



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

Citation: 2014 TMOB 6
Date of Decision: 2014-01-15

**IN THE MATTER OF AN OPPOSITION
by Campagnolo S.R.L. to application
No. 1,500,154 for the trade-mark Rebel
Leagues Logo Two-Montreal Winged
Wheelers and Design in the name of
Vintage Leagues Ltd.**

Introduction

[1] This opposition relates to an application filed on October 19, 2010 by Alfred J. Mikl, David Michael, a partnership. It was subsequently assigned to Vintage Leagues Ltd. (Alfred J. Mikl, David Micheal and Vintage Leagues Ltd. collectively referred to as the Applicant) to register the trade-mark identified as 'Rebel Leagues Logo Two-Montreal Winged Wheelers and Design' (the Mark) as illustrated hereinafter:



in association with:

Clothing, namely, coats, vests, undergarments, bathing suits, pajamas, and night shirts; sports uniforms; clothing accessories, namely, socks, belts, suspenders and scarves; pet accessories, namely, clothing, leashes and beds; bags, namely, athletic, golf, duffel, overnight and knapsacks; household gloves for general use and mittens; headbands and wristbands; footwear, namely, athletic and casual; headwear, namely, caps, visors and toques; coffee mugs and drinking glasses; stationery, namely, pens, pencils, paper, envelopes, notebooks, binders, calendars, post cards and wrapping paper; books; novelty items, namely, collectable figures, trading stamps and trading cards; party balloons; emblem badges, novelty pins and novelty buttons; playing cards; key chains; clocks and watches; umbrellas; miniature hockey sticks; lunch boxes; cloth towels; wall paper; pre-recorded CDs and DVDs containing music and video; computer accessories, namely, mouse pads; hockey equipment, namely, elbow and knee pads, face masks, hockey gloves, helmets, neck protectors, nets, skates, hockey sticks and street hockey balls; golf equipment, namely, balls, tees, golf gloves and golf club covers; soccer equipment, namely, balls; football equipment, namely, balls; baseball equipment, namely, bats and balls; lottery cards and tickets; digital photographic images downloadable to a computer or wireless device via a global communications network (the Wares); and

Retail sales, online sales, wholesale sales and wholesale distribution of clothing accessories, pet accessories, bags, gloves and mittens, headbands and wristbands, footwear, coffee mugs and drinking glasses, stationery, books, novelty items, party balloons, emblem badges, novelty pins and novelty buttons, playing cards, key chains, clocks and watches, umbrellas, miniature hockey sticks, lunch boxes, cloth towels, pre-recorded CDs and DVDs, mouse pads, hockey equipment (other than hockey pucks), lottery cards and tickets and computer software; online store services featuring downloadable pre-recorded music and video; restaurant services; promoting goods and services through the distribution of discount cards; promoting the sale of credit card accounts through the administration of incentive award programs; promoting the sale of goods and services by awarding purchase points for credit card use; entertainment services, namely, baseball games, basketball games, concerts, football games, hockey games, musical concerts, orchestra performances, fashion shows, personal appearances by a sports celebrity, roller derbies, soccer games, theatre productions and television shows (the Services).

[2] The application is based on proposed use. It was subsequently assigned to Vintage Leagues Ltd. (Alfred J. Mikl, David Michael and Vintage Leagues Ltd. collectively referred to as the Applicant). It was advertised on May 11, 2011 in the *Trade-marks Journal*. Campagnolo S.R.L. (the Opponent) filed a statement of opposition on July 11, 2011.

[3] The grounds of opposition raised by the Opponent are based on sections 30(e), 30(i), 22, 7(b), 12(1)(d), 16(3)(a), and section 2 (distinctiveness) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) as well as sections 3 and 27 of the *Copyright Act* RSC 1985, c. C-42. The specific grounds of opposition are detailed in Schedule A annexed to this decision.

