



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

**Citation: 2014 TMOB 180**  
**Date of Decision: 2014-06-12**

**IN THE MATTER OF AN OPPOSITION  
by Portolite Inc. to application  
No. 1,445,183 for the trade-mark  
FOREST CITY SPORT & SOCIAL  
CLUB in the name of N. Bridgland  
Enterprises Inc.**

[1] Portolite Inc. (the Opponent) opposes registration of the trade-mark FOREST CITY SPORT & SOCIAL CLUB (the Mark) that is the subject of application No. 1,445,183 by N. Bridgland Enterprises Inc. (the Applicant).

[2] Filed on July 17, 2009, the application is based on use of the Mark in Canada since at least as early as June 2009 in association with the following services (the Applicant's Services):

Organization, operation and administration of co-ed multi-sport recreational leagues, co-ed multi-sport leagues, co-ed multi-sport tournaments, co-ed multi-activity outdoor adventure events, social events, namely receptions, parties, dances, food and beverage tastings, awards ceremonies; web-based organization, operation and administration of co-ed multi-sport recreational leagues, co-ed multi-sport leagues, co-ed multi-sport tournaments, co-ed multi-activity outdoor adventure events, social events, namely receptions, parties, dances, food and beverage tastings, awards ceremonies.

[3] The Opponent alleges that: (i) the application does not conform to section 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable under section 12(1)(d) of the Act; (iii) the Applicant is not the person entitled to registration of the Mark under sections 16(1)(a), 16(1)(b) and 16(1)(c) of the Act; and (iv) the Mark is not distinctive under section 2 of the Act.

[4] For the reasons that follow, the opposition ought to be rejected.

#### The Record

[5] The Opponent filed its statement of opposition on June 6, 2011. The Applicant then filed and served its counter statement on August 22, 2011, denying all of the grounds of opposition alleged in the statement of opposition.

[6] In support of its opposition, the Opponent filed the affidavit of Rob Davies, Director of Operations of the Opponent, as well as the affidavit of Mary P. Noonan, a trade-mark searcher employed by the Opponent's agents. In support of its application, the Applicant filed the affidavit of Lael Morgan, an employee of the Applicant and Executive Director of Ottawa Sport & Social Club, Kingston Sport & Social Club, Halifax Sport & Social Club, Victoria Sport & Social Club, and Quinte Sport & Social Club. None of the affiants were cross-examined.

[7] Only the Applicant filed a written argument; an oral hearing was not held.

#### The Parties' Respective Burden or Onus

[8] 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 from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd.* (1990), 30 CPR (3d) 293 (FCTD) at 298].

#### Analysis of the Grounds of Opposition

[9] Aside from the ground of opposition based on section 30(i) of the Act, the opposition turns on the likelihood of confusion between the Mark and the Opponent's registered and applied for trade-marks, as well as its trade-names. I will analyse each of the issues in turn.

#### Section 30(i) of the Act

[10] In its statement of opposition, the Opponent pleads that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada since (i) the Applicant was or should

have been aware of each of the Opponent's registered trade-marks, set out in Schedule A to this decision, with which the Mark is confusing; and (ii) the Applicant is estopped as a licensee of the Opponent from applying to register the Mark, or anything confusingly similar thereto.

[11] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. There is no such evidence here.

[12] With respect to the first prong of the section 30(i) ground of opposition, the fact that the Applicant was aware of the Opponent's marks would not necessarily have prevented the Applicant from being satisfied that it was entitled to use the Mark, on the basis that the Applicant did not believe that the marks were confusing. Further, the Applicant's awareness of the Opponent's prior use of its trade-marks does not by itself preclude the Applicant from making the statement required by section 30(i) of the Act [*Woot, Inc v WootRestaruant Inc Les Restaurants Woot Inc* 2012 TMOB 197].

[13] With respect to the second prong of the section 30(i) ground of opposition, Mr. Davies indicates that in or around January 2003, the Opponent entered into a consulting agreement with "Nicki Birdgland, in trust for a Corporation to be incorporated, namely [the Applicant]". According to the affiant, "the purpose of the agreement was to allow the Applicant to conduct the administration of sports leagues in Ottawa, Ontario, as exemplified by the businesses being carried on by the Opponent". The affiant further states that the Opponent granted the Applicant a limited license for its intellectual property as part of the agreement but that there was no assignment of any such rights. A copy of the said consulting agreement is attached as Exhibit 35 to the Davies affidavit.

[14] I note that the agreement is between the Opponent and Nicki Bridgland, "in Trust for a Corporation to be incorporated to conduct the Business", effective January 12, 2003 to December 31, 2007 [section F]. It includes provisions related to the Opponent's ownership in the name and the trade-mark "Toronto Central Sport & Social Club", as well as its corresponding logo, and the corporation's right to use the name and the trade-mark "Ottawa Sport & Social Club", "a logo similar to the TCSSC logo" that incorporates the name "Ottawa Sport & Social

Club”, and the domain name *www.ottawassc.com* [section I]. The agreement does not, however, discuss or reference any other trade-marks or trade-names owned or used by either party, including the Mark, nor does it contain any provision regarding registration of trade-marks in general.

[15] Based on the foregoing, I am of the view that the agreement did not prevent the Applicant from making the statement required by section 30(i) of the Act, at the filing date of the subject application for the Mark. In the absence of any evidence of bad faith, the section 30(i) ground is dismissed for the Opponent’s failure to discharge its initial evidential burden.

Is the Mark Confusing with the Opponent’s Registered Trade-marks?

[16] In its statement of opposition, the Opponent alleges that the Mark is not registrable pursuant to section 12(1)(d) of the Act, on the ground that it is confusing with the Opponent’s registered trade-marks, set out in Schedule “A” to this decision.

[17] The material date for considering this issue, which arises from the section 12(1)(d) ground of opposition, is 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)].

[18] An opponent’s initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing. The Registrar has the discretion to check the register in order to confirm the existence of the registration 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)].

[19] Having exercised the Registrar’s discretion, I confirm that the Opponent’s registration Nos. TMA829,696, TMA762,546, TMA591,422, TMA761,815, TMA591,330 and TMA761,814 are in good standing.

[20] Since the Opponent has satisfied its initial evidential burden, the issue becomes whether the Applicant has met its legal burden to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the Opponent’s registered trade-

marks. For the reasons that follow, I reject this ground of opposition and decide this issue in favour of the Applicant.

