



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

Reference: 2013 TMOB 128
Date of Decision: 22/07/2013
Translation

**IN THE MATTER OF THE OPPOSITION
submitted by Industries RAD Inc. against
registration application No. 1,445,957 for the
ATTITUDE trade-mark & Drawing in the
name of Martin B nard.**

Introduction

[1] This opposition relates to a registration application submitted by Martin B nard (the Requesting Party), No. 1,445,957, on July 24, 2009 for the trade-mark illustrated below:



This application is based on a use of the Mark in Canada since July 7, 2008. The wares covered by this registration application are:

Bicycle; tools, specifically Allen key, clamp, multifunction tool, bicycle pump and screwdriver (the Wares).

[2] The grounds of opposition raised by Groupe Procycle inc. (Procycle) which remain contested are those based on subsections 16(1), 12(1)(d) and 2 (distinctive character of the Mark) of the *Trade-marks Act* RSC 1985, ch. T-13. These grounds of opposition are described in more detail in Appendix A attached to this decision. I would

like to stress that the Opponent (defined below) has withdrawn its ground of opposition based on subsection 30(b) of the Act in its written argument.

[3] During the course of proceedings, Procycle assigned its rights to the ALTITUDE mark to Industries RAD Inc. (RAD), the mark which is the basis of this opposition. Accordingly, RAD has become the opponent. For the purposes of this decision, the term Opponent will be used to define indistinctively Procycle and RAD.

[4] First of all, I must determine whether the Opponent has met its initial burden of proof for each ground of opposition. If such is the case, I will have to decide whether the Mark, when used in association with each of the Wares, causes confusion with the Opponent's ALTITUDE mark.

[5] For the reasons described in greater detail below, I conclude that the Opponent has not met its initial burden of proof in regard to the ground of opposition based on subsection 16(1) of the Act. I conclude that the Mark is not registrable and is not distinctive, since it causes confusion with the Opponent's ALTITUDE mark.

The burden placed on the Parties

[6] It is initially for the Opponent to establish the well-foundedness of its opposition. However, the legal onus of showing that the Mark is registrable, that it is distinctive and that the Requesting Party has the right to register the Mark falls to the Requesting Party, according to the balance of probabilities [see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 CPR (3d) 293 (CF); and *Dion Neckwear Ltd. v. Christian Dior, SA et al.* (2002), 20 CPR (4th) 155 (FCA)].

Ground of opposition based on subsection 16(1)(a) of the Act

[7] The Relevant Date under this ground of opposition is the date of the first use of the Mark claimed in the registration application [see introductory paragraph to subsection 16(1) of the Act]. Accordingly, the Opponent has the initial burden of proving that it used the ALTITUDE mark within the meaning of subsection 4(1) of the Act prior to July 7, 2008.

[8] The Opponent's proof concerning use of the ALTITUDE mark can be summarized as follows: Mr. Dutil is and has been president of Procycle since 1977. Procycle also does business under the name Rocky Mountain Bicycles. Mr. Dutil claims that Procycle is the owner of the ALTITUDE mark in Canada registered under TMA429,690 and he submitted an excerpt from the trade-marks register. He claims that this mark has been used in association with bicycles since at least the month of July 1990. However, this statement must be proved with the support of documentary evidence.

[9] Mr. Dutil provided the sales figures for bicycles bearing the ALTITUDE mark in Canada for the years 2008-2009, 2009-2010 and 2010-2011 which vary between \$749,000 and \$986,000. He also provided the amounts invested in advertising during the same period for promoting the ALTITUDE mark, which vary between \$13,400 and \$28,750. However, we do not have the fiscal periods corresponding to these financial years. Since the Relevant Date is July 7, 2008, it is possible that the sales figures for the period 2008-2009 cover a period after the Relevant Date, such as October 1, 2008 to September 30, 2009. I therefore cannot take these sales figures into consideration.

[10] Mr. Dutil submitted various catalogues and brochures having been circulated in Canada between 1991 and 2011 to promote the bicycles bearing the ALTITUDE mark. However, the use of a trade-mark in promotional materials does not constitute a use of the mark within the meaning of subsection 4(1) of the Act [see *BMW Canada Inc. v. Nissan Canada Inc.* (2007), 60 C.P.R. (4th) 181 (FCA)].

[11] Mr. Dutil also submitted invoices related to the sale of bicycles bearing the ALTITUDE mark, the oldest of which goes back to October 2008, i.e. after the Relevant Date.

[12] Lastly, he submitted copies of articles printed in various magazines featuring the bicycle sold under the ALTITUDE mark. Once again, these articles do not testify to use of the ALTITUDE trade-mark within the meaning of subsection 4(1) of the Act.

