

**IN THE MATTER OF AN OPPOSITION by Westcom Radio Group Ltd., now WIC Radio Ltd., and Shaw Radio Ltd. to application No. 788,606 for the trade-mark ROCKWEB filed by CHUM LTD., also doing business as CHOM-FM**

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On July 26, 1995, the applicant, CHUM LTD., also doing business as CHOM-FM, filed an application to register the trade-mark ROCKWEB based upon proposed use of the trade-mark in Canada in association with services identified as “Telecommunication services, namely storage and dissemination of information through computer networks”.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of February 7, 1996 and the opponents, Westcom Radio Group Ltd. and Shaw Radio Ltd., filed a statement of opposition on July 8, 1996, a copy of which was forwarded to the applicant on July 18, 1996. The opponents have alleged the following grounds of opposition:

- (a) The present application does not comply with Subsection 30(e) of the *Trade-marks Act* in that the trade-mark ROCKWEB has been used in Canada prior to July 26, 1995, the filing date of the present proposed use application;
- (b) The applicant’s trade-mark is not registrable in view of Paragraph 12(1)(b) of the *Trade-marks Act* in that the trade-mark ROCKWEB is clearly descriptive of the character of the applicant’s services;
- (c) The applicant is not the person entitled to registration of the trade-mark ROCKWEB having regard to the provisions of Paragraph 16(3)(a) of the *Trade-marks Act* in that, at the date of filing of the present application, the applicant’s trade-mark was confusing with the trade-mark ROCKWEB, previously used and made known in Canada by Silicon Forest Media, Inc.;
- (d) The applicant’s trade-mark is not distinctive in association with its services since it is not adapted to distinguish the applicant’s services from the wares and services of Silicon Forest Media, Inc., having regard to the fact that the applicant’s mark is likely to be confusing with that of Silicon Forest Media, Inc.;
- (e) The applicant’s trade-mark is not distinctive and is not adapted to distinguish the applicant’s services from the services of others, in that the mark is currently being used in Canada by other than the applicant, namely CHOM 97.7fm of Montreal.

The applicant served and filed a counterstatement in which it generally denied the opponents’ grounds of opposition and asserted that its trade-mark ROCKWEB is registrable and distinctive, that it is the person entitled to its registration, and that the present application complies with Section 30 of the *Trade-marks Act*. The opponents filed as their evidence the affidavits of Richard Yaker and Sharlene R. Olson while the applicant submitted the affidavit of Marylène Gendron. As evidence

in reply, the opponents also submitted the affidavit of Roxanne M. Zapisocki. Further, during the opposition proceeding, the opponent, Westcom Radio Group Ltd., changed its name to WIC Radio Ltd. Both parties filed a written argument and the applicant alone was represented at an oral hearing.

Considering initially the ground of opposition based on Section 30 of the *Act*, the legal burden or onus is on the applicant to show the its application complies with Section 30. This includes both the question as to whether or not the applicant has filed an application which formally complies with the requirements of Section 30 and the question as to whether or not the statements contained in the application are correct. To the extent that the opponents rely on allegations of fact in support of this ground, there is an evidential burden on the opponents to prove those allegations [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. To meet the evidential burden upon them in relation of a particular issue, the opponents must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist [see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293, at p. 298]. Further, the material time for considering the circumstances respecting the issue of non-compliance with Section 30 of the *Act* is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R.(3d) 469, at p. 475].

The opponents have alleged that the present application does not comply with Subsection 30(e) of the *Trade-marks Act* in that the trade-mark ROCKWEB was used in Canada in association with the services covered in the application prior to the filing date of the present application. However, no evidence has been furnished by the opponents to show that the applicant used the trade-mark ROCKWEB prior to filing the present application. As the opponents have failed to meet the evidential burden upon them in respect of this issue, this ground of opposition is unsuccessful.

As their second ground, the opponents allege that the applicant's trade-mark is not registrable in view of Paragraph 12(1)(b) of the *Trade-marks Act* since the trade-mark ROCKWEB is clearly descriptive of the character of the applicant's services. Paragraph 12(1)(b) of the *Act* provides as follows:

*12. (1) Subject to section 13, a trade-mark is registrable if it is not*

*(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;*

The issue as to whether the trade-mark ROCKWEB is clearly descriptive of the character or quality of the applicant's services must be considered from the point of view of the average user of those services. Further, in determining whether the trade-mark ROCKWEB is clearly descriptive, the trade-mark must not be dissected into its component elements and carefully analyzed, but rather 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, at pp. 27-28 and *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183, at p. 186]. Additionally, the material date for considering a ground of opposition based on Paragraph 12(1)(b) of the *Trade-marks Act* is the date of decision [see *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers*, 41 C.P.R. (3d) 243 (F.C.A.)].

