



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

Citation: 2014 TMOB 113
Date of Decision: 2014-06-03

**IN THE MATTER OF AN OPPOSITION
by MapQuest, Inc. to application
No. 1,423,905 for the trade-mark
TRIPQUEST, in the name of The
Lodging Company Reservations Ltd.**

[1] The Lodging Company Reservations Ltd. has applied to register the trade-mark TRIPQUEST in association with a variety of travel agency services. MapQuest, Inc. has opposed this application on several grounds, including on the basis that there is a reasonable likelihood of confusion between this trade-mark and its registered MAPQUEST trade-marks and its TRIPQUEST trade-marks, previously used in association with various travel, mapping and direction services and related wares.

[2] For the reasons that follow, I have found that this application should be refused.

Background

[3] On January 8, 2009, The Lodging Company Reservations Ltd. (the Applicant) filed application No. 1,423,905 for the registration of the applied-for mark TRIPQUEST (the Mark)

based upon proposed use in Canada in association with a variety of travel agency services. The statement of services is reproduced in its entirety in Schedule “A” to this decision (the Services).

[4] The application was advertised in the *Trade-marks Journal* on October 21, 2009. On January 18, 2011, MapQuest, Inc. (the Opponent) opposed the application under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The specific grounds of opposition are as follows: (i) the application does not conform to the requirements of section 30(b) of the Act; (ii) the application does not conform to the requirements of section 30(e) of the Act; (iii) the application does not conform to the requirements of section 30(i) of the Act; (iv) the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act, in view of the Opponent’s prior use of its MAPQUEST and TRIPQUEST trade-marks as set out in Schedule “B” attached hereto; (iii) the Mark is not registrable under section 12(1)(d) of the Act, in view of the Opponent’s registered MAPQUEST trade-marks as set out in Schedule “B” attached hereto; and (iv) the Mark is not distinctive within the meaning of section 2 of the Act.

[5] In support of its opposition, the Opponent filed certified copies of its MAPQUEST trade-mark registrations. The Opponent also filed the affidavits of Christian Dwyer, the General Manager and Senior Vice-President of the Opponent, and S. Noelle Engle-Hardy, a law student employed by the Opponent’s agent.

[6] As its evidence, the Applicant filed the affidavit of Dulce Campos, a trade-mark searcher employed by the Applicant’s agent.

[7] Both parties filed written arguments. Additionally, an oral hearing was held at which both parties were represented.

The Parties’ Respective Burden or 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. 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 [see *John Labatt*

Limited v The Molson Companies Limited (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

Grounds of Opposition Summarily Dismissed

Section 30(i) ground of opposition

[9] The Opponent has pleaded that the application does not conform to section 30(i) of the Act, in that the Applicant could not have been satisfied when it filed the application that it was entitled to use the Mark in Canada since:

- it was aware at that time that the Opponent had previously used and/or registered in Canada the MAPQUEST trade-marks and the TRIPQUEST trade-marks, with which it knew the Mark was and has been confusing at all material times; and
- it was aware at that time that all use by the Applicant of the Mark would be unlawful as depreciating the value of the goodwill attaching to the Opponent's registered MAPQUEST trade-marks, contrary to section 22(1) of the Act.

[10] The case law has established two circumstances under which non-compliance with section 30(i) of the Act may be found. The first circumstance is where there is evidence of bad faith on behalf of an applicant, an exceptional circumstance which would render the applicant's statement that it is satisfied that it is entitled to use the applied-for mark untrue [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; *Cerverceria Modelo, SA de CV v Marcon*, (2008), 70 CPR (4th) 355 (TMOB) at 369]. In the present case, there is no evidence of bad faith on the part of the Applicant. The Applicant's knowledge of the Opponent's trade-marks alone cannot be sufficient to conclude that the Applicant was in bad faith when it stated in its application that it was satisfied that it was entitled to use the Mark in Canada in association with the services.

[11] The second circumstance under which non-compliance with section 30(i) of the Act may be found is where a *prima facie* case of non-compliance with a federal statute is established [see for example *Interprovincial Lottery Corp v Monetary Capital Corp* (2006), 51 CPR (4th) 447 (TMOB) and *Canadian Bankers' Assn v Richmond Savings Credit Union* (2000), 8 CPR (4th) 267 (TMOB)]. In this regard, as indicated above, the Opponent has alleged that use of the Mark would violate section 22(1) of the Act. While the validity of this ground has not been clearly

established, even if it was to be considered a valid ground of opposition, it would not succeed as the Opponent has failed to adduce any evidence supporting a likelihood of depreciation of goodwill [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, (2006), 49 CPR (4th) 401 (SCC)].

