

**IN THE MATTER OF AN OPPOSITION  
by Darrell Lee Waltrip to application No.  
1159622 for the trade-mark BOOGITY  
BOOGITY BOOGITY filed by Boogiddy  
Boogiddy Racing Inc. (now standing in the  
name of Richard Poulin)**

On November 20, 2002, Boogiddy Boogiddy Racing Inc., (the “Applicant”) filed an application to register the trade-mark BOOGITY BOOGITY BOOGITY (the “Mark”) based upon proposed use of the Mark in Canada in association with wares and services. The statement of wares and services currently reads:

**Wares:**

Clothing, namely, baseball caps, t-shirts, sweatshirts, jackets, trousers, shorts, scarves, headbands and children's bibs; toys and sporting goods, namely, model cars, die-cast cars, stuffed animal toys, gym bags; printed materials, namely, posters and playing cards; jewellery; sunglasses, drinking cups, decorative magnets and mouse pads.

**Services:**

Retail sale of baseball caps, t-shirts, sweatshirts, jackets, trousers, shorts, scarves, headbands, children's bibs, model cars, die-cast cars, stuffed animal toys, gym bags; posters, playing cards, jewellery, sunglasses, drinking cups, decorative magnets and mouse pads.

On February 25, 2003, the Mark was assigned to Richard Poulin.

The application was advertised for opposition purposes in the Trade-marks Journal of April 7, 2004.

On June 7, 2004, Darrell Lee Waltrip (the “Opponent”) filed a statement of opposition against the application. The Applicant filed and served a counter statement, in which it denied the Opponent’s allegations.

The Opponent’s evidence consists of the affidavits of Darrell Lee Waltrip, Robert Weiss and Van Colley. Although the Applicant requested an order for the cross-examination of each of these affiants, the Applicant decided not to proceed with the cross-examinations. Further, the

Applicant did not file any evidence.

Only the Opponent filed a written argument. Neither party requested an oral hearing.

### **Summary of Opponent's Evidence**

In the present case, the evidence furnished by the Opponent establishes the following:

- Darrell Lee Waltrip has been a broadcast analyst and commentator for FOX Sports Network since 2001, before which he was a professional NASCAR sports car racer
- in the spring of 2002, he coined the expression BOOGITY BOOGITY BOOGITY at the start of a NASCAR race, and has announced this phrase continuously on Fox Broadcast programs at the start of all races during the NASCAR regular seasons
- Mr. Waltrip has been referred to as Mr. Boogity Boogity Boogity or Boogity Man by fans and other NASCAR commentators, and in various magazine articles and sports news including Sports Illustrated and Fox Sports
- since February, 2001, NASCAR and/or NDE (Nascar Digital Entertainment, LLC) has been licensing for broadcast in Canada NNCS (the Nascar Nextel Cup Series) and NBS (Nascar Busch Series) including without limitation Nascar broadcasts produced by Fox
- TSN and Rogers Sportsnet, Canadian broadcasters, are licensed by NASCAR and/or NDE to air the Fox Race Broadcasts in Canada
- the Fox Race Broadcasts airing in Canada via Fox and the same NNCS and NBS races broadcast by TSN and Rogers Sportsnet are similar to those airing in the U.S. via Fox, featuring regular appearances by Darrell Lee Watrip as the analyst and commentator and his announcement of the phrase BOOGITY BOOGITY BOOGITY at the start of each such race;
- between Canadian broadcasters and the carriage of U.S. NNCS and NBS race broadcasts in Canada via compulsory licensing, most NNCS and several NBS races are broadcast in Canada; as a result, at the date of Mr. Weiss' affidavit (i.e. August 2,

2005, the Fox Race Broadcasts were broadcast to more than 8 million households in Canada.

- since the early spring of 2002, Darrell Waltrip Motosports, Inc. and Boogity Brands, LLC (companies owned by the Opponent), have marketed and sold a variety of merchandise goods under the BOOGITY trade-mark through their on-line store at [www.DWStore.com](http://www.DWStore.com)
- since its first sale, the gross revenue from sales of goods of the Opponent's mark has been in excess of US\$400,000
- sales of merchandise in Canada, including a variety of items bearing the BOOGITY mark, have been made through the Opponent's on-line store since as early as March, 2004; representative invoices showing the sales of merchandise to Canadians through the website is attached as Exhibit E to the affidavit of Mr. Colley
- Darrell Waltrip is the owner of Canadian Trade-mark Application No. 1,242,359 for the mark BOOGITY BOOGITY BOOGITY
- the popularity of Darrell Waltrip and his signature phrase has been referenced in several website articles, interviews and fan commentary
- a DVD entitled "Darrell Waltrip: His Passion Beyond the Wheel" is available for sale to Canadians through the Chapters website; the phrase BOOGITY BOOGITY BOOGITY appears on the cover of such DVD
- NASCAR races are widely viewed in Canada, and that as of 2005, there was an estimated 5.8 million NASCAR fans in Canada.

