



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 105

Date of Decision: 2020-09-10

IN THE MATTER OF AN OPPOSITION

Playboy Enterprises International, Inc.	Opponent
and	
Pleasure Playmates	Applicant
1,691,928 for PLEASURE PLAYMATES	Application

INTRODUCTION

[1] Playboy Enterprises International, Inc. (the Opponent) opposes registration of the trademark PLEASURE PLAYMATES (the Mark), which is the subject of application No. 1,691,928 by Pleasure Playmates (the Applicant).

[2] The Mark is applied for in association with the following services:

- (1) Escort services.
- (2) Dating services.
- (3) Operation of an online interactive computer website advertising the wares and services of others.

[3] The opposition is based on an allegation that the application does not conform to the requirements of section 30 of the *Trademarks Act* (the Act) and that the Mark is confusing with

the Opponent's PLAYMATE and related trademarks, previously registered or applied for in Canada in association with similar goods and services.

THE RECORD

[4] The application for the Mark was filed on September 2, 2014 on the basis of proposed use in Canada.

[5] The application was advertised for opposition purposes on March 2, 2016. Numerous amendments to the Act came into force on June 17, 2019. As the application was advertised prior to June 17, 2019, pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read immediately before that date, an exception being that, with respect to confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[6] On August 2, 2016, the Opponent opposed the application by filing a statement of opposition under section 38 of the Act. The grounds of opposition are based on sections 30(e), 30(i), 12(1)(d), 16(3)(a), and 2 of the Act.

[7] The Applicant submitted a counter statement denying each of the grounds set out in the statement of opposition.

[8] In support of its opposition, the Opponent filed the affidavit of Eric Devenny, sworn February 13, 2017 in Ottawa, Ontario [the Devenny Affidavit]. Mr. Devenny was not cross-examined.

[9] In support of its application, the Applicant filed the affidavit of Kathryn Melnyk, sworn June 9, 2017 in Calgary, Alberta. The transcript of Ms. Melnyk's cross-examination was made of record.

[10] On July 5, 2018, the Opponent was granted leave to amend its statement of opposition. The Applicant was subsequently granted leave to amend its counterstatement on August 30, 2018.

[11] Both parties submitted written representations and attended an oral hearing.

[12] Before assessing the grounds of opposition, I will first provide an overview of the parties' evidence, the evidential burden on the Opponent, and the legal onus on the Applicant.

OVERVIEW OF THE OPPONENT'S EVIDENCE

[13] Mr. Devenny is a trademark agent with the Opponent's agent of record. He conducted various corporate and Internet searches related to the Applicant's business. Those search results include the following:

- A corporate profile report from the Government of Alberta for "Pleasure Playmates Inc." and related corporate certificates [para 7, Exhibits C and D];
- A printout of the website *www.pleasureplaymates.ca* from February 2017 [para 9, Exhibit E];
- A printout of the website *pleasureplaymates.com* from September 2014, accessed through the Internet Archive WayBackMachine at *archive.org* [para 12, Exhibit G].
- A printout of a 2013 decision from the World Intellectual Property Organization (WIPO) Uniform Dispute Resolution Process (UDRP) Administrative Panel, *Playboy Enterprises International, Inc. v P.P. Inc / Pleasure Playmates Inc.*, Case No D2013-1386, which relates, *inter alia*, to the website *pleasureplaymates.com* [para 15, Exhibit H].
- A printout of the *Twitter.com* user profile and tweets of the "@pleasuremates" account as of February 2017 [para 17, Exhibit I].

OVERVIEW OF THE APPLICANT'S EVIDENCE

[14] The Melnyk Affidavit is brief and can be summarized as follows:

- Ms. Melnyk is the director of Pleasure Playmates Inc. [para 1].
- Exhibit B is a copy of the aforementioned WIPO UDRP Administrative Panel Decision for Case No. D2013-1386 [referred to below as the WIPO UDRP decision].

- Exhibit C is a copy of the “PLEASURE PLAYMATES” business license from the City of Calgary from 2016/2017.
- Exhibit D is a copy of Pleasure Playmates Inc.’s Alberta Business Corporations Act Certificate of Incorporation, indicating that the company was incorporated in Alberta on April 29, 2009.
- Exhibit E is a printout from CIPO’s trademarks register of the search results for trademarks containing the words “playmate” or “playmates”, omitting results for trademarks owned by the Opponent.

[15] Relevant portions of Ms. Melnyk’s cross-examination will be discussed below.

