



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

**Citation: 2010 TMOB 59**  
**Date of Decision: 2010-05-06**

**IN THE MATTER OF AN OPPOSITION  
by Quiksilver International Pty Ltd., QS  
Holdings Sarl and 54<sup>TH</sup> Street Holdings  
Sarl to application No.1,194,451 for the  
trade-mark ROXY POKER in the name  
of Equinox Entertainment Limited**

THE RECORD

[1] On October 22, 2003, Equinox Entertainment Limited filed an application to register the trade-mark ROXY POKER, based on proposed use in Canada, in association with the service of

“providing on line casinos, and casino gaming  
entertainment services.”

The application disclaims the right to the exclusive use of the word POKER apart from the mark as a whole.

[2] The applied for mark was advertised for opposition purposes in the *Trade-marks Journal* issue dated September 22, 2004 and was opposed by Quiksilver International Pty Ltd. on February 22, 2005. The Registrar forwarded a copy of the statement of opposition to the applicant on June 8, 2005 as required by s.38(5) of the *Trade-marks Act* R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement. The statement of opposition was thereafter amended twice, first to add QS Holdings Sarl and then to add 54<sup>TH</sup> Street

Holdings Sarl as joint opponents. The applicant did not object to the addition of the joint opponents.

[3] The opponents' evidence consists of the affidavits of Randall Hild; Robert White; Jane Griffith and Mary P. Noonan. The applicant elected not to file evidence. The opponents and the applicant filed written arguments and were represented at an oral hearing held on April 6, 2010.

#### STATEMENT OF OPPOSITION

[4] The first ground of opposition alleges that the subject application does not conform to s.30(e) of the *Trade-marks Act* because at the date of filing the proposed use application on October 22, 2003, the applied for mark was already in use in Canada. In this regard, the opponents allege that the applicant's website indicates that the applicant has offered online gaming services since February 2002.

[5] The second ground alleges that the subject application does not conform to s.30(i) of the *Act* because the applicant was or should have been aware of the opponent 54<sup>TH</sup> Street's trademark ROXY with which the applied for mark ROXY POKER is confusing.

[6] The third ground, pursuant to s.12(1)(d), alleges that the applied for mark is not registrable because it is confusing with 54<sup>TH</sup> Street's mark ROXY, registration no. TMA703,880, which mark was assigned to 54<sup>TH</sup> Street by QS Holdings Sarl. The registered mark ROXY covers various items of women's and children's outerwear.

[7] The fourth ground, pursuant to s.16(3)(a), alleges that the applicant is not entitled to registration because, at the date of filing the application, the applied for mark ROXY POKER was confusing with 54<sup>TH</sup> Street's mark ROXY that had been previously used and made known in Canada by the opponent 54<sup>TH</sup> Street, and its predecessors in title, in association with a broad array of wares including sunglasses, watches, travel bags, clothing, personal hygiene and cosmetic products, jewellery, sports equipment (mainly surfboards, snowboards and skateboards) and with a variety of services including instruction in sports activities, organizing sports competitions and sports exhibitions and the like.

[8] The fifth ground, pursuant to s.16(3)(b), alleges that the applicant is not entitled to registration because, at the date of filing the application, the applied for mark ROXY POKER

was confusing with 54<sup>TH</sup> Street's trade-mark application for ROXY (application No.1,123,333) filed on November 27, 2001 for use in association with a variety of wares including sunglasses, watches, travel bags and clothing.

[9] The sixth ground, pursuant to s.16(3)(a), alleges that the applicant is not entitled to registration because, at the date of filing the application, the applied for mark ROXY POKER was confusing with 54<sup>TH</sup> Street's mark ROXY that had been previously used and made known in Canada by the opponent 54<sup>TH</sup> Street, and its predecessors in title, in association with various items of women's and children's outerwear. I note that the mark being relied on for this ground is the same mark that issued to registration No. TMA703,880 relied on for the third ground of opposition.

[10] The seventh ground, pursuant to s.16(3)(b), alleges that the applicant is not entitled to registration because, at the date of filing the application, the applied for mark ROXY POKER was confusing with 54<sup>TH</sup> Street's trade-mark application for ROXY (application No.1,1132,582) filed on February 28, 2002 for use in association with various items of women's and children's outerwear. I note that the trade-mark application being relied on for this ground is the same mark that issued to registration no. TMA703,880 relied on for the third ground of opposition and is the same mark relied on for the sixth ground.

[11] The eighth ground, pursuant to s.2, alleges that the applied for mark ROXY POKER is not adapted to distinguish the applicant's services from the wares and services of others including the opponents.

