

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

**Citation: 2012 TMOB 134**  
**Date of Decision: 2012-07-20**

**IN THE MATTER OF AN  
OPPOSITION by Effigi Inc. and  
88766 Canada Inc. to application  
Nos. 1,289,535 and 1,297,982 for  
the trade-marks DENVER  
OUTLAWS and DENVER  
OUTLAWS & Design in the name  
of Major League Lacrosse LLC**

[1] On February 10, 2006 and April 18, 2006, respectively, Major League Lacrosse LLC (the Applicant), filed applications for the trade-marks DENVER OUTLAWS (the Word Mark) and DENVER OUTLAWS & Design (the Design Mark), shown below (hereinafter referred to together as the Marks):



[2] The applications for the Marks claim the following wares and services (the Wares and Services), on the filing bases set out below:

**The Word Mark**

**WARES:**

(1) Clothing, namely, shirts, T-shirts, under shirts, night shirts, rugby shirts, polo shirts, cardigans, jerseys, sports uniforms, dress shirts, pants, trousers, slacks, jeans, culottes, cargo pants, denim jeans, overalls,

coveralls, jumpers, jump suits, shorts, boxer shorts, tops, crop tops, tank tops, halter tops, sweat shirts, sweat shorts, sweat pants, wraps, warm-up suits, jogging suits, track suits, play suits, blouses, skirts, dresses, gowns, sweaters, vests, fleece vests, pullovers, snow suits, parkas, capes, anoraks, ponchos, jackets, reversible jackets, coats, blazers, suits, turtlenecks, cloth ski bibs, swimwear, beachwear, tennis wear, surf wear, ski wear, layettes, infantwear, infants sleepers, baby bibs not of paper, cloth diapers, wrist bands, sweat bands, aprons, scarves, bandanas, belts, suspenders, neckwear, ties, neckerchiefs, ascots, underwear, thermal underwear, long underwear, briefs, swim and bathing trunks, bras, sports bras, brassieres, bustiers, corsets, panties, thongs, garters and garter belts, teddies, girdles, foundation garments, singlets, socks, loungewear, robes, smocks, underclothes, pajamas, sleepwear, night gowns, lingerie, camisoles, negligees, chemises, chemisettes, slips, sarongs, leg warmers, hosiery, pantyhose, body stockings, knee highs, leggings, tights, leotards, body suits, unitards, body shapers, gloves, mittens, and rainwear; headwear, namely, caps, swim caps, berets, beanies, hats, visors, headbands, and ear muffs; footwear, namely, shoes, sneakers, boots, booties, galoshes, sandals, flip-flops, and slippers.

Based on proposed use.

**SERVICES:**

(1) Entertainment namely the production of lacrosse games, competitions and tournaments; entertainment, namely, participation in lacrosse games and competitions namely, organization of lacrosse games and competitions; conducting entertainment exhibitions namely lacrosse games and competitions; organizing exhibitions of the sport of lacrosse; providing facilities for lacrosse tournaments; arranging and conducting athletic competitions, namely, lacrosse competitions; entertainment namely the production of on-going television programs in the field of sporting events; entertainment, namely, a continuing sports event show distributed over television, satellite, audio and video media; entertainment services, namely, providing a television program featuring sporting events via a global computer network; providing an on-line computer database in the field of lacrosse; entertainment services, namely, providing a web site featuring information pertaining to lacrosse goods and services.

Based on proposed use and use and registration in the US (registered in US on September 25, 2007 (No. 3299345)).

**The Design Mark**

**WARES:**

(1) Clothing, namely, shirts, T-shirts, polo shirts, jerseys, sports uniforms, shorts, boxer shorts, tops, crop tops, tank tops, halter tops, sweat shirts, sweat pants, warm-up suits, track suits, fleece vests, pullovers, jackets,

neckwear, ties, gloves, mittens, and rainwear; suspenders, headwear, namely, caps, hats, visors, headbands, footwear, namely, sneakers, flip-flops

Based on proposed use and use and registration in the US (registered in US on December 11, 2007 (No. 3353771)).

SERVICES:

(1) Entertainment namely the production of lacrosse games, competitions and tournaments; entertainment, namely, participation in lacrosse games and competitions, namely, organization of lacrosse games and competitions; conducting entertainment exhibitions namely lacrosse games and competitions; organizing exhibitions of the sport of lacrosse; providing facilities for lacrosse tournaments; arranging and conducting athletic competitions, namely, lacrosse competitions; entertainment namely the production of on-going television programs in the field of sporting events; entertainment, namely, a continuing sports event show distributed over television, satellite, audio and video media; entertainment services, namely, providing a television program featuring sporting events via a global computer network; providing an on-line computer database in the field of lacrosse; entertainment services, namely, providing a web site featuring information pertaining to lacrosse goods and services

Based on proposed use and use and registration in the US (registered in US on August 14, 2007 (No. 3280830)).

[3] The application for the Word Mark claims a priority filing date of September 26, 2005 based on United States application No: 78/720,605 for wares; and application No: 78/720,613 for services. The application for the Design Mark claims a priority filing date of November 29, 2005 based on United States application No: 78/762,957 for wares, and application No: 78/762,967 for services.

[4] The applications for the Word Mark and Design Mark were advertised for opposition purposes in the *Trade-marks Journal* of May 5, 2010 and July 8, 2009, respectively.

