



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

Citation: 2018 TMOB 149

Date of Decision: 2018-11-30

IN THE MATTER OF AN OPPOSITION

ISTOCKPHOTO LP

Opponent

and

Istockhomes Marketing Ltd.

Applicant

1,633,986 for ISTOCKHOMES

Application

INTRODUCTION

[1] IStockPHOTO LP (the Opponent) opposes registration of the trade-mark ISTOCKHOMES (the Mark), which is the subject of application No. 1,633,986. The application was filed by Bradley D. Camp (Camp) and Paul V. Hoffman (Hoffman), and was subsequently assigned to Istockhomes Marketing Ltd. (Istockhomes Marketing) (Camp, Hoffman and Istockhomes Marketing referred to as the Applicant unless specified otherwise).

[2] The application for the Mark is in association with the following services (the Services), and is based on proposed use in Canada:

Providing an Internet website portal offering information in the field of residential and commercial real estate; providing an online bulletin board in the field of housing sales and rentals; operation of a website in the field of home renovations; real estate services;

advertising the wares and services of others; electronic billboard advertising of the wares and services of others.

[3] The Opponent owns registrations for the following trade-marks: ISTOCK (TMA719,307), ISTOCKPHOTO (TMA660,331), ISTOCKPRO (TMA669,030), ISTOCKAUDIO (TMA727,658), and ISTOCKVIDEO (TMA728,325) (collectively the ISTOCK Trade-marks and ISTOCK Registrations, the particulars of which are set out in Schedule A). The Opponent's ISTOCK Registrations, in particular registrations for the trade-marks ISTOCK and ISTOCKPHOTO, cover a variety of services generally including the provision of a searchable online database of digital photographs, illustrations, audio, video, fonts, code snippets and other design elements, which allows for the sale or free giveaway and download of digital photographs, illustrations, audio, video, fonts, code snippets and other design elements to others.

[4] The Opponent alleges grounds of opposition based on non-compliance with sections 30(e) and 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), confusion (section 12(1)(d)), entitlement (sections 16(3)(a) and (c)), and distinctiveness (section 2). A key issue in this proceeding is the likelihood of confusion with the Opponent's ISTOCK Trade-marks.

[5] For the reasons that follow, the opposition is rejected.

THE RECORD

[6] The application for the Mark was filed by Camp and Hoffman on July 4, 2013 and was advertised for opposition purposes in the *Trade-marks Journal* of June 4, 2014. The application was assigned to Istockhomes Marketing effective October 1, 2014.

[7] On November 4, 2014 the Opponent filed a statement of opposition under section 38 of the Act.

[8] The Applicant denied each of the grounds of opposition in a counter statement filed on March 30, 2015.

[9] In support of its opposition, the Opponent filed the affidavits of Kjelti Wilkes Kellough, and Penelope Brady. In support of its application, the Applicant filed the affidavits of Bradley David Camp, and Coreen Adelle Hanson. No cross-examinations were conducted.

[10] Both parties filed a written argument, and no hearing was held.

ONUS AND MATERIAL DATES

[11] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements 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 [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[12] The material dates that apply to the grounds of opposition pleaded are:

- Sections 38(2)(a)/30 – the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Sections 38(2)(b)/12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade-marks* (1991), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c)/16(3) – the filing date of the application [section 16(3) of the Act]; and
- Sections 38(2)(d)/2 – the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185 (CanLII), 34 CPR (4th) 317 (FC)].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 30(i) ground – summarily dismissed

[13] The Opponent has pleaded that contrary to sections 38(2)(a) and 30(i), the Applicant could not have been, at the time the application was filed, and cannot now be, satisfied of its

entitlement to use the Mark in Canada in association with the Services in the application in light of the prior use in Canada by the Opponent of the Opponent's ISTOCK Trade-marks.

[14] Where an applicant has provided the statement required by section 30(i) of the Act, a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. Mere knowledge of the existence of an opponent's trade-mark does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use the Mark [*Woot Inc v Woot Restaurants Inc/Les Restaurants Woot Inc*, 2012 TMOB 197 (CanLII)].

[15] In the present case, the Applicant has provided the necessary statement and this is not an exceptional case. Accordingly, the section 30(i) ground is rejected.

Section 30(e) ground

[16] The Opponent has pleaded that contrary to sections 38(2)(a) and 30(e) of the Act, the application was filed based on proposed use and the Mark was used prior to the filing date of the application.

