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C I P O

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 70
Date of Decision: 2021-04-13

IN THE MATTER OF AN OPPOSITION

Allmax Nutrition Inc.

Opponent

and

Razer (Asia-Pacific) Pte. Ltd.

Applicant

1,778,869 for RAZER

Application

INTRODUCTION

[1] Allmax Nutrition Inc. (the Opponent) opposes registration of the trademark RAZER (the Mark), which is the subject of application No. 1,778,869 (the Application), filed by Razer (Asia-Pacific) Pte. Ltd. (the Applicant) on the basis of proposed use of the Mark in Canada in association with the following goods (the Goods), as revised by the Applicant:

Non-alcoholic beverages, namely, non-alcoholic carbonated drinks, non-alcoholic beverages containing fruit juices, non-alcoholic beverages with tea flavour, non-alcoholic fruit drinks, non-alcoholic honey-based beverages, and non-alcoholic beverages flavoured with coffee; mineral waters; syrups, essences, concentrates and powders for making energy drinks and non-alcoholic beverages, fruit juices and soft drinks; energy drinks, carbonated and non-carbonated; fruit juices, fruit concentrates for use in preparation of carbonated and non-carbonated soft drinks.

[2] The main issue in this proceeding is whether there would be a likelihood of confusion between the Mark in association with the Goods and the Opponent's trademark RAZOR8,

registered in association with the following goods: “Dietary supplement containing caffeine for weight loss.”

[3] For the reasons that follow, the opposition is rejected.

THE RECORD

[4] The Application was filed on April 22, 2016 and advertised for opposition purposes in the *Trademarks Journal* on November 15, 2017.

[5] On February 14, 2018, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). This Act was amended on June 17, 2019. All references herein are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act before it was amended (see section 70 of the Act which provides that section 38(2) of the Act, as it read prior to June 17, 2019, applies to applications advertised before that date).

[6] The grounds of opposition raised by the Opponent can be summarized as follows:

- (a) The Application does not conform to the requirements of section 30(i) of the Act because the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Goods as the Applicant must have been aware of the Opponent’s prior use of the trademark RAZOR8, that is the subject of Canadian trademark registration No. TMA795,628, in association with the goods: “Dietary supplement containing caffeine for weight loss”.
- (b) The Mark is not registrable pursuant to section 12(1)(d) of the Act as it is confusing with the Opponent’s aforementioned registered trademark RAZOR8.
- (c) The Mark is not distinctive pursuant to section 2 of the Act because it does not and is not capable of distinguishing the Applicant’s Goods from those of the Opponent.

[7] On April 25, 2018, the Applicant filed and served a counter statement denying each ground of opposition pleaded in the statement of opposition.

[8] In support of its opposition, the Opponent filed the affidavit of its President, Michael Kichuk, sworn August 20, 2018 (the Kichuk affidavit). In support of its Application, the Applicant filed the affidavits of Elaine Tan, Director in the Applicant’s Legal Department, sworn December 19, 2018 (the Tan affidavit), and Marianne Crozier, a trademark paralegal employed by the agents for the Applicant, sworn December 18, 2018 (the Crozier affidavit).

[9] None of the parties’ affiants were cross-examined on their affidavits.

[10] Both parties submitted written representations. An oral hearing was not requested.

ANALYSIS

The parties’ respective burden or onus

[11] The Opponent has the initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155].

Overview of the evidence

The Opponent’s evidence

[12] The Kichuk affidavit is very brief comprising only three substantive paragraphs, in which Mr. Kichuk states that:

- the Opponent “has used the [t]rademark RAZOR8 in Canada since at least as early as March 2005 in association with the goods specified in [its aforementioned trademark] registration [para 2; Exhibit “A”: “[unclear] pictures of bottles bearing the [t]rademark RAZOR8 used on the goods”];
- “annual sales in Canada of goods sold in association with the [t]rademark RAZOR8” for the years 2015 to 2017 totalled respectively: \$540,849.96; \$400,610.67; and \$328,999.82

[para 3; Exhibits “B” and “C”: “details of the annual sales of the goods for these years; and sample invoices for each of the years 2015, 2016 and 2017, respectively”]; and

- the Opponent’s “goods have been advertised using the [t]rademark RAZOR8 since at least as early as March 2005” [para 4; Exhibit “D”: “copies of [three undated] advertisements placed in ‘Muscle Insider’, ‘Inside Fitness’”, which nature and geographical area of circulation is unknown].

