



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

**Citation: 2014 TMOB 44**  
**Date of Decision: 2014-03-03**

**IN THE MATTER OF AN OPPOSITION  
by National Hockey League to application  
No. 1,425,027 for the trade-mark  
Montreal Maroons in the name of Todd  
Mikl, David Michael and Katherine Elo, a  
partnership**

[1] Todd Mikl, David Michael, and Katherine Elo (the Applicant) applied for the trade-mark Montreal Maroons (the Mark) for use in association with a number of wares including clothing, sports equipment, novelty goods, stationery and digital images on January 20, 2009. On February 10, 2009, the applicant was revised to Todd Mikl, David Michael and Katherine Elo, a partnership (the Amended Applicant). The wares as revised are attached as Schedule A to this decision (the Wares). The National Hockey League (the Opponent) has opposed this application primarily on the basis that consumers will be confused between the Mark and its MONTREAL MAROONS trade-mark associated with its hockey team which played in Montreal from 1924-1938 and its promotional, marketing and merchandising activities commemorating this team.

[2] For the reasons that follow, I find that this application should be refused.

Background

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 17, 2011.

[4] On January 13, 2012, the Opponent opposed the application on several grounds. The Opponent has pleaded non-compliance with section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) as the basis of two of its grounds of opposition. These grounds of opposition relate to whether the Applicant could have had the intention to use the Mark in Canada and been satisfied of its entitlement to do so. The remaining grounds turn on the determination of the likelihood of confusion between the Mark and the use of the Opponent's MONTREAL MAROONS trade-mark in association with hockey entertainment services and related promotional, marketing and merchandising activities commemorating the Montreal Maroons hockey team.

[5] The Opponent filed as its evidence the affidavits of Thomas H. Prochnow and Dane Penney. The Applicant did not file evidence. Both parties filed a written argument and attended a hearing held on February 11, 2014.

[6] As I indicated to the Applicant's representative, Mr. Michael, at the hearing any submissions that are not supported by evidence cannot be taken into consideration. In particular, Mr. Michael submitted that the Applicant was a partnership at the filing date of the application and that it was a musical group and as such that its wares were considerably different than those of the Opponent.

#### Evidential Burden and Legal Onus

[7] Before considering the various grounds of opposition, it is necessary to review some of the technical requirements with regard to (i) the evidential burden on the opponent to support the allegations in the statement of opposition and (ii) the legal onus on the applicant to prove its case.

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

the applicant to show that the application does not contravene the provisions of the Act as alleged by the opponent (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant.

### Material Dates

[9] The material dates with respect to the grounds of opposition are:

- sections 38(2)(a)/30 of the Act - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(c)/16(3) of the Act – the filing date of the application; and
- section 38(2)(d) of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

### Section 30(e) Ground of Opposition

[10] The Opponent has opposed the application on the basis that the Applicant was not a “person” as defined in section 2 of the Act and therefore could not have had a bona fide intention to use the Mark. The Opponent submits that:

- the application was filed in the name of Todd Mikl, David Michael and Katherine Elo - three separate individuals who could not constitute a “person”;
- the application was amended to add the words “a partnership” however there was no evidence or statement from the Applicant to establish that the partnership existed at the filing date; and
- without that the Applicant’s name could not be amended.

[11] The relevant sections of the Act and *Trade-marks Regulations*, SOR/96-195 (Regulations) are set out below.

Act

2 “person” includes any lawful trade union and any lawful association engaged in trade or business or the promotion thereof, and the administrative authority of any country, state, province, municipality or other organized administrative area;

30(e) in the case of a proposed trade-mark, a statement that the applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the trade-mark in Canada;

Regulations

31(a) No application for the registration of a trade-mark may be amended where the amendment would change the identity of the applicant, except after recognition of a transfer by the Registrar;

