

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

**Citation: 2017 TMOB 145**

**Date of Decision: 2017-10-27**

**IN THE MATTER OF AN OPPOSITION**

**Hockey Canada**

**Opponent**

**And**

**Canadian Adult Recreational Hockey  
Association, a legal entity**

**Applicant**

**1,678,548 for HOCKEY PROPERTY  
OF and Canadian Flag Design**

**Application**

**BACKGROUND**

[1] Hockey Canada (the Opponent) is a not-for-profit organization and national governing body for ice hockey and sledge hockey in Canada. It has opposed the registration of application No. 1,678,548 for the trade-mark HOCKEY PROPERTY OF and Canadian Flag Design (the Mark, shown below) which has been applied for by the Canadian Adult Recreational Hockey Association, a Canadian adult recreational hockey club. For the reasons that follow, the application is refused.



## THE RECORD

[2] The Applicant filed application No. 1,678,548 for the Mark on May 27, 2014, based on proposed use in association with the following goods and services:

GOODS: (1) Sweaters, t-shirts, jackets, wind-resistant and water repellent jackets, sweatshirts, training suits, rink officials' suits, underwear, shorts, rugby shirts, tank tops, hockey jerseys, pants, cummerbunds, suspenders, shoelaces, scarves, headbands, hats, caps, bath robes, coats, fleece clothing, namely jackets, sweatshirts, sweatsuits, headbands, vests and gloves, authentic and replica home and away uniforms, practice jerseys, polo shirts, sports shirts, sweatsuits, sweat pants, warm-up suits, mittens, gloves, neckwear, namely, lanyards, magazines, hockey cards, calendars, lithographs, tickets and passes for hockey games and sporting events, stickers, decals, game programs, books, manuals, photographs, printed materials for use in teaching and coaching sports, namely participants' and instructors' manuals, newsletters, pamphlets, recruitment posters, and information brochures; posters, binders, catalogues, pens, pre-recorded video tapes; lapel pins, medals, watches, medallions, souvenir coins, piggy banks, collectable dolls, music and trinket boxes, whistles, toy figures, ceramic collector plates, items made from lead crystal, namely trophies, drinking mugs, drinking glasses and plaques, skate holders, mousepads, paper tissues, radios, towels, golf bags, golf tees, golf balls, golf umbrellas, golf putter covers, head covers for golf clubs, golf towels, golf ball markers, fridge magnets, temporary tattoos, drink coasters, envelope openers, license plates, lamps, stained glass impressions, key rings, first aid kits packaged in a fanny pack, rugs, throws, pillows, compact refrigerators, photo frames, clocks, folding camp armchairs, sports bags, duffle bags, briefcases, suitcases, briefcase type portfolios, stationery type portfolios, umbrellas, backpacks, cellular telephone accessories, namely carrying cases, luggage, luggage tags, passport cases, recreation wallets, desk top organizers, desk calendars, desk stands and holders for pens, pencils and ink, stationery, namely, paper, envelopes and pads, handbags; hockey pucks, hockey sticks, sport helmets, goaltender masks, hockey gloves, mini hockey sticks, hockey stick carrier and shoulder strap; hockey stick gauges, trophies, engraved plates; banners, pennants; ornamental novelty buttons, badges, crests, statues, flags, emblems; coffee mugs, beer mugs, empty water bottles, bottleholders, can coolers, advertising inflatables, computer software, namely, a program for scheduling a hockey league.

SERVICES: (1) Promoting and fostering amateur athletics throughout Canada, through participation in recreational hockey for the benefit of third party amateur hockey players,

promoting and encouraging increased recreational activity and physical fitness among Canadians through participation in recreational hockey, promoting and encouraging strong and lasting fellowship among participants, co-ordinating and conducting hockey competition for participants in various series of competitions established from time to time at the provincial, regional, national or international level, promoting and encouraging the affiliation of oldtimers/recreational teams, leagues and associations with the Canadian Adult Recreational Hockey Association, for the benefit of third party amateur hockey players, making grants out of the funds of the association for patriotic, educational or charitable purposes, establishing a set of uniform rules for playing oldtimers/recreational hockey throughout Canada, co-operating with international organizations in the promotion of international competition for the benefit of third party amateur hockey players, fostering, developing, promoting and regulating the playing of oldtimers/recreational hockey throughout Canada for the benefit of third party amateur hockey players, co-operating with international organizations in the promotion of international competition for the benefit of third party amateur hockey players.

