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

Citation: 2019 TMOB 44

Date of Decision: 2019-05-29

IN THE MATTER OF AN OPPOSITION

Polaris Industries Inc.	**Opponent**
and	
Vittoria Industries Ltd.	**Applicant**
1,617,531 for VITTORIA & Design	**Application**

INTRODUCTION

[1] On March 8, 2013, Vittoria S.p.A filed application No. 1,617,531 (the Application) to register the trade-mark VITTORIA & Design (the Mark), depicted below:

[2] The Application claims priority to European Union trade-mark (EUTM) application No. 11541554 filed with the European Union Intellectual Property Office (EUIPO) on February 4, 2013. The Application is based on proposed use of the Mark in Canada in association with the

following goods, as amended:

> Motorcycles, scooters; sport utility vehicles, bicycles; Gear boxes for land vehicles; Inner tubes for pneumatic tires [tyres]; Tires for vehicle wheels; Studs for tires [tyres]; motorcycle cars; Casings for pneumatic tires [tyres]; bicycle brakes; bicycle handle bars; bicycle mudguards; Pedals for bicycles; Tires for bicycles, motorcycles; Vehicle wheel tires [tyres]; Adhesive rubber patches for repairing inner tubes; Freewheels for bicycles; Wheels for bicycles, motorcycles; bicycles and motorcycle saddles; Tubeless tires [tyres] for bicycles, motorcycles.

[3] At an earlier stage, the Application also included a claim to use of the Mark in the European Union in conjunction with the eventual registration of the Mark with the EUIPO; however, on August 3, 2017, the Application was amended to remove the foreign use and eventual registration basis. Thus, the sole basis for the Application is proposed use of the Mark in Canada.

[4] The Application was advertised for opposition purposes in the *Trade-marks Journal* on November 26, 2014.

[5] On November 26, 2015, Polaris Industries Inc. (the Opponent) filed a statement of opposition against the Application. The Applicant filed a counter statement denying the grounds of opposition. Both the statement of opposition and counter statement were later amended by the parties, as discussed below.

[6] On May 3, 2016, an assignment of the Application from Vittoria S.p.A to Vittoria Industries Ltd. (the Applicant) was filed with the Registrar. That change in ownership of the Application was recorded by the Registrar on June 2, 2016. The assignment document entitled "DECLARATION OF OCCURRED ASSIGNMENT" (the Assignment) is dated March 7, 2016 and describes that the transfer of the Mark which is the subject of the Application from Vittoria S.p.A. to the Applicant took place on December 4, 2013. In effect, the Assignment purports to be a confirmatory or *nunc pro tunc* assignment, confirming a transfer of rights which took place at an earlier date.

[7] On November 24, 2016, the Opponent sought leave to file a revised statement of opposition, which was accepted. The grounds of opposition in the revised statement of opposition are summarized below. I note that the revised statement of opposition includes

grounds of opposition under section 30(d) of the Act based on alleged deficiencies in the claim to foreign use and registration of the Mark, as well a ground of opposition based on section 16(2)(a) of the Act relating to non-entitlement for an application based on foreign use and registration. However, since the foreign use and registration basis for the Application was deleted on August 3, 2017, the section 30(d) and 16(2)(a) grounds of opposition are now moot and have therefore been dismissed. The remaining grounds of opposition may be summarized below.

a. The Application does not comply with section 30(a) of the Act because as of December 4, 2013, Vittoria S.p.A. was no longer the owner of the Application, and thus subsequent correspondence relating to the prosecution of the Application filed by Vittoria S.p.A. must be disregarded, which leaves all section 30(a) objections raised by the Examiner unanswered.

b. The Application does not comply with section 30(a) of the Act, because the Application as advertised did not contain a statement in ordinary commercial terms of the specific goods with which the Mark was proposed to be used. In particular, the goods that are not stated in ordinary commercial terms are "Cycle cars", "Tires for […] cycles", and "Tubeless tires [tyres] for […] cycles".

c. The Application does not comply with section 30(e) of the Act, in that the named applicant, Vittoria S.p.A., did not intend to use the Mark in Canada with all of the goods described in the Application.

d. The Application does not comply with section 30(e) of the Act, because effective December 4, 2013, the Application was assigned to Vittoria Industries Ltd, but the amended applications filed on December 19, 2013 and June 4, 2014 did not contain a statement that the assignee, Vittoria Industries Ltd., intended to use the Mark in Canada; instead, these amended applications continued to name Vittoria S.p.A. as the applicant and to state that Vittoria S.p.A. intends to use the Mark in Canada.

e. The Application does not comply with section 30(i) of the Act, because effective December 4, 2013, the Application was assigned to Vittoria Industries Ltd., but the amended applications filed on December 19, 2013 and June 4, 2014 continued to name

Vittoria S.p.A. as the applicant and to assert that Vittoria S.p.A. was satisfied that it was entitled to register the Mark in Canada.

