



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

Citation: 2012 TMOB 204
Date of Decision: 2012-10-31

**IN THE MATTER OF AN OPPOSITION by
Colba.Net inc. to application No. 1,365,053
for the trade-mark OPENCOLLABNET &
Design in the name of CollabNet, Inc.**

[1] On September 25, 2007, CollabNet, Inc. (the Applicant) filed an application to register the trade-mark OPENCOLLABNET & Design (shown below) (the Mark), based on use of the Mark in Canada in association with various computer wares and services, as well as use and registration of the Mark in the United States. The statement of wares and services, as revised, covered by the application reads as follows:



Wares:

(1) Computer software, namely computer software development tools for design and development of open-source and proprietary software programs; computer software and computer software development tools for design and development of open-source and propriety software programs, namely, software and web-based software platforms that serve as the infrastructure for developers to use software tools for the collaborative development of software programs; downloadable electronic publications, namely software manuals, white papers, articles, books, guides, webcasts, podcasts and streaming audio/video in the fields of computer software development, computer software development tools, open-source development tools, computer software, open-source development communities, computer and technology, software training, and technical support resource.

Services:

(1) Providing on-line electronic bulletin boards and forums for transmission of messages, articles, documents, white papers, data and information among computer users concerning open-source development tools, computer and technology, computer software development and programming, software training, web site design and development, application hosting resources, and technical support resources; providing webcasts, podcasts and streaming audio/video in the fields of computer software development, computer software development tools, open-source development tools, computer software, open-source development communities, computer and technology, software training, and technical support resources. (2) On-line journals, namely, blogs featuring computer software development tools, computer software, open-source development communities, computer and technology, computer software development and programming, software training, and technical support resources; providing on-line publications in the nature of white papers, technical papers, articles, books and guides in the field of computer software development, computer software development tools, computer software, open-source development communities, computer and technology, computer software development and programming, software training, and technical support resources; providing information in the field of software training; providing links to web sites, articles, webcasts, podcasts and streaming audio/video of others featuring software training. (3) Providing information in the fields of computer software development, computer software development tools, computer software, open-source development communities, computer and technology, computer software development and programming, and technical support resources, all via an interactive web site on the Internet; providing links to web sites, articles, webcasts, podcasts and streaming audio/video of others featuring information on computer software development, computer software development tools, computer software, open-source development communities, computer and technology, computer software development and programming, and technical support resources; technical support services, namely troubleshooting of computer software problems; computer software and information technology consultation; computer and technology services for others, namely, software design, development and programming; computer services, namely, designing and implementing websites for others to serve as the infrastructure and platform for collaborative software development [sic], management hosting, testing and deployment by developers; computer services, namely, designing and implementing website for others to serve as the infrastructure and platform for collaborative software development, management hosting, testing and deployment by developers hosting the aforementioned types of websites of others on a computer server for a global computer network; for collaborative software development, management, hosting, testing and deployment by developers application service provider, namely, hosting computer software applications of others for collaborative software development, management, hosting, testing and deployment by developers; providing temporary use of on-line non-downloadable software for software development, tracking changes and modifications to software and for managing software development projects; computer services, namely designing, developing, implementing, installing, maintaining, upgrading, supporting and configuring computer software and consulting related thereto; except [sic] as otherwise stated, all of the foregoing excluding: the provision of high-speed [sic] Internet access to the Internet,

consultation services concerning the creation and management of intranet communication networks, distribution and retail sale of computer hardware parts and accessories, providing educational courses to the public concerning how to access and use the Internet, maintenance and repair of computer hardware Systems, electronic telecommunications services, namely Internet services provider services.

Claims:

Priority Filing Date: March 28, 2007, Country: UNITED STATES OF AMERICA, Application No: 77/143,107 in association with the same kind of wares. Priority Filing Date: March 27, 2007, Country: UNITED STATES OF AMERICA, Application No: 77/141,966 in association with the same kind of services (1). Priority Filing Date: March 27, 2007, Country: UNITED STATES OF AMERICA, Application No: 77/141,970 in association with the same kind of services (2). Priority Filing Date: March 27, 2007, Country: UNITED STATES OF AMERICA, Application No: 77/141,978 in association with the same kind of services (3).

Used in CANADA since at least as early as November 02, 2006. Used in UNITED STATES OF AMERICA.

Registered in or for UNITED STATES OF AMERICA on December 11, 2007 under No. 3,351,694 on wares. Registered in or for UNITED STATES OF AMERICA on December 11, 2007 under No. 3,351,636 on services (1). Registered in or for UNITED STATES OF AMERICA on December 11, 2007 under No. 3,351,637 on services (2).

Registered in or for UNITED STATES OF AMERICA on December 11, 2007 under No. 3,351,639 on services (3).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of September 28, 2007.

[3] On February 6, 2009, Joseph Bassili filed a statement of opposition against the application. Colba.Net inc. was thereafter substituted to Joseph Bassili as opponent. Unless indicated otherwise, Joseph Bassili and Colba.Net inc. will be collectively referred to in my decision as the Opponent.

[4] The statement of opposition, as last amended by the Opponent and accepted by the Registrar on December 6, 2010, claims that the application does not conform to the requirements of section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); that the Applicant is not the person entitled to registration of the Mark pursuant to section 16 of the Act; that the Mark is not registrable pursuant to section 12(1)(d) of the Act; and that the Mark is non-distinctive of the Applicant pursuant to sections 2 and 38(2)(d) of the Act in view of the fact that the Mark is, among others, confusing with the trade-mark and/or trade-name COLBA.NET (and variations

thereof), previously used in Canada by the Opponent in association with various computer services.

