



REPORT FOR ACTION WITH CONFIDENTIAL ATTACHMENT

Request for Additional Funds: McCarthy Tétrault LLP

Date: July 5, 2021

To: Board of Directors, Toronto Parking Authority

From: President, Toronto Parking Authority

Wards: All

REASON FOR CONFIDENTIAL INFORMATION

The attachment to this report pertains to litigation involving Toronto Parking Authority (TPA) and contains advice that is subject to solicitor-client privilege.

SUMMARY

This report seeks authority from Toronto Parking Authority (TPA) Board of Directors to amend Purchase Order No. 4500000717 issued to McCarthy Tétrault LLP (McCarthy) for legal services related to TPA's opposition of trademarks proposed to be registered in Canada by Parkmobile International Holding B.V. (Parkmobile).

The trademarks, which Parkmobile is seeking to register are similar to the signs and symbols used by TPA, are protected as registered trademarks or as official marks under Section 9 of the Trademark Act. McCarthy commenced an opposition to all five (5) Parkmobile advertised applications on February 22, 2019, September 20, 2019, and June 28, 2021 (as detailed under *Confidential Attachment 1*).

TPA is seeking authority to increase the Purchase Order issued to McCarthy by more than 20 percent, which under TPA Policy Resolution 5-10: Delegation of Authority, requires the authority of TPA Board of Directors.

RECOMMENDATIONS

The President, Toronto Parking Authority (TPA) recommends that:

1. TPA Board of Directors adopt the confidential instructions to staff set out in *Confidential Attachment 1*; and

2. TPA Board of Directors direct that the confidential information contained in *Confidential Attachment 1* remain confidential in its entirety, as it pertains to litigation involving TPA and contains advice which is subject to solicitor-client privilege.

FINANCIAL IMPACT

The financial implications are discussed in the confidential attachment.

DECISION HISTORY

There has been no previous report to TPA Board of Directors regarding this intellectual property matter involving Parkmobile International Holding B.V.

COMMENTS

Background

All signs and symbols used by TPA are protected under Section 9 of the Trademark Act which states the following:

No person shall adopt in connection with a business, as a trade mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for:

(n) any badge, crest, emblem or mark

(iii) adopted and used by any public authority in Canada as an official mark for wares or services,

in respect of which the Register (of Trademarks) has, at the request of... the.... public authority... given public notice of its adoption and use.

TPA Policy Resolution 3-12: Use of Parking Authority Trademarks and Symbols, addresses Section 9 official marks however, TPA also owns a number of ordinary registered trademarks, which are not the subject of Section 9 applications. A list of all of TPA's Official Marks and Registered Trademarks are detailed under *Attachment 1*.

Additional information is included in *Confidential Attachment 1*.

CONTACT

Jeffrey Dea, Vice President, Business Development, Toronto Parking Authority,
437-243-6545, Jeffrey.Dea2@toronto.ca

Gregory Blyskosz, Manager, Parking Client Services, Toronto Parking Authority,
416-450-2000, gblysko@toronto.ca

SIGNATURE

W. Scott Collier, President,
Toronto Parking Authority

ATTACHMENTS



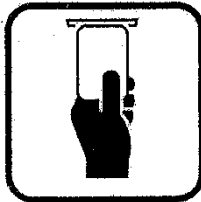




Confidential Attachment 1 - Confidential Information






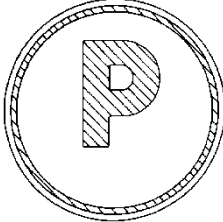
Attachment 1 - Toronto Parking Authority Official Marks and Registered Trademarks

ATTACHMENT 1


Toronto Parking Authority Official Marks and Registered Trademarks

Toronto Parking Authority Official Marks


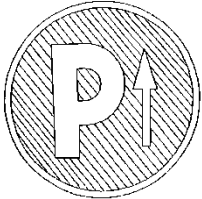
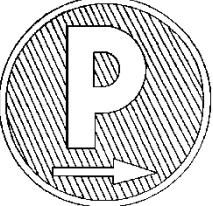
| Trademark | Design |
|---|--|
| App 907006 AUTOEXPRESS | N/A |
| App 907005 AUTOEXPRESS & DESIGN |  |
| App 923937 BIKE SHARE TORONTO & Design |  |
| App 923936 CARD Pictogram |  |
| App 923933 ELECTRIC VEHICLE CHARGING & Design |  |
| App 915550 FAST TRACK | N/A |
| App 915549 FAST TRACK & Design |  |
| App 915548 FAST TRACK & Design |  |
| App 915551 FAST TRACK & Design (colour) |  |
| App 923934 GREEN P | N/A |

| Trademark | Design |
|---------------------------------------|--|
| App 924655 IT STARTS HERE | N/A |
| App 923935 MOBILE DEVICE Pictogram |  |
| App 903893 P & DESIGN |  |
| App 903894 P & DESIGN |  |
| App 903221 P & DESIGN |  |
| App 903222 P & DESIGN |  |
| App 901604 P & DESIGN |  |

| Trademark | Design |
|---|--|
| App 901605 P & DESIGN |  |
| App 901606 P & DESIGN |  |
| App 901607 P & DESIGN |  |
| App 913621 P DESIGN LEFT ARROW (black & white) |  |
| App 913620 P DESIGN LEFT ARROW (colour) |  |
| App 913622 P DESIGN RIGHT ARROW (black & white) |  |
| App 913623 P DESIGN RIGHT ARROW (colour) |  |
| App 907951 PEDAL 'N PARK | N/A |

| Trademark | Design |
|--------------------------------------|--|
| App 907952 PEDAL 'N PARK & DESIGN |  |

Toronto Parking Authority Registered Trademarks

| Trademark | Design | Goods and Services |
|---|--|--|
| Reg TMA494383 WITH THE CONVENIENCE OF RAPID PARK DESIGN | WITH THE CONVENIENCE OF  | (1) Equipment used in the operation of motor vehicle parking facilities, namely ticket dispensers, and coding terminals, point of sale cashier terminals, traffic control barrier gates, pay and display machines, access card readers, access cards, vehicle detectors, vehicle count systems, slide and swing gate operating mechanisms, and pay on foot stations. (1) Management, operation, maintenance, and servicing of motor vehicle parking facilities. |
| Reg TMA466811 PEDAL 'N PARK | N/A | (1) Operation of a parking facility. |
| Reg TMA300438 P & DESIGN |  | (1) Construction, maintenance, control operation and management of municipal parking facilities. |
| Reg TMA292150 P & DESIGN |  | (1) Parking signs, parking tickets and parking stamps. (1) Construction, maintenance, control, operation and management of municipal parking facilities. |