



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

Citation: 2012 TMOB 214
Date of Decision: 2012-11-23

**IN THE MATTER OF AN OPPOSITION
by Yellow Pages Group Co. to application
No. 1,359,462 for the trade-mark YELP &
Design in the name of Yelp! Inc.**

[1] On August 3, 2007, Yelp! Inc. (the Applicant) filed an application to register the trade-mark YELP & Design (the Mark), shown below, claiming a priority filing date of February 6, 2007. The Mark has been applied for registration on the dual basis of registration and use in the United States of America and proposed use in Canada in association with services.



[2] The statement of services, as revised on September 9, 2008, reads:





providing telephone directory information via global communications networks; providing an online interactive website obtaining users comments concerning business organizations, service providers, medical professionals, professional services, personal services, real estate, restaurants, accommodations, travel, shopping, nightlife, beauty, and spas; providing information namely compilations, rankings, reviews, referrals and recommendations relating to business organizations, service providers, medical professionals, professional services, personal services, real estate, restaurants, accommodations, travel, shopping, nightlife, beauty, and spas using a global computer network.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of December 10, 2008.

[4] Yellow Pages Group Co. (the Opponent) filed a statement of opposition on April 17, 2009. The Opponent amended its statement of opposition twice. The amended statement of opposition of record is dated August 26, 2011.

[5] In preamble to the grounds of opposition the Opponent alleges ownership of registered and unregistered trade-marks consisting of or involving the word elements YELLOW PAGES in association with wares and services, including in association with internet services namely business and individual online advertising services on behalf of others; online publishing and dissemination of information for others in an internet guide and directory. The grounds of opposition allege, in summary, that:

- a) the application does not conform to the requirements of section 30(a) and (i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act);
- b) the Mark is not registrable pursuant to section 12(1)(d) of the Act since it is confusing with the following registered trade-marks of the Opponent:

<u>Trade-mark</u>	<u>Registration No.</u>
	TMA100,936
	TMA205,312
	TMA349,765
YellowPages.city	TMA511,461
YELLOW PAGES	TMA246,988
YELLOW PAGES EXPRESS	TMA546,443
 Yellow Pages Group	TMA616,547

 Yellow Pages Group Groupe Pages Jaunes	TMA616,918
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YELLOWPAGES.CA	TMA575,757
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 Yellow Pages Group	TMA740,892
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 Groupe Pages Jaunes Yellow Pages Group	TMA748,740
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YELLOWPAGES411	TMA740,939
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- c) the Applicant is not the person entitled to registration of the Mark pursuant to sections 16(2)(a) and 16(3)(a) of the Act since the Mark, at the filing date of the application, was confusing with the registered and unregistered trade-marks that had been previously used in Canada by the Opponent or a predecessor-in-title;
- d) the Applicant is not the person entitled to registration of the Mark pursuant to sections 16(2)(b) and 16(3)(b) of the Act since the Mark, at the filing date of the application, was confusing with the following unregistered trade-marks of the Opponent:

<u>Trade-mark</u>	<u>Application No.</u>
 Yellow Pages Group	1,288,481
 Groupe Pages Jaunes Yellow Pages Group	1,292,785
YELLOWPAGES411	1,354,706

- e) the Applicant is not the person entitled to registration of the Mark pursuant to sections 16(2)(c) and 16(3)(c) of the Act since the Mark, at the filing date of the application, was confusing with the trade-names “Yellow Pages” and Yellow Pages Group”; and
- f) the Mark is not distinctive within the meaning of sections 2 and 6 of the Act.

[6] The Applicant filed and served a counter statement on July 8, 2009 essentially denying the grounds of opposition.

[7] Both the Applicant and the Opponent filed evidence and written arguments and were represented at an oral hearing.

Onus and Material Dates

[8] The Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. There is, however, an initial 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 [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; and *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

[9] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30(a) and (i)- the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- sections 38(2)(c)/16(2)(a) to (c) and 16(3)(a) to (c) - the priority filing date of the application [sections 16(2) and 16(3) of the Act]; and
- sections 38(2)(d)/2 - the filing date of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Overview of the Evidence

[10] I am providing hereafter an overview of the parties' evidence, some of which I will discuss further in my analysis of the grounds of opposition, where appropriate. Also, in considering the evidence, I will not be affording weight to those portions of the evidence that are argumentative, mere allegations or opinions that go to the questions of fact and law to be determined by the Registrar in the present proceeding.