[5] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[6] As its evidence, the Opponent filed the solemn declaration of Joseph Bassili, dated August 18, 2009, and a certified copy of registration No. TMA496,843 for the trade-mark COLBA.NET. As its evidence, the Applicant filed the affidavits of Thomas Clark, dated May 21, 2010; Debbie Benson, dated May 20, 2010; and Karen Monteith, dated May 20, 2010. It is to be noted that as the original copies of these latter three affidavits were missing from the Registrar's record, the Opponent provided the Registrar with an extra copy of all three affidavits on September 5, 2012.

[7] Only the Applicant filed a written argument. Both parties were represented by counsel at an oral hearing held on September 11, 2012.

Onus

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidentiary 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); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

Overview of the parties' evidence

The Opponent's evidence

The Bassili solemn declaration

[9] This solemn declaration was executed by Mr. Bassili as opponent and owner of the trade-mark COLBA.NET registered under No. TMA496,843, as he was then, as well as president of

the licensee Colba.Net inc. This registration was assigned by Mr. Bassili to Colba.Net inc. on July 6, 2010. As indicated above, Colba.Net inc. was thereafter substituted to Mr. Bassili as opponent in the instant proceeding.

[10] Mr. Bassili states that he granted a license to “Colba. Net Inc.” (sic) with respect to the use of the trade-mark COLBA.NET, and its variations COLBANET and COLBANET Inc. I shall mention at this point of my decision that the name Colba.Net inc. has been misspelled throughout Mr. Bassili’s solemn declaration. I will refer to that entity as it is spelled in the amended statement of opposition and in the certificate of registration No. TMA496,843. Mr. Bassili states that by virtue of this license, he has direct or indirect control of the character and quality of the services performed in association with the trade-mark COLBA.NET, and its variations COLBANET and COLBANET Inc. Mr. Bassili adds that such control is notably made through the fact that he is the president of Colba.Net inc.

[11] The Applicant points out that Mr. Bassili does not provide evidence of such a license nor state whether the alleged license was written or oral. However, the fact that none of the exhibits to the Bassili solemn declaration include a copy of the license agreement is not fatal to the Opponent. Section 50 of the Act does not require a written license agreement. What is required by section 50 is that is that “the owner has, under the license, direct or indirect control of the character or quality of the wares and services”. Mr. Bassili has clearly stated in his solemn declaration that such control over the licensed use of the trade-mark COLBA.NET, and its variations COLBANET and COLBANET Inc., has been exercised. Mr. Bassili’s explicit statement regarding control is further supported by the statement that he has acted as president of Colba.Net inc. There is no evidence establishing that Mr. Bassili did not exercise, either directly or indirectly, control over the character or quality of the services. Furthermore, Mr. Bassili’s testimony has not been challenged by cross-examination. As a result, I am prepared to find that use of the trade-mark COLBA.NET, and its variations COLBANET and COLBANET Inc., as the case may be, by Colba.Net inc. as licensee of the marks prior to July 6, 2010 accrued to the benefit of Mr. Bassini as owner of the marks pursuant to section 50 of the Act.

[12] Reverting to Mr. Bassili’s testimony, Mr. Bassili states that the trade-mark COLBA.NET and its variations COLBANET and COLBANET Inc. are “essentially the same mark” and that a

reference to COLBA.NET in each of his solemn declarations can be understood as a reference to COLBA.NET and its variations. The Applicant points out that these statements of Mr. Bassili are, at best, misleading. More particularly, the Applicant submits that COLBA.NET and its variations COLBANET and COLBANET Inc. are not the same mark and that evidence, including evidence of use of one mark, is not necessarily evidence regarding the other marks. Moreover, the Applicant submits that Mr. Bassili fails to identify which marks are allegedly being used as trade-marks and which are allegedly being used as trade-names. Most importantly, the Applicant submits that Mr. Bassili provides no evidence of use of the registered trade-mark COLBA.NET *per se*, except as part of the domain name *www.colba.net*. Finally it submits that the evidence regarding use of COLBANET is very limited, since most of the evidence is in respect of COLBANET & Design and COLBANET itself is only used on four invoices. While I agree with the Applicant that evidence of use of one mark is not necessarily evidence regarding the other marks, I am satisfied from my review of the Bassili solemn declaration that the Opponent has evidenced use of the trade-marks COLBA.NET and COLBANET for the reasons explained below. However, I am not satisfied that the Opponent has evidenced use of COLBANET Inc. as a trade-mark.

[13] Mr. Bassili states that the services in association with the trade-mark COLBA.NET are offered to Canadian consumers through Colba.Net inc. These services include:

- Internet access services;
- Website hosting services; and
- Electronic telecommunication services that include service provider services.

[14] More particularly, Mr. Bassili explains that the services offered by the Opponent *today* (my emphasis) include ADSL (*asymmetric digital subscriber line*) services for commercial and residential customers, which is an ultra high speed Internet access service. The Opponent also provides telephone services, collocation servers for servers containing websites, and management services for email servers, as well as website hosting and domain name services. While Mr. Bassili does not expressly state for what period of time each of these services has been offered, he attaches to his solemn declaration the following exhibits, which do support and further clarify the above assertions of use:

- Exhibit JB-1: copies of representative advertisements published over the years in various publications including the *YellowPages* and the newspapers *Montreal Mirror*, *24 Heures* and *Metro*; and
- Exhibit JB-2: copies of representative invoices issued between the years 1998 and 2002.

