



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 90

Date of Decision: 2019-08-20

IN THE MATTER OF AN OPPOSITION

Alibaba Group Holding Limited

Opponent

and

Kaulins-Plaskacz, Ilze

Applicant

1,712,042 for ALIBABA.CA

Application

INTRODUCTION

[1] Alibaba Group Holding Limited (the Opponent) opposes registration of the trademark ALIBABA.CA (the Mark), subject of application No. 1,712,042 by Kaulins-Plaskacz, Ilze (the Applicant).

[2] The application is based upon use in Canada since at least as early as January 16, 2015 in association with the following services: “providing a website in the field of candy and chocolate” (hereinafter sometimes referred to as the Applicant’s Services).

[3] The Opponent opposes the application based on various grounds, including that the Mark is confusing with the Opponent’s trademarks ALIBABA.COM and ALIBABA identified under

Reg. Nos. TMA594,225 and TMA773,117, the particulars of which are in Schedule A attached herewith to my decision.

[4] For the reasons that follow below, I find the application ought to be refused.

THE RECORD

[5] The application for the Mark was filed January 22, 2015.

[6] Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13 (the Act) came into force on June 17, 2019. The date for identifying which version of the Act applies to opposition proceedings is the date on which the application being opposed was advertised. In the present case, the application was advertised for opposition purposes in the *Trademarks Journal* on December 23, 2015. As the application was advertised prior to June 17, 2019, pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read on June 16, 2019, with the exception of confusion for which subsections 6(2) to (4) of the Act as they currently read will be applied.

[7] On February 23, 2016, the Opponent filed a statement of opposition under section 38 of the Act, raising grounds of opposition based upon sections 2 (non-distinctiveness), 12(1)(d) (non-registrability), and 16(1)(a) (non-entitlement) of the Act.

[8] On March 10, 2016, the Applicant filed and served a counter statement denying the grounds of opposition set out in the statement of opposition.

[9] In support of its opposition, the Opponent filed the affidavit of Li, Ka Ming Angela, the Senior Legal Counsel, Head of Soft IP of the Opponent, sworn on July 8, 2016 (the Li affidavit).

[10] In support of her application, the Applicant filed the affidavit of Thelma Thibodeau, a retired member of the Quebec Bar and trademark agent, sworn on November 11, 2016 (the Thibodeau affidavit).

[11] None of the affiants were cross-examined.

[12] Both parties filed written arguments and attended an oral hearing.

OVERVIEW OF THE EVIDENCE

[13] I provide below an overview of the most salient points contained in the parties' evidence, which I will consider in more detail, as needed, in my analysis of the various grounds of opposition.

The Opponent's evidence – The Li affidavit

Background information on the Opponent

[14] Ms. Li explains the origins of the Opponent who was established in China in 1999 and led by Mr. Jack Ma in the creation of an online marketplace for business and consumers to compete effectively in domestic and global economies [paras 5-6].

[15] Throughout her affidavit, Ms. Li refers to the Opponent and its affiliates collectively as the "Alibaba Group", described as a "family of Internet-based businesses whose mission is to make it easy for anyone to buy and sell online anywhere in the world" [para 4].

[16] Ms. Li provides a detailed breakdown of the corporate legal structure of the Alibaba Group found in the Opponent's Annual Report for the fiscal year end of March 31, 2016, attached as Exhibit LKMA-1 to her affidavit. From this exhibit, it appears that all subsidiaries and consolidated entities of the Alibaba Group outside of China are 100% owned directly and indirectly by the Opponent [para 6].

[17] Ms. Li attests that since its adoption in 1999, ALIBABA is the "core and distinctive element" of the Alibaba Group's company name and its house mark under which its business activities are promoted [paras 7 and 10].

[18] Throughout her affidavit, Ms. Li collectively refers to the Opponent's ALIBABA and ALIBABA.COM marks as the "Alibaba Trademarks" and, unless otherwise noted, I will do the same throughout my decision. Ms. Li attests that the use of the Alibaba Trademarks is authorized by the Opponent to companies and affiliates within the Alibaba Group. She further attests that the Opponent maintains "direct or indirect control over the character and quality of the goods and services provided under the Alibaba Trademarks by the companies and affiliates within the

Alibaba Group” [para 8]. I shall note at this point of my decision that I am satisfied that all use of the Alibaba Trademarks made by the Opponent’s affiliates and companies comprising the Alibaba Group enures to the benefit of the Opponent pursuant to section 50(1) of the Act. Accordingly, my reference to the Opponent hereinafter in my decision shall collectively encompass Alibaba Group Holding Limited and its affiliates comprising the Alibaba Group.

Services provided by the Opponent and the *Alibaba.com* Website in Canada

[19] Ms. Li’s affidavit centres on the use of the Alibaba Trademarks in association with a global electronic marketplace for the buyers and sellers of goods and/or services, which I note is consistent with some of the Opponent’s services mentioned in Schedule A. Indeed, Ms. Li explains that the Opponent operates two business-to-business (B2B) marketplaces: (1) a global online marketplace for importers and exporters at *Alibaba.com* (*Alibaba.com* Website) and (2) a Chinese online marketplace for domestic trade in China at *Alibaba.com.cn* and *1688.com*, all under the trademark ALIBABA [para 12].

[20] Ms. Li attests that businesses from around the world use the online marketplace platforms to source products, and sellers from around the world use them to establish an online presence to market products and services to hundreds of millions of consumers and other businesses [para 13]. She specifically attests that the *Alibaba.com* Website connects buyers located in over 200 countries, including in Canada, with sellers located around the world, including in Canada. Ms. Li explains that sellers typically include wholesale distributors, re-sellers, and/or manufacturers of a wide variety of products and services, while buyers typically include trade agents, wholesalers, retailers, manufacturers and small and medium-sized enterprises engaged in the import and export businesses [para 16].