[12] Accordingly, the ground of opposition based on section 30(i) of the Act is dismissed.

Section 30(b) ground of opposition

[13] The Opponent has pleaded that the application does not conform to section 30(b) of the Act, in that contrary to the Applicant's representation in the application that the Mark was a proposed trade-mark, the Applicant had in fact already used the Mark in Canada in association with some or all of the services in the application as of the date of filing of the application.

[14] The Opponent submits that if the date of first use claimed in an application is incorrect or omitted, such an application may be invalid as failing to comply with section 30(b) of the Act. Specifically, with respect to applications based upon proposed use, the Registrar of Trade-marks has refused such applications where actual use of the trade-mark was evidenced prior to the filing date [see *Nabisco Brands Ltd v Cuda Consolidated Inc* (1997), 81 CPR (3d) 537 (TMOB) at 540 and *Systèmes de Formation & de Gestion Perform Inc v Scissons*, 2004 CarswellNat 1758 (TMOB)].

[15] The Opponent submits that the Applicant is "hiding" use of the Mark in Canada, as the Applicant registered the domain name *www.tripquest.ca* on December 16, 2008, as evidenced through the affidavit of Ms. Engle-Hardy (paragraphs 3 and 4 and Exhibit B-4). The Opponent further submits that this was a live and active website which displayed the Mark and that the Applicant has since replaced the live website with an inactive "parking page". However, the Opponent's evidence is not evidence of an active website which displayed the Mark; it is merely evidence that the domain name was previously registered.

[16] The Applicant filed evidence regarding the domain *www.tripquest.ca*. Specifically, Mr. Campos conducted a search to locate this site and attached the results as Exhibit 57 to his affidavit. The printout from the webpage shows no website content other than the words "It

Works!”. Further to this, Mr. Campos conducted a search of the Internet archive, Wayback Machine on-line search database for *www.tripquest.ca* and according to the results of his search (Exhibit 58), there are no archived pages of record for this website.

[17] The evidential burden on an opponent to put compliance with section 30(b) into issue is relatively light: see *Tune Masters v Mr. P’s Mastertune* (1986), 10 CPR (3d) 84 at 89 (TMOB). However, the mere registration of a domain name does not constitute use of a trade-mark for the purposes of section 4 of the Act [see *Sun media Corporation v The Montreal Sun (Journal Anglophone) Inc*, 2011 TMOB 15 (CanLii); and *Lutron Electronics Co v Litron Distributors Ltd*, 2013 TMOB 129 (CanLii)]. Consequently I agree with the Applicant that the Opponent has failed to meet its initial burden.

Section 30(e) ground of opposition

[18] In the alternative to the section 30(b) ground of opposition, the Opponent has pleaded that the application does not conform to the requirements of section 30(e) of the Act, in that the Applicant’s statement in the application that it intends to use the Mark in Canada was false.

[19] The application contains a statement that the Applicant by itself and/or through a licensee intends to use the trade-mark in Canada; thus, it formally complies with section 30(e) of the Act. Since there is no evidence suggesting that the Applicant did not actually intend to use the Mark when it filed its application, the section 30(e) ground of opposition is dismissed on the basis that the Opponent has not met its initial evidential burden.

Analysis of Remaining Grounds of Opposition

[20] I will now turn to the analysis of the remaining three grounds of opposition, all of which turn on the likelihood of confusion between the Opponent’s MAPQUEST and TRIPQUEST trade-marks and the Mark.

Confusion – Non-registrability ground under section 12(1)(d) of the Act

[21] The Opponent has pleaded that the Mark is not registrable because it is confusing with the Opponent's MAPQUEST trade-marks and TRIPQUEST trade-marks (listed in Schedule "B" to this decision).

[22] The material date with respect to a section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[23] The Opponent has met its initial burden of proof under this ground of opposition with respect to its MAPQUEST trade-marks. In this regard, the Opponent has filed certified copies of each of the registrations relied upon and I have exercised my discretion and checked the Register to confirm that the Opponent's registrations are extant [*Quaker Oats Co of Canada v Menu Foods Ltd*, (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent however, has not provided any evidence that its TRIPQUEST trade-marks are registered marks; thus, the Opponent's TRIPQUEST trade-marks will not be considered under this ground of opposition.

[24] I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with one or more of the Opponent's registered MAPQUEST trade-marks. Comparing the Mark and the registered trade-mark MAPQUEST (TMA586,287) will effectively decide the section 12(1)(d) ground of opposition. In other words, if confusion is not likely between the Mark and MAPQUEST, then it would not be likely between the Mark and the Opponent's registered trade-mark MAPQUEST.COM (TMA586,286).

