



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 006

Date of Decision: 2023-01-19

IN THE MATTER OF AN OPPOSITION

Opponent: Gang Cao

Applicant: Apple Inc.

Application: 1745321 for LIVE PHOTOS

INTRODUCTION

[1] Gang Cao (the Opponent) opposes registration of the trademark LIVE PHOTOS (the Mark), which is the subject of application No. 1745321 by Apple Inc. (the Applicant).

[2] The Mark is applied for on the basis of proposed use in association with the following goods in Nice class 9:

Computer software for use in recording, organizing, transmitting, and manipulating graphics, images, audio and video clips, movies, music video and photographs.

[3] The opposition is based on various grounds, including that the application does not conform to section 30 of the *Trademarks Act*, that the Mark is clearly descriptive

and/or non-distinctive in association with the applied-for goods, and that the Mark is confusing with a registered trademark.

THE RECORD

[4] The application for the Mark was filed on September 9, 2015, with a priority filing date of July 9, 2015 based on an application in Jamaica in association with the same kind of goods.

[5] The application was advertised for opposition purposes on March 22, 2017. 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, 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 August 17, 2017, the Opponent opposed the application by filing a statement of opposition under section 38 of the Act.

[7] Following a granting of leave to file an amended statement of opposition filed on May 16, 2019, the grounds of opposition are based on non-conformance with sections 30(a), 30(e), and 30(i) of the Act; non-registrability under sections 12(1)(b), 12(1)(c), and 12(1)(d) of the Act; and non-distinctiveness under section 2 of the Act.

[8] Pursuant to the Registrar's ruling dated June 20, 2019, I note that an insufficiently pleaded non-entitlement ground purportedly based on section 38(2)(c) of the Act was struck.

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

[10] In support of its opposition, the Opponent filed the following affidavits:

- Two affidavits of Rentaro Burress, sworn in Vancouver on April 13, 2018 and April 16, 2018, respectively (the Burress Affidavits);

- Affidavit of Georgia Horstman, sworn April 13, 2018 in Vancouver (the Horstman Affidavit); and
- Affidavit of Jennifer Huang, sworn April 16, 2018 in Vancouver (the Huang Affidavit).

[11] Mr. Buress was cross-examined and the cross-examination transcript and undertakings were made of record.

[12] In support of its application, the Applicant filed the following evidence:

- Affidavit of Thomas La Perle, sworn February 6, 2019 in Santa Clara, California (the La Perle Affidavit);
- Affidavit of Ginger Dorval, sworn February 7, 2019 in Toronto (the Dorval Affidavit);
- Affidavit of Richard Nigel Perreira, sworn January 10, 2019 in Toronto (the Perreira Affidavit);
- Affidavit of Wayne Badenhorst, sworn January 24, 2019 in Toronto (the Badenhorst Affidavit);
- Affidavit of Ian Davenport, sworn January 25, 2019 in Toronto (the Davenport Affidavit);
- Affidavit of Duncan Brown, sworn January 30, 2019 in Toronto (the Brown Affidavit); and
- Certified copies of trademark registrations for LIVETYPE (TMA646444) and LIVE LISTEN (TMA1003358), both owned by the Applicant.

[13] Mr. Brown and Ms. Dorval were cross-examined and the cross-examination transcripts and undertakings were made of record.

[14] As Mr. La Perle was not made available for cross-examination, the La Perle Affidavit was removed from the record.

[15] Both parties submitted written representations and were represented at an oral hearing. I also note that both parties changed representation multiple times over the course of the proceeding.

OVERVIEW OF THE OPPONENT'S EVIDENCE

April 16 Buress Affidavit

[16] Of the two Buress Affidavits, although less substantial and dated later, I note that the affidavit dated April 16, 2018 is identified in the document itself as the "First Affidavit of Rentaro Buress", presumably due to it describing earlier-conducted activities. For clarity, I will refer to it as the April 16 Buress Affidavit.

[17] Mr. Buress is employed by Cameron IP, the Opponent's agent of record at the time the Opponent submitted its evidence [para 1]. On February 22, 2018, per instructions to find reviews of the Applicant's "Live Photos" feature, Mr. Buress conducted a search for "Live Photos reviews" using the Google search engine [para 4, Exhibit A]. Exhibit B consists of printouts of ten such search results, accessed between February and April 2018.

[18] By way of example, I note that one of the exhibited reviews appears to be from the *Trusted Reviews* website, dated March 23, 2016. It includes the following text as part of a larger article:

What is a Live Photo?

A Live Photo is essentially a way to bring your photos to life by capturing a few seconds of video when you're taking a photo on your iPhone. It's a bit like a Gif, but it can also capture audio at the same time.

If you've used a Lumia phone recently, then it's very similar to the Living Images mode. It's not something new but simply Apple putting its own unique spin on it.

April 13 Buress Affidavit

[19] Again, although more substantial and dated earlier, I note that the affidavit dated April 13, 2018 is identified in the document itself as the “Second Affidavit of Rentaro Burress”. For clarity, I will refer to this affidavit as the April 13 Buress Affidavit.

[20] In April 2018, Mr. Buress was instructed to find certain applications in the Google Play application store [paras 3 to 13]. Aside from their respective ownership, Mr. Buress does not directly attest to the nature of these applications, but they appear to be five third-party applications that include “Live Photo” in their titles. Printouts for the following “apps” are attached to the affidavit:

- Exhibit A: “Live Photo”, owned by Live Animations [para 4, Exhibit A]. The “Updated” field indicates “July 18, 2017”, and the visible portion of the app description includes the following:

Get ready for magic! With this application you will be able to breathe life into the characters depicted on special notebooks, albums, notepads, puzzles etc. If you see the “Live Photo” logo of a red smiling hat on the product cover, it means its magical and characters on it come to life! ...

- “PICOO Camera – Live Photo”, owned by PICOO Design [para 6, Exhibit B]. The “Updated” field indicates “September 12, 2017”, and the description includes the following:

Tired of vapid still photos or robot-like GIFs, and wish to have a “Living” photos in which the view or people actually moves? Then PICOO Camera is your choice. With PICOO Camera, you can highlight and animate the topic spot on your photo, let your static photo contain dynamic movements, so your object in the photo really moves! Also, you can select photos from your phone gallery, and bring those memorable moments back to life again! ...

