



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

Citation: 2012 TMOB 43
Date of Decision: 2012-03-06

**IN THE MATTER OF AN OPPOSITION
by International Clothiers Inc. to
application No. 1,328,691 for the trade-
mark motogp & Design in the name of
DORNA SPORTS, S.L.**

[1] On December 18, 2006, DORNA SPORTS, S.L. (the Applicant) filed an application to register the trade-mark motogp & Design (the Mark), shown below:



[2] The application for the mark covers the following wares (the Wares), as amended, based on use proposed use in Canada:

Protective helmets for cyclists and motorcyclists, sunglasses and cases for glasses, frames for glasses; electronic and microprocessor programmers for games; protective reinforcements for shoulders and elbows, knees and other parts of the body for accident prevention; chronometric instruments namely, clocks and watches, watch and key fobs of precious metal, stop watches, sundials; printed matter namely, brochures, newsletters, pamphlets, leaflets; bookbinding material namely, bookbindings, bookbinding wire, bookbinding tape, bookbinding machines, covers, hangers, spines, laminating machines; photographs; stationery namely, books, magazines, newspapers, timetables, postcards, calendars, almanacs, maps, pamphlets, diaries, sheet music, rubber stamps and stamp pads, playing cards; personal writing stationery comprising envelopes, writing paper,

pens; drawing paper and pads, pens, pencils, markers, crayons; t-shirts, sweatshirts, polo shirts, caps, gloves, pants and balaclavas for motorcyclists, jackets, trousers and overalls of leather and imitation leather; games and playthings, namely action-type target, arcade, board, card, computer action, computer simulation, paddle ball, word games, puzzles, ring, role-playing, table tennis, target video; computer games (which are not adapted for use with television receivers only); board games, toy vehicles; remote-control toy vehicles; toy steering wheels and handlebars; replicas and models of scale vehicles.

[3] Colour is claimed as a feature of the Mark. Specifically, the Applicant claims the colours 'red' and 'black' as essential features of the Mark. The word 'motogp' appears in 'red' and the design elements appear in 'black'.

[4] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 27, 2008.

[5] On January 27, 2009, International Clothiers Inc. (the Opponent) filed a statement of opposition.

[6] The grounds of opposition can be summarized as follows:

- Non-compliance with s. 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) on the basis that the Applicant could not have been satisfied of its entitlement to use the Mark in Canada in association with the Wares because the Applicant was aware of the Opponent's registered trade-marks MOTO SPORT (TMA502,767) and MOTO GEAR (TMA731,143) (the Opponent's Registered Marks) as well as the Opponent's unregistered trade-marks MOTO, MOTO JEANS, MOTO TECHGEAR which were confusing with the Mark.
- The Mark is not registrable as it is confusing with the Opponent's Registered Marks contrary to s. 12(1)(d) of the Act.
- Pursuant to s. 16(3)(a) and (b) of the Act, the Applicant is not entitled to registration of the Mark on the basis that as at the date of filing the application for the Mark, the Mark was confusing with the Opponent's trade-marks MOTO, MOTO JEANS, MOTO SPORT and MOTO TECHGEAR, all of which had been used in Canada in association with clothing since prior to the date of filing the application for the Mark and none of which had been abandoned.
- Pursuant to s. 38(2)(d) and 2, the Mark is not and cannot be distinctive of the Applicant, as the Mark is confusing with the Opponent's marks MOTO, MOTO JEANS, MOTO SPORT, MOTO GEAR and MOTO TECHGEAR. The Mark does not distinguish and is not adapted to distinguish, nor is it capable of distinguishing, the Wares from those of the Opponent

[7] The Applicant served and filed a counter statement in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[8] The Opponent filed the affidavit of Paul Brener, the Opponent's Vice President, Finance and Administration, sworn November 6, 2009 with Exhibits A – F as its evidence pursuant to r. 41 of the *Trade-marks Regulations* SOR/96-195 (the Regulations).

[9] The Applicant filed the affidavit of Shannon Young, a trade-mark agent for the Applicant's agent, sworn March 9, 2010 with Exhibits A – P as its evidence pursuant to r. 42 of the Regulations.

