

**IN THE MATTER OF AN OPPOSITION  
by Danny Alex to applications Nos.  
1,103,151 and 1,153,018 for the trade-mark  
RAW filed by World Wrestling Federation  
Entertainment Inc.**

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On May 22, 2001, World Wrestling Federation Entertainment Inc. (the “Applicant”) filed an application to register the trade-mark RAW based upon use in Canada since the dates indicated, in association with the following wares and services:

wares:

(1) since October 4, 1994: paper products, namely, magazines relating to sports entertainment, comic books, event programs relating to sports entertainment, calendars, decals, stickers, posters, mounted and unmounted photographs, pictures, cardboard [sic] stand-ups, paper lunch sacks, napkins, trading cards, playing cards, collector cards, and colouring and activity books; printed matter, namely brochures, newsletters relating to wrestling; photographs; stickers, trading cards, decals, tattoo [sic] transfers, pre-recorded compact discs in the area of wrestling exhibitions, video games, bendable toys, all of the aforementioned related to wrestling

(2) since May 31, 1996: publications, namely magazines

services:

(1) since October 4, 1994: entertainment services, namely the production and presentation of live, televised and recorded wrestling exhibitions

(2) since January 31, 1997: entertainment services in the nature of providing on-line information in the field of wrestling via a global communications network.

The application was assigned serial number 1,103,151 and is hereinafter referred to as “Application 151”.

On September 18, 2002, the Applicant filed another application to register the trade-mark RAW, which was assigned serial number 1,153,018 (“Application 018”). Application 018 is based upon proposed use of the Mark in Canada in association with the following wares:

(1) magnets, electronic toys, namely, electronic toy vehicles, radio controlled

vehicles, handheld electronic games, voice synthesizers, walkie-talkies and electronic returning tops; computer software, namely, personal interactive desktop ("PID") software delivered via the Internet; cinematographic and television films; pre-recorded records; pre-recorded audio and visual tapes; pre-recorded video tapes and cassettes; pre-recorded audio-cassettes; pre-recorded tapes; coin-fed amusement gaming machines; cartridges; digital cameras with CD-ROM; mouse pads; disposable cameras; sunglasses; sunglass cases; sunglass cords; prescription glasses; optical cases

(2) full line of clothing, namely, tops, t-shirts, shirts, sweatshirts, sweaters, pullovers, blouses, jackets, coats, trousers, pants, jogging suits, exercise pants, exercise suits, sweatpants, shorts, underwear, boxer shorts, socks, clothing ties, pajamas, belts, gloves, Halloween and masquerade costumes, wrist bands, bandannas; footwear, namely, shoes, socks, sneakers, boots; headgear, namely, hats, caps

(3) toy action figures; toy action figure accessories; cases for action figures; toy vehicles; toy miniature dolls; board games; toy spinning tops; arcade games related to wrestling; pinball games and machines related to wrestling; hand-held units for playing electronic games; tabletop action skill games related to wrestling; jigsaw puzzles; kites; toy wrestling rings; dolls; puppets; stuffed toy animals; aerodynamic flying discs for use in playing catching games; card games; bean bag bears; electronic toy guitars; water guns; vinyl pool products, namely, pillow back lounge chair; one and two-man inflatable boats; jet skis; rafts; inner tubes; and foot pumps; Christmas lights; toy rockets; cases for toy vehicles; action figure clothing; collectible toy figures; costume masks; doll furniture; porcelain dolls; fantasy character toys; party favours in the nature of crackers and noisemakers; skateboards; bowling balls; windup toys; scooters; bowling pins; helmets; knee and elbow pads; walkie talkies; returning tops with lights and sounds; remote control robots; face painting sets; plastic model kits; inflatable pools; bowling accessories, namely, wrist bands, bowling gloves, ball cleaning kits, wrist supports, bowling ball bags and pool cues; Christmas stockings; tin carrying cases for play accessories; tin money banks; gum machines; candy bowl mechanical dispensers; stick gum dispensers; gum figure maker.

Application 018 is also based upon use and registration of the Mark in the United States of America in association with the following wares and services:

wares:

printed paper matter, namely, magazines relating to sports entertainment, comic books, event programs relating to sports entertainment, calendars, decals, stickers, posters, mounted and unmounted photographs, pictures, cardboard stand-ups, paper lunch sacks, napkins, trading cards, playing cards, collector cards, and colouring and activity books

services:

entertainment services, namely production and presentation of live wrestling sports entertainment television programs.

Application 151 and Application 018 were advertised for opposition purposes in the Trade-marks Journal of February 26, 2003 and July 7, 2004, respectively.

On July 30, 2003, Danny Alex (the “Opponent”) filed a statement of opposition against Application 151. On August 25, 2004, the Opponent filed a statement of opposition against Application 018.

The Applicant filed and served a counter statement in support of each application, in which it denied the Opponent’s allegations.

