

Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 155

Date of Decision: 2023-08-31

IN THE MATTER OF AN OPPOSITION

Opponent: Via Rail Canada Inc.

Applicant: Via Transportation, Inc.

Application: 1,870,039 for VIA & Design

INTRODUCTION

[1] Via Transportation, Inc. (the Applicant) has applied to register the trademark VIA & Design reproduced below (the Mark) for use in association with the transportation of passengers by vehicle and related mobile application software and telecommunication services.



[2] The Mark features of a large, downward-pointing teardrop shape with a circular hole in the centre—of the type used to represent location pins on digital maps—above the word “via” in small, lower-case lettering.

[3] Via Rail Canada Inc (the Opponent) opposes the application, based primarily on an allegation that the Mark is confusing with the Opponent's trademarks, official marks, and trade names consisting of or containing the word "VIA", used in association with the Opponent's national railway and related goods and services (respectively the Via Rail Trademarks, Via Rail Official Marks, and Via Rail Trade Names, and collectively the Via Rail Marks & Names). The particulars of the Opponent's pleaded trademark registrations for the Via Rail Trademarks (the Opponent's Registrations) and of the pleaded Via Rail Official Marks are set out at respectively at Schedules A and B to this decision.

[4] For the reasons that follow, I refuse the application.

THE RECORD

[5] Application no. 1,870,039 for the Mark (the Application) was filed on November 28, 2017, based on proposed use in Canada in association with the following goods and services:

Goods (Nice class & statement)

- 9 Mobile application software for connecting drivers and passengers; mobile application software for automated scheduling and dispatch of motor vehicles; mobile application software for coordinating transportation services; mobile application for engaging transportation services

Services (Nice class & statement)

- 38 Telecommunications services, namely, routing calls, SMS messages, and push-notifications to transportation providers and riders
- 39 Transportation of passengers by motorized vehicle; transportation of passengers by vehicle through a network of transportation providers

[6] The Application was advertised for opposition purposes in the *Trademarks Journal* on December 18, 2019, and opposed on June 3, 2020, when the Opponent filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The Applicant filed a counter statement denying each of the allegations set forth in the statement of opposition.

[7] The grounds of opposition allege that the Application does not conform to the filing requirements of sections 30(2)(a) and 30(2)(d) of the Act; that the Mark is not registrable under sections 12(1)(d) and 12(1)(e) of the Act; that the Applicant is not the person entitled to registration under sections 16(1)(a) and 16(1)(c) of the Act; that the Mark is not distinctive within the meaning of section 2 of the Act; that the Applicant was not using and did not propose to use the Mark in Canada, pursuant to section 38(2)(e) of the Act; and that the Applicant was not entitled to use the Mark in Canada, pursuant to section 38(2)(f) of the Act. In accordance with section 69.1 of the Act, since the Application was advertised after the Act was amended on June 17, 2019, the grounds of opposition will be assessed based on the Act as amended.

[8] In support of its opposition, the Opponent filed (i) the January 21, 2021 statutory declaration of its agent's law clerk Mathilde Garneau-Lebel, who introduces register extracts for the Via Rail Trademarks and Via Rail Official Marks, and (ii) the October 6, 2021 statutory declaration of its managing director of communications and marketing, Louis Lévesque, who describes the Opponent's operations and its use and promotion of the Via Rail Marks & Names. Mr. Levesque's declaration was substituted for the substantively identical, April 14, 2021, statutory declaration of the Opponent's chief commercial officer, Martin R. Landry, when Mr. Landry could not be made available for cross-examination. Mr. Lévesque was cross-examined on his statutory declaration and the transcript is of record.

[9] I note that Mr. Lévesque also expresses an opinion on the extent to which the Opponent's brand is known in Canada, which he states is based on his years of management experience in commercial marketing and consumer perceptions [para 27]. Mr. Lévesque holds degrees in business administration and marketing and has, since 1995, worked in the fields of trademarks and marketing, including in various management positions [para 1]. Under cross-examination, he confirmed that in his career he has conducted studies and surveys of customer perceptions, including for the Opponent [transcript Q97-Q104]. However, Mr. Levesque has not included any such research with his statutory declaration or otherwise indicated the facts and assumptions

on which his opinion is based, and I note that he is not independent of the parties. In the circumstances, his opinion on this question of fact has been disregarded.

[10] In support of the Application, the Applicant filed the May 27, 2021 affidavit of its agent's legal secretary Karen Lau Cardinell, who introduces the results of (i) register searches for trademarks containing the word VIA that she conducted using the SAEGIS online search platform on April 11, 2022, attached as Exhibits A and B to her affidavit; and (ii) Internet searches for references to the Applicant or its business that she conducted using the Google search engine on April 14, 2022, attached as Exhibits C, D, E, and F to her affidavit.

[11] Both parties filed written representations and were represented at an oral hearing.

EVIDENTIAL BURDEN AND LEGAL ONUS

[12] In an opposition proceeding, the legal onus is on the applicant to show that its application complies with the provisions of the Act. However, for each ground of opposition, there is an initial evidential burden on the opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist. If this initial burden is met, then the applicant must satisfy the Registrar, on a balance of probabilities, that the ground of opposition should not prevent registration of the trademark at issue [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)].

GROUND OF OPPOSITION SUMMARILY DISMISSED

[13] At the oral hearing, the Opponent conceded that the evidence of record is insufficient for the Opponent to meet its evidential burden with respect to the grounds of opposition based on non-compliance pursuant to sections 30(2)(a), 30(2)(d), 38(2)(e), and 38(2)(f) of the Act. Accordingly, these grounds of opposition are rejected.

REGISTRABILITY UNDER SECTION 12(1)(D) OF THE ACT

[14] The Opponent pleads that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act, because the Mark is confusing with the Via Rail Trademarks that are the subject of the Opponent's Registrations.

[15] The material date for this ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)]. An opponent's initial burden is met if the registration relied upon is in good standing on the material date and the Registrar has discretion to check the Register in this respect [per *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised this discretion, I confirm that all of the registrations set out at Schedule A to this decision are in good standing.

[16] The Opponent having met its evidential burden, the onus is on the Applicant to satisfy the Registrar, on a balance of probabilities, that the Mark is not likely to cause confusion with any of the Via Rail Trademarks covered by the Opponent's Registrations.

[17] In considering the issue of confusion, I will focus my discussion on the Opponent's VIA Design trademark, registered under no. TMA278,895 for use in association with "operation of a national railway for the transportation of passengers and the provision of such other services as normally performed by a national passenger train service". I consider this trademark to represent the Opponent's best chance of success, given the absence of separate word or design elements and the nature of the associated services.

The test for confusion

[18] Two trademarks will be considered confusing 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 in the same class of the international Nice Classification system [section 6(2) of the Act].

Thus, the test for confusion does not concern confusion of the trademarks themselves but rather confusion as to whether the goods and services associated with each party's trademark come from the same source. Where it is likely to be assumed that the applicant's goods or services either come from the opponent or are approved, licensed, or sponsored by the opponent, it follows that the trademarks are confusing [see *Glen-Warren Productions Ltd v Gertex Hosiery Ltd* (1990), 29 CPR (3d) 7 (FCTD)].

[19] The test is to be applied as a matter of first impression in the mind of a casual consumer somewhat in a hurry, who sees the applicant's trademark at a time when he or she has no more than an imperfect recollection of the opponent's trademark and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the trademarks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23]. Regard must be had to all the surrounding circumstances, including those set out in sections 6(5)(a) to (e) of the Act, but these criteria are not exhaustive and the weight given to each factor will vary in a context-specific analysis [*Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22].

Section 6(5)(e): Degree of resemblance between the trademarks, including in appearance or sound or in the ideas suggested by them

[20] The degree of resemblance between the trademarks at issue is often the factor likely to have the greatest effect on the confusion analysis and, thus, is an appropriate starting point [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27]. Each trademark must be considered as a whole and assessed for its effect on the average consumer as a matter of first impression; it is not the proper approach to set the trademarks side by side and carefully examine them to tease out similarities and differences [*Masterpiece; Veuve Clicquot*]. However, it is still possible to focus on particular features of each trademark that may have a determinative influence on the public's perception of it [per *United Artists Pictures Inc v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 (FCA)]. Indeed, the preferable approach is to begin by determining whether there is an aspect of each trademark that is "particularly striking or unique" [*Masterpiece* at para 64].

[21] The Opponent's VIA Design trademark consists of the word VIA in stylized capital lettering formed by a series of short, thick, vertical and forward slanting strokes:



[22] I find a striking aspect of this trademark to be its simplicity and regularity: the word VIA presented as a pattern of repeating parallel lines with an overall block shape and rotational symmetry (looking the same turned 180 degrees).

[23] The Mark features the word VIA in different, lower-case lettering, with an imposing pin icon over the letter "i". As was alluded to in the statement of opposition, the shape of the letter "a" also somewhat echoes the approximate shape of a pin icon. As an additional design feature, the large location pin graphic is cut in half horizontally by opposite-facing arcs on either side of the inner circle, as shown below:



[24] I find the dominant pin icon pointing to the word "via" to be the most striking feature of the Mark visually, by virtue of its sheer size and towering position. The first element of a trademark is generally considered to be important for the purpose of distinction [see *Conde Nast Publications Inc v Union des Éditions Modernes* (1979), 46 CPR (2d) 183 (FCTD)]. However, I cannot discount the impression on the consumer of the word component VIA anchoring the pin icon.

[25] The two trademarks highly resemble each other phonetically and in general ideas suggested, given that both feature the word VIA as the only word element. However, there is little resemblance visually, owing to the different design features, including in the lettering. The VIA Design has only straight lines and is very angular overall, whereas the Mark has predominantly rounded elements and is visually dominated by the large pin icon. There are also differences in the specific ideas suggested. Particularly, the visually dominant pin icon in the Mark suggests a location on a digital map. I note that

the Applicant proposes additional ideas suggested, for example, submitting that the symmetry of the Opponent's VIA Design suggests trains moving reliably along the same tracks whether coming or going, and that the Mark's configuration suggests consumers being brought to their destination with more precision than is possible in a train, and having the Applicant's technology available wherever they go [written representations at page 4]. However, I do not find that these additional suggestions would be evident to consumers as a matter of first impression.