[5] On May 19, 2010 for the Word Mark and November 30, 2009 for the Design Mark, Effigi Inc. and 88766 Canada Inc. (together jointly referred to as the Opponent) filed a statement of opposition. The Opponent was granted leave to file an amended statement of opposition in each of the opposition proceedings on December 9, 2010 for the Word Mark and on both June 18, 2010 and October 15, 2010 for the Design Mark.

[6] By way of letter dated May 29, 2012, the Opponent advised that it would be making a verbal request at the oral hearing to amend the statement of opposition in each proceeding to correct a typographical error. Specifically, the Opponent wished to correct an erroneous reference to section 30(1) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), where the appropriate reference was to section 31(1) of the Act.

[7] By way of letter dated June 5, 2012, the Opponent added to this request and advised that it also wished to limit the section 30(a) objection to specific services, rather than all of the Services as previously pleaded. With respect to the opposition to the Word Mark application, the Opponent also wished to delete an improper reference to US registration No. 3299345 in the section 30(d) ground of opposition.

[8] At the oral hearing, I advised the Opponent that I would require a formal written request for leave to file amended statements of opposition as set out in the June 5th letter. Later that day, the Opponent filed a formal request for leave to file an amended statement of opposition in each of the proceedings.

[9] At the oral hearing I advised the Opponent that, in the absence of comments from the Applicant and given the minor nature of the amendments sought to be made, I was satisfied that it was in the interests of justice to permit the Opponent to amend the statements of opposition as requested but that such ruling would be formally made in my final decision. Accordingly, the Opponent is hereby formally granted leave to amend the statements of opposition pursuant to the requests dated June 5, 2012 in accordance with section 40 of the *Trade-marks Regulations* SOR/96-195 (the Regulations).

[10] The grounds of opposition which are essentially identical for both oppositions are summarized below:

- Contrary to sections 38(2)(a) and 30(a) of the Act, the applications for the Marks do not contain statements in ordinary commercial terms of the wares “swimwear, beachwear, tennis wear, surf wear, ski wear, infant wear, loungewear, underclothes, neckwear, underwear, sleepwear, rainwear” for the Word Mark; the wares “suspenders, headwear, namely caps, hats, visors, headbands, footwear, namely sneakers, flipflops” for the Design Mark and the services identified below for both applications:


- entertainment namely the production of lacrosse games, competitions and tournaments;
  - entertainment, namely, participation in lacrosse games and competitions namely, organization of lacrosse games and competitions;
  - entertainment, namely the production of on-going television programs in the field of sporting events;
  - entertainment, namely, a continuing sports event show distributed over television, satellite, audio and video media;
  - entertainment services, namely, providing a television program featuring sporting events via a global computer network.
- Contrary to sections 38(2)(a) and 30(d) of the Act, the applications do not comply with section 30(d) of the Act.
  - Contrary to sections 38(2)(a) and 30(e) of the Act, the applications do not comply with section 30(e) of the Act.
  - Contrary to sections 38(2)(a) and 30(i) of the Act, the Applicant could not have been satisfied of its entitlement to use the Marks in Canada having regard to the allegations in the statement of opposition including the Applicant's knowledge of Effigi's rights, of the fact that any use of the Marks would be illegal for violating Effigi's rights, of the fact that any use of the Marks would depreciate the value of the goodwill attached to Effigi's marks contrary to section 22 of the Act and would be contrary to section 7(b) of the Act.
  - Contrary to sections 38(2)(b) and 12(1)(b) of the Act, the Marks are not registrable as when written, depicted or sounded, the Marks are clearly descriptive or deceptively misdescriptive in French or English of the place of origin of the Wares and Services, namely the city of Denver, Colorado.
  - Contrary to sections 38(2)(b) and 12(1)(d) of the Act, the Marks are not registrable because they are confusing with the registered trade-marks HORS LA LOI & Design (TMA376,697) and HORS LA LOI (TMA685,339).
  - Contrary to sections 38(2)(c) and 16(2)(a) and 16(3)(a) of the Act, at the dates of filing the applications for the Marks, as well as at any material date (including the priority filing dates), the Marks created confusion with the trade-marks HORS LA LOI and OUTLAW (and variants thereof) used or made known in Canada by the Opponent Effigi, its predecessors in title, or for their benefit by licensees, in association with wares and services related to fashion clothing and accessories or wares and services of the same nature, category or clientele as those claimed in the applications for the Marks.
  - Contrary to sections 38(2)(c) and 16(2)(b) and 16(3)(b) of the Act, at the dates of filing the applications for the Marks, as well as any other material date (including the priority filing dates), the Marks were confusing with a mark for which an

application had already been filed in Canada namely OUTLAW (application No. 1,146,692) for the wares and services claimed therein.