[13] Based on this evidence, I cannot conclude that the Opponent has met its initial burden of proof. In the circumstances, the ground of opposition based on 16(1)(a) of the Act is rejected.

Ground of opposition based on subsection 12(1)d) of the Act

[14] This ground of opposition must be analyzed as at the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 CPR (3d) 413, on page 424 (FCA)].

[15] Mr. Dutil submitted an excerpt from the trade-marks register corresponding to registration TMA429,690 for the ALTITUDE mark covering bicycles. I checked the register and this registration is still in order. RAD is listed in the register as the current owner of this mark. The Opponent has therefore fulfilled its initial burden of proof.

[16] It is therefore incumbent on the Requesting Party to prove, according to the balance of probabilities, that the use of the Mark in relation to the Wares does not risk creating confusion with the ALTITUDE mark. The test to be applied to rule on this issue is stated in subsection 6(2) of the Act. I must take into account all relevant circumstances, including those listed in subsection 6(5): the inherent distinctive character of the trade-marks and the extent to which they have become known; the period during which the trade-marks have been in use; the type of wares, services or enterprises; the type of business; the degree of similarity between the trade-marks in their presentation or sound, or in the ideas they suggest.

[17] This list is not exhaustive, and it is not necessary to grant the same weight to each of these factors. The Supreme Court of Canada, in its ruling on *Masterpiece Inc. v. Alavida Lifestyles Inc. et al* 2011 SCC 27 interpreted subsection 6(2) of the Act and has enlightened us on the scope of the various criteria listed in subsection 6(5) of the Act. It stems from this analysis that the degree of similarity between the marks in dispute remains the most significant factor.

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

[18] The proof on file, through the affidavit of Mr. Singh, law intern at the Requesting Party's firm of agents at the time of his signature, shows that the marks in this case are words in both French and English, having the same meaning in both languages. Accordingly, the excerpts from English and French dictionaries submitted by Mr. Singh show us that we can define the word "attitude" as being a behaviour or a state of mind, whereas the word "altitude" refers to an elevation or a vertical distance. The Mark has therefore no meaning when used in association with the Wares. However, the ALTITUDE mark could, at most, be suggestive of one of the characteristics of the Opponent's bicycles, i.e. they can be used on mountains.

[19] I also note that the Mark includes a drawing. However, I do not consider this drawing to be a dominant element of the Mark. Overall, I consider that the Mark has an inherent distinctive character slightly superior to that of the ALTITUDE mark.

[20] The distinctive character of a mark can be heightened by its use and the extent to which it has become known in Canada.

[21] In regard to the Mark, the only proof of use of the Mark is limited to a statement by Mr. Walsh, a specialized bicycle salesman, to the effect that he knows the bicycles of the Requesting Party marketed under the Mark. This simple statement does not enable me to conclude that the Mark is known in Canada by Canadian consumers.

[22] Concerning use of the ALTITUDE trade-mark by the Opponent, I refer to the content of Mr. Dutil's affidavit. Although the proof described above may not be sufficient to establish use of the ALTITUDE mark before July 7, 2008, it is however enough to conclude that the ALTITUDE mark was better known at that time than the Mark. The sales figures since 2008-2009 and the amounts disbursed by the Opponent to promote its ALTITUDE mark are sufficient elements of proof to justify this conclusion.

[23] I must mention, as the agent of the Requesting Party pointed out to me during the hearing, that I have no proof of the scope of distribution of the various magazines in

which mention is made of bicycles bearing the ALTITUDE mark. I have therefore not taken into account these magazine excerpts in my assessment of the distinctive character of the ALTITUDE mark.

[24] Accordingly, overall, this factor slightly favours the Opponent due to its sales volume despite the Mark having an inherent distinctive character slightly superior to that associated with the ALTITUDE mark.

The period during which the trade-marks have been in use

[25] The proof shows that the Opponent has used the ALTITUDE mark in association with bicycles since at least October 2008, whereas I have no proof of the use of the Mark in Canada. This factor therefore favours the Opponent.

The type of wares and the nature of businesses

[26] It goes without saying that there is an overlap in wares in regard to bicycles. With regard to other wares, both parties, whether in their arguments or during the hearing, remained silent on this point. It appears quite clearly from the registration application that there exists a relationship between the bicycles and the tools identified in the application. For example, I refer to the bicycle pumps. It goes without saying that these are pumps for bicycle tires.

