amount of users of the Opponent's services in Canada, and the extensive advertising and promotional efforts of the Opponent as detailed above, it is safe to assume that the Opponent's YAHOO! mark is known by many Canadians and is therefore entitled to the status of a famous mark in association with its wares and services. Such a finding is of great importance in the assessing the issue of confusion [see *Veuve Cliquot, supra*, at 417-418].

[33] With respect to the Opponent's YAHOO! MOBILE mark, while I do not find that it is as well known in Canada as the Opponent's YAHOO! trade-mark, I am still satisfied from Ms. Gosein's evidence as a whole that it has become known to some extent in Canada.

[34] Since there is no evidence of use of the Mark, I must conclude that the Applicant's proposed mark has not become known at all in Canada.

[35] This factor therefore favours the Opponent.

section 6(5)(b) - the length of time each trade-mark has been in use

[36] The length of time that each mark has been in use favours the Opponent.

sections 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

[37] The Opponent submits that there is clear overlap between the Applicant's applied for wares and services and the wares and services provided in association with the YAHOO! trade-marks. The examples of overlap provided by the Opponent in its written submissions is reproduced as follows:

Wares and Services in the Application	Wares and Services of the YAHOO! Trade-marks
Printed and electronic publications, namely, newsletters, bulletins, brochures, flyers, and manuals.	Printed publications, namely, magazines and manuals (TMA536,693; TMA615,851)
Printed matter, namely, posters, signs, calendars, postcards, and directories.	Printed matter, namely posters and signs (TMA536,693)
Promotional items, namely, hats, stickers, bumper stickers, mouse pads, key chains, novelty flags, banners, balloons, novelty buttons, greeting cards, note cards, writing pencils, pens, coffee mugs, and fridge magnets.	Promotional items, such as hats, stickers, mouse pads, key chains, magnets, mugs (TMA536,693; TMA556,622; TMA568,690; TMA615,851; TMA691,134)
Mobile telephone communication services; Paging services.	Telephony services, electronic mail services, providing telephone communication via computer terminals and networks, paging services, electronic storage of messages and data, electronic store-and-forward messaging services, and chat services, namely, providing online facilities for real-time interaction with other computer users concerning topics of general interest; telecommunication services, namely electronic mail services, voice mail services, voice messaging services, and personal communication services consisting of e-mail and personalized address books (TMA556,622; TMA568,690; TMA651,584; TMA654,433; TMA706,155; YAHOO!,

	YAHOO! MOBILE, YAHOO! MESSENGER)
Operating a website providing information in the field of mobile telephone services.	Searching and retrieving information, sites, and other resources available on computer networks for others; providing an online link to news, weather, sports, current events, and reference materials; computer services, namely, creating indexes of information, sites and other resources available on computer networks for the transfer and dissemination of a wide range of information; providing a wide range of general interest information via computer networks and communications networks; providing online computer bulletin and message boards in fields of general interest (TMA518,947; TMA556,622; TMA568,690; TMA615,851; TMA651,584; TMA706,155).

[38] In addition, as discussed above, the wares and services provided by the Opponent are primarily Internet-based. Further, several of the Internet based services, including the YAHOO! MOBILE services, are accessed by customers using Yahoo!’s software that is downloaded or preloaded on a customer’s computer or mobile phone.

[39] The only admissible evidence we have about the Applicant’s services is a screen capture printout of search results for the word “yahmobile” that describes the services provided by “Yahmobile” as follows: “YahMobile provides services for smartphones that eliminate minute overage and voice roaming fees”. Under the heading “residential phone line”, it states the following: YahMobile provides “the next generation telephony services” [see Holness, Exhibit A]. Attached as Exhibit B to Ms. Holness’ affidavit is a screen capture printout of the home page of www.yahoomobile.com which shows what appears to be the Applicant’s name at the top of the page. This page shows various headings at the top, including “wireless plans”, “wireless prepaid cards”, “home and business”, “long distance plans”, etc.

