

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

Citation: 2018 TMOB 141

Date of decision: 2018-11-14

**[UNREVISED ENGLISH
CERTIFIED TRANSLATION]**

IN THE MATTER OF THE OPPOSITIONS

COTE-RECO INC.

Opponent

and

IMPRESSIONS PRO-DESIGN INC.

Applicant

1,684,264 for GO HOCKEY ONE

Applications



LINE & DESIGN

1,684,265 for GO HOCKEY TWO

LINES & DESIGN

INTRODUCTION

[1] COTE-RECO INC. (the Opponent) opposes the registration of the trade-marks GO HOCKEY ONE LINE AND DESIGN and GO HOCKEY TWO LINES AND DESIGN (shown below), which are the subject of applications Nos. 1,684,264 and 1,684,265 respectively, on behalf of IMPRESSIONS PRO-DESIGN INC. (the Applicant), filed on July 8, 2014, with the Registrar of Trade-marks.

Application No. 1,684,264	Application No. 1,684,265
	

[2] Each of these applications is based on proposed use in Canada in association with the following goods and services: [TRANSLATION] “hockey bags, underwear” and [TRANSLATION] “operating a business to sell hockey equipment”.

[3] Except when otherwise indicated, I will refer collectively to these two trade-marks as “the Mark”.

[4] Each opposition was filed under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) and raises a total of 10 grounds for opposition based upon sections 2 (non-distinctiveness); 12 (non-registrability); 16 (non-entitlement); and 30 (non-compliance) of the Act.

[5] As my analysis will reveal, I find there is reason to refuse each of the applications.

THE RECORDS

[6] Each of the applications for registration was advertised for opposition purposes in the *Trade-marks Journal* of May 13, 2015.

[7] Each of the statements of opposition was originally filed on June 26, 2015 and subsequently amended with the Registrar’s permission by official letter dated February 19, 2016.

[8] A counter statement denying each of the grounds of opposition pleaded was filed on August 28, 2015 in each case.

[9] In support of each of its oppositions, the Opponent filed an affidavit from its Director of Finance, Stéphane Dion, dated December 7, 2015 and comprising Exhibits SD-1 to SD-17.

Mr. Dion was cross-examined on his affidavit, and the transcript of his cross-examination as well as the answers to the undertakings made during the latter are on the records. The Opponent has also filed certificates of authenticity concerning the following trade-mark registrations it holds:

Trade-mark	Registration No.	Goods/Services
GOSPORT	TMA324,003	For, among other things, sports clothing
GO SPORT	TMA821,022	For, among other things, sporting goods and sports clothing, including hockey bags and hockey underwear, and the sale of sporting goods
GO SPORT (& DESIGN—ON TWO LINES) 	TMA821,020	For, among other things, sporting goods and sports clothing, including hockey bags and hockey underwear, and the sale of sporting goods
GO SPORT (& DESIGN) 	TMA821,016	For, among other things, sporting goods and sports clothing, including hockey bags and hockey underwear, and the sale of sporting goods
GO CHAUSSURES SPORT	TMA876,780	For, among other things, sporting goods and sports clothing, including hockey bags and hockey underwear, and the sale of sporting goods
GO CHAUSSURES SPORT & DESIGN	TMA721,476	For, among other things, the import and sale of footwear and footwear accessories

 <p data-bbox="186 405 513 447">Chaussures • sport</p>		
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[10] In support of each of its applications, the Applicant filed an affidavit from its President, Jean Landry, dated April 7, 2016, comprising Exhibits JL-1 to JL-16; an affidavit from Jean Junior Landry, who is Jean Landry’s son and a shareholder of the Applicant, dated April 7, 2016, comprising Exhibit JLJR-1; and a statutory declaration from Élisabeth Breton, who is a lawyer with the firm representing the Applicant, dated April 6, 2016, which comprises Exhibits EB-1 to EB-6.

[11] Only the Applicant filed a written argument for each case. The two parties participated in the hearing held for the two cases.

ANALYSIS

The burden incumbent on the Parties

[12] It is initially for the Opponent to establish that each of its oppositions is well-founded. The Opponent must ensure that each of its grounds for opposition is properly pleaded and that it meets the initial burden of proof by establishing the facts on which each of these grounds is based. Once this initial burden of proof has been met, it is incumbent upon the Applicant to establish, on a balance of probabilities, that none of these grounds for opposition preclude the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

Overview of Evidence

[13] I provide below an overview of the evidence filed by the parties, which I will consider in more detail, as needed, in my analysis of the various grounds for opposition.

Affidavit of Stéphane Dion

[14] Mr. Dion states that the Opponent is a company founded more than 75 years ago that is engaged in the import, distribution and retail sale of footwear, clothing and accessories in Canada [para 5 of the affidavit].

[15] Mr. Dion states that GO SPORT stores sell a wide variety of sport clothing, accessories and footwear. The goods sold at these stores include third-party branded goods, GO SPORT branded goods and goods from the Opponent's other private labels [paragraph 6 of the affidavit].

[16] Mr. Dion states that the Opponent is the franchisor of seven GO SPORT franchised stores in various regions of Quebec. The Opponent controls by licence the character and quality of the Goods sold and the Services offered at its franchised stores operating under the GO SPORT mark [para 7 of the affidavit].

[17] Mr. Dion then describes the trade-mark registrations secured by the Opponent over the years relevant to the present proceedings, namely those mentioned above in paragraph 9 of my decision. He files jointly, as Exhibit SD-1, excerpts from the Intellectual Property Office's trade-mark database concerning these trade-mark registrations, in addition to the certificates of authenticity filed separately by the Opponent. Furthermore, he states that, in the course of its activities, the Opponent adopted in Canada, as of November 1, 2010, the GO SPORT trade-mark in association with the goods and services described in registration TMA821,022. He refers to these goods and services as the "Goods" and "Services," and I will do the same in my review of his affidavit [paras 8 to 11 of the affidavit].