[3] The Mark was advertised for opposition purposes in the *Trade-marks Journal* on May 13, 2015, and on July 10, 2015, the Opponent opposed it under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The Opponent is the owner of a large number of registered marks and official marks that include either the word HOCKEY (or an image representing the sport of HOCKEY) and the word CANADA (or an 11 point maple leaf image representing CANADA), set out in the attached Schedule A.

[4] The grounds of opposition, as revised September 21, 2015, can be summarized as follows:

- i. The application does not comply with section 30(e) of the Act because at the date of filing the Applicant did not intend to use the Mark in association with the applied for goods and services;
- ii. The Mark is not registrable pursuant to section 12(1)(b) because it is clearly descriptive or deceptively misdescriptive of the character or quality of some or all of the Applicant's goods and services;
- iii. The Mark is not registrable pursuant to section 12(1)(d) as it is confusing with the Opponent's registered trade-marks;

- iv. The Mark is not registrable pursuant to section 12(1)(e) as its registration is prohibited by section 9 of the Act;
- v. The Applicant is not the person entitled to the Mark in view of section 16(3) of the Act since at the date of filing it was confusing with the Opponent's trade-marks and the Opponent's trade-name HOCKEY CANADA which had been previously used in Canada by the Opponent; and
- vi. The Mark is not distinctive in that it is not adapted to distinguish and does not actually distinguish the Applicant's goods and services from the Opponent's goods and services having regard to the use and advertisement by the Opponent of the Opponent's trade-marks and trade-name.

[5] The Applicant served and filed a counter statement on November 18, 2015, in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[6] In support of its opposition, the Opponent filed the affidavit of Mr. Dale Ptyscia, Manager of Licensing of the Opponent. The Applicant filed the affidavit of Lori Lopez, Director, Business Operations of the Applicant and Alan Booth, Self-Employed Searcher. The Opponent did not file any evidence in reply and none of the affiants were cross-examined.

[7] Both parties filed a written argument and were represented at a hearing.

#### 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:

- 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)];
- section 38(2)(b)/12(1)(e) – the date of my decision [see *Canadian Council of Professional Engineers v Groupegénie Inc* (2009), 78 CPR (4th) 126 (TMOB) and *Canadian Olympic Assn v Olympus Optical Co* (1991), 38 CPR (3d) 1 (FCA)];
- section 38(2)(c)/16(3)(a) and (c) – the date of filing the application; and
- 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)].

#### GROUND OF OPPOSITION

##### **Non-compliance with section 30(e) of the Act**

[10] There is no evidence of record to suggest that the Applicant lacked the intention to use the Mark at the time of filing the application. As the Opponent has thus failed to meet its evidential burden, I dismiss the ground of opposition based on non-compliance with section 30(e) of the Act.

##### **Likelihood of Confusion – Mark is not registrable pursuant to section 12(1)(d)**

[11] One of the key issues in this proceeding is the likelihood of confusion between the Mark and any of the trade-marks which form the Opponent’s alleged family of marks. I choose to begin my analysis of the likelihood of confusion between the Mark and one or more of the Opponent’s registered trade-marks under the section 12(1)(d) ground of opposition.

[12] As previously noted, the Opponent’s registered trade-marks include the marks set out in Schedule A, registered in association with hockey related goods and services: TEAM CANADA

HOCKEY, CANADA and Hockey Player in Maple Leaf Design (black background), CANADA and Hockey Player in Maple Leaf Design (white background), TEAM CANADA 2008 Jersey Design, CANADA and Hockey Stick design, WORLD JUNIOR 1982 HERITAGE JERSEY Design, TEAM CANADA 1996 HERITAGE JERSEY Design and TEAM CANADA 1998 HERITAGE JERSEY Design.