[17] A proposed use application will be refused where the evidence points to use of the applied-for mark in advance of the filing date [*Sao Paulo Alpargatas v But Fashion Solutions (Comercio e Industria de Artigos em Pele, LDA)*, 2012 TMOB 178 (CanLII)].

[18] Since the facts regarding the Applicant's intentions are particularly within the knowledge of the Applicant, the initial burden on the Opponent under section 30(e) is lighter [*Molson Canada v Anheuser-Busch Inc* (2003), 2003 FC 1287 (CanLII), 29 CPR (4th) 315 (FCTD); *Green Spot Co v JB Food Industries* (1986), 13 CPR (3d) 206 (TMOB); *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. I am also aware that, even if an opponent is unable to adduce any evidence concerning use of the Mark prior to the filing date, the opponent is not limited to relying only on "clearly inconsistent" evidence adduced by the applicant: see *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at paragraphs 30 - 38 (CanLII). On this issue, all of the pertinent evidence of record is to be assessed according to the usual criteria, that is, taking into consideration its provenance

(including its quality and reliability), the absence of evidence that might reasonably be expected to exist, whether the evidence has been tested on cross-examination and if so, how it fared. Multiple diverse considerations inform the assessment of evidence (*Corporativo, supra* at paragraph 37).

[19] In its written argument, the Opponent notes that it has submitted the following as evidence in support of its pleading that the Applicant used the Mark prior to the filing date of the application, namely July 4, 2013:

- The Applicant created a Twitter account in April, 2013 (Brady affidavit, Exhibit Q). The Twitter handle “@istockhomes” incorporates the Mark;
- The Applicant’s LinkedIn page says that it was founded in 2012 (Brady affidavit, Exhibit O); and
- The Applicant’s domain name *www.istockhomes.com* was created on April 24, 2013. The domain name incorporates the Mark (Brady affidavit, Exhibit M).

[20] The Opponent further submits that the only evidence that the Applicant has provided on this point is in regards to a Tumblr post that Mr. Camp alleges he made on the Applicant’s Tumblr page dated July 28, 2013, stating that the Applicant was “getting close to opening the doors”. For ease of reference, portions of the relevant paragraph from the Camp affidavit are reproduced below (Camp affidavit, para 6):

6. ... On July 28, 2013, I posted a message on the Applicant’s Tumblr page stating that I was “getting close to opening the doors”, by which I meant that I had not yet commenced business using the Applicant’s Mark. On July 28, 2013, I also posted a link to this Tumblr message on the Applicant’s Twitter page. Now shown to me and attached as Exhibit “2” is a copy of an extract printed from the Applicant’s Tumblr page showing the July 28, 2013 posting. Now shown to me and attached as Exhibit “3” is a copy of an extract from the Applicant’s Twitter page showing the July 28, 2013 posting.

[21] The Opponent submits that this post cannot be interpreted as clear and unequivocal evidence that the Applicant had not yet commenced using the Mark in Canada in association with the Services as of the date that the application was filed. The Opponent submits that “opening the doors” of a business does not necessarily mean that the claimed services or

ancillary services were not already being performed in association with the Mark. The Opponent adds that it is curious that the Applicant's evidence does not also contain any Tumblr posts or Twitter tweets from a date that is after this Tumblr post, and that given the use of such social media by the Applicant in the lead up to "opening the doors, it seems odd that similar pronouncements wouldn't be posted after the business was up and running".

[22] In my view, the evidence of record discussed above is not sufficient for the Opponent to meet its evidentiary onus when the evidence is assessed according to the criteria set out in *Corporativo, supra*.

[23] With respect to registration of the domain name, it has been established that the mere registration of a domain name does not constitute use, as defined in section 4 of the Act, of a trade-mark [*Sun Media Corporation v The Montreal Sun (Journal Anglophone) Inc*, 2011 CarswellNat 940 (TMOB), 2011 TMOB 15 (CanLII); 4358376 *CanSada Inc v 770879 Ontario Ltd*, 2012 TMOB 213 (CanLII), CarswellNat 5263 (TMOB); *Lofaro v Esurance Inc*, 2010 TMOB 216 (CanLII)]. Similarly, I consider that neither the mere establishment of a Twitter account bearing the Twitter handle "@istockhomes" nor the fact the Applicant may have been founded in 2012 (as noted in the LinkedIn reference), support a finding of use, as defined in section 4 of the Act. Rather, I consider that the founding of the Applicant, the creation of a Twitter account, domain name, and Tumblr page constitute evidence of an intention to use the Mark [*Opus Corporation v HomeOpus*, 2017 TMOB 57].