[18] With respect to the use of the GO SPORT mark with the Goods in Canada, Mr. Dion states that the Opponent has been selling in Canada various sports clothing and accessories (including hockey underwear, hockey bags and water bottles) in association with the mark in its word mark form and its two graphic forms since at least 2011. He refers to these goods as the "Hockey Goods" and I will do the same in my review of his affidavit. Mr. Dion states that in the Opponent's normal course of trade in Canada, the GO SPORT mark is displayed on Hockey Goods. In support of his affidavit, he files jointly, as Exhibit SD-2, a representative (but not exhaustive) sample of excerpts from the Opponent's accounting system showing the sale of these

goods at various Opponent franchised stores to consumers, and under Exhibit SD-3, photos of Hockey Goods bearing the GO SPORT mark in both of its graphic forms. He confirms that these samples are representative of some of the ways in which the GO SPORT mark has been used in association with the Hockey Goods in Canada since at least 2011 [paras 12 to 14 of the affidavit].

[19] With respect to the use of the GO SPORT mark with the Services in Canada, Mr. Dion states that the Opponent is currently the franchisor of seven franchised stores operating under the mark in Boucherville, Plessisville, Drummondville, Shawinigan, Donnacona, Ville-Marie and Chandler. An eighth franchised store was in operation in St. Boniface from May 2011 to August 2014. The first franchised store opened in March 2011 [para 15 of the affidavit].

[20] Mr. Dion states that the franchised stores have made more than \$20 million in sales under the GO SPORT mark in Canada since 2011. He submitted a table of the franchised stores' annual sales figures for the period from 2011 to October 17, 2015 [para 16 of the affidavit].

[21] Mr. Dion states that the Opponent has been using the GO SPORT mark, in its word mark form and its two graphic forms, in association with the Services in its normal course of trade since at least March 2011. He states that franchised stores display the GO SPORT mark in the advertising and provision of Services in Canada. To this end and in support of his affidavit, he files the following exhibits jointly:

- SD-4: a sample of photos of the storefronts of some of the franchised stores, where the GO SPORT mark appears ostensibly in one of its graphic forms (design on one line as represented in registration TMA821,016).
- SD-5: a sample of posters displayed inside franchised stores on which the GO SPORT mark appears visibly in one or the other of its two graphic forms.
- SD-6: a photograph of a receipt from the Plessisville franchised store dated November 18, 2011, with the GO SPORT word mark appearing at the top of the receipt.

- SD-7: a photograph of a bag given to consumers on which the GO SPORT mark is clearly displayed in one of its graphic forms (design on two lines as represented in registration TMA821,020).
- SD-8: a sample of photos of the interior of franchised stores showing the various hockey goods sold in these stores [para 20 of the affidavit]. Mr. Dion explains that franchised stores sell a wide variety of sporting goods. Six of the seven franchised stores sell GO SPORT mark and third-party mark hockey goods, including skates, hockey sticks and pucks, field hockey balls, hockey tape, hockey bags, hockey clothing, hockey helmets, hockey visors, hockey pants, hockey jerseys, elbow pads, shoulder pads, gloves, leggings, socks, neck guards, wrap arounds, hockey underwear and hockey nets.
- SD-9: photos of clothing worn by franchised store employees on which the GO SPORT mark is displayed and is clearly visible to customers in one of its graphic forms (design on two lines as represented in registration TMA821,020).

[22] Mr. Dion confirms that although the above samples are not exhaustive, they are representative of the ways (or some of the ways) the GO SPORT mark has been used in association with the Services since at least March 2011 [paras 17 to 21 of the affidavit].

[23] With respect to the promotion of the Services, Mr. Dion states that, since at least 2011, the Opponent and the franchised stores have collectively spent more than \$477,000 on the production and distribution of flyers promoting franchised stores operating under the GO SPORT mark. He submits a table with the annual figures for the period from 2011 to October 17, 2015. In Exhibit SD-10, he files a sample of flyers promoting the Opponent's franchised stores. He confirms that even though the sample is not exhaustive, it is representative of the flyers distributed since at least March 2011. He further states that, on average, 94,000 copies of each flyer issue were distributed in Canada [paras 22 and 23 of the affidavit].

[24] Mr. Dion states that the Opponent also advertises in print in various publications. To illustrate this point and in support of his affidavit, he files Exhibit SD-11, which is an excerpt from the 2014–2015 edition of *POOL PRO* magazine containing an advertisement for GO SPORT franchised stores. Mr. Dion explains that *POOL PRO* is a magazine for hockey fans

published by TVA Publications Inc. with a circulation of 45,000 copies in Canada [para 24 of the affidavit].

[25] Mr. Dion states that the Opponent also sponsors various community events. To illustrate this point and in support of his affidavit, he files Exhibit SD-12, which is a photo taken during the Saint-Tite Winter Classic held on January 23 and 24, 2015 [para 25 of the affidavit].

[26] Mr. Dion then discusses the Opponent's use of the GO HOCKEY GO mark. He states that the Opponent has also been using this trade-mark in association with the Services since at least September 2011. He states that the GO HOCKEY GO mark is a trade-mark used by the Opponent to advertise its hockey goods retail sale services and that it controls by licence the character and quality of the Services offered by its franchised stores in association with the GO HOCKEY GO mark [para 26 of the affidavit].

