



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

Citation: 2011 TMOB 250
Date of Decision: 2011-12-12

**IN THE MATTER OF AN OPPOSITION
by Yamaha Motor Canada Limited to
application No. 1,217,558 for the trade-
mark THE WORLD'S TOUGHEST
ATVS & DESIGN in the name of Polaris
Industries Inc.**

[1] On May 17, 2004 an application to register the trade-mark THE WORLD'S TOUGHEST ATVS & DESIGN application No. 1,217,558 (the Mark) was filed by Polaris Industries Inc. (the Applicant). The application claims the priority filing date of March 18, 2004 based on U.S. application No. 78/386,658. The application is based on proposed use in Canada, as well as use and registration in the United States, in association with "*all terrain vehicles and structural parts therefore*". The Applicant has disclaimed the right to the exclusive use of ATV apart from the Mark as a whole. The Mark was advertised in the *Trade-marks Journal* of February 22, 2006 and is shown below:



[2] On July 21, 2006, a statement of opposition was filed by Yamaha Motor Canada Limited (the Opponent); the Applicant filed and served its counter statement on September 14, 2006.

[3] The Opponent filed the affidavits of Tim Chelli, Katherine Duffield (1 and 2), Robert Samuels, Stuart Blakeney, Sheila McEwing, and Sharon Elliott. Mr. Chelli was cross-examined on his affidavit and the transcript is of record in this proceeding.

[4] The Applicant's evidence consists of the affidavits of Linda Victoria Thibeault and Jan Rintamaki. Mr. Rintamaki was cross examined on his affidavit and the transcript is of record in this proceeding.

[5] Both parties filed written submissions and were represented at an oral hearing.

Grounds of Opposition pursuant to the *Trade-marks Act* R.S.C. 1985, c. T-13

[6] The grounds of opposition are summarized as follows:

- Section 38(2)(a) and Section 30: Non-compliance with s. 30(d) of the Act because, at the filing date of the application, the Applicant had not used the Mark anywhere in the world. Non-compliance with s. 30(e) as the Applicant does not intend to use the Mark in Canada in association with the wares set out in the application.
- Section 38(2)(b) and Section 12(1)(b): The Mark is not registrable as the words are the dominant portion of the Mark and they are clearly descriptive or deceptively misdescriptive of the associated wares.
- Section 38(2)(d) and Section 2: Non-distinctiveness as the Mark does not distinguish nor is it adapted to distinguish the wares covered by the application from the wares and services of others including the wares of the Opponent.

Onus

[7] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence that can support its allegations for each ground of opposition [*John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Main Issue

[8] The main issue argued by the parties is registrability under s. 12(1)(b). In my view this is the determinative issue; the relevant evidence is summarized below.

[9] The material date relating to a determination of descriptiveness under s. 12(1)(b) is the filing date of the application, namely, May 17, 2004 [*Zorti Investments Inc v. Party City Corp.* (2004), 36 C.P.R. (4th) 90 (T.M.O.B.); *Havana Club Holdings S.A. v. Bacardi & Co.* (2004), 35 C.P.R. (4th) 541 (T.M.O.B.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)]

Summary of the Opponent's Evidence

Affidavit of Tim Chelli

[10] Mr. Chelli identifies himself as the National Manager of Compliance and Product Liability for the Opponent. He states that he has been with the Opponent for 20 years, and has held this position since October 4, 1999. The affiant provides that it is common for the Opponent to use descriptive words, phrases or ideas similar to “world’s toughest” in advertisements promoting the sale of ATVs in Canada. The promotional materials are distributed through the Opponent’s dealer network, and a sample of advertisements is attached as Exhibit 1. I note that there are four ads attached, one from each of the years 1994, 1998, 2005 and 2006, respectively. These exhibits all contain pictures of the Opponent’s various models of ATVs and each contains one or more phrases that use the word “tough” or “toughest”, (and one contains the word “rugged”), as follows:

- 1994 – “Kodiak: The toughest ATV in the Wild”
- 1998 - “One tough ATV”

- 2005 - “Best ATVs on the planet. Period”. “The toughest and best mid-sized ATV on the market.”
- 2006 - “...building the most rugged ATVs on the planet”.... “our engineers are tougher on the ATVs than you’ll ever be.” “Success comes from building the toughest, most reliable, longest-lasting vehicles on earth.”

