

**IN THE MATTER OF AN OPPOSITION by Magammenon Corporation to application No. 768,901 for the trade-mark THE VIRTUAL LAW FIRM filed by Markus Cohen**

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On November 17, 1994, the applicant, Markus Cohen, filed an application to register the trade-mark THE VIRTUAL LAW FIRM based upon use of the trade-mark in Canada since November 16, 1994 in association with “the provision of legal services”. The applicant disclaimed the right to the exclusive use of the words LAW FIRM apart from his trade-mark.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of July 19, 1995 and the opponent, Magammenon Corporation, filed a statement of opposition on September 29, 1995 and, in response to a letter of objection from the Opposition Board, an amended statement of opposition on November 27, 1995. A copy of the amended statement of opposition was forwarded to the applicant on December 21, 1995. The opponent has alleged the following ground of opposition:

The applicant’s trade-mark is not registrable in view of Paragraph 12(1)(b) of the *Trade-marks Act* in that the trade-mark THE VIRTUAL LAW FIRM, whether depicted, written or sounded, is clearly descriptive of the character or quality of the services in association with which it is used. Further, the opponent asserted that the word VIRTUAL, which is now a common word in the English language which is being applied as an adjective to almost every possible endeavour, originated in the computer industry and has come to mean the character or quality of largeness or bigness or size or the like ...when substantially that attribute does not exist. When combined with the words LAW FIRM, the resulting meaning of the trade-mark as a whole becomes simply a large, big or sizeable law firm.

The applicant served and filed a counterstatement in which he generally denied the opponent’s ground of opposition and asserted that his trade-mark THE VIRTUAL LAW FIRM is registrable in that the trade-mark, taken as a whole, is not in any way descriptive of the intrinsic quality or character of legal services, but is suggestive or evocative only of a metaphysical or conceptual state or environment in which legal services are delivered.

The opponent filed as its evidence the affidavit of Barbara Ann Pitblado while the applicant submitted the affidavit of Alan J. Booth. Ms. Pitblado was cross-examined on her affidavit, the transcript of the cross-examination forming part of the opposition record. The applicant alone filed a written argument and neither party requested an oral hearing.

The issue as to whether the trade-mark THE VIRTUAL LAW FIRM is clearly descriptive of the character or quality of the applicant's services must be considered from the point of view of the average user of those services. Further, in determining whether the trade-mark THE VIRTUAL LAW FIRM is clearly descriptive, the trade-mark must not be dissected into its component elements and carefully analyzed, but rather must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks*, 40 C.P.R. (2d) 25, at pp. 27-28 and *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183, at p. 186]. Additionally, the material date for considering a ground of opposition based on Paragraph 12(1)(b) of the *Trade-marks Act* is the date of decision [see *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers*, 41 C.P.R. (3d) 243 (F.C.A.)].

While the legal burden is upon the applicant to show that his trade-mark is registrable, there is an initial evidential burden upon the opponent in respect of this ground to adduce sufficient evidence which, if believed, would support the truth of its allegations that the trade-mark THE VIRTUAL LAW FIRM is clearly descriptive of the character or quality of the applicant's services. It is therefore necessary to consider the opponent's evidence in order to determine whether they have met the initial burden upon it. In this regard, Ms. Pitblado identifies herself as being a trade-mark lawyer and states that the word "virtual" has become common in the computer industry. However, the affiant has not qualified herself as being an expert in linguistics or in the computer industry to express her opinion as to the significance of the word "virtual" either in the computer industry or otherwise. As a result, the only evidentiary value that can be attributed to the Pitblado affidavit is that it serves to introduce into evidence a dictionary definition appearing in the Oxford English Dictionary, 2nd Edition, for the word "virtual. In the dictionary definition referred to by Ms. Pitblado, the word "virtual" is defined as follows:

"Not physically existing as such but made by software to appear to do so from the point of view of the program or the user; applied to memory that appears to be internal although most of it is external, transfer between the two being made automatically as required"

Apart from the above, the Registrar does have the discretion to verify dictionaries in determining whether a trade-mark is clearly descriptive of the character or quality of the wares or services associated with that mark. In this regard, in the WWWebster Dictionary, the listing for the word "virtual" includes the following:

Main Entry: vir-tu-al  
Pronunciation: 'v&r-ch&-w&l, -ch&l; 'v&r-ch&-w&l  
Function: adjective  
Etymology: Middle English, possessed of certain physical virtues, from Medieval Latin virtualis, from Latin virtus strength, virtue  
Date: 1654  
1 : being such in essence or effect though not formally recognized or admitted <a virtual dictator>  
2 : of, relating to, or using virtual memory  
3 : of, relating to, or being a hypothetical particle whose existence is inferred from indirect evidence <virtual photons> -- compare REAL 3

In my view, the dictionary definitions noted above do not support the opponent's allegation relating to the applicant's trade-mark being clearly descriptive of the character or quality of the provision of legal services. At most, the definitions point to the trade-mark THE VIRTUAL LAW FIRM, when considered in its entirety, as being at most suggestive in some manner or other of the legal services being provided by the applicant. I find therefore that the opponent has failed to meet the evidential burden upon it in respect of its Paragraph 12(1)(b) ground of opposition.

Having been delegated by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I reject the opponent's opposition pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 22<sup>nd</sup> DAY OF SEPTEMBER, 1998.

G.W. Partington  
Chairperson  
Trade-marks Opposition Board