

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

Citation: 2013 TMOB 149
Date of Decision: 2013-09-05

**IN THE MATTER OF AN OPPOSITION
by Player's Company Inc. to application
No. 1,408,908 for the trade-mark
NAUTICAL & Design, in the name of
Edward Roundpoint**

[1] On August 28, 2008, Edward Roundpoint (the Applicant) filed an application to register the trade-mark NAUTICAL & Design shown below:



[2] The application is based on proposed use in Canada in association with “tobacco products” (the Wares).

[3] On December 1, 2009, Player's Company Inc. (the Opponent) filed a statement of opposition.

[4] In its statement of opposition (as amended), the Opponent provides that it is the owner of 23 trade-mark registrations, a list and particulars of which the Opponent attached as Schedules “A” and “B” to its statement of opposition, and a list of which is attached as Appendix “A” to this decision. In addition, the statement of opposition alleges that the Player’s Marks form a family of marks (the Player’s Family of Marks), centred around a sailboat design and nautical theme, which the Opponent submits are prominently featured in all of the Player’s Marks.

[5] Having regard to the above-noted Player’s Marks and the Player’s Family of Marks, the grounds of opposition (as amended) can be summarized as follows:

- Pursuant to sections 38(2)(a) and 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the Applicant could not have been satisfied that it was entitled to use the subject trade-mark in Canada in association with “tobacco products”, having regard to sections 20 and 22 of the Act for the following reasons:
 - The use of the Mark will be contrary to the provisions of section 20 of the Act insofar as the use of the Mark will be deemed to infringe Opponent’s exclusive right to the use throughout Canada of the Player’s Marks and the Player’s Family of Marks, since the Mark is confusing with the Player’s Marks and the Player’s Family of Marks.
 - The use of the Mark will be contrary to the provisions of section 22 of the Act insofar as the use of the Mark will be likely to have the effect of depreciating the value of the goodwill attaching to the Player’s Marks and the Player’s Family of Marks.
- Pursuant to sections 38(2)(b) and 12(1)(d) of the Act, the Mark is not registrable as it is confusing with the Player’s Marks and the Player’s Family of Marks.
- Pursuant to sections 38(2)(c) and 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because, as of the date of filing of the application the Mark was confusing with the Opponent’s Player’s Marks and the Player’s Family of Marks, all of which had been previously used and made known in Canada and none of which had been abandoned as of the date of advertisement of the application.
- Pursuant to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive and does not actually distinguish nor is it adapted to distinguish the wares of the Applicant from the wares of the Opponent, having regard to the adoption, use, making known and registration of the Player’s Marks and the Player’s Family of Marks, and the similarity between the subject trade-mark on the one hand, and the Player’s Marks and the Player’s Family of Marks on the other.

[6] 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.

[7] In support of its opposition, the Opponent filed the affidavits of Gay Owens and Paul Furfaro. The Applicant filed the affidavits of Karen E. Thompson and Greg Gilhooly.

[8] Only the Opponent filed a written argument and attended an oral hearing.

[9] Shortly before the oral hearing, the Opponent requested leave to file an amended statement of opposition to add two registrations to Schedules "A" and "B". The Opponent explained in its request that these registrations, although included in the Opponent's evidence, were inadvertently omitted from Schedules "A" and "B" of the statement of opposition at first instance. The agent for the Opponent explained that the omission was only realized during preparations for the oral hearing. As the Applicant was not in attendance at the oral hearing, a letter was sent to the Applicant, dated July 11, 2013, giving the Applicant an opportunity to submit comments in response to the Opponent's request for leave. The Applicant did not reply.

[10] The practice of the Trade Marks Opposition Board is to grant leave to amend a statement of opposition where it is satisfied that it is in the interest of justice to do so having regard to all the surrounding circumstances including (i) the stage the opposition proceeding has reached, (ii) whether the request for leave to amend could have been made at an earlier stage, (iii) the importance of the proposed amendment to the opponent and (iv) the extent to which the applicant would be prejudiced if leave was granted: see *Nabisco Brands Ltd, also trading as Christie Brown & Co v Perfection Foods* (1986), 12 CPR (3d) 456 at p. 458 (FCTD).