Opponent's Evidence in Chief

[11] In support of its opposition, the Opponent filed an affidavit of Louise-Marie St-Arnaud, Senior Manager Brand Transformation at the Opponent, as evidence pursuant to section 41 of the *Trade-marks Regulations*, SOR/96-195 (the Regulations). The Opponent also filed a solemn affirmation of Simon Picard, an employee of the Opponent's trade-marks agent, as further evidence pursuant to section 44 of the Regulations. Neither Ms. St-Arnaud nor Mr. Picard was cross-examined.

Affidavit of Louise-Marie St-Arnaud

[12] Ms. St-Arnaud describes the Opponent as Canada's leading local commercial search provider and the largest telephone directory publisher; it is the primary and only national publisher of print directories for businesses in Canada and operates Canada's leading on line business directory. In addition to its business directories, the Opponent is the official publisher of Bell Canada's and Telus' residential telephone directories, as well as the publisher of a number of other telephone company directories [para. 3 of the affidavit].

[13] Ms. St-Arnaud states that the Opponent owns in Canada the YELLOW PAGES trade-mark and several other trade-marks that contain the word elements YELLOW PAGES. I note that throughout her affidavit Ms. St-Arnaud collectively refers to the other trade-marks as the YPG Marks, although there are a few instances where she specifically references one of the YPG Marks, such as the YELLOWPAGES.CA trade-mark. I also note that when she refers to the trade-marks displayed on the exhibits filed as specimens of use and advertisement, Ms. St-Arnaud mostly, although not exclusively, refers to the display of the trade-mark YELLOW PAGES and/or the trade-mark YELLOWPAGES.CA.

[14] I reproduce hereafter paragraph 6 of the affidavit:

6. [The Opponent] and its predecessors have used and continue to use the YELLOW PAGES trade-mark and the YPG Marks in association with advertising businesses in print directories and compiling and publishing printed business and telephone directories (hereinafter the "Print Directory Services"), and in association with publishing and advertising businesses via searchable on line and electronic directories and electronic transmissions (hereinafter the "Online Directory Services")

(collectively “Print and Online Directory Services”). Since 1948 the Print Directory Services and since 1996 the Online Directory Services have been a prime source of business listings across Canada.

[15] Ms. St-Arnaud provides at paragraph 4 of her affidavit a table detailing the registrations relied upon by the Opponent. She states at paragraph 8 of her affidavit that “the YELLOW PAGES trade-mark and the YPG Marks have been used continuously in Canada by [the Opponent] and its predecessors (where applicable), in association with the wares and services described in each of the trade-mark registrations”. Ms. St-Arnaud files Certificates of Authenticity of the registrations owned by the Opponent; she references the Opponent’s predecessors-in-title, where applicable [paras. 9 to 12, Exhibits 2 to 5 of the affidavit].

[16] Ms. St-Arnaud introduces evidence as to the use of the YELLOW PAGES mark and at least one of the YPG Marks in association with printed business directories and combination business and residential directories published by the Opponent and its predecessors (the “Print Directories”) in Canada [paras. 13 to 15, Exhibit 6 of the affidavit].

[17] Ms. St-Arnaud introduces evidence with respect to the Opponent’s online business directory offered in Canada: (i) through the website located at *www.yellowpages.ca* (the Website) owned and managed by the Opponent; (ii) through Co-Brand agreements with important partners such as AOL, Yahoo and Sympatico to offer users of these websites access to the Opponent’s online directory services; and (iii) through mobile applications, including a mobile application that is downloaded directly to a user’s device, and the website *mobile.yip.ca* [paras. 16 to 31, Exhibits 7 to 16 of the affidavit]. She also introduces evidence with respect to the Opponent’s directory services offered through CD-ROMs that contain a digitized version of the directory listings available in the Opponent’s Print Directories [para. 32, Exhibit 17 of the affidavit].

[18] Ms. St-Arnaud files representative samples of invoices issued to customers purchasing advertising space in the Opponent’s directories to serve as evidence of use of the YELLOW PAGES mark and of certain of the YPG Marks in association with advertising services [para. 33, Exhibit 18 of the affidavit].