[24] With respect to the Opponent's submissions on the "curious" absence of posts in the Applicant's evidence, including Tumblr posts post-dating the single Tumblr post provided, I cannot speculate as to the reason why the Applicant elected not to file such evidence in the context of this opposition. Further, in the absence of cross-examination of Mr. Camp, I have no reason to draw negative inferences from any shortcomings in his evidence.

[25] Accordingly, the section 30(e) ground is dismissed.

Section 12(1)(d) ground

[26] The Opponent has pleaded that the Mark is not registrable because it is confusing with the Opponent's ISTOCK Registrations. Having exercised the Registrar's discretion to check the

Register [*Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)], I confirm the Opponent's ISTOCK Registrations are in good standing. In particular, I note the Opponent's registration for the trade-mark ISTOCK, which covers the following services, is in good standing:

Providing a searchable online database of digital photographs, digital illustrations, digital audio recordings, digital video recordings, digital fonts and other digital design elements which allows for the sale or free giveaway and download of digital photographs, digital illustrations, digital audio recordings, digital video recordings, digital fonts and other digital design elements to others;(2) Providing an online social network and discussion forum related to digital photographs, digital illustrations, digital audio recordings, digital video recordings, digital fonts and other digital design elements, namely, discussion forums related to the topics of: digital design tools, software and hardware; creative processes and methods relating to the creation, editing and usage of digital content; traditional and digital photography methods and processes; intellectual property matters, training, articles, tutorials and quizzes relating to the creation, editing and usage of visual and audio content; (3) providing online support services for the upload and download of digital photographs, illustrations, audio, video, fonts and other digital content over the Internet.

[27] The Opponent has therefore met its initial burden with respect to this ground.

[28] As the Opponent has satisfied its initial burden, I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with the Opponent's ISTOCK Trade-marks.

[29] In assessing this ground of opposition, I will focus on the Opponent's registration for the trade-mark ISTOCK (TMA719,307) as I consider this registration to represent the Opponent's strongest case. If there is no likelihood of confusion found between the Mark and this registration, it is unlikely that a likelihood of confusion would be found between the Mark and the Opponent's other registrations.

Test to determine confusion

[30] 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 goods or

services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[31] Accordingly, section 6(2) 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 purchasers of the Applicant's Services, provided under the trade-mark ISTOCKHOMES, would believe that those Services were being provided by the Opponent, or that the Applicant was authorized or licensed by the Opponent who offers services under the trade-mark ISTOCK.

[32] 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 goods, 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. These enumerated factors need not be attributed equal weight [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 (CanLII), 49 CPR (4th) 321 (SCC); *Masterpiece v Alavida Lifestyles Inc*, 2011 SCC 27 (CanLII), 92 CPR (4th) 361 (SCC) (*Masterpiece*)]. However, as noted by the Supreme Court of Canada in *Masterpiece*, although the degree of resemblance is the last factor cited in section 6(5) of the Act, it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion (*Masterpiece*, para 49).

Inherent distinctiveness of the trade-marks and the extent to which they have become known

[33] The Opponent's trade-mark ISTOCK possesses a low degree of inherent distinctiveness as it is highly suggestive of the Opponent's services of providing (or 'stocking', if the word 'stock' is applied as a verb) a searchable database of 'stock photography'. In this regard, I note the Applicant's inclusion of the entry for "stock photography" from Wikipedia (Exhibit 11, Hanson affidavit), which defines it as:

"the supply of photographs, which are often licensed for specific uses. It is used to fulfill the needs of creative assignments instead of hiring a photographer, often for a lower cost.

Today, stock images can be presented in searchable online databases. They can be purchased and delivered online...”

[34] I accept this Wikipedia evidence even though it is hearsay since the Opponent had an opportunity to reply to it [*Virgin Enterprises Limited v Body Shop International Plc*, 2015 TMOB 37 (CanLII) at para 42; *Association of Professional Engineers, Geologists and Geophysicists of Alberta v Alberta Institute of Power Engineers*, 2008 CanLII 88222 (TMOB)].