[21] Ms. Li attests that the ALIBABA.COM trademark, an integral part of the global online marketplace platform operated by the Opponent has been used since the registration and launch of the *Alibaba.com* Website in 1999. In support, she attaches screenshots of a WHOIS Report for the registration of the domain name *Alibaba.com* and of various webpages extracted from the *Alibaba.com* Website wherein the Alibaba Trademarks are displayed. I reproduce below the images which appear in these webpages [para 15; Exhibit LKMA-4]:



[22] With respect to both images, I note the word “Alibaba” appears in more prominent bolded text relative to the surrounding text which appears in conjunction with the .com element and a design element to the left. I am therefore satisfied that the word ALIBABA sufficiently stands out to constitute display of the ALIBABA trademark as registered. I am also satisfied that the display of Alibaba.com in the stylized forms reproduced above amounts to the display of the ALIBABA.COM trademark as registered. In that regard, with respect to the first image, the component Alibaba.com sufficiently stands out from both the surrounding text “Global trade starts here” as well as the accompanying design element to the left. With respect to the second image, the component Alibaba.com also sufficiently stands out from the same design element to the left [per *Registrar of Trade-marks v Compagnie Internationale pour l’informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA); and *Nightingale Interloc v Prodesign* (1984), 2 CPR (3d) 535 (TMOB)].

[23] With respect to Canadian activity on the *Alibaba.com* Website or version of the site targeted at Canadians via a “Canada Channel”, Ms. Li provides various screenshots, some of which display the Alibaba Trademarks [paras 16-21; Exhibits LKMA-5 to LKMA-8]. I note Ms. Li has not provided information as to when the “Canada Channel” was created.

[24] Ms. Li provides statistics with respect to worldwide numbers of registered users (buyers), paying members (sellers who pay membership fees to establish storefronts on the *Alibaba.com* Website) and storefronts from January 2006 to March 2012. For each of these three categories, she attests that the numbers have grown steadily: the number of buyers rose from approximately 3 million in December 2006 to over 27 million in March 2012, the number of sellers rose from approximately 29,000 in December 2006 to over 95,000 in March 2012 and the number of storefronts rose from just under 515,000 in December 2006 to over 2.3 million in March 2012. Ms. Li then attests that while the number of registered users and storefronts since March 2012

and the number of paying members from March 2012 to March 2015 are confidential, she confirms that these numbers have generally grown in connection with the increasing revenues earned through the *Alibaba.com* Website. However, she does not provide a breakdown of the number of Canadian buyers, sellers or storefronts [para 21; Exhibit LKMA-9].

[25] Ms. Li further attests that more than 136,000 and 137,000 worldwide paying members were registered through the *Alibaba.com* Website as of March 2015 and March 2016 respectively, though she does not provide a breakdown of the number of Canadian paying members (sellers) registered through the *Alibaba.com* Website [para 22].

[26] Ms. Li provides substantial approximate total annual revenues generated by the Opponent for all of its goods and services sold from April 2010 to March 2016, as well as those revenues generated by the Opponent through the *Alibaba.com* Website from January 2011 to March 2016. From 2013 to 2016, the Opponent's annual revenues generated through the *Alibaba.com* Website rose from approximately \$592 million USD to approximately \$841 million USD, though again she provides no breakdown as to what portion of these revenues may be attributed to Canada [paras 24-26; Exhibit LKMA-11].

[27] Ms. Li attests the *Alibaba.com* Website may also be accessed through an *Alibaba.com* mobile application available for Android or iPhone devices. She further attests that according to the GooglePlay website, the Android version of the mobile application has been installed between 1,000,000 and 5,000,000 times by users worldwide and has over 30,000 reviews. In support, she attaches screenshots of the *Alibaba.com* application as offered for download through GooglePlay, as well as upon download and installation, showing confectionery and chocolate products made available from sellers located in Canada [para 23; Exhibit LKMA-10].

The Alibaba Trademarks in Advertising and Promotional Materials

[28] Ms. Li attests that the Opponent extensively advertises and promotes its services in association with the Alibaba Trademarks through a variety of means, including online advertisement banners on media, technology and finance websites accessible to Canadians. In support, she attaches screenshots dated July 7, 2016 of online advertising materials displaying

the Alibaba Trademarks from the *New York Times*, *Forbes*, *Reuters* and *Tech Insider*, distributed by the Opponent [paras 28-29; Exhibit LKMA-12].

[29] Ms. Li also attests the Opponent has a significant online social media presence, including a Facebook page dedicated to Alibaba.com, a Twitter account, a LinkedIn page as well as a YouTube account, all accessible to Canadians, the latter featuring informational videos (published between April 13, 2009 and January 5, 2015) to consumers about the products and services available through the *Alibaba.com* marketplace. In support, she attaches media pages displaying the Alibaba Trademarks [paras 30, 31, 33; Exhibit LKMA-13].

[30] Ms. Li provides substantial approximate annual worldwide sales and marketing expenditures incurred by the Opponent between April 2010 and March 2016, which rose from approximately \$477 million USD in April 2010 to approximately \$1.7 billion USD in March 2016, though she provides no breakdown as to what portion of these expenditures may be attributed to Canada [para 32; Exhibit LKMA-11].

Trade and Industry Events

[31] Ms. Li attests that the Opponent also advertises and promotes the Alibaba Trademarks by attending trade and industry events hosted in locations around the world, including Canada, where its employees and executives give talks and the Alibaba Trademarks are often prominently displayed in connection with such talks. In support, she attaches documents relating to two such talks which took place in Canada, one relating to a keynote speech given in June 2015 by the director of global marketing for Alibaba.com at the ASI Power Summit Canada, held in Whistler, British Columbia, the other relating to a talk given in May 2015 by an executive of Strategic Partnership Development, Americas Region of Alibaba.com, at the International Trade Day: Canada Meets the New Pacific event, held in Ottawa, Ontario [paras 34-37; Exhibit 14].

[32] To specifically promote the *Alibaba.com* marketplace, Ms. Li also attests that the Opponent regularly attends and rents booth space at tradeshow and industry events that are well attended by visitors from around the world. In support, she attaches photographs from two events which took place in the United States in 2014, the Consumer Electronics Show and the National

Hardware Show, both in Las Vegas, Nevada, showing the prominent display of the Alibaba Trademarks [paras 38-39; Exhibit LKMA-16].