The evidence in both opposition proceedings is essentially the same.

Pursuant to r. 41 of the *Trade-marks Regulations*, the Opponent filed the following affidavits (with the indicated dates of signature):

- Danny Alex (July 21, 2003 re Application 151 and June 2, 2005 re Application 018),
- Christina Mee (July 21, 2003 re both applications),
- Kevin Wilson (July 22, 2003 re both applications),
- Jacqueline Chwartacki (July 23, 2003 re both applications).

The Applicant obtained orders to cross-examine Mr. Alex, Ms. Mee and Mr. Wilson and the transcripts of cross-examination have been filed (a single cross-examination of each affiant was done for both applications).

Pursuant to r. 42, the Applicant filed the following affidavits (with the indicated dates of signature):

- Carl DeMarco (May 18, 2005 re Application 151 and April 13, 2006 re Application 018),
- Sharon Elliott (May 19, 2005 re Application 151 and April 18, 2006 re Application 018).

Both parties filed written arguments. After the written arguments were exchanged, the Opponent sought leave pursuant to r. 44(1) to file further evidence, but leave was denied in the Office Letters dated February 14, 2008.

An oral hearing was held at which both parties made representations.

#### Grounds of Opposition

The grounds of opposition regarding Application 018 have been pleaded as follows:

- (1) Pursuant to s. 38(2) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”), the application does not conform with s. 30(i) of the Act, because the Applicant cannot accurately state in its application that it is entitled to use the applied for mark in association with the wares and services described in the Application.
- (2) Pursuant to s. 38(2)(b) of the Act, the Applicant’s proposed mark, “RAW” is not registrable because it is confusing with the Opponent’s registered mark, “IN THE RAW”, Registration Number TMA498,200, under s. 16(1)(a) of the Act, which registered mark has been previously been used and made known since at least as early as 1991 in Canada.
- (3) At the same time, the Applicant’s mark is not registrable pursuant to s. 37(1)(b) of the Act, which states that an applicant would not be the person entitled to registration of a trade-mark if it is not registrable, which the Opponent submits is the case with its trade-mark, TMA498,200, and pursuant to s. 37(3) the Applicant’s application has

- been deemed a 'doubtful case' by the Registrar, and should not be allowed to proceed.
- (4) Pursuant to s. 38(2)(c) of the Act, that the Applicant could not state that it was satisfied it was entitled to use the trade-mark in Canada in association with the wares and services described in its application.
  - (5) Pursuant to s. 38(2)(d) of the Act, the proposed mark cannot be deemed distinctive from the Opponent's registered mark. The Applicant's mark, "RAW" does not distinguish itself, nor can it be adapted to distinguish itself from the wares and services of the Opponent's registered mark, "IN THE RAW".

The grounds of opposition regarding Application 151 have been pleaded as follows:

- (1) Pursuant to s. 38(2)(a) of the Act, the application does not comply with the requirements of s. 30(i) of the Act, as the Applicant was aware at the time of its application that Danny Alex had registered TMA498200, and therefore, the Applicant could not have been satisfied that it was entitled to use its mark in Canada.
- (2) Pursuant to s. 38(2)(b) of the Act, the Applicant is not entitled to registration of its trade-mark "RAW" because under s. 16(3)(a) and (b) of the Act, the Applicant's mark is confusing with the Opponent's mark, "IN THE RAW", registered as TMA498200, which has been previously used and made known in Canada since as early as 1992, and registered as a trade-mark in Canada since July 1998.
- (3) Pursuant to s. 38(2)(d) of the Act, the proposed mark cannot be deemed distinctive from the Opponent's registered mark. The Applicant's mark does not distinguish itself, nor can it be adapted to distinguish itself from the wares and services of the Opponent's mark.

Although the pleadings in the two oppositions are not identical, it is clear that the main issue throughout is the likelihood of confusion between the Applicant's Mark, RAW, and the Opponent's mark IN THE RAW.

Parts of the pleadings are somewhat confused, for example: the fourth pleading re Application 018 should have referred to s. 38(2)(a), not (c), and is basically a duplication of the first ground;

and the second pleading re Application 151 refers to s. 38(2)(b) which deals with registrability but then discusses entitlement, which is properly pleaded under s. 38(2)(c). In the following, I have proceeded on the assumption that the Opponent has properly pleaded grounds of opposition with respect to both applications under each of s. 38(2)(a), (b), (c) and (d) as the Applicant seems to have accepted that in its counter statements.

