



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

Citation: 2014 TMOB 96
Date of Decision: 2014-05-07

**IN THE MATTER OF AN OPPOSITION
by zip.ca Inc. to application No. 1,484,414
for the trade-mark CINEMANOW in the
name of BBY Solutions, Inc.**

[1] BBY Solutions, Inc. has applied to register the trade-mark CINEMANOW, based upon prior use in the United States and proposed use in Canada in association with providing movies and television programs for sale and for rent to be displayed and downloaded on or from the Internet. The application has been opposed by zip.ca Inc. primarily on the basis that the applied for trade-mark is clearly descriptive or deceptively misdescriptive of the applied for services, and there is a reasonable likelihood of confusion between this trade-mark and Zip.ca Inc.'s previous use and making known of its CINEMANOW mark in association with entertainment services and the distribution of various types of recordings and computer games in digital form by Internet connection or other electronic means.

[2] For the reasons that follow, I have found that this opposition should be rejected.

Background

[3] On June 9, 2010, BBY Solutions, Inc. (the Applicant), filed application no. 1,484,414 for the registration of the applied-for mark CINEMANOW (the Mark) based on proposed use in Canada in association with the following services:

Entertainment services, namely, providing for sale and for rent action, documentary, dramatic, foreign, horror, science fiction and musical based movies and television programs, by streaming, and to be displayed and downloaded on or from the Internet.

[4] The application is also based on use and registration in the United States on April 13, 2004, under No. 2,832,243.

[5] The Mark was advertised on June 8, 2011, and zip.ca Inc. (the Opponent) filed a Statement of Opposition on November 8, 2011, based on the following grounds of opposition set out in under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act): section 30(i), section 12(1)(b), section 16(3)(a) and section 2.

[6] In support of its opposition, the Opponent filed the affidavit of Jennifer Leah Stecyk, trade-mark searcher employed by the Opponent's agent. As its evidence, the Applicant filed the affidavits of Dane Penney, trade-mark searcher employed by the Applicant's agent and Fredrik Jakob Bernhard Baral, Merchandise Manager, New Business at Best Buy Canada Ltd.

[7] None of the affiants were cross-examined. Only the Applicant filed a written argument and no hearing was held.

Onus and Material Dates

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

[9] The material dates that apply to the grounds of opposition are as follows:

- Section 38(2)(a)/Section 30(i) - the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Section 38(2)(b)/Section 12(1)(b) – the filing date of the application [see *Havana Club Holdings SA v Bacardi & Co* (2004), 35 CPR (4th) 541 (TMOB); *Fiesta Barbeques Ltd v General Housewares Corp* (2003), 28 CPR (4th) 60 (FCTD)];

- Section 38(2)(c)/Section 16(3)(a) – the filing date of the application [see section 16(4) of the Act]; and
- Section 38(2)(d)/non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Preliminary Issue

Admissibility Issue

[10] The Applicant has made several objections to the Stecyk affidavit. The most objectionable parts of Ms. Stecyk’s affidavit may be summarized as follows.

[11] On July 20, 2012, in order to obtain information about the Applicant, Ms. Stecyk conducted an Internet search of the terms BBY SOLUTIONS CINEMANOW and BBY SOLUTIONS CINEMA NOW. Attached to her affidavit are copies of web pages she downloaded and printed from the website *www.cinemanow.com*. These web pages provide information relating to the CINEMANOW service and indicate that it is a digital entertainment service that allows users to “start watching new releases, movies and TV shows instantly” (Stecyk, para. 6 and Exhibit G).

[12] Also on July 20, 2012, Ms. Stecyk conducted an Internet search using the terms BEST BUY CANADA CINEMANOW and BEST BUY CANADA CINEMA NOW to obtain additional information about the Applicant’s entertainment services offered in Canada in association with the trade-mark CINEMANOW. Attached to her affidavit are copies that she made of web pages downloaded and printed from the website *www.bestbuy.ca*. The web pages provide information relating to Best Buy Canada Ltd. and indicate that Best Buy Canada Ltd. is the provider in Canada of the CinemaNow digital entertainment service that “offers instant access to an extensive library of premium video content for rental and purchase” (Stecyk, Exhibit D).

[13] The first objection made by the Applicant is that the evidence of Ms. Stecyk was introduced by an employee of the Opponent’s firm. The general argument is that employees are not independent witnesses giving unbiased evidence when they give opinion evidence on

contested issues [see *Cross-Canada Auto Body Supply (Windsor) Ltd v Hyundai Auto Canada* (2006), 53 CPR (4th) 286 (FCA) (“*Cross-Canada*”)]. The Applicant submits that, as a result, little if any weight should be accorded to this affidavit.

[14] Second, the Applicant submits that that even if the exhibits attached to Ms. Stecyk’s affidavit are admissible, in view that the printouts of third party websites are hearsay, these exhibits are not admissible for the truth of their contents.

