

COURT OF APPEAL FOR BRITISH COLUMBIA

Citation: *Insurance Corporation of British Columbia
v. Stainton Ventures Ltd.*,
2014 BCCA 296

Date: 20140722
Docket: CA039955

Between:

Insurance Corporation of British Columbia

Appellant
(Plaintiff)

And

Stainton Ventures Ltd.

Respondent
(Defendant)

Before: The Honourable Mr. Justice Frankel
The Honourable Mr. Justice Tysoe
The Honourable Madam Justice D. Smith

On appeal from: An order of the Supreme Court of British Columbia, dated
April 26, 2012 (*ICBC v. Stainton Ventures Ltd*, 2012 BCSC 608,
Vancouver Docket S095366).

Counsel for the Appellant: S.B. Garland and K.F. MacDonald

Counsel for the Respondent: W.D. Mussio

Place and Date of Hearing: Vancouver, British Columbia
November 21, 2013

Place and Date of Judgment: Vancouver, British Columbia
July 22, 2014

Written Reasons by:

The Honourable Mr. Justice Frankel

Concurred in by:

The Honourable Mr. Justice Tysoe
The Honourable Madam Justice D. Smith

Summary:

Under the provisions of the Trade-marks Act (Can.), the Insurance Corporation of British Columbia adopted “ICBC” as one of its official marks. ICBCadvice.com is a commercial website used as a marketing tool of a lawyer who acts for persons involved in claims against ICBC. ICBC commenced an action seeking to gain control of the ICBCadvice.com website and its related domain names, <icbcadvice.com> and <icbcadvice.ca>. It contended that the owner of the website was in violation of the protections accorded to the holders of official marks. That action was dismissed and ICBC appealed. Held: Appeal dismissed.

Internet users would not be mistaken by the website’s name and its related domain names into believing that the website was affiliated with or approved by ICBC. Rather, Internet users familiar with the acronym ICBC would believe no more than that the website likely had something to do with the corporation.

Reasons for Judgment of the Honourable Mr. Justice Frankel:

Introduction

[1] As a “public authority” under the *Trade-marks Act*, R.S.C. 1985, c. T-13, the appellant, the Insurance Corporation of British Columbia, has adopted a number of “official marks”, including the acronym “ICBC”. The respondent, Stainton Ventures Ltd., operates a commercial website called “ICBCadvice.com” and owns the internet domain names <icbcadvice.ca> and <icbcadvice.com>, both of which resolve to the ICBCadvice.com website. Being of the view that Stainton Ventures was using its official mark without authorization, ICBC commenced an action in the Supreme Court of British Columbia seeking a declaration to that effect and various orders, including one requiring transfer of the domain names to it.

[2] Following a summary trial, Mr. Justice Grauer dismissed the majority of ICBC’s claims. In particular, he refused to grant an injunction, or to require the transfer of the domain names. It is from those refusals that ICBC appeals.

[3] For the reasons that follow, I would dismiss this appeal.

Factual Background

[4] The parties presented their respective evidence by way of affidavits. There was no cross-examination on those affidavits and there were no material facts in dispute.

[5] ICBC is a provincial Crown corporation, established by statute in 1973 to provide universal automobile insurance to British Columbia motorists. It is the predominant automobile insurer in British Columbia as the owners of vehicles registered in the province must obtain basic insurance coverage from it. In addition, it provides extended third party liability and optional coverage. It is also responsible for driver licencing, and vehicle registration and licencing.

[6] Stainton Ventures is a British Columbia corporation. Penelope Stainton-Mussio is its president, sole director, and sole shareholder. Ms. Stainton-Mussio is married to Wesley D. Mussio, the company's counsel on this appeal. Mr. Mussio's law practice includes acting for persons who have been injured in motor vehicle accidents. In the majority of those matters, ICBC will be the defendant's insurer.