### Material Dates

The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(a)/s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 38(2)(b)/s. 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(c)/s. 16(1) - the Applicant's date of first use [see s. 16(1)];
- s. 38(2)(c)/s. 16(2) - the filing date of the application [see s. 16(2)];
- s. 38(2)(c)/s. 16(3) - the filing date of the application [see s. 16(3)];
- s. 38(2)(d)/non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

### Onus

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. [*John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]

### Summary of Opponent's Evidence

#### *Danny Alex*

Mr. Alex is the owner of registration TMA498200. He attests that he has been using IN THE RAW since 1991 and that it first appeared on various promotional products that he used as a

professional dancer. He states that he referred to himself as both “In The Raw” and “Raw” and was promoted by agents to club owners as “In The Raw”. By 1992/93, the Opponent had begun work on a collection of songs and created an original demo CD entitled “In The Raw”, which resulted in a CD being released in June 1998. The Opponent mailed a copy of the demo tape to himself by registered mail on November 8, 1993, which he then gave unopened to his counsel. Mr. Alex has provided a number of exhibits concerning his activities with regard to his CD and related matters (Exhibits “B” through “K”); although these show that he was actively working on getting his CD and promotional materials together, they do not show use of IN THE RAW as a trade-mark pursuant to s. 4 of the Act, nor do they show that members of the general public were being exposed to the Opponent’s mark. Similar comments may be said about his Exhibits “M” and “N”.

Exhibit “L” is a press release dated March 3, 1998 concerning the Opponent and his IN THE RAW CD, which a publicist apparently used to promote the Opponent and his CD to radio stations for air play. Exhibit “R” includes a number of Tracking Status Reports from the same publicist dating from 1998 for a song (*Those Old Summer Nights*) from the Opponent’s IN THE RAW CD. This indicates that the song was played on a large number of Canadian radio stations; however, it is not clear that the Opponent’s trade-mark was mentioned on these radio stations and overall the information set out in the publicist’s report is inadmissible hearsay. The remainder of Exhibit “R” appears to be the Opponent’s own records concerning his efforts at promoting his music to Canadian radio stations during three weeks in 1998.

The Opponent’s IN THE RAW CD was released in 1998 in both a short and a long form; copies of packaging displaying IN THE RAW have been provided [Exhibits “O” and “P”]. No sales figures have been provided but it appears that no more than 500 CDs were produced (see page 19, cross-examination of Mr. Alex).

Mr. Alex attests that both of his CDs have received much exposure by way of advertising, Internet sales and reviews, as depicted in attachments provided as Exhibit “Q”. These materials are evidence of promotion of the CD, not evidence of use, and there is no evidence concerning

the numbers of Canadians who would have been exposed to the advertisements, websites, *etc.* introduced by Mr. Alex.

Although there is some evidence that the Opponent sold up to 75 videos, there is no evidence that IN THE RAW was associated with such videos when they were sold. (See Exhibits “T” and “J”, Alex affidavit, and page 28 of his cross-examination.)

Mr. Alex also provides the following details concerning his live performances:

- 7 performances in 1999 in Calgary;
- an unidentified number of performances in Calgary between February and December 2000;
- performances “on a consistent and regular basis” in Calgary from 1993-2001;
- performance in Kelowna, B.C. in August 2002;
- weekly performances “from June 18, 2002” in Kelowna;
- at two wedding receptions in the fall of 2002;
- weekly performances from July 3, 2003 to September 5, 2003 in Kelowna.

He provides his sale figures regarding some of these performances, as well as details of some sales of his CDs and T-shirts, together totalling \$4097 between February 13, 2001 and December 12, 2002 [Exhibit “T”].

He also provides copies of two advertisements “put up” with respect to the Kelowna performances; both refer to his trade-mark IN THE RAW in association with his CD and one refers to the “RAW” sounds of Danny Alex. [Exhibits “S” and “U”] He has not provided a photograph of the Opponent’s T-shirts, nor any associated labels or packaging.

At paragraph 27 of his affidavits, Mr. Alex attests, “I am also working in the planning stages with Dave Hamilton, the original producer of the CD, which was released in 1998, to remix and release the new version of the CD in mid-late 2004.” I note that this paragraph has not been updated in Mr. Alex’s second affidavit, even though it was executed at least six months after the anticipated release date.



I do not consider Mr. Alex's evidence concerning his future plans, his listing of one of his CDs for sale on eBay, or his personal views of the resemblance between the marks or the likelihood of confusion to be relevant or significant with respect to the issues in these proceedings. (I note that his attestation re listing his CD on eBay only appears in his affidavit re Application 018.)

*Chwartacki Affidavit*

Ms. Chwartacki used to work for the Opponent's parents. She attests that she first associated "IN THE RAW" with the Opponent when she saw his dance show in 1993 and that his performance was based on a "raw" theme in that he wore ripped jeans and danced to "raw" types of music such as hard rock and pop metal. She says that he was referred to as "IN THE RAW" and "RAW". She most recently heard him promoting IN THE RAW in late 2000 in Calgary.

