



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

Citation: 2011 TMOB 219
Date of Decision: 2011-11-25

**IN THE MATTER OF AN OPPOSITION
by Tripit, Inc. to application No. 1,347,920
for the trade-mark TRIPIT in the name of
Annie Myara**

Introduction

[1] On May 18, 2007 Annie Myara (the Applicant) filed application No. 1,347,920 to register the trade-mark TRIPIT (the Mark). Originally the application was filed on the basis of proposed use.

[2] There was a first office action from an examiner requesting modifications to the description of the services in order to comply with the provisions of s. 30(a) of the *Trade-marks Act*, R.S.C. 1985 c. T-13 (the “Act”). A revised application was filed on November 7, 2007 in which not only the Applicant modified the description of the services but also claimed a date of first use of the Mark, namely May 1st, 2006. The examiner responded by an office action dated November 21, 2007 requiring further changes to the description of the services. There were other revised applications filed wherein corrections were made to the description of the services in order to obtain the preliminary approval of the Registrar. A revised application dated September 5, 2008 was finally accepted. It should be noted that the Applicant is claiming a date of first use of May 1st, 2006 with respect to the following services:

Online coordination of travel arrangements for individuals and groups; travel information services; providing links to other websites featuring travel information and services; advertising and marketing services, namely by phone, by mail and by Internet, of providers of travel related services; designing, printing and collecting marketing information (the Services).

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of October 15, 2008. Tripit, Inc. filed a statement of opposition on December 12, 2008 which was forwarded by the Registrar on January 6, 2009 to the Applicant. The Applicant filed a counter statement on February 25, 2009 in which she denies all grounds of opposition pleaded in the original statement of opposition.

[4] On July 23, 2009 the Opponent requested leave to file an amended statement of opposition to add two grounds of opposition which will appear hereinafter as the last two grounds of opposition pleaded by the Opponent. On November 3, 2009 the Registrar granted leave to the Opponent to file the aforesaid amended statement of opposition. It should be noted that the Applicant has not filed an amended counter statement to respond to those two additional grounds of opposition.

[5] The Opponent filed the affidavits of Gregg Brockway and Alain D. Bourassa. The Applicant filed the affidavit of Annie Myara.

[6] Only the Opponent filed written arguments and there was no hearing requested.

The Grounds of Opposition

[7] The grounds of opposition raised by the Opponent in its amended statement of opposition are:

1. The Application, as amended, does not conform to the requirements of s. 30(a) of the Act in that “Online advertising and marketing services, namely by phone, by mail and by Internet, of providers of travel related services and designing, printing and collecting marketing information” are not services set forth in ordinary commercial terms;
2. The application does not does not conform to the requirements of s. 30(b) of the Act in that the Applicant did not use the Mark in Canada since May 1, 2006 in association with each of the Services;