f. Contrary to Section 12(1)(d) of the Act, the Mark is not registrable in association with the goods: "motorcycles"; "wheels for motorcycles"; "motorcycle saddles"; "scooters"; "sport utility vehicles"; and "tires for cycles", "tubeless tires [tyres] for cycles", and "cycle cars" if these cycles and cycle cars encompass motorcycles or other motorized cycles, because the Mark if used with these goods is confusing with the Opponent's family of registered VICTORY trade-marks, many of which are registered in association with motorcycles and parts therefor. The registered trade-marks on which the Opponent relies are set out in Schedule A to this decision.

g. Contrary to Section 16(3)(a) of the Act, Vittoria S.p.A. is not the person entitled to registration of the Mark in association with the goods: "motorcycles"; "wheels for motorcycles"; "motorcycle saddles"; "scooters"; "sport utility vehicles"; and "tires for cycles", "tubeless tires [tyres] for cycles", and "cycle cars" if these cycles and cycle cars encompass motorcycles or other motorized cycles, because at the date the Application was filed (March 8, 2013) and at the alleged priority filing date (February 4, 2013), the Mark was confusing with the Opponent's VICTORY trade-marks previously used or made known in Canada.

h. Contrary to Section 2 of the Act, the Mark does not actually distinguish and is not adapted to distinguish the goods of the Applicant from the goods or services of others, namely Vittoria S.p.A., because the Mark was assigned from Vittoria S.p.A. to the Applicant effective December 4, 2013; however, Vittoria S.p.A. continued to be identified as the owner of the Mark and the source of the goods sold in association with the Mark in Canada.

i. Contrary to Section 2 of the Act, the Mark does not actually distinguish and is not adapted to distinguish the goods of the Applicant from the goods or services of others, namely Vittoria S.p.A., because the Mark was assigned from Vittoria S.p.A. to the Applicant effective December 4, 2013; however, Vittoria S.p.A. continued to be identified as the owner of the Mark and to purport to license others to use the Mark in

Canada and to purport to control the quality of the goods sold in association with the Mark in Canada.

j. Contrary to Section 2 of the Act, the Mark does not actually distinguish and is not adapted to distinguish the goods of the Applicant from the goods or services of others, namely Vittoria S.p.A., because the Mark was assigned from Vittoria S.p.A. to the Applicant effective December 4, 2013; however, after the effective date, the Applicant did not control the character and quality of the goods sold in association with the Mark in Canada.

k. Contrary to Section 2 of the Act, the Mark is not distinctive in Canada of the Applicant's goods in that the Mark does not distinguish, nor is it adapted to distinguish, the following goods of the Applicant:

> "motorcycles"; "wheels for motorcycles"; "motorcycle saddles"; "scooters"; "sport utility vehicles"; and "tires for cycles", "tubeless tires [tyres] for cycles", and "cycle cars" if these cycles and cycle cars encompass motorcycles or other motorized cycles

from the goods and services of the Opponent, having regard to the Opponent's prior use of its VICTORY trade-marks.

[8] On August 3, 2017, the Applicant sought leave to file a revised counter statement, which was accepted. The revised counter statement denies the grounds of opposition set out in the revised statement of opposition.

[9] Both parties filed evidence which is discussed below. Only the Applicant filed a Written Argument. An oral hearing was not requested.

EVIDENCE

[10] The Opponent's evidence is comprised of the following:

- Affidavit of Brandon Evenson dated June 1, 2016. Mr. Evenson is a lawyer and trade-mark agent with the firm representing the Opponent. His affidavit attaches printouts from various websites, including from the Canadian Intellectual Property Office, the EUIPO,

www.vittoria.com, www.victorymotorcycles.com/en-ca/, as well as archived versions of webpages from the website www.victorymotorcycles.com/en-ca/.

- Certified copy of the records of the Registrar of Trade-marks for the Application from filing to advertisement (inclusive).

- Certified copy of the records of the Registrar of Trade-marks for a proceeding under section 45 of the Act relating to registration No. TMA549,319 (VITTORIA DESIGN). The Applicant is the registered owner of registration No. TMA549,319.

- Certified copy of the records of the Registrar of Trade-marks for registration No. TMA729,501 (VICTORY). The Opponent is the registered owner of registration TMA729,501.

[11] Mr. Evenson was cross-examined on his affidavit and the transcript was filed on April 3, 2017.

[12] The Applicant's evidence is comprised of the following two affidavits:

- Affidavit of Thomas James dated July 27, 2017. Mr. James is a Trade-mark Research – Analyst with CompuMark. His affidavit includes the results of searches for trade-marks and business names having the prefix "VICTOR".

