



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

**Citation: 2014 TMOB 213
Date of Decision: 2014-10-01**

**IN THE MATTER OF AN OPPOSITION
by SIXTY INTERNATIONAL S.A. to
application No. 1,491,394 for the trade-
mark SPEED ENERGY in the name of
Speed Energy Drink, LLC**

[1] On August 6, 2010, Speed Energy Drink, LLC (the Applicant) filed an application to register the trade-mark SPEED ENERGY (the Mark) on the basis of its proposed use in association with the following Wares (as amended):

(1) Metal key chains and key rings, metal license plates and statues of non-precious metal; Stickers, decals, bumper stickers, paper cups, paper coasters, pens, pencils, markers, paper banners, flags and pennants, framed art prints, posters, calendars, checkbook covers, note cards, notebooks, note pads, mounted and un-mounted photographs, picture books, post cards and trading cards; Leather key chains, key cases, sports bags, carrying bags and wallets; Plastic key chains and key rings, plastic license plates, plastic license plate frames, plastic pennants, vinyl banners and sleeping bags; Cups, mugs, plastic water bottles sold empty, cocktail shakers, drinking flasks, thermal insulated containers for food or beverages and insulated containers for beverage cans for domestic use; Clothing, namely, jeans, dresses, vests, shirts, t-shirts, tube tops, tank tops, polo shirts, sports jerseys, sweatshirts, hooded pullovers, hooded sweatshirts, short and long sleeve buttoned and zippered pullovers, sweaters, jackets, pants, shorts, skirts, underpants, panties, boxer briefs, socks, jumpers, pajamas, bathing suits, swimsuits, robes, uniform-inspired clothing, neckties, scarves, gloves; waterproof

clothing, namely, waterproof jackets, pants and hats; motorists' clothing, namely, driving gloves, motorcycle gloves, jackets, pants, and chaps; head wear, namely, hats, caps, visors, scarves, beanies and skull caps; Toys, namely, die cast toy vehicles, play motor cars, radio-controlled toy vehicles, toy vehicles, model cars, collectible toy figures, dolls, plush toys, stuffed toys, action figures, miniature toy helmets, balls for sports, namely, baseballs, volleyballs, basketballs, tennis balls, footballs, soccer balls and handballs, beach balls; Candy (referred to as Wares (1)).

(2) Sports drinks, namely, energy drinks (referred to as Wares (2)).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 25, 2011.

[3] On October 14, 2011, International Stars S.A. (the Opponent) filed a statement of opposition pleading the grounds summarized below. The Opponent's name was subsequently changed to Sixty International S.A. as a result of a merger and the statement of opposition was amended accordingly.

(a) The application does not comply with section 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) as the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Wares in view of the prior use and registration of the trade-mark ENERGIE of the Opponent.

(b) The application does not comply with section 30(e) of the Act as the Applicant did not have the intention to use the Mark in Canada in association with each of the Wares.

(c) The Mark is not registrable, pursuant to section 12(1)(d) of the Act, because it is confusing with the following registration of the Opponent:

Registration No.	Trade-mark
TMA765,742	ENERGIE

(d) The Applicant is not the person entitled to registration of the Mark, pursuant to section 16(3)(a) of the Act, because at the date of filing, the Mark was confusing with the Opponent's previously used and made known trade-mark ENERGIE.

(e) The Mark is not distinctive, pursuant to section 2 of the Act, having regard to the Opponent's trade-mark.

[4] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[5] The Opponent filed as its evidence the affidavit of Lena Brazeau and the particulars of its registration. The Applicant filed as its evidence the affidavits of Alison McCabe and Jennifer Leah Stecyk.

[6] Both parties filed a written argument. A hearing was not held.

