



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 219**

**Date of Decision: 2021-09-29**

**IN THE MATTER OF OPPOSITIONS**

**Tribu Expérientiel Inc.**

**Opponent**

**and**

**JKLP IP Pty Ltd**



**Applicant**

**1,723,772 for JACKALOPE Vertical Design**

**Applications**

**1,723,775 for JACKALOPE Horizontal Design**

[1] JKLP IP Pty Ltd (the Applicant) has applied to register (i) the trademark JACKALOPE Vertical Design, consisting of the word JACKALOPE written as the stacked syllables JAC, KAL, and OPE, in the manner reproduced below (Vertical Mark), and (ii) the trademark JACKALOPE Horizontal Design, consisting of the word JACKALOPE written simply from left to right in the same font, as reproduced below (Horizontal Mark), both trademarks being for use in association with various hotel, resort, restaurant, and bar services:

	
Vertical Mark (App. no. 1,723,772)	Horizontal Mark (App. no. 1,723,775)

[2] Tribu Expérientiel Inc. (the Opponent) opposes registration of the Vertical Mark and the Horizontal Mark (collectively the Marks), based primarily on an allegation that each of them is confusing with the Opponent's trademarks and trade name featuring the word JACKALOPE, registered and used in Canada in association with a sports festival, as well as related goods and services, some of which are in the travel or food and beverage fields.

[3] The Opponent also alleges that the application does not comply with formal requirements because the Applicant did not intend to use the Marks as claimed.

[4] For the reasons that follow, I refuse the applications in part.

#### THE RECORD

[5] The applications to register the Marks (the Applications) were filed by the Applicant on April 15, 2015, and accorded serial numbers 1,723,772 and 1,723,775, respectively. They are based on proposed use of the Marks in Canada in association with the following services (the Services):

Accommodation reservation services; Arranging hotel accommodation; Booking of hotel accommodation; Hospitality services (accommodation); Hotel accommodation reservation services; Hotel accommodation services; Inn keeping (bar, restaurant and accommodation); Provision of hotel accommodation; Reservation of hotel accommodation; Resort accommodation; Resort hotel services; Arranging hotel reservations; Hotel catering services; Booking services for hotels; Hotel information; Hotel services; Hotel reservation services; Bar services; Wine bar services; Coffee bar and coffee house services (provision of food and drink); Salad bar restaurant services; Restaurant reservation services; Restaurant services; Restaurants; Theatre restaurants (Provision of food and drink); Reservation of places at holiday resorts; Hotels; Booking of restaurant places.

[6] The Applications claim a priority filing date of October 16, 2014, based on Australian applications nos. 1652937 (in the case of the Vertical Mark) and 1652936 (in the case of the Horizontal Mark), filed on that date for the same or substantially the same trademark in association with the same kind of services.

[7] The Applications were advertised in the *Trademarks Journal* on June 15, 2016, and opposed on June 20, 2016, when the Opponent filed statements of opposition pursuant to

section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The statements of opposition were subsequently amended on March 2, 2018, and again on January 13, 2021.

[8] The grounds of opposition are based on the following sections of the Act: 30(e) and 30(i) (compliance with formal application requirements); 12(1)(d) (registrability of the trademark); 16(3)(a) and 16(3)(c) (entitlement to registration); and 2 (distinctiveness of the trademark). The Applicant's counter statements, filed on August 25, 2016, contain blanket denials of all the allegations in the statements of opposition and are broad enough to contest all of the grounds as amended.

[9] Numerous amendments to the Act came into force on June 17, 2019. Pursuant to the transitional provisions in section 70 of the Act for applications advertised before June 17, 2019, the grounds of opposition in this case will be assessed based on the Act as it read immediately before amendment, an exception being that the definition of confusion in sections 6(2) to 6(4) of the Act as it currently reads will be applied.

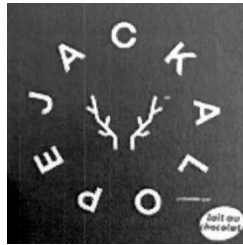
[10] In support of its oppositions, the Opponent filed the following evidence:

- A certified copy of its application no. 1,702,712 (since registered under no. TMA991,019) for the trademark "JACKALOPE & dessin" depicted below, which consists of the word JACKALOPE on the silhouette of an antlered jackrabbit (*i.e.* a "jackalope") leaping over a small logo featuring the word AMNESIA, with a circular background design behind the jackalope:



- The affidavit of its president, Micah Desforges, dated September 19, 2016. Mr. Desforges describes the Opponent's use and promotion of the following trademarks in association with an annual extreme or "action" sports festival in Canada: (i) the

JACKALOPE word mark (Opponent’s Word Mark); (ii) the design mark depicted above (Opponent’s Design Mark); and (iii) a design mark consisting of the word JACKALOPE encircling a line drawing of antlers, often displayed with a “*LAIT AU CHOCOLAT*” (chocolate milk) logo to the right of the entire design, as depicted below (Opponent’s New Logo):



[11] Mr. Desforbes was cross-examined on his affidavit and the cross-examination transcript is of record. I note that both parties corresponded with the Registrar in September and October 2017 regarding an undertaking requested during cross-examination, to which the Opponent did not respond until after the deadline to complete cross-examination had expired. Given that either party could have requested leave to file the response as evidence when it became available but both parties chose not to, I confirm that no negative inferences will be drawn against either party from the absence of this evidence on file.

[12] In support of its applications, the Applicant filed as evidence the affidavit of Emily Makiv, dated July 20, 2017. Ms. Makiv is the Chief Operating Officer and former group general manager of a group of affiliated companies (JKLP Group) that includes the Applicant and which oversees the operation of a JACKALOPE-branded hotel in Australia. In her affidavit, she describes the Applicant’s use and promotion of the Marks in association with this hotel business, including display of the Horizontal Mark below a stylized jackalope head, as reproduced below:



[13] Neither party filed a written argument and only the Opponent was represented at the oral hearing.

[14] Finally, I note that the present case was heard together with three related opposition proceedings, concerning the Applicant's applications nos. 1,723,795, 1,723,797, and 1,723,802. Separate decisions will issue for the related proceedings.

#### THE OPPONENT

[15] The Opponent is a marketing agency specialising in experiential marketing ("*marketing expérientiel*"), whereby businesses engage consumers through events or experiences [Desforges para 5]. As such, the Opponent conceives, produces, and coordinates special events and original experiences for product launches, official openings, promotional tours, *etc.*, while also creating marketing content for social media, television, and other distribution channels [para 6]. Its expertise lies in the creation of stunts and promotional events linking extreme sports with associated lifestyles for consumers age 13 to 34 [paras 5-6].

[16] Among such special events, the Opponent has since 2012 organised and run the JACKALOPE festival, an annual 2-3 day summer extreme sports festival in Montreal, featuring initiation clinics and demonstrations and as well as international competitions [paras 7-8]. Mr. Desforges explains that the Opponent has generated revenues from the festival primarily by selling sponsorship opportunities and exhibitor/vendor space but also through ticket sales and competitor/participant registrations, a JACKALOPE-branded bar on site, and the sale of branded merchandise [para 16; cross-examination pages 6-7, 16-18]. He also notes that, since the festival's inception, restaurant services have been available on the festival site, provided by food trucks leasing space from the Opponent [para 9; cross-examination page 13].

#### THE APPLICANT

[17] The Applicant, together with Jackalope Mornington Peninsula Pty Ltd. (Mornington Pty) and JKLP Group Pty Ltd. (Group Pty), forms the JKLP Group, which oversees hotel, hospitality and wine operating businesses in the state of Victoria, Australia, including the JACKALOPE hotel, located on the site of a vineyard with a working winery on the Mornington Peninsula [Makiv paras 2-4, 24]. Ms. Makiv describes this hotel as the first in a series under the

“innovative international luxury boutique brand called JACKALOPE” [para 3]. She specifies that this brand was chosen to “communicate the unique and mystical experience to be offered at a luxury hotel in a beautiful natural setting” and is used in association with “various accommodation services, restaurant services, events and merchandise” [paras 5, 8].

[18] Ms. Makiv specifies that Mornington Pty is the member of the JKLP Group responsible for operating the hotel and associated restaurants and that it uses the Marks in this regard pursuant to the Applicant’s “authorization” [para 8]. She confirms that the Applicant controls the character and quality of the associated goods and services through its sole director, who is also the sole director of Mornington Pty and Group Pty [paras 3, 8]. For the purposes of this decision, I am satisfied that the arrangement she describes meets the licensing requirements of section 50 of the Act, such that use of the Marks by Mornington Pty enures to the Owner’s benefit.