[40] In my view, while not all of the parties’ wares and services are identical, I agree with the Opponent that there is a clear overlap between them. As argued by the Opponent’s agent at the oral hearing, the Opponent is in the business of providing telephony services, including paging,

messenger and voice over IP. The Opponent has also shown use of its YAHOO! mark in association with printed matter, electronic publications and promotional items.

[41] I also agree with the Opponent that given this overlap, and in the absence of evidence to the contrary, it is reasonable to expect that the wares and services of the Applicant would be sold and or distributed through the same channels of trade as the wares and services of those of the Opponent. These factors therefore favour the Opponent.

Further surrounding circumstances

Opponent's Family of Trade-marks

[42] As an additional surrounding circumstance, I have considered the Opponent's family or series of marks. As discussed above, the Opponent has evidenced extensive use of several of its YAHOO! trade-marks in the marketplace [see *McDonald's Corp v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101 (FCTD)]. I am therefore satisfied that the Opponent has established the existence of a family of trade-marks that include the component YAHOO! for use in association with a wide variety of Internet based wares and services. I conclude that consumers familiar with the Opponent's YAHOO! marks may be more likely to assume that the Applicant's YAHMOBILE mark is part of the Opponent's family because it begins with the same distinctive component YAH. The Opponent's family of trade-marks therefore increases the likelihood of confusion in the present case.

Notoriety of the trade-mark YAHOO!

[43] The Opponent also submits that, as a further surrounding circumstance, I should consider the notoriety of its YAHOO! trade-mark. As noted above, I am satisfied from the Opponent's evidence that its YAHOO! trade-mark has become well known if not famous in Canada in association with a variety of Internet based wares and services. In view of the fame and reputation of the Opponent's YAHOO! trade-mark, I agree with the Opponent that it should be afforded a wider ambit of protection [see *United Artists Corp v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 (FCA) at 267].

Trade-mark Examiner's decision

[44] The Opponent further submits that another relevant surrounding circumstance is the fact that the Registrar, through one of its Trade-mark Examiners, has already concluded that the trade-mark YAHMOBILE is confusing with the Opponent's mark YAHOO! MOBILE. In making this submission, the Opponent relies on the certified copy of the Examiner's report dated May 1, 2012, wherein the Examiner objected to registration of the Opponent's mark YAHOO! MOBILE on the basis that it was confusing with the Applicant's application for the trade-mark YAHMOBILE.

[45] I do not consider this factor to be a relevant surrounding circumstance because a decision by the examination section of the Trade-marks Office is not binding on this Board and does not have precedential value for this Board [see *Thomas J Lipton Inc v Boyd Coffee Co* (1991), 40 CPR (3d) 272 (TMOB) at p 277; *Procter & Gamble Inc v Morlee Corp* (1993), 48 CPR (3d) 377 (TMOB) at p 386].

Conclusion

[46] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees YAHMOBILE on the Applicant's wares and services at a time when he or she has no more than an imperfect recollection of the Opponent's YAHOO! or YAHOO! MOBILE trade-marks, and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot*].

[47] In view of my findings above, and in particular the Opponent's extensive reputation of its YAHOO! marks, the fact that the parties' wares and services overlap, and the high degree of resemblance between the marks in appearance and sound, and in particular between the Mark and the Opponent's mark YAHOO! MOBILE, it seems to me that such a consumer would, as a matter of first impression, be likely to believe that the wares and services associated with the Opponent's YAHOO! and YAHOO! MOBILE marks and the Applicant's YAHMOBILE mark were manufactured, sold or performed by the same person.

[48] As the Applicant has not shown that its Mark was able to distinguish its wares and services from the wares and services of the Opponent as of March 14, 2011, the section 38(2)(d) ground of opposition succeeds.

