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

**Citation: 2018 TMOB 122**

**Date of Decision: 2018-10-26**

**IN THE MATTER OF AN OPPOSITION**

**HomeZilla Inc.**

**Opponent**

**and**

**Syed Shah**

**Applicant**

**1,700,345 for Homila**

**Application**

THE RECORD

[1] On October 30, 2014 the Syed Shah (the Applicant) filed the application bearing serial No. 1,700,345 to register the trade-mark Homila (the Mark). This application covers the following services: Real estate marketing, namely marketing real estate listings for others, real estate sales, real estate service (the Services).

[2] The application is based on use of the Mark in Canada since July 1, 2014.

[3] The application was published on August 19, 2015 in the *Trade-marks Journal* for the purposes of opposition.

[4] On January 20, 2016 HomeZilla Inc. (the Opponent) filed a statement of opposition which was forwarded to the Applicant by the Registrar on February 12, 2016. The grounds of

opposition pleaded are based on sections 12(1)(d) (registrability); 16(1)(a) (entitlement); 30(i) (compliance); and 2 (distinctiveness) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[5] The Applicant filed a counter statement on April 6, 2016.

[6] The Opponent filed the affidavit of Anna Roppovalente sworn on November 7, 2016 as its evidence. The Applicant filed the affidavit of Syed Shah sworn on March 7, 2017 as its evidence. The Opponent filed the affidavit of Sandy Ward, executed on April 7, 2017 as its reply evidence.

[7] None of the deponents were cross-examined.

[8] The parties did not file written arguments and there was no hearing.

[9] This opposition turns on the issue of likelihood of confusion between the Mark and the Opponent's trade-mark HOMEZILLA.

[10] For the reasons that follow, I refuse the application.

#### PRELIMINARY REMARKS

[11] In reaching my decision I have considered all the evidence in the file. However, I shall only refer to those portions of the evidence which are directly relevant to the issues discussed in the body of my decision.

[12] Ms. Ward is the founder and CEO of the Opponent. Her affidavit was filed as reply evidence. section 43 of the *Trade-marks Regulations* stipulates that such evidence must strictly be confined to matters in reply. There is no allegation in Ms. Ward's affidavit that constitutes evidence in reply to the Applicant's evidence, namely the affidavit of Sayed Shah. Ms. Ward describes the Opponent's business activities and its use of its trade-mark HOMEZILLA. Such evidence should have been filed as the Opponent's evidence under section 41 or as additional evidence, with the Registrar's permission, as prescribed under section 44.

[13] Consequently I shall disregard the content of Ms. Ward's affidavit.

### THE OPPONENT'S EVIDENCE

[14] Ms. Roppovalente is a registered trade-mark agent with the Opponent's agent firm. She attaches as Exhibit A to her affidavit a photocopy of the original Certificate of Registration for the trade-mark HOMEZILLA under No. TMA903,366. It is in the name of the Opponent and it covers a long list of goods and services enumerated in Schedule A to this decision.

[15] Ms. Roppovalente then visited the online Canadian Intellectual Property Office's website and she confirms that the Opponent is the current owner of the trade-mark HOMEZILLA under No. TMA903,366. She filed an extract of the register taken from that website.

### THE APPLICANT'S EVIDENCE

[16] Mr. Shah is the Applicant. He is a registered real estate broker. He is in the business of providing real estate services to clients for purchase and sale and leasing of properties. He provides details as to how he came up with the Mark as a trade-mark for the Services. This information is informative but not relevant to the issues in this opposition.

[17] Mr. Shah states that on June 21, 2014 he acquired and registered the domain name Homila.com and he filed, as Exhibit 2, a copy of the registration details of that domain name. He adds that his website was developed within the next few days and he filed, as Exhibit 3, an invoice dated June 28, 2014 for the development of the website <www.homila.com>.

[18] Mr. Shah states that he has been using the Mark for his real estate practice since July 1, 2014. He affirms that he has done a lot of advertising by promoting his website and the Mark by way of search engine optimization. He promoted his website and the Mark through Google marketing services and he filed, as Exhibit 4, "Google searches" as well as payments made to Google for those services. Without any explanation on the Google report, Exhibit 4, it is difficult to determine the amount spent by Mr. Shah for the advertisement of his website. However, under the line "Total-all campaigns" the amount appearing therein is over \$9,000.

