

O P I C



C I P O

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 275

Date of Decision: 2021-12-10

IN THE MATTER OF AN OPPOSITION

Supreme Brands L.L.C.

Opponent

and

Joy Group Oy

Applicant

1,750,241 for TORSPO

Application

INTRODUCTION

[1] Supreme Brands L.L.C. (the Opponent) opposes registration of the trademark TORSPO (the Mark), which is the subject of application No. 1,750,241 by Joy Group Oy (the Applicant).

[2] The Mark is applied for on the basis of proposed use in Canada in association with the following goods:

Clothing, namely, shirts, collared shirts, t-shirts, knit shirts, open-necked shirts, polo shirts, short-sleeved shirts, sweat shirts, sport shirts, hats, jackets, hockey garter belts, hockey and inline clothing, namely, jerseys, shirts, pants, shorts and uniforms, padded hockey pants and breezers in the nature of hockey pants; inline skating, ice hockey and ice skating equipment, namely, protective upper torso pads and guards, protective shoulder pads, elbow pads, shin pads and guards, forearm pads, neck pads, hockey gloves, inline skating protective gloves, hockey goalie gloves, hockey goalie pads, ice skates, inline skates, hockey skates, figure skates, hockey sticks, goalie hockey sticks, replacement blades for hockey sticks, hockey stick shafts, hockey and inline pucks and balls, mouth guards, neck guards, forearm slashguards, chest and arm guards, protective athletic cups and supporters for shoulders and elbows, hockey and inline skating equipment bag; headwear, namely, hats, caps, headbands, head scarves; belts; hockey garter belts; padded hockey pants and breezers in the nature of hockey pants; hockey

bags, inline skating equipment bags, sports bags, hockey skates; figure skates; inline skates; skate blades; skate blade guards; straps for skates; knee, shoulder, neck, upper torso, chest, arm, forearm, elbow, shin, and wrist pads and guards for athletic use; hockey pads; hockey goalie pads; mouth guards; protective athletic cups and athletic supporters; hockey gloves, inline skating protective gloves, hockey goalie gloves; hockey sticks, goalie hockey sticks, replacement blades for hockey sticks, hockey stick shafts, hockey and inline pucks and balls; hockey helmets; hockey nets; hockey goals.

[3] The opposition is primarily based on an allegation that the Opponent is the rightful owner of the trademark TORSPO in relation to a variety of clothing and sporting goods, and appears to relate to a multi-jurisdictional dispute between the parties over ownership of the trademark.

THE RECORD

[4] The application for the Mark was filed on October 13, 2015. The application was advertised for opposition purposes on January 4, 2017. Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13 (the Act) came into force on June 17, 2019. Pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read immediately before June 17, 2019.

[5] On June 5, 2017, the Opponent opposed the application by filing a statement of opposition under section 38 of the Act. The grounds of opposition are based on non-compliance with section 30 of the Act, non-distinctiveness under section 2 of the Act, non-entitlement under section 16 of the Act, and non-registrability under section 12(1)(d) of the Act.

[6] The Applicant filed a counter statement denying the grounds of opposition.

[7] In support of its opposition, the Opponent submitted two affidavits of D. Jill Roberts (collectively, the Roberts Affidavits). The first affidavit was sworn January 23, 2018 in Ottawa (the First Roberts Affidavit). The second affidavit, submitted as leave evidence, was sworn January 16, 2020 in Ottawa (the Second Roberts Affidavit). Ms. Roberts was not cross-examined on either affidavit.

[8] The Applicant did not file evidence. Neither party filed written representations. An oral hearing was not held. As discussed further below, in the absence of representations, it was

somewhat difficult to discern the exact nature of the grounds of opposition. Accordingly, for each ground of opposition, I have reproduced the relevant portions of the parties' pleadings.

[9] However, before assessing the grounds of opposition, I will first provide an overview of the Opponent's evidence, the evidential burden on the Opponent, and the legal onus on the Applicant.