Material Dates and Onus

[7] While various grounds of opposition are pleaded, the determinative issue for decision is whether the Mark is confusing with the Opponent's trade-mark ENERGIE. The earliest material date to assess the issue of confusion is the priority date of the application (in this case the priority date of June 10, 2010 for Wares (2) and July 23, 2010 for Wares (1)) while the latest material date is the date of my decision: for a review of material dates in opposition proceedings see *American Assn of Retired Persons v Canadian Assn of Retired Persons* (1998), 84 CPR (3d) 198 (FCTD) at 206-208 (FCTD) and sections 16 and 34 of the Act.

[8] Before considering the issue of confusion between the parties' marks, it is necessary to review some of the technical requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[9] With respect to (i) above, there is an evidential burden on an opponent to prove the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v Molson*

Companies Limited (1990), 30 CPR (3d) 293 (FCTD) at 298. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on an applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against it.

Preliminary Issue: Evidence of Ms. Brazeau

[10] Ms. Brazeau, a secretary employed by the agent for the Opponent, attaches to her affidavit printouts of the Opponent's website *www.energie.it* including a list of Canadian stores and the Energie catalogue for Fall & Winter 2011-2012 to her affidavit (Exhibits A and B). Ms. Brazeau also attaches printouts from the portion of the website entitled "Online Store" of items such as jackets, accessories, pants, shirts, sweaters and bags all of which pricing in US\$ (Exhibit C).

[11] The content of Ms. Brazeau's affidavit is hearsay and there is no evidence of record setting out why it was necessary for her to provide such evidence, nor any evidence concerning its reliability such as confirmation that the store listing was accurate and up to date and that each of the wares identified was available in Canada. In these circumstances, I am not prepared to find this evidence admissible for the truth of its contents [*R v Khan*, 1990 CanLII 77 (SCC), [1990] 2 SCR 531 (SCC); *Gowling Lafleur Henderson LLP v Guayapi Tropical* (2012), 104 CPR (4th) 65 TMOB at paras 7-9].

[12] That being said, if I had found Ms. Brazeau's evidence admissible, it would not have impacted my ultimate decision in this case.

Grounds which Can be Summarily Dismissed

[13] The section 30(e) ground of opposition alleges that the Applicant did not intend to use the Mark in Canada with each of the Wares. There is no evidence that supports this ground of opposition. Consequently, it is rejected on the basis that the Opponent has not satisfied its initial burden.

[14] The section 30(i) ground of opposition alleges that the Applicant could not have been satisfied that it was entitled to use the Mark because it is confusing with the Opponent's trade-mark. Where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith [*Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As this application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, the section 30(i) ground is rejected.

[15] The sections 16(3)(a) and 2 grounds are rejected because the Opponent has not met its initial burden. The Opponent has not evidenced that its trade-mark was used, made known or had a reputation in Canada as of the priority dates with respect to the section 16(3)(a) ground of opposition [*TLV Co, Ltd v Tyco Flow Control, Inc*, 2003 CanLII 71145 (TMOB)] or as of the date of filing the statement of opposition for the section 2 ground of opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 at 324 (FC)]. Although the Opponent's registration for its trade-mark refers to use, that is not sufficient for the Opponent to meet its burden for these grounds of opposition [*Roxxs, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB) at 268].

Section 12(1)(d) Ground of Opposition

[16] The Opponent has pleaded that the Mark is not registrable under section 12(1)(d) of the Act as it is confusing with the Opponent's registered trade-mark set out below:

Registration No. Trade-mark Wares and Services

TMA765,742	ENERGIE	(1) Glasses; sun-glasses; spectacles frames; spectacles cases. (2) Jackets; trousers; jeans; gloves; socks; sweaters; cardigans; belts; tracksuits; sport shirts; t-shirts; polo shirts; overcoats; raincoats; half coats; suits; pullovers; hats; caps. (3) Shoes; boots; slippers and sandals; leather straps of shoulder bags; folding briefcases; shoulder bags; Gladstone bags; briefcases; portfolios, namely, stationery type portfolios and briefcase type portfolios; suitcases; hand luggage; tote bags; trunks; handbags; purses; key cases; wallets/billfolds; wallets for keeping credit cards, passes and name cards; umbrellas.
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[17] I have exercised my discretion and checked the Register to confirm that this registration is extant. Therefore, the Opponent has met its initial burden with respect to this ground.

