Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 143

Date of Decision: 2023-08-10

IN THE MATTER OF AN OPPOSITION

Opponent: Gang Cao

Applicant: Apple Inc.

Application: 1995940 for LivePhotosKit

INTRODUCTION

[1] Gang Cao (the Opponent) opposes registration of the design trademark LivePhotosKit (the Mark), which is the subject of application No. 1995940 by Apple Inc. (the Applicant). The Mark is shown below:

LivePhotosKit

[2] The Mark is applied for in association with the following goods (in Nice class 9) and services (in Nice class 42):

> Goods: Computer software used in developing other software applications; application development software; website development software; multimedia development software, namely, computer software for assisting users in creating, editing, and publishing multimedia files containing a combination of digital images, photographs, and video clips; computer software for displaying digital photographs and videos on

webpages.

Services: Computer programming; design and development of computer software; computer software consulting services; support services in the nature of consultation services for developing applications; providing computer software information online; application service provider (ASP) services featuring application programming interface (API) software for use in developing websites, software and multimedia content, namely, digital files featuring a combination of photographs and video clips; application service provider featuring application programming interface (API) software for displaying digital photographs and videos on webpages; providing online non-downloadable software, namely, computer software for assisting developers in creating computer program code for use in single and multiple application programs.

[3] All references are to the *Trademarks Act*, RSC 1985, c T 13 as amended June 17, 2019 (the Act), unless otherwise noted.

THE RECORD

[4] The application for the Mark was filed on October 18, 2019, based on a request for extension of protection for international registration No. 1370108 under the Madrid Protocol.

[5] The application was advertised for opposition purposes on June 9, 2021.

[6] On December 7, 2021, the Opponent opposed the application by filing a statement of opposition under section 38 of the Act.

[7] As set out in the statement of opposition, the grounds of opposition are based on non-conformance with section 30(2)(a) of the Act; non-registrability under sections 12(1)(b) and 12(1)(c) of the Act; and non-distinctiveness under section 2 of the Act.

[8] The Applicant filed its counter statement on December 17, 2021.

[9] The Opponent elected not to submit evidence.

[10] In support of its application, the Applicant submitted certified copies of three registrations and the following affidavits:

- Affidavit of David Kincaid, affirmed June 7, 2022 (the Kincaid Affidavit);

- Affidavit of Ruth Corbin, sworn June 10, 2022 (the Corbin Affidavit);
- Affidavit of Shana Poplack, affirmed April 12, 2022 (the Poplack Affidavit);
- Affidavit of Rachel Barker, affirmed May 25, 2022 (the Barker Affidavit).

[11] None of the affiants were cross-examined.

[12] Only the Applicant submitted written representations, but both parties were represented at an oral hearing. The hearing was conducted concurrently with respect to the opposition proceedings for application Nos. 1971882 to 1971887 and 1979565 (all for the trademark LIVE PHOTOS). Separate decisions will issue in respect of those proceedings.

[13] I also note that the parties have a history and that the Registrar has recently issued decisions involving the Mark [*Gang Cao v Apple Inc*, 2023 TMOB 14] and the LIVE PHOTOS trademark [*Gang Cao v Apple Inc*, 2023 TMOB 6], the latter of which is currently under appeal by the Applicant.

OVERVIEW OF THE APPLICANT'S EVIDENCE

[14] Given the reasons below, it is not necessary to describe the Applicant's evidence in detail. In particular, with respect to the four affidavits, it is not necessary to rule on the admissibility of – or weight to be given – each affidavit. Suffice to say, the Kincaid Affidavit purports to be expert opinion evidence on the distinctiveness of the "Live Photos" brand. Similarly, the Poplack Affidavit purports to be expert opinion evidence on whether the Mark constitutes a generic term and whether it is inherently distinctive, from that affiant's perspective as a sociolinguist. The Corbin Affidavit evidences a survey of Canadian owners of smartphone or tablet devices, seeking to assess the extent to which the term LIVE PHOTO(S) is used generically in the context of photo and video applications for such devices. Finally, the Barker Affidavit evidences Internet, online dictionary, and Google Trends searches for the Mark and the term LIVE PHOTOS.

[15] Otherwise, the Applicant furnished certified copies of its Canadian trademark registrations for LIVETYPE (TMA646444), LIVE LISTEN (TMA1003358), and LIVE TITLES (TMA1067498).

EVIDENTIAL BURDEN AND LEGAL ONUS

[16] In accordance with the usual rules of evidence, there is an evidential burden on the Opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd*, 1990 CarswellNat 1053 (FCTD)]. The presence of an evidential burden on the Opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

[17] For those allegations for which the Opponent has met its evidential burden, the legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. The presence of a legal onus on the Applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against it.

GROUNDS OF OPPOSITION WITHDRAWN BY THE OPPONENT

[18] First, pursuant to section 38(2)(a) of the Act, the Opponent pleads that the application does not conform to the requirements of section 30(2) of the Act because the application does not contain a statement in ordinary commercial terms of the goods or services in association with which the Mark is used or proposed to be used. In this respect, I note that the pleading reproduces the entirety of the statement of goods and services from the application.