The test for confusion

[25] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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.

[26] In applying the test for confusion, the Registrar must have regard to all surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them. The above-noted criteria are not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 96 CPR (4th) 361 (SCC)].

Section 6(5)(a) – inherent distinctiveness and the extent to which the marks have become known

[27] The overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness of the parties' trade-marks, favours the Opponent. Neither mark is inherently strong. Nevertheless, the Opponent has shown evidence of use of its trade-mark MAPQUEST in Canada while there is no evidence of promotion or use of the Mark by the Applicant in Canada.

[28] The Mark consists of the word TRIPQUEST. Although it is a coined word, it is comprised of two common dictionary words, trip and quest. Likewise, the Opponent's mark MAPQUEST is a coined word comprised of two common dictionary words, map and quest.

[29] The Applicant filed evidence of several definitions of the words trip, map, and quest (Campos affidavit, Exhibits 1 and 2), including the following definitions from *Merriam-Webster's* online dictionary:

map: a representation usually on a flat surface of the whole or part of an area

trip: to make a journey.

quest: an act or instance of seeking

[30] The Applicant submits that considering the Opponent's services are geographical in nature, the MAPQUEST trade-mark is highly suggestive of searching a diagrammatic representation of geographical locations (i.e. a map). The Applicant concedes that its Mark is also suggestive of its proposed travel agency services. That is, the Mark suggests the general idea of looking for a journey, expedition or vacation. I agree that both parties' marks are suggestive of the nature of their respective associated services. As a result, I do not consider either of the parties' marks to be inherently strong.

[31] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. The Applicant did not provide any evidence of promotion or use of the Mark.

[32] On the other hand, the Opponent submits that the Dwyer affidavit establishes that its MAPQUEST trade-marks (MAPQUEST and MAPQUEST.COM) are renowned in Canada. In paragraph 33 of its written argument, the Opponent submits that such notoriety is a result of:

- (i) their use for nearly a decade in association with a broad range of travel related services online, including providing directions to travelers;
- (ii) the significant advertising and promotion of the MAPQUEST and MAPQUEST.COM trade-marks in Canada;
- (iii) the significant traffic to the MAPQUEST website and to websites that feature MAPQUEST products and services and the respective high traffic ranking of such sites in Canada; and
- (iv) considerable revenue generated through the MAPQUEST website and by companies embedding MAPQUEST maps on their website.

[33] I note the following from the Dwyer affidavit regarding use of the MAPQUEST trade-mark:

- Mr. Dwyer states that the MAPQUEST trade-mark has been used consistently and extensively at *mapquest.com* since at least as early as 1996 and at *mapquest.ca* since April 2011, and that these websites are accessible to, and visited by, Internet users located in Canada [paras. 8 and 11 of Dwyer affidavit].
- Exhibit B-1 consists of printouts from the websites *www.mapquest.com* and *www.mapquest.ca* of representative examples of use of the MAPQUEST trade-mark in association with hotel reservation and travel information services.

- Exhibit B-2 consists of archived pages from the *www.mapquest.com* website, printed from the Internet archive, Wayback Machine, showing the MAPQUEST trade-mark on the website as it appeared in October and November of 2009.
- Exhibit C includes printouts from third party websites in travel related industries (*www.travelocity.com* and *www.travelocity.ca*), showing embedded MAPQUEST maps.
- Mr. Dwyer states that the Opponent has invested substantial sums of money in developing and marketing its MAPQUEST services to customers in Canada. These customers include Internet users, as well as Canadian websites and travel agency operators in Canada [para. 10 of Dwyer affidavit].
- Mr. Dwyer states that the Opponent monitors the number of Canadian visitors to MAPQUEST websites each month [para. 12 of Dwyer affidavit]. He attaches as Exhibit D, reports generated from *comScore* data summarizing the number of unique monthly Canadian visitors to various MAPQUEST websites, including *www.mapquest.com* and *www.mapquest.ca* for the periods April 2009 through June 2011. During that period, traffic ranged from 2.1 to 4 million unique monthly Canadian visitors, a significant portion of which represents visits to the *mapquest.com* website.
- Mr. Dwyer states that due to the popularity of the MAPQUEST website among Canadians, sales in Canada of advertising on the MAPQUEST website and sales of embedded MAPQUEST maps to Canadian third party websites have been significant [para. 13 of Dwyer affidavit].

[34] The Applicant made lengthy submissions regarding Mr. Dwyer's evidence. To begin with, the Applicant submits that the bulk of Mr. Dwyer's statements constitute bare assertions. In this regard, the Applicant submits that Mr. Dwyer has not provided specifics with respect to advertising expenditures, sales revenues, the identity of customers, or licensing with respect to third party use of the Opponent's embedded maps.