[27] Mr. Dion states that the GO HOCKEY GO mark is displayed on posters posted outside franchised stores and in the franchised stores' flyers. To this end, he files a representative (but not exhaustive) sample of such advertising posters (Exhibit SD-13) and a flyer dated August 6, 2012 (Exhibit SD-14) [paras 27 and 28 of the affidavit].

[28] Mr. Dion concludes his affidavit by discussing the Applicant's activities. He states that they are the same as the Opponent's, namely the sale of sporting goods, including hockey-related goods, to casual consumers. He files jointly, as Exhibits SD-15 to SD-17, excerpts from the websites <http://gohockeygo.ca> and <http://prodesign.gohockeygo.ca> apparently used by the Applicant.

Affidavit of Jean Landry

[29] Mr. Landry begins his affidavit with a preamble outlining some of his activities prior to 2008, the year in which he decided to open a retail store specializing in the sale of hockey goods and supplies under the name GO HOCKEY. Furthermore, Mr. Landry also alleges that he owned a retail business specializing in the sale of hockey equipment operating under the name *L'Entrepôt du hockey*, which was [TRANSLATION] "very well-known in the Québec City area and located [...] in Québec City" [paras 4 to 10 of the affidavit]. I will not go into the details of

Mr. Landry's past activities as they are not relevant in the present proceedings, as rightly noted by the Opponent during the oral hearing.

[30] Mr. Landry then describes the applications for registration filed by the Applicant in anticipation of the opening of a hockey equipment retail store under the Mark, namely, the present applications for registration [paras 11 to 16 of the affidavit].

[31] Mr. Landry continues his affidavit by discussing the use of the Mark in association with the services covered by the present applications. He states that after filing the present applications for registration, and beginning at the time of the opening of the GO HOCKEY store on July 23, 2014, the Applicant, and only the Applicant, used the Mark for its hockey equipment retail store. In support of his affidavit, he files as Exhibit JL-4 photographs of the exterior and interior of the GO HOCKEY store that he took on January 26, 2015. These photographs show, among other things, the colour version of the Mark in its one-line format (application No. 1,684,264) [paras 13 and 14 of the affidavit].

[32] Mr. Landry explains that the GO HOCKEY store is located in Québec City and serves consumers from the region. The store has a 10,500 square-foot area entirely dedicated to the sale of hockey-related items and equipment, primarily skates, sticks, helmets, gloves, leggings, shoulder pads, pucks, hockey jerseys and various other hockey-related accessories [paras 18 and 19 of the affidavit]. Mr. Landry provides details on the GO HOCKEY store's employees and suppliers [paras 22 and 23 of the affidavit].

[33] Mr. Landry states that for the period from March 1, 2015 to March 31, 2015, the Applicant's GO HOCKEY store recorded \$1,381,777.24 in sales of hockey-related goods and equipment alone.

[34] With respect to the use of the Mark in association with the Goods covered by the present applications, Mr. Landry states in paragraph 26 of his affidavit that:

[TRANSLATION]

Subsequent to the opening of the store, the Mark was displayed only on private-label goods used strictly for promotional purposes and/or given to customers as a gift with the purchase of specific goods or occasionally with the purchase of goods with a specific value. [My underlining]

[35] Mr. Landry files as Exhibit JL-6 [TRANSLATION] “representative photographs of these promotional products bearing the Mark” [para 27 of the affidavit]. Upon review of these photographs, I note that they show hockey bags and underwear, i.e. the products covered by the present applications.

[36] Mr. Landry states that the Applicant uses the Mark on receipts given to customers who purchase merchandise at the GO HOCKEY store, as indicated on a copy of a receipt filed as Exhibit JL-7 in support of his affidavit.

[37] In paragraphs 29 and 30 of his affidavit, Mr. Landry states that:

[TRANSLATION]

For the rest, and like the stores operating under the GO SPORT banner, the only goods distributed or sold by the Applicant are third-party products that do not bear the Mark.

Since the store opening on July 23, 2014, in addition to private label items used for promotional purposes, the Mark has been used exclusively to distinguish its hockey equipment retail services available at its establishment [in Québec City]. [My underlining]

[38] Mr. Landry then discusses the promotion and awareness of the Mark. He states that, since the opening of the GO HOCKEY store, the Mark has become known in Canada, particularly in Québec City. Mr. Landry offers personal opinions about the Mark’s reputation by comparing it with the reputation of the Opponent’s marks cited in the present proceedings [paras 31 and 32, 40 to 46 of the affidavit].

[39] Mr. Landry states that when the GO HOCKEY store opened, the Applicant initiated an advertising campaign. In support of his affidavit, he files as Exhibit JL-8 advertisements published in *Le Journal de Québec* as well as the advertising placement grid for this campaign. He also files as Exhibit JL-9 a CD-ROM containing television commercials produced by TVA Group for the same campaign, along with the invoices for this television campaign totalling more than \$12,000.00 [paras 33 to 35 of the affidavit].

[40] Mr. Landry states that since the store opened, the Applicant has allocated a significant amount to advertising each year. He states that [TRANSLATION] “between March 1, 2015 and

March 31, 2015, the Applicant spent \$99,401.55 on advertising to promote the store and the GO HOCKEY Mark,” [paras 36 and 37 of the affidavit].

[41] Mr. Landry affirms that the Applicant’s Facebook page now has more than 1,500 followers [para 39 of the affidavit].