OVERVIEW OF THE OPPONENT'S EVIDENCE

First Roberts Affidavit

[10] Ms. Roberts is a Law Clerk [para 1]. The First Roberts Affidavit evidences the following:

- United States Patent and Trademark Office (USPTO) registration Nos. 5218059 and 3022926 for the trademark TORSPO, including assignment and ownership histories on the U.S. trademarks register [paras 2 to 4, Exhibits 1 to 3];
- Copies of the declarations of Jussi Salonoja, both declared February 1, 2017 in Helsinki, Finland (the Salonoja Declarations), submitted as evidence in response to section 45 notices issued by the Registrar against registration No. TMA656,049 for the trademark TORSPO and registration No. TMA707,775 for the trademark TORSPO and Design, respectively [paras 5 and 6, Exhibits 4 and 5].

[11] As noted by Ms. Roberts, the two U.S. registrations are registered in the name of Supreme Brands, LLC Limited Liability Company Florida. Based on the evidenced assignment histories, this company would appear to be either the Opponent or a successor-in-title of the Opponent.

Second Roberts Affidavit

[12] The Second Roberts Affidavit evidences the following:

- A copy of the Registrar's decision, *Supreme Brands LLC v Joy Group OY*, 2019 TMOB 45 (the Section 45 Decision), related to the aforementioned Salonoja Declarations and the

expungement of registration No. TMA656,049 for the trademark TORSPO and registration No. TMA707,775 for the trademark TORSPO and Design [para 2 and Exhibit 1]; and

- A copy of the register pages from the Canadian trademarks database for registration Nos. TMA656,049 and TMA707,775, showing that both registrations were expunged and inactivated on September 18, 2019 [paras 3 and 4, Exhibits 2 and 3].

[13] In the referenced expungement proceedings, I note that the Applicant was the Registered Owner and that the Opponent was the Requesting Party.

EVIDENTIAL BURDEN AND LEGAL ONUS

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

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

SECTION 30 GROUND OF OPPOSITION – NON-COMPLIANCE

[16] Based on section 38(2)(a) of the Act, the Opponent pleads as follows:

... the application does not comply with the requirements of section 30 of the Act in that the Applicant could not have been satisfied that it was entitled to use or register its trademark. The Applicant knew or should have known that the Opponent owns the trademark TORSPO, as the Opponent obtained rights to the trade-mark by way of a security interest prior to the Applicant misappropriating it for themselves. Accordingly, the Applicant could not have been satisfied that it was entitled to use or register the trade-mark

TORSPO in Canada. The Applicant knew of the Opponent's security interest prior to the filing of this application and knew of the Opponent's prior rights in advance of the filing of this application.

[17] In its counter statement, the Applicant pleads as follows:

... the application conforms to the requirements of Section 30(i) of the *Trademarks Act* as the application contains a statement that the Applicant is satisfied that it is entitled to use the trademark in Canada in association with the goods described in the application. The Applicant was so satisfied at the time of filing and all other relevant times, and remains so satisfied.

[18] As noted above, neither party submitted representations. The only evidence before me is the file histories of two USPTO registrations for the trademark TORSPO owned by the Opponent (or a successor-in-title); the Salonoja Declarations and the subsequent Section 45 Decision issued in 2019; and the register pages for the Applicant's now-expunged TORSPO trademarks in Canada.

[19] However, the Roberts Affidavits do not speak substantively to the relevance of the exhibits to the present proceeding. The exhibits are left to speak for themselves and it is otherwise left to the Registrar to piece together any issues based on such exhibits.

[20] As Ms. Roberts makes no statements regarding the relevance of those exhibits, much less regarding the Opponent itself or any use of the Opponent's TORSPO trademark in Canada, the Roberts Affidavits are of little value. To the extent that one is meant to make inferences from the exhibits regarding the Opponent's use or ownership of the TORSPO trademark in Canada, they shed little light and, furthermore, the exhibits largely constitute hearsay.

