



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

Citation: 2014 TMOB 131
Date of Decision: 2014-06-25

IN THE MATTER OF AN OPPOSITION
by Zillow, Inc. to application
No. 1,445,278 for the trade-mark
HOMEZILLA in the name of HomeZilla
Inc.

[1] HomeZilla Inc. (the Applicant) has applied-for registration of the trade-mark HOMEZILLA for use in association with real estate related wares and services including computer software and advertising and marketing services on the basis of its use in Canada with certain of the wares and services since December 2007 and its proposed use in Canada with the remaining wares and services.

[2] Zillow, Inc. (the Opponent) owns the trade-marks ZILLOW and ZILLOW.COM which are used with real estate related wares and services including the operation of a real estate website and mobile apps where consumers can search for homes for sale, find home prices, see home values, view recently sold homes and check mortgage rates. The Opponent has primarily opposed this application on the basis that the HOMEZILLA trade-mark is confusing with its registrations for and previous use and/or making known of its ZILLOW and ZILLOW.COM trade-marks and Zillow trade-name. The Opponent also challenges the date of first use in the application.

[3] For the reasons that follow, I find that the application should be refused with respect to the wares and services applied-for on the basis of use since the Applicant has not proven that it had used the Mark as of the stated date. I find that the opposition should be rejected with respect

to the wares and services based on proposed use as there is not a reasonable likelihood of confusion between the HOMEZILLA trade-mark and the Opponent's ZILLOW and ZILLOW.COM trade-marks and Zillow trade-name.

Background

[4] On July 20, 2009, the Applicant filed an application for the trade-mark HOMEZILLA (the Mark) based on both use and proposed use. The Wares and Services as amended, along with the first use dates, if any, are set out in Schedule A.

[5] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 9, 2011. The Opponent filed a statement of opposition on August 9, 2011 which was subsequently amended. The Opponent has pleaded non-compliance with section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) as the basis of two of its grounds of opposition. The remaining grounds turn on the determination of the likelihood of confusion between the Opponent's registration Nos. TMA781,741 and TMA805,900 for ZILLOW and ZILLOW.COM and its use and/or making known of these trade-marks and its trade name Zillow (see sections 2 and 16 of the Act). The Applicant filed and served a counter statement, in which it denies the Opponent's allegations.

[6] The Opponent filed as its evidence the affidavits of Michelle Wynne and Karen Monteith. The Applicant did not file any evidence. Ms. Wynne was cross-examined on her affidavit. Both parties filed a written argument. A hearing was held on March 12, 2014 at which both parties were represented.

Onus and Material Dates

[7] 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].

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

- 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 [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 at 422 (FCA)];
- sections 38(2)(c)/16(1) – the date of first use alleged in the application [section 16(1)], if however, an opponent successfully challenges the date of first use, the material date becomes the filing date of the application [*Everything for a Dollar Store (Canada) Inc v Dollar Plus Bargain Centre Ltd* (1998), 86 CPR (3d) 269 (TMOB)].
- sections 38(2)(c)/16(3) - the filing date of the application [see section 16(3)]; and
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 at 324 (FC)].

Grounds of Opposition

Section 30 Grounds of Opposition

Section 30(i)

[9] The Opponent alleges that on the filing date of the application the Applicant knew or should have known that it was not entitled to use the Mark. Where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As the application includes the required statement and there is no evidence of bad faith or other exceptional circumstances, the section 30(i) ground is dismissed.

Section 30(b) – Use Prior to Filing

[10] The Opponent alleges that the application does not comply with section 30(b) of the Act with respect to the Use Based Wares and Services as the Mark was not being used as of the date claimed in the application. The evidential burden on the Opponent respecting the issue of the Applicant's non-compliance with this section of the Act is lighter because the facts supporting the use of the Mark are particularly within the knowledge of the Applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89].

[11] An opponent need only produce evidence to support its objections or adduce evidence from which it may reasonably be concluded that the facts alleged to support this ground of opposition exist [*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at para 34]. There is no requirement that the evidence be clearly inconsistent with the claimed date of first use if an opponent has not relied on an affidavit filed by the applicant in the opposition proceeding [*Bacardi, supra* at para 33].