Affidavits of Stuart Blakeney and Sheila McEwing

[11] Stuart Blakeney is a Helpdesk Analyst at Gowling Lafleur Henderson LLP, solicitors for the Opponent. He provides two video recordings, downloaded from the Applicant’s website on March 13, 2007, related to a challenge put forward by the CEO of the Applicant to CEOs of other ATV manufacturers. Sheila McEwing is a legal assistant at the same law firm who transcribed the audio portion of the videos. I refer to the following part of the transcription relating to the challenge that states “[a]s the CEO of Polaris, I believe we build the world’s toughest ATV. But it seems like almost every ATV manufacturer is out there trying to claim the exact same thing” (McEwing: Exhibit 1). Following this statement, the CEO challenges the other CEOs to compete with the Applicant, with their ATVs. Even though this evidence is dated after the filing date of the application, I am willing to consider it as evidence of the fact that "tough" and "toughest" are desirable attributes in all terrain vehicles (which are specifically designed to travel over rough terrain). I find it reasonable to infer this would have been the case at the material date.

Affidavit of Robert Samuels

[12] Robert Samuels is an articling student at the Opponent’s firm; he was instructed on March 12, 2007, to visit the website address www.polarisindustries.com/PolarisDuel/ and print out portions of the Applicant’s website. Attached as Exhibit 1 are copies of excerpts from this website. The excerpts summarize a challenge put forward by the CEO of the Applicant where he states that “Lately, many manufacturers have been claiming their ATVs are tough. As the CEO of Polaris, I believe we build the world’s toughest ATVs and I’m ready to prove it.” The excerpts also show that there is a section labeled “Competitor Ad” that gives the viewer the option to see advertisements by competitors. These competitor advertisements use phrases such as “tough and

dependable”, “the ATV that is tough enough to ...” Underneath this option is the following: “Tom wasn’t kidding when he said that every other ATV manufacturer out there was claiming the same thing. Just go through the competitor ads above, all saying they are the toughest.” Even though this evidence is dated after the filing date of the Application, I am, for the reasons given above, willing to consider it as evidence of the fact that "tough" and "toughest" are desirable attributes in all terrain vehicles and to infer this would have been the case at the material date.

Other Affidavits

[13] Sharon Elliot is a law clerk at the Opponent’s firm and provides certified copies of file histories of various U.S. trade-marks that contain the phrase “THE WORLD’S TOUGHEST” as part of the mark. I do not consider evidence of the state of the US Trademark Register of great relevance in an opposition proceeding for the purposes of assessing descriptiveness under the Canadian *Trade-marks Act* since the descriptiveness provisions of the *Lanham Act* are not identical to those in Canada. The affiant also provides the file history for U.S. Registration No. 78/386,658 for the Mark. I note that originally the Mark was refused on the basis of being “merely descriptive and laudatory” under s. 2(e)(1) of the *Lanham Act*. Subsequently the Applicant provided requisite evidence of use and the Mark was registered on the supplemental register.

[14] Katherine Duffield is a student-at-law with the Opponent’s firm. She performed database searches of the United States Patent and Trademark Office (USPTO) and provides print-outs of trade-marks incorporating “world’s toughest”. As stated above, I do not consider the state of the US Trademark Register to be relevant to this proceeding. In her second affidavit, Ms. Duffield states that she obtained printouts of articles from the Internet on August 2, 2007. Over 80 Exhibits are attached, comprised of articles that make reference to a variety of third party wares, which are described as the “world’s toughest”, the “world’s most rugged” and the “world’s most durable”. Again, this evidence is dated after the material date; however, it is relevant to the extent that it confirms that “tough” (and its synonyms) can be an apt word for describing wares. Again, I am willing to infer that such a state of affairs would have existed at the filing date of the application.

Summary of Applicant’s Evidence

Affidavit of Jan Rintamaki

[15] Mr. Rintamaki has been the Marketing Manager of the ATV Division of the Applicant since March 2008. He states that as the Marketing Manager, he is familiar with all aspects of the marketing, sale, distribution and advertising of the Applicant's ATVs and their structural parts; he is also responsible for all aspects of marketing, promotion, and communications relating to ATVs.

[16] Mr. Rintamaki provides that the Applicant specializes in manufacturing snowmobiles, ATVs, utility vehicles and motorcycles. He has provided excerpts from the Applicant's website *www.polarisindustries.com* as Exhibit B, which show various models and types of the vehicles. I note that one of the excerpts shows the picture of an ATV in close proximity to the statement "MAKE THE WORLD'S TOUGHEST EVEN TOUGHER".