[35] In its written argument, the Applicant submits that the letter “I” in the Opponent’s ISTOCK trade-mark is suggestive of internet based services given that the letter is commonly recognized as a reference to the “internet”, although no dictionary or similar reference resource is provided to substantiate this assertion. In any event, regardless of whether the letter “I”, in the context of the trade-mark ISTOCK, would possibly be considered to suggest the services are internet based, or else simply seen as a personal pronoun, I consider the Opponent’s ISTOCK trade-mark to be highly suggestive.

[36] Similarly, I am of the view that the Mark ISTOCKHOMES possesses a fairly low level of inherent distinctiveness given that it is also suggestive of the Services, which include “providing an internet website portal offering information in the field of residential... real estate; real estate services”.

[37] In its written argument, the Applicant submits that the Mark is a double entendre in that it is also suggestive of the fictional detective, Sherlock Holmes, although it provides no evidence establishing that the average consumer would in fact make this connection. Even though I do not see the Mark as comprising a double entendre, if I am wrong in this finding, I note that it would not affect my overall finding on this factor.

[38] The distinctiveness of a trade-mark may be further increased through promotion or use. In this case, the Opponent has submitted evidence, through the affidavit of Kjelti Wilkes Kellough, Vice President, Corporate Counsel of both the Opponent and its parent company, Getty Images, Inc (Getty Images), showing the use of the ISTOCK and ISTOCKPHOTO trade-marks in Canada.

[39] Portions of the Kellough affidavit are summarized below. In particular, Ms. Kellough states that:

- The Opponent is a limited partnership company formed under the laws of Alberta, Canada, and commenced operations in 2000, as one of the first websites on the Internet that hosted user generated images for use and download by its users. Initially, these images were provided to website users at no charge (paras 5, 6).
- Shortly after 2000, the Opponent transitioned into a micropayment system for the use and download of images on its website (para 7).
- In February 2006, the Opponent was acquired by Getty Images, and following its acquisition, the Opponent became a wholly-owned subsidiary of Getty Images (para 8).
- To date, the Opponent continues to provide users of its website at *www.istockphoto.com* (the Opponent's Website) with royalty-free, user generated photographs and images, media and design elements that are sourced by approved contributors from the general public. Through the Opponent's Website, the Opponent and its affiliate companies offer millions of handpicked photos, illustrations, videos and audio tracks, most of which may be used for commercial purposes (para 9). The Opponent currently has tens of millions of digital assets in its collection (para 10).
- In conjunction with providing an online database of images, video and audio, the Opponent also operates an online social network and discussion forum, online support services, and related services (para 11), and all of the foregoing business and activities are carried out in association with the Opponent's ISTOCK and ISTOCKPHOTO trade-marks (para 12).
- The Opponent has used the trade-marks ISTOCK and ISTOCKPHOTO extensively in association with its business, including on the Opponent's Website (para 14). In fact, the driver of the Opponent's business is the Opponent's Website. The services offered by the Opponent, from its database of images, video and audio, are provided through the Internet and specifically, the Opponent's Website (para 15). In addition, the Opponent's

online social network and discussion forum are hosted at a Getty Images website on which the Opponent's trade-mark ISTOCK appears prominently (para 15).

- Exhibit B includes printouts from the Opponent's website as it currently appears; I note that the trade-mark ISTOCK appears on the website (it also appears as a watermark on stock photographs appearing on the website), the website also includes a notice attributing ownership of the "istock design" trade-mark to the Opponent. Exhibit C is comprised of screenshots from *archive.org* displaying the Opponent's Website as it appeared between 2001 and 2013; I note that the trade-marks ISTOCKPHOTO and ISTOCK appear on various of these screenshots (para 15; Exhibits B, C).
- The Opponent registered the domain name *www.istockphoto.com* on January 6, 2000. Getty Images owns registrations for the domain names *www.istock.com*, *www.istockaudio.com*, and *www.istockvideo.com*. These domains redirect to the *www.istockphoto.com* website, which is currently registered to Getty Images (para 16, Exhibit D).
- Through the Opponent's Website, users are able to browse images, video and audio content generated by other users that has been approved for uploading by the Opponent. To acquire the right to download and use the content from the Opponent's Website, a user must buy "credits", which are the transactional currency used on the Opponent's Website. Users may purchase credits using real-world currency, including Canadian Dollars and US Dollars. The number of credits required to purchase content on the Opponent's Website varies with the content in question (para 17).
- Alternatively, a user can purchase a monthly or annual subscription for licensing content through the Opponent's Website (para 18).
- The Opponent's Website has been available to Canadians since it first launched in 2000, and many Canadians have accessed and used the Opponent's Website. There have been tens of millions of unique visitors to the Opponent's Website each year for the past five years, with Canadian unique visitors exceeding a million per year since 2011 (para 19).

