



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

Citation: 2018 TMOB 153

Date of Decision: 2018-11-30

IN THE MATTER OF AN OPPOSITION

Icon Health & Fitness, Inc.

Opponent

and

Sports Distributors of Canada Limited

Applicant

1,684,894 for

Application

PRO-FORMANCE ADVANTAGE

INTRODUCTION

[1] Sports Distributors of Canada Limited (the Applicant) has applied to register the trade-mark PRO-FORMANCE ADVANTAGE (the Mark) in association with the following goods and services based on its use of the Mark in Canada since 2005:

Goods:

Sporting goods of all kinds and clothing, namely shoes, laces, sport bags, tennis rackets, badminton rackets, racquetball rackets, squash rackets, pickleball racquets, racquet bags, racquet grip tapes, racquet strings, racquet balls, racquet shuttles, head bands, wrist bands, bumper guards and bumper tapes for racquets, racquet covers, elliptical machines, treadmills, and weight lifting machines, rowers, stair climbers, exercise bicycles, weights, weight benches, weight belts, weight gloves, ankle weights, wrist weights, orthopedic braces, tummy toners, sauna suits, soccer balls, basketballs, volleyballs, nets for ball games, nets for sports, pumps for pumping sport balls, repair kits for soccer balls,

footballs, basketballs, lacrosse stick net and baseball gloves; backboards for basketball, golf balls, golf gloves, golf clubs, golf bags, golf shoes, golf carts, golf shirts, golf pants, golf tees, alpine skis, alpine ski boots, ski poles, ski goggles, ski goggle bags, snowboards, cross-country skis, cross-country boots, cross-country ski poles, jackets, shirts, pants, socks, gloves, winter toques, caps, headbands, underwear, sweaters, T-shirts, sweat tops, sweat bottoms, sports bags, sweat bands, rainjackets, raincoats, rainpants, training suits, sunglasses, pens, pencils, key chains, souvenir hockey sticks, cups, mugs, briefcases, fanny packs, knap sacks, kneepads, baseball gloves, baseball bats, baseball balls, baseball hats, baseball shirts, baseball shoes, baseball uniforms, water bottles, bags specially adapted for sports equipment, baseball bases, whistles, bicycle tire pumps, bicycle seat bags, pannier bags, bicycle lights, bicycle repair kits, tricycles, bicycle gloves, bicycle parts, sports helmets, skates, hockey uniforms, hockey sticks, ice skates, insoles, hockey helmets, hockey faceguards, hockey underwear, shin pads, shoulder pads, elbow pads, hockey pants, pucks, hockey tape.

Services:

Operation of a retail sporting goods store.

[2] Icon Health & Fitness, Inc. (the Opponent) opposes the application on several grounds, including on the basis that the Mark is confusing with its use and registration of the trade-mark PRO FORM in association with exercising apparatus, namely rowing machines and multiple purpose exercising machines (the Opponent's Goods). The Opponent also challenges the date of first use claimed in the application.

[3] For the reasons that follow, the application is refused.

THE RECORD

[4] On July 11, 2014, the Applicant filed the application for the Mark. It was advertised for opposition purposes in the *Trade-marks Journal* on October 21, 2015. On February 5, 2016, the Opponent opposed the application. The Applicant filed a counter statement denying each of the allegations in the statement of opposition. The Opponent was subsequently granted leave to file an amended statement of opposition. The grounds of opposition, as amended, can be summarized as follows:

- (a) The application does not comply with the requirements of sections 38(2)(a) and 30(b) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) in that the Applicant has not used the Mark in Canada in association with each of the general classes of Goods and Services described in the application since the date of first use in the application.

- (b) The application does not comply with the requirements of sections 38(2)(a) and 30(i) of the Act in that the Applicant could not have been satisfied as to its entitlement to use the Mark in association with the applied-for Goods and Services, having regard to the prior use of the Opponent's PRO FORM mark.
- (c) The Mark is not registrable because it is confusing with the Opponent's registration for PRO FORM (per sections 38(2)(b) and 12(1)(d) of the Act).
- (d) The Applicant is not the person entitled to registration of the Mark having regard to the provisions of sections 38(2)(c) and 16(3)(a) of the Act in that as at the date of first use of the Mark, it was confusing with the Opponent's PRO FORM mark, which had previously been used in Canada in association with the Opponent's Goods by the Opponent and its predecessors-in-title.
- (e) The Applicant is not entitled to registration of the Mark having regard to the provisions of sections 38(2)(d) and 2 of the Act in that the Mark is not distinctive since it does not distinguish nor is it adapted so as to distinguish the Goods and Services of the Applicant from the Opponent's Goods in association with which the Opponent and the Opponent's predecessors-in-title have used the Opponent's PRO FORM mark.

