OPIC CIPO

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 158

Date of Decision: 2021-01-29

IN THE MATTER OF AN OPPOSITION

Greater Edmonton Taxi Service Inc.	**Opponent**
and	
Tappcar Inc.	**Applicant**
1,764,943 for Tappcar	**Application**

INTRODUCTION

[1] Greater Edmonton Taxi Service Inc. (the Opponent) opposes registration of the trademark Tappcar (the Mark), which is the subject of application No. 1,764,943 by Tappcar Inc. (the Applicant).

[2] The application for the Mark is based on proposed use in association with the following goods (Goods) and services (Services):

Goods

(1) Computer software for coordinating transportation services of people and cargo, namely, software for the automated scheduling and dispatch of motor vehicles.

Services

(1) Taxi Services.

(2) Courier Services.

(3) Vehicle for hire services.

(4) Providing a website featuring information regarding transportation services and bookings for transportation services by car.

(5) Providing temporary use of online non-downloadable software for providing car transportation services, bookings for car transportation services and for dispatching motor vehicles to customers.

(6) Telecommunications services, namely, routing calls, SMS messages, and push-notifications to local motor vehicle dispatchers in the vicinity of the caller using mobile phones for coordinating transport services of people and cargo.

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent's prior use of its trademarks TAPP, TAPP YOUR CAB and TAPP YOUR RIDE, in word and design form, in association with goods and services including taxi services.

[4] For the reasons that follow, the application is refused.

THE RECORD

[5] The application for the Mark was filed on January 26, 2016, and was advertised for opposition purposes in the *Trademarks Journal* of September 7, 2016.

[6] On February 6, 2017 the Opponent filed a statement of opposition under section 38 of the *Trademarks Act* (RSC 1985, c T-13) (the Act). The grounds of opposition pleaded by the Opponent include sections 12(1)(d), 16(3)(a) and 2 of the Act, all of which turn on the issue of a likelihood of confusion between the applied for Mark and the Opponent's trademarks. The 12(1)(d) ground of opposition was later withdrawn by the Opponent in its written argument. The Opponent has also pleaded grounds of opposition under section 30(i) of the Act. As the Act was amended on June 17, 2019, all references in this decision are to the Act as amended, with the exception of references to the grounds of opposition (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised before this date).

[7] The Applicant denied all the grounds of opposition in a counter statement served on the Opponent on April 10, 2017.

[8] In support of its opposition, the Opponent filed the affidavit of Philip Strong. In support of its application, the Applicant filed the affidavit of Jonathon L. Wescott. Mr. Wescott was cross-examined on his affidavit, and his transcript forms part of the record. The undertakings from the cross-examination of Mr. Wescott were subsequently filed and also form part of the record.

[9] Both parties filed a written argument, and were represented at a hearing.

[10] Before assessing the allegations advanced in the statement of opposition, I will first discuss the parties' evidence, the evidential burden on the Opponent, and the legal onus on the Applicant. It will also be necessary to discuss the meaning of "confusion" within the context of the Act, and the factors to be considered in assessing the issue of confusion.

THE EVIDENCE

The Opponent's Evidence

[11] The Opponent's evidence is comprised of the affidavit of Philip Strong, President of the Opponent, sworn on August 10, 2017 (para 1). Pertinent portions of Mr. Strong's affidavit are summarized below.

The Opponent's operations, goods and services

[12] The Opponent was founded in 1945 and is based in Edmonton, Canada (para 2). The Opponent is a wholly owned subsidiary of 331001 Alberta Ltd., a corporation under the laws of Alberta. 331001 Alberta Ltd. also owns Prestige Transportation Ltd. and Cliff's Towing Ltd. Mr. Strong is the president of all of these corporate entities (para 3).

[13] Mr. Strong states that the Opponent is Edmonton's largest taxi transportation provider, providing transportation and taxi cab services in the Edmonton area through its taxi fleets under the following divisions: Yellow Cab, Barrel Taxi, Checker Cabs, Prestige Cab, 24-7 Taxi, Capital Taxi, Garage division and Body shop division, Prestige Transportation Ltd operating as Prestige Limousine, DATS Contractors, Stretch division, Skyshuttle Service, and Charter division (para 4).

The Opponent's trademarks

[14] Mr. Strong states that since at least January 2015, the Opponent has "continuously used the trademarks TAPP, TAPP YOUR RIDE and TAPP YOUR CAB in association with its mobile applications to identify its goods and services" (the "Opponent's marks") (para 13, 14). These trademarks, depicted in both word and design mark formats, are set out in Schedule A of this decision, and are the subject of applications filed with the Canadian Trademarks Office (para 15).

Use and promotion of the Opponent's marks

[15] Mr. Strong states that since at least 2015, the Opponent has actively promoted the Opponent's marks in Canada in association with its taxi services. He describes the Opponent's marks as "central to the identification of the Opponent's goods and services in Canada and in particular to its mobile applications" (para 16).