Global media exposure including in Canada

[33] Ms. Li attests that in September 2014, the Alibaba Group completed a US\$25 billion initial public offering at the New York Stock Exchange. This initial public offering received worldwide press coverage. In support, she attaches to her affidavit printouts of articles (dated between August 2014 to January 12, 2015) from various newspapers, magazines and other global media outlets [para 9, Exhibit LKMA-2]. Though Ms. Li has not provided circulation information for all of these publications, I am prepared to take judicial notice that, for those articles from *Bloomberg*, *Forbes*, *The New York Times*, and *The Financial Times*, there has been some circulation in Canada [see by analogy *H-D Michigan Inc v MPH Group Inc*, (2004), 40 CPR (4th) 245 at 256 (TMOB)].

[34] Similarly, Ms. Li attests that this initial public offering also received press coverage in Canada. Ms. Li further attests that the Opponent regularly receives press interest and coverage in Canada concerning the Opponent and the *Alibaba.com* marketplace. In support, she attaches to her affidavit copies of articles (dated January 2014 to December 2015) appearing in Canadian media publications such as *CBC*, the *Financial Post*, the *Globe & Mail* and the *Toronto Star* [paras 40-41; Exhibits LKMA-17 and LKMA-18]. Though Ms. Li has not provided circulation information for these Canadian media publications, I can take judicial notice of national circulation in Canada of these publications [*Milliken & Co v Keystone Industries (1970) Ltd*, (1986), 12 CPR (3d) 166 (TMOB) at 168-169; *Carling O'Keefe Breweries of Canada Ltd v Anheuser-Bush, Inc* (1985) 4 CPR (3d) 216 at 224 (TMOB); and *Whole Foods Market IP, LP v Salba Corp NA* (2012), CPR (4th) 361 (TMOB)].

Global Trademark Portfolio

[35] Ms. Li attests that the Opponent has applied for and/or registered its Alibaba Trademarks in over 80 jurisdictions since 1999, with its oldest registration for the “ALIBABA” trademark having been filed in 1993 [para 43; Exhibit LKMA-19].

Brand Recognition

[36] Lastly, Ms. Li attests that the ALIBABA brand is considered as one of the world's most valuable brands, worth several billion US dollars. In support, Ms. Li attaches to her affidavit extract copies from the 2015 and 2016 reports from brand valuator BrandZ and the 2016 report from brand valuator Brand Finance [paras 44-46; Exhibit LKMA-20].

The Applicant's evidence – The Thibodeau affidavit

[37] Ms. Thibodeau explains that she is an investigator in the field of trademarks and the founding owner of ThelmaPI Investigations since 2001 [para 2]. She conducted various searches, including online searches on November 10 and 11, 2016. The purpose of the Thibodeau affidavit seemingly relates to three different subjects, which will be addressed in further detail in my confusion analysis.

[38] First, Ms. Thibodeau purports to furnish state of the register and marketplace evidence regarding the use by third parties of trademarks and tradenames containing the words "ALI BABA" and "ALIBABA". In support, Ms. Thibodeau introduces into evidence the results of her searches on the Canadian Trademarks Database, the NUANS Corporate Name search system and the Quebec Enterprise Registry, for active trademarks and tradenames that include the words "ALI BABA" or "ALIBABA" [paras 5-8 and 12; Exhibits TT-4 –TT-6; Exhibit TT-8]. She describes her online searches for the entities identified in these databases and also includes webpage printouts, including from the Google Street View search engine, for the entities which allegedly correspond to those identified in the course of her searches in these databases, and display the words "ALI BABA" or "ALIBABA" as part of their trademark or tradename [paras 9-11 and 13; Exhibits TT-7 and TT-9].

[39] Second, Ms. Thibodeau appears to contextualize the Applicant's alleged use of the Mark on her website. In support, she introduces into evidence screenshots from the Applicant's website, accessible using the domain name "*alibaba.ca*" that was registered on February 10, 2003 by the Applicant [paras 3-4; Exhibits TT-2 and TT-3].

[40] Third, Ms. Thibodeau introduces into evidence the definition of “Ali Baba” from the 2001 edition of *The Canadian Oxford Dictionary* [para 14, Exhibit TT-10] as well as webpage printouts from her online searches explaining the origin of the Ali Baba name [para 15, Exhibit TT-11].

THE PARTIES’ RESPECTIVE BURDEN OR ONUS

[41] The Opponent has the initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155 (FCA)].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Non-registrability of the Mark under section 12(1)(d) of the Act

[42] The Opponent has pleaded that the Mark is not registrable pursuant to section 12(1)(d) of the Act as it is confusing with the Opponent’s trademarks ALIBABA.COM and ALIBABA, registered under Nos. TMA594,225 and TMA773,117 respectively.

[43] I have exercised the Registrar’s discretion to confirm that the Opponent’s registrations for the trademarks ALIBABA and ALIBABA.COM are in good standing as of today’s date, which is the material date for assessing this ground of opposition [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[44] As the Opponent’s evidential burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent’s Alibaba Trademarks.

The test for confusion

[45] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[46] Thus, this section does not concern the confusion of the trademarks themselves, but of the goods or services from one source as being from another.

[47] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have 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 trademarks in appearance or sound or in the ideas suggested by them. This list is not exhaustive and all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *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) for a thorough discussion of the general principles that govern the test for confusion].

[48] In *Masterpiece, supra* at paragraph 49, the Supreme Court of Canada discussed the importance of the section 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with section 6 of the Act:

[...] the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar [...] As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

[49] Under the circumstances of the present case, I consider it appropriate to analyse the degree of resemblance between the parties' marks first.

The degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them

[50] The parties' marks are virtually identical, in that they all comprise the word "ALIBABA", which constitutes the dominant or striking element at the core of the trademarks under review.

[51] Indeed, I find there is nothing particularly striking or unique about the elements ".COM" or ".CA", as they consist of generic or descriptive top-level domain name suffixes which serve as identifiers common to all domain names, as opposed to the word "ALIBABA", which occupies the first dominant position in the parties' marks and does not describe any intrinsic feature or characteristic of the parties' goods and/or services. Rather, the word "ALIBABA" is merely evocative of the well-known character "Ali Baba" in the story of "Ali Baba and the Forty Thieves" (one of the stories in "The Arabian Nights"), who discovers a secret cave full of beautiful or rare treasures [as evidenced by Exhibits TT-10 and TT-11 attached to the Thibodeau affidavit].

