



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 75

Date of Decision: 2024-04-17

IN THE MATTER OF AN OPPOSITION

Opponent: Shopify

Applicant: Ubeing Mobility Limited

Application: 1,886,294 for POSIFY & design

INTRODUCTION

[1] Ubeing Mobility Limited (the Applicant) has applied to register the trademark POSIFY & design (the Mark), shown below:

The trademark logo for 'posify' is centered on the page. It features the word 'posify' in a bold, lowercase, sans-serif font. A small, stylized leaf icon is positioned above the letter 'i'.

[2] The Mark is applied for in association with a variety of goods and services, including goods and services related to software and online sales, set out in Schedule A to this decision (the Applicant's Goods and Services).

[3] Shopify (the Opponent) opposes registration of the Mark. The opposition is based primarily on allegations that the Mark is confusing with five SHOPIFY word and design marks (collectively, the Opponent's Marks) registered by the Opponent in association with a range of goods and services (the Opponent's Goods and Services) including e-commerce and software-related goods and services, set out in Schedule B to this decision.

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

THE RECORD

[5] The application was filed on March 6, 2018. The application was advertised for opposition purposes in the *Trademarks Journal* on July 1, 2020. On December 30, 2020, the Opponent opposed the application by filing a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). I note that the Act was amended on June 17, 2019. As the application in this case was advertised after June 17, 2019, the Act as amended applies (see section 69.1 of the Act).

[6] The grounds of opposition are summarized below:

- Contrary to section 38(2)(a.1) of the Act, the application was filed in bad faith, since the application was filed with knowledge of the Opponent's Marks and with intent to trade off the goodwill in those marks.
- Contrary to sections 38(2)(b) and 12(1)(d) of the Act, the Mark is not registrable because it is confusing with one or more of the Opponent's Marks.
- Contrary to sections 38(2)(c) and 16(1)(a) of the Act, the Applicant is not the person entitled to registration of the Mark in Canada in association with the Applicant's Goods and Services because, at the filing date of the application, the Mark was confusing with the Opponent's Marks which were previously used in Canada by the Opponent and which were not abandoned at the date of advertisement of the application.

- Contrary to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive because it does not actually distinguish nor is it adapted to distinguish the Applicant's Goods and Services from the goods and services of the Opponent, having regard to the Opponent's prior use and reputation in Canada of the Opponent's Marks.
- Contrary to sections 38(2)(e) of the Act, the Applicant was not using and did not propose to use the Mark in Canada in association with the Applicant's Goods and Services.
- Contrary to section 38(2)(f) of the Act, at the filing date of the application, the Applicant was not entitled to use the Mark in Canada in association with the Applicant's Goods or Services since such use would be likely to have the effect of depreciating the value of the goodwill attaching to the Opponent's Marks contrary to section 22, and/or constitutes passing off, contrary to section 7(b) and the common law.

[7] On February 26, 2021, the Applicant served and filed a counter statement. Both parties filed evidence. The Applicant's affiant was cross examined on his affidavit. Both parties filed written representations; only the Opponent was represented at an oral hearing.

EVIDENCE

Opponent's Evidence

[8] As its evidence in this proceeding, the Opponent filed the affidavit of Hana Abaza, Director of Global Marketing for the Opponent, sworn November 24, 2021, and the affidavit of Akiv Jhirad, an articling student at the Opponent's agent of record, sworn November 26, 2021.

[9] The Abaza affidavit contains the following:

- Information about the Opponent, a global commerce company that is Canada's largest company by market capitalization as of the date of the affidavit, whose primary services include setup and management of online e-

commerce stores, and payment processing services, including point-of-sale (POS) solutions;

- Particulars for the Opponent's Marks as well as several common law trademarks and trademark applications;
- Information about the Opponent's "SHOPIFY Platform", a cloud-based commerce platform designed for use by merchants, as well as user information showing that Canadian merchants ran over 600,000 "shops" on the platform in Canada;
- Information about the Opponent's other services, including the "SHOPIFY App" and "SHOPIFY Merchant Solutions";
- Revenue figures in USD generated from the SHOPIFY Platform and SHOPIFY Merchant Solutions for the years 2012 to 2020, with total Canadian revenues in excess of \$400 million;
- Global sales and marketing expenses in USD for the years 2012 to 2020, with total expenses of over \$1.9 billion, approximately \$115 million of which is specific to Canada;
- Website and social media screenshots, including screenshots from the Opponent's website *shopify.ca* that are representative of how the Opponent's Marks were displayed on the website since as early as 2006, and information regarding the Opponent's awards and accolades; and
- Statements from the affiant regarding the similarities between the Mark and the Opponent's Marks.

[10] The Jhirad affidavit includes the following information:

- Search results on *Nexis.com* for Canadian news articles for the term "shopify", showing thousands of articles from sources including *The Globe and Mail*, *The Toronto Star*, *CBC News*, and *The Vancouver Sun*;
- Search results on *Nexis.com* for Canadian news articles for the term "posify", showing no results;

- Search results on *Google.ca* for the term “shopify”, showing millions of results, including “News” results;
- Search results on *Google.ca* for the term “posify”, showing tens of thousands of results, including a few hundred “News” results; and
- Screenshots from the Applicant’s website *posify.me*, including results translated from Chinese to English from Google’s “Translate this page” feature.

[11] While no circulation figures have been provided, I am prepared to take judicial notice of the fact that *The Globe and Mail*, *The Toronto Star* and *CBC News* have wide circulation in Canada, and that *The Vancouver Sun* has some circulation in Vancouver [*Milliken & Co v Keystone Industries (1979) Ltd (1986)*, 12 CPR (3d) 166 (TMOB) at 168-169].

Applicant’s Evidence

[12] As its evidence in this proceeding, the Applicant filed the affidavit of Kwok Leung Lam, the founder and CEO the Applicant, sworn June 27, 2022. The Lam affidavit includes the following information:

- Information about the Applicant, a digital technology company offering a retail management cloud platform. Mr. Lam describes POSIFY as “a cloud-based, cost effective, fully-integrated, and one-stop retail management solution which helps clients enhance their operational efficiency for both in-store and online selling”. He states that its “Online-to-Offline” or “O2O” marketing model “is a new business model, which provides a robust cloud-based ecosystem that unlocks omni-channel potential to drive efficiency, productivity and profitability”;
- Articles, dictionary definitions, and database searches relating to the suffix “IFY” and showing the number of companies and trademarks incorporating this suffix;

- A comparison between “POSIFY” and “SHOPIFY” by Mr. Lam, including dictionary definitions and screenshots from the website of “The Posify Group”, a third party; and
- Particulars for trademarks for “POSIFY” and “SHOPIFY” in other jurisdictions, including China, Republic of Korea, Vietnam, Hong Kong, Taiwan, and other jurisdictions. Mr. Lam states that he is not aware of any instances of actual confusion between goods and services provided under the Mark and under the Opponent’s Marks. As Exhibits I and J, he attaches a copy of a European Union Intellectual Property Office decision in which an opposition by the Opponent against the Applicant’s POSIFY & design trademark was rejected, and an appeal decision in which the rejection of the opposition was upheld. Mr. Lam states that when the Applicant enters the Canadian marketplace, it intends to provide its goods and services through a dedicated POSIFY website.