[13] Upon review of the exhibits attached to the Kichuk affidavit, I note that they all seemingly pertain to a product displaying the trademark RAZOR8 and identified as “Allmax Razor8 Blast Powder”, a “Highly Concentrated Pre-Workout Stimulant”. I will return to this point.

The Applicant’s evidence

The Tan affidavit

[14] The Tan affidavit provides background information about the history and business of the Applicant. More particularly, Ms. Tan attests to the following:

- the Applicant is a global gaming lifestyle company with dual-headquarters in Singapore and San Francisco. Founded in 2005, the Applicant has expanded its product offerings from gaming hardware to an entire suite of gaming and entertainment software solutions and services with activities in 43 jurisdictions worldwide, including Canada. The Applicant is now one of the leading gaming brands in the world, and has won numerous international awards [paras 3, 4, 6 and 7; Exhibit “A”];
- the Applicant advertises extensively through digital media, as well as through gaming and technology websites and magazines, event sponsorship and exhibitions at international conventions [paras 8 and 9; Exhibit “C”]. The Applicant is also a major advocate for electronic sports (“e-sports”) [para 10];
- the Applicant's vision is to create and develop products that may be demanded by the gaming community. To further this vision the Applicant has incrementally added to its

product lines lifestyle products such as clothing, glasses, bags, smart phones, smart watches and fitness trackers. The Applicant considers the addition of drinks and beverages to its product line to be a strategic move to further strengthen its position as the leading lifestyle gaming brand [paras 5, 7 and 12; Exhibit “B”]; and

- the Applicant intends to sell the Goods through its online store, via authorized dealers of the Applicant's electronic products, at electronic fairs and at e-sports tournaments and events [para 13].

The Crozier affidavit

[15] The Crozier affidavit purports to introduce into evidence the results of various Internet searches, the majority of which related to the way the Opponent’s RAZOR8 product is commercialized as a “pre-workout stimulant” rather than as a dietary supplement “for weight loss” as described in its aforementioned trademark registration, namely:

- printouts of selected pages from the Opponent’s product catalog and website *www.allmaxnutrition.com* [para 4; Exhibits “B”, “C”, “D” and “E”];
- printouts from the websites of the 22 Canadian retailers of nutritional products as named in the screenshots of the Opponent’s website contained in Exhibit “E” [Exhibit “F”], and screenshots from the websites of three major Canadian grocery chains displaying the product search results for “energy drinks” [Exhibit “H”];
- pictures of the RAZOR8 product obtained on the Internet using the Google search engine [Exhibit “G”];
- copies of corresponding trademark registrations obtained by each party in foreign jurisdictions, namely: a copy of the certificate of registration issued by the United States Patent and Trademark Office (USPTO) for the Mark, as well as a printout obtained from the online database maintained by the USPTO regarding the prosecution history of this application [Exhibit “I”]; a printout obtained from the online database maintained by the European Union Intellectual Property Office (EUIPO) for the Mark [Exhibit “J”]; a printout obtained from the online database maintained by the USPTO for the Opponent’s

trademark RAZOR8 [Exhibit “K”]; and a printout obtained from the online database maintained by the EUIPO for the Opponent’s trademark RAZOR 8 [Exhibit “L”].

Ground of opposition summarily rejected

Non-compliance of the Application with section 30(i) of the Act

[16] Section 30(i) of the Act merely requires that an applicant include a statement in its application that it is satisfied that it is entitled to registration of its trademark. 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), 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 mark [*Woot, Inc v WootRestaurants Inc*, 2012 TMOB 197]. The Application for the Mark contains the statement required under section 30(i) of the Act and there is no evidence that this is an exceptional case.