3. In the alternative to what has been alleged in the previous paragraph, in the event that the Applicant did use the Mark in Canada in association with each of the Services since May 1, 2006, which is denied, such use had not been a continuous use of the Mark by the Applicant in the normal course of trade;
4. The application does not conform with the requirements of s. 30(i) of the Act in that the Applicant could not have been satisfied that she was entitled to use the Mark in Canada in association with the Services as both prior to and at the time of filing of the application on May 18, 2007 the Applicant was aware of the Opponent's prior U.S. and Canadian use of the trade-mark TRIPIT, Opponent's operational website "tripit.com" and the Opponent's U.S. trade-mark application 77/173,537 filed May 4, 2007 to register the trade-mark TRIPIT since the original services description was a virtual copy of the services specified in the Opponent's earlier filed U.S. application;
5. The Applicant is not the person entitled to registration of the Mark pursuant to the provisions of s. 16(1)(a) and (c) of the Act because at the Applicant's actual first Canadian use date or dates, if any, and which actual use date or dates are currently unknown to the Opponent, it was confusing with the Opponent's trade-mark TRIPIT that had been previously used in Canada and made known in Canada by the Opponent in association with online advertising and marketing services; online coordination of travel arrangements for individuals and groups; travel information services; online advertising and marketing services; providing links to websites of others featuring travel information and services, and also with the Opponent's trade-names Tripit, Tripit, Inc. and tripit.com that the Opponent had previously used;
6. The Mark is not distinctive within the meaning of s. 2 of the Act in that the Mark does not distinguish nor is adapted so as to distinguish the Services from the services of the Opponent, and which Services the Opponent has advertised and performed in Canada under its trade-mark TRIPIT, under its trade-names Tripit and Tripit, Inc. and under its domain name "tripit.com";
7. The application does not conform with the requirements of s. 30(b) of the Act in that the application as originally filed did not specify the date from which the Applicant used the Mark in association with each of the Services, and the purported amendment subsequently filed by the Applicant cannot remedy the failure to conform with s. 30(b) since the purported amendment is itself contrary to rule 31(d) of the *Trade-marks Regulations* (Regulations);
8. The application does not conform with the requirements of either s. 30(e) or 30(i) of the Act as the Applicant improperly converted said application from one originally based on proposed use of the Mark in Canada to one claiming use in Canada since May 1, 2006, contrary to rule 31(d) of the Regulations and improperly added to the description of the services the additional service description reading "Designing, printing and collecting marketing information" contrary to rule 31(e) of the Regulations. Contrary to s. 30(i) of the Act the

Applicant could not be satisfied that she was entitled to use the Mark in Canada in association with the services as described in the improperly amended and non-compliant trade-mark application.

Legal Onus and Burden of Proof in Trade-marks Opposition Proceeding

[8] The legal onus is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential 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. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.); *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) and *Wrangler Apparel Corp. v. The Timberland Company* [2005] F.C. 722].

Relevant dates

[9] The relevant date for the analysis of each ground of opposition varies depending on the ground of opposition to be assessed:

- Non-compliance with the requirements of s. 30 of the Act: the filing date of the application (May 18, 2007);
- Entitlement to the registration of the Mark, where the application is based on use: the claimed date of first use (May 1, 2006) [see s. 16(1) of the Act];
- Distinctiveness of the Mark: the filing date of the statement of opposition (December 12, 2008) [see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

The Opponent's Evidence

[10] Mr. Brockway is the Opponent's President. He alleges that the Opponent was incorporated on October 6, 2006 under the laws of the State of Delaware, one of the United States of America. He states that the Opponent is an on-line travel organization

service. Virtually all of its promotion is done over the Internet with its primary site being www.tripit.com. He filed an extract of such website providing information about the Opponent's history.

[11] Mr. Brockway states that the Opponent began advertising its services in association with the trade-mark TRIPIT at the TechCrunch 40 technology conference held in San Francisco, California on September 17-18, 2007.

[12] He states that on May 4, 2007 the Opponent filed with U.S. Patent and Trademarks Office (USPTO) an application under serial number 77173537 to register the trade-mark TRIPIT and filed an extract of the USPTO's website containing the details of such application.

[13] He also filed, through the Internet Archive Wayback machine, extracts of the Opponent's home pages of its website that existed on March 12, 2007 and September 22, 2007. The Opponent's online travel organization service performed under its trade-mark TRIPIT has been a free service to individual travellers. He asserts that a large number of users visiting the Opponent's website are Canadians.

[14] During the year ending December 21, 2007 the Opponent had 229 active accounts with an email address ending in ".ca". In the year ending December 31, 2008 that number increased to 2,686 and for the year 2009, ending on May 31, 2009 there were 4,544 active accounts with an email address ending in ".ca".

[15] Based on information furnished to the Opponent by Google Analytics as the source, he provides the total number of visits of the Opponent's website for the years 2007, 2008 and 2009 (through May 31, 2009) and the specific number of visits from Canada.

[16] He states that the Opponent has not carried out any print advertising under its trade-mark TRIPIT in Canada; however it does generate some volume of traffic via search engines such as Google. He filed the results of a search performed by the Opponent's agent on its behalf of the first 30 hits obtained under a Google search which was carried out in Canada under the word "tripit". All the listings refer to the Opponent.