### The test for confusion

[21] 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.

[22] 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 *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

[23] Comparing the Mark and the registered trade-mark TORONTO CENTRAL SPORT AND SOCIAL CLUB (No. TMA591,422) will effectively decide the section 12(1)(d) ground of opposition. In other words, if confusion is not likely between the Mark and TORONTO CENTRAL SPORT AND SOCIAL CLUB, then it would not be likely between the Mark and any of the other registered trade-marks alleged by the Opponent (Nos. TMA829,696, TMA762,546, TMA761,815, TMA591,330 and TMA761,814).

[24] I will now turn to the assessment of the section 6(5) factors.

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

[25] The overall consideration of the section 6(5)(a) factor involves a combination of inherent and acquired distinctiveness of the parties' trade-marks. I assess the inherent distinctiveness of both parties' marks to be equal in that they are both very weak. In this regard, both marks are descriptive of organizations that offer sport and social activities in a particular area of Canada.

[26] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. In this regard, both parties provide some evidence of promotion and/or use of their trade-marks. I shall begin with a review of the Opponent's evidence.

Acquired Distinctiveness – TORONTO CENTRAL SPORT AND SOCIAL CLUB

[27] As a preliminary matter, I am of the view that any evidence of use of the design mark TORONTO CENTRAL SPORT & SOCIAL CLUB & Design of registration No. TMA591,330 (the TORONTO CENTRAL Design Mark), shown below, and of the word mark TORONTO CENTRAL SPORT & SOCIAL CLUB, qualify as use of the registered word mark TORONTO CENTRAL SPORT AND SOCIAL CLUB.



No. TMA591,330  
(The TORONTO CENTRAL Design Mark)

[28] In this regard, I note that the Opponent is not under any restriction to use the word mark in any particular format. Moreover, I am of the view that the use of the ampersand symbol “&” in place of the term “AND” is a deviation that may be qualified as inconsequential given that the dominant features of the word mark are preserved [see *Registrar of Trade-marks v Compagnie Internationale pour l'Informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltee v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[29] In his affidavit, Mr. Davies states that the Opponent is “an Ontario corporation engaged in the administration, organization and management of adult co-ed and single sex recreational sport leagues, tournaments, social clubs and various other sporting, social and entertainment events”. Examples of activities organized by the Opponent include badminton, basketball, bowling, curling, dodgeball, fitness classes, floor hockey, football, inner tube water polo, soccer, softball, squash, tennis, ultimate, volleyball, award nights and party events [Exhibit 1 and paragraph 10 of the Davies affidavit]. The affiant further states that since 1996, the Opponent has become the leading provider of sporting, social and entertainment events for adults in the city of Toronto.

[30] According to Mr. Davies, the Opponent has also expanded its operations to other cities and regions in Canada, establishing:

- “York Region Sport and Social Club” in 2001 under the trade-mark YORK SPORT & SOCIAL CLUB & Design (No. TMA761,814);
- “Durham Region Sport and Social Club” in 2006 under the trade-mark DURHAM SPORT & SOCIAL CLUB & Design (No. TMA762,546);
- “Hamilton Sport and Social Club” in 2009 under the trade-mark HAMILTON SPORT & SOCIAL CLUB & Design (No. TMA829,696);
- “Mississauga Sport and Social Club” in 2010 under the trade-mark MISSISSAUGA SPORT & SOCIAL CLUB;
- “Sudbury Sport and Social Club” in 2011 under the trade-mark SUDBURY SPORT & SOCIAL CLUB & Design (application No. 1,516,169); and
- “Barrie Sport and Social Club” in 2012 under the trade-mark BARRIE SPORT & SOCIAL CLUB & Design (application No. 1,567,748).

[31] In terms of revenue, Mr. Davies explains that the Opponent generates income through registration fees for individual customers and teams participating in its sport and social events, as well as through sponsorship agreements, business consulting and licensing relationships. In particular, the affiant states that since 1996, over 130,000 individual customers have purchased and participated in its sport and social club services, totalling over 30 million dollars in revenues,

with substantial growth each year. I note that no breakdown of the revenues per trade-mark, per trade-name, or per year, has been provided.

[32] In terms of promotion, Mr. Davies states that the Opponent has spent a significant amount of money in advertising its “trade-marks and/or trade names” in association with its services since 1996. In this regard, the affiant indicates that the Opponent’s advertising expenditures for its sport and social club services from 2003 to 2012 varied between \$130,000 and \$250,000 each year. I note that no breakdown of the advertising expenditures per trade-mark or per trade-name has been provided.

[33] Mr. Davies further explains that the Opponent’s trade-marks and trade-names have been advertised through printed publications, the internet, media appearances, flyers, pamphlets and newsletters. I note that the mark TORONTO CENTRAL SPORT AND SOCIAL CLUB can be seen in the following exhibits:

- Exhibit 2 – 13 sample print ads bearing the TORONTO CENTRAL Design Mark and the word mark TORONTO CENTRAL SPORT & SOCIAL CLUB extracted from NOW Magazine and EYE Weekly dated between 1996 and 2005, said to be distributed in Toronto. No circulation number of the printed publications has been provided. I note that the ads mention sport leagues and social events for adults;
- Exhibit 3 – 6 sample flyers and registration sheets for various sport and social activities bearing the TORONTO CENTRAL Design Mark and the word mark TORONTO CENTRAL SPORT & SOCIAL CLUB dated between 1997 and 2007, said to be distributed in Toronto. According to Mr. Davies, the Opponent typically prints and distributes 2,000 copies of flyers and registration sheets for all of its sport and social clubs each year. However, no breakdown of the distribution numbers per trade-mark or per club has been provided;
- Exhibit 4 – sample printed newsletters promoting various sport and social activities bearing the TORONTO CENTRAL Design Mark and the word mark TORONTO CENTRAL SPORT & SOCIAL CLUB dated between 1996 and 2002, said to be distributed to its members. No circulation number of the printed newsletters per trade-mark or per club has been provided;



- Exhibit 24 – sample printouts of the Opponent’s website *www.tcssc.com* as it appeared from 2001 to 2009, obtained via the Wayback Machine. I note that the TORONTO CENTRAL Design Mark can be seen prominently at the top of each page. No information regarding the number of Canadians who have accessed the website has been provided; and
- Exhibit 32 – 26 pages of the Opponent’s Facebook social networking website, dated November 19, 2012, bearing the mark TORONTO CENTRAL SPORT AND SOCIAL CLUB. According to Mr. Davies, the Opponent launched the website in September 2009 to promote its sport and social club services. I note that the printouts contain entries and photos of various sport and social activities dated October and November 2012. No information regarding the number of Canadians who have accessed the website has been provided.