Remaining grounds of opposition

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

[17] As a preliminary matter, I note that in its written representations, the Applicant takes the position that the section 12(1)(d) ground of opposition ought to be dismissed as being improperly pleaded.

[18] The Applicant argues that:

While the Opponent’s [trademark RAZOR8] is registered, the scope of registration does not cover the scope of the Opponent’s [m]ark as used in commerce. As such, the Opponent’s rights in the Opponent’s [m]ark are not protected by a registration, which renders the [section] 12(1)(d) ground of opposition inapplicable.

[19] More particularly, the Applicant submits that the registration of the Opponent’s trademark RAZOR8 covers the very specific good of “Dietary supplement containing caffeine for weight loss” whereas all the evidence of record points to the unequivocal finding that the

product used in association with the Opponent's trademark RAZOR8 is that of a pre-workout stimulant for promoting mental focus, energy and muscle mass during workout routine.

[20] The Applicant understands that opposition proceedings are not the venue to determine the validity of the Opponent's trademark registration. However, it submits that as registration No. TMA795,628 forms the basis of the section 12(1)(d) ground of opposition, the ability of the Opponent to rely on registered rights is of utmost importance, and should be thoroughly assessed in this proceeding.

[21] In any event, the Applicant submits that the Mark is not confusing with the Opponent's trademark RAZOR8.

The Opponent's ability to rely on registration No. TMA795,628

[22] First, I note that, as properly acknowledged by the Applicant in its written representations, opposition proceedings are not the appropriate forum to challenge the validity of a registered trademark cited by an opponent in support of a ground of opposition based on section 12(1)(d) of the Act [see *Magill v Taco Bell Corp.* (1990), 31 CPR (3d) 221 (TMOB)].

[23] Second, an opponent's initial evidential burden with respect to a section 12(1)(d) ground of opposition is met if a registration relied upon in the statement of opposition is in good standing as of the date of the decision. Stated differently, there is no need for an opponent to show use of the relied upon registered trademark. In this regard, the Registrar has discretion to check the register in order to confirm the existence of a registration relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. In this case, I have exercised that discretion and confirm that the Opponent's registration No. TMA795,628 for use with the goods "Dietary supplement containing caffeine for weight loss" is in good standing. Hence, the Opponent has met its evidential burden in respect of this ground of opposition.

[24] Third, I note that in its written representations, the Applicant refers to a section 45 proceeding against the Opponent's aforementioned registration that was pending at the time of filing the Applicant's written representations. A decision has since been rendered by the Registrar in which the registration was maintained [see *Palmer IP Inc v Allmax Nutrition Inc*

2020 TMOB 109]. In that decision, the Registrar did discuss the argument made by the requesting party in that proceeding according to which the use of the trademark RAZOR8 that was shown by the Opponent as owner of the said trademark registration, was not in association with a dietary supplement for weight loss, but instead, a pre-workout stimulant for promoting mental focus, energy, and muscle growth. In rejecting the requesting party's argument, the Registrar wrote at paragraph 16:

It is a well-established principle that when interpreting a statement of goods or services in a section 45 proceeding, one is not to be "astutely meticulous when dealing with [the] language used" [see *Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654 at para 17]. In this respect, I note that the Owner's product is advertised as a stimulant for use before a workout, that it contains active ingredients that facilitate weight loss, and that the Owner's website promotes the product's capacity for "fat oxidation". Given the limited scope of section 45 proceedings, I am satisfied that the Owner's product falls within the scope of the registered goods.

[25] Similarly, in the present case, I note that the Opponent's product is advertised as a stimulant for use before a workout that "increases ATP production, supporting high intensity training and reducing muscle fatigue, all while incinerating fat through increased fat oxidation", that the ingredients for the product include caffeine, and that Mr. Kichuk identifies the pre-workout supplement product as the registered good [Crozier affidavit, Exhibit "C"; Kichuk affidavit, Exhibits "A" and "D"].

[26] I shall therefore turn to the test for confusion.

The test for confusion

[27] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act 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.