#### EVIDENTIAL BURDEN AND LEGAL ONUS

[19] In an opposition proceeding, the legal onus is on the applicant to show that its application complies with the provisions of the Act. However, for each ground of opposition, there is an initial evidential burden on the opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist. If this initial burden is met, then the applicant must satisfy the Registrar, on a balance of probabilities, that the ground of opposition should not prevent registration of the trademark at issue [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)].

#### GROUND OF OPPOSITION REGARDING INTENT TO USE THE MARKS UNDER SECTION 30(E) SUMMARILY DISMISSED

[20] The Opponent pleads that the Applications do not comply with the requirements of section 30(e) of the Act in that the Applicant never intended to use the Marks in Canada in the form applied for and in association with each of the Services. In the alternative, the Opponent pleads that, when the Applications were filed, the Applicant had already used the Marks in Canada in association with the Services, such that the Applicant was required to file the Applications based on “use” of the Marks under section 30(b) of the Act rather than “intent to


use” under section 30(e). However, there is no evidence in the record to support either allegation. Accordingly, these grounds of opposition are dismissed, as the Opponent has failed to meet its evidential burden.

GROUND OF OPPOSITION BASED ON CONFUSION BETWEEN THE TRADEMARKS

[21] The remaining grounds of opposition in this case turn on allegations of confusion between the Marks and the Opponent’s JACKALOPE trademarks.

**Registrability of the Marks under section 12(1)(d)**

[22] The Opponent pleads that the Marks are not registrable under section 12(1)(d) of the Act because they are confusing with the Opponent’s Word Mark and the Opponent’s Design Mark as set out in the following trademark registrations owned by the Opponent (Opponent’s Registrations):

Trademark (Reg. No.)	Registered Goods & Services	Journal Translation
 (TMA991,019)	<p><i>T-shirts, casquettes, sac à dos, planche à roulettes.</i></p> <p><i>Organisation et tenue d’un festival de sport dans le domaine du ballet aérien, du base jump, du saut à l’élastique, du vol à voile, du deltaplane, du parapente, du funambulisme, du saut à ski, du parachutisme, de la moto cross, de l’alpinisme, de l’escalade, du ski, du vélo de montagne, de la planche à roulette, de la planche à neige, de la motoneige, du plongeon de haut-vol, de l’apnée, de la motomarine, de la nage, de la plongée sous-marine, du surf, du wakeboard, du kayak, de la planche à voile, et du parkour.</i></p>	<p>T-shirts, caps, backpacks, skateboards.</p> <p>Organization and conduct of a sports festival in the field of aerial ballet, base jumping, bungee jumping, gliding, hang gliding, paragliding, tightrope walking, ski jumping, sky diving, motocross, mountaineering, climbing, skiing, mountain biking, skateboarding, snowboarding, snowmobiling, high diving, apnea, personal watercrafting, swimming, scuba diving, surfing, wakeboarding, kayaking, windsurfing, and free running.</p>
<b>JACKALOPE</b> (TMA1,083,111)	<p><i>(1) Noix préparées; arachides préparées; croustilles. (2) Barres énergisantes; maïs grillé et éclaté (pop corn). (3) Bière; boissons énergétiques; eau en bouteille.</i></p>	<p>(1) Prepared nuts; prepared peanuts; potato chips. (2) Energy bars; popping corn (popcorn). (3) Beer; energy drinks; bottled water.</p>

Trademark (Reg. No.)	Registered Goods & Services	Journal Translation
<b>JACKALOPE</b> (TMA1,090,656)	<i>(1) Organisation de voyages. (2) Éducation, nommément, initiation sportive par le biais de camps d'entraînement, de livres, de vidéos et de manuels dans le domaine du ballet aérien, du base jump, du saut à l'élastique, du vol à voile, du deltaplane, du parapente, du funambulisme, du saut à ski, du parachutisme, de la moto cross, de l'alpinisme, de l'escalade, du ski, du vélo de montagne, de la planche à roulettes, de la planche à neige, de la motoneige, du plongeon de haut-vol, de l'apnée, de la motomarine, de la nage, de la plongée sous-marine, du surf, du wakeboard, du kayak, de la planche à voile, et du parkour; organisation d'activités et d'évènements sportifs dans le domaine du ballet aérien, du base jump, du saut à l'élastique, du vol à voile, du deltaplane, du parapente, du funambulisme, du saut à ski, du parachutisme, de la moto cross, de l'alpinisme, de l'escalade, du ski, du vélo de montagne, de la planche à roulettes, de la planche à neige, de la motoneige, du plongeon de haut-vol, de l'apnée, de la motomarine, de la nage, de la plongée sous-marine, du surf, du wakeboard, du kayak, de la planche à voile, et du parkour; organisation de camps de vacances; organisation de camps sportifs. (3) Productions audiovisuelles, nommément, production de films, préparation de présentations audiovisuelles.</i>	(1) Travel arrangement. (2) Education, namely sports education through training camps, books, videos and manuals in the fields of aerial acrobatics, base jumping, bungee jumping, gliding, hang gliding, paragliding, tightrope walking, ski jumping, skydiving, motocross racing, mountaineering, climbing, skiing, mountain biking, skateboarding, snowboarding, snowmobiling, high diving, freediving, personal watercraft riding, swimming, underwater diving, surfing, wakeboarding, kayaking, windsurfing and free running; organization of sporting events and activities in the fields of aerial acrobatics, base jumping, bungee jumping, gliding, hang gliding, paragliding, tightrope walking, ski jumping, skydiving, motocross racing, mountaineering, climbing, skiing, mountain biking, skateboarding, snowboarding, snowmobiling, high diving, freediving, personal watercraft riding, swimming, underwater diving, surfing, wakeboarding, kayaking, windsurfing and free running; organization of holiday camps; organization of sports camps.(3) Production of audiovisual media, namely film production, preparation of audiovisual presentations.

[23] The material date for this ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)]. The opponent's initial burden is met if the registration relied upon is in good standing on this date and the Registrar has discretion to check the Register in this respect [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised that discretion, I confirm that the Opponent's three registrations are extant.

[24] The Opponent having met its initial burden, the onus is now on the Applicant to satisfy the Registrar, on a balance of probabilities, that the Marks are not likely to cause confusion with any of the trademarks in the Opponent's Registrations.



### The test for confusion

[25] 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 system for trademark registrations [section 6(2) of the Act].

[26] The test for confusion is to be applied as a matter of first impression in the mind of a casual consumer somewhat in a hurry, who sees the applicant's trademark at a time when he or she has no more than an imperfect recollection of the opponent's trademark and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the trademarks [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[27] Regard must be had to all the surrounding circumstances, including those set out in section 6(5) of the Act: (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. These criteria are not exhaustive and the weight given to each will vary in a context-specific analysis [see *Veuve Clicquot, supra*; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22; *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27].

[28] In my opinion, the Opponent's Word Mark represents the Opponent's strongest case and I will therefore focus my discussion on the two word mark registrations.

### Resemblance between the trademarks

[29] The degree of resemblance between the trademarks is generally the most important factor in assessing the likelihood of confusion [*Masterpiece, supra*]. It is not the proper approach to set the trademarks side by side and carefully examine them to find similarities and differences; rather, each trademark must be considered as a whole and assessed for its effect on the average consumer [see *Veuve Clicquot, supra*; and *Masterpiece, supra*]. However, it is still possible to

focus on particular features of each trademark that may have a determinative influence on the public's perception of it [*United Artists Pictures Inc v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 (FCA)]. The preferable approach is to begin by determining whether there is an aspect of each trademark that is “particularly striking or unique” [*Masterpiece* at para 64].

[30] In the present case, the Marks are identical to the Opponent's Word Mark in sound and ideas suggested and strongly resemble it in appearance, having incorporated it in its entirety. Although the letters of the Marks are each in a specific font and, in the case of the Vertical Mark, arranged in three stacked lines, the fonts in question are plain ones and the word JACKALOPE remains readily recognizable in the stacked arrangement [for a similar conclusion see *Native One Inc v Grand River Enterprises Six Nations Ltd*, 2011 TMOB 195, where judicial notice was taken that English text is ordinarily read from left to right and then from top to bottom]. I would also note that registration of a word mark permits the registered owner to use the mark with any style of lettering or design [*Masterpiece, supra*], such that nothing would prevent the Opponent from displaying its trademark in a more similar font or in a vertical arrangement.

[31] In view of the foregoing, this factor favours the Opponent.