[18] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would likely lead to the inference that the wares and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the wares and services are of the same general class. In making such an assessment I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them. In *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, [2006] 1 SCR 824 at para 20, the Supreme Court of Canada set out how the test is to be applied:

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [mark] at a time when he or she has no more than an imperfect recollection of the [prior] trade-marks and does not pause to give the matter any

detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

Inherent Distinctiveness

[19] I can take judicial notice of dictionary definitions [*Tradall SA v Devil's Martini Inc* (2011), 92 CPR (4th) 408 (TMOB) at para 29].

[20] The on-line dictionary www.dictionary.com defines “speed”, in part, as “rapidity in moving, going, travelling, proceeding, or performing; swiftness; celerity” and “energy”, in part, as “the capacity for vigorous activity; available power”. I consider the combination of speed and energy to be unique, as energy is not generally understood to have speed. As such, the meaning of the Mark is somewhat obscure. When considered in light of the Wares, I find that the Mark is inherently distinctive for use in association with Wares (1). With respect to Wares (2) energy drinks, I do not find the Mark has a high degree of inherent distinctiveness since it suggests energy drinks, which give a consumer speed and energy.

[21] The Collins French-English dictionary (www.collinsdictionary.com) provides that “énergie” means “energy”. While the Opponent’s trade-mark has a unique spelling, I do not consider that the use of an “e” rather than an “é” significantly increases the inherent distinctiveness of its trade-mark. Given that there is no clear link between the Opponent’s registered wares and the word ENERGIE, I find that the Opponent’s mark is inherently distinctive.

[22] As the Mark (with respect to Wares (1)) and the Opponent’s trade-mark ENERGIE have a similar degree of inherent distinctiveness, this factor favours neither party.

Extent Known and Length of Time in Use

[23] While the Opponent's registration is based on use, this only entitles me to assume de minimis use [*Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. De minimis use does not support a conclusion that the Opponent's mark has become known to any significant extent, nor that it has necessarily been used continuously.

[24] The Applicant's affiant, Ms. McCabe, its General Manager, states that as of the date of swearing her affidavit (February 26, 2013) the Applicant intends to use the Mark in Canada (para 10). As such, this factor slightly favours the Opponent.

Nature of the Wares and Trade

[25] This factor only favours the Opponent with respect to the Wares set out below (the Applicant's Clothing and Accessory Wares) as these wares overlap with the Opponent's registered wares:

Metal key chains and key rings, checkbook covers, Leather key chains, key cases, sports bags, carrying bags and wallets; Plastic key chains and key rings, sports bags, carrying bags and wallets; clothing, namely, jeans, dresses, vests, shirts, t-shirts, tube tops, tank tops, polo shirts, sports jerseys, sweatshirts, hooded pullovers, hooded sweatshirts, short and long sleeve buttoned and zippered pullovers, sweaters, jackets, pants, shorts, skirts, underpants, panties, boxer briefs, socks, jumpers, pajamas, bathing suits, swimsuits, robes, uniform-inspired clothing, neckties, scarves, gloves; waterproof clothing, namely, waterproof jackets, pants and hats; motorists' clothing, namely, driving gloves, motorcycle gloves, jackets, pants, and chaps; head wear, namely, hats, caps, visors, scarves, beanies and skull caps;

With respect to the remaining Wares, this factor favours the Applicant as there is no overlap in the nature of these wares, nor presumably the channels of trade.