- Contrary to sections 38(2)(c) and 16(2)(c) and 16(3)(c) of the Act, at the dates of filing the applications for the Marks, as well as any other material date (including the priority filing dates), the Marks were confusing with the trade-names HORS LA LOI and OUTLAW previously used in Canada by Effigi and its predecessors in title, or for their benefit by licensees, in association with wares, services or business relating to fashion clothing and accessories, of the same nature and category as those claimed in the applications for the Marks.
- Contrary to sections 38(2)(c) and the introductory paragraph of sections 16(2) and 16(3) of the Act, the Applicant is not entitled to registration of the Marks because the applications do not comply with section 30 of the Act.
- Contrary to sections 38(2)(d) and 2 of the Act, the Marks are not distinctive of the claimed wares and services and cannot so distinguish them for the following reasons:
  - the Marks do not distinguish the Wares and Services from those of others, including those of Effigi;
  - the Applicant has permitted third parties, namely Denver Outlaws Lacrosse, Pro Lacrosse LLC and MLN Sport Group LLC to use the Marks in Canada not in compliance with section 50 of the Act;
  - by way of improper assignment, two or more persons, namely Denver Outlaws Lacrosse, Pro Lacrosse LLC and MLN Sport Group LLC possessed rights to and were using the Marks concurrently, contrary to section 48(2) of the Act.

[11] For each of the applications 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.

[12] In both oppositions, the Opponent filed certified copies of registration Nos. TMA685,339, TMA376,697 and application No. 1,146,692 for the Opponent's HORS LA LOI/OUTLAW trade-marks, shown in the chart below. For the Word Mark, the Opponent filed affidavits of Simon Picard, sworn August 26, 2010 and Andrea Salera, sworn September 3, 2010 and for the Design Mark, the Opponent filed affidavits of Andrea Salera sworn March 19, 2010 and Anne-Christine Boudreal sworn March 23, 2010. With respect to the opposition against the Design Mark, the Opponent was also granted leave on October 15, 2010 to file an additional affidavit of Simon Picard, sworn August 26, 2010 pursuant to section 44 of the Regulations.

Trade-mark	Wares/Services
HORS LA LOI (TMA685,339)	[Summary] clothing; headwear; bags; eyewear; perfume; watches; jewellery; footwear; textiles; household linen; bathroom linen; table linen; kitchen utensils; dishes; operation of a retail store selling clothing, footwear and accessories
HORS LA LOI & DESSIN  HORS LA LOI (TMA376,697)	[Summary] clothing; bags
OUTLAW (1,146,692 – status allowed)	[Summary] clothing; headwear; bags; eyewear; perfume; watches; jewellery; footwear; textiles; household linen; bathroom linen; table linen; kitchen utensils; dishes; operation of a retail store selling clothing, footwear and accessories

[13] The Applicant did not file any evidence in support of its applications.

[14] Both parties filed written arguments. An oral hearing was held at which only the Opponent was represented.

Onus and Material Dates

[15] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its applications comply with the requirements of the Act. However, there 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].

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

- sections 38(2)(a)/30 - the date of filing 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 (3d) 428 at 432 (TMOB)].
- sections 38(2)(b)/12(1)(b) - the date of filing the application [see *Fiesta Barbeques Ltd. v. General Housewares Corp.* (2003), 28 CPR (4th) 60 (FC)].
- 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(2)/(3) - the priority filing date [see sections 16(2), 16(3) and 34 of the Act].
- sections 38(2)(d)/2 - the date of filing the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 CPR (4th) 317 (FC)].

Preliminary Issue: Alleged Section 38(7.2) Issue re: Application for the Word Mark

[17] By way of letter dated April 7, 2011 the Opponent asked that the application for the Word Mark be deemed abandoned by virtue of section 38(7.2) of the Act on account of an allegation that the Applicant did not properly serve its statement that it would not be filing evidence pursuant to section 42 of the Regulations on the Opponent. Specifically, the Opponent submitted that the statement was forwarded by facsimile without the Opponent's consent and thus the Applicant failed to properly serve the Opponent with its statement in accordance with section 37 of the Regulations.

[18] In its written argument, the Applicant points to section 38(7.2) of the Act which states:

The application shall be deemed to have been abandoned if the applicant does not file and serve a counter statement within the time referred to in subsection (6) or if, in the prescribed circumstances, the applicant does not submit either evidence under subsection (7) or a statement that the applicant does not wish to submit evidence. (Emphasis is mine)

[19] The Applicant submits, and I agree, that the language of section 38(7.2) of the Act makes it clear that deemed abandonment is triggered by a failure to file and/or serve the counter statement or by a failure to file the Applicant's evidence. The language of the Act makes a distinction such that a failure to serve evidence does not trigger deemed



abandonment under section 38(7.2) of the Act. Based on the foregoing, the Applicant is not in default and the Opponent's request that the application for the Mark be deemed abandoned is refused.

### Section 30 Grounds of Opposition

#### *Section 30(a) of the Act*

[20] The Opponent's initial evidential burden under section 30(a) is a light one. In fact, the Opponent may need only present sufficient argument in order to meet its initial burden [see *McDonald's Corporation and McDonald's Restaurants of Canada Ltd. v. M.A. Comacho-Saldana International Trading Ltd. carrying on business as Macs International* (1984), 1 CPR (3d) 101 at 104 (TMOB)].

[21] The Opponent submits that the wares "swimwear, beachwear, tennis wear, surf wear, ski wear, infant wear, loungewear, underclothes, neckwear, underwear, sleepwear, rainwear", while having been accepted at the prosecution stage, should not be accepted as they are broad terms which require further specification. The Opponent indicated that wares which would be considered as belonging to these broader categories are included separate and apart from the broader terms (e.g. underwear vs. "bras, sports bras, brassieres, etc."; sleepwear vs. "night gowns, lingerie, camisoles, negligees, etc."). The Opponent submitted that this suggests that the broader terms lack specificity.

