



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2013 TMOB 3
Date of Decision: 2013-01-04

**IN THE MATTER OF AN OPPOSITION
by GetThere L.P. to application
No. 1,450,380 for the trade-mark
HELPING YOU GET THERE FASTER
in the name of Sears Brands, LLC**

File Record

[1] On September 2, 2009 Sears, Roebuck and Co. filed an application to register the trade-mark HELPING YOU GET THERE FASTER (the Mark). Subsequently the application was assigned to Sears Brands, LLC (the Applicant).

[2] The application was filed on the basis of proposed use in association with:

Operation of an on-line travel booking and reservation system; operation of an agency and reseller business for the sale of airline tickets, hotel rooms, car rentals, cruises, tickets for sporting, cultural and entertainment events, namely tickets for concerts, sporting events, theatres, sightseeing trips, theme and water parks, operas, plays, movies and amusement parks, travel insurance, bus and rail tours, placing of on-line advertising for others; and dissemination of travel information via an on-line communication network. (the Services).

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 17, 2010. GetThere L.P. (the Opponent) filed a statement of opposition on August 16, 2010 which was forwarded by the Registrar to the Applicant on August 24, 2010.

[4] The grounds of opposition pleaded are:

1. The application does not comply with the requirements of section 30(e) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) in that the Applicant, by itself or through a licensee, or by itself and through a licensee, never intended to use the Mark in Canada;
2. The application does not comply with the requirements of section 30(i) of the Act in that the Applicant could not have been satisfied of its entitlement to use the Mark in Canada in association with the Services as the Applicant knew, or ought to have known that, as of the filing date of the application the Mark was and is confusing with the Opponent's trade-mark GETTHERE, which was registered, used and/or made known in Canada by the Opponent and/or its predecessor in title GetThere Inc. (previously known as GetThere.com, Inc.) in association with travel information services prior to the Applicant's filing date;
3. The Mark is not registrable in view of section 12(1)(d) of the Act since the Mark is confusing with the Opponent's registered trade-mark GETTHERE, certificate of registration TMA626,480 in association with travel information services; namely, providing travel information in the areas of airlines, car rental, news, weather, maps, and pricing information; travel procurement and supply services, primarily for businesses and travel suppliers, including enabling users to make airline, hotel, and car rental reservations and to purchase airline tickets over global computer networks;
4. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(3)(a) of the Act in that at the filing date of the application the Mark was confusing with the Opponent's trade-mark GETTHERE which had been previously used by the Opponent and/or its predecessor in title GetThere Inc. (previously known as GetThere.com, Inc.) in Canada in association with the travel information and procurement and supply services described above;
5. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(3)(c) of the Act in that at the filing date of the application the Mark was confusing with the Opponent's trade-names including GetThere and GetThere.com previously used by the Opponent and/or its predecessor in title GetThere Inc. (previously known as GetThere.com, Inc.) in Canada in association with the travel information and procurement and supply services described above;
6. Pursuant to section 38(2)(d) of the Act, the Mark is not distinctive of the Applicant in that it does not distinguish nor is it adapted to distinguish the Services of the Applicant from the services of the Opponent including travel information services and travel procurement and supply services described above sold or performed in Canada by the Opponent and/or its predecessor in title GetThere Inc. (previously known as GetThere.com,

Inc.) in association with the trade-mark GETTHERE previously registered and used or made known in Canada.

[5] In the counter statement filed on October 19, 2010 the Applicant essentially denied all grounds of opposition.

[6] The Opponent filed as its evidence the affidavit of Dawna Code while the Applicant filed the affidavit of A. Louise McLean and certificates of registration:

TMA540,096 for the trade-mark HOW TO GET THERE
TMA6452,667 for the trade-mark GET OUT THERE
TMA560,948 for the trade-mark GET OUT THERE!
TMA249,184 for the trade-mark WHEN IT'S JUST GOT TO GET THERE
TMA690,249 for the trade-mark GET THERE
TMA616,505 for the trade-mark GET OUT THERE.

[7] Ms. Code was cross-examined and the transcript of her cross-examination is part of the record. Each party filed a written argument and was represented at a hearing.