[26] The Opponent submits that the pin icon does not detract from the high degree of resemblance because it is conceptually too insignificant to be considered a distinguishing feature. In the Opponent's submission, consumers would tend to identify the Mark by its verbal portion, such that resemblance in sound and ideas suggested outweighs lack of visual similarity. In support, the Opponent cites *Joey Tomato's (Canada) Inc v 1786328 Ontario Ltd*, 2019 TMOB 17, where the Registrar found a fair degree of resemblance between the trademarks LOCAL and LOCALE & Design despite a dominant rooster silhouette above the word LOCALE; *Nada Fashion Designs Inc v Groupe Boyz Inc*, 2011 TMOB 155, where the Registrar found that a star-in-circle shape integrated with the letter "O" was insufficiently significant to distinguish the trademark NO NADA & Design; and *Ferrero SpA v A & V 2000 Inc*, 2017 TMOB 84, where the Registrar found resemblance between the trademarks NUTELLA and NUTERRA & Design despite the latter's distinctive font and design of a person with a bowl above the word NUTERRA. However, I note that in each of these cases, the opponent was invoking a word mark, whereas in the present case, the Opponent's trademark is in a specific form of stylized lettering that differs from the style of lettering in the Mark.

[27] By contrast, the Applicant submits that the trademarks at issue in the present case do not create the same overall impression, even on a passing glance, and that to ignore the notable visual differences by focussing only on the word elements and phonetic similarity is the wrong approach. The Applicant argues that the word VIA itself is not inherently distinctive because it is a preposition that evokes "routing by means of" or "traveling through a route to arrive at a destination", and, as such, relates directly to the provision of rail transportation, while merely alluding to vehicle routing software

[written representations at page 12]. The Applicant further submits that the word VIA, in fonts more similar to the Opponent's, is common in trademarks (as will be further discussed below). In the circumstances, the Applicant stresses the importance of the large pin icon over the letter "i" in the Mark. In the Applicant's submission, the pin icon actually forms an integral part of the word's stylization, acting as the dot of the lower-case "i" [at page 9]. However, while not determinative, I note that the exhibited examples of the Applicant's advertising, discussed below, do not necessarily support this interpretation, as they show a variation of the Mark wherein the word "via" appears either without the pin icon or to its right, in comparably sized lettering, without any dot on the letter "i".

[28] It is well established that, when a portion of a trademark is a common descriptive or suggestive word, its importance diminishes [see *Merial LLC v Novartis Animal Health Canada Inc.* (2001), 11 CPR (4th) 191 (FCTD)]. Accordingly, there may be a tendency to discount somewhat the importance of the word VIA in trademarks associated with travel and transportation, to the extent that this word suggests, in both English and French, the notion of a route or means of transit or, as suggested by the Opponent, the idea of "passing through". However, given that both the Opponent's trademark and the Applicant's trademark have VIA as their *only* word element, and feature only relatively simple designs whose connotations are arguably also transit-related, I do not find that the word VIA would be significantly discounted in either trademark in the present case. In my view, a geographic location pin, which may suggest a route's start, end, or transit points, is at least as suggestive of travel and transportation services. I would also note that the lettering of the word VIA in the Mark is quite simple. Although the Applicant argues that the dot of the "i" is the giant pin icon, and I find that the shape of the letter "a" also subtly resembles a pin icon shape, I do not find that either effect would necessarily be appreciated by consumers as a matter of first impression. In this respect, I note that the diminutive size of the word "via" in the Mark would make the features of its font more difficult to notice as a matter of immediate impression, particularly in situations where the display of the Mark in its entirety is also relatively small.

[29] Overall, I find that the degree of resemblance between the two trademarks is relatively high, owing to the phonetic and conceptual similarities, and despite the visual differences in presentation. Although I find the location pin design to be the Mark's dominant feature, the Mark nevertheless also includes the word VIA as the only word element, in a relatively simple font. Accordingly, this important factor favours the Opponent.

Section 6(5)(a): Inherent distinctiveness of the trademarks

[30] Trademarks comprising rare, arbitrary, or invented words are generally considered to be more inherently distinctive than trademarks consisting of everyday dictionary words or words of a descriptive or suggestive character [see *Joseph E Seagram & Sons Ltd v Canada (Registrar of Trade Marks)* (1990), 33 CPR (3d) 454 (FCTD); and *YM Inc v Jacques Vert Group Ltd*, 2014 FC 1242]. An original design is also considered to be inherently distinctive whereas trademarks comprising simple line patterns or geometric shapes are generally not [see *Tommy Hilfiger Licensing Inc v Produits de Qualité IMD Inc*, 2005 FC 10; and e.g. *Levi Strauss & Co v Vivant Holdings Ltd* (2003), 34 CPR (4th) 53 (TMOB)]. Inherently distinctive trademarks “strike the imagination and become more firmly rooted in the consumer’s memory”; as such, they are generally accorded a greater degree of protection [see *G M Pfaff Aktiengesellschaft v Creative Appliance Corp Ltd* (1988), 22 CPR (3d) 340 (FCTD) at para 7]. Trademarks lacking in distinctiveness are only entitled to a narrow ambit of protection, in the sense that a greater degree of discrimination may fairly be expected from the public and relatively small differences between the trademarks may suffice to avert confusion [see *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)].

[31] I find that the Opponent's VIA Design trademark possesses a moderate level of inherent distinctiveness. Although the preposition VIA conveys the notion of a route or means of transit, I find it to be at most suggestive, rather than descriptive, of railway or passenger train services. Visually, the effect of the VIA Design trademark is that of a relatively simple line pattern; however, I find the degree of repetition and symmetry achieved in rendering the three different letters—replacing some diagonal strokes with

vertical ones (in the V and A) and *vice versa* (in the I)—provides some visual and conceptual interest. Insofar as the overall design might evoke the idea of railway tracks, I find the visual suggestion too subtle to affect the trademark’s overall level of inherent distinctiveness to any notable extent.

[32] I also find the Mark to have a moderate level of inherent distinctiveness. The preposition VIA is at most suggestive of the associated goods and services, namely passenger transportation as well as mobile apps and telecommunication services for arranging routes and means of transport. Contrary to the Applicant’s submissions, I do not find the allusion to the Applicant’s goods and services to be significantly less direct than the allusion to the Opponent’s services. The pin icon is a relatively simple geometric design and it too is suggestive of passenger transportation and related mobile apps and telecommunication services, to the extent that it suggests a destination or point en route, as pinpointed on a digital map, including in the context of mobile communications. When the Mark is considered as a whole, the word “via” under the pin may suggest a location “via” which transit occurs or a destination reached “via” some means. I also agree with the Opponent that it could suggest a location identified as “Via”, such as a business or service with that name, being in a particular location or being itself a consumer destination. I find the two arcs going in opposite directions a relatively subtle feature that has only a minor impact on the Mark’s level of inherent distinctiveness.

[33] The Applicant submits that the Mark is much more inherently distinctive than the Opponent’s VIA Design trademark because the Opponent’s trademark merely reproduces the word VIA in an italic, capitalized font with the bar removed from the A, whereas the Mark contains a much more unique design feature that goes beyond the word itself, including the lowercase “a” and the large icon over the “i”. However, I find that the stylization of the Opponent’s trademark to be more distinctive than mere italics and a missing bar; it features a combination of very thick strokes, a diagonal letter I to create the effect of three parallel lines, vertical stroke on either side to create the overall shape of a rectangular block, and rotational symmetry, resulting in a certain visual impact. In comparison, the shape of the letters in the Mark exhibits only minimal

stylization, and thus contributes only minimally to the inherent distinctiveness of the Mark, particularly as the word element in the Mark is relatively small.

[34] Overall, I find the two trademarks at issue to have a comparable level of inherent distinctiveness, both being moderately inherently distinctive.

Section 6(5)(a): Extent to which the trademarks have become known

[35] A trademark's distinctiveness can be enhanced through use and promotion. Only the Opponent filed probative evidence in this respect.

[36] Although Ms. Lau Cardinell's affidavit includes screenshots from the Applicant's website, LinkedIn profile, and Wikipedia entry, as well as from the App Store and Google Play pages selling the Applicant's mobile, there is no indication that the Applicant has begun operating under the Mark in Canada or that any Canadians have visited the aforementioned sites. I note that the Wikipedia entry mentions the Applicant operating in partnership with local governments in over 20 countries globally, including Canada; however, this evidence constitutes double hearsay that has not been shown to be necessary or reliable and, in any event, does not address whether or how the "operations" might involve the Mark. Accordingly, Ms. Lau Cardinell's evidence does not establish that the Mark has become known in Canada to any extent since the Application was filed.

[37] As for the Opponent's evidence, Mr. Lévesque explains that the Opponent is an independent Crown corporation operating a national passenger railway service on behalf of the Canadian government. Founded in 1977, it offers over 450 departures every week on over 12,500 km of train tracks linking over 400 Canadian communities [para 5]. According to Mr. Lévesque, the Via Rail Marks & Names are used in close association with all of the Opponent's transportation services, including on passenger and maintenance vehicles, staff uniforms, signage, tickets, a ticket sale and informational app, the Opponent's website, and other marketing and promotional materials [paras 8–9].

[38] Mr. Levesque notes that the Opponent provides its reservation and ticket sale services at the counter, through its ReserVIA online reservation service, and through its mobile app [paras 19, 22]. Average annual ticket sales through ReserVIA exceeded 2 million in the period 2011-2019, while those through mobile Web (accessing the Opponent's website by smartphone) exceeded 135 thousand in the period 2012-2019 and those through the Opponent's app exceeded 175 thousand in the period 2015-2019 [para 22]. Ridership figures in Canada from 2010 to 2019 ranged from 3.8 million to 5 million passengers per year and the Opponent's sales revenues over the same period ranged from over \$270 million to over \$410 million [paras 12-13].

[39] Since 2009, the Opponent's marketing and promotion has been done through newspapers, magazines, social media, the Internet, billboard advertising, radio and television [paras 14, 16–17]. Mr. Lévesque states that, as of his October 2021 declaration, advertising expenditures in Canada for each of the last ten years had varied between \$4 million and \$13 million, averaging close to \$10 million per year [para 15]. He further states that, between 2010 and 2020, the Opponent's website received over 10 million unique visitors from Canada per year [para 21].