[4] The Opponent filed as its evidence certified copies of its Canadian registrations mentioned in its statement of opposition and the affidavit of Valentino Campagnolo. The Applicant chose not to file any evidence. Both parties filed written argument and were represented at the hearing.

[5] The first issue is to determine if the Opponent has furnished sufficient evidence to support its grounds of opposition. If so, then I must decide if they are well founded.

[6] For the reasons detailed hereinafter, I conclude that the Opponent has failed to meet its evidential burden with respect to the grounds of opposition based on sections 30(i), 30(e), 30(i) combined with sections 7(b) and 22 of the Act and section 30(i) combined with sections 3 and 27 of the *Copyright Act*. The introductory paragraph of section 16(3) of the Act cannot form the basis of a ground of opposition.

[7] Finally I maintain in part, for the reasons detailed hereinafter, the grounds of opposition based on sections 12(1)(d), 16(3)(a) and 2 of the Act.

Legal Onus and Burden of Proof

[8] The legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached in favour of the Applicant once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA) and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

Preliminary Remark

[9] In coming to my decision I have considered all of the evidence and submissions made by the parties; however, only the portions of the evidence and submissions which are directly relevant to my findings will be discussed in the body of my decision. As I indicated to the Applicant's representative at the hearing any submissions contained in its written argument that are not supported by the evidence in the record cannot be taken into consideration. As an illustration, in its argumentation, the Applicant alleges that the Mark has been used in association with some of the Wares. The Applicant chose not to file any evidence. Therefore any reference to the Applicant's use of the Mark will be disregarded.

Grounds of Opposition Summarily Dismissed

[10] Section 30(i) of the Act only requires the Applicant to declare itself satisfied that it is entitled to use the Mark in Canada in association with the wares and services described in the application. Such a statement is included in this application. An opponent may rely on section 30(i) in specific cases such as where bad faith on the part of the applicant is alleged [see *Sapodilla Co Ld v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. There is no allegation of that nature in the statement of opposition or any evidence in the record to that effect.

[11] Consequently the ground of opposition based on section 30(i) of the Act is dismissed.

[12] At the hearing the Opponent's agent conceded that there is no evidence in the record to support the grounds of opposition based on sections 30(e), 30(i) combined with sections 22 and 7(b) of the Act, as well as section 30(i) combined with sections 3 and 27 of the *Copyright Act*. Consequently all those grounds of opposition are dismissed for failure by the Opponent to meet its initial burden.

[13] There is also no evidence to support the grounds of opposition based on the fact that the Applicant would not be a person or an existing partnership. Therefore that ground of opposition is also dismissed.

[14] The introductory paragraph of section 16(3) of the Act does not create a ground of opposition separate and apart from the ground of opposition commonly known as entitlement,

and described in each of the sub paragraph of section 16(3) of the Act. Any grounds of opposition based on the introductory paragraph of section 16(3) are also dismissed.

Grounds of Opposition based on Confusion

[15] All the remaining grounds of opposition (sections 16(3), 12(1)(d) and 2 of the Act) are based on an allegation of likelihood of confusion between the Mark and the Opponent's trade-marks. They have to be assessed at different material dates namely:

- Registrability of the Mark under section 12(1)(d) of the Act: the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA)];
- Entitlement to the registration of the Mark, where the application is based on proposed use: the filing date of the application (October 19, 2010) [see section 16(3) of the Act];
- Distinctiveness of the Mark: the generally accepted date is the filing date of the statement of opposition (July 11, 2011) [see *Andres Wines Ltd and E & J Gallo Winery* (1975), 25 CPR (2d) 126 at 130 (FCA) and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 CPR (4th) 317 (FCTD)].

[16] I agree with the Opponent that the difference in those dates will not be a determining factor in my analysis of the relevant criteria listed in section 6(5) of the Act to determine if there exists a likelihood of confusion between the Mark and the Opponent's marks.

