



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 014

Date of Decision: 2023-01-30

IN THE MATTER OF AN OPPOSITION

Opponent: Gang Cao

Applicant: Apple Inc.

Application: 1853995 for LivePhotosKit (Stylized)

INTRODUCTION

[1] Gang Cao (the Opponent) opposes registration of the trademark LivePhotosKit (Stylized) (the Mark), which is the subject of application No. 1853995 by Apple Inc. (the Applicant). The Mark is shown below:

LivePhotosKit

[2] The Mark is applied for in association with the following goods (in Nice class 9) and services (in Nice class 42):

Goods: Computer software used in developing other software applications for use in recording, organizing, transmitting, and manipulating computer graphics, digital images, audio and video clips, movies, music video and photographs; application development software, namely, computer software for assisting developers in creating computer program code for use in single and multiple application programs; website development

software, namely, computer software for developing and creating websites; multimedia development software, namely, computer software for assisting users in creating, editing, and publishing multimedia files containing a combination of digital images, photographs, and video clips; computer software for displaying digital photographs and videos, namely, video clips on webpages.

Services: Computer programming; design and development of computer software; computer software consulting services; support services in the nature of consultation services for developing applications, namely providing technical support and technician training to assist others in the development of computer software; providing computer software information online in the field of design and development of computer software; application service provider (ASP) services featuring application programming interface (API) software for use in developing websites, software and multimedia content, namely, digital files featuring a combination of photographs and video clips; application service provider featuring application programming interface (API) software for displaying digital photographs and videos, namely, video clips on webpages; providing online non-downloadable software, namely, computer software for assisting developers in creating computer program code for use in single and multiple application programs.

[3] The opposition is based on various grounds, including that the Mark is clearly descriptive and/or non-distinctive with respect to the applied-for goods and services.

THE RECORD

[4] The application for the Mark was filed on August 23, 2017, based on use in Canada since at least as early as April 20, 2017, with a priority filing date of April 28, 2017 based on an application in Jamaica in association with the same kind of goods and services.

[5] The application was advertised for opposition purposes on April 24, 2019. Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13 (the Act) came into force on 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 June 17, 2019.

[6] On October 23, 2019, the Opponent opposed the application by filing a statement of opposition under section 38 of the Act.

[7] The grounds of opposition are based on non-conformance with sections 30(a), 30(b), and 30(i) of the Act; non-registrability under sections 12(1)(b) and 12(1)(c) of the Act; and non-distinctiveness under section 2 of the Act.

[8] The Applicant filed a counter statement denying the grounds of opposition.

[9] In support of its opposition, the Opponent filed the affidavit of L. Jane Sarjeant, dated August 28, 2020 (the Sarjeant Affidavit). Ms. Sarjeant was cross-examined on her affidavit and the transcript was made of record.

[10] In support of its application, the Applicant filed certified copies of three registrations and the affidavit of Delina Lam, dated June 10, 2021 (the Lam Affidavit).

[11] Only the Applicant submitted written representations, but both parties were represented at an oral hearing.

OVERVIEW OF THE OPPONENT'S EVIDENCE

Sarjeant Affidavit

[12] Ms. Sarjeant is employed by Bereskin & Parr LLP, the Opponent's agent of record at the time the Opponent submitted its evidence [para 1]. In August 2020, Ms. Sarjeant was instructed to conduct various Internet searches [paras 2 to 9]. Accordingly, printouts of the following are attached to her affidavit:

- Exhibit A: European Union Intellectual Property Office refusal and appeal decisions rendered in connection with EU trademark application No 01575592 for LIVEPHOTOS, obtained from *euipo.europa.eu*.
- Exhibit B: Definitions for the terms LIVE, LIFE, PHOTOGRAPH, and KIT, obtained from *merriam-webster.com*.
- Exhibit C: Printouts from 54 webpages that Ms. Sarjeant was asked to visit on August 14, 2020, which appear to primarily be those of third parties, but include printouts from the Applicant's website, *apple.com*. Ms. Sarjeant does not explain the significance of any of these printouts, but indicates that she highlighted certain passages "relating to the term LIVE PHOTOS(S)" [para 4].
- Exhibit D: Printouts of United States Patent application No. 62243848 filed on October 20, 2015 by the Applicant, obtained from *appft.uspto.gov*.