[19] Mr. Shah affirms that he has continuously paid for the development of his website and he filed, as Exhibit 5, the receipts for payments made to the web developer. They total approximately \$20,000.

[20] Mr. Shah states that the Mark became very popular on the worldwide web, among people in the Greater Toronto Area and other places who are looking to buy, sell, or lease properties in the Greater Toronto Area and people started using his website to search for properties. He filed, as Exhibit 6, a list of people who registered through his website and sent him enquiries. The list comprises over 350 email addresses.

[21] Mr. Shah also filed, as Exhibit 7, a copy of his business card on which appears the Mark. Additionally, he also filed, as Exhibit 8, copies of snap shots of his website showing different properties and real estate maps on which is displayed the Mark.

[22] Finally, Mr. Shah affirms that he never ever received any inquiries from anyone asking if "...Homila and/or www.homila.com is associated with Honzilla (sic)".

#### EVIDENTIAL BURDEN

[23] The legal onus is on the applicant to show that the application complies with the provisions 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 to support each ground of opposition exist. Once this initial burden is met, the applicant has to prove, on a balance of probabilities, that the particular ground of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB), *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD), and *Wrangler Apparel Corp v The Timberland Company* [2005] FCJ No 899, (FC)].

#### GROUNDS OF OPPOSITION SUMMARILY DISMISSED

##### **Section 30(i)**

[24] It has often been ruled that section 30(i) of the Act only requires an applicant to declare itself satisfied that it is entitled to use the mark applied for in Canada in association with the goods and services described in the application. Such a statement is included in the present application. An opponent may rely on section 30(i) in specific cases such as where bad faith on

the part of the applicant is alleged [see *Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)].

[25] The Opponent has not filed any evidence of that nature in the record. Therefore it has not met its initial evidential burden.

[26] Consequently, this ground of opposition is dismissed.

### **Section 16(1)(a)**

[27] The relevant date for the ground of opposition based on section 16(1)(a) of the Act, is the alleged date of first use claimed in the present application (July 1, 2014) [see section 16(1) of the Act].

[28] The Opponent pleads that the Applicant is not the person entitled to the registration of the Mark in that, at the relevant date, it was confusing with the Opponent's trade-mark HOMEZILLA previously used in Canada as early as December 2009.

[29] In order to succeed under this ground of opposition, the Opponent must establish first that it has used its trade-mark HOMEZILLA prior to July 1, 2014 in Canada in association with the Opponent's services and that it had not abandoned such use at the advertisement date of the present application (August 19, 2015) [see section 16(5) of the Act].

[30] Since the Opponent has not filed admissible evidence relating to its prior use of its trade-mark HOMEZILLA, it failed to meet its initial burden.

[31] Consequently, this ground of opposition is also dismissed.

### **Section 2 of the Act (distinctiveness)**

[32] The relevant date for this ground of opposition is the filing date of the statement of opposition (January 20, 2016) [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed 2006 FC 657].

[33] Under this ground of opposition, the Opponent had the initial burden to prove that its trade-mark HOMEZILLA was known in Canada to some extent so as to negate the distinctiveness of the Mark.

[34] Given that there is no admissible evidence of prior use of the mark HOMEZILLA in the record, the Opponent failed to meet its initial burden.

[35] Therefore, this ground of opposition is also dismissed.

REGISTRABILITY OF THE MARK (SECTION 12(1)(D) GROUND OF OPPOSITION)

[36] The relevant date to assess this ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA)].

[37] As described above, the Opponent filed a photocopy of a certified copy of registration TMA903,366 for its registered trade-mark HOMEZILLA. I checked the register and this registration is still extant.

[38] Therefore, the Opponent has met its initial burden with respect to this ground of opposition.

[39] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks or trade names have been in use; the nature of the goods, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC), *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC)].

[40] The test under section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether a consumer, with an imperfect recollection of the Opponent's trade-mark, who sees the Applicant's Services in association with the Mark, would think they emanate from, or are sponsored by, or approved by the Opponent.

[41] For the purpose of this decision, the following services are the most relevant:

Advertising and marketing services, namely advertising and marketing the goods and services of others in the fields of real estate, dissemination of advertising and marketing for others in the fields of real estate, mortgages; operating online marketplaces for sellers of goods and services in the field of real estate.