[7] ICBC adopted "ICBC" as its official mark in 1989. In total, it has adopted 23 official marks that incorporate "ICBC", including some that have a design component. ICBC's marks include: "ICBC GLASS EXPRESS"; "ICBC c.a.r. shop"; and "ICBC. WE CAN, AND WE WILL".

[8] As discussed below, pursuant to s. 9(1)(n) of the *Trade-marks Act*, an official mark can be registered by the Canadian Armed Forces, a university, or a "public authority" such as ICBC. That process is less arduous than that required to register a trade-mark. The rights associated with an official mark are broader than those afforded a trade-mark.

[9] The ICBCadvice.com website is a marketing tool for Mr. Mussio's law practice. It offers free advice on dealing with ICBC and contains links to "Recommended Service Providers" under the followings headings: Plaintiff Lawyers;

Doctors; Chiropractors; Physiotherapists; Massage Therapy; and MRI Clinics. At times, it has also contained a link to ICBC's website.

[10] A link to the ICBCadvice.com website will appear in the list of results when a member of the public uses an internet search engine to search the term "ICBC". In addition, Stainton Ventures pays Google to prominently display ICBCadvice.com in the list of results it produces for "ICBC" searches.

[11] The ICBCadvice.com website was launched in 2005, as fighticbc.com. However, for reasons that are not relevant to this appeal, the website was renamed ICBCadvice.com in 2006. A booklet entitled "ICBC Claim Guide" could be purchased on the website.

[12] In 2009, ICBC commenced an action against Stainton Ventures. Its purpose was to gain control of the ICBCadvice.com website and the related domain names. In addition, it sought to restrain Stainton Ventures from distributing the ICBC Claim Guide or using "ICBC Claim Guide" as a mark.

[13] ICBC tendered an affidavit which had attached as exhibits screenshots of the ICBCadvice.com homepage on various days in 2007, 2008, and 2011. It is readily apparent from those pages that the website is not affiliated with ICBC. The last page (from June 2, 2011) contains the following very near the top (the second extract appearing to the right of the first):

ICBCadvice Overview

ICBCadvice.com is a completely FREE online resource outlining all the issues and complications you may encounter when dealing with ICBC – from start to finish. This site is not connected in any way with ICBC and helps you to receive fair treatment from ICBC by providing: ...

...

ICBC Claim Help

This independent site from Stainton Ventures Ltd knows advancing your ICBC claim can be very difficult and confusing. **You are dealing with trained insurance adjusters** who are hired by and paid by ICBC. Their employment requires that they minimize the pay-out on ICBC claim [*sic*] and

so you need to be adequately educated to understand how best to pursue your ICBC claim to get a fair result. ...

[Bold in original; underline emphasis added.]

Under those statements is one stating that information provided through the website comes from “authors who have no connection with ICBC”. Under that statement the following appears:

The articles provide you with information from independent individuals that have no connection to ICBC. Throughout the website you will find articles ranging from what types of claims to advance to legal issues to health issues to vehicle issues. As the website is not affiliated with ICBC, we hope you will find it helpful and objective.

[Emphasis added.]

[14] Stanton Ventures tendered affidavit evidence with respect to domain names that begin with “icbc”. Webpages were provided for a number of these, including:

<u>Domain Name</u>	<u>Nature of Website</u>
<icbc.com>	ICBC’s site
<icbcinjurylawyers.ca>	Law firm that acts in claims against ICBC
<icbclawyers.ca>	Law firm that acts in claims against ICBC
<icbctips.ca>	Offering a course on how to deal with ICBC to persons injured in automobile accidents
<icbccases.com>	Law firm that acts in claims against ICBC
<icbcclaimslawyer.com>	Lawyer who acts in claims against ICBC
<icbcclaimsnewton.com>	Lawyer who acts in claims against ICBC
<icbc-claims.com	Lawyer who acts in claims against ICBC
<icbc-settlement.ca	Lawyer who acts in claims against ICBC