- Affidavit of Eric C. Devenny dated August 3, 2017. Mr. Devenny is a trade-mark agent with the firm representing the Applicant. His affidavit includes printouts of the websites of various businesses, as well as particulars of telephone conversations Mr. Devenny indicates he had with representatives of some of those businesses.

[13] Neither Mr. Thomas nor Mr. Devenny were cross-examined on their affidavits.

ONUS AND MATERIAL DATES

[14] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the 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].

[15] The material dates with respect to the grounds of opposition are as follows:

- Sections 38(2)(a)/30 of the Act - 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) of the Act - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c)/16(3) of the Act – the priority filing date of the Application [sections 16(3) and 34 of the Act]; and
- Sections 38(2)(d) of the Act - the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185, 34 CPR (4th) 317 (FC)].

GROUNDS OF OPPOSITION SUMMARILY REJECTED

Non-compliance with section 30(a) of the Act – description of goods

[16] Paragraph 8(a)(ii) of the revised statement of opposition alleges that the following goods in the Application are not described in ordinary commercial terms in compliance with section 30(a) of the Act:

> "Cycle cars", "Tires for […] cycles" and "Tubeless tires [tyres] for […] cycles."

[17] By virtue of amendments made to the Application on August 3, 2017 and February 12, 2018, the above descriptions were amended to the following:

> "Motorcycle cars", "Tires for […] motorcycles" and "Tubeless tires [tyres] for […] motorcycles."

[18] The Opponent did not seek leave to amend its statement of opposition to contest the amended descriptions, or make any submissions regarding non-compliance of the amended descriptions with section 30(a). Further, in my view, there is no evidence of record to suggest

that the amended descriptions are not in accordance with section 30(a) of the Act. Consequently, I dismiss the section 30(a) ground of opposition set out in paragraph 8(a)(ii) of the revised statement of opposition.

Non-compliance with sections 30(a), 30(e) and 30(i) of the Act due to the Assignment

[19] In paragraphs 8(a)(i), (viii), (ix) and (x) of the revised statement of opposition, the Opponent asserts multiple deficiencies in the Application by virtue of the filing of the Assignment on May 3, 2016 which transferred ownership of the Application from Vittoria S.p.A. to the Applicant. Specifically, the Opponent alleges that because the Assignment purports to confirm the transfer of the Application was effective as of December 4, 2013, steps taken during prosecution of the Application after December 4, 2013 in the name Vittoria S.p.A. were not valid. For example, the Opponent asserts that amendments made to the Application in the name of Vittoria S.p.A. on December 19, 2013 and June 4, 2014 were not valid because Vittoria S.p.A. no longer owned the Application. Also, the Opponent asserts that, after December 4, 2013, the statements in the Application regarding Vittoria S.p.A. intending to use the Mark and being satisfied of its entitlement to register the Mark were not valid because Vittoria S.p.A. was no longer the owner of the Application.

[20] Section 48 of the Act permits the transfer of a trade-mark from one party to another and for the Registrar to register such a transfer. There is no prohibition in the Act or Regulations on recording a transfer which purports to be confirmatory or *nunc pro tunc*.

[21] In the present case, there is no dispute that at the time of filing the Application, namely, March 8, 2013, Vittoria S.p.A. was the entity which owned the Mark and was properly named as the applicant having the intent to use the mark in Canada and that was satisfied of its entitlement to register the Mark. Over three years after filing the Application, the Assignment was filed transferring ownership of the Application to the current Applicant. The Assignment purported to be confirmatory of a transfer which took place on December 4, 2013. I am not aware of any provision of the Act or Regulations or any jurisprudence to suggest that a confirmatory assignment of this nature can invalidate an application under sections 30(a), 30(e) or 30(i) of the Act as contended by the Opponent in its revised statement of opposition (with the possible exception of an assignment that purports to have an effective date preceding the application

filing date, but that is not the case here). The Opponent has provided no submissions on this point or referenced any legislative provision or jurisprudence to support its position.

[22] If I were to adopt the Opponent's position on this point, any assignment of an application purporting to have an effective date prior to an amendment to the application would have the effect of invalidating the application. In the absence of clear authority to support this position, in my view, such facts do not support a ground of opposition under sections 30(a), 30(e) or 30(i) of the Act.

[23] In view of the above, I find that the facts pleaded by the Opponent in paragraphs 8(a)(i), (viii), (ix) and (x) of the revised statement of opposition do not constitute valid grounds of opposition under sections 30(a), 30(e) or 30(i) of the Act, and I therefore dismiss these grounds of opposition.

Non-compliance with sections 30(e) of the Act – no intent to use the Mark

[24] In paragraph 8(a)(viii) of the revised statement of opposition, the Opponent alleges that the Application does not comply with section 30(e) of the Act, because the named applicant, Vittoria S.p.A., did not intend to use the Mark in Canada in association with all of the goods described in the Application.

