

Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 97

Date of Decision: 2024-05-24

IN THE MATTER OF AN OPPOSITION

Opponent: ContextLogic Inc.

Applicant: Abdelmadjid Hammou

Application: 2,068,920 for ANYWISH

INTRODUCTION

[1] This is an opposition brought by ContextLogic Inc. (the Opponent) in respect of application No. 2,068,920 for the trademark ANYWISH (the Mark) filed by Abdelmadjid Hammou (the Applicant).

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

CI 35 (1) Advertising on the Internet for others; advertising the goods and services of others; compilation of advertisements for use as web pages on the internet; computerized on-line gift ordering service which matches the gift giver's requirements with the gift recipient's wants and needs; dissemination of advertising for others via an on-line communications network on the internet; dissemination of advertising for others via the Internet; dissemination of advertising matter for others; distribution of advertising materials for others; gift registry services; on-line advertising for others on computer networks; on-line advertising the goods and services of others on computer communications networks; online advertising for others via a computer communications network; promoting the goods and services of others

by preparing and placing advertisements in electronic magazines; promoting the goods and services of others through advertisements on Internet websites

CI 45 (2) Internet-based social networking services; on-line social networking services; online social networking services; online social networking services accessible by means of downloadable mobile applications

[3] For the reasons set out below, the application is refused.

THE RECORD

[4] The application for the Mark was filed on December 7, 2020, and was advertised for opposition in the *Trademarks Journal* of October 5, 2022.

[5] On November 30, 2022, the Opponent filed its statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T 13, as amended June 17, 2019 (the Act). The Opponent bases the opposition on sections 30(2)(a) (services not set out in ordinary commercial terms), 38(2)(a.1) (bad faith), 38(2)(b) (confusion with registered trademarks), 38(2)(c) (non-entitlement to registration), 38(2)(d) (non-distinctiveness), 38(2)(e) (no use or proposed use) and 38(2)(f) (non-entitlement to use).

[6] With the exception of the section 30(2)(a) and section 38(2)(e) grounds, the grounds of opposition are based on an allegation of confusion with the Opponent's registered trademarks WISH (registration Nos. TMA1,090,583 and TMA1,068,905) and WISH SHOPPING MADE FUN (registration No. TMA948,594) (the "Registered Trademarks") and/or its applied for trademarks, namely WISH (application No. 1,972,641), WISH & Design (application No. 2,006,596), WISH PICK UP (application No. 1,978,411) and WISH LOCAL (application No. 1,978,412) (collectively referred to by the Opponent as the Opponent's WISH Trademarks). A full list of the goods and services associated with the Opponent's WISH Trademarks is attached as Schedule A.

[7] The Applicant filed a counterstatement denying the grounds of opposition.

[8] In support of its opposition, the Opponent filed the affidavit of Lara Mary M. Ruggerio, Counsel, Intellectual Property for the Opponent, sworn May 31, 2023 (the Ruggerio Affidavit) and the affidavit of Mary P. Noonan, trademark searcher employed by the Opponent's agent, sworn May 31, 2023 (the Noonan Affidavit). Neither of these affiants were cross-examined.

[9] The Applicant elected not to file any evidence.

[10] Neither party filed written representations and no hearing was held.

EVIDENTIAL BURDEN AND LEGAL ONUS

[11] The Opponent has the initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd*, 1990 11059 (FC), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA*, 2002 FCA 29, 20 CPR (4th) 155]. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all the evidence, then the issue must be decided against the Applicant.

ASSESSMENT OF THE GROUNDS OF OPPOSITION

Sections 38(2)(b) and 12(1)(d) - Registrability

[12] The Opponent pleads that the Mark is not registrable as it is confusing with the Opponent's Registered Trademarks.

[13] The relevant date for this ground of opposition is the date of my decision [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd*, (1991), 37 CPR (3d) 413 (FCA)].