[5] The Opponent filed the affidavit of its General Counsel, Everett Smith.

[6] The Applicant filed the affidavit of its President and Secretary, Brad Hause.

[7] Both parties filed written arguments, but only the Opponent was represented at an oral hearing. The hearing was conducted concurrently with respect to the opposition proceeding for application No. 1,864,983 for the trade-mark AVANTAGE PRO-FORMANCE. A separate decision will issue in respect of that proceeding.

ONUS

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, the Opponent must first adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged

to support each ground of opposition exist [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155 (FCA)].

MATERIAL DATES

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

- sections 38(2)(a)/30 with respect to non-compliance with section 30 – the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(b)/12(1)(d) with respect to confusion with a registered trade-mark – the date of this decision [*Park Avenue Furniture Corporation v Wickes/Bedding Ltd and the Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- sections 38(2)(c)/16(1)(a) with respect to entitlement – the date of first use set out in the application for the Mark [section 16(1) of the Act]. However, when an opponent successfully challenges an application based on the claimed date of first use, the material date is the filing date of the application [*Everything for a Dollar Store (Canada) Inc v Dollar Plus Bargain Centre Ltd* (1998), 86 CPR (3d) 269 (TMOB)]; and
- sections 38(2)(d)/2 with respect to distinctiveness – the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

GROUND OF OPPOSITION SUMMARILY REJECTED

Section 30(i) – Compliance

[10] Section 30(i) of the Act requires a statement by an applicant that it “is satisfied that he is entitled to use the trade-mark in Canada in association with the goods or services described in the application.” The Applicant provided such a statement in its application.

[11] Where an applicant has provided this statement, a section 30(i) ground of opposition should only succeed in exceptional cases such as where there is evidence of bad faith on the part of an applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. There is no evidence to indicate that this is such an exceptional case. Accordingly, as the Opponent has failed to meet its evidential burden, I reject this ground of opposition based on non-compliance with section 30(i) of the Act.

GROUND OF OPPOSITION BASED ON COMPLIANCE WITH SECTION 30

Section 30(b) – Compliance

[12] The Opponent has pleaded that the Applicant has not used the Mark in Canada since 2005 as claimed. The claimed first use date of 2005 is interpreted as no later than December 31, 2005 [see *Canadian Jewellers Association v American Gem Society*, 2010 TMOB 106 at para 55].

[13] The initial burden on an opponent is light respecting the issue of non-conformance with section 30(b) of the Act, because the facts regarding an applicant's first use are particularly within the knowledge of an applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. This burden may be met by reference not only to an opponent's evidence but also to an applicant's [*Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. While an opponent may rely upon an applicant's evidence to meet its evidential burden in relation to this ground, an opponent must show that the applicant's evidence is "clearly" inconsistent with the claims in the application [*Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply Co* (1999), 2 CPR (4th) 562 (TMOB), aff'd (2001), 11 CPR (4th) 489 (FCTD); *Bacardi v Corporativo de Marcas* (2014), 122 CPR (4th) 389 (FC)].

[14] The relevant definitions of "use" in association with goods and services are set out in section 4 of the Act as follows:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is

in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

4(2) A trade-mark is deemed to be used in association with services it is used or displayed in the performance or advertising of those services.

[15] In the Opponent's evidence, on this issue, Mr. Smith attaches to his affidavit, as Exhibit 7, screenshots from the Applicant's website at *www.sourceforsports.com*. The screenshots include a listing of the brands offered by the Applicant and search results for the terms "pro-formance advantage" and "avantage pro-formance". The search results show no relevant results and that the list of brands does not include PRO-FORMANCE ADVANTAGE or AVANTAGE PRO-FORMANCE (Smith affidavit, Exhibit 7).