[34] Despite its deficiencies, based on a fair reading of Mr. Davies’ affidavit, I am satisfied that the Opponent’s trade-mark TORONTO CENTRAL SPORT AND SOCIAL CLUB has acquired some measure of distinctiveness in association with sport and social club services as evidenced by the many exhibits demonstrating sample use and promotion of the mark since 1996. However, given that the bulk of Mr. Davies’ statements and figures deal with all of the Opponent’s “trade-marks and/or trade names” as a group rather than individually, and taking into account the lack of information on the number of Canadians who would have seen most of the Opponent’s advertising materials, I am unable to determine the extent to which the trade-mark TORONTO CENTRAL SPORT AND SOCIAL CLUB has acquired distinctiveness.

Acquired Distinctiveness – FOREST CITY SPORT & SOCIAL CLUB

[35] In her affidavit, Ms. Lael Morgan states that the Applicant operates the following sport and social clubs: “Ottawa Social & Sport Club” launched in 2003, “Kingston Sport & Social Club” launched in 2005, “Halifax Sport & Social Club” launched in 2008, “Victoria Sport & Social Club” launched in 2010, and “Quinte Sport & Social Club” launched in 2013. In addition, the Applicant has licensed “Forest City Sport & Social Club” (FCSSC), launched in 2009, and “Rose City Sport & Social Club”, launched in 2013, “to use one or more of [the Applicant’s] trade-marks”.

[36] According to Ms. Morgan, all the social clubs, including FCSSC, organize, administer, manage and operate “sports leagues, outdoor pursuits and social events for individuals over nineteen years of age”. Examples of activities organized by the Applicant include basketball, dodgeball, floor hockey, beach volleyball, flag football, golf, and inner tube water polo [Exhibit A of the Morgan affidavit].

[37] In terms of use of the Mark, Ms. Morgan explains that the Applicant has licensed FCSSC to use the Mark and the design mark FCSSC FOREST CITY SPORT & SOCIAL CLUB & Design, reproduced below. The affiant further states that in accordance with the licence, the Applicant has direct or indirect control of the character or quality of the services offered and conducted by FCSSC in association with the trade-marks.



[38] In terms of the number of participants at the FCSSC, Ms. Morgan states that there are approximately 1,370 individuals who have participated in a sports league operated by the club in the Spring/Summer 2012 season, 1,360 individuals in the Fall 2012 season, and 1,430 individuals in the Winter 2013 season. The affiant also sets out the number of participants at the other sport and social clubs operated by the Applicant over the three seasons.

[39] Included as Exhibit A to the Morgan affidavit is a printout of the homepage of the FCSSC website with references to the Spring/Summer 2013 season. I note that the Mark appears prominently at the top of the homepage, as part of the design mark FCSSC FOREST CITY SPORT & SOCIAL CLUB & Design. Attached as Exhibit B is a printout of the FCSSC website as it appeared on July 17, 2009, obtained via the Wayback Machine. I note that the Mark is shown prominently at the top of a webpage with references to indoor and outdoor sport activities offered. No information regarding the number of Canadians who have accessed the website has been provided.

[40] The Morgan affidavit also includes similar printouts of the homepages of other sport and social clubs operated or licensed by the Applicant. However, the affidavit does not contain any

other information regarding the manner in which nor the extent to which the Mark has been used or promoted by the Applicant or its licensees in association with the applied for services since 2009. Moreover, there is no information regarding revenues generated by the applied for services, if any, nor any advertising expenditures, associated with the Mark, since 2009. When the Morgan affidavit is considered in its entirety, I am unable to determine if the Mark has acquired any distinctiveness in association with the applied for services.

[41] Accordingly, the section 6(5)(a) factor favours the Opponent, to the extent that it involves the acquired distinctiveness of the parties' marks.

*Section 6(5)(b) – the length of time the trade-marks have been in use*

[42] The overall consideration of the section 6(5)(b) factor clearly favours the Opponent. As per my review of the Davies affidavit, the Opponent has shown use of the mark TORONTO CENTRAL SPORT AND SOCIAL CLUB in association with sport and social club services since 1996. In comparison, even I were to set aside the deficiencies of the Morgan affidavit, the earliest evidence of use of the Mark provided by the Applicant is dated July 2009, well after that of the Opponent's.

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

[43] Sections 6(5)(c) and (d) factors, which involve the nature of the services, trade and business, also favour the Opponent.

[44] When considering sections 6(5)(c) and (d) of the Act, it is the statements of services as defined in the application for the Mark and in the Opponent's registration No. TMA591,422 that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[45] There is clear overlap between the parties' services as both operate establishments that offer sport and social activities. In addition, neither the Opponent's registration nor the subject application contains any restriction on the parties' channels of trade. There is clear potential for

overlap considering that both parties are in the business of organizing sport activities and social events for adults in various regions across Canada.

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

[46] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality. It is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trade-marks. Nevertheless, the first component of a mark is often considered more important for the purpose of distinction [*Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD) and *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (F.C.A.)]. Also, when a word is a common, descriptive word, it is entitled to a narrower range of protection than an invented or unique word [*Laurentide Chemicals Inc v Les Marchands Deco Inc* (1985), 7 CPR (3d) 357 (FCTD) at 365].

[47] There are both similarities and differences between the parties' marks. In this regard, both marks are descriptive of the geographical location and of the nature of the services offered. However, the first portion of the Opponent's mark is the expression "TORONTO CENTRAL" whereas the first portion of the Mark is "FOREST CITY". While there are similarities between the latter portions of the parties' marks, I do not consider the expression "sport and social club" or "sport & social club" to be striking or unique in any shape or form as these are words common to the trade and merely describe the types of services offered by the entity.

[48] The ideas suggested by the parties' marks are also somewhat different. While both marks identify the services provided as that of a sport and social club, the Opponent's mark identifies a central area of Toronto by the expression "TORONTO CENTRAL" whereas the Mark refers to the city of London, Ontario, not by its official name, but by its nickname "FOREST CITY". According to *The Canadian Oxford Dictionary*, the term "Forest City" is defined as "an informal name for London, Ontario". The expression "FOREST CITY" thus arguably conveys a somewhat affectionate or familiar message.