[14] The Opponent's initial burden is met with respect to a section 12(1)(d) ground of opposition if the registrations relied upon remain in good standing as of the date of the opposition decision. The Registrar has discretion to check the register and I have exercised this discretion to confirm the Opponent's Registered Trademarks remain extant [see *Quaker Oats Co of Canada Ltd/La Compagnie Quakers Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I therefore find that the Opponent has satisfied its evidential burden. I must now assess whether the Applicant has met its legal burden.

[15] In determining whether two trademarks are confusing, all the surrounding circumstances should be considered, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks, including in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 at para 54; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

[16] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the applicant's mark, at a time when they have no more than an imperfect recollection of the opponent's trademark, and do not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot*, para 20].

[17] I consider the Opponent's strongest case to be with respect to its WISH trademark, registration No. TMA1,068,905 (the Opponent's First WISH Trademark). If the Mark is not found to be confusing with this trademark, it will not be found confusing with the Opponent's other registered trademarks.

Inherent Distinctiveness and Extent Known

[18] The inherent distinctiveness of a trademark refers to its uniqueness when considered with its associated goods and/or services.

[19] In this case, I do not find either party's trademark to be inherently strong. While the Mark is a unique combination of two common English language words, both it and the Opponent's First WISH Trademark suggest that the associated goods and services can help fulfill one's wishes. They are both therefore suggestive of their associated goods and services.

[20] The acquired distinctiveness of a trademark refers to the extent to which it has become known in Canada. In this case, there is no evidence of record demonstrating use or making known of the Mark in Canada.

[21] On the other hand, the Opponent's evidence, specifically the Ruggerio Affidavit, provides, *inter alia*, evidence of use of all of the Opponent's WISH Trademarks in Canada since 2011, as well as the number of annual Canadian transactions and Canadian annual sales revenue derived from commissions on sales by merchants to consumers through the WISH platforms (*www.wish.com* and *www.wishwall.me*) associated with the

Opponent's WISH Trademarks for the years 2014 to 2021. In this regard, transactions ranged from 650,000 to 12,500,000 annually and revenue ranged from \$350,000 USD to \$52,000,000 USD between 2017 and 2021 [para 43]. The Ruggerio Affidavit also provides Canada-specific expenditures for advertising, promotional and marketing efforts involving the Opponent's WISH Trademarks for the years 2017 through to 2022 demonstrating annual expenditures ranging from \$17.5 million USD to over \$40 million USD [para 48].

[22] While Ms. Ruggerio does not provide a breakdown of sales by specific trademark or by goods or services, I am prepared to infer from her evidence as a whole that the Opponent's First WISH Trademark has become known to a significant extent in Canada.

[23] In view of the above, I find that overall this factor favours the Opponent.

Length of Time in Use

[24] As previously noted, the Applicant did not file any evidence of use of its Mark whereas the Opponent has evidenced use of its First WISH Mark since at least as early as 2011.

[25] This factor therefore favours the Opponent.

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

[26] When considering the nature of the goods and services of the parties it is the statements in the subject application and registration that govern [*Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CanLII 8953 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[27] In the present case, the Opponent's First WISH Trademark is registered in association with the following services:

CI 35 (1) Gift registry services; providing a web site where consumers can post recommendations on products and services.

CI 42 (2) Online computer services, namely, creating an online database featuring gift registries and lists; online computer services, namely, providing an interactive website that gives users the ability to create customized gift registries and lists and share them with others; online computer services, namely, providing an interactive website that gives users the ability to recommend products and services to others in a social network setting; providing a website featuring non-downloadable software enabling users to track selections and purchases of products and services related to gift lists and gift registries; computer services, namely, creating an on-line community for registered users to engage in social networking in the field of e-commerce and online shopping; providing temporary use of non-downloadable software to provide consumer product recommendations and related data based on user-defined preferences and tracked purchasing behavior; providing temporary use of online non-downloadable software that analyzes and reports on the consumer preferences and buying behavior of registered users of an Internet website.

[28] I find that the services contained in the application for the Mark overlap with the Opponent's registered services. In this regard, based on a reading of the services in the application and the services registered in association with the Opponent's First WISH Trademark, I find that both parties are offering consumers the opportunity to create lists of goods or services that they have a desire to obtain and allows them to share these lists with others.