[17] Mr. Bourassa is a Canadian Patent and Trade-mark agent working for the Opponent's agent firm. He filed a copy of the present application as advertised in the October 15, 2008 edition of the *Trade-marks Journal*. He states that his firm has been periodically monitoring the present application both before and after the application was advertised for opposition purposes.

[18] He states that originally the application was based on proposed use and that the services described as "designing, printing and collecting marketing information" was not included in the original services description. He filed the three revised applications filed by the Applicant during the course of the examination of this application.

[19] He states that on November 12, 2007 his firm downloaded the single webpage available at the website for <http://www.tripit.ca>. On November 13, 2007 he called the phone number appearing on the webpage and got the following response: "the number you reached is not in service".

[20] Mr. Bourassa states that his firm also downloaded an extract of <http://whois.cira.ca> for the domain name [tripit.ca](http://www.tripit.ca) and filed such extract. It shows Tripit Inc. as the administrative and technical contacts. On November 13, 2007 he called the phone number listed for both the administrative and the technical contacts. There was no response. There was no voice mail access and the line was disconnected after six rings.

[21] On September 22, 2008 his firm downloaded the single page available at [tripit.ca](http://www.tripit.ca) website and filed a copy of same which shows that the website was under construction. Then he filed a copy of the results when entering the domain name [tripit.com](http://www.tripit.com) that shows that the source is <http://www.tripit.mobi>.

[22] On March 17, 2009 his firm did research entering the domain name [tripit.mobi](http://www.tripit.mobi) and Mr. Bourassa filed the results obtained. Finally he filed copies of documentation relating to U.S. trademark application 77173537 as well as drawings filed by the Opponent on May 4, 2007 for the trade-mark TRIPIT. He states that the description of the services in such application is identical to the services' description originally set forth in the present application filed two weeks later, namely on May 18, 2007.

The Applicant's Evidence

[23] Annie Myara has been the President of Tripit, Inc. a company which was incorporated on October 10, 2007 under the laws of Canada and has a principal place of business located at 606-5720 Cavendish in Montreal, Quebec. She defines such entity as "my company".

[24] She states that her company uses the Mark. She does not state that such use is under the terms and conditions of a license agreement between herself and her company. It is on-line travel organization and information service provider. It provides users with information they could use to help them plan a trip itinerary for their travel and through the website, users can book online directly their travel needs. She refers to two websites: www.tripit.ca and www.tripit.mobi. She filed extracts of WHOIS search results showing that the domain name "tripit.ca" was approved on April 21, 2006 while tripit.mobi was created on November, 1, 2007. Those facts, by themselves, do not establish use of the Mark within the meaning of s. 4(2) of the Act at the claimed date of first use.

[25] She alleges that her commercial presence on the internet began with www.tripit.ca on May 1, 2006 "...as a portal for customers to feel comfortable to interact...". She states that through telephone, word of mouth, mail and email she corresponded to provide information to her clients' needs to plan trip itinerary for their travel. She filed what she describes as "examples" but what has been filed as exhibits B1, B2 and B3 are simply lists of attractions in Montreal and Hamilton as well as an email received on September 17, 2008 at an address tripit@sympatico.ca from a third party. I do not consider those pages as evidence of use of the Mark by the Applicant in association with the Services.

[26] She filed documentation to prove that she was actively involved in the creation, upgrading and fine tuning of the website going as far as March 21, 2006. However the documents referred thereto (exhibits 1 to 6 inclusive to her affidavit) show that there was work carrying on by a website developer providing template demos. There were questions still unanswered as of May 18, 2006 and an email dated June 15, 2006 originating from the email address tripit@sympatico.ca (not yet identified as the Applicant's email address) wherein pictures were provided to the website developer as

examples of “what I am looking for...”. There is also an invoice from IVC Host for a hosting plan paid on a yearly basis starting in January 2007 and for the design of a website with templates. None of these documents demonstrate any commercial activities by the Applicant in association with the Mark in Canada as of the alleged date of first use.