[19] Ms. St-Arnaud introduces evidence as to the promotion of the Print and Online Directory Services: (i) in the Print Directories themselves; (ii) through direct mailing, pamphlets and billing inserts; (iii) via other media, including television, radio, print and billboards; and (iv) on various types of promotional materials [paras. 35 to 45, Exhibits 19 to 27 of the affidavit].

[20] Finally, Ms. St-Arnaud files a table showing the approximate revenue generated during the period 2003 to 2009, broken down on a yearly basis, in association with the Print and Online Directory Services [para. 47, Exhibit 28 of the affidavit].

Solemn affirmation of Simon Picard

[21] Mr. Picard files copies of six articles and of one document printed from websites and purportedly showing that the Mark comes from a contraction of “yellow pages” [Exhibits SP-1 to SP-7 of the affidavit].

Applicant’s Evidence

[22] In support of its application, the Applicant filed affidavits of: Laurence Wilson, General Counsel of the Applicant; Gay Owens, a trade-mark searcher with the Applicant’s trade-marks agent; and Timothy Law, a law clerk employed by the Applicant’s trade-marks agent. Only Mr. Law was cross-examined and the transcript of his cross-examination is of record. I will refer to the cross-examination of Mr. Law to the extent that it is relevant to the evidence and the parties’ submissions.

Affidavit of Laurence Wilson

[23] As a preliminary matter, I note that the documents appended as exhibits to the affidavit were not certified as prescribed by the *Federal Courts Rules*, SOR/98-106, which are generally followed in opposition proceedings. Although un-notarized exhibits would probably be found inadmissible by the Federal Court, the Registrar does not strictly adhere to the rules of practice of the Federal Court. Further, the Opponent never raised the fact that the documents appended to the affidavit had not been certified by the Notary Public. In the circumstances of this case, I find that the documents appended to the affidavit of Mr. Wilson are admissible as exhibits.

[24] According to Mr. Wilson's statements, the Applicant operates a social networking, user review and local search website at *www.yelp.com* that is accessed by approximately 30 million people each month, making it one of the top 100 U.S. Internet websites [para. 2, Exhibit "A" of the affidavit]. The Applicant began operating the Canadian website *www.yelp.ca* in August of 2008. Since that time the number of users of its Canadian website has increased such that the Applicant now receives more than one million visitors to the website per month. The Applicant has "tens of thousands of registered Canadian users" and "tens of thousands of Canadian businesses" have been reviewed on the website [para. 3 of the affidavit, Exhibit "B"].

[25] Mr. Wilson was unable to identify even a single instance of actual confusion between the Applicant's business and trade-marks and those of the Opponent [para. 4 of the affidavit].

Affidavit of Gay Owens

[26] Ms. Owens introduces the results of state of the register searches that she conducted on February 18, 2010 for active trade-mark registrations and applications "containing the syllable YEL". Her first search, which was apparently conducted without limitation for wares and services, yielded 209 active trade-mark applications and registrations [para. 3, Exhibit "A" of the affidavit]. Her second search, which was limited to wares such as "directories, publications, journals, books" and to services corresponding to the statement of services in the application for the Mark, yielded 39 active registrations and applications [para. 4 and 5, Exhibit "B" of the affidavit].

Affidavit of Timothy Law

[27] The affidavit of Mr. Law purports to evidence use of the words "yellow pages" by different traders worldwide, including in Canada, in association with business directory and related services. More particularly, Mr. Law provides:

- the results of Internet searches that he carried out using the Google search engine and Wikipedia [para. 2 to 5, Exhibits "A" to "D" of the affidavit];
- printouts of pages from 22 websites "having Canadian content" listed in paragraph 6 of his affidavit [Exhibit "E"].

- printouts of pages from 66 websites listed in paragraph 7 of his affidavit [Exhibit “F”]; and
- printouts of pages from the websites *www.yellow-net.com*, *www.cyellit.org* and *www.yellgroup.com* [paras. 8 to 10, Exhibits “G” to “I” of the affidavit].

Opponent’s Reply Evidence

[28] Pursuant to section 43 of the Regulations, the Opponent filed:

- a Certificate of Authenticity showing that application No. 1,414,978 (YellowSpaces) has been abandoned;
- Certificates of Authenticity showing that the Opponent owns registration Nos. TMA516,914 (YELLOW.CA), TMA520,569 (YELLOW.CA & Design), TMA677,910 (HelloYellow & Design) and TMA720,424 (HELLOYELLOW); and
- a solemn affirmation of Louise-Marie St-Arnaud, dated December 9, 2010. Ms. St Arnaud, who was not cross-examined, introduces evidence as to the use of the Opponent’s trade-marks HelloYellow & Design and HELLOYELLOW (collectively the HELLOYELLOW Marks).