[16] In October 2013, the Opponent launched its mobile application software for smartphones using the Apple and Android operating systems to bring automation and operational efficiency to the Opponent's taxi fleet with both auto and manual dispatch management. Mr. Strong states that there were 44,000 downloads of the mobile application software, and that these downloads generated 11% of the trips booked for the Opponent's taxi cabs (para 17).

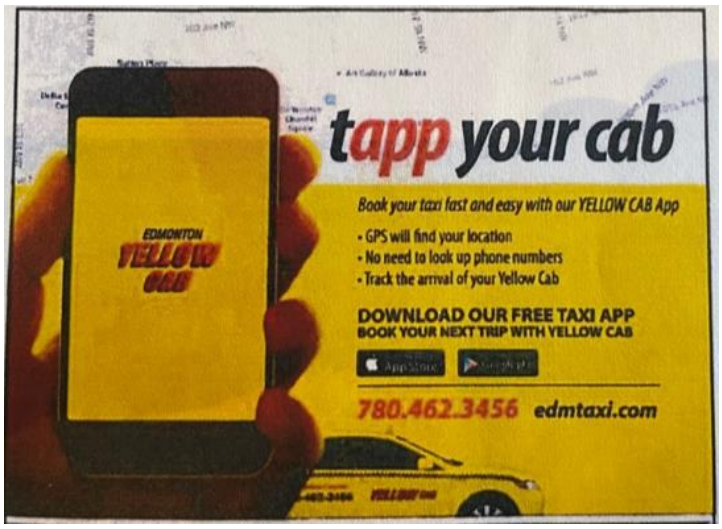
[17] In 2013, the mobile application for Yellow Cab and Barrel Taxi was completed. In 2014, the mobile application software for Checker and Prestige Cab was implemented. In addition, the taxi services operated under Leduc Yellow and Sherwood were integrated into the Yellow Cab mobile application. In April 2017, the mobile software applications for Capital Taxi and 24-7 Taxi were implemented (para 17).

[18] Mr. Strong states that on average, the Opponent conducts a total of between 228,000 and 310,000 trips per month, depending on the season and state of the economy. Mr. Strong states that the TAPP YOUR RIDE trademark is used in the advertising of the mobile software application on the Opponent's website, and that "accordingly, the mobile software applications are a material component of the Opponent's business" (para 18).

Display of the Opponent's TAPP YOUR CAB trademark

[19] Mr. Strong states that in order to build awareness of its mobile application services, the Opponent advertises in popular travel publications such as EDMONTON TRAVEL GUIDE and WHERE EDMONTON published by Tanner Young Publishing Group (Tanner Young) (para 19).

[20] Exhibit B is an excerpt from the January/February 2015 issue of WHERE EDMONTON containing the cover page and a page featuring an advertisement (shown below) displaying the TAPP YOUR CAB mark and information for downloading of the mobile applications for smart phones (para 20). Mr. Strong states that copies of this issue were distributed to hotels, restaurants and retailers, galleries, attractions and visitor information centers (para 20).



[21] Mr. Strong states that the WHERE EDMONTON publication is published every two months, and that the TAPP YOUR CAB mark has been advertised in at least nine issues of the publication (para 21). Mr. Strong also provides distribution information for the publication, which appears to be taken from an excerpt of a WHERE EDMONTON media kit dated 2017 (para 22, Exhibit C).

[22] The same advertisement also appears in the "Edmonton Travel Guide 2015". Exhibit D contains the cover page of this publication and a copy of the page featuring the advertisement. Mr. Strong advises that copies of the Edmonton Travel Guide for 2015 (which subsequently

changed to the Edmonton City Guide) were distributed to over 400 locations across four provinces including Alberta, British Columbia, Saskatchewan and Manitoba (para 23). Exhibit E is described as an excerpt from the (undated) Tanner Young media kit showing the distribution of the Edmonton Travel Guide in Western Canada and the USA (para 24).

Display of the Opponent's TAPP YOUR RIDE trademark

[23] Mr. Strong states that since October 2015, the Opponent has distributed over 2,000 brochures bearing the TAPP YOUR RIDE mark to its customers; Exhibit F contains copies of two such brochures. I note that the brochure is similar to the TAPP YOUR CAB advertisement shown above in that the TAPP YOUR RIDE mark is shown in close proximity to various of the Opponent's taxi brands (Barrel Taxi and Yellow Cab, respectively). Mr. Strong states that in March 2016, an additional 2,000 brochures were received and distributed to the Opponent's "preferred customers" (para 25).

[24] Mr. Strong states that the TAPP YOUR RIDE trademark was printed on each receipt issued to customers using the Opponent's taxi cabs, and that the Opponent issues over 200,000 receipts each year to its customers (para 26).

[25] Mr. Strong states that in April 2017, the Opponent updated its mobile application and distributed an instruction sheet to its customers to update their mobile application. Exhibit G is a copy of this instruction sheet, which displays the TAPP YOUR RIDE trademark (para 27).