[25] In my view, the evidence of record is not sufficient to permit the Opponent to meet its initial evidential burden for this ground. The Opponent has not directed the Registrar to what evidence, if any, it believes supports this ground. I note that the Evenson affidavit includes printouts of searches Mr. Evenson conducted on the website www.vittoria.com for goods listed in the Application. However, in my view, there is nothing in that evidence which is inconsistent with the stated intention of the Applicant (and its predecessor in title Vittoria S.p.A.) to use the Mark in association with all of the goods listed in the Application.

[26] Consequently, in my view, the Opponent has not met its initial evidential burden with respect to this section 30(e) ground of opposition and so it is dismissed.

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

[27] This ground of opposition is set out in paragraph 8(c)(ii) of the revised statement of opposition. As with the other grounds of opposition which are based on alleged confusion between the Mark and the Opponent's VICTORY trade-marks, the Opponent has alleged confusion only in respect of a subset of the goods listed in the Application. That subset of goods is identified in the revised statement of opposition as follows:

> "motorcycles"; "wheels for motorcycles"; "motorcycle saddles"; "scooters"; "sport utility vehicles"; and "tires for cycles", "tubeless tires [tyres] for cycles", and "cycle cars" if these cycles and cycle cars encompass motorcycles or other motorized cycles

[28] As noted previously, the descriptions "Cycle cars", "Tires for […] cycles" and "Tubeless tires [tyres] for […] cycles" in the Application were amended to "Motorcycle cars", "Tires for […] motorcycles" and "Tubeless tires [tyres] for […] motorcycles", respectively, and so it is apparent that those goods do relate to motorcycles.

[29] I will refer to the goods (as amended) for which the Opponent alleges a likelihood of confusion as the "Impugned Goods". The revised statement of opposition indicates that the Opponent only alleges confusion in respect of the Impugned Goods and does not allege confusion in respect of the remaining goods listed in the application. For ease of reference, set out below is the list of goods (as amended) with the Impugned Goods underlined:

> Motorcycles, scooters; sport utility vehicles, bicycles; Gear boxes for land vehicles; Inner tubes for pneumatic tires [tyres]; Tires for vehicle wheels; Studs for tires [tyres]; motorcycle cars; Casings for pneumatic tires [tyres]; bicycle brakes; bicycle handle bars; bicycle mudguards; Pedals for bicycles; Tires for bicycles, motorcycles; Vehicle wheel tires [tyres]; Adhesive rubber patches for repairing inner tubes; Freewheels for bicycles; Wheels for bicycles, motorcycles; bicycles and motorcycle saddles; Tubeless tires [tyres] for bicycles, motorcycles.

[30] With the ground of opposition under section 16(3)(a), the Opponent has an initial evidential burden to demonstrate use of its trade-mark(s) in Canada prior to the priority filing date of the Application (February 4, 2013) and non-abandonment of the Opponent's trade-mark(s) as of the date of advertisement (November 26, 2014).

[31] In the present case, the Opponent has included as part of its evidence a certified copy of its registration No. TMA729,501 for the trade-mark VICTORY which is registered in association with the goods “motorcycles”. However, a certified copy alone only permits the Registrar to assume a de minimus use of the opponent's trade-mark (see *Red Carpet Food Systems Inc v Furgale*, CarswellNat 5089, [2003] TMOB 52 and *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)) and is not sufficient to meet an opponent's evidential burden with respect to a ground of opposition based on allegations of non-entitlement based on prior use (see *Rooxs Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB)).

[32] The Evenson affidavit filed by the Opponent includes printouts of multiple pages from the website www.victorymotorcycles.com/en-ca/, as well as archived versions of those web-pages. However, there is no information regarding the extent to which Canadians have visited or viewed those web-pages, or any data relating to the volume of goods or services offered or sold in Canada in association with the Opponent’s trade-marks. Also, I note that these website printouts were not attested to by a representative of the Opponent or someone who otherwise had first-hand knowledge of the ownership and operation of the website and its content. Mr. Evenson is not an employee of the Opponent and, as was established during his cross-examination, does not have first-hand knowledge regarding the ownership and operation of this website [see pages 38-43/Q86-102 of the transcript of the cross-examination of Mr. Evenson].

[33] In my view, this evidence is not sufficient to demonstrate use or making known by the Opponent of its VICTORY trade-marks in association with any goods or services in Canada prior to the relevant date, and thus the Opponent has not met its initial evidential burden under section 16(3)(a). This ground of opposition is therefore dismissed.

[34] In any event, even if I had found that the Opponent’s evidence was sufficient to meet its evidential burden under the section 16(3)(a) ground of opposition, I would have found no likelihood of confusion between the Mark and the Opponent’s trade-marks, for the same reasons set out in my consideration of the section 12(1)(d) ground of opposition, discussed below.