[15] More particularly, upon review of Exhibit JB-1, I note that the advertisement published in the weekend 02-04 November 2001 edition of the *Metro* newspaper describes the Opponent's services as "*Un des meilleurs services internet au Québec! Accès commuté, Haute-Vitesse, Hébergement, Co-location*". The advertisement published in the 2001-2002 *Montreal YellowPages* describes the Opponent as an "Internet Access Provider" offering residential and commercial high speed Internet access services. The advertisement also refers to "Free Software Installation", "The Lowest Prices in Town", "User's Ration by Modem Very Low", "Link T3 Dedicated to the Internet", and "Turnkey Solution for Company". The advertisements published in the September 2008 of the *HUB: The Computer Paper – Montreal* as well as the August 7-13 2008 *Montreal Mirror* and the October 28, 2008 *Montreal 24 heures* further refer to "ADSL2+" and "VoIP telephony" services, etc.

[16] Each of these advertisements prominently displays the trade-mark COLBANET & Design reproduced below, which is followed by the word "inc." appearing in much smaller characters in the two specimens of advertisements published in the *YellowPages*:



[17] I find that use of the trade-mark COLBANET & Design may qualify as use of the trade-mark COLBA.NET. Indeed, the Opponent's trade-mark covered by registration No. TMA496,843 consists of the word mark COLBA.NET, therefore permitting use of the mark in any size and with any style of lettering, color or design. The different font size and character used for the letter "N" in the COLBANET & Design mark creates a separation between the words COLBA and NET, as does the dot in the registered trade-mark COLBA.NET. The

registered trade-mark remains recognizable in and of itself and retains its identity [see leading cases *Registrar of Trade-marks v Compagnie Internationale pour l'Informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA); and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[18] Likewise, I find that use of the trade-mark COLBANET & Design may also qualify as use of the trade-mark COLBANET. Indeed, despite its design feature, the mark is formed of the word COLBANET.

[19] Upon review of the invoices attached as Exhibit JB-2, I note that they pertain to telephone services as well as “*hosting base*” and websites update services. The invoices prominently display at the top of the page the trade-mark COLBANET & Design, followed underneath by the Opponent’s address. As such, it may arguably be perceived by the average consumer as identifying the name under which the Opponent’s business is carried on. However, as the trade-mark COLBANET & Design appears in much larger and bolder print than the Opponent’s address, it can also be perceived as a trade-mark. As stated by Board Member Martin in *Consumers Distributing Company Limited v Toy World Limited*, 1990 CarswellNat 1398 (TMOB), at paragraph 14, “trade-mark and trade-name usage are not necessarily mutually exclusive”. Whether the use of a trade-name may also be use as a trade-mark depends on the circumstances of each particular case [see *Road Runner Trailer Manufacturing Ltd v Road Runner Trailer Co* (1984), 1 CPR (3d) 443 (FCTD)]. The invoices further include at the bottom of the page the mention “*Please make check payable to ColbaNet and write your user name on the checks*”, which supports a finding of use of COLBANET as a trade-name.

[20] Reverting to the *YellowPages* advertisements, I find that they also support a finding of use of the trade-names COLBA.NET INC. and COLBANET INC. However, they do not support a finding of use of COLBA.NET INC. and COLBANET INC. as trade-marks in view of the much smaller characters used for the word “inc.” Insofar as the domain name *www.colba.net* at the bottom of the advertisements is concerned, I find that it serves as a contact reference for the consumer.

[21] Turning to the Opponent’s sales and advertising figures, Mr. Bassili explains that for each year since 1998, the annual business income realized in Canada by the Opponent in respect of

the services used in association with the trade-mark COLBA.NET for the period 1998 to the time of executing his solemn declaration has never been less than \$1.5 million per year. Mr. Bassili further states that the annual advertising expenses incurred by the Opponent promoting the trade-mark COLBA.NET have never been less than an estimated \$8000 per year for the period 1998 to the time of executing his solemn declaration. However no breakdown for each of the Opponent's services is provided. Furthermore, the specimens of invoices attached as Exhibit JB-2 pertain to sales made in the provinces of Quebec and Ontario only, whereas all samples of advertisements attached as Exhibit JB-1 appear to be drawn from the province of Quebec only. I will revert to these limitations below when assessing the section 6(5)(c) and (d) factors and the additional surrounding circumstances under the test for confusion.

The Applicant's evidence

The Clark affidavit

[22] Mr. Clark, who is the Vice President, Finance, of the Applicant first goes over the history of the Applicant. He states that the Applicant is in the business of providing computer software and related support services to clients developing and operating collaborative software and computer programs. He explains that the Applicant was founded and incorporated in 1999 under the name Collab.Net, Inc. in order to develop and market a proprietary collaborative software development environment founded on open source software concepts, which was expanded to include web-based development life-cycle management services, such as code versioning, bug tracking, email discussion forums, source-code browsing tools and an administrative interface.

[23] Mr. Clark further explains that the Applicant's products improved and evolved to include in late 2000 providing on-demand and onsite distributed Application Life-Cycle Management (ALM) solutions aimed to speed deployment and facilitate collaboration between developers across different locations and geographies.

[24] Mr. Clark states that the Applicant's current product offerings are CollabNet Enterprise Edition and CollabNet TeamForge. He explains that each is usable by small to mid-size project teams up through large development teams that span across an enterprise with thousands of users. The Applicant provides support, training and consulting services in connection with these

products. Market forces leading to adoption of the Applicant's products and services include: merger and acquisition activity; business efficiencies gained by the leverage of offshore resources; open source and interoperable services oriented architecture (SOA) software systems; mandates such as Sarbanes Oxley (the U.S. federal act setting out standards for U.S. public company boards, management and public accounting firms) or SAS 70 (professional standards used by a service auditor); government and industry regulations; and the problems arising with complex software configuration management (SCM) systems that require significant investment.