- “Motion Picture: Live Photo”, owned by Ocean Tech Lab [para 8, Exhibit C]. The updated field indicates “February 10, 2018” and the description includes the following:

Give life to your picture with Motion Picture. Apply a fantastic Cinemagraph effect. Motion Picture is very easy to use: 1. Take a new photo to add motion or select photo from your gallery. [READ MORE]

- “Live Photos – Movense”, owned by Movense Live Photos [para 10, Exhibit D]. The “Updated” field indicates “August 24, 2017” and the app description includes the following:

Movense is a Live photos capturing and motion photography based social network for users to express and share their life events (parties), surrounding (travel, animals, nature, food and fashion) and emotions (selfies) in 3D motion and then reverse playback on simple flip of your wrist.

- “Live Photos and Camera”, owned by Ingenico Games [para 12, Exhibit E]. The “Updated” field indicates “April 15, 2017” and the app description includes the following:

HD live camera and camera in your phone
Super photo and camera application
Create high resolution pictures and videos immediately

[21] Mr. Buress confirms that he downloaded each of the aforementioned apps onto a mobile phone in April 2018.

[22] I note that none of the printouts indicate when the respective third-party applications were first made available on Google Play or otherwise. However, dated comments and the “Updated” fields indicate two of the apps were available in April 2017 (Exhibits A and E), whereas the other three may not have been available until after August 2017 (i.e., after the filing of the statement of opposition).

[23] Also attached is a printout of the “Take and edit Live Photos” webpage from the Applicant’s website, *apple.com*, dated April 13, 2018 [para 14, Exhibit F].

[24] Relevant portions of the cross-examination of Mr. Buress on his affidavits will be addressed below.

Horstman Affidavit

[25] Ms. Horstman is an employee of Cameron IP [para 1]. Ms. Horstman was also instructed to use the Google search engine to find reviews of the Applicant’s Live

Photos feature [para 4, Exhibit A]. Exhibit B consists of printouts of eight search results, dated April 12, 2018.

[26] As noted by the Opponent in its written representations, the *Trusted Reviews* article “iPhone 6S Plus – Camera, Live Photos, 4K Video” at Exhibit B to the Horstman Affidavit includes the following text: “Apple has added a special new photo feature called Live Photos”, “it does add a vibrancy and motion to photos that helps bring them to life”, and “the effect reminds me of the living paintings in the Harry Potter films” [para 27(c)]. The latter reference is echoed in the September 2017 *Macworld* article “How to take Live Photos on iPhone”, which includes the byline “Take Harry Potter-like moving photos on your iPhone” and text such as “...what Live Photos actually does ... results in moving photos that you’d be forgiven for thinking were straight out of Hogwarts” [para 27(d), referencing Exhibit B of the Horstman Affidavit].

Huang Affidavit

[27] Ms. Huang is an employee of Cameron IP [para 1]. In April 2018, Ms. Huang was instructed to find and view the YouTube video titled “Apple announces Live Photos!”, uploaded by AppAdvice Daily [para 4]. Attached to the affidavit is a screenshot of the search results for that video [Exhibit A], a screenshot taken while Ms. Huang watched the video [Exhibit B], and “a full transcript of the video” that Ms. Huang typed out herself [Exhibit C]. Exhibit B indicates that the video is from September 2015.

OVERVIEW OF THE APPLICANT’S EVIDENCE

Dorval Affidavit

[28] Ms. Dorval is a trademark agent with Baker & McKenzie LLP, the Applicant’s agent of record at the time the Applicant submitted its evidence [para 1]. Ms. Dorval states that she was instructed to conduct various searches on the Canadian Trademarks Register, other trademark databases and the Internet generally to obtain the following information:

- A list and particulars of third-party LIVE or LIVE-formative trademarks in Canada;

- Any information or documentation evidencing use of third-party LIVE or LIVE-formative trademarks in Canada;
- Definitions for LIVE and LIVE PHOTO(S);
- Popularity/notoriety of the Applicant's LIVE PHOTOS software via general Google and Google Trends searches; and
- A list of jurisdictions where Creative Technology Ltd.'s LIVE! trademark and the Applicant's trademarks coexist.

[29] As such, the Dorval Affidavit evidences the following:

- Exhibit 1: search results from the Canadian Trademarks Register for “active LIVE or LIVE formative trademarks that have been approved, allowed, advertised, or registered in Canada” and “active LIVE or LIVE formative trademarks that have been approved, allowed, advertised, or registered in Canada that specifically cover [Nice] class 9 goods” [para 4].
- Exhibit 2: a chart showing “a selection of active LIVE formative marks that have been approved or registered in Canada without a disclaimer of the word ‘live’ and where the word ‘live’ appears to be used as an adjective ... including in many cases class 9 goods such as software” [para 5].
- Exhibit 3: printouts from websites “that show online use and advertising of some of the marks from the chart”, subsequent to searches Ms. Dorval conducted in late-November 2018 “to look for use and advertising of the third-party marks included in the chart at Exhibit 2” [para 6].
- Exhibit 4: printout from CIPO's database of application No. 1618760 for the trademark HP LIVE PHOTO; Ms. Dorval notes that the application was “allowed” on October 2, 2015, but subsequently abandoned [para 7].
- Exhibit 5: printout of the definitions of LIVE as obtained from the American Heritage Dictionary of the English Language online via *ahdictionary.com* on

November 26, 2018. Ms. Dorval notes that LIVE has multiple meanings as a verb, adjective and adverb, including: “Broadcast while actually being performed; not taped, filmed or recorded: a live television program” [para 8].