[27] A good portion of the argument during the hearing focused on the nature of the parties' businesses. In his affidavit, Mr. Walsh states that the sale of bicycles was achieved using a specialized salesman when the customer went to a bicycle retailer. Accordingly, this specialized salesman advises customers according to their needs. Mr. Walsh states that there are significant differences between a road bike and a mountain bike. The specialized salesman will therefore direct customers toward the type of bicycle appropriate for their needs.

[28] Mr. Walsh also states that bicycles bearing the Mark sell for approximately \$325 per unit whereas those of the Opponent bearing the ALTITUDE mark retail at over \$2,000 per unit.

[29] On the basis of these claims, the Requesting Party argues that by the very nature of the bicycle sales business, there can be no confusion, since the consumer will be advised by a specialized salesman. In addition, the difference between unit prices for the parties' bicycles is such that the customer will be able to distinguish the bicycles bearing the parties' trade-marks. The Requesting Party submits that to these two factors must be added the fact that the marks in this case have a totally different meaning. I will deal with this latter argument when I address the issue of the degree of similarity between the marks.

[30] Mr. Walsh does not mention that the only place where these bicycles can be purchased is at a bicycle retailer. In any event, the Requesting Party is on the wrong track when it tries to argue that there is less likelihood of confusion because consumers will be assisted by a specialized salesman during their purchase. The fact that consumers can obtain the assistance of a specialized salesman does not reduce the likelihood of confusion. In fact, the test I must apply is that of the average consumer, and not the latter assisted by a specialized salesman, having a vague memory of the ALTITUDE mark, and who sees a bicycle bearing the Mark. The true test is: will the consumer's first impression on contact with the Mark be that of believing that this bicycle originates from the same manufacturer as bicycles bearing the ALTITUDE mark [see *Masterpiece, supra, Henkel Kommanditgesellschaft Auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 CPR (3d) 110 on page 112 (FCA) and *Wolverine Outdoors Inc. v. Marker Völkl (International) GmbH*, 2012 TMOB 75].

[31] The value of the wares cannot be a factor for consideration when it is an issue of the same types of wares.

[32] From the names of businesses as they appear on the invoices produced by the Opponent, it appears that it sells its ALTITUDE mark bicycles to merchants specializing in the sale of bicycles. I have no proof regarding the nature of the Requesting Party's business. However, I can presume that it will sell, at the very least, its bicycles bearing the Mark to merchants of the same type as those who purchase the Opponent's bicycles.

[33] I conclude therefore that these factors favour the Opponent.

The degree of similarity between the trade-marks

[34] I recall that the Supreme Court of Canada, in its *Masterpiece ruling, supra* clearly indicated that the degree of similarity between the marks is the most important factor among those listed in subsection 6(5) of the Act.

[35] I have already indicated above that there is no doubt the marks are words whose meanings differ and it follows that the ideas suggested by these marks are different. However, from the visual and phonetic standpoint, the marks in this case are greatly similar to each other. I do not believe that the drawing portion of the Mark is so dominant that a consumer would come to identify the Mark solely by this drawing, which is limited to the use of a specific font and the circle around the letter “A.” I believe that the similarity, both phonetic and visual, takes predominance over the difference in the ideas suggested by these marks.

[36] The parties have referred several items of case law to me in support of their claims. I am duty bound to make several comments on this subject. The Requesting Party cited the ruling in *Anheuser-Busch Inc. v. Carling O’Keefe Breweries of Canada Ltd.* (1986), 10 CPR (3d) 433 (FCA). The Opponent cited, among others, the decision of the Registrar in *Sears Canada Inc. v. Latitude Men’s Wear Ltd.*, 2002 TMOB 136. It must be recalled that each case is a separate issue and will have been determined in the light of the evidence submitted.

[37] I have to make a comment on the Registrar’s decision in *Groupe Procycle Inc. v. Castello Cycle Company Ltd.*, [2012] TMOB 94 brought to my attention by the Opponent. This case concerns an opposition by the Opponent to the registration of the BIKE ATTITUDE mark on the basis of confusion with its ALTITUDE mark. The registrar concluded in a certain similarity, both visual and phonetic, between the words “attitude” and “altitude.” However, my colleague Andrea P. Flewelling, had clearly indicated and that she had to consider the marks overall. Accordingly, the fact that the word “attitude” is found in the BIKE ATTITUDE mark was not sufficient in itself to conclude that the marks had a significant degree of similarity in their appearance, the sound or the ideas suggested by the marks. However, in our case, there are no other

words added to the word “attitude” that would make it possible to distinguish the overall marks in this case.

