

IN THE MATTER OF AN OPPOSITION by Saskatoon Blades Hockey Club Ltd. to application No. 819,680 for the trade-mark KC BLADES & Design filed by DP Fox KC Holdings, Ltd.

On August 2, 1996, the applicant, DP Fox KC Holdings, Ltd., filed an application to register the trade-mark KC BLADES & Design (shown below) for use in association with the following wares:

Playing uniforms; sports equipment, namely hockey sticks and hockey pucks;

and the following services:

Entertainment services in the form of professional ice hockey games and exhibitions.



The drawing is lined for the colours red and grey and these colours are claimed as features of the trade-mark.

The application was based on use and registration in the United States on September 28, 1993 (Registration No. 1,795,105). The application was advertised for opposition purposes on September 8, 1997.

The opponent, Saskatoon Blades Hockey Club Ltd., filed a statement of opposition on March 13, 1998. The first ground of opposition is that the trade-mark is not registrable under s.12(1)(d) of the *Trade-Marks Act*, R.S.C. 1985, c. T-13 (hereinafter “the *Act*”) because it is confusing with the opponent’s registered trade-mark BLADES Design, Registration No. TMA 459,679 (shown below). As its second ground of opposition, the opponent maintains that the applicant is not the person entitled to registration of the mark under s.16(2) of the *Act* because, since the date of the filing of the application in question, the applicant’s trade-mark KC BLADES & Design was confusing with the opponent’s trade-marks BLADES and SASKATOON BLADES and with the opponent’s trade-name Saskatoon Blades Hockey Club, all of which had been previously used and made known in Canada by the opponent in association

with wares encompassed by the applicant's application and services similar to those set out in the applicant's application. The opponent's third ground of opposition is that pursuant to s.38(2)(d) of the *Act* the applicant's trade-mark is not distinctive as it does not actually distinguish nor is adapted to distinguish the wares and services of the applicant from the wares of others, including the wares and services of the opponent. As its fourth ground of opposition, the opponent submits that the application does not comply with s.30(i) of the *Act* in that at the date of filing of the application, the applicant could not have been satisfied that it was entitled to use the trade-mark in association with the applied for wares and services because it was aware of the prior trade-mark and trade-name rights of the opponent as set out above.



The applicant filed and served a counter statement on April 24, 1998, in which it generally denied the allegations asserted by the opponent in its statement of opposition. As its Rule 41 evidence, the opponent submitted the affidavit of Jackson M. Brodsky, President of the Saskatoon Blades Hockey Club Ltd., and a certified copy of trade-mark registration No. TMA459,679 for BLADES & Design. The applicant did not file any evidence. Only the opponent filed a written argument and an oral hearing was conducted at which only the opponent was represented.

The main issue in this proceeding is whether the applicant's trade-mark is confusing with the opponent's trade-marks or trade-name. With respect to the issues of non-entitlement, non-distinctiveness and non-registrability, the material times for considering the issue of confusion are, respectively, the date of filing of the application (*i.e.* August 2, 1996); the date of opposition (*i.e.* March 13, 1998) and the date of my decision. In the circumstances of this case, nothing turns on which material date is chosen to assess the issue of confusion.

In assessing whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances including those specifically enumerated in s.6(5) of the *Act*. The Registrar must also bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the material date, which under s.12(1)(d) is the date of my decision: see the decision in **Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.**, 37 C.P.R. (3d) 413 (F.C.A.). As I consider the most

relevant of the marks pleaded by the opponent to be the mark BLADES and the registered mark BLADES & Design, a determination of the issue of confusion between the applied for mark and these marks will effectively decide the outcome of this proceeding.

Considering initially the inherent distinctiveness of the trade-marks at issue, neither the applicant's nor the opponent's marks possess a high degree of inherent distinctiveness as they are each suggestive of the wares and services in association with which they are used. With respect to the extent to which the trade-marks have become known, the applicant has not shown any evidence of use of its mark in Canada. The opponent, on the other hand, has shown extensive use of its BLADES mark in association with various wares and services related to the operation of a junior hockey team known as the Saskatoon Blades since the mid 1960's, and use of the registered BLADES Design mark since at least the mid 1990's. Thus, the extent to which the trade-marks have become known favours the opponent.

With respect to s.6(5)(b) of the *Act*, the opponent's BLADES and BLADES Design marks have been in use since the mid 1960's and mid 1990's respectively, while the applicant has not shown any evidence of use of its mark in Canada. Thus, this factor also favours the opponent.

Considering next the nature of the wares and services associated with the trade-marks at issue and the nature of the trades associated with those marks, the applicant's "playing uniforms; sports equipment, namely hockey sticks and hockey pucks" and "entertainment services in the form of professional ice hockey games and exhibitions" are almost identical to the opponent's wares and services which include, *inter alia*, hockey sticks, hockey pucks and jerseys and the "operation of a hockey team and entertainment services, namely, arranging of athletic contests and events pertaining to ice hockey". Although the applicant's services pertain to professional ice hockey while the opponent's services pertain to the operation of a junior hockey team, the opponent's evidence shows that the Saskatoon Blades are a member of the Western Canada Hockey League which is one of the feeders of young hockey players to the National Hockey League. It is the opponent's submission that use of the trade-mark by the applicant in Canada would likely lead to the inference that there was some connection or affiliation between the Saskatoon Blades hockey club and the hockey club which would operate under the trade-mark KC BLADES & Design. Further, the opponent has shown that its wares have been sold in locations where one would expect to also find merchandise from professional hockey teams while the applicant has filed no evidence to show that the wares of the parties would not be sold

in the same types of locations. Thus, there is a potential overlap in the parties' channels of trade.

With respect to s.6(5)(e) of the *Act*, the trade-marks at issue are similar in appearance and sound as the central element of the parties' marks is the word BLADES. Although the applicant's design mark includes the letters KC as part of the mark, I agree with the opponent's submission that the letters are so stylized as to be unobvious to the public. The parties' marks are also similar in that the designs of both parties' marks include an element which symbolizes a blade: a skate blade for the opponent's mark and the blade of a hockey stick hitting a puck for the applicant's mark. The ideas suggested by the parties' marks are slightly different, however, as the applicant's mark suggests the idea of hockey whereas the opponent's mark suggests the idea of skating.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. Having regard to my conclusions above, and particularly in view of the resemblance between the marks and trades of the parties, and the applicant's apparent lack of interest in this proceeding, I find that the applicant has failed to satisfy the onus on it to show that its applied for mark is not confusing with the opponent's BLADES and BLADES & Design marks. Thus, the opponent is successful on the first three grounds of opposition and I need not consider the fourth ground.

Accordingly, and with the authority delegated to me under s. 63(3) of the *Act*, I refuse the applicant's application pursuant to s.38(8) of the *Act*.

DATED AT HULL, QUEBEC, THIS 30th DAY OF March, 2001.

C.R. Folz
Member,
Trade-Marks Opposition Board