[25] Mr. Clark explains that in support of its basic offerings, the Applicant operates multiple, geographically distributed datacenters with redundant Internet links and worldwide technical support centers available 24 hours a day. Additionally it offers encrypted data, encrypted backups, hot failover, disaster recovery, dedicated physical infrastructure and virtual private network ("VPN") and private line connectivity.

[26] Mr. Clark states that the Applicant has numerous government agencies as customers and several million users from thousands of companies representing 200 countries worldwide. Its customer base also comprises a variety of industries, including financial services, IT, hardware, software, pharmaceuticals, wireless and telecommunications, and includes companies such as Hewlett-Packard, Sun Microsystems and Motorola. Target customers are software development teams of 30-5,000+ members in the upper midmarket and enterprise space, and from 5-50 member teams in the lower midmarket space.

[27] Mr. Clark states that the Applicant hosts and invites customers and others to join its online community. OpenCollabnet is the name the Applicant has given to its end-user and developer community using the COLLABNET TeamForge and Subversion platforms. He explains that OpenCollabnet members get access to certain community resources, including: in-depth help and technical articles; free software downloads and trials; participation in community forums; participation in development projects; the OpenCollabnet Technical Newsletter; release and patch notifications.

[28] Mr. Clark states that the Applicant first offered its wares and services in association with the Mark in the United States beginning in or about October 2006 and in Canada beginning in or about November 2006. He attaches to his affidavit as Exhibit J copies of selected entries from

the Applicant's record of registered account holders of OpenCollabnet accounts. Mr. Clark explains that to become a member, a user completes an online registration form. The member is provided with a log in information for the OpenCollabnet account. There are no registration fees to establish an account for the Applicant's online community and the wares may be downloaded or accessed for free. Since the wares and services used in association with the Mark are free, there are no applicable sales figures.

[29] Mr. Clark states that the Applicant has used the Mark extensively in association with its online community and the wares available to members of that community. He further states that the Applicant has used the trade-mark COLLABNET extensively in association with the marketing and sale of its collaborative software programs and services.

[30] Mr. Clark states that the Applicant's primary promotion vehicle is its website located at collab.net and accessible through collabnet.com, opencollabnet.com and opencollab.net. He attaches as Exhibit B to his affidavit, exemplary pages from the Applicant's website collab.net printed on May 18, 2010, and as Exhibit C, exemplary pages from the Applicant's websites opencollanet.com and opencollab.net printed on May 20, 2010 displaying the Mark. He further attaches as Exhibit H, exemplary pages of archived pages from the Applicant's websites collabnet.com and opencollabnet.com printed from the website *www.internetarchive.org* (known as the "wayback machine") on May 18, 2010. He also attaches as Exhibits D, E, F and G to his affidavit, printouts of VeriSign, Inc. Whois searches and Network Solutions Whois searches providing the registration details for these domain names.

[31] Mr. Clark states that the Applicant has maintained a significant presence on the World Wide Web. He attaches as Exhibit I to his affidavit, copies of various Web-based publication articles, press releases and advertisements referencing the Applicant. He explains that the Applicant has pioneered, on a worldwide basis, Collaborative Software Development based on extending the best principles of open source software development to the enterprise. He states that the Applicant has won dozens of business, technology, and industry awards based on this leadership, and has been pointed to as a leader in such best selling books as Tom Friedman's "The World is Flat". He further states that the Applicant was also the founder and still remains as the corporate sponsor of arguably the world's most successful enterprise open source application,

the Subversion software configuration management tool, which is the underpinning of collaborative software development networks and development servers for over 5,000,000 users worldwide. Mr. Clark further states that in December 2009 the World Economic Forum named the Applicant to the 2010 class of Technology Pioneers. In December 2010, IDC, a leading analyst firm, named the Applicant an “Innovative Application Development and Deployment Company under \$100M to Watch”. Mr. Clark states that as a result of its leadership, and its importance to the software industry, CollabNet’s brand recognition and use of its associated trade-marks is respected, and known worldwide in the \$100B+ IT industry.

[32] Mr. Clark explains that the name COLLABNET was originally chosen because it is suggestive in English of a collaborative process on the Internet. Early in the Applicant’s history, when asked what the name “CollabNet” meant, the representatives of the company would state that it was meant to imply “**collaborative software development over the net**”. Likewise, Mr. Clark states that the Mark is suggestive of the openness and collaborative process of community-developed computer software, open-source computer software development and programming the like.

[33] Mr. Clark comments on the differences existing between the Applicant’s product offerings and trade and the Opponent’s. The nature of the parties’ wares, services or business and the nature of the parties’ trade will be discussed at length later on in my decision when assessing the section 6(5)(c) and (d) factors under the test for confusion.

[34] Mr. Clark states that the Applicant first offered its products and services for sale in association with its trade-mark COLLABNET in the United States beginning in or about July 2000. He attaches to his affidavit invoices issued by the Applicant and evidencing sales of the Applicant’s products and services in association with the trade-mark COLLABNET in that country both prior to November 15, 2002 (Exhibit K), and after that date (Exhibit L).

[35] Mr. Clark states that since 2000 the Applicant’s customer base has grown to include customers based worldwide, in North America, Asia, Europe and South America. Concerning more particularly Canada, Mr. Clark states that the Applicant has provided its wares and services in this country in association with the trade-mark COLLABNET since 2006, at which time the Applicant sold wares and services valued at \$5,000 to its first Canadian customer. He attaches as

Exhibit N to his affidavit copies of invoices issued by the Applicant and evidencing the sale in 2006 and further sales in Canada since 2006. Since 2007 the Applicant has sold wares and services in Canada worth at least \$160,000. I will revert to the expansion of the Applicant's business and clientele later on in my decision when assessing the section 6(5)(c) and (d) factors and the additional surrounding circumstances under the test for confusion.