[40] To provide an overview of the Opponent and its infrastructure projects and to give some examples of its activities, marketing, and branding, Mr. Levesque attaches to his statutory declaration the Opponent's annual reports from 2016 to 2019 and two printouts from its corporate website at *corpo.viarail.ca* [Exhibits A-1 to Exhibits A-5]. The printouts are dated April 1, 2021, but Mr. Levesque confirms that they are representative of the Opponent's mission and activities since at least 2010 [para 7].

[41] To the extent that these materials are furnished for the truth of their contents, I find them to be admissible. The documents originate from the Opponent and are akin to business records. Furthermore, Mr. Levesque confirms that, by virtue of his position as the Opponent's managing director of communications and marketing, he has personal knowledge of the Opponent's marketing and trademark and trade name use and has access to all the relevant business documents and corporate information in this regard [paras 1–2, transcript Q18]. In the circumstances, I consider Mr. Levesque to be

adopting the contents of the furnished annual reports and webpages insofar as they concern the Opponent's mission, activities, marketing, and branding, and I note that it was open to the Applicant to challenge Mr. Levesque's evidence in this regard by cross-examination. I do not find it problematic that Mr. Levesque only assumed his position with the Opponent in August 2020 [transcript Q7–Q8], given his access to the Opponent's business records and given that he had over a year to become familiar with the Opponent's general practices.

[42] The exhibited annual reports and website extracts display the Opponent's VIA Design trademark on various pages and also include photographs showing it displayed on trains, station signage, related equipment, advertising, and promotional items. Various additional examples of the Opponent's VIA Design trademark displayed in the performance and advertising of the Opponent's services are also attached as exhibits to Mr. Levesque's statutory declaration, and these include photographs of trains, stations, and stop signage [Exhibits A-7 and A-9]; copies of tickets, boarding passes, and itineraries [Exhibit A-6]; screenshots from the Opponent's mobile app and passenger website at www.viarial.ca [Exhibits A-10 to A-11]; and recordings of the Opponent's audio and video advertising [Exhibit A-8].

Evidentiary issue

[43] With respect to the last exhibit mentioned above, I note that Mr. Levesque indicates, at paragraphs 16 to 17 of his statutory declaration, that Exhibit A-8 includes representative examples of advertising not only through the media of radio, television, and web videos, but also through print media, web banners, and promotional signage. Moreover, he provides a summary table listing one example of advertising per year from 2010 to 2020, specifying for each example both the medium and the specific location where the advertisement appeared, and I note that each of the above-mentioned media are represented in this table. However, the only materials actually included in the Exhibit A-8 filed with the Registrar are an audio recording (presumably the CHBM – Toronto radio advertisement from 2011); a four-second video featuring a living room scene, which does not include any Via Rail Marks & Names (presumably part of the

CTV television advertisement from 2010); and two videos featuring branding identified in the annual reports as being from the 2017, namely the “WHY DON’T YOU TAKE THE TRAIN?” slogan, and 2018, namely the 40th anniversary logo (which are presumably the CBC web video from 2017 and the Bell Media web bumper ad from 2018).

[44] It is not clear whether documentation for the remaining examples listed in the table was inadvertently omitted from the electronic submission. The Opponent’s agent indicated, when submitting Mr. Levesque’s declaration and again during cross-examination, that his declaration (aside from the first paragraph) is the same as Mr. Landry’s declaration. That declaration—which is not of record—had included some additional materials at Exhibit A-8, which appear to correlate with at least the listed examples for 2012 to 2016. Moreover, the Applicant’s agent appears to acknowledge that Exhibit A-8 includes examples of the different types of advertising identified in Mr. Levesque’s paragraph 16 [transcript Q39–Q40].

[45] Regardless, I find that furnishing the content listed in paragraph 16 of Mr. Levesque’s declaration but omitted from the filed Exhibit A-8 would not have affected the outcome of this ground of opposition. Mr. Levesque attests that the Opponent has displayed the Via Rail Marks & Names on station and stop signage since at least 2010 and I am prepared to accept the undated examples of such outdoor signage he provides as being representative of the manner of display since 2010 [para 16, Exhibit A-9]. Furthermore, Mr. Levesque’s affidavit also includes other examples of use of the Opponent’s VIA Design trademark dating back to 2015, and I am prepared to accept the images of such use reproduced in the annual reports as being representative of use since at least 2015. In the circumstances, and in the absence of circulation, frequency, or reach figures for any of the specific advertisements listed at paragraph 16, I find that knowing how those particular advertisements looked would have little impact on my findings with respect to the extent to which the VIA Design trademark has become known as of today’s date. Since there is no indication of the frequency or duration of each advertisement’s appearance in its advertising channel, I would not be in a position to assess the effect of such additional advertisements on the reputation of the Opponent’s VIA Design trademark over the years. In any event, as

noted above, Mr. Levesque attests to advertising expenditures averaging close to \$10 million per year since 2011, and I am prepared to accept that, since at least 2015, these amounts related to advertising that is consistent with the exhibited representative examples.

Deviation issue

[46] Regarding the manner in which the Opponent's VIA Design trademark is used, some of the evidence shows it displayed exactly as it is registered. In some cases, it is displayed vertically instead of horizontally or with one or both edges cropped off. In a number of cases, a second symbol or trademark overlaps with or is superimposed on the VIA Design trademark, for example, the Opponent's 40th anniversary logo, Canada's 150th anniversary logo, or the Opponent's slogan "la voie qu'on aime" / "love the way". These overlapping logos and slogans vary in how they are positioned vis-à-vis the VIA Design trademark. By way of example, the following images showing the VIA Design trademark together with the abovementioned slogan are reproduced from the 2021 website printouts (top row) and 2018 annual report (bottom row):



branding on side of train engine



branding on corporate website



branding on annual report



outdoor advertising on side of streetcar

[47] Applying the principles set out in *Canada (Registrar of Trade-marks) v Cie Internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA); *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA); *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB), I find that the

Opponent's VIA Design trademark has not lost its identity and remains recognizable as a distinct trademark within each of the variations and combinations noted above.

[48] In this respect, I do not find that rotating the VIA Design trademark alters its identity, and I find that the stylized letters of the trademark are sufficiently preserved in the instances where the design is cropped. Furthermore, I find that the slogans and other logos that are occasionally displayed with the VIA Design trademark stand out as distinct trademarks, particularly given the contexts in which they appear, namely anniversary campaigns and other promotional campaigns. It is well established that nothing prevents two trademarks from being used together [*Stikeman, Elliot v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB)]. Going forward, I will generally refer to the Opponent's trademark displayed in any of these manners or contexts as simply the "VIA Design trademark".

[49] The evidence also shows use of a composite trademark in which the VIA Design trademark, followed by an eleven-point maple leaf, is displayed above the Opponent's trade name "Via Rail Canada" (having a Canadian flag above the final "a" in "Canada"), as reproduced below (the Via Rail Logo):



[50] It is the Via Rail Logo that is displayed exclusively on the exhibited examples of the Opponent's booking documentation, namely tickets and boarding passes. In many of the examples of promotional signage and of items used in the performance of the Opponent's services—such as the trains themselves and employee uniforms—the VIA Design trademark on its own (with or without overlapping branding) is displayed in relative proximity to the Via Rail Logo.

[51] The Applicant argues that the Opponent's VIA Design trademark is only used in the context of the Via Rail Logo, which does not constitute use of the Opponent's VIA Design trademark as registered, and that the Via Rail Logo's maple leaf and "Rail

Canada” elements distinguish this branding from the Mark. In the Applicant’s submission, there is no evidence that consumers would recognize use of the Via Rail Logo as use of the Opponent’s VIA Design trademark alone.

[52] However, applying the principles set out in *CII Honeywell Bull, Nightingale Interloc*, and *Loro Piana SPA v Canadian Council of Professional Engineers*, 2009 FC 1096, I find that the Opponent’s VIA Design trademark, by virtue of its relative size, stylization, and position, stands out both from the eleven-point maple leaf denoting Canada and from the trade name Via Rail Canada in the Via Rail Logo, and remains recognizable as a distinct trademark within this combination of elements.

[53] Furthermore, the evidence shows the VIA Design trademark displayed in multiple ways: alone, in conjunction with other branding, with design variations (such as cropping or repetition), with the eleven-point maple leaf but without the trade name, and within the Via Rail Logo. The VIA Rail Logo is often displayed in close proximity to one of these other displays, for example, on train engines displaying a large VIA Design trademark on the side and a small Via Rail Logo on the front, or on billboards featuring a large VIA Design trademark along one side and a small Via Rail Logo in the opposite corner [Exhibits A-2 to A-4]. There are also examples of the Via Rail Logo displayed next to text that includes the VIA Rail or VIA Rail Canada trade name and/or the VIA word mark, for instance, on web pages displaying the Via Rail Logo under a notice referencing VIA Rail service (“*Le service de VIA Rail*”) and VIA tickets (“*votre billet VIA*”) [Exhibit A11]; on station signage for arrivals and departures that displays the Via Rail Logo as well as the trade name VIA Rail Canada and/or domain name *www.viarail.ca* [Exhibit A-7]; and on receipts/itineraries that refer to VIA stations (“*une gare VIA*”) and give *www.viarail.ca*, *reservia.viarail.ca*, *service@viarail.ca*, and 1-888-VIA RAIL as contact information [Exhibit A-6]. I find that, in this context, the Opponent’s customers would perceive the VIA Rail Logo both as a composite trademark and as the VIA Design trademark followed by the Via Rail Canada trade name and other emblems or symbols of Canada.

[54] Thus, I find that display of the Via Rail Logo also constitutes display of the VIA Design trademark, such that the Opponent's VIA Design trademark can acquire distinctiveness through use and promotion of the Via Rail Logo.