Sections 12(1)(e) and 9(1)(k)

As its third ground of opposition, the Opponent pleads that the Mark is not registrable pursuant to Section 12(1)(e) of the *Trade-Marks Act*, R.S.C. 1985, c. T-13 ("the Act"), and is prohibited by Section 9(1)(k) in that the Mark falsely suggests a connection with the Opponent, a living individual, who is a famous race car driver and sports announcer.

The relevant sections read as follows:

12(1) Subject to section 13, a trade-mark is registrable if it is not

(e) a mark of which the adoption is prohibited by section 9 or 10

9(1) 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,

.....

( k ) any matter that may falsely suggest a connection with any living individual . . .

Relying on the decision in *Bousquet v. Barmish, Inc.* (1991), 37 C.P.R. (3d) 516 (F.C.T.D.), the Opponent argued that the relevant date for considering this issue is the date of adoption of the Applicant's Mark. I respectfully disagree. In my view, the relevant date for considering this issue is the date of my decision (see *Villeneuve v. Mazsport Garment Manufacturing Inc.* (2005), 50 C.P.R. (4<sup>th</sup>) 127 at 148 (T.M.O.B.)). Regardless of which date is used, the outcome of this ground would be the same.

While there is a legal burden on the Applicant to establish that its Mark is registrable and that its adoption is not prohibited by s.9(1)(k), there is an evidential burden on the Opponent to adduce sufficient evidence from which it may be concluded that the phrase BOOGITY BOOGITY BOOGITY is so identified with Darrell Lee Waltrip that the adoption and use of the Mark by the Applicant would be likely to lead to the inference that the wares and services are somehow connected to Darrell Lee Waltrip.

In the present case, the evidence shows that NASCAR races are widely viewed in Canada, and are enjoying a growing popularity in Canada. While it can be assumed that many fans have heard the signature phrase "BOOGITY BOOGITY BOOGITY" at the start of a race, it has not been shown that a significant number of Canadians would associate this phrase with Darrell Waltrip, or would even know who Darrell Waltrip is by name. In this regard, although Mr. Colley attached copies of webpages featuring articles, interviews and fan commentary demonstrating the

popularity of Darrell Waltrip and his signature phrase, the Opponent provided no evidence regarding the number of Canadians who may have accessed these websites or read these articles. While Mr. Waltrip states that he has been nicknamed “Mr. Boogity” by various sport news and article writers who interviewed him for magazines and sports news including Sports Illustrated and Fox Sports, copies of such articles have not been provided. Finally, while the Opponent has marketed and sold merchandise in Canada through its on-line store since as early as March, 2004, sales figures for the amount of items sold in Canada bearing the mark BOOGITY BOOGITY BOOGITY were not provided, nor was any information provided regarding the number of Canadians who have visited the website.

The present case can be distinguished from *Carson v. Reynolds* (1980), 49 C.P.R. (2d) 57 (F.C.T.D.), wherein there was evidence that The Tonight Show had been available to Canadian viewers since its inception in 1962. The number of Canadian viewers each night, from the spring of 1970 to the fall of 1975 ranged from 74,600 to 262,300. Further there was survey evidence that more than one half of those Canadians questioned associated the words “Here’s Johnny” with Johnny Carson.

It can also be distinguished from *Villeneuve v. Mazsport, supra*, wherein the Applicant provided, *inter alia*, evidence regarding Jacques Villeneuve Junior’s reputation as an internationally known race car driver, evidence of various wares sold in Canada bearing Villeneuve’s name, and copies of over 1,000 articles published in well known Canadian newspapers between 1990 and 1998 that referenced Jacques Villeneuve Junior. From the evidence furnished in that case, the Board Member was satisfied that Jacques Villeneuve Jr. had a significant reputation as a race car driver among the Canadian public such that the trade-marks JACQUES VILLENEUVE RACING or JACQUES VILLENEUVE SPORTS would suggest a connection with him.

In view that the evidence furnished in the present case is insufficient to establish a significant public reputation for Darrell Waltrip in Canada, I am not satisfied that the average person buying a BOOGITY BOOGITY BOOGITY product or service would assume the product or service was somehow connected with Darrell Waltrip. This ground of opposition is therefore unsuccessful.