[17] The Opponent's registration TMA291,902 as illustrated hereinafter:



(Winged Wheel logo)

covers:

bicycles, parts, components and fittings for bicycles, namely: bicycle frames, tubes and connectors for bicycle frames; pedals; hubs, devices for fast locking and complete hubs for these devices; change-speed gears and front changers; cranks; simple and multiple gear wheels; cranks with gear wheels; gears; free wheels; brakes; driving and control means for change-speed gears, front changers and brakes; cable guides; knobs and control levers; pillars and saddles; pumps and pump bearings; pins and bearings for cranks and pedals; steering knuckles and bearings and bushes therefor; front and back forks; bolts and nuts; cables and sheathes; fastening clips (the Opponent Bicycles and Parts)

[18] The Opponent's registration TMA653,437 for the trade-mark CAMPAGNOLO & Design and reproduced below:



(CAMPAGNOLO & design mark)

covers:

Protective helmets for cyclists and motorcyclists, goggles as protective glasses for cyclists, spectacles, frames and cases for spectacles, computer hardware for bicycles, cyclometers; Bicycles; bicycle parts, components and accessories namely bicycle

frames, tubes and connectors for bicycle frames, bicycle wheels, rims and spokes for bicycle wheels, pedals, hubs, fast-locking means and complete hubs of said means, change-speed gears, derailleurs, cranks, simple and multiple gear wheels, cranks with gear wheels, gears, free wheels, drive chains, brakes, drive or control means for change-speed gears, derailleurs and brakes, cable guides, knobs and control levers, pillars and saddles, pumps and pump bearings, pins and bearings for cranks and pedals, steering knuckles and bearings and bushes thereof, front and back forks, cables and sheathes, fastening clips, central movement cases, handlebar connections and handlebars, forks and cushioned forks, stands, tires, tubular tires, inner tubes, tires for bicycles; all for bicycles; Sport and leisure wear, namely jackets, wind resistant jackets, coats, raincoats, jerseys, shirts, plush shirts, tops, sweatshirts, sweaters, underwear, T-shirts, trousers, shorts, leg and arm warmers, bibs, jeans, socks, thick socks, sleeveless, pants, bathing suits, track suits, sport uniforms, caps, hats and headwear, gloves, sweat bands and wrist bands, belts, suspenders, ties, foulards, bandana, headscarves, handkerchiefs, scarves, bath robes, shoes, overshoes, sport shoes, cycling shoes, running shoes, tennis shoes, football shoes, golf shoes, climbing shoes, ski boots, snow board boots, après-ski boots, slippers, mules, sandals, boots. (The Opponent's wares)

[19] I shall do my analysis of the likelihood of confusion between the marks in issue under the ground of opposition based on section 12(1)(d) of the Act. It will become obvious from my analysis of the evidence in the record that the Opponent has not provided enough evidence of use of the Winged Wheel logo mark such that it would have met its initial burden of proof with respect to the grounds of opposition based sections 16(3) and 2 of the Act in so far as that mark is concerned.

[20] The Opponent has filed a certified copy of registrations TMA291,902 and TMA653,437. I exercised my discretion to check the register and both registrations are extant. Therefore the Opponent has met its initial burden with respect to this ground of opposition [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[21] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in

appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight but the most important factor is often the degree of resemblance between the marks [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC), *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC)].

[22] The test under section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether a consumer who sees the Applicant's Wares bearing the Mark, would think they emanate from or sponsored by or approved by the Opponent.

Inherent distinctiveness of the trade-marks and the extent to which they have become known

[23] The Mark as well as the Winged Wheel logo mark are inherently distinctive being design marks. However I believe the latter mark possesses a lower degree of inherent distinctiveness when used in association with bicycles, parts and components as its design could represent a bicycle wheel and a lever. I also consider the CAMPAGNOLO & design trade-mark to be inherently distinctive.