The Benson affidavit

[36] Ms. Benson identifies herself as a librarian with the firm representing the Applicant. Ms. Benson simply attaches to her affidavit as Exhibits A to H copies of pages from various English or French dictionaries indicating the results found from her searches for entries beginning with the letters "colba" and "collab". Ms. Benson's searches disclose that there is no dictionary word in English or French, beginning with "colba", but "collab" is reflected in the English word "collaborate" and the French word "collaborer" and their variations.

The Monteith affidavit

[37] Ms. Monteith identifies herself as a trade-mark agent with the firm representing the Applicant. Ms. Monteith simply attaches to her affidavit as Exhibits A and B copies of the results of the corporate searches she conducted of "colbanet" from the NUANS computerized search system and from the website of the *Registre des entreprises du Québec*. No listings were found.

Analysis of the grounds of opposition

[38] I will now assess the grounds of opposition without necessarily respecting the order in which they were raised in the statement of opposition.

Section 12(1)(d) ground of opposition

[39] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act in that it is confusing with the Opponent's registered trade-mark COLBA.NET identified above. I have exercised the Registrar's discretion to confirm that this registration is in good standing as of today's date, which date is the material date to assess a section 12(1)(d) ground of opposition [see *Park Avenue Furniture Corp v Wickers/Simmons*

Bedding Ltd (1991), 37 CPR (3d) 413 (FCA)].

[40] As the Opponent's evidentiary 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 trade-mark COLBA.NET.

[41] 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.

[42] 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 trade-marks and the extent to which they have become known; (b) the length of time the trade-marks have 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 in appearance or sound or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered, and are not necessarily attributed equal weight [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].

a) the inherent distinctiveness of the trade-marks and the extent to which they have become known

[43] Despite the descriptive connotation of "NET" in the context of the parties' wares and/or services, the Mark and the Opponent's COLBA.NET mark are both inherently distinctive, although arguably less so in the case of the Mark given also the descriptive connotation of "OPEN" and the suggestive connotation of "COLLAB" in the context of the Applicant's applied-for wares and services (see Mr. Clark's comments regarding the suggestive connotation of the Mark and how the name COLLABNET was originally chosen). I will revert to the ideas

suggested by the parties' marks below when assessing the section 6(5)(e) factor.

[44] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. As per my review of the evidence of record, both of the parties' trade-marks have been used in Canada for some time. While the Bassili solemn declaration does not evidence use of the trade-mark COLBA.NET back to the date of first use claimed in the registration thereof, namely September 1996, the annual business income provided for each year since 1998, combined with the specimens of advertising of the Opponent's services in association with the COLBA.NET trade-mark and advertising expenses incurred by the Opponent, lead me to conclude that the trade-mark COLBA.NET has become known to some extent in Canada, particularly in the province of Quebec.

[45] Turning to the Applicant's Mark, the Clark affidavit leads me to conclude that the Mark has become known to the Applicant's target audience given the recognition that the Applicant has received in trade journals and the continued growth of the number of customers globally and more particularly in Canada since 2006.

[46] In view of the foregoing, the overall consideration of the inherent distinctiveness of the trade-marks at issue and the extent to which they have become known does not significantly favour either party.

b) the length of time the trade-marks have been in use

[47] As indicated above, the Opponent alleges that it has used its registered mark in Canada in association with the claimed services since at least as early as September 1996, although it has only provided evidence of use since 1998. The Applicant began using the Mark in Canada in 2006. The length of time the trade-marks have been used thus favours the Opponent.

c) the nature of the wares, services or business; and d) the nature of the trade

[48] As for the nature of the wares and services and the nature of the trade, I must compare the Applicant's statement of wares and services with the statement of services in the Opponent's registration [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 19

CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR. (4th) 266 (TMOB); and *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[49] The Opponent's registration covers the following services:

Computer services, namely; providing access to Internet network, creation of Internet site in worldwide web, managing of web sites, consultation services concerning the creation and management of Intranet network, creation of softwares, distribution and retail sale of computer parts and accessories, providing courses to the public concerning the use of Internet; maintenance and repair of computer systems; electronic telecommunication services including Internet service provider.

whereas the Applicant's applied-for wares and services all expressly revolve around collaborative software development for software developers, except for the following services:

(3) [...] technical support services, namely troubleshooting of computer software problems; computer software and information technology consultation; computer and technology services for others, namely, software design, development and programming; [...] computer services, namely designing, developing, implementing, installing, maintaining, upgrading, supporting and configuring computer software and consulting related thereto

[50] As evidenced by the Clark affidavit, the Applicant's core product is a software tool used by software developers and IT departments within large organizations to collaborate on software development. The Applicant's customers are sophisticated software developers and IT departments seeking an extensive platform.

[51] By comparison, the Opponent's advertisements evidenced by the Bassili solemn declaration indicate that the Opponent's customers would be seeking to purchase ISP (Internet Service Provider) or similar services for their homes or businesses.

[52] Considering more particularly the Opponent's services, the Bassili solemn declaration evidences that they include ADSL services for commercial and residential customers, telephone services, collocation servers for servers containing websites, and management services for email

servers, as well as website hosting and domain name services. As stressed by Mr. Clark in his affidavit, these are not the types of services that the Applicant provides. The Applicant is not an “ISP”. The Applicant does not provide web hosting services *except* as an ancillary service to those clients using the Applicant’s collaborative software and program. The Applicant also does not offer its goods and services to household consumers or small businesses.

