

O P I C



C I P O

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 155

Date of Decision: 2021-01-27

IN THE MATTER OF AN OPPOSITION

Kayak Software Corporation	Opponent
and	
Kayak Creative Services Inc.	Applicant
1,697,381 for KAYAK & Design	Application

INTRODUCTION

[1] Kayak Software Corporation (the Opponent) opposes registration of the trademark KAYAK & Design (the Mark), which is the subject of application No. 1,697,381 by Kayak Creative Services Inc. (the Applicant). The Mark is shown below:



[2] The Mark is applied for in association with the following goods and services:

Goods: Online publications in the field of marketing.

Services: Online and inbound marketing services, namely, business marketing consulting and training services, content marketing services, developing marketing strategies and marketing concepts for others, marketing creation and analysis services and search optimization services for others; website design and website development for others.

[3] The opposition is based on allegations that the application does not conform to the requirements of section 30 of the *Trademarks Act* (the Act) and that the Mark is confusing with the Opponent's KAYAK trademarks, previously registered or used in Canada in association with similar services.

THE RECORD

[4] The application for the Mark was filed on October 9, 2014 on the basis of use in Canada since at least as early as 2011.

[5] The application was advertised for opposition purposes on July 8, 2015. Numerous amendments to the Act came into force on June 17, 2019. As the application was advertised prior to June 17, 2019, pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read immediately before that date, an exception being that, with respect to confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[6] On December 4, 2015, the Opponent opposed the application by filing a statement of opposition under section 38 of the Act. The grounds of opposition are based on sections 30(a), 30(b), 30(i), 12(1)(d), 16(1)(a), 16(1)(c) and 2 of the Act. The Applicant submitted a counter statement denying each of those grounds.

[7] In support of its opposition, the Opponent filed certified copies of nine of its trademark registrations as well as the affidavit of Stephanie Retcho, sworn July 8, 2016 in Stamford, Connecticut [the Retcho Affidavit]. Ms. Retcho was not cross-examined.

[8] In support of its application, the Applicant filed the affidavit of Randy Milanovic, sworn November 9, 2016 in Calgary, Alberta. Mr. Milanovic was cross-examined on his affidavit and the transcript and related undertakings were made of record.

[9] Both parties submitted written representations and attended an oral hearing.

[10] Before assessing the grounds of opposition, I will first provide an overview of the parties' evidence, the evidential burden on the Opponent, and the legal onus on the Applicant.

OVERVIEW OF THE OPPONENT'S EVIDENCE

Certified Copies of the Opponent's Registrations

[11] Two of the certified copies (TMA801,142 and TMA855,352) are for the trademark K & Design, shown below:



[12] In view of the evidence as a whole and the submissions of the parties, I do not consider it necessary to discuss these two registrations further.

[13] The remaining registrations (the Opponent's KAYAK Trademarks) are as follows:

- TMA724,197 for KAYAK, registered in September 2008 in association with “computer software for providing geographic maps, travel route information and recommendations, and travel information guides” and a variety of travel-related online services, discussed further below.
- TMA724,199 for KAYAKNETWORK.COM, registered in September 2008 in association with “Advertising services, namely dissemination of advertising for others via the Internet; providing advertising space and rental of advertising space on the Internet”.
- TMA724,804 for KAYAK.COM, registered in September 2008 in association with “Computer software for providing geographic maps, travel route information and recommendations, and travel information guides” and “Providing on-line information, namely, schedules, listings, reviews, postings, and locations in the field of entertainment”.
- TMA770,861 for KAYAK.COM, registered in June 2010 in association with various online location and travel-related services.

- TMA826,222 for KAYAK & Design (shown below), registered in June 2012 in association with various online travel-related services.



- TMA855,342 for KAYAK & Design (same as above but with a colour claim), registered in July 2013 in association with various online travel-related services.

Retcho Affidavit

[14] Ms. Retcho is a Senior Vice-President with the Opponent. She describes the Opponent as “a leading metasearch provider in the field of online technology travel services” [para 4]. The Retcho Affidavit describes the use of the Opponent’s KAYAK trademarks and trade name in Canada [paras 4 to 11], primarily via a website and mobile applications that “allow users to research and compare fares, rates and a variety of other travel related information collected from numerous travel and travel-related websites” and complete purchases accordingly [para 5]. In particular, the Retcho Affidavit also describes the Opponent’s Canadian users [para 6], revenues [paras 7 to 10], and advertising [paras 11 and 12].

[15] Ms. Retcho also opines on the likelihood of confusion with respect to the Mark [paras 13 and 15] and notes that the Applicant’s website, *kayakonlinemarketing.com*, did not become active until late 2012 [para 14].