[49] In the end, in view of the descriptive nature of the marks, although there are some similarities between them, I do not consider there to be a high degree of resemblance when the marks are assessed in their entirety. There are sufficient differences visually, phonetically and in ideas suggested in the first portions of the marks, which is arguably the relatively more dominant portion of the Opponent's mark, to outweigh any similarities in the latter portions of the marks, which merely describe the services offered by the parties.

[50] Accordingly, the section 6(5)(e) factor strongly favours the Applicant.

*Additional surrounding circumstances – Family of marks*

[51] In its statement of opposition, the Opponent alleges that the Mark is confusing with its “registered SPORT AND SOCIAL CLUB Family of Trade-marks”, namely HAMILTON SPORT & SOCIAL CLUB & Design (TMA829,696), DURHAM SPORT & SOCIAL CLUB & Design (TMA762,546), TORONTO CENTRAL SPORT AND SOCIAL CLUB (TMA591,422), TORONTO SPORT & SOCIAL CLUB & Design (TMA761,815), TORONTO CENTRAL SPORT & SOCIAL CLUB & Design (TMA591,330), and YORK SPORT & SOCIAL CLUB & Design (TMA761,814). As noted above, the Opponent did not make any submissions in the present proceeding.

[52] In order to rely on a family of marks, the party must evidence use of those marks in the marketplace [see *McDonald's Corp v Yogi Yogurt* (1982), 66 CPR (3d) 101 (FCTD)]. In addition to providing sample use of the trade-marks TORONTO CENTRAL SPORT AND SOCIAL CLUB (TMA591,422) and TORONTO CENTRAL SPORT & SOCIAL CLUB & Design (TMA591,330) discussed above, the Davies affidavit also includes some documentary evidence of use of the trade-mark TORONTO SPORT & SOCIAL CLUB & Design (TMA761,815).

[53] In this regard, attached as Exhibits 1 and 25 of the Davies affidavit are printouts from the Toronto Sport and Social Club website located at [www.torontoscc.com](http://www.torontoscc.com) bearing the trade-mark TORONTO SPORT & SOCIAL CLUB & Design, as it appeared from 2010 to 2012. According to the affiant, the said website has received over 800,000 visits from over 195,000 unique Internet visitors, resulting in over 3,900,000 views of individual pages of the website. A copy of the Google Analytics Report with details of visits to the said website from January to

November 2012 is attached as Exhibit 26 of the Davies affidavit. When this evidence is viewed in conjunction with Mr. Davies' testimony on the Opponent's overall revenue figures and advertising expenditures for all of its trade-marks "and/or" trade-names, I am satisfied that the trade-mark TORONTO SPORT & SOCIAL CLUB & Design has been used in association with sport and social club services since 2010.

[54] However, the Opponent provides little evidence of use of the remaining trade-marks, HAMILTON SPORT & SOCIAL CLUB & Design (TMA829,696), DURHAM SPORT & SOCIAL CLUB & Design (TMA762,546), and YORK SPORT & SOCIAL CLUB & Design (TMA761,814). Specifically, Mr. Davies merely provides a single "representative" printout as evidence of use for each of the three marks in question as they appear on their respective websites on November 19, 2012 [Exhibits 26, 27 and 29]. With no information regarding the number of Canadians who would have visited these websites, no indication as to whether the printouts are "representative" of the manner in which the trade-marks have been used for a given period of time or simply of other webpages, and no other information on the extent to which these trade-marks were used by the Opponent, I am not prepared to place much weight on these exhibits.

[55] I also note that the Davies affidavit includes numerous exhibits showing use of a design similar to that the Opponent's registered design marks, reproduced below. However, the design does not contain any reference to a geographic location. Although the name of a geographic location is considered to be descriptive matter, I am of the view that it is nevertheless a dominant and essential element of each of the Opponent's registered trade-marks such that their identities have been lost in these exhibits. In fact, I am unable to determine which of the registered marks the Opponent is alleging use. Without reference to the geographic location, the registered mark, whichever it might be, is no longer recognizable given that a dominant feature of the registered mark has been omitted. [See *Mendelsohn Rosentzveig Shacter v Parmalat Dairy & Bakery Inc* (2004) 40 CPR (4th) 443 (TMOB).]



[56] As pointed out by Cattnach, J. in the *Mcdonald's* case, there can be no presumption of the existence of a family or series of trade-marks in opposition proceedings; the party seeking to establish a family of marks must show that it has used the trade-marks comprising the series to a sufficient extent as to constitute a family of marks. In this case, the Opponent has not broken down any of its sales and advertising figures per trade-mark “and/or” trade-name and it has provided little to no evidence of use of half of its marks, thus it is difficult to assess the extent to which a “family” of marks would be recognized by the consumer.

[57] In the end, bearing in mind that most of the exhibits only show use of the registered trade-marks TORONTO CENTRAL SPORT AND SOCIAL CLUB (TMA591,422), TORONTO CENTRAL SPORT & SOCIAL CLUB & Design (TMA591,330), and to a much smaller extent, TORONTO SPORT & SOCIAL CLUB & Design (TMA761,815). I am not satisfied that the Opponent has established a family of SPORT AND SOCIAL CLUB trade-marks.

*Additional surrounding circumstances – Instances of actual confusion*

[58] Lastly, as one further surrounding circumstance in the confusion analysis, Mr. Davies states that even though the Opponent “does not keep records detailing instances where its customers have thought that the Applicant’s businesses were associated or affiliated with the Opponent”, he has personally been asked by “a number of members” whether the Applicant’s establishments in Ottawa and Kingston belong to the Opponent. Moreover, the affiant states that he has been informed by staff that they have received similar inquiries from members “over the years”. Mr. Davies further states that he estimates that the Opponent received on average one to two such inquiries per month over the past 10 years.

[59] The Applicant submits that Mr. Davies’ statements on this point are based on nothing but his recollection and that of his staff, which is hearsay evidence. I agree. I cannot afford any weight to Mr. Davies’ testimony in this regard. The affiant’s statements are self-serving and they lack specificities. Since no details have been provided with respect to the nature and the context of these inquiries, I cannot determine whether they would constitute instances of actual confusion or not.

