



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

Citation: 2015 TMOB 62
Date of Decision: 2015-04-02

**IN THE MATTER OF AN OPPOSITION
by Office of the Commissioner of Baseball
to application No. 1,408,115 for the trade-
mark ALL-STAR BASEBALL in the
name of Throwback Entertainment Inc.**

[1] On August 21, 2008, Throwback Entertainment Inc. (the Applicant) filed an application to register the trade-mark ALL-STAR BASEBALL (the Mark). The application, as amended pursuant to a revised application accepted by the Registrar on February 19, 2013, claims the following goods and services, all based on proposed use in Canada (the Goods and Services):

GOODS:

- (1) Interactive computer video games.
- (2) Electronic games, namely, coin-operated amusement games, electronic game cartridges, video game software, electronic hand-held, and free-standing arcade games.
- (3) Video output games for use with televisions.
- (4) Arcade video games.
- (5) Handheld units for playing electronic games, namely, electronic game cartridges, video game software, and electronic hand-held games.
- (6) Electronic equipment, namely, computer and video game components, apparatus and equipment, namely, computer game programs, computer game software and computer peripherals, namely, keyboards, modems, mouse, speakers, video recorders, and video game interactive control pads and floor pads or mats.
- (7) Computer game joysticks.
- (8) Video game controllers.

SERVICES:

- (1) Entertainment services, namely, providing online video game tournaments.
- (2) Providing on-line information in the field of video games.
- (3) Providing on-line forums for the discussion of video games.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 7, 2010.

[3] On June 7, 2011, Office of the Commissioner of Baseball (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- pursuant to sections 38(2)(a) and 30(a) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) the application does not comply with section 30(a) because it does not contain a statement in ordinary commercial terms of the specific goods and services in association with which the Mark is proposed to be used.
- pursuant to sections 38(2)(a) and 30(i) of the Act, the application does not comply with section 30(i) of the Act, because although the Applicant stated in the application that it was satisfied that it was entitled to use the Mark in Canada in association with the Goods and Services, the Applicant was aware of the Opponent's prior use and making known in Canada of the Opponent's confusingly similar ALL-STAR trade-marks and therefore the Applicant is not entitled to use the Mark in Canada in association with the Goods and Services.
- pursuant to sections 38(2)(b) and 12(1)(d) of the Act, the Mark is not registrable for the Goods and Services because it is confusing with the Opponent's registrations for the trade-mark ALL-STAR GAME:
 - i. TMA320,504 registered for "entertainment services in the nature of the presentation and promotion of baseball games and exhibitions rendered live and through the media of radio and television broadcasts which are played by selected players of the major league baseball organizations, namely the American and National leagues of professional baseball clubs";
 - ii. TMA501,507 registered for "jewellery, namely pins"
 - iii. TMA695,397 registered for "metal novelty items, namely, key chains and money clips, all relating to or promoting the sport of baseball; watches, clocks, souvenir coins, and jewelry, namely, wall clocks and wristwatches, non-monetary coins and medallions, lapel pins, pins, pendants and charms, all relating to or promoting the sport of baseball; paper goods and printed matter, namely laminated paper signs, decals, paper weights, posters, baseball cards, programs, magazines, books, all relating to or promoting the sport of baseball; luggage, namely, all purpose athletic bags, tote bags, all relating to or promoting the sport of baseball; beverage containers, namely mugs, water bottles, aluminum tankards, foam can holders, ceramic mugs, ceramic tankards, glass tankards, glasses, vacuum bottles, all relating to or promoting the sport of baseball; fabrics, namely, towels, pennants, all relating to or

promoting the sport of baseball; clothing, namely, shirts, shorts, jackets, sweaters, hats, caps, sweatshirts, all relating to or promoting the sport of baseball; toys and sporting goods, namely stuffed animals, baseballs, gloves and mitts, Christmas tree ornaments, computer and electronic games, golf equipment, including golf balls, autographed baseballs and inflatable bats, all relating to or promoting the sport of baseball.” and the services: “entertainment services in the nature of the presentation and promotion of baseball games and exhibitions rendered live and through the media of radio and television broadcasts, which are played by selected players of the Major League Baseball organizations, namely, the American and National Leagues of professional baseball clubs”.