*Christina Mee*

Ms. Mee, a professional entertainer, met the Opponent when they were both working in live stage performances, namely exotic dancing. She first associated "IN THE RAW" with the Opponent when she saw his dance show in 1993. Her affidavit is otherwise quite similar to that of Ms. Chwartacki.

On cross-examination, Ms. Mee (now Ms. Levagood) explained that the Opponent used the name IN THE RAW by being announced as Danny Alex In The Raw. (page 5, cross-examination)

*Kevin Wilson*

Mr. Wilson, a booking agent and musician, met the Opponent in 1991 when they were both in the entertainment industry or stripper business. He attests that Mr. Alex used the phrase "In The Raw" to market his show in late 1992 and was and is known as a "Raw" performer. Mr. Wilson provides his personal knowledge with respect to the creation of the IN THE RAW six-song CD. He last heard IN THE RAW being marketed by the Opponent in Kelowna in the summer of 2002 (on cross-examination, pages 6-7, he explained that the source for that information was Mr. Alex).

### Inconsistencies in Opponent's Evidence

The validity of the Opponent's registration is not at issue in these proceedings, but I need to address inconsistencies between the Opponent's registration and its evidence in order to assess the likelihood of confusion between the parties' marks.

The Opponent filed the application that issued to registration under No. TMA498200 on May 12, 1997 based on proposed use. The registration issued after a declaration of use was filed on July 15, 1998 for the following wares and services:

#### wares:

pre-recorded audio compact discs, audio cassette tapes and video cassettes; music videos; posters and photographs; key rings; clothing namely hats, caps, cowboy hats, T-shirts, tank tops, sweatshirts, sweatpants, shorts, pajamas, lingerie, jackets and coats; pens; pencils; erasers; flags; pennants; towels; blankets and sheets; license plates; notebooks and notepads; stickers; playing cards; school bags and knapsacks; computer mouse pads and computer software namely computer screen savers; watches; condoms.

#### services:

entertainment services namely the performance of live music concerts; audio and video recording and production services; composition of music for others; public appearances on behalf of others; and endorsement of products and services of others.

Despite this, Mr. Alex attested that:

- 1) he has been using IN THE RAW as a trade-mark since 1991 "when it first appeared on various promotional products that [he] used as a professional dancer" (paragraph 5, Alex affidavit) and
- 2) IN THE RAW has never been used in association with a number of the wares and services listed in his registration, in particular key rings, hats, caps, cowboy hats, tank tops, sweatshirts, sweatpants, shorts, pajamas, lingerie, jackets and coats, pens, pencils, erasers, flags, pennants, towels, blankets, sheets, license plates, notebooks, notepads, stickers, playing cards, school bags, knapsacks, computer mouse pads, computer software namely computer screen savers, watches, condoms and

endorsement of products and services of others (pages 32-36, cross-examination of Mr. Alex).

Based on 2), it appears that the declaration of use filed in support of the Opponent's registration contained incorrect or false information. The question remains however whether the trade-mark application also contained incorrect information (insofar as it relied solely on proposed use) or whether Mr. Alex's statement that he began use of his mark in 1991 is either not a reference to trade-mark use or is not a reference to use in association with any of the services covered by the application.

On cross-examination, Mr. Alex confirmed that in 1991 he was performing as a male exotic dancer (page 3, lines 22-24). When asked if such performances included singing, he replied, "Singing and the performance was very rare. ... In the time that we tried it, it became very confusing so I never pursued it to the extent that it was a real viable entertainment product." (page 4, lines 19-24) He further explained that IN THE RAW would have appeared primarily on picture promos that were posted in the strip bars and sometimes in newspapers. However, no examples have been provided of these early promotional photos. (Mr. Alex stated that he stopped performing as a male exotic dancer in 1995: page 4, cross-examination.)

Section 4 of the Act sets out when a trade-mark is deemed to be used:

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

Use by export

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

The only evidence that has been provided that "shows" trade-mark use of IN THE RAW in association with "entertainment services namely the performance of live music concerts" is dated

2002 or later (see Exhibits “S” and “T”, Alex affidavit). The earliest evidence that has been provided that “shows” trade-mark use of IN THE RAW in association with any wares is from 2001 (Exhibit “T”, Alex affidavit); that evidence takes the form of hand-written invoices made out for the sale of CDs and T-shirts to individuals, with the trade-mark appearing in the body of the invoices, which I am prepared to accept would have been given to the purchasers at the time of transfer of the wares. (No evidence has been provided that shows that the mark appeared directly on T-shirts, their labels or packaging. Although Mr. Alex did provide packaging for CDs that display IN THE RAW, on cross-examination it became evident that both pieces of packaging (Exhibits “O” and “P”) relate to shorter CDs, *i.e.* a 6-song version that was primarily used for promotion and forwarded to radio stations and the like, rather than the longer 11-song CD which was released for sale (pages 14-18, cross-examination). In addition, although Mr. Alex has attested that there were sales of videos (pages 29-30, cross-examination), there is no evidence that IN THE RAW was associated with the videos as required by s. 4; no invoices listing videos were provided and the labelling provided in Exhibit “J” does not display IN THE RAW.)