[13] On cross-examination, Mr. Lam was asked, *inter alia*, how he chose the name “POSIFY”, when he became aware of the Opponent’s “SHOPIFY” trademarks, and about his experience in conducting trademark searches. He stated that the “POS-” element referred to “possibilities” and that the suffix “-IFY” was inspired by the music company “Spotify”. He stated that he would likely have first heard of the Opponent in 2016 in the course of research into “-IFY” companies and trademarks. He further discussed the likelihood that the Applicant’s clients would recognize the acronym “POS” as referring to “point of sale”.

ANALYSIS

Ground of Opposition: Section 12(1)(d)

[14] The Opponent alleges that contrary to section 12(1)(d) of the Act, the Mark is not registrable due to the Opponent’s registrations for the Opponent’s Marks. I have exercised my discretion to check the register and confirm that these registrations remain extant [per *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410

(TMOB)]. The Opponent has therefore met its initial evidential burden for the section 12(1)(d) ground of opposition.

[15] Since the Opponent has discharged its evidentiary burden regarding this ground of opposition, I must assess whether the Applicant has discharged its legal onus to prove, on balance of probabilities, that there is no reasonable likelihood of confusion between the Applicant's Mark and the aforementioned registrations of the Opponent. The material date with respect to confusion with a registered trademark is the date of this decision [*Simmons Ltd v A to Z Comfort Beddings Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[16] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see, in general, *Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22 (*Mattel*), and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 (*Masterpiece*)]. Moreover, in *Masterpiece*, the Supreme Court stated that the degree of resemblance between the trademarks is often likely to have the greatest effect on the confusion analysis.

[17] Finally, section 6(2) of the Act does not concern confusion between the trademarks themselves, but confusion regarding goods or services from one source as being from another source. In this case, the question posed by section 6(2) is whether there would be confusion regarding the goods and services sold under the Mark such that they would be thought to have emanated from the Opponent.

[18] In conducting the confusion analysis, I will focus on the Opponent's SHOPIFY & Design mark, registration No. TMA963,059 (the Opponent's Colour Design Mark), as the Opponent submits, and I agree, that it represents the Opponent's best case with respect to the issue of confusion.

Inherent and acquired distinctiveness

[19] The Opponent submits that its trademark has a high degree of inherent distinctiveness as it is a coined term combining “shop” and “ify”, and notes that at the time its trademark was adopted in 2005, there were virtually no businesses using “ify” endings, and there continue to be no direct competitors to the Opponent using such a formulation. The Applicant, by contrast, submits that the Opponent’s Marks possess a low degree of inherent distinctiveness as they consist of a common word combined with a common suffix, and the word and design elements are suggestive of the Opponent’s services. The Applicant submits that where a trademark is suggestive of its associated goods or services, it will be entitled to a narrower scope of protection, citing, *inter alia*, *General Motors Corp v Bellows* (1949), 10 CPR 101 (SCC).

[20] By contrast, the Applicant submits that the Mark consists of a coined word and design elements without any particular meaning or suggestive character as a matter of first impression. In this respect, the Applicant notes that Mr. Lam coined the term “posify” from the word “possibility” [Lam cross-examination Q41]. At the oral hearing, the Opponent submitted that on Mr. Lam’s cross-examination, he indicated that the Applicant’s main clientele were merchants [Lam cross-examination Q71], many of whom would understand that the acronym “POS” refers to “point of sale” [Lam cross-examination Q76-87].

[21] In assessing what customers would understand from a combination of ordinary words or an acronym, the Registrar must not only consider the evidence but also apply common sense [see *Candrug Health Solutions Inc v Thorkelson*, 2008 FCA 100; *Neptune SA v Attorney General of Canada*, 2003 FCT 715; with respect to acronyms, see *ATP Athlétique et Thérapeutique Pharma Inc. and ATP Institute Pty Ltd*, 2023 TMOB 65]. Further, the Registrar may take judicial notice of the dictionary definitions of words found in trademarks [*Tradall SA v Devil's Martini Inc*, 2011 TMOB 645]; in this respect, I note that one of the definitions for “POS” in the *Oxford English Dictionary* is “Point of sale”.

[22] In this case, in view of the aforementioned evidence set out by Mr. Lam in his cross-examination, of the dictionary definition cited above, and of a common-sense understanding of how the Applicant's customers would understand the Mark, I am of the view that the Applicant's customers would likely understand the prefix "pos" in the Mark as referring to "point-of-sale", even though it is rendered in lower-case letters. Although I agree with the Applicant that the "pos" element of the Mark would likely be pronounced as a single syllable rather than as the three component letters, in my view, this does not mean that the Applicant's customers would fail to recognize it as a commonly-used acronym. Accordingly, I find that the Mark is of roughly equal inherent distinctiveness to the Opponent's Mark, as the design elements do little to increase the inherent distinctiveness of the Mark.

[23] Even if I were to find that the "pos" element would not be recognized as referring to "point-of-sale", and the Mark possessed greater inherent distinctiveness than the Opponent's Colour Design Mark, the distinctiveness of a trademark can be increased through its use and promotion in Canada [see *Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD)]. In this respect, the Opponent has provided substantial sales figures since 2012, and evidence of display of its trademarks, including the Opponent's Colour Design Mark, on its website in association with its services since 2006, along with evidence of its trademark and services being referenced in publications with wide circulation in Canada. By contrast, the Applicant has not used its Mark in Canada. Accordingly, the Opponent's Colour Design Mark has much higher degree of acquired distinctiveness than the Applicant.

[24] On balance, therefore, this factor favours the Opponent.

Length of time in use

[25] As noted above, the Opponent has provided evidence of use of the Opponent's Colour Design Mark since at least 2012, while the Applicant has not used its Mark in Canada.

[26] Accordingly, this factor favours the Opponent.

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

[27] When considering sections 6(5)(c) and (d) of the Act, it is the statement of goods and services as defined in the registration relied upon by the Opponent and the current statement of goods and services in the application for the Mark that governs the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, as each statement must be read with a view to determining the probable type of business intended, evidence of the parties' actual trades is useful [see *McDonald's Corp v Coffee Hut Stores Ltd*, 1996 CanLII 3963 (FCA); *McDonald's Corp v Silcorp Ltd* (1989), 55 CPR (2d) 207 (FCTD), *aff'd* (1992), 41 CPR (3d) 67 (FCA)].

[28] The Opponent submits that both parties offer online and offline solutions to merchants in the nature of software as a service for creating, hosting, and managing online stores, providing payment processing solutions, inventory management, customer communications, order fulfilment, promotional activities, and the like. While the Opponent acknowledges that the application contains a number of "extraneous" goods and services, it submits that these are invalid pursuant to section 38(2)(e). Similarly, the Opponent submits that the channels of trade are expected to be identical since merchants could encounter both parties' trademarks while searching for e-commerce solutions online or on app stores. The Applicant makes no submissions with respect to these factors.

