



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

Citation: 2014 TMOB 76
Date of Decision: 2014-04-01

**IN THE MATTER TWO OPPOSITIONS by
Canadian Football League Players' Association
to application Nos. 1,344,153 and 1,344,156 for
the trade-marks PRO PLAYER and P2 BY
PRO PLAYER & Design, respectively, in the
name of PEI Licensing, Inc.**

APPLICATION No. 1,344,153 - PRO PLAYER

FILE RECORD

[1] On April 19, 2007, PEI Licensing, Inc. filed an application to register the mark PRO PLAYER, for use in association with the following wares:

(1) luggage, bags, backpacks, and all-purpose athletic bags, school bags, sport bags, messenger bags, cinch sacs, utility bags, weekenders, fanny packs, water bottle bags, CD cases, handbags, soft-sided luggage, rolling pilot cases, camera bags, travel totes, flight bags, computer bags, agendas, cosmetic bags, key chains;

stationery namely, portfolios, binders, composition books, folders, memo pads, die-cut tablets, notebooks, journals, spiral theme books, pencils, pens, pencil toppers, erasers, pencil cases, stretch book covers, study kits, namely, a notebook holder that can also hold rulers, pens, pencils and other small school supplies;

tool kits (ruler, sharpener, stapler, erasers, markers) corkboards, message combo boards, wipe-off calendar/message boards, clipboards with memo pads, locker magnets, lunch boxes, insulated coolers.

(2) performance underwear, namely, shorts and shirts.

The application was based on proposed use in Canada for the wares denoted by (1) and use since at least as early as March 2005 for the wares denoted by (2).

[2] The application was subsequently amended to add a further claim to registration, based on use and registration of the mark in the applicant's country of origin – The United States of America, for the wares shown below:

(3) clothing, namely, pants, shorts, athletic pants, workout pants, underwear, boxers, briefs, sport bras, trunks, athletic uniforms, jerseys, shirts, tops, fleece, knit and woven shirts, t-shirts, casual shirts, warm-up shirts, sport shirts, sweatshirts, t-shirts, sweatpants, outerwear, jackets, pullovers, coats, warm up suits, swimwear, cover-ups;

head gear, namely, hats, caps, visors, fedoras; gloves;

all categories of men's, women's and children's footwear, namely, shoes, boots, sneakers, slippers, thongs, flip-flops;

all men's, women's and children's socks & hosiery.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* issue dated March 25, 2009 and opposed by Canadian Football League Players' Association on May 25, 2010 - the filing of the statement of opposition was delayed as the opponent had been granted a nine month "cooling-off period" to attempt a resolution of its concerns. The Registrar forwarded a copy of the statement of opposition to the applicant on July 6, 2010, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[4] The opponent's evidence consists of the affidavits of Stuart Laird and Kyle Runzer. The applicant's evidence consists of the affidavits of Mark Faassen and Lester Blum. The opponent's rely evidence consists of the affidavit of Jada Lui. Both parties filed written arguments. An oral hearing was scheduled for February 4, 2014, however, the parties advised the Board (on January 29, 2014) that they were pursuing settlement and that neither party would attend the hearing. However, the parties did not request a postponement or a new hearing date. In the circumstances, the Board advised the parties

that the hearing for February 4, 2014 was cancelled and that a decision would issue in due course: see the Board notice dated February 3, 2014.

STATEMENT OF OPPOSITION

[5] The opponent pleads that it is the owner of (i) the trade-names CFLPA PRO PLAYERS and AJLCF PRO PLAYERS, and (ii) trade-mark registration Nos. TMA659743 and TMA660479, shown below



It may not be apparent that the letters CFLPA and AJLCF appear in the first and second marks, respectively.

[6] The opponent's marks are, at present, registered for use in association with the following services:

- (1) licensing the services of Canadian Football League football players and alumni members of the applicant to others, namely, personal appearances and participation at exhibitions and promotional events, namely, public appearances and keynote speeches,
- (2) licensing the use of the names, nicknames, photographs, designs, likenesses, images, visual representations and signatures of professional football players and alumni members of the applicant to others,
- (3) licensing the use of the name, trade-marks and logos of the applicant to others.

The opponent's licensing activities are expressed in informal language in Exhibit E of Kyle Runzer's affidavit:

CFLPA PRO PLAYERS, the licensing and marketing subsidiary of the Canadian Football league [sic] Players Association, was created in 2003 with the mission of "taking the Helmuts [sic] off" active CFL players and marketing them as personalities as well as respected professional athletes. Representing over 450 active players and 1,500 retired players, CFLPA PRO PLAYERS offers a wide variety of marketing opportunities to its partners.