[26] Attached as Exhibit H are printouts, dated "8/10/2017" (August 10, 2017), from the Opponent's website (*www.edmtaxi.com*) displaying the TAPP YOUR RIDE trademark. The last page includes a ©2017 notation.

[27] Mr. Strong states that all staff communications to customers, suppliers, and anyone else, include the TAPP YOUR RIDE tag line as well as a link to the Opponent's website as part of their signatory line (para 29).

Advertising expenditures

[28] Mr. Strong provides estimated annual advertising expenditures in Canada in association with the Opponent's marks from 2014 – 2017 (July) (para 30).

The Applicant's Evidence

[29] In support of its application, the Applicant filed the affidavit of Jonathan L. Wescott, an owner, director, and co-founder of the Applicant (para 1, Wescott affidavit; Wescott cross-examination at p10, line 20). At the outset, I note that in reviewing this affidavit, I have disregarded those portions of the affidavit containing assertions by Mr. Wescott that amount to opinions on questions of fact and law to be determined by the Registrar. I have also disregarded statements in the affidavit that are essentially arguments on the merits of the opposition, for example, Mr. Wescott's assertions of no confusion (para 28) [*British Drug Houses Ltd v Battle Pharmaceuticals* (1944), 1944 CanLII 308 (FC), 4 CPR 48 at 53 and *Les Marchands Deco Inc v Society Chimique Laurentide Inc* (1984), 2 CPR (3d) 25 (TMOB)]. Pertinent portions of Mr. Wescott's affidavit, sworn December 11, 2017, are summarized below.

The TappCar Business

[30] Mr. Wescott states that in late 2014, he and his business partner set out to change the vehicle-for-hire industry by devising a new ride-sharing model that would offer convenient, reliable and safe service by featuring an industry-leading mobile application, in addition to phone and web booking capability, and drivers that are properly insured and professionally licensed, and can accept various forms of payment, including payment via the mobile application (the "TappCar Business") (para 4).

[31] Following the coming into force of the city of Edmonton's vehicle-for-hire bylaw in or about March 1, 2016, the Applicant officially launched the TappCar Business on March 14, 2016, in Edmonton, Alberta (paras 8-10). The TappCar Business was launched in Calgary, Alberta on May 24, 2016 (para 11).

Pre-official launch activities

[32] Mr. Wescott states that prior to the Applicant's registration as a corporation, he enlisted the services of a third party license and registry service provider to reserve the name TappCar Inc. for his use and to conduct a NUANS® corporate name and trademark search. On or about January 26, 2016, Mr. Wescott reviewed the search results and was satisfied that there were no corporate or trademark applications/registration that would prevent him from filing an application for the Mark (para 13; Exhibits G, H).

[33] Mr. Wescott states that on or about January 21, 2016, he engaged in at least one focus session with his team discussing ideas for a trademark for the TappCar Business. During the focus meetings, draft logo options (for the Tappcar trademark) were reviewed and top selections were chosen for further consideration (para 21). On cross-examination, in discussing the evolution of the Mark, Mr. Wescott noted that "Tyson or one of the other members of the team had suggested that utilizing the "APP" made a good play on words" (p.33, line 9).

[34] Ms. Wescott states that the Applicant began the process of advertising for drivers in or around February 2016 (para 14). In a further effort to attract qualified drivers, the Applicant invited the Teamsters Local Union 987 of Alberta Miscellaneous Employees to unionize the Applicant's future drivers (para 15). In the days leading up to the official launch, driver training sessions were also held, commencing on March 6 and 7, 2016, at the Teamsters Union office (para 17).

The mobile application

[35] Mr. Wescott states that prior to the official launch, on or about March 9, 2016, the Applicant made its free downloadable mobile app available to customers through Google Play, and the Apple App Store soon followed (the TappCar App). The TappCar App allowed customers to book a ride using the Applicant's state of the art technology through the customer's cell phone, website, or by calling the Applicant's call center (para 22, Exhibit N, O).

Promotion of the TappCar Business

[36] Mr. Wescott states that the Applicant has engaged in extensive marketing and promotion of the TappCar Business. In particular, the Applicant:

- has distributed written communications, displaying the Mark, directed to the Edmonton non-profit community (Exhibit F);
- entered into partnerships with a number of local professional sports teams to become their official transportation provider (para 24);
- entered into an agreement with the Edmonton International Airport (EIA) to allow the Applicant's customers to utilize the TappCar app or its phone dispatch service to seek transportation to and from EIA (para 25);
- further advertised the TappCar Business through social media platforms including Facebook (para 26, Exhibit R).
- Exhibit T contains copies of invoices, services agreements, advertising proposals, and a media plan associated with the Applicant's advertising efforts (para 31). These materials are in the timeframe of February-March 2016 (Wescott cross, pages 36-37).