[52] In that regard, the Opponent's trademark ALIBABA is incorporated entirely within the Mark. As for the Opponent's trademark ALIBABA.COM, while it is not entirely incorporated within the Mark, ALIBABA.COM highly resembles the Mark as they have identical structures (*i.e.* the word "ALIBABA" followed by a descriptive top-level domain name suffix). In fact, if anything, I agree with the Opponent that the descriptive suffix ".CA" increases the similarity between the parties' marks in that both the ".CA" and ".COM" suffixes convey the idea of internet based activities – the country code top-level domain name suffix ".CA" merely identifying a website as Canadian.

[53] To sum up, I find there is a very high degree of resemblance in appearance, sound and ideas suggested between the Mark and the Opponent's Trademarks.

[54] Therefore, this important factor strongly favours the Opponent.

The inherent distinctiveness of the trademarks and the extent to which they have become known

[55] The parties' marks are both inherently distinctive owing to the word "ALIBABA", which, as indicated above, is not descriptive of either of the parties' goods and/or services. However, neither of the parties' marks is particularly strong in the sense of being a coined term, as it is readily apparent that they were derived from the famous character Ali Baba.

[56] The strength of a trademark may be increased by means of it becoming known through promotion or use.

[57] There is no conclusive evidence that the Mark has become known in Canada to any extent in association with the Applicant's Services.

[58] Indeed, while the screenshots of the Applicant's website attached as Exhibit TT-3 to the Thibodeau affidavit suggest that the Applicant operates a website providing recipes, ratings for recipes, coupons and blog posts relating to candy and chocolate, there is no information as to whether Canadians visited this website, and if so, how many. Notably, the mention "no comments" appears throughout the rating for the recipes and there are no messages in the "Category Archives: Blog" other than the Applicant's own welcoming message to her website.

[59] In contrast, based on my review of the Li affidavit, I find it reasonable to conclude that the Opponent's Alibaba Trademarks have become known, at the very least, to some extent in Canada, particularly in relation to the Opponent's global online marketplace services.

[60] Indeed, despite the fact that there are some gaps in the Opponent's evidence, including the absence of a breakdown of the Opponent's worldwide sales and marketing expenditures and worldwide revenues attributable to Canada, and the absence of the precise numbers of Canadian sellers and buyers that have been using the *Alibaba.com* Website, the evidence nonetheless clearly includes Canada-specific elements showing use of the Alibaba Trademarks in Canada, the Opponent's participation in trade and industry events in Canada, as well as media attention received in Canada by the Opponent in relation to its global online marketplace services. In that regard, I refer more particularly to the following elements:

- Exhibit LKMA-5: contains screenshots of webpages from the *Alibaba.com* Website dated June 22, 2016, wherein the Alibaba Trademarks are displayed, showing multiple Canadian vendors of a variety of products from lobster and vitamins, to chocolate, candy and various related confectionery.
- Exhibit LKMA-6: contains screenshots of webpages from the *Alibaba.com* Website dated June 22, 2016, wherein the Alibaba Trademarks are displayed, showing the Canada-specific version of the website with the prominent mention “Welcome to Alibaba.com’s Canada Channel”. This Canada Channel allows buyers to make purchases from verified Canadian suppliers of a variety of products including chocolate, candy and various related confectionery.
- Exhibit LKMA-7: contains copies of printouts from the *Alibaba.com* Website dated July 7, 2016, filtering listings by “category” including “candy”, “chocolate” and “confectionery” in which buyers from around the world, including Canada, can view such listings, featuring suppliers, including from Canada, of such product categories.

I note that the Alibaba Trademarks are not displayed in these printouts. However, Ms. Li attests that the *Alibaba.com* Website permits the filtering of listings by “Category” [para 18]. Therefore, I am prepared to attribute this absence to a Canadian user’s filtering choices while so navigating the *Alibaba.com* Website, which as the evidence shows, displays the Alibaba Trademarks outside this filter [paras 15-17].

- Exhibit LKMA-8: contains copies of printouts from the *Alibaba.com* Website dated July 5, 2016, filtering listings by “location of sellers”, which display the company profiles (virtual storefronts) of 10 sellers located in Canada, who list candy, confectionery and chocolate products for sale. In this regard, Ms. Li’s uncontroverted statement at paragraph 19 of her affidavit specifies that 8 out of these 10 Canadian sellers started offering such products for sale through the *Alibaba.com* Website, prior to January 16, 2015.

Here also, I note that the Alibaba Trademarks are not displayed in these printouts. However, Ms. Li attests that the *Alibaba.com* Website permits the filtering of listings by

the location of the sellers [para 19]. Therefore, as explained above, I am prepared to once again attribute this absence to a Canadian user's filtering choices while so navigating the *Alibaba.com* Website.

- Exhibit LKMA-14: contains documents relating to two talks given by the Opponent's representatives at trade and industry events hosted in Canada.
- Exhibit LKMA-18: contains various articles appearing in Canadian media publications referring to the Opponent's global online marketplace services, including:
 - an online newspaper article published November 7, 2014, from *The Globe and Mail* entitled "In China trade talks, Alibaba tells Harper: 'We want your cherries'" about Canada's then Prime Minister Stephen Harper's having shared a stage with Mr. Ma before an audience of Chinese and Canadian businesspeople in China regarding the Opponent's interest in opening up China's markets for Canadian agricultural products.
 - an article dated January 20, 2014, in the online magazine *Canadian Business*, entitled "Why Alibaba's IPO will make it the next global tech powerhouse", explaining that the Opponent's growth saw it become an increasingly important tool for vendors outside China. The article's author mentions the following:

Thousands of Canadian businesses use it to find buyers for their own goods, too. Do Lobster Ltd. in Nova Scotia, for instance, advertises live lobster in bulk [...] to international buyers.

[61] In view of all the foregoing, I find that the overall assessment of the section 6(5)(a) factor, which is a combination of the inherent distinctiveness of the parties' trademarks and the extent to which they have become known, favours the Opponent.

The nature of the goods, services or business; and the nature of the trade

[62] When considering the goods and services of the parties, it is the statement of goods and services in the parties' trademark application and registrations that govern the issue of confusion arising under section 12(1)(d) [*Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (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, particularly where there is an ambiguity as to the goods or services covered in the application or registration at issue [*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)].