[7] At the time that the statement of opposition was filed, the opponent's registrations covered additional services, various items of clothing and other wares. The additional services and all the wares were deleted pursuant to a proceeding under s.45 of the *Trade-marks Act*: see *PEI Licensing Inc v Canadian Football League Players Association*, 2013 TMOB 110 (CanLII).

[8] Various grounds are pleaded in the statement of opposition, two of which were withdrawn at the written argument stage. The main issues for decision, with respect to the remaining grounds of opposition, are whether the applied-for mark PRO PLAYER is confusing, within the meaning of the *Trade-marks Act*, with (i) either of the opponent's trade-names or (ii) either of the opponent's trade-marks. The earliest material date to assess the issue of confusion is the date of first use claimed by the applicant, that is, March 31, 2005, with respect to the wares denoted by (2), while the latest material date is the date of my decision: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 CPR(3d) 198 at 206-209 (FCTD).

[9] I would also mention that use of the opponent's logos would likely qualify as use of the word mark PRO PLAYERS *per se*: in this regard, see the Board decision in *Nightingale Interloc v. Prodesign Ltd.* (1984), 2 CPR(3d) 535 at 538. Of course, the opponent has not relied on any word marks in its statement of opposition; it has relied solely on its logos and trade-names. Nevertheless, in view of the evidence filed by the opponent and the Court's guidance in *Novopharm Limited v. AstraZeneca AB et al.*, (2002), 21 CPR (4th) 289 (FCA) at para. 10 concerning how evidence may broaden the scope of a statement of opposition, it is also necessary to consider the issue of confusion between the opponent's word mark PRO PLAYERS and the applied-for mark PRO PLAYER. As the applied-for mark more closely resembles the opponent's mark PRO PLAYERS than any other of the opponent's marks (or trade-names), the determinative

issue for decision is whether the applied-for mark PRO PLAYER is confusing with the opponent's mark PRO PLAYERS.

WHEN IS A TRADE-MARK USED IN CANADA?

[10] As the technical meaning of “use” of a mark in Canada is of some significance in the instant case, the statutory definition of “use” of a trade-mark, found in s.4 of the *Trade-marks Act*, is shown below:

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.

(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.

[11] Before reviewing the parties' evidence, I will next discuss the meaning of confusion within the context of the *Trade-marks Act*, the test for confusion, and factors to be assessed in determining confusion.

WHEN ARE TRADE-MARKS AND TRADE-NAMES CONFUSING?

[12] Trade-marks and trade-names are confusing when there is a reasonable likelihood of confusion within the meaning of s.6(2) and s.6(3) of the *Trade-marks Act*, shown below:

6(2) The 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 . . . or performed by the same person, whether or not the wares or services are of the same general class.

6(3) The use of a trade-mark causes confusion with a trade-name if the use of both the trade-mark and trade-name in the same area would be likely to lead to the inference that the wares or services associated with the trade-mark and those associated with the business carried on under the trade-name are manufactured . . . or

performed by the same person, whether or not the wares or services are of the same general class.

[13] Thus, the issue is not confusion between the marks and trade-names themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether purchasers of the applicant's clothing and other wares, sold under the mark PRO PLAYER, would believe that those items of clothing and other wares were produced or authorized or licensed by the opponent who performs its services under its logos, trade-names and trade-marks. The legal onus is on the applicant to show, on the usual civil balance of probabilities standard, that there would be no reasonable likelihood of confusion.

TEST FOR CONFUSION

[14] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are "all the surrounding circumstances including" those specifically mentioned in s.6(5)(a) to s.6(5)(e) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as the weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 CPR(3d) 308 (FCTD). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR(4th) 361 (SCC), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

OPPONENT'S EVIDENCE

Stuart Laird

General Background

[15] Mr. Laird identifies himself as president of the opponent. The opponent is an unincorporated association that represents the interests of professional football players in the Canadian Football League. The opponent was formed in 1965 and acts on behalf of players for various purposes including negotiating a collective bargaining agreement with the CFL. The number of players in the CFL varies from year to year, ranging from 507 to 612 for the years 2004 – 2010.

[16] In 2003, the opponent created a sales and marketing division and started an initiative to develop a brand for itself as a means to generate revenue. The brand created by Mr. Laird was CFLPA PRO PLAYERS. In early 2004 the opponent developed new French and English versions of a logo as shown in para. 5, above. The official launch of the opponent's logos occurred on May 15, 2004.