- In 2007, the Opponent had worldwide sales (represented by the total value of credits sold on the Opponent's Website) in excess of \$70 million USD, and its business has grown since that time (para 20). However, I note that there is no indication of what amount or percentage of these worldwide sales is attributable to consumers from Canada. I further note that no other sales information (for example, a breakdown of the sales attributable under each trade-mark; and any other annual sales figures) is provided.
- The Opponent and Getty Images have used the ISTOCKPHOTO and ISTOCK trade-marks on invoices issued to customers for the purchaser of credits on the Opponent's Website, as well as for paid subscriptions to the Opponent's Website. I note that among the representative samples of invoices provided by the Opponent are two invoices addressed to customers in Canada; one dated June 8, 2015 bearing the trade-mark ISTOCK and one dated January 15, 2010 bearing the trade-mark ISTOCKPHOTO (para 21, Exhibit E).
- To promote its services, the Opponent advertises by means of banner ads on approximately 300+ websites worldwide. Tens of millions of banner impressions have been delivered to Canadian users in the past 3 years (para 22; Exhibit F).
- The Opponent also advertises by means of acquiring keywords and advertisement on search engines, including Google and Yahoo, spending tens of thousands of dollars each year in respect of same (para 22; Exhibit G). The Opponent further promotes its services through social media such as Facebook, Instagram and Twitter; screenshots from these websites bearing the ISTOCK trade-mark are included at Exhibit H (para 23).
- The Opponent has also placed advertisements for its services in print advertising around the world (para 24). I note that while the Opponent has identified various publications targeting the North American region, it does not indicate the number or proportion of advertisements targeted to Canadian consumers or that would have been seen by consumers in Canada (para 24, Exhibit I).

[40] In view of the above, I find that the Opponent's ISTOCK trade-mark has acquired a considerable degree of distinctiveness.

[41] There is some indication in the Kellough affidavit that the Opponent's parent company Getty Images has also used the Mark. However, this has not been raised by the Applicant as an issue which might affect the distinctiveness of the Opponent's trade-mark. In the absence of cross-examination of Ms. Kellough, I am prepared to infer that there was no loss of distinctiveness of the Opponent's trade-mark through any possible use of the trade-mark by Getty Images.

[42] With respect to the applied for Mark, which is based on proposed use in Canada, the Applicant, through the affidavit of Mr. Camp, Director of the Applicant, advises that the Applicant has now begun to use the Mark in association with at least some of the services listed in the Application (Camp affidavit, para 9). Limited evidence of use of the Mark is provided, in particular print-outs of social media pages (which appear to be circa November 2015, though the dates are not readily ascertainable for all of the print-outs) for the Applicant, namely Facebook, LinkedIn, Twitter, Tumblr, and Google+ advertising some of the Services (Camp affidavit, para 5; Exhibit 1).

[43] Accordingly, this factor favours the Opponent.

Length of time the trade-marks have been in use

[44] The Opponent's registration for the trade-mark ISTOCK claims use since at least as early as January 1, 2005; as discussed above, the Opponent has filed evidence of use of the ISTOCK trade-mark.

[45] In contrast, the Applicant's application is based on proposed use and the Applicant has filed very limited evidence of use.

[46] Accordingly, this factor also favours the Opponent.

Nature of the services and trade

[47] When considering sections 6(5)(c) and 6(5)(d) of the Act, it is the statement of goods and services in the application and the statement of goods and services in an opponent's registration that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act

[*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful [*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); *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[48] The nature of the parties' services and business is very different. Through the Opponent's Website, the Opponent provides users with royalty-free, user generated photographs and images (*ie*, stock images), media and design elements that are sourced by approved contributors from the general public. Users are offered millions of handpicked photos, illustrations, videos and audio tracks, most of which may be used for commercial purposes (Kellough affidavit, paras 7, 9).