[29] I concur with the Opponent that there is considerable similarity between the nature of the Applicant's and Opponent's Goods and Services related to software, e-commerce, and online purchasing, finance, and marketing, as set out in Schedule A to this decision (collectively, the Applicant's Overlapping Goods and Services). Similarly, I find that there would be likely to be overlap in the channels of trade in which the Applicant's Overlapping Goods and Services are offered, given that both are likely to be offered to a similar client base (namely, business owners and merchants, as set out in the Applicant's evidence and cross-examination) and could be provided through channels such as app stores.

[30] However, I find that there is little similarity between the Opponent's Goods and Services and the Applicant's remaining Goods and Services (the Applicant's Non-Overlapping Goods and Services), as there is no evidence that I could infer that they are oriented towards a similar client base or would be provided through similar channels of trade.

[31] Accordingly, these factors favour the Opponent with respect to the Applicant's Overlapping Goods and Services. They favour the Applicant with respect to the Applicant's Non-Overlapping Goods and Services.

Degree of resemblance

[32] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality; it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trademarks. The Supreme Court of Canada in *Masterpiece* has advised that the preferable approach when comparing trademarks is to begin by determining whether there is an aspect of the trademark that is particularly striking or unique.

[33] The Opponent submits that the most striking element of both design marks are their word elements, particularly the suffix "-IFY", since the terms "SHOP" and "POS" are both suggestive of the parties' services. Accordingly, the Opponent submits that the trademarks suggest similar ideas, and that the design element and the lower-case bold font present in both trademarks enhances the visual similarity between the trademarks.

[34] The Applicant submits that the Opponent's Colour Design Mark is a combination of a common word and common suffix, neither of which is particularly striking or unique. By contrast, the Applicant submits that its Mark would not be perceived as an acronym and would instead be pronounced as an individual unit which does not have a commonly recognized meaning, as discussed above. The Applicant submits that the first portion of the trademarks is the most dominant, making confusion unlikely, and that

the stylized elements are not similar. As such, the Applicant submits that the trademarks are not similar visually, phonetically, or in ideas suggested.

[35] Both parties have put forward a number of cases in support of their respective positions and sought to distinguish the other parties' case law. For example, the Opponent points to *Motorola Inc v Fonorola Inc* (1998), 78 CPR (3d) 509 (FCTD) and *Home Hardware Stores Limited v Benjamin Moore & Co*, 2015 FC 1344 (which I note has been set aside in 2017 FCA 53), as cases where the suffix or last part of a trademark anchored a finding of resemblance, and the Applicant points to a number of cases where no confusion was found despite similar suffixes [*Reynolds Consumer Products, Inc v PRS Mediterranean Ltd*, 2012 FC 824 (which I note has been set aside in 2013 FCA 119); *Beiersdorf AG v Laboratoires BIOCOS, SAS*, 2014 TMOB 199; *Intime Solutions Inc v Epic Systems Corp*, 2011 TMOB 159; *Vincor International IBC Inc v Oenoforos AB*, 2011 TMOB 93; *Anheuser-Busch, LLC v Tequila Cuervo, SA de CV*, 2021 TMOB 48; *General Electric Company v LG Electronics Inc*, 2016 TMOB 54; and *Breville Pty Limited v Keurig Green Mountain, Inc*, 2014 TMOB 248]. Ultimately, however, each case turns on its own facts, and as noted above, the trademarks must be considered in their totality when determining the degree of resemblance.

[36] In this case, I find that the Opponent's Colour Design Mark and the Mark have a fair degree of visual similarity. For instance, both trademarks include a word consisting of almost exactly the same letters in a slightly different order, set in a black lower-case sans serif font, with limited design elements. Phonetically, there is some similarity between the trademarks. In terms of ideas suggested, to the extent that "pos" is likely to be understood as referring to "point of sale", as discussed above, the trademarks convey related ideas.

[37] Accordingly, I find that this factor, on balance, favours the Opponent.

Additional surrounding circumstances: coexistence of the trademarks

[38] The Applicant submits that the coexistence of the Mark and the Opponent's Marks in other jurisdictions is a factor that weighs against a finding of confusion. The

Applicant notes that with the exception of the EUIPO proceeding referenced in Mr. Lam's affidavit, in which the Applicant was successful, the Opponent did not take any step to oppose or cancel the Mark in any of the jurisdictions where the trademarks coexist.

[39] However, as there may be factors that justify the co-registration of trademarks in a foreign jurisdiction that do not exist in Canada (such as differences in the law or a different state of the register), little can be drawn from the fact that trademarks coexist in other jurisdictions. The Registrar's decision must be based on Canadian standards, having regard to the situation in Canada [see *Quantum Instruments, Inc v Elinca SA* (1995), 60 CPR (3d) 264 (TMOB) and *Vivat Holdings Ltd v Levi Strauss & Co* (2005), 2005 FC 707, citing *Re Haw Par Brothers International Ltd v Registrar of Trade Marks* (1979), 48 CPR (2d) 65 (FCTD) and *Sun-Maid Growers of California v Williams & Humbert Ltd* (1981), 54 CPR (2d) 41 (FCTD)].

[40] I therefore do not consider this to be a relevant surrounding circumstance in this case.

Conclusion

[41] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection and have considered all of the surrounding circumstances. In most instances, it is the degree of resemblance between the trademarks that is the most crucial factor in determining the issue of confusion [*Masterpiece; Beverley Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145 (FCTD) at 149, aff'd 60 CPR (2d) 70 (FCA)]. Furthermore, section 6(2) of the Act is not concerned with confusion between the trademarks themselves, but rather confusion as to the source of the goods or services.

[42] In this case, I find that the Applicant has not discharged its burden to show that there is not a reasonable likelihood of confusion between the Mark and the Opponent's Colour Design Mark with respect to the Applicant's Overlapping Goods and Services in view of the similar nature of those goods and services with those of the Opponent, the

similar nature of the trade, the resemblance between the trademarks, and the greater acquired distinctiveness and longer time in use of the Opponent's Colour Design Mark. I note that given the visual and phonetic similarities between the trademarks, I would reach this conclusion even if I did not find that the Applicant's customers would recognize the "pos" element of the Mark as referring to "point of sale". However, with respect to the Applicant's Non-Overlapping Goods and Services, I find that the different nature of these goods and services as compared to those of the Opponent, as well as their respective channels of trade, are sufficient to shift the balance of probabilities regarding confusion in favour of the Applicant.

[43] As such, this ground of opposition succeeds with respect to the Applicant's Overlapping Goods and Services, and is rejected with respect to the Applicant's Non-Overlapping Goods and Services.

Ground of Opposition: Section 16(1)(a)

[44] Pursuant to sections 38(2)(c) and 16(1)(a) of the Act, the Opponent pleads that the Applicant is not the person entitled to registration of the Mark in Canada in association with the Applicant's Goods and Services because, at the filing date of the application, the Mark was confusing with one of the Opponent's Marks which were previously used in Canada by the Opponent and which were not abandoned at the date of advertisement of the application.