Manner of use and promotion

[55] Mr. Levesque's evidence shows the Opponent's VIA Design trademark displayed in the following contexts:

- The covers of the annual reports display both a large VIA Design trademark and a smaller Via Rail Logo [Exhibits A-1 to A-4]. The VIA Design trademark is also displayed in other contexts within the reports, for example, as a motif on select pages and on the trains in the preliminary drawings for a new fleet design (2018–2019) and on the train engine symbol in infographics (2016–2017). However, there is no indication of how widely or to what audience the annual reports are circulated. That said, I also find the annual reports to be relevant in that various photographs and screenshots within the reports show how the VIA Design trademark and/or the Via Rail Logo are displayed on various installations and promotional materials, as further detailed below.
- The VIA Design trademark followed by a maple leaf is displayed in the header of the printouts from the Opponent's corporate website [Exhibit A-5]. Additionally, various photographs show the VIA Design trademark displayed on trains, signage, and uniforms (as detailed below), while drawings of the new fleet design show train cars displaying a large VIA Design trademark and smaller Via Rail Logos.
- The Via Rail Logo is displayed in the header of the screenshots of the intermodality webpages from the Opponent's customer website at www.viarail.ca, while the VIA Design trademark is displayed in the footer [Exhibit A-11]. These webpages advertise the availability of connections from the train to other modes of transportation and list the carriers with which the Opponent has agreements to

coordinate services. Mr. Levesque attests that these webpages have existed in the same or similar form since 2011 [para 24].

- External station and stop signage displays the Via Rail Logo [Exhibit A-9]. Mr. Levesque provides an April 7, 2021 printout from the Opponent's website at www.viarail.ca listing over 450 stops and stations and he attests that the Opponent has displayed its Via Rail Marks & Names on the over 596 stops and stations in its network since at least 2010 [para 18, Exhibit A-9].
- Internal station signage displays the VIA Design trademark, the Via Rail Logo, or both, and the VIA Design trademark has also been displayed on other installations and equipment within the stations [Exhibits A-1 to A-4, A-7 & A-9]. For example, the Vancouver station's lounge features the VIA Design trademark in a decorative repeating pattern on a dividing wall and the VIA Design trademark followed by a maple leaf is displayed on wheelchairs [Exhibit A-3].
- Paper and electronic tickets as well as boarding passes from online reservations display the Via Rail Logo [Exhibit A-6, which includes boarding passes from February 2014, December 2014, and September 2020].
- On trains, the VIA Design trademark has been displayed on the side of passenger cars and on seat covers, while the Via Rail Logo has been displayed on passenger cars and on the front of the train engine [Exhibits A-2 to A-4 & A-9]. Additionally, the aforementioned video that appears to be from 2018 has a scene showing an onboard meal where the a glass is branded with the VIA Design trademark and what appears to be the maple leaf, possibly as part of the Via Rail Logo (the glass is obscured below the design) [Exhibit A-8].
- The VIA Design trademark and Via Rail Logo have also been displayed on various parts of employee uniforms [Exhibits A-1 to A-3].
- The VIA Design trademark and the Via Rail Logo have been displayed on memorabilia. For example, both trademarks were displayed on commemorative

40th anniversary tickets forged in steel in 2018; the VIA Design trademark was displayed on what appears to be Canada 150 anniversary memorabilia in 2017; and the Via Rail Logo was displayed on a children's activity kit in 2017 [Exhibits A-2 to A-3].

- The Via Rail Logo was displayed on advertising billboards in 2016, 2017, and 2018, with at least some billboards in 2016 and 2018 simultaneously displaying the VIA Design trademark (the 2018 example replaces the A in VIA with a striding pedestrian) [Exhibits A-2 to A-4].
- As part of the Opponent's "love the way" advertising campaign, a large VIA Design trademark was displayed on bus shelter signage (2018 and 2019) and, in a repeating pattern, on the sides of streetcars (in 2018)—in both cases a small Via Rail Logo was also displayed [Exhibit A-2]. The Opponent's annual report for 2019, on page 23, explains the Opponent's strategy of advertising in public transit venues such as bus stations, bicycle rental stations, and bus shelters in Toronto, Ottawa, and Montreal, to remind travellers of the Opponent's place in intermodal public transportation networks [Exhibit A-1].
- Additionally, the aforementioned videos at Exhibit A-8 that appear to be online videos from 2017 and 2018 end with scenes showing, respectively, (i) the VIA Design trademark and Via Rail Logo in the corners while a passing train displays the Via Rail Logo; and (ii) a 40th anniversary variation of the Via Rail Logo.
- The VIA Design trademark and Via Rail Logo are displayed in the Opponent's promotional activities online, including in social media [Exhibits A-3 to A-4]. For example, the VIA Design trademark in giant lettering formed the backdrop for an executive committee Q&A session on the Opponent's YouTube channel in 2019 and advertisements also appear on the Opponent's travel blog [Exhibits A-1, A-3]. Mr. Levesque does not provide reach figures for the Opponent's social media accounts; however, according to the 2017 annual report, a Facebook video in the Opponent's "Why don't you take the train?" campaign was viewed over 115,000 times [Exhibit A-3]. The evidence does not include any printouts

from the Opponent's social media pages or details regarding the accounts; however, I note that the 2019 annual report lists the social media addresses and profile names @viarailcanada (Facebook), viarailcanada (Instagram) VIA Rail Canada (LinkedIn), @VIA-Rail (Twitter), and VIARailCanadaInc (YouTube), while the 2017 annual report shows a screenshot of Instagram posts for the hashtag #viacanada150, which holders of the opponent's Canada 150 youth travel pass were invited to use on Twitter, Facebook, and other social networks [Exhibit A-3].

- The Via Rail Logo is displayed during special events, for example, on parade signage in Ottawa (2017) and Montreal (2018) and on an anniversary cake at the Ottawa station (2016) [Exhibits A-2 to A-4].
- The VIA Design trademark and the Via Rail Logo are displayed on advertisements for the Opponent's free ticket reservation app, as well on screens in the app [Exhibit A-10, transcript Q64–Q72]. Compatible with both Android and iOS operating systems, the app has been available since at least 2015 and has since then averaged over 175 thousand ticket sales per year (up to 2019) [paras 20, 22]. It provides digital itineraries and boarding passes displaying the VIA Rail Logo and is advertised to include a variety of functions to facilitate users' train travel. I note that its icon on Apple's App Store is the Opponent's VIA (& Dessin) trademark, registered since 2017 for use in association with [TRANSLATION] downloadable software, namely a mobile application for reserving train tickets and managing train itineraries. Mr. Levesque explained during cross-examination that the Opponent's business model for providing transportation services includes the provision of such apps, which today are "part of life" ("*aujourd'hui en 2021, les applications font partie de notre vie*") [Q71]. In the circumstances, I am prepared to accept that making this type of app available would fall within the ambit of such services as are normally performed by a national passenger train service and is thus within the scope of the reservation.
- The 2018 annual report also shows screenshots of the VIA Design on a lost & found app and on a "VIAppreciation" employee recognition app; however, these

apps appear to be for internal use and there is no indication that their branding would be displayed to passengers in the performance of passenger train services [Exhibit A-2].

[56] In view of the foregoing, I find that the VIA Design trademark has become known to a significant extent in Canada. I am satisfied that the level of ridership and advertising to which Mr. Lévesque attests, in conjunction with the evidence regarding the manner in which the VIA Design trademark is displayed, establishes a considerable reputation for the VIA Design trademark in association with the Opponent's operation of a national railway for the transportation of passengers, and also to some extent in association with the related service of providing mobile apps to facilitate passenger's travel on the Opponent's trains.

Intermodalities

[56] Mr. Lévesque emphasizes that the Opponent's use of its VIA marks and names is not limited to the railway sector, as the services rendered include connections to other forms of transport—such as taxi, subway, bus, shuttle, and carshare—available at ticket counters and through the Opponent's website and mobile app [paras 23-24]. Since 2011, the Opponent has been collaborating with numerous transportation providers in this regard, including commuter trains, taxis, motorcoaches, rideshare companies, ferries, airport shuttles, and airlines, so that transport operators and travel planners can combine different modes of transport into a seamless travel experience [para 25, transcript Q6]. In 2017, over 114 thousand passengers took advantage of such connections (representing a 97 per cent increase over 2012) and the number grew to over 122 thousand passengers in 2018 and 153 thousand in 2019, with further growth of such intermodality partnerships having been planned for 2020 [paras 25-26].

[57] Mr. Lévesque provides a list of the types of connections offered at the Opponent's train stations and other travel hubs across Canada and, as noted above, he includes printouts of the Opponent's webpages advertising these connections and the Opponent's alternative transportation partners. One of the webpages promotes a shuttle service between Québec and Sainte-Foy offered by Taxi Québec for holders of VIA Rail

reservations, and mentions ticket sales through *viarail.ca* and VIA Rail ticket counters [Exhibit A-11]. I also note the 2016 annual report, which on page 19 highlights several of the Opponent's intermodality partnerships, noting specifically passengers' ability, since July 2016, to reserve Maritime Bus tickets directly on the Opponent's website; the addition in 2016 of six Discount car rental kiosks to train stations, bringing the total number of stations with such kiosks to nine; the coordination in November 2016 of VIA Rail train and Robert Q Airbus bus schedules in Southwestern Ontario; and the Opponent becoming accessible through the Wanderu, Rome2rio, and Combitrip trip planning search engines [Exhibit A-4]. According to the annual report, in 2016, over 95,000 travellers took advantage of an intermodal connection (representing a 23% increase over 2015) and over 50,000 travellers used the *viarail.ca* website to buy tickets for a trip provided by one of the Opponent's intermodal partners.

[58] Under cross-examination, Mr. Lévesque elaborated on the nature of the Opponent's intermodality partnerships, explaining that passengers' ability to schedule trips involving other modes of transport end-to-end depends on the nature of the individual agreements, which vary year-to-year and by location [transcript Q58, Q63, Q74, Q76–Q77, Q80]. In some cases, passengers may book third-party transportation, like the bus, through the Opponent and receive a ticket that takes care of the entire trip (and, in some such cases, the Opponent earns a commission) [Q57, Q62–Q63, Q77–Q80]. In other cases, passengers may simply be provided with contact information to book the supplementary transportation directly themselves [Q63, Q80]. In some cities, the Opponent arranges for taxi companies to coordinate with its train schedules, or for car rental companies to have offices at the train station, so that arriving passengers can rest assured they will have options for reaching their ultimate destination within the city [Q57–Q63, Q74–Q75, Q82–Q85, Q89–Q91]. Thus the Opponent advertises and sells not only a train service but an end-to-end transportation service that assures passengers the ability to reach their final destination—even if none of the third-party partner taxis, buses, or rental cars bears the name “VIA” [Q57, Q75, Q82, Q86–Q88].