<icbc-injury.com>	Lawyer who acts in claims against ICBC
<icbccollisionrepair.com>	Collision repair shop
<icbccarrepair.com>	Collision repair shop
<icbcbodyshop.com>	Collision repair shop
<icbcfightforbenefits.blogspot.com>	Blog offering advice on how to deal with ICBC
<icbcsucks.com>	Site for posting complaints about ICBC

[15] Other domain names referred to in the affidavit filed by Stainton Ventures include:

<ihateicbc.com>
<sueicbc.com>
<icbcclawyer.net>
<icbcclaims.biz>
<icbcinjuryclaim.com>
<icbcbraininjuryclaim.com>
<icbc-personal-injury-lawyer.com>
<icbc-personal-injury-lawyers.com>
<icbc-claims-lawyer.com>
<icbc-car-accident-lawyers.com>
<michaelwelsh-icbc.com>

[16] The trial judge granted ICBC the relief it sought with respect to the Claim Guide, but dismissed the remainder of its claim. As Stainton Ventures has not cross-appealed with respect to the Claim Guide, the name of which has been changed to “ICBCadvice Claim Guide”, nothing further need be said about it.

Relevant Provisions of the Trade-marks Act

[17] Official Marks

9.(1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for,

- (n) any badge, crest, emblem or mark
 - (i) adopted or used by any of Her Majesty's Forces as defined in the National Defence Act,
 - (ii) of any university, or
 - (iii) adopted and used by any public authority, in Canada as an official mark for wares or services,

in respect of which the Registrar has, at the request of Her Majesty or of the university or public authority, as the case may be, given public notice of its adoption and use;

...

11. No person shall use in connection with a business, as a trade-mark or otherwise, any mark adopted contrary to section 9 or 10 of this Act or section 13 or 14 of the Unfair Competition Act, chapter 274 of the Revised Statutes of Canada, 1952.

Passing Off

7. No person shall ...
- (b) direct public attention to his wares, services or business in such a way as to cause or be likely to cause confusion in Canada, at the time he commenced so to direct attention to them, between his wares, services or business and the wares, services or business of another;

Trade-marks

6.(1) For the purposes of this Act, a trade-mark or trade-name is confusing with another trade-mark or trade-name if the use of the first mentioned trade-mark or trade-name would cause confusion with the last mentioned trade-mark or trade-name in the manner and circumstances described in this section.

(2) The 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.

(3) The use of a trade-mark causes confusion with a trade-name if the use of both the trade-mark and trade-name in the same area would be likely to lead to the inference that the wares or services associated with the trade-mark and those associated with the business carried on under the trade-name are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

(4) The use of a trade-name causes confusion with a trade-mark if the use of both the trade-name and trade-mark in the same area would be likely to lead to the inference that the wares or services associated with the business carried on under the trade-name and those associated with the trade-mark are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

(5) In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

- (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 the trade-marks or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them.

Trial Judge's Decision

(2012 BCSC 608)

[18] The trial judge held that Stainton Ventures had not adopted and used the ICBC mark in contravention of the *Trade-marks Act*. In so doing so, he stated:

[23] Accordingly, the question becomes whether “ICBCadvice.com” so nearly resembles “ICBC” that it is likely to be mistaken for it. The test is whether a person familiar with ICBC’s mark, but having an imperfect recollection of it, would be likely to mistake the defendant’s mark for it: *Canadian Olympic Association v. Coopérative Fédérée de Québec* (2000), 7 C.P.R. (4th) 309 at para. 26 (F.C.T.D.); *Canada v. Kruger* (1978), 44 C.P.R. (2d) 135 (Reg. T.M.); *Big Sisters Assn. of Ontario v. Big Brothers of Canada* (1999), 86 C.P.R. (3d) 504 (F.C.A.) affg. 131 F.T.R. 161, 75 C.P.R. (3d) 177. The question is not to be resolved on the basis of a straight comparison of the marks.