[22] In its written argument, the Applicant submits that the terms beachwear, infant wear, underwear and rainwear are all found in the Wares and Services Manual as acceptable. The Applicant submits that the remaining Wares are also specifically defined.

[23] I am not satisfied that the Opponent's submissions on this point are sufficient to enable it to meet its burden. Rather, I am satisfied that the terms "swimwear, beachwear, tennis wear, surf wear, ski wear, infant wear, loungewear, underclothes, neckwear, underwear, sleepwear, rainwear" when read in conjunction with the statement of wares as a whole are defined specifically enough to comply with section 30(a) of the Act.

[24] With respect to the wares “suspenders, headwear, namely caps, hats, visors, headbands, footwear, namely sneakers, flipflops”, the Opponent submitted that they were not properly defined due to the punctuation used. Specifically, the Opponent submitted that the presence of a comma instead of a semi-colon after “suspenders” creates uncertainty as it suggests that “namely, caps, hats, visors, headbands...” relates to “suspenders” as well as to “headwear”. Since “caps, hats, visors, headbands...” are not suspenders, these wares have not been properly defined in accordance with section 30(a) of the Act. Similarly, the Opponent submits that the absence of a semi-colon between headbands and footwear suggests that footwear is part of the general class of “headwear”. Since this is not true, the Opponent submits that the specification does not comply with section 30(a) of the Act.

[25] In its written argument, the Applicant submits that the nature of the wares which have been objected to is readily apparent, particularly considering their context (i.e. that caps and visors are further specifications of headwear and sneakers and flipflops of footwear).

[26] I find the Opponent’s arguments regarding the punctuation in the statement of wares to be overly technical and I am not willing to accept them as sufficient to meet the Opponent’s burden under section 30(a) of the Act.

[27] With respect to the services that have been objected to, the Opponent submitted firstly that the services in the Canadian applications differ from the services in the corresponding US registrations. I have reviewed the specifications and accept that while there are some differences in the exact wording used, the services in the Canadian applications are essentially the same as those in the corresponding US registrations.

[28] Secondly, the Opponent pointed to a dictionary definition for “entertainment” and submitted that, as drafted, the offending services do not constitute entertainment. I am permitted to take judicial notice of dictionary definitions [see *Insurance Co. of Prince Edward Island v. Prince Edward Island Insurance Co.* (1999), 2 CPR (4th) 103 (TMOB)]. The Opponent submits that “entertainment” means: “the act or instance of entertainment; the process of being entertained”. The Opponent submitted that, for

example, in the case of the services described as “entertainment, namely the production of on-going television programs in the field of sporting events”, while the television program may constitute entertainment, the production of the television program would not constitute entertainment.

[29] I do not accept the Opponent’s submissions centered on the definition of the term entertainment as being sufficient to meet the Opponent’s burden. The issue is not whether production of a television program constitutes entertainment, but rather whether the services as drafted are defined in ordinary commercial terms. I am satisfied that each of the services is specifically enough defined to satisfy section 30(a) of the Act.

[30] Based on the foregoing, I find that the Opponent has failed to meet its evidential burden under the section 30(a) ground and dismiss this ground accordingly.

*Section 30(d) of the Act – relates to the Services for the Word Mark and the Wares and Services for the Design Mark*

[31] This ground of opposition relates to the Wares and Services for the Design Mark but only to the Services for the Word Mark, as there is no section 30(d) claim with respect to the Wares for the Word Mark.

[32] The Opponent makes various allegations in support of the ground of opposition based on non-compliance with section 30(d) of the Act. Specifically, the Opponent alleges that:

- a. the Applicant had not used or registered the Marks as claimed in association with each of the Wares and Services;
- b. the Applicant is not the owner of the alleged foreign registrations;
- c. at the dates of filing the applications for the Marks, the Marks had not been used in the US;
- d. the alleged use of the Marks has been discontinued for all or some of the Wares and Services;
- e. the Marks are not trade-marks because they are purely functional or decorative;
- f. the Applicant failed to produce copies of the related US registrations certified by the USPTO contrary to section 31(1) of the Act; and

- g. the marks for which the Applicant has claimed use and registration in the US are not the Marks, but different marks.

[33] The Opponent has only filed evidence and made submissions in support of the allegations set out above in paragraphs (a), (c) and (f). The remainder of the allegations are dismissed summarily on the basis that the Opponent has failed to meet its evidential burden.

[34] In support of its allegation that the Applicant failed to file certified copies of the corresponding US registrations in accordance with section 31(1) of the Act, the Opponent filed excerpts from the file wrappers for the applications for the Marks (Exhibit SP1 to the affidavit of Simon Picard in support of the Design Mark and Exhibit SP4 to the affidavit of Simon Picard in support of the Word Mark). The Opponent submits that the evidence shows that what was filed in each case was an electronic PDF version of the actual certified copy and not the original certified copy which the Opponent submits is required by section 31(1) of the Act.

[35] The Opponent submits that the evidence is sufficient to meet the Opponent's light evidential burden. I do not agree.