[13] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if one of the registrations relied upon are 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 registrations 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 note that the registrations for the Opponent's trade-marks remain extant. Thus the Opponent has met its evidential burden. I must now assess whether the Applicant has met its legal onus.

[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] The Applicant submits that due to the descriptive nature of the Opponent's trade-marks which are used in respect of Canadian hockey related goods and services, each of the Opponent's marks lack inherent distinctiveness. I agree that none of the Opponent's marks are inherently strong.

[17] The Mark also includes the word hockey (which is also descriptive of its goods and services) and a design which is clearly recognizable as a Canadian flag. However, in view that the Mark also includes components that are not descriptive of the associated goods and services, I consider it to be slightly inherently stronger than each of the Opponent's marks.

[18] The extent to which a trade-mark has become known can increase the scope of protection to be afforded to it, even to inherently weak marks [*Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238, (FCTD) at 240; Gill: *Fox on Canadian Law of Trade-marks and Unfair Competition*, at 8.2(c)]. In this case, the strength of certain of the Opponent's marks has been increased by means of them becoming well known in Canada through promotion and use. Some of the most pertinent evidence of the acquired distinctiveness of the Opponent's trade-marks includes the following:

- Since as early as 1981, some or all of the Opponent's family of marks have been used nationwide in association with the goods and services by the Opponent who is the national governing body for ice hockey. The Opponent works with thirteen provincial member branches and affiliated organizations in respect of ice hockey at all levels, and these member branches use some or all of the Opponent's family of marks under licence [Ptycia, para. 12; Exh. E];
- The Opponent offers membership and registration services to all Canadian hockey players, parents, coaches, officials, referees and trainers. The number of Canadians who have registered with the Opponent and its member branches has ranged between 552,914 in 2005-2006 to 639,510 in 2014-2015 [Ptycia, para. 15];

- Since at least as early as 1988, the Opponent has used some or all of its family of marks in association with co-ordinating adult recreational hockey leagues and providing registration for Canadians across the country. The number of registrations for such adult recreational programs has ranged between 9,975 in 2009-2010 to 107,603 in 2014-2015 [Ptycia, para. 18];
- Some or all of the Opponent's family of marks is displayed through a variety of print, signage, online, video, news, media and social media advertising across Canada and around the world [Ptycia, para. 21, 22-35; Exhibits G-P];
- The approximate number of worldwide page views of the Opponent's website has ranged between 16.3 million and 25.9 million between 2009-2010 and 2014-2015 [Ptycia, para. 22]; 83% of the 356,964 views of videos available on the Opponent's website in 2014-2015 are attributable to views in Canada [Ptycia, para. 31];
- Since at least as early as 1981, some or all of the Opponent's family of marks has been featured in association with the Opponent's provision of awards, grants, and scholarships to Canadians that have made significant contributions to the sport of hockey in Canada [Ptycia, para. 43; Exhibits W & X];
- The Opponent has distributed and/or sold goods displaying some or all of the Opponent's family of marks to Canadians through its website and through more than 45 licensees across Canada sold at approximately 2200 retailer locations [Ptycia, para. 55].

[19] In its written argument, the Applicant submits that the Opponent's evidence did not provide information regarding the manner and extent of use of each of its marks on a per mark basis. At the oral hearing, the Opponent pointed to specific examples in the evidence described above where the Opponent submits use had been shown of at least four of the Opponent's registered marks, including TEAM CANADA HOCKEY (TMA828,220), CANADA and Hockey Player in Maple Leaf Design (white background)(TMA 461,663); CANADA and Hockey Player in Maple Leaf Design (black background) and CANADA and Hockey Stick Design (TMA284,534) as well as the Opponent's HOCKEY CANADA official mark (Serial No. 906,441) in association with various hockey related goods and services.



[20] For example, the Opponent submitted that attached as Exhibit DD to Mr. Ptycia's affidavit are representative sample images of jerseys, uniforms, sweaters, jackets, caps and other clothing featuring the Opponent's CANADA and Hockey Player Design marks that were sold in various years between July 1996 and January 2015. Representative images of novelty items such as mugs and water bottles also featuring these marks sold between 1998 and 2014, and collectible items sold since 2014 were attached to the Ptycia affidavit as Exhibits GG and II respectively.