*Conclusion in the likelihood of confusion*

[60] In *Masterpiece*, the Supreme Court of Canada discussed the importance of section 6(5)(e) in conducting an analysis of the likelihood of confusion. Specifically, the Court noted that the degree of resemblance is the statutory factor that is often likely to have the greatest effect on the confusion analysis; the other factors become significant only once the marks are found to be identical or very similar.

[61] In *Man and His Home Ltd v Mansoor Electronic Ltd* (1999), 87 CPR (3d) 218 (FCTD), the Court stated the following regarding marks that have little inherent distinctiveness:

It is well established that trade-marks containing words which are suggestive of the wares or services offered by the owner are considered to be weak marks and consequently, are afforded a minimal level of protection. In such cases, even a small difference between the marks will be sufficient to diminish the likelihood of confusion. Furthermore, where a person adopts a word in common use and seeks to prevent competitors from doing the same, the trade-marks will have less inherent distinctiveness and the range of protection granted by the Court will be limited. Finally, where a party chooses to use a suggestive non-distinctive name, regardless of any acquired distinctiveness, it must accept a certain amount of confusion without sanction.

[62] 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, despite some acquired distinctiveness of the Opponent's mark TORONTO CENTRAL SPORT AND SOCIAL CLUB, the length of time for which it has been in use, the clear overlap in the nature of the parties' services as well as the potential for overlap for their channels of trade, I am of the view that low inherent distinctiveness of the Opponent's mark and the differences in the marks are significant enough to shift to balance of probabilities in favour of the Applicant.

[63] It is difficult to monopolize weak words such as the name of a geographical location and the description of the services "sport and social club". Moreover, there is nothing striking or unique in the particular combination of the two components. In my view, this is the sort of mark that has such low inherent distinctiveness that it cannot be given a broad scope of protection considering that the Opponent elected to take words common to the trade, with clear and apparent meaning to the average consumer, as its trade-mark. While the Opponent might have shown some acquired distinctiveness in TORONTO CENTRAL SPORT AND SOCIAL CLUB,



the ambit of protection for the Opponent's mark does not extend to the name of any geographical location used in association with sport and social club services, nor does it extend to the term "sport and social club" alone. Since the Opponent has not established a family of SPORT AND SOCIAL CLUB trade-marks, this is a case where small differences are sufficient to distinguish a similar mark [see *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD), *Anamet Inc v Acklands Ltd* (1996), 67 CPR (3d) 478 (FCTD) and *Commercial Union Assurance Co plc v Canadian Co-Operative Credit Society Ltd* (1992), 42 CPR (3d) 239 (FC)].

[64] I therefore find that the marks are sufficiently different to make confusion unlikely. Consequently, the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's mark TORONTO CENTRAL SPORT AND SOCIAL CLUB. Furthermore, as I previously indicated, I find that comparing the Mark with this registered trade-mark effectively decides the outcome of this ground of opposition.

[65] Accordingly, the ground of opposition based on section 12(1)(d) of the Act is dismissed.

Was the Applicant the person entitled to registration of the Mark?

[66] In its statement of opposition, the Opponent alleges that the Applicant is not the person entitled to registration of the Mark:

- 1) pursuant to section 16(1)(a) of the Act, on the ground that it is confusing with the Opponent's registered trade-marks, set out in Schedule "A" to this decision, which have been used or made known in Canada;
- 2) pursuant to section 16(1)(b) of the Act, on the ground that it is confusing with the Opponent's trade-mark HAMILTON SPORT & SOCIAL CLUB & Design (application No. 1,443,526), for which an application had been previously filed; and
- 3) pursuant to section 16(1)(c) of the Act, on the ground that it is confusing with the Opponent's trade-names, "Toronto Central Sport & Social Club", "Hamilton Sport and Social Club", "York Sport and Social Club", and "Durham Sport and Social Club", which have all been used by the Opponent in Canada.

[67] As a preliminary matter, I wish to address the Applicant's submission that since the Opponent has only alleged confusion as of the filing date of the application in its statement of opposition for the entitlement grounds, the Registrar is restricted to considering possible confusion as of the filing date rather than the date of first use of the Mark. The Applicant cites *Massif Inc v Station Touristique Massif du Sud (1993) Inc* (2011), 95 CPR (4th) 249 (FC) in support of its argument.

[68] While I agree with the Applicant that in the *Massif* decision, the Federal Court has directed that an opposition is to be assessed on the basis of the grounds of opposition raised by the opponent, the material date that applies to a particular ground of opposition that has been properly identified in a statement of opposition is not an element that is dependant on the Opponent's pleading. Rather, the applicable material date is a question of law that is to be determined by the Registrar, not by the statement of opposition.

[69] Given the clear direction set out in section 16 of the Act and the fact that nothing in the Opponent's statement of opposition suggests that the Mark was not confusing with the Opponent's trade-marks or trade-names at the applicable material date, I will be assessing confusion as of the alleged date of first use of the Mark, namely, June 2009 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004) 34 CPR (4th) 317 (FC)].

[70] For the reasons that follow, I reject the non-entitlement grounds of opposition and decide each of these issues in favour of the Applicant.

The section 16(1)(a) ground

[71] With respect to the section 16(1)(a) ground, the Opponent has the initial burden of proving that one or more of the alleged trade-marks was used or made known in Canada prior to the material date and had not been abandoned at the date of advertisement of the application for the Mark [section 16(5) of the Act].

[72] Once again, I find that comparing the Mark with the trade-mark TORONTO CENTRAL SPORT AND SOCIAL CLUB (No. TMA591,422) will effectively decide this ground of opposition. In other words, if confusion is not likely between the Mark and TORONTO

CENTRAL SPORT AND SOCIAL CLUB, then it would not be likely between the Mark and any of the registered trade-marks alleged by the Opponent (Nos. TMA829,696, TMA762,546, TMA761,815, TMA591,330 and TMA761,814).

[73] As per my review of the Davies affidavit under the section 12(1)(d) analysis, I am satisfied that the trade-mark TORONTO CENTRAL SPORT AND SOCIAL CLUB has been used in association with sport and social club services in Canada prior to June 2009, and that it had not been abandoned as of April 13, 2011. Furthermore, assessing each of the section 6(5) factors as of June 2009 rather than as of today's date does not significantly impact my previous analysis of the surrounding circumstances of this case.