[11] While at a late stage of the proceedings, the reasons put forth by the Opponent are clear as to why the Opponent could not have made the request for leave to amend the statement of opposition earlier. With respect to the importance of the proposed amendment, the addition of the two registrations to Schedules "A" and "B" under the 12(1)(d), entitlement and distinctiveness grounds of opposition is central to the Opponent's family of marks submissions. Lastly, I agree with the Opponent that the amendment would not cause any prejudice to the

Applicant since a review of the evidence shows that these marks were included in the Opponent's evidence. Thus, the Applicant would have been aware of these marks. Furthermore, the Applicant has not provided any comments or objections in this regard. In view of the above, I consider it to be in the interests of justice to grant leave to the Opponent to amend its statement of opposition. Consequently, the statement of opposition as amended, forms part of the record of this proceeding and is reflected in the above summarized statement of opposition.

[12] Lastly, I would like to note that there was an additional ground of opposition in the statement of opposition based upon sections 38(2)(a) and 30(i) of the Act. Specifically, the ground of opposition alleged that the Applicant could not have been satisfied that it was entitled to use the subject trade-mark in Canada having regard to section 19 of the Act. However, the Opponent withdrew this ground at the oral hearing.

Onus and Material Dates

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

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

- sections 38(2)(a)/30 – the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR 428 at 432 (TMOB)];
- sections 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade-marks* (1991), 37 CPR (3d) 413 (FCA)];
- sections 38(2)(c)/16(3) – the filing date of the application [see section 16(3)]; and

- sections 38(2)(d)/2 – the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Overview of the Evidence

Opponent's Evidence

[15] As previously mentioned, the Opponent filed the affidavits of Gay Owens and Paul Furfaro.

[16] Ms. Owens is a trade-mark searcher employed by the Opponent's agent. Ms. Owens conducted a search of the Trade-marks Register to locate the Opponent's pleaded Player's Marks. She attaches the results of the search to her affidavit.

[17] Mr. Furfaro is the Brand Manager for the Opponent (a subsidiary of Imperial Tobacco Canada Limited). Mr. Furfaro provides representative use under license of the Opponent's Player's Marks as pleaded in the statement of opposition. In particular, he provides images of product packaging (Exhibits A – C), annual sales figures and marketing expenditures for the Player's Marks.

Applicant's Evidence

[18] As also previously indicated, the Applicant filed the affidavits of Karen E. Thompson and Greg Gilhooly.

[19] Ms. Thompson, a trade-mark searcher employed by the Applicant's agent provides results of a search of the Trade-marks Register for:

...active trade-marks that consist of or include a design element corresponding to Category 18.3 (Vehicles for Use in Water and Amphibious Vehicles) and/or Category 18.4 (Anchors, Buoys or Lifebelts) under the Vienna Classification, and are for use in association with goods listed under International Class 34 (tobacco; smokers' articles; matches) and/or in association with wares and/or services that include the words "tobacco", "cigar", "cigarette", "matches", "lighters" or "pipe".

[20] The search yielded 162 trade-marks (Exhibits A – B).

[21] Mr. Gilhooly, an articling student employed by the Applicant's agent, provides results of his visits to various tobacco product and convenience stores in Ottawa, Ontario (Exhibits 1 – 12). Mr. Gilhooly purchased tobacco products bearing trade-marks which feature elements that “would be or could be associated with a marine or maritime theme.” Mr. Gilhooly provides purchase receipts as well as copies of images of various tobacco product packaging. Mr. Gilhooly also provides results from online searches for “tobacco products that feature elements that would be or could be associated with a marine or maritime theme and that could be purchased online in Canada” (Exhibits 13 – 24).

Section 12(1)(d) Ground of Opposition

[22] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing. The Registrar has the 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 CPR (3d) 410 (TMOB)]. I have exercised that discretion and confirm that the Opponent's registrations relied upon in support of this ground of opposition remain in good standing. The Opponent has therefore satisfied its evidential burden.