[29] While evidence of actual use of the trademarks at issue can influence these factors, the Applicant has filed no evidence in this proceeding relating to its services, business or trade that would distinguish them from those of the Opponent.

[30] Accordingly, these factors favour the Opponent.

Degree of Resemblance

[31] Considering the Applicant has adopted the Opponent's First WISH Trademark in its entirety as the second component of the Mark, I find that there is a considerable degree of resemblance between the trademarks in appearance and sound.

[32] With respect to ideas suggested, the parties' trademarks suggest a desire for certain goods and/or services.

[33] As I am of the view that the parties' trademarks are more alike than they are different in all respects, I find this factor favours the Opponent.

ENTITLEMENT TO REGISTER – SECTION 16(1)(A) AND DISTINCTIVENESS – SECTIONS 38(2)(D) AND 2

[34] With respect to the ground of opposition based on section 16(1)(a) of the Act, since the Applicant has not shown any use of the Mark, the material date is the filing date of the application (*i.e.*, December 7, 2020). The material date for assessing the non-distinctiveness ground is the date of opposition (*i.e.*, November 30, 2022).

[35] To meet its initial evidential burden for the section 16(1)(a) ground of opposition, the Opponent must show that it had used at least one of its trademarks at the filing date of the application. To meet its initial burden for the section 38(2)(d) and 2 ground of opposition, the Opponent must show that one or more of its trademarks was known to some extent at least and the reputation of one or more of these trademarks in Canada was substantial, significant or sufficient as of the filing date of the opposition [*Motel 6, Inc v No 6 Motel Ltd*, 1981 CanLII 2834 (FC), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd* (2006), 2006 FC 657, 48 CPR (4th) 427 (FC)].

[36] I am satisfied from the evidence furnished that the Opponent has met its initial evidential burden with at least its First WISH Trademark under both of these grounds of opposition.

[37] The analysis of the likelihood of confusion under these grounds is essentially the same as for the section 12(1)(d) ground. Therefore, as the Opponent has succeeded under the section 12(1)(d) ground, and has met its evidential burden for each of the section 16(1)(a) and section 2 grounds of opposition, it also succeeds under these grounds of opposition.

Remaining Grounds of Opposition

[38] As the Opponent has already succeeded under three grounds of Opposition, it is not necessary to address the remaining grounds of opposition.

DISPOSITION

[39] 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.

Cindy R. Folz
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A


The Opponent's WISH Trademarks

Trademark	Registration No./Application No.	Goods and Services
WISH	TMA1090583	Retail store services featuring flatware, cookware, bakeware, housewares, beverage and table glassware, and kitchen appliances; online sales of flatware, cookware, bakeware, housewares, beverage and table glassware, and kitchen appliances; gift registry services
WISH	TMA1068905	<p>Gift registry services; providing a web site where consumers can post recommendations on products and services.</p> <p>Online computer services, namely, creating an online database featuring gift registries and lists; online computer services, namely, providing an interactive website that gives users the ability to create customized gift registries and lists and share them with others; online computer services, namely, providing an interactive website that gives users the ability to recommend products and services to others in a social network setting; providing a website featuring non-downloadable software enabling users to track selections and purchases of products and services related to gift lists and gift registries; computer services, namely, creating an on-line community for registered users to engage in social networking in the field of e-commerce and online shopping; providing temporary use of non-downloadable software to provide consumer product recommendations and related data based on user-defined preferences and tracked purchasing behavior; providing temporary use of online non-downloadable software that analyzes and reports on the</p>

