

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 153

Date of Decision: 2021-01-25

IN THE MATTER OF AN OPPOSITION

National Hockey League	Opponent
and	
Tap & Barrel Brands Ltd.	Applicant
1,711,378 for Badge Design	Application

INTRODUCTION

[1] National Hockey League (the Opponent) opposes registration of the trademark Badge Design (the Mark), which is the subject of application No. 1,711,378 by Tap & Barrel Brands Ltd. (the Applicant). The Mark is shown below:



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

Goods: Clothing, namely athletic and casual clothing; jackets; headwear, namely hats, caps, toques; glassware, namely, drinking glasses, beer glasses, shooter glasses; mugs; novelty items, namely, key chains, key rings, bottle openers, fridge magnets, pens, pencils; lighters;

Services: Restaurant and bar services; operation of a brewery.

[3] The opposition is largely based on an allegation that the Mark is confusing with the Opponent's NHL Shield Design and related trademarks, previously registered or used in Canada.

THE RECORD

[4] The application for the Mark was filed on January 19, 2015 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 *Trademarks Act* (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. The Applicant submitted a counter statement denying each of these grounds.

[7] In support of its opposition, the Opponent filed the following evidence:

- affidavit of Thomas H. Prochnow, sworn February 8, 2017 in New York, New York [the Prochnow Affidavit];
- affidavit of Herman Cheung, sworn February 13, 2017 in Toronto, Ontario [the Cheung Affidavit];
- affidavit of Dane Penney, sworn February 10, 2017 in Toronto, Ontario [the Penney Affidavit]; and
- as reply evidence, the affidavit of Thomas H. Prochnow, sworn June 20, 2018 in New York, New York [the Second Prochnow Affidavit].

[8] None of these affiants were cross-examined.

[9] In support of its application, the Applicant filed the following evidence:

- affidavit of Daniel Frankel, sworn October 24, 2017 in Vancouver, British Columbia [the Frankel Affidavit]; and
- affidavit of Jeannine Summers, sworn October 19, 2017 in Vancouver, British Columbia [the Summers Affidavit].

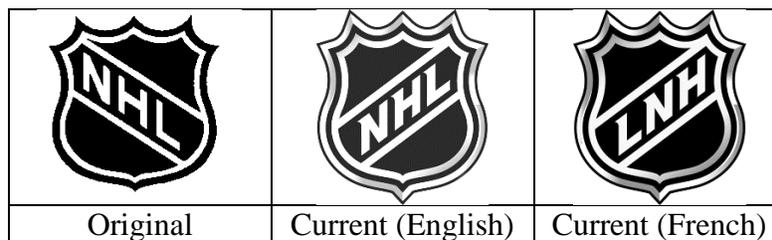
[10] Both of these affiants were cross-examined, and the transcripts and related undertakings were made of record.

[11] Both parties submitted written representations, but only the Opponent was represented at a hearing.

[12] Before assessing the grounds of opposition, I will first provide a broad 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] The Opponent is a professional ice hockey organization and the Owner of the six-pointed NHL Shield Design trademark and its variations (collectively, the NHL Shield Trademarks). As identified in the Prochnow Affidavit, the Opponent's original, current English, and current French variations are depicted below:



Prochnow Affidavit

[14] Mr. Prochnow is the Group Vice President, Legal and Business Affairs, of National Hockey League Enterprises Canada, Inc., which is the general partner of NHL Enterprises

Canada, L.P. (NHLE). NHLE is authorized to license and enforce the Opponent's trademark rights in Canada. The Prochnow Affidavit details the following:

- The history of the Opponent as a professional ice hockey organization, dating back to 1917 [para 3].
- The history of the Opponent's NHL Shield Trademarks [paras 4 and 5] and their various registrations [para 6].
- The use of the NHL Shield Trademarks and the extent to which such trademarks have become known in Canada in association with professional ice hockey [paras 7 to 11], as well as in association with a variety of licensed products [paras 12 to 18].
- The licensing and use of the NHL Shield Trademarks in association with beer and beer brewing specifically [paras 19 to 21 and 25], and in association with food and beverage products specifically [paras 22 and 23].