- Exhibit 6: Printouts from American Heritage Dictionary’s website, *ahdictionary.com*, showing that searches for the phrases LIVE PHOTO and LIVE PHOTOS return no matches [para 9].
- Exhibit 7: Printouts and screenshots from various dictionaries and thesauruses resulting from Ms. Dorval’s searches for the terms ‘live photos’ and ‘live photo’. Ms. Dorval notes that the only search results that included definitions for ‘live photos’ were in *thefreedictionary.com* and *Your Dictionary*, both of which define the term “by direct reference to Apple’s LIVE PHOTOS software” [para 10].
- Exhibit 8: printouts of Google search results for ‘live photos’, ‘live photos reviews’, and “define live photos”, conducted on January 31, 2019 [para 11].
- Exhibit 9: printouts and a screenshot from a Google Trends search conducted on January 31, 2019 for the term ‘live photos’ in Canada [para 12].
- Exhibit 10: search results of a “global trademarks search” using the Saegis database for LIVE! Applications and registrations owned by Creative Technology Ltd. Ms. Dorval states that her search shows that Creative Technology Ltd. has registered the trademark LIVE! in Nice class 9 in 11 jurisdictions, including Canada, the U.S., and Australia [para 13].
- Exhibit 11: search results using the Saegis database for LIVE PHOTOS applications/registrations owned by the Applicant. Ms. Dorval states that the Mark is registered in over 100 jurisdictions, including five jurisdictions where the LIVE! trademark is also registered, such as Australia [para 14].

[30] In addition, Ms. Dorval states that, in November 2018, she conducted searches using the *Saegis* database for LIVE LISTEN applications/registrations owned by the Applicant. She states that her search results indicate that LIVE LISTEN is registered in

numerous jurisdictions worldwide, including ten jurisdictions where the LIVE! trademark is also registered, such as Canada, the United States, and Australia [para 15].

[31] Relevant portions of the cross-examination of Ms. Dorval will be addressed below.

Perreira Affidavit

[32] Mr. Perreira is an IT Service Delivery Manager at Baker & McKenzie LLP [para 1]. He states that he is familiar with the Applicant's iPhone devices, in part because his firm has offered iPhone devices to its attorneys since 2014 [para 2]. He states that he is familiar with the LIVE PHOTOS pre-installed software available with iPhone devices, stating that he believes the LIVE PHOTOS feature on iPhone devices is a unique feature and that he is not aware "of any third party in the technology space using the phrase LIVE PHOTOS, other than in relation to Apple's iPhone products/technology" [para 3]. He states that he associates the LIVE PHOTOS phrase with Apple and its products, and that he believes that the LIVE PHOTOS phrase distinguishes Apple's technology from other third party technology [para 3]. I note that Mr. Perreira does not actually describe the "unique feature" or "Apple's technology" associated with the "LIVE PHOTOS phrase".

Davenport Affidavit

[33] Mr. Davenport is an IT Support Analyst with Baker & McKenzie LLP [para 1]. Mr. Davenport gives similar evidence as that of Mr. Pereira, stating that he is one of that firm's IT professionals and that he is familiar with the LIVE PHOTOS pre-installed software available with iPhone devices [paras 2 and 3]. Mr. Davenport states that he is "not aware of any other third party in the technology space using the phrase LIVE PHOTOS, other than in relation to Apple's iPhone products/technology", and that he associates "the LIVE PHOTOS phrase with Apple and its products, and believe[s] that the LIVE PHOTOS phrase distinguishes Apple's technology from other third party technology" [paras 3 and 4].

Badenhorst Affidavit

[34] Mr. Badenhorst is the Director of Interface Platforms at Baker & McKenzie LLP [para 1]. Echoing the evidence of Mr. Pereira and Mr. Davenport, Mr. Badenhorst states that he is one of the IT professionals responsible for setting up iPhone devices for attorneys at his firm and that he is familiar with the LIVE PHOTOS pre-installed software available with iPhone devices [para 2]. Mr. Badenhorst also states that he is “not aware of any other third party in the technology space using the phrase LIVE PHOTOS, other than in relation to Apple’s iPhone products/technology”, and that he associates “the LIVE PHOTOS phrase with Apple and its products, and believe[s] that the LIVE PHOTOS phrase distinguishes Apple’s technology from other third party technology” [paras 3 and 4].

Brown Affidavit

[35] Mr. Brown is a Computer Software Engineer with various credentials and experience in the IT field [para 1]. He states that he has extensive knowledge about “the newest developments in software and technology”, including the technology associated with the Applicant’s iPhone mobile phone [para 1]. He attests that he is familiar with the LIVE PHOTOS pre-installed software available with iPhone devices, stating that he believes that “the LIVE PHOTOS feature on iPhone devices is a unique feature and I am not aware of any other third party in the technology space using the phrase LIVE PHOTOS, other than in relation to Apple’s iPhone products/technology [para 3]. He further states that he associates the LIVE PHOTOS phrase with the Applicant and its products; that he believes that the LIVE PHOTOS phrase distinguishes the Applicant’s technology from other third party technology; and that he does not believe that “there is any other technology platform that offers a similar feature to the LIVE PHOTOS feature” [paras 3 and 4].

[36] In the course of his cross-examination, Mr. Brown acknowledged that his workplace experience related to “block chain technology” [Q14 to Q17]; that he had no “inside knowledge” of the Applicant or its marketing programs [Q27 to Q37]; and that his knowledge of the LIVE PHOTOS pre-installed software was a result of his ownership of one of the Applicant’s iPhone products, purchased in February 2018 [Q81 to Q83, Q87].

[37] He described the LIVE PHOTOS feature as “many frames stitched together” that shows or simulates movement as “a long shutter frame photo” [Q99 to Q103]. However, he acknowledged that the term LIVE PHOTOS does not appear on the iPhone itself, its packaging or any insert that accompanies the device [Q92 to Q97].

EVIDENTIAL BURDEN AND LEGAL ONUS

[38] 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.

[39] 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 the 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.

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

[40] Pursuant to section 38(2)(a) of the Act, the Opponent pleads that the application does not comply to the requirements of section 30(a) of the Act because it does contain a statement in ordinary commercial terms of the specific goods in association with which the Mark is proposed to be used.

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

[42] 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)].

[43] 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.

[44] 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].

[45] Section 2.4.5.2 of the *Trademarks Examination Manual*, titled “Specific goods or services”, sets out the following three-part test to assist in determining whether a statement of goods identifies a “specific” good or service within the meaning of the Act:

1. Are the goods or services described in a manner such that it is possible to assess whether paragraph 12(1)(b) of the Act applies? A trademark that clearly describes a character or quality of the goods or services is not registrable.