[12] Ms. Wynne, corporate counsel for the Opponent, attaches to her affidavit the following evidence concerning the Applicant's use of the Mark:

- A press release dated September 30, 2008 entitled “Former Yahoo! Manager Launches HomeZilla, the Next Generation Real Estate Website to Help Canadian Homebuyers” (Exhibit J to the Wynne affidavit). This press release states:
 - “HomeZilla (www.homezilla.ca), the powerful next-generation Canadian real estate website, launched today with an open invitation to visit their site”
 - “HomeZilla has been in stealth mode since April 2008 but is now having an online open house”
 - “For further information: Sandy Ward, Founder, HomeZilla, sandy@homezilla.com”
- An “elevator pitch” presentation entitled “HomeZilla Deck” with the notation “Confidential January 2008” (Exhibit L).
 - “HomeZilla is an easy to use one-stop shop to help home buyers and agents research neighbourhoods. HomeZilla’s next generation tools go beyond today’s websites...”
- Pages of the HomeZilla web-site *homezilla.ca* archived by WayBack Machine between December 2, 2007 and March 26, 2008. Each of these pages indicate that the website is “coming soon” and provides for site visitors to subscribe by email to “find out about our launch” (Exhibit K to the Wynne affidavit). The March 26, 2008 page further states:
 - “Building a web application is like building a house. You need a strong foundation and a good skeleton to have a quality house. We completed our foundation and skeleton at the end of January ... Once all the rooms on our first

floor are decorated we will be having an open house! The open house plan will be in Q2 of 2008.”

[13] Ms. Wynne was cross-examined on her affidavit and during her cross-examination stated that she was unable to confirm the accuracy of the cached pages attached to her affidavit since she didn't see the pages in 2007 (Q57). She, however, does indicate that when she has used the service to look up pages from the Zillow website they have been accurate (Q57). While Exhibit 1 to the cross-examination is a page stating that pages can be removed from WayBack Machine, there is no evidence to suggest the text archived on a given date may be altered or otherwise inaccurate.

[14] The Applicant objects to Ms. Wynne's evidence of the press release, elevator pitch and archived pages from WayBack Machine on the basis that it is hearsay. The press releases and launch are admissible even though they are hearsay since it was necessary for the Opponent to file them to challenge the section 30(b) claim to use and they are reliable since the Applicant, appears to have participated in their creation and had the opportunity to refute the evidence [*Reliant Web Hostings Inc v Tensing Holding BV*; 2012 CarswellNat 836 (TMOB) at para 35].

[15] With respect to the pages from the archive Wayback Machine, showing the *www.homezilla.ca* website at prior dates, WayBack Machine has been found to be generally reliable [see *Candrug Health Solutions Inc v Thorkelson* (2007), 60 CPR (4th) 35 (FC) at para 21; reversed on other grounds 2008 FCA 100]. More particularly, Wayback Machine evidence in support of an opponent's section 30(b) ground of opposition has been found admissible [*Royal Canadian Golf Assn v O.R.C.G.A.* (2009), 72 CPR (4th) 59 (TMOB), at pages 64-65]:

I appreciate that there be limitations to the accuracy of the Wayback Machine, including but not limited to possible hearsay issues. However, for the purpose of meeting the Opponent's light initial burden under s. 30(b), I find that the search results are sufficient to raise a doubt concerning the correctness of the Applicant's claimed date of first use [...]. The Applicant had the opportunity to file evidence to rebut the results of the Wayback Machine search but chose not to.

In the present case, I find that Ms. Wynne's evidence raises a doubt as to the correctness of the Applicant's statement that it has used the Mark in association with the Use Based Wares and Services since December 2007. The Use Based Wares and Services appear to relate to a web application available through the HomeZilla “website providing home buyers and real estate

agents with a one-stop shop to find neighbourhood information and a house.” Based on the evidence of record, the Opponent has met its light evidential burden. As the Applicant did not file any evidence, this ground of opposition is successful.

Section 12(1)(d) – Non-registrability

[16] The section 12(1)(d) ground of opposition turns on the issue of the likelihood of confusion between the Mark and the Opponent’s ZILLOW trade-mark (registration No. TMA781,741) as it is more similar in appearance to the Mark than the ZILLOW.COM trade-mark (registration No. TMA805,900). The wares and services of the ZILLOW trade-mark registration are set out in Schedule B to this decision. The Opponent has met its initial burden with respect to the section 12(1)(d) ground since registration No. TMA781,741 is in good standing.

test for confusion

[17] 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 wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. 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 or trade-names and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight.

[18] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361

(SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

inherent distinctiveness

[19] Both parties' trade-marks consist of coined words and are inherently distinctive.

extent of use and the length of time each trade-mark has been in use

[20] The extent of use and length of time in use significantly favours the Opponent. The Opponent provides the *www.zillow.com* website which allows consumers to search for homes for sale in the United States, find home prices, check mortgage rates, and obtain neighbourhood information (Exhibits A and B). The Opponent's ZILLOW trade-mark and trade-name are featured prominently on this website and have been so featured since 2006 (Exhibits B and E). Ms. Wynne states that *www.zillow.com* has been accessible to Canadians since its launch in February 2006 and provides the following information about unique Canadian visitors to the site (Wynne affidavit, para 12, 18-20; Exhibits B and E).