Legal Onus and Burden of Proof

[8] The legal onus is upon the Applicant to show that the application complies with the provisions of the Act, but there is however an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) and *Wrangler Apparel Corp v The Timberland Company* [2005] FC 722].

Ground of Opposition based on Section 30(e) of the Act

[9] Since the facts regarding the Applicant's intentions are particularly within the knowledge of the Applicant, the initial burden on the Opponent under section 30(e) is lighter than usual [see *Molson Canada v Anheuser-Busch Inc* (2003), 29 CPR (4th) 315 (FCTD)].

[10] The Opponent has not filed any evidence to support this ground of opposition. In its written submissions the only argument raised by the Opponent on this issue is the absence of evidence filed by the Applicant on its use of the Mark in Canada or that it has any real intention of using the Mark in Canada in association with the Services. Thus according to the Opponent, the Applicant has failed to prove, on a balance of probabilities, that this ground of opposition should not prevent it from registering the Mark.

[11] At the hearing the Opponent reiterated that there is no evidence of use of the Mark and no evidence of intention on the part of the Applicant to use the Mark. Finally the Opponent submitted that, because the application was filed originally by an American company and then assigned to a Canadian entity, consequently at the filing date the original applicant did not have the intention to use the Mark in Canada in association with the Services.

[12] The fact that the Applicant provided no evidence, direct or otherwise, of its intention to use the Mark in association with the Services is not sufficient to discharge the initial evidential burden on the Opponent. An applicant does not have to evidence use of a proposed trade-mark and there is no requirement to use the proposed trade-mark until the application has been allowed [see *Black Entertainment Television Inc v CTV Ltd* (2008), 66 CPR (4th) 274 (TMOB)]. Moreover the fact that the application was filed by an American corporation and subsequently assigned to a Canadian entity does not prove that the original applicant had no intention to use the Mark in Canada in association with the Services. In any event the original applicant did state in its application that “The applicant by itself or through its licensee, or by itself and through a licensee, intend to use the trade-mark in Canada....”.

[13] For these reasons I dismiss the first ground of opposition.

Ground of Opposition based on Section 30(i) of the Act

[14] Section 30(i) of the Act only requires the Applicant to declare itself satisfied that it is entitled to use the Mark in Canada in association with the Services. Such a statement is included in the application. An opponent may rely on section 30(i) in specific cases such as where fraud by the applicant is alleged [see *Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152

(TMOB)]. There is no allegation of that nature in the statement of opposition or any evidence in the record to that effect.

[15] The second ground of opposition is therefore dismissed.

The Admissibility of Ms. Code's Affidavit

[16] Ms. Code describes herself as the Customer Solutions Specialist for the GETTHERE travel program, for the Opponent. She has held such position since 2006. She states that she has been employed with Sabre Inc. (Sabre), an affiliated company of the Opponent for over 20 years. She has held several positions at Sabre including Account Executive, Customer Solutions Manager, Merchandising Manager and Corporate Online Services manager. She further declares that she has access to "company records and key personnel...".

[17] She affirms that Sabre is a global travel company serving airlines, hotels, travel retailers, online and offline agents, travel buyers, and car, rail, cruise and tour operators. It is a wholly owned subsidiary of Sabre Holdings Corporation (Sabre Holdings). The latter acquired in 2000 GetThere Inc., which is a provider of web-based travel reservations systems for travel agencies, travel suppliers and businesses. It was incorporated in 1999 under the name GetThere.com Inc. and changed its name in June 2000 to GetThere Inc. She asserts that GetThere Inc. is the general partner of the Opponent which is a limited partnership. Finally she states that the trade-mark GETTHERE was assigned on November 13, 2000 from GetThere Inc. to the Opponent and a copy of the assignment is attached to her affidavit.

[18] During her cross-examination Ms. Code stated that she works from her home in Carp, Ontario while Sabre is located in Southlake, Texas. She described herself as a virtual employee, using a laptop as her principal tool to be in contact with Sabre and her customers. She also stated that, besides two software of Sabre and a social media type of site, she does not have access through her laptop to any other documents. Moreover she stated that she does not have immediate access through her laptop to the invoices attached to her affidavit but if she makes a request and goes to the billing department she would be able to have a copy.