- Exhibits E1 and E2: The first page of search results for the words “live photos review”, obtained from the Google search engine, and printouts of the 10 webpages reflected in the search results.
- Exhibits F1 and F2: The first page of search results for the words “live photos kits review”, obtained from the Google search engine, and printouts of the 10 webpages reflected in the search results.
- Exhibit G: A screenshot of a 2015 video titled “Apple Announces Live Photos” from 2015, obtained from *youtube.com*, as well as a transcript of the video prepared by Ms. Sarjeant.
- Exhibit H: Printouts of 13 further third-party webpages that Ms. Sarjeant was instructed to visit on August 27, 2020.
- Exhibit I: Printouts of user guides for two ZTE-brand mobile phones and an INSIGNIAFLEX-brand tablet.

[13] I note that Ms. Sarjeant does not make any statements directed at the Opponent’s pleadings. In her cross-examination, she confirms that she did not read or review all of the exhibited webpages [Q48] and that she had no information regarding how many Canadians would have visited any of those webpages [Q59]. Aside from the aforementioned highlighting, she allows the exhibited printouts to speak for themselves.

OVERVIEW OF THE APPLICANT’S EVIDENCE

Lam Affidavit

[14] Ms. Lam is a Law Clerk employed by the Applicant’s agent of record [para 1]. Between April and June 2021, Ms. Lam was instructed to conduct various Internet searches [paras 2 to 12]. Accordingly, printouts of the following are attached to her affidavit:

- Exhibits A and B: The first page of search results for the term “LivePhotosKit”, obtained from the Google search engine, and printouts of the first page of each such search result.
- Exhibits C and D: The first page of search results for the term “LivePhotosKit” together with the word “Apple”, obtained from the Google search engine, and printouts of the first page of each such search result.
- Exhibits E and F: Printouts from four online dictionaries showing no results for the terms “livephotos” and “livephotoskit”.
- Exhibit G: Search results for “LivePhotosKit”, obtained from the European Union Intellectual Property Office trademark database, showing two results in the Applicant’s name.
- Exhibit H: Printouts of the two registration records from the EUIPO database, with respect to the Applicant’s LivePhotosKit trademark.

[15] Again, I note that Ms. Lam does not make any substantive statements directed at the Opponent’s pleadings, but instead allows the exhibits to speak for themselves.

Certified Copies

[16] The Applicant furnished certified copies of its Canadian trademark registrations for LIVETYPE (TMA646444), LIVE LISTEN (TMA1003358), and LIVE TITLES (TMA1067498).

EVIDENTIAL BURDEN AND LEGAL ONUS

[17] 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 (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.

[18] For those allegations for which the Opponent has met its evidential burden, the legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. 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 it.

[19] In the absence of written representations, I note that the Opponent focused on the grounds based on sections 12(1)(b) and 2 of the Act at the hearing. Nonetheless, I will address each of the pleaded grounds in turn.

30(A) GROUND – GOODS SPECIFIED IN ORDINARY COMMERCIAL TERMS

[20] Pursuant to section 38(2)(a) of the Act, the Opponent pleads that the application does not conform to the requirements of section 30(a) of the Act because the applied-for goods and services i) are not stated in ordinary commercial terms, and ii) are not stated in a manner that identifies the specific good or service in association with which the Mark has been used.

[21] The material date for this ground is the filing date of the application.

[22] The initial burden on an opponent under a section 30(a) ground is a light one and it can succeed through argumentation alone, i.e., the Registrar may take judicial notice of facts in support of the Opponent's pleading [see *McDonald's Corp v MA Comacho-Saldana International Trading Ltd*, 1984 CarswellNat 1074 (TMOB) and *Pro Image Sportswear Inc v Pro Image Inc*, 1992 CarswellNat 1487 (TMOB)].

[23] Section 30(a) of the Act stated as follows:

30 An applicant for the registration of trademark shall file with the Registrar an application containing

(a) a statement in ordinary commercial terms of the specific goods or services in association with which the mark has been or is proposed to be used.

[24] As such, a ground of opposition based on section 30(a) of the Act such as this involves two issues: first, whether the statement of goods is in ordinary commercial terms and, second, whether it adequately identifies the specific goods [*Whirlpool SA v Eurotherm Holdings Ltd*, 2010 TMOB 171].

[25] However, in the absence of representations from the Opponent and as none of the evidence appears to be directed towards this ground, I find that the Opponent has not met its initial burden.