- February 2006-December 2007 – average of at least 20,000 unique Canadian visitors per month;
- January 2008-December 2009 – average of at least 60,000 unique Canadian visitors per month;
- January 2010-February 2012 – average of at least 190,000 unique Canadian visitors per month;

The use of the ZILLOW trade-mark on the *www.zillow.com* website visited by Canadians to obtain information regarding United States real estate is use in Canada [*TSA Stores, Inc v Canada (Registrar of Trade-marks)* (2011), 91 CPR (4th) 324 (FC)].

[21] Ms. Wynne also attaches articles referencing the ZILLOW trade-mark, trade-name or website *www.zillow.com* appearing in the periodicals set out below. This evidence suggests that the ZILLOW trade-mark is known to at least some extent in Canada.

<u>Newspaper</u>	<u>Date Article Was Published</u>
<i>National Post</i>	February 9, 2006
<i>Calgary Herald</i>	August 28, 2006
<i>Montreal Gazette</i>	February 13, 2008
<i>National Post</i>	April 4, 2008
<i>Maclean's</i>	April 20, 2009
<i>The Globe and Mail</i>	January 30, 2010
<i>National Post</i>	May 10, 2011

nature of the wares, services and trade

[22] This factor favours the Opponent. There is significant overlap between the wares and services of the parties, some of which are described using identical terms, and their target audiences (those looking to purchase homes and find out real estate and neighbourhood information).

degree of resemblance

[23] In *Masterpiece Inc, supra* the Supreme Court of Canada indicates that the most important factor amongst those listed under section 6(5) of the Act will often be the degree of resemblance between the marks. Given the differences in appearance, sound and ideas suggested by the marks, I do not find that the marks have a high degree of resemblance. Although the parties' trade-marks both contain ZILL, I find that the trade-marks as a whole have a significantly different appearance and sound. Furthermore, the parties' trade-marks don't suggest the same idea. In her affidavit, Ms. Wynne explains that ZILLOW is a coined word – a combination of “zillion” and “pillow” - and evolved from a desire to make zillion of data points for homes accessible to everyone [Wynne affidavit, para 6]. The Mark has no such connotation. Where consumers are unaware of the origins of the ZILLOW trade-mark, I still consider that the trade-

marks would not suggest the same idea to consumers. A consumer confronted with the Mark would assume that it is a business related to goods or services for one's home. A consumer confronted with the Opponent's trade-mark may be unsure of what idea is being suggested since the combination of "zillion" and "pillow" is unlikely to be immediately apparent.

[24] The Opponent submits in its written argument and at the oral hearing that the fact that both parties marks contain the ZILL component results in trade-marks that resemble each other in look, sound and ideas suggested:

130 ... The word "ZILLA" is similar in appearance to the word "ZILLOW". The word "ZILLA" and the word "ZILLOW" share the initial letters "ZILL".

131 The Trade-mark and the Opponent's Marks are similar when sounded... Since the word "HOME" is a common word and is used as a descriptive word in the Trade-mark, the word "ZILLA" is the dominant portion of the Trade-mark. The short vowel "a" in the second element of the Trade-mark "ZILLA", when pronounced is similar to the sound of the long vowel "o" in the word "ZILLOW".

132 Since the Trade-mark incorporates a major and the dominant portion of the Opponent's Marks, namely the element "ZILL", it is also similar in the ideas suggested by the Opponent's Marks.

The Opponent's approach, however, appears to involve a side-by-side comparison of the type warned against by the courts [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 at para 20; *International Stars SA v Simon Chang Design Inc*, 2013 FC 1041 at para 9].

conclusion re likelihood of confusion

[25] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Mark when he or she has no more than an imperfect recollection of the Opponent's ZILLOW trade-mark, and does not pause to give the matter any

detailed consideration or scrutiny [*Veuve Clicquot Ponsardin, supra*]. I conclude that, on a balance of probabilities, there is no reasonable likelihood of confusion between the Opponent's ZILLOW trade-mark and the Mark for use in association with the Wares and Services given the differences between the parties' marks. Accordingly, the section 12(1)(d) ground of opposition is dismissed.