[63] As indicated above, the Applicant’s Services are described as: “providing a website in the field of candy and chocolate”. While Exhibit TT-3 of the Thibodeau affidavit suggests that the Applicant’s website mainly provides candy and chocolate recipes, the fact remains that there are elements in this website which exceed sharing recipes amongst users of such website. In that regard, as stressed by the Opponent, the Applicant’s website contains one category named “Coupons”. Notably, in that section, the Applicant provides a link to a third-party website “*chocolate.com*” apparently publicizing “fine chocolate for fine occasions” and she also provides a coupon code for a 10% rebate on chocolates purchased on “*chocolate.com*”. I agree with the Opponent that the foregoing could be characterized as a form of advertising, commercial activity or even a form of electronic commerce. What is more, the wording of the Applicant’s services is by no means limited to an informational website relating to candy and chocolate recipes. To the contrary, the Applicant’s Services are broad enough to encompass commercial activities.

[64] Turning to the Opponent’s Alibaba Trademarks, as shown in Schedule A, each one is registered in association with various services, including the below reproduced services which overlap amongst one another, and which I consider the most relevant for the purposes of my analysis:

ALIBABA.COM – Reg. No. TMA594,225	ALIBABA – Reg. No. TMA773,117
<ul style="list-style-type: none"> • business services, namely facilitating the transaction of business via local and global computer networks; • providing computerized online ordering services; 	<ul style="list-style-type: none"> • business services, namely facilitating the transaction of business via local and global computer networks by locating and providing referrals for the delivery of a wide variety of business and

<ul style="list-style-type: none"> • advertising of goods and services of others via local and global computer networks; • providing an interactive web site on a global computer network for third parties to post information, respond to requests and place and fulfill orders for products, services and business opportunities; • computer services, namely, creating an online community for the transaction of business among and between third parties, providing a web site on a global computer network by which third parties can offer goods and services, place and fulfill orders, enter into contracts and transact business; • e-commerce services; • providing links to third party web sites to facilitate e-commerce and real world business transactions; 	<p>consumer products and services and by dissemination of information about goods and services of others via local and global computer networks</p> <ul style="list-style-type: none"> • providing a web site on a global computer network by which third parties can offer and source goods and services, place, determine the status of and fulfill trade leads and orders, enter into contracts and transact business; • providing computerized online ordering services featuring general consumer merchandise and industrial products; • advertising of goods and services of others via local and global computer networks; • operating an electronic marketplace for the buyers and sellers of general consumer and industrial goods and/or services on a global computer network; • providing multiple user access [<i>sic</i>] to global computer information networks for the transfer and dissemination of a wide range of information; • providing computer links to third party websites to facilitate e-commerce and real world business transactions; • providing access to an interactive website on a global computer network for third parties to post information, respond to requests and place and fulfill orders for products [<i>sic</i>], services and business opportunities; • providing access to a website on a global computer network by which third parties can offer goods and services; • providing access to a website on a
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	<p>global computer network by which third parties can offer goods and services; providing access to an interactive website on a global computer network for third parties; information, advisory and consultancy services in relation to the operation of an electronic marketplace for the buyers and sellers of general consumer and industrial goods and/or services on a global computer network.</p>
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[65] I am of the view that Ms. Li’s evidence which centers on the Opponent’s global online marketplace services, supports use of the Alibaba Trademarks with most, if not all, of the above reproduced registered services which, broadly speaking, relate to such online marketplace services.

[66] The Applicant argues that nature of the parties’ services and trades are obviously dissimilar because the Applicant’s Services “only pertain to providing a website in the field of candy and chocolate”. I would perhaps agree to some extent if the Applicant’s Services were not so broadly described and instead, for instance, limited to providing an informational website relating to chocolate and candy recipes. But I cannot ignore the wording of the Applicant’s Services because its website currently appears to be mainly related to providing online informational services relating to candy and chocolate recipes. In that regard, in *Masterpiece, supra*, the Supreme Court of Canada makes it clear that actual use cannot be the focus of the confusion analysis because the issue is what the trademark registration would authorize the Applicant to do, rather than the Applicant’s existing business. The Applicant’s statement of services does not provide sufficient context to specify that the Applicant’s Services would not, for example, relate to a transactional website for third parties to respond to requests and place and fulfil orders for candy and chocolate. As such, the application seeks to have the Mark registered in association with any type of website, including transactional, in the field of candy and chocolate [see by analogy *Seara Alimentos LTDA v Amira Enterprises Inc*, 2019 FCA 63].

[67] Likewise, there is no restriction in the Opponent’s registered services as to the type or field of goods third parties offer through the *Alibaba.com* Website. What is more, the record

shows that the Opponent's registered services, including through its country-specific Canada Channel allowing buyers to make purchases from verified Canadian suppliers, extend to the field of candy and chocolate [paras 17-19 of the Li affidavit; Exhibits LKMA-6 to LKMA-8].

Therefore, I find it reasonable to conclude that the nature of the parties' services and channels of trade may, in some way, potentially overlap.

[68] Accordingly, the overall consideration of the sections 6(5)(c) and (d) factors lends support to the Opponent's case.

The length of time the trademarks have been in use

[69] Exhibit TT-3 of the Thibodeau affidavit suggests that the Applicant posted some recipes on her *Alibaba.ca* website, between January 1 and January 16, 2015, between January 20 and January 28, 2016 and on March 1, 2016, which postings support the Applicant's claimed date of first use of the Mark in Canada. In this regard, the fact that Exhibit TT-2 shows that the Applicant registered the domain name "alibaba.ca" back in 2003 by no means establishes use of the Mark pursuant to section 4 of the Act [per *Sun Media Corporation v The Montreal Sun (Journal Anglophone), Inc* 2011 TMOB 15].

[70] Turning to the Opponent, registration No. TMA773,117 for the trademark ALIBABA contains a claim of first use of the mark in Canada since at least as early as March 10, 1999, while registration No. TMA594,225 for the ALIBABA.COM trademark shows the filing of a declaration of use on September 29, 2003. Contrary to the Opponent's position, the Li affidavit does not conclusively evidence use of the Alibaba Trademarks in Canada going as far back to those years. The most that I can presume from the mere existence of these registrations is that there has been *de minimis* use of the Alibaba Trademarks in Canada since those dates. Having said that, as indicated above, the fact remains that the Opponent has evidenced use of the Alibaba Trademarks in Canada, going back to at least sometime before January 16, 2015.