Cheung Affidavit

[15] Mr. Cheung is an Articling Law Student employed by the Opponent's agent. The Cheung Affidavit describes the following:

- His access of various books and resources relating to the Opponent and its display of the NHL Shield Trademarks [paras 3 and 4];
- Mr. Cheung's Internet searches relating to the NHL Shield Trademarks [para 5];
- Mr. Cheung's viewing of an NHL hockey game's live television broadcast at a Toronto sports bar and restaurant [para 6].

Penny Affidavit

[16] Mr. Penny is a Trademark Search Specialist employed by the Opponent's agent. The Penny Affidavit includes printouts from the Applicant's websites, *www.tapandbarrel.com* and *tapbrands.com*.

Second Prochnow Affidavit

[17] The Second Prochnow Affidavit is brief, and primarily relates to display of the outline of the NHL Shield Design as a portal for players to skate through at the NHL All Star Game held on January 28, 2018 in Tampa, Florida [para 4].

OVERVIEW OF THE APPLICANT'S EVIDENCE

[18] The Applicant operates five restaurants in Vancouver, British Columbia. It is the owner of trademark registration TMA871,066 for TAP & BARREL & Design, registered in 2014 and shown below:



Frankel Affidavit

[19] Mr. Frankel is the Founder and Chief Executive Officer of the Applicant and of the Applicant's predecessor and related companies [para 1]. The Frankel Affidavit details the following:

- The history of the Applicant and the subject application [paras 3 to 5];
- The origin (inspired by the iconic U.S. Route 66 sign), use and registration of TAP & BARREL & Design [paras 7 to 9];
- The use of the Mark since the filing date of the subject application in association with the Applicant's restaurant services as well as with some goods [paras 10 to 12 and 15]; and
- The history, operations, and reputation of the Applicant's restaurants in the Vancouver area since 2012 [paras 13, 14, 16 to 23].

[20] Mr. Frankel also states that he is not aware of any customers who are unable to distinguish between the Applicant's restaurants and the goods and services associated with the Opponent's NHL Shield Trademarks [paras 24 to 25].

[21] Relevant portions of the cross-examination of Mr. Frankel will be discussed below.

Summers Affidavit

[22] Ms. Summers is a paralegal employed by the Applicant's agent. The Summers Affidavit includes printouts of the particulars of 36 applications and registrations from the Canadian Trademarks Database. In her cross-examination, Ms. Summers confirms that she was given a design and asked to find similar or identical trademarks [Q14]. She subsequently searched for, printed, and gave to the responsible lawyer particulars of any trademarks that were "similar in shape to the design" [Q23], and the lawyer narrowed that initial "large number" to the 36 included in her affidavit [Q26].

EVIDENTIAL BURDEN AND LEGAL ONUS

[23] 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.

[24] 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.

[25] 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

[26] The Opponent pleads that the application does not conform to the requirements of section 30(e) of the Act because, contrary to the Applicant's statement in the application, at the date of filing of the application the Applicant did not intend to use the Mark in Canada with each and every one of the goods and services specified in the application.

[27] 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.

[28] The material date with respect to compliance with section 30 of the Act is the filing date of the application.

[29] In this case, as the application includes the requisite statement, the issue is whether or not the Applicant substantially complied with section 30(e), *i.e.*, whether the Applicant's statement that it intended to use the Mark was true [*Home Quarters Warehouse, Inc v Home Depot, USA, Inc*, 1997 CarswellNat 2870, 76 CPR (3d) 219 (TMOB) at para 7; *Jacobs Suchard Ltd v Trebor Bassett Ltd*, 1996 CarswellNat 3039, 69 CPR (3d) 569 (TMOB) at para 7].

[30] The Opponent led no evidence in support of this ground. Nevertheless, an opponent may rely upon the applicant's evidence to meet its initial burden if the opponent shows that the applicant's evidence puts into issue the claims set forth in the application [see *Bacardi & Co v Corporativo de Marcas GJB, SA de CV*, 2014 FC 323 at paras 30-38].