OVERVIEW OF THE APPLICANT’S EVIDENCE

Milanovic Affidavit

[16] Mr. Milanovic is the Chief Executive Officer of the Applicant. He identifies the Applicant as a Calgary-based company, incorporated in May 2011, that is “a leading provider of online marketing, web and search optimization services, focusing on helping clients generate well-qualified leads with a unique optimized website design approach” [para 3]. Mr. Milanovic states that, as a cancer survivor, kayaking played a key role in his recovery and that the Mark (intended to suggest the paddle of a kayak) was inspired by his personal experience [para 6].

[17] The Milanovic Affidavit provides examples of use of the Mark [paras 7 to 11], including advertising [para 7, Exhibit B], publications [para 8, Exhibit C], example invoices [para 9, Exhibit D], and screen shots of the Applicant's website [para 11, Exhibit E]. Mr. Milanovic asserts that the Applicant spends an average of \$300,000 annually on marketing the applied-for goods and services in association with the Mark [para 10].

[18] Relevant portions of the cross-examination of Mr. Milanovic will be discussed below.

EVIDENTIAL BURDEN AND LEGAL ONUS

[19] Before considering the grounds of opposition, it is necessary to review the basic 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.

[20] With respect to (i), in accordance with the usual rules of evidence, there is an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd*, 1990 CarswellNat 1053, 30 CPR (3d) 293 (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.

[21] With respect to (ii), 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 the 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 has been considered, then the issue must be decided against the applicant.

SECTION 30(A) GROUND OF OPPOSITION - APPLICATION REQUIREMENTS

[22] The Opponent pleads that the application does not comply with the requirements of section 30(a) of the Act as the description of goods and services does not meet the requisite degree of specificity nor does it comprise ordinary commercial terminology. As a consequence, the Opponent pleads that a comparison of the similarity in goods, services, businesses and possible channels of trade of the parties is not possible.

[23] However, the Opponent led no evidence and made no substantive representations in support of this ground of opposition. Accordingly, the ground of opposition based on section 30(a) of the Act is rejected.

SECTION 30(B) GROUND OF OPPOSITION – APPLICATION REQUIREMENTS

[24] The Opponent pleads that the application does not comply with section 30(b) of the Act, in that the Applicant had not used the Mark in association with the applied-for goods and services continuously and/or at all since the claimed date of first use, namely since at least as early as 2011.

[25] With respect to a ground of opposition based on section 30(b) of the Act, to the extent that the relevant facts are more readily available to the applicant, the evidential burden on an opponent is not onerous [*Tune Master v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. While an opponent can meet its initial burden by reference to its own evidence, its burden can in some cases be met with reference to the applicant's evidence [*Molson Canada v Anheuser-Busch Inc*, 2003 FC 1287, 29 CPR (4th) 315; *Corporativo de Marcas GJB, SA De CV v Bacardi & Company Ltd*, 2014 FC 323], and an opponent can rely upon cross-examination of an applicant's affiant to meet the evidential burden upon it [see *Coca-Cola Ltd v Compagnie Francaise de Commerce International Cofci, SA* (1991), 35 CPR (3d) 406 (TMOB)]. However, it has been held that, in order to do so, the opponent must show that the evidence is "clearly inconsistent" with the claims set forth in the application [see *Ivy Lea Shirt Co v 1227624 Ontario Ltd* (1999), 2 CPR (4th) 562 (TMOB), *aff'd* 2001 FCT 252, 11 CPR (4th) 489 (FCTD)].

[26] In this case, the Opponent's evidence consists of search results from the Wayback Machine at www.archive.org to show that the Applicant's website, kayakonlinemarketing.com "did not become active until late 2012" [Retcho Affidavit, para 14]. The Opponent submits that this evidence is sufficient to meet its light burden to cast doubt on the validity of the Applicant's claim to use of the Mark in association with the applied-for goods since the 2011 date claimed.

[27] However, while the applied-for goods and services are online in nature, as Ms. Retcho's search was limited to the Applicant's "current" website address only and there was no apparent

effort made to assess whether the services were offered otherwise (*e.g.* through a different website), I do not find that the Opponent's evidence meets its initial burden.

[28] Furthermore, I agree with the Applicant that nothing in the Applicant's evidence or in the cross-examination of Mr. Milanovic is clearly inconsistent with the claimed date of first use. Indeed, Mr. Milanovic confirms that the Applicant operated through another website, *kayakcreative.ca*, in 2011, consistent with the claimed date [Undertakings 1 and 2]. Accordingly, I decline to draw any negative inferences regarding any refused or allegedly incomplete undertakings, given that the Applicant was under no obligation to evidence its claimed date of first use in this case.