Undertakings requested during the cross-examination on the Wescott affidavit

[37] By letter dated June 22, 2018, the Applicant responded to the request for undertakings made during the Wescott cross-examination. The Applicant refused to provide responses to three of the four requested undertakings, listed below "on the basis of relevance". The Opponent submits that an adverse inference ought to be drawn as these undertakings relate to issues including the Applicant's entitlement to use and use of the Mark:

- To provide the number of employees working for the Applicant in 2016, 2017 and 2018;
- to provide a copy of the agreement with the Edmonton International Airport referenced at para 25 of the Wescott affidavit;
- to provide particulars of the allegations of illegality and fraud that has been alleged that para 7 of the Wescott affidavit.

[38] I note that answers to these undertakings would not have figured into my analysis of the entitlement ground as they primarily relate to use of the Applicant's Mark, and the application is based on proposed use. As a result, I do not consider it to be appropriate for an adverse inference

to be drawn. Likewise, I have not considered Mr. Wescott's assertions relating to fraud and the taxi industry in my analysis.

LEGAL ONUS AND EVIDENTIAL BURDEN

[39] As previously mentioned, before considering the grounds of opposition, it is necessary to review some of the technical requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[40] With respect to (i) above, there is, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Limited v The Molson Companies Limited*, 1990 CanLII 11059 (FC), 30 CPR (3d) 293 at 298 (FCTD)]. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on the applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent in the statement of opposition (for those allegations for which an opponent has met its evidential burden). The presence of a legal onus on an applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against an applicant.

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 16(3)(a) ground of opposition

[41] The section 16(3)(a) ground of opposition alleges that the Applicant is not the person entitled to register the Mark because the Mark "is and was at the time of filing any relevant date, confusing within the meaning of Section 6 of the Act" with the Opponent's marks (set out in Schedule A of this decision), all of which had been previously used and made known in Canada by the Opponent or its predecessors in title and licensees in association with the goods and services set out in Schedule B of this decision.

[42] At the outset, I note that the Opponent has not met the requirements for making known set out in section 5 of the Act since it has not evidenced that any of the Opponent's marks were used in another country of the Union, other than Canada. However, as discussed below, I find that the Opponent has provided sufficient evidence to satisfy the requirements for use in Canada of its trademarks TAPP YOUR CAB and TAPP YOUR RIDE (in word and design format) in association with taxi services.

[43] For this ground of opposition, there is an initial burden on the Opponent to show use of one or more of the Opponent's marks prior to the material date, January 26, 2016 (the filing date of the subject application), and that it had not abandoned its trademarks as of September 7, 2016, the date of advertisement of the Applicant's application [section 16(5) of the Act]. Section 4 of the Act, part of which is reproduced below, explains what is required in order for a trademark to have been used in association with goods and services:

> 4(1) A trademark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.
>
> (2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[44] With respect to use in association with services, it has been established that section 4(2) of the Act may be complied with if it is shown that the trademark owner is offering and is prepared to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

<u>The Opponent meets its initial onus for the ground of opposition under section 16(3)(a) for the trademarks TAPP YOUR CAB and TAPP YOUR RIDE</u>

Prior use of TAPP YOUR CAB with taxi services

[45] I find that the Opponent meets its initial burden in that the Strong affidavit shows the Opponent displayed this trademark in the advertising of the Opponent's taxi services prior to the material date of January 26, 2016. In particular, the TAPP YOUR CAB mark prominently appears in the advertisement (reproduced above in paragraph 20 of this decision) in the

January/February 2015 issue of WHERE EDMONTON (Exhibit B, Strong affidavit). The same advertisement also appears in the "Edmonton Travel Guide 2015" (Exhibit D).

[46] The evidence also indicates that the Opponent's taxi services were available to be performed in Canada prior to the material date of January 26, 2016. Mr. Strong states that on average, the Opponent conducts a total of between 228,000 and 310,000 trips per month, depending on the season and state of the economy, however it is unclear whether these statistics applied as of the material date. There is nothing in the evidence to suggest that the Opponent had abandoned its trademark as of September 7, 2016. Accordingly, I find that the Opponent has shown the requisite use, in association with taxi services, allowing it to meet its burden under this ground.

[47] In its written argument, the Applicant submits that TAPP YOUR CAB is not being used in association with any of the Opponent's services (enumerated in Schedule B), given that "the Opponent's purported mark TAPP YOUR CAB is not being used to advertise any of the Opponent's services, as would be required in order to establish use under section 4(2) of the Act". With respect to use under section 4(1) of the Act, the Applicant submits that the Opponent is attempting to use TAPP YOUR CAB to advertise the application referred to as the "YELLOW CAB App", however this "does not and cannot constitute use of the purported mark TAPP YOUR CAB in association with the Opponent's mobile application and any of the goods listed in the Opponent's trademark applications… in light of how "use" under section 4(1) of the Act is defined".