[36] I note that section 31(1) of the Act does not specifically require the original certified copy to be filed and the correspondence provisions of Regulations (e.g. section 3(6) of the Regulations) permit for the electronic transfer of correspondence to the Registrar. Furthermore, I am of the view that I do not have authority, in the instant cases, to revisit the Registrar's decision made under section 31(1) of the Act as I do not find that the Registrar made clear errors of law (or errors in interpretation of the facts) in permitting the applications for the Marks to proceed to advertisement [see *Magill v. Taco Bell Corp.* (1991), 31 CPR (3d) 221 at 226 (TMOB)].

[37] With respect to the Opponent's allegation that the Applicant had not used the Marks in the US at the material dates, the Opponent has filed certified copies and materials printed from the USPTO website regarding the US registrations upon which the Canadian applications are based. Specifically, the Opponent provides copies of requests

for extensions of time for the filing of statements of use in association with the Applicant's corresponding US applications.

[38] I have reviewed all of the evidence and note that the only evidence which is relevant to the present proceedings is one extension of time request dated March 26, 2007 filed in relation to US application 78-762957 (Exhibits ASA-2 to the Salera affidavit and ACB1-ACB2 to the Boudreault affidavit) which supports the section 30(d) basis for the Wares for the Design Mark. I note that this was a first extension of time request and no reasons were given supporting the request.

[39] Section 30(d) of the Act states the following:

(d) in the case of a trade-mark that is the subject in or for another country of the Union of a registration or an application for registration by the applicant or the applicant's named predecessor in title on which the applicant bases the applicant's right to registration, particulars of the application or registration and, if the trade-mark has neither been used in Canada nor made known in Canada, the name of a country in which the trade-mark has been used by the applicant or the applicant's named predecessor in title, if any, in association with each of the general classes of wares or services described in the application;

[40] Based on a fair reading of section 30(d) of the Act, compliance requires an applicant or its predecessor to have used the mark in a country at the material date and to include a statement to that effect in the application.

[41] In the present case, the Applicant makes a statement in its application for the Design Mark that, at the material date, the Design Mark had been used in the US in association with the Wares. However, the evidence filed by the Opponent calls into question the truth of this statement. While I acknowledge that there can be any number of reasons as to why an applicant would request an extension of time to file its statement of use, I note that the request does raise a doubt as to the truth of the Applicant's statement that it was using the Design Mark in association with the Wares in the US at the material date. Thus I am satisfied that the Opponent has met its evidential burden but only with respect to the Wares for the Design Mark. The ground of opposition is therefore dismissed with respect to the Services for both the Word and the Design Mark.

[42] The onus now shifts to the Applicant to establish that the Applicant had been using the Design Mark in the US in association with the Wares at the material date. Given that the Applicant has not filed any evidence, I am not satisfied that the Applicant has met its onus and thus the ground of opposition based on section 30(d) of the Act is successful with respect to the Wares for the Design Mark.

[43] I note, however, that the success of the section 30(d) ground of opposition does not automatically result in the refusal of the application for the Design Mark with respect to the Wares as the application may proceed based on the proposed use claim depending upon the outcome of the remaining grounds of opposition.

*Section 30(e) of the Act*

[44] The Opponent pleads that the application does not comply with section 30(e) of the Act because the Applicant did not intend to use the Marks in Canada; the Applicant had already used the Marks in Canada before the filing dates; the marks the Applicant intends to use are not the Marks; and the Marks are not trade-marks as they are merely decorative.

[45] Since it is difficult to prove a negative, and certainly more so in the case of a proposed use application, the initial burden upon the Opponent with respect to the ground of opposition based upon non-compliance with section 30(e) is a relatively light one [see *Molson Canada v. Anheuser-Busch Inc.*, (2003) 29 CPR (4th) 315 (FC)]. Since the Applicant did not file any evidence, this is not a case where the Opponent could rely on the Applicant's evidence to meet its burden [see *Molson, supra*, and *York Barbell Holdings Ltd. v. ICON Health and Fitness, Inc.* (2001), 13 CPR (4th) 156 (TMOB)].

[46] Since the applications contain a statement that the Applicant intends to use the Marks by itself or through a licensee, they formally comply with section 30(e) of the Act. The issue becomes whether or not the Applicant has substantially complied with section 30(e) of the Act (i.e. is the Applicant's statement that it intended to use the applied for mark true?) [see *Home Quarters Warehouse, Inc. v. Home Depot, U.S.A., Inc.* (1997), 76

CPR (3d) 219 (TMOB); *Jacobs Suchard Ltd. v. Trebor Bassett Ltd.* (1996), 69 CPR (3d) 569 (TMOB)].

[47] I agree with the Applicant's submissions that the Opponent has not met its evidential burden as the Opponent has failed to file evidence in support of any of the allegations. Based on the foregoing, I dismiss the ground of opposition based on section 30(e) accordingly.

*Section 30(i) of the Act*

[48] Section 30(i) of the Act requires that an applicant declare itself satisfied that it is entitled to use the applied-for mark. The jurisprudence suggests that non-compliance with section 30(i) can be found in one of two circumstances. The first circumstance is where there are exceptional circumstances such as bad faith which 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, S.A. de C.V. v. Marcon* (2008), 70 CPR (4th) 355 (TMOB) at 369]. In this case, there is no evidence of bad faith on the part of the Applicant. The second circumstance is where there is a *prima facie* case of non-compliance with a federal statute such as the *Copyright Act* R.S.C. 1985, c. C-42, *Food and Drugs Act*, R.S.C. 1985, c. F-27 or *Canada Post Corporation Act*, R.S.C. 1985, c. C-10 [see *Interactiv Design Pty Ltd. v. Grafton-Fraser Inc.* (1998), 87 CPR (3d) 537 (TMOB) at 542-543].