[45] As the Applicant has not filed any evidence of use of the Mark prior to the application filing date, in order to meet its initial burden under this ground, the Opponent must show that at least one of its trademarks was used prior to this date (March 6, 2018) and was not abandoned at the date of the advertisement of the application (July 1, 2020). The Opponent's evidence set out in the Abaza affidavit, and summarized above, is sufficient to meet its evidential burden with respect to the Opponent's Colour Design Mark.

[46] I reach the same conclusions in the confusion analysis as those set out in the section 12(1)(d) ground, as the difference in material dates makes little difference in the confusion analysis.

[47] Accordingly, this ground of opposition succeeds with respect to the Applicant's Overlapping Goods and Services, and is rejected with respect to the Applicant's Non-Overlapping Goods and Services.

Ground of Opposition: Section 2

[48] The Opponent has also pleaded that contrary to section 2 of the Act, the Mark does not actually serve to distinguish and is not adapted to distinguish the Applicant's Goods and Services from the services associated with the Opponent's Marks. The material date with respect to a distinctiveness ground of opposition is the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FCTD)].

[49] In order to meet its initial burden in support of the non-distinctiveness ground of opposition, the Opponent must show that as of December 30, 2020, at least one of the Opponent's Marks were known to some extent at least and its reputation in Canada was substantial, significant or sufficient [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657].

[50] I find that the Opponent's evidence of use of the Opponent's Colour Design Mark, showing significant sales in Canada since 2012, along with its evidence of reputation as shown through references to SHOPIFY in third party publications is sufficient to meet its evidential burden. As the difference in material dates has no impact on my analysis of this ground of opposition, I reach the same conclusions with respect to confusion as those set out in the section 12(1)(d) ground.

[51] Accordingly, this ground of opposition succeeds with respect to the Applicant's Overlapping Goods and Services, and is rejected with respect to the Applicant's Non-Overlapping Goods and Services.

Ground of Opposition: Section 38(2)(a.1)

[52] The Opponent alleges that the Applicant filed the application in bad faith, since the application was filed with knowledge of the Opponent's Marks and with intent to

trade off the goodwill in those marks. The material date for the analysis under section 38(2)(a.1) of the Act is the date the application was filed (March 6, 2018).

[53] As for the parties' respective burdens, where there are facts that fall uniquely within the knowledge of the Applicant, circumstantial evidence and inferences from proved facts may be sufficient to establish the objectives of the Applicant at the time of filing, while hearsay evidence and vague conjecture will not [*Beijing Judian Restaurant Co Ltd v Meng*, 2022 FC 743 at para 39 (*Beijing Judian*); *Beijing Jingdong 360 Du E-Commerce Ltd v Zhang*, 2019 FC 1293 at para 23-24; *Domaines Pinnacle Inc v Les Vergers de la Colline*, 2016 FC 188 at para 68].

[54] The Opponent submits that given the manner in which the Applicant settled on the Mark, as set out in Mr. Lam's cross-examination, it is more likely than not that the Applicant intentionally chose the Mark to benefit from the prior goodwill and reputation of the Opponent. By contrast, the Applicant submits that the Opponent has filed no evidence of bad faith on the part of the Applicant, and that it is well established that mere knowledge of an opponent's trademark does not, by itself support an allegation that an application was filed in bad faith.

[55] I agree with the Applicant that the Opponent has not met its burden with respect to this ground. Adopting and/or applying to register a trademark that is similar to a competitor's trademark, even for use in association with identical or similar goods and services, is not, in itself, evidence of bad faith [see *Galperti SRL v FIAL Finanziaria Industrie Alto Lario SPA*, 2022 TMOB 127 at para 145], particularly in the absence of other factors, such as evidence of an intention to harm a prior user's business [*Yiwu Thousand Shores E-Commerce Co. Ltd v Lin*, 2021 FC 1040] or evidence demonstrating that a party registered a trademark without a legitimate commercial purpose, but rather, to extort money from another party [*Beijing Judian* at para 46]. I note that this is not a situation where an applicant applied to register a trademark identical to a well-known trademark to coattail on its reputation [see *Cerverceria Modelo, SA de CV v Marcon* (2008), 70 CPR (4th) 355; *Julia Wine Inc v Marques Metro, SENC*, 2016 FC 738]

[56] Accordingly, this ground of opposition is rejected as the Opponent has not met its evidentiary burden.

Ground of Opposition: Section 38(2)(e)

[57] The Opponent has pleaded that the Applicant was not using and did not propose to use the Mark in Canada in association with the Applicant's Goods and Services. In its written representations, the Opponent specifies that this ground of opposition only applies to certain of the Applicant's Goods and Services, namely, those that are unrelated to the Applicant's business as a retail management cloud platform, which correspond to the Applicant's Non-Overlapping Goods and Services.

[58] The material date for this ground of opposition is the filing date of the application (March 6, 2018).

[59] The principles set out in cases relating to the former section 30(e) ground of opposition, based upon whether an applicant had a *bona fide* intention to use the trademark in Canada, can be instructive in regards to this new ground. As with the former section 30(e) ground, since the relevant facts are more readily available to and particularly within the knowledge of the applicant under a section 38(2)(e) ground of opposition, the evidential burden on an opponent in respect of this ground is light and the amount of evidence needed to discharge it may be very slight [*Allergan Inc v Lancôme Parfums & Beauté & Cie, société en nom collectif* (2007), 64 CPR (4th) 147 (TMOB); *Canadian National Railway v Schwauss* (1991), 35 CPR (3d) 90 (TMOB); *Green Spot Co v John M Boese Ltd* (1986), 12 CPR (3d) 206 at 210-11 (TMOB)].

[60] In the Opponent's submission, the Applicant has filed a "bloated" list of goods and services, "many of which it clearly has no interest, intention or ability to deliver". In this respect, the Opponent notes that Mr. Lam states in his affidavit that the Applicant "is a digital technology company that offers a retail management cloud platform" and that "POSIFY is a cloud-based, cost effective, fully-integrated, and one-stop retail management solution which helps clients enhance their operational efficiency both for in-store and online selling".

[61] I am not satisfied that the Opponent has met its evidentiary burden with respect to this ground. Notably, the Opponent does not point to any aspect of the Applicant's evidence which would suggest that the Applicant could not propose to use the Mark in association with any of the Applicant's Goods and Services, and did not choose to question Mr. Lam about any of the so-called "extraneous goods and services" in cross-examination. Moreover, the Opponent has not referred to any authority for the proposition that the list of goods and services was "improperly filed" contrary to section 38(2)(e). While the evidence cited by the Opponent in support of its submissions refers to use of the Mark in association with a retail management cloud platform, evidence that an applicant is using or intending to use a trademark in association with one good or service is not, in itself, clearly inconsistent with and does not cast doubt on the Applicant's proposal to use the Mark in association with other goods or services in future, either by itself or through a licensee [for similar conclusions, see *Specialty Rice Company v Shackelton Inc*, 2020 TMOB 127; *The Coryn Group II, LLC and NH HOTEL GROUP, SA*, 2023 TMOB 18 at paras 39-43].

[62] As the Opponent has not met its burden, this ground of opposition is rejected.