[12] The requirement in section 30(e) for an applicant to state that it intends to use the applied for mark in Canada is not merely pro forma, that is, the named applicant must have an actual intention to use it [*Dollar General Merchandising Inc v Steinberg* (2009), 74 CPR (4th) 341 (TMOB)]. The initial burden on an opponent is light respecting the issue of non-conformance with section 30(e) of the Act, because the facts regarding an applicant’s intention are particularly within the knowledge of an applicant [*Tune Masters v Mr P. ’s Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89]. The opponent can meet its evidential burden by reference to the actions taken by the applicant during prosecution of the application [*SmithKline Beecham Corp v Pierre Fabre Médicament*, [1998] TMOB No 141]. If there is an amendment to the name of the applicant, the Trade-marks Opposition Board may consider the propriety of the amendment if challenged by an opponent [*LendingTree, LLC v Lending Tree Corp* (2006), 48 CPR (4th) 355 (FC), aff’d (2007), 55 CPR (4th) 385 (FCA) at paras 19-20].

[13] In this case, I find that the Opponent has met its light burden of raising doubt as to whether the application complies with section 30(e). The application as filed is consistent with the Opponent's allegation that the application was filed in the name of three individuals since no lawful association is referenced. When two or more individuals or legal entities apply for the registration of a trade-mark, they must form a lawful association, such as a partnership or a joint

venture to be a “person” in accordance with section 2 of the Act [*Compagnie des Montres Longines Francillon SA v Pinto Trading Co* (1983), 75 CPR (2d) 283 (TMOB)]. Therefore, the Applicant is not a “person” as required by the Act. While the application was subsequently amended to reference a partnership, in these circumstances where the Amended Applicant did not make a statement that it existed at the time of filing, nor was any evidence filed subsequently proving this, the Opponent has raised sufficient doubt as to whether the Amended Applicant is a “person” in accordance with section 2 of the Act. As the Applicant has filed no evidence it has not met its legal onus. Finally, I note that the Applicant had ample time to address this issue through the filing of evidence as it was raised in the Statement of Opposition and in the Opponent’s written argument.

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

[14] The section 30(i) ground of opposition alleges in part that the Applicant could not have been satisfied that it was entitled to use the Mark because it must have been aware of the MONTREAL MAROONS 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, this part of the section 30(i) ground is dismissed.

[15] The section 30(i) ground of opposition further alleges that the Applicant could not have been satisfied it was entitled to use the Mark because at the time of filing of the application, the Applicant was not a person as defined in Section 2 but rather was multiple individuals and could not hold the belief that it was entitled to apply for or use the mark. For the reasons set out with respect to the section 30(e) ground of opposition, this ground of opposition is successful.

#### Distinctiveness

[16] The Opponent pleads that the Mark is not distinctive because of the Opponent’s and its licensees use of the trade-mark MONTREAL MAROONS in association with hockey entertainment services and related promotional marking and merchandising activities, all of which are commemorative of a hockey team.

[17] There is an initial burden on the Opponent to establish that, as of January 13, 2012, the MONTREAL MAROONS trade-mark was known to such an extent that it could negate the distinctiveness of the Mark. The Opponent will have met its burden if its mark is known in Canada to some extent and its trade-mark's reputation is substantial, significant or sufficient or, in the alternative, that it is well known in a part of Canada [*Bojangles' International, LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC) at paras 33-34]. An attack based on non-distinctiveness is not restricted to the advertising or performance of services or sales of goods in Canada. It may also be based on evidence of knowledge or reputation of the Opponent's trade-mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD) at 58-59].

[18] The Opponent filed as its evidence the affidavits of Thomas H Prochnow and Dane Penney. Mr. Prochnow, is the Group Vice President, Legal and Business Affairs of National Hockey League Enterprises Canada, Inc (para 1 of the Prochnow affidavit). His responsibilities include matters relating to trade-marks owned by the NHL and its member clubs (para 2). Mr. Dane Penney is a Searcher employed by the Opponent's Agent (para 1 of the Penney affidavit) who used the Internet Archive Wayback Machine to locate and print the earliest archived versions of web-sites included in the Prochnow affidavit.