[21] Although the Opponent did not provide evidence of sales figures or invoices of any of its goods sold in association with these marks, the Opponent submitted that the copies of its annual reports included in its evidence corroborate its submissions that sales of the Opponent's goods in association with its marks have occurred. For example, p. 35 of the 2011 annual report states the following: "officially licensed Team Canada product currently commands in excess of 11 percent of the Canadian retail sport-licensed market share" [Ptycia, Exh. S]. Further, on page 35 of the 2012 annual report, it states that the estimated licensed merchandise sales figure for 2011 for sports in Canada and the United States is \$12.79 billion dollars. The Opponent further explained that it could not provide specifics about its sales in view of the vast number of retailers of the Opponent's products and the fact that it is a not for profit company. The Opponent therefore submits that based on its evidence as a whole, the extent of the use of these marks cannot be disputed.

[22] I respectfully disagree with the Opponent that the extent of the use of its marks in association with its registered goods cannot be disputed based on its evidence as a whole. In the absence of quantitative evidence such as sales figures or invoices, I am unable to find there is significant use of any of the Opponent's registered trade-marks in association with the registered goods.

[23] I do, however, find the Opponent's evidence sufficient to establish that at least two of the Opponent's registered marks (i.e. TMA461,664 and TMA461,663) have become well known in Canada in association with the Opponent's services including, *inter alia*, the organization and operation of Canadian national sports teams which participate in international and other hockey games, tournaments and series; planning and arranging international and other hockey games

tournament and series; advancing the participation in and awareness of ice hockey, raising funds to support programs for the advancement of the sport of ice hockey; providing public education programs in relation to ice hockey; raising awareness, namely advertising the sport of hockey generally; and providing access to resources and materials that would be helpful to coaches, administrators, teams, players, fans and the public regarding the sport of hockey. While a large majority of the Opponent's evidence comprises screen shots of various pages from the Opponent's website, I confirm that these screen shots display these registered marks of the Opponent in association with advertising the above services on the Opponent's website, through the Opponent's social media accounts, through videos on the Opponent's YouTube channel, and also reference the Opponent's services in news releases (Ptycia, Exhibits G-K, M, P). As noted above, the approx. number of worldwide page views of the Opponent's website per year has been between 16.3 and 25.9 million between 2009 and 2015 (Ptycia, para. 22). Further, at para. 27 of his affidavit, Mr. Ptycia states that in the 2013-2014 season, an estimated 2.2 billion interactions were made across all of the Opponent's Twitter and Facebook accounts, by 1,500,602 unique users and approximately 511,138,412 impressions were made. In view of the nature of the Opponent's services, I consider it reasonable to infer that a significant number of the website and social media views were Canadian.

[24] I also confirm that these registered marks of the Opponent appear throughout the annual reports for the years 2010-2015 which are provided to the public through the Opponent's website and are also distributed to various Canadian stakeholders, including the Opponent's provincial, regional or territorial branch members (Ptycia, Exh. S). The Opponent's annual report describes who the Opponent is as well as the services the Opponent offers.

[25] The application, on the other hand, is based on proposed use. While there is some evidence that the Mark has been used to some extent in Canada in association with various clothing goods, the evidence is not sufficient to conclude that such use was to any meaningful extent.

[26] Overall, this factor therefore favours the Opponent.

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

[27] In view of the above, it follows that the length of time the marks have been in use also favours the Opponent.

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

[28] When considering the goods, services and trades of the parties, it is the statement of goods or services in the parties' trade-mark application and registrations that govern in respect of the issue of confusion arising under section 12(1)(d) [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[29] The Opponent's marks are registered in association with a wide variety of hockey related goods and services, most of which are covered by registration Nos. TMA461,663 and TMA461,6644 which are registered in association with the following:

Goods: Magazines, hockey cards, calendars, lithographs, tickets and passes for games and events, stickers, decals, game, programs, books, manuals, printed materials for use in teaching and coaching sports, namely participants' and instructors' manuals, newsletters, pamphlets, recruitment posters and information brochures; posters, binders, catalogues, pens; lapel pins, medals, watches, medallions, coins, cuff links; caps, T-shirts, sweatshirts, sweaters, golf shirts, baseball shirts, jackets, track suits, training suits, rink suits, underwear, headbands, shorts, rugby shirts, tank tops, hockey jerseys, pants, hockey pants, socks, cardigans, turtleneck sweaters, ties, cummerbunds, suspenders, scarves, bath robes; sport bags, duffle bags, briefcases, suitcases, portfolios, umbrellas; hockey pucks, helmets, hockey gloves, golf balls, mini hockey sticks; hockey stick gauges, videotapes; trophies, engraved plates, key chains; banners, pennants, towels; buttons, badges, crests; ash trays; coffee mugs, beer mugs, water bottles.

Services: Organization and operation of Canadian national sport teams which participate in international and other hockey games, tournaments and series; planning and arranging international and other hockey games, tournaments and series; advancing the participation in, and awareness of, ice hockey, roller hockey and adaptive forms of hockey; raising funds to support programs for the advancement of the sports of ice hockey, roller hockey and adaptive forms of hockey; providing public education programs in relation to ice hockey, roller hockey and adaptive forms of hockey; raising awareness, namely advertising, the sport of hockey generally; providing access to

resources and materials that would be helpful to coaches, administrators, teams, players, fans and the public regarding the sport of hockey.

[30] The Applicant's goods also include similar clothing items, novelty items, and various printed materials. I therefore find that many of the applied for goods are either identical or related to the registered goods of the Opponent set out above.

[31] The Applicant's services include, *inter alia*, promoting and fostering amateur athletics throughout Canada, as well as co-ordinating and conducting hockey competition for participants at the provincial, regional, national or international level, and promoting and encouraging the affiliation of old-timers/recreational teams, leagues and associations with the Canadian Adult Recreational Hockey Association. The Applicant submits that there is a difference between the parties' services because the Opponent's activities are focused on international hockey competitions while the Applicant's activities are focused on domestic hockey leagues.

[32] The Opponent, on the other hand, submits that the evidence shows otherwise. I agree. The evidence shows that in addition to using its marks in association with international hockey competitions, the Opponent also uses its marks in association with adult recreational hockey leagues for Canadians. Page 23 of the 2011 Annual Report attached as Exhibit S to the Ptycia affidavit, for example, states that the Opponent's adult recreation program has more than 250 teams from across Canada. Further, Mr. Ptycia states at paragraph 18 of his affidavit that the number of registrations for adult recreational hockey programs has grown from 9,975 in 2009-2010 to 107,603 in 2014-2015.

[33] I therefore find that there is clear overlap between the parties' services.

[34] With respect to the parties' channels of trade, the Opponent submits, and I agree, that the Opponent's goods and services are likely to be offered to the identical consumers as those of the Applicant. In this regard, the Opponent's goods and services are offered and marketed to hockey players at all levels (including adult recreational hockey leagues and players) in Canada, parents, coaches, referees, officials and trainers in Canada as well as the general public [Ptycia, paras.14 - 18]. Further, the Opponent's evidence shows that its goods and services are marketed directly to the purchasing public through the Opponent's website, and at various locations across Canada including rinks and the Opponent's events and games across Canada. Likewise, Ms. Lopez has

attested that the Applicant's consumers include adult recreational and old timers hockey markets in Canada and its goods and services are marketed to leagues, tournaments, teams, players and referees. The Applicant also promotes or plans to promote the Mark through the Applicant's website and at hockey tournaments in Canada.

[35] This factor therefore also favours the Opponent.

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

[36] When considering the degree of resemblance between the marks, the law is clear that the marks must be considered in their totality; it is not correct to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC) at para 20]. In *Masterpiece, supra*, the Supreme Court further advises 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.

[37] There is a fair degree of resemblance in sound between the Mark and the Opponent's registered marks TEAM CANADA HOCKEY (TMA828,220), CANADA and Hockey Player in Maple Leaf Design (black background) (TMA461,664); and CANADA and Hockey Player in Maple Leaf Design (white background)(TMA 461,663). In this regard, the Mark would be sounded as HOCKEY PROPERTY OF CANADA while the Opponent's registered marks TMA461,663 and TMA461,664 would likely be sounded as HOCKEY CANADA and registration No. TMA828,220 as TEAM CANADA HOCKEY. There is not as much resemblance in sound between the Mark and the other registered marks of the Opponent.