[10] No cross-examinations were conducted.

[11] Both parties filed written arguments and were represented at an oral hearing.

Onus and Material Dates

[12] 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 Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

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

- s. 38(2)(a)/30(i) - the date of filing the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 at 475 (T.M.O.B.) and *Tower Conference Management Co. v. Canadian Exhibition Management Inc.* (1990), 28 C.P.R. (3d) 428 at 432 (T.M.O.B.)].
- s. 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].
- s. 38(2)(c)/16(3)(a) and (b) - the date of filing the application [see s. 16(3) of the Act].
- s. 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Summary Dismissal of Grounds of Opposition

[14] In its written argument the Opponent withdrew the grounds of opposition based on s. 38(2)(a) and 30(i) and s. 38(2)(c) and 16(3)(b) of the Act. These grounds are therefore dismissed.

Non-registrability Ground – s. 12(1)(d) of the Act

[15] An opponent's initial onus is met with respect to a s. 12(1)(d) ground of opposition if the registrations relied upon are in good standing as of the date of the opposition decision. In its written argument and at the oral hearing, the Applicant submitted that the Opponent had failed to meet its evidential burden under this ground for having filed "particulars" (i.e. printouts from the Canadian Intellectual Property (CIPO) Trade-marks Database) as opposed to certified copies of its registrations. I do not accept the Applicant's submissions on this point.

[16] The Registrar has discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. I have exercised that discretion and confirm that the registrations for the Opponent's Registered Marks remain valid and therefore the Opponent has satisfied its evidential burden. I must now assess whether the Applicant has met its legal burden.

[17] 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.

[18] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or

sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.).]

[19] As a preliminary matter, I note that the Opponent made no submissions regarding the likelihood of confusion between the parties' marks with respect to the following wares, for which there is no overlap with the Opponent's clothing wares:

Protective helmets for cyclists and motorcyclists, sunglasses and cases for glasses, frames for glasses; electronic and microprocessor programmers for games; protective reinforcements for shoulders and elbows, knees and other parts of the body for accident prevention; chronometric instruments namely, clocks and watches, watch and key fobs of precious metal, stop watches, sundials; printed matter namely, brochures, newsletters, pamphlets, leaflets; bookbinding material namely, bookbindings, bookbinding wire, bookbinding tape, bookbinding machines, covers, hangers, spines, laminating machines; photographs; stationery namely, books, magazines, newspapers, timetables, postcards, calendars, almanacs, maps, pamphlets, diaries, sheet music, rubber stamps and stamp pads, playing cards; personal writing stationery comprising envelopes, writing paper, pens; drawing paper and pads, pens, pencils, markers, crayons; [...]; games and playthings, namely action-type target, arcade, board, card, computer action, computer simulation, paddle ball, word games, puzzles, ring, role-playing, table tennis, target video; computer games (which are not adapted for use with television receivers only); board games, toy vehicles; remote-control toy vehicles; toy steering wheels and handlebars; replicas and models of scale vehicles.

(the Non-Clothing Wares)

[20] In the absence of evidence or submissions supporting a likelihood of confusion with respect to the Non-Clothing Wares, I am dismissing the s. 12(1)(d) ground of opposition summarily with respect to the Non-Clothing Wares.

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

[21] The parties' marks share the word MOTO. In her affidavit Ms. Young states that while the word "moto" does not appear in traditional dictionaries (e.g. Websters, Gage, Oxford, etc.), it does appear to have some meaning in ordinary parlance. Specifically, she attaches to her affidavit various meanings in English and French for the term "moto" which she located through online resources (Exhibit P). She states that the term "moto" is used in common English parlance to refer to "one of the heats in a motocross event"; "the sport of motocross in general"; or "as a

short form for the words ‘motor’ and ‘motorcycle’”. Ms. Young’s search also revealed that the word “moto” translates from French into English as “an informal expression for motorbike, bike or motorcycle” and possesses the following definition in French: “motocyclette véhicule à deux roues équipé d’un moteur de plus de 125 cm³, sport pratiqué sur ce véhicule”.

