



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 027

Date of Decision: 2023-02-16

IN THE MATTER OF AN OPPOSITION

Opponent: Nitro AG

Applicant: Nitro Circus IP Holdings LP, Limited Partnership Delaware

Application: 1,724,719 for NITRO CIRCUS

INTRODUCTION

[1] Nitro AG (the Opponent) opposes registration of the trademark NITRO CIRCUS (the Mark), which is the subject of application No. 1,724,719 (the Application), standing in the name of Nitro Circus IP Holdings LP, Limited Partnership Delaware (previously named Nitro Circus IP Holdings LP) (the Applicant). The Application relies on the dual bases of proposed use of the Mark in Canada in association with a wide range of goods from Nice class (CI) 5 to CI 32 and services from CI 35 and CI 41, and use of the Mark in Canada since at least as early as May 2014 in association with other services from CI 41. The full particulars of the goods and services covered by the Application are set out in Schedule A attached hereto.

[2] The main issue in this proceeding is whether there would be a likelihood of confusion between the Mark in association with the applied-for goods and services and

the Opponent's trademark NITRO, which is registered under Canadian trademark registration No. TMA397323 in association with "sporting goods and equipment, namely snowboards" and which has allegedly been previously used in Canada by the Opponent in association with the aforementioned registered goods, as well as [TRANSLATION] "snowboard accessories, apparel and bags" (sometimes hereinafter collectively referred to as the Opponent's non-registered goods).

[3] For the reasons that follow, the opposition succeeds in part.

THE RECORD

[4] The Application was filed on April 14, 2015 and claims the priority of a corresponding application filed on March 29, 2015 in the United States of America. The Application was advertised for opposition purposes in the *Trademarks Journal* on December 30, 2020.

[5] On January 25, 2021, the Opponent opposed the Application by filing a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). Leave was subsequently granted to the Opponent to file an amended statement of opposition dated June 22, 2021. The grounds of opposition raised by the Opponent are based upon section 2 (non-distinctiveness of the Mark); section 12(1)(d) (non-registrability of the Mark); sections 16(1)(a) and (1)(c) (non-entitlement of the Applicant); and section 38(2)(e) (non-compliance of the Application) of the Act.

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

[7] In support of its opposition, the Opponent filed an affidavit of its Managing Director ("*directeur-gérant*"), Johannes Späth, sworn June 10, 2021 (the Späth affidavit). In support of its Application, the Applicant filed an affidavit of Andrew James Edwards, President, Asia Pacific of Thrill One Sports & Entertainment (Thrill One Sports), sworn October 22, 2021 (the Edwards affidavit) and an affidavit of Jane Buckingham, a trademark searcher employed by the agent for the Applicant, sworn October 19, 2021 (the Buckingham affidavit). None of the affiants were cross-examined.

[8] Both parties filed written representations. An oral hearing was not requested.

ANALYSIS

Evidential burden and legal onus

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

Non-compliance of the Application with section 38(2)(e) of the Act

[10] I note that the Opponent conceded in its written representations that there is no evidence of record with which the Opponent could meet its initial evidential burden for the section 38(2)(e) ground of opposition. This ground is therefore rejected.

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

[11] The Opponent has pleaded that the Mark is not registrable because it is confusing with the Opponent's aforementioned registered trademark NITRO.

[12] I have exercised the Registrar's discretion to confirm that this registration is in good standing as of today's date, which is the material date for assessing a section 12(1)(d) ground of opposition [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[13] Hence, the Opponent has met its evidential burden in respect of this ground of opposition. The Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's registered trademark NITRO.

The test for confusion

[14] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[15] Thus, section 6(2) of the Act does not concern the confusion of the trademarks themselves, but of the goods or services from one source as being from another. In the present case, the question is essentially whether a consumer, with an imperfect recollection of the Opponent's trademark NITRO, who sees the Applicant's applied-for goods and services in association with the Mark, would think that they are sold or otherwise emanate from or are licensed, approved or sponsored by the Opponent.

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

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

become known

[17] The trademarks at issue are both inherently distinctive albeit somewhat suggestive in the context of their associated goods or services.