[49] In contrast, the Applicant's listed Services encompass "providing an Internet website portal offering information in the field of residential and commercial real estate; providing an online bulletin board in the field of housing sales and rentals; operation of a website in the field of home renovations; real estate services; advertising the wares and services of others; electronic billboard advertising of the wares and services of others". The Applicant has a website at *www.istockhomes.com* (Camp affidavit, para 6).

[50] In its written argument, the Opponent takes the position that "although at first blush the subject matter of the Services appears to be different than the subject matter of the Opponent's services, at their core, both the website from which the Applicant carries on business (the Applicant's Website) and the Opponent's Website are marketplaces where business and individual consumers can purchase goods and services." However, while it may be that both parties provide an internet-based marketplace, I do not consider this to be determinative as this comprises an extremely broad category and the parties' business areas (stock digital images and media versus real estate information and home renovation related services) are substantively distinct and focused in very different areas.

[51] The Opponent also submits the Opponent's services are "aimed at consumers in every possible industry sector, including, without limitation, consumers who are in the real estate, real estate marketing and mortgage professions". I assume this statement is in reference to Ms. Kellough's statement that "among the tens of millions of digital assets in the Opponent's collection are digital images of houses and homes, which are able to be used for real estate marketing and related industries" (Kellough affidavit, para 10). The Opponent further submits that these same individuals – namely real estate agents, real estate marketing professionals, and mortgage professionals - are among the intended consumers for the Applicant's Services.

[52] In its written argument, the Applicant submits that "it is hard to image (*sic*) anything that is not likely to be included as subject matter in at least some of the "tens of millions" of images in the Opponent's collection", and that the Opponent's services overlap with the Applicant's Services no more than they overlap with services relating to the subject matter of any other images in the Opponent's collection. I agree with the Applicant's reasoning and do not consider this potential for overlap to be of particular significance.

Degree of resemblance

[53] When considering the degree of resemblance between trade-marks, they must be considered in their totality; it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the marks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* 2006 SCC 23 (CanLII) at para 20].

[54] There is a significant degree of resemblance between the parties' marks in appearance, sound, and ideas suggested as the Mark incorporates the entirety of the Opponent's registered trade-mark ISTOCK. I do not consider the addition of the word HOMES to diminish the resemblance between the parties' trade-marks given that it appears to be suggestive of the Applicant's Services (*inter alia*, providing information in the field of residential real estate; providing an online bulletin board in the field of housing sales and rentals; operation of a website in the field of home renovations).

[55] The Applicant, in its written argument, submits that "the word HOMES, which is the dominant feature of the Applicant's Mark, is not present in any of the Opponent's ISTOCK

Trade-marks, and it suggests ideas that are not present in any of the Opponent's Trade-marks – in particular, a place to live **and the surname of a famous literary detective**" (emphasis added). As previously discussed, I do not consider the Mark to be suggestive of the fictional detective Sherlock Holmes. While the Applicant's evidence indicates that, in actual use, the Mark appears in proximity to an image of "a sleuth with a magnifying glass suggestive of Sherlock Holmes" (Camp affidavit, para 7; Exhibit 4), there is no evidence that consumers would associate this image with the fictional detective character Sherlock Holmes. Moreover, in any event, this is not a relevant consideration as the issue of confusion is to be decided only with respect to the Mark as applied for [*PEI Licensing Inc v Disney Online Studios Canada Inc*, 2012 TMOB 49 at para 26]. In this case, the applied-for Mark consists solely of the phrase ISTOCKHOMES.

[56] Accordingly, this factor strongly favours the Opponent.

Surrounding circumstance – Family of marks

[57] In its written argument, the Opponent submits that it has registered and used a family of ISTOCK formative marks, and that this family of marks should be afforded a broader ambit of protection than if the Opponent owned only one such mark. The Opponent submits this is because the public is likely to believe that the Mark is yet another in the Opponent's ISTOCK family of marks in light of the similarities between the Mark and the Opponent's Trade-marks and the overlap between the respective services, business, and nature of trade.

[58] Where there is a family of trade-marks, there may be a greater likelihood that the public would consider a trade-mark that is similar to be another trade-mark in the family and consequently, assume that the product or service that is associated with that trade-mark is manufactured or performed by the same person [*Everex Systems Inc v Everdata Computer Inc*, (1992), 44 CPR (3d) 175 at 183 (FCTD)]. There is, however, no presumption of the existence of a family of marks in opposition proceedings. A party seeking to establish a family of marks must establish that it is using more than one or two trade-marks within the alleged family [*Techniquip Ltd v Canadian Olympic Assn* (1998), 145 FTR 59 (FCTD), aff'd 250 NR 302 (FCA); *Now Communications Inc v CHUM Ltd* (2003), 32 CPR (4th) 168 (TMOB)].