[19] The Montreal Maroons played in the NHL from 1924-1938 qualifying for the playoffs 11 times and winning the Stanley Cup Championship in 1926 and 1935 (para 5 of the Prochnow affidavit). The NHL promotes the history of the NHL and its past teams by marketing, distributing and displaying apparel, souvenirs, and commemorative material featuring the names and trade-marks used by former NHL clubs, including the MONTREAL MAROONS, MAROONS and M Design trade-marks (para 10 of the Prochnow affidavit). Mr. Prochnow states that Montreal Maroons T-shirts, pins, pucks and caps have been available for sale in Canada since 2007 and provides pictures of these goods featuring the M Design and MONTREAL MAROONS trade-marks historically used by the Montreal Maroons (paras 11-12, 18 and Exhibits E,F,G,L). Further, Mr. Prochnow states that the Opponent's corporate sponsors have distributed items including these marks such as t-shirts, USB keys, and tins with the logos of the Stanley Cup champions (paras 15-17; Exhibits I-K).

[20] Mr. Prochnow also provides print-outs of web-sites about or referencing the Montreal Maroons team. Information about the Montreal Maroons and their history appears on the following web-sites *www.legendsofhockey.net*; *www.hockeylegend.com*; *www.thehockeywriters.com*; *www.montrealmaroons.blogspot.com*; *Goaliesarchive.com*; *icehockey.wikia.com*; *ourhistory.canadiens.com* and *Wikipedia*. In each case, Mr. Penney's affidavit confirms that these web-sites were archived prior to July 2011 (Exhibit A) [*Candrug Health Solutions Inc. v. Thorkelson* (2007), 60 CPR (4th) 35 (FC); reversed on other grounds 2008 FCA 100]. However, there is no information regarding how many Canadians have viewed these web-sites.

[21] Pages from the books *The Official Illustrated NHL History The Story of the Coolest Game on Earth* and *Total Hockey The Official Encyclopaedia of the National Hockey League* (in print since 1999 and 1998 respectively) referencing the Montreal Maroons are also provided by Mr. Prochnow (para 8, Exhibit C). Mr. Penney provides a copy of the cover, publisher information and introduction to the book *The Montreal Maroons* (published January 1, 1999) by William Brown (Exhibit B). Again, there is no information as to how many copies have been sold or how widely circulated these books are in Canada.

[22] Mr. Prochnow also provides a series of newspaper articles published from 1928-2004 referencing the Montreal Maroons. The only newspaper articles published after 2000 are:

- the New York Times article *Devils Snap Out of Funk, at Maple Leafs' Expense* dated January 11, 2004 which mentions the Montreal Maroons goaltender Lorne Chapot who has eight shut outs (Exhibit B); and
- the New York Times article *The Case for Playing All Night* dated May 31, 2009 discussing overtime which states "far behind the 116:30 of overtime in 1936, when a rookie, Mud Bruneteau, scored the only goal as the Red Wings beat the Montreal Maroons in the first game of the semifinals." (Exhibit B).

[23] While there is sufficient evidence for me to find hockey fans would be aware of the Montreal Maroons team, in the absence of information quantifying how many goods including the Montreal Maroons trade-mark were distributed or how many Canadians have been exposed to the Montreal Maroons trade-mark and/or team name, I am unable to determine that the Opponent's trade-mark's reputation was substantial, significant or sufficient as required by

*Bojangles*. Accordingly, I find that the Opponent has not met its initial burden and this ground of opposition is dismissed.

### Section 16 Confusion

[24] The Opponent also pleads that the Applicant is not the person entitled to registration because the Mark is confusing with the Opponent's MONTREAL MAROONS trade-mark which has previously been used in Canada in association with hockey entertainment services and related promotional, marketing and merchandising activities and consumer merchandise, all of which are commemorative of a hockey team.

[25] The Opponent has an initial evidential burden to prove that it had used the Opponent's MONTREAL MAROONS trade-mark prior to the filing date of the application, January 20, 2009. The Opponent must also demonstrate that it had not abandoned its trade-mark at the date of advertisement of the Mark, August 17, 2011.

[26] I find that Mr. Prochnow's evidence that the MONTREAL MAROONS trade-mark has appeared on t-shirts and pins available for sale since 1996 is sufficient to meet the Opponent's burden (Exhibits E and L; paras 11,18). While it would have been preferable if Mr. Prochnow had confirmed sales, in the absence of a challenge to his evidence by cross-examination, given the length of time products were available it is reasonable to infer sales occurred.