[35] In addition to these submissions, the Applicant submits that it is not clear from the evidence that the web pages furnished under Exhibits B-1 and C to the Dwyer affidavit have been accessed by Canadian consumers, or whether these websites emanate from, relate to, or could be accessed from Canada. This is so, the Applicant submits, as Mr. Dwyer does not indicate when, where or by who these web pages were printed. The Applicant submits one can only assume that Mr. Dwyer accessed these pages in the United States around the swearing of his affidavit, namely, July 28, 2011 and that this solely establishes that there were web pages available for access in the United States which displayed the MAPQUEST trade-mark. I disagree. Mr. Dwyer provides a sworn statement at paragraph 11 of his affidavit, that the

MAPQUEST websites are accessible to, and visited by, Internet users located in Canada. Further to this, Mr. Dwyer states that the Opponent monitors the number of Canadian visitors to MAPQUEST websites each month (para. 12) and has provided website traffic data (Exhibit D) that show that a significant number of Canadians accessed the MAPQUEST websites. While the Applicant questions the admissibility of this evidence on the basis that there is no evidence to support the reliability of this data, I am prepared to give it weight since it appears that such information would be provided to the Applicant in the normal course [*Miller Brewing Co v Labatt Brewing Co* (1991), 36 CPR (3d) 400 at 406 (TMOB)].

[36] In any event, the Applicant submits that Mr. Dwyer's affidavit does not show that the Opponent has used its MAPQUEST trade-mark in association with "hotel reservation and travel information services", rather instead, the actual alleged services would be properly defined as "advertising" related services. In this regard, the Applicant submits that the Opponent's MAPQUEST website simply includes online map searches, third party business listings and advertising space, including sponsored links for third parties to promote their wares/services in numerous different fields and areas of business.

[37] The Opponent's registered services do not include "hotel reservation services". Furthermore, the evidence shows that the Opponent offers searchable online maps, wherein consumers can search for hotels, restaurants, obtain driving directions, etc. While the hotels, restaurants, etc. identified in such searches are obviously third parties, it is clear that the search mechanism has been provided by the Opponent and this is consistent with the registered services as defined in the Opponent's MAPQUEST registration.

[38] Having regard to the foregoing, I accept that the Opponent's MAPQUEST mark has become known in Canada to a significant extent with respect to the following Opponent's registered services:

- (1) [...]; providing interactive maps, driving directions, and destination information by means of an on-line website; providing information, by means of an interactive on-line website on a global computer network, in the field of maps and travel.
- (2) [...]; [...]; providing map enablement for the websites of others; providing on-line interactive access to geographic information, map images, and trip routing on websites of others; providing on-line interactive access to geographic information, map images, and

downloadable software programs in the field of consumer oriented travel, business, education, and entertainment applications; providing on-line maps and travel information; customized mapping services.

[39] As a result, I consider this factor strongly favours the Opponent.

Section 6(5)(b) – the length of time of use

[40] As discussed above, the Opponent has evidenced use of its MAPQUEST trade-mark whereas the Applicant did not file any evidence of use of the Mark. This factor therefore favours the Opponent.

Section 6(5)(c) and (d) – the nature of the wares and services and business or trade

[41] It is the Applicant's statement of services as defined in its application versus the Opponent's registered wares and services that govern my determination of this factor [see *Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB)]. 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 particularly where there is an ambiguity as to the wares or services covered in the application or registration(s) at issue [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)].

[42] The Applicant submits that the Opponent's "travel" related services are insufficiently specific, and one must recognize the specific nature of the actual wares/services offered or performed to properly assess the issue of confusion. Furthermore, the Applicant submits that in the context of the Opponent's services, "travel" should be interpreted to mean the movement of people from one place to another or otherwise have a geographic context. Thus, the Applicant submits that the Opponent offers geographical based wares and services, while it proposes to offer vacation reservation and booking services; services that it submits are therefore sufficiently different.

[43] While I accept that the Opponent is not a travel agency, the Opponent's registered services have some overlap in that they too relate to travel-based activities, including the provision of travel and destination information. Furthermore, I find no ambiguity in the word "travel" in the Opponent's statement of services. Even if I did, the evidence tendered by Mr. Dwyer clearly shows that the Opponent's interactive maps are designed to provide users with travel and destination related information, including the ability to conduct searches for hotels and restaurants, etc. Furthermore, the evidence also shows that the Opponent's target market includes travel related websites such as *Travelocity.com* and *Travelocity.ca*, suggesting that the Opponent's services are relevant and related to the travel industry.