[17] Mr. Laird describes the opponent's activities in paras. 10 and 11 of his affidavit, sworn December 23, 2010:

10. The Opponent has used all of the above-mentioned "PRO PLAYERS" trade-marks jointly and severally, the "Marks") in association with services the Opponent provides to professional football players who are members of the Opponent, and are on a team roster of a member football club of the CFL, and in association with a number of events hosted by the Opponent. The Opponent has also used the Marks in respect with a variety of wares and services, including those as listed in the registrations and applications for the Marks. The services include the licensing of the Marks to others, as described in more detail below.

11. The Opponent has spent considerable effort and expense in building goodwill in the Marks in making the Opponent known as the representative of all professional football players who are members of the Opponent, and are on a team roster of a member football club of the CFL. The Opponent has made publicly known the association of the Marks with wares and services, as described in more detail below. Advertisement of the Marks in association with these wares and services, has occurred through the Opponent's web sites www.cf1pa.com and www.proplayers.ca, trade shows, press releases as well as public events held by the Opponent, including events held during the week leading up to the Grey Cup football game each year since at least as early as 2003. Public notice was also achieved by trade-mark registrations and the publication of trade-mark applications owned by the Opponent. Some of the costs of making known the Marks include the

cost of: the website; trade shows exhibitions; media releases; and newsletters sent to player members of the Opponent.

The Opponent's License Agreements

[18] The opponent entered into an agreement with Jogo Novelties Inc., in 2005, to produce player cards and to use the opponent's marks in association with the cards. The opponent has received \$12,633 in revenue from Jogo since 2005. Attached as Exhibit H are copies of the agreements between the opponent and Jogo dated from 2005 to 2010.

[19] The opponent also entered into an agreement with Canadian Football League Properties Limited ("Properties") which enabled Properties to grant rights to Reebok Canada Inc. to manufacture and sell items of clothing bearing the names of players in the CFL. The opponent granted licenses to Properties to use its marks since at least as early as 2004. The opponent has received \$371,081 in revenue from Properties since 2005. Attached as Exhibit J are copies of the agreements between the opponent and Properties dated from 2004 to 2010.

[20] Mr. Laird provides further information concerning Reebok's use of the opponent's marks at paragraph 16 of his affidavit:

Also attached in Exhibit "J" are true copies of 15 photographs of various articles with the Opponent's CFLPA PRO PLAYERS LOGO marked on them. The first 3 photographs are of shirts made by Reebok. The next 4 photographs are of pullovers or sweaters made by Reebok. The next 3 photographs are of sweatpants made by Reebok. The next 2 photographs are of sweatpants made by Reebok with my name [S. Laird] stitched on the bag. The next photograph is of a luggage tag. The next photograph is of a thermos. The last photograph is of a lanyard.

I have reviewed Exhibit J and can confirm Mr. Laird's description of the opponent's logos appearing on items of clothing and other wares is accurate.

[21] In July 2008 the applicant filed further applications for the word mark PRO PLAYERS, application No. 1,403,415, and PRO PLAYERS logo, application No. 1,403,416, shown below:



The above-mentioned applications are based on proposed use in Canada and cover, among other things, clothing and novelty items and the type of licensing services covered in the opponent's registrations and as described by Mr. Laird in his affidavit. For the purposes of this proceeding, I consider the above logo to be a variation of the opponent's registrations, rather than as a different mark, as the logo it maintains the same dominant features as the registered marks: in this regard, see *Promafil Canada Ltée v. Munsingwear Inc.* (1992) 44 CPR (3d) 59 at paras. 36-38.

[22] In paragraphs 17 to 33 of his affidavit, Mr. Laird describes further licensing agreements between the opponent and other third parties, attaches copies of the agreements, and provides figures for payments received pursuant to the agreements. I do not believe that reviewing Mr. Laird's evidence in detail concerning the further agreements would serve a useful purpose. This is because, in my view, Mr. Laird's evidence pertaining to the opponent's licensing agreements lacks the specificity necessary to establish that the opponent actually used its marks, for clothing or other wares, within the meaning of s.4 of the *Trade-marks Ac.* In this regard, I find that the applicant's critique of Mr. Laird's evidence, at paragraph 59 of its written argument, shown below, is, for the most part, fair comment:

59. The Applicant notes the following in respect of the above-noted license agreements:

(a) Although the licensing agreements purport to license to various third parties the right to use the Opponent's Marks [the logos shown in para. 5, above], the Opponent's New Marks [PRO PLAYERS and the logo shown in para. 21, above] and/or the Opponent's Word Marks [CFLPA PRO PLAYERS; AJLCF PRO PLAYERS], the agreements never specifically require the licensee to use them in association with the licensed wares or services.