2. Does the statement identify a specific good or service to ensure that the applicant will not have an unreasonably wide ambit of protection? For example, goods described as “computer software”, without further specification, would give the applicant an unreasonably wide ambit of protection.

3. Are the goods or services described in a sufficiently specific manner such that it is possible to assess confusion? A trademark that is confusingly similar to a registered trademark or a pending trademark is not registrable.

[46] Furthermore, section 2.4.5.10 of the Canadian Intellectual Property *Goods and Services Manual* describes the requirements for a compliant statement in relation to “computer software” goods:

An identification of “computer software” or “computer programs” is not acceptable without further specification. The specific function of the computer software must be provided and, if the area of use is not obvious from the function of the computer software, the specific area of use should also be provided.

[47] In its written representations, the Opponent submits that the applied-for goods do not identify the area of use and that, as software used for “recording, organizing,

transmitting, and manipulating graphics, images, audio and video clips, movies, music video and photographs” could be used in any area, the area of use is not obvious from the function of the applied-for goods [para 134].

[48] In view of the foregoing, I accept that the Opponent has met its initial burden under this ground.

[49] In its written representations, the Applicant submits that an application “must clearly set forth [goods] or services as they are customarily referred to in the trade”, arguing that there is no evidence or argument that such is not the case in this proceeding and, as such, that the Opponent has not met its evidentiary threshold [para 92, citing *Pro Image Sportswear, Inc v Pro Image, Inc* (1992), 42 CPR (3d) 566 at 573]. However, as I have found that the Opponent has met its initial burden, the legal onus is on the Applicant to prove, on a balance of probabilities, that the application conforms with the requirements of section 30(a) of the Act. Furthermore, I note that the statement of goods as articulated in the application is not reflected anywhere in the marketplace evidence such that it is, on its face, “customarily referred to in the trade”, either by the Applicant or by third parties.

[50] The Applicant further submits that the applied-for goods are “sufficiently clear and specified in ordinary commercial terms when compared to entries in the Goods and Services Manual which CIPO has deemed acceptable”, listing nine purported examples of analogous acceptable listings; these examples include “computer software for creating and editing music”, “computer software for image processing”, and “computer software for processing digital music files” [para 95].

[51] However, these listings identify essentially single-function computer software goods. In contrast, the applied-for goods cover multiple functions (recording, organizing, transmitting, and manipulating) and multiple subjects (graphics, images, audio and video clips, movies, music video and photographs), without a clear area of use.

[52] In my view, it is at best not clear whether the statement is described in a sufficiently specific manner such that it is possible to assess confusion and/or whether the Mark is clearly descriptive of the applied-for goods. Even if the statement is considered sufficient to make such assessments, as discussed below with respect to the ground of opposition based on section 12(1)(d) of the Act, those assessments are simply not in the Applicant's favour in this case.

[53] Indeed, one of the reasons the section 12(1)(d) ground below is successful is that the applied-for goods are broad enough to overlap with the goods set out in Creative Technology Ltd.'s registration. Had the Creative registration further specified whether the software was for mobile applications or phones, this may have impacted the analysis. Similarly, it is not clear that the broadly-stated applied-for goods have a different function or area of use from the software goods aspect in that third-party registration.

[54] As such, I agree with the Opponent that software used for "recording, organizing, transmitting, and manipulating graphics, images, audio and video clips, movies, music video and photographs" is broad and could relate to many areas of use, not limited to software for mobile applications or for general consumer use as an app [Opponent's written representations at paras 134 to 136]. In this respect, while the application is based on proposed use, the evidence can be fairly interpreted to characterize the relevant goods as "mobile application software for general consumer use to add or simulate motion to digital photographs" or the like.

[55] Accordingly, in my view, more appropriate comparable listings in the *Goods and Services Manual* would include: "applications for mobile phones in the form of downloadable sports games" [active since 2014-03-20]; "computer software for organizing and viewing digital images and photographs" [2011-05-05]; "downloadable instant messaging software for electronically exchanging text messages, photographs, graphics, music, audio books, podcasts, and voice messages" [2021-07-08]; "downloadable applications for tablet computers to take and edit photographs" [2017-

11-14]; “downloadable applications for mobile phones to take and edit photographs” [2017-10-31].

[56] In any event, it is not for the Registrar to dictate to the Applicant what would have been an appropriate statement of goods; the Applicant knows its business and goods better than the Registrar. However, if it strategically applied for its Mark with a broadly-worded statement of goods, it did so at its own risk.

[57] In this case, I find that the statement is not in compliance with section 30(a) of the Act on its face, notwithstanding that the application proceeded through examination. I note that this may have been a function of the applied-for goods being amended *after* advertisement, which deleted portions of the statement which the examiner may have considered to provide sufficient context to make the “area of use” for the applied-for goods more obvious.

[58] In any event, at best for the Applicant, I find that it has not met its legal burden to demonstrate, on a balance of probabilities, that the applied-for statement of goods conforms with the requirements of section 30 of the Act.

[59] In view of the foregoing, the ground of opposition based on section 30(a) of the Act is successful.

30(E) GROUND – NON-CONFORMANCE

[60] Pursuant to section 38(2)(a) of the Act, the Opponent pleads that the application does not conform with the requirements of section 30(e) of the Act, because at the date of filing the application, namely September 9, 2015, at the deemed date of filing of the application, namely July 9, 2015, and at all material times, the Applicant did not intend to use the Mark by itself or through a licensee, or by itself and through a licensee, because:

- The Applicant did not intend to use the Mark as a “trademark”, within the meaning of section 2 of the Act; and

- The Applicant did not intend to “use” the Mark in relation to any good identified in the application, within the meaning of section 4 of the Act.