[19] She was asked what was the meaning of “general partner” when she states in her affidavit that GetThere Inc. is the general partner of GetThere L.P. Her answer was “As one company, being one company” (see answer to question 105). As to what she meant by “limited partnership”, her answer was “I would say it was based on the laws that were required, under the laws of Delaware” (see answer to question 107). When she was questioned on the wording used in her affidavit she admitted that it was drafted by legal counsel.

[20] From this corporate information we know that Ms. Code works for Sabre, which is a subsidiary of Sabre Holdings, which in turn acquired GetThere Inc. The latter is the general partner of the Opponent. Do that corporate structure and the fact that Ms. Code is an employee of Sabre make her a duly authorized representative of the Opponent, i.e. is she qualified to make statements on behalf of the Opponent?

[21] I agree with the Applicant that there appears to be a link missing, namely between Sabre and the Opponent. How can Ms. Code, as an employee of Sabre, testify on the use of the trade-mark GETTHERE by the Opponent. There is no allegation of the existence of a license for the use of the trade-mark GETTHERE by Sabre. If the use of the trade-mark GETTHERE is by the Opponent then how can she, as an employee of Sabre, testify on behalf of the Opponent of such use.

[22] Therefore the content of her affidavit will be of limited value. Any use of the trade-mark GETTHERE by Sabre described in her affidavit cannot benefit to the Opponent in the absence of a license. Moreover the corporate structure described above does not establish that she is a duly authorized representative of the Opponent. Consequently any evidence of facts related to the use of the trade-mark GETTHERE by the Opponent not to the personal knowledge of Ms. Code constitutes inadmissible hearsay evidence.

Entitlement and Distinctiveness Grounds of Opposition

[23] The Opponent has the initial burden to prove that it has used or made known its trade-mark GETTHERE in Canada prior to the filing date of the application and that it has not abandoned such use at the advertising date of the application [see sections 16(1) and (5) of the Act]. As I have already ruled that Ms. Code’s allegations on the use of the Opponent’s trade-

mark GETTHERE constitute inadmissible hearsay evidence, the Opponent has failed to meet its initial burden of proof. Consequently the fourth and fifth grounds of opposition are dismissed.

[24] As for the distinctiveness ground of opposition, the Opponent has an initial burden to prove that its trade-mark GETTHERE had become sufficiently known in Canada as of August 16, 2010, the filing date of the statement of opposition, so to negate any distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)]. Since, for the reasons detailed above, there is no admissible evidence of prior use or making known in Canada of the trade-mark GETTHERE by the Opponent, the sixth ground of opposition is also dismissed.

Registrability of the Mark under Section 12(1)(d)

[25] Ms. Code has attached to her affidavit a copy of a certificate of authenticity of registration TMA626,480 for the trade-mark GETTHERE. I accept that portion of her evidence. In any event I checked the register and such registration is extant [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats Ltée v Manu Foods Ltd*, 11 CPR (3d) 410 (FCTD)]. It covers: Travel information services; namely, providing travel information in the areas of airlines, car rental, news, weather, maps, and pricing information; travel procurement and supply services, primarily for businesses and travel suppliers, including enabling users to make airline, hotel, and car rental reservations and to purchase airline tickets over global computer networks. Consequently the Opponent has met its initial burden.

[26] The relevant date for this ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (

[27] 3d) 413 at 424 (FCA)].

[28] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the

trade-marks or trade-names in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [See *Clorox Co v Sears Canada Inc* (1992), 41 CPR (3d) 483 (FCTD) and *Gainers Inc v Marchildon* (1996), 66 CPR (3d) 308 (FCTD)].]. I also refer to the judgments of the Supreme Court of Canada in *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 and *Mattel Inc v 3894207 Canada inc* (2006), 49 CPR (4th) 321 where Mr. Justice Binnie commented on the assessment of the criteria enumerated under section 6(5) to determine if there is a likelihood of confusion between two trade-marks.