[24] As Gibson J. noted in the *Big Sisters* case, 75 C.P.R. (3d) 177 at 202, the onus of establishing mistake or confusion based on resemblance is on the plaintiff. The judge concluded that:

...The evidence adduced simply does not discharge that onus.
... It was open to the plaintiffs to bring direct evidence from those alleged to have been led into mistake or confusion, but such evidence was not forthcoming. Equally, it was open to the plaintiffs to bring their own independent survey evidence and they chose not to do so.

[25] I come to the same conclusion in this case. The only relevant evidence is from the defendant, and establishes that no one ever communicated any confusion or mistake as to whether the website was ICBC's. The evidence just does not support the contention that through its domain names, the defendant either intended or accomplished the redirection to its site of traffic looking for ICBC's own website at <icbc.com>.

[26] Anyone familiar with motoring in British Columbia would, I expect, conclude that "ICBCadvice.com" was probably about the Insurance Corporation of British Columbia. ICBC is, after all, a very large institution that is the subject of widespread public commentary. In this context, would British Columbians be likely to mistake "ICBCadvice.com" for ICBC's official mark? I think not. More probably, I find, they would take it as identifying the subject-matter of the site, not whose site it is.

[27] I therefore conclude that the defendant has not acted contrary to sections 9 and 11 of the *Trade-marks Act* in its use of the website/domain name "ICBCadvice.com". The same logic applies to the defendant's use of the domain names <icbcadvice.ca>, <fighticbc.com> and <fighticbc.ca>.

[28] In my view, the defendant's use of the acronym "ICBC" throughout its website also does not contravene the *Trade-marks Act*. The defendant does not use that acronym as a "trade-mark or otherwise" in the sense required, which is the use of the mark in connection with its business in some way that is intended to identify and distinguish its products. Rather, it simply uses the acronym to identify the plaintiff, as thousands do every day, and as I do in these reasons.

[19] In rejecting ICBC's contention that Stainton Ventures was guilty of passing-off contrary both the common law and s. 7(b) of the *Trade-marks Act*, the trial judge said, in part:

[44] ... I conclude that the defendant's current ICBCadvice.com website, and its other domain names, do not constitute a passing-off. I cannot see how an average customer would be deceived into thinking that the website is somehow associated with or approved by ICBC. There is no evidence of either actual confusion or likelihood of confusion, and as noted, a likelihood of confusion is not so obvious that evidence is unnecessary.

...

[48] In the context of British Columbia's universal automobile insurance scheme, I am satisfied that the average customer of normal intelligence would not be led astray, and would have no difficulty recognizing that

ICBCadvice.com would probably relate to how to deal with ICBC in an arm's length or even adversarial sense, rather than in a manner endorsed by ICBC.

[20] Last, the trial judge rejected ICBC's claim for damages under the *Competition Act*, R.S.C. 1985, c. C-34, based on an assertions that Stainton Ventures knowingly made a representation to the public that was false or misleading. In that regard, the judge said:

[51] In the plaintiff's submission, conduct that constitutes the misrepresentation component of the tort of passing-off also constitutes a false or misleading representation under section 52 of the *Competition Act*.

[52] I have found, however, that the use by the defendant of the website/domain name "ICBCadvice.com", and its other related usages, do not constitute misrepresentation because they are not likely to deceive the public as is required to establish the tort of passing-off. By the same reasoning, those uses do not constitute a representation to the public that is false or misleading in a material respect, and so do not breach section 52 of the *Competition Act*.

The Nature of an Official Mark and Some Examples

[21] To my knowledge, Canada is the only jurisdiction in the world with legislation that grants such a broad power to "public authorities" and others to create official marks. While bearing some similarity to trade-marks, official marks are not governed by the same rules as trade-marks. Indeed, they are not "registered" as are trade-marks. However, they are recorded by the Registrar of Trade-marks and are included in the Trademarks Database found on the website of the Canadian Intellectual Property Office, an agency of Industry Canada.