[23] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates 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 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.

[24] In applying the test for confusion, the Registrar must have regard to all surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them. The above-noted criteria are not exhaustive and it is not necessary to give each one of them equal

weight [see, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 96 CPR (4th) 361 (SCC)].

[25] Recently, in *Masterpiece*, the Supreme Court of Canada discussed the importance of the section 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with section 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...

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

Section 6(5)(e) – degree of resemblance in appearance, when sounded, or in idea suggested

[27] The law is clear that when assessing confusion it is not proper to dissect trade-marks into their component parts, rather, marks must be considered in their entirety [see *British Drug Houses Ltd v Battle Pharmaceuticals*, [1944] Ex. CR 239, at 251, affirmed [1946] SCR 50 and *United States Polo Assn v Polo Ralph Lauren Corp* (2000), 9 CPR (4th) 51 at para 18, aff'd [2000] FCJ No 1472 (CA)].

[28] The parties' marks all feature a sailboat design. However, the similarities end there. The parties' marks are entirely different when sounded (the Mark features the word elements NAUTICAL and INTERNATIONAL BLEND; whereas the Opponent's Player's Marks feature the dominant word element PLAYER'S). Furthermore, while the Opponent's Player's Marks feature a number of different sailboat designs, some of which are more similar to the one featured in the Mark than others, none of them share any significant degree of similarity in appearance with the Mark. The different word elements also serve to contribute to the lack of visual similarity between the parties' marks.

[29] When viewed as a whole, with exception of one registration (TMA376,872 – SAILBOAT DESIGN), all of the Opponent’s Player’s Marks feature the dominant word element PLAYER’S, thereby further decreasing the degree of resemblance between the parties’ marks which is attributable to the fact that both parties’ marks feature sailboat designs. Furthermore, even with respect to the sole registration referred to above that does not feature the dominant word PLAYER’S the design elements are so strikingly different that the marks bear very little resemblance to one another in appearance.

[30] Confusion will be 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)].

[31] Ultimately, when considering the marks as a whole, I am not convinced that the mere fact that the Mark contains a sailboat design and the Opponent’s Family of Player’s Marks also feature sailboat designs (albeit visually different from the Applicant’s) is sufficient to create any significant similarities between the parties’ marks in appearance, sound or ideas suggested.

[32] 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 them are sufficient 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

[33] The Opponent’s Player’s Marks consist mainly of varying combinations of the elements PLAYER’S or JOHN PLAYER’S prominently displayed with the image of a sailboat in the background, and the image of a sailor with the words “Player’s Navy Cut” and other nautical elements. I agree with the Opponent that there is no evidence to suggest that any of the Opponent’s Player’s Marks are descriptive of any of the wares or services in association with which they are registered. Thus, when viewing the Player’s Marks in their entirety, I find that the Opponent’s Player’s Marks are inherently distinctive since they have no meaning with respect to the Opponent’s wares and services.

[34] The Mark prominently displays the word NAUTICAL followed below by the words INTERNATIONAL BLEND in smaller font and a relatively large sailboat image. Similar to the Opponent's Player's Marks, aside from any descriptive or suggestive connotation of the words "international blend", as there is no evidence to suggest that the Mark is descriptive of "tobacco products", I find that the Mark is also inherently distinctive.

[35] Thus, I assess the inherent distinctiveness of the parties' marks as being the same.

[36] A mark may acquire distinctiveness through use or promotion. There is no evidence of the use or promotion of the Mark and thus I can only conclude that the Mark has not become known to any extent.

[37] By contrast, the Opponent has provided representative evidence of use and promotion of a variety of its Player's Marks, including images of product packaging, as well as substantial sales and promotion figures (Furfaro affidavit). Mr. Furfaro's affidavit focuses on the Opponent's PLAYER'S FILTER and PLAYER'S SILVER brand cigarettes. The representative packaging provided for the PLAYER'S FILTER cigarettes is attributable to the years 1998-2004, with associated sales figures and/or marketing expenditures spanning from 1998-2007. Similarly, the representative packaging provided for the PLAYER'S SILVER cigarettes is attributable to the years 2001-2007, with associated sales figures and/or marketing expenditures spanning for the same years. Furthermore, Mr. Furfaro attests that the PLAYER'S NAVY CUT & Design trade-mark has been present on each package of PLAYER'S cigarettes sold in Canada since at least as early as 1921.