[42] Mr. Landry returns to the alleged lack of awareness of the Opponent’s GO SPORT mark and name. He offers many personal opinions, arguing that the Opponent’s GO SPORT mark [TRANSLATION] “is definitely not used in the same region as the Mark and never in Québec City, but rather in peripheral markets that are not competitive with that of the Applicant,” and that the parties’ marks [TRANSLATION] “are not likely to create potential confusion”, etc. [paras 42 to 71 of the affidavit]. I will not go into details about these various personal opinions as they are factual and legal matters that must be decided by the Registrar as part of the present proceedings.

[43] Mr. Landry ends his affidavit by discussing the ground of opposition based on the Opponent’s alleged GO HOCKEY GO mark. He states that shortly after the opening of the GO HOCKEY store in October 2014, he received service of proceedings filed in Federal Court by the Opponent and that he filed a statement of defence to these proceedings, which are filed jointly as Exhibit JL-15 in support of his affidavit. He states that these proceedings were concurrent with his refusal to partner with the Opponent and followed a visit from the Opponent’s representatives to the Applicant’s store after its opening on July 23, 2014, to inquire about his interest and encourage him to partner with the Opponent. He states that, in the present Federal Court proceedings, the Opponent never claimed to have any rights whatsoever on an alleged GO HOCKEY GO trade-mark, nor did the Opponent indicate that it used an alleged mark of this kind [paras 72 to 79 of the affidavit].

Affidavit from Jean JR. Landry

[44] Mr. Jean JR. Landry is the Manager of the GO HOCKEY store.

[45] With the exception of the paragraphs discussed below, the affidavit of Mr. Jean JR. Landry is a copy of his father’s and essentially serves to corroborate it.

[46] Mr. Jean JR. Landry concludes his affidavit by mentioning that the *http://gohockeygo.ca* and *http://prodesign.gohockeygo.ca* web addresses:

[TRANSLATION]

... are not used as trade-marks, but only as domain names, due to availability issues because Gohockey.ca and gohockey.com are already reserved and/or used by third parties, as indicated on an excerpt from the web pages filed as Exhibit JLJR-1.

[47] Exhibit JLJR-1 consists of a copy of the homepage of an English-language website apparently dedicated to hockey news and a copy of a website that is “*under construction*”. No other information about these sites or the entities behind them was filed.

[48] Mr. Jean JR. Landry also clarifies that the statement [TRANSLATION] “A division of Go hockey Inc.” appearing on the Applicant’s website was [TRANSLATION] “a mere programming error since no company named Go Hockey Inc. exists or is in operation”.

Statutory declaration from Ms. Élisabeth Breton

[49] Ms. Élisabeth Breton states that she searched the databases contained on the Canadian Intellectual Property Office website for trade-marks using the terms “go” and “sport” currently registered in Canada.

[50] In support of her statement, Ms. Breton files her search results as Exhibits EB-1 to EB-6.

Analysis of the grounds of opposition

Ground of opposition based on non-compliance of the application under section 30(e) of the Act

[51] Each of the statements of opposition alleges that the application for registration herein opposed does not meet the requirements of section 30(e) of the Act in that the Applicant never intended to use, directly or through a licensee or directly and through a licensee, the Mark in Canada in association with each of the goods or services mentioned in the application.

[52] More specifically, at the hearing, the Opponent submitted that the statements contained in paragraphs 26 to 30 of Mr. Jean Landry’s affidavit (described above in my summary review of the evidence) to the effect that, since the GO HOCKEY store opened on July 23, 2014, the Mark

has only been displayed on private-label goods used strictly for promotional purposes and/or given to customers as a gift with the purchase of specific goods, unequivocally confirm that the Applicant never intended to use the Mark in association with the products described in each of the present applications within the meaning of section 4 of the Act.

[53] The material date for assessing a ground of opposition under section 30(e) of the Act is the filing date of the application [*Canadian National Railway Co v Schwauss* (1991), 35 CPR (3d) 90 (TMOB)]. Since the facts concerning the Applicant's intentions are primarily the knowledge of the Applicant, the burden of proof on the Opponent with respect to this ground is lighter [*Molson Canada v Anheuser-Busch Inc* (2003), 2003 FC 1287 (CanLII), 29 CPR (4th) 315 (FCTD); *Canadian National Railway Co v Schwauss, supra*; and *Green Spot Co v JB Food Industries* (1986), 13 CPR (3d) 206 (TMOB)]. Furthermore, the Opponent may rely on its own evidence and the Applicant's evidence [*Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) (FCTD)]. However, the Opponent may only successfully rely upon the Applicant's evidence if it is clearly inconsistent or puts into issue the claims set forth in the Applicant's applications [*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd* (2014) FC 323, paras 30 to 38].

[54] I agree with the Opponent that Mr. Jean Landry's statements are clearly inconsistent with the claims concerning the proposed use of the Mark in association with the goods described in each of the present applications and put into issue the veracity of these claims. It is clear from Mr. Landry's affidavit that the Applicant never intended to use the Mark in association with the goods covered by the present applications within the meaning of section 4(1) of the Act since giving away goods strictly for promotional purposes is not the same as selling them in the normal course of trade. Rather, the Applicant always intended to use the Mark exclusively to distinguish its hockey equipment retail services available at its establishment in Québec City. I also note that the Applicant did not submit any representation at the hearing in an attempt to counter this finding.

[55] Therefore, I partially accept the ground of opposition based on section 30(e) of the Act, with respect to the proposed use of the Mark in association with the goods covered by each of the applications.

Non-entitlement to the Registration of the Mark under section 16(3)(a) of the Act

[56] Each of the statements of opposition alleges that the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act in that, on the filing date for each of the applications, the Mark created confusion with the GO SPORT trade-marks that are described above in paragraph 9 of my decision and were previously used in Canada by the Opponent in association with its goods, services and sporting goods and sport clothing retail business, as well as with the GO HOCKEY GO trade-mark previously used in Canada by the Opponent in association with its sporting goods and sport clothing retail business.