[29] As the Certificates of Authenticity establish the status of trade-mark application and registrations located by the searches conducted by Ms. Owens, I am satisfied that they properly reply to the Applicant’s evidence. As for the solemn affirmation of Ms. St-Amour, the Applicant in its written argument submits that it is not proper reply evidence; however, the Applicant does not expand on its position.

[30] Evidence filed pursuant to section 43 of the Regulations should not serve to fill in voids in the evidence filed by an opponent. However, the test is not simply whether the evidence could have been included in the evidence of the opponent. The test is whether the evidence properly responds to issues raised in the evidence filed by an applicant pursuant to section 42 of the Regulations and is responsive to unanticipated matters. I find that the solemn affirmation of Ms. St-Arnaud does not qualify as reply evidence pursuant to section 43 of the Regulations for the reasons that follow.

[31] For one thing, I am not affording any significance to Ms. St-Arnaud's statement that "part of the Applicant's evidence in this opposition refers" to the HELLOYELLOW Marks [para. 3 of the solemn affirmation]. Suffice it to say that I consider this statement to be self-serving. Further, in my opinion the evidence does not reply to any new facts contained in the Applicant's evidence and could easily have been filed as part of the Opponent's evidence in chief pursuant to section 41 or with leave from the Registrar pursuant to section 44 of the Regulations. In that regard, I note that besides Ms. St-Amour's allegation that the HELLOYELLOW Marks were used starting in February 2005 [para. 6 of the solemn affirmation], the Certificates of Authenticity confirm that the corresponding registrations were issued *in the Opponent's name* on November 30, 2006 (TMA677,910) and August 7, 2008 (TMA720,424). The Opponent's contention that the solemn affirmation confirms that the Opponent has used shortened or abbreviated versions of its YELLOW PAGES mark arguably lends support to a finding that the evidence should have been filed as part of the Opponent's evidence in chief.

Analysis of the Grounds of Opposition

[32] I shall now analyze the grounds of opposition in regard to the parties' evidence, excluding the solemn affirmation of Ms. St-Arnaud that I am disregarding as I have concluded that it does not qualify as evidence pursuant to section 43 of the Regulations.

Non-Conformity to Section 30(a) and (i) of the Act

[33] Since the Opponent did not expand on the section 30(a) and (i) grounds of opposition in written and oral arguments, I am summarily dismissing these grounds of opposition for the reasons that follow.

[34] First, the section 30(a) ground of opposition alleges that "the Applicant's Wares and Services are not defined in ordinary commercial terms". Since the application is restricted to services, the portion of the ground of opposition referencing wares is dismissed for being improperly pleaded. As for the portion of the ground of opposition referencing services, it is dismissed for the Opponent's failure to meet its evidential burden. Besides not making any submissions with respect to this ground of opposition, the Opponent did not file evidence in support thereto.

[35] Secondly, section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue such as evidence of bad faith or non-compliance with a federal statute [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; and *Canada Post Corporation v Registrar of Trade-marks* (1991), 40 CPR (3d) 221 (FCTD)]. Such circumstances do not exist in the present case.

Registrability/Section 12(1)(d) of the Act

[36] Having exercised the Registrar's discretion, I confirm that each registration alleged in support of the ground of opposition is extant and so the Opponent's initial burden under section 12(1)(d) of the Act has been met. The question becomes whether the Applicant has met its legal onus to show that, as of today's date, the Mark is not reasonably likely to cause confusion with any of the Opponent's registered trade-marks.

[37] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[38] In applying the test for confusion, I 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 trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion.]

[39] In my opinion, the section 12(1)(d) ground of opposition will be effectively decided by comparing the Mark and the word mark YELLOW PAGES (No. TMA246,988) registered in association with the following wares and services:

Wares: Prerecorded CD-roms containing advertising pertaining to various businesses.

Services: (1) Advertising businesses in directories and compiling and publishing business and telephone directories. (2) Compiling and publishing mailing lists. (3) Advertising businesses via CD-Roms, and compiling and publishing CD-Roms. (4) Advertising businesses via internet, on-line, electronic publishing and electronic transmissions.