[28] Thus, section 6(2) of the Act does not concern the confusion of the trademarks themselves, but of the goods or services from one source as being from another. In the present

case, the question is essentially whether a consumer, with an imperfect recollection of the Opponent's RAZOR8 trademark, who sees the Applicant's Goods in association with the Mark, would think that they emanate from, are sponsored by or approved by the Opponent.

[29] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them. This list is not exhaustive, and all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v 3894207 Canada Inc* 2006 SCC 22, 49 CPR (4th) 321; *Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée* 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 for a thorough discussion of the general principles that govern the test for confusion].

The inherent distinctiveness of the trademarks and the extent to which they have become known

[30] Both of the parties' trademarks are inherently distinctive, although arguably less so in the case of the Opponent's trademark given the somewhat descriptive character of the word "RAZOR" in the context of the Opponent's product, to refer to the "razor-sharp mental focus" as promised by the Opponent's product [Crozier affidavit, Exhibits "B" and "C" that present the four features of the Opponent's pre-workout stimulant, namely: "explosive strength"; "razor-sharp mental focus"; "pump & vascularity"; and "endurance"]. I will return to this point when considering the degree of resemblance between the parties' marks in appearance or sound or in the ideas suggested by them.

[31] The degree of distinctiveness of a trademark may be increased by means of it becoming known through promotion or use.

[32] There is no evidence that the Applicant's Mark has been used or has become known in Canada in association with the Goods to any extent.

[33] Turning to the Opponent's trademark RAZOR8, and keeping in mind my comments made above with respect to the scope of the Opponent's registration, I am satisfied that the Kichuk affidavit establishes use of the Opponent's trademark in association with the registered goods in Canada during the years 2015-2017. While the Opponent's volume of sales has not been broken down per province, I note that it has never been less than \$325,000.00 in any of the three years and that this evidence is supported by invoices showing sales of the Opponent's RAZOR8 "Blast Powder" to retailers in the provinces of Alberta, British Columbia, Ontario, Quebec and Nova Scotia. Therefore, such use increases the distinctiveness of the trademark RAZOR8 and tends to outweigh the somewhat higher degree of inherent distinctiveness of the Mark.

[34] Accordingly, the overall consideration of this factor slightly favours the Opponent.

The length of time the trademarks have been in use

[35] While the Kichuk affidavit does not establish continuous use of the Opponent's trademark RAZOR8 since the date of first use of March 23, 2005 claimed in the Opponent's registration, there is evidence that the Opponent's trademark has been used in Canada during at least the recent years.

[36] Accordingly, this factor favours the Opponent.

The nature of the goods, services or business; and the nature of the trade

[37] When considering the nature of the goods, services or business and the nature of the trade, I must compare the Applicant's statement of Goods with the statement of goods in the registration relied upon by the Opponent [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. Evidence of the parties' actual trades

is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

The nature of the goods and business

[38] In its written representations, the Opponent points out that its dietary supplement is sold in powdered form as a mix for making beverages. More particularly, it submits that the Opponent's powdered drink mixes come in four flavors and contain caffeine in addition to other ingredients such as hordenine HCL and yerba mate.

[39] The Opponent submits that the Applicant's Goods relate to non-alcoholic beverages generally and include "energy drinks" and "syrops, essences, concentrates and powders for making energy drinks and non-alcoholic beverages". The Opponent submits that it is commonly known that energy drinks provide the consumer with increased energy typically through the use of caffeine, an ingredient widely used as a stimulant in energy drinks.

[40] Accordingly, the Opponent submits that the Opponent's products and the Applicant's Goods are overlapping or closely related.

[41] The Opponent further submits that the statement in the Tan affidavit that "the Applicant's targeted clientele of the claimed goods comprise gamers, particularly youth and millennials" is not consistent with the statements in the same affidavit equating gamers to "athletes" and asserting the Applicant's efforts to bring e-sports into traditional sporting events such as the Southeast Asian games and the Olympics [Tan affidavit, paras 5, 10 and 12].