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

30(B) GROUND – NON-CONFORMITY

[27] Pursuant to section 38(2)(a) of the Act, the Opponent pleads that the application does not conform to the requirements of section 30(b) of the Act, because the Applicant had not used the Mark in Canada since the date of first use as claimed, namely April 20, 2017 because:

- The Applicant did not use the Mark at any material time as a “trademark” within the meaning of section 2 of the Act; and
- The Applicant did not at any material time “use” the Mark in relation to any of the applied-for goods and/or services, within the meaning of section 4 of the Act.

[28] Again, none of the evidence is clearly directed towards this ground and, in the absence of representations from the Opponent, I find that it has not met its initial burden.

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

30(I) GROUND – NON-CONFORMITY

[30] Pursuant to section 38(2)(a) of the Act, the Opponent pleads that the application does not conform with the requirements of section 30(i) of the Act, because the

Applicant could not have been satisfied when it filed the application, or at any material time, of its entitlement to use of the Mark in Canada in association with the goods and/or services described in the application because:

- The application was filed in bad faith; and
- The application was made contrary to a Federal statute, namely section 34 of the *Trademarks Act*.

[31] In particular, the Opponent pleads that the Applicant declared that it was entitled to claim under section 34 of the Act, the April 28, 2017 filing of Jamaica application no. 72385 as the deemed filing date of the application in Canada but, at all material times, the Applicant was not a citizen or national of Jamaica, was not domiciled in that country, and did not have a real and effective industrial or commercial establishment therein; as such, the Applicant was not entitled to claim priority due to that Jamaican application.

[32] As there is no evidence in support of this ground, the Opponent fails to meet its initial burden. Accordingly, the ground of opposition based on non-conformity with section 30(i) of the Act is rejected.

12(1)(B) GROUND – CLEARLY DESCRIPTIVE OR DECEPTIVELY MISDESCRIPTIVE

[33] Pursuant to section 38(2)(b) of the Act, the Opponent pleads that the Mark is not registrable because, contrary to section 12(1)(b) of the Act, it is clearly descriptive or deceptively misdescriptive of a character or quality of one, more, or all of the applied-for goods and services because:

- “LivePhotosKit” is the name and/or title of the applied-for “software” goods and of the applied-for services, and is the most certain way of identifying them;
- “LivePhotosKit” clearly describes (or deceptively misdescribes) the function of the applied-for “software” goods and that such software is part of a “kit”. In particular, the term “live photos” is commonly used in the trade and/or by the public to refer to photographs, or software in relation to photographs, that create the impression of movement, or being “live”. The Mark therefore clearly

describes that the goods and services are in connection with a software kit intended to create or bring photos to life through movement; and

- “LivePhotosKit” clearly describes (or deceptively misdescribes) a character of the goods and services in the application, in that they pertain to a “kit” for “live photos” for the aforementioned reasons.

[34] The Opponent further pleads that the Mark has not been so used in Canada by the Applicant as to have become distinctive at either the date of filing the application, namely August 23, 2017, or the claimed priority filing date, namely April 28, 2017.

[35] I note that the Opponent’s pleadings pursuant to sections 12(1)(b), 12(1)(c) and 2 of the Act are related, to the extent that the Opponent’s position includes its view that “live photos” is a generic term in the trade to identify a type of photograph, and that “kit” is descriptive of a collection of software related to such photographs.

[36] The material date for a ground of opposition based on section 12(1)(b) of the Act is the filing date of the application, namely August 23, 2017 in this case.

[37] Section 12(1)(b) of the Act states as follows:

12(1) Subject to subsection (2), a trademark is registrable if it is not ...

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the goods or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin.

[38] The purpose of the prohibition in section 12(1)(b) of the Act is to prevent any single trader from monopolizing a term that is clearly descriptive or common to the trade, thereby placing legitimate traders at a disadvantage [*Canadian Parking Equipment v Canada (Registrar of Trade Marks)*, 1990 CarswellNat 834 (FCTD)].

[39] The issue as to whether a trademark is clearly descriptive or deceptively misdescriptive must be considered from the point of view of the average purchaser of the associated goods and services. “Character” means a feature, trait or characteristic

of the goods or services and “clearly” means easy to understand, self-evident or plain [*Drackett Co of Canada v American Home Products Corp*, 1968 CarswellNat 9 (Can Ex Ct)]. The trademark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd v Canada (Registrar of Trade Marks)* (1978), 40 CPR (2d) 25 (FCTD) at 27; *Atlantic Promotions Inc v Canada (Registrar of Trade Marks)* (1984), 2 CPR (3d) 183 (FCTD) at 186; *Biofert Manufacturing Inc v Agrisol Manufacturing Inc*, 2020 FC 379 at para 183]. In other words, the trademark must not be considered in isolation, but rather in its full context in conjunction with the subject goods and services [*Ontario Teachers’ Pension Plan Board v Canada (Attorney General)*, 2012 FCA 60]. Finally, one must apply common sense in making the determination about descriptiveness [*Neptune SA v Canada (Attorney General)*, 2003 FCT 715 (FCTD)].