[71] In view of all the foregoing, the section 6(5)(b) factor lends support to the Opponent's case, though not to a significant degree.

Additional surrounding circumstances

“Fame” of the Alibaba Trademarks

[72] The Opponent, relying on *Mattel, supra* and *Veuve Clicquot, supra*, argues that the fame of its Alibaba Trademarks is an important surrounding circumstance because fame presupposes that the mark transcends, to some extent, the goods or services with which it is normally associated. At paragraph 83 of its written argument, the Opponent submits that:

[...] a trademark with significant associated reputation and goodwill in the marketplace may be found to be confusing with another trademark even where the goods or services are very different, much less where the goods and services are very similar.

[73] At paragraph 84 of its written argument, the Opponent further submits that:

[It] has expended considerable resources and efforts to develop, promote, and advertise [its Alibaba Trademarks] in Canada and worldwide, to such an extent that the Opponent’s brand is considered one of the most valuable retail brands in the world.

[74] I acknowledge that the Opponent’s evidence points to a certain international notoriety in the ALIBABA brand. In that regard, Ms. Li affirms that the ALIBABA brand has been recognized as one of the top worldwide brands by brand valuers BrandZ and Brand Finance. In support, Ms. Li attaches extract copies of the 2015 BrandZ report ranking the ALIBABA brand 13th amongst the Top 100 Most Valuable Global Brands, and the 2015 and 2016 BrandZ reports ranking the ALIBABA brand as the world’s most valuable retail brand and second most valuable brand, respectively. Ms. Li also attaches an extract copy from the 2016 Brand Finance report, ranking the ALIBABA brand 62nd amongst the Top 100 Most Valuable Global Brands [paras 44-46; Exhibit LKMA-20].

[75] While that may be the case, I consider these brand valuation rankings do not allow me to go so far as concluding that the Alibaba Trademarks have necessarily become well-known or famous in Canada. There is nothing in these rankings particularizing the methodology used, including which countries were included in these global rankings. Furthermore, these mere rankings do not cure the gaps outlined above in my review of the section 6(5)(a) factor concerning which portion of the Opponent’s worldwide sales and marketing expenditures and worldwide revenues are attributable to Canada.

[76] Accordingly, I am not prepared to accord weight to this surrounding circumstance.

State of the register and state of the marketplace evidence

[77] As mentioned above, the Applicant has introduced, by way of the Thibodeau affidavit, state of the Canadian trademarks register evidence as well as alleged third-party use of trademarks and tradenames in Canada which include the words “ALI BABA” or “ALIBABA”. The Applicant’s position is that the Thibodeau affidavit “show[s] that the name ‘Ali Baba’ is very common, not only in general, but also as trademarks and tradenames for various Canadian businesses” which in turn should narrow the scope of protection afforded to the Opponent’s Alibaba Trademarks in this case. I respectfully disagree.

[78] State of the register evidence serves to show the common nature or the distinctiveness of a trademark or part of a trademark in relation to a particular trade. The evidence regarding the state of the register is relevant only insofar as inferences may be made on it concerning the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[79] With respect to Ms. Thibodeau’s searches on the Canadian trademarks register, she conducted searches for active trademarks (not in the name of the Opponent), which contain the words “ALI BABA” or “ALIBABA”. With the exception of the Mark, Ms. Thibodeau’s searches generated the following four registrations only [para 12, Exhibit TT-8]:

- Ali Baba’s Middle Eastern Cuisine & Design (Reg. No. TMA718,962 dated July 22, 2008) and ALI BABA’S MIDDLE EASTERN CUISINE (Reg. No. TMA717,834 dated July 3, 2008), both in the name of Ali Baba's Middle Eastern Cuisine Ltd. c.o.b. as Ali Baba Restaurant, for restaurant services;

- ALI BABA PIZZA (Reg. No. TMA851,324 dated May 22, 2013) in the name of Nilgun Dardere) for pizza, hamburgers and the like, including related restaurant and catering services;
- ALIBABA (Reg. No. TMA919,016 dated November 2, 2015) in the name of Universal Entertainment Corporation, for slot machines, gaming machines and the like.

[80] Not only are these four trademark registrations a low number and in the name of only three different owners, they are also irrelevant as they cover goods and services of a different nature than the services of the parties.

[81] With respect to the state of the marketplace evidence regarding purported trademarks and tradenames containing the words “ALI BABA” or “ALIBABA”, as a general remark, it is not necessarily surprising that the NUANS Corporate Names Database, Quebec Enterprise Registry and Google searches yielded names containing these words. Indeed, as mentioned above, Ali Baba is the name of a famous fictional character and as such, the words “ALI BABA” or “ALIBABA” are not *per se* particularly strong.

[82] Concerning more particularly the NUANS search results attached as Exhibit TT-4 to the Thibodeau affidavit, other than what may be surmised from the names themselves, there is no mention of what types of businesses are operated under the names listed therein. Conversely, I note that the particulars of the Quebec Enterprise Registry results attached as Exhibit TT-6 to the Thibodeau affidavit provide information as to the business activities of the tradenames contained therein. Once again, they often relate to restaurant services, though I note an array of other types of business activities associated with these names, including:

- Ali Baba for [TRANSLATION] “distribution of newspapers” (in French: “distribution des journaux”)
- ALI BABA ET SES 40 TOUTOUS for [TRANSLATION] “daycare services” (in French: “service de garde d’enfants”)
- ALIBABA AUTO for [TRANSLATION] “used car dealerships (in French: “concessionnaires d’automobiles d’occasion”)

- Les Glaces Ali Baba for [TRANSLATION] “operation of a grocery store and ice cream factory” (in French: “exploitation d’un commerce d’épicerie et d’une fabrique de crème glacée”)
- SINBAD ET ALIBABA for [TRANSLATION] “home furniture retail store” (in French: “commerce de detail de meubles de maison”)