Non-distinctiveness as a result of the Assignment

[35] Paragraphs 8(d)(i), (ii) and (iii) of the revised statement of opposition allege that, contrary to section 2 of the Act, the Mark does not actually distinguish and is not adapted to distinguish the goods of the Applicant from the goods or services of others, namely Vittoria S.p.A., because:

- the Mark was assigned from Vittoria S.p.A. to the Applicant effective December 4, 2013; however, Vittoria S.p.A. continued to be identified as the owner of the Mark and the source of the goods sold in association with the Mark in Canada;

- the Mark was assigned from Vittoria S.p.A. to the Applicant effective December 4, 2013; however, Vittoria S.p.A. continued to be identified as the owner of the Mark and to purport to license others to use the Mark in Canada and to purport to control the quality of the goods sold in association with the Mark in Canada; and

- the Mark was assigned from Vittoria S.p.A. to the Applicant effective December 4, 2013; however, after the effective date, the Applicant did not control the character and quality of the goods sold in association with the Mark in Canada.

[36] The Opponent has not directed the Registrar to what evidence of record, if any, supports the above grounds of opposition, nor am I able to identify such evidence based on my own review of the record. Consequently, I find that the opponent has not met its initial evidential burden with respect to the distinctiveness grounds of opposition set out in paragraphs 8(d)(i), (ii) and (iii) of the revised statement of opposition, and therefore these grounds of opposition are dismissed.

Non-distinctiveness as a result of the Opponent's use of its VICTORY trade-marks

[37] Paragraph 8(d)(iv) of the revised statement of opposition alleges that, contrary to section 2 of the Act, the Mark is not distinctive in Canada of the Applicant's goods in that the Mark does not distinguish, nor is it adapted to distinguish, the Impugned Goods of the Applicant from the goods and services of the Opponent, having regard to the Opponent's prior use of its VICTORY trade-marks.

[38] In order to meet its initial evidential burden under this ground of opposition, an opponent must show that its trade-marks had a substantial, significant or sufficient reputation in Canada in association with relevant goods and/or services so as to negate the distinctiveness of the applied for trade-mark [see *Motel 6, Inc v No 6 Motel Ltd*, (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427].

[39] In the present case, the Opponent has not provided sufficient evidence of the use or making known of its VICTORY trade-marks in Canada to meet its initial evidential burden with respect to this distinctiveness ground of opposition. In particular, as discussed above with respect to the section 16(3)(a) ground of opposition, there is no evidence of record regarding the extent to which the opponent's trade-marks were used in Canada or known by Canadians. Therefore, the Opponent has not met its initial evidential burden and this ground of opposition is dismissed.

REMAINING GROUNDS OF OPPOSITION

Section 12(1)(d) – Confusion with the Opponent's registered trade-marks

[40] The Opponent's evidence includes a certified copy of the Opponent's registration No. TMA729,501 for the trade-mark VICTORY. This certified copy is sufficient to meet the Opponent's initial burden under the section 12(1)(d) ground of opposition with respect to that registration, and I have exercised my discretion to confirm that registration is extant. With respect to the remaining registrations relied upon by the Opponent in the revised statement of opposition, the Registrar is permitted to exercise its discretion to confirm that the registrations are extant, and an opponent in this manner can meet its initial burden under section 12(1)(d) [see *Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB) and *Morsam Fashions Inc v HK Enterprises Inc* (1996), 66 CPR (3d) 387 (TMOB)]. I have exercised my discretion and checked the Register to confirm that the registrations relied on by the Opponent - set out in Schedule A to this decision - are also extant. I note that particulars from the Canadian Intellectual Property Office website for each of the registrations relied upon by the Opponent are also included in Exhibit 20 to the Evenson Affidavit.

[41] Thus, the Opponent has met its initial evidential burden for the section 12(1)(d) ground of opposition in respect of the registrations listed in the revised statement of opposition.

[42] In considering this ground of opposition, I will assess the likelihood of confusion between the Mark and the Opponent's registered trade-mark VICTORY (TMA729,501) as I consider this registration to represent the Opponent's strongest case in terms of the degree of resemblance and the degree of overlap in goods with the Application. If there is no likelihood of confusion between the Mark and the Opponent's trade-mark VICTORY (TMA729,501), then there will be no likelihood of confusion between the Mark and the Opponent's remaining registered trade-marks included in Schedule A, as the Opponent's remaining registered trade-marks contain additional word or design elements which lessen the degree of resemblance with the Applicant's Mark, or are registered in association with different goods or services.

Test for confusion

[43] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trade-mark causes confusion with another trade-mark 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, whether or not the goods and services are of the same general class. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): 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.

[44] 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, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 (SCC) 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. In considering the likelihood of confusion, I have assessed the respective parties' marks from the perspective of a unilingual Anglophone, unilingual Francophone and bilingual English/French

consumer [see *Mattel, supra*; see also *Mexx International BV v Poulin* (2004), 35 CPR (4th) 241 (TMOB)].