[29] Accordingly, the ground of opposition based on section 30(b) of the Act is rejected.

12(1)(D) GROUND OF OPPOSITION – CONFUSION WITH A REGISTERED TRADEMARK

[30] The Opponent pleads that the Mark is not registrable pursuant to section 12(1)(d) of the Act since it is confusing with the Opponent's registered trademarks. A schedule attached to the statement of opposition gives the particulars of nine trademark registrations owned by the Opponent, including the Opponent's seven KAYAK Trademarks, identified above.

[31] I have exercised my discretion to check the register and confirm that these registrations remain extant [see *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. As such, the Opponent meets its initial burden under this ground.

[32] In this case, I note that the nature of the Opponent's KAYAK Trademarks and the supporting evidence necessarily results in some overlap in the analysis and consideration of the surrounding circumstances with respect to each registration. However, I will focus the analysis on the Opponent's registration for KAYAK (TMA724,197), registered in September 2008 in association with the following goods and services:

Goods: Computer software for providing geographic maps, travel route information and recommendations, and travel information guides.

Services: Providing on-line price comparisons of travel and lodging services; online referral services in the travel community; a searchable directory of travel information for obtaining data and information from others via the Internet; providing on-line

information to others, namely advertisements or solicitations for others; providing on-line chat rooms and on-line bulletin boards for transmission of messages among computer users in the travel community; providing multi-user access to an interactive global computer information network in the field of travel information; providing travel information over global computer networks, namely providing search services for travel listings, travel information and related topics, and for making reservations and bookings for transportation; providing on-line information, namely, schedules, listings, reviews, postings or locations in the field of entertainment; providing on-line publications in the nature of guides and directories featuring schedules, listings, advertisements for others, reviews, postings, locations or solicitations for use by travelers available electronically via computer networks, global information networks and wireless networks; providing an Internet search engine to assist travelers to locate and compare prices and ratings for travel reservations; travel agency services, namely, making reservations and booking for temporary lodging.

[33] Given the scope of the registered goods and services, I consider the registration of this word mark to represent the Opponent's strongest case.

Test to determine confusion

[34] The test to determine the issue of confusion is set out in section 6(2) of the Act, which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[35] 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 in association with the applied-for goods or services at a time when they have no more than an imperfect recollection of the Opponent's trademark and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[36] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: 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, 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.

[37] The criteria in section 6(5) of the Act 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, 1 SCR 772]. In *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 (*Masterpiece*), the Supreme Court of Canada stated that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis [at para 49] and that, while the first word in the trademark may be the most important in some cases, the preferable approach is to first consider whether there is an aspect of the trademark that is particularly “striking or unique” [at para 66].

Degree of Resemblance

[38] Notwithstanding the design elements of the Mark, including the backwards “K”, I find that there is strong resemblance between the parties’ trademarks in appearance, when sounded and in the ideas suggested by them. I note that, to the extent that KAYAK is common to the Mark and the Opponent’s KAYAK Trademarks, the Applicant largely concedes that the parties trademarks “are similar or may resemble each other visually and in sound” [Applicant’s written representations, page 11]. To the extent that the Mark differs visually or perhaps in the idea suggested when compared to some of the other Opponent’s KAYAK Trademarks, I consider such differences to be largely insignificant, in particular with respect to the Opponent’s KAYAK word mark.

[39] Accordingly, I find this important factor favours the Opponent.

Inherent Distinctiveness and the Extent Known; Length of Time in Use

[40] While the parties’ trademarks may be considered to have some suggestiveness of marketing or travel-related services involving kayaks or kayaking, I consider the parties’ trademarks to have an equivalent degree of inherent distinctiveness.

[41] In any event, there is clear evidence of use and reputation of the Opponent’s KAYAK trademark in Canada since 2004 [Retcho Affidavit, paras 5 to 12]. In particular, I note the

annual number of Canadian users of the Opponent’s website from 2011 to 2016 [para 6], revenue amounts in Canada since 2011 [para 9], and annual Canadian advertising expenses from 2014 to 2016 [para 10] in relation to the Opponent’s KAYAK-branded services. In contrast, while I accept that there is some evidence of use of the Mark in Canada since 2011, I agree with the Opponent that the extent to which the Mark has become known in Canada is somewhat unclear.

[42] Accordingly, I find these factors favour the Opponent.

