

LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 220**

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

**IN THE MATTER OF OPPOSITIONS**

**Tribu Expérientiel Inc.**

**Opponent**

**and**

**JKLP IP Pty Ltd**



**Applicant**

**1,723,797 for JACKALOPE Vertical Design**

**Applications**

**1,723,802 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 shirts and caps:

	
Vertical Mark (App. no. 1,723,797)	Horizontal Mark (App. no. 1,723,802)

[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, including T-shirts and caps.

[3] The Opponent also alleges that the applications do 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 1,723,797 and 1,723,802, respectively. They are based on proposed use of the Marks in Canada in association with the following goods (the Goods):

Baseball shirts; Casual shirts; Denim shirts; Dress shirts; Formal shirts; Open-necked shirts; Polo shirts; Printed t-shirts; Rugby shirts; Shirt fronts; Shirt jackets; Shirts; Short-sleeve shirts; Sports shirts; T-shirts; Tee-shirts; Woven shirts; Baseball caps; Bathing caps; Beach caps; Cap peaks; Caps (headwear); Flat caps; Shower caps; Slumber caps; Sports caps; Swimming caps.

[6] The Applications claim a priority filing date of March 27, 2015, based on Australian applications nos. 1684016 (in the case of the Vertical Mark) and 1684017 (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 goods.

[7] The Applications were advertised in the *Trademarks Journal* on February 17, 2016, and opposed on April 6, 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), 16(3)(b), and 16(3)(c) (entitlement to registration); and 2 (distinctiveness of the trademark). The Applicant's counter statements, filed on June 13, 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.

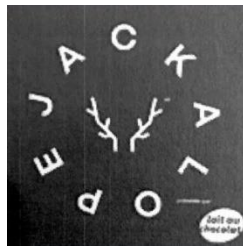
[10] In support of its oppositions, the Opponent filed the following evidence:

- 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: (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, 1,723,772, and 1,723,775. 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 not only 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, including t-shirts and caps [para 16; cross-examination pages 6-7, 16-18].

#### 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 Goods. 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 Goods, 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, tighrope 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 )	<p>(1) <i>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.</i></p> <p>(3) <i>Productions audiovisuelles, nommément, production de films, préparation de présentations audiovisuelles.</i></p>	<p>(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.</p>

[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 Design Mark, registered for use in association with goods that include "T-shirts" and "caps", represents the Opponent's strongest case and I will therefore focus my discussion on this registration.

### 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 strongly resemble the most striking and unique aspect of the Opponent's Design Mark, namely, the word JACKALOPE (which I note is in a similar albeit slightly thicker font) and the related idea of a creature that is part jackrabbit and part antelope. Indeed, the Marks are identical to this aspect of the Opponent's Design Mark when sounded. Although the Vertical Mark is in a stacked arrangement, the word JACKALOPE remains readily recognizable [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].

[31] Although the Opponent's Design Mark includes other elements, I find that they do little to reduce the likelihood of confusion. The jackalope silhouette reinforces the idea conveyed by the word JACKALOPE, the geometric shape in the background is not a particularly distinctive feature, and the details and fine print within this shape are too small to have much impact. I also note that the fine print is descriptive, reading "*FESTIVAL DE SPORTS D'ACTION*" (extreme or "action" sports festival).

[32] I also do not consider the AMNESIA logo under the jackalope design to be a particularly striking or distinctive feature of the Opponent's Design Mark. The AMNESIA logo consists of the statement "*présenté par AMENSIA www.amnesiashop.com*" (presented by AMNESIA *www.amnesiashop.com*) and a stylized letter A. Thus, it merely identifies a sponsor or organizer of the JACKALOPE festival. Moreover, I find that, by virtue of its size and position within the Opponent's Design Mark, the AMNESIA logo would be perceived as a secondary feature, in the nature of a house mark or double branding. As such, it would not significantly affect the impression created by the JACKALOPE word and design elements as the primary brand.

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

### Inherent and acquired distinctiveness

[34] 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.

[35] I consider the Vertical Mark to be slightly more inherently distinctive than the Horizontal 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. I consider the Opponent's Design Mark to be slightly more inherently distinctive than either of the Marks, in view of its additional design elements.