[74] As in the case of the non-registrability ground, I conclude that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between its Mark and the Opponent's mark TORONTO CENTRAL SPORT AND SOCIAL CLUB as of June 2009. Accordingly, the section 16(1)(a) ground of opposition is dismissed.

The section 16(1)(b) ground

[75] With respect to the section 16(1)(b) ground of opposition, the Opponent has the initial burden of establishing that its application for the trade-mark HAMILTON SPORT & SOCIAL CLUB & Design was filed prior to the filing date of the Applicant's application (July 17, 2009), and that it was not abandoned at the date of advertisement of the application for the Mark (April 13, 2011) [section 16(4) of the Act].

[76] The Registrar has the discretion to check the register in order to confirm the existence of registrations and applications relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I have exercised that discretion and confirm that the Opponent's application No. 1,443,526 was filed prior to the filing date of the Applicant's application, namely July 2, 2009, and was pending as of its date of advertisement.

[77] As the Opponent has satisfied its initial burden, the Applicant must therefore establish, on a balance of probabilities, that as of the date of first use of the Applicant's application, namely, June 2009, there was not a reasonable likelihood of confusion between its Mark and the Opponent's trade-mark HAMILTON SPORT & SOCIAL CLUB & Design.

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

[78] I assess the inherent distinctiveness of the Opponent's mark to be slightly higher than that of the Mark in view of the addition of the design element. However, both marks are inherently weak as they are descriptive of organizations that offer sport and social activities in a particular area of Canada.

[79] With respect to acquired distinctiveness, both parties provide some evidence of promotion and/or use of their trade-marks. I shall begin with a review of the Opponent's evidence.

Acquired Distinctiveness – HAMILTON SPORT & SOCIAL CLUB & Design

[80] As per my review of the Davies affidavit under the section 12(1)(d) analysis, the Opponent has provided very little evidence of use of the trade-mark HAMILTON SPORT & SOCIAL CLUB & Design. In this regard, Mr. Davies states that the Opponent began operating Hamilton Sport and Social Club in 2009, the same year as the material date, and that it has offered its sport and social club services under the trade-mark HAMILTON SPORT & SOCIAL CLUB & Design since that time. The affiant attaches as Exhibit 29 a single "representative" printout of the club's webpage located at *www.hamiltonssc.com* as it appeared on November 19, 2012, well after the material date.

[81] With no information regarding the number of Canadians who would have visited the website, no indication as to whether the printout is "representative" of the manner in which the trade-mark has been used prior to the material date, and no other information on the manner and the extent to which the trade-mark was used by the Opponent, I am not prepared to place much weight on this exhibit.

[82] Moreover, as discussed above, given that the large majority of Mr. Davies' statements and figures deal with all of the Opponent's trade-marks "an/or" trade-names as a group rather than individually, and taking into account the lack of documentary evidence regarding the manner in which the trade-mark was used and the fact that the club was only launched in 2009, I am not satisfied that the trade-mark HAMILTON SPORT & SOCIAL CLUB & Design has any acquired distinctiveness in association with the applied for wares and services as of June 2009.

Acquired Distinctiveness – FOREST CITY SPORT & SOCIAL CLUB

[83] I refer to my previous analysis on the inherent distinctiveness of the Applicant's Mark under the non-registrability ground of opposition. In the end, given the lack of evidence of promotion or use of the Mark prior to the material date, I am not satisfied that the Mark has acquired any distinctiveness in association with the applied for services as of June 2009.

[84] Accordingly, the section 6(5)(a) factor only marginally favours the Opponent to the extent that it involves the inherent distinctiveness of its mark.

*Section 6(5)(b) – the length of time the trade-marks have been in use*

[85] Application No. 1,443,526 for the trade-mark HAMILTON SPORT & SOCIAL CLUB & Design, which has since proceeded to registration under No. TMA829,696, claims use of the mark in Canada in association with the services since at least as early as March 2009. The mere existence of the registration establishes no more than minimal use and cannot give rise to an inference of significant and continuous use of the trade-marks in association with the registered wares [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)]. Further, as per my review of the Davies affidavit, I am not satisfied that the Opponent has shown use of the trade-mark HAMILTON SPORT & SOCIAL CLUB & Design prior to June 2009.

[86] In comparison, the application for the Mark is based on use in Canada since at least as early as June 2009. However, as per my review of the Morgan affidavit, even I were to set aside its deficiencies, the earliest evidence of use of the Mark provided by the Applicant is July 2009, after the material date.

[87] Accordingly, the overall consideration of the section 6(5)(b) factor does not significantly favour either party.

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

[88] Sections 6(5)(c) and (d) factors, which involve the nature of the wares, services, trade and business, favour the Opponent.

[89] There is clear overlap between the parties' services as both operate establishments that offer sport and social activities. Moreover, the Opponent's wares, which include a variety of sport apparel and accessories, sport equipment, and sport protective gear, are closely related to the Applicant's services as they are both in the field of sports.

[90] Similarly, neither the Opponent's application nor the subject application contains any restriction on the parties' channels of trade. There is clearly a potential for overlap considering that both parties are in the business of organizing sport activities and social events for adults in various regions across Canada. Moreover, nothing prevents the Opponent's wares from being sold in these establishments.

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

[91] For the reasons that follow, this factor strongly favours the Applicant.

[92] There are both similarities and differences between the parties' marks. In this regard, both marks are descriptive of the geographical location and of the nature of the services offered. However, the first word portion of the Opponent's mark is "HAMILTON" whereas the first portion of the Mark is "FOREST CITY". As per my analysis under section 12(1)(d), despite similarities between the latter word portions of the parties' marks, I do not consider the expression "sport & social club" to be striking or unique in any shape or form. When the Opponent's mark is viewed in its entirety, I consider the crest design to be its striking portion.

[93] The ideas suggested by the parties' marks are also somewhat different. While both marks identify the services provided as that of a sport and social club, the Opponent's mark identifies

the city of Hamilton whereas the Mark refers to the city of London, Ontario, not by its official name, but by its nickname “FOREST CITY”, arguably conveying a somewhat affectionate or familiar message.

[94] In the end, in view of the descriptive nature of the marks, although there are some similarities between them, I do not consider there to be a high degree of resemblance when the marks are assessed in their entirety. There are sufficient differences visually, phonetically and in ideas suggested in the marks in their totality to outweigh any similarities in the latter word portions of the marks.