[16] At this point, it is helpful to summarize Mr. Hause's evidence::

- The Applicant is a sporting goods buying group, composed of licensed dealers who operate under the name "Source for Sports". Through this dealer network, the Applicant sells goods for various sports and fitness activities and provides services including custom fitting and repair (para 2).
- The Applicant operates the website *www.sourceforsports.com* (para 2; Exhibit 1).
- The independent businesses that form the dealer network operate pursuant to a Dealer Agreement with the Applicant. As part of that Agreement, the dealers also operate under a Trade-mark Use and License Agreement that enables dealers to use the Applicant's marks in association with the operation of the dealers' retail sporting goods stores (para 3; Exhibit 2).
- The Mark was "conceived of and developed in 2005" as branding for the Applicant's "custom fitting protocol" (para 5; Exhibit 4).
- In 2006, the Applicant developed training materials, including manuals, a video and a seminar that were delivered across Canada as part of the custom fitting initiative within the dealer network retail stores (para 6; Exhibit 5).

- In the exhibited materials, the program is described as follows: “The Pro-Formance Advantage is a marketing tool designed to elevate the service levels of all [Source For Sports] stores across Canada”. Elements of the program include “Foot and Body Analysis”, “Foot to Skate Match”, “Gait and Body Balancing”, “Footbeds and Superfeet”, and “Marketing and Merchandising” (Exhibit 5).
- Together with the training materials, in 2006, the Applicant developed and provided to stores extensive in-store “Point-of-Purchase” materials to advertise the program (para 7; Exhibit 6).
- In 2007, the Applicant developed a national advertising campaign to promote the program. This campaign continues to the present as part of the Applicant’s efforts “to provide customized sales and service experiences to customers” (para 8 and Exhibit 7).
- In 2013, the Applicant introduced a new set of point-of-purchase materials specifically designed to advertise the goods and services connected with the Mark (para 9; Exhibit 8).
- Mr. Hause purports that the Mark has been used in association with a number of goods. He attests that, since 2006, the Applicant has used the Mark on “footbeds”, “hockey skate guards” and “hockey skate socks”. He also attests that the Mark is used in association with “hockey skate laces”. Photos of such goods as well as purchase orders from a supplier are attached as Exhibit 9 to Mr. Hause’s affidavit (para 10).
- Since 2005, the Applicant has had annual sales in the range of \$360 million and the network of 156 dealer stores has served over 10 million customers (para 11).

[17] In its representations, the Opponent submits that it meets its initial evidential burden:

43. Of the long list of goods comprising the Applicant’s Goods & Services, the Hause Affidavit only mentions footwear insoles, socks and laces, and asserts a date of first use of 2006 in association with those goods (Hause Affidavit ¶10), which date is subsequent to the date of first use alleged in the Application. Accordingly, the Application must be refused (pursuant to Section 30(b)) for all of the goods comprising the Applicant’s Goods & Services. The absence of a valid Section 50 license (discussed below) also applies to the goods comprising the Applicant’s Goods & Services.

44. Regarding the services comprising the Applicant’s Goods & Services, the Hause

Affidavit asserts that the Applicant itself does not “use” (as defined in Sections 2 and 4) the Subject Mark because it is a buyers group; only the Dealers that comprise the buyers group interact with the purchasing public. As previously discussed, the Hause Affidavit fails to establish a valid Section 50 license from the Applicant to the Dealers. As a result, the Hause Affidavit fails to establish any use of the Subject Mark in association with the operation of a retail sporting goods store.

[18] On this issue, the Applicant’s written representations are silent.

[19] I find that the Applicant’s evidence is clearly inconsistent with the 2005 date of first use claimed in the subject application and that the Opponent has met its burden for the following reasons:

- Mr. Hause asserts use of the Mark only in association with a limited number of goods and only since 2006.
- Mr. Hause’s evidence that point-of-purchase and training materials displaying the Mark were provided to stores in 2006 (Hause Affidavit, paras 6-7) appears to be clearly inconsistent with the 2005 first use date claimed.
- While Mr. Hause refers to Exhibit 4 as “marketing and customer service materials from 2005”, it is not clear that the materials in that exhibit were displayed in the advertisement or performance of the services. The first page is merely a reproduction of the PRO-FORMANCE ADVANTAGE logo. The second page is a price list from Signature Graphics, displaying various examples of PRO-FORMANCE ADVANTAGE signage that could be ordered. Finally, the last two pages appear to merely be a mock up for a pamphlet regarding “The PA Approach”, as the document includes filler text in Latin. As such, I am not prepared to infer it was circulated in the advertisement or performance of the Services in 2005.