- pursuant to sections 38(2)(c) and 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because the Mark is confusing with the Opponent`s ALL-STAR marks which have been previously used.
- pursuant to sections 38(2)(d) of the Act, the Mark is not distinctive because it does not distinguish and it is not adapted to distinguish, the Goods and Services from those associated with the Opponent`s ALL-STAR trade-marks. In light of the reputation and fame attached to the Opponent`s ALL-STAR marks, the Mark would not distinguish and cannot be adapted to distinguish the Goods and Services from those associated with the Opponent`s ALL-STAR trade-marks – specifically, the Mark would be confused with the Opponent`s ALL-STAR marks.

[4] 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.

[5] In support of its opposition, the Opponent filed an affidavit of Thomas J. Ostertag, the Opponent`s Secretary.

[6] In support of its application, the Applicant filed an affidavit of Thomas Maduri, the Applicant`s Director.

[7] The Applicant filed a written argument and a hearing was held at which both parties were represented.

Onus and Material Dates

[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 Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

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

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

Section 30 Grounds

Section 30(a) of the Act

[10] The Opponent has provided no evidence or submissions in support of this ground of opposition and accordingly it is dismissed.

Section 30(i) of the Act

[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]. The Applicant has provided the necessary statement and this is not an exceptional case; the section 30(i) ground is accordingly dismissed.

Non-registrability Grounds – Section 12(1)(d) of the Act

[12] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration(s) relied upon is in good standing as of the date of the opposition decision. The Registrar has discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[13] I have exercised my discretion and note that each of the pleaded registrations for the Opponent's ALL-STAR GAME trade-mark remains extant and thus the Opponent has met its initial evidential burden.

[14] 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[15] 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 goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 96 CPR (4th) 361 (SCC).]

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

[16] Both parties' marks include the word element ALL STAR, which is a laudatory term connoting the best in a field. The *Canadian Oxford Dictionary* defines "all-star" as "a player chosen as among the finest in his or her league". The additional word elements in the parties' marks (BASEBALL and GAME) are at the very least suggestive of the associated goods,

services or the subject matter thereof. The Applicant submits, and I agree, that the Opponent's ALL-STAR GAME trade-mark possesses a low degree of inherent distinctiveness. However, the Mark, which shares the same structure as the Opponent's mark, possesses the same low degree of inherent distinctiveness.

[17] 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.

[18] The application for the Mark is based on proposed use and the Applicant has not provided any evidence of use of the Mark since the filing date. As a result, I can only infer that the Mark has not become known to any extent.

[19] By contrast, the Opponent provides substantial evidence in which it asserts that its ALL-STAR GAME trade-mark has become well-known in Canada. The evidence establishes that the Opponent puts on an "all-star" baseball game annually – and has done so since the late 1930s. The game has been played in Canada and has featured Canadian baseball players as well as players from Canadian Major League Baseball teams. The evidence also establishes that the game is broadcast on television and on the radio/internet in Canada; and that the Opponent has licensed the production and sale of various promotional merchandise bearing the ALL-STAR GAME trade-mark in connection with the annual ALL-STAR GAME exhibition.

[20] That being said, the evidence is vague in terms of the actual numbers of Canadians who have watched or listened to the Opponent's ALL-STAR GAME exhibition games. Likewise, there is no clear evidence of sales figures for the licensed goods bearing the Opponent's ALL-STAR GAME mark, as the evidence is for sales of goods in association with all Major League Baseball trade-marks (of which the ALL-STAR GAME trade-mark is just one). Furthermore, it is relevant to note that there is no evidence whatsoever demonstrating use of the ALL-STAR GAME trade-mark in association with the registered goods "computer and electronic games".

[21] All of this being said, the sheer volume of evidence, including evidence of the ALL-STAR GAME trade-mark in Canada is sufficient to enable me to determine that the Opponent's ALL-STAR GAME trade-mark has become known to a greater extent than the Mark.

[22] Based on the foregoing, this factor favours the Opponent.

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

[23] As discussed in greater detail above in the analysis of the section 6(5)(a) factor, the Mark has not been used in Canada whereas the Opponent has established some of use of its ALL-STAR GAME trade-mark in Canada in association with some of the registered goods and services such that this factor favours the Opponent.