[61] Section 30(e) of the Act (as it read prior to June 17, 2019) stated:

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

... (e) in the case of a proposed trademark, a statement that the applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the trademark in Canada

[62] The application includes the requisite statement. However, in its written representations, the Opponent submits that the Applicant employs the Mark “as something other than a trademark – e.g. as the title and name of the Goods and the result produced by operation of the goods” [para 10(e)] and further that, as the Applicant’s software comes pre-installed on the Applicant’s proprietary iPhone devices and the Mark is not otherwise displayed on such phones, packaging, or insert materials, that the Mark is not being used by the Applicant within the meaning of section 4 of the Act [para 117]. As such, the Opponent submits that it is “reasonable to infer from this behaviour that, at the time the Application was filed,” the Applicant did not intend to use the Mark [para 118].

[63] However, I see no basis from the record as a whole from which such an inference can or should be made. The application is based on proposed use and the definition(s) of use in association with goods is broad, including association “in any other manner” that may or may not include the manner of display the Applicant has already employed to date.

[64] As such, I find that the Opponent has not met its initial evidential burden; accordingly, the ground based on section 30(e) of the Act is rejected.

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

[65] Pursuant to section 38(2)(b) of the Act, the Opponent pleads that, by virtue of section 12(1)(b) of the Act, the Mark is not registrable since it is clearly descriptive or

deceptively misdescriptive of the character or quality of the goods in association with which it is proposed to be used because:

- LIVE PHOTOS is the name and/or title of the applied-for “computer software” goods, and is the most certain way of identifying them; and
- LIVE PHOTOS clearly describes (or deceptively misdescribes) the function of the applied-for “computer software” goods.

[66] Furthermore, the Opponent 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 September 9, 2015, or the priority filing date, namely July 9, 2015.

[67] I note that the Opponent’s pleadings pursuant to sections 2, 12(1)(b), and 12(1)(c) of the Act are at least partially related, to the extent that the Opponent’s position includes it’s view that “live photos” is a generic term in the trade to identify a type of photograph, as addressed further below.

[68] 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 September 9, 2015.

[69] 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.

[70] 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)].

[71] 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. “Character” means a feature, trait or characteristic of the goods 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 [*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)].

[72] For a trademark to be considered deceptively misdescriptive, the trademark must mislead the public as to the character or quality of the goods. The trademark must be found to be descriptive so as to suggest the goods 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)].

[73] In its written representations, the Opponent submits that “As a matter of first impression, it is self-evident that the term ‘LIVE PHOTOS’ ... would be clearly understood to describe a character or quality of the [applied-for goods], namely that operation of the Applicant’s computer software produces photographs that ‘come alive’” and that consumers describe the Applicant’s computer software “as having this function and achieving this same result” [para 10(a)].

[74] The Opponent also submits that LIVE PHOTOS is the “title” of the applied-for computer software goods, submitting that the goods constitute a “literary work”. In this respect, the Opponent relies on the propositions that, i) titles of literary works are

necessarily descriptive and therefore cannot be trademarked and, ii) that computer software constitutes a literary work [paras 52 to 57]. However, even if I were to consider these propositions to be apt or logical, the Opponent's argument appears to be premised on a particular means of use or display of the Mark. However, the Mark is applied for on the basis of proposed use, and the applicable definitions of "use" as set out in section 4 of the Act are broad enough such that, at a minimum, the Mark could be associated with the Applicant's goods in a manner other than that of a "title".

[75] As such, I agree with the Applicant that this "literary work" aspect of the Opponent's 12(1)(b) ground of opposition cannot be successful. Indeed, accepting the Opponent's arguments would seem to result in any word mark applied for in association with "books" or the like would be necessarily susceptible if not objectionable under section 12(1)(b) of the Act. Furthermore, as the Act does not define "literary work", attempting to incorporate and apply definitions from other sources with no basis in the Act would result in a high degree of uncertainty bordering on absurdity.

[76] With respect to whether the Mark clearly describes a characteristic of the applied-for goods, as submitted by the Opponent [para 66], the term LIVE can function as an adjective that can mean, *inter alia*:

- [attributive] Not dead or inanimate; living (*Oxford English Dictionary*) [Dorval Affidavit, Exhibit 7]
- "to have life", "to exist in an active state", "being alive", and "possessing life" (*Wordsmyth Dictionary*) [Dorval Affidavit, Exhibit 7];
- "having life" (*American Heritage Dictionary*) [Dorval Affidavit, Exhibit 5].

[77] At the hearing, the Opponent submitted "live" does not necessarily narrowly mean live and in person – it can also mean animated, or giving the impression of moving or life. In this respect, I also note the following definition of "live" from *dictionary.com*:

adjective (prenominal) showing the characteristics of life

[78] The Opponent further notes that, on cross-examination, Ms. Dorval accepted a definition of “live” from the *Merriam-Webster* dictionary as meaning “to make or design in such a way as to create apparently spontaneous lifelike movement” [Q144].

[79] With respect to the word PHOTO, I agree with the Opponent that the Registrar can apply common sense and take judicial notice that “photo” is widely understood as meaning the term “photograph”, and that this term is defined as “a picture or likeness obtained by photography” [*merriam-websiter.com*].

[80] Accordingly, the Opponent submits that, when used together, LIVE PHOTOS clearly describes that such software is used to produce photographs that have the appearance of being alive [para 69].

[81] I accept that the foregoing definitions and argument are sufficient for the Opponent to meet its initial burden to put into issue the question of whether the Mark is clearly descriptive of a character of the applied-for goods.

[82] The Opponent further argues that the following evidence “reinforces” that the Applicant has not met its legal burden [Opponent’s written representations at paras 72 and 73]:

- Printouts from the Applicant’s website contain statements showing that when implemented, the software produces a photograph with movement that has the appearance of being alive [April 13 Bures Affidavit at para 14, Exhibit F];
- Statements made in the video “Apple Announces Live Photos!” include “when you swipe across [the image] you see a little bit of a moment of vitality a sense of how alive they are” and “you can set the Live Photo as your watch face. So every time you raise your arm, it comes alive as it’s telling you the time” [Huang Affidavit, Exhibit C];
- Statements on third-party websites that shows how the public (including users) describes the Applicant’s goods as operating to produce photographs that

appear alive [para 72, citing Horstman Affidavit at Exhibit B, Second Buress Affidavit at Exhibit B]; and

- The Applicant’s affiant, Mr. Brown, describing the result of operating the software as “many frames stitched together” that shows movement as “a long shutter frame photo” [Brown cross-examination at Q99 to Q103].