(b) Mr. Laird never states in his Affidavit that the Opponent's Marks, the Opponent's New Marks and/or the Opponent's Word Marks were in fact used in association with the licensed wares or services pursuant to the above-noted agreements.

(c) Mr. Laird does not describe how the Opponent's Marks, the Opponent's New Marks and/or the Opponent's Word Marks were used pursuant to the above-noted agreements (if at all), nor does his Affidavit provide examples showing the manner in which the Opponent's Marks, the Opponent's New Marks and/or the Opponent's Word Marks were used in association with the licensed wares or services (if at all).

(d) Absent any supporting evidence, it cannot be assumed that the respective parties performed any of their obligations under the terms of the agreements. In most cases, Mr. Laird does not provide any indication that the parties did in fact perform their obligations apart from statements made by him regarding revenue paid to the Opponent.

(e) There is no evidence of control actually being exercised over the quality of the wares and services allegedly offered (if at all) under license in association with the Opponent's Marks, the Opponent's New Marks and/or the Opponent's Word Marks.

(f) In respect of the Opponent's statements regarding the revenue derived by the Opponent pursuant to the license agreements, in many instances the amount of revenue directly corresponds to financial compensation due pursuant to the agreements irrespective of whether the licensed products or services are ever offered by the licensee. Where royalty payments appear to be above guaranteed amounts due, the Opponent never states that the revenue received relates to the provision of wares or services offered or sold in association with Opponent's Marks, the Opponent's New Marks and/or the Opponent's Word Marks. Because none of the agreements specifically required that these marks be used, the wares or services could just as easily have been offered in association with any of the other rights licensed (e.g. use of the Players' names, images and likenesses or use of team logos and colours) and royalty payments would have still been owed.

(g) . . . these [the opponent's] license agreements do not, in and of themselves, amount to use of the Opponent's Marks, the Opponent's New Marks and/or the Opponent's Word Marks in association with the licensing services. Rather, the evidence must show that the trade-mark is "used or displayed in the performance or advertising of those services" to qualify as use of the mark in association with services. A mark is not used pursuant to Section 4(2) of the Act in respect of licensing services simply because the Mark itself has been licensed. Rather, it must be used in association with the performance or advertising of those services. The licence agreements themselves are not probative in respect of the degree of acquired distinctiveness of the Opponent's Marks, the Opponent's Word Marks or the Opponent's New Marks in association with these services.

[23] I am also in substantial agreement with the applicant's general comments concerning Mr. Laird's evidence set out at paragraph 31 of its written argument:

31. . . . some important points to note concerning Mr. Laird's evidence include the following:

(a) Mr. Laird's Affidavit provides very little evidence of any actual use of the Opponent's Marks, the (currently) registered trade-marks CFLPA PRO PLAYERS LOGO and AJLCF PRO PLAYERS LOGO, or the trade-marks CFLPA PRO PLAYERS and AJLCF PRO PLAYERS (the "Opponent's Word Marks"), within the meaning of Section 4(2) of the Act in association with services, and virtually no evidence of use of the Opponent's Marks or the Opponent's Word Marks in association with wares within the meaning of Section 4(1) of the Act (with the exception of some use of the Opponent's CFLPA PRO PLAYERS LOGO and the CFLP A PRO PLAYERS word mark and trade-name in association with newsletters, which were distributed only to professional football players in the Canadian Football League ("Players").

(b) Mr. Laird states in his Affidavit that in 2008 the Opponent adopted and began using a different PRO PLAYERS Football Design Logo (shown below) and representing itself to CFL players and to the public in association with the words "PRO PLAYERS" (the Opponent's New Marks). There is very little evidence of any actual use of the Opponent's New Marks within the meaning of Section 4(2) of the Act in association with services, and virtually no evidence of use of the Opponent's New Marks in association with wares within the meaning of Section 4(1) of the Act (with the exception of some use of the Opponent's New Marks in association with newsletters, which were distributed only to the Opponent's player members).



(c) Mr. Laird's Affidavit does not evidence any confusion between the Opponent's Marks or the Opponent's Word Marks and the Applicant's Mark.