Ground of Opposition: Section 38(2)(f)

[63] The Opponent alleges that at the filing date of the application, the Applicant was not entitled to use the Mark in Canada in association with the Applicant's Goods or Services since such use would be likely to have the effect of depreciating the value of the goodwill attaching to the Opponent's Marks contrary to section 22, and/or constitutes passing off, contrary to section 7(b) and the common law. As section 38(2)(f) of the Act focuses on whether an applicant can lawfully use the applied-for trademark in Canada, I find that the jurisprudence pertaining to section 30(i) of the Act as it read before June 17, 2019 (the Old Act), may inform the interpretation of section 38(2)(f) of the Act.

[64] As noted by the Applicant, the Opponent made no submissions in its written representations that use of the Mark would constitute passing off. In any event, in the absence of evidence of deception to the public due to a misrepresentation [see *Kirkbi*

AG v Ritvik Holdings Inc, 2003 FCA 297, aff'd 2005 SCC 65; and *Ciba-Geigy Canada Ltd v Apotex Inc*, [1992] 3 SCR 120 (SCC)], I do not find that the Opponent has met its evidential burden for a *prima facie* case.

[65] With respect to the Opponent's allegation that the Applicant's use of the Mark would be likely to depreciate the value of the goodwill attaching to the Opponent's Marks contrary to section 22, the jurisprudence applying section 30(i) of the Old Act has established this to constitute a valid ground of opposition on the basis that the Registrar cannot condone the registration of a trademark if an applicant's use of the mark would violate federal legislation, including the Act [see *McDonald's Corporation and McDonald's Restaurants of Canada Limited v Hi-Star Franchise Systems, Inc*, 2020 TMOB 111 at para 28 (*McDonald's*)]. To demonstrate a depreciation of goodwill under section 22 of the Act in this case, the following four elements are required: (1) use by the Applicant of the Opponent's trademark(s); (2) sufficient goodwill in the Opponent's trademark(s), (3) likely connection or linkage in the consumer's mind between the Opponent's goodwill and the Applicant's use, and (4) likelihood of depreciation [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 (*Veuve Clicquot*) at paras 46, 63-68].

[66] On the first step, the Opponent submits that the Mark is sufficiently similar to the Opponent's Marks, particularly its design marks, that it would evoke a mental association with those trademarks. In support, it cites a number of Federal Court cases (discussed below) in which trademarks were found to be sufficiently similar to evoke a mental association between them.

[67] The Applicant submits that this ground of opposition fails at the first step because a ground of opposition based on section 22 cannot succeed where there has been no actual use of an applicant's trademark [citing *Children's Miracle Network v Foundation for Prader-Willi Research Canada*, 2015 TMOB 16 at para 49, along with a number of cases from the Board where this precedent has been followed]. Further, the Applicant submits that the evidence does not show "use of the trade-mark or something so closely akin to it so as to be understood as the other party's mark", as required by the Federal

Court of Appeal in *Venngo Inc v Concierge Connection Inc (Perkopolis)*, 2017 FCA 96 (*Venngo*) at para 13.

[68] At the oral hearing, the Opponent submitted that the *Children’s Miracle Case* and its progeny should not be followed as they rely on an obiter statement in *Indigo Books & Music Inc v C & J Clark International Ltd*, 2010 FC 859, which was not followed in *Dairy Processors Assn of Canada v Producteurs Laitiers du Canada / Dairy Farmers of Canada*, 2014 FC 1054. However, even if I were to agree with the Opponent that a section 22 ground of opposition could succeed where there has been no evidenced use of an applicant’s trademark, I would not find that the ground of opposition based on depreciation of goodwill can succeed in this case because use of the Mark would not amount to use of any of the Opponent’s Marks, and it is not so closely akin as to be understood as any of the Opponent’s Marks in a relevant universe of consumers [see *Veuve Clicquot* at para 38; *Venngo* at para 79]. I note that in *Veuve Clicquot*, the Supreme Court held that depreciation may occur where only the “distinguishing feature” of the senior trademark is being used by the allegedly offending trademark, where “the casual observer would recognize the mark used by the respondents as *the mark of the appellant*” [para 48, emphasis added], even where that element is misspelled or differently spelled, so long as the requisite mental association exists [para 49]. As noted above, the Federal Court of Appeal in *Venngo* has held that section 22 can apply where there has been use of an identical trademark or a trademark that “is so closely akin to the registered mark that it would be understood in a relevant universe of consumers to be *the registered mark*” [para 80, emphasis added].

[69] Although I have found in the confusion analysis above that the Mark shares a degree of resemblance with certain of the Opponent’s Marks, the tests for confusion and depreciation of goodwill are conceptually different [*Veuve Clicquot* at para 46; see also *Sleep Country Canada Inc v Sears Canada Inc*, 2017 FC 148 (*Sleep Country*) at para 99; *Novartis AG v Biogen Inc*, 2024 FC 52 at para 124], and I do not find the resemblance to be so strong as to meet the threshold for depreciation of goodwill. In other words, the fact that the Mark may be confusing with the Opponent’s Colour

Design Mark does not mean that the Mark is, or would be understood as being, the Opponent's Colour Design Mark.

[70] For instance, the words "posify" and "shopify" simply cannot be said to be identical or nearly identical, even if they are similar, unlike the trademarks at issue in *Sleep Country* [see para 109] or *1196278 Ontario Inc (Sassafras) v 815470 Ontario Ltd (Sassafras Coastal Kitchen & Bar)*, 2022 FC 116. While "shop" and "pos" may suggest similar ideas, as discussed above, they do not suggest *identical* or *almost identical* ideas, unlike *Techno-Pieux Inc v Techno Piles Inc*, 2023 FC 581 or *Sleep Country*, respectively.

[71] Further, although the Mark and certain of the Opponent's Marks may include lower-case words in a bold, black sans-serif font, the fonts are not identical, and the font in the Opponent's design marks is set in italics. Further, even if the design element of the Mark is rendered in green, the design elements and their placement are not especially similar (with the Mark having a leaf design placed above the letter "i", and the Opponent's Mark having a larger shopping bag placed before the word "shopify"), unlike in *Subway IP LLC v Budway, Cannabis & Wellness Store*, 2021 FC 583, or *Toys "R" Us (Canada) Ltd v Herbs "R" Us Wellness Society*, 2020 FC 682, cited by the Opponent, in which distinctive design elements from the applicants' design marks were reproduced nearly wholesale in the trademarks at issue [see also *H-D USA, LLC v Varzari*, 2021 FC 620 at para 46]. Finally, in the *McDonald's* case, the opponent had established a large family of MC-prefixed trademarks [para 23]; the Opponent has not established any similar family of -IFY-suffixed trademarks in the present case.

[72] Accordingly, the Opponent has not met its evidentiary burden to show that any use of the Mark would be contrary to section 22 of the Act, as it fails at the first step of the test for depreciation of goodwill.

[73] As the Opponent has not met its burden, this ground of opposition is rejected.