Section 6(5)(c) and (d) – the nature of goods, services or business and trade

[24] One of the Opponent's registrations, TMA695,397 includes in its long list of goods and services, the goods "computer and electronic games". In the absence of evidence of use of the Opponent's ALL-STAR GAME mark in association with "computer and electronic games" and taking into account the lack of evidence of use of the Mark in association with the Goods, my assessment of the nature of the parties goods and trade is limited to a mere reading of the specifications as drafted. I consider the only clear overlap between the parties' goods to be with respect to applied-for goods defined as "interactive computer video games" and "electronic games, namely, coin-operated amusement games, electronic game cartridges, video game software, electronic hand-held, and free-standing arcade games" (the Overlapping Goods).

[25] With respect to the Overlapping Goods, I am prepared to infer that there may also be an overlap between the parties' channels of trade. However, I cannot make the same inference with respect to the remaining goods and the applied-for services.

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

[26] The Supreme Court in *Masterpiece* 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, supra* at para 64]. As mentioned above in the analysis of the section 6(5)(a) factor, the ALL STAR element of the parties' marks is laudatory, and the additional elements GAME and BASEBALL are at least suggestive (possibly even descriptive) of the associated goods and services. I do not find that there is any element of the parties' marks

which is particularly striking or unique. The fact remains that the first element of the parties' marks is the same which serves to create a fairly high degree of resemblance in appearance, and sound.

[27] I agree with the Applicant that the additional word element GAME associated with the Opponent's marks suggests the idea of a specific event whereas the Applicant's BASEBALL suggests the idea of high caliber sport generally. Thus there is some difference in the ideas suggested by the parties' marks.

Additional Surrounding Circumstance: state of the register

[28] In his affidavit, Mr. Maduri provides results for a search of the Canadian Intellectual Property Office Trade-marks Database for registered trade-marks containing the element "ALL-STAR". He states that the search returned 47 registered trade-marks, three of which were owned by the Opponent. He attaches to his affidavit the search results (Exhibit B), as well as particulars of 11 "relevant" entries (Exhibit C).

[29] In its written argument, the Applicant points to various third party registrations containing ALL-STAR associated with baseball or things related to baseball (paragraphs 8-9 of Maduri affidavit). Specifically, the Applicant points to:

- a. ALL-STAR (TMA342,752) registered by Ampac Enterprises Inc. in association with among other things, baseball equipment;
- b. ALL STAR CHALLENGE (TMA530,841) registered by Blast Promotions Inc. in association with computer software designed for the calculation, tracking and reporting of statistical information, the marketing of the goods and services of others through the creation of contests and promotions of skill in the fields of basketball, football, baseball, and golf drafts, and operation of a computer database management system;
- c. ALLSTAR HEROES & Design (TMA514,763) registered by Allstar Marketing Corp. in association with sports trading cards and sports collectibles, namely autographed baseballs and baseball bats;
- d. ALL-STAR SPORTS CAMP (TMA700,597) registered by All-Star Sports Camp Inc. in association with the operation of a children`s summer sports camp;

- e. ALL STAR GAME PARTY (App No. 0909266) is an official mark owned by the Canadian Mental Health Association Ontario Division;
- f. ALLSTARLINEUP (TMA565,304) is registered by WCINET Inc. in association with retail and wholesale services in the field of memorabilia and collectibles by means of mail order, catalog, telephone, fax order, in-person customer meetings, and sales booths at collectibles and memorabilia shows, and related services; and
- g. ALLSTAR (TMA643,818) is registered by Imarketing Solutions Group Inc. in association with, among other things, entertainment services in the field of entertainment and sporting events and the production of sporting events for others.

[30] The Applicant also submits that the term ALL-STAR is often used in the baseball context (see paragraphs 10 and 11 of the Maduri affidavit). However, I find that without any information as to where or how Mr. Maduri obtained this evidence and in light of the fact he does not have direct knowledge of this evidence, it consists of inadmissible hearsay evidence. Furthermore, as submitted by the Opponent, the website evidence cannot be relied upon for the truth of its contents [see *ITV Technologies Inc v WIC Television Ltd* (2003), 29 CPR (4th) 182 (FCTD)].