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

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

[37] 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, including on branded merchandise. 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. Moreover, the Opponent's Design Mark is occasionally displayed without the logo acknowledging the festival's sponsor. However, in applying the principles set out by the Federal Court of Appeal in *Canada (Registrar of Trade Marks) v Cie International pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), I find that the Opponent's Design Mark has not lost its identity and remains recognizable. The word JACKALOPE printed across a jackalope silhouette and the circular background element have been maintained. I am satisfied that the trademark's dominant features have thus been preserved

and that the variations therefore constitute acceptable deviations from the trademark as registered.

[38] I also note that, 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. In this case, the dominant features of the Opponent's Design Mark—the word JACKALOPE printed across a jackalope silhouette—have not been preserved and I therefore consider the Opponent's New Logo to be a separate trademark.

[39] The supporting materials furnished by Mr. Desforbes include the following:

- Annual attendance, revenue, and advertising figures for the festival from 2012 to 2016 [paras 7, 13-15, 18]. Mr. Desforbes 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]. The site includes images of branded merchandise.
- 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 and caps [Exhibit MD-5]. The depicted merchandise appears to be that offered for sale online in 2016, featuring the Opponent's New Logo [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. Some of the articles include images and, in a couple of these, the Opponent’s Design Mark is displayed on caps being worn; however, the design is difficult to make out from the photographs.
- 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 Design Mark (or Opponent’s New Logo as of 2016) appears in images of advertising, signage, apparel, giveaways, and merchandise. It is also printed on the 2014 recap’s various cover and section heading pages.
  - Photographs show branded apparel such as t-shirts, tank tops, and caps, which 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]. In addition, the 2015 recap refers to influencers receiving an upgrade kit with a JACKALOPE hat and to “key people in the industry” and “[t]op athletes” receiving branded t-shirts, tank tops, and caps [MD-2 at 140, 164].
  - Photographs in the 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 [MD-2 at 30, 111, 127-130, 136-137].
  - 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. With respect to branded promotional apparel in particular, the 2015 recap indicates that 100 t-shirts, 100 tank tops, 100 caps, 100 backpacks, and 9 medals were distributed to the “key people” and “top athletes”, resulting in a total of 10,000 impressions. 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.
- The 2013 festival was reported to include an after party at a bar [MD-7 at 323, 327] and “satellite events” mentioned in the 2015 recap include an after party in two bars [MD-2 at 121].

[40] 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].

[41] Based on Mr. Desforges' evidence, I conclude that the Opponent's Design Mark has become known to some extent in the Montreal area in association with action sports festival events and activities—and at least to a limited extent in association with related promotional goods such as t-shirts, tank tops, and caps—and is likely also known to some extent among action sports enthusiasts throughout Canada.

### **The Applicant's evidence**

[42] 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 and on merchandise available for purchase at the hotel [paras 35-36, Exhibits M-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 Jackalope Hotel's "debut property", including the 7-metre tall jackalope sculpture at the hotel entrance [Exhibit L].
- 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 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]. I note that highlighted features include its 30-metre infinity pool and bath products made exclusively for the hotel.

[43] Although Ms. Makiv confirms that customers in Canada can access the hotel website at *www.jackalopehotels.com* and book stays online, she provides essentially no information about the associated merchandise depicted at Exhibit N. In the absence of any evidence regarding the sale or promotion of such products in Canada, I cannot find that the Marks have become known in Canada to any extent in association with the Goods.

### **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.

### Length of use

[45] The evidence demonstrates continual use and promotion of the Opponent’s Design Mark as of 2012; however, there is no documentary evidence of sales of t-shirts or caps and the only relevant sales figure is merely a rough estimate of combined revenues from merchandise and bar



sales in 2016. That being said, the Application is based on proposed use. Overall, this factor very slightly favours the Opponent, but is not particularly significant.

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 there to be considerable overlap between the following Goods, being various shirts and caps in the nature of wearing apparel and sports apparel, and the goods "T-shirts" and "caps" in the Opponent's Design Mark registration:

Baseball shirts; Casual shirts; Denim shirts; Dress shirts; Formal shirts; Open-necked shirts; Polo shirts; Printed t-shirts; Rugby shirts; Shirt fronts; Shirt jackets; Shirts; Short-sleeve shirts; Sports shirts; T-shirts; Tee-shirts; Woven shirts; Baseball caps; Bathing caps; Beach caps; Cap peaks; Caps (headwear); Flat caps; Slumber caps; Sports caps; Swimming caps.

[48] Although the evidence shows the Opponent's "T-shirts" and "caps" to be casual T-shirts, and baseball caps, there are no such restrictions in the registration, which I also find broad enough to cover more specialized wearing and sporting apparel, such as slumber caps and bathing or swimming caps.