DISPOSITION

[74] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to all of the Applicant's Goods and Services set out below:

Goods (Nice class & Statement)

- 9 (1) Bar code printers; bar code scanners; cash registers; computer software for handling employee's profile, payroll calculations and information; computer software for handling employee's shift schedules; computer software for managing employee's leave; computer software for managing employee's travelling and expenses claims; credit card terminals; electronic payment terminals; interactive touch screen terminals; point-of-sale terminals; secure terminals for electronic transactions; computer software for creating, sending and receiving e-mail; computer software for use in providing multiple user access to a global computer information network; communications computers.

Services (Nice class & Statement)

- 35 (1) conducting marketing studies; business marketing consulting services; conducting market surveys for others; design of marketing surveys; development of marketing strategies and concepts for others; direct marketing of the goods and services of others; market analysis; market research services; marketing services in the field of arranging for the distribution of the products of others; providing business marketing information for others; secretarial services; business administration consulting services; promoting the goods and services of others by arranging for sponsors to affiliate their goods and services with soccer competitions; accounting; book-keeping; computer database management services; business management assistance for industrial and commercial companies; advertising agency services; advertising on the Internet for others; advertising the goods and services of others; advertising the goods and services of others through all public communication means; on-line advertising for others on computer networks; production of advertising matter and commercials for others; computerized file management; rental of office machinery and equipment; computerized on-line ordering services in the field of retail sale of food and beverage; computerized on-line ordering services for booking the services of spas, beauty salons and nail spas; computerized on-line ordering services in the field of products for spas, beauty salons and nail spas, namely, sleep masks, bath robes, bath sandals, bath slippers, bath wraps, bathing caps, bathing costumes, bathing trunks, bath linen, bath mitts, bath sheets, bath sponges, body care soap, body creams, body deodorants, body emulsions, body lotions, body masks, body milks, body moisturizers, body oils, body powders, body scrubs, body soak, body wash, exfoliating scrubs for the body, cosmetics, skin care preparations, cuticle conditioners, cuticle cream, cuticle nippers, cuticle pushers, cuticle removing preparations, cuticle scissors, cuticle softeners, cuticle tweezers, nail lamps, nail polish, towels; computerized online ordering featuring clothing; dissemination of advertising for others via the Internet; compilation, production and dissemination of advertising matter for others; online sales of clothing; online sales

of cosmetics; online sales of food items; online sales of footwear; online sales of headwear; online sales of housewares; online sales of lingerie; online sales of photographic equipment; online sales of sporting goods; online sales of toys; providing home shopping services of car audio electronics via the internet; providing home shopping services of fitness equipment via the internet; providing home shopping services of sporting goods via the internet; advertising the goods and services of others via email; advertising by transmission of on-line publicity for third parties through electronic communications networks; sponsoring in the form of advertising the goods and services of others; rental of advertising space on the internet; commercial business management of the licensing of goods and services, for others; business management consulting and advising services in the field of retail sale of food, beverages and beauty products; business management consulting and advising services in the field of health care services and beauty salon services.

- 36 (2) Instalment loans; electronic funds transfer; financial analysis; fiscal assessments; financial management; advisory services in the field of credit and debit control, investment, grants and financing of loans; financial planning and investment advisory services; providing companies' financial information for credit rating and assessment; hire-purchase financing; lease-purchase financing; insurance services; payment card services; credit and debit card services.
- 38 (3) wireless digital messaging services; providing multiple user access to global computer information networks for the transfer and dissemination of a wide range of information; providing user access to a global computer network; providing e-mail services.
- 42 (5) Conversion of data or documents from physical to electronic media; computer software consulting; consultancy in the design and development of computer hardware; consultancy in the field of webpage design; internet security consultancy; rental of computer software; software as a service (SAAS) provider in the field of providing customer relations management, human resource management, inventory management, e-vouchers and e-coupons; software as a service (SAAS) provider in the field of software for small business accounting; software as a service (SAAS) provider in the field of office productivity software; software as a service (SAAS) provider in the field of providing software for product and order management for retail stores; software as a service (SAAS) provider in the field of providing software for order management for restaurants; software as a service (SAAS) provider in the field of providing software for booking and rostering management for spas, beauty salons and health care clinics; software as a service (SAAS) provider in the field of providing software for digital marketing, namely providing chatbots and software for managing integration with social media; cloud computing photo sharing services; cloud computing provider services for general storage of data; cloud computing providing software for database management; cloud computing web hosting services; cloud seeding; cloud computing provider services allowing customers to run their own software in the cloud; electronic storage of payroll data; electronic storage of information about goods and services of others; electronic storage of consumers' personal details and consumption history; electronic storage of medical records; electronic storage of photographic images; hosting internet sites for others;

technical research in the field of computing and point-of-sale terminals; creating and maintaining web sites for others; server hosting; rental of web servers; designing and developing webpages on the internet for others; design, development, installation and maintenance of computer software; software as a service (SAAS) provider in the field of software for business administration.

[75] I reject the opposition with respect to the remainder of the Applicant's Goods and Services set out below:

Goods (Nice class & Statement)

- 9 (1) computer games; blank USB cards; blank USB flash drives; hard disk drives; blank Cds; blank DVDs; blank magnetic discs; blank secure digital (SD) memory cards; blank smart cards; electronic books; downloadable electronic journals; global positioning system (GPS) receivers; pre-recorded compact discs containing computer games; personal computers; computer printers; punched card machines for offices; global positioning system (GPS) consisting of computers, computer software, transmitters, receivers, and network interface devices; global positioning system (GPS) satellites; global positioning system (GPS) transmitters; navigation apparatus for vehicles in the form of on-board computers; tablet computers.

Services (Nice class & Statement)

- 35 (1) Personnel management consultancy; advertising services of a radio and television advertising agency; providing advertising space in periodicals, newspapers and magazines; direct mail advertising of the goods and services of others; administration of employee pension plans.
- 36 (2) investment of funds for others; financial investment counselling.
- 38 (3) Cellular text messaging services; leasing access time to a computer database containing legal information; leasing access time to a computer database in the field of community social events; leasing access time to a computer database in the field of cooking; leasing access time to a computer database in the field of job postings; videoconferencing services; teleconferencing services; voice mail services; providing an online bulletin board in the field of community social events; providing an online bulletin board in the field of professional development and networking events; providing access to digital music websites on the internet; streaming of audio via the Internet featuring music.
- 41 (4) Arranging and conducting financial conferences; arranging and conducting real estate conferences; organisation of conferences and symposia in the field of medical science; arranging and conducting of exhibitions for education and entertainment, seminars and symposiums in the field of retail sale of food, beverages and beauty products; arranging and conducting of exhibitions for education and entertainment, seminars and symposiums in the field of health care services provided by a health spa and beauty salon services; production of video

games; providing on-line computer games; event planning; party planning; organizing and managing parliaments, conferences, colloquiums, symposiums, seminars, lectures, speeches and workshops in the field of retail sale of food, beverages and beauty products; organizing and managing parliaments, conferences, colloquiums, symposiums, seminars, lectures, speeches and workshops in the field of health care services provided by a health spa and beauty salon services; driver education training; physical education services; vocational education in the field of computers; vocational education in the field of food services; vocational education in the field of hospitality; vocational education in the field of mechanics; airplane flight instruction; art instruction; bookkeeping instruction; commercial flying instruction; conducting courses of instruction at the college level; conducting courses of instruction at the high school level; conducting courses of instruction at the primary level; cooking instruction; dance instruction; teaching in the field of retail sale of food, beverages and beauty products; teaching in the field of health care services provided by a health spa and beauty salon services; tutoring; providing facilities for hockey tournaments; providing golf course facilities; providing gymnastic facilities; providing karaoke facilities; providing skating rink facilities; providing sports arena facilities; providing swimming pool facilities; providing tennis court facilities; provision of cinema facilities; rental of diving equipment; rental of ski equipment; rental of sports equipment; providing educational and entertainment information in the field of retail sale of food, beverages and beauty products; providing educational and entertainment information in the field of health care services provided by a health spa and beauty salon services; publication of electronic books and journals on-line.