[38] The Opponent submits that there is a high degree of resemblance in appearance and ideas suggested between the Mark and the Opponent's registered marks because all include either the word HOCKEY (or an image representing the sport of HOCKEY) and the word CANADA (or an 11 point maple leaf image representing CANADA). However, when I apply the approach to compare marks suggested in the *Masterpiece* decision, the dominant feature of the Mark is the phrase "PROPERTY OF". I therefore do not find that there is a high degree of resemblance

between the marks in appearance. Further, I find that the ideas suggested by the marks are different in that the Mark suggests that hockey belongs in Canada whereas each of the Opponent's marks suggest the idea of hockey related goods and services based in Canada.

### Surrounding Circumstances

#### *Family of Marks*

[39] The Opponent has relied on its family of trade-marks as a further surrounding circumstance. In order to rely on a family of trade-marks an opponent must prove use of each mark of the alleged family [*McDonald's Corp v Alberto-Culver Co* (1995), 61 CPR (3d) 382 (TMOB)]. In addition, the presumption of the existence of a family is rebutted where there is evidence that the alleged family's common feature is registered or used by others [*Thomas J. Lipton Inc v Fletcher's Fine Foods Ltd* (1992), 44 CPR (3d) 279 (TMOB) at 286 -7].


[40] As noted above, I am satisfied that the Opponent has evidenced at least some use of certain of its trade-marks in association with its registered services including CANADA and Hockey Player in Maple Leaf Design (black background) (TMA461,664); CANADA and Hockey Player in Maple Leaf Design (white background) (TMA 461,663). I am also satisfied that the Opponent has shown considerable use of its official mark HOCKEY CANADA (Serial No.0906441) as this mark appears in association with many of the Opponent's services throughout the Opponent's evidence. I am therefore satisfied that the Opponent has shown use of a small family of trade-marks including the word or the image of hockey and the word or image of Canada. In my view, the use of this family of marks increases the likelihood of consumers assuming that the Mark is simply another mark of the Opponent [*McDonald's Corp v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101 (FCTD); *Air Miles International Trading B.V. v SeaMiles LLC* (2009), 76 CPR (4th) 369 (TMOB) at para. 46].









*State of the Register*

[41] There are two issues raised by the state of the register evidence. The first is whether the evidence establishes that Canadian consumers are used to seeing and distinguishing between various marks which include the word or the image of hockey and the word or image of Canada for hockey related goods and services. The second issue is whether the presumption of the existence of the Opponent’s family of marks is rebutted in view of the Applicant’s state of the register evidence that the family’s common features (i.e. the word/image HOCKEY and the word/image CANADA) have been registered by many others in association with similar goods or services.

[42] The Booth affidavit introduces into evidence as Exhibit 1 full particulars from the Canadian Trade-mark Database. Mr. Booth’s search identifies 24 registered or official marks which contain the words HOCKEY and CANADA or the descriptive maple leaf graphic.

[43] The Opponent submits that Mr. Booth’s results include irrelevant marks which are unrelated to the field of hockey, as well as marks comprised of design elements which are arguably distinct from the marks at issue in the present case. I have summarized some of the submissions identified by the Opponent in both its written argument and at the hearing below:

<b>Trade-mark/Official Mark</b>	<b>Registration/ Serial No.</b>	<b>Opponent’s submissions</b>
	910189	This registration comprises the trade-mark IIHF as well as the words ICE HOCKEY WOMEN’S WORLD CHAMPIONSHIP and Ottawa. The addition of these words, as well as a distinctive design element, points to the IIHF as the specific source of the associated goods and services.
	878862	Same submission as above.