Inherent distinctiveness of the trade-marks and the extent to which they have become known

[29] It is interesting to note that the parties have put emphasis on the second portion of this criterion, namely the use or lack thereof of the respective parties' trade-marks. No comment has been submitted with respect to the inherent distinctiveness of the marks in issue. Neither of the marks is inherently distinctive. Even though the Opponent's trade-mark is a coined word, phonetically it is equivalent to the expression "get there". As for the Mark, it is a slogan.

[30] There is no evidence of use of the Mark in the record. As I ruled that any evidence of use of the Opponent's trade-mark GETTHERE constitutes inadmissible hearsay evidence, there is no evidence of use of the Opponent's trade-mark. Accordingly, this factor does not favour either of the parties.

The length of time the trade-marks or trade-names have been in use

[31] It has been held that the Registrar can refer to the certificate of registration to establish a period of use of the Opponent's registered trade-mark GETTHERE [See *Cartier Men's Shops Ltd v Cartier Inc* (1981), 58 CPR (2d) 68]. According to certificate of registration TMA626,480 the trade-mark GETTHERE has been used since at least as early as July 1999 but I can only presume from such evidence *de minimis* use. This factor favours the Opponent as there is no evidence of use of the Mark. However this finding will not be a determining factor in this file.

The nature of the wares, services, or business; the nature of the trade

[32] I must compare the Services to the services covered by the Opponent's registration TMA626,480. There is clearly an overlap. In its written argument and at the hearing the Applicant argued that the Opponent's registration covers services primarily directed to businesses and suppliers of travel services and not to end users, (i.e. customers or travelers). The Applicant claims that in the description of the Services there is no such specification.

[33] However there is no restriction in the application that would prevent the Applicant from offering the Services to businesses and suppliers of travel services. The application is not restricted to customers or travelers. Consequently this factor favours the Opponent.

The degree of resemblance

[34] In its judgment in *Masterpiece Inc v Alavida Lifestyles Inc et al* 2011 SCC 27, the Supreme Court of Canada has clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks. In *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359, the Federal Court stated that the first portion of a trade-mark is the most relevant for purposes of distinction.

[35] The only common elements of the marks in issue are the words "get" and "there". I understand that the words making the Opponent's trade-mark GETTHERE are included in the Mark. However the Mark has additional words: "how", "to" and "faster". As a whole the Mark is different in sound, appearance and the idea suggested. The Opponent's trade-mark sounds like a command while the Mark suggests that the Services will enable a customer to get to his destination faster.

[36] This most important factor favours the Applicant.

State of the Register evidence

[37] As an additional surrounding circumstance the Applicant relies on the state of register evidence as it filed certified copies of the following certificates of registration:

TMA540,096 for the trade-mark HOW TO GET THERE

TMA6452,667 for the trade-mark GET OUT THERE

TMA560,948 for the trade-mark GET OUT THERE!

TMA249,184 for the trade-mark WHEN IT'S JUST GOT TO GET THERE
TMA690,249 for the trade-mark GET THERE
TMA616,505 for the trade-mark GET OUT THERE

Without reviewing the content of these registrations, the number of registrations cited by the Applicant is insufficient to infer a wide use in the market place of the words “Get” and “there” as part of a trade-mark used in association with on-line travel booking services [See *Welch Foods Inc v Del Monte Corp* (1993), 44 CPR (3d) 205].

[38] Ms. McLean has been a law clerk employed by the Applicant's agent firm. She filed certain pages from the Royal Caribbean International website. Even assuming that such pages constitute proper evidence of the use of the trade-mark GET OUT THERE in Canada, such evidence could only establish that one of the six registered trade-marks listed above is being used in Canada.

Conclusion

[39] From this analysis of the relevant criteria, I conclude that the Applicant has demonstrated, on a balance of probabilities, that the Mark would not likely cause confusion with the Opponent's trade-mark GETTHERE when used in association with the Services. The Opponent's trade-mark is not inherently distinctive and despite the fact that there is an overlap in the parties' services the differences in appearance, sound and the ideas suggested by the marks are sufficient to enable a consumer to distinguish the origin of one's services over the other.

[40] The third ground of opposition is also dismissed.

Disposition

[41] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office