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

[45] The Opponent's trade-mark VICTORY is an English word which does not directly describe the nature of the Opponent's goods. In this regard, this Board in the past has recognized that the mark VICTORY has, at most, a slightly laudatory connotation in association with the Opponent's goods [see *Victory Cycle Ltd v Polaris Industries, Inc*, 2006 CanLII 80719 (TMOB)]. Thus, I find that the Opponent's mark possesses some inherent distinctiveness.

[46] With respect to the Applicant's Mark, the word component "vittoria" has no meaning in English or French. As indicated in the Application (as required pursuant to Rule 29 of the Trade-marks Regulations) and as acknowledged by the Applicant in it is written argument, the word "vittoria" in Italian means "victory". As discussed in greater detail below with respect to the degree of resemblance factor, while I am prepared to take judicial notice that there are Canadians fluent in Italian who would understand "vittoria" to mean "victory", there is no evidence of record in this proceeding as to how many Canadians would have that understanding or that a substantial proportion of the Applicant's target market in Canada would have that understanding. The Applicant's Mark also includes a stylized tire design component which is somewhat suggestive of the Applicant's goods. However, as a whole, I find that the Applicant's Mark is inherently stronger than the Opponent's mark.

[47] There is no evidence from either party regarding the extent to which their marks have become known in Canada. As discussed above, while the Evenson affidavit includes printouts of multiple pages from the website www.victorymotorcycles.com/en-ca/, as well as archived versions of those web-pages, I have no information regarding the extent to which Canadians have viewed those web-pages, or are otherwise familiar with the Opponent's trade-marks.

[48] In view of the above, I find that, overall, this factor favours the Applicant.

Length of time the trade-marks have been in use

[49] There is no evidence from either party on this point. While the Evenson affidavit includes archived versions of the website www.victorymotorcycles.com/en-ca/, in the absence of any data relating to sales in Canada or exposure of Canadians to this website, in my view, this evidence is not sufficient to demonstrate the Opponent's use of its trade-mark VICTORY in association with goods or services in Canada or the duration of any such use.

Nature of the goods and services; nature of the trade

[50] The Opponent's registration No. TMA729,501 is registered in association with the goods "motorcycles".

[51] The Impugned Goods in the Application are underlined below:

> Motorcycles, scooters; sport utility vehicles, bicycles; Gear boxes for land vehicles; Inner tubes for pneumatic tires [tyres]; Tires for vehicle wheels; Studs for tires [tyres]; motorcycle cars; Casings for pneumatic tires [tyres]; bicycle brakes; bicycle handle bars; bicycle mudguards; Pedals for bicycles; Tires for bicycles, motorcycles; Vehicle wheel tires [tyres]; Adhesive rubber patches for repairing inner tubes; Freewheels for bicycles; Wheels for bicycles, motorcycles; bicycles and motorcycle saddles; Tubeless tires [tyres] for bicycles, motorcycles.

[52] I find that the Impugned Goods do overlap with the goods of the Opponent, as both relate to motorcycles or powered wheeled vehicles.

[53] With respect to the nature of the trade, as I do not have evidence from the parties speaking to this point, I must assess this issue with a view to determining the probable type of business or trade intended rather than all possible trades that might be encompassed by the words in the list of goods included in the Application [see *Bridgestone Corporation v Campagnolo SRL*, 2014 FC 37, 117 CPR (4th) 1 at para 55]. As the Impugned Goods overlap with the goods listed in the Opponent's registration No. TMA729,501, in my view, the channels of trade will likely overlap as well.

[54] Thus, with respect to the Impugned Goods, this factor favours the Opponent.

[55] As noted above, the revised statement of opposition indicates that the Opponent asserts a likelihood of confusion only in respect of the Impugned Goods and does not assert a likelihood

of confusion in respect of the remaining goods in the Application. Therefore, there is no need to consider this factor with respect to the remaining goods.

Degree of resemblance

[56] With respect to the appearance and sound of the respective parties' marks, in my view, the degree of resemblance is low. Visually, the similarities are limited to the components "vi" and "tor" which are common to both marks. When sounded, the Applicant's Mark has four syllables compared to the Opponent's trade-mark VICTORY which has three. When pronounced, the hard ⟨c⟩ of Opponent's trade-mark VICTORY is absent from the Applicant's Mark. The Applicant's Mark also includes a design element which is absent from the Opponent's trade-mark and there is no evidence that the Opponent depicts its trade-mark in conjunction with a similar design.