[26] The Applicant submits that there are significant differences in the nature of the wares and trade with respect to the Applicant's Clothing and Accessory Wares and the Opponent's registered wares. Ms. McCabe's evidence provides the following:

- Ms. McCabe is the General Manager of the Applicant (para 1);

- the Applicant was founded by the American race car driver and racing team owner Robby Gordon (para 5);
- much of the regular sponsorship and promotional activity in the energy drink industry is focused on motorsports and other forms of racing (para 6);
- the Applicant sells energy drinks as well as apparel, toy cars and other merchandise branded with the Mark (para 9);
- the Applicant's target market is 14-30 year old customers, primarily men, who are interested in motosports such as off-road and track racing, dirt biking, motocross, snowboarding, skate boarding, and NASCAR (para 8); and
- SPEED ENERGY branded drinks and apparel and other SPEED ENERGY merchandise is available on the SPEED ENERGY website (www.speedenergy.com), on Robby Gordon's official website (www.robbygordon.com) and at various events the Applicant sponsors or participates in such as NASCAR race events and Stadium Super Trucks (para 10, Exhibits A, B1-B-11). The www.speedenergy.com website also indicates that SPEED ENERGY drinks can be found at convenience stores in the North Carolina area (Exhibit A).

However, as there is no restriction in either the application or the Opponent's registration, the Applicant's Clothing and Accessory Wares could travel through the same channels of trade. Accordingly, the nature of wares and trade factors favour the Opponent with respect to the Applicant's Clothing and Accessory Wares.

Degree of Resemblance Between the Trade-marks

[27] In considering the two marks as a whole, I find that there is not a great degree of resemblance in appearance, sound or idea suggested. There is of course some resemblance between the parties' marks as a result of their common use of the word ENERGY/ENERGIE. However, as stated in *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46

CPR (2d) 183 (FCTD) at 188, “It is axiomatic that the first word or the first syllable in a trade mark is far the more important for the purpose of distinction.” In applying that reasoning, the first word of the Applicant’s Mark, SPEED, would serve to distinguish the Mark in appearance, sound and idea suggested. But more importantly, the Supreme Court of Canada recently noted in *Masterpiece* that “While the first word may, for purposes of distinctiveness, be the most important in some cases, I think a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking and unique”. In the present case, I do not consider the fact that the Applicant has essentially incorporated the Opponent’s mark as the second component into its Mark to be decisive, because the most striking feature of the Mark is that it consists of a unique and non-sensical phrase SPEED ENERGY.

Evidence of Third Party Use of Energy

[28] Exhibit A to Ms. Stecyk’s affidavit sets out the particulars of various trade-mark registrations and allowed applications including ENERGY or a variant owned by a number of different parties including the marks set out below. In each case, the registration or application includes clothing in the statement of wares without a restriction as to the channel of trade.

Application or Registration No. Owner	Trade-mark	Statement of Wares
TMA769,599 AG Energy Co-Operative Ltd.		(1) ... wearing apparel, namely, shirts, t-shirts, polo shirts, tank tops, jackets, sweaters, sweat shirts, sweatpants, coats, neckties and vests;...
TMA553,781 C-Tech Oilwell Technologies	C-TECH ENERGY	(1) Clothing, namely hats, caps, t-shirts, sweatshirts and jackets. (2) Novelty items, namely drinking glasses, mugs, pens, pencils, golf balls and coasters.

Application or Registration No. Owner	Trade-mark	Statement of Wares
Inc.		
TMA665,495 T.R.A.D. Import/Export Inc.	EXTRA ENERGY	(1) Ladies' pants and overalls; children's pants and overalls. (2) Ladies' wear, namely sleepwear, tank tops, sweatshirts, t-shirts, jackets, shorts, and rompers. (3) Ladies' wear, namely underwear and sweaters; children's wear, namely outerwear, jackets, t-shirts, swimwear, short sets, jogging suits, shorts, rompers and dresses. (4) Children's clothing, namely suits, blazers, vests, jumpsuits; ...
TMA811,356 3M Company	FUTURO ENERGIZING	Hosiery; anti-embolism hosiery, socks and stockings; compression hosiery, socks, stockings; diabetic socks.
TMA833,012 Monster Energy Company		Stickers, sticker kits, decals; sports bags, travel bags, school bags, handbags, messenger bags, knapsacks, backpacks; clothing, namely t-shirts, sweat shirts, pants, jackets, shorts; and headgear namely, hats, caps and beanies; ...
TMA200,351 HBI Branded Apparel Enterprises, LLC	SHEER ENERGY	Ladies' hosiery and panty hose.
TMA437,948	ENERGY & MOTION	Activewear, namely, leotards, leggings, tops and tights.