[22] The association of the word “moto” with motorcycles renders it highly suggestive of the Wares which relate, in part, to motorcycles. However, the Mark also features design elements, including a colour claim, as well as the suffix “gp” which serves to create a coined word. These factors contribute to the inherent distinctiveness of the Mark.

[23] In addition to the word “moto”, the Opponent’s Registered Marks also feature the words SPORT and GEAR, respectively. Neither of these additional words adds much inherent distinctiveness to the Opponent’s Registered Marks as they are both common dictionary words which are suggestive of the nature of the Opponent’s clothing wares.

[24] By virtue of the inclusion of the design and colour features and the suffix “gp”, the Mark possesses a higher degree of inherent distinctiveness than the Opponent’s Registered Marks.

[25] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. I will now turn to the extent to which the trade-marks have become known in Canada.

[26] The application for the Mark is based on proposed use. In her affidavit, Ms. Young states that she was able to purchase a t-shirt displaying the Mark from an entity named Canada Motorcycle through the website, *www.canadamotorcycle.ca*. This purchase suggests that the Applicant’s clothing wares were available in Canada as of March 2010 (Exhibit I). That said this does not constitute evidence of use of the Mark in association with clothing by the Applicant since it is not clear what the relationship is between the Applicant and Canada Motorcycle. Furthermore, I note that at the oral hearing, the Applicant conceded that it had not filed any evidence regarding the extent to which the Mark had become known. In the absence of evidence, I can only conclude that the Mark has not become known to any extent in Canada.

[27] In his affidavit, Mr. Brener states that the Opponent has extensively used, promoted and advertised various trade-marks in Canada in association with clothing that include or comprise the word MOTO since at least as early as 1997, including the Opponent's Registered Marks.

[28] The Applicant submits that Mr. Brener's affidavit is ambiguous and does not support his statement that the Opponent's Marks have been used since 1997. The Applicant submits that this statement constitutes a conclusion of law, which is not appropriate for an affiant to make. Rather, the Applicant submits that affiants are to adduce sufficient evidence to enable the Registrar to come to a conclusion regarding use [see *Conde Nast Publications v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)]. While I agree with the Applicant on this principle of law, I am satisfied, for the reasons that follow, that Mr. Brener has provided sufficient evidence to support his sworn statement that the Opponent has used one or more of the MOTO marks since 1997.

[29] Mr. Brener attaches to his affidavit sample purchase worksheets and related invoices for the purchase of MOTO-branded clothing by the Opponent, which he states was in turn sold at retail in Canada through various retail stores of the Opponent (Exhibit C). The worksheets and invoices display the Opponent's Marks, including the Opponent's Registered Marks, as follows:

- a. 1997 – display the MOTO and MOTO SPORT marks;
- b. 2003 – display the MOTO and MOTO GEAR marks;
- c. 2004 – display the MOTO JEANS and MOTO GEAR marks;
- d. 2007 – display the MOTO JEANS and MOTO marks; and
- e. 2008 – display the MOTO mark.

[30] At the oral hearing, the Opponent explained the interconnection between the purchase worksheets and the invoices. Suffice it to say that the worksheets feature “purchase order numbers” which match up with entries on the accompanying invoices.

[31] The Applicant submits that the worksheets and invoices do not constitute evidence of use of the Opponent's Registered Marks in Canada by the Opponent. The Applicant highlights the fact that the invoices do not correspond to retail sales of goods in Canada. The Applicant submits that proper evidence of a transaction in the normal course of trade for the Opponent in Canada

would have shown the Opponent selling goods to Canadian end-consumers. The Applicant also submits that no information has been given as to who the seller is on these invoices and what their relationship is to the Opponent and the Opponent's Registered Marks.

[32] I agree with the Applicant that no information has been given as to the identity of the entity from which the Opponent has purchased the clothing wares associated with these worksheets and invoices. Furthermore, the Opponent has not provided any information regarding the relationship between this entity and the Opponent or the Opponent's Registered Marks. Finally, I agree that better evidence would have been invoices evidencing sales from the Opponent to end-consumers in Canada. However, Mr. Brener makes it clear that the Opponent sells the wares shown in the purchase worksheets and invoices in its retail stores to its end-consumers in Canada.