[31] However, the Frankel Affidavit confirms the Applicant's *bona fide* intent to use the Mark [para 5] and shows that the Applicant has subsequently commenced use of the Mark in association with the applied-for "Restaurant and bar services" as well as in association with some of the applied-for goods [paras 14 and 15]. In my view, nothing in the cross-examination of Mr. Frankel refutes the Applicant's stated intent with respect to the "operation of a brewery" or the remaining goods; indeed Mr. Frankel essentially affirms the Applicant's intent to sell merchandise branded with the Mark, albeit somewhat vaguely in terms of specific plans [for example, Q196 and Q407 to Q431].

[32] In view of the foregoing, I am not satisfied that the Opponent has met its initial burden with respect to this ground. Accordingly, the ground of opposition based on section 30(e) of the Act is rejected.

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

[33] The Opponent pleads that the application does not conform to the requirements of section 30(i) of the Act because, contrary to the Applicant's statement in the application, the Applicant could not have been satisfied when it filed the application that it was entitled to use the Mark in Canada in association with the applied-for goods and services. In this respect, the Opponent further pleads that the Applicant could not have been so satisfied because it was aware at that time that: (i) the NHL Shield Trademarks had become well known in Canada, and (ii) the Applicant's use in Canada of the Mark in association with the goods and services specified in the application would be likely to cause confusion in Canada with the NHL Shield Trademarks in violation of sections 7(b) and 20 of the Act.

[34] 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)]. 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].

[35] In this case, there is no evidence that this is an exceptional case.

[36] 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

[37] The Opponent pleads that the Mark is not registrable pursuant to section 12(1)(d) of the Act because it is confusing with the Opponent’s registered NHL Shield Trademarks.

[38] Attached as Schedule A to the statement of opposition is a chart showing 11 NHL Shield Trademarks and their associated goods and services. All of the registrations consist of or include variations of the former or current NHL Shield Design. Some of the registrations only relate to the services of presentation and/or broadcast of professional ice hockey (*e.g.*, TMA249,988; TMA249,989; TMA694,017; TMA299,293). However, some of the NHL Shield Trademarks are also registered in association with a broad variety of goods, such as clothing, luggage, glassware, pre-recorded discs, collectibles, and the like (*e.g.*, TMA777,113; TMA816,510; TMA329,685; TMA330,561). Notwithstanding the broad scope of such registrations, I note that none are registered in association with “restaurant services”, “alcoholic beverages”, or the like.

[39] I have exercised my discretion to check the register and confirm that these registrations remain extant [see *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. As this satisfies the Opponent’s initial burden, the onus is on the Applicant to demonstrate, on a balance of probabilities, that there is no likelihood of confusion as to the source of the parties’ goods and services.

Test to determine confusion

[40] 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.

[41] 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 goods and 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].

[42] In making such an assessment, all the relevant surrounding circumstances must be considered, 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.

[43] 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, the Supreme Court of Canada stated that section 6(5)(e), concerning the resemblance between the trademarks, will often have the greatest effect on the confusion analysis [at para 49] and that the preferable approach is to first consider whether there is an aspect of each trademark that is particularly “striking or unique” [at para 64].

Opponent’s submissions

[44] On the issue of resemblance, the Opponent’s submissions can be summarized as follows:

- The *visual* resemblance between the parties’ marks is the most important aspect, given that the Mark consists solely of a design element with no reading matter.
- The only difference between the respective designs is the “slightly more pronounced points on the upper portions” of the NHL Shield Trademarks [Opponent’s Written Representations at para 61].
- Given that the shield elements are “virtually identical”, there is a high degree of visual similarity between the respective trademarks.
- There is also a high degree of resemblance in the ideas suggested, whether the design element is considered a shield or a badge.

- The Opponent has also used an “empty shield design” [Second Prochnow Affidavit at para 4], demonstrating the similarity between the parties’ marks.
- The Opponent has a family of trademarks, showing the fluidity and variation of the NHL Shield Design.
- At minimum, the empty shield/badge design of the Mark closely resembles the outline of the NHL Shield Design.