[20] As the Opponent has met its burden, the Applicant has the onus of showing use of the Mark in association with the Goods and Services from December 31, 2005. The Applicant has not met its onus, as there is no evidence of use of the Mark in association with either the Goods or the Services as of December 31, 2005. In this respect, there is no evidence of transfers of any of the registered goods in association with the Mark to consumers in the normal course of trade

or otherwise and, as summarized above, the evidence of advertisement and performance of the Services in association with the Mark is limited to 2006 and beyond.

[21] Accordingly, this ground of opposition is successful.

GROUND OF OPPOSITION BASED ON CONFUSION

[22] The remaining three grounds turn on the issue of confusion between the Mark and the Opponent's trade-mark PRO FORM. I will deal with the section 12(1)(d) ground first.

Section 12(1)(d) – Registrability

[23] The Opponent alleges that the Mark is not registrable because it is confusing with the Opponent's registration for PRO FORM (per sections 38(a)(b) and 12(1)(d) of the Act).

[24] Exhibit 2 to Mr. Smith's affidavit is a certified copy of the Opponent's registration TMA379,069 for the trade-mark PRO FORM, registered in association with the Opponent's Goods. I have confirmed that the registration is extant. Therefore, the Opponent has met its initial burden with respect to this ground.

[25] As such, the Applicant has a legal onus to show, on a balance of probabilities, that the Mark was not likely to create confusion with the Opponent's PRO FORM mark.

[26] At this point, it may be helpful to summarize the Opponent's evidence. Mr. Smith's evidence is:

- The Opponent is one of the world's largest developers and marketers of fitness equipment with brands that include NordicTrack, Pro Form, Weider and Gold's Gym (para 2).
- The Opponent and its predecessors-in-title have used the Mark throughout Canada in association with the Opponent's Goods since at least as early as May 1986 (para 4).
- The Opponent's Goods are manufactured by the Opponent or by third-party manufacturers with which the Opponent has contracted and are distributed in Canada by

ICON of Canada, Inc. Any use of the PRO FORM mark by ICON of Canada, Inc. is pursuant to a license under which the Opponent maintains direct and indirect control of the quality and character of the sale, advertisement, promotion and performance of the Opponent's Goods (para 5).

- The PRO FORM mark appears on the consoles of the Opponent's exercise equipment and in user manuals that accompany the Opponent's Goods when they are delivered to customers in Canada (para 6; Exhibits 3 and 4).
- The Opponent's Goods are available through the website, *www.proformfitness.ca*, operated by the Opponent and through retailers such as Sears Canada, Costco Canada and Canadian Tire (para 11).
- Since 2008, annual sales of PRO FORM fitness equipment to Canadian purchasers have been in the range of US\$4.8 to 9.4 million (para 11, with examples of invoices at Exhibit 6, showing sales of PRO FORM exercise equipment from March 2005 to September 2014).
- In addition to the Opponent's website, the Opponent's Goods have been advertised by Canadian retailers pursuant to a cooperative advertising program with the Opponent (para 12).

Test for Confusion

[27] There is a likelihood of confusion if the use of both trade-marks in the same area would likely lead to the inference that the goods and services associated with those trade-marks are manufactured, sold or leased by the same person. A likelihood of confusion does not concern confusion of the marks themselves, but confusion of the goods or services from one source as being from another source.

[28] In assessing confusion, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the goods and services or business; the nature of the trade; and the

degree of resemblance between the trade-marks in appearance, or sound, or in the ideas suggested by them.

[29] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 1 SCR 772 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis. Accordingly, I will begin the confusion analysis with the degree of resemblance between the trade-marks.

Degree of resemblance in appearance or sound or in the ideas suggested

[30] In *Masterpiece*, the Supreme Court of Canada advises that the preferable approach when comparing trade-marks is to begin by determining whether there is an aspect of each trade-mark that is particularly striking or unique [para 64].