[44] With respect to channels of trade, there is no restriction in the specification for the Services limiting the Applicant to conducting its travel agency services through any particular channel (such as a brick and mortar operation for example); consequently, the Applicant may offer its Services online through a website, as does the Opponent. In the absence of any restrictions, and given the overlap in the nature of the services of the parties, it is conceivable that the parties' services could travel through the same channels of trade.

[45] Having regard to the foregoing, sections 6(5)(c) and (d) favour the Opponent.

Section 6(5)(e) – degree of resemblance in appearance, when sounded, or in idea suggested

[46] When considering the degree of resemblance between the marks, the law is clear that the marks must be considered in their totalities; it is not correct to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks. The Supreme Court of Canada in *Masterpiece, supra* advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[47] The Opponent submits that the word QUEST is the most striking or dominant element of the parties' marks, as it is the portion of the parties' marks that distinguishes the Opponent and the Applicant from other sources of trip or map related services. The Applicant, on the other hand, submits that the word QUEST is not inherently distinctive, and as such, the prefix of the parties' marks becomes more relevant for the purposes of distinction [citing *Conde Nast*

Publications Inc v Union des editions modernes (1979), 46 CPR (2d) 183 at para 34; and *Ratiopharm Inc v Laboratoires Riva Inc* 2006 FC 889]. Furthermore, the Applicant submits that the ideas suggested by the parties' marks are different. In this regard, the Applicant submits that the Opponent's MAPQUEST trade-mark is suggestive of searching a map, whereas its TRIPQUEST trade-mark is suggestive of looking for a vacation or expedition.

[48] I agree that the word QUEST, being suggestive of the parties' associated services, is not inherently strong. Nonetheless, I agree with the Opponent that it is the most dominant element of the parties' marks, since the words TRIP and MAP are clearly descriptive of the services to which they are associated. This being so, I find that there is a degree of resemblance between the parties' marks in appearance and when sounded due to the common element QUEST.

[49] Lastly, contrary to the Applicant's submission, the Opponent submits that the parties' marks are highly similar in the ideas suggested, since one uses "maps" to plan "trips". While I would not characterize the ideas suggested between the parties' marks as being "highly" similar, I find the Opponent's submission is not completely without merit. When considering the marks in their totalities, the ideas evoked by the parties' marks are somewhat related. In this regard, I find the Opponent's MAPQUEST trade-mark conveys the idea of searching for a destination, while the idea suggested by the Mark relates to searching for a journey or voyage.

[50] To sum up, I find that the overall consideration of the degree of resemblance between the Mark and the Opponent's MAPQUEST trade-mark favours the Opponent. The parties' marks both include the element QUEST, which I consider to be the most striking or unique portion of the parties' one word marks; consequently, there is a degree of resemblance between the marks in appearance and when sounded. Furthermore, there is overlap or a relationship between the ideas evoked by the parties' marks.

Additional Surrounding Circumstances

The State of the Register and the State of the Marketplace

[51] The evidence concerning the state of the register is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the

marketplace can only be drawn where large numbers of relevant registrations are located. [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432; *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FCTD); *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)].

[52] Attached as Exhibit 4 to the Campos affidavit are the results of a search Mr. Campos conducted of the Canadian trade-marks database for “active trade-mark registrations for marks which incorporate the terms “*quest*” (however, excluded the queries “*request*”, “*equestr*” and “*question*””. Exhibits 6 through 8 contain particulars of 61 of the 340 trade-marks identified by this search.

[53] The Opponent submits that many of the trade-marks identified in Mr. Campos’ above-noted search are not relevant, as they contain the word QUEST embedded within the trade-mark and/or are associated with unrelated wares and/or services. The Opponent submits that the marks identified in this search that are associated with overlapping wares and/or services were allowed to coexist due to visual differences, to which none of the marks identified contain a prefix that, like the word “trip”, is so closely related to the word “map”. In summary, the Opponent submits that there are too few relevant marks identified in Mr. Campos’ search to make any inferences about the state of the marketplace [citing *Kellogg Salada, supra*, and *Pharmacia AB v Homeocan Inc* (2003), 33 CPR (4th) 375 (TMOB)]. I agree.