[83] Furthermore, the Opponent argues that other third-party mobile applications also employ the term LIVE PHOTO (or the plural) in the application title to connote the app’s function [referring to April 13 Buress Affidavit, paras 4 to 16, Exhibits A to E].

[84] Lastly, the Opponent submits that the evidence shows that third parties and the Applicant itself use the term LIVE PHOTO to descriptively identify the result produced by the Applicant’s software, i.e., a type of photograph, namely a “Live Photo” [paras 73 and 74].

[85] However, in its written representations, the Applicant submits that the word “live” has no common descriptive meaning in connection with the applied-for software goods [para 26]. It further submits that, in connection with photographs, the Mark is, at most, suggestive, because “[LIVE] is an incongruous, playful use of the word” and that the Mark “is fun because photographs are not actually alive” [para 29].

[86] As a feature of the Applicant’s software, the Applicant submits that the idea suggested by the Mark, 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 30].

[87] Indeed, even in context of the applied-for goods, 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.

[88] In view of the foregoing, I am satisfied that the Opponent has met its legal burden under this ground. Accordingly, the section 12(1)(b) ground is rejected.

12(1)(C) GROUND – NAME OF THE GOODS

[89] 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 in connection with which it is used or proposed to be used, that is LIVE PHOTOS is the name of the Applicant’s “computer software for use in recording, organizing, transmitting, and manipulating graphics, images, audio and video clips, movies, music video and photographs”.

[90] 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; *David Oppenheimer Co LLC v Imagine IP LLC*, 2011 TMOB 84 at para 46].

[91] In its written representations, the Opponent submits that “statements by the Applicant on its website show that the Applicant employs ‘Live Photos’ (and the singular ‘Live Photo’) as the name of the goods [para 83]. However, as discussed at the hearing, this argument appears to be a variation of the Opponent’s failed argument above that LIVE PHOTOS is the unregistrable “title” of the Applicant’s computer software.

[92] Indeed, even if I were to find that the Opponent’s evidence is sufficient to put this ground into issue, I would find that the Applicant has met its legal burden, for largely the same reasons as above under the section 12(1)(b) ground, notwithstanding the later material date.

[93] In this respect, I agree with the Applicant that the evidence does not show that the Mark is the generic name of the relevant software goods or of a particular type of photograph [Applicant’s written representations at para 55 to 64]. In particular, although

Mr. Buress confirms that he downloaded the aforementioned five third-party “LIVE PHOTOS”-formative apps, he was unable to attest to their function or the extent to which they had been downloaded, advertised or promoted in Canada [Buress cross-examination Q92 to Q97]. Similarly, with respect to the Google Trends report in the Dorval Affidavit, while the term LIVE PHOTOS may have been the subject of some Google searches prior to the filing of the subject application, the significance of this evidence is not clear.

[94] Accordingly, the section 12(1)(c) ground of opposition is rejected.

SECTION 2 GROUND – NON-DISTINCTIVENESS

[95] Per section 38(2)(d) of the Act and having regard to section 2 of the Act, the Opponent pleads that the Mark is not distinctive of the goods of the Applicant. In this respect, there are four branches to the Opponent’s pleading as follows:

- The term LIVE PHOTOS does not actually distinguish nor is it adapted to distinguish the goods of the Applicant in association with which it is intended 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 computer software that creates the impression of moving, or live, photographs (Branch One);
- The term LIVE PHOTOS is descriptive of the applied-for goods (Branch Two);
- The term LIVE PHOTOS is inherently descriptive because it is the only way to identify the applied-for “computer software” goods (Branch Three); and/or
- The term LIVE PHOTOS will neither be used nor perceived as a trademark because it describes the applied-for “computer software” goods (Branch Four).

[96] The material date for this ground is the filing date of the opposition, August 17, 2017 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

[97] 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.

[98] 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].

[99] In its written representations, the Opponent submits that the Mark lacks distinctiveness, as it plainly describes the function and result of the Applicant’s computer software goods, namely, to produce photos that “come alive”. The Opponent submits that the Mark is used descriptively, and further that it is the type of apt descriptive term that should remain free for use by other traders selling software that produces the same result [para 5]. The Opponent submits that, “as a matter of first impression, it is self-evident that the term ‘LIVE PHOTOS’ in association with the Goods would be clearly understood to describe a character or quality of the Goods, namely that operation of the Applicant’s computer software produces photographs that ‘come alive’” [para 10].

[100] In this respect, the Opponent further submits, *inter alia*, the following in its written representations:

- the Mark is a generic term for photos generated by the operation of the Applicant’s computer software, and that the term LIVE PHOTO denotes a type of photograph, similar to the terms COLOUR PHOTO or DIGITAL PHOTO [para 6];
- other traders employ the term LIVE PHOTOS in connection with mobile applications/computer software, and that such applications were downloaded to a mobile device in Canada by Mr. Bures [para 10].

[101] The Opponent also relies on a decision of the European Intellectual Property Office that found the term LIVE PHOTOS to be “a descriptive indication and absent of distinctive character in association with the Goods, and not registrable” [para 90, citing

EUIPO Case R 1485/2017-2 (12 January 2018)]. On this point, I note that the Registrar is not bound by the foreign EUIPO and USPTO decisions referenced by the Opponent in its representations and discussed by the parties at the hearing.

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

[103] Accordingly, I consider it sufficient that, with respect to Branch Two and Branch Three of this ground, even if I accept that that the Opponent has met its initial burden, for reasons substantially similar to those discussed above under the 12(1)(b) ground, I find that the Applicant has met its legal onus, notwithstanding the later material date.

[104] Similarly, with respect to Branch Four, to the extent this pleading is essentially a mix of the Opponent's pleadings pursuant to sections 12(1)(b) and 30(e) of the Act, for essentially the same reasons above, I find that the Applicant has met its legal onus.

[105] As for Branch One of this ground, I agree with the Applicant that the evidence does not establish that, prior to the material date, that the term LIVE PHOTOS was *commonly* used in the trade, in particular with respect to "computer software that creates the impression of moving, or live, photographs".