[59] At the oral hearing, the Applicant questioned whether actual arrangements are made with taxi companies or whether they are merely given a copy of train schedules for their own information. However, Mr. Levesque specifically refers to there being agreements in certain cities where the taxis meet the train at given places and times (*“il y a des ententes dans certaines villes où les taxis savent que le train va arriver à 8 heures lundi matin et les taxis sont au rendez-vous à 8 heures le lundi matin à la station de Sainte-Foy, par exemple”* [Q61]) and I note that the exhibited photographs of station signage include one station with an exit door marked “Taxis”, under a high overhead display that includes the Via Rail Logo [Exhibit A-9].

[60] The Applicant submits that Mr. Levesque’s evidence is insufficient to justify extending the Opponent’s reputation beyond the registered services “operation of a national railway for the transportation of passengers”. However, I am satisfied that the foregoing evidence is sufficient to show that the Opponent’s trademark has become known to at least some extent in association with the service of making connections to other modes of transportation available to passengers who wish to arrange end-to-end transportation and also with the coordination service offered to contracting partners who benefit by attracting customers from the train [see e.g. transcript Q84]. In my view, these specific services come under the ambit of the registered service “provision of such other services as normally performed by a national passenger train service”.

[61] In this respect, although the Opponent furnished no evidence of what services other national railways normally perform, I accept Mr. Levesque’s statements under cross-examination to the effect that passengers arriving at the station by train need to know they will have access to another transportation service in order to reach their ultimate destination and that providing passengers with simple and efficient connections to other transportation providers for this purpose allows railway companies to grow their business [Q75]. Mr. Levesque emphasizes that the Opponent considers it essential to assure passengers of the availability of such connections and will expend human resources to coordinate with its partners across Canada to this end [Q82, Q88]. Furthermore, I note that the Opponent’s registration for the trademark VIANET, which issued under no. TMA525,692 in 2000 and was renewed in 2015, covers [TRANSLATION]

automated reservation services for trains, aircraft, buses, ferries, tours, hotels, and car rentals. While not determinative, I find that the Opponent's longstanding registration of a trademark for use in association with reservation services for other modes of transportation is consistent with the provision of such coordination services being a service normally performed by a national passenger train service.

[62] In view of the foregoing, I find that the VIA Design trademark has also become known to some extent in association with the provision of another service normally performed by a national passenger train service, namely arranging and making available connections to other modes of transportation, to facilitate end-to-end travel in a transportation network that includes the Opponent's trains.

Section 6(5)(b): Length of time the trademarks have been in use

[63] I am satisfied that the Opponent has established use of its VIA Design trademark in association with "operation of a national railway for the transportation of passengers" since at least as early as 2010 and in association with "the provision of such other services as normally performed by a national passenger train service"—namely (i) providing a mobile application for reserving train tickets and managing train itineraries and (ii) arranging and making available connections to other modes of transportation for end-to-end travel—since at least as early as 2015.

[64] Conversely, the Application is based on proposed use and there is no evidence that the Mark has yet been used in Canada.

[65] Accordingly, this factor favours the Opponent.

Sections 6(5)(c) & (d): Nature of the goods, services, businesses, and trades

[66] Under a registrability ground of opposition, the statements of goods and services in the applicant's application and in the opponent's registration must be assessed, having regard to the channels of trade that would normally be associated with such goods and services [*Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR

(3d) 3 (FCA); *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export* (1986), 12 CPR (3d) 110 (FCA)]. Each statement must be read with a view to determining the probable type of business or trade intended rather than all possible trades that might be encompassed by the wording [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)].

[67] Evidence of a party's actual trade may provide valuable context when interpreting the statements of goods and services in an application or registration; however, caution should be taken not to restrict the scope of protection based on actual use [*Absolute Software Corporation v. Valt.X Technologies Inc.*, 2015 FC 1203]. Actual use is not irrelevant, but it should not be considered to the exclusion of potential uses within the registration [*Masterpiece, supra*].

[68] In the present case, the nature of the parties' goods and services overlaps, since both parties' services involve the transportation of passengers. The Applicant's applied-for service "transportation of passengers by motorized vehicle" could arguably encompass any motorized vehicle, including train engines, and thus directly overlap with the Opponent's railway operation service. The Applicant's applied-for service "transportation of passengers by vehicle through a network of transportation providers" differs on its face to the extent that it implies operating different modes of transportation. However, in his statutory declaration, Mr. Levesque emphasizes how the Opponent coordinates with other transportation providers to offer connections to different services—including taxi, shuttle, and carshare—at its ticket counters, on its website, and through its mobile app. Depending on the Opponent's agreement with each such intermodality partner, the Opponent may provide passengers with a ticket taking care of the entire trip or simply arrange for the availability of third-party transportation options at its stations. Thus the Opponent may be considered part of a network of transportation providers, offering a seamless travel experience, even if other providers in the network do not operate under any of the Via Rail Trademarks.

[69] The Applicant's applied-for goods "mobile application software for coordinating transportation services" and "mobile application for engaging transportation services" do

not specify any particular mode of transportation and thus overlap with the Opponent's service of providing free ticket reservation and itinerary management apps to its passengers. As noted above, I consider this service to fall within the ambit of the description "provision of such other services as normally performed by a national passenger train service" in the Opponent's VIA Design trademark registration.

[70] The applied-for goods "mobile application software for connecting drivers and passengers" and "mobile application software for automated scheduling and dispatch of motor vehicles" would not appear to overlap directly with the Opponent's services, to the extent that "connecting drivers and passengers" would not be an ordinary commercial term for train obtaining train tickets and to the extent that the term "motor vehicles" refers specifically to road vehicles rather than vehicles running on tracks. Nevertheless, I consider these goods to be related to the Opponent's services to the extent that both involve connecting transportation providers with passengers. Moreover, Mr. Levesque's evidence is that, in some cases, passengers may book third-party transportation through the Opponent's website. I would consider providing the ability to book third-party motor vehicle transportation through the Opponent's mobile web service or through its ticket reservation and itinerary management mobile app to be, if not offered already, at the least a natural extension of the Opponent's existing services.

[71] Finally, in the absence of evidence to the contrary, I find that the Applicant's "telecommunications services, namely, routing calls, SMS messages, and push-notifications to transportation providers and riders" could also fall within "provision of such other services as normally performed by a national passenger train service". In this respect, I would consider such telecommunications services to relate to the Opponent's telephone, web-based, and mobile train reservation services.

[72] With respect to the nature of the parties' respective businesses and trades, the Applicant submits that, although its services include "transportation" using "motorized vehicles", it is in fact a software technology company, selling software for planning, optimizing, and operating efficient transit systems. In the Applicant's submission, the nature of its business can be gleaned from the wording of the Application itself, given its

focus on software and transportation networks. Further, in the Applicant's submission, Ms. Lau Cardinell's Internet research supports the assertion that (i) the Applicant is fundamentally an innovative software company that is in the business of linking transportation systems for communities using digital networks and is not a railway or other transportation company; and (ii) the Applicant's Mark is also available as a mobile application for ride sharing services.

[73] The Applicant additionally submits that its business would not attract the same type of customer as the Opponent, since the Opponent is not in the software business, and providing train services for long distance travel is fundamentally different from providing the computer applications used to book short distance local travel or to connect passengers to travel options. For example, in the Applicant's submission, the Opponent has a monopoly on national railway services and is more likely to compete with airlines than with companies offering short distance trips within a city that are facilitated by the Applicant's software. The Applicant further submits that consumers of the services defined in the Application would more likely be business-to-business consumers or transportation providers than riders in a hurry.

[74] I would first note that the Application provides no indication on its face that the transportation services listed are only ancillary or secondary to the software goods. Nor is the Application restricted to use in the in the business-to-business market. None of the references to "transportation" in the Application specify a restriction to short-distance, local transportation, and I do not find that the statement of goods and services as a whole carries this implication.

[75] As for the results of Ms. Lau Cardinell's Internet searches for references to the Applicant or its business, she attaches screenshots of the following to her affidavit:

- Webpages from the website at *ridewithvia.com*, depicting two vehicles (car or van) with the Mark on the rear door and featuring a menu that begins with a variation of the Mark wherein the word VIA is of comparable size to the pin icon and displayed to its right [Exhibit C]. The exhibited extracts advertise a customizable digital platform ranging from branded apps to sophisticated

software algorithms to plan, optimize, and operate transit systems and control public transportation networks—targeting markets that include cities, transit authorities, transit operators, institutions and corporations, and riders and drivers.

- Parts of the Wikipedia entry for the Applicant at en.wikipedia.org/wiki/Via_Transportation [Exhibit D]. The same variation of the Mark is displayed in the sidebar that provides an overview of the company. The exhibited excerpt contains similar information to the ridewithvia.com website, and I note that it references the company providing both software-as-a-service and transit-as-a-service, allowing customers to either use their own vehicle fleets, drivers, and staff, or have the Applicant supply and manage these resources.
- App Store and Google Play pages for a “Via — smarter mobility” shuttle service app whose icon is the Applicant’s location in design [Exhibit E]. Both stores depict screenshots from the app where the pin icon identifies points on a map while the word VIA in the Mark’s font is displayed at the top of the screen and, along with a clock icon, identifies messages relating to the shuttle service (for example, the message “Via is 4 minutes away”).
- LinkedIn Page at linkedin.com/company/ridewithvia, featuring the Mark at the top of the page and advertising essentially the same type of software described on the ridewithvia.com website [Exhibit F].

[76] The Applicant concedes in its written argument that Ms. Lau Cardinell’s evidence is not advanced for the truth of the information provided by the webpages, but rather for establishing that such websites displaying the Mark existed at the date of her searches [see page 7].

[77] The evidence of an employee of a party’s agent is generally admissible to the extent that it relates to non-controversial and non-central matters [*Cross-Canada Auto Body Supply (Windsor) Ltd v Hyundai Auto Canada*, 2005 FC 1254, 43 CPR (4th) 21, aff’d 2006 FCA 133, 53 CPR (4th) 286]. Ms. Lau Cardinell’s affidavit is admissible on this basis, since her evidence consists essentially of a selection of screenshots with an

objective description of their origin and no subjective observations or opinions. However, the existence of this content is not, by itself, particularly probative. The mere fact that such websites are accessible in Canada does not establish whether any of the goods or services offered, promoted, or described on the sites actually have been or will be sold or performed in Canada.