Application or Registration No. Owner	Trade-mark	Statement of Wares
Jacques Moret Inc.		
TMA535,049 Daniel Cheng	ENERGY TECHNO	Bags, namely school bags, hand bags, purses, tote bags, waist bags, knapsacks, duffle bags, sports bags; clothing, namely dress pants, casual pants, shorts, boxers, sweat pants, sweat shirts, t-shirts, casual shirts, tank tops, dress shirts, jackets, coats, skirts, dresses, underwear, scarves, gloves.
TMA738,279 VS Energy Conservation Inc.	ENERGYBANK	... promotional items, namely magnets, t-shirts, hats, caps, flags, banners, pens, pencils, stickers, decals and sweatshirts, golf shirts.
TMA803,975 Bag Bazaar Ltd	ACTIVE ENERGY SYSTEM	Hosiery, leggings, socks and stockings.
TMA647,511 Lea Amaral	ENERGIA ATHLETICS	Athletic and exercise clothing, namely shirts, t-shirts, sweatshirts, sweaters, jackets, gloves, hats, head bands, sweat bands, sports bras, tank tops, shorts, tights, pants, socks, swimwear, underwear; jogging suits; sweat suits; track suits; athletic accessories namely gym bags, running pouches, water bottles, running gloves, socks, hats, head bands, wrist bands, magazines, nutrition bars; athletic shoes; casual shoes; jewellery; purses; ...

Application or Registration No. Owner	Trade-mark	Statement of Wares
TMA688,095 Astral Media Radio Inc.		Promotional products, namely fleece-lined sweaters, Tshirts, peak caps, vests or sweaters, polos, buttons, inflatable balls, stickers, crests, pins, pencils, pens, posters, mouse pads, computer mouse, glasses, coasters, cups, USB keys, shoulder bags, backpacks, flags; video recordings and audio, namely prerecorded discs and compact discs, pre-recorded audio cassettes, videocassettes and DVD discs containing music or reproducing comedy or monolog shows.
1,493,004 Enersource Corporation	MORE THAN ENERGY	... Clothing.

[29] Ms. Stecyk has evidenced more than ten relevant registrations in the name of different owners to show that use of ENERGY is somewhat common in the clothing trade [*Old Spaghetti Factory Canada Ltd v Spaghetti House Restaurants Ltd* (1999), 2 CPR (4th) 398 at 407; *Player's Company Inc v Edward Roundpoint* 2013 TMOB 149 at paras 43-47]. Consequently, consumers would be somewhat accustomed to seeing such marks used with clothing and accessories and therefore would be more likely to differentiate the Mark on the basis of the SPEED component.

Conclusion

[30] I conclude that, on a balance of probabilities, given all the surrounding circumstances there is not a reasonable likelihood of confusion. The differences between the marks are sufficient to make confusion unlikely. Confusion is unlikely in situations where marks share common features but also feature dominant differences [see *Foodcorp Ltd v Chalet Bar B Q (Canada) Inc* (1982), 66 CPR (2d) 56 at 73 (FCA)]. In this case, the component SPEED is such a dominant difference. Finally, I note that if my finding on the state of the Register evidence is incorrect, it would not have affected my decision on the section 12(1)(d) ground.

Disposition

[31] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office