[57] To discharge its initial burden under section 16(3)(a) of the Act, the Opponent must show that one or the other, or even each of the trade-marks alleged in support of such ground, had been used in Canada prior to the filing date of each of the present applications and had not been abandoned at the date of their announcement in the *Trade-Marks Journal* [section 16(5) of the Act].

[58] I agree with the Opponent that this burden has been met with respect to the GO SPORT mark used in association with the Hockey Goods described by Mr. Dion and all of its retail services for clothing, accessories and sporting goods available at its franchised stores. In this regard, I will start by noting that the use of the GO SPORT mark in its two graphic forms (one-line design or two-line design, which are registered under TMA821,016 and TMA821,020 respectively) demonstrated through the various exhibits produced in support of Mr. Dion's affidavit applies to the use of the GO SPORT nominal mark. To this, I would add that the addition of the words [TRANSLATION] "sports fashion" in fine print below the word "SPORT," which the Applicant noted among the exhibits filed by Mr. Dion, is inconsequential in that it does not alter the identity of the GO SPORT mark [*Registrar of Trade Marks v Compagnie Internationale pour l'Informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA); and *Nightingale Interloc v Prodesign* (1984), 2 CPR (3d) 535 (TMOB)].

[59] However, I am not satisfied that the Opponent has discharged this burden for the marks GO CHAUSSURES SPORT and GO CHAUSSURES SPORT & Design. None of the exhibits filed in support of Mr. Dion's affidavit show use of these marks.

[60] With respect to the GO HOCKEY GO mark, the Applicant asserts that it is a simple generic slogan that the Opponent has only used sporadically for promotional or decorative purposes, as shown in the flyer filed as Exhibit SD-14 in support of Mr. Dion's affidavit referring to the "PROMOTION GO HOCKEY GO!" ["GO HOCKEY GO SALE!"]. The Applicant adds that if we follow the Opponent's position that this expression is used as a trade-mark, the Opponent would therefore be justified in claiming that the following expressions are also trade-marks: "Go Look", "Go plaisirs d'hiver!", "Go Performance" as well as "Mode sportive", "Pour ceux qui bougent", "Look et confort", "Beau et chaud", "Pour un hiver qui bouge" ["Go Look," "Go Winter Fun," "Go Performance," "Sport Mode," "For Those Who Move," "Style and Comfort," "Warm and Beautiful," "For a Winter That Moves"] etc. All these references are "used" by the Opponent for promotional purposes in its advertising, as shown in various pages of the flyers filed as Exhibit SD-10 in support of Mr. Dion's affidavit.

[61] To the contrary, the Opponent asserts that the expression GO HOCKEY GO is not a simple generic slogan used on occasion. The Opponent asserts that it is a trade-mark having no meaning in itself and that the Opponent is not required to register a "sub-mark" of this nature.

[62] While the Opponent's submissions are not without merit, I find the evidence on file insufficient to conclude that the Opponent has discharged the burden of proof incumbent on it in support of the ground concerning the GO HOCKEY GO mark. The only exhibits relating to "GO HOCKEY GO" are [TRANSLATION] "two posters that were posted outside some of the franchised stores in September 2011" and [TRANSLATION] "photographs taken in January 2015 showing the posters outside the franchised stores in Plessisville and Donnacona" on which "GO HOCKEY GO" appears at the very bottom [Exhibit SD-13, an excerpt from which is included in Appendix A of this document], and a flyer issued by the Plessisville store on August 6, 2012 announcing the "GO HOCKEY GO SALE!" [Exhibit SD-14]. As noted by the Applicant, the expression "GO HOCKEY GO" appearing in Exhibit SD-14 is an integral part of the name of a sale event and does not specifically identify the Opponent's services and business. As for the posters in Exhibit SD-13, they each show a different hockey player using a BAUER or REEBOK uniform and equipment, with each of these brands appearing separately and ostensibly on the poster in question. When cross-examined about the nature and scope of the use of "GO HOCKEY GO," Mr. Dion's responses remained evasive. He testified that the posters filed as

Exhibit SD-13 were displayed on one of the exterior side walls instead of the frontage of the Plessisville and Donnacona stores. In the absence of further information and based on a review of these isolated posters alone, I cannot conclude that “GO HOCKEY GO” was in fact used by the Opponent as a trade-mark in association with its services and sports items and clothing retail business in order to discharge the burden of proof incumbent upon it in support of this ground of opposition.

[63] In light of the foregoing, I will focus my analysis of this ground of opposition to the Opponent’s GO SPORT trade-mark, for which the Opponent has demonstrated that the word and design marks (as shown in registrations TMA 821.020 and TMA821.016) have been used in association with the Hockey Goods and entire retail service for sports clothing, accessories and items offered through its franchised stores.

The Test for Confusion

[64] The test for confusion is one of first impression and imperfect recollection. According to section 6(2) of the Act, 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.

[65] In deciding whether these trade-marks cause confusion, the registrar must take into account all circumstances in the case, specifically those listed in section 6(5) of the Act, i.e. a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks or trade-names have been in use; c) the nature of the goods, services or business; d) the nature of the trade; e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive and a different weight could be given to each of these factors, depending on the situation [see *Mattel, Inc v 3894207 Canada Inc.* (2006), 2006 SCC 22, 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 2006 SCC 23, 49 CPR (4th) 401 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 2011 SCC 27, 92 CPR (4th) 361 (SCC) for a more thorough examination of the general principles governing the test for confusion].