[22] In her text, *Canadian Trademark Law* (Markham: LexisNexis Canada, 2010), Professor Teresa Scassa says the following about the nature of official marks and the process by which they are created:

At 81:

Any entity which qualifies as a "public authority" may request that the Registrar give public notice of the adoption and use of any badge, crest, emblem or mark adopted by that public authority. Public notice is not the same as registration; there is no examination process, and indeed, there is no requirement that official marks conform to any particular standards. There

is thus no requirement of distinctiveness, nor is there any requirement that the official mark not be confusing with registered trademarks or marks already used or made known in Canada. They do not need to be renewed, and can only be challenged through an application for judicial review of the decision of the Registrar of Trademarks to give public notice of the mark as an official mark. [Footnotes omitted.]

At 159:

There is no public notice or opposition period for official marks. There is also no examination requirement for the mark — it may be identical to or confusing with existing registered trademarks. It is not necessary for wares or services to be identified with respect to official marks, although some public notices do provide this information. Even if wares or services are specified, these do not limit the scope of the mark. An official mark can be descriptive and is not required to be distinctive. It may also be confusingly similar to an already existing mark. Once public notice is given, no one may adopt the mark, or a mark “so nearly resembling as to be likely to be mistaken for” the official mark. Official marks do not expire. They are not registered trademarks, and are not subject to the same proceedings for examination, opposition, challenge or expungement. As noted by one court, “[o]nce public notice has been given with respect to the adoption and use of an official mark, the mark is ‘hardy and virtually unexpungeable’”. Any challenge to the validity of the mark must be made through the vehicle of an application for judicial review of the Registrar’s decision to give public notice of the adoption and use of the mark. [Footnotes omitted.]

[23] In some cases, as with ICBC, an official mark is an acronym. For example, “CBC” is an official mark of the Canadian Broadcasting Corporation (Application No. 0944739). Interestingly, “CBC” is the registered trade-mark of an American company with respect to the sales of its wares, being an acid cleaning composition for toilet bowls, traps, and drains (Registration No. TMA175018).

[24] By virtue of s. 9(1)(n)(ii) of the *Trade-marks Act*, the acronyms of a number of universities, both Canadian and foreign, have been given official mark status. In some cases, a university has also registered its acronym as a trade-mark with respect to certain wares and/or services. The following are examples. The prefix “TMA” indicates a registered trade-mark. Numbers without the prefix are official marks.

<u>Acronym</u>	<u>University</u>
UBC (No. 0902488; TMA715904)	University of British Columbia
UVIC (No. 0900903; TMA316276)	University of Victoria
SFU (No. 0902238)	Simon Fraser University
TRU (No. 0916748; TMA 657337)	Thompson Rivers University
UWO (No. 0903774)	University of Western Ontario
AU (No. 0908024)	Athabasca University
UCLA (No. 0903900; TMA274091)	University of California

[25] The Vancouver Airport Authority has been given official mark status for “YVR”, the international code for the Vancouver International Airport (Application No. 0907399).

[26] Official mark status has been given to single letters, words, and phrases. The following are but a few examples:

<u>Official Mark</u>	<u>Mark Holder</u>
Y (No. 0901932)	Yale University
JUSTICE (No. 0904687)	Ministre de la Justice du Gouvernement du Québec
BLUES (No. 0903488)	University of Toronto
TOP	University of Toronto

(No. 0909251) WESTERN (No. 0903775)	University of Western Ontario
FLORIDA (No. 0916099)	University of Florida
GO (No. 0911271)	Greater Toronto Transit Authority
COMPASS (No. 0921032)	British Columbia Transportation Authority
DOCTOR (Nos. 0907423, 0912998)	Canadian Medical Association
NURSE (No. 0913567)	Canadian Nurses Association
GO CANADA GO (No. 0915675)	Royal Canadian Mint
THE GRAPEVINE (No. 0905194)	British Columbia Liquor Distribution Branch
WOOF (No. 0914856)	University of Washington
BOO HOO (No. 0900832)	Queen's University

Grounds of Appeal

[27] In its factum, ICBC alleges that the trial judge made a number of “fundamental errors”, both legal and factual. I will not set them out, as they take up two pages in that factum. In summary form, ICBC says the judge erred in law by failing to apply the correct tests for determining breaches of ss. 9 and 11 of the *Trade-marks Act* and with respect to passing-off. It further says the judge erred in mixed fact and law in finding the use of the ICBCadvice.com domain name did not violate the *Act* or amount to passing-off.