[49] However, I do not find that "shower caps", which I consider to be bath products, are contemplated by the Opponent's registration. The full statement of goods in the Opponent's registration reads "T-shirts, caps, backpacks, skateboards". I am of the view that, in this context, "caps" would likely be understood to refer to caps in the nature of wearing apparel and sporting goods. Conversely, "shower caps" are a bath product with a very specific function that would not be considered apparel or sports gear.

[50] With respect to the services covered by the Opponent's Design Mark registration, there is no evidence that sports festivals are known to sell branded shower caps or branded bath products in general, or that such sales would be considered anything more than promotional activity. Thus the evidence falls short of demonstrating a meaningful connection between the good "shower caps" and the service "organization and conduct of a sports festival" *per se*.

#### Nature of the trade

[51] 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)]. 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 [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*).

[52] 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. The evidence appears to be that both parties' goods are provided for purchase or as promotional goods in association with those two core services of interest. There is no indication that either party may in the future use its JACKALOPE brand in a different context.

[53] However, given the overlap in the nature of the goods and the absence of any limitations on the channels of trade in either the Application nor the Opponent's registration, I consider it reasonable to conclude that any promotional sales made outside the parties' own venues could be made through the same channels of trade. I also note that nothing would prevent either party from selling its promotional goods at outdoor festivals or hotel giftshops.

[54] I also 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 who are young or young-at-heart and looking for "original experiences". There has also accordingly been some overlap in advertising channels, with the Opponent's festival being promoted through travel-related publications and websites [Exhibits MD-2 at 165, 170, MD-3 at 227, MD-6]. However, this overlapping target customer base is a broad one.

[55] On balance, I do not find that the nature of the trade weighs heavily in favour of either party.

#### Conclusion on the likelihood of confusion

[56] 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.

[57] 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 Design Mark and a finding of no confusion, in respect of all of the Goods except "shower caps". I reach this conclusion based primarily on (i) the strong resemblance between the Opponent's Design Mark and each of the Marks and (ii) the considerable overlap in the nature of goods. In the circumstances, and bearing in mind the possibility of promotional sales of goods such as shirts and caps being made outside one's own venue, the fact that the parties' core operations occupy different and distinct channels of trade does not, in my view, eliminate the likelihood of confusion. As the onus is on the Applicant, I must find against the Applicant in respect of this category of Goods.

[58] Conversely, given the different nature of the good "shower caps", I find that, on a balance of probabilities, notwithstanding the inherent distinctiveness of the Opponent's Design Mark and its resemblance to each of the Marks, a consumer is not likely to believe that the Applicant's "shower caps" are from the same source or are otherwise related to the "caps" covered by the Opponent's Design Mark registration.

[59] Furthermore, I find that the Opponent’s case is no stronger if one considers its word mark registrations. For each of the Marks, the degree of resemblance is higher when the comparison is with the Opponent’s Word Mark, owing to the absence of design elements; moreover, any use and promotion of the Opponent’s Word Mark in the form of either the Opponent’s Design Mark or the Opponent’s New Logo could be considered. However, in my view, the different nature of the goods and services in the Opponent’s Word Mark registrations renders confusion unlikely. Even if certain types of caps might be sold in the course of performing or advertising some of the services covered by registration no. TMA1,090,656—for example, “organization of sporting events and activities” or “sports education through training camps”—this fact alone would fall short of demonstrating that the average consumer would consider any of the goods or services in the Opponent’s Word Mark registrations to be related to “shower caps” or would expect “shower caps” to come from the same source as such goods and services.

[60] In summary, I find that the Applicant only meets its legal onus in respect of “shower caps”. Accordingly, the ground of opposition based on registrability of the Marks under section 12(1)(d) of the Act succeeds with respect to all of the Goods except “shower caps” and is rejected with respect to “shower caps”.

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

[61] 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.

[62] 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.

[63] 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, March 27, 2015, in accordance with section 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 February 17, 2016, as stipulated in section 16(5) of the Act. 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

[64] As discussed above under the section 12(1)(d) ground of opposition, Mr. Desforges' 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 March 27, 2015. 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 February 17, 2016.

[65] 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 February 17, 2016.

[66] 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.

[67] 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.

[68] 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 March 27, 2015 [section 16(3)(a) of the Act].

Previously used trademarks: the likelihood of confusion

[69] 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.