[106] In this respect, again, I note that Mr. Buress downloaded the five third-party "LIVE PHOTOS"-formative apps in 2018 and it is not clear whether at least three of those apps existed prior to the August 2017 material date. For the two apps that appear to have existed in April 2017, the meaning of and references to "LIVE PHOTOS" is at best ambiguous (13 April Buress Affidavit at Exhibits A and E). In any event, again, Mr. Buress was unable to speak to the function of these apps or their distribution in Canada.

[107] Referencing the Dorval Affidavit, the Opponent further notes that the term "live photos" was searched by Canadians through the Google search engine prior to the September 2015 application filing date, i.e., the earliest date on which the Applicant could have used the Mark in Canada; the Opponent submits that this is consistent with

the Mark being a generic phrase, and not distinctive of the Applicant [Opponent's written representations at para 95].

[108] However, in my view, this also falls short of establishing that LIVE PHOTOS was a term commonly used in the trade to refer to software that creates the impression of moving photographs. This is in contrast to the analysis under the 12(1)(d) ground below, which does not turn on the relevant software goods being particularly for the creation of moving photographs.

[109] As discussed above, while the Mark has low inherent distinctiveness, 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 akin to "digital photograph" or "colour photograph", or that the Mark is clearly descriptive of the applied-for goods.

[110] As each branch of the ground as pleaded fails, even if the proper approach was to consider the pleading as a whole rather than as four distinct pleadings, I would come to the same conclusion, that the Applicant meets its legal onus under this ground.

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

12(1)(D) GROUND – CONFUSING WITH A REGISTERED TRADEMARK

[112] Per section 38(2)(c) of the Act, the Opponent pleads that the Mark is not registrable because it is confusing with registration No. TMA644035 for the trademark LIVE!, owned by Creative Technology Ltd. (Creative). The LIVE! trademark is registered in association with the following goods in Nice class 9:

Computer hardware, computer peripherals and computer software for the integration of text, graphics, and still images for use with a personal computer for home entertainment and manuals sold as a unit.

[113] The material date with respect to confusion with a registered trademark is the date of this decision [*Simmons Ltd v A to Z Comfort Beddings Ltd*, 1991 CarswellNat 1119 (FCA)]. As the LIVE! registration is extant on the register, the Opponent meets its initial burden. In this respect, I note that the Opponent is permitted to rely on the

registration of another party under this ground [see *USV Pharmaceuticals of Canada Ltd v Sherman and Ulster Ltd* (1974), 15 CPR (2d) 79 (TMOB)].

[114] Accordingly, the Applicant must establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the LIVE! trademark.

[115] I note that neither party directly addressed this ground in their respective written representations; however, the ground was addressed by both parties at the hearing.

Test to determine confusion

[116] 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.

[117] 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 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 Clicquot Ltée*, 2006 SCC 23 at para 20].

[118] In making such an assessment, all the relevant surrounding circumstances must be taken into consideration, 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 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.

[119] The criteria or factors 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 at para 54]. In *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 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 consider whether there is an aspect of the trademark that is particularly “striking or unique” [at para 64].

Inherent Distinctiveness and the Extent Known

[120] At this point, I note that four of the Applicant’s affidants were employed by the Applicant’s trademark agent at the time of filing, Baker & McKenzie LLP.

[121] As discussed at the hearing, to the extent one is meant to draw conclusions or make inferences from such affidavits regarding the Applicant’s use of the Mark – including the length of use, the extent to which the Applicant’s Mark has become known, the distinctiveness of LIVE PHOTOS, and the nature of the relevant goods, business and trade – those affidavits largely constitute hearsay. As the Applicant appeared to acknowledge to some extent at the hearing (noting that the Opponent’s evidence was similarly problematic), evidence dealing with such matters are central to the determination of the issues in this case, and of the assessment of confusion and distinctiveness in particular. Accordingly, they should have been introduced by a knowledgeable and competent individual, e.g., from the Applicant or a licensee, and not by an employee or employees of the Applicant’s agent. Generally speaking, an affidavit of an employee of an agent’s firm is admissible only to the extent that the evidence relates to non-controversial and non-central matters [*Cross Canada Auto Body Supply (Windsor) Limited et al v Hyundai Auto Canada*, 2005 FC 1254, aff’d 2006 FCA 133].

[122] Accordingly, while not entirely hearsay, I agree with the Opponent that little weight should be given to the Badenhorst, Davenport and Perreira affidavits, in particular in assessing the confusion factors in this case.

[123] Similarly, the Opponent questions the value of the Brown Affidavit – even if Mr. Brown is an expert in the field of blockchain technology, there is no indication that the Applicant’s LIVE PHOTOS software is related to blockchain technology and it is not

clear that Mr. Brown's assertions regarding the purported uniqueness of the Applicant's goods should be given any weight [Opponent's written representations at para 33].

[124] In any event, throughout its representations, the Opponent submits that the Mark lacks inherent distinctiveness. It further notes that the evidence of actual use of the Mark is limited, if not non-existent, in terms of the definitions of "use" set out in section 4 of the Act [paras 8 and 9].

[125] With respect to the registered LIVE! trademark, the exclamation point gives that trademark a slightly greater degree of inherent distinctiveness. However, while the registration indicates that a declaration of use was filed on June 15, 2005, there is no evidence of use or extent known before me. In contrast, notwithstanding the problematic and hearsay nature of much of the evidence discussed above, I accept that the Mark has become known at least to some extent in Canada.

[126] Accordingly, overall, I find that this factor favours the Applicant, albeit not to a significant extent.

Length of Time in Use

[127] Again, notwithstanding the aforementioned declaration of use, neither party furnished evidence of use of the registered LIVE! trademark.

[128] With respect to the Mark, it is at best unclear when it was first used in Canada in association with the relevant goods. As discussed above, while Mr. Brown, for example, states that he is "familiar with the LIVE PHOTOS pre-installed software", it is not clear how or whether any such familiarity was due to "use" of the Mark within the meaning of section 4 of the Act [Opponent's written representations at para 109].

[129] Accordingly, this factor favours neither party.