[27] She states that she used marketing tools and conducted advertising campaigns by giving out business cards, t-shirts and pens but failed to specify when such activities took place.

[28] She alleges that in November 2007 in order to attract mobile phone users she incorporated online booking features for car rental, cruise, hotel, flight and train and switch her platform website to www.tripit.mobi. By May 2008 she moved completely to the mobile platform site. It is unclear from her affidavit if the booking features were only introduced in November 2007. The wording of paragraph 7 of her affidavit seems to suggest such fact.

[29] She alleges that when she began using the Mark (no date specified) she had no knowledge that TRIPIT was used in the travel industry in Canada “prior to my use in 2006”. She placed what she calls “a backorder” for both www.tripit.com and www.tripit.net domain addresses on November 10, 2006 (after the claimed date of first use) and she filed a copy of the response received from GoDaddy.com. However no explanation was provided as to the meaning of “backorder” and if it was to backdate the reservation, to which date such reservation applies.

[30] I am disregarding the statement made in paragraph 10 of her affidavit about her opinion on the distinctiveness of the Mark as it is one of the legal issues raised by the Opponent in these proceedings.

[31] She filed documentation pertaining to the chain of title of the domain address www.tripit.com. None of the entities referred thereto are the Applicant or the Opponent.

[32] It was only in September 2007 that she apparently discovered the existence of the Opponent through an article dated September 17, 2007.

[33] She alleges that in a recent burglary she lost many documents that were valuable for her. However the date of the burglary was not provided nor any details as to the nature of those documents stolen. Finally she provides a list of some of her clients.

[34] I am disregarding the content of the documentation filed as exhibits 13 to 17 inclusive, which are print screens from the website located at <http://www.18885tripit.com/>, as they are dated subsequent to any of the relevant dates associated with the grounds of opposition pleaded by the Opponent.

Section 30(b) Ground of Opposition

[35] I will now assess the second ground of opposition described above. The Opponent has an initial evidential burden when alleging non-compliance with s. 30(b) of the Act but it has been characterized as a light one. Moreover the Opponent can rely on the evidence filed by the Applicant herself [see *York Barbell Holdings Ltd. v. ICON Health & Fitness, Inc.* (2001), 13 C.P.R. (4th) 156]. However such evidence must raise serious doubts on the accuracy of the statements made by the Applicant in her application [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986) 10 C.P.R. (3d) 84 (T.M.O.B.), *Labatt Brewing Co. v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.) and *Williams Telecommunications Corp. v. William Tell Ltd.*, (1999) 4 C.P.R. (4th) 107 (T.M.O.B)].

[36] The evidence filed by the Opponent through the affidavit of Mr. Bourassa does raise serious doubts on the use of the Mark in Canada in association with the Services as of the claimed date of first use since the searches performed by Mr. Bourassa in November 2007 did not reveal any use of the Mark by the Applicant in Canada. Consequently the burden shifts on the Applicant to establish use, within the meaning of s. 4 of the Act, of the Mark in Canada in association with the Services as of the claimed date of first use.

[37] The evidence filed by Ms. Myara and described above does not dissipate the serious doubts raised by the Opponent on the claimed date of first use of the Mark by the Applicant. In fact it confirms the concerns of the Opponent. Firstly it would appear from

her own evidence that her website was hosted by IVC Host only starting in January 2007. Also, as of June 15, 2006 she was providing examples to the website developer of what she was looking for. She states that her “commercial presence on the internet began with www.tripit.ca May 1, 2006...”. Yet the usage statistics for tripit.ca filed by the Applicant go back to only June 2007. There is no evidence of use of the Mark in Canada within the meaning of s. 4(2) of the Act by the Applicant in association with any of the Services as of the claimed date of first use. General bald statement of use of a trade-mark is not proper evidence of use of that trade-mark.

[38] Under these circumstances, the Opponent succeeds on the second ground of opposition.

Other grounds of opposition

[39] Given the fact that the Opponent is successful under the ground of opposition based on s. 30(b) of the Act; I consider that it is not necessary to rule on the other grounds of opposition.

Disposition

[40] Having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office