[28] For its part, Stainton Ventures submits the trial judge did not commit any of the alleged errors. In the alternative, it submits that even if the judge erred, this appeal should be dismissed by reason of the doctrine of estoppel by acquiescence. In light of the conclusions I have reached on the principal issue on this appeal, I have not found it necessary to address that alternative submission.

Analysis

Standard of Review

[29] In my view, the correctness standard applies to this appeal. That is because the resolution of issues raised involves the legal effect of undisputed facts. More particularly, it involves an objective legal characterization of those facts: see *R. v. J.M.H.*, 2011 SCC 45 at para. 28, [2011] 3 S.C.R. 197; *Wilson v. Williams*, 2013 BCCA 471 at paras 46-60, 368 D.L.R. (4th) 253.

Infringement of ICBC's Official Mark

[30] By virtue of ss. 9 and 11 of the *Trade-marks Act*, once a mark has been given official mark status, persons other than the holder of the rights to that mark are prohibited from adopting and using it "in connection with a business, as a trade-mark or otherwise". This prohibition has been held to operate prospectively only, so as not to affect persons who were using the mark in connection with goods and services prior to it being given official mark status: *Canadian Olympic Assn. v. Allied Corp.*, [1990] 1 F.C. 769 at 774 (C.A.); *Canadian Olympic Assn. v. Konica Canada Inc.* (1991), 85 D.L.R. (4th) 719 at 721 (F.C.A.), leave ref'd [1992] 1 S.C.R. ix.

[31] ICBC relies on decisions of the Federal Courts as setting out the test for determining whether an official mark has been adopted in contravention of s. 9 of the *Act*, i.e., in the present context whether ICBCadvice.com "so nearly resemble[es] as to be likely mistaken for" ICBC.

[32] The test applied by the Federal Courts originated in *The Queen v. Kruger* (1978), 44 C.P.R. (2d) 135 (Reg. T.M.). In that case, the holder of the official mark

“SPORTS CANADA” objected to an application to register as a trademark for use in connection with the sale of boats, canoes, sleighs and similar items, a design that included a maple leaf over which appeared the word “canasport”. In his decision, the Registrar of Trade-marks noted that the test for determining an infringement of an official mark is not the same as for determining an infringement of a trademark(at 139):

In some respects the protection provided under s-s 9(1)(n)(iii) is broader than the protection afforded by way of tests for confusion and in other respects the resemblance test provided by s-s 9(1)(n)(iii) is narrower than the test for confusion in s. 6 of the *Trade Marks Act*. If the mark in use by a person so nearly resembles the prohibited mark as to be mistaken therefor, the use of that mark may be prohibited even in those cases where there is no likelihood of confusion. The test under s-s 9(1) (n)(iii) is restricted to resemblance between the prohibited mark and the adopted mark. In determining the likelihood of confusion under s. 6 reference is had to all the surrounding circumstances including those set out in s-s 6(5) of the *Trade Marks Act*, the degree of resemblance between the marks is only one of numerous surrounding circumstances taken into consideration.

[Emphasis added.]

In finding no infringement of the SPORTS CANADA mark, he stated (at 141):

The applicant has disclaimed the exclusive right to the 11-point maple leaf and all the reading matter except the words “Cana-sport” apart from the design. The applicant’s design mark and the opponent’s mark as a whole both suggest the idea of Canada. A person of imperfect recollection familiar with the opponent’s mark and having an imperfect recollection thereof upon seeing the applicant’s mark applied to or associated with the wares applied for would not be led to the inference that the wares associated with the applicant’s mark were manufactured, sold, leased, hired, or performed by the opponent.