[53] The Applicant contends that the only commonality between the Applicant and the Opponent is the Internet: the Internet is used to deliver the Applicant’s wares and services and providing access to the Internet is the basis of the Opponent’s services. The Opponent contends for its part that there is an overlap between the Applicant’s wares and services and the services listed in the Opponent’s registration as “creation of softwares”. In my opinion, the truth is partway between the parties’ contentions. It seems to me that the Applicant’s position fails to take into account some of the other services listed in the Opponent’s registration, such as those described as “creation of softwares”, “distribution and retail sales of computer parts and accessories”, and “maintenance and repair of computer systems”, which do not necessarily involve the Internet. On the other hand, the Opponent’s position fails to take into account the fact that the statement of services covered by the instant application expressly excludes:

[...] the provision of high-speed [sic] Internet access to the Internet, consultation services concerning the creation and management of intranet communication networks, distribution and retail sale of computer hardware parts and accessories, providing educational courses to the public concerning how to access and use the Internet, maintenance and repair of computer hardware Systems, electronic telecommunications services, namely Internet services provider services.

and that most of the Applicant’s applied-for wares and services expressly revolve around collaborative software development for software developers.

[54] However, I agree with the Opponent that there is a potential overlap between the services listed in the Opponent’s registration as “creation of softwares”, “maintenance and repair of computer systems”, “creation of Internet site in worldwide web”, and “managing of web sites” and the ones broadly described as follows in the Applicant’s applications:

(3) [...] technical support services, namely troubleshooting of computer software problems; computer software and information technology consultation; computer and technology services for others, namely, software design, development and programming;

[...]computer services, namely designing, developing, implementing, installing, maintaining, upgrading, supporting and configuring computer software and consulting related thereto

e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[55] There is a fair degree of resemblance between the Mark and the Opponent's trade-mark COLBA.NET in appearance given that the word COLLABNET may be considered the dominant element of the Mark. However, I find that they differ in sound and, most importantly, in the ideas suggested.

[56] As stressed by the Applicant, the initial element of the Opponent's trade-mark COLBA.NET is both spelled and pronounced differently from the initial element of the Mark, which consists of the word OPEN. As well, the Opponent's trade-mark is pronounced to indicate the "dot" or "point" between the words "COLBA" and "NET" - "COLBA dot NET" or "COLBA point NET". Both marks use the termination "NET", but the importance of that portion of the marks is lessened given the descriptive connotation of "NET" in the context of the parties' wares and/or services.

[57] As further stressed by the Applicant, the Opponent's trade-mark COLBA.NET is a coined mark. As evidenced by the Benson affidavit, "COLBA" does not reflect a word in either the English or French dictionaries, although "NET" reflects the medium with which the Opponent's services are connected, as per the disclaimer of the right to the exclusive use of "NET" found in the Opponent's registration. By comparison, "OPEN" is descriptive of the open nature of the community-developed computer software, open-source computer software development and programming and the like, and "COLLAB" is suggestive, in both English and French, of the collaborative nature of the Applicant's wares and services [see the definition of "collab." found in the second edition of the *Random House Webster's Unabridged Dictionary* attached as Exhibit A to the Benson affidavit]. As indicated above, the name COLLABNET was originally chosen by the Applicant because it suggested « **collaborative** software development over the **net** ».

Additional surrounding circumstances

[58] As a further surrounding circumstance, the Applicant submits that the parties' marks have co-existed in the Canadian marketplace since 2006 and the Opponent has provided no evidence of actual confusion.

[59] The relevance of such surrounding circumstance has been commented as follows in *Dion Neckwear, supra*:

With respect to the lack of evidence by the opponent of actual confusion, the Registrar expressed the view that an opponent does not need to file that kind of evidence. This is true in theory, but once an applicant has filed some evidence which may point to unlikelihood of confusion, an opponent is at great risk if, relying on the burden of proof the applicant is subject to, it assumes that it does not need to file any evidence of confusion. While the relevant issue is "likelihood of confusion" and not "actual confusion", the lack of "actual confusion" is a factor which the courts have found of significance when determining the "likelihood of confusion". An adverse inference may be drawn when concurrent use on the evidence is extensive, yet no evidence of confusion has been given by the opponent. (See *Pink Panther Beauty Corp. v. United Artists Corp.*, [1998], 80 C.P.R. (3d) 247 (F.C.A.); *Multiplicant Inc. v. Petit Bateau Valton S.A.* (1994), 55 C.P.R. (3d) 372 (F.C.T.D.); *Bally Schuhfabriken AG/Bally's Shoe Factories Ltd. v. Big Blue Jeans Ltd.* (1992), 41 C.P.R. (3d) 205 (F.C.T.D.); *Monsport Inc. v. Vêtements de Sport Bonnie (1978) Ltée* (1988), 22 C.P.R. (3d) 356 (F.C.T.D.).)

[60] As indicated above, the Bassili solemn declaration evidences use of the Opponent's trade-mark COLBA.NET in the provinces of Quebec and Ontario. The Clark affidavit for its part does not provide much information as to the extent to which the Mark has been used in Canada. As indicated above, the Mark is the name the Applicant has given to its end-user and developer community using the COLLABNET TeamForge and Subversion platforms. According to the Clark affidavit, the number of the Applicant's customers in Canada has grown from 1 in 2006 to 19 in 2008, and the number of individual members of the Applicant's online community from Canada has grown from 1,818 in 2008 to 11,429 in 2010. While some of the Applicant's customers and individual members are apparently located in the provinces of Ontario and Quebec [see Exhibits J and N mentioned above], it is not possible to determine the proportion of the Applicant's customers and individual members located in these provinces only. In the circumstances, and transposing the comments of the Court in *Dion Neckwear*, I am not prepared to find that concurrent use on the evidence is *extensive*. Accordingly, I am not prepared to accord

significant weight to such surrounding circumstance.