The inherent distinctiveness of the trade-marks and the extent to which they have become known

[66] The parties' marks have an equivalent inherent distinctiveness in the context of the goods and/or services associated with them. Although the "GO" portion cannot be considered "generic" or clearly descriptive of the parties' goods and services as claimed by the Applicant, the same cannot be said for the "SPORT" and "HOCKEY" portions.

[67] The design portions included in the Mark, while original, add to the Mark's suggestiveness to the extent that they represent a hockey helmet and damaged rink bottom.

[68] It is possible to increase the strength of a trade-mark by making it known through promotion or use in Canada.

[69] In the case at bar, the present applications for registration are based on the proposed use of the Mark in Canada and all of the Applicant's evidence of use and promotion of the Mark is after the material date for assessing this ground of opposition, namely the date of filing of the present applications.

[70] In comparison, and contrary to the Applicant's unfounded claims, the Opponent's evidence of use and promotion of the GO SPORT mark establishes that it had become known, at least to some extent, in certain regions of Quebec at the time the present applications were filed and that it has not been abandoned by the Opponent.

[71] Consequently, my overall assessment of this first factor favours the Opponent.

The period during which the trade-marks have been in use

[72] Given my comments above, this factor also favours the Opponent.

The nature of the goods, services or enterprises and the nature of the trade

[73] The Applicant asserts that [TRANSLATION] "the products sold by the Opponent and the Applicant differ [...] significantly" and that [TRANSLATION] "the mere fact that [the parties] are

both involved in the retail sale of sporting goods and items is not sufficient to conclude that it is the same type of goods” The Applicant adds that:

[TRANSLATION]

4.17 [...] the parties’ products are intended for two entirely different markets and, therefore, there is no likelihood of confusion. To this effect, the Applicant points out that, while the likelihood of confusion must be assessed against the average consumer, this consumer must nevertheless be interested and likely to buy the type of product in question. In this case, a consumer interested in purchasing hockey equipment and items has no chance of making a mistake and dealing with a non-specialized sports item supplier.

4.18 Moreover, purchasing hockey equipment is an investment for the average consumer, and there is every reason to believe that it will not be done lightly, thoughtlessly and hastily [...].

[74] The Applicant emphasizes the fact that its GO HOCKEY store and the Opponent’s GO SPORT stores are located in different cities, with the nearest store using the GO SPORT mark being located in Donnacona. The Applicant also insists that the Opponent’s stores are general sporting goods stores, while its store is exclusively dedicated to the sale of hockey goods and equipment and has a much larger and more extensive inventory of models and brands of hockey goods and equipment than non-specialized sporting goods retailers.

[75] The Opponent makes an opposite claim, asserting that the parties’ goods and services are the same or related, and that they are intended for the same types of consumers. The Opponent points out that, in his cross-examination, Mr. Dion specified the approximate size of the area dedicated to hockey goods at each of the Opponent’s franchised stores. The GO SPORT store in Drummondville has the largest amount of floor space (40%) dedicated to hockey goods, and the Shawinigan store follows with approximately 20%. The other franchised stores allocate approximately 10% of their total floor space to hockey [see response to Undertaking No. 3 given during cross-examination, in addition to Exhibit SD-8 filed in support of Mr. Dion’s affidavit].

[76] The Opponent further points out that the current geographical location of the parties’ stores is irrelevant for the purposes of this analysis because the test for confusion set out in section 6(2) of the Act is based on the hypothetical use of both trade-marks in the same area. The Opponent also points out that the test for confusion does not consist in asking whether

[TRANSLATION] “a consumer interested in purchasing hockey equipment and items has no chance

of making a mistake and dealing with a non-specialized sports item supplier,” but rather, whether the use of the Mark and of the Opponent’s mark in the same region would be likely to lead to the inference that the goods associated with these trade-marks are manufactured, sold, leased or rented, or that the services associated with these trade-marks are rented or performed, by the same person, or that they otherwise originate from or have been licensed, sponsored or approved by the Opponent.

[77] I agree with the Opponent that the parties’ goods and services and their channels of trade are directly overlapping. The same applies to the target customer base of the parties’ respective retail stores, regardless of what the Applicant says.

[78] Consequently, my overall assessment of these third and fourth factors favours the Opponent.

The degree of resemblance between the trade-marks in the presentation or sound, or in the ideas they suggest

[79] As recalled by the Supreme Court in the *Masterpiece* case cited above, in paragraph 49, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them is the factor that is often likely to have the greatest effect on the confusion analysis and the one that proves decisive in most cases.

[80] Moreover, as previously mentioned, it is well-established in case law that the likelihood of confusion is a matter of first impression and imperfect recollection. In this regard, “[w]hile registrations must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public’s perception of it” [*Pink Panther Beauty Corp v United Artists Corp* (1998), 80 CPR (3d) 247 (FCA), para 34]. Even though it is true that, in some cases, the first word of a trade-mark is the most important aspect for establishing its distinctiveness, a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique [*Masterpiece, supra*, para 64].

[81] In the case at bar, the parties’ marks have the same “architecture”. Both consist of two words, with the word “GO” appearing first and being the dominant aspect, given that the

“HOCKEY” and “SPORT” aspects are clearly descriptive or generic in the context of the parties’ goods and services. In this regard, I disagree with the Applicant’s argument that:

[TRANSLATION]

4.6 [...] the main distinctive aspect of the Mark is the word “HOCKEY,” which represents the fundamental characteristics of the Applicant’s goods, and not the word “GO,” which is obviously a generic and common term that could refer to any type of good, in any field. In fact, and ironically, when used on its own, the term “GO” does not express anything distinctive.