EVIDENTIAL BURDEN AND LEGAL ONUS

[16] Before considering the grounds of opposition, it is necessary to review the basic requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[17] With respect to (i), in accordance with the usual rules of evidence, there is an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd*, 1990 CarswellNat 1053, 30 CPR (3d) 293 (FCTD)]. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

[18] With respect to (ii), the legal onus is on the applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent in the statement of opposition (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on an applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against the applicant.

SECTION 30(E) GROUND OF OPPOSITION - APPLICATION REQUIREMENTS

[19] Section 30 of the Act (as it then was), states as follows:

An applicant for the registration of a trademark shall file with the Registrar an application containing [...] (e) in the case of a proposed trademark, a statement that the applicant [...] intends to use the trademark in Canada.

[20] The Opponent pleads that the application does not comply with the requirements of section 30(e) of the Act for the following reasons:

- the Applicant had used the Mark prior to filing an application on the basis of proposed use;
- in the alternative, the Applicant did not and does not intend to use the Mark in association with the applied-for services; and
- the application was filed in the name of a trading style, Pleasure Playmates, and not the legal entity that owns the mark, Pleasure Playmates Inc.

[21] The material date with respect to compliance with section 30 of the Act is the filing date of the application, September 2, 2014.

Is the Applicant a legal entity?

[22] In the circumstances, it is appropriate to first consider the question of whether the application was filed in the name of a trading style, Pleasure Playmates, rather than that of a legal entity.

[23] Fundamentally, a trademark is a mark or sign used by a “person” for the purposes of distinguishing the goods or services of that person from those of others. While the definition of “person” under section 2 of the Act is broad, it has been held that a trading style does not fall into the definition of “person” for purposes of the Act [*Cie des Montres Longines Francillon SA v Pinto Trading Co* (1983), 75 CPR (2d) 283 at 285 (TMOB)].

[24] In this case, the Opponent’s evidence includes the results of corporate name searches for corporations that include the term “Pleasure Playmates” from all Canadian jurisdictions [Devenny Affidavit, paras 5 to 7, Exhibits B to D]. Such searches disclosed the existence of one such entity, Pleasure Playmates Inc. The Applicant’s evidence includes the Calgary business license for “PLEASURE PLAYMATES”, which indicates that the business owner is Pleasure

Playmates Inc. [Melnyk Affidavit, Exhibit C]. In Ms. Melnyk's cross-examination, she confirmed that the business called "Pleasure Playmates" is not a separate business from Pleasure Playmates Inc. [Melnyk cross-examination, page 6, lines 6 to 9].

[25] Accordingly, it would appear that the subject application was filed in the name of a trading style, rather than that of a legal entity. At a minimum, I am not satisfied that the Applicant has met its burden to demonstrate that the application complies with this aspect of section 30(e) of the Act. In this respect, I would first note that it cannot be said that the Applicant *per se* had used the Mark prior to filing the application on the basis of proposed use. As discussed below, any use of the Mark was by the legal entity, Pleasure Playmates Inc. More importantly, however, as the Applicant was not a legal entity, it could not have the requisite intention to use the Mark as required by section 30(e) of the Act (as it then was).

[26] While section 35 of the current *Trademarks Regulations* (the Regulations) permits the amendment of an application "to correct an error in the applicant's identification", no such amendment has been requested as of the date of this decision.

[27] It follows that this ground of opposition is successful.

Was the Mark used prior to the filing date?

[28] I would further note that, had the application been amended to change the name of the applicant to Pleasure Playmates Inc., this ground of opposition would also be successful on the basis that the Mark had been used prior to the filing date of the application.

[29] In this respect, the Opponent's evidence includes printouts of the *pleasureplaymates.com* website as it appeared on August 17, 2014 [Devenny Affidavit, paras 12 and 13, Exhibit G]. Copyright notices dated 2009 or 2013 for Pleasure Playmates Inc. appear on each page and the Mark appears throughout.

[30] At paragraph 2 of its counter statement, the Applicant states that "the applicant has used the name Pleasure Playmates as its corporation name prior to filling an application for trademark". While this pleading is arguably ambiguous regarding use of the Mark in association with the applied-for services prior to the filing date, Ms. Melnyk confirms that her business has been

offering dating and escort services in the Calgary area since 2009 [Melnyk cross-examination, page 15, lines 15 to 24]. More specifically, Ms. Melnyk confirms that the Mark was used in association with those services since at least as early as 2010 or 2011, but in any event prior to the filing date of the application [page 16, lines 4 to 13 and page 20, lines 10 to 19].

