



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

Citation: 2012 TMOB 94
Date of Decision: 2012-05-29

**IN THE MATTER OF AN OPPOSITION
by Groupe Procycle inc. to application
No. 1,473,720 for the trade-mark BIKE
ATTITUDE in the name of CASTELLO
CYCLE COMPANY LTD.**

[1] On March 18, 2010, CASTELLO CYCLE COMPANY LTD. (the Applicant) filed an application to register the trade-mark BIKE ATTITUDE (the Mark) based on use in Canada since August 1, 2007 in association with “Bicycles and bicycle parts, namely, bells, brakes, brake shoes, chains, fenders, forks, frames, front fork joints, gears, handle bars, handle bar ends, handle bar grips, bicycle grip tape, handle bar stems, horns, kickstands, pedals, saddle covers, saddles, seat posts, sprockets, water bottle cages, wheels; bicycle stands; bicycle pumps; bicycle training wheels; frames for luggage carriers, frames for bicycles; suspension systems for bicycles; wheel hubs for bicycles; tricycles” (the Wares).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 25, 2010.

[3] On September 20, 2010, Groupe Procycle inc. (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- Pursuant to s. 38(2)(b) and 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the Mark was not registrable as it was confusing with the Opponent’s trade-mark ALTITUDE registered under No. TMA429,690 for “bicycles”.

- Pursuant to s. 38(2)(c) and 16(1)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because at the date of filing the Mark was confusing with the Opponent's trade-mark ALTITUDE previously used in Canada in association with bicycles.
- Pursuant to s. 38(2)(d) and 2, the Mark is not distinctive because it cannot actually distinguish the Wares from the wares of others, namely those of the Opponent in association with the Opponent's trade-mark ALTITUDE.

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

[5] In support of its opposition, the Opponent filed the affidavit of Raymond Dutil, sworn March 4, 2011 with Exhibits RD-1 to RD-4. The Applicant did not file any evidence.

[6] Neither party filed a written argument. An oral hearing was not conducted.

Section 12(1)(d) Ground

[7] An opponent's initial onus is met with respect to a s. 12(1)(d) ground of opposition if the registration relied upon is in good standing as of the date of the opposition decision. The Registrar has discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. I have exercised that discretion and confirm that the registration for the Opponent's trade-mark ALTITUDE (TMA429,690) remains valid and therefore the Opponent has satisfied its evidential burden. I must now assess whether the Applicant has met its legal burden.

[8] 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.

[9] 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), 49 C.P.R. (4th) 321 (S.C.C.) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.).]

[10] Recently, in *Masterpiece*, the Supreme Court of Canada discussed the importance of the s. 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with s. 6 of the Act (see para 49):

...the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar. As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

[11] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)].

[12] Under the circumstances of the present case, I consider it appropriate to analyse the degree of resemblance between the parties' marks first.

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

[13] The only area of similarity between the parties' marks is the inclusion of the word "attitude" in the Mark. The word "attitude" is somewhat similar in appearance and sound to the Opponent's mark, ALTITUDE in that there is only one letter that differs between the two words. However, as will be seen below, the words have entirely different meanings.

[14] Both parties' marks are made up of dictionary words. I may refer myself to a dictionary to determine the meaning of words [see *Insurance Co. of Prince Edward Island v. Prince*

Edward Island Insurance Co. (1999), 2 C.P.R. (4th) 103 (T.M.O.B.)). I have looked into the *Canadian Oxford Dictionary* and found the following definitions:

- bike: “noun; a bicycle or motorcycle” or “intransitive verb; ride a bicycle or motorcycle”;
- attitude: “noun; a settled opinion or way of thinking. behaviour reflecting this”;
- altitude: “noun; the height of an object in relation to a given point, esp. sea level or the horizon”.

[15] Ultimately, when considering the marks as a whole, I am not convinced that the mere fact that the Mark contains the word “attitude” which is somewhat similar in appearance and sound to the Opponent’s trade-mark ALTITUDE is sufficient to find that the parties’ marks share any significant degree of similarity in appearance, sound or idea suggested.

[16] Having found that the parties’ marks do not resemble each other to any significant extent, I must now assess the remaining relevant surrounding circumstances to determine whether any of these other factors are significant enough to find a likelihood of confusion [see *Masterpiece*, *supra* at para 49].

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[17] As discussed above, in the analysis of the s. 6(5)(e) factor, the parties’ marks are made up of dictionary words. While the word “bike” is descriptive of the Wares, the addition of the word “attitude” which has no particular meaning in relation to the Wares creates some degree of inherent distinctiveness in the Mark. The Opponent’s mark possesses some inherent distinctiveness but this is diminished by virtue of the fact that the word “altitude” could be understood to be suggestive of a feature of the terrain on which the Opponent’s bicycles would be used.

[18] Based on the foregoing, I assess the degree of inherent distinctiveness of the party’s marks as being the same while noting that neither party’s mark is particularly strong.

[19] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. I will now turn to the extent to which the trade-marks have become known in Canada.

[20] The Applicant has not provided any evidence regarding the extent to which the Mark has become known and thus I can only conclude that it has not become known to any extent.