(d) Mr. Laird's Affidavit makes it clear that the Opponent began using its new marks, PRO PLAYERS Football Design Logo and PRO PLAYERS, in 2008. Based on this admission and the evidence before the Board including the lack of evidence showing use of the Opponent's Marks, CFLPA PRO PLAYERS LOGO and AJLCF PRO PLAYERS LOGO, from 2009 on (and very little, if any, evidence of actual use prior to 2009), it seems clear that these marks were abandoned by the Opponent at least as early as 2008. Indeed, the registrations for TMA659,743 for the trade-mark CFLPA PRO PLAYERS LOGO, and TMA660,479 for AJLCF PRO PLAYERS LOGO are the subject of current Section 45 proceedings initiated by the Applicant in 2010. If successful, the registrations pertaining to the Opponent's Marks are liable to be expunged for non-use or to be amended to eliminate some or all of the wares and services claimed in said registrations.

(e) Out of the more than thirty licence agreements included in Mr. Laird's affidavit, only the agreements included as Exhibit "J" relate to clothing, the balance of the agreements covering wares are personality rights licences

which only deal with trade-mark licensing in a secondary manner, with no evidence to confirm that the licensed wares were ever offered in association with any of the Opponent's trade-marks. The licensed products to which these license agreements pertain go hand in hand with personality rights licensing, namely player cards, bobble-head figurines, calendars, pre-paid credit cards, football based strategy board games, locker room photographs and photographs of football players.

[24] As mentioned earlier (see para. 7, above), the Section 45 proceeding referred to in paragraph 31(f) of the applicant's written argument, above, did in fact result in deleting some of the services and all of the wares claimed in the opponent's registrations

Kyle Runzer

[25] Mr. Runzer's affidavit evidence is summarized at paragraph 10 of the opponent's written argument as follows:

Mr. Runzer, at the time he swore his affidavit, was a student-at-law . . . His affidavit contains numerous exhibits. Exhibits A to C contain copies of internet website pages from websites owned by the Opponent. Exhibits D to L contain information on an internet archive website known as the "Wayback Machine," and copies of pages of the Opponent's websites as they appeared from November 2004 to June 2006. Exhibits M and N contain information concerning the domain names, "cflpa.com" and "proplayers.ca", as owned by the Opponent.

[26] I agree with the applicant's submissions, at pages 15-17 of its written argument, regarding Mr. Runzer's evidence that (i) the opponent's services under its marks CFLPA PRO PLAYERS and PRO PLAYERS are offered by, directed to, or relate to professional football players, (ii) as of the date of Mr. Runzer's affidavit, December 21, 2010, there does not appear to be any use of the opponent's registered marks.

APPLICANT'S EVIDENCE

Lester Blum

[27] Mr. Blum identifies himself as the Vice President of the applicant company, PEI Licensing, which is a wholly owned subsidiary of Perry Ellis International ("Perry Ellis" or "the Company"). Perry Ellis is a leading producer of men's and women's apparel in the United States and internationally. PEI Licensing owns the Company's Canadian and U.S. trade-marks and licenses the Company's trade-marks in the U.S. and in Canada. The applicant PEI Licensing exercises control over the character and quality of wares which

are manufactured and sold by third parties under license and which bear the Company's marks. In Canada, Perry Ellis products are distributed by, among others, The Bay, Sears, Winners and Costco.

[28] I do not believe that reviewing Mr. Blum's evidence in further detail would serve a useful purpose. This is because Mr. Blum's evidence regarding the use of the applicant's marks in Canada is stated in generalities and is too vague to establish anything above minimal use of its marks in Canada. In this regard, I find that the opponent's critique of Mr. Blum's evidence, at paragraphs 13-21 of its written argument, portions of which are shown below, is, for the most part, fair comment:

13. . . . Mr. Blum's affidavit contains a number of statements that the Trade-mark had been licensed to CBK and Knothe Apparel Group in respect of certain wares, and for the sale of these wares in Canada. Mr. Blum's affidavit does not contain . . . any evidence as to any sales of the licensee's wares in Canada or whether any such wares sold in Canada even bore the Trade-mark [PRO PLAYER].

14. Paragraphs 3 to 7 of Mr. Blum's affidavit sets out background information of the Applicant's business, none of which pertains to the use of the Trade-mark in Canada.

15. Paragraphs 8 to 11 of Mr. Blum's affidavit sets out information regarding the business activities of the Applicant around the world, including Canada, and its licensing business with third parties to produce clothing sold around the world. . .

16. Paragraphs 12 to 15 of Mr. Blum's affidavit set out the Applicant's revenues and advertising activities, however, no evidence is provided as to the revenue generated by the Applicant in Canada nor is there any evidence provided that the Applicant advertised its wares in Canada at all, let alone any wares bearing the Trade-mark.