#### OPPONENTS' EVIDENCE

##### *Randall Hild*

[12] Mr. Hild identifies himself as the Executive Vice-President Roxy Global Marketing for "Quiksilver." Mr. Hild explains that Quiksilver International Pty Ltd. (the first opponent) is an Australian corporation. Quiksilver, Inc. is a Delaware, U.S.A. corporation that carries out its operation activities in California. In July 2000, Quiksilver, Inc. acquired ownership of Quiksilver International Pty Ltd. which resulted in Quiksilver International becoming a wholly owned subsidiary of Quiksilver, Inc. QS Holdings Sarl (the second opponent) is another wholly

owned subsidiary of Quiksilver, Inc. In November 2004, QS Holdings Sarl acquired all the trade-marks owned by Quiksilver International. Quiksilver Canada Corp. (a Nova Scotia corporation) is another wholly owned subsidiary of Quiksilver, Inc.

[13] Mr. Hild collectively refers to Quiksilver, Inc., Quiksilver International, QS Holdings Sarl and Quiksilver Canada Corp. as Quiksilver. In mid 2009 the trade-marks relied on in the statement of opposition were assigned from QS Holdings Sarl to 54<sup>TH</sup> Street Holdings Sarl (the third opponent). As Mr. Hild's affidavit is dated March 11, 2008, his evidence (and my summary of his evidence which follows) refers to the period when the marks relied on in the statement of opposition were owned by QS Holdings Sarl.

[14] Mr. Hild refers collectively to the marks relied on in the statement of opposition as the ROXY trade-mark or brand. The ROXY trade-marks are owned by QS Holdings Sarl in Canada and are licensed to Quiksilver Canada Corp.. Mr. Hild states that the trade-mark owner exercised direct or indirect control over the character and the quality of the wares and services offered in Canada under the ROXY mark.

[15] Beginning in about 1989, Quiksilver developed a women's line of clothing under the ROXY brand. In the last three decades Quiksilver has also become a prominent sponsor of board-riding events. Quiksilver was among the first board-riding organizations to sponsor prestigious events such as the Big Wave International and the ROXY Pro. Quiksilver has created a "lifestyle" around its ROXY brand by virtue of its advertising, product design, sponsored athletes and sponsored events. Mr. Hild states that "a lifestyle brand is one that connects the target demographic to an entire culture . . . The ROXY lifestyle is one that embraces characteristics such as daring, confident, naturally beautiful, fun and alive." Quiksilver provides clothing and other products under its ROXY mark which "connect consumers with the history and the 'real' culture of surfing, snowboarding, windsurfing and other board-related extreme sports." Mr. Hild, at paragraph 22 of his affidavit, cites from the *Quiksilver, Inc. 1995 Annual Report*:

Quiksilver is a worldwide surf/boardriding lifestyle label . . . [Quiksilver, Inc.] works to stay close to extreme sports like surfing, snowboarding and skating . . . [sports] accepted internationally by teens and young adults who are attracted to the look that is cool, unique and authentic . . . the ROXY customer has a strong sense of independent style. She uses fashion in the expression of her sport and active outdoor lifestyle.

[16] Mr. Hild states that the ROXY brand is intended to appeal primarily to the female market. He refers to Exhibit RH-21 of his affidavit which describes the ROXY brand target demographic as females between 15-25 years old. Exhibit RH-21 also indicates that the channels of distribution of ROXY wares are through “surf specialty stores,” “juniors specialty stores and boutiques” and “better department stores.” The ROXY consumer can go online at [www.roxy.com](http://www.roxy.com) to update herself on new ROXY brand products.

[17] ROXY brand clothing was first sold in Canada in 1995. Accessories, beauty products and other consumer goods followed soon after. The ROXY brand is displayed on product packaging, labelling, hang tags or on the wares themselves. ROXY brand products sales in Canada totalled about \$54,000 in the year 1996 and increased gradually to \$9.2 million by the year 2000. Annual sales for the years 2001 to 2005 inclusive averaged about \$22.3 million, increasing to over \$34 million annually in the years 2006 and 2007. Total sales in Canada beginning in 1996 and ending in 2007 have amounted to about \$200 million. I mention in passing that worldwide sales under the ROXY brand since inception to the end of 2007 total about \$2 billion USD.

[18] The remaining portion of Mr. Hild’s affidavit describes the various means by which the ROXY brand is advertised and promoted throughout the world and in Canada. Although the extent of such expenses for Canada is not quantified, I am satisfied that advertising and promotion in Canada of the opponents’ wares and services under their ROXY mark, and sales in Canada under their ROXY mark, made the ROXY mark well known in Canada by about 2002, at least in respect of the opponents’ target demographic. Further, in the absence of cross-examination of Mr. Hild, I find that all of the use, advertising and display of the mark ROXY referred to in his affidavit enures to the benefit of the opponents.

*Robert W. White*

[19] Mr. White identifies himself as Senior Vice President, Canada of the Audit Bureau of Circulations. His evidence serves to provide circulation figures for Canada for various magazines referred to by Mr. Hild in his affidavit.