[49] Neither the Registrar, nor the Federal Court has ruled on whether a section 30(i) ground of opposition based on the violation of section 22 is a valid ground of opposition [*Parmalat Canada Inc. v. Sysco Corp.* (2008), 69 CPR (4th) 349 (FCTD) at paras. 38-42]. Even if I found this to be a valid ground of opposition, as the Opponent has failed to adduce any evidence supporting a likelihood of depreciation of goodwill which would support a violation of section 22 [see *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC) at paras. 46, 63-68], it would have no chance of success. The same is true with respect to the allegation of the use being contrary to section 7(b) of the Act. Accordingly, this ground of opposition is dismissed.

## Non-registrability Ground of Opposition

### **Section 12(1)(d) of the Act**

[50] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if one or more of the registrations relied upon are 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 CPR (3d) 410 (TMOB)]. I have exercised that discretion and confirm that the registrations for the marks cited remain valid and therefore the Opponent has satisfied its evidential burden. I must now assess whether the Applicant has met its legal burden.

[51] 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.

[52] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 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 CPR (4th) 321 (SCC) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR (4th) 361 (SCC).]

[53] The Opponent's case is strongest with respect to the trade-mark HORS LA LOI subject to registration No. TMA685,339 as the design elements associated with registration No. TMA376,697 share no similarity with the Marks. As a result, I will



assess the ground of opposition based on section 12(1)(d) of the Act with respect to this word mark.

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

[54] The Marks include the words DENVER OUTLAWS which have no particular meaning in relation to the Wares and Services. The Design Mark also features design elements in the form of stylized text and the image of a piece of barbed wire. I find that the Marks possess a high degree of inherent distinctiveness.

[55] The Opponent's mark is made up of the word element HORS LA LOI, which literally translated into English means "outlaw". As submitted by the Opponent, I note that these words have no particular meaning with respect to the Opponent's wares. I find that the Opponent's mark possesses a high degree of inherent distinctiveness.

[56] Ultimately, I assess the inherent distinctiveness of the parties' marks as being about the same, and as being relatively high.

[57] A trade-mark may acquire distinctiveness through use or promotion. However, in the present case neither party has filed evidence to show use or promotion of its marks. While it is true that registration No. TMA685,339 for the Opponent's trade-mark HORS LA LOI claims use since at least as early as February 1995 for some of the wares and a declaration of use was filed on February 27, 2007 with respect to the remainder, at most this entitles me to assume *de minimis* use of the Opponent's mark [see *Entre Computer Centers Inc. v. Global Upholstery Co.* (1991), 40 CPR (3d) 427 (TMOB) at 430]. *De minimis* use does not support a conclusion that the Opponent's mark had become known to any significant extent.

[58] This factor does not significantly favour either party.

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

[59] While it may be true that *de minimis* use is more than no use, I do not agree with the Opponent that this factor favours the Opponent. Rather, in the absence of evidence of

continuous use of either party's marks, I find that this factor does not significantly favour either party.

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

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

[61] The parties' wares share some degree of overlap as they both include clothing. At the oral hearing, the Opponent conceded that the Services differ from the Opponent's clothing wares. However, the Opponent submitted that the average consumer may infer an association between the Services and the Opponent in light of the fact that the Opponent's wares include sports clothing. In the absence of any supporting evidence, I refuse to make such an inference.

[62] Neither party has provided evidence of the channels of trade through which their respective wares and/or services are provided. With respect to the Wares, however, in light of the overlap with the Opponent's wares, and in the absence of any evidence of the nature of the Applicant's trade, I consider it reasonable to infer that the parties' channels of trade could overlap, but only with respect to the Wares.

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

[63] In this case, we have an English trade-mark versus a French trade-mark. Visually and aurally the marks differ. However, the test in these circumstances is not limited to a unilingual Anglophone or Francophone. One must also consider the bilingual consumer [see *Pierre Fabre Medicament v. SmithKline Beecham Corp.* (2001), 11 CPR (4th) 1 (FCA)].

[64] As discussed above in the analysis of the section 6(5)(a) factor, the words in the Opponent's mark (HORS LA LOI) can be translated into English as "outlaw" and thus, to

the average bilingual consumer, the Marks and the Opponent's mark suggest the same idea.

*Additional Surrounding Circumstance*

[65] At the oral hearing, the Opponent submitted that, while not determinative, it is relevant to note that the Registrar forwarded a notice to the Opponent pursuant to section 37(3) of the Act.

[66] I note that a decision by an Examiner of the Canadian Intellectual Property Office has no precedential value for the Board because both the onus and evidence before an Examiner differs from that before the Board [see *Thomas J. Lipton Inc. v. Boyd Coffee Co.* (1991), 40 CPR (3d) 272 (TMOB) at 277 and *Procter & Gamble Inc. v. Morlee Corp.* (1993), 48 CPR (3d) 377 (TMOB) at 386]. I must come to a decision based solely on the evidence of record in this opposition proceeding.

[67] Based on the foregoing, I do not find that this forms a relevant surrounding circumstance supporting the Opponent's position.