Nature of the Goods or Business / Nature of the Trade

[130] When considering the nature of the goods of the parties in respect of the issue of confusion, it is the statements of goods in the subject application and registration that

govern [*Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CarswellNat 749 (FCA); *Miss Universe Inc v Bohna*, 1994 CarswellNat 1443 (FCA)].

[131] While the statements of goods differ somewhat, I consider the “integration of text, graphics, and still images” aspect in the LIVE! registration overlaps with the functions and subjects of the broadly-worded software goods as set out in the application for the Mark. Furthermore, I consider there to be potential overlap in that the “computer hardware, computer peripherals and computer software ... for use with a personal computer...” described in the LIVE! registration could be broad enough to encompass mobile devices such as those of the Applicant.

[132] There does appear to be some difference – “sold as a unit” indicates that Creative’s software is not sold separately. However, the evidence indicates that the Applicant’s software is also not sold separately, but rather as part of the “black box” that is the purchase of an iPhone [per Brown cross-examination at Q74 to Q77].

[133] Again, at best, it is not clear, and the onus is on the Applicant to demonstrate that the nature of the relevant goods differ.

[134] Similarly, there is no evidence regarding Creative’s business or trade. In this respect, while the Applicant alleged at the hearing that the Opponent admitted that the businesses of the Applicant and Creative do not overlap, at most I consider the Opponent’s submissions to indicate that he did not know if the businesses overlapped. In any event, the onus remains on the Applicant.

[135] In view of the foregoing, at a minimum, I accept there is the potential for overlap in the nature of the parties’ goods, businesses, and trades to some extent.

[136] Accordingly, these factors favour the Opponent.

Degree of Resemblance

[137] In this case, I consider there to be a significant degree of resemblance between the Mark and the registered LIVE! trademark.

[138] At a minimum, the first portion of both trademarks is the same. While the exclamation point creates some visual difference and the word PHOTOS adds a difference when sounded, I consider the first LIVE portion of each trademark to be the striking element, especially considering that PHOTOS is descriptive in association with the relevant goods.

[139] Accordingly, this factor favours the Opponent.

Additional Surrounding Circumstance – State of the Register and Marketplace

[140] I note that state of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [*Ports International Ltd v Dunlop Ltd*, 1992 CarswellNat 1431 (TMOB); and *Welch Foods Inc v Del Monte Corp*, 1992 CarswellNat 178 (FCTD)]. Such inferences can only be drawn from state of the register evidence where large numbers of relevant registrations are located [*Maximum Nutrition Ltd v Kellogg Salada Canada Inc*, 1992 CarswellNat 124 (FCA)]. As such, I do not consider the certified copies of the Applicant’s LIVETYPE and LIVE LISTEN registrations to be significant.

[141] Similarly, I do not consider the evidence relating to third-party LIVE-formative trademarks in Canada as set out in the Dorval Affidavit to be significant [paras 4 to 7, Exhibits 2 to 4]. In this respect, the extent to which such LIVE-formative trademarks have been used in the Canadian marketplace is unclear and, in any event, I consider such trademarks to be sufficiently different in resemblance and/or in the nature of the associated goods and services [Exhibits 2 and 3]. Even where the associated goods appear to be in the nature of software, the function of such software does not appear to overlap with the broadly-stated applied-for goods or those set out in the Creative registration (e.g., ESCORT LIVE appears to be associated with a traffic radar detection app, per Exhibit 3).

[142] Although submitted by the Opponent in support of its position that the Mark is not distinctive, I also note the evidence of third-party use of “LIVE” in the marketplace in association with computer software, in the form of the five mobile apps downloaded by

Mr. Buress in 2018 [April 13 Buress Affidavit]. However, again, the extent of such use is unclear.

[143] Accordingly, I only consider such third-party use in the marketplace to nominally favour the Applicant under this ground.

Additional Surrounding Circumstance – Co-Existence in Other Jurisdictions

[144] The Dorval Affidavit indicates that the Mark is registered in over 100 jurisdictions, including five jurisdictions where Creative's LIVE! trademark is also registered – Brazil, Peru, Singapore, New Zealand, and Australia [paras 13 and 14, Exhibit 10]. Even if I were to accept this co-existence on foreign-jurisdiction trademark registers as a surrounding circumstance in the Applicant's favour, I do not consider it to be significant or determinative in the overall assessment on the issue of confusion in this case. In this respect, the test for confusion here contemplates the casual consumer with imperfect recollection – the average casual consumer would be unaware of the co-existence of the subject trademarks in other jurisdictions.

Conclusion – Confusion with the Registered Trademark

[145] As mentioned above, the degree of resemblance between the parties' trademarks is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

[146] Having considered all of the surrounding circumstances, at best for the Applicant, I find the balance of probabilities regarding the likelihood of confusion as to the source of the Applicant's goods and the goods of Creative to be evenly balanced. I reach this conclusion due to the high degree of resemblance between the parties' trademarks and the potential overlap in the nature of the parties' goods, business and trades, and notwithstanding some evidence of third-party LIVE-formative trademarks in the marketplace.

[147] In view of the foregoing, the section 12(1)(d) ground of opposition based on confusion with the LIVE! registered trademark is successful.

SECTION 30(i) GROUND – NON-CONFORMANCE

[148] Per section 38(2)(a) of the Act, the Opponent pleads that the application does not conform to the requirements of section 30(i) of the Act, as the Applicant could not have been satisfied when it filed the application, or at any material time, of its entitlement to use the Mark in Canada in association with the applied-for goods. In particular, the Opponent alleges, including as of June 17, 2019, that the application was filed in bad faith, because the Applicant declared it was entitled to claim under section 34 of the Act, the July 9, 2015 filing of Jamaica application no. 67593 as the deemed filing date of the application in Canada. However, on the date the priority filing claim was made in the application, and 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.

[149] The Opponent submitted no evidence in support of this ground and nothing in the record puts into question the Applicant's statements regarding its claimed priority filing date or its entitlement to use the Mark in Canada.

[150] Accordingly, the ground based on section 30(i) of the Act is rejected.

DISPOSITION

[151] 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 refuse the application.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2022-09-01

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.