#### Inherent and acquired distinctiveness

[32] For both parties' trademarks, the word JACKALOPE has some inherent distinctiveness in association with the relevant goods and services. Although the evidence shows that it is not a unique word originated by either party—it refers to a mythical jackrabbit-antelope hybrid—it is not a common word either. Moreover, although both parties' advertising and promotion ties the term's symbolism to the nature of the customer experience, the word JACKALOPE itself has no immediate or obvious connection to either party's goods or services. Indeed, to consumers who are unaware of the term's meaning, JACKALOPE would likely appear to be a coined word.

[33] I consider the Vertical Mark to be slightly more inherently distinctive than the Horizontal Mark or the Opponent's Word Mark, in view of the design feature creating what appears to be a grid of letters. However, I find that the word “jackalope” is still readily recognizable within the Vertical Mark. Given the simple presentation of the word JACKALOPE in the Horizontal Mark,

I consider the Horizontal Mark and the Opponent's Word Mark to enjoy a similar level of inherent distinctiveness.

[34] With respect to the extent to which the parties' trademarks have become known, both parties filed evidence in this regard.

### **The Opponent's evidence**

[35] Mr. Desforges attaches various materials as exhibits to his affidavit to show how the Opponent's JACKALOPE trademarks have been displayed during the festival and in its promotion. I note from these materials that the Opponent's Design Mark, used since 2012, was modified for the 2015 festival: instead of jumping over an AMNESIA logo the jackalope jumps over a FIDO logo. Occasionally, the logo acknowledging the festival's sponsor is omitted. Furthermore, for the 2016 festival and in an advertisement for the 2017 festival, the Opponent's Design Mark has been replaced by the Opponent's New Logo.

[36] I consider use of the Opponent's Design Mark, the variation with a FIDO logo or without a sponsor logo, and the Opponent's New Logo to each constitute use of the Opponent's Word Mark. The Opponent's Word Mark remains recognizable and stands out from these various design marks' graphic features [for the principles regarding use of a trademark with additional elements and stylization, see *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB) and *Stikeman, Elliot v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB)].

[37] In addition, I consider use of the word JACKALOPE followed by the year of the festival to be use of the Opponent's Word Mark followed by descriptive matter.

[38] The supporting materials furnished by Mr. Desforges include the following:

- Annual attendance, revenue, and advertising figures for the festival from 2012 to 2016 [paras 7, 13-15, 18]. Mr. Desforges attests to thousands of visitors from across Canada attending the festival each year; to each of the Opponent's websites receiving approximately 10,000 unique Canadian visits per year (2012-2015); to annual revenues growing from nearly \$100,000 to over \$300,000; and to annual advertising expenditures in the tens of thousands of dollars.

- Extracts from the Opponent’s website at *tribuexperientiel.com* describing the JACKALOPE festivals held in 2012 and 2013 [Exhibit MD-2] and including images of a branded tank top and caps [at pages 15, 18, 19].
- Extracts from the Opponent’s website at *jackalopefest.ca* printed on September 14, 2016, regarding the festivals held from 2012 to 2016 and promoting the 2017 edition [Exhibit MD-4]. I note that the site includes images of branded merchandise and also advertises a trip to engage in various extreme sports across Panama in 2017, offered by Voyage Grand V in collaboration with the festival [at 245-246].
- Photographs of a representative sampling of the JACKALOPE-branded merchandise the Opponent has sold to the public at various editions of the festival since 2012, including t-shirts, caps, and a beverage bottle [Exhibit MD-5]. The depicted merchandise appears to be that offered for sale online in 2016 [Exhibit MD-4 at 244-245]. However, sales figures for branded merchandise are not provided. The closest indication of the extent of sales is an estimate made during cross-examination that roughly 20% of the revenues for 2016 were from the sale of branded merchandise and bar services combined [pages 14-18].
- The official poster for the JACKALOPE festival held in 2016, which Mr. Desforges confirms is representative of the Opponent’s promotional posters from 2012 to 2015 [Exhibit MD-3].
- A sampling of articles mentioning the festival that were published online from 2012 to 2016, some including images featuring the Opponent’s Design Mark or the Opponent’s New Logo [Exhibit MD-7]. I note that many of the publications appear to target either Montreal news or action sports.
- A summary of the festival’s press coverage in 2013 and documents prepared by the Opponent recapping the festivals held in 2014, 2015, and 2016, including media plans, summaries of press coverage, and outlines of how sponsors’ brands were promoted [Exhibits MD-2, MD-3, MD-6]. I note the following:
  - The Opponent’s Word Mark is displayed throughout the recap documents, including certain images of advertising and signage, while the Opponent’s Design Mark (or Opponent’s New Logo as of 2016) appears in images of advertising, signage, apparel,

- giveaways, and merchandise. Mr. Desforbes mentions that electronic tickets and programmes displayed the “JACKALOPE” trademark as well [para 16].
- The media plans provide distribution figures for advertising flyers, posters, billboards, signs, promotional objects, web banners, social media posts, newspaper and magazine ads, television and radio spots, promotional videos online, and a live webcast—summaries for 2014 and 2015 show a total number of such media impressions in the millions for each year. In addition, press coverage reports provide reach figures for print, television, radio, and the Internet, with each of these channels receiving millions of impressions in each of 2014 and 2015. Since the recap documents appear to be records made in the usual and ordinary course of business, as reports targeting the festival’s main sponsors, I am prepared to accept the distribution and reach figures as indicators of the extent to which the Opponent’s trademarks have become known.
  - Much of the print media appear to have focussed on Montreal. Indeed, survey results summarized in the 2014 and 2016 recaps indicate that approximately 70-75% of respondents in each of those two years were from the Montreal area, while approximately 15% of respondents in 2014 were from Quebec but outside Montreal [MD-2 at 85, MD-3 at 236]. Although no information regarding the administration of these surveys is provided, a photograph in the 2014 recap shows festivalgoers completing the survey electronically on site [MD-2 at 83]. The 2014 recap also references a promotional tour of six major Quebec cities that year, but provides no details in this regard [MD-2 at 23]. In the absence of further particulars, I am not prepared to accord much weight to the surveys’ precise figures; however, the evidence does tend to suggest that the Opponent’s trademarks may be best known in and around Montreal.
  - Photographs show that branded apparel items such as t-shirts and caps appear to be worn by festivalgoers and staff as well as spokespersons giving television interviews [MD-2 at 36, 164, MD-3 at 195, 228]. Additionally, in 2015, influencers received an upgrade kit with “JACKALOPE” hat and backpack while “key people in the industry” and “[t]op athletes” received branded back packs, t-shirts, and caps [MD-2

at 140, 164]. In 2016, promotional branded water bottles were distributed before the event [MD-3 at 221].

- Mr. Desforges explains that the television show referenced in 2015 and 2016 is a 30-minute television program recapping events from the festival, produced by the Opponent and broadcast in Canada through the TVA Sports network and also sold internationally [para 20, MD-2 at 167, MD-3 at 223]. I am prepared to accept this television program as correlating broadly with the registered service “production of audiovisual media, namely film production, preparation of audiovisual presentations”.

[39] I note that Mr. Desforges was cross-examined about the source of the Opponent’s services, given that the festival website indicates the event is an initiative of both the Opponent and Action Sports Association. However, based on the documentary evidence and Mr. Desforges’s descriptions, I am satisfied that the Opponent is the source of the festival. The Opponent’s advertising and promotion is consistent with this finding, as the majority of the press coverage identifying the source of the festival names only the Opponent and the contact particulars provided on the festival website are e-mail addresses of the Opponent. Mr. Desforges also confirmed during cross-examination that the Association only manages certain minor aspects of the festival, such as athlete registrations and the liquor licence [pages 10-13]. To the extent that any such activities might involve trademark use, I am satisfied that it would be licensed by the Opponent with the requisite control over the character and quality of the associated services, per section 50 of the Act, given that Mr. Desforges is the president of both entities [pages 10-11].

[40] Based on Mr. Desforges’ evidence, I conclude that the Opponent’s Word Mark has become known to some extent in the Montreal area in association with action sports festival events and activities and is likely also known to some extent among action sports enthusiasts across Canada. I am also satisfied that this trademark has become known to at least a limited extent in association with related promotional goods such as t-shirts and caps. However, I am not satisfied that it is known to any particular extent in association with the other goods and services in the Opponent’s registrations, for example, snack foods, travel arrangement, or organization of holiday and sports camps.