[24] Any mark may acquire distinctiveness through extensive use. There is no evidence of use of the Mark in Canada in association with any of the Wares. I shall now review the evidence of use of the Winged Wheel logo mark to determine if it has acquired distinctiveness in Canada and if so to what extent.

[25] Mr. Campagnolo is the Opponent's President. He states that the Opponent was founded in 1933 in Vicenza, Italy. It designs, produces and distributes components for racing bikes. He alleges that the Opponent is recognized as a world leader in the manufacture of components for racing bikes and related accessories.

[26] Mr. Campagnolo alleges that the Winged Wheel logo, and potentially other minor variations, has been used in Canada by the Opponent since the early 80's mainly in association

with bicycles, parts, components and fittings for bicycles, sport and leisure wear and footwear. However such statement constitutes a bald assertion of use of a trade-mark. There must be evidence of use within the meaning of section 4(1) of the Act to support such contention.

[27] Mr. Campagnolo provides the yearly sales figures of the Opponent's wares and services in association with the trade-mark Winged Wheel logo since 2005 and the yearly sales figures in Canada of the Opponent's clothing and sportswear bearing the trade-mark Winged Wheel logo since 2005. Those sales figures are at least over 750,000 Euros and can exceed 1.3 million Euros. He filed as exhibit 2 to his affidavit random copies of invoices issued to Canadian customers allegedly illustrating sales of the Winged Wheel logo branded products. I note that the invoices do not make reference to the Winged Wheel logo mark and the earliest one goes back to 2008. Also none of the invoices filed make reference to the sale of bicycles or parts thereof. They are all for cycling wear. However each invoice filed bears the CAMPAGNOLO & design trade-mark.

[28] Mr. Campagnolo filed as exhibit 3 to his affidavit samples of catalogues illustrating mainly sportswear for cycling. The earliest one goes back to Winter 2003. We have no information on their distribution in Canada. Also, except for the 2011-2012 catalogue, the only trade-marks that can be clearly seen on the various products illustrated in these catalogues are the CAMPAGNOLO & design mark and the word mark CAMPAGNOLO written in various stylized forms. There is no bicycle parts illustrated in these catalogues bearing the Winged Wheel logo mark.

[29] The Winged Wheel logo mark appears on the side of each page of the 2011-12 catalogue part of exhibit 3 to Mr. Campagnolo's affidavit. However no information has been provided on its circulation in Canada. In any event representation of a mark in a catalogue does not constitute *per se* evidence of use of a trade-mark in association with wares.

[30] Finally the Winged Wheel logo mark may appear on the zipper's slider of some of the jackets illustrated in the various catalogues as suggested by the Opponent's agent but, because of its small size, it is impossible to distinguish it on these illustrations. It would appear that the CAMPAGNOLO & design mark is depicted on most of the zipper's sliders. I note that in some of the catalogues and pamphlets reference is made to the word mark CAMPAGNOLO. Also in

the catalogues and on the brochures there are bicycles illustrated or portion of them simply to associate the wearing apparel advertised to the sport of cycling. There is no illustration of a bike bearing the Winged Wheel logo that I could locate in these catalogues.

[31] I gave the opportunity to the Opponent's agent at the hearing to identify, in the evidence filed, examples of the use of the Winged Wheel logo in association with any wares covered by registration TMA291,902. Beside on the 2011-12 catalogue and perhaps on the zipper's slider of some of the jackets illustrated in the various catalogues (both examples not constituting evidence of use of that mark in association with wares covered by its registration), the agent was unable to provide me with any further examples.

[32] There is evidence of use of the CAMPAGNOLO & design mark in association with cycling wearing apparel but no evidence of use of the Winged Wheel logo in association with any of the wares covered by registration TMA291,902.

[33] Consequently only the CAMPAGNOLO & design mark is known in Canada to some extent in association with cycling wearing apparel. Ultimately this factor favours the Opponent only in so far as the CAMPAGNOLO & design mark is concerned.