Non-entitlement Ground - section 16(3)(a)

[49] The Opponent has also pleaded that the Applicant is not the person entitled to registration on the basis that the Mark is confusing with the Opponent's YAHOO! Registered Marks, the YAHOO! Family of Marks and the YAHOO! Mobile marks previously used and made known in Canada by the Opponent.

[50] With respect to this ground of opposition, there is an initial burden on the Opponent to evidence use or making known of its trade-marks prior to the Applicant's claimed date of first use and non-abandonment of its marks as of the date of advertisement of the Applicant's application [section 16]. I am satisfied from the evidence furnished that the Opponent has met its evidential burden under this ground with respect to many of its YAHOO! trade-marks, including YAHOO! MOBILE.

[51] In my view, the differences in material dates do not have any significant impact on the determination of the issue of confusion between the trade-marks of the parties. Thus, my finding above that the trade-marks are likely to be confused applies to this ground of opposition which also succeeds.

Remaining Grounds of Opposition

[52] As I have found the Opponent successful under two grounds of opposition, I do not find it necessary to consider the remaining grounds.

Disposition

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

Cindy R. Folz
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule A
Summary of the Grounds of Opposition

Yahoo! is the owner in Canada of a number of registered trade-marks as set out in the attached Schedule B (the YAHOO! Registered Marks).

All of the YAHOO! Registered Marks make prominent use of the distinctive letter combinations YAHOO and YAH appearing at the beginning of a word. These trade-marks therefore comprise a series or family of trade-marks directed to these common features (the YAHOO! Family of Marks).

Yahoo! has also made prominent use in Canada of the trade-mark YAHOO! MOBILE as well as other YAH and YAHOO formative trade-marks in association with mobile phone related services (the YAHOO! Mobile Marks).

Yahoo! bases its opposition on the following grounds of opposition:

1. The application does not conform to the requirements of section 30(i) of the Act, in that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the wares and services identified in the application, having regard to:

- i) Section 19 of the Act. The use of the Mark will infringe Yahoo's exclusive right to the use throughout Canada of each of the YAHOO! Registered Marks as well as the YAHOO! Family of Marks;
- ii) Section 20 of the Act. The use of the Mark will be deemed to infringe YAHOO!'s exclusive right to the use throughout Canada of each of the YAHOO!'s Registered Marks as well as the YAHOO! Family of Marks since the Mark is confusing with each of the YAHOO! Registered Marks and the YAHOO! Family of Marks;
- iii) Section 22 of the Act. The use of the Mark will be likely to have the effect of depreciating the value of the goodwill attaching to each of the YAHOO! Registered Marks and the YAHOO! Family of Marks.

2. The Mark is not registrable in view of section 12(1)(d) of the Act because the Mark is confusing with each of the YAHOO! Registered Marks and the YAHOO! Family of Marks.

3. The Applicant is not the person entitled to registration of the Mark in view of section 16(3) of the Act because as of the filing date of the registration the Mark was confusing with each of the YAHOO! Registered Marks as well as the YAHOO! Family of Marks and the YAHOO! Mobile Marks.

4. The Mark is not distinctive and does not actually distinguish nor is adapted to distinguish the wares and services of the Applicant from the wares and services of Yahoo! having regard to the adoption, use, making known and/or registration of each of the YAHOO! marks and the similarity between the Mark on the one hand and each of the YAHOO! Registered Marks, YAHOO! Family of Marks and the YAHOO! Mobile Marks on the other.

Schedule B
Opponent's Registered Marks

MY YAHOO!	TMA706,155
YAHOO!	TMA691,134
YAHOO!	TMA654,433
1-800-MY-YAHOO	TMA651,584
YAHOO!	TMA571,707
YAHOO!	TMA615,851
YAHOO!	TMA568,690
YAHOO!IGANS!	TMA518,947
YAHOO!	TMA556,622
YAHOO!	TMA536,693
YAHOO'S SPORTS BAR & GRILL	TMA550,063