[48] I agree that the advertisement in Exhibit B does not constitute use by the Opponent of the TAPP YOUR CAB trademark in association with its mobile application (or for that matter, any goods), since there is no indication that, at the time of transfer, in the normal course of trade, that it was marked on the mobile application (or any other goods) or on the packages in which they were distributed or were in any other way so associated with the goods so as to provide the requisite notice of association. However, I find the advertisement in Exhibit B (and D) is being used to advertise the Opponent's taxi services, even though the advertisement also advertises the Opponent's Yellow Cab app. There is no reason why this advertisement cannot also be considered to promote the Opponent's taxi services, particularly since prospective customers

would use the app as one way to access the taxi services. Further, there is also no restriction against multiple trademarks (in this case, YELLOW CAB and TAPP YOUR CAB being used together in association with the same product or services [*AW Allen Ltd v Warner Lambert Canada Inc* (1985), 6 CPR (3d) 270 at 272 (FCTD)].

[49] On cross-examination, Mr. Wescott characterizes TAPP YOUR CAB as a "nice rhyming slogan" rather than as a trademark (page 38). In this regard, I note that the fact that the Mark may be displayed or used as a slogan does not necessarily mean that it cannot be used as a trademark [*Valeo Electrical Systems, Inc v Pennzoil-Quaker State Company*, 2011 TMOB 90]. To the extent that the Mark as it appears in the advertisement is a slogan, I find that it is also used as a trademark, as discussed above.

Prior use of TAPP YOUR RIDE with taxi services

[50] I find that the Opponent meets its initial burden in that the Strong affidavit shows the Opponent displayed this trademark in the advertising of the Opponent's taxi services prior to the material date of January 26, 2016. In particular, the TAPP YOUR RIDE mark is prominently displayed on brochures distributed to customers since October 2015 (Exhibit F, para 25). I make this finding notwithstanding that Mr. Strong does not indicate how many brochures were distributed prior to January 2016.

[51] As with the advertisements in Exhibits B and D, the TAPP YOUR RIDE advertisements at Exhibit F include other trademarks of the Opponent (YELLOW CAB and BARREL TAXI), and also promote the Opponent's mobile applications to order taxi services. As noted above, I find there is no reason why this advertisement cannot simultaneously be considered to promote the Opponent's taxi services, particularly since prospective consumers would use the app as one way to access taxi services. Further, there is also no restriction against the use of more than one mark (for example, YELLOW CAB and TAPP YOUR RIDE) being used together in association with the same product or services [*AW Allen Ltd supra*].

No evidence of prior use of TAPP

[52] The Opponent fails to meet its initial burden in respect of the trademark TAPP as this trademark does not appear in the Strong affidavit. In making this finding, I do not consider the inclusion of the element TAPP in the trademarks TAPP YOUR CAB and TAPP YOUR RIDE to constitute use of the TAPP mark as I do not consider that the public would perceive the mark TAPP *per se* being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)].

Test to determine confusion

[53] As I am satisfied that the Opponent has met its evidential burden under the section 16(3)(a) ground of opposition with respect to the trademarks TAPP YOUR CAB and TAPP YOUR RIDE in association with taxi services, I must now determine whether the Applicant has met its onus of proving no reasonable likelihood of confusion on a balance of probabilities.

[54] In considering the issue of confusion, I will focus on the Opponent's trademark TAPP YOUR CAB as in my view it represents the Opponent's strongest case. That is, if the Opponent is not successful with this mark, it would not achieve a more favorable result with the TAPP YOUR RIDE trademark.

[55] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold or leased by the same person, whether or not the goods or services are of the same general class or appear in the same Nice Class. In making such an assessment, I must consider all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them. In *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, [2006] 1 SCR 824 at para 20, the Supreme Court of Canada set out how the test is to be applied:

> The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [mark] at a time when he or she has no more than an imperfect recollection of the [prior] trademarks and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[56] The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 (SCC) at para 54. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* 2011 SCC 27 at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

[57] Finally, section 6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another. In the instant case, the question posed by section 6(2) is whether purchasers of the Applicant's Goods and Services, provided under the Mark, would believe that those Goods and Services were being provided by the Opponent, or that the Applicant was authorized or licensed by the Opponent.

Inherent distinctiveness of the trademarks

[58] The Mark is a coined word in which the intentionally misspelled element TAPP is combined with the word CAR. The Opponent's Mark is a phrase beginning with the misspelled element TAPP coupled with the words YOUR CAB. In both of the parties' trademarks, I consider the element TAPP to combine and represent the words "TAP" and "APP", short for "application" in the context of an application downloaded by a user to a mobile device.

[59] I find that the Opponent's mark and the Mark both possess a limited degree of inherent distinctiveness as the trademarks are highly suggestive of goods and services related to the acquisition of transportation services (by car or cab) through a mobile application (*ie*, through the tap of an app).

Extent known and length of time in use

[60] The Strong affidavit establishes that the TAPP YOUR CAB mark appeared in the January/February 2015 issue of the WHERE EDMONTON magazine; the same advertisement also appeared in the 2015 EDMONTON TRAVEL GUIDE (Exhibits B and D, respectively).