[45] On the issues of distinctiveness, extent known and use, the Opponent’s submissions can be summarized as follows:

- The shield or badge design element has no relationship to the goods or services of either party and therefore the respective trademarks have the same degree of inherent distinctiveness.
- However, the NHL Shield Trademarks have been used extensively in Canada since the 1940s.
- The NHL Shield Trademarks appear on a wide variety of branded goods, with significant retail sales of products bearing such trademarks.
- The Prochnow Affidavit demonstrates that the Opponent’s NHL Shield Trademarks are very well known in Canada, if not famous.
- Although the Applicant has provided customer sales figures from 2012, the extent to which the Mark has become known is not clear.
- The significant extent to which the NHL Shield Trademarks have been used and become known in Canada strongly favours the Opponent, for any material date.

[46] On the nature of the goods, services and trades, the Opponent’s submissions can be summarized as follows:

- The applied-for goods directly overlap or are related to the Opponent’s NHL Shield Trademarks-branded merchandise and there is no restriction to the channels of trade.
- There is a “clear, ongoing and historical connection between [the applied-for services] and the sport of hockey in Canada” [para 99], there is “a long standing history of licensing of the NHL Shield Trademarks for various corporate partners in the food and beverage industry” [para 100], and “the Opponent has historically licensed the use of the NHL Shield Trademarks for use in association with beer” [para 101].
- The Opponent “has established a strong connection between its NHL Shield Trademarks and the sale of beer” [para 111], such that a consumer would likely assume that use of the Mark “was authorized or licensed by the Opponent” [para 112].
- The NHL Shield Trademarks are very well known in Canada, associated primarily with professional hockey, but also a range of licensed goods and services.
- The Applicant is a sports bar-styled business, with a focus on beer, which is relevant because the likely consumer attending the Applicant’s premises would be aware of the Opponent’s NHL Shield Trademarks.
- Even if the Applicant’s goods are sold only to consumers visiting the Applicant’s restaurants, such consumers “are quite likely to be familiar with the Opponent’s goods and services and/or to view an NHL hockey game at the Applicant’s establishment” [para 98].
- The NHL Shield Trademarks are commonly encountered on TV screens; the ways the Applicant displays the Mark (including on a wall next to televisions that potentially air NHL hockey games, as depicted in Exhibit G of the Frankel Affidavit) increases the likelihood of confusion.
- The Applicant also displays the Mark next to third-party trademarks (*e.g.*, as shown in the Exhibit G posters in the Frankel Affidavit); such concurrent display increases the likelihood of confusion when the name of the restaurant, Tap & Barrel, is displayed at the

top of the poster. This is because consumers may view the Mark as a further third-party trademark (that of the Opponent), rather than as the Applicant's logo or trademark.

[47] In sum, with respect to the applied-for Services at least, the Opponent submits that the resemblance of the trademarks is strengthened by the context in which the consumer would be exposed to the Mark – *e.g.*, in a restaurant or “sports bar” context showing NHL games. In this respect, I note that while the Applicant resisted the characterization of its restaurants as “sports bars”, Mr. Frankel acknowledged in his cross-examination that NHL hockey games are shown on its TV screens, at least to some extent [Q275 to Q286].

[48] Similarly, the Opponent submits that it has a diverse licensing program, across a wide range of promotional merchandise, such as that reflected in the applied-for goods, and that consumers would likely be aware of such.

[49] The Opponent likens the present case – namely, one involving a famous (or at least well-known) trademark and a pattern of licensing – to the MISS CANADA decision in *Glen-Warren Productions v Gertex Hosiery Ltd* (1990), 29 CPR (3d) 7 (FCTD). Similarly, the Opponent favourably cites the COFFEE NIGHT IN CANADA decision in *Canadian Broadcasting Corp v Big Mountain Coffee House & Roasters Ltd*, 2014 TMOB 240. In the latter case, the key was the extent known of that opponent's trademark HOCKEY NIGHT IN CANADA, given the evidence relating to the volume of broadcasting and the pattern of licensing, despite no direct overlap in the relevant goods and services.

[50] The Opponent submits that, in this case, to the extent that there is weakness on the resemblance element, it is compensated for by the extent known factor. In this respect, it submits that the proportions of the Mark and the NHL Shield Design are similar enough that, based on an imperfect recollection, there is not enough in the empty shield/badge design of the Mark to steer the relevant consumer away from an inference that there is some kind of business connection, *e.g.*, licensing or approval from the Opponent.