[15] With respect to the Applicant’s first objection, I do not find that the concerns raised by the Federal Court of Appeal in *Cross-Canada*, apply here. Ms. Stecyk’s affidavit does not contain conclusions or opinions on the contentious issues of the opposition. She simply searched the Internet for various terms to obtain additional information about the Applicant’s entertainment services offered in Canada in association with the trade-mark CINEMANOW. I do not see how the fact that this evidence was introduced by an employee of the Opponent’s agent makes it less proper than if the Opponent or its agent had hired any outside investigator to make such Internet searches and swear an affidavit. Overall, the evidence does not appear to me to be controversial.

[16] With respect to the Applicant’s second objection, even if the website print-outs are considered to be hearsay, I would have given at least some weight to them since it was necessary for the Opponent to file them and they are reliable since the Applicant, being a party, has the opportunity to refute the evidence regarding the provider of its services in Canada [*Reliant Web Hostings Inc v Tensing Holding BV*; 2012 CarswellNat 836 (TMOB) at para 35; *Blistex Inc v Smiths Medical ASD, Inc*, 2012 TMOB 184 (CanLII)].

Grounds of Opposition Summarily Dismissed

Non-compliance – Section 30(i)

[17] The Opponent pleads that the application does not comply with section 30(i) of the Act in that the Applicant knew or ought to have known of the existence of the Opponent's rights in and to the trade-mark CINEMANOW and that its use of the Mark in association with the applied for services would falsely suggest a connection with the Opponent and/or would direct public attention to the Applicant's services or business in such a way as to cause or likely cause confusion in Canada between the Applicant's services and those of the Opponent.

[18] Section 30(i) of the Act merely requires that an Applicant declare in its application that it is satisfied that it is entitled to registration of its trade-mark. Where an applicant has provided the requisite statement, 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 [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. Mere knowledge of the existence of the Opponent's trade-mark or a third party's trade-mark does not in and of itself support an allegation that the Applicant could not have been satisfied of its entitlement to use the Mark [see *Woot, Inc v WootRestaruants Inc Les Restaurants Woot Inc* 2012 TMOB 197 (CanLII)].

[19] As there is no evidence of bad faith in the present case, I am dismissing this ground of opposition.

Non-entitlement – Section 16(1)(a)

[20] As its non-entitlement ground of opposition, the Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark since at the date of filing the Mark was confusing with the trade-mark CINEMANOW which had been previously used in Canada by the Opponent in association with entertainment services and the distribution of video recordings, sound recordings, musical recordings, multimedia recordings and computer games in digital form electronically, namely by Internet connection, cable, satellite, telephone lines, wireless or other electronic medium.

[21] Sections 16(5) and 17(1) of the Act place a burden on the Opponent to establish its use of its CINEMANOW mark prior to the Applicant's date of filing and non-abandonment of such mark as of the date of advertisement of the present application. For the reasons discussed below, I find that the Opponent has not shown use of its CINEMANOW mark prior to June 9, 2010, and I therefore reject the section 16(3)(a) ground.

[22] The only evidence put forward by the Opponent of its mark is evidence relating to its registration of the domain name *cinemanow.ca*.

[23] I agree with the Applicant that the mere registration of a domain name does not constitute use of the trade-mark CINEMANOW for the purposes of section 4(1) or 4(2) of the Act. In *Jack W Chow Realty Ltd v Millenium Insurance Corp* (2005), 46 CPR (4th) 382 (TMOB) ("Jack Chow Realty"), former Member Bradbury stated the following at p. 388:

The mere ownership of a domain name registration by another party cannot affect the distinctiveness of the applicant's trade-mark. A domain name registration is analogous to a business name registration. In the absence of evidence that the registered name has been used, the registration of a name cannot affect the distinctiveness of the applicant's mark.

[24] Also, in *SMART Technologies ULC v Sunrise Technology, Inc* (2011), 99 CPR (4th) 263 (TMOB), Board Member de Paulsen held that section 16(3)(a) "does not preclude the registration of a trade-mark which is confusingly similar with a domain name." Only use of a domain name that meets the Section 4 criteria for use is relevant.

[25] As the Opponent has not met its initial evidential burden under this ground of opposition, it must fail.

Clearly Descriptive or Deceptively Misdescriptive – Section 12(1)(b)

[26] The Opponent pleads that the Mark is not registrable under section 12(1)(b) because it is either clearly descriptive or deceptively misdescriptive of the character or quality of the Applicant's services.

[27] Section 12(1)(b) is reproduced below:

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

...

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

[28] The issue as to whether the Applicant's Mark is clearly descriptive or deceptively misdescriptive must be considered from the point of view of the average purchaser of the associated services. Further, the Mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd v Registrar of Trade Marks*, 40 CPR (2d) 25 (FCTD) at 27-8; *Atlantic Promotions Inc v Registrar of Trade Marks*, 2 CPR (3d) 183 (FCTD) at 186]. Character means a feature, trait or characteristic of the services and "clearly" means "easy to understand, self-evident or plain" [see *Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 at 34]. To be objectionable as clearly descriptive under section 12(1)(b) of the Act, a mark must be a word so apt for normal description of the article that a monopoly on the use of it should not be acquired [see *Clarkson Gordon v Registrar of Trade-marks* (1985), 5 CPR (3d) 252 at 256 (FCTD)].