While Mr. Strong provides information relating to the distribution and circulation of the WHERE publication by submitting a copy of the magazine's media kit, it is from 2017 and so falls outside the material date. Mr. Strong also indicates that the TAPP YOUR CAB mark has been advertised in at least 9 issues of the publication, but does not indicate the dates of these issues. Likewise, distribution information for the EDMONTON TRAVEL GUIDE is provided via an excerpt from the Tanner Young Publishing Group media kit (Exhibit E), however this document is undated and cannot be assumed to apply to the relevant period. Mr. Strong also provides annual estimated amounts for advertising in Canada in association with the Opponent's marks between 2014 – July 2017, however, without more information, such as the amount attributable to the TAPP YOUR CAB mark and reference to any other forms of advertisement, this information is not particularly helpful. In any event, only the 2015 advertising expenditures (of approximately $21,500) would apply in view of the material date.

[61] The Applicant's Mark is based on proposed use in association with the Goods and Services. While evidence relating to use of the Mark is provided in the Wescott affidavit, none of it had occurred by the material date with the result that I am unable to consider it.

[62] Accordingly, these factors favour the Opponent, albeit only slightly.

Nature of the goods, services, or business, and trade

[63] The Applicant submits that the nature of the Applicant's Goods and Services and the TappCar Business are not confusing for several reasons, including that:

- the Applicant's drivers use, almost exclusively, their own vehicles;
- the Applicant and the TappCar Business are not subject to regulations requiring top lighting on vehicles, shields, panic buttons, and approval of taxi color;
- the Applicant provides a health plan to its drivers.

[64] The Applicant further submits that, contrary to the Opponent, its business model is grounded in innovation and the use of state of the art technology, as the TappCar app has been available to the Applicant's customers for download since the official launch of the TappCar

Business. The Applicant submits that the Applicant's Goods and Services are not destined for the same customers and are thus not likely to be distributed in the same market niches.

[65] At the outset, I note that the Goods and Services in the application are not restricted in any way. Accordingly, notwithstanding any of these differences, I consider the parties' goods, services, and business to be sufficiently related such that this factor favours the Opponent. In particular, I find there to be direct overlap with the Applicant's listed "taxi services" and the Opponent's taxi services. I also consider there to be some overlap in the nature of the remaining Services and the Goods and the Opponent's taxi services insofar as they both relate to the provision of transportation (by car) services.

[66] To the extent that the Applicant's business model is "innovation-based" and would appeal to customers that prefer to employ newer technologies to order their car transportation/taxi services, the Opponent's evidence establishes that it also offers newer technologies, namely a mobile application, for customers to order its taxi services, which could be used by those customers with a preference for newer technologies.

Degree of resemblance

[67] The preferable approach when comparing trademarks is to begin by determining whether there is an aspect of the marks that is particularly striking or unique [*Masterpiece, supra* at para 64]. In the present case, I find the most striking element of the Opponent's trademark to be the prefix TAPP given that the word CAB is descriptive of the Opponent's taxi services. The element YOUR is simply a pronoun that helps to form the phrase.

[68] Similarly, with respect to the Mark, I find the most striking element to be the prefix TAPP, given that the word CAR is similarly descriptive of the Applicant's taxi and transportation services, and suggestive of the character of the Applicant's computer software insofar as it is relates to the coordination of transportation by car.

[69] Accordingly, I find that there is a significant degree of resemblance between the parties' marks as the most striking element in both marks is identical. The striking element also appears as the first element of both marks, and it is often the first portion of a trademark that is usually

considered more important for assessing the likelihood of confusion [*Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD) at 188].

[70] With respect to the ideas suggested, I find that both of the parties' trademarks include a "play on words" as they suggest the "tap" of an "app" (application) to obtain car transportation services. However, there can be no monopoly in this idea [*American Assn of Retired Persons v Canadian Assn of Retired Persons/Assoc Canadienne des Individus Retraites* (1998), 84 CPR (3d) 198 at para 34 (FCTD)]. At the hearing, the Applicant argued that the Mark is a single word used as a noun, therefore referring to a 'thing', whereas the Opponent's trademark employs TAPP as a verb, with the result that, when taken as a whole, the trademarks clearly have different connotations. However, I do not consider this difference (use as a noun or a verb) to meaningfully affect the overall ideas suggested by the parties' marks.

Surrounding circumstance – no evidence of actual confusion

[71] At the hearing, the Applicant pointed to Mr. Wescott's statement that "in the two years plus of (the Applicant's operation), we've not had one instance or complaint of anybody being confused between any taxi service, including the opponent, and our service" (Wescott cross, page 35, lines 24-28).

[72] However, I am unable to consider this evidence as it postdates the material date and is not intrinsically connected with facts occurring at the material date [*Servicemaster Co v 385229 Ontario Ltd* 2015 FCA 114 at paras 21-22].