*Conclusion*

[68] In applying the test for confusion I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, in particular the similarity in the nature of the parties' wares and the ideas suggested by the parties' marks, I am not 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 and the Opponent's mark with respect to the Wares. However, I find the difference between the Services and the Opponent's clothing wares to be sufficient to shift the balance of probabilities in the Applicant's favour.

[69] Having regard to the foregoing, I accept the ground of opposition based on section 12(1)(d) with respect to the Wares and I am dismissing the ground of opposition based on section 12(1)(d) with respect to the Services.

## **Section 12(1)(b) of the Act**

[70] The Opponent has made no submissions in support of the section 12(1)(b) ground of opposition and thus I do not intend to engage in a lengthy analysis of this ground.

[71] The issue as to whether the Marks are clearly descriptive or deceptively misdescriptive must be considered from the point of view of the average purchaser of the associated wares. The Marks must not be dissected into their component elements and carefully analyzed but must be considered in their entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Registrar of Trade-marks* (1978), 40 CPR. (2d) 25 (FCTD) at 27-8; *Atlantic Promotions Inc. v. Registrar of Trade-marks* (1984), 2 CPR. (3d) 183 (FCTD.) at 186]. Finally, the purpose of the prohibition in section 12(1)(b) of the Act is to prevent any single trader from monopolizing a term that is clearly descriptive or common to the trade, thereby placing legitimate traders at a disadvantage [see *Canadian Parking Equipment Ltd. v. Canada* (Registrar of Trade-marks) (1990), 34 CPR. (3d) 154 (FCTD) at para 15].

[72] The Marks include the word DENVER. I am prepared to take judicial notice of the fact that Denver is the name of the capital city of the state of Colorado in the US. The Marks also, however, include the word OUTLAWS, which is the dominant element of the Marks (either by virtue of it being the largest and most visually prominent element in the case of the Design Mark, or the more inherently distinctive element in the case of the Word Mark). As a result, when considered as a whole, I do not find that the Marks are clearly descriptive of the place of origin of the Wares and Services.

[73] Based on the foregoing, I am dismissing the ground of opposition based on section 12(1)(b) of the Act on the basis that the Opponent has failed to meet its evidential burden.

## Non-entitlement Grounds of Opposition

### *Sections 16(2)/(3)(a) and (c) of the Act*

[74] The Opponent has not filed any evidence of use of its HORS LA LOI trade-marks and trade-names. The mere statement of use in a registration is insufficient to satisfy the Opponent's initial burden under section 16 of the Act. As a result, the Opponent has failed to meet its evidential burden for the grounds of opposition based on sections 16(2)(a) and (c) and 16(3)(a) and (c) of the Act.

### *Sections 16(2)/(3)(b) of the Act*

[75] Despite the burden of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Marks and the Opponent's pending application for the trade-mark OUTLAW (application No. 1,146,692), the Opponent has the initial onus of proving that the OUTLAW application was pending at the dates of filing the applications for the Marks, in the present case, the priority filing dates (September 26, 2005 and November 29, 2004), and remained pending at the dates of advertisement of the applications for the Marks, May 5, 2010 and July 8, 2009 [section 16(5) of the Act]. The Registrar has the discretion, in view of the public interest, to check the register for applications relied upon by an opponent [see *Royal Appliance Mfg. Co. v. Iona Appliance Inc.* (1990), 32 C.P.R. (3d) 525 (T.M.O.B)]. I have exercised my discretion to check the status of the application cited by the Opponent.

[76] The OUTLAW application was filed prior to the priority filing dates for the applications for the Marks and remained pending at the dates of advertisement for the applications for the Marks and thus the Opponent has met its burden with respect to this ground of opposition.

[77] The Opponent submitted that its case is even stronger with respect to this mark as the whole of the Opponent's OUTLAW trade-mark is incorporated into the Marks. I agree. The wares associated with the OUTLAW application are similar to those associated with the Opponent's registered HORS LA LOI trade-mark.

[78] 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, with the modification that the section 6(5)(e) factor is even stronger for the Opponent with respect to the trade-mark OUTLAW.

[79] As a result, I am not 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 and Opponent's OUTLAW trade-mark with respect to the Wares. However, I find the difference between the Services and the Opponent's clothing wares to be sufficient to shift the balance of probabilities in the Applicant's favour.

[80] Having regard to the foregoing, I accept the grounds of opposition based on sections 16(2)/(3)(b) of the Act with respect to the Wares and I am dismissing the grounds of opposition based on sections 16(2)/(3)(b) with respect to the Services.

*Introductory Paragraphs of Sections 16(2) and 16(3) of the Act*

[81] The Opponent alleges that the Applicant is not entitled to registration of the Marks since, contrary to the introductory paragraphs of sections 16(2) and 16(3) of the Act the applications do not comply with the requirements of section 30 of the Act.

[82] The introductory paragraphs of sections 16(2) and 16(3) of the Act do not form the basis of grounds of opposition as defined in section 38(2) of the Act since sections 16(2) and 16(3) of the Act as a whole relate to the entitlement grounds of opposition. Accordingly, I dismiss the two grounds of opposition based solely upon the introductory paragraphs of sections 16(2) and 16(3) of the Act.