[27] Section 6(2) of the Act states that there is a likelihood of confusion 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. Confusion will also be found if consumers believe that the wares or services are somehow approved, licensed or sponsored by an opponent [*Big Apple Ltd v BAB Holdings Inc* (2000), 8 CPR (4th) 252 (TMOB) at para 5; *Office of the Commissioner of Baseball v GWE Group Inc*, 1999 CanLii 19569 (TMOB)].

[28] In assessing confusion, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: 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.

[29] These criteria 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.

*degree of resemblance*

[30] The parties' marks are identical.

*inherent distinctiveness and extent known*

[31] This factor favours the Opponent. The marks of each party are inherently distinctive. Other than a relationship to the city of Montreal, there is no apparent connection between the marks of each party and their respective wares. Furthermore, it appears there is at least some knowledge of the Opponent's MONTREAL MAROONS trade-mark amongst hockey fans and those knowledgeable about hockey, whereas there is no evidence that the Mark is known to any extent.

*length of time in use*

[32] This factor favours the Opponent as there is no evidence that the Applicant has used the Mark.

*nature of the wares, services, business or trade*

[33] This factor favours the Opponent. The application as filed included numerous hockey related wares including hockey jerseys, miniature and full size hockey sticks, and hockey equipment. Even though these wares have been deleted, their inclusion in the initial application suggests a relationship between hockey related goods and the Wares. Furthermore, the Wares

could be considered to be souvenir or commemorative type goods related to a NHL team. Mr. Prochnow's evidence is that the following goods have been available for sale or distributed with the MONTREAL MAROONS or M Design trade-marks: hockey pucks (Exhibit F), t-shirts (Exhibits E, I), USB keys (Exhibit J), a tin featuring Stanley Cup champions (Exhibit K), pins (Exhibits E, L), hats (Exhibit E), and trading cards (Exhibit H). In addition to the items identified above, the following NHL team goods have been available: key chains, framed team logos, charms, earrings, rings, money clips, spoons, and jackets (Exhibit G). In the absence of evidence from the Applicant as to the nature of its wares and trade or a restriction in the application, this factor favours the Opponent as the Wares could be commemorative of a hockey team.

*conclusion re likelihood of confusion*

[34] As the parties' marks are identical and given the nature of the Wares, I find that there is a likelihood of confusion as consumers may believe that such goods are approved, licensed or sponsored by the Opponent. I am not satisfied that the Applicant has discharged its burden of showing that there is no reasonable likelihood of confusion between the parties' marks. Having regard to the foregoing, I find that the non-entitlement ground of opposition based on section 16(3)(a) of the Act is successful.

Disposition

[35] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

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

## Schedule A

### Wares

(1) Clothing, namely skirts, pants, shirts, jackets, tee shirts, golf shirts, sweat shirts, sweaters, sleepwear, lacrosse jerseys, football jerseys, socks, pullovers, short pants, scarves, turtle necks, mock necks, undergarments, vests, capes, dresses, hoodies, neck warmers, headbands and wristbands; footwear, namely, athletic shoes, boots, and football shoes; bags, namely athletic, golf, duffle, overnight and knapsacks; household gloves for general use, mittens; belts and belt buckles; hats, toques visors and sun visors; coffee mugs and drinking glasses; stationary, namely pens, pencils, paper, envelopes, notebooks, binders, calendars, postcards, wrapping paper, posters; novelty items, namely collectable figurines, comic books, playing cards, emblem badges, party balloons, novelty pins and buttons, keychains, clocks and watches, umbrellas, lunch boxes, cloth towels, and household wallpaper; pre-recorded CD's and DVD's containing music and video; computer accessories, namely mouse pads; golf equipment, namely balls, tees, golf gloves and golf club covers; soccer equipment namely balls; football equipment namely miniature and full size footballs; baseball equipment, namely bats and balls and baseball uniforms; digital photographic images downloadable to a computer or any wireless device via a global communications network.