*Jane Griffith*

[20] Ms. Griffith identifies herself as a professional researcher. Her affidavit serves to introduce into evidence, among other things, (i) several web pages of links to the URL address <http://www.roxypoker.com>, as Exhibit JG-1 and (ii) the results of a WHOIS search pertaining to the aforementioned website, as Exhibit JG-4. The first mentioned exhibit indicates that the website “roxypoker” provides online casino gaming services, that the website is licensed and regulated by the Kahnawake Gaming Commission, based in Mohawk Territory, Canada and that the website has been in operation since February 2002. The second mentioned exhibit does not provide any further information regarding the provider of the above mentioned online gambling service, other than to indicate that as of February 21, 2008 the service provider was located in Vancouver, British Columbia. I note that the business address for the applicant given in the subject application is in Belize City, Belize.

*Mary Noonan*

[21] Ms. Noonan’s affidavit serves to introduce into evidence, by way of exhibits, nine trademark applications and one registration standing in the name of QS Holdings Sarl.

#### LEGAL ONUS AND EVIDENTIAL BURDEN

[22] The legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition. The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant. However, there is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

FIRST GROUND OF OPPOSITION - SECTION 30(E)

[23] The first ground of opposition, based on s.30(e), essentially alleges that the subject application for ROXY POKER should have been based on prior use in Canada rather than on proposed use in Canada. The material date for considering compliance with s.30(e) is the filing date of the application namely, October 22, 2003: see *Canada National Railway Co. v. Schwauss* (1991), 35 C.P.R. (3d) 90 (TMOB). The evidential burden on the opponent with respect to s.30(e) is relatively light as the facts at issue may be exclusively in the possession of the applicant: see *Schwauss*, above, at p. 94-96; *Green Spot Co. v. J.B. Food Industries* (1986), 13 C.P.R. (3d) 206 at p.210-211 (T.M.O.B.).

[24] The opponents rely on Ms. Griffith's affidavit to meet their evidential burden in respect of the first ground. The opponents submit that their evidence of the gaming website "roxypoker," referred to in Ms. Griffith's affidavit, establishes that the applicant was providing online gaming services in Canada as of February 2000, that is, prior to the filing of the application on October 22, 2003. The applicant argues that Ms. Griffith's evidence is insufficient to meet the opponents' evidential burden because the opponents' have failed to establish any connection between the applicant Equinox Entertainment Limited and the entity Kahnawake Gaming Commission referred to in Ms. Griffith's affidavit. The applicant submits, at para. 13 of its written argument, that "It is not enough to meet the opponents' slight [evidential] onus by simply locating a third party website and claiming it is the applicant's without substantiation." I agree with the applicant that the opponents have failed to establish a connection between the applicant and the Kahnawake Gaming Commission or between the website "roxypoker" and the applicant. I therefore find that the opponents have failed to put the first ground of opposition into issue. The first ground is therefore rejected.

[25] I would add that if I am wrong in my assessment of the probative value of Ms. Griffith's affidavit, and that if her evidence is in fact sufficient to satisfy the opponents' relatively light evidential burden, then the opponents would succeed on the first ground of opposition. In such case the application would be refused.

## SECOND GROUND OF OPPOSITION - SECTION 30(I)

[26] No evidence has been filed by the opponents in support of their allegation that the applicant could not have been satisfied that it was entitled to use the trade-mark ROXY POKER in Canada. The opponents have therefore failed to meet their evidential burden to put the second ground into issue. Even if the evidence had shown that the applicant had been aware of the opponents' ROXY trade-mark prior to filing the present application, such a fact is not inconsistent with the statement in the application that the applicant was satisfied that it was entitled to use the trade-mark ROXY POKER on the basis *inter alia* that the applied for mark is not confusing with the opponents' mark. The second ground is therefore rejected.

## MAIN ISSUE

[27] The remaining grounds of opposition turn on the issue of whether the applied for mark ROXY POKER is confusing with the opponents' ROXY mark within the meaning of s.6(2) of the *Act*, shown below:

The 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 . . . or performed by the same person, whether or not the wares or services are of the same general class.

Thus, s.6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether there would there be confusion of gaming services emanating from the applicant as being gaming services provided by the opponents.

## *Material Dates*

[28] The material dates to assess the issue of confusion are (i) the date of decision with respect to the ground of opposition alleging non-registrability, (ii) the filing date of the application (October 22, 2003) with respect to the grounds of opposition alleging non-entitlement, and (iii) the date of opposition (February 22, 2005) with respect to the ground of opposition alleging non-



distinctiveness: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.).