Much of the evidence concerning usage of IN THE RAW takes the form of statements by affiants; their references to the promotion of IN THE RAW (as well as RAW) may simply mean that the words IN THE RAW and RAW were used orally when promoting the Opponent. However, oral references to a trade-mark do not qualify as use of a trade-mark for either wares or services [see *Playboy Enterprises Inc. v. Germain* (1987), 16 C.P.R. (3d) 517 (F.C.T.D.) and *Waltrip v. Boogiddy Boogiddy Racing Inc.* (2007), 64 C.P.R. (4th) 357 (T.M.O.B.)].

For the foregoing reasons, I find that the evidence only supports the conclusion that the Opponent’s mark has been used as a trade-mark since 2002 in association with entertainment services and since 2001 in association with pre-recorded CDs and T-shirts. In this regard, I note that in *Park Avenue Furniture v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413, the Federal Court of Appeal indicated that non-use of a registered trade-mark is to be considered during the assessment of the likelihood of confusion under s. 6(5) of the Act.

## Summary of Applicant's Evidence

### *Carl DeMarco*

Mr. DeMarco is the President of World Wrestling Entertainment Canada, Inc. ("WWE Canada"), which is a wholly owned subsidiary of the Applicant. Mr. DeMarco states that WWE Canada is the exclusive distributor of the Applicant's products for Canada and a licensee of the Applicant.

The Applicant is a U.S. company that Mr. DeMarco states is associated in Canada and abroad with sports entertainment and specifically wrestling entertainment. It puts on live wrestling events that "are broadcast to fans in Canada and the U.S. primarily through two flagship television programs marketed in association with the trade-marks RAW and SMACKDOWN..." "The RAW television program made its debut live from the Manhattan Center in New York City on the USA Network on January 11, 1993...The subject matter of the show has remained constant – a two-hour weekly program presenting wrestling matches and the attendant elaborate backstage stories involving the wrestlers, managers, referees and commissioners." "The trade-mark RAW is prominently and consistently featured in the RAW television program and related WWE events and programs. The trade-mark RAW appears in opening and closing credits and on signs, banners and video screens on and around the wrestling ring."

Revenues generated by the Applicant with respect to the RAW television program in Canada from 2001-2005 ranged between 2.4 and 3.5 million dollars U.S. annually. From 1996-2005, the RAW television program is said to have attracted an average of over 34 million viewers per year in Canada.

The RAW mark is associated with "a wide range of products along the programs' wrestling themes" and these are sold in Canada through a number of large retail chains including Wal-Mart, Toys "R" Us, HMV, Zellers, Sears, Canadian Tire, Future Shop CD Plus, and Giant Tiger, as well as various independent retailers. Mr. DeMarco provides packaging for RAW DVDs and videogames available for sale at retailers in Canada.

RAW products are also available for sale in Canada through the Internet and Mr. DeMarco

provides evidence showing the following such wares that display the Mark: jigsaw puzzles; programs; video games; bracelets; T-shirts; DVDs; lanyard; coaster set; video cassette; magazine; poster.

RAW magazines are also circulated throughout Canada by retailers.

*Sharon Elliott*

Ms. Elliott, a law clerk employed by the Applicant's trade-mark agent, provides dictionary definitions of "in the raw" and particulars of three Canadian trade-mark registrations and one application for marks that incorporate the phrase "in the raw".

#### Section 30(i) Grounds of Opposition

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] As there is no such evidence in the present case, the s. 30(i) grounds of opposition are dismissed.

#### Likelihood of Confusion

Each of the remaining grounds of opposition is based on the likelihood of confusion between the parties' marks. I will begin by assessing the likelihood of confusion as of today's date between the Opponent's registered mark and the Mark as applied for under Application 018. The Opponent has met its initial burden in this regard since its registration is extant.

#### *the 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 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 in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* [2006] 1 S.C.R. 772 and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* [2006] 1 S.C.R. 824.]

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

Both marks are inherently distinctive, as neither directly relates to its associated wares or services.

The distinctiveness of a trade-mark may be increased as a result of it becoming known through promotion or use. Based on the evidence, I conclude that the Opponent's mark has not become known or been used to any great extent. In contrast, there is evidence of the Applicant's Mark becoming known extensively, but only with respect to its wrestling-based entertainment services.

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

As discussed earlier, the Opponent's evidence only satisfies me that its IN THE RAW mark has been used in accordance with s. 4 since 2001.

Mr. DeMarco attests that the Applicant has been using the Mark since 1993 in association with its services. (Although Application 151 refers to a date of first use of October 4, 1994 for similar services, an applicant is not required to identify its earliest date of use in an application: *Marineland v. Marine Wonderland and Animal Park* (1974), 16 C.P.R. (2d) 97 (F.C.T.D.).)