[17] Mr. Rintamaki states that the Applicant has extensively used the Mark with its ATVs since at least as early as April 29, 2004 in the U.S. Use in Canada began in July 2004. The Applicant has registered the Mark with the USPTO and printouts of its registration are attached as Exhibit C. He has also provided a printout of the Canadian pending application for the Mark as Exhibit Q.

[18] Mr. Rintamaki sets out that the Applicant sells ATVs under various model names such as SPORTSMAN and TRAILBLAZER. These various models are all associated with the Mark and as examples Mr. Rintamaki has provided what he states are owner's manuals for the ATVs for 2006, 2007, and 2008 (Exhibits D, E and F). However, during cross-examination, Mr. Rintamaki clarified that these Exhibits actually show the Applicant's catalogues for the above-mentioned years. I note that Mr. Rintamaki clearly stated during cross-examination (p. 33, line 7) that the owner's manuals also bear the Mark and that these manuals are provided to both American and Canadian customers. It is not clear, however, whether the catalogues that are shown in Exhibits D, E, and F are available to Canadian customers as well. In any event, with respect to the typical manner of use of "tough" and "toughest" by the Applicant, I note that these catalogues make mention of the word "tough". For example, the catalogue for the ATV SPORTSMAN has a subject line of "THE ANATOMY OF TOUGH" followed by the following description "Front to back, top to bottom, Sportsman has the guts to stand up to the toughest condition."

[19] Mr. Rintamaki states that the Applicant owns a wholly owned subsidiary in Canada called Polaris Industries Ltd., which has approximately 250 authorized dealers in Canada. The Applicant provides marketing materials such as banners bearing the Mark which the dealers are encouraged to display in their stores. Mr. Rintamaki has attached as Exhibit O a representative sample of a banner that was displayed in 2004 at authorized dealerships. The banner clearly shows an ATV alongside the words THE WORLD'S TOUGHEST ATVs. The applicant has advertised extensively in Canada, in outdoor magazines and national and local cable broadcasts. Annual advertising and promotional expenditures for on-line, print and television in Canada for the ATVs since its introduction into the Canadian marketplace in 2004 (July) have exceeded \$1,000,000 each year.

[20] Mr. Rintamaki provides that the Applicant has been very successful in the past five years in generating substantial revenues per annum in Canada for sales of ATVs bearing the Mark. Between 2004 and March 2008, the Applicant has sold in excess of 60,000 units to consumers in the Canadian marketplace; gross revenue has exceeded \$80,000,000 each year.

[21] The balance of Mr. Rintamaki's affidavit relates to the sale and advertisement of ATVs in the United States, and as such is of limited relevance to the issues at hand.

Affidavit of Linda Victoria Thibeault

[22] Linda Victoria Thibeault is employed as a trade-mark searcher with Trade Mark Reflections Ltd., a company that was requested by the Applicant's firm to carry out searches of the Canadian Trade-marks Office records. She was instructed to search the records for trade-marks containing the terms "WORLD'S TOUGHEST", "TOUGH" "TUFF" and "RUGGED"; the results of her search are attached as Exhibits A to J.

[23] More particularly, Exhibit F provides information on the trade-mark most similar to the Mark, namely, WORLD'S TOUGHEST OFF-ROAD TIRES. I note that the application was advertised, with a disclaimer of "toughest off-road tires", and was subsequently refused during opposition proceedings on the basis that the trade-mark was clearly descriptive contrary to s. 12(1)(b) [*BFS Brands LLC v. Michelin Recherche & Technique S.A.*, 2010 TMOB 152].

[24] I also note the many other trade-marks located by Ms Thibeault contain words such as “rugged”, “tough” or “tuff” as portions of the respective trade-marks. In most cases, these portions are either part of coined words, or two word fanciful phrases, i.e. “TUFF STUFF”. In some cases the use of “tough” is not used in direct reference to the wares, such as in TOUGH DUCK OUTBOARD COVER & Design. In my view, there are really only two relevant trade-marks consisting of arguably descriptive multi-word phrases, similar to the subject Mark, namely THE WORLD’S TOUGHEST ACTIVEWEAR & CCC LOGO and THE WORLD’S TOUGHEST SHREDDERS; these will be discussed below.