### Section 16(3)(a) Ground of Opposition

The Opponent has also pleaded that the Applicant is not the person entitled to registration pursuant to s. 16(3)(a) on the basis that the Mark is confusing with the mark BOOGITY BOOGITY BOOGITY, which had been previously used and/or made known in Canada by the Opponent in association with entertainment services and in association with promotional wares (including, inter alia, clothing, jewellery, printed matter pertaining to auto racing, glasses and event flags).

With respect to this ground of opposition, there is an initial burden on the Opponent to evidence use and/or making known of its trade-mark prior to the Applicant's filing date and non-abandonment of its mark as of the date of advertisement of the Applicant's application [s. 16].

Use of the mark has not been shown prior to the relevant date in association with wares. The Opponent did not begin selling BOOGITY merchandise in Canada until March 2004, which is after the relevant date.

With respect to services, sample recordings of Mr. Waltrip announcing the expression BOOGITY BOOGITY BOOGITY were attached as Exhibit F to the affidavit of Mr. Colley. However, aside from a hand-made sign shown by a fan in the audience, the phrase "BOOGITY BOOGITY BOOGITY" was not displayed in the performance of these broadcasts. Use has therefore not been shown of the Mark in accordance with s.4(2) of the Act. This ground therefore remains to be determined on the basis of the Opponents' alleged prior making known of its trade-mark in Canada in association with wares and services.

Considering the Opponent's allegation relating to its alleged prior making known of its trade-mark in Canada, Section 5 of the Act provides as follows:

5. A trade-mark is deemed to be made known in Canada by a person only if it is used by that person in a country of the Union, other than Canada, in association with wares or services, and
  - (a) the wares are distributed in association with it in Canada, or

- (b) the wares or services are advertised in association with it in
  - (i) any printed publication circulated in Canada in the ordinary course of commerce among potential dealers in or users of the wares or services, or
  - (ii) radio broadcasts ordinarily received in Canada by potential dealers in or users of the wares or services,and it has become well known in Canada by reason of the distribution or advertising.

In other words, the Opponent is obliged, as a matter of law, to show that its mark had been “made known” and had become “well known” by the specific means set out in s.5: see *Valle's Steak House v. Tessier* (1980), 49 C.P.R.(2d) 218 at pp. 224-5 (F.C.T.D.), and see *Motel 6 Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R.(2d) 44 at p. 56 (F.C.T.D.). It follows that a mark which becomes well known in Canada by means of word of mouth, or through newspaper or magazine articles (as opposed to advertising) is not a mark that has been "made known" in Canada within the meaning of s.5: see *Motel 6, supra*, at page 59, where this distinction is made.

While merchandise bearing the Opponent’s mark has been offered for sale in the U.S. through the Opponent’s on-line store since the spring of 2002, there is no evidence that this merchandise was advertised in any printed publication circulated in Canada or on radio broadcasts ordinarily received in Canada such that it has become known in Canada by reason of such advertising. I am therefore not satisfied that the Opponent’s mark was made known in association with wares in Canada prior to the material date.

With respect to the evidence showing the use of the phrase BOOGITY BOOGITY BOOGITY at the start of NASCAR races broadcast in Canada, the reference to Mr. Watrip and his signature phrase in various magazine articles and sports news, and reference to Mr. Waltrip in various website articles describing NASCAR’s growing popularity in Canada, I am able to infer that some Canadians would have associated the phrase BOOGITY BOOGITY BOOGITY with entertainment services, namely the provision of sports broadcast commentary via television. However, neither the reference to the phrase BOOGITY BOOGITY BOOGITY during a sports broadcast, nor the references to the phrase in website and magazine articles qualify as advertising. Thus, I am not satisfied that the Opponent’s mark has become “made known” in Canada within the meaning of section 5 of the Act. As I therefore find that the Opponent has

not met its burden under Sections 16(5) and 17(1) of the Act in relation to this ground, this ground of opposition is not successful.

Section 38(2)(d) Ground of Opposition

The Opponent has also pleaded that the Mark is not capable of being distinctive of the Applicant, nor was it adapted to distinguish the goods and services of the Applicant from those of others, and particularly those of the Opponent. Specifically, the Opponent's continuous use of the signature phrase BOOGITY BOOGITY BOOGITY at the start of NASCAR races, and the Opponent's use of BOOGITY BOOGITY BOOGITY as a trade-mark in both Canada and the U.S. in association with clothing, jewelry, printed matter pertaining to auto racing, glasses, event flags, and other wares, has resulted in BOOGITY BOOGITY BOOGITY being distinctive of the Opponent in the minds of the Canadian public.