[42] In contrast, the Applicant submits that the Mark is to be used in association with everyday drinks and beverages such as fruit juices, tea drinks and water, which nature is very remote from that of weight loss supplements. The Applicant submits that while the Application does cover energy drinks and syrops, essences, concentrates and powders for making energy drinks, the nature of energy drinks is fundamentally different than that of weight loss supplements.

[43] More particularly, the Applicant submits that weight loss supplements are consumed for the very specific purpose as described in its name. They are sought and purchased by customers to achieve this very purpose. While most energy drinks contain caffeine, the caffeine in energy drinks serves to promote energy (as the name “energy drinks” suggests), not weight loss. The Applicant highly doubts any reasonable person would consume or expect the consumption of energy drinks would facilitate or achieve weight loss — to say that customers are likely to consume energy drinks in order to lose weight is equivalent to saying customers would believe drinking coffee could help them lose weight, which notion is completely absurd and untrue.

[44] The Applicant further submits that it is irrelevant as to whether e-sport is a traditional sport event or not. This is because e-sport does not require its athletes (or gamers as a whole) to lose weight in order to play or thrive in the sport. E-sport demands, among other things, precision, skill, exceptionally fast reaction time, decision-making and pattern-recall ability; staying thin is completely irrelevant. E-sport athletes need energy, but not a slim body, to thrive. As such, the Applicant submits that it is highly unlikely that e-sport athletes, when encountering the Opponent’s registered goods, would believe the weight loss supplements branded under the Opponent’s mark would help skill-enhancement required for e-sport, nor would consumers wishing to lose weight believe the energy drinks branded under the Mark would help them lose weight. The meaning of staying fit as required by e-sport has nothing to do with weight.

[45] Lastly, the Applicant submits that as evidenced in the Tan affidavit, it has always been the Applicant’s intention to provide an immersive gaming experience, such that the Mark would become a lifestyle brand. The expansion from gaming peripherals to software, to mobile phone, to fitness trackers, to clothing, etc., is part of the process. The Applicant envisages gamers to consume its branded beverages while playing video games, to further the immersive experience.

[46] I am in general agreement with the Applicant’s submissions. In this regard, I further note that the fact that the Opponent’s RAZOR8 product is advertised and commercialized as a “Highly Concentrated Pre-Workout Stimulant” does not render the parties’ goods more similar, as the evidence shows that the Opponent’s product is of a specialized nature and “is not for everyone”, but rather is directed to bodybuilders to “swell the cell” and “grow the muscle” [Kichuk affidavit, Exhibit “D”; Crozier affidavit, Exhibit “C”].

The nature of the trade

[47] The Opponent stresses that to establish a likelihood of confusion it is not necessary to prove that the goods associated with the parties' marks are effectively sold in the same place, as long as the parties are entitled to do so.

[48] The Opponent submits that there is no limitation to the channels of trade in which the Opponent's RAZOR8 product may be sold in Canada and accordingly, the Opponent's product may be sold in all manner of online and brick and mortar retail outlets, including grocery stores. In addition, the Opponent submits that its exhibited invoices show actual sales of the Opponent's RAZOR8 product "through a wide variety of retail outlets including Canex stores (i.e., stores selling all manner of consumers products, including electronic and gaming equipment, to Canadian military personnel)" [Kichuk affidavit, Exhibits "B" and "C"].

[49] The Opponent submits that similarly, there are no limitations to the channels of trade in the description of the Goods in the Application, and despite the Applicant's stated intentions to sell the Goods through its online store and authorized retail distributors of RAZER products, which the Applicant alleges are all distributors of electronic and computer goods, the Applicant's evidence shows that "energy drinks" are typically sold through retail grocery store chains [Crozier affidavit, para 4 and Exhibit "H"].

[50] The Opponent submits that given the actual and potential channels of trade through which the Opponent's goods may be sold, the lack of any limit on the channels of trade through which the Goods may be sold and the Applicant's evidence which shows sales of energy drinks through retail grocery store chains and sworn statements concerning the Applicant's efforts to associate computer gaming competitions with traditional sporting events [Tan affidavit, paras 10 and 13], there is a strong likelihood of overlap in the channels of trade of the respective parties.