Conclusion

[73] Having considered all of the surrounding circumstances, and in particular the high degree of resemblance between the trademarks, and the fact that the Applicant's Goods and Services and the Opponent's taxi services are related, I find that at best the probability of confusion between the Mark and the Opponent's trademark TAPP YOUR CAB is evenly balanced between a finding of confusion and no confusion. As the onus is on the Applicant to demonstrate on a balance of probabilities that there is no reasonable likelihood of confusion between the marks, I must therefore find against the Applicant.

[74] Accordingly, the section 16(3)(a) ground of opposition is successful.

Section 2 ground of opposition

[75] The Opponent alleges that Mark is not distinctive within the meaning of section 2 of the Act, in that it does not actually distinguish, nor is it adapted to distinguish nor is it capable of distinguishing, the goods and services of the Applicant from the goods and services in association with which the Opponent's marks (set out in Schedule A) have been used in Canada.

[76] In order to meet its evidential burden with respect to this ground, the Opponent must show that as of the date of filing of the opposition (February 6, 2017), the Opponent's marks had become known in Canada sufficiently to negate the distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD) at 58].

[77] I am not satisfied that the Opponent has met its initial burden in respect of this ground of opposition for its TAPP YOUR CAB, TAPP YOUR RIDE, or TAPP trademarks (in word or design format). With respect to the trademark TAPP YOUR CAB, I have had regard to the fact that the sole advertisement displaying the trademark appears exclusively in publications from 2015, specifically WHERE EDMONTON and the Edmonton Travel Guide (2015). Regarding the WHERE EDMONTON publication, while the evidence indicates that TAPP YOUR CAB has been advertised in at least nine issues of the magazine, the dates of publication are not provided, with the result that it is unclear whether the advertisement appeared in any issues of the publication in or by early 2017. For the Edmonton Travel Guide/ Edmonton City Guide, there is no indication that advertisements bearing the TAPP YOUR CAB appeared in any issue beyond 2015.

[78] With respect to the trademark TAPP YOUR RIDE, the Opponent has provided evidence of brochures displaying the trademark, and indicates that since October 2015, the Opponent has distributed over 2,000 brochures to customers, with an additional 2,000 brochures distributed to preferred customers in March 2016. However, there is no indication of additional brochures distributed after March 2016. While Mr. Strong states that the trademark "was printed on each receipt issued to customers using the Opponent's taxi cabs", and that the Opponent issues over 200,000 receipts yearly, it is unclear when this practice began, and in any event, no

representative samples are provided showing how the trademark appeared on the invoices, such that I am unable to determine if this would constitute use under section 4(2) of the Act. The Opponent also indicates that the TAPP YOUR RIDE trademark is used in the advertising of the mobile software application on the Opponent's website (Strong affidavit, para 18). While a copy of the Opponent's website is provided (Exhibit H), the printout (dated 8/10/2017) post-dates the material date, and is not identified as being representative as of the material date. Further, there is no indication of the number of consumers that may have accessed the website. The mobile application instruction sheet (Exhibit G, Strong affidavit) displaying the trademark was distributed to customers in April 2017, which falls outside the relevant period. I have also had little regard to the Opponent's statements regarding the inclusion of the trademark on signatory lines in staff communications since it is unclear when this practice began. Finally, while estimated advertising expenditures for 2014 – July 2017 are provided, the Opponent does not indicate what proportion is attributable to which marks and the corresponding goods and/or services they apply to. Based on the foregoing, I find that the evidence falls short of establishing that the trademark was sufficiently known as of the material date.

[79] With respect to the trademark TAPP, as discussed above in my analysis of the non-entitlement ground of opposition, I do not find that the Opponent has provided any use of the trademark TAPP *per se* at any of the material dates.

[80] Accordingly, this ground of opposition is rejected on the basis that the Opponent has not met its evidential burden.

Section 30(i) ground of opposition

[81] The section 30(i) ground of opposition alleges that the application does not conform to the requirements of section 30 of the Act in view of the prohibition against the provision of such services without lawful authorization, registration and licenses, including without limitation, driver's license for such purposes, vehicle license for such purpose, dispatcher's license for such purposes and the *Vehicle for Hire Bylaw 17400* (effective March 1, 2016) made under sections 7 & 8 under the *Municipal Government Act*, RSA 2000, c. M-26. The Opponent further alleges that the application does not conform to the requirements of section 30 of the Act because the

Applicant could not have been satisfied of its entitlement to use the Mark in Canada in association with the Goods and Services in view of the prior use by the Opponent of the Opponent's marks, of which the Applicant was, or should have been, aware.

[82] The material date to assess this issue is the filing date of the application for the mark [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB)].

[83] Where an applicant has provided the statement required by section 30(i) of the Act, a ground of opposition under section 30(i) should only succeed in exceptional circumstances such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB)] or where there is a *prima facie* case of violation of a piece of federal legislation [*Interprovincial Lottery Corp v Monetary Capital Corp* (2006), 51 CPR (4th) 447 (TMOB); and *Interactive Design Pty Ltd v Grafton-Fraser Inc* (1998), 87 CPR (3d) 537 (TMOB)].