[40] For a trademark to be considered deceptively misdescriptive, the trademark must mislead the public as to the character or quality of the goods or services. The trademark must be found to be descriptive so as to suggest the goods or services are or contain something that is not the case. The purpose of the prohibition with respect to deceptively misdescriptive trademarks is to prevent the public from being misled [*Atlantic Promotions Inc v Canada (Registrar of Trade Marks)*, 1984 CarswellNat 831 (FCTD); and *Provenzano v Canada (Registrar of Trademarks)*, 1977 CarswellNat 676 (FCTD)].

[41] Finally, an opponent’s initial evidential burden may be met by reference to the ordinary meaning of the words in an applicant’s trademark [*Unilever Canada v Coty Germany GmbH*, 2019 TMOB 50 at para 10].

[42] At the hearing, the Opponent submitted that the component elements of the Mark are descriptive and retain their descriptive meaning in combination. In this respect, the Opponent submitted that LIVE PHOTOS is a term commonly used in the trade to refer to photographs that create the impression of movement, and that KIT is a generic term

meaning a collection (in this case, a collection of software tools for the creation or manipulation of “live photos”).

[43] To some extent, the Opponent seemingly relies on definitions of “LIVE”, “PHOTO” and “KIT” from the *Merriam-Webster Dictionary*, as included amongst the various website printouts at Exhibit C of the Sarjeant Affidavit. These definitions include PHOTO being a synonym of “photograph” and, amongst many, the following definitions of “live” and “kit”:

Live (adjective):

having life; existing in fact or reality; being in operation; abounding with life: vivid; of continuing or current interest; of or involving a presentation (such as a play or concert); broadcast directly at the time of production; not imaginary, actually existing.

Kit (noun):

a collection of articles usually for personal use; a set of tools or implements; a packaged collection of related material; a group of persons or things – usually used in the phrase the whole kit and caboodle.

[44] Although not evidenced, at the hearing, the Opponent also referenced section 2.4.7.2.4 of the *Trademarks Examination Manual* re: “Kits, gift baskets and goods sold as a unit”, which refers to a “kit” as goods sold as a unit.

[45] The Opponent also referenced decisions of the EUIPO regarding an application for the word mark LIVE PHOTOS by the Applicant [Sarjeant Affidavit, Exhibit A]. The EUIPO refused the Opponent’s application on the basis that “LIVE PHOTOS” was a descriptive indication, further finding no clear and conclusive evidence of acquired distinctiveness. I note those decisions did not address the Mark at issue in this case. In any event, I further note that the Registrar is not bound by the foreign EUIPO and USPTO decisions referenced by the parties and discussed at the hearing.

[46] The Opponent’s position that the Mark is clearly descriptive of a software kit for “live photos”, appears to be premised on a finding that “live photos” is a generic term in the trade describing a type of photograph, akin to “colour photograph” or “digital

photograph”. Furthermore, the Opponent’s submissions appeared to rely on equating the term “living photo” with the term “live photo”.

[47] In particular, at the hearing, the Opponent directed attention to an undated article titled “The History of Cinemagraphs Includes David Bowie” from the third-party website *blog.flixel.com* (included amongst the website printouts at Exhibit C of the Sarjeant Affidavit). At the hearing, in part, the Opponent noted the following passage from the article, purporting to indicate that “live photos” have existed since at least as early as 2011:

That is, until the year 2011, when two artists joined forces to produce what ultimately became the first known instance of a living photo: an entirely new visual medium, which would henceforth earn the colloquial title of cinemagraph. Now, only so many years later, cinemagraphs are gaining momentum and attracting people from all disciplines, as the novel format’s fresh appeal garners more and more support. At this very moment, we’re at a critical point in the cinemagraph’s short history...”