Non-distinctiveness Ground

[83] The non-distinctiveness ground is pleaded as a three-pronged ground of opposition. The first prong relates to an allegation that the Marks do not distinguish, and are not adapted to distinguish, the Wares and Services from the wares of the Opponent in association with its HORS LA LOI trade-marks. The Opponent has not filed any evidence of use of its HORS LA LOI trade-marks and thus there is no evidence that

establishes that any of the Opponent's marks had, as of the material date of May 19, 2010 for the Word Mark and November 30, 2009 for the Design Mark, acquired a reputation in Canada that was sufficient to affect the distinctiveness of the Marks [see *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. The Opponent has thus failed to meet its evidential burden with respect to the first prong of the non-distinctiveness ground of opposition based on sections 38(2)(d) and 2 of the Act. The first prong of the non-distinctiveness ground of opposition is accordingly dismissed.

[84] The second and third prongs of the non-distinctiveness ground of opposition relate to improper licensing and assignment of the Marks, respectively. The Opponent has not filed any evidence in support of these allegations and thus the second and third prongs of the non-distinctiveness ground of opposition are also dismissed on account of the Opponent's failure to meet its evidential burden.

#### Disposition

[85] Due to the success of the ground of opposition based on section 30(d) of the Act, the application for the Design Mark must be amended to delete the use and registration claim with respect to the Wares.

[86] The following disposition relates to the intent to use claims which remain. Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse application No. 1,289,535 with respect to "clothing, namely, shirts, T-shirts, under shirts, night shirts, rugby shirts, polo shirts, cardigans, jerseys, sports uniforms, dress shirts, pants, trousers, slacks, jeans, culottes, cargo pants, denim jeans, overalls, coveralls, jumpers, jump suits, shorts, boxer shorts, tops, crop tops, tank tops, halter tops, sweat shirts, sweat shorts, sweat pants, wraps, warm-up suits, jogging suits, track suits, play suits, blouses, skirts, dresses, gowns, sweaters, vests, fleece vests, pullovers, snow suits, parkas, capes, anoraks, ponchos, jackets, reversible jackets, coats, blazers, suits, turtlenecks, cloth ski bibs, swimwear, beachwear, tennis wear, surf wear, ski wear, layettes, infantwear, infants sleepers, baby bibs not of paper, cloth diapers, wrist bands, sweat bands, aprons, scarves, bandanas, belts, suspenders, neckwear, ties, neckerchiefs, ascots, underwear, thermal underwear, long underwear, briefs, swim and bathing trunks,

bras, sports bras, brassieres, bustiers, corsets, panties, thongs, garters and garter belts, teddies, girdles, foundation garments, singlets, socks, loungewear, robes, smocks, underclothes, pajamas, sleepwear, night gowns, lingerie, camisoles, negligees, chemises, chemisettes, slips, sarongs, leg warmers, hosiery, pantyhose, body stockings, knee highs, leggings, tights, leotards, body suits, unitards, body shapers, gloves, mittens, and rainwear; headwear, namely, caps, swim caps, berets, beanies, hats, visors, headbands, and ear muffs; footwear, namely, shoes, sneakers, boots, booties, galoshes, sandals, flip-flops, and slippers” and I reject the opposition with respect to “entertainment namely the production of lacrosse games, competitions and tournaments; entertainment, namely, participation in lacrosse games and competitions namely, organization of lacrosse games and competitions; conducting entertainment exhibitions namely lacrosse games and competitions; organizing exhibitions of the sport of lacrosse; providing facilities for lacrosse tournaments; arranging and conducting athletic competitions, namely, lacrosse competitions; entertainment namely the production of on-going television programs in the field of sporting events; entertainment, namely, a continuing sports event show distributed over television, satellite, audio and video media; entertainment services, namely, providing a television program featuring sporting events via a global computer network; providing an on-line computer database in the field of lacrosse; entertainment services, namely, providing a web site featuring information pertaining to lacrosse goods and services” [see *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 482 (F.C.T.D.) as authority for a split decision].

[87] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse application No. 1,297,982 with respect to “clothing, namely, shirts, T-shirts, polo shirts, jerseys, sports uniforms, shorts, boxer shorts, tops, crop tops, tank tops, halter tops, sweat shirts, sweat pants, warm-up suits, track suits, fleece vests, pullovers, jackets, neckwear, ties, gloves, mittens, and rainwear; suspenders, headwear, namely, caps, hats, visors, headbands, footwear, namely, sneakers, flip-flops” and I reject the opposition with respect to “entertainment namely the production of lacrosse games, competitions and tournaments; entertainment, namely, participation in lacrosse games and competitions, namely, organization of lacrosse games and competitions; conducting entertainment exhibitions namely lacrosse games and competitions; organizing exhibitions of the sport



of lacrosse; providing facilities for lacrosse tournaments; arranging and conducting athletic competitions, namely, lacrosse competitions; entertainment namely the production of on-going television programs in the field of sporting events; entertainment, namely, a continuing sports event show distributed over television, satellite, audio and video media; entertainment services, namely, providing a television program featuring sporting events via a global computer network; providing an on-line computer database in the field of lacrosse; entertainment services, namely, providing a web site featuring information pertaining to lacrosse goods and services” [see *Produits Ménagers, supra* as authority for a split decision].

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Andrea Flewelling  
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Trade-marks Opposition Board  
Canadian Intellectual Property Office