[59] In this case, the Opponent has only shown use of the trade-marks ISTOCK and ISTOCKPHOTO. While there is evidence that the trade-marks ISTOCKAUDIO and ISTOCKVIDEO have been incorporated into domain names which then redirect to the Opponent's Website (*www.istockphoto.com*), I do not consider this to constitute trade-mark use pursuant to section 4 of the Act, particularly as there is no evidence that either of these trade-marks, as part of their original URL (*www.istockaudio.com* and *www.istockvideo.com*), would be displayed in association with the Opponent's services accessible via the Opponent's Website following the redirect [*McMillan LLP v SportsLine.com, Inc.*, 2014 TMOB 51 (CanLII)]. See also *Sun Media Corporation v The Montreal Sun*, *supra* which establishes that the mere registration of a domain name does not constitute use of a trade-mark pursuant to section 4 of the Act].

[60] Accordingly, I do not find that the Opponent has evidenced that it has a family of ISTOCK trade-marks such that there would be an increased likelihood of confusion.

Surrounding circumstance – Examination of the Mark at CIPO and USPTO

[61] Through the Camp affidavit, the Applicant has included a copy of an extract from the Canadian Intellectual Property Office (CIPO) website showing the status of the Applicant's application as at March 27, 2014 (Camp affidavit, para 8; Exhibit 5). Mr. Camp states that "on March 27, 2014, CIPO approved the application without issuing an examination report identifying any registered or pending trade-marks which would be considered confusing with the Applicant's Mark". The Applicant submits that this supports its contention that there is no likelihood of confusion between the parties' trade-marks.

[62] Notwithstanding that a copy of the file history for the application has not been provided, it has previously been noted that this Board is not in a position to explain findings by the examination section of the Canadian Trade-marks Office [*Drummond Brewing Company Ltd v Moosehead Breweries Ltd*, 2017 TMOB 113 at para 62]. The examination section does not have before it evidence that is filed by the parties in an opposition proceeding and the burden is different in examination [see sections 37 and 38 of the Act; *Thomas J Lipton Inc v Boyd Coffee co* (1991), 40 CPR (3d) 272 at 277 and *Proctor & Gamble Inc v Morlee Corp* (1993), 48 CPR (3d) 377 at 386].

[63] The Applicant also provides a copy of an extract from a favorable initial office action from the United States Patent and Trademark Office (USPTO) for the Applicant's corresponding application to register the trade-mark ISTOCKHOMES in the United States (Camp affidavit, para 9; Exhibit 6). Mr. Camp states that the USPTO's search of its records "did not recover any similar registered or pending marks which would bar registration of the trade-mark in the US". However, the mere fact that parties' marks may co-exist on foreign trade-mark registers (though in the present case I note that such evidence has not even been provided) is not binding on the Registrar [*Quantum Instruments Inc v Elinca SA* (1995), 60 CPR (3d) 264 (TMOB)]. In this regard, there may be other factors that justify the co-existence of two marks on a register in a foreign jurisdiction that do not exist in Canada (for instance, differences in the law, a different state of the register, etc) [*Barilla G v Nam Phuong VN Company Limited*, 2016 TMOB 174 (CanLII) at para 45].

[64] Accordingly, I do not consider these to be surrounding circumstances assisting the Applicant.

Conclusion

[65] As noted above, section 6(2) of the Act is not concerned with confusion between the marks themselves, but rather confusion as to the source of the services.

[66] In this case, an assessment of confusion asks whether a consumer confronted with the Mark in association with the Services would be confused and think that they emanate from the Opponent, who, through its website provides users with access to millions of royalty-free stock photographs, most of which may be used for commercial purposes. On a balance of probabilities, I do not find that they would.

[67] Although the section 6(5)(e) factor strongly favours the Opponent, and the section 6(5)(a) and (b) factors also favour the Opponent, having regard to all the surrounding circumstances, in particular, the differences in the nature of the parties' services and business, I find that the balance of probabilities between finding that there is no reasonable likelihood of confusion, and that there is a reasonable likelihood of confusion falls slightly in favour of the Applicant. Accordingly, this ground of opposition is rejected.