Conclusion regarding the likelihood of confusion

[61] As indicated above, the issue is whether a consumer, who has a general and not precise recollection of the Opponent's trade-mark COLBA.NET, will, upon seeing the Mark be likely to believe that their associated wares or services share a common source.

[62] Having regard to my comments above, I find that the differences existing between the exact nature of the parties' wares and businesses combined with the ones existing between the parties' marks shift the balance of probabilities in favour of the Applicant as far as the Applicant's wares and services revolving around collaborative software development are concerned.

[63] However, I find that the balance of probabilities is evenly balanced when considering the following broadly described services in the Applicant's application:

(3) [...] technical support services, namely troubleshooting of computer software problems; computer software and information technology consultation; computer and technology services for others, namely, software design, development and programming; [...] computer services, namely designing, developing, implementing, installing, maintaining, upgrading, supporting and configuring computer software and consulting related thereto

[64] Indeed, I find that the differences existing between the parties' marks are insufficient by themselves to outweigh the similarities existing between these latter services and the ones covered by the Opponent's registration. Accordingly, the section 12(1)(d) ground of opposition succeeds partially.

Non-entitlement grounds of opposition

[65] The Opponent has pleaded various grounds of opposition pursuant to section 16 of the Act.

[66] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark having regard to the provisions of section 16(1)(a) and (c) of the Act in that at the alleged date of first use of the Mark in Canada, the Mark was confusing with the trade-marks

incorporating the word COLBA (including COLBA.NET and COLBANET) and the trade-names incorporating the word COLBA (including COLBA.NET, COLBANET, COLBANET INC. and COLBA.NET INC.), previously used or made known in Canada by the Opponent in association with the services listed in registration No. TMA496,843 or wares or services similar to those of the Applicant.

[67] The Opponent has also pleaded that the Applicant is not the person entitled to registration of the Mark having regard to the provisions of section 16(2)(a) and (c) of the Act in that at the date of filing of the Applicant's application, the Mark was confusing with the trade-marks incorporating the word COLBA (including COLBA.NET and COLBANET) and the trade-names incorporating the word COLBA (including COLBA.NET, COLBANET, COLBANET INC. and COLBA.NET INC.), previously used or made known in Canada by the Opponent in association with the services listed in registration No. TMA496,843 or wares or services similar to those of the Applicant.

[68] The Opponent has further pleaded various grounds of opposition under the introductory paragraphs of section 16(1) and (2) of the Act including, among others, that the application does not conform to the requirements of section 30 of the Act, that the Mark is not registrable and does not function as a trade-mark, etc.

[69] I am of the view that all of the grounds of opposition based on the introductory paragraphs of section 16(1) and (2) of the Act do not raise valid grounds of opposition. Such pleadings would be more appropriately raised under section 38(a) (non-compliance with section 30 of the Act - discussed below) or (b) (non-registrability pursuant to section 12(1)(d) of the Act - discussed above). I further note that the Opponent did not make any representation at the oral hearing with respect to such pleadings. Accordingly, each of these particular grounds is dismissed.

[70] As for the remaining grounds of opposition under section 16(1)(a) and (c), and 16(2)(a) and (c), the Opponent has to show that as of the alleged date of first use of the Mark in Canada or as of the date of filing of the Applicant's application (in this case, the applicable priority filing date), as the case may be, the above-alleged trade-marks or trade-names incorporating the word COLBA had been previously used in Canada and had not been abandoned as of the date of

advertisement of the Applicant's application [section 16(5) of the Act]. As per my review of the Bassili solemn declaration above, the Opponent has failed to meet its initial evidentiary burden with respect to the trade-marks COLBA and COLBANET INC. and the trade-name COLBA. However, I find that the Opponent has met its burden with respect to the trade-marks COLBA.NET and COLBANET and the trade-names COLBANET, COLBANET INC. and COLBA.NET INC. as far as the Opponent's services described above at paragraphs 13 and 14 of my decision are concerned.

[71] The difference in relevant dates does not substantially affect my analysis above under the section 12(1)(d) ground of opposition. However, the Opponent's position is weaker under the non-entitlement grounds of opposition when considering the differences existing between the parties' wares and/or services and their corresponding channels of trade. Indeed, such differences are more important when considering the Opponent's services as they have been used (as required by section 16(5) of the Act), as opposed to as registered (as required by section 12(1)(d) of the Act). As per my review of the Bassili solemn declaration, the Opponent's evidence is silent as to some of the services listed in the Opponent's registration No. TMA496,843, namely those described as "creation of softwares" and "maintenance and repair of computer systems". While the trade-mark COLBANET is somewhat closer in sound to the Mark since there is no dot that needs to be pronounced, the ideas suggested by the parties' marks remain different (not to mention that most instances of use provided by the Opponent are for COLBANET & Design, which design further distinguishes the Opponent's trade-mark, particularly in terms of appearance). The same reasoning applies to the Opponent's trade-names.

[72] Accordingly, I find that the Applicant has satisfied its burden to show that there is not a reasonable likelihood of confusion between the Mark and either of the trade-marks COLBA.NET and COLBANET and the trade-names COLBANET, COLBANET INC. and COLBA.NET INC.

[73] The non-entitlement grounds of opposition based on section 16(1)(a) and (c) and 16(2)(a) and (c) are dismissed.

Non-distinctiveness ground of opposition

[74] The non-distinctiveness ground of opposition, as pleaded by the Opponent in its amended

statement of opposition, has three prongs.