[70] 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. Moreover, only limited distribution figures for promotional apparel are provided and they are for the 2015 festival, which is after the relevant date. There is thus insufficient evidence for a conclusion that the organization and conduct of the Opponent's festival was, at the material date, associated with goods in the nature of shirts or caps or that there was any overlap in the channels of trade.

[71] Accordingly, I find that the Applicant meets its legal onus under the section 16(3)(a) entitlement ground of opposition regardless of which of the Opponent's two trademarks is considered. In either case, upon consideration of all the surrounding circumstances, I am satisfied that, on a balance of probabilities, there is no reasonable likelihood of confusion. Consequently, the entitlement ground based on prior trademark use is rejected.

#### Previously used trade name

[72] 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."

[73] 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.jackalopefest.com>" [TRANSLATION]: **JACKALOPE** Presented by amnesiashop and webcast amplified by ROGERS! July 18, 19 and 20, 2014 at Olympic Park, Montreal, Canada! <http://www.jackalopefest.com>.

- In 2016: “**JACKALOPE** Presented by @lait.chocolat #skateboarding #basejump #bouldering #FMX August 19-21, 2016, Montreal, Olympic park #jackalopefest Buy your tickets now!”.

[74] 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.

[75] 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 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.

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

**Entitlement to registration over previously filed application under section 16(3)(b)**

[77] The Opponent also pleads that the Applicant is not the person entitled to registration of the Marks under section 16(3)(b) of the Act because, at all material times, each of the Marks was confusing with the Opponent’s previously filed trademark application no. 1,702,712 for the Opponent’s Design Mark (Opponent’s Application).

[78] To meet its initial burden under this ground, the Opponent must evidence that its trademark application was not only filed prior to the material date—in this case the Applications’ priority filing date of March 27, 2015—in accordance with sections 16(3) and 34(1) of the Act, but also still pending at the Applications’ advertisement date, February 17, 2016, as stipulated in section 16(4). Having exercised my discretion to check the Register in this respect, I confirm that the Opponent’s Application was filed prior to the material date and that, although it has now matured to registration, it was still pending on the date the Applications were advertised.

[79] The Opponent having met its initial burden, the onus is on the Applicant to satisfy the Registrar, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Marks and the Opponent’s Application at the material date.



[80] For the reasons discussed above under the registrability ground of opposition, having considered all the surrounding circumstances, I find that the Applicant has failed to demonstrate, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Opponent’s Design Mark and each of the Marks, in respect of all of the Goods except “shower caps”. Given the different nature of the good “shower caps”, I find that, on a balance of probabilities, confusion in respect of that Good is unlikely for either of the Marks.

[81] In summary, for each of the Marks, I find that the Applicant only meets its legal onus in respect of “shower caps”. Accordingly, the entitlement ground of opposition based on prior application succeeds with respect to all of the Goods except “shower caps” and is rejected with respect to “shower caps”.

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

[82] The Opponent also pleads that the Marks are not and cannot be distinctive of the Goods within the meaning of section 2 of the Act, because they do not distinguish the Goods 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.

[83] The material date for the grounds of opposition based on non-distinctiveness is the date the statements of opposition were filed, in this case April 6, 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*].

[84] 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 Goods from the goods and services of the Opponent.

[85] 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. The evidence fails to show that the Opponent's clothing and other promotional goods were sold or distributed to any particular extent.

[86] However, 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 in respect of all the Goods, 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 Goods. Accordingly, the distinctiveness ground of opposition is rejected.

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

[87] 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 Goods 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.

[88] 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)].

[89] 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.

[90] 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. By analogy, shirts or caps of poor quality are another hypothetical possibility. 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 of its trademarks on this basis would be speculative.

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

DISPOSITION

[92] 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 goods:

Baseball shirts; Casual shirts; Denim shirts; Dress shirts; Formal shirts; Open-necked shirts; Polo shirts; Printed t-shirts; Rugby shirts; Shirt fronts; Shirt jackets; Shirts; Short-sleeve shirts; Sports shirts; T-shirts; Tee-shirts; Woven shirts; Baseball caps; Bathing caps; Beach caps; Cap peaks; Caps (headwear); Flat caps; [...] Slumber caps; Sports caps; Swimming caps.

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

Shower caps.

---

Oksana Osadchuk  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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

---

**HEARING DATE** 2021-02-08

**APPEARANCES**

Barry Gamache	For the Opponent
No one appearing	For the Applicant

**AGENTS OF RECORD**

Robic	For the Opponent
Stikeman Elliott LLP	For the Applicant