[40] In other words, if confusion is not likely between the Mark and the YELLOW PAGES mark of registration No. TMA246,988 then it would not be likely between the Mark and any of the other registered trade-marks alleged by the Opponent.

[41] In *Masterpiece* the Supreme Court of Canada discussed the importance of section 6(5)(e) in conducting an analysis of the likelihood of confusion at paragraph 49:

[...] the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start [...].

[42] Thus, I will hereafter assess the surrounding circumstances of this case, starting with the degree of resemblance between the Mark and the YELLOW PAGES mark

The degree of resemblance between the marks in appearance or sound or in the ideas suggested by them

[43] The law is clear that when assessing confusion it is not proper to dissect trade-marks into their component parts; rather, marks must be considered in their entirety.

[44] The crux of the Opponent's position that there is a great deal of resemblance between the parties' respective trade-marks is based on its contention that the Mark would be seen as an abbreviated version of the YELLOW PAGES mark. In that regard, the Opponent submits that its

evidence shows the Opponent's practice of adopting modified or abbreviated version of its YELLOW PAGES mark. The Opponent also submits that the solemn affirmation of Mr. Picard shows the objective association between the expression YELP and the YELLOW PAGES mark. In both cases, the Applicant has objected to the value of the evidence relied upon by the Opponent.

[45] Considering the trade-marks relied upon by the Opponent in support of its opposition, I find that its submissions as to its use of modified or abbreviated versions of its YELLOW PAGES mark advance an additional surrounding circumstance rather than being germane to the consideration of the section 6(5)(e) factors. Hence, I will return to these submissions when discussing the additional surrounding circumstances of this case.

[46] As for the solemn affirmation of Mr. Picard, the Opponent did not convince me that it is reliable evidence that the Mark comes from a contraction of "yellow pages". In that regard, I agree with the Applicant that the printed excerpts of websites provided by Mr. Picard are not admissible for the truth of their contents. At most, I accept that the websites, from which these excerpts were taken, existed when they were accessed by Mr. Picard on July 23, 2010. Arguably, it was open to the Applicant to file evidence denying the Opponent's evidence purporting to show that the Mark is a contraction of the word "yellow pages" and so one could find that the evidence introduced by Mr. Picard should be afforded some probative value. However, even if one finds that the such evidence suffices to establish that the Mark comes from a contraction of the words "yellow pages", there is no evidence that Canadian consumers have accessed at any time whatsoever any of the websites referenced by Mr. Picard, nor is there evidence that Canadian consumers would have any knowledge of the genesis of the Mark.

[47] I agree with the Applicant that despite the letters "yel" found in the Mark, the latter is readily distinguishable from the YELLOW PAGES mark when viewed and sounded. As for the idea suggested by the Mark, I first remark that the Applicant's written submissions that the Mark "is suggestive of a vocal response (i.e. 'to yelp or make a high pitched noise')" [para. 32 of its written argument] seemingly contradict its oral submissions that there is no evidence that "yelp" is a word of the English language having its own significance. In any event, since I may refer myself to dictionaries [see *Insurance Co. of Prince Edward Island v Prince Edward Island*

Insurance Co (1999), 2 CPR (4th) 103 (TMOB)], I note that the word “yelp” is defined in *The Canadian Oxford Dictionary* as: “*n.* a sharp shrill cry of or as of a dog in pain or excitement. • *v.intr.* utter a yelp.” Given the meaning of the word “yelp” and my findings with respect to the evidence introduced by Mr. Picard, I conclude that the Mark is distinguishable from the YELLOW PAGES mark when considering the ideas suggested.

[48] Ultimately, I conclude that the section 6(5)(e) factors considerably favour the Applicant.

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

[49] The section 6(5)(a) factor involves a combination of the inherent and acquired distinctiveness of the marks at issue.

[50] The Applicant contends that the YELLOW PAGES mark lacks inherent distinctiveness because it has for many years been and continues to be descriptive since many different traders print business telephone directories on “yellow pages”. In support of its position, the Applicant relies, among others, upon the Wikipedia excerpts attached as Exhibits “B” to “D” to the Law affidavit. Further, the Applicant submits that judicial notice may be taken of the fact that business directory portions of telephone directories in Canada have for many years and continue to be printed on yellow paper.