[31] In sum, this appears to be a case where the application was filed on the basis of proposed use in Canada in error. While the 2019 amendments to the Act Regulations now permit an applicant to amend the basis of their application [as indicated in the *Practice Notice on the Amendment and Deletion of Use, Proposed Use, and Use and Registration Abroad Claims* published June 17, 2019], no such amendment has been requested in this proceeding as of the date of this decision.

[32] Accordingly, in the absence of such an amendment, had the application been filed (or amended to be) in the name of Pleasure Playmates Inc., this ground of opposition would have been successful.

SECTION 30(i) GROUND OF OPPOSITION – STATEMENT OF ENTITLEMENT

[33] Notwithstanding the distinction above with respect to the Applicant and the legal entity Pleasure Playmates Inc., for the remainder of this decision, I will refer to both as the Applicant for the sake of simplicity.

[34] The Opponent pleads that the application does not comply with the requirements of section 30(i) of the Act because the Applicant cannot be satisfied that it is entitled to register the Mark in Canada in view of the prior use by the Opponent of a family of trademarks comprising the terms PLAYBOY and PLAYMATE. In this respect, the Opponent pleads that:

- The Applicant should have been aware that it is not the party entitled to register the Mark in Canada given the fact that the Opponent and its family of PLAYBOY and PLAYMATE trademarks are well known in the adult entertainment industry;
- The Applicant was well aware and familiar with the Opponent and its trademarks, having been forced to transfer to the Opponent three different domain names containing the word

“playmates” as a result of WIPO UDRP proceedings “followed by an In Rem Action against one of the domain names that was initiated in Virginia”; and

- The Applicant filed its application for the Mark after such WIPO UDRP proceedings were initiated.

[35] Section 30(i) of the Act, as it then was, merely required that an applicant include a statement in its application that it is satisfied that it is entitled to use its trademark in Canada in association with the goods or services described in the application. Where this statement has been provided, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol Myers Co*, 1974 CarswellNat 476, 15 CPR (2d) 152 (TMOB)]. Mere knowledge of the existence of an opponent’s trademark does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use its trademark [*Woot, Inc v WootRestaurants Inc*, 2012 TMOB 197].

[36] In this case, the Opponent references two decisions from foreign jurisdictions regarding the transfer of website domain names from the Applicant to the Opponent.

[37] First, while they may be considered for their persuasive value where appropriate, foreign decisions are not binding upon the Registrar [see *Neutrogena Corp v Guaber SRL* (1993), 49 CPR (3d) 282 (TMOB); *Origins Natural Resources v Warnaco US* (2000), 9 CPR (4th) 540 (TMOB) at 548].

[38] Second, only the aforementioned WIPO UDRP decision from 2013 is before me. I note that the panel in that case found that the complainant Opponent had failed to make out its case with respect to the domain name *pleasureplaymates.com* and declined to order Pleasure Playmates Inc. to transfer that domain name to the Opponent.

[39] While the parties confirmed that this *.com* domain name was subsequently transferred to the Opponent, the Applicant indicates in its representations that this was due to a default judgement for a proceeding that took place in the Northern District of Virginia Federal Court.

[40] Accordingly, while not determinative in itself, I consider the WIPO UDRP decision to actually be consistent with the Applicant's statement under section 30(i) of the Act.

[41] In view of the foregoing, the ground of opposition based on section 30(i) of the Act is rejected.

12(1)(D) GROUND OF OPPOSITION – CONFUSION WITH A REGISTERED TRADEMARK

[42] The Opponent pleads that the Mark is not registrable by virtue of section 12(1)(d) of the Act since it is confusing with one or more of the trademarks that are part of the Opponent's family of trademarks comprising the terms PLAYBOY and PLAYMATE, registered for various goods and services relating to the adult entertainment industry.

[43] Attached as Schedule A to the statement of opposition are two charts. The first chart shows 26 registrations owned by the Opponent that include the term PLAYMATE. The second chart shows 48 registrations owned by the Opponent that include the term PLAYBOY.

[44] I note that the Opponent did not discuss this ground of opposition or the issue of confusion in its written representations. At the hearing, the Opponent briefly addressed the issue of confusion, acknowledging that it did not submit evidence of use of any of its trademarks. Rather, the Opponent referenced a small subset of its PLAYMATE registrations that include goods and services that in some way relate to "adult entertainment".