G.M. Melchin
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2024-03-14

APPEARANCES

For the Opponent: Daniel Anthony

For the Applicant: No one appearing

AGENTS OF RECORD

For the Opponent: Smart & Biggar LP

For the Applicant: Neomark Ltd.

SCHEDULE A

POSIFY & design, Application number 1897974



[Note: Applicant's Overlapping Goods and Services, as defined above, indicated by underlining]

Goods (Nice class & Statement)

- 9 (1) Bar code printers; bar code scanners; cash registers; computer games; computer software for handling employee's profile, payroll calculations and information; computer software for handling employee's shift schedules; computer software for managing employee's leave; computer software for managing employee's travelling and expenses claims; credit card terminals; electronic payment terminals; interactive touch screen terminals; point-of-sale terminals; secure terminals for electronic transactions; blank USB cards; blank USB flash drives; hard disk drives; blank Cds; blank DVDs; blank magnetic discs; blank secure digital (SD) memory cards; blank smart cards; electronic books; downloadable electronic journals; global positioning system (GPS) receivers; computer software for creating, sending and receiving e-mail; computer software for use in providing multiple user access to a global computer information network; communications computers; pre-recorded compact discs containing computer games; personal computers; computer printers; punched card machines for offices; global positioning system (GPS) consisting of computers, computer software, transmitters, receivers, and network interface devices; global positioning system (GPS) satellites; global positioning system (GPS) transmitters; navigation apparatus for vehicles in the form of on-board computers; tablet computers.

Services (Nice class & Statement)

- 35 (1) Personnel management consultancy; conducting marketing studies; business marketing consulting services; conducting market surveys for others; design of marketing surveys; development of marketing strategies and concepts for others; direct marketing of the goods and services of others; market analysis; market research services; marketing services in the field of arranging for the distribution of the products of others; providing business marketing information for others; secretarial services; business administration consulting services; promoting the goods and services of others by arranging for sponsors to affiliate their goods and services with soccer competitions; accounting; book-keeping; computer database management services; business management assistance for industrial and commercial companies; advertising agency services; advertising on the Internet for others; advertising services of a radio and television advertising agency; advertising

the goods and services of others; advertising the goods and services of others through all public communication means; on-line advertising for others on computer networks; production of advertising matter and commercials for others; providing advertising space in periodicals, newspapers and magazines; computerized file management; rental of office machinery and equipment; computerized on-line ordering services in the field of retail sale of food and beverage; computerized on-line ordering services for booking the services of spas, beauty salons and nail spas; computerized on-line ordering services in the field of products for spas, beauty salons and nail spas, namely, sleep masks, bath robes, bath sandals, bath slippers, bath wraps, bathing caps, bathing costumes, bathing trunks, bath linen, bath mitts, bath sheets, bath sponges, body care soap, body creams, body deodorants, body emulsions, body lotions, body masks, body milks, body moisturizers, body oils, body powders, body scrubs, body soak, body wash, exfoliating scrubs for the body, cosmetics, skin care preparations, cuticle conditioners, cuticle cream, cuticle nippers, cuticle pushers, cuticle removing preparations, cuticle scissors, cuticle softeners, cuticle tweezers, nail lamps, nail polish, towels; computerized online ordering featuring clothing; dissemination of advertising for others via the Internet; compilation, production and dissemination of advertising matter for others; online sales of clothing; online sales of cosmetics; online sales of food items; online sales of footwear; online sales of headwear; online sales of housewares; online sales of lingerie; online sales of photographic equipment; online sales of sporting goods; online sales of toys; providing home shopping services of car audio electronics via the internet; providing home shopping services of fitness equipment via the internet; providing home shopping services of sporting goods via the internet; direct mail advertising of the goods and services of others; advertising the goods and services of others via email; advertising by transmission of on-line publicity for third parties through electronic communications networks; sponsoring in the form of advertising the goods and services of others; rental of advertising space on the internet; commercial business management of the licensing of goods and services, for others; business management consulting and advising services in the field of retail sale of food, beverages and beauty products; business management consulting and advising services in the field of health care services and beauty salon services; administration of employee pension plans.

- 36 (2) Instalment loans; electronic funds transfer; investment of funds for others; financial investment counselling; financial analysis; fiscal assessments; financial management; advisory services in the field of credit and debit control, investment, grants and financing of loans; financial planning and investment advisory services; providing companies' financial information for credit rating and assessment; hire-purchase financing; lease-purchase financing; insurance services; payment card services; credit and debit card services.
- 38 (3) Cellular text messaging services; wireless digital messaging services; providing multiple user access to global computer information networks for the transfer and dissemination of a wide range of information; providing user access to a global computer network; leasing access time to a computer database containing legal information; leasing access time to a computer database in the field of community social events; leasing access time to a computer database in the field of cooking; leasing access time to a computer database in the field of job postings; videoconferencing services; teleconferencing services; voice mail services;

providing an online bulletin board in the field of community social events; providing an online bulletin board in the field of professional development and networking events; providing access to digital music websites on the internet; streaming of audio via the Internet featuring music; providing e-mail services.