The nature of the wares, services, or business; the nature of the trade

[34] Under section 12(1)(d) ground of opposition I must compare the Wares and the Services as described in the application with the wares covered by the Opponent's registrations [See *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 at 10-11 (FCA); *Henkel Kommadnitgellschaft v Super Dragon* (1986), 12 CPR (3d) 110 at 112 (FCA); *Miss Universe Inc v Dale Bohna* (1994), 58 CPR (3d) 381 at 390-392 (FCA)]. However, those statements must be read with a view to determine the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[35] The Opponent's registration TMA291,902 covers the Opponent's Bicycles and Parts. There is no overlap between those wares and the Applicant's Wares and Services.

[36] There is an overlap between some of the Opponent's wares covered by registration TMA653,437 and some of the Wares, namely: clothing, sports uniforms, clothing accessories, bags, household gloves and mittens, headbands and wristbands, footwear, headwear (the Overlapping wares); as well as with some of the Services, namely: Retail sales, online sales, wholesale sales and wholesale distribution of clothing accessories, gloves and mittens, headbands and wristbands, footwear (the Overlapping services).

[37] As for the nature of the trade of the parties, I have no evidence of the Applicant's business activities even though the Applicant, in its written argument and at the hearing, tried to argue the difference between the parties' businesses by introducing facts not in the record on the nature of its business.

[38] When considering the wares covered by registration TMA653,437 and the Overlapping wares and services, in the absence of evidence of the Applicant's channels of trade, and in view of the nature of those wares and services, I must infer that there would be some overlap in the parties' channels of trade, in so far as those wares and services are concerned.

The degree of resemblance

[39] As stated earlier, in its judgment in *Masterpiece* the Supreme Court of Canada has clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks. The appropriate test is not a side by side comparison but the imperfect recollection in the mind of a Canadian consumer of the Opponent's marks dominant features.

[40] Registration TMA291,902 for the Winged Wheel logo has the following dominant features: two wings in an upright position, a circle and a lever. I agree with the Opponent that the Mark has some visual resemblance with the Winged Wheel logo as it has two wings in an upright position and a circle. In both instances the wings attached to a circle give the idea of a flying wheel.

[41] As for registration TMA653,437 for CAMPAGNOLO & design mark, the Mark has some visual resemblance with it. It does have two wings in an upright position and a circle.

Additional surrounding circumstances

[42] At the hearing the Opponent argued that the Winged Wheel logo mark has become the Opponent's corporate logo as it appears on each single page of its 2011-12 catalogue. The fact that a mark is used as a corporate logo does not necessarily mean that it is entitled to a wider ambit of protection. In order to obtain such protection, the corporate logo must be well known. As discussed above, there is no evidence of use of the Winged Wheel logo in association with any of the Opponent's Bicycles and Parts.

[43] The Opponent also relies on an extract of its website filed as exhibit 6 to Mr. Campagnolo's affidavit. It refers to the following quote: 'Compagnolo S.r.l. is not only a star of the cycling world, but of sport in general, as recognized by the Wall Street Journal which has named it as one of the most prominent sports brands in the world.' The extract filed makes proof that it was published on the Internet but it does not make proof of its content.

[44] Mr. Campagnolo alleges that there have been numerous articles published in international newspapers distributed and available in Canada that refer to the Opponent and the Winged Wheel logo. He filed as exhibit 5 to his affidavit a press kit containing various articles published in international publications and allegedly available in Canada between 2008 and 2010. I note that half of the articles produced are in foreign language(s). There is no representation of the Winged Wheel logo trade-mark. The CAMPAGNOLO & design trade-mark appears on some of them. Finally there is no information on the extent of their circulation in Canada.

[45] Mr. Campagnolo alleges that the Opponent benefits from extensive media coverage of famous cycling events broadcasted around the world including Canada. He alleges that the Opponent also sponsors various cycling competitions. We have no information on the extent of the coverage in Canada of those cycling events and competitions. Also it is impossible from this statement alone to determine which of the Opponent's trade-mark(s) has (have) been exposed to the Canadian public through this media coverage.