In order to meet its evidential burden with respect to this ground, the Opponent must show that, as of the filing of the opposition, its trade-mark had become known sufficiently to negate the distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.); and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)]. As noted in *Motel 6*, supra, at p.58:

“A trade mark can neither distinguish nor be adapted to distinguish the services of a person if another person has used the mark in a foreign country and it has become known in Canada as the latter's mark in respect of similar services. On the issue of lack of distinctiveness of a mark, although it must be shown that the rival or opposing mark must be known to some extent at least, it is not necessary to show that it is well known or that it has been made known solely by the restricted means provided for in s. 5, supra. It is sufficient to establish that the other mark has become known sufficiently to negate the distinctiveness of the mark under attack.”

All relevant evidence which tends to establish non-distinctiveness may be considered. In other words, the opponent may rely on television broadcasts, website articles, etc. to establish that the Opponent's BOOGITY BOOGITY BOOGITY mark acquired a reputation in Canada. In view of the evidence of Mr. Waltrip, Mr. Weiss and Mr. Colley, I am satisfied that the Opponent's



mark has become known in Canada by the material date to the extent necessary to support the ground of opposition alleging non-distinctiveness of the applied for mark.

In view of the above, the legal burden is on the Applicant to satisfy the Registrar that its Mark is adapted to distinguish its wares and services throughout Canada. In considering the issue of distinctiveness, it is useful to assess whether there would have been a reasonable likelihood of confusion between the marks within the scope of s.6(2) and s.6(5) of the Act, as of the date of opposition.

*Test for confusion*

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. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; b) the length of time each has 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 or trade-names 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 C.P.R. (4<sup>th</sup>) 321 (S.C.C.) and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltee* (2006), 49 C.P.R. (4<sup>th</sup>) 401 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

*s.6(5)(a) – inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known*

Both parties' marks are inherently distinctive in relation to their respective wares and services. As of the material date, the Opponent's mark had become known to some extent in Canada in association with entertainment services. Since the Applicant did not provide evidence of use of its Mark, I cannot conclude that its Mark has become known to any extent.

*s.6(5)(b)-the length of time each trade-mark has been in use*

The length of time the marks have been in use favours the Opponent.

*s.6(5)(c) and (d)-the nature of the wares, services or business; the nature of the trade*

The Applicant's wares include various types of clothing, toys and sporting goods, printed materials; jewellery; sunglasses; drinking cups; decorative magnets; mouse pads and the Applicant's services include the retail sale of such items. By the relevant date, the Opponent's mark had been made known in association with the provision of sports broadcast commentary via television and had begun to be used in Canada in association with promotional wares. There is some overlap between the parties' wares. Further, as the Opponent's entertainment services are commonly promoted through the use of promotional wares of the type found in the Applicant's application, the parties' channels of trade could also overlap.

*s.6(5)(e) – degree of resemblance between the marks*

The parties' marks are identical in all respects.

*Conclusion re: likelihood of confusion*

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the overlap in the parties' wares and channels of trade, and the fact that the parties' marks are identical, I find that the Applicant has failed to meet the legal burden upon it to show that, on a balance of probabilities, confusion between the marks was unlikely as of the material date. That is, the use by the Applicant of the Mark BOOGITY BOOGITY BOOGITY in association with clothing, toys and sporting goods, printed materials; jewellery; sunglasses; drinking cups; decorative magnets; mouse pads, would likely have lead to the inference that these wares or services were manufactured, sold, leased, hired or performed by the Opponent. Accordingly, I find that the Applicant's Mark was not adapted to distinguish the wares and services of the Applicant from those of the Opponent at the filing date of the statement of opposition. This ground of opposition is therefore successful.

Section 30(i)

The Opponent's s.30(i) ground was pleaded as follows:

“Having regard to s.38(2)(a) of the Act, the application does not comply with the requirements of s.30(i) in that, contrary to the statement made in the application, the Applicant could not have been satisfied of its entitlement to use or register the trade-mark in Canada. Specifically, prior to the filing date of the application, the Applicant was aware, or should have been aware of the trade-mark BOOGITY BOOGITY BOOGITY which was created and widely used by the Opponent in Canada and the United States as a signature phrase during sports broadcasts on a Twentieth Century Fox Film television station Corporation...”

As pleaded, this is not a proper ground of opposition. The mere fact that the Applicant may have been aware of the existence of the Opponent's trade-mark does not preclude it from truthfully making the statement in its application required by s. 30(i) of the Act. The Opponent did not allege that the Applicant adopted its Mark knowing it to be confusing with the Opponent's mark. Thus, the first ground of opposition is unsuccessful.

Even if the ground had been properly pleaded, where an Applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the Applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. There is no such evidence in the present case.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the Applicant's application pursuant to s. 38(8).

DATED AT Gatineau, Quebec, THIS 25th DAY OF October, 2007.

Cindy R. Folz  
Member  
Trade-marks Opposition Board