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

When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application or registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [*Henkel Kommanditgesellschaft auf Aktien v. Super Dragon*

*Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.); cf. *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R. (4<sup>th</sup>) 266 (T.M.O.B.)]

It is clear from the evidence that all of the Opponent's wares and services relate to his singing career and that his wares, although sold separately, are used in part (if not primarily) to promote his entertainment services. However, the statement of wares and services in his registration is not restricted in this manner.

On the other hand, it is clear that the wares and services marketed by the Applicant relate to wrestling. However, the statement of wares in Application 018 is not restricted in this manner.

While both parties are in the entertainment field, wrestling and singing are different lines of entertainment. Even though the parties' channels of trade may cross in certain circumstances, there are significant differences between the parties' businesses. Nevertheless the wares in the Applicant's applications overlap with those of the Opponent's registration to some degree as follows:

<u>Registration 498200</u>	<u>Application 151</u>	<u>Application 018</u>
Pre-recorded audio compact discs, audio cassette tapes and video cassettes; music videos	Pre-recorded compact discs in the area of wrestling exhibitions	Pre-recorded records; pre-recorded audio and visual tapes; pre-recorded video tapes and cassettes, pre-recorded audio-cassettes; pre-recorded tapes
Posters	Posters related to wrestling	Posters
Photographs	Mounted and unmounted photographs; photographs, all related to wrestling	Mounted and unmounted photographs
Clothing namely hats, caps, cowboy hats, T-shirts, tank tops, sweatshirts, sweatpants, shorts, pajamas, lingerie, jackets and coats		Full line of clothing, namely, tops, t-shirts, shirts, sweatshirts, sweaters, pullovers, blouses, jackets, coats, trousers, pants, jogging suits, exercise pants, exercise



		suits, sweatpants, shorts, underwear, boxer shorts, socks, clothing ties, pajamas, belts, gloves, wrist bands, bandannas; headgear, namely, hats, caps
Stickers	Stickers related to wrestling	Stickers
Playing cards	Playing cards related to wrestling	Playing cards
Computer mouse pads		Mouse pads

It is reasonable to assume that the overlapping wares could travel through similar channels of trade, *e.g.* there is no reason to believe that record stores would not sell both IN THE RAW audio cassette tapes and RAW pre-recorded audio-cassettes.

I note that in its written argument, the Opponent only emphasizes that its registered wares and services are overlapping or similar to the following wares and services in Application 018: pre-recorded records; pre-recorded audio and visual tapes; pre-recorded video tapes and cassettes; pre-recorded audio cassettes; pre-recorded tapes; T-shirts, sweatshirts, sweatpants, pajamas; entertainment services. With regard to Application 151, the Opponent’s written argument is concerned only with the Applicant’s entertainment services. On the other hand, the Applicant takes the position in its written argument regarding Application 018 that the most similar wares are “posters, photographs and clothing consisting of t-shirts”; in so doing, it takes the position that the pre-recorded records, pre-recorded audio and visual tapes, pre-recorded video tapes and cassettes, pre-recorded audio cassettes and pre-recorded tapes in Application 018 are unrelated to the similar wares in the Opponent’s registration on the basis of the differences between wrestling exhibitions and country music performances. Regarding Application 151, the Applicant’s written argument admits that there are similarities between the Opponent’s registered wares and the Applicant’s photographs and posters, but the Applicant points out that the Applicant’s wares are identified in this application as being “related to wrestling”.

*s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them*

There is a fair degree of resemblance between the marks due to the common component RAW,

which dominates both marks. However, when considering the marks as a whole, there are differences between them in appearance, sound and idea suggested. As pointed out by the Applicant, the Applicant's Mark is one word, whereas the Opponent's mark comprises three. The first, traditionally more important, portions of the marks differ. Although the first portion of the Opponent's mark is merely a preposition and an article, these two small words result in the Opponent's mark being a defined phrase: the *Paperback Oxford Canadian Dictionary*, 2<sup>nd</sup> Edition defines "in the raw" as **1** in its natural state without mitigation. **2** naked. On the other hand, the *Paperback Oxford Canadian Dictionary* provides thirteen definitions for the word "raw": **1** (of food) uncooked, **2** in the natural state; not processed (*raw sewage*), **3** (of statistics, data, *etc.*) not analyzed or processed. **4** (of a person) inexperienced, untrained; new to an activity (*raw recruits*) **5 a** stripped of skin; having the flesh exposed. **b** sensitive to the touch from having the flesh exposed. **c** abnormally sensitive (*touched a raw nerve*). **6** (of the atmosphere, day, *etc.*) chilly and damp **7 a** crude in artistic quality; lacking finish. **b** not controlled or refined (*raw emotion*). **8** (of the edge of cloth) without hem or selvage. **9** (of liquor) undiluted. **10** (of silk) as reeled from cocoons. **11** (of milk) not pasteurized. **12** (of leather) untanned. **13** (of film or video footage *etc.*) unedited. Clearly, some of these definitions are not likely to be associated with the Mark as applied to the Applicant's particular wares and services; at the same time, it is not clear to me which of the defined meanings is most likely to dominate in the mind of the average Canadian consumer. I note the similarities between the first definition for "in the raw" and the second definition for "raw".