[57] With respect to the ideas conveyed by the marks, in my view, this factor also favours the Applicant. In particular, the Opponent's trade-mark VICTORY is a commonly used English word meaning "success" or "triumph". The term "vittoria" has no meaning in English or French. While I am prepared to take judicial notice that there are Canadians who speak Italian and would understand the word component of the Applicant's Mark to mean "victory", there is no evidence of record in this proceeding as to how many Canadians would have that understanding, or that a substantial proportion of the likely Canadian consumers of the parties' goods would have that understanding. For example, in *Krazy Glue Inc v Grupo Cyanomex SA de CV* (1989), 27 CPR (3d) 28 (TMOB), the Registrar rejected an opposition to the mark KOLA LOKA on the basis of the opponent's registered trade-mark KRAZY GLUE, despite evidence that the words "cola loca" in Spanish translates to "crazy glue", as there was no evidence of record which permitted the Registrar to conclude how many Canadian consumers understand Spanish. Similarly, in *Robert Bosch GmbH v Grupo Bler de Mexico SA de CV* (1997), 76 CPR (3d) 397 (TMOB), the Registrar rejected an opposition to the trade-mark BLUE POINT based on the opponent's registered trade-mark BLAUPUNKT (German for "blue point") in the absence of evidence as to how many Canadian consumers would understand the translation.

[58] In addition, in this proceeding there is no evidence of record to suggest that the Applicant's target market is a particular subset of Canadians that would understand Italian, such

that I could assume that a significant portion of prospective purchasers of the parties' goods would understand the word "vittoria" to mean "victory" [see *Cheung Kong (Holdings) Ltd v Living Realty Inc* (1999), 4 CPR (4th) 71 (FCTD) where the opposition to a mark consisting of Chinese characters based on the opponent's mark CHEUNG KONG succeeded because the evidence indicated that the applicant was specifically targeting the Chinese speaking community in Toronto who would understand the Chinese characters and their transliteration].

[59] Consequently, in the absence of evidence that a significant proportion of relevant Canadian purchasers would understand the word "vittoria" to translate to "victory", and since the word "vittoria" has no meaning in English or French, I must assume that a typical unilingual Anglophone, unilingual Francophone, or bilingual English-French Canadian consumer would perceive the word "vittoria" as having no particular meaning. Thus, the Applicant's Mark does not resemble the Opponent's trade-mark in terms of the idea conveyed.

[60] For the reasons set out above, in my view, the degree of resemblance factor favours the Applicant.

Surrounding circumstances

Family of trade-marks

[61] The Opponent in its revised statement of opposition asserts that it owns a "family" of registered trade-marks. However, in order to benefit from the wider scope of protection that may be afforded to a "family" of trade-marks, an opponent must prove use of each of the marks in the family [*McDonald's Corp v Alberto-Culver Co* (1995), 61 CPR (3d) 382 (TMOB)]. In the present case, since there is no evidence of use by the Opponent of any of its marks in Canada, the Opponent cannot rely on a "family" of trade-marks.

State of the register and state of the marketplace evidence

[62] The Applicant included extensive evidence and written submissions regarding third party trade-mark registrations and alleged third party use of trade-marks and trade-names in Canada which included the term "VICTORY" or the term/prefix "VICTOR" in fields related to motor vehicles. The Applicant's position is that this evidence of third party use and registration in

Canada of similar marks narrows the scope of protection which should be afforded to the Opponent's marks.

[63] Some examples of third party trade-mark registrations included in this evidence are set out in the table, below.

Reg. No.	Trade-mark	Owner	Goods/Services
TMA561506	VICTORY	Pride Mobility Products Corporation	Three and four wheel electrically powered scooter vehicles for use both indoors and outdoors aimed at elderly, disabled, handicapped and infirm persons.
TMA414443	VICTORY LAP	Clean Plus, Inc.	Alternator and starter repair kits.
TMA728340	VICTOR EQUIPMENT	Just Wheels & Tires Co.	Land vehicle parts, namely, wheels.
TMA429029	VICTORACER	Kumho Industrial Co., Ltd.	Automobile tires and tubes
TMA116042	VICTORIA	Ford Motor Company of Canada Limited	Automotive Vehicles

[64] On balance, I do not find that the state of the register and state of the marketplace evidence has a significant impact on the confusion analysis in the present case. For example, this evidence does not demonstrate that the term "VICTORY" *per se* has been registered or used by third parties in Canada in association with motorcycles or motorcycle accessories, specifically. Consequently, I find that the state of the register and state of the marketplace evidence is effectively neutral in this case, as it does not assist the Opponent, and does not favour the Applicant to a significant degree.

Conclusion regarding the Section 12(1)(d) ground

[65] In view of the above, and in particular having regard to the inherent distinctiveness of the Applicant's mark and lack of resemblance between the parties' marks, I am satisfied on a balance of probabilities that there is no likelihood of confusion between the Mark and the Opponent's registered trade-mark VICTORY (TMA729,501). In particular, I am satisfied that a consumer with an imperfect recollection of the Opponent's registered trade-mark VICTORY when seeing the Applicant's Mark in association with the Impugned Goods listed in the

Application, would not infer that the Applicant's goods share the same source as the Opponent or are otherwise associated with the Opponent.