*Section 6(5) Factors*

[29] The legal onus is on the applicant to show that, on a balance of probabilities, there would be no reasonable likelihood of confusion. The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in s.6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

[30] The opponents' mark ROXY possesses a fairly low degree of inherent distinctiveness because it is a shortened form of the female name Roxanne. Similarly, the applied for mark ROXY POKER possesses a fairly low degree of inherent distinctiveness as the second component POKER is descriptive of the applicant's services and therefore does not contribute to the inherent distinctiveness of the mark. The opponents' mark ROXY was well known in Canada at all material dates, at least in respect of the opponents' target demographic. However, as noted by the applicant at para.39 of its written argument, ". . . the Opponents have failed to provide any breakdown of the sales figures in the Hild Affidavit to establish that its mark has a reputation beyond sport apparel." Of course, there is no evidence to indicate that the applied for mark ROXY POKER acquired any reputation at any material time.

[31] The length of time that the marks in issue have been in use in Canada favours the opponents as the opponents' use of their mark ROXY commenced in 1995. There is no evidence that the applicant commenced use of its mark at any time after filing the application.

[32] The nature of the parties' wares and services are quite different as the applicant's services are online gambling while the opponents offer casual clothing wares as well as other wares and entertainment services connected to board sports. Further, the casual clothing offered by the opponents have been marketed in such a way as to associate the wares with a "boarding lifestyle," that is, with an adventurous outdoor lifestyle. The parties' channels of trade overlap to the extent that the opponents' wares and services are available online. However, there is no evidence to indicate that the opponents' target demographic would form a significant or even a meaningful portion of the demographic accessing online casino gambling. The marks ROXY and ROXY POKER are essentially identical for the purposes of assessing the likelihood of confusion. In this regard, the component POKER is descriptive of the applicant's services and therefore does little to differentiate the parties' marks.

### *Jurisprudence*

[33] The applicant has brought to my attention, among other cases, the Supreme Court of Canada decision in *Veuve Clicquot Ponsardian v. Boutique Clicquot* (2006), 49 C.P.R.(4th) 401. In that case, the plaintiff brought an infringement action attaching to its mark VEUVE CLICQUOT, used in association with champagne, against the defendant who was using the mark CLIQUOT in association with a women's clothing business. The Court accepted that the plaintiff's mark was famous and distinctive but nevertheless found that there was no risk of confusion with the defendant's mark. Part of the Court's reasoning, at p. 418, is shown below:

[31] Luxury champagne and mid-priced women's wear are as different as chalk and cheese but the intervener argues that

...while the existence of a connection between the parties' wares and services can be an important consideration in the case of a weak senior mark, its importance diminishes as the strength of the mark increases, and in the case of a famous mark it has little bearing on the question of confusion. [INTA factum, at para. 29.]

[32] This proposition, with respect, is an oversimplification. Famous marks do not come in one size. Some trade-marks may be well known but have very specific associations (Buckley's cough mixture is advertised as effective despite its terrible taste, not, one would think, a brand image desirable for restaurants). Other famous marks, like Walt Disney, may indeed have largely

transcended product line differences.

The applicant in the instant case relies on *Veuve Clicquot*, above, to argue as follows at paragraph 39 of its written argument:

The Opponents seem to be suggesting that they possess a famous trade-mark which thus trumps all other considerations. Even if their mark was considered famous, which is denied, the Supreme Court of Canada in the *Veuve Clicquot* decision clearly held that fame was only one of the “surrounding circumstances” to be considered. Just as was the case with VEUVE CLICQUOT luxury champagne and CLIQUOT mid-priced women’s wear, so to[sic] the Applicant’s on-line casino services and the Opponents’ surfing, snowboarding, and other board-related extreme sport apparel “are as different as chalk and cheese.” Further, even if the Opponents’ mark is deemed famous, it is not the type of mark which has been shown to cross several product lines . . .

[34] I am in general agreement with the applicant’s above submission. While I have inferred from the evidence of record that the opponents have established that their mark ROXY is well known in Canada, nevertheless the mark has very specific associations (clothing and extreme sports) and appears to be well known to a restricted demographic (females between 15 - 25 years old). Further, the opponents have not established the extent to which their target demographic is likely to participate in online casino services. I am therefore unable to find that the opponents’ mark ROXY transcends the product line differences in the instant case.

#### DISPOSITION

[35] In view of the above, and taking into account in particular that the opponents’ have not established that their mark ROXY transcends product line differences and that the parties’ wares and services are very different, I find that the applicant has met the onus on it to show, on a balance of probabilities, that at all material times there is no reasonable likelihood of confusion between the applied for mark ROXY POKER and the opponents’ mark ROXY.

[36] Accordingly, the opposition is rejected. This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

[37] I would add that if the opponents had established that their target demographic participates to a meaningful extent in online casino gambling, then the opponents' case would have been considerably strengthened and the disposition of this proceeding might have favoured the opponents.

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Myer Herzig  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office