[78] Furthermore, at least some of the screenshots do not appear to show the full content of the captured webpage or website. Accordingly, they are not particularly helpful in determining what goods and services have *not* been offered or advertised by the Applicant. The Applicant notes that it was open to the Opponent to cross-examine Ms. Lau Cardinell; however, the onus is on the Applicant to establish that there would be no likelihood of confusion. It is not up to the Opponent to seek information that would help the Applicant make its case. Moreover, the Federal Court of Appeal has made it clear in *Cross-Canada Auto Body Supply (Windsor) Ltd v Hyundai Auto Canada*, 2006 FCA 133, that “it is not good practice for a law firm to cause its employees to act as investigators for the purpose of having them later give opinion evidence on the most crucial issues in the case” [at para 4]. In the present case, the Applicant has not explained why it was necessary to introduce its evidence on the nature and scope of its business as hearsay rather than through a representative of the Applicant with direct knowledge. Unlike the Opponent’s website evidence, that of the Applicant has not been introduced by an individual with personal knowledge of the company’s practices with respect to its presence on the Internet and social media or access to business records in this regard.

[79] In any event, I do not find that the promotional materials attached to Ms. Lau Cardinell’s affidavit support the Applicant’s position, given that they refer to a “shared shuttle” service as well as to “transit-as-a-service” and to having the Applicant supply vehicle fleets, drivers, and staff. Thus it would appear that the advertised services include transportation services. In this respect, I would also note that it is not clear whether the vehicles depicting the Mark on a rear door might be used for passenger transportation, as they appear to depict passengers entering the rear seats.

[80] Finally, I am not satisfied that the markets and customer base for long-distance travel and local travel would not overlap, given Mr. Levesque's evidence regarding train passengers needing to connect with local transportation providers to get from the train station to their final (or next) destination within the city, and given Mr. Levesque's confirmation during cross-examination that the Opponent's competitors offer transportation services not only by air but also by bus and automobile [Q43].

[81] In the circumstances, and given my finding that the parties' respective goods and services either directly overlap or are related in the sense that the goods and services defined in the Application may be seen as a natural extension of the Opponent's registered services, I find it reasonable to conclude that there is potential for similarity and overlap in the nature and channels of trade.

[82] In view of the foregoing, I find that the section 6(5)(c) and (d) factors favour the Opponent.

Additional surrounding circumstance: State of the register

[83] The common occurrence of a certain element in trademarks tends to cause purchasers to pay more attention to the other features of the trademarks and to distinguish between them by those other features [see *Polo Ralph Lauren Corp v United States Polo Assn* (2000), 9 CPR (4th) 51 (FCA); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].





[84] However, this principle requires that the trademarks comprising the common element be in fairly extensive use in the same market [*Maximum Nutrition, supra*]. The state of the register is relevant in this respect, but only insofar as one can draw inferences from it regarding the state of the marketplace. Where a large number of relevant trademarks are identified on the register, it may give some indication of the state of the marketplace, allowing the Registrar to infer at least some use of the element that the trademarks all have in common [see *Maximum Nutrition, supra*]. Where the number of relevant trademarks identified on the register is not large, evidence of use needs to be furnished [*McDowell v Laverana GmbH & Co KG, 2017 FC 327*]. Relevant



trademarks include those owned by third parties that (i) are registered or are allowed and based on use; (ii) are for similar goods and services as the trademarks at issue, and (iii) include the element at issue in a material way [*Sobeys West Inc v Schwan's IP, LLC*, 2015 TMOB 197, aff'd 2017 FC 38].

[85] The Applicant submits Ms. Lau Cardinell's searches of the Canadian trademarks register show VIA to be a common element in trademarks, as the searches reveal "a large number" of VIA-formative trademarks for use in association with "closely related goods and services, including computer software with a wide variety of functions and applications, rental and sales of vehicles and transportation of goods" [written representations at page 6]. However, it is difficult to assess the precise number of relevant trademarks revealed from Ms. Lau Cardinell's evidence. She gives separate counts for each of the three Nice classes that are in the Application, but the lists of select hits she provides suggest that these counts include trademarks at all stages of the application process, official marks, the parties' marks, and instances of the same mark being counted separately for each class.


[86] Furthermore, although Ms. Lau Cardinell's searches returned 238 active trademarks containing the word VIA, a striking feature of the Opponent's trademark is that this preposition is the *sole* word element, and Ms. Lau Cardinell's search across all NICE classes located only 18 active third-party trademarks (two owned by the same company) whose verbal portion is "VIA" alone (Ms. Lau Cardinell's count of 26 includes hits for the parties' trademarks, for the words VIAS and VIA², and for a wordless design).


[87] At the hearing, the Applicant noted the following registered trademarks as being in the same Nice classes as the Application—some with specifications alluding to transportation and related goods and services—and being "much closer" with a "striking and stronger resemblance" to the Opponent's VIA Design trademark, due to design features that include capital letters, the crossbar missing from the A, and rotational symmetry [at pages 6–7]:

Trademark	Status	Goods/Services	Owner
 (VIA Stylized)	TMA998,481 Registered	<p>Downloadable software applications for providing access to secure, cloud-based file storage, transfer, and sharing.</p> <p>Software as a service (SAAS) services featuring software for secure, cloud-based file storage, transfer, and sharing; cloud computing featuring software for secure file storage, transfer, and sharing; consulting services in the field of facilitating communication and collaboration through secure online file storage, transfer, and sharing.</p>	IntraLinks, Inc.
 (VIA & DESIGN)	TMA809,294 Registered	<p>Computer software, namely, software for business management enabling the management of insurance claims, invoices, quotes and accounting functions.</p> <p>Promoting the sale of goods and services in the field of vehicle glass, vehicle accessories, auto trim and accessories. The repair and maintenance of vehicles and vehicle glass through a consumer loyalty and incentive programme. Training services, namely, the provision of training in the field of the repair and maintenance of vehicle glass.</p>	Belron International Limited
 (Down and Up Arrows and Vertical Line Design)	TMA900,261 Registered	<p>Architectural planning and design services, namely, urban planning and design, building planning and design, transit and infrastructure planning and design, community consultation and development, planning and design for the renovation and historic preservation of buildings, master planning involving public consultation, gathering of information and opinion, analysis and rationalization of long-term actions and consequences regarding future growth and development of urban areas, and environmental sustainability involving studies, initiatives and efforts in relation to urban growth and development to achieve maximum present and future benefits for societies and their stakeholders.</p>	VIA Architecture Incorporated
 (VIA DESIGN)	TMA580,946 Registered	<p>CPU's memory chips; hard disk drives; computer chips; silicon chips, semiconductors; micro-circuits, integrated circuits, micro-processors; central processing units (CPU); computer software, namely, drivers associated with the aforementioned computer hardware.</p>	VIA Technologies, Inc.

 (VIA & DESIGN)	TMA554,780 Registered	Travel magazines and related publications, namely, books and destination guides, offered primarily to members of the applicant and affiliated automobile clubs.	California State Automobile Association
 (VIA Logo)	TMA991,717 Registered	Electric powered land vehicles; vehicles propelled by electricity; vans, pickup trucks; sport utility vehicles.	Via Motors, Inc.

[88] Conversely, the Opponent submits that none of the trademarks located in Ms. Lau Cardinell's searches cover the same goods and services as the trademarks at issue and that only the following located trademarks cover goods or services that can be considered in some sense "similar":

Trademark	Status	Goods/Services	Owner
VIA	App 2,165,290 Formalized	...software as a service (SAAS) and platform as a service (PAAS) for management optimization of care services, namely, social activities, maintenance, transportation, dining, housekeeping and laundry services in the fields of senior care, home care, home health, nursing homes, assisted living communities, and hospice services.	Serviam Care Network, P.B.C., Inc
 VIATRANS (VIATRANS)	App 2,002,182 Formalized	[TRANSLATION] Transport, packaging, and storage of goods; organizing travel; inspection of goods prior to transport; transport brokerage; storage rental; organizing transportation services; providing access to information regarding transport; electronic planning and reservation of travel and transportation; advice regarding storage and transport of goods, freight or charges; providing access of information regarding transport and storage of goods; providing access to information regarding transport of products and passengers; providing access to online information in the field of transport, packaging, and storage of goods; logistics and supply chain services and of inverse logistics including goods storage, transport and delivery services.	Viatrans SA




VIYA	TMA1,050,202 Registered	Computer software platforms, for businesses for data analysis, data management and data visualization, namely for interpreting, searching, analyzing, viewing and reporting data in graphic representations, text, and numerical form, for use in the Automotive, Banking, Casino, Telecommunications, Security, Hos[pita & Health Care, Insurance, Computer Manufacturing, Education , hospitality, scientific research, Oil & Gas, Professional S[Opponent's Registered Trademarks, Travel, Transportation, electricity and natural gas industries.	SAS Institute Inc.
 VIA ROUTE (VIA ROUTE & DESSIN)	TMA410,979 Registered	[TRANSLATION] Rental of cars and trucks, operating a used car and truck sales business.	9189-7751 Quebec Inc.
ViaDirect	TMA1,006,701 Registered	[TRANSLATION] Travel itinerary information. [JOURNAL TRANSLATION] Information related to road itineraries.	L'ILE DES MEDIAS, SAS

[89] Noting that two of the above-referenced applications had only been formalized at the time of Ms. Lau Cardinell's search, the Opponent submits that three registrations is an insufficient number from which to draw inferences about the state of the marketplace. Conversely, the Applicant submits that there is no set number of entries required for state of the register evidence to be relevant.