[54] With respect to other marks that include QUEST and incorporate other elements that may also relate to travel (such as elements that are suggestive of travel or a travel destination or vacation related services), as well as are in association with overlapping wares and/or services of the parties, upon a thorough review of the state of the register evidence, I note the following relevant active registrations: RIDEQUEST (TMA747,885), AFRICAQUEST (TMA572,640), AMERICAQUEST (TMA572,524), ASIAQUEST (TMA572,403), GALAPAGOSQUEST (TMA572,639), GUESTQUEST (TMA717,824), ISRAEL QUEST (TMA477,387), SUNQUEST (TMA414,100, TMA429,162), SUNQUEST SELECT (TMA562,100), SUNQUEST VACATIONS (TMA244,580), VACANCES SUNQUEST (TMA496,612), and RESORTQUEST Logo (TMA721,320). In terms of marks for overlapping wares and/or services which include the word QUEST as the dominant portion of the mark, the state of the register

evidence includes the following active relevant registrations: QUESTPERKS (TMA621,751), QUEST UNIVERSITY CANADA DESIGN (TMA725,065), and QUEST UNIVERSITY CANADA (TMA698,301). In all, I have identified 16 registrations owned by nine separate entities.

[55] To buttress the state of the register evidence, Mr. Campos also conducted Internet searches on Google to locate 18 of the trade-mark registrations identified in the search results attached under Exhibit 4 to his affidavit. Exhibits 9 through 17 contain printouts from webpages which contain these marks. The following relevant trade-marks appear in these exhibits (i.e. – contain the word QUEST as the dominant element or together with another element related to travel or to a destination, and are in association with overlapping wares and/or services): RIDEQUEST (TMA747,885), GUESTQUEST (TMA717,824), QUEST (TMA382,121), QUEST UNIVERSITY CANADA (TMA698,301), RESORTQUEST Logo (TMA721,320), and SUNQUEST (TMA414,100, TMA429,162).

[56] Further to this, Mr. Campos conducted an Internet search using Google to locate websites “which contain the word QUEST in association with travel and tourism related wares and services and navigational, map and geographical related wares and services.” Exhibits 18 through 43 contain a representative sampling of the results of this search, wherein there were various indicia on the websites identified to indicate they were Canadian or directed at Canadians. However, I do not consider trade-marks associated with navigational, map and geographical related wares and services to necessarily be relevant; I only consider trade-marks for travel-related wares and services that overlap between the parties to be relevant. Thus, the following relevant marks appear in these exhibits: Quest Travel & Design, Quest Nature Tours & Design and WorldwideQuest & Design (both owned by the same entity), TravelQuest, Travel Quest & Design, Galaxy Quest Travel, YourTravelQuest, OceanQuest & Design, Adventure Quest & Design, Victoria Adventure Quest & Design, and GeoQuest.

[57] Mr. Campos also conducted an Internet search using Google to locate websites “which contain the word QUEST in association with maps/mapping, global position systems (GPS), navigational and geographical related fields which co-exist in North America with the Opponent, MapQuest, Inc.” Attached as Exhibits 44 through 52 are the results of representative samplings

of this search. However, as previously stated, I do not consider marks associated with maps, navigation, etc. *per se* as relevant, but more particularly, only those marks that are associated with travel-related wares and/or services, in the nature of those that overlap between the parties. While the Opponent's MAPQUEST mark may coexist with other "QUEST" marks in the mapping and navigational fields, this is not relevant to the question of whether "quest" is common to the travel industry, having regard to the overlap between the wares and services of the parties in the present proceeding.

[58] Lastly, Mr. Campos conducted "a search of the on-line interactive driving directions site located at *www.mapquest.ca*" and located results for the queries "travel quest vancouver", "quest university" and "resort quest". The results of this search are attached as Exhibit 56 to his affidavit, and identify three entities Mr. Campos previously located through the state of the register search or through an Internet search he conducted.

[59] Having regard to the above, I am satisfied that the Applicant has brought forth sufficient evidence to show that the use of the word QUEST, when combined with words that are suggestive of travel, or as the dominant component of a trade-mark, is common to the travel industry. In this regard, while not overwhelming, given the number of relevant registrations located by the Applicant, I am prepared to infer that at least some of these marks are in use in the marketplace, such that consumers would be accustomed to seeing such marks in association with travel-related wares and/or services. Furthermore, the state of the marketplace evidence corroborates this finding.

Conclusion

[60] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. In *Masterpiece, supra* the Supreme Court highlighted the importance of the section 6(5)(e) factor in the analysis of the likelihood of confusion. In the present case, I have found the parties' marks share similarities in appearance and when sounded due to the common element QUEST. Furthermore, the ideas evoked by the parties' marks are related. There is also overlap in the nature of the services and of the trade of the parties. While the parties' marks are not inherently strong, the evidence shows that the Opponent's mark has become known to a significant extent in Canada. Despite the state of the register and state of the

marketplace evidence, I find the balance of surrounding circumstances favours the Opponent. Indeed, I am not satisfied that the state of the register and state of the marketplace evidence are additional surrounding circumstances so significant as to shift the balance of probabilities in favour of the Applicant. At best for the Applicant, I would find that these additional surrounding circumstances result in an even balance of probabilities between a finding of confusion and a finding of no confusion. As the onus is on the Applicant to establish on a balance of probabilities that the Mark is not confusing with the MAPQUEST trade-mark, I would still decide against the Applicant.