## **The Applicant's evidence**

[41] Ms. Makiv's evidence shows that the JACKALOPE hotel opened on April 1, 2017, and by the date of her affidavit, had received nearly 3000 staying guests [para 34]. However, marketing for the hotel had already begun in late 2016. As evidence of the extent to which the Marks have been used and promoted in this regard, Ms. Makiv provides the following:

- Photographs taken in July 2017 showing the Marks on hotel signage [para 35, Exhibit M], including two large, three-dimensional signs consisting of the Vertical Mark and the Horizontal Mark respectively, and two white cards or signs displaying the Horizontal Mark below a stylized jackalope head.
- Photographs taken in July 2017 showing the Marks on merchandise available for purchase at the hotel [para 36, Exhibit N], including a T-shirt with the Horizontal Mark printed on the neck label and the stylized jackalope head displayed on the front, as well as a cap and tote bag displaying the Vertical Mark.
- Printouts made on July 20, 2017, from the hotel's website at *www.jackalopehotels.com* and from its Instagram and Facebook social media pages, which provide information about and images of the hotel and its two restaurants and bar [Exhibit L]. The website emphasizes the importance of art and design in "Jackalope Hotel's debut property", including a 7-metre tall jackalope sculpture at the hotel entrance, while the Facebook posts—which begin in November 2016—promote the hotel's refined dining restaurant Doot Doot Doot, its winery restaurant Rare Hare for "immersive wine and culinary experiences", and the hotel's bar Flaggerdoot for a "daring cocktail menu", among other features.
- Lists of print and online publications in which the JACKALOPE hotel was promoted or featured from late 2016 to June 2017—including design, food, travel, and lifestyle magazines—as well as information on television and Internet broadcasts [paras 12-21]. Reach statistics are provided for many of the publications and range from tens of thousands to millions of media impressions.
- Statements regarding other initiatives, namely a photo shoot for the hotel's "Rare Hare Wine and Food Store" [para 13], a meeting with the operators of the region's tourism

website [para 11], and negotiation of strategic partnerships with certain luxury brands [para 13]. However, Ms. Makiv's only reference to the outcome of these other initiatives is the mention of a LEXUS LC launch at the hotel in June 2017 and its coverage in "premium men's blogs and lifestyle publications" [para 19].

- Copies of articles regarding the JACKALOPE hotel and its associated restaurants and bar, from various print and online publications dated January 2017 to July 2017 [Exhibits A-K]. In the body of her affidavit, Ms. Makiv reproduces certain descriptions from these articles and I consider her to be adopting these chosen characterizations of the hotel as her own [paras 22-32]. Highlighted features include the hotel's curated art collection and sense of theatre, its working winery and vineyard view, its refined dining restaurant Doot, Doot, Doot (the term for an "alpha" jackalope), its cocktail bar Flaggerdoot (the collective noun for jackalopes), its 30-metre infinity pool, and its bath products made exclusively for the hotel.

[42] Although Ms. Makiv confirms that customers in Canada can access the hotel website at *www.jackalopehotels.com* and book stays online, she does not specify whether the site actively targets Canadians, has actually been accessed from Canada, or has resulted in any hotel bookings from Canada. Nor does she provide any Canadian circulation or reach figures for the hotel's press coverage, much of which appears to be in Australia. The only listed publication with an explicit connection to Canada is a brief review in Air Canada's digital *En Route* magazine downloaded in July 2017, but again, there is no indication of the extent to which the article may have been accessed from Canada [para 31, Exhibit I].

[43] Based on Ms. Makiv's evidence, it is possible that Canadians visiting Australia or browsing online have become aware of the Marks' association with a boutique luxury hotel and related features and merchandise. However, in the absence of any information regarding the extent to which the Marks' use and promotion has reached Canada, I cannot find that the Marks have become known in Canada to any meaningful extent.



### **Conclusion on inherent and acquired distinctiveness**

[44] In view of the foregoing, I find that the overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness, favours the Opponent—at least to the extent that the Opponent relies on its trademarks having become known in association with action sports festival events and activities and related promotional goods.

#### Length of use

[45] The evidence demonstrates continual use and promotion of the Opponent's Word Mark as of 2012, whereas the Application is based on proposed use. Accordingly, this factor favours the Opponent.

#### Nature of the goods, services, and business

[46] When considering the nature of the parties' goods and services under section 12(1)(d) of the Act, it is the statement of goods and services in the applicant's application and the statement of goods and services in the opponent's registration that must be assessed. However, each statement must be interpreted in a holistic manner and read with a view to determining the probable type of business intended; evidence of the parties' actual trades is useful in this respect [*Triangle Tyre Co, Ltd v Gestion André Touchette inc*, 2019 FC 220; *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *McDonald's Corp v Silcorp Ltd* (1989), 55 CPR (2d) 207 (FCTD), *aff'd* (1992), 41 CPR (3d) 67 (FCA)].

[47] I find that the Services in this case fall into three broad categories: (i) arrangement and reservation of accommodations and meals; (ii) provision of accommodations and other hotel services, and (iii) restaurant, catering, and bar services. I will discuss each of these in turn.

#### **Arrangement and Reservation Services**

[48] I find that the following services in the Application (Arrangement and Reservation Services) directly overlap with the service "travel arrangement" in the Opponent's Word Mark registration no. TMA1,090,656:

Accommodation reservation services; Arranging hotel accommodation; Booking of hotel accommodation; Hotel accommodation reservation services; Reservation of hotel

accommodation; Arranging hotel reservations; Booking services for hotels; Hotel information; Hotel reservation services; Restaurant reservation services; Reservation of places at holiday resorts; Booking of restaurant places.

[49] In this respect, I consider the nature of “travel arrangement” to be such that it could include reservation and booking of accommodations (including at hotels) and of meals (including at restaurants) and providing information in that regard.

### **Accommodation and Hotel Services**

[50] Conversely, I do not find any of the following services listed in the Application (Accommodation and Hotel Services) to be similar or significantly related in nature to goods or services in the Opponent’s Word Mark registrations:

Hospitality services (accommodation); Hotel accommodation services; Inn keeping ( [... ] accommodation); Provision of hotel accommodation; Resort accommodation; Resort hotel services; Hotel services; Hotels.

[51] In this respect, I note the following.

#### *Registration TMA1,090,656*

[52] Although I accept that “travel arrangement” encompasses *booking* accommodations, I am not prepared to find that “travel arrangement” includes the actual *provision* of the accommodations themselves or of the services of a hotel. Furthermore, the Opponent provides no evidence that travel arrangement businesses also tend to offer accommodations or the services of a hotel.

[53] Nor do I find that any of the other services in the Opponent’s registration no. TMA1,090,656 overlap with accommodation or hotel services. I appreciate that certain resorts (for example, ski or beach resorts) may provide for certain sporting events and activities and that the Service “hospitality services (accommodation)” may be broad enough to cover accommodations for overnight camps, including holiday and sports camps. However, the specific services in the Opponent’s registration are “organization of sporting events and activities”, “organization of holiday camps; organization of sports camps”, and “education, namely sports education through training camps”. I do not find that such organization and education services

are related to providing accommodations or hotel services. Accordingly, I do not find that the organization and education services in the Opponent's registration are related in a meaningful way to the specific Services of "resort accommodation", "resort hotel services", or "hospitality services (accommodation)".

*Registration TMA1,083,111*

[54] I also do not find that any of the beverage or snack goods in the Opponent's Word Mark registration no. TMA1,083,111 are related in nature to accommodation services or to the services of hotels *per se*. As for potential overlap with hotel restaurant, catering or bar services, that question will be discussed below.

**Restaurant, Catering, and Bar Services**

[55] The Opponent makes a number of submissions alleging overlap between its registered goods and services and the Applicant's restaurant and bar services. However, upon consideration of the parties' actual and potential trade channels, I do not find a meaningful connection between any of the goods or services in the Opponent's two word mark registrations and the remaining Services, which read as follows (Restaurant, Catering, and Bar Services):

Inn keeping (bar, restaurant [...]); Hotel catering services; Bar services; Coffee bar and coffee house services (provision of food and drink); Salad bar restaurant services; Wine bar services; Restaurant services; Restaurants; Self-service restaurants; Theatre restaurants (Provision of food and drink).

[56] With regard to these services, I note the following.

*Registration TMA1,083,111*

[57] The Opponent submits that the snack and beverage goods covered by its word mark registration no. TMA1,083,111 overlap with the restaurant services in the Application in that restaurants sell foods and beverages. Indeed, as emphasized by the Opponent, Ms. Makiv's affidavit contains references to the "Rare Hare Wine and Food Store" [para 13], suggesting that the Rare Hare restaurant can be characterized as either being or including a food store. In this respect, I would also note that one of the exhibited articles describes Rare Hare as a "winery, restaurant and produce store" [Makiv Exhibit D].