[19] Second, pursuant to section 38(2)(b) of the Act, the Opponent pleads that, by virtue of section 12(1)(b) of the Act, the Mark is not registrable because whether depicted, written or sounded, it is either clearly descriptive or deceptively misdescriptive in the English language of the character or quality of all of the applied-for goods and services. In this respect, the Opponent pleads that:

- “LivePhotosKit” is the name and/or title of the applied-for “software” goods and of the applied-for services, and is the most certain way of identifying them;

- “LivePhotosKit” clearly describes (or deceptively misdescribes) the function of the “software” goods with which it is alleged to be used and that such software is part of a “kit”. In particular, the term “live photos” is commonly used in the trade and/or by the public to refer to photographs, software or services in relation to photographs, that create the impression of movement, or being “live”. The Mark therefore clearly describes that the goods and services are in connection with a software kit intended to create or bring photos to life through movement; and/or

- “LivePhotosKit” clearly describes (or deceptively misdescribes) a character of the goods and services in the application, in that they pertain to a “kit” for “live photos” for the aforementioned reasons.

[20] Third, pursuant to section 38(2)(b) of the Act, the Opponent pleads that, by virtue of section 12(1)(c) of the Act, the Mark is not registrable because it is the name in the English language of the goods and services in connection with which it is alleged to be used, that is “LivePhotosKit” is the name of the Applicant’s “software” goods and related services.

[21] Fourth, pursuant to section 38(2)(d) of the Act, the Opponent pleads that, having regard to section 2 of the Act, the Mark is not distinctive of the goods and/or services of the Applicant within the meaning of “distinctive” as set out in section 2 of the Act because as of the material date:

- The Applicant had not used the Mark to such an extent that it acquired any distinctiveness, and the Mark is not inherently distinctive (Branch One);

- The term “LivePhotosKit” is the name of the applied-for goods and services (Branch Two); and/or

- The Mark is, and/or has always been, a generic term in respect of the applied-for goods and services (Branch Three).

[22] With respect to Branch One, the Opponent further pleads that i) the term "LivePhotosKit" does not actually distinguish, nor is it adapted to distinguish, the goods and services of the Applicant in association with which it is alleged to be used from the goods and services of others in Canada, because the term "live photos" is commonly used in the trade and/or by the public to refer to photographs, software, or services in relation to photographs, that create the impression of movement, or being "live", and the term "kit" is commonly used in the trade and/or by the public to refer to a set of things used for a particular purpose or activity, so the term "LivePhotosKit" would be understood by the trade and/or the public to be a software kit employed to create or bring photos to life through movement, or services related thereto; ii) the term "LivePhotosKit" is descriptive of a character of the goods and services in association with which the Applicant is alleged to have used the term; iii) the term "LivePhotosKit" is inherently descriptive because it is the only way to identify the applied-for "software" goods and the applied-for services; and iv) the term "LivePhotosKit" will neither be used nor perceived as a trademark because it describes the applied-for "software" goods and the applied-for services.

[23] At the hearing, the Opponent withdrew all of these pleaded grounds of opposition. In any event, in the absence of evidence from the Opponent, suffice to say that I ultimately agree with the Applicant that the Opponent fails to meet its initial burden with respect to each of these grounds [Applicant's written representations at paras 9 to 11].

[24] In view of the foregoing, all of the pleaded grounds of opposition are rejected.

UNPLED BAD FAITH GROUND OF OPPOSITION

[25] At the hearing, the Opponent submitted that the application should be refused on the basis that it was filed in bad faith. In this respect, the Opponent appeared to echo the bad faith grounds pleaded and argued in some of the aforementioned co-pending oppositions, suggesting that the Applicant's multiple applications in association with a diverse range of goods and services is an improper attempt to prevent others from using the Mark and the term LIVE PHOTOS.

[26] Acknowledging that such a ground was not specifically pleaded in the statement of opposition, the Opponent nonetheless argued that it should be considered and would not be prejudicial to the Applicant, given that the Applicant addresses the issue of bad faith in its written representations [at para 91]. However, as discussed at the hearing, the inclusion of a section on bad faith in such written representations appears to merely be a function of the Applicant submitting essentially the same written representations across all of the aforementioned co-pending opposition proceedings.

[27] In any event, as a bad faith ground was not pleaded in the statement of opposition in this case, the Opponent is precluded from relying on it and such a ground cannot be considered [see, for example, *Great Northern Growers Inc v NewAgco Inc*, 2021 TMOB 107 at para 54, relying on *Imperial Developments Ltd v Imperial Oil* (1984), 79 CPR (2d) 12 (FCTD) for the general proposition that an opponent cannot rely on a ground of opposition which it has not plead].

[28] Given that the subject application is a Protocol application, I further note section 128 of the *Trademarks Regulations*, which states as follows:

> **128.** If the Registrar sends to the International Bureau a notification of provisional refusal based on an opposition, the statement of opposition may not be amended to add a new ground of opposition.

[29] Accordingly, had the Opponent submitted a request for leave to amend its statement of opposition to add such a bad faith ground, the request would have been refused [see also section I.10 of the practice notice *Opposition to Protocol applications and section 45 cancellation proceedings against Protocol registrations*, re: No new grounds of opposition].

DISPOSITION

[30] In view of all of the foregoing, pursuant to section 38(12) of the Act and the authority delegated to me under section 63(3) of the Act, I reject the opposition.

_____

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-06-27

APPEARANCES

For the Opponent: Gang Cao

For the Applicant: Antonio Turco

AGENTS OF RECORD

For the Opponent: No Agent Appointed

For the Applicant: CPST Intellectual Property Inc.