[90] I agree with the Applicant that there is no such precise threshold. Indeed, in *Hawke & Company Outfitters LLC v Retail Royalty Company*, 2012 FC 1539, the Federal Court noted that the exact number of similar marks needed to establish that an element of a mark was commonly adopted as a component of trademarks used in association with the relevant goods or services at the material date likely depends on the facts of a given case. In *Eclectic Edge Inc v Gildan Apparel (Canada) LP* 2015 FC 1332, the Federal Court explained that it is "not the quantity or sheer numbers that count but rather the quality of evidence showing actual use of the common [element] in the relevant industry in Canada" [at para 92]. In this respect, I would also note the Federal Court's caution in *Hawke* that a register search is not the best way to establish the state of the marketplace, since the fact that a mark appears on the register does not

show that it is in use, was in use at the material date, or is used in relation to goods or services similar to those of the parties, or the extent of any such use. The Federal Court affirmed these comments in *Canada Bread Company, Limited v Dr Smood ApS*, 2019 FC 306, noting that it remains “very much unclear” what inference may legitimately be drawn from the state of the register without evidence of the use of the common element made by third parties in the marketplace [at para 61].

[91] Given the nature of the goods, services, businesses and trades in this case, I consider the relevant market to be that of passenger transportation services and related software. In my view, only the following trademarks identified by the parties are relevant to this general market:

Trademark	Status	Goods/Services	Owner
	TMA900,261 Registered	Architectural, planning and design services, namely ... transit and infrastructure planning and design....	VIA Architecture Incorporated
VIYA	TMA1050202 Registered	Computer software platforms, for businesses ... for interpreting, searching, analyzing, viewing and reporting data ...for use in the ...Travel, Transportation, ...industries.	SAS Institute Inc.
ViaDirect	TMA1006701 Registered	[TRANSLATION] Travel itinerary information.	L'ILE DES MEDIAS, SAS
	TMA554,780 Registered	Travel magazines and related publications, namely, books and destination guides, offered primarily to members of the applicant and affiliated automobile clubs.	California State Automobile Association
	TMA410979 Registered	[TRANSLATION] Rental of cars and trucks.	9189-7751 Quebec Inc.

[92] I do not consider software for cloud access, insurance claims management, and hardware drivers to be in the same market as the parties’ software, which is essentially for travel coordination. The Applicant has not established that trademarks associated with software in these other fields might be relevant to the impressions of an average consumer of software in the travel and transportation field. Nor do I consider land vehicles and vehicle repair services to be in the relevant market. Those goods and services are in the fields of vehicle ownership and maintenance rather than passenger

transportation. Again, the Applicant has not established how trademarks in those fields might be relevant to the impressions of a consumer encountering the Mark.

[93] As noted above, the inference that needs to be drawn is that trademarks comprising the common element are in “fairly extensive use” in the market in which the trademarks under consideration are being or will be used [*Maximum Nutrition, supra* at para 14] and such inferences may only be drawn when the number of relevant registrations is large [*McDowell, supra* at 42].

[94] By way of example, in *Kellogg*, such an inference was drawn when the state of the register evidence demonstrated in excess of 50 relevant trademark registrations and more than 40 trade names containing the element NUTRI. By contrast, in *McDowell*, the state of the register evidence demonstrated only 10 registered trademarks (in the names of only seven different owners) that contained the word HONEY as a dominant feature, which the Court held was insufficient for a finding that HONEY was common to the trade, absent evidence of actual use.

[95] The Applicant cites *Perfection Foods Ltd v Otto Pick & Sons Seeds Ltd* (1986), 8 CPR (3d) 551 (TMOB), where evidence of approximately 10 registrations for the trademark PERFECTION covering a wide variety of goods was found to emphasize, at least to some extent, the inherent weakness of the parties’ trademarks and to underscore the average consumer’s ability to distinguish different parties’ products sold under the identical trademark PERFECTION. However, *Perfection Foods* was a case where the parties’ respective goods—grass seed and dairy products—were found to be “totally dissimilar” [at 554]. This is not a case where state of the register evidence was found to decrease the likelihood of confusion between trademarks for use in association with similar services or overlapping trades.

[96] I note that the Applicant also cites a number of additional past decisions where state of the register was considered to decrease the likelihood of confusion. However, each case must be decided on its own facts. For example, the trademarks at issue may be descriptive rather than suggestive, or there may be evidence of a larger relevant market or of actual third-party use of the shared element in the marketplace. I would

also note that cases predating the Federal Court's guidance in *McDowell* regarding the inferences that may properly be drawn from relatively small numbers of relevant trademarks on the register must be approached with caution.

[97] In the present case, the evidence of five registered trademarks containing the element VIA (or a phonetic equivalent), each in the name of a different owner, is more in line with the evidence considered by the Court in *McDowell*. In the absence of any evidence concerning their use or promotion in Canada, I find the existence of this limited number of trademarks too small for any meaningful inferences to be drawn concerning the state of the marketplace and consumer perceptions. Consequently, I am unable to conclude that consumers are used to seeing marks containing the word VIA in the marketplace such that they would therefore be more likely to distinguish between trademarks having VIA as their only word element in association with goods and services connected to passenger transportation. [For similar conclusions, see *Tokai of Canada Ltd v Kingsford Products Company, LLC*, 2021 FC 782, involving 11 relevant trademarks in the names of 9 different owners; and *Caterpillar Inc v Puma SE*, 2021 FC 974, involving 13 relevant trademarks.]

[98] In view of the foregoing, the state of the register and marketplace is not a significant surrounding circumstance in the present case.

Conclusion with respect to registrability under section 12(1)(d)

[99] In an opposition proceeding, the onus is not on the Opponent to show that confusion is likely but rather on the Applicant to satisfy the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion. 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 the applicant.

[100] Having considered all the surrounding circumstances, I find that the probabilities are evenly balanced between a finding of confusion with the Opponent's VIA Design trademark and a finding of no confusion. I reach this conclusion considering the

relatively high degree of resemblance between the parties' trademarks, the considerable overlap in the nature of the goods and services at issue, and the potential for similarity or overlap in the channels of trades. I am also mindful that, although the inherent distinctiveness of the Opponent's VIA Design trademark may not be particularly high, the evidence is sufficient to establish that the Opponent's trademark has become known to a significant extent, whereas there is no evidence of use of the Mark in Canada. In arriving at my conclusion, I have considered the notable visual differences between the trademarks at issue. However, in my view, a casual consumer encountering the Mark, with only a general recollection of the Opponent's VIA Design trademark, may well nevertheless assume, as a matter of first impression, that the associated goods and services, come from the Opponent.

[101] Based on all the foregoing, I find that the Applicant has not met its legal onus to demonstrate, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's VIA Design trademark. The registrability ground of opposition under section 12(1)(d) of the Act is therefore successful.

REGISTRABILITY UNDER SECTION 12(1)(E) OF THE ACT

[102] The Opponent also pleads that the Mark is not registrable having regard to the provisions of section 12(1)(e) of the Act because its adoption is prohibited by section 9(1)(n) of the Act, given that the Mark consists of, or so nearly resembles as to be likely to be mistaken for, the Via Rail Official Marks, which have been adopted and used by a public authority in Canada as official marks for goods or services, of which the Registrar has given public notice.

[103] The material date for this ground of opposition is the date of the Registrar's decision [*Canadian Olympic Assn v Olympus Optical Co* (1991), 38 CPR (3d) 1 (FCA)]. I have exercised my discretion and checked the register to confirm that all of the Via Rail Official Marks set out at Schedule B to this decision are in good standing [per *Quaker Oats, supra*]. The Opponent thus having met its evidential burden, the onus is now on the Applicant to satisfy the Registrar, on a balance of probabilities, that the Mark

does not consist of, or so nearly resemble as to be likely to be mistaken for, any of the Via Rail Official Marks, and is thus registrable under section 9(1)(n)(iii) of the Act.

[104] In considering the issue of resemblance, I will focus my discussion on the Opponent's official mark "VIA" advertised under no. 924,807 (the VIA Official Mark). I consider this word mark to represent the Opponent's best chance of success, given the absence of any additional word elements or design features that might decrease its degree of resemblance to the Mark.

[105] The Federal Court of Appeal has confirmed that the words "consists of" in section 9 of the Act mean "identical to" [*Big Sisters Assn of Ontario v Big Brothers of Canada* (1997), 75 CPR (3d) 177 (FCTD), *aff'd* (1999), 86 CPR (3d) 504 (FCA)]. The Mark is clearly not identical to the VIA Official Mark, which does not include a design. Thus, the question in this case is whether the Mark so nearly resembles the VIA Official Mark as to likely be mistaken for it.

[106] The resemblance test under section 9(1)(n)(iii) of the Act differs from a standard confusion analysis in that it requires a likelihood that consumers will be mistaken as between the marks themselves rather than a likelihood that consumers will be confused as to the source of the goods or services. The test has been held to have a high threshold for success, requiring the applicant's trademark to be "almost the same as, or substantially similar to," any or all of the pleaded official marks [*Big Sisters, supra*]. It is not a test of straight comparison, but rather one of first impression and imperfect recollection [*Big Sisters, supra*; *Techniquip Ltd v Canadian Olympic Assn* (1998), 80 CPR (3d) 225 (FCTD), *aff'd* (1999), 3 CPR (4th) 298 (FCA); *Canadian Olympic Assn v Health Care Employees Union of Alberta* (1992), 46 CPR (3d) 12 at 21-23 (FCTD)]. Regard must be had to the factors set out in section 6(5)(e) of the Act, including the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them [see *Big Sisters, supra*; *Techniquip, supra*; and *Hope International Development Agency v Aga Khan Foundation Canada* (1996), 71 CPR (3d) 407 (TMOB)]. However, the nature of the goods or services, as set out under section 6(5)(c), is not relevant to assessing whether a trademark is likely to be mistaken for an official

mark [*Chartered Professional Accountants of Ontario v American Institute of Certified Public Accountants*, 2021 FC 35]

[107] The Applicant submits that the only resemblance in the present case is in respect of the word “VIA”, which has limited inherent distinctiveness because it evokes routing for travel to a destination, a significance that is recognized among Canadian consumers by reason of the word’s common use in trademarks, as demonstrated by the state of the register. In the Applicant’s submission, the Registrar has previously considered the state of the register to be relevant to a section 9(1)(n)(iii) ground of opposition when a sufficient number of marks shares the common characteristics of the parties’ marks, even where the parties’ marks are found to resemble each other [citing *Vermillion Networks Inc v Cenovus Energy Inc*, 2021 TMOB 289, where the Registrar considered 65 active third-party trademark applications and registrations that contained a vortex or similar design].