[66] As I have found no likelihood of confusion with respect to the Opponent's registered trade-mark VICTORY (TMA729,501), I similarly find no likelihood of confusion between the Mark and the Opponent's remaining registered trade-marks included in Schedule A.

DISPOSITION

[67] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

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

SCHEDULE A

Opponent's Registrations

Reg. No.	Trade-mark	Goods/Services
TMA729501	VICTORY	Motorcycles
TMA721474	VICTORY AND DESIGN 	Motorcycles and their parts and fittings
TMA557789	VICTORY CYCLE	Retail sales and servicing of motorcycles, parts and accessories.
TMA710130	VICTORY	(1) Non-luminous and non-mechanical metal signs; common metal belt buckles; common metal key fobs; common metal key chains; common metal zipper pulls; pewter belt buckles; pewter key fobs; pewter key chains; pewter zipper pulls. (2) Truck floor mats; mud flaps. (3) Jewelry, bracelets, earrings, clocks; belt buckles of precious metals; key chains of precious metals; lapel pins, collector coins; wood nutcracker. (4) Posters; books; decals; decal kits, photo albums; daily planners, pens; calendars. (5) Barstools; cup holders; stools. (6) Mugs, drinking glasses; stainless steel insulated vacuum bottles; can coolers; water bottles, saddlebag coolers, collapsible bag coolers, floating coolers; collector steins. (7) Fleece blankets; blankets; cloth pennants; felt pennants. (8) Belts, bandannas, scarves, caps, hats; warm-up suits; factory race pullover shell, factory race long sideline jacket, factory race check vest, factory race pants, factory race bibs, factory race leather pants, factory race rider jersey and factory race driver gloves; wind shirt, wind pants, polo shirt, denim shirt, knit sweater, knit vest, gloves, jackets, pants, chaps, rainsuits, fleece thermal and nylon bomber caps, stocking caps, face mask, neck gaiters, riding chaps, bib overalls and coveralls for motocycle riders; headbands, ball caps, boots, hiking boots,

		work boots, rugged all-weather boots, balaclavas; hand warmers. (9) Wallpaper. (10) Toy vehicles and miniature vehicle replicas.
TMA685459	VICTORY RIDERS ASSOCIATION	Association services, namely, promoting the interests of riders of motorcycles and motorcycle riding.
TMA721438	VICTORY PERFORMANCE	(1) Motorcycle exhaust pipes. (2) Motorcycle exhaust pipes and clothing, namely, t-shirts, caps and leather jackets.
TMA730418	VICTORY VISION	Clothing, namely, shirts and hats.
TMA735628	VICTORY MOTORCYCLES	Dresses, parkas, belts, bandannas, scarves, sweat pants, t-shirts, shirts, sweaters, hats, jackets, pants, chaps, rain suits and gloves, namely, leather gloves, driving gloves, riding gloves, motorcycle gloves and winter gloves; warm up suits, shorts; baby clothing, namely, shirts, shorts, pants, jumpers, pajamas, cloth bibs, overalls; racing shell pullovers; check vests; mittens, neck gaiters, headbands, balaclavas; clothing, namely, vests and leather vests, hand warmers; and coveralls, sweatshirts, boots, caps and knit hats.
TMA736139	VICTORY MOTORCYCLES & Design VICTORY MOTORCYCLES	Dresses, parkas, belts, bandannas, scarves, sweat pants, t-shirts, shirts, sweaters, hats, jackets, pants, chaps, rain suits and gloves, namely, leather gloves, driving gloves, riding gloves, motorcycle gloves and winter gloves; warm up suits, shorts; baby clothing, namely, shirts, shorts, pants, jumpers, pajamas, cloth bibs, overalls; racing shell pullovers; check vests; mittens, neck gaiters, headbands, balaclavas; clothing, namely, vests and leather vests, hand warmers; and coveralls, sweatshirts, boots, caps and knit hats.
TMA737963	VICTORY CHALLENCE	Motorcycles and structural parts therefor.
TMA776407	VICTORY VISION	Motorcycles and structural parts therefor.
TMA768082	VICTORY BACKROADS	Motorcycles and structural parts therefor.
TMA787830	VICTORY CROSS ROADS	Motorcycles and structural parts therefor.
TMA787828	VICTORY CROSS COUNTRY	Motorcycles and structural parts therefor.
TMA838197	VICTORY V MOTORCYCLES & Design	Motorcycles and structural parts therefor.
TMA865932	VICTORY JUDGE	Motorcycles and structural parts therefor.
TMA839044	V VICTORY	Motorcycles and structural parts therefor.

	MOTORCYCLES USA & Design	

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

No Hearing Held

AGENTS OF RECORD

Borden Ladner Gervais LLP	FOR THE OPPONENT
Aventum IP Law LLP	FOR THE APPLICANT