The Opponent referred to a number of cases wherein confusion was found to be likely where the second portion of two marks were identical but the first words of each mark were different. The Applicant has however pointed out that each of those cases was dealing with an applicant whose mark incorporated the opponent's mark in its entirety, which is not the case here.

*other surrounding circumstances*

Ms. Elliott has submitted evidence of a few other marks on the Canadian Trade-marks Register that include the phrase "IN THE RAW". However, state of the Register evidence is only meaningful where large numbers of relevant marks have been located, which is not the case at hand. [*Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349

(F.C.A.)]

*conclusion re likelihood of confusion*

It is clear that the parties are in different fields of entertainment and that the Applicant has acquired a substantial reputation in its field whereas the Opponent has not. Having considered all of the surrounding circumstances, I find that on a balance of probabilities there is not a reasonable likelihood of confusion between the parties' wares and services in so far as the Applicant's wares and services are restricted to its field of wrestling. However, the Applicant has not satisfied its legal burden when it comes to its wares that are not so restricted and which overlap with those of the Opponent. Although I have considered the non-use of the Opponent's mark in assessing the likelihood of confusion, I cannot ignore the fact that its registration remains standing for all of the listed wares and services. The Opponent's mark is not a strong one and is not entitled to a broad scope of protection. Nevertheless, the marks bear some degree of resemblance, there is no evidence that "raw" is a common formative for marks, and the channels of trade of the parties may well overlap. The onus is on the Applicant to satisfy me that there is not a reasonable likelihood of confusion between the marks and I find that the Applicant has not met this onus with respect to the following wares in Application 018:

pre-recorded records; pre-recorded audio and visual tapes; pre-recorded video tapes and cassettes, pre-recorded audio-cassettes, pre-recorded tapes, posters, mounted and unmounted photographs, full line of clothing, namely, tops, t-shirts, shirts, sweatshirts, sweaters, pullovers, blouses, jackets, coats, trousers, pants, jogging suits, exercise pants, exercise suits, sweatpants, shorts, underwear, boxer shorts, socks, clothing ties, pajamas, belts, gloves, wrist bands, bandannas; headgear, namely, hats, caps, stickers, playing cards, mouse pads.

It is noted that the Applicant's evidence does not demonstrate that it has established any significant reputation in association with the above-mentioned general categories of wares.

The registrability ground of opposition with respect to Application 018 succeeds in regard to the aforementioned wares but is otherwise rejected.

Turning to the likelihood of confusion between the Opponent's registered mark and the Mark as applied for in Application 151, I reach a different conclusion. The wares in that application are all restricted to ones that relate to wrestling, a field in which the Applicant has established a substantial reputation, which distinguishes these wares from those in Application 018. The registrability ground of opposition with respect to Application 151 is therefore rejected.

#### Entitlement Grounds of Opposition

In order to meet its evidential burden with respect to its entitlement grounds, the Opponent must show use of its mark prior to the filing date with respect to Application 018 (September 18, 2002) and prior to the dates of first use set out in Application 151 (October 4, 1994, May 31, 1996 and January 31, 1997). As discussed earlier, the Opponent's evidence shows use of IN THE RAW in association with the Opponent's entertainment services since June 2002 and in association with CDs and T-shirts since February 2001. Thus, the entitlement ground is dismissed with respect to Application 151 on the basis that the Opponent did not meet its evidential burden with regard thereto.

The Opponent has met its evidential burden with respect to its entitlement grounds concerning Application 018, even though its use was fairly minimal as of September 18, 2002. However, the entertainment services performed by the Opponent are significantly different from the Applicant's production and presentation of live wrestling sports entertainment television programs and therefore the entitlement grounds of opposition are rejected with respect to the Applicant's services. The Opponent does however succeed under s. 16 with respect to t-shirts, pre-recorded records; pre-recorded audio and visual tapes; pre-recorded audio-cassettes, and pre-recorded tapes, based on the Opponent's prior use of IN THE RAW with T-shirts and CDs, for reasons similar to those set out under my discussion of the registrability grounds of opposition.