While the legal burden is upon the applicant to show that its trade-mark is registrable, there is an initial evidential burden upon the opponents in respect of this ground to adduce sufficient evidence which, if believed, would support the truth of their allegations that the trade-mark ROCKWEB is clearly descriptive of the character or quality of the applicant's services. It is therefore necessary to consider the opponents' evidence in order to determine whether they have met the initial burden upon them. In this regard, the Yaker affidavit describes the use by Silicon Forest Media, Inc., located at Suite 300, 4647 Admiralty Way, Marina del Rey, California, U.S.A., of the trade-mark ROCKWEB in association with the service of a music entertainment on-line service provided over the global Internet. This evidence is therefore of no assistance to the opponents in relation to their Paragraph 12(1)(b) ground. The Olson affidavit introduces into evidence the results of Internet searches conducted by the affiant for the words "Rock Web" and "RockWeb". This evidence, together with the Zapisocki affidavit, confirm that the word "Rock" describes a kind of music while the word "Web" is an abbreviation for the World Wide Web of the Global Internet. Of the 48 site matches for "RockWeb", 39 represent site matches for Silicon Forest Media, Inc. referred to in the Yaker affidavit which is located at <http://www.rockweb.com>. Thus, this evidence points to the use of ROCKWEB as a trade-mark and not in a descriptive sense. As a result, the opponents'

evidence fails to support the allegations made in the statement of opposition relating to the Paragraph 12(1)(b) ground. In any event, I am of the view that the trade-mark ROCKWEB, while certainly suggestive of the applicant's services, is not clearly descriptive of the character or quality of those services. I have therefore rejected the second ground of opposition.

The third ground is based on paragraph 16(3)(a) of the *Trade-marks Act*, the opponents alleging that the applicant is not the person entitled to registration of the trade-mark ROCKWEB in that, at the date of filing of the present application, the applicant's trade-mark was confusing with the trade-mark ROCKWEB, previously used and made known in Canada by Silicon Forest Media, Inc. As Silicon Forest Media, Inc. is not one of the opponents (or one of their predecessors-in-title) in this proceeding, any use by it of the trade-mark ROCKWEB is of no relevance to the applicant's entitlement to registration in view of the provisions of Subsection 17(1) of the *Trade-marks Act*. Consequently, this ground is also unsuccessful.

The remaining grounds of opposition relate to the distinctiveness of the applicant's mark, the opponents asserting that the trade-mark ROCKWEB is not adapted to distinguish the applicant's services in that the mark is currently being used in Canada by other than the applicant, namely CHOM 97.7fm of Montreal and considering the fact that the applicant's mark is likely to be confusing with the trade-mark of Silicon Forest Media, Inc. Initially, I would note that no evidence has been furnished by the opponents in support of their allegation that the trade-mark ROCKWEB is used by a person other than the applicant, namely, CHOM 97.7fm of Montreal. The opponents have therefore failed to meet their evidential burden in respect of this ground. In any event, the applicant is identified as CHUM LTD., also doing business as CHOM-FM and therefore CHOM-FM identifies the applicant. I have therefore rejected this aspect of the non-distinctiveness ground.

With respect to the second aspect of the non-distinctiveness ground, the opponents claim that the activities involving the use by Silicon Forest Media, Inc. of the trade-mark ROCKWEB in relation to its website is such as to render the applicant's trade-mark non-distinctive. In this regard, Mr. Yaker attests to approximately 60,000 connections per day having been made to the Silicon Forest Media, Inc. ROCKWEB website as of July 26, 1995 and approximately 200,000 connections

daily as of the date of his affidavit [March 3, 1997]. However, no evidence has been furnished by Mr. Yaker as to the number of connections by Canadians to the ROCKWEB website. While the opponents would obviously want the Registrar to infer from these numbers that a significant number of Canadians were likely accessing the ROCKWEB website, the meeting of the opponents' evidential burden cannot be left to a matter of inference. The opponents were obliged to establish that Canadians had accessed the ROCKWEB website prior to the date of opposition, the material date for assessing the non-distinctiveness ground, in order to meet their initial burden in relation to this ground. In this regard, I would also note that the Olson affidavit (dated March 6, 1997) deals with matters arising subsequent to the date of opposition and therefore is of little relevance to the non-distinctiveness issue. As a result, I have dismissed this aspect of the non-distinctiveness ground for failure of the opponents to meet their evidential burden.

Having been delegated by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I reject the opponents' opposition pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 30<sup>th</sup> DAY OF SEPTEMBER, 1998.

G.W. Partington  
Chairperson  
Trade-marks Opposition Board