*Additional surrounding circumstances – Family of marks*

[95] Since the Opponent did not make any submissions in the present proceeding, it is unclear whether it is alleging the use of a family of SPORT AND SOCIAL CLUB marks as an additional surrounding circumstance in support of its entitlement ground of opposition. In any event, as per my previous discussion under the non-registrability ground of opposition, bearing in mind the earlier material date of the section 16(1)(b) ground of opposition and the lack of evidence of use, sales and advertising figures by trade-mark, trade-name, and by year, I am not satisfied that the Opponent has established a family of SPORT AND SOCIAL CLUB trade-marks as of the material date.

*Additional surrounding circumstances – Instances of actual confusion*

[96] As per my review of the Davies affidavit under the section 12(1)(d) analysis, I cannot afford any weight to Mr. Davies’ testimony in this regard.

*Conclusion in the likelihood of confusion*

[97] 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, despite clear overlap in the nature of the parties’ services and close connection between the parties’ wares and services, as well as the potential for overlap in their channels of trade, I am of the view that the low inherent distinctiveness and the lack of acquired distinctiveness of the Opponent’s mark,

combined with the overall differences in the marks, are significant enough to shift to balance of probabilities in favour of the Applicant.

[98] As in the case of TORONTO CENTRAL SPORT AND SOCIAL CLUB, it is difficult to monopolize weak words such as the name of a geographical location and the description of the services “sport & social club”. Similarly, there is nothing striking or unique in the particular combination of the word components. The ambit of protection for the Opponent’s mark does not extend to the name of any geographical location used in association with sport and social club services, nor does it extent to the term “sport & social club” alone. This is also a case where small differences are sufficient to distinguish a similar mark [see *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD), *Anamet Inc v Acklands Ltd* (1996), 67 CPR (3d) 478 (FCTD) and *Commercial Union Assurance Co plc v Canadian Co-Operative Credit Society Ltd* (1992), 42 CPR (3d) 239 (FC)].

[99] I therefore find that the marks are sufficiently different to make confusion unlikely. Consequently, the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent’s mark HAMILTON SOCIAL & SOCIAL CLUB & Design.

[100] Accordingly, the ground of opposition based on section 16(1)(b) of the Act is dismissed.

The section 16(1)(c) ground

[101] With respect to the section 16(1)(c) ground, the Opponent has the initial burden of proving that one or more of the alleged trade-names, Toronto Central Sport & Social Club, Hamilton Sport and Social Club, York Sport and Social Club, and Durham Sport and Social Club, was used in Canada prior to the filing date of the Applicant’s application (July 17, 2009) and had not been abandoned at the date of advertisement of the application for the Mark (April 13, 2011) [section 16(5) of the Act].

[102] While Mr. Davies attests to the use of the trade-name Hamilton Sport and Social Club since 2009, the trade-name York Sport and Social Club since 2001, and the trade-name Durham Sport and Social Club since 2006, the only documentary evidence of use of the trade-names are



the single-page printouts of their respective websites on November 19, 2012 [see Exhibits 26, 27 and 29]. Moreover, the affiant did not provide a breakdown of the sales and advertising figures associated with each of the trade-names, some of which were launched after the material date. With no information regarding the number of Canadians who would have visited these websites, no indication as to whether the printouts are representative of the manner in which the trade-names had been used prior to July 17, 2009, and no other information on the use of these trade-names by the Opponent, the non-entitlement ground of opposition raised under section 16(3)(c) of the Act is dismissed, to the extent that the ground is based on the trade-names Hamilton Sport and Social Club, York Sport and Social Club, and Durham Sport and Social Club, for the Opponent's failure to meet its initial evidential burden.

[103] In terms of the use of the trade-name Toronto Central Sport & Social Club, Mr. Davies states that the Opponent has been operating in Toronto under this trade-name since 1996 and provides representative newsletters and advertising materials with the trade-name dated between 1996 and 2012 [Exhibits 2, 3, 4, 24 and 32]. When viewed in conjunction with the affiant's statements regarding revenues and memberships discussed above, I am satisfied that the Opponent has shown use of the trade-name Toronto Central Sport & Social Club prior to the filing date of the Applicant's application and had not been abandoned at the date of advertisement of the application for the Mark.

[104] As the Opponent has satisfied its initial burden, the Applicant must therefore establish, on a balance of probabilities, that as of the date of first use of the Applicant's application, namely, June 2009, there was not a reasonable likelihood of confusion between its Mark and the Opponent's trade-name Toronto Central Sport & Social Club.

[105] Since the Opponent's trade-name Toronto Central Sport & Social Club is nearly identical to its trade-mark TORONTO CENTRAL SPORT AND SOCIAL CLUB of registration No. TMA591,422, I refer to my previous analysis under the section 16(1)(a) ground of opposition.

[106] As my findings made above concerning the likelihood of confusion between the Mark and the Opponent's trade-mark TORONTO CENTRAL SPORT AND SOCIAL CLUB remain

applicable to the Opponent's trade-names, I conclude that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between its Mark and the Opponent's trade-name Toronto Central Sport & Social Club as of June 2009.

[107] Accordingly, the section 16(1)(c) ground of opposition is dismissed.

Was the Mark distinctive of the Applicant's services at the filing date of the statement of opposition?

[108] The Opponent has pleaded that the Mark does not and cannot act to distinguish the Applicant's services from those of the wares and services of the Opponent, nor are they adapted so to distinguish them, in view of the provisions of section 2 of the Act.

[109] The material date to assess the ground of opposition is the filing date of the statement of opposition, namely June 6, 2011 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)]. For the reasons that follow, I dismiss the ground of opposition and decide this issue in favour of the Applicant.

[110] As discussed above, while Mr. Davies alleges use of no less than eight distinct trade-marks, and their respective trade-names, in association with the Opponent's sport and social club services since 1996, most of the exhibits attached to the Davies affidavit only show use of the trade-marks TORONTO CENTRAL SPORT AND SOCIAL CLUB (TMA591,422), TORONTO CENTRAL SPORT & SOCIAL CLUB & Design (TMA591,330), and to a much smaller extent, TORONTO SPORT & SOCIAL CLUB & Design (TMA761,815), as well as the use of the trade-name Toronto Central Sport & Social Club.