[48] As indicated in the article, the author’s intent is to answer the question “What is a cinemagraph?”, and the author suggests that an easily-accessible answer to the question would be to the effect of “Cinemagraphs are like, I don’t know, high-definition GIFs” and “Cinemagraphs are like, I don’t know, moving photos. They’re dynamic – elements of the composition seem to come alive”. The author equates cinemagraphs to various terms, including “animated pictures” and “living photos”, likening them to something out of “Hogwarts” of “Harry Potter lore”. The Opponent equated these descriptions to the Applicant’s LIVE PHOTOS application feature and the type of photographs produced by the Applicant’s software application.

[49] However, the article itself also has a subsection titled “Cinemagraphs vs. Live Photos” and compares cinemagraphs to the Applicant’s “iOS Live Photos feature”. Given the colloquial nature of the article, it is not clear to what extent the author distinguishes the two. In any event, as with much of the Opponent’s evidence, the article is hearsay and it is at best not clear what relevance it has to the pleadings at issue. I note, however, that the article itself does not appear to use the term LIVE PHOTOS generically. Rather, it appears to attribute the term to the Applicant.

[50] Indeed, in its representations, the Applicant criticized much, if not all, of the evidenced webpages in the Sarjeant Affidavit as hearsay, submitting that the Opponent fails to meet its initial burden for each pleaded ground [Applicant's written representations at para 7]. In addition and, in any event, per the table at Schedule A to its written representations, the Applicant goes through each of the furnished articles, noting the "lack of value to be ascribed" to the exhibits, broken down by whether the article/printout: i) contains the phrase "Live Photo(s)"; ii) contains the phrase "LivePhotosKit", iii) refers to "Live Photo(s)" as the Applicant's product and; iv) post-dates the material date.

[51] At the hearing, the Applicant submitted that, if one parses out the exhibited material that reference the Applicant's products, the affidavit "amounts to nothing". In sum, even if not dismissed wholesale as hearsay, the Applicant submits that it is at best not clear what inferences should be made from the various "cherry-picked" exhibits to the Sarjeant affidavit.

[52] In any event, the Applicant submitted that, to the extent that an inference could be made that the average Canadian consumer would have come across any of these articles, it would appear that "living photos" or "cinemagraphs" is more likely to be the applicable generic or apt term.

[53] In contrast, the Applicant submits that the word "live" has no common descriptive meaning in connection with the applied-for software goods and services [Applicant written representations at para 22]. It further submits that, in connection with photographs, at most the Mark is suggestive, because "[LIVE] is an incongruous, playful use of the word" and that the Mark "is fun because photographs are not actually alive" [para 24].

[54] As a feature of the Applicant's software, the Applicant submits that the idea suggested by LIVE PHOTOS, as a matter of first impression could include "a lot of things", including: software to create photographs that are more vivid than typical photos; photographs that can be simultaneously sent to third parties, akin to "live broadcasting"; photographs with some form of three-dimensional functionality that

makes them appear “alive”; or photographs with a specified lifespan, such that they may “age, die, and disappear” (or be deleted) over time [para 25]. This submission is consistent with the many definitions of “live” included in the dictionary definitions evidenced in the Sarjeant Affidavit.

[55] Indeed, even in context of the applied-for goods and services, I agree with the Applicant that the first impression created by “LIVE PHOTOS” is something of an oxymoron, given that a photograph, by definition, cannot be “live” *per se*. In my view, it is only with explanation of the end-photographic effect that the Opponent’s preferred definition(s) of “live” could be applicable to the Applicant’s software and the photographs generated; this is not, then, a matter of first or immediate impression.

[56] At the hearing, the Applicant further noted that the trademark as a whole must be considered, and not dissected into its component parts. It noted that none of the evidenced definitions of KIT or KITS applies to software *per se* or to any of the applied-for goods and services. Indeed, the Opponent conceded that nowhere in the evidence is it shown that KIT is a term commonly used in relation to software.

[57] In view of the foregoing, even if I were to accept that the Opponent’s initial burden is constructively met in view of the evidenced dictionary definitions, I find that the Applicant has met its legal onus to demonstrate that the Mark does not contravene section 12(1)(b) of the Act.

[58] Accordingly, the ground of opposition based on section 12(1)(b) of the Act is rejected.

12(1)(C) GROUND – NAME OF THE GOODS

[59] Per section 38(2)(b) of the Act, the Opponent pleads that the Mark is not registrable because, contrary to section 12(1)(c) of the Act, the Mark is the name in the English language of the goods and services in connection with which it is alleged to be used, that is “LivePhotosKit” is the name of the Applicant’s “software” and related services.