[51] I see no need to extensively address the Applicant’s submissions. Indeed, apart from the deficiencies that may be attached to its evidence, whether or not the Applicant rightly submits that the words “yellow pages” are descriptive of the Opponent’s wares and services, the YELLOW PAGES mark undoubtedly benefits from significant acquired distinctiveness. In fact, the Opponent’s evidence provided by the St-Arnaud affidavit, including the following evidence, satisfies me that the YELLOW PAGES mark has become well known throughout in Canada:

- at the date of the affidavit (November 6, 2009), the Opponent was publishing more than 334 Print Directories having a circulation of over 26 million copies per year and distributed to homes, businesses and other organizations in markets that cover approximately 97% of the Canadian population [para. 15];

- the average monthly traffic figures for the Website went from approximately 1.1 million unique visitors in 2003 to 4.6 million unique visitors as of September 2009 [Exhibit 11];
- the average monthly traffic figures for the *mobile.yip.ca* website went from 30,701 in 2003 to 199,896 as of September 2009 [Exhibit 15];
- the mobile applications have been downloaded by more than 500,000 individuals [para. 31];
- the approximate advertising expenditures for the period 2003 to 2010 (estimated) totaled in excess of \$42 million; and
- each year from 2006 up to November 3, 2009, the Opponent’s Print and Online Directories Services have generated revenues of over 1 billion dollars [para. 47].

[52] Despite the dictionary meaning attaching to the word “yelp”, I find that the Mark possesses some measure of inherent distinctiveness in the context of the applied-for services. I see no need to address at length the parties’ submissions with respect to the extent to which the Mark has become known in Canada due to the operation of the Applicant’s Canadian website since August 2008. Indeed, whatever the extent to which the Mark may have become known, it is certainly fair to conclude that it is much less than the YELLOW PAGES mark.

[53] In the end, the overall consideration of the section 6(5)(a) factors favours the Opponent.

The length of time each trade-mark has been in use

[54] I will not discuss extensively the section 6(5)(b) factor since it is clear that it significantly favours the Opponent.

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

[55] When considering the section 6(5)(c) and (d) factors, it is the statement of services in the application for the Mark and the statement of wares and services in the Opponent’s registration that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR

(3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[56] The submissions of the Applicant with respect to the consideration of the section 6(5)(c) and (d) factors were essentially put forward at the oral hearing. In a nutshell, given its evidence that the Mark is associated with the operation of a social networking, user review and local search website, the Applicant contends that the nature of the services and the nature of the trade associated with the Mark differ from the nature of the wares and services and the nature of the trade associated with the YELLOW PAGES mark, as does the nature of each party's business.

[57] Although not entirely identical, the applied-for services "providing telephone directory information via global communications networks..." are certainly similar to the services "(1) ...compiling and publishing business and telephone directories..." of registration No. TMA246,988. Also, to the extent that the Applicant stresses the "on-line" nature of its services, I fail to understand how it may reasonably argue differences between the parties' channels of trade as the statement of services of registration No. TMA246,988 specifically reference on-line services in "... (4) Advertising businesses via internet, on-line, electronic publishing and electronic transmissions."

[58] In the end, the Applicant did not convince me that it is favoured by the consideration of the section 6(5)(c) and (d) factors; rather, they tend to favour the Opponent.

Additional surrounding circumstances

[59] I will start my consideration of the additional surrounding circumstances of this case by reverting to the Opponent's contention that since its evidence establishes a practice of adopting modified or abbreviated versions of the YELLOW PAGES mark, it would seem entirely likely that the average consumer in a hurry would conclude that the services associated with the Mark are somehow associated with the Opponent. In support of its contention, the Opponent cited the decision *Benson & Hedges (Canada) Limited v St-Regis Tobacco Corporation*, [1969] SCR 192 where the Supreme Court of Canada stated at page 203:

In the present case there is a distinct possibility that "Golden Circlet" would appear as a sort of diminutive of "Gold Band", especially on account of the meaning of

“circlet”. This, as well as the other considerations above stated, in my opinion, further supports the learned President's finding that confusion would be likely to occur.