		<p>consumer preferences and buying behavior of registered users of an Internet website.</p>
<p>WISH SHOPPING MADE FUN</p>	<p>TMA948594</p>	<p>Computer software that enables users to access internet websites and obtain, transmit, store, organize and interact with data, information and digital content online; computer software to enable creating, locating, identifying, uploading, displaying, tagging, blogging, sharing or otherwise providing electronic media, audio, video, images, photos, multimedia content and information over the Internet or other communications networks; search engine software; computer software that feeds content and recommendations regarding content, information and individuals based on proprietary algorithms and the user's preferences and behavior; computer software that analyzes and reports on the behavior, preferences and buying behavior of registered users of an Internet website</p> <p>Retail services namely the bringing together, for the benefit of others, of a variety of goods and services of others, enabling customers to conveniently view and purchase those goods and services from an Internet web site which markets the sale of goods and services of others by providing product information, user ratings, store ratings and shipping information; particularly specializing in the marketing of the sale of goods and services of others; online computer services, namely, creating an online database featuring gift registries and lists; online computer services, namely, providing an interactive website that gives users the ability to create customized gift registries and lists and share them with others; online computer services, namely, providing an interactive website that gives users the ability to recommend products and services to others in a social network setting; providing a website featuring non-</p>

		<p>downloadable software enabling users to track selections and purchases of products and services related to gift lists and gift registries. computer services, namely, creating an on-line community for registered users to engage in social networking; providing temporary use of non-downloadable software to provide consumer product recommendations and related data based on user-defined preferences and tracked purchasing behavior; providing temporary use of online non-downloadable software that analyzes and reports on the consumer preferences and buying behavior of registered users of an Internet website</p>
<p>WISH</p>	<p>1972641</p>	<p>Downloadable computer software and mobile application software for use in retail transactions and ordering a wide variety of general merchandise and consumer goods, namely, clothing, footwear, headgear, bags, wallets, jewellery, eyewear, consumer electronics, cases and accessories for consumer electronics, pet supply products, office supplies, personal care products, cosmetics, toys and sporting goods, household products, bed and bath products, hand tools, machine tools, musical instruments, safety equipment, baby products, child care products, and home furnishings; downloadable computer software and mobile application software for providing advertising space accessible via a global computer network; search engine software; downloadable computer software and mobile application software for use in providing online reviews and recommendations about general merchandise and consumer goods, and for accessing userposted ratings, reviews and recommendations on products; downloadable computer and mobile application software for use in creating, organizing, managing, and transmitting lists;</p>

		<p>computer and mobile application software that analyzes consumer buying behavior and patterns and assists in matching consumers with products in the field of clothing, footwear, headgear, bags, wallets, jewellery, eyewear, consumer electronics, cases and accessories for consumer electronics, pet supply products, office supplies, personal care products, cosmetics, toys and sporting goods, household products, bed and bath products, hand tools, machine tools, musical instruments, safety equipment, baby products, child care products, and home furnishings</p> <p>Online retail store services featuring a wide variety of general merchandise and consumer goods, namely, clothing, footwear, headgear, bags, wallets, jewellery, eyewear, consumer electronics, cases and accessories for consumer electronics, pet supply products, office supplies, personal care products, cosmetics, toys and sporting goods, household products, bed and bath products, hand tools, machine tools, musical instruments, safety equipment, baby products, child care products, home furnishings; providing a searchable online database featuring general merchandise and consumer goods; providing consumer product information via the internet; providing pricing information about third-party consumer goods via the internet; advertising services, namely, dissemination of advertising for the goods of others via the internet; operating online marketplaces for sellers and buyers of goods; operating online marketplaces featuring a wide variety of thirdparty consumer goods in the field of clothing, footwear, headgear, bags, wallets, jewellery, eyewear, consumer electronics, cases and accessories for consumer electronics, pet supply products, office supplies, personal care products, cosmetics, toys and sporting goods,</p>
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		<p>household products, bed and bath products, hand tools, machine tools, musical instruments, safety equipment, baby products, child care products, and home furnishings; providing a website for online marketplaces featuring a wide variety of consumer goods in the field of clothing, footwear, headgear, bags, wallets, jewellery, eyewear, consumer electronics, cases and accessories for consumer electronics, pet supply products, office supplies, personal care products, cosmetics, toys and sporting goods, household products, bed and bath products, hand tools, machine tools, musical instruments, safety equipment, baby products, child care products, and home furnishings</p>
	<p>2006596</p>	<p>Downloadable computer software and mobile application software for use in retail transactions and ordering a wide variety of general merchandise and consumer goods, namely, clothing, footwear, headgear, bags, wallets, jewellery, eyewear, consumer electronics, cases and accessories for consumer electronics, pet supply products, office supplies, personal care products, cosmetics, toys and sporting goods, household products, bed and bath products, hand tools, machine tools, musical instruments, safety equipment, baby products, child care products, and home furnishings; downloadable computer software and mobile application software for providing advertising space accessible via a global computer network; search engine software; downloadable computer software and mobile application software for use in providing online reviews and recommendations about general merchandise and consumer goods, and for accessing userposted ratings, reviews and recommendations on products; downloadable computer and mobile</p>