17. Paragraphs 16 to 22 of Mr. Blum's affidavit set out background information concerning the history of the Applicant's use of the PRO PLAYER trade-mark, none of which pertains to use of the same in Canada.

18. Paragraphs 23 to 41 of Mr. Blum's affidavit allege the use and license of PRO PLAYER to a variety of third parties, of which Mr. Blum further alleges they have used the mark in Canada. In reviewing these statements and the corresponding exhibits, it is observed that there is no evidence of use of the PRO PLAYER mark in Canada, either by the Applicant or its alleged licensees.

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20. Exhibits "2", "3" and "4" of Mr. Blum's affidavit set forth examples of clothing catalogues of Sam's Club prepared by Knights Apparel, a licensee of the Applicant. All of the examples of clothing in these exhibits pertain to American universities; there are no examples of such wares pertaining to Canadian universities. . .

21. Exhibit "5" of Mr. Blum's affidavit contains pages from the Applicant's website, located at www.proplaver.com. . . there is no evidence provided as to whether there was ANY traffic to this web site by any persons located in Canada let alone whether there were any sales of wares bearing the Trade-mark to any persons located in Canada . . .

Mark Faassen

[29] Mr. Faassen identifies himself as an articling student with the firm representing the applicant. His affidavit serves to introduce into evidence, by way of exhibits, materials downloaded from the Internet. The exhibits include (i) copies of articles originally published in the United States concerning the history of the applicant's mark PRO PLAYER and (ii) auction listings from ebay.com for various items of clothing bearing the mark shown below.



[30] The applicant's mark, above, was registered in Canada in 1992 (under registration No. TMA404,013) but was expunged in 2010 as a consequence of the applicant not filing evidence in respect of a s.45 proceeding commenced in June 2009: see para. 32, below.

[31] The opponent in its written argument submits that "Mr. Faassen's affidavit provides no evidence of use of the Trade-mark [PRO PLAYER] in Canada." I agree.

OPPONENT'S REPLY EVIDENCE

Jada Lui

[32] Ms. Lui identifies herself as a paralegal employed by the firm representing the opponent. Her affidavit serves to introduce into evidence, by way of an exhibit, the file

wrapper history for registration No.TMA404,013 for the mark PRO PLAYER & Design referred to in para. 30, above.

ASSESSING CONFUSION – S.(6)(5) FACTORS

[33] As mentioned earlier, the determinative issue for decision is whether the applied-for mark PRO PLAYER is confusing with the opponent's mark PRO PLAYERS.

First Factor - Inherent and Acquired Distinctiveness

[33] The parties' marks possess relatively low degrees of inherent distinctiveness. In this regard, the opponent's marks are highly suggestive, if not descriptive, of the opponent's services, that is, offering the services of professional athletes playing in the Canadian Football League. The opponent's marks are weak marks and therefore entitled to a narrow scope of protection. The applied-for mark is somewhat laudatory of the applicant's wares as PRO PLAYER alludes to a quality of wares suitable for professional athletes. I do not consider that either party has established any significant acquired distinctiveness for their marks in Canada, nor has the opponent established any significant acquired distinctiveness for its trade-names. I therefore find that the first factor in s.6(5), which is a combination of inherent and acquired distinctiveness, favours neither party.

Second Factor - Length of Time in Use

[34] It appears that the opponent used its registered marks and word marks from 2004 to about 2008, at which time the opponent began to use its new mark PRO PLAYERS & Design. There is insufficient evidence to establish that any of the opponent's marks were used for any meaningful length of time in relation to wares rather than to licensing services. Similarly, there is insufficient evidence to establish that the applied-for mark was used for any meaningful length of time. Thus, the second factor in s.6(5) does not favour the opponent to a significant extent as the applied-for mark is for use in association with wares rather than with licensing services similar to the opponent's services.

Third and Fourth Factors - Nature of the Wares, Services or Business and Trades

[35] I have already found that the opponent has not established use of its marks in association with wares. I am also in substantial agreement with the applicant's submissions regarding the parties' services and trades found at paras. 128-130 of the applicant's written argument:

128. The Opponent's services also appear to be offered to professional athletes of the Canadian Football League, to the Canadian Football League, and to companies desiring to license the services, names, nicknames, photographs, designs, likenesses, images, visual representations and signatures of professional athletes of the Canadian Football League and the use of the name, trade-marks and logos of the Applicant. The Opponent's services are not offered in the same retail channels where the Applicant's wares would be offered, namely, department stores and the like, rather, they [sic] Opponent's services are offered in an entirely different channel of trade.

