



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 80

Date of Decision: 2024-04-25

IN THE MATTER OF AN OPPOSITION

Opponent: ContextLogic Inc.

Applicant: Eyewish Inc.

Application: 1929088 for EYEWISH

INTRODUCTION

[1] This is an opposition brought by ContextLogic Inc. (the Opponent) in respect of application number 1929088 for the trademark EYEWISH (the Mark) filed by Eyewish Inc. (the Applicant).

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

CI 9 (1) Computer and cellular telephone software for creating and sharing wish lists of products and services

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

THE RECORD

[4] The application for the Mark was filed on November 6, 2018 and was advertised for opposition in the *Trademarks Journal* of June 2, 2021.

[5] On December 2, 2021, 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 39(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 38(2)(e) ground, the grounds of opposition are rooted in an allegation of confusion with the Opponent's registered trademarks WISH (registration nos. TMA1090583 and TMA1068905) and WISH SHOPPING MADE FUN (registration no. TMA948594) (the "WISH Trademarks"). A full list of the goods and services associated with the WISH Trademarks is attached as Schedule A.

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

[8] No cross-examinations were conducted.

[9] The Applicant filed written representations on November 20, 2023. The Opponent did not file written representations.

[10] Both parties requested an oral hearing, however, only the Opponent attended the hearing on April 4, 2024.

OVERVIEW OF THE EVIDENCE

The Opponent's Evidence

[11] In support of its opposition, the Opponent filed the affidavit of Franklin Goldberg, Deputy General Counsel of the Opponent, sworn June 6, 2022 (the Goldberg Affidavit) and the affidavit of Daniel Derkach, summer student at law for the Opponent's agent, affirmed June 3, 2022 (the Derkach Affidavit).

[12] The Goldberg Affidavit contains, *inter alia*, a detailed description of the Opponent's worldwide business, goods and services, details of use of the WISH Trademarks in Canada and abroad, as well as the Opponent's sales revenue from Canadian transactions for over seven years commencing in 2014 and Canadian advertising expenditures for over five years commencing in 2017.

[13] The Derkach Affidavit details Mr. Derkach's attempt to download and access the Applicant's EYEWISH mobile and desktop applications.

The Applicant's Evidence

[14] In support of the application, the Applicant filed the affidavit of Heather Ryan, Director of the Applicant, sworn October 4, 2022 (the Ryan Affidavit).

[15] The Ryan Affidavit provides, *inter alia*:

- a brief history of the Applicant;
- dictionary definitions for the words "wish", "wish list" and "eye";
- results of a Canadian Trademark Register (the Register) search for registered trademarks containing the word "wish", as well as a narrower subset of this search for registered trademarks containing the word "wish" associated with "retail sale/store, online marketplaces, advertising and related services"; and
- results of a search for apps available for download from Google Play that are named or that mention the word wish.

The Opponent's Reply Evidence

[16] In reply, the Opponent filed the affidavit of Lamont Abramczyk, an articling student employed by the Opponent's agent, sworn May 1, 2023 (the Abramczyk Affidavit) and the affidavit of Mary Noonan, a trademark searcher

employed by the Opponent's agent, sworn May 1, 2023 (the Noonan Affidavit).

[17] The Abramczyk Affidavit contains a description of a search conducted by Mr. Abramczyk in the Google Play website for the Opponent's WISH app as well as a screenshot of the accessed webpage.

[18] The Noonan Affidavit contains a description of online searches conducted by Ms. Noonan of the Register for five registrations containing the word "wish" that had been expunged or in respect of which a notice of expungement had been sent, along with screenshots of the database records for each of the searched registrations. All five of these registrations were referenced in the Ryan Affidavit as being in the 11 registered trademarks containing the word "wish" associated with "retail sale/store, online marketplaces, advertising and related services".

EVIDENTIAL BURDEN AND LEGAL ONUS

[19] 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 (FC)]. 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 admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist [*John Labatt* at 298].

[20] 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 an 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.

ASSESSMENT OF THE GROUNDS OF OPPOSITION

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

[21] The Opponent pleads that the Mark is not registrable as it is confusing with the Opponent's WISH Trademarks which were previously registered in Canada.