[31] With respect to the Mark, I do not consider the term ADVANTAGE to be particularly striking, as it is a laudatory term [see *Vantage Computer Systems Inc v Sterling Software Inc*, 1997 CarswellNat 2993, 84 CPR (3d) 366 (TMOB)]. The first element, PRO-FORMANCE, a play on “performance”, is the more striking aspect of the Mark.

[32] In this respect, the first portion of a trade-mark is usually considered more important for assessing the likelihood of confusion [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD) at 188]. As such, I consider there to be some degree of resemblance between the parties’ marks, in view of the fact that the first portion of the Mark is PRO-FORMANCE and the Opponent’s mark is PRO FORM. On the other hand, I agree with the Applicant that the addition of “-ANCE ADVANTAGE” reduces the degree of resemblance somewhat in sound and appearance between the respective trade-marks.

[33] With respect to the ideas suggested, although both marks elicit the idea of “professional” attributes, PRO FORM suggests that the Opponent’s exercise equipment itself is of a professional form or that use of the equipment will result in a professional form. On the other hand, PRO-FORMANCE ADVANTAGE suggests a performance advantage to consumers of the Applicant’s Goods and Services.

Inherent distinctiveness, extent known and the length of time in use

[34] These factors favours the Opponent as the trade-marks have a similar degree of inherent distinctiveness and the PRO-FORM trade-mark appears to be known to a greater extent than the Mark.

[35] Despite the parties' trade-marks consisting of or including a coined word, these trade-marks have a limited degree of inherent distinctiveness as they are suggestive of characteristics of the associated goods and/or services.

[36] The Opponent has evidenced that its PRO FORM mark is known in Canada, through its use and advertisement in relation to the Opponent's Goods since May 1986 (Smith affidavit, para 4). As of the date of this decision, the Opponent's PRO FORM trade-mark has been used in association with the Opponent's Goods since at least March 2005, the earliest dated exhibited invoice, with annual sales in the range of \$4.8 to \$9.4 million since 2008 (Smith affidavit, para 11; Exhibit 6). In contrast, at best, the Mark has been used in association with the applied-for Services since 2006 including in advertising and point-of-purchase materials (Hause affidavit, paras 7, 8; Exhibits 6, 7) and perhaps the following goods since 2006: footbeds, hockey skate guards, hockey skate socks, and hockey skate laces (para 10).

Nature of goods, services, business and trade

[37] With respect to the nature of the goods, while both the Opponent's Goods and the Goods and Services are in the field of "sporting goods", there is significant overlap with respect to the Goods that can be characterized as exercise equipment, namely, "elliptical machines, treadmills, and weight lifting machines, rowers, stair climbers, exercise bicycles, weights, weight benches, weight belts, weight gloves, ankle weights, [and] wrist weights". With respect to the remaining goods, although they fall into the broad category of "sporting goods", there is less overlap between the goods.

[38] The Applicant submits that it and the Opponent sell their goods through different channels of trade (see the Applicant's written submissions, page 4). In particular, the Applicant sells its Goods and provides its Services through its licensed retail dealer network, primarily in

SOURCE FOR SPORTS-branded locations. In contrast, the Opponent's Goods are sold through third-party retailers and through the Opponent's website.

[39] When considering sections 6(5)(c) and (d) of the Act, it is the statement of goods and services as defined in the application for the Mark and in the Opponent's registration that govern the assessment of the likelihood of confusion [see *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)]. In this case, neither the application for the Mark nor the Opponent's registration includes restrictions on the respective channels of trade.

Surrounding Circumstance – Third Party Use of PRO FORM

[40] In its written argument, the Applicant submits that there are 13 registered trade-marks that use PRO FORM or similar phrasing, arguing that such marks "have been allowed to co-exist on the Register notwithstanding that the marks are identical or substantially similar to one another, and are used in relation to related goods and services" (Applicant's Written Argument, page 3).