[51] At a minimum, the Opponent submits that the question is whether the Applicant has met its burden in this case, not whether the Opponent has a monopoly on shield designs, relying on

the following from *Advance Magazine Publishers Inc v Masco Building Products Corp*, 1999 CarswellNat 133 (FCTD):

Where an opponent has a strong trade mark and the applicant has not led any evidence to dispel the connection between the products or services offered by the opponent and those offered by the applicant, in the sense that the public might infer that the applicant was approved, licensed or sponsored by the opponent, or that there was some business connection between the two parties, the applicant has failed to satisfy the onus upon it. [at para 38]

[52] Finally, with respect to the state of the register evidence found in the Summers Affidavit, the Opponent favourably cites *Iluminacion Especializada De Occidente, SA De CV v Voltech International Inc*, 2020 TMOB 23, and notes the following:

- Some of the 36 entries for shield designs on the register are irrelevant for various reasons.
- There are not a particularly large number of registrations for any particular goods or services from which an inference regarding the marketplace for such goods or services can be made.
- The vetting and narrowing of Ms. Summer's search results by the instructing lawyer may have been inappropriate.

[53] On the latter point, the Opponent questions whether the Applicant "crossed a line" by having Ms. Summers' initial search results reduced to those included in her affidavit by an unidentified lawyer with the Applicant's agent. However, the Opponent took the opportunity to cross-examine Ms. Summers on her evidence and it was open to the Opponent to submit its own state of the register or marketplace evidence. At worst, there may be more registered "shield" designs that the Applicant chose not to enter into evidence for whatever reason. The Summers Affidavit merely offers that these entries (34 registrations and 2 applications) existed; if there is anything specifically untoward about that, the Opponent has not made that clear.

[54] In any event, I agree with the Opponent that, of the 34 registrations, not all are relevant, for different reasons (*e.g.*, official marks, not registered, and/or for clearly unrelated goods or services). 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. However, I do note that some of the registrations for “hockey” or general “sport”-related services include a shield design similar to the applied-for Mark or the current NHL Shield Design (*e.g.*, TMA635,380; TMA435,130; TMA434,917; TMA885,926; and TMA207,403). While not determinative, the existence of these registrations does tend to expose the weakness of the Opponent’s arguments regarding the degree of resemblance and likelihood of confusion, addressed below.

Conclusion – Confusion with a registered trademark

[55] I have considered the Opponent’s submissions and acknowledge that there is overlap in the applied-for goods and the Opponent’s registered goods. There is also overlap with respect to the provision of “restaurant and bar services” serving food and alcohol and the evidenced licensing of the Opponent’s NHL Shield Design for food and alcohol products (noting that the Opponent’s NHL Shield Trademarks are not registered in association with food and alcohol products *per se*, and that this has greater relevance with respect to the pleaded entitlement grounds based on prior use of the NHL Shield Trademarks).

[56] Furthermore, there is potential for overlap in the nature of the parties’ trades in that, *inter alia*, the Applicant’s clientele may be familiar with the Opponent and, indeed, the Applicant’s restaurants may display broadcasts of NHL hockey games on their premises.

[57] However, even accepting the Opponent’s submissions with respect to the other factors, I consider the degree of resemblance in this case to be determinative. In this respect, I largely agree with the Applicant that “a huge stretch of imagination” is required to come to the conclusion sought by the Opponent [Applicant’s Written Representations at page 1].

[58] While the Mark is similar in shape to elements of the NHL Shield Trademarks (*e.g.*, the inner-most shield element in the current NHL Shield Design), the test for confusion requires consideration of the subject trademarks as a whole and with imperfect recollection; the trademarks are not to be dissected into their component parts. Granted, there is little to dissect in the Mark, but a finding of confusion would require disregard of the letters NHL or LNH in the Opponent’s NHL Shield Trademarks.

[59] The Opponent submits that it is the absence of content within the Mark that results in the likelihood of confusion. However, to the contrary, the “imperfect recollection” of the casual consumer “somewhat in a hurry” will recall there being content in the shield design. Accordingly, I find that it is the absence of the more striking letters NHL, LNH or the like in the Mark that is determinative in this case.