[33] The Applicant had the opportunity to cross-examine Mr. Brener if it had concerns regarding the ownership of the Opponent's Registered Marks or the reliability of Mr. Brener's evidence of use. Based on the foregoing, I am satisfied that Exhibit C, when viewed in association with Mr. Brener's affidavit as a whole, supports a finding that the Opponent has been selling its wares in Canada since at least 1997.

[34] Mr. Brener attaches to his affidavit photocopies of digital photographs of a few examples of MOTO-branded clothing sold in Canada by the Opponent (Exhibit D). I agree with the Applicant that the quality of these photocopies is poor and that this makes it difficult to see what product is being shown in each photo and whether the Opponent's Registered Marks are displayed on the products or the tags affixed thereto. That said, I am satisfied that Exhibit D provides photographs which satisfactorily show the trade-marks MOTO and MOTO JEANS on what appear to be pairs of jeans; the trade-mark MOTO GEAR on what appears to be a sweater; and the trade-mark MOTO TECH GEAR on what appears to be a jacket. I note that none of the clothing in the photographs displays the MOTO SPORT mark. I note that these photographs are not dated and thus I am only willing to accept them as evidence of the manner in which the Opponent's Registered Marks were displayed on the Opponent's clothing wares as of the date Mr. Brener swore his affidavit (2009).

[35] Mr. Brener attaches to his affidavit what he states are sample labels both currently and previously used by the Opponent in association with its sale of MOTO-branded clothing in Canada. I note, however, that these are merely “mock ups” of the actual labels used (Exhibit E). Absent other supporting evidence, mock ups of this nature are not evidence of use. The mock ups are dated from 2003 – 2008 and some of the mock ups match the actual labels displayed on the Opponent’s clothing wares as seen in Exhibit D. The mocks ups display the Opponent’s Marks, including the Opponent’s Registered Marks as follows:

- a. 2003 – display MOTO; MOTO TECHGEAR and MOTO GEAR marks;
- b. 2004 – display MOTO; MOTO GEAR; MOTO JEANS and MOTO SPORT marks;
- c. 2005 – display MOTO; MOTO JEANS and MOTO GEAR marks;
- d. 2007 – display MOTO mark; and
- e. 2008 – display MOTO.

[36] When the labels are viewed in association with the sample photographs of clothing and in conjunction with Mr. Brener’s affidavit as a whole, I am satisfied that the Opponent has displayed the Opponent’s Registered Marks on tags applied to clothing wares.

[37] Mr. Brener attaches to his affidavit sample print advertisements for the Opponent’s MOTO-branded clothing. Mr. Brener states that these advertisements appeared in the *Toronto Star* and *Toronto Sun* newspapers. The Applicant submits, and I agree, that I am unable to accept the handwritten dates on these advertisements as evidencing the dates of the advertisements without information as to where the dates came from. That said, I note that two of the advertisements are dated (in the advertisements themselves) 2005. I am willing to take judicial notice that the *Toronto Star* and the *Toronto Sun*, circulate at least in the Toronto area [see *Milliken & Co. v. Keystone Industries (1970) Ltd.* (1986), 12 C.P.R. (3d) 166 (T.M.O.B.), at 168 and *Carling O’Keefe Breweries of Canada Ltd. v. Anheuser-Busch, Inc.* (1985), 4 C.P.R. (3d) 216 (T.M.O.B.), at 224]. At the oral hearing, the Applicant noted, and I agree, that these advertisements display some of the Opponent’s MOTO marks but do not display either of the Opponent’s Registered Marks.

[38] I note that the fact that the Opponent has not provided any sales figures or invoices to end-consumers in Canada makes it difficult to establish the extent to which the Opponent's Registered Marks have become known. As a result, I am unable to determine the extent to which the Opponent's Registered Marks have become known except that they must have become known to some extent in light of my finding that one or more of the Opponent's Registered Marks have been used in Canada since 1997 in association with the Opponent's clothing wares.