[60] At the outset, I note that the Opponent’s submissions based on the evidence introduced by the solemn affirmation of Ms. St-Arnaud are a moot point since I have found that such evidence is to be disregarded. As I understand the Opponent’s submissions with respect to its evidence in chief, its adoption of modified or abbreviated versions of its YELLOW PAGES mark is reflected in the element “yp” found in the website address *mobile.yp.ca* [para. 16 of the St-Arnaud affidavit] and in the element “yelo” found in the telephone number 310-YELO(9356) displayed on several pages of the website [see Exhibit 7 of the St-Arnaud affidavit].

[61] First, apart from the fact that each case must be decided based upon its own merit, I agree with the Applicant that the *Benson & Hedges* decision is clearly distinguishable from the present proceeding. Suffice it to say that in *Benson & Hedges* the opponent relied upon its registered trade-marks GOLD BAND in support of its opposition to the registration of the trade-mark GOLDEN CIRCLET. In the instant the Opponent relies upon trade-marks involving the word elements YELLOW PAGES; the Opponent does not rely upon confusion between the Mark and the trade-mark YP or the trade-mark YELO in support of any of the grounds of opposition.

[62] Second, whether or not the Opponent rightly argues the relevancy of modified or abbreviated versions of the YELLOW PAGES mark as an additional surrounding circumstance, in my opinion its evidence does not support the conclusion that such additional surrounding circumstance exists in the instant case. I agree with the Applicant that the Opponent’s evidence at the utmost shows use of YP as part of a URL address and use of YELO instead of the numeral 9356 in a telephone number. I would add that if it was to be found that the Opponent’s evidence establishes trade-mark use of YP or YELO *per se* pursuant to section 4 of the Act, or for that matter use of any abbreviated or modified versions of the YELLOW PAGES mark, in my view this additional circumstance would not be of assistance to the Opponent; having found that the evidence as introduced by Mr. Picard does not suffice to establish a link between the Mark and the word elements YELLOW PAGES, by extension I would find that such evidence does not suffice to establish a link between the Mark and an abbreviated or modified version of the YELLOW PAGES mark.

[63] At the oral hearing, the Opponent also relied upon its family of trade-marks containing the word elements YELLOW PAGES as an additional surrounding circumstance supporting a finding of confusion. I am satisfied that the Opponent's evidence establishes the existence of such a family of trade-marks [see *MacDonald's Corporation v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101 (FCTD)]. However, I consider this additional circumstance to be of no assistance to the Opponent's case since the Mark does not involve the word elements YELLOW PAGES.

[64] The Applicant's submissions advance its evidence as to the state of the register and of the marketplace as well as the absence of evidence of actual confusion as additional surrounding circumstances supporting a finding of no likelihood of confusion. I deem it not necessary to address these additional surrounding circumstances to find in favour of the Applicant.

Conclusion on the likelihood of confusion

[65] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Even though my assessment of the circumstances of this case leads me to conclude that the section 6(5)(a) through (d) factors favour the Opponent, in my opinion the differences between the Mark and the YELLOW PAGES mark in appearance, sound and in the ideas suggested by them are so significant that they shift the balance of probabilities in favour of the Applicant. Hence, I conclude that the Applicant has discharged the legal onus resting upon it to show that confusion between the Mark and the YELLOW PAGES mark of registration No. TMA246,988 is not likely. Further, as I previously indicated, I find that comparing the Mark with the Opponent's trade-mark YELLOW PAGES of registration No. TMA246,988 effectively decides the outcome of the ground of opposition.

[66] In view of the above, the section 12(1)(d) ground of opposition is dismissed in its entirety.

Non-Entitlement/Sections 16(2)(a) and 16(3)(a) of the Act

[67] Despite the legal onus resting on the Applicant, the Opponent has the initial burden of proving that each of the trade-marks alleged in support of the sections 16(2)(a) and 16(3)(a) grounds of opposition was used in Canada prior to the priority filing date of the application,

namely February 6, 2007, and had not been abandoned at the date of advertisement of the application for the Mark, namely December 10, 2008 [section 16(5) of the Act].

[68] Once again, I find that comparing the Mark with the YELLOW PAGES mark will effectively decide both grounds of opposition and so I find it unnecessary to consider whether the Opponent has discharged its evidentiary burden to establish prior use and non-abandonment of the other trade-marks alleged in support of these grounds of oppositions. Suffice it to say that I am satisfied that the Opponent has discharged its evidentiary burden to show prior use and non-abandonment of its YELLOW PAGES mark. Further, assessing each of the section 6(5) factors as February 6, 2007 rather than as of today's date does not significantly impact my previous analysis of the surrounding circumstances of this case. Accordingly, I dismiss the non-entitlement grounds of opposition based upon sections 16(2)(a) and 16(3)(a) for reasons similar to those expressed under the section 12(1)(d) ground of opposition.