[41] However, the state of the register evidence referred to by the Applicant in its written argument has not been filed as evidence. State of the register evidence cannot be considered where it is adduced without filing certified copies of the registrations or at least an affidavit affixing particulars of the relevant registrations [*Papillon Eastern Imports Ltd v Apex Trimmings Inc* (2007), 63 CPR (4th) 101 (TMOB) at para 14]. The Registrar does not exercise discretion to take cognizance of third-party applications and registrations [*Quaker Oats of Co of Canada Ltd v Menu Foods Ltd* (1986), 11 CPR (3d) 40 (TMOB)]. Parties to opposition proceedings are expected to prove each aspect of their case and registrations listed in written argument are not admissible [*Unitron Industries Ltd v Miller Electronics Ltd* (1983), 78 CPR (2d) 244 (TMOB) at 253]. Therefore, I will not have regard to any of the trade-marks set out in the Applicant's written argument.

[42] Even if I were to have regard to those registrations, as none of them relate to the Opponent's Goods or the Goods and Services, it would not have impacted the conclusion set out below.

Conclusion

[43] Having considered all of the surrounding circumstances and applying the test of confusion as a matter of first impression and imperfect recollection, I conclude that, on a balance of probabilities, that there is a reasonable likelihood of confusion between the Opponent's PRO FORM trade-mark and the Mark with respect to "elliptical machines, treadmills, and weight lifting machines, rowers, stair climbers, exercise bicycles, weights, weight benches, weight belts, weight gloves, ankle weights, [and] wrist weights". I conclude this based on the degree of resemblance between the trade-marks and the overlap in the nature of these goods with the Opponent's Goods, being "exercising equipment, namely rowing machines and multiple purpose exercising machines". Accordingly, this ground of opposition would be successful with respect to such goods.

[44] In contrast, the differences in the nature of the remaining Goods and Services shifts the balance of probabilities in the Applicant's favour and there is no reasonable likelihood of confusion with the Opponent's PRO FORM trade-mark. Accordingly, this ground of opposition is rejected with respect to the remaining Goods and the Services.

Section 16(1)(a) – Entitlement

[45] The Opponent has pleaded that the Applicant is not the person entitled to registration pursuant to section 16(1)(a) of the Act as the Mark is confusing with its PRO FORM mark previously used in Canada in association with the Opponent's Goods.

[46] With respect to this ground of opposition, as the Opponent has successfully challenged the Applicant's claimed date of first use, the Opponent must evidence use of its trade-mark prior to the filing date of the application and establish non-abandonment of its trade-mark as of the date of advertisement of the Applicant's application [per *Everything for a Dollar Store (Canada) Inc, supra*].

[47] In view of the evidence summarized above, I find that the Opponent has evidenced use of its PRO FORM mark in association with the Opponent's Goods since at least March 2005, the earliest dated exhibited invoice. Further, I find that the Opponent has not abandoned its PRO FORM mark. This is sufficient to satisfy the Opponent's burden with respect to this ground of opposition.

[48] In this case, I do not consider the confusion analysis above to be materially affected by the difference in the material date. Accordingly, this ground of opposition is successful with respect to "elliptical machines, treadmills, and weight lifting machines, rowers, stair climbers, exercise bicycles, weights, weight benches, weight belts, weight gloves, ankle weights, [and] wrist weights" and unsuccessful with respect to the remaining Goods and the Services.

Section 2 - Distinctiveness

[49] The Opponent has pleaded that the Mark is not distinctive having regard to the PRO FORM trade-mark of the Opponent. In order to meet its evidential burden with respect to this ground, the Opponent must show that as of the filing of the opposition (February 5, 2016), the Opponent's PRO FORM trade-mark had become known in Canada sufficiently to negate the distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD) at 58; *Andres Wines Ltd v E & J Gallo Winery* (1975), 25 CPR (2d) 126 (FCA) at 130; and *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA) at 424].

[50] In view of the evidence summarized above, I am satisfied that the Opponent has shown that, as of the material date, the Mark had become known through its use and advertisement of the Mark by the Opponent in association with the Opponent's Goods.

[51] Again, however, I do not consider the confusion analysis above to be affected by the difference in the material date. Accordingly, this ground of opposition is successful with respect to "elliptical machines, treadmills, and weight lifting machines, rowers, stair climbers, exercise bicycles, weights, weight benches, weight belts, weight gloves, ankle weights, [and] wrist weights" and unsuccessful with respect to the remaining Goods and the Services.

DISPOSITION

[52] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the application is refused pursuant to section 38(8) of the Act.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2018-07-25

APPEARANCES

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