[61] Thus, having regard to the foregoing, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's MAPQUEST trade-mark. Accordingly, the ground of opposition based on section 12(1)(d) of the Act is successful.

Non-entitlement ground of opposition under section 16(3)(a) of the Act

[62] The Opponent pleads that the Applicant is not entitled to the registration of the Mark because it is confusing with the Opponent's MAPQUEST and TRIPQUEST marks (listed in Schedule "B" to this decision), which had been previously used in Canada.

[63] In order to meet its initial burden under section 16(3)(a) of the Act, the Opponent must show that one or more of the trade-marks alleged in support of its ground of opposition were used in Canada prior to the date of filing of the application for the Mark (January 8, 2009) and had not been abandoned at the date of advertisement of the application for the Mark (October 21, 2009) [section 16(5) of the Act].

[64] As previously discussed in the confusion analysis under the ground of opposition based on section 12(1)(d) of the Act, the Opponent's evidence of use of its MAPQUEST trade-mark in Canada is provided through the Dwyer affidavit. However, aside from statements of use of the trade-mark in Canada, evidence showing use of the MAPQUEST trade-mark in Canada post-dates the material date under this ground of opposition. In particular, the archived *www.mapquest.com* webpages attached as Exhibit B-2 to the Dwyer affidavit, show the website as it appeared in October and November of 2009. Similarly, the web traffic data summarizing

the number of unique monthly Canadian visitors to the *www.mapquest.com* website (Exhibit D to the Dwyer affidavit) for the period April 2009 through June 2011 post-dates the date of filing of the application for the Mark.

[65] Based on the foregoing, the Opponent has failed to meet its evidential burden under sections 16(3)(a) of the Act with respect to its MAPQUEST and MAPQUEST.COM trade-marks.

[66] I will now consider whether the Opponent has met its burden under this ground of opposition with respect to its TRIPQUEST and/or TRIPQUEST.COM trade-marks. The Opponent has filed evidence relating to these marks in both the Dwyer and the Engle-Hardy affidavits.

[67] At paragraph 5 of his affidavit, Mr. Dwyer states that the Opponent owns the *tripquest.com* domain name, which was registered in 1996. He further states that the TRIPQUEST trade-mark and domain name were first used with a driving directions service in 1996 through the MAPQUEST website. Mr. Dwyer then states that today, the *tripquest.com* domain name is used to redirect internet traffic to the MAPQUEST website.

[68] The Applicant submits, and I agree, that Mr. Dwyer's above-noted statements regarding use of the TRIPQUEST trade-mark and domain name dating back to 1996 are bare assertions, as the Opponent has not supplied any evidence to support such statements. With respect to the *tripquest.com* domain name specifically, the Applicant submits that contrary to Mr. Dwyer's statement in paragraph 5 of his affidavit, the evidence shows that it is AOL Inc., and not the Opponent [referring to Exhibit B-1 of the Engle-Hardy affidavit and Exhibit 59 of the Campos affidavit] that owns the *tripquest.com* domain name. Again, I agree. The Opponent attempted to address this discrepancy by submitting that the Opponent is the "beneficial owner" of the domain name, and further, that AOL Inc. owns the Opponent. However, the Opponent cannot rely on the use or making known of a trade-mark by any person other than itself or its predecessor-in-title in challenging an applicant's entitlement. In any event, as I have previously noted in the ground of opposition based on section 30(b) of the Act, the mere registration of a domain name does not constitute use of a trade-mark.

[69] With respect to the Engle-Hardy affidavit, Ms. Engle-Hardy's affidavit includes the results of an Internet search that she conducted through *Google.ca* for "TRIPQUEST" (Exhibit A-1). The Opponent submits that this shows that a Google search for "tripquest" renders MAPQUEST as the first result. Lastly, Ms. Engle-Hardy conducted a search on *www.alexa.com* for website traffic details for *tripquest.com*. She attaches the results of this search under Exhibit C-3 to her affidavit.

[70] Essentially, the Opponent is relying on the existence of the domain name *tripquest.com* and its use in redirecting Internet traffic to its MAPQUEST website, as well the ability to locate the Opponent's MAPQUEST website through use of the search term "tripquest". In support of its position, the Opponent has cited the decision in *Dentec Safety Specialists Inc v Degil Safety Products Inc*, 2012 ONSC 4721.