[21] In his affidavit, Mr. Dutil, states that the Opponent's mark has been used in association with bicycles since at least July 1990. In support of this statement, Mr. Dutil provides a sampling of catalogues and brochures which were circulated in Canada from 1991 – 2010. I acknowledge that the appearance of a trade-mark in a catalogue does not necessarily constitute evidence of use of the mark in association with wares in accordance with s. 4(1) of the Act. However, I note that the catalogues all feature photographs of the Opponent's bicycles and the bicycles in the photographs are clearly marked with the Opponent's mark. I am therefore willing to accept this as evidence of the appearance of the Opponent's bicycles at the dates of the various catalogues and thus I am satisfied that the Opponent has established that the ALTITUDE trade-mark has been marked on its bicycles since at least 1991.

[22] Mr. Dutil also provides a sampling of articles published in various magazines from 2008-2010 discussing the Opponent's ALTITUDE brand bicycles. I have not been provided with circulation figures for these magazines, all of which appear to be specialized bicycle publications. As a result, I am only able to conclude from this evidence that the Opponent's bicycles were mentioned in a selection of magazines from 2008-2010.

[23] Mr. Dutil provides sales figures and advertising expenditures, both of which appear to be substantial, for the three years prior to the date of swearing his affidavit, namely 2008-2011.

[24] Mr. Dutil provides sample invoices relating to bicycles sold by the Opponent under the ALTITUDE trade-mark in the years 2008-2011.

[25] I note that much of the evidence, including the brochures and invoices, refers to "Rocky Mountain Bicycles" as the source of the bicycles. I am satisfied that this is the Opponent as Mr. Dutil states in his affidavit that the Opponent also does business under the name "Rocky Mountain Bicycles".

[26] Based on a review of the evidence as a whole, I am satisfied that the Opponent has established a reputation for the Opponent in the ALTITUDE trade-mark.

Section 6(5)(b) – the length of time each has been in use

[27] The Applicant claims use of the Mark since August 1, 2007 in its application. However, no evidence of use has been adduced in support of this claim.

[28] As discussed further above in the analysis of the s. 6(5)(a) factor, I am satisfied that the Opponent has evidenced use of the Opponent's trade-mark ALTITUDE in Canada since 1991.

Sections 6(5)(c) and (d) – the nature of the wares, services or business and trade

[29] Both parties' wares cover bicycles and thus share a significant degree of overlap.

[30] In the absence of evidence regarding the Applicant's trade and in light of the overlap in the nature of the parties' wares, I am prepared to infer that the parties' channels of trade could also overlap.

Conclusion

[31] As discussed above, in *Masterpiece* the Supreme Court of Canada highlighted the importance of the s. 6(5)(e) factor in the analysis of the likelihood of confusion. In the present case, I have found very little similarity between the parties' marks. I am of the view that none of the other factors assist the Opponent in overcoming this lack of similarity between the marks in terms of appearance, sound and ideas suggested. Therefore while the parties' wares share some degree of overlap, this is insufficient to result in a likelihood of confusion given the lack of similarity between the parties' marks.

[32] Having regard to the foregoing, I reject the ground of opposition based on s. 12(1)(d) of the Act.

Non-entitlement Ground – s. 16(1)(a) of the Act

[33] As discussed more fully in the analysis of the s. 12(1)(d) ground of opposition, I am satisfied that the Opponent's evidence supports a finding that the Opponent's mark had been used in Canada as of the material date and had not been abandoned at the date of advertisement thus the Opponent has met its evidential burden.

[34] I must now assess whether the Applicant has met its legal burden. Specifically, the onus is on the Applicant to establish on a balance of probabilities that there is no likelihood of confusion between the parties' marks.

[35] The difference in material dates is not significant and as a result my findings under the ground of opposition based on s. 12(1)(d) of the Act are equally applicable here. As a result, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the marks at issue. Having regard to the foregoing, I reject the ground of opposition based on s. 16(1)(a) of the Act.

Non-distinctiveness Ground – s. 38(2)(d) of the Act

[36] In order to meet its initial burden with respect to this ground, the Opponent must establish that the Opponent's mark was known to some extent at least in Canada as of September 20, 2010 [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.) and *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.)]. As stated in *Bojangles* at para 34:

A mark must be known to some extent at least to negate the established significance of another mark, and its reputation in Canada should be substantial, significant or sufficient.

[37] As discussed more fully in the analysis of the s. 12(1)(d) ground of opposition, I am satisfied that the Opponent's evidence supports a finding that the Opponent's mark had developed a reputation in Canada as of the material date and thus the Opponent has met its evidential burden.

[38] I must now assess whether the Applicant has met its legal burden. Specifically, the onus is on the Applicant to establish on a balance of probabilities that there is no likelihood of confusion between the parties' marks.

[39] The difference in material dates is not significant and as a result my findings under the ground of opposition based on s. 12(1)(d) of the Act are equally applicable here. As a result, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the marks at issue. Having regard to the foregoing, I reject the ground of opposition based on non-distinctiveness.

Disposition

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

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office