[58] In support, the Opponent cites two decisions of the Registrar wherein confusion was found between an applicant's trademark for use in association with "restaurant services" and an opponent's trademark used in association with food products: *Campbell Soup Co v Spectrum Foods, Inc* (1987), 15 CPR (3d) 362 and *Culinar Inc v Saga Enterprises Inc* (1990), 30 CPR (3d) 361. In both cases, the Registrar found that (i) it is not uncommon for restaurants to also sell food products and for food stores to also provide services in the nature of a restaurant and (ii) the broad term "restaurant services" could include the provision of food to restaurants.

[59] However, in both cited cases, the Registrar also found a specific connection between the restaurant trade and the opponent's food products and trade. In *Campbell Soup*, in the absence of evidence from the applicant, it appeared that the applied-for "restaurant services" could include the provision of food to restaurant outlets and the applicant's agent conceded that the opponent's PREGO spaghetti sauce goods could be sold to restaurants—it was on this basis that the Registrar held that "there clearly could be a connection between the trades of the parties" [at para 8]. In *Culinar*, the Registrar found not only that the term "restaurant services" in the application included the provision of food to restaurants and that the opponent's STUART cakes and pastries were products that one might find in a restaurant and that could "certainly be sold to restaurants" but also that the opponent operated restaurants [at paras 10-11].

[60] By contrast, in the present case, there is no indication that the Opponent's trade overlaps with restaurant services in the manners found to be relevant in *Campbell Soup* and *Culinar*. I am prepared to take judicial notice that beer is served (and occasionally brewed) in some types of bars and that bottled water is served in some restaurants and by some caterers. In addition, although there is no evidence on the meaning of the term "theatre restaurants" or the nature of the theatre involved, I appreciate that at least movie theatres prepare and sell "popcorn". However, terms such as "bar services", "restaurant services", "restaurants", and "hotel catering services" relate primarily to a range of *services* concerning food and beverage goods and not to the goods themselves. This level of connection between an opponent's goods and an applicant's services is not necessarily a strong indicator of potential confusion, particularly if each party's business model is fundamentally different [see *Triangle Tyre, supra*].

[61] Unlike in *Campbell Soup* and *Culinar*, the Applicant in the present case filed evidence concerning the nature of its business. It is clear from this evidence and from a reading of the Application that the Applicant is in the hospitality business and not the restaurant supply business. Furthermore, although the Opponent’s registration contains no restrictions on the channels of trade, it is clear from the Opponent’s evidence that the Opponent is not a manufacturer or brewer but is rather in the experiential marketing business and that its JACKALOPE branded goods and services relate to an action sports festival and are not made available in any other context.

[62] I would also note that, in the absence of evidence on point, I am not prepared to find that any of the *specific* types of restaurants or bars listed in the Application—such as coffee bars and coffee houses, salad bar restaurants, wine bars, or theatre restaurants—would be expected to prepare, serve, or sell the specific types of food and drink goods listed in the Opponent’s registration namely, prepared nuts, prepared peanuts, potato chips, energy bars, popping corn (popcorn), beer, energy drinks, and bottled water.

[63] In the circumstances, I find that, in spite of some superficial overlap, the beverage and snack goods covered by the Opponent’s registration are not related in a meaningful way to the restaurant, catering, or bar services contemplated by the Application.

*Registration TMA1,090,656*

[64] Although I accept that “travel arrangement” encompasses *booking* meals, I am not prepared to find that “travel arrangement” includes the actual *provision* of the meals themselves or related restaurant, catering, or bar services. Furthermore, the Opponent provides no evidence that travel arrangement businesses also tend to offer restaurant, catering, or bar services. Similarly, with respect to “organization of holiday camps; organization of sports camps”, although I appreciate that campers may require meals, I do not find that the specific service of *organizing* camps includes or is otherwise related to the *provision* of the required meals.

[65] With respect to “organization of sporting events and activities”, “organization of sports camps”, and “sports education through training camps”, although the Opponent notes that the Applicant’s “restaurant services” could include sports bars, there is no evidence that sports bars

tend to organize or run sporting events, activities, or camps—or that sports camps tend to operate sports bars. Furthermore, in my view, the fact that events, activities, camps, and restaurants may all have sports as their theme is an insufficient basis for a finding that organizational or education services in the field of sports are related to “restaurant services”.

### **Summary for the nature of the goods, services, and business**

[66] In summary, I find there to be (i) direct overlap between the Arrangement and Reservation Services in the Application and the service “travel arrangement” in the Opponent’s Word Mark registration no. TMA1,090,656; (ii) no similarity or significant relation between the Accommodation and Hotel Services in the Application and any of the goods or services in the Opponent’s two word mark registrations; and (iii) in spite of some superficial overlap with goods such as “beer” and “bottled water”, no meaningful connection between the Restaurant, Catering, and Bar Services in the Application and any of the goods or services in the Opponent’s two word mark registrations.

### **Note re Opponent’s Design Mark registration no. TMA991,019**

[67] I note that the Opponent’s position would be no better if I were to consider the Opponent’s Design Mark and registration no. TMA991,019 therefor, which includes the service “organization and conduct of a sports festival” as well as the goods “t-shirts” and “caps”.

[68] I reach a similar conclusion with respect to this service as with respect to “organization of sporting events and activities”: although a resort might conceivably host a sports festival, the organization and conduct of the festival would not be related to the resort’s accommodation or hotel services *per se*.

[69] The Opponent seeks to draw a connection between hotel services and festival services in that hotels have swimming pools, an amenity also made available at the Opponent’s festival. Indeed, the Applicant’s Facebook posts specifically advertise a 30-metre infinity pool, as do many of the exhibited articles, and some of these materials highlight additional features linked to the pool, such as a hot tub, an adjacent pavilion available for spa treatments or private dining, and a view overlooking the vineyards [Makiv Exhibits A-L]. As concerns the Opponent, photographs in its recap documents show what appears to be a public swimming pool on the site

of the 2014 and 2015 festivals; it was promoted as part of a “Refresh Zone” and “Pool Party” in 2015 [Desforges Exhibit MD-2 at 30, 111, 127-130, 136-137]. However, the fact that both hotels and sports festivals may seek to attract customers through an ancillary swimming pool amenity does not mean that the organization and conduct of sports festivals is related to hotel services.

[70] In the Opponent’s submission, because providing access to a swimming pool is ancillary to providing hotel services, registration of the Marks in association with hotel services would give the Applicant the exclusive right to advertise JACKALOPE swimming pool facilities on their own [per the definition of trademark “use” in section 4(2) of the Act]. However, even if a hotel company *may* be considered to perform “hotel services” when customers receive the benefit of a hotel swimming pool, I am not prepared to accept that registering a trademark for “hotel services” grants an exclusive right to use that trademark in advertising access to swimming pools outside the context of hotels. By way of example, an independent sports complex advertising swimming pool facilities would not be considered to advertise “hotel services”. I therefore disagree with the Opponent that registration of the Marks in association with “hotel services” would allow confusion to occur on that basis.

[71] Similarly, although Ms. Makiv states that the Applicant’s hotel sells JACKALOPE branded t-shirts and caps, I am of the view that a hotel displaying its name on apparel available for purchase at the hotel is a promotional activity and falls short of demonstrating meaningful overlap between the service “hotel services” and the goods “t-shirts” or “caps” *per se*.

[72] The Opponent also submits that the organization and conduct of sports festivals involves the provision of restaurant and bar services. In this respect, as noted above, Mr. Desforges attests that the Opponent leases space at the festival to food trucks and provides a JACKALOPE-branded bar on site [cross-examination pages 13, 17]. I also note the following evidence:

- Mr. Desforges states that restaurant services have been available on the site of the JACKALOPE festival since 2012 [para 9] and, indeed, some of the festival’s press coverage as of 2013 promotes the availability of food trucks, as well as beer or alcohol [Exhibit MD-7].
- The Opponent’s 2014 recap document confirms that the festival sells beer while site maps in the 2015 and 2016 recaps indicate the location of a bar and food trucks

[Exhibits MD-2 at 23, 134, MD-3 at 186-87]. The logos of seven food trucks were displayed on the festival website in 2016 [Exhibit MD-4 at 259].

- The influencers' upgrade kit referenced in the 2015 recap is described as including a bottle of water (not said to be branded), a lunch ticket, and two beer tickets [Exhibit MD-2 at 140].
- The 2013 festival was reported to include an after party at a bar [Exhibit MD-7 at 323, 327] and "satellite events" mentioned in the 2015 recap include an after party in two bars [Exhibit MD-2 at 121].

[73] However, I find that the service "organization and conduct of sports festivals" listed in the Opponent's registration is not related in a meaningful way to the restaurant, catering, or bar services contemplated by the Application.