[60] The material date for this ground is the date of this decision [*Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA) at 424].

[61] I agree with the Applicant that the Opponent has failed to meet its initial burden to put into issue that the Mark is understood as the name of the applied-for goods or services. In this respect, as noted by the Applicant in its written representations, there is no evidence of generic use of the Mark and no evidence that any third party uses the Mark [paras 51 and 52]. Furthermore, I agree with the Applicant's assessment of the evidence that references to the Mark in the evidence are actually to that of the Applicant's goods and services [para 52, referencing the Lam Affidavit at paras 3 and 4, Exhibit A].

[62] Accordingly, the ground of opposition based on section 12(1)(c) of the Act is rejected.

SECTION 2 GROUND – NON-DISTINCTIVENESS

[63] Per section 38(2)(d) of the Act, the Opponent pleads that the Mark is not distinctive of the Applicant within the meaning of "distinctive" as set out in section 2 of the Act because as of the material date:

- The Applicant had not used the Mark to such an extent that it acquired any distinctiveness, and the Mark is not inherently distinctive (Branch One);
- The term "LivePhotosKit" is the name of the applied-for goods and services (Branch Two); and
- The Mark is, and/or has always been, a generic term in respect of the applied-for goods and services (Branch Three).

[64] With respect to Branch One, the Opponent further pleads that the Mark is not inherently distinctive because i) the term "LivePhotosKit" does not actually distinguish, nor is it adapted to distinguish, the goods and services of the Applicant in association with which it is alleged to be used from the goods and services of others in Canada, because the term "live photos" is commonly used in the trade and/or by the public to

refer to photographs, or software in relation to photographs, that create the impression of movement, or being “live”, and the term “kit” is commonly used in the trade and/or by the public to refer to a set of things used for a particular purpose or activity, so the term “LivePhotosKit” would be understood by the trade and/or the public to be a software kit employed to create or bring photos to life through movement, or services related thereto; ii) the term “LivePhotosKit” is descriptive of a character of the applied-for goods and services; and iii) the term “LivePhotosKit” is inherently descriptive because it is the only way to identify the applied-for “software” goods and the applied-for services, and the term “LivePhotosKit” will neither be used nor perceived as a trademark because it describes the applied-for software goods and the applied-for services.

[65] The material date for this ground is the filing date of the opposition, October 23, 2019 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

[66] Section 2 of the Act, as it then was, defined “distinctive” as follows:

distinctive, in relation to a trademark, means a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or is adapted so to distinguish them.

[67] A trademark “actually distinguishes” by acquiring distinctiveness through use, resulting in distinctiveness in fact. On the other hand, a trademark that is “adapted so to distinguish” is one that does not depend upon use for its distinctiveness because it is inherently distinctive [see *Astrazeneca AB v Novopharm Ltd*, 2003 FCA 57 at para 16].

[68] As noted above, there is overlap in the Opponent’s pleadings and argument under this ground and those under the grounds based on sections 12(1)(b) and 12(1)(c) of the Act.

[69] Accordingly, with respect to Branch Two and Branch Three, I agree with the Applicant that the Opponent has failed to meet its initial burden to show that the Mark, (or “live photos kit”) is the name of the applied-for goods and services or that it is a generic term in respect of such goods and services, regardless of the material date to be considered.

[70] Similarly, with respect to Branch One of this ground, I agree with the Applicant that the evidence does not establish that, prior to the material date, the term LIVE PHOTOS was commonly used in the trade or by the public to refer to photographs (or software in relation to photographs) that create the impression of movement, or being “live”. Even giving some weight to the exhibits in the Sarjeant Affidavit, I do not consider the evidence to show that LIVE PHOTOS is a common or apt term in the trade for a type of photograph (e.g. akin to “digital photograph” or “colour photograph”), or that the Mark as a whole is clearly descriptive of the applied-for goods and services.

[71] As the Opponent has not met its initial burden in this respect, Branch One of this ground also fails.

[72] In view of the foregoing, the non-distinctiveness ground of opposition is rejected.

DISPOSITION

[73] In view of all of the foregoing, pursuant to section 38(12) of the Act and the authority delegated to me under section 63(3) of the Act, I reject the opposition.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2022-12-05

APPEARANCES

For the Opponent: Gang Cao

For the Applicant: Antonio Turco

AGENTS OF RECORD

For the Opponent: No Agent Appointed

For the Applicant: CPST Intellectual Property Inc.