[38] Given Mr. Furfaro's sworn statements and the substantial sales and promotion figures provided in conjunction with the representative product packaging, I accept that the Opponent's Player's Marks have developed a reputation and have become known to a significant extent in Canada over the years.

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

[39] As discussed above in the analysis of the section 6(5)(a) factor, I am satisfied that the Opponent has evidenced use of its PLAYER’S Marks since approximately 1998 whereas the Mark was applied for on the basis of proposed use and no evidence of use has been provided. Therefore it is clear that the Opponent’s PLAYER’S Marks have been in use for longer than the Mark.

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

[40] It is the Applicant’s statement of wares as defined in its application versus the Opponent’s registered wares that govern my determination of this factor [see *Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB)].

[41] The Applicant’s Wares are “tobacco products”, and the Opponent’s wares include “cigarettes”. I am satisfied that cigarettes would be captured in the broader category of “tobacco products”. Thus, there is a clear overlap in the nature of the parties’ wares.

[42] As the Applicant has not evidenced the nature of its proposed trade in Canada, nor limited itself to a channel of trade different than that of the Opponent, in light of the similarity in the nature of the parties’ wares, I am prepared to infer that the parties’ channels of trade would likely also overlap.

Additional Relevant Surrounding Circumstances

State of the Register

[43] The evidence concerning the state of the Register is relevant only to the extent that inferences may be drawn concerning the state of the marketplace [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FCTD)]. Furthermore, inferences concerning the state of the marketplace may be drawn from this evidence only if a large number of relevant registrations are found [*Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)].

[44] As previously indicated, state of the register evidence was introduced by the Applicant through the affidavit of Ms. Thompson. I have reviewed the results of Ms. Thompson's search and I agree with the Opponent that the majority of the trade-marks located by Ms. Thompson are owned either by the Opponent or its related company, Imperial Tobacco Products Limited. Indeed, 91 of the 162 trade-marks retrieved in this search are owned by the Opponent, and a further 6 are owned by Imperial Tobacco Products Limited.

[45] The Opponent submits that the remaining third party registrations which include an image of a sailboat are not registered for use in association with cigarettes, but instead pertain to other tobacco products such as cigars, pipe tobacco, or related wares such as matches, lighters and ashtrays. I agree that the latter items in the context of many registrations are novelty items; for this reason, I have not considered these registrations to be relevant. However, I do not agree with the Opponent that registrations associated with all other tobacco products other than cigarettes are necessarily irrelevant. Indeed, cigars and pipe tobacco for example, like cigarettes, are products that fall under the general category of tobacco products, sold through the same channels of trade in proximity to one another.

[46] A thorough examination of Ms. Thompson's search results reveals that of the remaining third party registrations located, there are approximately 12 trade-marks that: include a sailboat as an integral or dominant element of the mark, a nautical theme, and are registered in association with wares that are made from tobacco.

[47] In the present case, I accept that Ms. Thompson has evidenced more than ten relevant registrations, to show that the use of a sailboat design and nautical elements are common to the trade [see *Old Spaghetti Factory Canada Ltd v Spaghetti House Restaurants Ltd* (1999), 2 CPR (4th) 398 at 407 (TMOB)]. That is, given the number of relevant registrations, the presumption is that consumers are accustomed to commonly seeing these elements used in the trade for these types of wares. As will be discussed below, the Applicant has also furnished evidence of use of several of these relevant registrations in the marketplace (Gilhooly affidavit).