[...]

4.12 The lack of confusion is even more certain given that the Mark’s main distinctive aspect is the word “HOCKEY,” which represents the fundamental characteristics of the Applicant’s goods, and not the word “GO”.

[82] It is true that the word “HOCKEY” indicates that the goods and services associated with the Mark are exclusively related to hockey. However, this does not make it the most distinctive aspect that lends “originality” to the Mark. The same is true for the design portions representing a hockey helmet and damaged rink bottom. Even though they have a certain degree of originality in of themselves and are prominent in a visual respect only, these graphic elements only reinforce the idea that the goods and services associated with the Mark are exclusively related to hockey. This leaves the “GO” portion. In this regard, as the Opponent mentioned at the oral hearing, the Applicant’s claims that it is a [TRANSLATION] “generic and common” term in the context of the parties’ services are not supported by the evidence on file (I will come back to this point by discussing Ms. Breton’s statutory declaration in my assessment of additional circumstances below). Instead, I agree with the Opponent that, when considered in combination with the other portion(s) of the marks in presence and in the context of the goods and services associated with them, the “GO” portion suggests the idea of “Come on!” “Let’s go!” in association with sport in general or hockey, as the case may be.

[83] In light of the foregoing, I agree with the Opponent that there are significant similarities between the parties’ marks and the ideas they suggest.

[84] However, I consider these similarities to be less pronounced at the phonetic and visual levels. Even though the “GO” portion appearing in the first part of these marks is dominant, the terms “HOCKEY” and “SPORT” are not phonetically similar. Similarly, the design portion of

the Mark and the design versions of the GO SPORT mark, as represented in Registrations TMA821,020 and TMA821,016, are not visually similar, except that the GO SPORT mark uses the same one-line and two-line variations in the layout of the words “GO” and “SPORT”.

[85] In summary, when all three aspects of the degree of resemblance are taken into account, I find that the parties’ marks are more similar than dissimilar, but only slightly, particularly when the design versions of the GO SPORT mark are considered rather than its nominal version.

Additional circumstance—State of the register

[86] The Applicant asserts that Ms. Breton’s statutory declaration demonstrates that:

[TRANSLATION]

[...] as of April 6, 2015, 4,640 trade-marks containing the terms “GO” and/or “SPORT” were registered with the Canadian Intellectual Property Office for various types of goods. In addition, of these, several trade-marks identical to the Opponent’s, specifically marks formed by the sole term “GO,” were and continue to be registered for several types of goods, including:

- Sports clothing and items;
- Shoes and safety boots;
- Books, magazines, promotional items;
- Paintball equipment and accessories;
- Handbags, sunglasses;
- Outdoor games.

[87] Evidence of the state of the register serves to show the common nature or the distinctiveness of a mark or part of a mark in relation to all the marks appearing in the register. The evidence regarding the state of the register is relevant only insofar as one can draw conclusions from it concerning the state of the marketplace, and conclusions regarding the state of the marketplace can only be drawn if a large number of relevant registrations are identified [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[88] In the case at bar, the exhibits included with Ms. Breton's statutory declaration consist of the following:

- EB-1: a page listing the results of the register search for trade-marks that include the word "SPORT" as an aspect of the trade-mark; details about each of the marks in question are not included.
- EB-2: a page listing the results of the register search for trade-marks that include the word "GO" as an aspect of the trade-mark; details about each of the marks in question are not included.
- EB-3: a page listing the results of the register search for trade-marks that include the word "GO" as an aspect of the trade-mark and the word "SPORT" in the statement of goods; details about each of the marks in question are not included.
- EB-4 and EB-5: a summary table prepared by Ms. Breton following the results of the search filed as Exhibit EB-3 listing the [TRANSLATION] "trade-marks using the word 'GO' for goods or services related to sport" and the data sheets for these marks. It includes the Opponent's registered mark GO CHAUSSURES SPORT and nine other registered marks, as well as an allowed trade-mark application in the name of third parties.
- EB-6: a montage prepared by Ms. Breton [TRANSLATION] "containing logos and trade-marks of all kinds" found through a search on *www.google.com* using the terms "GO" and "SPORT".

[89] With particular reference to the third-party trade-marks listed in Exhibits EB-4 and EB-5, the Opponent rightly points out that none of them are associated with sporting goods retail services. At most, six or seven of them are associated with clothing and/or various types of bags, such as GO HABS GO; GO.COLOR & Design; GO THE HEALTHY WAY; GO PAINTBALL; LET GO; GO RED Design; GO! SAC; and GO ORGANIC.

[90] With regard to Exhibit EB-6, the Opponent rightly points out that it is a simple montage prepared by Ms. Breton and providing no details as to the web addresses of the sites that were allegedly accessed, nor excerpts from these websites. The Opponent further argues that, in the absence of conclusive information about the source and origin (Canadian vs. foreign) of the

websites allegedly accessed, it is not possible, in all objectivity, to assess the relevance of the montage.

[91] In the circumstances, I agree with the Opponent that no negative inferences can be drawn regarding the prevalence of the word “GO” as a component of trade-marks in relation to retail sales of sport items on the Canadian market.

Conclusion—Likelihood of Confusion

[92] As I indicated previously, the Applicant bears the legal onus of establishing, on a balance of probabilities, that each of its applications complies with the requirements of the Act. The fact that the Applicant bears the legal onus means that, if it is impossible to reach a determining conclusion once all the evidence has been presented, the question must be decided against the Applicant.