[74] With respect to the restaurant aspect, I find that, even if food trucks operate at sports festivals or if sports festivals hold satellite events at restaurants, the evidence suggests that such food trucks and satellite venues are operated by third parties rather than by the festival organizer (be it directly or through licensees). The Opponent submits that the involvement of third parties is immaterial: there remains a connection between restaurant services and sports festivals in that consumers in search of a meal can choose to eat at a sports festival. In my view, however, there is at most evidence of an overlap in the channels of trade, which will be discussed below.

[75] The Opponent also notes that the Applicant's "restaurant services" could include sports bars. Again, however, there is no evidence that sports bars tend to organize sports festivals or that sports festivals tend to operate restaurants in the nature of sports bars. In my view, the fact that both festivals and restaurants may have sports as their theme is an insufficient basis for a finding that "organization and conduct of festivals" is related to "restaurant services".

[76] Finally, with respect to bar services, to the extent that there is evidence of the Opponent selling beer or alcohol, I would be prepared to accept that this aspect of running a festival would be similar in nature to a service performed by certain bars and that slight overlap would thus be possible between the organization and conduct of sports festivals and the general category "bar services". However, a bar in the form of a beer tent set up specifically for an outdoor festival



would be different in nature to a hotel cocktail bar, coffee bar, wine bar, or salad bar. Although I am mindful that the actual use of a mark to date should not be considered to the exclusion of potential future uses within a registration and that there is no guarantee the Applicant will never operate a beer tent or provide bar services at an outdoor festival, there is no evidence to suggest that the Applicant's existing business model is likely to change.

[77] Moreover, in the absence of further evidence on point, offering beer and alcohol appears to represent a relatively minor aspect of the Opponent's festival. Mr. Desforges does not mention providing bar services in his affidavit and none of the evidence shows any of the Opponent's trademarks displayed in the performance or advertising of such services (except inasmuch as the recap documents constitute advertising).

[78] Accordingly, I find that the demonstrated connection between "bar services" and the organization and conduct of action sports festivals is not particularly strong.

#### Nature of the trade

[79] Regard must also be had to the channels of trade that would normally be associated with the parties' goods and services [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export* (1986), 12 CPR (3d) 110 (FCA)]. The likelihood of confusion is generally greater where the parties' goods or services, even if dissimilar, are offered through the same types of venues or to the same kind of customers; conversely, the likelihood of confusion may be discounted where the channels of trade of each party are very different (see *Toys R Us (Canada) Ltd v Manjel Inc*, 2003 FCT 282).

[80] Again, the statements of goods and services in the applicant's application and opponent's registration 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 [see *Coffee Hut, supra*; *Procter & Gamble Inc v Hunter Packaging Ltd*, 1999 CarswellNat 3465 (TMOB)]. The proper emphasis is on the parties' entitlement to operate through a given channel rather than whether they in fact do so; that said, one should look at the parties' actual trades as a basis for determining the likelihood

of the parties ever overlapping (*Distribution Prosol PS Ltd v Custom Building Products Ltd*, 2015 FC 1170; see also *Masterpiece*, *supra*).

[81] In the present case, the parties' goods and services have been delivered through distinct channels: a sports festival in the case of the Opponent and a hotel in the case of the Applicant. There is no indication that either party may in the future use its JACKALOPE brand in a different context. That said, nothing would prevent the Opponent from making reservations at the Applicant's hotel and restaurant in the course of arranging travel for trips like the Panamanian tour advertised on the Opponent's JACKALOPE website or prevent the Applicant from providing further information or reservation services under the JACKALOPE banner to purchasers of such trips arranged by the Opponent. Similarly, nothing would prevent one of the Applicant's bars or restaurants from leasing space at a festival like the one operated by the Opponent or prevent the Opponent from hosting a satellite event at a hotel restaurant or bar like those of the Applicant or from selling branded beverage and snack goods at such a venue. There is at least potential for overlap to these extents.

[82] I would also note that the Applicant's hotel is located on the site of a working winery and is associated with a winery restaurant [Makiv para 24]. The hotel also features amenities such as bath products made exclusively for the hotel [Makiv para 22; see also reference in article at Exhibit D to "bespoke unguents, including a pinot grape skin bath soak and body scrub"]. There is no evidence that the Applicant's amenities include bottled water or that it plans to expand from wineries and winery restaurants to, for example, breweries and brewpubs. Nevertheless, insofar as the Applicant operates a business producing and selling alcoholic beverages in a related restaurant and commissions exclusive amenities that may be bottled, I find that there is at least the possibility that either house branded or third-party branded beer or bottled water would be sold in the planned series of JACKALOPE hotels. To that extent, there would also be a potential for overlap in channels of trade between the Restaurant, Catering, and Bar Services and goods such as "beer" and "bottled water". However, in the absence of evidence regarding the Applicant's future business plans, a finding along these lines would be speculative. Moreover, the possibility of beer, bottled water, or other such goods sold in a hotel context being sourced (or being thought to be sourced) from an action sports festival seems remote.

[83] Furthermore, I agree with the Opponent that there is potential for overlap in the parties' customers and clientele, as both the Applicant and the Opponent provide services for travellers, tourists, and food and entertainment seekers, and in particular those looking for "original experiences". The evidence shows the experiences offered by the Opponent differing in theme and style from those offered by the Applicant; however, there are no restrictions in this respect in either the Application or the Opponent's Registrations. Moreover, as noted by the Opponent, consumers in search of a meal can choose to eat at either one of the Applicant's hotel restaurants or the Opponent's action sports festival. During cross-examination, Mr. Desforges added that the target audience for the Opponent's festival comprises both the young and the young at heart [page 22], which the Opponent submits includes the Applicant's target age group as well.

[84] There has also been some corresponding overlap in advertising channels. The Opponent notes in particular that signage promoting the JACKALOPE festival was displayed at a hotel front desk and at two bars a month before the 2015 festival and in 11 bars and restaurants for the 2016 festival [see media plans in Exhibits MD-2 at 166, MD-3 at 212]. In the Opponent's submission, patrons of such restaurants seeing the Opponent's promotional signage could simultaneously be exposed to the Applicant's JACKALOPE signage should the Applicant launch a neighbouring restaurant. I would also note that (i) the Opponent's festival appears to have been mentioned on at least one hotel-related website, *westinmontreal.com* [Desforges Exhibit MD-6]; (ii) both parties' summaries of press coverage list publications with travel-related titles, and Air Canada's *En Route* magazine in particular [Desforges Exhibits MD-2 at 170, MD-3 at 227, MD-6; Makiv paras 11-12, 14-18, 24-25, 28-31]; and (iii) the Opponent's 2015 recap mentions distribution of a promotional video on Montreal's tourism website, while Ms. Makiv mentions the Applicant at least meeting with the operators of her region's tourism website [Desforges Exhibit MD-2 at 165; Makiv para 11].

[85] In summary, I find that the parties' channels of trade are different and distinct, although I am prepared to accept a slight potential for overlap to the extent that restaurants may lease vending space at a festival featuring sporting events and activities or that festivals host satellite events at hotel restaurants. Although an intermingling in the channels of trade between the Applicant's hotel restaurant, catering, or bar services and the Opponent's goods such as beer or bottled water is also possible, I do not find it likely in the particular circumstances of the present

case. I also accept the potential for general overlap in the parties' customers and clientele and accordingly in advertising channels; however, the overlapping customer base in the present case—young or young-at-heart travellers, tourists, and food and entertainment seekers—is a broad one. On balance, regardless of which of the Opponent's Registrations is considered, I find that the nature of the trade does not weigh heavily in favour of either party.

#### Conclusion on the likelihood of confusion

[86] As noted above, the onus is not on the Opponent to show that confusion is likely but rather on the Applicant to satisfy the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion.

[87] For each of the Marks, having considered all the surrounding circumstances, I find that, at best for the Applicant, the probabilities are evenly balanced between a finding of confusion with the Opponent's Word Mark in respect of the Arrangement and Reservation Services and a finding of no confusion. I reach this conclusion based primarily on (i) the strong resemblance between the Opponent's Word Mark and each of the Marks and (ii) the direct overlap between the Arrangement and Reservation Services and the "travel arrangement" services in the Opponent's registration no. TMA1,090,656. In the circumstances, the fact that the parties' respective arrangement and reservation services would be provided through different channels of trade does not necessarily eliminate the likelihood of confusion. As the onus is on the Applicant, I must find against the Applicant in respect of these Services.

[88] Having found a reasonable likelihood of confusion with the Opponent's Word Mark on the basis of registration no. TMA1,090,656, there is no need to consider the likelihood of confusion on the basis of registration no. TMA1,083,111 or TMA991,019 in respect of this category of Services.