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

[39] As set out in more detail above in the analysis of the s. 6(5)(a) factor, the Applicant has not established use of the Mark by itself or a licensee pursuant to s. 50 of the Act.

[40] Based on the evidence as a whole, I am satisfied that one or more of the Opponent's Registered Marks have been used in Canada since 1997.

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

[41] It is the Applicant's statement of wares as defined in its application versus the Opponent's registered wares that govern my determination of this factor [see *Esprit International v. Alcohol Countermeasure Systems Corp.* (1997), 84 C.P.R. (3d) 89 (T.M.O.B.)].

[42] As I have already summarily dismissed the s. 12(1)(d) ground of opposition with respect to the Non-Clothing Wares, the remaining Wares make up the only area of potential overlap between the parties' wares. Specifically, the remaining Wares are "t-shirts, sweatshirts, polo shirts, caps, gloves, pants and balaclavas for motorcyclists, jackets, trousers and overalls of leather and imitation leather". The Opponent's Registered Marks claim:

- a. MOTO SPORT (TMA502,767) – Clothing, excluding motorcycle clothing, namely, suits, jackets, pants, coats, vests, shirts, sweaters, T-shirts and shorts.
- b. MOTO GEAR (TMA731,143) – Men's, women's, teen's and children's wearing apparel, namely, jackets, coats, sweaters, vests, sweatshirts, pants, jeans, shorts, skirts, t-shirts, shirts, blouses, dresses, belts, socks, scarves, hats and gloves.

[43] There is some overlap in the nature of the parties' wares as both cover clothing.

[44] The Applicant submits that its t-shirts, priced at approximately \$30 each according to the Young affidavit, would be considered expensive and thus likely to be sold in specialty stores and end-consumers would take extra care in making purchasing decisions due to the high price. Firstly, I note that there is no evidence of record regarding the price of t-shirts generally, or the nature of the Applicant's target consumer. More importantly, however, I note that the Supreme Court of Canada recently commented on the issue of the sophisticated consumer in *Masterpiece* where Justice Rothstein stated that the fact that wares are expensive is not a relevant factor and not something that should limit trade-mark protection. The test for confusion is one of first impression [*Polo Ralph Lauren Corp. v. United States Polo Assn.* (2000), 9 C.P.R. (4th) 51 (F.C.A.)]. Any subsequent steps taken by sophisticated consumers in an attempt to remedy any such first instance confusion are irrelevant [by analogy see paragraphs 68-74 of *Masterpiece*]. Based on the foregoing, I am not placing any weight on the Applicant's submissions on this point.

[45] With respect to the nature of the parties' trades, the evidence suggests that the Opponent sells its clothing through its retail stores. No clear evidence has been provided establishing the nature of the Applicant's trade. Given the overlap in the nature of the parties' wares with respect to clothing, and in the absence of any restriction, it is conceivable that the parties' clothing wares could travel through the same channels of trade.

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

[46] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)]. This principle was recently upheld by the Supreme Court of Canada in *Masterpiece*.

[47] In *Masterpiece*, the Supreme Court of Canada advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique [see *Masterpiece* at para 64]. I find the design elements and the

suffix “gp” to be the most striking and unique aspects of the Mark as they are the most distinctive elements thereof.

[48] I agree with the Opponent that the parties’ marks share similarities in sound, appearance and idea suggested by virtue of the inclusion of the word MOTO which suggests the ideas of motocross or motorcycles. However, I find that the addition of the suffix “gp” and the design and colour elements serves to create significant differences in the appearance, sound and ideas suggested by the parties’ marks.

Additional Surrounding Circumstance – State of the Register and Marketplace

[49] The Applicant filed state of the register and marketplace evidence by way of the Young affidavit. In March 2010 Ms. Young conducted a search of the CIPO Trade-marks Database for trade-marks including the word MOTO registered or applied for in association with clothing, headwear and footwear.

[50] The parties have provided differing interpretations of the state of the register evidence itself and of its purpose and intent.