Non-Entitlement/Sections 16(2)(b) and 16(3)(b) of the Act

[69] Considering the Certificates of Authenticity filed as Exhibit 2 to the affidavit of Ms. St-Arnaud, I conclude that the Opponent's initial burden under the sections 16(2)(b) and 16(3)(b) grounds of opposition has been met; each of the applications, which proceeded to registration either on May 27, 2009 or May 28, 2009, was filed prior to February 6, 2007 and was pending at the date of advertisement of the application for the Mark [section 16(4) of the Act].

[70] The Opponent did not necessarily expand on these grounds of opposition either in written or oral submissions; it has essentially focused its submissions, both written and oral, on the likelihood of confusion between the Mark and its YELLOW PAGES mark, only referencing in a few instances the mark YELLOWPAGES411 of registration No. TMA740,939 (corresponding application No. 1,354,706).

[71] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. When considering the marks at issue in their entirety, I conclude that the differences between each of the Opponent's applied-for marks and the Mark in appearance, sound and in the ideas suggested by them are even more significant than between the Mark and

the Opponent's YELLOW PAGES mark. In other words, the Opponent's case under these grounds of opposition is not stronger than under the previously discussed grounds of opposition and so I deem it not necessary to extensively discuss the sections 16(2)(b) and 16(3)(b) grounds of opposition.

[72] In the end, I conclude that the Applicant has discharged the legal onus resting upon it to show that, as of February 6, 2007, the Mark was not reasonably likely to cause confusion with any of the alleged trade-marks in respect of which an application for registration had been previously filed by the Opponent. Accordingly, I dismiss the non-entitlement grounds of opposition based upon sections 16(2)(b) and 16(3)(b) of the Act.

Non-Entitlement/Sections 16(2)(c) and 16(3)(c) of the Act

[73] Despite the legal onus resting on the Applicant, the Opponent has the initial burden of proving that the trade-names Yellow Pages and Yellow Pages Group alleged in support of the sections 16(2)(c) and 16(3)(c) grounds of opposition were used in Canada prior to February 6, 2007 and had not been abandoned at the date of advertisement of the application for the Mark [section 16(5) of the Act].

[74] Once again, I note that the Opponent did not necessarily expand on these grounds of opposition either in written or oral submissions. It is also noteworthy that Ms. St-Arnaud has essentially introduced the Opponent's evidence by referencing the YELLOW PAGES mark. In other words, the evidence does not distinguish between use of YELLOW PAGES as a mark or as a trade-name. That being said, if it ought to be found that the evidence, as introduced by Ms. St-Arnaud, is sufficient for the Opponent discharging its evidentiary burden under the sections 16(2)(c) and 16(3)(c) grounds of opposition, then it ought to be found that these grounds of opposition can be dismissed for reasons similar to those expressed under the previous grounds of opposition based upon confusion with the Mark and the YELLOW PAGES mark.

Non-Distinctiveness

[75] The ground of opposition revolves around the likelihood of confusion between the Mark and the Opponent's trade-marks and trade-names alleged in the statement of opposition.

[76] Once again, I find that comparing the Mark with the YELLOW PAGES mark will effectively decide the outcome of this ground of opposition. Accordingly, I find it unnecessary to consider whether the Opponent has discharged its evidentiary burden to establish that any of its other alleged trade-marks or any of its alleged trade-names had become known sufficiently as of April 17, 2009 to negate the distinctiveness of Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. Suffice it to say that I am satisfied that the Opponent has met its evidentiary burden with respect to its YELLOW PAGES mark.

[77] Since assessing each of the section 6(5) factors as of April 17, 2009 does not significantly impact my previous analysis of the surrounding circumstances of this case, for reasons similar to those expressed previously, I am satisfied the Applicant has discharged the legal onus resting upon it to show that, as of April 17, 2009, the Mark was not reasonably likely to cause confusion with any of the Opponent's alleged trade-marks or trade-names. Accordingly, I dismiss the non-distinctiveness ground of opposition.

Disposition

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

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office