[31] In light of the hearsay deficiencies with the state of the marketplace evidence, I am left with only the state of the register evidence regarding the term ALL STAR.

[32] State of the register evidence will only be relevant insofar as one can make inferences from it about the state of the marketplace. Inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432; *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FCTD); *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 C.P.R. (3d) 349 (FCA)] or where evidence of use of the marks in the marketplace.

[33] At the oral hearing, the Opponent submitted that 11 relevant entries are too few to enable any inferences about the marketplace to be made [see *Jacques Vert PLC v YM Inc*, 2014 TMOB 88] While I agree with the Opponent that the state of the register evidence is insufficient to find that ALL STAR trade-marks have been commonly adopted, I am prepared to find that the evidence results in the inference that the Opponent does not have a monopoly over the use of the component ALL STAR in the sports/entertainment sector. As such, this factor slightly favours the Applicant.

Conclusion

[34] With respect to the Overlapping Goods, the section 6(5)(a) – (e) factors favour the Opponent such that the Applicant has failed to meet its legal burden of establishing on a balance of probabilities that no likelihood of confusion exists between the parties' marks. As a result, the section 12(1)(d) ground of opposition is successful with respect to the Overlapping Goods.

[35] With respect to the remainder of the applied-for goods and services, I find that the lack of similarity with the Opponent's registered goods and services serves to shift the balance of probabilities in the Applicant's favour, such that the Applicant has satisfied its burden and the section 12(1)(d) ground of opposition is dismissed with respect to the remainder of the goods and services.

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

[36] The Opponent is under an initial burden of establishing use of one or more of the pleaded ALL-STAR GAME marks prior to the filing date for the application for the Mark (August 1, 2008) as well as non-abandonment of its pleaded marks at the date of advertisement (April 7, 2010).

[37] The evidence does not establish use of the Opponent's ALL-STAR GAME mark in association with computer and electronic games – which was the only area of overlap between the parties' goods and services in the section 12(1)(d) ground of opposition. Given the low degree of inherent distinctiveness of the parties' marks, and the state of the register evidence which enabled me to infer that the Opponent does not have a monopoly over the use of the component ALL STAR in the sports/entertainment sector – I find that these factors in combination with the fact that there is no overlap in the nature of the parties' goods and services under this ground of opposition shift the balance of probabilities even further in the Applicant's favour. As a result, I find that there is no likelihood of confusion between the parties' marks and dismiss the non-entitlement ground of opposition accordingly.

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

[38] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Goods and Services from those of others throughout Canada [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[39] Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing of the statement of opposition, one or more of its pleaded ALL-STAR GAME marks had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[40] As was the case in the non-entitlement ground of opposition, the Opponent has not established any evidence of use of the ALL-STAR GAME mark in association with the overlapping goods (computer and electronic games). Given the low degree of inherent distinctiveness of the parties' marks, and the state of the register evidence which infer that the Opponent does not have a monopoly over the use of the component ALL STAR in the sports/entertainment sector – I find that these factors in combination with the fact that there is no overlap in the nature of the parties' goods and services under this ground of opposition – I find that there is no likelihood of confusion between the parties' marks and dismiss the non-distinctiveness ground of opposition accordingly.

Disposition

[41] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application for the Mark with respect to the goods “(1) interactive computer video games; (2) electronic games, namely, coin-operated amusement games, electronic game cartridges, video game software, electronic hand-held, and free-standing arcade games.” and I reject the opposition with respect to the goods “(3) video output games for use with televisions; (4) arcade video games; (5) handheld units for playing electronic games, namely, electronic game cartridges, video game software, and electronic hand-held games; (6) electronic equipment, namely, computer and video game components, apparatus and equipment, namely, computer game programs, computer game software and computer peripherals, namely, keyboards,

modems, mouse, speakers, video recorders, and video game interactive control pads and floor pads or mats; (7) computer game joysticks; (8) video game controllers; and the services (1) entertainment services, namely, providing online video game tournaments; (2) providing on-line information in the field of video games; (3) providing on-line forums for the discussion of video games.” pursuant to section 38(8) of the Act [see *Produits Menagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (FCTD) as authority for a split decision].

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