[51] The Applicant relies on Ms. Young’s affidavit as supporting a finding that 64 relevant marks were found.

[52] By contrast, the Opponent submits that Ms. Young’s search results reveal only five relevant registrations owned by four different entities. The Opponent submits that there are three categories of trade-marks found in Ms. Young’s search which should not be considered, as follows:

- a. pending applications;
- b. coined words;
- c. marks which include elements such as MOTOR, MOTORE, MOTOSPORT/MOTORSPORTS or MOTORCYCLE rather than MOTO.

[53] At the oral hearing, the Applicant submitted that it is reasonable to presume that, in the ordinary course, pending applications will mature to registration and that as a result pending applications should be considered. With respect to the Opponent’s submission on coined words,

the Applicant submitted that the mark itself is a coined word and that there is no judicial support for refusing to consider coined words when assessing state of the register evidence. I agree. With respect to the MOTOR, MOTOSPORT/MOTORSPORT, MOTORCYCLE marks the Applicant submitted that these marks are relevant to a consideration of the state of the register in part as the evidence has shown that MOTO is an abbreviation in French for the word MOTORCYCLE.

[54] I do agree with the Opponent that some of the marks are not relevant. Specifically, pending applications which have not been approved for advertisement and marks which include the element MOTOR or MOTORCYCLE as opposed to MOTO, are not relevant. I do not agree with the Opponent, however, that there are only five relevant marks. By my calculations, the search revealed at least 17 relevant marks.

[55] With respect to the purpose of state of the register evidence, I note that the Opponent submitted the following:

Moreover, the Federal Court in *Cartier Men's Shops Limited v. Cartier Inc.* (1981), 58 C.P.R. (2d) 68 clearly stated at page 71 that "a state of the register is irrelevant as evidence to establish that, because similar marks were granted previously, one more should not be refused".

[56] In response, the Applicant submitted that the purpose of state of the register evidence is merely to provide a "snapshot" of the state of the register at a particular time. In this case, the evidence was adduced to provide a snapshot regarding the presence of the MOTO element in association with clothing wares. The Applicant further submitted, and I agree, that state of the register evidence can, in situations where large numbers of relevant registrations are located, enable one to make inferences about the state of the marketplace [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)]. In this case, the inference would be that the MOTO element is commonly used in association with clothing wares.

[57] The Applicant made submissions relying on decisions in which varying numbers of registrations were found to be sufficient or insufficient to enable the Registrar to make inferences regarding the marketplace from state of the register evidence.

[58] Ultimately, I am satisfied that 17 relevant marks are sufficient to enable me to draw an inference that at least some of these marks are in use in the Canadian marketplace.

[59] Furthermore, Ms. Young conducted searches of the Internet using the Google search engine for websites selling the products associated with some of the trade-marks found in her search of the CIPO Trade-marks Database.

[60] Ms. Young purchased ten products in the nature of clothing and headwear displaying various trade-marks incorporating the word MOTO (i.e. MOTOJEWEL, MOTORESS, MOTO GUZZI, MOTOROLA, MOTORCRAFT, CROWN MOTO, OMOTO, MOTO, MOTO HEAD, MOTO XXX) (Exhibits C – G; J; L – O). Ms. Young also states that she was able to purchase clothing displaying the trade-marks MOTORFIST, ICON MOTO and OMOTO CROSS and have these shipped to Canada, however, actual purchases were not made due to the high cost of these products (Exhibits H, K).

[61] The Opponent objected to the state of the marketplace evidence on the basis that the Applicant did not provide evidence regarding the extent to which any of these marks have become known in Canada (i.e. no evidence of extent of sales or how long these wares have been available for sale in Canada).

[62] In response, the Applicant submitted that the state of the marketplace evidence was merely adduced in order to provide some evidentiary support for the inference that was drawn from the state of the register evidence. Specifically, it was adduced to show that some of the MOTO marks found in the state of the register search were in fact in use in the Canadian marketplace. I accept the Applicant's submissions.