Conclusion

[46] I conclude that, with respect to section 12(1)(d) ground of opposition, there is no likelihood of confusion between the Mark and the Winged Wheel logo covered by registration TMA291,902 as the difference in the nature of the Wares and Services is sufficient to rule in favour of the Applicant.

[47] As for registration TMA653,437 the visual resemblance between the Mark and the CAMPAGNOLO & design mark, and the overlap in some of the wares enables me to conclude that there exists, on a balance of probabilities, a likelihood of confusion between those marks but only in so far as the Overlapping wares and services are concerned. An analogy can be made with the case of *Tommy Hilfiger Licensing Inc v Produits de Qualité IMD Inc* (2005), 37 CPR (4th) 1 where the Federal Court concluded that the addition of the words EXPLORE CANADA to the design mark of Tommy Hilfiger Licensing Inc was not sufficient to negate the likelihood of confusion. *A contrario* the absence of the word CAMPAGNOLO in the Mark, in my opinion, is not sufficient to negate the likelihood of confusion between the Mark and the CAMPAGNOLO & design mark.

[48] With respect to the grounds of opposition based on sections 16(3)(a) and distinctiveness, there is no evidence in the record of prior use in Canada of the Winged Wheel logo mark as discussed above and as such the Opponent has not met its initial burden of proof with respect to those two grounds of opposition in so far as that trade-mark is concerned.

[49] However, there is evidence of prior use of the CAMPAGNOLO & design mark in Canada in association with cycling wearing apparel and cycling accessories. As such that trade-mark was known in Canada. Therefore the Opponent has met its initial burden. I reach the same conclusion as for the ground of opposition based on section 12(1)(d) of the Act. There exists a likelihood of confusion between the CAMPAGNOLO & design mark and the Mark only with respect to the Overlapping wares and services.

[50] Consequently the grounds of opposition based on sections 12(1)(d), 16(3) and 2 (distinctiveness) of the Act are all maintained in part only with respect to the Overlapping wares and services.

Disposition

[51] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition in so far as the following wares and services are concerned:

pet accessories, namely, clothing, leashes and beds; coffee mugs and drinking glasses; stationery, namely, pens, pencils, paper, envelopes, notebooks, binders, calendars, post cards and wrapping paper; books; novelty items, namely, collectable figures, trading stamps and trading cards; party balloons; emblem badges, novelty pins and novelty buttons; playing cards; key chains; clocks and watches; umbrellas; miniature hockey sticks; lunch boxes; cloth towels; wall paper; pre-recorded CDs and DVDs containing music and video; computer accessories, namely, mouse pads; hockey equipment, namely, elbow and knee pads, face masks, hockey gloves, helmets, neck protectors, nets, skates, hockey sticks and street hockey balls; golf equipment, namely, balls, tees, golf gloves and golf club covers; soccer equipment, namely, balls; football equipment, namely, balls; baseball equipment, namely, bats and balls; lottery cards and tickets; digital photographic images downloadable to a computer or wireless device via a global communications network; and

Retail sales, online sales, wholesale sales and wholesale distribution of pet accessories, coffee mugs and drinking glasses, stationery, books, novelty items, party balloons, emblem badges, novelty pins and novelty buttons, playing cards, key chains, clocks and watches, umbrellas, miniature hockey sticks, lunch boxes, cloth towels, pre-recorded CDs and DVDs, mouse pads, hockey equipment (other than hockey pucks), lottery cards and tickets and computer software; online store services featuring downloadable pre-recorded music and video; restaurant services; promoting goods and services through the distribution of discount cards; promoting the sale of credit card accounts through the administration of incentive award programs; promoting the sale of goods and services by awarding purchase points for credit card use; entertainment services, namely, baseball games, basketball games, concerts, football games, hockey games, musical concerts, orchestra performances, fashion shows, personal appearances by a sports celebrity, roller derbies, soccer games, theatre productions and television shows.