Discussion

Section 38(2)(b)/s. 12(1)(b) of the Act

[25] Section 12(1)(b) of the Act states that:

12. (1) Subject to section 13, a trade-mark is registrable if it is not

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

[26] The issue of whether THE WORLD’S TOUGHEST ATVs is clearly descriptive or deceptively misdescriptive of “*all terrain vehicles and structural parts therefore*” must be considered from the point of view of the average consumer of those wares. Further, in determining whether the Mark is clearly descriptive, it must not be dissected into its component elements and carefully analysed, but rather must be considered in its entirety as a matter of immediate impression [*Atlantic Promotions Inc. v. Registrar of Trade Marks*, (1984) 2 C.P.R. (3d) 183 at 186 (F.C.T.D.)]. “Character” in s. 12(1)(b) means a feature, trait or characteristic of the wares or services and “clearly” means “easy to understand, self-evident or plain” [*Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 at 34 (Ex. Ct.)]. Further, it is well established that words or phrases having a laudatory connotation are *prima facie* descriptive terms [*Mitel Corp. v. Canada (Registrar of Trade Marks)* (1984), 79 C.P.R. (2d) 202 (F.C.T.D.); *Imperial Tobacco Ltd. v. Benson & Dehdes (Canada) Inc.* (1983), 75 C.P.R. (2d) 115 (F.C.T.D.)].

[27] The Opponent has pleaded that the Mark is not registrable pursuant to s. 12(1)(b) on the basis that it is clearly descriptive or deceptively misdescriptive of the character or quality of the wares. I would observe at this juncture that it is clear from the evidence that the common name for “all terrain vehicles” such as the Applicant’s is ATVs. Further, the Opponent argues that the word “tough” or “toughest” and other similar words clearly describe that the Applicant’s ATVs are designed not to break but to withstand the challenges of use on rough terrain. The Opponent argues that the Mark clearly describes the highest degree of excellence of this characteristic. The Opponent’s initial evidential burden has been met in view of the ordinary meaning of the commonly known words “tough”, “toughest”, “world’s” and “ATVs”.

[28] As I may take judicial notice of dictionary definitions, I have taken the liberty of reproducing relevant definitions of “tough”:

- *Canadian Oxford Dictionary* (1998 ed.): Tough: adj: hard to break, cut, tear, or chew; durable; strong: and
- *Online Oxford Dictionary of English*: Tough: (of a substance or object) strong enough to withstand adverse conditions or rough handling

[29] Consequently, the onus is now on the Applicant to demonstrate that the Mark is registrable.

[30] The Applicant submits that the Mark is not clearly descriptive but merely suggestive. During cross-examination Mr. Rintamaki stated that the TV advertisements in Canada make mention of the word “toughest” to indicate the whole brand experience, riding experience and rider confidence and only spends a small amount of time on using the word to describe attributes of the machine (Cross Exam: p. 23, line 2; p. 26, line 3). However, I note that the descriptions provided in the catalogues (Rintamaki: Exhibits D, E, and F), as set out above, clearly use the word “tough” to denote the durability and ruggedness of the Applicant’s ATVs.

[31] This is further supported by the language in the video challenges and the Applicant’s website, for example: “As the CEO of Polaris, I believe we build the world’s toughest ATV. But it seems that like almost every ATV manufacturer is out there trying to claim the same thing.” In

addition, the fact that the Applicant's website also provided options to view competitor advertisements that use the word "tough" or similar words to describe their products is persuasive. I am of the view that the evidence provided by both the Applicant and the Opponent demonstrates that ATV manufacturers use the word "tough" to denote a characteristic of their products. While I understand that much of the evidence post-dates the material date for determining descriptiveness under s. 12(1)(b), I find it reasonable to infer, given the ordinary meaning of "tough" and "toughest", that its appropriateness in describing all terrain vehicles would have existed at the filing date of the Application. This is further supported by the two examples of the Opponent's advertising that Mr. Chelli provided in his affidavit (Exhibit 1) which are dated before the material date.

[32] Further, with respect to the ordinary meaning of the words in the context of the phrase "the world's toughest ATVs", I find that "toughest", being the superlative form of the adjective, takes on a laudatory connotation to indicate that not only is being tough a desirable characteristic, but by being the toughest, it is the best ATV.

[33] The Applicant, however, argues that the Mark is registrable on the basis of examples of registered trade-marks that contain the phrase "WORLD'S TOUGHEST", (namely, THE WORLD'S TOUGHEST ACTIVEWARE & CCC LOGO, THE WORLD'S TOUGHEST SHREDDERS). I would observe, however, that each case must be decided on its own merits. There may, for example, be additional text and/or design material in the trade-mark as in the WORLD'S TOUGHEST ACTIVEWARE & CCC LOGO. In addition, consideration must be given to whether or not the trade-mark was the subject of an opposition since a decision of the Registrar at the examination stage to advertise a trade-mark for opposition pursuant to s.37 is not a decision that the mark is registrable; rather, it reflects that the Registrar is not satisfied that the mark is *not* registrable. In an opposition, however, in accordance with the scheme of the Act, the onus is on the Applicant to show that its mark is registrable. I would therefore note, in this regard, that THE WORLD'S TOUGHEST SHREDDERS was not the subject of an opposition.