129. With regard to the overlap in the channels of trade (if any) between the applied-for wares of the Applicant and the wares covered by the Opponent's registrations, while it is conceivable (theoretically) that the wares (currently) covered by the Opponent's registrations could be sold in department stores, there is no evidence that any of the wares covered by the Opponent's registrations (or detailed in the Opponent's evidence) were ever sold or offered for sale in association with any of the Opponent's marks, much less sold or offered for sale in department stores or even retail stores for that matter.

130. With respect to the Opponent's wares which could conceivably be sold in retail channels, it is also noteworthy that, the primary markings of such wares (including name and logo jerseys) appear to be the CFL member clubs logos and team colours, the name and player number of the Opponent's Players and lastly, if at all, a reference to CFLPA.

The third and fourth factors in s.6(5) therefore favour the applicant.

Fifth Factor - Resemblance

[36] I consider that there is a high degree of resemblance between the parties' marks in all respects, that is, visually, in sounding and in ideas suggested as the applied-for mark PRO PLAYER is almost identical to either the dominant portion (or a dominant portion) of the opponent's marks (or trade-names), that is, the term PRO PLAYERS.

JURISPRUDENCE

[37] I have taken guidance from jurisprudence concerning "weak" marks generally and more particularly from the Court's approach to marks which are weak because they

are descriptive, as discussed in *Handi-Foil Corporation v. Sunbeam Products Inc.* 2014 TMOB 35, yet unreported:

[38] In *Coventry Inc. v. Abrahamian* (1984), 1 CPR (3d) 238 (FCTD), the opponent was relying on its mark SARAH used in association with costume jewellery to oppose the mark ZAREH used in association with custom-made (real) jewellery. The opponent's mark was not inherently strong and had not acquired significant distinctiveness through use or advertising or other means:

at p. 240

The trade mark SARAH is a commonly used female Christian name and as such offers little inherent distinctiveness: *Bestform Foundations Inc. v. Exquisite Form Brassiere (Canada) Ltd.* (1972), 34 C.P.R. (2d) 163. Such marks are considered to be weak marks and are not entitled to a broad scope of protection: *American Cyanamid Co. v. Record Chemical Co. Inc.* (1972), 7 C.P.R. (2d) 1, [1972] F.C. 1271; and *GSW Ltd. v. Great West Steel Industries Ltd. et al.* (1975), 22 C.P.R. (2d) 154. . . . However, the degree of distinctiveness attributed to a weak mark may be enhanced through extensive use: *GSW Ltd. v. Great West Steel, supra.*

(underlining added)

[39] The Court in *Coventry* upheld the Board's finding that the marks were not confusing. I am aware that the *Coventry* case is distinguishable from the instant case in that (i) there was less resemblance between the marks in issue and (ii) the parties' wares were sold through different channels of trade.

[40] The principles set out in *Coventry* have been applied in numerous cases including, for example, *Boston Pizza International Inc. v. Boston Chicken Inc.* (2001), 15 CPR (4th) 345 (FCTD). Boston Pizza sought to expunge registration of the trade-mark BOSTON CHICKEN, used in association with takeout restaurant and catering services, alleging confusion with its mark BOSTON PIZZA, used in association restaurant services and wares including pizza. The Court found that the marks were not confusing. Shown below is the Court's discussion of the ambit of protection to be accorded to descriptive marks, at para. 66:

[66] I commence with para. 6(5)(a) -- the inherent distinctiveness of the trade-marks or trade names and the extent to which they have become known. Neither the applicant's mark [BOSTON PIZZA], nor that of the respondent [BOSTON CHICKEN] is inherently distinctive. I adopt, in that regard, the words of Rouleau J. in *Prince Edward Island Mutual Insurance v. Insurance Co. of Prince Edward Island* (1999), 86 C.P.R. (3d) 342 (F.C.T.D.), where the learned judge states the following at paras. 32, 33 and 34:

[32] With respect to the first factor in subsection 6(5) of the Act, inherent distinctiveness of the trade marks in question, it is well established that marks which contain descriptive words are not inherently distinctive and

will be afforded only a minimal degree of protection by the Court. In particular, trade marks or trade names which contain a reference to a geographic location, such as those in issue here, are descriptive rather than distinctive and do not deserve a wide ambit of protection. Where the court is called upon to determine the "likelihood of confusion" in respect of a descriptive name or mark, even small differences between the marks will be sufficient to diminish the "likelihood of confusion".