Conclusion

[38] I conclude that the Requesting Party has not met its burden of proof according to the balance of probabilities that the Mark would not cause confusion with the Opponent’s ALTITUDE mark when used in association with the Wares. In effect, these wares, when it is an issue of “bicycles,” are the same as those of the Opponent covered by its registration certificate. As for the “tools,” there exists a connectivity between the latter and the “bicycles.” Furthermore, there exists great similarity, both phonetic and visual, between the marks. The accumulation of these factors in favour of the Opponent, even though the marks express different ideas, is such that I have a doubt regarding the absence of probability of confusion between these marks. This doubt must be interpreted in favour of the Opponent.

[39] This ground of opposition is therefore accepted.

Ground of opposition based on the absence of distinctive character of the Mark

[40] The relevant date generally accepted for this ground of opposition is the submission date of the Statement of Opposition (October 13, 2010) [see *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 CPR (4th) 317 (CFPI)].

[41] The Opponent has the initial burden of proving that its ALTITUDE trade-mark was sufficiently known in Canada on the Relevant Date such that the Requesting Party's Mark could not be distinctive. Certain elements of proof which could not be taken into consideration in analyzing the ground of opposition based on the right to the registration pursuant to subsection 16(1)(a) of the Act can be considered under this ground since the relevant date associated with this ground of opposition is after that related to the ground opposition based on subsection 16(1)(a) of the Act.

[42] Accordingly, the sales figures for bicycles bearing the ALTITUDE trade-mark must be taken into consideration. For the year 2008-2009, they amounted to almost \$750,000. In 2009-2010, they were approximately \$1 million. For the same period, Mr. Dutil provided the amounts disbursed on promoting and advertising bicycles bearing the ALTITUDE trade-mark. In total, during this period, the Opponent disbursed over \$46,000 to promote its mark.

[43] From this evidence, I conclude that the ALTITUDE trade-mark in association with bicycles was sufficiently known in Canada as at October 13, 2010 and thus the onus is placed on the Requesting Party which has a duty to show that the Mark was distinctive or at the very least able to distinguish the Wares from the Opponent's bicycles bearing the ALTITUDE mark.

[44] I open a parenthesis to stress that I intentionally omitted to take into consideration the excerpts of articles published in what appears to be specialized magazines in the field of cycling and covering the Opponent's ALTITUDE mark bicycles submitted by Mr. Dutil, since I have no information regarding the circulation of each of these magazines. I also did not take into account the Opponent's catalogues submitted in support of Mr. Dutil's affidavit, since I have no information regarding the number of copies distributed over the years.

[45] Accordingly, the Requesting Party has the legal onus of proving, according to the balance of probabilities, that the Mark would not cause confusion with the Opponent's ALTITUDE trade-mark on the Relevant Date such that the Mark truly distinguished the Wares from the Opponent's wares, or that it was able to distinguish them [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 CPR (3d) 272 (TMOB)].

[46] The relevant circumstances listed in subsection 6(5) of the Act are analyzed to determine whether the Mark distinguishes or is able to distinguish the Wares from the Opponent's wares. In the circumstances of this case, the fact that the analysis of these circumstances is made at a date prior to the Relevant Date under the preceding ground of opposition (registrability of the Mark under subsection 12(1)(d) of the Act) in no way

changes the result of my analysis. Accordingly, the conclusions described above for each of these factors are identical.

[47] In conclusion, I also accept this ground of opposition.

Decision

[48] In exercising the authority delegated to me pursuant to the provisions of subsection 63(3) of the Act, I reject the application in compliance with the provisions of subsection 38(8) of the Act.

Jean Carrière
Member of the Trade-marks Opposition Board
Canadian Intellectual Property Office

Traduction certifiée conforme
Alan Vickers

Appendix A

The grounds of opposition contained in the Opponent's amended Statement of Opposition are based on:

1. Subsections 38(2)(a) and 30(b) of the *Trade-marks Act*, RSC 1985, ch. T-13 ("Act") in that the registration application does not satisfy the requirements of the Act. In particular, the Requesting Party had not used the Mark in Canada in association with the Wares since July 7, 2008;
2. Subsections 38(2)(b) and 12(1)(d) of the Act in that the Mark is not registrable, since it causes confusion with the Opponent's ALTITUDE mark bearing registration No. TMA429,690 for use in association with bicycles;
3. Subsections 38(2)(c) and 16(1)(a) of the Act in that the Requesting Party is not the person having entitlement to the registration since at the date of submitting this registration application the Mark caused confusion with the Opponent's ALTITUDE mark previously used in Canada in association with bicycles;
4. Subsections 38(2)(d) and 2 of the Act in that the Mark is not distinctive in that it cannot truly distinguish the Wares from products of other persons, specifically products in association with which the Opponent's ALTITUDE mark has been used in Canada, specifically bicycles.