[60] As such, I do not consider the cases cited by the Opponent particularly helpful in the present case, as they largely involved the consideration of word marks.

[61] Having considered all of the surrounding circumstances, I find that the Applicant has met its legal burden with respect to the applied-for goods and services. I reach this conclusion due to the lack of resemblance between the trademarks, notwithstanding that there is some overlap in the nature of the relevant goods, services and trades, and the extent to which the Opponent’s NHL Shield Trademarks have become known in Canada.

[62] Accordingly, the ground of opposition based on section 12(1)(d) of the Act is rejected.

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

[63] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark because i) prior to the filing date of the Application, the Opponent had used the NHL Shield Trademarks in Canada in association with relevant goods and services; ii) as of the filing date of the application, the NHL Shield Trademarks had become well known in Canada, and each was confusing with the Mark; and iii) the Opponent had not abandoned the NHL Shield Trademarks as of the date of advertisement of the application. Again, attached as Schedule A to the statement of opposition is a chart listing the Opponent’s 11 NHL Shield Trademarks.

[64] While I accept that the Opponent has met its initial burden for this ground at least with respect to some of its NHL Shield Trademarks, my findings above with respect to the issue of confusion largely apply here as well.

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

SECTION 2 GROUND OF OPPOSITION – NON-DISTINCTIVENESS

[66] The Opponent pleads that the Mark is not distinctive under section 2 of the Act because it does not actually distinguish, nor is it adapted to distinguish, the Applicant's goods and services from the goods and services of others in Canada, and particularly from the goods and services associated with the Opponent's NHL Shield Trademarks. In this respect, the Opponent further pleads that the NHL Shield Trademarks have become known in Canada to such an extent as to negate the potential for the Mark to be distinctive of the Applicant's goods and services in Canada.

[67] The material date for a ground of opposition based on non-distinctiveness is the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317 at para 25].

[68] Section 2 of the Act, as it then was, defined "distinctive" as follows:

distinctive, in relation to a trademark, means a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or is adapted so to distinguish them.

[69] A trademark "actually distinguishes" by acquiring distinctiveness through use, resulting in distinctiveness in fact. On the other hand, a trademark that is "adapted so to distinguish" is one that does not depend upon use for its distinctiveness because it is inherently distinctive [see *Astrazeneca AB v Novopharm Ltd*, 2003 FCA 57 at para 16].

[70] In *Suzanne's Inc v Auld Phillips Ltd*, 2005 FCA 429, in the context of an expungement proceeding under section 57 of the Act, the Federal Court of Appeal stated that "Obviously, it will be a rare occurrence when one party is in a position to cause a mark to lose its distinctiveness, but nothing in principle prevents this result" [at para 7].

[71] Accordingly, first, in order to meet its evidential burden with respect to this ground, the Opponent must show that its NHL Shield Trademarks had a substantial, significant or sufficient reputation in Canada in association with the relevant goods and services [see *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR

(4th) 427 at para 34; see also *Navsun Holdings Ltd v Sadhu Singh Handrad Trust*, 2020 TMOB 64 at para 40].

[72] In view of the Prochnow Affidavit in particular, I am satisfied that the Opponent has shown that its NHL Shield Trademarks had a substantial, significant and/or sufficient reputation in Canada.

[73] With respect to the Applicant's legal onus, the Applicant has submitted no evidence of actual use of the Mark prior to the material date in association with some of the applied-for goods, and at best only limited display and use in association with the applied-for "restaurant and bar services" [*e.g.*, Frankel Affidavit at para 14 and Exhibit D]. However, an inquiry into whether the Mark "actually distinguishes" is not necessary in this case. In view of the particular pleading for this ground by the Opponent, I first note that, as acknowledged by the Opponent above, the Mark has at least some inherent distinctiveness in association with the applied-for goods and services. Otherwise, my findings above with respect to confusion substantially apply here as well.

[74] Accordingly, I am satisfied that the Applicant has met its legal onus with respect to this ground as pleaded. In the absence of a likelihood of confusion, the ground of opposition based on non-distinctiveness is rejected.

DISPOSITION

[75] 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 reject the opposition.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: 2020-09-24

APPEARANCES

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No one appearing For the Applicant

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