[22] 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)].

[23] An 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. In the present case, the Opponent is relying on three registered trademarks, one registration for the trademark WISH SHOPPING MADE FUN (registration no. TMA948594), and two registrations for the word WISH (registration nos. TMA1090583 and TMA1068905, the "WISH Word Marks"). I have exercised my discretion to check the register and confirm that all three of the registrations relied upon by the Opponent remain extant [see *Quaker Oats Co of Canada 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.

[24] 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.

[25] 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].

[26] Both of the WISH Word Mark registrations cover, *inter alia*, gift registry services. Registration no. TMA1068905 (the '905 Registration) also covers the services "Online computer services, namely, creating an online database featuring gift registries and lists" and "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".

[27] Given that the Opponent's registered WISH Word Marks more closely resemble the Mark compared to the Opponent's WISH SHOPPING MADE FUN trademark, I do not consider it necessary to separately discuss this latter registration. If the Mark is not found to be confusing with the WISH Word Marks, it will not be found confusing with the WISH SHOPPING MADE FUN mark given the lower degree of resemblance to the Mark. However, as both

the Opponent and Applicant have made submissions based on all three of the WISH Trademarks collectively, reference will be made to the WISH Trademarks where required.

Inherent Distinctiveness and Extent Known

[28] The Applicant submits that the WISH Trademarks are composed of common English words, no coined words, are clearly descriptive of the services relating to "wish lists" or "gift lists", and have no inherent distinctiveness [Applicant's written representations, paras 48 and 49]. The Applicant further submits that the Mark has a unique and distinctive element, namely the word EYE, which is not present in the Opponent's WISH Trademarks and that, therefore, the Mark has a much higher degree of inherent distinctiveness [Applicant's written representations, para 56].

[29] At the oral hearing, the Opponent submitted that the WISH Trademarks are not clearly descriptive of the associated goods or services and that the Applicant is attempting to conflate the Opponent's WISH Trademarks into the trademark WISH LISTS, which they are clearly not. At most, the Opponent submits that its WISH Trademarks suggest that the associated goods and services can help fulfill your wishes and are not devoid of inherent distinctiveness.

[30] Overall, I find that the Opponent's WISH Trademarks to be suggestive of the associated goods and services, but not clearly descriptive thereof. I find that the Mark is also suggestive of the associated goods, but to a lesser degree given that the Mark is a coined word that is a somewhat novel play on words, with the "eye" element, when sounded, being a common statement but which also could also be considered a clever reference to visually seeing a product or service that the consumer desires. Accordingly, I find the Applicant is favoured in respect of inherent distinctiveness.

[31] With respect to extent known, the Opponent's evidence, specifically the Goldberg Affidavit, provides, *inter alia*, evidence of use of the WISH Trademarks in Canada since 2011, the number of annual Canadian transactions and Canadian annual sales revenue associated with the WISH Trademarks for the years 2014 to 2022 with transactions ranging from 650,000 to 12,500,000 annually and revenue ranging from \$350,000 USD to \$52,000,000 [para 25]. The Goldberg Affidavit also provides that in 2021 alone, the Opponent had more than 7.5 million individual logins from Canadian customers on the Opponent's WISH platform [para 40]. Finally, the Goldberg Affidavit provides Canada-specific expenditures for advertising, promotional and marketing efforts involving the WISH Trademarks for the years 2017 through to 2022 demonstrating annual expenditures in the tens of thousands of dollars [para 47].

[32] As there is no evidence of record demonstrating any use or making known of the Mark in Canada, the factor of extent known favours the Opponent.

[33] Overall, I consider the Opponent to be favoured by this factor, although only slightly.

Length of Time in Use

[34] In addition to the unchallenged statement of Mr. Goldberg that the WISH Trademarks have been very extensively used and promoted in Canada since 2011, the Opponent has also evidenced use of the WISH Trademarks in Canada for each of the years 2014 to 2022, both in number of Canadian transactions as well as sales revenue [Goldberg Affidavit, paras 31 and 42].

[35] As the Applicant did not file evidence of use of the Mark, this factor favours the Opponent.