[Emphasis added.]

See also: *Techniquip Ltd. v. Canadian Olympic Assn.* (1998), 145 F.T.R. 59 at paras. 12-16, aff’d (1999), 250 N.R. 302 (F.C.A.); *Big Sisters Assn. of Ontario v. Big Brothers of Canada* (1997), 75 C.P.R. (3d) 177 at 217-218 (F.C.T.D.), aff’d (1999), 86 C.P.R. (3d) 504 (F.C.A.); *Canadian Olympic Assn. v. Health Care Employees Union of Alberta* (1992), 46 C.P.R. (3d) 12 at 19 (F.C.T.D.).

[33] In addition, ICBC relies on decisions from the Federal Court for the proposition that the characteristics of its “family” of official marks—all of which

contain the acronym ICBC—is to be considered in determining whether ICBCadvice.com runs afoul of the *Act*: see *Canadian Olympic Assn. v. Health Care Employees Union of Alberta* at 19; *Canadian Olympic Assn. v. Coopérative Fédérée du Québec* (2000), 77 C.P.R. (3d) 232 at 239 (F.C.T.D.).

[34] ICBC also submits that the fact its official mark comprises the first, and in its view, dominant part of ICBCadvice.com supports finding that the domain name will likely be confused with its official marks. In this regard, it relies on decisions from the Federal Court and the Trade-marks Opposition Board: see *Canadian Olympic Assn. v. Coopérative Fédérée du Québec* at 238; *Hope International Development Agency v. Hope Worldwide, Ltd.* (2009), 81 C.P.R. (4th) 224 at para. 26 (T.M.O.B.); *Bruce Trail Assn. v. Camp* (2001), 12 C.P.R. (4th) 104 at 112 (T.M.O.B.).

[35] Lastly, again with reference to decisions of the Federal Court and the Trade-marks Opposition Board, ICBC says the rights it has to its official family of marks cannot be circumvented by simply adding a non-distinctive word after its primary official mark: see *Canadian Olympic Assn. v. Health Care Employees Union of Alberta* at 20; *WWF – World Wide Fund for Nature v. Incaha Inc.* (1995), 61 C.P.R. (3d) 413 at 416 (T.M.O.B.); *Reno-Dépôt Inc. v. Homer TLC, Inc.* (2009), 84 C.P.R. (4th) 58 at para. 58 (T.M.O.B.).

[36] ICBC summarizes its position as follows in its factum:

47. ... the relevant person, being familiar with but having an imperfect recollection of the ICBC Official Marks, ... would be likely to mistake ... ICBCadvice ..., for the ICBC Official Marks. The appearance, sound and idea of the phrase “ICBC”, which is the first and dominant portion of both the ICBC Official Marks and the impugned marks, is identical. The fact that it is the first and dominant portions that are identical increases the likely mistake to be made by the relevant person.

48. Further, the additional subject matter of the impugned marks are the descriptive words “advice Claim Guide”, “advice.com” and “advice.ca”, which do nothing to distinguish ... ICBCadvice ... from the ICBC Official Marks, particularly when viewed in the context of the family of ICBC Official Marks, which contain the common element ICBC. Indeed, the relevant consumer, having the familiarity but imperfect recollection of the ICBC Official Marks, would likely be led to believe that ICBC itself is offering advice on its

business, wares and services, when viewing such marks as a matter of first impression.

[Emphasis added.]