Nature of the Goods, Services or Business / Nature of the Trade

[43] In its representations, the Applicant submits that the nature of the Applicant’s goods and services and those of the Opponent “are entirely different” [Applicant written representations, page 7]. The Applicant characterizes the Opponent as operating “entirely in the travel bookings and travel itineraries spaces” [page 7], with no evidence that it sells goods or services “in any of the fields of trade occupied by the Applicant, namely business marketing consulting and training, content marketing and developing market strategies, or website design and development” [page 8]. The Applicant provides examples of jurisprudence where the Registrar has “shown a willingness to consider even a very nuanced difference in the channel[s] of trade when considering confusion” [page 9]. In part, the Applicant relies on the purported principle that “the parties respective statements of services must be read with a view to determine the probable type of business or trade intended by the parties rather than all trades that may be encompassed by the reading” [citing *Movenpick Holding AG v Exxon Mobil Corporation*, 2013 FCA 6 at para 6].

[44] Nevertheless, when considering the nature of the goods and services of the parties in respect of the issue of confusion, it is the statements in the subject application and registrations that govern [*Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CarswellNat 749, 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[45] For its part, the Opponent notes that the cases cited by the Applicant deal with different goods/services and trades and that, in any event, jurisprudence “going the other way” is also common. I would note that, where arguably rooted in principles or jurisprudence that pre-date the guidance of the Supreme Court in *Masterpiece*, *supra*, cases in either direction should be approached with caution.

[46] In this case, I consider it sufficient to consider the potential for overlap given the broad nature of the Applicant's applied-for goods and services. In the context of the section 30(a) ground above, the Opponent pleaded that it is not possible to assess the similarity or the extent of overlap between the parties services and trades, given the broad articulation of the Applicant's applied-for goods and services. Although that ground was rejected, the submission does have traction in the context of this confusion analysis. While the applied-for goods and services may comply with the requirements of section 30 of the Act, they are nonetheless inherently broad. As the Opponent notes, while the Opponent's services are travel-related, the Applicant's services "are available to all industries, including travel service providers and related industries" such that there is potential overlap with "the Opponent's core market" [Opponent's written representations, para 91]. Indeed, I find that the applied-for goods "online publications in the field of marketing" and the applied-for marketing services have potential to overlap with the Opponent's registered travel-related services. In particular, I note that such travel-related services include advertising and marketing services for third parties. Although such services and evidenced use is limited to the field of travel, the Applicant's goods and services are not so limited. At a minimum, there is potential for overlap.

[47] Accordingly, I find that this factor favours the Opponent, albeit not to a high degree, in the absence of clear evidence of direct overlap in the nature of the services offered by the parties.

Conclusion – Confusion with the registered trademark KAYAK

[48] Having considered all of the surrounding circumstances, I find that the Applicant has not met its legal burden with respect to the applied-for goods and services.

[49] At best for the Applicant, I find the balance of probabilities regarding the likelihood of confusion as to the source of the parties' goods and services to be evenly balanced. I reach this conclusion due to the high degree of resemblance between the trademarks and the potential overlap in the nature of the parties' goods, services, businesses and trades, notwithstanding that the Applicant does not appear to have operated in the field of travel-related marketing services to date.

[50] As the onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion, I must find against the Applicant.

[51] Accordingly, this ground of opposition based on section 12(1)(d) of the Act is successful.

SECTION 16(1)(A) GROUND OF OPPOSITION – NON-ENTITLEMENT BASED ON PRIOR USE

[52] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(a) of the Act because, as of the alleged date of first use and all other material times, the Mark was confusing with the Opponent's family of KAYAK trademarks as well as with each of the Opponent's trademarks which had been previously used by the Opponent in Canada.

[53] Again, the schedule to the statement of opposition includes the Opponent's KAYAK trademarks, including the registered KAYAK word mark.

[54] Noting that the issue is not in dispute, in view of the Opponent's evidence of prior use of its KAYAK trademark, I am satisfied that the Opponent has met its initial burden with respect to this ground.

[55] Furthermore, I consider the confusion analysis above to be substantially similar with respect to this ground, notwithstanding the earlier material date. It follows that the ground of opposition based on section 16(3)(a) of the Act is also successful.

REMAINING GROUNDS OF OPPOSITION

[56] As the Opponent is successful with respect to two grounds of opposition, it is not necessary to address the remaining grounds of opposition, namely the ground based on 30(i) of the Act (regarding the statement of entitlement), the ground based on section 16(1)(c) of the Act (regarding confusion with a previously-used trade name), and the ground based on section 2 of the Act (regarding non-distinctiveness).

DISPOSITION

[57] In view of all of the foregoing, pursuant to section 38(12) of the Act and the authority delegated to me under section 63 of the Act, I refuse the application.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: 2020-10-02

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