[21] Evidence dealing with matters of use and ownership of the TORSPO trademark would appear to be central to the determination of the pleaded grounds in this proceeding. Accordingly, such evidence should have been introduced by a knowledgeable and competent individual, *e.g.*, from the Opponent or a licensee, and not by a law clerk who, presumably, is an employee of the Opponent's agent. Generally speaking, an affidavit of an employee of an agent's firm is admissible only to the extent that the evidence relates to non-controversial and non-central matters [*Cross Canada Auto Body Supply (Windsor) Limited v Hyundai Auto Canada*, 2005 FC 1254, *aff'd* 2006 FCA 133].

[22] In any event, section 30(i) of the Act merely required that an applicant include a statement in its application that it is satisfied that it is entitled to use its trademark in Canada in association with the goods or services described in the application.

[23] Where this statement has been provided, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of an applicant [*Sapodilla Co Ltd v Bristol-Myers Co*, 1974 CarswellNat 476]. Knowledge of the existence of an opponent's trademark does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use its trademark [*Woot Inc v WootRestaurants Inc*, 2012 TMOB 197].

[24] The "security interest" referenced in the Opponent's pleading appears to reference proceedings in the U.S. in relation to the two USPTO registrations. However, their relevance to this proceeding relating to the application for the Mark *in Canada* is at best unclear.

[25] In this case, the Applicant provided the requisite statement and, while the parties clearly have a contentious history, I am not satisfied that the Opponent has met its initial burden under this ground.

[26] As the Opponent has failed to meet its initial burden, the ground of opposition based on section 30 of the Act is rejected.

SECTION 2 GROUND OF OPPOSITION – NON-DISTINCTIVENESS

[27] Based on section 38(2)(d) of the Act, the Opponent pleads as follows:

[The Mark] is not distinctive in view of the facts alleged in this Statement of Opposition and also since it is not adapted to distinguish the wares in association with which it is proposed to be used by the Applicant from the wares/services of others including the wares/services of the Opponent and the Applicant's trade-mark is not adapted to distinguish them. The Opponent owns the trade-mark TORSPO in Canada and in other countries and [the] Opponent also owns the registered mark TORSPO in the United States. Any consumer seeing the Applicant's proposed mark would think that it is a trade-mark of the Opponent.

[28] In its counter statement, with respect to this ground, the Applicant pleads as follows:

[The Mark] is distinctive within the meaning of Section 2 of the *Trademarks Act* since it actually distinguishes the goods and services in association with which it is used by its owner from the goods or services of others or is adapted so to distinguish them. In particular, [the Mark] is distinctive since it actually distinguishes the goods in association with which it is used by its owner from the goods/services of the Opponent, or is adapted so to distinguish them as the Opponent is not the registered owner of the TORSPO trademark in Canada and has not used the TORSPO trademark in Canada.

[29] The material date for this ground is the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

[30] Section 2 of the Act, as it then was, defined “distinctive” as follows:

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

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

[32] As noted above, there is an evidential burden on the Opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd, supra*]. In this case, there is no evidence with respect to the goods and services of “others”. Otherwise, the initial burden is on the Opponent to prove that, as of the material date, its trademark was known to some extent in Canada in association with the relevant goods and had a reputation in Canada that was “substantial, significant or sufficient” so as to negate the distinctiveness of the Mark [see *Bojangles’ International LLC v Bojangles Café Ltd*, 2006 FC 657 at paras 33 and 34; and *Canadian Dental Association v Ontario Dental Assistants Association*, 2013 FC 266 at para 42, *aff’d* 2013 FCA 279]. In *Auld Phillips Ltd v Suzanne’s Inc*, 2005 FCA 429, in the context of an expungement proceeding under section 57 of the Act, the Federal Court of Appeal stated that “Obviously, it will be a rare occurrence when one party is in a position to cause a mark to lose its distinctiveness, but nothing in principle prevents this result” [at para 7].