State of the Marketplace

[48] As previously described, Mr. Gilhooly's evidence consisted of a variety of purchase receipts as well as copies of images of packaging of various tobacco products purchased or located online, available for sale in Canada. I note that many of the trade-marks appearing on the products located by Mr. Gilhooly are trade-marks belonging to third parties that I have identified as relevant registrations within the state of the register evidence submitted by Ms. Thompson (including for example TMA381,676, TMA599,275, and TMA126,804, among others). Evidence of use of such marks in the marketplace is further evidence that consumers are accustomed to commonly seeing an image of a sailboat and nautical elements used in the trade for these types of wares.

[49] As with the state of the register evidence, the Opponent submits that none of the products located by Mr. Gilhooly available for sale in Canada were cigarettes. However, my comments above with respect to products that fall under the general category of tobacco products are equally applicable here.

Family of Marks

[50] The Opponent submits that the evidence shows that it is the owner of a family of marks, consisting of over twenty trade-mark registrations prominently featuring a sailboat design and incorporating a nautical theme. The Opponent submits that such a collection of registered trade-marks owned by a single owner having a common feature and relating to a particular trade is known as a family or series of trade-marks. Further, the Opponent submits that the existence of a family of trade-marks is a circumstance which reflects adversely upon an application for a mark containing that same common feature, since the public will often be likely to believe that such a mark indicates goods coming from the same source as the goods covered by the family of marks [*Molnlycke AG v Kimberly-Clark of Canada Ltd* (1982), 61 CPR (2d) 42 at 47-48 (FC)].

[51] The Opponent further submits that in view of the extensive use of the Player's Family of Marks, consumers are accustomed to the Opponent using variations of its trade-marks.

Thus, the Opponent submits that consumers would naturally think that the Applicant's Mark is just another variant within the Player's Family of Marks.

[52] It is clear from the evidence that the Opponent has established a family of marks. While it is true that these marks include a sailboat design, as previously mentioned, all but one of these marks also feature the dominant word element PLAYER'S. Consequently, I find that the family of marks of the Opponent centres around the word element PLAYER'S, rather than just the sailboat and other nautical elements. Thus this does not form a surrounding circumstances which serves to support the Opponent's position in the present opposition.

Conclusion

[53] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. As discussed above, in *Masterpiece* the Supreme Court of Canada highlighted the importance of the section 6(5)(e) factor in the analysis of the likelihood of confusion. In the present case, I have found significant differences between the parties' marks. I am of the view that none of the other factors assist the Opponent in overcoming these differences between the marks.

[54] Having considered all of the surrounding circumstances, in particular the fact that the parties' marks share very little similarities in sound, appearance and ideas suggested, 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 Mark and the Opponent's Player's Marks.

[55] In conclusion I note that, to find in favour of the Opponent in the present case would be akin to granting the Opponent a trade-mark monopoly over the image of a sailboat in any form in relation to cigarettes. The Federal Court recently stated that a similar monopoly (i.e. "the word HORSE of any colour (green, golden, brown, blue, etc.) in relation to beer") would be inappropriate [see *San Miguel Brewing International Limited v Molson Canada 2005* [2013] FC 156 at para 40].

Non-entitlement Ground – section 16(3) of the Act

[56] In order to satisfy its onus, the Opponent must show that its Player's Marks were used prior to the filing date of the application and were not abandoned at the date of advertisement.

[57] I am satisfied that the Opponent's Player's Marks had been used in Canada in association with cigarettes as of the material date and had not been abandoned at the date of advertisement. Thus, the Opponent has met its evidential burden.

[58] 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 Mark and the Opponent's Player's Marks. In this regard, my findings under the ground of opposition based on section 12(1)(d) are equally applicable here. Accordingly, the ground of opposition based on section 16(3) of the Act is also dismissed.

Non-distinctiveness Ground of Opposition

[59] In order to meet its initial burden under this ground, the Opponent must establish that as of the filing date of the statement of opposition, namely, December 1, 2009, one or more of the Opponent's Player's Marks had become known sufficiently to negate the distinctiveness of the Mark [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc, supra; Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)].

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

[61] I must now assess whether the Applicant has satisfied 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 Mark and the Opponent's Player's Marks.