[71] To begin with, I note that Ms. Engle-Hardy's evidence post-dates the material date under this ground of opposition. In any event, I agree with the Applicant that the *Dentec* case is not relevant for the purposes of this ground of opposition. The decision in *Dentec* was an action for passing off in the context of domain names; thus, the question of whether such use constitutes use as a trade-mark pursuant to section 4 of the Act was not a consideration.

[72] Based on the foregoing, the Opponent has failed to meet its evidential burden under sections 16(3)(a) of the Act; accordingly, this ground of opposition is dismissed.

Non-distinctiveness ground of Opposition

[73] In order to meet its initial burden under this ground, the Opponent must establish that as of the filing date of the statement of opposition, namely, January 18, 2011, one or more of the Opponent's marks had become known sufficiently to negate the distinctiveness of the Mark [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, (2004), 34 CPR (4th) 317 (FC); and *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)].

[74] As per my as per my analysis under the section 12(1)(d) ground of opposition, I accept that the Opponent's MAPQUEST trade-mark had become known to a significant extent in Canada as of the material date. As the Opponent has met its evidential burden at least with

respect to its MAPQUEST trade-mark, I will not consider whether or not the Opponent had also developed a sufficient reputation for its claimed TRIPQUEST trade-mark and/or *tripquest.com* trade-mark and/or domain name as of the material date.

[75] Since I am satisfied that the Opponent's evidence establishes that its MAPQUEST trade-mark had become sufficiently known as of January 18, 2011 to negate the distinctiveness of the Mark, the issue becomes whether the Applicant has satisfied its legal onus to show that the Mark was not reasonably likely to cause confusion with the Opponent's MAPQUEST trade-mark.

[76] The difference in material dates is not significant, and as a result, my findings under the ground of opposition based on section 12(1)(d) are equally applicable here. Accordingly, the ground of opposition based on non-distinctiveness is successful.

Disposition

[77] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Darlene H. Carreau
Chairperson
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule "A"

<u>Application Number</u>	<u>Trade-mark</u>	<u>Services</u>
1,423,905	TRIPQUEST	Travel agency services, namely, making reservations and bookings for transportation, temporary accommodations, restaurants and dining, travel tours, sightseeing tours, day tours, travel activities, recreational activities, attractions and entertainment events;

Schedule “B”

<u>Registration Number</u>	<u>Trade-mark</u>	<u>Wares/Services</u>
TMA586,287	MAPQUEST	<p><u>Wares:</u></p> <ul style="list-style-type: none"> (1) Computer software for trip planning and customized mapping, for the personal use of travellers; pre-recorded CD-Rom containing trip planning information; pre-recorded CD-Rom containing a street atlas. (2) Printed maps and city guides. <p><u>Services:</u></p> <ul style="list-style-type: none"> (1) On-line sale of maps; providing interactive maps, driving directions, and destination information by means of an on-line website; providing information, by means of an interactive on-line website on a global computer network, in the field of maps and travel. (2) Custom design and printing of maps; custom development of informational, interactive kiosks containing driving directions; providing map enablement for the websites of others; providing on-line interactive access to geographic information, map images, and trip routing on websites of others; providing on-line interactive access to geographic information, map images, and downloadable software programs in the field of consumer oriented travel, business, education, and entertainment applications; providing on-line maps and travel information; customized mapping services.
TMA586,286	MAPQUEST.COM	<p><u>Wares:</u></p> <ul style="list-style-type: none"> (1) Computer software for trip planning and customized mapping, for the personal use of travellers; pre-recorded CD-Rom containing trip planning information; pre-recorded CD-Rom containing a street atlas. (2) Printed maps and city guides.

		<p><u>Services:</u></p> <p>(1) On-line sale of maps; providing interactive maps, driving directions, and destination information by means of an on-line website; providing information, by means of an interactive on-line website on a global computer network, in the field of maps and travel.</p> <p>(2) Custom design and printing of maps; custom development of informational, interactive kiosks containing driving directions; providing map enablement for the websites of others; providing on-line interactive access to geographic information, map images, and trip routing on websites of others; providing on-line interactive access to geographic information, map images, and downloadable software programs in the field of consumer oriented travel, business, education, and entertainment applications; providing on-line maps and travel information; customized mapping services</p>
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Other:

<u>Trade-mark</u>	<u>Wares/Services</u>
TRIPQUEST	Travel-related and online services, including providing maps, directions and destination information to consumers.
TRIPQUEST.COM	Travel-related and online services, including providing maps, directions and destination information to consumers.