[51] In contrast, the Applicant submits that whether considered to be weight loss products or pre-workout stimulants, the Opponent's products are not found in general grocery stores, but specialized health or nutritional supplement stores as supported by the 22 Canadian retailers listed in the Opponent's website [Crozier affidavit, Exhibit "E"]. The Applicant points out that the invoices reflecting the actual channels of the Opponent support this observation [Kichuk affidavit, Exhibit "C"]. In response to the Opponent's argument referring to a store

named “Canex”, the Applicant submits that: i) the Opponent's evidence contains no information about this store for the Registrar to determine its nature; ii) the volume of sales by the Opponent of products bearing the Opponent’s trademark RAZOR8 to this Canex store is minimal, with only 11 units sold all invoices combined, for a total sale value of \$300; iii) even assuming this Canex store does sell consumer products (which is unknown by the Applicant due to the lack of information, and on this basis, expressly denied), the Opponent mentioned that the store is targeted at military personnel. The Applicant submits that Canadian army are highly trained and specialized, and should not be considered to be ordinary consumers which might more easily (though still highly improbable) be misled into thinking that energy drinks are the same thing as weight loss products or pre-workout stimulants.

[52] The Applicant further submits that screenshots of the websites of the 22 Canadian retailers do not show that any of the retailers offer energy drinks [Crozier affidavit, Exhibit “F”], and the Opponent fails to evidence that any of these retailers otherwise do so.

[53] The Applicant submits that it intends to sell its Goods through its online store, authorized dealers of the Applicant’s gaming products, electronic fairs and e-sports tournaments or events [Tan affidavit, para 13]. The Applicant submits that even in the absence of information regarding the Applicant's intended channel of trade, everyday experience tells us that energy drinks are typically offered in general grocery stores [Crozier affidavit, Exhibit “G”], gas stations, convenience stores, or even food court and restaurants, and not specialized supplement stores.

[54] Lastly, the Applicant submits that while the registration of the Opponent’s trademark is not limited in channels of trade, evidence of actual trade clearly supports that the Opponent’s RAZOR8 product is sold through specific and differing channels only. Assuming the claimed date of first use of the Opponent’s trademark is true (which is unknown by the Applicant due to the lack of information, and on this basis, expressly denied), the longstanding use for 15 years suggests that the channels of trade are unlikely to deviate in the future from its existing course.

[55] Based on the above, the Applicant submits that the products of the two parties will travel through distinct channels that do not overlap.

[56] I am in general agreement with the Applicant's submissions.

[57] In view of all the foregoing, I find that the overall assessment of the third and fourth factors in section 6(5) favour the Applicant.

The degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them

[58] As noted by the Supreme Court in *Masterpiece, supra*, at paragraph 49, "the degree of resemblance, although the last factor listed in [section] 6(5) [of the Act], is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion".

[59] Moreover, as previously mentioned, it is well-established in the jurisprudence that likelihood of confusion is a matter of first impression and imperfect recollection. In this regard, "[w]hile the marks must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public's perception of it" [*Pink Panther Beauty Corp v United Artists Corp* (1998), 80 CPR (3d) 247 (FCA), at para 34]. I also must take into consideration the fact that the first portion of a trademark is often considered the most important one for the purpose of distinction [*Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)].

[60] Applying those principles to the present case, I find the parties' trademarks are somewhat more different than alike as a matter of first impression.

[61] When considered as a whole, the Opponent's trademark RAZOR8 does not strike me as having one single dominant feature over the other. The two components of the Opponent's mark, i.e. the dictionary word RAZOR and the number 8 are both fairly equally dominant. While I acknowledge that numbers in and by themselves are generally of a low level of inherent distinctiveness and that the number 8 in the Opponent's trademark does not appear in the first portion of the mark, it nonetheless remains an integral component of the mark and cannot be dissociated from the component RAZOR. The two components form a unitary trademark.