Real estate sales management; real estate marketing services, namely, on-line services featuring tours of real estate, neighbourhood research, providing a marketplace for goods of others in the field of real estate ; providing information in the field of consumer goods for home maintenance, decoration, and sales, and consumer services relating to real estate; promoting the goods and services of others via an online electronic communication network by means of providing links to others' websites in the fields of real estate, mortgages, general consumer merchandise and general consumer services; real estate agencies and brokerages; real estate consultancy and appraisal services, financial valuation of personal property; real estate research services; real estate valuation service, financial valuation of real estate; profile information for neighbourhoods; providing information in the field of real estate; providing non-downloadable computer database software for administering, managing, storing, retrieving, and coordinating the storage of data files featuring information on the field of real estate.

(Collectively referred as the Opponent's services.)

### **Degree of resemblance**

[42] As indicated by the Supreme Court of Canada in *Masterpiece*, in most instances, the degree of resemblance between the marks in issue is the most important relevant factor. One must consider the degree of resemblance from the perspective of appearance, sound and in the ideas suggested by them.

[43] The Mark resembles the Opponent's trade-mark HOMEZILLA, phonetically, visually and in the ideas suggested by them. The first component of each mark is made of the letters HOM, which refers to the common English word "home" when used in association with the

respective parties' services. They also have similar second components namely, on one hand ZILLA and on the other hand ILA.

[44] In all, this factor favours the Opponent. Consequently, I must review the other factors to determine if they favour the Applicant in such a way that they would outweigh the degree of resemblance between the marks.

#### **Inherent distinctiveness of the marks and the extent to which they have become known**

[45] Both marks consist of coined words. However, their components are suggestive of real estate services, as discussed previously.

[46] The degree of distinctiveness of a trade-mark can be enhanced through use and promotion in Canada. In absence of evidence of use, it has been held that the Registrar can only infer a *de minimis* use of a registered trade-mark from the certificate of registration [see *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. *De minimis* use does not support a conclusion that the trade-mark has become known to any significant extent, nor that the trade-mark has been used continuously. Even if I were to consider such argument, I have no indication of the magnitude of such use. Consequently, I am unable to determine the extent to which the Opponent's registered trade-mark would have become known in Canada as of this date.

[47] On the other hand, as described above, I have evidence of use of the Mark by the Applicant in association with the Services. From the evidence in the record, I can conclude that the Mark is more known in Canada than the Opponent's trade-mark HOMEZILLA.

[48] In all, this factor favours the Applicant.

#### **The length of time the trade-marks have been in use**

[49] As it appears from certificate of registration TMA903,366 for the trade-mark HOMEZILLA, a declaration of use of that mark was filed on April 29, 2015 in association with the Opponent's services. On the other hand, the Applicant has established use of the Mark since



at least as early as July 1, 2014, less than a year prior to the filing date of the declaration of use of the Opponent's mark.

[50] This factor slightly favours the Applicant.

### **The nature of the parties' services and the nature of their trade**

[51] Under a section 12(1)(d) ground of opposition, I must compare the services as described in the application with the goods and services covered by the Opponent's registration [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 at 10-11 (FCA); *Henkel Kommanditgesellschaft v Super Dragon* (1986), 12 CPR (3d) 110 at 112 (FCA); *Miss Universe Inc v Dale Bohna* (1994), 58 CPR (3d) 381 at 390-392 (FCA)]. However, those statements must be read with a view to determine the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[52] From a plain reading of the description of the Services and the Opponent's services, it is obvious that they overlap.

[53] Mr. Shah, in his affidavit, states that he is in the business of providing real estate services to clients for purchase and sale and leasing of properties. He states, as mentioned earlier, that he promotes his website through Google marketing services.

[54] I have no evidence of the Opponent's type of business. Nevertheless, given the overlapping of the parties' services, when considering the Opponent's services, as defined above, and given that some of those services are on-line services, I can conclude that the parties' nature of their trade is similar.

[55] Therefore, these factors favour the Opponent.