[108] However, as discussed above, I find the preposition VIA to be at most suggestive, particularly when considered apart from any goods or services. Moreover, a striking feature of the VIA Official Mark is that this preposition is the sole element, and I note that the state of the register evidence in the present case reveals only 18 active third-party trademarks (two owned by the same company) whose verbal portion is “VIA” alone. This is a much smaller number than the 65 trademarks located in the case cited by the Applicant.

[109] I find the present case to be closer to the situation in *Pacific Carbon Trust Inc v The Carbon Trust*, 2012 TMOB 206 and *Vancouver Organizing Committee for the 2010 Olympic and Paralympic Winter Games v Bester*, 2009 CanLII 82114 (CA TMOB), cited in *Chartered Professional Accountants of Ontario* as examples of opposition proceedings where the Registrar found the trademarks at issue to be unregistrable pursuant to sections 12(1)(e) and 9(1)(n)(iii) after considering which aspects of the parties’ marks were striking and unique [per *Masterpiece*, *supra*]. In *Pacific Carbon Trust*, the trademark CARBON TRUST was found to consist of the most striking aspect of the official mark PACIFIC CARBON TRUST, with PACIFIC being a geographical term

that acted merely as a qualifier for the more striking element. In *Bester*, the official mark TOURISM 2010 was found to be the dominant aspect of the trademark ECO-TOURISM 2010, despite the prefix ECO being the first portion of the trademark.

[110] In the present case, I find that the marks at issue bear a high degree of resemblance, visually, phonetically, and in ideas suggested. I reach this conclusion for the same reasons as discussed under the section 12(1)(d) registrability ground of opposition, with the added reason that the word VIA in the VIA Official Mark has no stylization to distinguish it from the relatively simple stylization of the word VIA in the Mark. Furthermore, although I find the location pin design to be the Mark's dominant feature visually, I also find the word VIA to be an important feature—particularly when considering how the Mark will be sounded but also visually and conceptually, given that it is the only word element, and the element to which the pin icon points. In my view, the pin icon is a relatively simple geometric design essentially suggesting a point on a digital map. As discussed above, this design could suggest something named or identified as "VIA" located at a particular spot.

[111] In view of the foregoing, I find that the Mark could be mistaken for the VIA Official Mark under a location pin. Bearing in mind that official marks must be adopted and used by a public authority in Canada for goods or services, I find that a pin icon above the word VIA could be seen as a type of qualifier emphasizing the location of "VIA" goods and services. In the absence of evidence as to whether the Mark is likely to be used in contexts that lend themselves to this interpretation, or any evidence as to the prevalence of pin icons on the Register, I am left in a state of doubt concerning the issue of resemblance in this case. Since the onus is on the Applicant to show that its trademark is registrable, I must resolve this doubt against it. Thus, the registrability ground of opposition under section 12(1)(e) of the Act is also successful.

DISTINCTIVENESS UNDER SECTION 2 OF THE ACT

[112] The Opponent pleads that, having regard to the provisions of section 2 of the Act, and the allegations in the statement of opposition, the Mark is not and cannot be distinctive of the Applicant's goods or services, because it does not distinguish the

goods or services in association with which the Applicant is alleged to have used it or to intend to use it from the Opponent's goods and services.

[113] In the absence of further particulars, this ground must be read in conjunction with the statement of opposition as a whole, and is thus limited to the allegations of confusion and resemblance otherwise pleaded in the statement of opposition.

[114] The material date for this ground of opposition is June 3, 2020, the date the statement of opposition was filed [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185]. To succeed, an opponent relying on its own mark or name must establish that, as of this date, its mark or name was known in Canada to some extent at least, *i.e.* that its reputation was "substantial, significant or sufficient" to negate the established distinctiveness of another party's trademark, or else that it was well known in a specific area of Canada [*Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657; *1648074 Ontario Inc v Akbar Brothers (PVT) Ltd*, 2019 FC 1305].

[115] The Applicant submits that the June 3, 2020 material date is problematic for the Opponent, because it did not produce its annual report or any other evidence of use for 2020, when train service was suspended and the Opponent's advertising was likely also non-existent. In the Applicant's submission, the Opponent needed to provide evidence of use that was continuous and in the ordinary course of trade. Indeed, Mr. Levesque admits that the 2020 ridership and revenue figures, had they been available at the time of his declaration, would not have been in line with the other years' figures, given suspensions of rail service in February 2020 and the effects of the global pandemic in 2020 [paras 12–13, transcript Q31–Q32]. However, I find that the evidence *does* include an indication of the advertising figure for 2020, since Mr. Levesque states the annual expenditure for each of the ten years preceding his 2021 declaration was between 4 and 13 million, and I find it reasonable to infer that the bottom figure of 4 million would apply to the year 2020. Moreover, Mr. Levesque indicates that the Opponent was still serving passengers in 2020 and 2021, albeit in numbers that were greatly reduced [Q29–Q30].

[116] In any event, I agree with the Opponent's submission at the hearing to the effect that, at the material date of June 3, 2020, any suspension in rail service or advertising owing to the pandemic would not have been long enough to have a significant effect on the Opponent's reputation. Moreover, to meet the evidential burden under a distinctiveness ground of opposition, the reputation of an opponent's mark or name need not have been acquired through use or making known in the technical sense of sections 4 and 5 of the Act. For example, an opponent may rely on evidence of knowledge or reputation spread by word of mouth or by means of newspaper or magazine articles as opposed to advertising [see *Motel 6, supra*]. Accordingly, a brief interruption in use or advertising would not be decisive.

[117] I find that the Opponent's evidence of use and promotion of its VIA Design trademark discussed above is sufficient to meet its evidential burden. Furthermore, the earlier material date associated with the distinctiveness ground of opposition does not significantly alter the results of the test for confusion performed under the section 12(1)(d) registrability ground based on the Opponent's VIA Design trademark. Under a distinctiveness ground, it is the goods and services in association with which the Opponent has shown actual use, rather than the statement of services defined in the Opponent's registration, that governs the analysis. Furthermore, since a distinctiveness ground of opposition is based on the actual reputation of an opponent's trademark, rather than on the scope of a registration, the manner and context of the trademark's use, promotion, and publicity gain importance. However, I find that neither distinction would materially affect my analysis in the present case.

[118] Thus, the outcome of this ground of opposition is the same as under the registrability ground based on the Opponent's VIA Design trademark. Accordingly, the distinctiveness ground of opposition succeeds as well.

ENTITLEMENT UNDER SECTIONS 16(1)(A) AND 16(1)(C) OF THE ACT

[119] The Opponent pleads that the Applicant is not entitled to registration having regard to the provisions of section 16(1)(a) and (c) of the Act because, at the Application's filing date or at the alleged date of first use the Mark, or at any material

date, it was confusing with trademarks and trade names previously used in Canada by the Opponent, its predecessors in title, or, for their benefit, by licensees, namely (i) the trademark VIA or trademarks containing this term in word or design form, including VIA, VIA Rail, and each of the Via Rail Trademarks, and (ii) the trade name VIA or trade names containing this term, including VIA RAIL. The Opponent pleads use of its trademarks and trade names in association with its goods and services relating to passenger transport as well as the goods and services covered by the Opponent's Registrations, by the Via Rail Official Marks, and by the Application, and those that are of the same nature or similar to the goods and services covered by the Application.

[120] Section 16 of the Act does not require an opponent to demonstrate any particular level of use or reputation. If the opponent demonstrates that its trademark or trade name functions as such, that its use meets the requirements of section 4 of the Act, that such use occurred prior to the filing date of the opposed application, and that the trademark or trade name was not abandoned at the date of advertisement of the application, then the opponent will meet its burden under sections 16(a) and (c) of the Act [*JC Penney Co v Gaberdine Clothing Co*, 2001 FCT 1333; see also *Olive Me Inc, et al v 1887150 Ontario Inc*, 2020 TMOB 26].

[121] However, as the Opponent has already succeeded under three other grounds of opposition, there is no need to address these remaining grounds.




DISPOSITION

[122] In view of all the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the Application pursuant to section 38(12) of the Act.

Oksana Osadchuk
Member
Trademarks Opposition Board
Canadian Intellectual Property Office


SCHEDULE A

Opponent's Via Rail Trademarks

Trademark	Reg. No.	Goods or Services
VIA Design 	TMA278,895	Operation of a national railway for the transportation of passengers and the provision of such other services as normally performed by a national passenger train service .
VIA PREFERENCE	TMA510,700	<i>Programme d'avantages divers, nommément: programme d'accumulation de points offerts aux usagers du service de transport par train exploité par le requérant et qui sont échangeables contre des billets de train à destinations multiples ainsi que contre d'autres produits.</i> [TRANSLATION: Program offering various benefits, namely: points program for users of the train transportation service operated by the applicant, with points redeemable against train tickets for different destinations and other products.]
VIA PRÉFÉRENCE	TMA 510,670	
VIAPREFERENCE	TMA510,648	
VIAPRÉFÉRENCE	TMA510,650	
VIANET	TMA525,692	<i>Services automatisés de réservation pour les trains, les avions, les autobus, les traversiers, les excursions et les hôtels, location de voitures.</i> [TRANSLATION: Automated reservation services for trains, aircraft, buses, ferries, tours and hotels, car rental.]
VIA DESTINATIONS	TMA581,301	<i>Magazines.</i> [TRANSLATION: Magazines.]
VIA (Dessin) 	TMA638,813	<i>Luggage, back packs, handbags, wallets, umbrellas and belt pouches.</i>
VIA (& Dessin) 	TMA963,659	<i>Logiciel téléchargeable, nommément une application mobile pour la réservation de billets de train et la gestion des voyages en train.</i> [TRANSLATION: Downloadable software, namely mobile application for reserving train tickets and managing train itineraries.]

SCHEDULE B

Opponent's Via Rail Official Marks

Trademark	Serial No.
VIA Rail	924,496
VIA Préférence	924,806
VIA	924,807
VIA (logo) 	924,808

Appearances and Agents of Record

HEARING DATE: 2023-04-06

APPEARANCES

For the Opponent: Barry Gamache

For the Applicant: May Cheng

AGENTS OF RECORD

For the Opponent: ROBIC

For the Applicant: Dipchand LLP