[83] Turning to Exhibit TT-7 of the Thibodeau affidavit, this exhibit contains web printouts from her online searches on the Google search engine, limited to Canada, purporting to find commercial displays or other forms of such publicity showing trademarks allegedly corresponding to the business activities of the entities identified in the NUANS and the Quebec Enterprise Registry database results attached as Exhibits TT-5 and TT-6 to her affidavit. More specifically, Exhibit TT-7 contains what appears to be commercial advertising of the activities associated with tradenames containing the words “ALI BABA” or “ALIBABA”, which is sometimes accompanied by images of the commercial signage for these tradenames. In the same vein as the business activities mentioned in Exhibit TT-6 above, most of these tradenames are associated with restaurant services, though they are also associated with several other types of services, such as:

- Ali Baba Rug Co for repair and cleaning services on Persian and oriental rugs;
- ALI BABA LIQUIDATION STORE for the sale of electronics, home appliances, toys, and clothing;
- ALI BABA BAKERY specialising in the sale of fresh pies, meat pies and cheese pies;
- ALI BABA MOTORS for used car dealership services;
- Alibaba Elite Cricket for services related to organising cricket tournaments and events;
- Garderie les trésors d’Ali Baba for day care services.

[84] At best, these website printouts are evidence that they existed on the date they were printed (November 10-11, 2016) as they constitute hearsay evidence not admissible for the truth of their contents. Hearsay issue aside, there is no information with respect to the extent of the operations or the length of time that these businesses have been operating in Canada. More importantly, none of these identified entities appear to offer services of a nature similar to that of the services associated with the parties’ trademarks in issue.

[85] In view of all the foregoing, I am not prepared to accord significant weight to this surrounding circumstance.

Conclusion regarding the likelihood of confusion

[86] The issue here is not whether the Opponent should be granted a monopoly on the word ALIBABA in Canada, but whether a person, who has an imperfect recollection of the Opponent's Alibaba Trademarks in association with the Opponent's registered services would believe, based on a first impression and imperfect recollection, that the Applicant's Services come from the same source or are otherwise associated with or authorized by the Opponent.

[87] As stressed above, the parties' trademarks are virtually identical. Furthermore, I cannot disregard the potential overlap in the parties' services of interest owing to the difficulties which reside, on the one hand, in the description of the Applicant's statement of services which I find broad enough to encompass commercial activities and, on the other, in the confusion analysis not being limited to the Applicant's existing business. It is worth recalling in this regard that while the Applicant's website appears to mainly focus on providing candy and chocolate recipes, it also includes the category "Coupons", discussed above. In view of these difficulties and my finding that the Opponent's Alibaba Trademarks have become known, at the very least, to some extent in Canada in association with the Opponent's registered services, I am not satisfied that the Applicant has established, on a balance of probabilities, that a consumer with a vague recollection of the Opponent's Alibaba Trademarks, who is then exposed to the Mark, would not be likely to believe that the Mark corresponds to the Canadian top-level domain name of the Opponent's Alibaba Trademarks and that the Applicant's Services come from the same source or are otherwise associated with or authorized by the Opponent.

[88] Accordingly, the section 12(1)(d) ground of opposition succeeds.

Non-entitlement under section 16(1)(a) of the Act

[89] The Opponent has pleaded that:

[...] the Applicant is not the person entitled to registration in that contrary to [s]ection 16(1)(a) [of the Act] at the date on which the Applicant allegedly first used [the

Mark] in Canada [...], [the Mark] was confusing with the Opponent's [Alibaba Trademarks], both of which had been previously used in Canada in association with *inter alia* online and e-commerce services, including providing a website and online marketplace for buyers and sellers of general consumer and industrial goods and services, including food and beverages such as candy and chocolate, the use of which has not been abandoned by the Opponent.

[90] To meet its evidential burden in respect of this ground, the Opponent must show that, as of the alleged date of first use claimed in the Applicant's application (January 16, 2015), its Alibaba Trademarks had been previously used in Canada and had not been abandoned at the date of advertisement of the Applicant's application (December 23, 2015) [section 16(5) of the Act]

[91] As explained below, I am of the view that the Opponent has met its initial evidential burden thereof.

[92] In this respect, as previously discussed, Ms. Li's affidavit substantiates use of the Alibaba Trademarks in Canada prior to January 16, 2015 [para 19; Exhibit LKMA-8]. Indeed, Canadian sellers of candy, chocolate and confectionery goods used the *Alibaba.com* Website to establish storefronts and transact business in the field of candy and chocolate prior to January 16, 2015.

[93] The differences between the relevant dates does not materially impact my preceding analysis regarding the ground of opposition based on the non-registrability of the Mark under section 12(1)(d) of the Act. In that regard, while my overall assessment of the factor set out in section 6(5)(a) of the Act favours the Opponent slightly less owing to the Alibaba Trademarks having become marginally less known as of the earlier material date, it does not change my analysis of the factors set out in sections 6(5)(b), 6(5)(c), 6(5)(d) and 6(5)(e) of the Act.

[94] Accordingly, the section 16(1)(a) ground of opposition succeeds.

Non-distinctiveness under section 2 of the Act

[95] Having already found in favour of the Opponent on the section 12(1)(d) and section 16(1)(a) grounds of opposition, it is not necessary for me to consider this remaining ground of opposition.