[68] I note that had the Opponent established use of a family of trade-marks, it may possibly have convinced me that the balance of probabilities in this case would have been equal; this would have led to a finding that the Applicant would not have met its legal onus.

Sections 16(3)(a) and (c), and 2

[69] In this case, the date at which the issue of confusion is assessed does not change the result of my analysis. Accordingly, to the extent that the Opponent has met its initial burden in respect of these grounds, they all fail for reasons similar to those set out above with respect to the section 12(1)(d) ground of opposition.

DISPOSITION

[70] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Jennifer Galeano
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE No Hearing Held

AGENT(S) OF RECORD

Clark Wilson LLP

FOR THE OPPONENT

Shift Law

FOR THE APPLICANT

SCHEDULE A

Reg. No.	Trade-mark	Services	Use Claim
TMA660,331	ISTOCKPHOTO	(1) Providing a searchable online database of digital photographs, illustrations, audio, video, fonts, code snippets and other design elements, which allows for the sale or free giveaway and download of digital photographs, illustrations, audio, video, fonts, code snippets and other design elements to others; providing an online discussion forum related to digital photographs, illustrations, audio, video, fonts, code snippets and other design elements, including discussion forums related to the topics of: digital design tools, software and hardware; creative process; traditional and digital photography methods and processes; training, articles, tutorials and quizzes; providing online support services for the upload and download of digital photographs, illustrations, audio, video, fonts, code snippets and other design elements over the Internet.	Used in CANADA since at least April 07, 2000
TMA719,307	ISTOCK	(1) Providing a searchable online database of digital photographs, digital illustrations, digital audio recordings, digital video recordings, digital fonts and other digital design elements which allows for the sale or free giveaway and download of digital photographs, digital illustrations, digital audio recordings, digital video recordings, digital fonts and other digital design elements to others;(2) Providing an online social network and discussion forum related to digital photographs, digital illustrations, digital audio recordings, digital video recordings, digital fonts and other digital design elements, namely, discussion forums related to the topics of: digital design tools, software and hardware; creative	Used in CANADA since at least January 01, 2005.

		processes and methods relating to the creation, editing and usage of digital content; traditional and digital photography methods and processes; intellectual property matters, training, articles, tutorials and quizzes relating to the creation, editing and usage of visual and audio content; (3) providing online support services for the upload and download of digital photographs, illustrations, audio, video, fonts and other digital content over the Internet.	
TMA669,030	ISTOCKPRO	<p>(1) Providing a searchable online database of digital photographs, illustrations, audio, video, fonts, code snippets and other design elements, which allows for the sale or free giveaway and download of digital photographs, illustrations, audio, video, fonts, code snippets and other design elements to others.</p> <p>(2) Providing an online discussion forum related to digital photographs, illustrations, audio, video, fonts, code snippets and other design elements, including discussion forums related to the topics of: digital design tools, software and hardware; creative process; traditional and digital photography methods and processes; training, articles, tutorials and quizzes.</p> <p>(3) Providing online support services for the upload and download of digital photographs, illustrations, audio, video, fonts, code snippets and other design elements over the Internet.</p>	Used in CANADA since at least December 04, 2002.
TMA727,658	ISTOCKAUDIO	<p>(1) Providing a searchable online database of digital audio recordings and clips, which allows for the sale, licensing or free giveaway and download of digital audio recordings and clips, to others; Providing an online discussion forum related to digital audio recordings and clips, discussion forums related to the topics of digital design tools, software and</p>	Declaration of Use filed October 09, 2008.

		hardware, creative process, traditional and digital audio methods and processes, training, articles, tutorials and quizzes; Providing online support services for the upload and download of digital audio recordings and clips over the Internet; Organizing and conducting on-line contests relating to digital audio recordings.	
TMA728,325	ISTOCKVIDEO	(1) Providing a searchable online database of digital video recordings and clips, which allows for the sale, licensing or free giveaway and download of digital video recordings and clips, to others; Providing an online discussion forum related to digital video recordings and clips, discussion forums related to the topics of digital design tools, software and hardware, creative process, traditional and digital video methods and processes, training, articles, tutorials and quizzes; Providing online support services for the upload and download of digital video recordings and clips over the Internet; Organizing and conducting on-line contests relating to digital video recordings.	Used in CANADA since at least July 31, 2006.