[84] As the *Municipal Government Act* cited by the Opponent is not federal legislation, an allegation of non-compliance with this legislation does not form an appropriate basis for a section 30(i) ground of opposition [*Interprovincial Lottery, supra; Canadian Council of Professional Engineers v Lubrication Engineers Inc* (1992), 41 CPR (3d) 243 (FCA), at 244].

[85] With respect to the second prong advanced under the section 30(i) ground, even assuming that the Applicant was aware of the Opponent's marks, the mere knowledge of their existence does not in and of itself support an allegation that the Applicant could not have been satisfied of its entitlement to use the Mark [*Woot Inc v Woot Restaurants Inc/Les Restaurants Woot Inc*, 2012 TMOB 197 (CanLII)]. In this case, the Applicant has provided the necessary statement and this is not an exceptional case.

[86] Accordingly, the grounds of opposition under section 30(i) are summarily dismissed.

DISPOSITION

[87] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

Jennifer Galeano
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD

HEARING DATE 2020-09-22

APPEARANCES

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AGENT OF RECORD

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SCHEDULE A – THE OPPONENT'S MARKS

Trademark	App. No.	Filing Date	Date of Use for Goods & Services in Schedule B
tapp your ride	1,775,082	2016-03-31	2015-01-19 for goods described in (1) and on services described in (1), (2), (3), (4), (5), (6)
TAPP YOUR RIDE	1,774,035	2016-03-24	2015-01-19 for goods described in (1) and on services described in (1), (2), (3), (4), (5), (6)
tapp your cab	1,775,083	2016-03-31	2015-01-19 for goods described in (1) and on services described in (1), (2), (3), (4), (5), (6)
TAPP YOUR CAB	1,774,033	2016-03-24	2015-01-19 for goods described in (1) and on services described in (1), (2), (3), (4), (5), (6)
tapp	1,775,081	2016-03-31	2015-01-19 for goods described in (1) and on services described in (1), (2), (3), (4), (5), (6)
TAPP	1,773,813	2016-03-23	2015-01-19 for goods described in (1) and on services described in (1), (2), (3), (4), (5), (6)
tapp your ride (with colour claim)	1,774,034	2016-03-24	2015-01-19 for goods described in (1) and on services described in (1), (2), (3), (4), (5), (6)
tapp your cab (with colour claim)	1,774,031	2016-03-24	2015-01-19 for goods described in (1) and on services described in (1), (2), (3), (4), (5), (6)
tapp (with colour claim)	1,774,032	2016-03-24	2015-01-19 for goods described in (1) and on services described in (1), (2), (3), (4), (5), (6)

SCHEDULE B

Identified in the statement of opposition as **"Opponent's prior use of goods and services with the Opponent's marks"**

Goods:

(1) Computer software for navigation; computer software for coordinating transportation services, namely, software for the scheduling and dispatch of motorized vehicles; computer software for obtaining, arranging and booking transportation services; computer software for coordinating and obtaining delivery services; mobile application software for coordinating transportation services namely, software for the automated scheduling and dispatch of motorized vehicles; mobile application software for navigation; mobile application software for obtaining, arranging and booking transportation services; mobile application software for coordinating and obtaining delivery services; computer software; downloadable software;

Services:

(1) Telecommunications services, namely, routing calls, SMS and text messages, and push-notifications to customers and to vehicle operators in the vicinity of the caller using mobile phones; electronic transmission of data; telecommunications;
(2) Providing a website featuring information regarding transportation services, bookings for transportation services, information regarding delivery services and bookings for delivery of goods, airport procedures, documents, packages and cargo; transportation logistics services; coordinating and arranging transportation services; packaging and storage of goods; delivery of goods, documents, packages and cargo; food delivery; courier services;
(3) Providing temporary use of online non-downloadable software for providing transportation services, bookings for transportation services and for dispatching motorized vehicles to customers, and for coordinating and obtaining delivery services; design and development of computer hardware and software;
(4) Taxi services; courier services; limousine services; assisted transportation of passengers with physical disabilities and special medical needs by motor vehicle; passenger motor vehicle charter transportation, namely sedans, shuttle vans, taxis, wheel chair and physically disabled accessible vehicles; designated driving services, namely meeting customers at predetermined locations and driving them to their destinations in their own vehicles;
(5) Operation for hire of taxis, point to point shuttles and busses, taxicabs and other motor vehicles for the conveyance of passengers and goods; operation of taxi stands and taxicab dispatch services; and
(6) Financial services, namely, providing credit card services for customers of taxicabs, delivery transports and other motorized vehicles; taxi and delivery transports and other motorized vehicles; taxi and delivery transport transaction processing services; gift cards, vouchers and corporate charge slips.