[75] The first prong alleges that the Mark does not distinguish the wares and services with which the Mark is used from the wares and services of others, including those of the Opponent. The second prong alleges that the Applicant has allowed third parties, including CollabNet Japan K.K., to use the Mark in Canada, such use being without a license and contrary to section 50 of the Act. The third prong alleges that as a result of a transfer, the right to use the Mark subsisted in two or more persons, including CollabNet Japan K.K., and these rights were exercised concurrently, contrary to section 48(2) of the Act.

[76] The second and third prongs can be summarily dismissed on the basis that the Opponent has not met its initial evidentiary burden in respect thereof. There is no evidence whatsoever revolving around the use of the Mark by other entities that puts into issue the distinctiveness of the Mark pursuant to section 48(2) or 50 of the Act. I further note that the Opponent did not make any representation at the oral hearing with respect to such pleadings.

[77] With respect to the first prong, I find that the Opponent has met its burden to show that as of the filing date of the opposition, the trade-marks COLBA.NET and COLBANET and the trade-names COLBANET, COLBANET INC. and COLBA.NET INC. had become known to some extent at least to negate the distinctiveness of the applied-for mark as far as the Opponent's services described above at paragraphs 13 and 14 of my decision are concerned.

[78] The difference in relevant dates does not substantially affect my analysis above under the non-entitlement grounds of opposition. As a result, my finding made above concerning the likelihood of confusion between the Mark and each of the trade-marks COLBA.NET and COLBANET and the trade-names COLBANET, COLBANET INC. and COLBA.NET INC. remains applicable.

[79] In view of the above, the non-distinctiveness ground of opposition is dismissed.

Section 30 grounds of opposition

[80] The Opponent has pleaded various grounds of opposition pursuant to section 30 of the Act.

[81] Except for the section 30(b) ground of opposition discussed below, I do not wish to discuss in detail each and every of the specific section 30 grounds of opposition pleaded by the Opponent. Suffice it to say that even if I were to assume that each of these other grounds of opposition is validly pleaded, the Opponent has not provided any evidence to support its allegations, nor is there any evidence from the Applicant that puts into issue the correctness of the statements made in the Applicant's application. I further note that the Opponent did not make any representation at the oral hearing with respect to such pleadings.

[82] Turning to the section 30(b) ground of opposition, the Opponent has pleaded that the Applicant did not use the Mark in Canada with each of the wares and services mentioned in the application and the date of first use claimed is false. The Opponent has not filed any evidence to support its factual allegations. Rather, the Opponent relies on the Applicant's evidence, and more particularly on the Clark affidavit.

[83] To the extent that the relevant facts pertaining to a ground of opposition based on section 30(b) of the Act are more readily available to the Applicant, the evidentiary burden on the Opponent with respect to such a ground of opposition is lower [see *Tune Master v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. Also, the Opponent may rely upon the Applicant's evidence provided however that such evidence is clearly inconsistent with the Applicant's claim [see *York Barbell Holdings Ltd v ICON Health & Fitness, Inc* (2001), 13 CPR (4th) 156 (TMOB)]. I agree with the Applicant that this is not such a case.

[84] In the absence of any evidence suggesting that the Applicant has not used the Mark in Canada as claimed in its application, the Applicant was under no obligation to positively evidence such use. Furthermore, Mr. Clark has stated that the Applicant has provided its wares and services in Canada in association with the Mark "beginning in or about November 2006", which statement *per se* is not clearly inconsistent with the Applicant's claimed date of first use of the Mark in Canada as ultimately conceded by the Opponent at the oral hearing.

[85] As indicated above, the Mark is the name the Applicant has given to its end-user and developer community using the COLLABNET TeamForge and Subversion platforms. As explained by Mr. Clark, the Applicant fosters a community to encourage innovation and development around its TeamForge and Subversion platforms, as well as to provide free

workplace for software projects related to these platforms. The Applicant provides community forums in which software developers can communicate and collaborate with each other. As indicated above, OpenCollabnet members get access to certain community resources, including: in-depth help and technical articles; free software downloads and trials; participation in community forums; participation in development projects; the OpenCollabnet Technical Newsletter; release and patch notifications.

[86] The mere fact that the wares and services associated with the Mark are free is not fatal to the Applicant given that this constitutes the normal course of trade for such wares and services. The wares and services used in association with the Mark are ancillary to the Applicant's COLLABNET TeamForge and Subversion platforms for which the Applicant's customers must pay for as evidenced by the copies of invoices attached as Exhibit N, which include, among others, an invoice dated 06/22/06 for the amount of \$5000 pertaining to "Subversion Training Services – 2 Classes" and referring to an "Agreement dated 6/16/06". As explained by Mr. Clark, the "CollabNet Subversion" product offering is usable by small to mid-size project teams up through large development teams that span across an enterprise with thousands of users and the Applicant provides support, training and consulting services in connection with such product.

[87] Considering the Clark affidavit as a whole, I find that the Applicant's evidence is not clearly inconsistent with the claimed date of first use of the Mark in association with the applied-for wares and services. Accordingly, I find that the Opponent has not satisfied its initial evidentiary burden and the section 30(b) ground of opposition is dismissed.

Disposition

[88] In view of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application in respect of the following services:

(3) [...] technical support services, namely troubleshooting of computer software problems; computer software and information technology consultation; computer and technology services for others, namely, software design, development and programming; [...] computer services, namely designing, developing, implementing, installing, maintaining, upgrading, supporting and configuring computer software and consulting related thereto

and I reject the opposition with respect to the remainder of the wares and services pursuant to section 38(8) of the Act [see *Produits Menagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (FCTD) as authority for a split decision].

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office