- 41 (4) Arranging and conducting financial conferences; arranging and conducting real estate conferences; organisation of conferences and symposia in the field of medical science; arranging and conducting of exhibitions for education and entertainment, seminars and symposiums in the field of retail sale of food, beverages and beauty products; arranging and conducting of exhibitions for education and entertainment, seminars and symposiums in the field of health care services provided by a health spa and beauty salon services; production of video games; providing on-line computer games; event planning; party planning; organizing and managing parliaments, conferences, colloquiums, symposiums, seminars, lectures, speeches and workshops in the field of retail sale of food, beverages and beauty products; organizing and managing parliaments, conferences, colloquiums, symposiums, seminars, lectures, speeches and workshops in the field of health care services provided by a health spa and beauty salon services; driver education training; physical education services; vocational education in the field of computers; vocational education in the field of food services; vocational education in the field of hospitality; vocational education in the field of mechanics; airplane flight instruction; art instruction; bookkeeping instruction; commercial flying instruction; conducting courses of instruction at the college level; conducting courses of instruction at the high school level; conducting courses of instruction at the primary level; cooking instruction; dance instruction; teaching in the field of retail sale of food, beverages and beauty products; teaching in the field of health care services provided by a health spa and beauty salon services; tutoring; providing facilities for hockey tournaments; providing golf course facilities; providing gymnastic facilities; providing karaoke facilities; providing skating rink facilities; providing sports arena facilities; providing swimming pool facilities; providing tennis court facilities; provision of cinema facilities; rental of diving equipment; rental of ski equipment; rental of sports equipment; providing educational and entertainment information in the field of retail sale of food, beverages and beauty products; providing educational and entertainment information in the field of health care services provided by a health spa and beauty salon services; publication of electronic books and journals on-line.
- 42 (5) Conversion of data or documents from physical to electronic media; computer software consulting; consultancy in the design and development of computer hardware; consultancy in the field of webpage design; internet security consultancy; rental of computer software; software as a service (SAAS) provider in the field of providing customer relations management, human resource management, inventory management, e-vouchers and e-coupons; software as a service (SAAS) provider in the field of software for small business accounting; software as a service (SAAS) provider in the field of office productivity software; software as a service (SAAS) provider in the field of providing software for product and order management for retail stores; software as a service (SAAS) provider in the field of providing software for order management for restaurants; software as a service (SAAS) provider in the field of providing software for booking and rostering management for spas, beauty salons and health care clinics; software as a service (SAAS) provider in the field of

providing software for digital marketing, namely providing chatbots and software for managing integration with social media; cloud computing photo sharing services; cloud computing provider services for general storage of data; cloud computing providing software for database management; cloud computing web hosting services; cloud seeding; cloud computing provider services allowing customers to run their own software in the cloud; electronic storage of payroll data; electronic storage of information about goods and services of others; electronic storage of consumers' personal details and consumption history; electronic storage of medical records; electronic storage of photographic images; hosting internet sites for others; technical research in the field of computing and point-of-sale terminals; creating and maintaining web sites for others; server hosting; rental of web servers; designing and developing webpages on the internet for others; design, development, installation and maintenance of computer software; software as a service (SAAS) provider in the field of software for business administration.

SCHEDULE B

SHOPIFY, Application number 1752594, Reg. No. TMA960113

Goods (Nice class & Statement)

- 9 (1) Software for mobile devices for use in e-commerce and the retail industry to allow users to perform business management via a global computer network, namely, database management, sales and customer tracking and inventory management.
- 9 (2) Software for mobile devices for use in e-commerce and the retail industry, namely, software for point of sale transactions.
- 9 (3) Application programming interface (API) software that enables developers to build software applications for use in the retail and e-commerce industry.

Services (Nice class & Statement)

- 35 (1) Business management and marketing consultation; business management services for online stores; business management services relating to information and data compiling and analyzing; business marketing consultation.
- 36 (2) Cash advance services.
- 36 (3) Providing electronic processing of credit card transactions and electronic payments via a global computer network.
- 39 (4) Parcel shipping services.
- 42 (5) A web-based service that allows users to create hosted e-commerce stores to sell their goods and services online; a web-based service that allows the creation of a unique URL for an online store and the ability for users to manage the content and inventory of their online store; design, creation, hosting and maintenance of internet sites for third parties; Software as a Service (SAAS) featuring software for use in e-commerce and the retail industry to allow users to perform electronic business transactions via a global computer network; Software as a Service (SAAS) services featuring software for use in database management, sales and customer tracking and management, and inventory management for the retail industry.
- 42 (6) Online retail store services featuring computer software for use in the retail and e-commerce industry.

SHOPIFY, Application number 1456336, Reg. No. TMA787767

Services (Nice class & Statement)

(1) A web-based service that allows users to create hosted e-commerce stores to sell their goods and services online; a web-based service that allows the creation of a unique URL for an online store and the ability for users to manage the content and inventory of their online store; design, creation, hosting and maintenance of internet sites for third parties.

S shopify & Design, Application number 1287868, Reg. No. TMA700694



Services (Nice class & Statement)

- 42 (1) A web-based service that allows users to create hosted e-commerce stores to sell their goods or services online. This service includes the creation of a unique URL for each online store and the ability for users to manage the content and inventory of their online store.

Shopify and S Bag Logo (black and white), Application number 1753982, Reg. No. TMA963084



Goods (Nice class & Statement)

- 9 (1) Software for mobile devices for use in e-commerce and the retail industry to allow users to perform business management via a global computer network, namely, database management, sales and customer tracking and inventory management; software for mobile devices for use in e-commerce and the retail industry, namely, software for point of sale transactions; application programming interface (API) software that enables developers to build software applications for use in the retail and e-commerce industry.
- 16 (2) Notebooks.
- 18 (3) Tote bags.
- 25 (4) Hooded sweatshirts, t-shirts, toques.

Services (Nice class & Statement)

- 35 (1) Business management and marketing consultation; business management services for online stores; business management services relating to information and data compiling and analyzing; business marketing consultation.
- 36 (2) Cash advance services.
- 36 (3) Providing electronic processing of credit card transactions and electronic payments via a global computer network.
- 39 (4) Parcel shipping services.
- 42 (5) A web-based service that allows users to create hosted e-commerce stores to sell their goods and services online; a web-based service that allows the creation of a unique URL for an online store and the ability for users to manage the content and inventory of their online store; design, creation, hosting and maintenance of internet sites for third parties; Software as a Service (SAAS) featuring software for use in e-commerce and the retail industry to allow users to perform electronic business transactions via a global computer network; Software as a Service (SAAS) services featuring software for use in database management, sales and customer tracking and management, and inventory management for the retail industry; online retail store services featuring computer software for use in the retail and e-commerce industry.

Shopify and S Bag Logo (color), Application number 1753983, Reg. No. TMA963059



Goods (Nice class & Statement)

- 9 (1) Software for mobile devices for use in e-commerce and the retail industry to allow users to perform business management via a global computer network, namely, database management, sales and customer tracking and inventory management; software for mobile devices for use in e-commerce and the retail industry, namely, software for point of sale transactions; application programming interface (API) software that enables developers to build software applications for use in the retail and e-commerce industry.
- 16 (2) Notebooks.
- 18 (3) Tote bags.

25 (4) Hooded sweatshirts, t-shirts, toques.

Services (Nice class & Statement)

35 (1) Business management and marketing consultation; business management services for online stores; business management services relating to information and data compiling and analyzing; business marketing consultation.

36 (2) Cash advance services.

36 (3) Providing electronic processing of credit card transactions and electronic payments via a global computer network.

39 (4) Parcel shipping services.

42 (5) A web-based service that allows users to create hosted e-commerce stores to sell their goods and services online; a web-based service that allows the creation of a unique URL for an online store and the ability for users to manage the content and inventory of their online store; design, creation, hosting and maintenance of internet sites for third parties; Software as a Service (SAAS) featuring software for use in e-commerce and the retail industry to allow users to perform electronic business transactions via a global computer network; Software as a Service (SAAS) services featuring software for use in database management, sales and customer tracking and management, and inventory management for the retail industry; online retail store services featuring computer software for use in the retail and e-commerce industry.