Therefore, when sounded, the Opponent's trademark is RAZOR-EIGHT. The number 8 is impossible to slur or otherwise become inaudible. Being a short mark, there is also no basis to believe that viewers would miss the number 8 at the end of the Opponent's trademark. When seeing the Opponent's trademark RAZOR8, consumers would be puzzled as to its meaning in the mark. Conceptually, the Opponent's trademark refers to razor-sharp mental focus in combination with the number 8, which meaning is unknown.

[62] The Applicant's Mark consists of a single coined word, with no striking or dominant feature. Conceptually, I agree with the Applicant that one might think that RAZER refers to a person or an object that razes (i.e. tears down, demolishes or destroys). This understanding is arguably apt, considering that razing is a somewhat frequent activity in the playing of video games. In this regard, I agree with the Applicant that the Opponent's argument that the Mark "is but a mere misspelling of the word RAZOR" and that "the Applicant's adoption of other marks such as Razer Switchblade and Razer Blade Stealth [in association with laptops and software] clearly demonstrates that the Applicant's mark RAZER is intended to look like, sound like and suggest the same idea as the word RAZOR" is not convincing.

Surrounding circumstances

Coexistence of the parties' marks

[63] According to Exhibits "I" to "L" of the Crozier affidavit, the parties' trademarks already coexist on both the USPTO and EUIPO registers.

[64] However, this fact is not binding upon the Registrar. It is worth referring to the following observation from the Registrar in *Quantum Instruments Inc v Elinca S.A.* (1995), 60 CPR (3d) 264:

As yet a further surrounding circumstance in respect of the issue of confusion, the applicant submitted evidence of registrations obtained by both parties in Great Britain and in the United States of America for the trade-marks QUANTA and QUANTUM. However as noted ... in *Re Haw Par...*, little can be drawn from the fact that the trade-marks at issue coexist in other jurisdictions ... the Registrar must base [the] decision on Canadian standards, having regard to the situation in Canada. Further, in *Sun-Maid* ... [the court] pointed out that "no significance can be attached to failure to oppose or object to registrations in other jurisdictions since such actions, of necessity, have their basis

entirely in foreign law and procedure." Additionally, while the applicant has relied upon evidence of coexistence of the trade-marks at issue on the registers in Great Britain and the United States of America, no evidence has been adduced of the coexistence of the trade-marks at issue in the market-place in either of these countries... Accordingly, I do not consider this evidence to be persuasive in this proceeding.

Conclusion regarding the likelihood of confusion

[65] As noted by the Federal Court of Appeal in *Dion Neckwear, supra*, at page 163, the Registrar "need not be satisfied beyond doubt that confusion is unlikely. Should the 'beyond doubt' standard be applied, applicants would, in most cases, face an insurmountable burden because certainty in matters of likelihood of confusion is a rare commodity."

[66] Having considered all of the surrounding circumstances, I find that the Applicant has satisfied the onus on it to show that, on a balance of probabilities, there is not a reasonable likelihood of confusion as to the source of the parties' goods. Indeed, I find that the differences existing between the parties' trademarks combined with the differences existing in the exact nature of their associated goods and corresponding channels of trade are sufficient to avoid a likelihood of confusion.

[67] Accordingly, the section 12(1)(d) ground of opposition is rejected.

Non-distinctiveness of the Mark under section 2 of the Act

[68] In order to meet its initial evidential burden under this ground of opposition, the Opponent had to show that as of the filing date of the statement of opposition (namely February 14, 2018), its relied upon RAZOR8 trademark had a substantial, significant or sufficient reputation in Canada in association with its alleged dietary supplement so as to negate the distinctiveness of the Applicant's Mark [*Motel 6, Inc v No 6 Motel Ltd*, (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657].

[69] In my view, the Opponent's evidence of its use of the trademark RAZOR8 in association with its pre-workout stimulant discussed above with respect to the section 12(1)(d) ground of opposition is sufficient to meet the Opponent's burden with respect to the section 2 ground of opposition. That said, the difference in relevant dates does not affect my analysis above under

the section 12(1)(d) ground of opposition. As the section 2 ground of opposition is not stronger than the section 12(1)(d) ground of opposition, it is also rejected.

DISPOSITION

[70] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

No Hearing Held

AGENTS OF RECORD

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