[89] I reach a different conclusion with respect to the Accommodation and Hotel Services and the Restaurant, Catering, and Bar Services. Despite the strong resemblance between each of the Marks and the Opponent's Word Mark, and notwithstanding the inherent distinctiveness of the Opponent's Word Mark and the extent to which it has become known in association with the organization of sporting events and activities, I am satisfied that, on a balance of probabilities,

there is no reasonable likelihood of confusion, regardless of which of the Opponent's registrations is considered. I arrive at this conclusion based primarily on the differences in the nature of the goods and services involved and bearing in mind the minimal degree of overlap in the channels of trade. In my view, a consumer is not likely to believe that any of the Accommodation and Hotel Services or any of the Restaurant, Catering, and Bar Services covered by the Application are from the same source as, or are otherwise related to, any of the goods or services covered by the Opponent's registration no. TMA1,083,111 or TMA1,090,656.

[90] I find the Opponent's position to be no better when one considers the Opponent's Design Mark and the goods and services covered by its registration no. TMA991,019. The degree of resemblance is slightly less given this trademark's additional design elements. Furthermore, although the Opponent's Design Mark has become known to some extent in association with the organization and conduct of a sports festival and related merchandise, I do not find the evidence regarding this trademark's use and promotion sufficient to tip the balance in favour of the Opponent. In particular, I am not prepared to find that the average consumer would expect any of the Accommodation and Hotel Services or any of the Restaurant, Catering, and Bar Services to come from or to be approved, licensed, or sponsored by a sports festival, on the basis that such festivals may provide on-site access to food trucks, beer, alcohol, or swimming pools, or access to satellite events at restaurants and bars off site. Moreover, the fact that the Applicant may sometimes cater to the same consumers as the Opponent, and advertise accordingly, does not necessarily mean that these consumers are likely to be confused as to the source the parties' respective services.

[91] In summary, I find that the ground of opposition based on registrability of the Marks under section 12(1)(d) of the Act succeeds with respect to the Arrangement and Reservation Services, but not with respect to the Accommodation and Hotel Services or with respect to the Restaurant, Catering, and Bar Services.

**Entitlement to registration over previously used trademarks and trade name under sections 16(3)(a) and (c)**

[92] The Opponent pleads that the Applicant is not the person entitled to registration of the Marks under sections 16(3)(a) and 16(3)(c) of the Act because, at the priority filing date and all

material times, the Marks were confusing with the following trademarks and trade name previously used by the Opponent or its predecessors in title, or for their benefit by licensees:

- the Opponent’s Word Mark;
- the trademark JACKALOPE & Design of a Hare and Antelope Hybrid (“*JACKALOPE (& dessin d’un mélange entre un lièvre et une antilope)*”), which I accept corresponds to the Opponent’s Design Mark; and
- the trade name JACKALOPE.

[93] The Opponent pleads use of these trademarks and trade name in association with its goods, services, and business pertaining to the organisation and conduct of an action sports festival, and to clothing and accessories, of the same nature as those covered by (i) the Opponent’s application no. 1,702,712 [now registration TMA991,019] and (ii) the Application.

[94] To meet its initial burden under these grounds, the Opponent must evidence not only use of its trademark or trade name prior to the Applications’ priority filing date, October 16, 2014, in accordance with sections 16(3) and 34(1) of the Act, but also that its trademark or trade name had not been abandoned when the Applications were advertised on June 15, 2016, as stipulated in section 16(5). Abandonment requires both an absence of use and an intention to abandon use [*Labatt Brewing Co v Formosa Spring Brewery Ltd* (1992), 42 CPR (3d) 481 (FCTD); *Marineland Inc v Marine Wonderland and Animal Park Ltd* (1974), 16 CPR (2d) 97 (FCTD)].

Previously used trademarks: the Opponent’s initial burden

[95] As discussed above under the section 12(1)(d) ground of opposition, Mr. Desforages’ affidavit provides evidence of use of the Opponent’s Word Mark and Opponent’s Design Mark in association with the organization and conduct of an action sports festival beginning in 2012, which is prior to the Applicant’s priority filing date of October 16, 2014. Furthermore, given the edition of the festival held in 2016 and the festival website’s advertisement of the 2017 edition of the festival, I accept that the Opponent’s Word Mark was not abandoned when the Applications were advertised on June 15, 2016.

[96] With respect to the Opponent's Design Mark, it was replaced in 2016 by the Opponent's New Logo, whose graphic element consists only of antlers and not of a hare and antelope hybrid as pleaded. The adoption of a new trademark *may* show an intention to abandon the use of an older and unused mark; however, this factor is not conclusive in itself [*Labatt, supra*]. In the present case, I agree with the Opponent that the introduction of the new logo in 2016 does not necessarily mean that the Opponent had no intention of ever returning to its original logo. In any event, I find that the Opponent's Design Mark is not an "older and unused mark". It remained displayed on the festival website in September 2016 in photographs from earlier editions of the festival, not only in depicted scenes (on apparel and signage) but also stamped on the corner of certain photographs [Exhibit MD-4 at 260-261]. Thus the Opponent's Design Mark continued to be displayed in advertising for the festival after June 15, 2016.

[97] Based on the foregoing, I am satisfied that the Opponent has met its initial burden with respect to use of both the Opponent's Word Mark and the Opponent's Design Mark in association with the organisation and conduct of an action sports festival.

[98] However, I am not satisfied that the Opponent has met its burden for either trademark in association with clothing and accessories. The only documentary evidence prior to the material date appears to be a photograph of a pair of caps bearing the Opponent's Design Mark, on a webpage regarding the 2013 festival [Exhibit MD-2 at 12]. However, unlike the festival website for 2016, which clearly shows branded merchandise priced for sale online, the webpages for 2013 do not indicate whether merchandise was available for purchase online and it is not clear whether the particular caps depicted were actually sold or merely distributed free of charge for promotional purposes. The Opponent provides no sales figures for clothing or accessories sold prior to the material date.

[99] Accordingly, I find that the Opponent has met its initial burden under the section 16(3)(a) entitlement ground of opposition in respect of both its pleaded trademarks, but only in association with the organisation and conduct of an action sports festival. The onus is thus on the Applicant to satisfy the Registrar, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Marks and either of the Opponent's trademarks used in

association with such services at the material date, being the Applicant's priority filing date of October 16, 2014 [section 16(3)(a) of the Act].

Previously used trademarks: the likelihood of confusion

[100] In applying the test for confusion according to the factors set out in section 6(5) of the Act, the earlier material date associated with this ground of opposition does not significantly alter the analysis performed under the registrability ground with respect to the degree of resemblance between the parties' trademarks, their inherent and acquired distinctiveness, and their length of use. Although use and promotion of the Opponent's trademarks in connection with the 2015 and 2016 festivals can no longer be considered, there remains evidence of use and promotion of both trademarks from 2012 to 2014, whereas there is no evidence whatsoever that the Marks were used or known in Canada at the material date.

[101] However, when one considers the nature of the parties' goods, services, businesses and trades, the Opponent's case is weaker under the entitlement ground. Under this ground, it is the statement of services as defined in the Applications versus the goods and services for which the Opponent has shown actual use that governs the analysis, and the Opponent has only shown use in association with the organisation and conduct of an action sports festival.

[102] For the reasons discussed under the registrability ground, I am of the view that no significant connection has been demonstrated between the Opponent's organization and conduct of an action sports festival and either the Accommodation and Hotel Services or the Restaurant, Catering, and Bar Services.

[103] Furthermore, I am of the view that no significant connection with the Arrangement and Reservation Services has been demonstrated either. Even if the Opponent's festival may be associated with the arrangement of meals and accommodations for trips like the one to Panama advertised on the festival website, this advertisement appears to be from 2016, for a trip in 2017, and as such is after the material date. There is no evidence of the Opponent's festival being associated with the arrangement of such trips at the material date.

[104] With respect to the channels of trade, I would also note that the majority of the evidence regarding the JACKALOPE festival's promotion in publications with travel-related titles, on



tourism websites, and in restaurants and bars post-dates the material date. Additionally, the evidence with respect to the specific nature of the Applicant's business post-dates the material date.

[105] In view of the foregoing, for each of the Marks, I find that the Applicant meets its legal onus under the section 16(3)(a) entitlement ground of opposition in respect of all the Services, regardless of which of the Opponent's two pleaded trademarks is considered. In either case, despite the resemblance between the parties' trademarks, and notwithstanding the inherent distinctiveness of the Opponent's trademark and the extent to which it has become known, I am satisfied that, on a balance of probabilities, there is no reasonable likelihood of confusion. I arrive at this conclusion based primarily on the differences in the nature of the respective parties' goods, services, businesses, and trades. In my view, a consumer is not likely to receive the impression that any of the Applicant's Services come from or are approved, licensed, or sponsored by the Opponent.