[29] Where a coined word is not defined, reference may be made to the meanings of the component parts of the trade-mark as defined in standard dictionaries. In order for a trade-mark to be clearly descriptive of the character or quality of an applicant's wares or services, the combined words forming the trade-mark must also have a combined meaning which is readily discernable from the combination, this being best determined from the meanings of the individual components. Finally, the trade-mark is to be considered in connection with the wares or services to which it is associated.

[30] Ms. Stecyk provided the following dictionary definitions of the words CINEMA and NOW, as found in the Merriam Webster Dictionary database:

Cinema:

1. a. Motion Picture – usually used attributively
b. a motion-picture theatre

Now:

1. a. at the present time or moment
- b. in the time immediately before the present “thought of them just now”
- c. in the time immediately to follow: forthwith “come in now”

[31] The Applicant argues that the Opponent has not introduced any evidence showing any performance or advertising in Canada of any digital entertainment service with a mark, name or even description that includes the words CINEMA and NOW, together, apart from the Applicant’s business, nor has the Opponent adduced any evidence to show that Canadian consumers ascribe any particular meaning to the words CINEMA and NOW despite conducting several Internet searches. Accordingly, the Applicant submits that there is no evidence that makes it self evident or plain that consumers would perceive the Mark as being clearly descriptive.

[32] The Applicant further submits that CINEMANOW is not a word in English or French, and that the Opponent has failed to introduce any evidence of any common use of the words CINEMA and NOW together.

[33] As noted, the Opponent has not made any written or oral submissions.

[34] The mere joining together of two descriptive words to form a single word never seen before in the English language does not necessarily make such a word an invented word such that it is non-descriptive [see *Wool Bureau; supra; Oshawa Group Ltd v Registrar of Trade Marks* (1980), 46 C.P.R. (2d) 145 (FCTD); *CKR Inc v Procter & Gamble Inc* (1986), 14 CPR (3d) 231 (TMOB); *Mitel Corporation v Registrar of Trade Marks* (1984), 79 CPR (2d) 202 (FCTD); *Shaw Cablesystems GP v Nucleus Information Service Inc* (2005), 49 CPR (4th) 132 (TMOB)].

[35] From the dictionary definitions provided by the Opponent, I am able to conclude that the word CINEMANOW describes motion pictures or a motion picture theatre that is provided at the present time or instantly. The question then becomes whether the Mark CINEMANOW is either

clearly descriptive or deceptively misdescriptive of the Applicant's services comprising the following: "Entertainment services, namely, providing for sale and for rent action, documentary, dramatic, foreign, horror, science fiction and musical based movies and television programs, by streaming, and to be displayed and downloaded on or from the Internet."

[36] The Applicant's entertainment services comprise both online movies and television programs. While the word CINEMA may be suggestive of a place where one can view motion pictures, it is not at all suggestive of a place where one can view television programs. Further, it is not clear to me what the word CINEMA means with respect to online entertainment services in general. The fact that the Opponent did not make any submissions about what either this term or the term NOW means in the industry, combined with the fact that there is no evidence of third parties using either of the components of the Mark together in association with similar services, makes me question whether Canadian consumers of these services would attribute a clearly descriptive meaning to the combination of these words in the Mark.

[37] In view of the above, I consider that the average purchaser of on-line Internet entertainment would not, as a matter of immediate impression, find the Mark clearly describes that the Applicant is providing motion pictures instantly. While the Mark may be suggestive, I do not consider it to be clearly descriptive or deceptively misdescriptive of the Applicant's entertainment services. As a result, this ground of opposition fails.

Non-Distinctive – Section 2

[38] The Opponent has also pleaded that the Mark is not distinctive of the Applicant because it does not distinguish nor is adapted to distinguish the services of the Applicant from the services of others including the Opponent because: 1) the Mark is clearly descriptive or deceptively misdescriptive of the character or quality of the Applicant's services; and/or 2) of the prior use, promotion and making known by the Opponent in Canada of the trade-mark CINEMANOW.

[39] As noted above, the Mark has been not been found to be clearly descriptive or deceptively misdescriptive of the Applicant's services. The first argument of the Opponent under this ground therefore fails.

[40] In order to meet its evidential burden with respect to the second part of this ground, the Opponent must show that as of the filing of the opposition the Opponent's mark had become known sufficiently to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD); *Re Andres Wines Ltd and E & J Gallo Winery* (1975), 25 CPR (2d) 126 at 130 (FCA); and *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 412 at 424 (FCA)].

[41] As noted above, the Opponent has not filed any evidence of any use by it or any licensee of the trade-mark CINEMANOW with any services. The only evidence put forward by the Opponent of its mark is evidence relating to its registration of the domain name *cinemanow.ca*. As previously noted, in the absence of evidence that the registered domain name has been used, the registration of a domain name cannot affect the distinctiveness of the Mark [see *Jack Chow Realty, supra*].

[42] As the Opponent has not met its evidential burden with respect to the second part of this ground, this part of this ground of opposition also fails.

Disposition

[43] In view of the above, and 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.

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