[45] Given that the Opponent's PLAYBOY trademarks have less resemblance to the Mark than its PLAYMATE trademarks, I do not consider it necessary to discuss the PLAYBOY trademarks. Further, as there is no evidence of use of the Opponent's trademarks before me, I do not consider it necessary to discuss all of the Opponent's PLAYMATE trademarks. As acknowledged by the Opponent at the hearing, many of the registrations are for or include goods completely unrelated to "adult entertainment" – much less dating and escort services – such as "photo frames" (TMA818,526), "coasters" (TMA592,467), "trading cards" (TMA444,209), and "scraper mitts" (TMA327,669).

[46] Having been directed to only a small subset of potentially relevant Opponent's PLAYMATE registrations, I will focus only on the registrations listed in the table below:

PLAYMATE TMA419,150	Registration Date: 05-Nov-1993 Goods: (1) Monthly magazines. (2) Calendars. (3) Pre-recorded video cassettes. (4) Phonograph records and cartridge tapes. Services: (1) Entertainment services, namely, presentation of shows with musical and comedy revues featuring singing, dancing and other variety entertainment; communication services which include the development, production and transmission, including via satellite, of cable and free television programs. (2) Entertainment in the nature of pre-recorded wake-up messages by telephone.
PLAYMATE TMA531,445	Registration Date: 18-Aug-2000 Services: Computer services, namely providing on-line magazines in the field of fashion, entertainment, health, lifestyle and other topics of general interest.
PLAYMATE TMA586,208	Registration Date: 30-July-2003 Goods: Electronic games, namely slot machines, video games, video game cartridges, video game cassettes, hand-held units for playing electronic games, video discs, and video game discs; board games, pinball machines and puzzles, all related to the field of adult themed entertainment.
PLAYMATE TMA586,332	Registration Date: 31-July-2003 Goods: Adult dolls.
PLAYMATE TMA672,867	Registration Date: 19-Sep-2006 Goods: Pre-programmed data storage media, namely computer disks, compact disks, CD-ROM's and DVD's featuring computer games, music, images, magazine content or adult entertainment.

[47] I have exercised my discretion to check the register and confirm that these five registrations remain extant [see *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[48] As discussed further below, it is not necessarily clear which of these registrations represent the Opponent's strongest case. Nevertheless, I will refer to these registrations collectively as the PLAYMATE mark below, as the analysis for each is essentially the same. Furthermore, I will initially focus on the applied-for dating and escort services, and then comment briefly on the applied-for advertising services at the close of the analysis.

Test to determine confusion

[49] The test to determine the issue of confusion is set out in section 6(2) of the Act which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same

person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[50] The test to be applied is a matter of first impression in the mind of a casual consumer “somewhat in a hurry” who sees the Mark in association with the applied-for services at a time when they have no more than an imperfect recollection of the Opponent’s trademark and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[51] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods, services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[52] The criteria in section 6(5) of the Act are not exhaustive and different weight will be given to each one in a context-specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 1 SCR 772]. In *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 (SCC), the Supreme Court of Canada stated that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis [at para 49] and that, while the first word in the mark may be the most important in some cases, the preferable approach is to first consider whether there is an aspect of the trademark that is particularly “striking or unique” [at para 66].

Degree of Resemblance

[53] There is some resemblance in appearance and sound between the Mark and the Opponent’s PLAYMATE trademark, in that the Mark incorporates PLAYMATE in its entirety, albeit pluralized and prefaced with PLEASURE. Although the first portion of the Mark is PLEASURE, it acts as an adjective for the more striking term PLAYMATES.

[54] Furthermore, there is some resemblance in the ideas suggested, in that PLAYMATE invokes the idea of a companion and the Mark invokes the idea of pleasurable companions.

[55] In this respect, the aforementioned WIPO UDRP decision acknowledged that one of the definitions for PLAYMATE in the *Oxford English Dictionary* is that it is “used euphemistically to refer to a person’s lover” [at page 8]. Furthermore, per the Registrar’s discretion to take notice of dictionary definitions [see *Tradall SA v Devil’s Martini Inc*, 2011 TMOB 65], *Dictionary.com* provides the following definitions for PLAYMATE:

- 1 a companion, especially of a child, in play or recreation.
- 2 *Informal* a social companion or lover; girlfriend or boyfriend.

[56] Accordingly, I find this important factor favours the Opponent, albeit not to a high degree.

Inherent Distinctiveness and the Extent Known

[57] As a dictionary word, I do not consider the Opponent’s PLAYMATE trademark to possess a high degree of inherent distinctiveness, and given its “companion” meaning – while not descriptive – it has some suggestive meaning in association with the Opponent’s adult entertainment-related goods and services.