#### Distinctiveness Grounds of Opposition

The legal onus is on the Applicant to show that its Mark is adapted to distinguish or actually

distinguishes its wares and services from the wares and services of others throughout Canada [*Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)]. However, an evidential burden lies on the party claiming that the reputation of its mark prevents the other party's mark from being distinctive. Therefore, to meet its evidential burden under these grounds, the Opponent must show that as July 30, 2003 and August 25, 2004 the reputation of its mark was substantial, significant or sufficient to negate the distinctiveness of the Mark. [*Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.T.D.)]

I am not certain that the Opponent has met its evidential burden under this ground for several reasons. For example, because his CD was released in 1998 in the limited quantity of 500, it is difficult to assess the degree to which there might be any residual reputation existing from use of IN THE RAW in association with the CD as of 2003 and 2004 (although I acknowledge that there is evidence of a handful of individual sales of the Opponent's CD in 2002). In any event, if the Opponent had met its initial burden, then the outcome of these grounds would have been the same as that of the entitlement grounds, *i.e.* they would not succeed with respect to Application 151 and would only succeed with respect to Application 018 with respect to t-shirts, pre-recorded records; pre-recorded audio and visual tapes; pre-recorded audio-cassettes, and pre-recorded tapes.

### Reverse Confusion

The Opponent has argued that the likelihood of confusion is of “reverse confusion”, *i.e.* that consumers will incorrectly conclude that the Opponent's wares and services emanate from or are associated with the Applicant. Although the Opponent has not referred to any case law in support of its arguments, the leading Canadian case on this topic is *A & W Food Services of Canada Inc. v. McDonald's Restaurants of Canada Ltd.* (2005), 40 C.P.R. (4<sup>th</sup>) 126 (F.C.T.D.), in which Mr. Justice O'Reilly made the following comments and conclusions about “reverse confusion”, starting at paragraph 23 of his decision:

23 The concept of reverse confusion appears to be well accepted in the United States. A leading U.S. author describes reverse confusion as follows:

The rule of reverse confusion is highly fact-specific and depends for its

application on the presence of a critical mass of key facts. The paradigm case is that of a knowing junior user with much greater economic power who saturates the market with advertising of a confusingly similar mark, overwhelming the marketplace power and value of the senior user's mark. When the facts vary from that model, the reverse confusion rule is not applicable. (J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, 4<sup>th</sup> ed., Danvers, MA; Thomson West, 2004, ch. 23:10, at p. 23-46.

24 It appears, however, that U.S. courts are less doctrinaire about the requirements of reverse confusion than McCarthy. The parties agree that the leading authority on reverse confusion is *A & H Sportswear Co. v. Victoria's Secret Stores Inc.* (2001), 167 F.Supp.2d 770 (U.S. Dist. Ct. E.D. Penn. 2001). There, the plaintiff was a manufacturer of swimsuits sold under the trade-mark "Miraclesuit", registered in 1992. The defendant sold a line of lingerie and swimwear under the mark "The Miracle Bra", which it registered in 1994. The plaintiff argued that the defendant was using a confusing mark, in the sense that consumers were led to believe that the plaintiff was selling goods that originated with the defendant - in other words, reverse confusion. The District Court found that the plaintiff had proved its case.

25 It is very clear, however, that the Court approached the issue of reverse confusion in exactly the same way as it would have considered a claim of forward confusion. It did not apply any special criteria or insist on proof of the factual scenario described by McCarthy.

...

32 I see nothing in the [Canadian Trade-mark] Act that would confine plaintiffs to the forward or direct confusion situation. The Act is broad enough to cover both forward and reverse confusion. Both are actionable under the Act, and the same criteria apply.

33 Accordingly, there is no need to rely on U.S. legislation, doctrine, jurisprudence or criteria to decide a claim of reverse confusion in Canada.

Thus, any reference to "reverse confusion" seems to be a red herring, given that the analysis does not differ from the traditional approach. I will mention nevertheless that the Applicant's agent did submit that the requirement for finding "reverse confusion" set out in the McCarthy text would not be found in the present case as it is its position that it is the Applicant who is the senior user, not the Opponent.

#### Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, pursuant

to s. 38(8) I reject the opposition with respect to application No. 1,103,151. In addition, I refuse application No. 1,153,018 only with respect to the following wares: pre-recorded records; pre-recorded audio and visual tapes; pre-recorded video tapes and cassettes, pre-recorded audio-cassettes, pre-recorded tapes; posters; mounted and unmounted photographs; full line of clothing, namely, tops, t-shirts, shirts, sweatshirts, sweaters, pullovers, blouses, jackets, coats, trousers, pants, jogging suits, exercise pants, exercise suits, sweatpants, shorts, underwear, boxer shorts, socks, clothing ties, pajamas, belts, gloves, wrist bands, bandannas; headgear, namely, hats, caps; stickers; playing cards; mouse pads. Authority for a split decision is set out in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 492 (F.C.T.D.).

DATED AT TORONTO, ONTARIO, THIS 18th DAY OF JUNE 2008.

Jill W. Bradbury  
Member  
Trade-marks Opposition Board