### **No instances of confusion**

[56] Mr. Shah alleges that no one has inquired whether his business was associated with the Opponent's business. Firstly, the Opponent does not need to prove instances of confusion. The burden is on the Applicant to establish, on a balance of probabilities, that there is no likelihood of confusion. Moreover, the list of clients provided by the Applicant comprises only approximately 350 names from the Greater Toronto Area. Finally, we have no information as to the extent of the Opponent's use of its trade-mark HOMEZILLA. If that mark has not been used extensively in the same market than the Applicant's Mark, it is not surprising that no instances of confusion have been reported.

### **Conclusion**

[57] I conclude that the Applicant has not discharged its burden to prove that, on a balance of probability, there is no likelihood of confusion between the Mark and the Opponent's trade-mark HOMEZILLA when used in association with the Services.

[58] I reach this conclusion on the basis that the marks resemble phonetically, visually and in the ideas suggested by them. Moreover, there is an overlap in the parties' services and the nature of their businesses. The fact that the evidence in the record shows that the Applicant's Mark is more known in Canada than the Opponent's trade-mark HOMEZILLA and that it has used the Mark for a slightly longer period of time is not sufficient to override the effect of the degree of resemblance between the marks in issue and the similarities in the parties' channels of trade and businesses.

[59] A consumer, with an imperfect recollection of the Opponent's trade-mark HOMEZILLA, who sees the Services being offered in association with the trade-mark HOMILA could reasonably think that the Services emanate from, or are sponsored by, or approved by the Opponent.

[60] For all these reasons, I maintain this ground of opposition.

DISPOSITION

[61] 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.

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

## SCHEDULE A

### Goods:

(1) Computer software, namely, consumer data storage software for administering, managing, storing and retrieving and coordinating the storage data files in the fields of real estate, general consumer merchandise, mortgages, and general consumer services; computer software for use in database management featuring information in the fields of real estate, general consumer merchandise and general consumer services.

(2) Non-downloadable computer e-commerce software to allow users to perform electronic business transactions; non-downloadable computer database software for administering, managing, storing, retrieving, and coordinating the storage of data files featuring information in the fields of general consumer merchandise and general consumer services; non-downloadable computer database software for administering, managing, storing, retrieving, and coordinating the storage of data files featuring information in the field of real estate.

### Services

(1) Advertising and marketing services, namely advertising and marketing the goods and services of others in the fields of real estate, general consumer merchandise and general consumer services; dissemination of advertising and marketing for others in the fields of real estate, mortgages, general consumer merchandise and general consumer services via an online electronic communications network; on-line services featuring neighbourhood research and listing presentations; webservices, namely the operation of a website to provide information on neighbourhoods, both geo-data and historic trend and to sell/share data with other websites and backend data systems; operating online marketplaces for sellers of goods and services in the field of real estate.

(2) Real estate sales management; real estate marketing services, namely, on-line services featuring tours of real estate, neighbourhood research, providing a marketplace for goods of others in the field of real estate, general consumer merchandise and general consumer services via an online electronic communication network; providing information in the field of consumer goods for home maintenance, decoration, and sales, and consumer services relating to real estate; promoting the goods and services of others via an online electronic communication network by means of providing links to others' websites in the fields of real estate, mortgages, general consumer merchandise and general consumer services; real estate agencies and brokerages; real estate consultancy and appraisal services, financial valuation of personal property; real estate research services; design of computer software; providing non-downloadable software tools for others to design and create websites; hosting websites for other including blogs, providing access to non-downloadable computer software, namely, non-downloadable consumer data storage software for administering, managing, storing, retrieving and coordinating the storage of data files in the area of real estate; providing non-downloadable computer e-commerce software to allow users to perform electronic business transactions; providing non-downloadable computer database software for administering, managing, storing,

retrieving, and coordinating the storage of data files featuring information in the fields of general consumer merchandise and general consumer services; web services; API providing temporary and downloadable information to provide neighbourhood information and real estate listings; real estate valuation service, financial valuation of real estate; profile information for neighbourhoods; providing information in the field of real estate; providing non-downloadable computer database software for administering, managing, storing, retrieving, and coordinating the storage of data files featuring information on the field of real estate.

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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No Hearing Held

Dentons Canada LLP *or* No Agent Appointed

FOR THE OPPONENT

No Agent Appointed

FOR THE APPLICANT