DISPOSITION

[96] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Trademark	Reg. No./ Reg. Date	Statement of goods and services
ALIBABA.COM	TMA594,225/ 2003-11-06	<p>Services</p> <p>(1) Business services, namely facilitating the transaction of business via local and global computer networks; providing computerized online ordering services; advertising of goods and services of others via local and global computer networks; providing an interactive web site on a global computer network for third parties to post information, respond to requests and place and fulfill orders for products, services and business opportunities; online auction services; providing international import and export services, computer services, namely, creating an online community for the transaction of business among and between third parties, providing a web site on a global computer network by which third parties can offer goods and services, place and fulfill orders, enter into contracts and transact business; e-commerce services; providing product selection, sampling, inspection and quality control for others; providing a directory of third party web sites to facilitate business transactions; providing links to third party web sites to facilitate e-commerce and real world business transactions; providing electronic bulletin boards for the posting and transmission of messages among and between computer users concerning products, services and business opportunities; providing online chat services; providing an electronic calendar , address book and notes feature that can be accessed and used via local and global computer networks; providing electronic mail and electronic mail forwarding services</p> <p>(2) Business services, namely facilitating the transaction of business via local and global computer networks by providing computerized online ordering services featuring a wide variety of business and consumer products; dissemination of advertising of goods and services of others via local and global computer networks; providing a web site on a global computer network by which third parties can offer goods and services, place and fulfill orders, enter into contracts and transact business; providing a directory of third party web sites to facilitate business transactions; operating an electronic marketplace for the buyers and sellers of goods and/or services on a global computer network; providing an interactive web site on a global computer network for third parties to post information, respond to requests and place and fulfill orders for products, services and business opportunities; providing electronic bulletin boards for the posting and transmission of messages among and between computer users concerning products, services and business opportunities; providing electronic mail and electronic mail forwarding services.</p> <p>Claims Priority Filing Date: July 29, 1999, Country: UNITED STATES OF AMERICA, Application No. 75/764,395 in association with the same kind of services Used in UNITED STATES OF AMERICA on services (2) Registered in or for UNITED STATES OF AMERICA on July 02, 2002, under No. 2,589,009 on services (2) Declaration of Use filed September 29, 2003 on services (1)</p>

ALIBABA	TMA773,117/ 2010-07-28	<p>Goods</p> <p>(1) Computer software for use in connection with the provision of an interactive website for third parties to post information, create electronic product catalogs, respond to requests and place and fulfill orders for products, services and business opportunities via local and global computer networks; computer software for use in document management; computer software for searching, browsing and receiving transmissions of text, electronic documents, graphics and audiovisual information on local remote area, global computer networks, on intranets or directories of information available on computer networks; computer software for use in software development and web authoring; computer software for use in exchanging information via global computer networks and online from a computer database and the internet for the promotion, sale and resale of general consumer and industrial goods and services.</p> <p>Services</p> <p>(1) Market research and business consulting services; business services, namely facilitating the transaction of business via local and global computer networks by locating and providing referrals for the delivery of a wide variety of business and consumer products and services and by dissemination of information about goods and services of others via local and global computer networks; providing a web site on a global computer network by which third parties can offer and source goods and services, place, determine the status of and fulfill trade leads and orders, enter into contracts and transact business; providing computerized online ordering services featuring general consumer merchandise and industrial products; advertising of goods and services of others via local and global computer networks; international import and export agency services; rental of advertising space on a web site on a global computer network; advertising services, namely, advertising the wares and services of others; online trading services relating to electronic auctioneering and providing online business evaluation relating thereto; providing a directory of third party web sites to facilitate business transactions; operating an electronic marketplace for the buyers and sellers of general consumer and industrial goods and/or services on a global computer network; providing multiple user access [sic] to global computer information networks for the transfer and dissemination of a wide range of information; providing access to a website on a global computer network by which third parties can offer goods and services, place and fulfill orders, enter into contracts and transact business; providing computer links to third party websites to facilitate e-commerce and real world business transactions; providing access to electronic calendar, address book and notes feature, via local and global computer networks; providing access to an interactive website on a global computer network for third parties to post information, respond to requests and place and fulfill orders for products [sic], services and business opportunities; communication services, namely, text and numeric digital messaging services; electronic transmission of data and documents among users of computers via email and instant messaging; transmission of information by electronic communications networks via email, instant messaging and fax; electronic transmission of data, messages and pictures in relation to an electronic marketplace for the buyers and sellers of general</p>
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	<p>consumer and industrial goods and/or services, from cellular sites; web conferencing services; virtual chatrooms established via text messaging; providing electronic bulletin boards for the posting and transmission of messages among and between computer users concerning products, services and business leads and opportunities; providing an online interactive bulletin board for the posting of messages for the promotion, sale and resale of goods, and services via a global computer network; providing electronic mail and electronic mail forwarding services; computer services, namely, creating, maintaining, and hosting websites for others; computer programming; computer system software services; computer software design; computer system design; providing computer access and leasing access time to online interactive bulletin boards and databases for all the aforesaid purposes; design and development of computer software and hardware; design and development of webpages; hosting webpages for others; hosting computer application software for searching and retrieving information from databases and computer networks; providing multiple user access to global computer information networks for a wide range of information; computer services relating to customized searching of computer databases and websites; providing access to a website on a global computer network by which third parties can offer goods and services; providing access to an interactive website on a global computer network for third parties; information, advisory and consultancy services in relation to the operation of an electronic marketplace for the buyers and sellers of general consumer and industrial goods and/or services on a global computer network.</p> <p>(2) Market research and business consulting services; business services, namely facilitating the transaction of business via local and global computer networks by locating and providing referrals for the delivery of a wide variety of business and consumer products and services and by dissemination of information about goods and services of others via local and global computer networks; providing a web site on a global computer network by which third parties can offer and source goods and services, place and fulfill orders, enter into contracts and transact business; providing a directory of third party web sites to facilitate business transactions; operating an electronic marketplace for the buyers and sellers of general consumer and industrial goods and/or services on a global computer network; providing an interactive web site on a global computer network for third parties to post information, respond to requests and place and fulfill orders for products, services and business opportunities; providing electronic bulletin boards for the posting and transmission of messages among and between computer users concerning products, services and business opportunities; providing electronic mail and electronic mail forwarding services.</p> <p>(3) Computer services, namely, software design and development for others; designing, implementing, maintaining and hosting web sites for others; providing temporary use of on-line non-downloadable software that provides an electronic calendar, address book and notes feature, which is accessible via local and global computer network.</p> <p>Claims: Used in CANADA since at least as early as March 10, 1999 on goods and on services (1)</p>
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		Used in UNITED STATES OF AMERICA on goods and on services (2),(3) Registered in or for UNITED STATES OF AMERICA on April 06, 2004, under No. 2,829,317 on goods Registered in or for UNITED STATES OF AMERICA on June 11, 2002, under No. 2,579,498 on services (2) Registered in or for UNITED STATES OF AMERICA on June 08, 2004, under No. 2,851,634 on services (3)
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**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2019-01-23

APPEARANCES

Daniel Anthony

FOR THE OPPONENT

Marcel Naud

FOR THE APPLICANT

AGENTS OF RECORD

Smart & Biggar

FOR THE OPPONENT

Robic

FOR THE APPLICANT