[34] I would further observe that the trade-mark application for "WORLD TOUGHEST OFF-ROAD TIRES", included among the trade-marks provided by the Applicant, was refused in an

opposition proceeding on December 2010 [*BFS Brands, supra*], a year after the Applicant and the Opponent had provided their written submissions.

[35] In *BFS Brands, supra*, the Member found that “toughest” in combination with the words “off-road tires” were clearly descriptive of the character and quality of the wares as these commonly known words would indicate to the average English speaking consumers of tires and related wares that the wares in question are the toughest off-road tires. Following the same line of reasoning, I am of the view that to the average English speaking Canadian consumers of ATVs, the word “toughest” clearly describes the durability of the ATVs. The evidence clearly supports this conclusion as the words “tough” and “toughest” or other similar words are used by the Applicant, the Opponent, and other industry competitors to describe their products. In my view, and consistent with the *BFS Brands* decision, the addition of the word “world” does not remove the Mark from the realm of being clearly descriptive as a whole. In fact, I am in agreement with Member Pelletier in *BFS Brands* who found that “world’s” together with the superlative adjective “toughest”, forms a laudatory epithet that describes the excellence of the products. In addition, I would add that in the present case, the shaded background of the Mark, having little or no inherent distinctiveness, does not alter the finding of descriptiveness.

[36] This case is distinguishable from *Canadian Parking Equipment Ltd. v. Registrar* (1990), 34 C.P.R. (3d) 154 F.C.T.D, cited by the Applicant, wherein Jerome ACJ reasoned at p. 160 that the combination of words as a whole (AUTOMATIC PARKING DEVICES OF CANADA) was “at least unusual and a distinguishing feature of the mark as a whole”. In AUTOMATIC PARKING DEVICES OF CANADA the trade-mark references “devices” when in fact the mark is for use with services (servicing parking-lot and access-control equipment, consulting, engineering and design services in connection with the installation of parking-lot and access-control equipment). Furthermore, I would argue that an “automatic parking device” is not an ordinary or commonly understood phrase and its relationship to the services is a bit mystifying. In the present case, however, the Mark is a descriptive phrase in proper grammatical order, which directly references the wares for which it is to be used; each word has a common ordinary meaning, and together as a whole the phrase is easily understood in relation to the wares.

[37] I would agree with the Opponent that the present case is also distinguishable from the KIDFITTERS case [*GWG Ltd. v. Registrar of Trade-marks* (1981), 55 C.P.R. (2d) 1 (F.C.T.D.)] I note that Cattanach J. refers to the oft cited principle from *Standard Ideal Co. v. Standard Sanitary Mfg. Co* [1911] A.C. 78, namely, that a “common word having reference to the character and quality of the goods in connection with which it is used and having no reference to anything else cannot be an apt or appropriate instrument for distinguishing the good of one trade from those of another.” In this regard, I find that the Mark has only one reference, which is the fact that the wares are the toughest (and therefore the best) available.

[38] Although I understand Mr. Rintamaki’s statement that the Mark is used to create a “tough” “brand experience”, in my view, any additional “brand experience” meaning would have been the result of advertising and promotion subsequent to the filing date (since the application is based on proposed use). I find that each of the words is commonly known, and that taken together the plain and ordinary meaning of the Mark as a matter of first impression to the average consumer of all terrain vehicles is that they are the toughest, and therefore the best, ATVs available. I am of the view that at the date of filing of the application, the Mark was not susceptible of any other meaning in Canada.

[39] In view of the foregoing, I find that the Applicant has not discharged its burden with respect to this ground of opposition. I find that the Mark THE WORLD’S THougHEST ATVs & Design clearly describes the character and quality of the ATVs as a matter of first impression contrary to s. 12(1)(b) of the Act.

[40] Accordingly, this ground of opposition is successful.

Remaining Grounds of Opposition

[41] Having found the Opponent successful under its s. 12(1)(b) ground of opposition, the application must be refused. It is therefore not necessary to consider the remaining grounds of opposition.

Disposition

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

P.Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office