	878863	Same submission as above.
CANADA'S HOCKEY BANK	839424	This registration is for unrelated services, namely banking services.
HOCKEY NIGHT IN CANADA	227771	This registration is for unrelated services, namely radio and tv program services.
	227772	Same submission as above.
	6611622	This registration includes a fanciful globe design along with letters or numerals representing a human being or a part of the human body and the words CHAMPIONNATS MONDIAUX DE HOCKEY PEE-WEE going around the globe design rendering this mark distinct from the marks at issue.
	904458	This registration also points to the IIHF as the specific source of the associated goods and services.
		This registration includes the number 95 and the words "WORLD JUNIOR HOCKEY CHAMPIONSHIP ALBERTA CANADA" and a fanciful maple leaf design which renders the mark distinct from the marks at issue.
	563660	This registration includes the stylized words repeated by mirror effect "hockey net in Canada" which is visually and phonetically different from the marks at issue in the present case.
	474330	This registration includes the Canadian Tire trade-mark which renders the marks distinct and a clear indicator of source. The word "store" is also included which conveys a very different meaning than the marks at issue in the present case.
	471518	Same submissions as above.



[44] The Opponent also submitted that registration No. TMA671,106 for HOCKEY COLLECTION CANADA, also relied upon by the Applicant, has now been expunged. However, the Opponent did not provide any evidence to that effect. I therefore cannot have regard to this submission.

[45] Otherwise, I agree with the Opponent that all of the above marks are distinguishable from the marks at issue. This leaves about 5 registered trade-marks and 7 official marks that include both the components HOCKEY and CANADA or HOCKEY and a representation of the Canadian flag as their dominant components which are for related goods or services.

[46] It is well known that state of the register evidence is only useful insofar as one can draw inferences from it about the state of the market place [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB)]. Also, inferences about the state of the market place can only be made when there exists a large number of registrations [*Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)]. In this case 5 registrations and 7 official marks are not enough for me to infer that at least some are actually in use in the market place and, as such, the state of the register evidence is not a surrounding circumstance which assists the Applicant in demonstrating that consumers are able to distinguish between the Mark and the Opponent's registered trade-marks.

[47] Furthermore, as the Applicant has not shown that the word HOCKEY (or an image representing the sport of HOCKEY) and the word CANADA (or an 11 point maple leaf image representing CANADA) are common dominant elements for trade-marks covering hockey related goods and services, the Applicant's state of the register evidence is also insufficient to rebut the Opponent's evidence about the use of its family of marks [*Techniquip Limited v Canadian Olympic Association*, 1998 CanLII 7573 (FC)].

[48] This evidence therefore does not support the Applicant's case.

*Alleged use of PROPERTY OF TEAM CANADA HOCKEY mark by the Opponent*

[49] As a further surrounding circumstance, the Opponent has pointed to Exhibit CC of the Ptycia affidavit which shows representative sample images of t-shirts designed by an authorized licensee of the Opponent and dated December 28, 2005. Several of these t-shirts display the words PROPERTY OF above the Opponent's hockey player in maple leaf design mark under which appears the words TEAM CANADA HOCKEY. These t-shirts were distributed by the Opponent's licensee through various retail channels including major national sportswear chains such as Sport Check and via Hockey Canada's online retail storefront on its website. The Opponent submits in its written argument at paragraph 67 that this evidence shows the display of a PROPERTY OF TEAM CANADA HOCKEY mark on clothing goods by the Opponent.

[50] The Applicant objected to this evidence on the basis that this mark was not pleaded in the statement of opposition and thus does not form the basis for any grounds of opposition. While I agree with the Applicant that a trade-mark not pleaded cannot be relied upon as a ground of opposition, it has previously been held that it can still be relied upon as a surrounding circumstance [see *Mondo Foods Co Ltd v Saverio Coppola*, 2011 TMOB 228].

[51] At the oral hearing, the Opponent submitted that it did not register this trade-mark because it considered it to be clearly descriptive of the Opponent's goods and services. The Opponent further submits that its use of this mark which is almost identical to the applied for mark and displayed in association with highly similar goods and services further supports a finding that the average consumer may reasonably infer that the goods and services sold in association with the Mark are somehow associated with the Opponent.

[52] I agree with the Opponent. I therefore consider this to be a relevant surrounding circumstance.