but refuse the application for:

Clothing, namely, coats, vests, undergarments, bathing suits, pajamas, and night shirts; sports uniforms; clothing accessories, namely, socks, belts, suspenders and scarves; bags, namely, athletic, golf, duffel, overnight and knapsacks; household gloves for general use and mittens; headbands and wristbands; footwear, namely, athletic and casual; headwear, namely, caps, visors and toques; and

Retail sales, online sales, wholesale sales and wholesale distribution of clothing accessories, gloves and mittens, headbands and wristbands, footwear.

pursuant to section 38(8) of the Act [see *Produits Menagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (FCTD) as authority for a split decision].

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule A

The relevant grounds of opposition can be summarized as follow:

1. The application does not comply with the requirements of section 30(e) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) in that the Applicant at the filing date of the application was already using the Mark in Canada;
2. The application does not comply with the requirements of section 30(e) and (h) of the Act in that the trade-mark proposed to be used in Canada is not the Mark but another, different from the one referred to in the application;
3. The application does not comply with the requirements of section 30(e) of the Act in that the Applicant at the filing date of the application never intended to use the Mark in Canada with each of the wares or services referred in the application;
4. The application does not comply with the requirements of section 30(e) of the Act in that the Mark is not a trade-mark since it is solely functional or ornamental and decorative;
5. The statement that the Applicant is satisfied as to its entitlement to the use of the Mark in Canada is false in view of the content of the present opposition, including the knowledge of the Applicant of the rights of the Opponent as herein alleged and the unlawfulness of said use, if any, as such use would be, was and is unlawful in that it:
 - a) is encroaching upon the Opponent's proprietary rights, as alleged therein;
 - b) is likely to have the effect of depreciating the value of the goodwill attached to the Opponent's trade-marks, contrary to section 22 of the Act;
 - c) would direct public attention to Applicant's wares, services or business in such a way as to cause confusion in Canada between these wares, services or business and those of the Opponent contrary to section 7(b) of the Act;
 - d) would constitute an infringement of the copyright of the Opponent in the artistic work of which the Mark is a copy or colorable imitation, contrary to sections 3 and 27 of the *Copyright Act*;

6. The Applicant is not a person, alternatively, the Applicant is not an existing partnership;
7. The Mark is not registrable in view of section 12(1)(d) of the Act since the Mark is confusing with the Opponent's registered trade-marks:
 - CAMPAGNOLO & Design, certificate of registration TMA653,437 owned by the Opponent in association with various wares including bicycles, bicycle parts, components and accessories, sport and leisure wear, footwear;
 - Winged Wheel & Design, certificate of registration TMA 291,902 owned by the Opponent for various wares including bicycles, bicycle parts, components and fittings for bicycles;
8. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(3)(a) of the Act in that at the filing date of the application the Mark was confusing with the trade-marks mentioned above that had been previously used in Canada or made known in Canada by the Opponent or its predecessors in title in association with the wares mentioned above;
9. The Applicant is not the person entitled to the registration of the Mark pursuant to the introductory paragraph of section 16(3) of the Act in that the application does not comply with the requirements of section 30 of the Act; the Mark is not a proposed one but rather an used one, in whole or in part; and the Mark is not registrable or does not function as a trade-mark, namely that the Mark does not or is not adapted to distinguish the wares of the Applicant from those of others, being solely functional or merely decorative, and the Applicant is not a person;
10. Pursuant to section 38(2)(d) of the Act, the Mark is not distinctive of the wares or services of the Applicant since:
 - a) The Mark does not actually distinguish the wares or services in association with which the Mark is used or proposed to be used by the Applicant from the wares or services of the Opponent, nor is adapted to so distinguish them;
 - b) The Mark does not actually distinguish the wares or services of the Applicant from those of others, being solely functional or merely decorative.