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

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

[37] In the present case, the registrations for both WISH Word Marks cover “gift registry services”, while the ‘905 Registration also covers “online computer services, namely, creating an online database featuring gift registries and lists”, and “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”. The application for the Mark contains the goods “Computer and cellular telephone software for creating and sharing wish lists of products and services”.

[38] I agree with the Opponent that, despite the WISH Word Marks containing only services and the application for the Mark containing only goods, the Applicant’s goods overlap with the services in the WISH Word Mark registrations. The fact that the Applicant has described its software for creating and sharing wish lists as goods, whereas the Opponent has described what I consider to be the same consumer product as services is not sufficient to distinguish the goods, services, businesses or trades of the parties.

[39] Based on a reading of the goods in the application for the Mark and the services in the WISH Word Mark registrations, in my view, 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.

[40] 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 goods, business or trade that would distinguish them from those of the Opponent.

[41] Accordingly, these factors all favour the Opponent.

Degree of Resemblance

[42] When considering the degree of resemblance, the trademarks at issue must be considered in their entirety as a matter of first impression. They must not be carefully analyzed and dissected into their component parts [*Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD)]. That being said, the preferable approach is to consider whether there is an aspect of each trademark that is particularly striking or unique [*Masterpiece*, para 64].

[43] As the trademark covered by the WISH Word Marks consist solely of the word WISH, I consider the most striking element of this trademark to be the trademark as a whole.

[44] I also consider the most striking or unique element of the Mark to be the Mark in its totality, given that it is a somewhat unique combination of two common English language words.

[45] In its written representations, the Applicant submits that the Mark "has a unique and distinctive "EYE" element" that is not present in the Opponent's trademarks, and that "there is very little resemblance" between the Mark and all of the Opponent's WISH Trademarks [paras 55 and 62]. The Applicant further submits that this factor significantly favours the Applicant since "the marks do not resemble each other when viewed as-a-whole" [para 64].

[46] I disagree with the Applicant's assertion that there is very little resemblance between the Mark and the WISH Word Marks. First, the Mark encompasses the entirety of the trademark covered by the WISH Word Marks. Accordingly, there is necessarily a certain degree of aural resemblance between the trademarks at issue on first impression. While the fact that the Mark as a whole contains a different initial element, I consider the addition of the word "eye", sounded as "I", does little to differentiate the trademarks of the parties at least in terms of sound.

[47] With respect to appearance, given, as the Applicant points out, that the term "eyewish" is a coined word, I am of the view that visually the Mark is notably different from the WISH Word Marks.

[48] Finally, with respect to ideas suggested by the trademarks at issue, I do not consider there to be a significant difference. The trademarks of both parties are highly suggestive of a desire for certain goods and/or services. The fact that one expresses this as a general concept and the other as a personal desire does not, in my view, result in a meaningful distinction in idea suggested.

[49] Overall, I am of the view that the Mark and the WISH Word Marks are more alike than they are different. I therefore consider this factor to favour the Opponent.

Surrounding Circumstances – State of the Register

[50] The Applicant submitted state of the register evidence through the Ryan Affidavit which contained a search of the Register for all registered trademarks containing the word "wish" [para 6]. The Ryan Affidavit then provided the particulars for 11 third-party registered trademarks containing the word "wish" associated with "retail sale/store, online marketplaces, advertising and related retail services" [para 7].

[51] In its reply evidence, the Opponent demonstrated that five of the 11 third-party registrations listed in the Ryan Affidavit were expunged or were subject to a notice of possible expungement [Noonan Affidavit, para 4, Exhibits 6 to 10].

[52] While state of the register evidence can be favourable for an applicant, this is only the case where a large number of relevant registrations and evidence of actual use allow for inferences regarding the state of the marketplace to be drawn [*Tweak-D Inc v Canada (Attorney General)*, 2023 FCA 238]. In the present case, I am not prepared to draw any conclusions regarding the state of the marketplace based on the existence of five registrations containing the word “wish” generally associated with retail services.