[33] In this case, there is no evidence of use or reputation of the Opponent’s TORSPO trademark in Canada or otherwise. Furthermore, the Roberts Affidavits do not evidence

substantial, significant or sufficient reputation in the Opponent's TORSPO trademark so as to negate any distinctiveness of the Mark.

[34] As the Opponent has failed to meet its initial burden, the section 2 ground of opposition is rejected.

SECTION 16 GROUND OF OPPOSITION – NON-ENTITLEMENT

[35] Based on section 38(2)(c) of the Act, the Opponent pleads as follows:

... the Applicant is not the person entitled to registration of [the Mark] in view of the provisions of Section 16 [of the Act] in view of the facts contained in this Statement of Opposition. The Opponent is the owner of the trade-mark TORSPO as it is the rightful owner of Registration Nos. TMA656,049 and TMA707,775. Accordingly, the Applicant is not entitled to registration as its proposed trade-mark is confusing with the Opponent's trade-mark TORPSO which was subject of prior applications.

[36] In its counter statement, the Applicant pleads as follows:

The Applicant is the person entitled to registration of [the Mark]. In particular, the Applicant is the person entitled to registration under Section 16 of the *Trademarks Act* as at the date of filing October 13, 2015 [the Mark] was not confusing with a trademark that had been previously used in Canada or made known in Canada by any other person including the Opponent, [the Mark] was not confusing with a trademark in respect of which an application for registration had been previously filed in Canada by any other person including the Opponent, and as [the Mark] was not confusing with a trade name that had been previously used in Canada by any other person including the Opponent.

[37] As suggested by the Applicant's broadly worded pleading in response, it is somewhat difficult to discern the exact nature of the Opponent's pleading pursuant to section 16 of the Act. Rather, this ground appears to be premised on the unsupported assertion by the Opponent that it owns the TORSPO trademark in Canada.

[38] In any event, the two Canadian registrations relied upon by the Opponent were in the name of the Applicant at the time of their expungement in 2019, pursuant to the aforementioned Section 45 Decision. Furthermore, the applications for those trademarks were not pending as of the filing date of the Mark.

[39] With respect to the Opponent's pleading "in view of the facts alleged in this Statement of Opposition", I note that the Opponent references its own application No. 1,789,002 for the trademark TORSPO based on proposed use in Canada in association with a variety of clothing and sporting goods [Statement of Opposition at para 2]. However, the Opponent's application was filed on June 28, 2016, after the filing date for the Mark in the present proceeding.

[40] As such, even with a generous read of the statement of opposition, this later application would also fail to support any ground based on section 16 of the Act.

[41] In view of the foregoing, the section 16 ground of opposition is rejected.

SECTION 12(1)(D) GROUND OF OPPOSITION – NON-REGISTRABILITY

[42] Based on sections 38(2)(b) and 12(1)(d) of the Act, the Opponent pleads as follows:

... the Opponent is the rightful owner of Registration Nos. TMA656,049 and TMA707,775 and [the Mark] is confusing with these registrations.

[43] In its counter statement, the Applicant pleads as follows:

[The Mark] is registrable. In particular, [the Mark] is registrable under Section 12(1)(d) of the *Trademarks Act* as it is not confusing with a registered trademark. The Opponent is not the current owner of record of TMA656,049 and TMA707,775 and thus this pleaded ground of opposition cannot be considered.

[44] Again, this ground appears to be premised on the Opponent's unsupported assertion that it owns the TORSPO trademark in Canada.

[45] In any event, the material date with respect to confusion with a registered trademark is the date of this decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd et al*, 37 CPR (3d) 413 (FCA)]. As the relied-upon registrations were expunged in 2019, for that reason alone, the Opponent fails to meet its initial burden under this ground.

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

DISPOSITION

[47] In view of all of the foregoing, pursuant to section 38(12) of the Act and the authority delegated to me under section 63(3) of the Act, I reject the opposition.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: No hearing held

AGENTS OF RECORD

Moffat & Co.

For the Opponent

Kirby Eades Gale Baker

For the Applicant