[93] Contrary to the Applicant’s claims, the issue is not whether the Opponent should be granted a monopoly on the word “GO” in Canada, but whether a person with an imperfect recollection of the Opponent’s GO SPORT trade-mark, used in association with the Opponent’s Hockey Goods and retail services for clothing, accessories and sporting goods, would believe, based on a first impression and imperfect recollection, that the Applicant’s goods and services come from the same source or are otherwise associated with or authorized by the Opponent.

[94] Although the parties’ marks differ from each other in certain respects (particularly when considering the design versions of the GO SPORT mark as shown in registrations TMA821,020 and TMA821,016 rather than the word mark only) and are not inherently strong, the Opponent’s GO SPORT mark had become known at least to some extent in certain regions of Quebec, which increased its distinctiveness compared with the Mark at the time the present applications were filed. In addition, the parties’ goods and services and their respective marketing channels are the same or clearly overlapping, with the Opponent’s franchised stores allocating in some cases approximately as much as 20% to 40% of their floor space to hockey products and in other cases approximately 10%. I find the state of the register evidence on the files insufficient to counterbalance the factors favouring the Opponent in the cases under consideration, particularly with respect to the parties’ services. At best for the Applicant, I find the balance of probabilities

to be equal. Accordingly, I find that the Applicant has not discharged its legal burden to demonstrate that, on the date the present applications were filed, there was no reasonable likelihood that a person with an imperfect recollection of the GO SPORT trade-mark could conclude, on the basis of their first impression and imperfect recollection, that the Applicant's goods and services originate from the same source or that an agreement exists between the parties.

[95] Therefore, I accept the ground of opposition based on section 16(3)(a) of the Act in each case.

Non-registrability of the Mark under section 12(1)(d) of the Act

[96] Each of the statements of opposition alleges that the Mark is not registrable within the meaning of section 12(1)(d) of the Act on the ground that it creates confusion with the Opponent's GO SPORT registered trade-marks, described above in paragraph 9 of my decision.

[97] The relevant date for deciding on a ground of opposition based on the non-registrability of a trade-mark in regard to the confusion created with a registered trade-mark is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[98] I exercised my discretion and checked that each of the registrations alleged by the Opponent in support of this ground is still in effect in the Register of Trade-marks. Since this is the case, the Opponent has met the initial burden of proof incumbent on it. The Applicant must now show, on a balance of probabilities, that there is no risk of confusion between the Mark and either of these marks registered by the Opponent.

[99] I will focus my analysis of this ground of opposition with respect to the GO SPORT word mark registered under TMA821,022, which is the Opponent's strongest argument. If this mark does not allow the Opponent to succeed, the other cited marks will not allow it to do so either.

[100] While the test for confusion is the same, the difference between the relevant dates impacts my preceding analysis regarding the ground of opposition based on the non-registrability of the Mark under section 16(3)(a) of the Act.

[101] Indeed, I must now take into account the extent to which the Mark has become known and the period during which it has been in use (see the factors set out in sections 6(5)(a) and (b) of the Act).

[102] The evidence of the Mark's use and promotion filed by the Applicant through the affidavit of Mr. Jean Landry, and in particular the substantial sales and advertising figures for the period between March 1, 2015 and March 31, 2015, lead me to conclude that the Mark has become known, even well known, in and around Québec City. This increases its distinctiveness. Accordingly, my overall assessment of the factor set out in section 6(5)(a) of the Act no longer favours the Opponent so significantly. The same applies to the factor set out in section 6(5)(b) of the Act in that, even if the Opponent's mark has been in use longer than the Applicant's, the Mark has nevertheless been used since July 23, 2014. That said, I am not prepared to draw a negative inference concerning the likelihood of confusion between the marks in light of their concurrent use since this date, given the fact that the parties have, until now, conducted their activities in different geographical areas, as emphasized by the Applicant.

[103] On the other hand, the factor set out in section 6(5)(e) of the Act is more favourable towards the Opponent in that I must also consider not the manner in which the Opponent's GO SPORT mark has been used but rather the rights conferred by the registration of the GO SPORT word mark and how the Opponent could use its registered mark.

[104] In accordance with the principle set out in paragraph 55 of the *Masterpiece* case *supra*, the registration of the GO SPORT word mark allows the Opponent to use it in "in any size and with any style of lettering, color or design," it being understood, however, that [TRANSLATION] "one should be careful not to give the principle set out in paragraph 55 of *Masterpiece* too great a scope" since it would no longer be necessary to register a design mark when a word mark is owned. [...]. When comparing the marks, the examination is always limited to a "use [...] within the scope of a registration" (*Masterpiece*, para 59) [*Pizzaiolo Restaurants inc v Les Restaurants La Pizzaiolle inc*, 2016 FCA 265, para 33].

[105] Accordingly, my overall assessment of the factor set out in section 6(5)(e) of the Act now favours the Opponent more strongly. Thus, even if the assessment of the factors set out in section 6(5)(a) and (b) of the Act no longer favours the Opponent as significantly to the

detriment of the Applicant, I find these factors insufficient to counterbalance the factor set out in section 6(5)(e) and to tip the balance of probabilities in favour of the Applicant.

[106] Therefore, I accept the ground of opposition based on section 12(1)(d) of the Act in each case, to the extent that it is based upon the GO SPORT word mark registered under No. TMA821,022.

Other grounds of opposition

[107] In light of the foregoing, I do not consider it necessary to consider the other grounds for opposition put forward by the Opponent.

DECISION

[108] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse each of the applications pursuant to the provisions of section 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified translation
Monique James

APPENDIX A



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

HEARING DATE: 2018-07-18

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