[111] Moreover, given that the bulk of Mr. Davies' statements and figures deal with all of the Opponent's "trade-marks and/or trade names" as a group rather than individually, with no breakdown per mark, per trade-name or per year, and taking into account the lack of information on the number of Canadians who would have seen most of the Opponent's advertising materials, I am unable to determine the extent to which any of the Opponent's trade-marks or trade-names had become known in Canada, as of June 6, 2011.

[112] When the Opponent's evidence is viewed in its entirety, it does not lead to any meaningful conclusion regarding the extent of use, advertising, or reputation of any of the trade-marks or trade-names in Canada. Consequently, the Opponent has failed to discharge its initial burden to show that any of its trade-marks or trade-names had become known sufficiently to negate the distinctiveness of the Mark in Canada, as of June 6, 2011.

[113] I would add that even if I was wrong in so finding, the overall outcome of the present case would have been the same since assessing each of the section 6(5) factors as of June 6, 2011 does not significantly impact my previous analysis of the surrounding circumstances of this case. For reasons similar to those expressed previously, I would have concluded that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the Opponent's trade-marks or trade-names in association with its services as of June 6, 2011.

[114] Accordingly, the non-distinctiveness ground of opposition is dismissed.

#### Disposition

[115] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

---

Pik-Ki Fung  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

## Schedule "A"

### Opponent's trade-mark:



Registration No.:  
TMA829,696

#### Wares:

Clothing, namely shirts, tank tops, t-shirts, sweatshirts, sweaters, shorts and socks; athletic clothing, namely shirts, t-shirts, shorts, pants, jackets, warm-up suits and jogging suits; headwear, namely hats, caps and visors; raingear, namely coats and umbrellas; bags, namely all-purpose sports bags, backpacks, duffel bags, shoulder bags, waistpacks, fannypacks, and computer bags; sporting goods, namely flying discs, volleyballs, softballs, dodge balls, golf balls, basketballs, soccer balls, footballs, tennis balls, kick balls, handballs and cricket bats, softball bats and baseball bats, hockey sticks, hockey stick shafts, golf club head covers, sports mitts for baseball and softball, gloves for baseball, softball, golf, hockey, soccer, football and cycling; protective padding for football, soccer and hockey; helmets for hockey; protective hockey uniforms, namely lower body suits with protective layers integral thereto.

#### Services:

Administration, organization and management of co-ed recreational sports leagues and a social club; hosting and facilitating sporting and social events; facilitating and managing sports events, sports leagues and sports tournaments and social events; organizing receptions; organizing and administering sports skills clinics; reservation of sports facilities, facilitating and managing corporate sports and entertainment events.

**Opponent's trade-mark:**



Registration No.:  
TMA762,546

**Wares:**

Clothing, namely shirts, t-shirts, sweatshirts, shorts and socks; athletic clothing, namely shirts, t-shirts, shorts, pants, jackets, headwear, namely hats, caps and visors; bags, namely all-purpose sports bags, backpacks; sporting goods, namely flying discs, volleyballs, softballs, dodge balls, golf balls, basketballs, soccer balls, footballs, tennis balls, kick balls, handballs, and softball bats.

**Services:**

Administration, organization and management of co-ed recreational sports leagues and a social club; hosting and facilitating sporting and social events; facilitating and managing sports events, sports leagues and sports tournaments and social events; organizing receptions; organizing and administering sports skills clinics; reservation of sports facilities, facilitating and managing corporate sports and entertainment events.

**Opponent's trade-mark:**

TORONTO CENTRAL SPORT AND SOCIAL CLUB

Registration No.:  
TMA591,422

**Services:**

Co-ed recreational sports leagues; social club; Marketing and promotion services for others namely, hosting and facilitating sporting and social events, promoting the goods and services of others by way of recruiting business sponsorship; Facilitating and managing sports events, sports leagues and sports tournaments and social events namely basketball, beach volleyball, court volleyball, curling, European team handball, fitness classes, flag football, floor hockey, mixed doubles tennis, soccer, softball, ultimate, dances, parties, receptions, sports skills clinic and travel coordination and management services for such events namely, airline ticket reservations, hotel reservations, transportation reservations, reservation of sports facilities.

**Opponent's trade-mark:**



Registration No.:  
TMA761,815

**Wares:**

Clothing, namely shirts, t-shirts, sweatshirts, shorts and socks; athletic clothing, namely shirts, t-shirts, shorts, pants, jackets; headwear, namely hats, caps and visors; bags, namely all-purpose sports bags, backpacks; sporting goods, namely flying discs, volleyballs, softballs, dodge balls, golf balls, basketballs, soccer balls, footballs, tennis balls, kick balls, handballs and softball bats.

**Services:**

Administration, organization and management of co-ed recreational sports leagues and a social club; hosting and facilitating sporting and social events; facilitating and managing sports events, sports leagues and sports tournaments and social events; organizing receptions; organizing and administering sports skills clinics; reservation of sports facilities, facilitating and managing corporate sports and entertainment events.

**Opponent's trade-mark:**



Registration No.:  
TMA591,330

**Services:**

Co-ed recreational sports leagues, social club; marketing and promotion services for others namely, hosting and facilitating sporting and social events, promoting the goods and services of others by way of recruiting business sponsorship; facilitating and managing sports events, sports leagues and sports tournaments and social events namely basketball, beach volleyball, court volleyball, curling, European team handball, fitness classes, flag football, floor hockey, mixed doubles tennis, soccer, softball, ultimate, dances, parties, receptions, sports skills clinic and travel coordination and management services for such events namely, airline ticket reservations, hotel reservations, transportation reservations, reservation of sports facilities;

**Opponent's trade-mark:**



Registration No.:  
TMA761,814

**Wares:**

Clothing, namely shirts, t-shirts, sweatshirts, shorts and socks; athletic clothing, namely shirts, t-shirts, shorts, pants, jackets; headwear, namely hats, caps and visors; bags, namely all-purpose sports bags, backpacks; sporting goods, namely flying discs, volleyballs, softballs, dodge balls, golf balls, basketballs, soccer balls, footballs, tennis balls, kick balls, handballs and softball bats.

**Services:**

Administration, organization and management of co-ed recreational sports leagues and a social club; hosting and facilitating sporting and social events; facilitating and managing sports events, sports leagues and sports tournaments and social events; organizing receptions; organizing and administering sports skills clinics; reservation of sports facilities, facilitating and managing corporate sports and entertainment events.