Section 38(2)(c)/16(1) and 16(3) Entitlement

[26] The Opponent has pleaded that the Applicant is not the person entitled to registration pursuant to sections 16(1)(a), 16(1)(c), 16(3)(a) and 16(3)(c) of the Act on the basis that the Mark is confusing with the Opponent's marks ZILLOW and ZILLOW.COM and trade-name Zillow. As the Opponent was successful in challenging the date of first use, the initial burden is on the Opponent to evidence use of its marks and trade-name prior to the Applicant's filing date and non-abandonment of its marks and trade-name as of the date of advertisement of the Applicant's application [*Everything for a Dollar Store (Canada) Inc v Dollar Plus Bargain Centre Ltd* (1998), 86 CPR (3d) 269 (TMOB) at 282]. While the Opponent's evidence is sufficient to meet its burden with respect to each of these grounds of opposition, the conclusion reached with respect to the section 12(1)(d) ground of opposition are equally applicable. Accordingly, these grounds of opposition are rejected.

Section 38(2)(d)/(2) – Non-Distinctiveness

[27] Regarding the ground of opposition based on lack of distinctiveness pursuant to section 2 of the Act, the Opponent needs to have shown that as of the date of filing the statement of opposition its trade-marks and trade-name had become known sufficiently to negate the distinctiveness of the applied-for mark [*Bojangles' International, LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FCTD)]. To do so, the Opponent must establish that its marks and trade-name are either known to some extent in Canada or is well known in a specific area of Canada [*Bojangles, supra* at paras 33-25]. While the Opponent's evidence is sufficient to meet its burden, the conclusion reached with respect to the section 12(1)(d) ground of opposition is equally applicable to this ground of opposition. Consequently the Mark is adapted to distinguish and actually distinguishes the wares and services from the Opponent's wares and services. Accordingly, this ground of opposition is rejected.

Disposition

[28] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse application No. 1,445,278 with respect to the wares and services set out below:

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

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

[29] I reject the opposition with respect to the remainder of the wares and services, pursuant to section 38(8) of the Act [see *Coronet-Werke Heinrich Schlerf GmbH v. Produits Ménagers Coronet Inc* (1986), 10 CPR (3d) 482 (FCTD) as authority for a split decision].

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule A

Appl No. 1,445,278 for HOMEZILLA

Use Based Wares and Services

(since at least as early as 2007)

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

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

Wares and Services Based on Proposed Use

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

Services: Real estate sales management; real estate marketing services, namely, on-line services featuring tours of real estate, neighbourhood research, providing a marketplace for goods of others in the field of real estate, general consumer merchandise and general consumer services via an online electronic communication network; providing information in the field of consumer goods for home maintenance, decoration, and sales, and consumer services relating to real estate; promoting the goods and services of others via an online electronic communication network by means of providing links to others' websites in the fields of real estate, mortgages, general consumer merchandise and general consumer services; real estate agencies and brokerages; real estate consultancy and appraisal services, financial valuation of personal property; real estate research services; design of computer software; providing non-downloadable

software tools for others to design and create websites; hosting websites for other including blogs, providing access to non-downloadable computer software, namely, non-downloadable consumer data storage software for administering, managing, storing, retrieving and coordinating the storage of data files in the area of real estate; providing non-downloadable computer e-commerce software to allow users to perform electronic business transactions; providing non-downloadable computer database software for administering, managing, storing, retrieving, and coordinating the storage of data files featuring information in the fields of general consumer merchandise and general consumer services; web services; API providing temporary and downloadable information to provide neighbourhood information and real estate listings; real estate valuation service, financial valuation of real estate; profile information for neighbourhoods; providing information in the field of real estate; providing non-downloadable computer database software for administering, managing, storing, retrieving, and coordinating the storage of data files featuring information on the field of real estate.

Schedule B – ZILLOW (Reg. No. TMA781,741)

Wares:

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

Services:

(1) Advertising and marketing services, namely advertising and marketing the services of others in the fields of real estate; advertising and marketing services, namely advertising and marketing the goods and services of others in the fields of general consumer merchandise and general consumer services; dissemination of advertising and marketing for others in the fields of real estate, general consumer merchandise and general consumer services via an online electronic communications network; real estate marketing services, namely, on-line services featuring tours of real estate; providing a marketplace for the goods of others in the field of real estate and general consumer services via an online electronic communications network; providing information in the field of consumer services for home maintenance, decoration and sales; providing information in the field of consumer services relating to real estate.

(2) Promoting the goods and services of others via an online electronic communications network by means of providing links to others' web sites in the fields of real estate, general consumer merchandise and general consumer services.

(3) Real estate research services; providing non-downloadable software tools for others to design and create webpages; hosting webpages for others; providing access to non-downloadable computer software, namely, non-downloadable consumer data storage software for administering, managing, storing, retrieving and coordinating the storage of data files in the area of real estate.

(4) Operating marketplaces for sellers of goods and services in the field of real estate; real estate valuation services, financial valuation of real estate; providing information in the field of real estate.

(5) Providing access to non-downloadable computer database software for administering, managing, retrieving and coordinating the storage of data files featuring information in the field of real estate.