Surrounding Circumstance – Unlicensed Third-Party Use

[53] In its written representations, the Applicant requested an adverse inference be drawn against the Opponent due to the fact that Exhibit 1 of the Abramsky Affidavit, being a screenshot from the Google Play website for the Opponent’s WISH app, as the screenshot refers to Wish Inc. and not the Opponent [para 18]. The Applicant further notes that there is no indication that Wish Inc. is controlled by the Opponent within the scope of section 50(1) of the Act or otherwise.

[54] Even if I were to conclude that the Abramsky Affidavit contains evidence of unlicensed third-party use of the Opponent’s WISH Trademarks, I do not consider evidence of one webpage screenshot to be sufficient to draw a meaningful adverse inference against the Opponent. Further, even if I were to draw an adverse inference against the Opponent based on the Abramsky Affidavit, it would be insufficient to materially affect my conclusion in this case given that there is no evidence as to the extent or duration of

the third-party use [see *MEXX International B V v NBC Fourth Realty Corp*, 2003 CanLII 71215 (CA TMOB) for similar reasoning].

Conclusion in Respect of Confusion

[55] Having considered all of the surrounding circumstances, I find that the Applicant has failed to meet its legal burden, on a balance of probabilities, regarding the likelihood of confusion as to the source of the parties' goods and services. I reach this conclusion due to the overlapping, if not identical goods, services, business and trades of the parties, the length of time the Opponent's WISH Trademarks have been in use in Canada and the extent they have become known, in conjunction with the notable resemblance between the Opponent's WISH Word Marks and the Mark.

[56] This ground of opposition is therefore successful.

Section 16(1)(a) – Non-Entitlement

[57] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark as, at the filing date of the application, the Mark was confusing with the Opponent's WISH Trademarks that had been previously used and/or made known in Canada.

[58] The material date for this ground is the filing date of the application, namely, November 6, 2018.

[59] While the earlier material date for this ground necessarily reduces the length of time of use and extent known of the Opponent's WISH Trademarks discussed above under the section 12(1)(d) ground, both of these factors remain in favour of the Opponent. As my conclusion in respect of confusion is not materially affected by the earlier material date for this ground, I also find this ground of opposition successful.

Section 2 – Non- Distinctiveness

[60] The Opponent pleads the Mark is not distinctive within the meaning of section 2 of the Act because it does not actually distinguish nor is it adapted to distinguish the goods associated with the Mark from the Opponent's goods and services.

[61] The material date for this ground is the filing date of the opposition, namely, December 2, 2021 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

[62] Section 2 of the Act defines "distinctive" in relation to trademarks as follows:

"distinctive" in relation to a trademark, describes a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or that is adapted so to distinguish them.

[63] In order to meet its burden in respect of this ground, the Opponent must show that, as of the material date, the reputation of its trademark prevents the Mark from being distinctive and the required level of use must be "substantial, significant" or constitute "sufficient reputation" in association with the relevant goods and services as of the material date [*Hilton Worldwide Holding LLP v Solterra (Hastings) Limited Partnership*, 2019 TMOB 133 citing *Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657].

[64] I am satisfied that the Opponent has provided sufficient evidence of use and advertisement of the WISH Trademarks in Canada, including annual transactions and revenue for the years 2014 to 2022 and annual advertising figures for the years 2017 to 2022, to meet its evidentiary burden for this ground of opposition.

[65] As the determination of this ground also rests upon the assessment of the likelihood of confusion between the trademarks at issue, and the earlier material date for this ground does not affect my conclusion set out under the section 12(1)(d) ground, I find that this ground of opposition is also successful.

Remaining Grounds of Opposition

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

DISPOSITION

[67] 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.

Leigh Walters
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

The Opponent's Trademark Registrations

Trademark	Registration 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 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-downloadable software enabling users to track selections and purchases of products and services related to gift lists and gift registries. computer services, namely,</p>
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		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
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Appearances and Agents of Record

HEARING DATE: 2024-04-04

APPEARANCES

For the Opponent: James Green

For the Applicant: No one appearing

AGENTS OF RECORD

For the Opponent: Gowling WLG (Canada) LLP

For the Applicant: Sander R. Gelsing (Warren Sinclair LLP)