[58] As for the Mark, the additional adjective PLEASURE gives it a slightly higher degree of inherent distinctiveness than simply PLAYMATE, though the Mark as a whole also has a rather suggestive meaning in association with the Applicant’s dating and escort services.

[59] With respect to the extent the subject trademarks have become known in Canada, as noted above, there is no evidence regarding the extent to which the Opponent’s PLAYMATE trademark has become known in Canada in association with any of the associated goods and services. There is some evidence of use of the Mark since 2009, although the extent to which the Mark has become known in the Calgary area or otherwise has not been evidenced.

[60] Accordingly, I find this factor only nominally favours the Applicant.

Length of Time in Use

[61] Again, there is no evidence of use of the Opponent’s PLAYMATE trademark in Canada, and only minimal evidence of use of the Mark, since 2009.

[62] Accordingly, I find this factor only nominally favours the Applicant as well.

Nature of the Goods, Services or Business / Nature of the Trade

[63] When considering the nature of the goods and services of the parties in respect of the issue of confusion, it is the statements in the subject application and registrations that governs [*Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CarswellNat 749, 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[64] At the hearing, the Opponent submitted that the parties' respective goods and services are both related to adult entertainment.

[65] In its representations, the Applicant asserts that its services are *not* in the nature of entertainment, but rather are dating and escort services. It further notes that none of the Opponent's registrations are for "dating services", "escort services", or the like.

[66] Both parties may have benefitted greatly had they submitted evidence with respect to these factors. As asserted by the Applicant, the parties appear to be in different businesses and offer different products and services to the public. However, there are potentially some connections, albeit somewhat weak, between the applicant's dating and escort services and the Opponent's "adult entertainment"-related goods and services. For example, while not directly evidenced, I note that that the WIPO UDRP decision acknowledges that the Opponent is the publisher of *Playboy* magazine, a feature of which "incorporates a picture of a female model in the centrefold portion of the magazine" [at page 2]. Similarly, the Applicant's website and twitter feed display extensive sexualized imagery, including advertisements and photographs of women in lingerie. Broadly speaking, then, it can be said that the Applicant's services and the Opponent's goods and services (such as "adult dolls") both relate to sex and both parties likely target similar audiences seeking "adult" experiences.

[67] Accordingly, I find that this factor favours the Opponent, albeit in the absence of clear direct evidence, not to a high degree.

Additional Surrounding Circumstance: WIPO UDRP Decision

[68] As an additional surrounding circumstance, both parties referenced the aforementioned WIPO UDRP decision. As noted above, cases decided in foreign jurisdictions have no precedential authority on the Registrar. Suffice to say, given that proceeding involved a burden on the Opponent as the complainant and the assessment of different factors, I do not consider the WIPO UDRP decision in itself to be a surrounding circumstance favouring either party in this case.

Additional Surrounding Circumstance: State of the Register

[69] As noted above, the Melnyk Affidavit includes search results from CIPO's trademark register pertaining to third-party registrations that include the terms PLAYMATE or PLAYMATES. However, ten of these registrations are shown as expunged. Of the remaining three registrations, two are for the goods "portable container for ice, good and beverages" and one is for "toys ... but expressly excluding ... goods in the field of adult themed entertainment featuring female models in full or partial nudity".

[70] In any event, state of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [see *Ports International Ltd v Dunlop Ltd*, 1992 CarswellNat 1431, 41 CPR (3d) 432 (TMOB); and *Welch Foods Inc v Del Monte Corp*, 1992 CarswellNat 178, 44 CPR (3d) 205 (FCTD)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located [*Maximum Nutrition Ltd v Kellogg Salada Canada Inc*, 1992 CarswellNat 124, 43 CPR (3d) 349 (FCA)].

[71] In the absence of evidence of third-party use, there are too few relevant registered trademarks to draw any inference regarding the state of the Canadian marketplace with respect to the goods and services at issue. As such, I do not find the state of the register to be a relevant surrounding circumstance assisting either party

Conclusion – Confusion with the registered trademark PLAYMATE

[72] Having considered all of the surrounding circumstances, I find that the Applicant has not met its legal burden with respect to the applied-for dating and escort services.

[73] At best for the Applicant, I find the balance of probabilities regarding the likelihood of confusion as to the source of the parties' goods and services to be evenly balanced. I reach this conclusion due to the resemblance between the trademarks and the absence of clear evidence regarding potential overlap in the nature of the parties' goods, services, businesses and trades.