[106] Consequently, the entitlement ground based on prior trademark use is rejected.

#### Previously used trade name

[107] Section 2 of the Act defines "trade name" as "the name under which any business is carried on, whether or not it is the name of a corporation, a partnership or an individual."

[108] At the oral hearing, the Opponent submitted that display of the word JACKALOPE in the following Instagram posts in 2014 and 2016 (as reproduced in the respective recap documents) demonstrates use of the Opponent's Trade Name [Exhibits MD-2 at 67 & MD-4 at 207, bold emphasis in original]:

- In 2014: "**JACKALOPE** Présenté par amnesiashop et diffusion web amplifiée par **ROGERS!** Le 18, 19 et 20 juillet 2014 au Parc Olympique, Montréal, Canada! <http://www.jackalopfest.com>" [TRANSLATION]: **JACKALOPE** Presented by amnesiashop and webcast amplified by **ROGERS!** July 18, 19 and 20, 2014 at Olympic Park, Montreal, Canada! <http://www.jackalopfest.com>.
- In 2016: "**JACKALOPE** Presented by @lait.chocolat #skateboarding #basejump #bouldering #FMX August 19-21, 2016, Montreal, Olympic park #jackalopfest Buy your tickets now!".

[109] In the Opponent’s submission, the word JACKALOPE in these instances could be perceived as both the festival name and a trade name; one does not exclude the other.

[110] It is not necessary to address this ground of opposition in detail. Even if I were to accept use of the Instagram handle “JACKALOPE” as trade name use, the confusion analysis would be no more favourable to the Opponent for any of the Services than the confusion analysis performed in respect of the Opponent’s Word Mark under the section 16(3)(a) entitlement ground. Accordingly, the Applicant would meet its legal onus.

[111] Consequently, this ground of opposition is rejected.

### **Distinctiveness of the Marks under section 2**

[112] The Opponent also pleads that the Marks are not and cannot be distinctive of the Services within the meaning of section 2 of the Act, because they do not distinguish the Services from the Opponent’s goods and services, having regard to what is alleged in the statement of opposition. In the absence of further particulars, I interpret the pleading to be that the Marks are confusing with the Opponent’s Word Mark and the Opponent’s Design Mark in the manners alleged under the grounds of opposition based on registrability and entitlement.

[113] The material date for the grounds of opposition based on non-distinctiveness is the date the statements of opposition were filed, in this case June 20, 2016 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185]. To succeed under this ground, an opponent relying on its own trademark must establish that, as of the material date, its trademark had become sufficiently known in Canada 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]. The opponent must show that its trademark was known in Canada to some extent, having a “substantial, significant or sufficient” reputation, or else that it was well known in a specific area of Canada—in either case, there must be clear evidence of the extent to which the trademark was known [*Bojangles, supra*].

[114] If this initial burden is met, the Applicant will then have the legal onus of showing, on a balance of probabilities, that the Marks were adapted to distinguish or actually distinguished the Services from the goods and services of the Opponent.

[115] It is not necessary to address this ground of opposition in detail. The only evidence of the Opponent's trademarks being used or promoted so as to become known to some extent is with respect to the organisation and conduct of the Opponent's action sports festival. Although this evidence includes a webpage advertising a trip to Panama offered in collaboration with the festival, there is no indication of the extent to which this particular webpage was accessed from Canada; in the circumstances, I am not prepared to find that the Opponent's trademarks are known in association with travel arrangement. I would also note that the webpage displaying the advertisement appears to have been printed after the August 2016 festival took place and, as such, likely postdates the material date. The evidence also fails to show that the Opponent's clothing and other promotional goods were sold or distributed to any particular extent.

[116] Furthermore, even if I were to find that the Opponent has met its initial burden with evidence pertaining to the organization and conduct of an action sports festival—by showing that the trademarks on which it relies either had a substantial, significant, or sufficient reputation across Canada or were well known in the Montreal area—the Applicant would meet its legal onus, for the reasons discussed above under the entitlement grounds based on prior use. Despite the additional evidence of use and promotion at the later material date, the Opponent's case for confusion would be no stronger for any of the Services.

[117] In view of the foregoing, this ground of opposition is rejected.

#### **Satisfaction of entitlement to use the Marks under section 30(i)**

[118] The Opponent pleads that the Applications do not conform to the requirements of section 30(i) of the Act because the Applicant's statements that it is satisfied it is entitled to use the Marks in Canada are false, given its knowledge of the Opponent's rights and of the unlawfulness of any such use. More specifically, the Opponent pleads that the Applicant was aware that (i) the Marks are confusing with the Opponent's trademarks and trade names referenced in the statement of opposition; and (ii) use of the Marks would direct public attention to the Services in such a way as to cause or be likely to cause confusion with the goods, services or business of the Opponent, contrary to paragraph 7(b) of the Act.

[119] Awareness of an allegedly confusing trademark or trade name does not in itself preclude an applicant from being satisfied of its own entitlement to use the mark it is applying to register. Accordingly, where, as here, the required statement is included in the application, an opponent may only rely on section 30(i) in specific cases, such as where bad faith or fraud is alleged or where a *prima facie* case of non-compliance with a federal statute arguably prevents registration [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB); *Interactiv Design Pty Ltd v Grafton-Fraser In.* (1998), 87 CPR (3d) 537 (TMOB); and *Interprovincial Lottery Corp v Western Gaming Systems Inc* (2002), 25 CPR (4th) 572 (TMOB)].

[120] In the present case, there are no allegations in the nature of bad faith or fraud in the statement of opposition and there is no evidence in the record to that effect. As for the allegation combining sections 30(i) and 7(b) of the Act, the Registrar has previously considered such a ground to be valid under the general principle that registration of a mark cannot be condoned if its use would violate federal legislation [see *Bojangles' International LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553 (TMOB); and *Institut national des appellations d'origine v Pepperidge Farm Inc.* (1997), 84 CPR. (3d) 540 (TMOB)]. However, to successfully invoke section 7(b), an opponent must provide sufficient evidence to support the existence of the three elements of passing off: (i) the existence of goodwill; (ii) deception of the public due to a misrepresentation; and (iii) actual or potential damage [*Kirkbi AG v Ritvik Holdings Inc*, 2003 FCA 297, aff'd 2005 SCC 65; and *Ciba-Geigy Canada Ltd v Apotex Inc.*, [1992] 3 SCR 120]. In the present case, the Opponent did not provide any evidence of actual or potential damage.

[121] An inference of damage *may* be drawn if a loss of control over the use and commercial impact of a plaintiff's trademark is implicit in a defendant's confusing use [see *e.g. Boulangerie Vachon Inc v Racioppo*, 2021 FC 308]. However, in the present case, there is no basis to infer that the Applicant's use of either of the Marks would necessarily lead to a loss of control over the use and commercial impact of the Opponent's trademarks in a way that could weaken their reputation so as to result in a loss of goodwill. At the oral hearing, the Opponent emphasized the constant presence a hotel or restaurant chain would have compared to a seasonal festival and raised the possibility of a negative impression being created should the Applicant use one of the Marks in association with, for example, sports bars of poor quality. However, as there is no indication that the Applicant would actually use either of the Marks in such a manner, a finding

that the Opponent would lose control over the commercial impact of its trademarks on this basis would be speculative.

[122] Consequently, the section 30(i) grounds of opposition are dismissed as well, as the Opponent has failed to meet its evidential burden.

#### DISPOSITION

[123] In view of all the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse each of the Applications pursuant to section 38(12) of the Act in respect of the following services:

Accommodation reservation services; Arranging hotel accommodation; Booking of hotel accommodation; [...] Hotel accommodation reservation services; [...] Reservation of hotel accommodation; [...] Arranging hotel reservations; [...] Booking services for hotels; Hotel information; [...] Hotel reservation services; [...] Restaurant reservation services; [...] Reservation of places at holiday resorts; [...] Booking of restaurant places.

and I reject the opposition against each of the Applications pursuant to section 38(12) of the Act with respect to the remaining services:

Hospitality services (accommodation); [...] Hotel accommodation services; Inn keeping (bar, restaurant and accommodation); Provision of hotel accommodation; [...] Resort accommodation; Resort hotel services; [...] Hotel catering services; [...] Hotel services; [...] Bar services; Wine bar services; Coffee bar and coffee house services (provision of food and drink); Salad bar restaurant services; [...] Restaurant services; Restaurants; Theatre restaurants (Provision of food and drink); [...] Hotels [...].

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Oksana Osadchuk  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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

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**HEARING DATE** 2021-02-08

**APPEARANCES**

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No one appearing	For the Applicant

**AGENTS OF RECORD**

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