[37] I am unable to accept this argument as it fails to give the “relevant consumer”, i.e., an Internet user, credit for even the most basic understanding of the function of a domain name. Even though there is some resemblance between ICBCadvice.com and ICBC’s family of marks, the average Internet user with an imperfect recollection of ICBC’s marks would not likely be mistaken by the domain name. They understand, for example, that a domain name which, in part, contains the name of a business or its acronym will not necessarily be affiliated with or endorsed by that business and may, instead, be the subject matter of the website or entirely unrelated to that business. As well, they understand that it is necessary to view a website to determine whose site it is. While I appreciate that *Mattel, Inc. v. 3894207 Canada Inc.*, 2006 SCC 22, [2006] 1 S.C.R. 772, involved a dispute over a trade-mark rather than an official mark, it is noteworthy that the Court attributed a reasonable level of intelligence to “the casual consumer somewhat in a hurry”: paras. 56-58. In the present context, to paraphrase a passage from *Michelin & Cie v. Astro Tire & Rubber Co. of Canada Ltd.* (1982), 69 C.P.R. (2d) 260 (F.C.T.D.), quoted with approval in *Mattel, Inc.*, one must not proceed on the assumption that average Internet users are completely devoid of intelligence or of normal powers of recollections or are uninformed as to what goes on around them.

[38] ICBC submits this Court must be cautious to avoid failing to differentiate the test applicable to official marks from the “source confusion” test applicable to trade-marks under s. 6 of the *Trade-marks Act*. In its oral submissions it repeatedly adverted to the need to avoid applying the “source confusion” test in the context of official marks. While different tests do apply, it must be kept in mind that any mark, including an official mark, serves an identification function, whether as to source, endorsement, or otherwise. ICBC’s submission that “the relevant consumer, having the familiarly but imperfect recollection of the ICBC Official Marks, would likely be led to believe that ICBC itself is offering advice”, suggests that ICBC appreciates that

one of the objectives of the official-marks regime is to protect the public by prohibiting the use of a mark which so nearly resembles an official mark that a person seeing that mark would mistakenly believe it to be the rights-holder's mark.

[39] As indicated above, I am unable to accept that the average Internet user does not appreciate that domain names—which are limited to short combinations of alphanumeric characters—are often merely descriptive of the subject matter of the website to which the domain name resolves, rather than indicating affiliation, source, or endorsement. Put otherwise, a person who conducted a search—using, for example, the terms “ICBC” and “advice”—which returned ICBCadvice.com in its list of results would not, based solely on observing that domain name, mistakenly believe that the “advice” referred to is provided or endorsed by ICBC. Neither would they, as a matter of first impression, be mistaken by the fact that the domain name starts with “ICBC”. The most that person would conclude is that the website likely had something to do with the corporation.

[40] In the result, I agree with the trial judge that the website ICBCadvice.com and its related domain names do not contravene ss. 9 and 11 of the *Trade-marks Act*.

Passing-Off

[41] ICBC contends that Stainton Ventures has passed its business and services off as being the business and services of the Insurance Corporation of British Columbia. In so doing it relies on the common law and on s. 7(b) of the *Trade-marks Act*. In the detailed argument set out in its factum it submits that the trial judge made numerous errors in deciding this issue against it.

[42] I do not intend to rehearse all of ICBC's submissions. The core of its position is reflected in the following extract from its factum:

80. The average consumer would see the dominant word ICBC, and the descriptive word “advice” or “advice.com”, and would be likely to believe that the ICBCadvice Trade-marks and Domain Names were directing the consumer to advice being given by ICBC itself (to its customers or interested public), or that the website was somehow associated or approved by ICBC,

given the dominant use of ICBC's well known mark. This is particularly true given the family of ICBC Official Marks, which all share the common element ICBC, as the average consumer would be used to seeing ICBC in association with other words while still designating the Appellant as the source of such usage.

[43] I would reject this argument for the reasons already given. As explained above, Internet users would not believe that the website ICBCadvice.com and its related domain names are affiliated with or approved by the Insurance Corporation of British Columbia. Rather, Internet users familiar with the acronym ICBC would believe no more than that the website likely had something to do with the corporation.

[44] I, therefore, agree with the trial judge that Stainton Ventures has not engaged in passing-off.

Disposition

[45] I would dismiss this appeal.

“The Honourable Mr. Justice Frankel”

I AGREE:

“The Honourable Mr. Justice Tysoe”

I AGREE:

“The Honourable Madam Justice D. Smith”