[63] The online purchases serve as evidence of the fact that it was possible for Canadians to buy these wares off the Internet. That said I do not consider it to be very strong evidence of marketplace use in Canada. However, given the state of the register evidence, I am satisfied, based on the evidence as a whole, that the Applicant has established that the word MOTO is common to the clothing trade.

[64] Based on the foregoing, this creates a factor supporting the Applicant's position.

Conclusion

[65] Having considered all of the surrounding circumstances, including the differences in the parties' marks with respect to appearance, sound and idea suggested, and the state of the register evidence showing common adoption of the element MOTO with respect to clothing, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's Registered Marks with respect to "t-shirts, sweatshirts, polo shirts, caps, gloves, pants and balaclavas for motorcyclists, jackets, trousers and overalls of leather and imitation leather". Having regard to the foregoing, I reject the ground of opposition based on s. 12(1)(d) of the Act.

Non-entitlement Ground – s. 16(3)(a) of the Act

[66] Despite the onus of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's MOTO marks, the Opponent has the initial onus of proving that one or more of the trade-marks alleged in support of its ground of opposition based on s. 16(3)(a) of the Act was used in Canada prior to the date of filing the application for the Mark (December 18, 2006) and had not been abandoned at the date of advertisement of the application for the Mark (August 27, 2008) [s. 16(5) of the Act].

[67] I acknowledge the Applicant's submissions regarding the deficiencies in the Opponent's evidence and I agree that the evidence does possess some deficiencies. However, as discussed more fully in the analysis of the registrability ground of opposition, I am satisfied that the Opponent's evidence supports a finding that one or more of the Opponent's MOTO marks had been used in Canada as of the material date and had not been abandoned as of the advertisement date. Thus the Opponent has met its evidential burden.

[68] The difference in material dates is not significant. I wish to make one note, however, regarding the impact of the material date on the evidence of record. Specifically, I note that the state of the register and marketplace evidence, having been produced in 2010, is dated after the material date for this ground of opposition. With respect to the state of the marketplace evidence, Ms. Young has provided printouts from the Wayback Machine Internet archive. I accept this

evidence as sufficient to support a finding that the websites from which Ms. Young purchased the clothing wares would have been active at the earlier material dates. Having reviewed the state of the register evidence I am satisfied that there was a sufficient number of relevant marks on the register as of the earlier material date to enable me to make an inference regarding the state of the marketplace. Based on the foregoing, I find the state of the register and marketplace evidence equally relevant for the non-entitlement ground of opposition.

[69] None of the trade-marks claimed under the s. 16(3)(a) ground of opposition shares any more similarity in terms of appearance, sound or idea suggested with the Mark than the Opponent's Registered Marks. Furthermore, the additional unregistered marks pleaded under s. 16(3)(a) also claim use only with clothing wares. As a result my findings under the ground of opposition based on s. 12(1)(d) of the Act are equally applicable here. Therefore, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the marks at issue.

[70] Based on the foregoing, I reject the non-entitlement ground of opposition.

Non-distinctiveness Ground – s. 38(2)(d) of the Act

[71] In order to meet its initial burden with respect to this ground, the Opponent must establish that one or more of the Opponent's MOTO marks was known to some extent at least in Canada as of January 27, 2009 [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.) and *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.)]. As stated in *Bojangles* at para 34:

A mark must be known to some extent at least to negate the established significance of another mark, and its reputation in Canada should be substantial, significant or sufficient.

[72] As indicated in my discussion of the s. 6(5)(a) factor above in my analysis of the s. 12(1)(d) ground of opposition, in light of the Opponent's failure to provide sales figures or invoices to end-consumers in Canada, I was not able to clearly establish the extent to which the Opponent's MOTO marks had become known in Canada. As a result, I am not satisfied that the Opponent has met its burden of establishing that one or more of the Opponent's MOTO marks

had developed a “substantial, significant or sufficient” reputation in Canada to negate the distinctiveness of the Mark as of the material date.

[73] Based on the foregoing, the Opponent has failed to meet its evidential burden and the non-distinctiveness ground is dismissed accordingly.

Disposition

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

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office