[62] The difference in material dates is not significant and as a result my findings under the ground of opposition based on section 12(1)(d) of the Act are equally applicable here. Having regard to the foregoing, I reject the ground of opposition based on non-distinctiveness.

Section 30(i) Grounds of Opposition

[63] Section 30(i) of the Act requires that the Applicant declare itself satisfied that it is entitled to use the Mark in Canada in association with the Wares. Such a statement is included in the application.

[64] The case law has established two circumstances under which non-compliance with section 30(i) may be found. The first is where there is evidence of bad faith on behalf of an applicant, an exceptional circumstance which would render the applicant's statement that it is satisfied that it is entitled to use the applied-for mark untrue [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; *Cerverceria Modelo, SA de CV v Marcon* (2008), 70 CPR (4th) 355 (TMOB) at 369]. In the present case, there is no evidence of bad faith on the part of the Applicant. The second circumstance is where a *prima facie* case of non-compliance with a federal statute is established [see for example *Interprovincial Lottery Corp v Monetary Capital Corp* (2006), 51 CPR (4th) 447 (TMOB) and *Canadian Bankers' Assn v Richmond Savings Credit Union*, (2000), 8 CPR (4th) 267 (TMOB)].

[65] In this case, the Opponent has alleged that use of the Mark would violate sections 20 and 22 of the Act. While the validity of these grounds has not been clearly established, even if they were to be considered valid grounds of opposition, they would not succeed for the following reasons. Section 20 requires a finding of confusion; however, I have found that the parties' marks are not confusing. Lastly, with respect to section 22, the Opponent has failed to adduce any evidence supporting a likelihood of depreciation of goodwill [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC)].

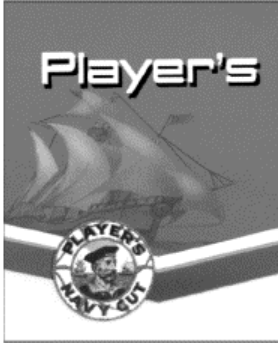



[66] Accordingly, the grounds of opposition based on section 30(i) of the Act are dismissed.

Disposition

[67] 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.






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

Appendix "A"

Registration Number	Trade-mark
TMA515,500	<p>PLAYER'S & DESIGN:</p> 
TMA624,669	<p>PLAYER'S ARGENT & DESIGN:</p> 
TMA670,158	<p>PLAYER'S ARGENT & DESIGN:</p> 
TMA670,163	<p>PLAYER'S EXTRA LÉGÈRE & DESIGN:</p> 
TMA516,025	<p>PLAYER'S EXTRA LIGHT & DESIGN:</p>

	
TMA670,160	PLAYER'S EXTRA LIGHT & DESIGN: 
TMA670,166	PLAYER'S FILTER & DESIGN: 
TMA670,332	PLAYER'S FILTRE & DESIGN: 
TMA669,491	PLAYER'S LÉGÈRE & DESIGN: 
TMA512,897	PLAYER'S LÉGÈRE VELOUTÉE & DESIGN: 
TMA670,171	PLAYER'S LÉGÈRE VELOUTÉE & DESIGN:

	
TMA512,926	PLAYER'S LIGHT & DESIGN: 
TMA670,156	PLAYER'S LIGHT & DESIGN: 
TMA670,168	PLAYER'S LIGHT SMOOTH & DESIGN: 
TMA670,799	PLAYER'S MEDIUM & DESIGN: 
TMA617,131	PLAYER'S PLAIN and Design: 
TMA624,642	PLAYER'S SILVER & DESIGN: 
TMA670,157	PLAYER'S SILVER & DESIGN:

	
TMA322,467	<p>PLAYER'S SPECIAL BLEND & DESIGN:</p> 
TMA376,872	<p>SAILBOAT & DESIGN:</p> 
TMDA11355	<p>SAILOR, TWO SHIPS & THE WORDS "PLAYER":</p> 
TMA516,597	<p>PLAYER'S FILTER & DESIGN:</p> 
TMA516,563	<p>PLAYER'S FILTRE & DESIGN:</p>