		<p>application software for use in creating, organizing, managing, and transmitting lists; computer and mobile application software that analyzes consumer buying behavior and patterns and assists in matching consumers with products in the field of clothing, footwear, headgear, bags, wallets, jewellery, eyewear, consumer electronics, cases and accessories for consumer electronics, pet supply products, office supplies, personal care products, cosmetics, toys and sporting goods, household products, bed and bath products, hand tools, machine tools, musical instruments, safety equipment, baby products, child care products, and home furnishings</p> <p>Online retail store services featuring a wide variety of general merchandise and consumer goods, namely, clothing, footwear, headgear, bags, wallets, jewellery, eyewear, consumer electronics, cases and accessories for consumer electronics, pet supply products, office supplies, personal care products, cosmetics, toys and sporting goods, household products, bed and bath products, hand tools, machine tools, musical instruments, safety equipment, baby products, child care products, home furnishings; providing a searchable online database featuring general merchandise and consumer goods; providing consumer product information via the internet; providing pricing information about third-party consumer goods via the internet; advertising services, namely, dissemination of advertising for the goods of others via the internet; operating online marketplaces for sellers and buyers of goods; operating online marketplaces featuring a wide variety of thirdparty consumer goods in the field of clothing, footwear, headgear, bags, wallets, jewellery, eyewear, consumer electronics, cases and accessories for consumer electronics, pet supply products,</p>
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		office supplies, personal care products, cosmetics, toys and sporting goods, household products, bed and bath products, hand tools, machine tools, musical instruments, safety equipment, baby products, child care products, and home furnishings; providing a website for online marketplaces featuring a wide variety of consumer goods in the field of clothing, footwear, headgear, bags, wallets, jewellery, eyewear, consumer electronics, cases and accessories for consumer electronics, pet supply products, office supplies, personal care products, cosmetics, toys and sporting goods, household products, bed and bath products, hand tools, machine tools, musical instruments, safety equipment, baby products, child care products, and home furnishings
WISH PICKUP	1978411	<p>Transportation logistics services, namely, arranging the transportation of goods for others; transportation logistics services, namely, coordinating package pick-up and delivery of consumer goods ordered via an online marketplace; shipping and delivery services, namely, arranging for the pick-up, transportation, delivery and storage of a wide variety of consumer goods purchased via an online marketplace</p> <p>Transport and delivery of a wide variety of consumer goods by air, rail, ship, boat, truck, car, motor vehicle, bicycle, courier, mail order, and train</p>
WISH LOCAL	1978412	Transportation logistics services, namely, arranging the transportation of goods for others; transportation logistics services, namely, coordinating package pick-up and delivery of consumer goods ordered via an online marketplace; shipping and delivery services, namely, arranging for the pick-up, transportation, delivery and storage of a wide

		<p>variety of consumer goods purchased via an online marketplace</p> <p>Transport and delivery of a wide variety of consumer goods by air, rail, ship, boat, truck, car, motor vehicle, bicycle, courier, mail order, and train</p>
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Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Opponent: Gowling WLG (Canada) LLP

For the Applicant: Lei Zhou (Witmart Inc.)