Conclusion

[53] It is well established that marks which contain descriptive words are not inherently distinctive and are therefore only afforded a minimal degree of protection by the Court. However, as noted above, it has also been held that acquired distinctiveness through use and

promotion can increase the scope of protection to be afforded, even for inherently weak trade-marks [*Sarah Coventry Inc v Abrahamian* (1984), *supra*].

[54] Also as noted above, section 6(2) of the Act is not concerned with confusion of the trade-marks themselves, but confusion of goods or services from one source as being from another source. In this case, the question posed is whether a consumer with an imperfect recollection of any of the Opponent's trade-marks who sees the Mark in association with the Applicant's goods and services would, as a matter of first impression, think that the goods and services emanate from or are sponsored or approved by the Opponent. The onus or legal burden is on the Applicant to show no reasonable likelihood of confusion between any of the Opponent's marks and its Mark on a balance of probabilities. That means that if the probabilities favour neither side, I must resolve the issue against the Applicant.

[55] Although my conclusions above discuss the Opponent's registered marks collectively, in view of the resemblance in particular between the Mark and the Opponent's marks CANADA and Hockey Player in Maple Leaf Design (white background) (TMA461,663) and CANADA and Hockey Player in Maple Leaf Design (black background) (TMA461,664) when sounded, the extensive reputation of these particular marks for identical or highly similar services, and the existence of the Opponent's family of marks, I find that the probabilities are evenly balanced. The Applicant has therefore failed to show on a balance of probabilities that there would be no reasonable likelihood of confusion between its Mark and either of these marks. I conclude that a consumer, who has an imperfect recollection of either of these trade-marks of the Opponent, might reasonably infer that goods and services sold in association with the Mark share the same source as or are otherwise associated with the Opponent.

[56] This ground of opposition is therefore successful.

## SECTION 2 GROUND OF OPPOSITION

[57] In order to meet its evidentiary burden under this ground of opposition, the Opponent has to show that as of the filing of the statement of opposition one or more of the Opponent's trade-marks or the Opponent's trade-name had become sufficiently known to negate the distinctiveness of the Mark and their reputation in Canada is substantial, significant, or sufficient [*Bojangles'*

*International LLC v Bojangles Café Ltd* 2006 FC 657 at para 34]. I am satisfied from the evidence furnished in this case that the Opponent has met its burden, at least with respect to those marks which comprise its family of marks as described above. The Applicant is accordingly required to show that its Mark is adapted to distinguish or actually distinguishes its goods and services from the goods and services of the Opponent [*Muffin Houses Inc v Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[58] The Applicant's position is no stronger as of the filing date of the statement of opposition than it is as of today's date. Accordingly, I reach the same conclusion regarding the likelihood of confusion as under the section 12(1)(d) ground of opposition and this ground of opposition is also successful.

#### REMAINING GROUNDS OF OPPOSITION

[59] As I have already refused the application under two grounds, I will not address the remaining grounds of opposition.

#### DISPOSITION



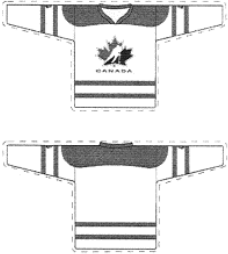

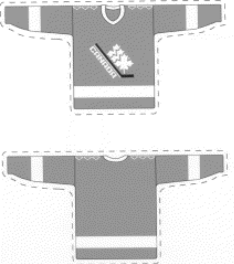
[60] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.




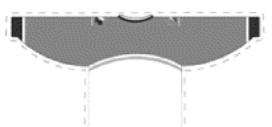
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Cindy R. Folz  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

SCHEDULE A




**Opponent's Registered Marks**

Mark	Registration No.
TEAM CANADA HOCKEY	TMA828220
	TMA461664
	TMA461663
	TMA787358
	TMA284534
	TMA691935

 	<p>TMA691925</p>
 	<p>TMA706620</p>

SCHEDULE B

**Opponent's Official Marks**

Mark	Serial No.
	903983
HOCKEY CANADA	906441
TEAM CANADA HOCKEY	918378
	913980
	913981

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE** 2017-08-23

**APPEARANCES**

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