[33] Furthermore, where a party adopts a descriptive name, it must accept that a certain amount of confusion may arise. In *Walt Disney Productions v. Fantasyland Hotel Inc.* (1994), 56 C.P.R. (3d) 129 (Alta. Q.B.); affirmed (1996) 67 C.P.R. (3d) 444 (Alta. C.A.); the Court made the following comments in this regard at p. 183:

"Even where services are identical, where the name is descriptive rather than distinctive, a certain amount of confusion may be inevitable without sanction . . . *Office Cleaning Services Ltd. v. Westminster Window and Sign General Cleaners Ltd., supra.* In the latter authority, Lord Simonds, at p. 41, said:

'So long as descriptive words are used by two traders as part of their respective trade names, it is possible that some members of the public will be confused whatever the differentiating words may be . . . It comes in the end, I think, to no more than this, that where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must run unless the first user is allowed unfairly to monopolize the words. The Court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.'"

(emphasis added)

Of course, the principles that apply to trade-names apply equally to trade-marks.

[41] Former Chairman Partington applied the principles in *Coventry*, above, in *Drexel Heritage Furnishings Inc. v Hoo Cheung Industries Limited*, 1998 CanLII 18462 (CA TMOB) at page 4:

With respect to the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark HERITAGE CEILING FANS & Design as applied to "Ceiling fans" and the opponent's registered trade-mark HERITAGE covering "Living room, bedroom and dining room furniture, occasional tables and chairs for household, office and public use" possess little inherent distinctiveness. As noted by the then Registrar of Trade-marks in *Drexel Enterprises Division, U.S. Plywood-Champion Papers Inc. v. National Homes Ltd.*, 21 C.P.R. (2d) 149, at p. 152, the word "Heritage" is commonly understood to refer to something of value from the past and when used in respect of such wares as furniture, the word indicates furniture being a replica or incorporating the design of older accepted styles. Likewise, the applicant's mark suggests that its ceiling fans are based on designs from the

past. As a result, the trade-marks at issue are weak marks and, in the absence of significant evidence of acquired distinctiveness, are only entitled to a narrow ambit of protection.

(emphasis added)

[42] In the result the opposition was rejected. I am aware that, unlike the present case, Chairman Partington did “not expect there to be any overlap in the channels of trade” between the parties’ wares.

[43] I have also been guided by the *dicta* of the Court in *S. C. Johnson & Son, Ltd. et al. v. Marketing International Ltd.* 44 CPR (2d) (1979) 16 (SCC), which concerned an infringement action. The action was brought by S. C. Johnson, the owner of the mark OFF!, used in association with a personal insect repellent, against Marketing International who used the mark BUGG OFF in association with an insect repellent cloth. The infringement action failed. Among other things, the Court found (at p. 26) that “no one could have an exclusive proprietary right in relation to the word ‘off’ as applied to an insect repellent” because (at p. 25) the mark (OFF!) was descriptive of the effect or purpose of the wares. Similarly, in the instant case, the mark COOK-N-CARRY is descriptive of the purpose of the opponent’s wares and is therefore entitled to only a narrow ambit of protection.

CONCLUSION

[38] In the instant case, considering in particular that the opponent has not established that its marks or trade-names acquired significant degrees of distinctiveness in Canada, that any reputation for the opponent’s marks and trade-names are limited to a restricted set of entrepreneurs and professional football players, that there is no demonstrated connection between the applicant’s wares and the opponent’s services, and considering the jurisprudence with respect to traders monopolizing words descriptive of the wares/services to be sold, I find that, at all material times, the applied-for mark PRO PLAYER was not and is not confusing with any of the opponent’s trade-marks or trade-names. Accordingly, the opposition is rejected.

APPLICATION No. 1,344,156 - P2 BY PRO PLAYER & Design

[39] The application and file history for the mark P2 BY PRO PLAYER & Design, shown below, parallels the PRO PLAYER application and file history, discussed above, in all respects.



[40] The issues, evidence and material dates in the P2 BY PRO PLAYER & Design opposition are entirely analogous to the PRO PLAYER opposition, with one notable exception: there is far less resemblance between the applied-for mark P2 BY PRO PLAYER & Design and the opponent's marks and trade-names as the dominant component of the applied-for mark is the stylized portion P2. I therefore find that, at all material times, the applied-for mark P2 BY PRO PLAYER & Design was not and is not confusing with any of the opponent's trade-marks or trade-names.

DISPOSITION

[41] The oppositions to the marks PRO PLAYER and P2 BY PRO PLAYER & Design are rejected. These decisions have been made pursuant to a delegation of authority by the Registrar of Trade-marks under s.63(3) of the *Trade-marks Act*.

Myer Herzig, Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office