[74] As the onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion, I must find against the Applicant with respect to such services.

[75] With respect to the Applicant's service, "Operation of an online interactive computer website advertising the wares and services of others", given the inherently broad nature of such services with the potential to overlap with any and all goods and services – not just those related to sex or the adult entertainment industry – the above finding against the Applicant is stronger.

[76] Accordingly, this ground of opposition based on section 12(1)(d) of the Act is successful.

SECTION 16(3)(A) GROUND OF OPPOSITION – NON-ENTITLEMENT BASED ON PRIOR USE

[77] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(a) of the Act because at the date of filing, the Mark was confusing with one or more of the trademarks that are part of the Opponent's family of trademarks comprising the term PLAYBOY and PLAYMATE, which have been used and made known by the Opponent in association with various goods and services relating to the adult entertainment industry.

[78] To discharge its initial burden with respect to this section 16(3)(a) ground of opposition based on prior use a trademark, the Opponent was required to demonstrate use or making known of its trademark(s) in Canada prior to the material September 2, 2014 filing date. Some evidence

of use or making known is required [*Rooxs, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB)]. However, the Opponent submitted no such evidence with respect to any of its trademarks.

[79] Accordingly, this ground of opposition based on section 16(3)(a) of the Act is rejected.

SECTION 16(3)(B) GROUND OF OPPOSITION – NON-ENTITLEMENT BASED ON PRIOR APPLICATIONS

[80] The Opponent further pleads that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(b) of the Act because at the date of filing of the application, the Mark was confusing with one or more of the trademarks that are part of the Opponent's family of trademarks for or comprising PLAYBOY, applications for which had been filed prior to the Applicant's adoption of the Mark.

[81] Attached as Schedule B to the statement of opposition is a chart showing ten "pending" applications for trademarks owned by the Opponent that include the term PLAYBOY.

[82] To discharge its initial burden with respect to this section 16(3)(b) ground of opposition, the Opponent was required to show that its trademark application was (i) filed prior to the filing date of the application for the Mark and (ii) pending at the date of advertisement of the application for the Mark [section 16(4) of the Act]. The Registrar does have the discretion to check his records to confirm the existence of a pleaded pending application being relied upon in support of such a ground [see *Royal Appliance Manufacturing Co v Iona Appliances Inc*, 1990 CarswellNat 1466, 32 CPR (3d) 525 (TMOB)].

[83] However, I note that these PLAYBOY applications are for a variety of consumer goods (such as "perfumery", "bath oils", "socks", "linens", "travel bags", and "pyjamas") or for beverages (such as "fruit drinks" and "beer"). None of the applications are for services and none of the goods are clearly related to sex or the adult entertainment industry. Most importantly, none of these applications include the terms PLEASURE or PLAYMATE.

[84] As such, primarily given the lack of resemblance, in any event, I am satisfied that the Applicant meets its legal onus because I would not find any confusion in favour of the Opponent with respect to these PLAYBOY trademarks.

[85] Accordingly, this ground of opposition based on section 16(3)(b) of the Act is rejected.

SECTION 2 GROUND OF OPPOSITION – NON-DISTINCTIVENESS

[86] The Opponent pleads that, having regard to section 2 of the Act, the Mark is not distinctive of the Applicant's services since it does not actually distinguish nor is it adapted to distinguish the services in association with which it is used from the goods and services of the Opponent in Canada.

[87] The material date for this ground of opposition is the filing date of the opposition, namely, August 2, 2016 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317]. An opponent meets its evidentiary burden with respect to a non-distinctiveness ground if it shows that, as of the filing of the opposition, its trademark had become known to some extent at least to negate the distinctiveness of the applied-for trademark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)].

[88] I note that the Opponent did not specify any of its trademarks in its pleading with respect to this ground. In any event, as the Opponent submitted no evidence regarding the extent to which any of its trademarks have become known in Canada as of the material date or otherwise, the Opponent has not met its initial evidential burden with respect to this ground.

[89] Accordingly, this ground of opposition based on non-distinctiveness is rejected.

DISPOSITION

[90] In view of all of the foregoing, pursuant to section 38(12) of the Act and the authority delegated to me under section 63 of the Act, I refuse the application.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: 2020-06-26

APPEARANCES

Chantal Bertosa For the Opponent

Kathryn Melnyk For the Applicant

AGENTS OF RECORD

Aventum IP Law LLP For the Opponent

No one appointed For the Applicant