[18] In its written representations, the Applicant submits that the Opponent's trademark NITRO is somewhat suggestive of the Opponent's extreme sports related goods as it would be understood as a noun connoting nitroglycerine, an explosive liquid, and would likely be understood as connoting that the Opponent's snowboards are suitable for high speed and explosive movement. I agree. In this regard, I note that the word NITRO is defined in the *Oxford Canadian Dictionary*, second edition, as the informal word for nitroglycerin. However, the same comment applies to the Mark, especially with respect to its applied-for goods and services that relate to the performance of extreme sports and stunts, as the fanciful combination of the words NITRO and CIRCUS would likely be understood as connoting that the Applicant's performances, films, videos, and shows offer thrills and excitement reminiscent of a circus performance featuring explosive movements and stunts. I will return to this point when assessing the degree of resemblance between the parties' trademarks in the ideas suggested by them. I will also comment later on the state of the register evidence filed by the Applicant showing the presence of other registered trademarks having as a component the word NITRO.

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

[20] This brings me to review the evidence on this point filed through the Späth and Edwards affidavits, in light of some of the representations made by the parties in their written representations.

The Opponent's evidence filed through the Späth affidavit

[21] I summarize below those portions of the Späth affidavit that I consider to be the most pertinent regarding the extent of use and promotion of the Opponent's trademark NITRO.

[22] Mr. Späth essentially attests to the following:

- he has been the Managing Director of the Opponent since 2013 and has been employed by the Opponent since 2001, where he held the position of Director of International Sales from 2001 to 2013 [para 1];
- the Opponent is a Swiss company that was created in 1990 and specializes in the design, manufacture, distribution and sale of snowboards and snowboarding equipment and accessories, including clothing, under the trademark NITRO [para 4];
- the Opponent's range of products sold under the trademark NITRO mainly consists of snowboards, snowboard boots, snowboard bindings, bags and clothing [para 5];
- the Opponent's NITRO-brand products are generally offered for sale and sold anywhere in the world where sliding sports are practiced and have been sold in Canada for 30 years [paras 6 and 7];
- since 2016, the Opponent's NITRO-brand products have been exclusively distributed in Canada by Nitro Snowboards Canada Inc. ("Nitro Canada"), a company based in Edmonton, Alberta [para 8];
- as of March 24, 2021, approximately 100 retailers were selling the Opponent's NITRO-brand products throughout Canada [para 11];
- the Opponent's NITRO-brand products are sold by retailers of general sport gear (such as *Sports aux puces* ([TRANSLATION]: Flea Sports)), or stores that specialise in sliding sports (skiing and snowboarding, such as Oberson), or board sports (skateboards and snowboards, such as Empire stores) [para 12];
- in terms of sales, Mr. Späth provides a table showing what he describes as the Opponent's annual sales figures to its distributors in Canada since 2011, which total in excess of 8 million dollars. These sales figures are not broken down per product, except Mr. Späth states that approximately 50% of the sales relate to snowboards while the other 50% relate to other NITRO-brand products and that [TRANSLATION]: "the sales figures for each of these years include apparel" ("*les chiffres de vente ci-dessus, pour chaque année, incluent des vêtements*").

Mr. Späth further asserts that the Opponent's distributors sold these products at a profit to NITRO retailers who in turn sold the products at a profit to consumers. Mr. Späth therefore estimates that the actual consumer sales figures in Canada for NITRO-brand products are between 2.5 to 3 times higher than the figures shown in the aforementioned table [paras 13 to 16];

- in terms of advertising and marketing, Mr. Späth provides a table showing what he describes as the Opponent's North American annual budget (for Canada and the United States of America) for the years 2007 to 2020, which total in excess of 5 million Swiss francs. Commenting on the fact that these numbers are falling, Mr. Späth asserts that this is misleading since the Opponent's Canadian and U.S. distributors have, over the years, increasingly assumed promotional expenses for NITRO brand products sold in North America so that promotional activities have not been significantly reduced. He further explains that he simply does not have access to the numbers from Nitro Canada and its U.S. counterpart to complete the above-mentioned table [paras 19 and 20];
- the Opponent's investments in marketing and advertising take the form of targeted advertising (such as mass emails), trade magazine ads, and event and athlete sponsorships, and have generated significant exposure for the NITRO brand [paras 21 to 29]; and
- the Opponent has also collaborated with Red Bull to produce short films showing the snowboarding lives and achievements of members of the NITRO team. These short films, *28 Winters* (50 minutes) and *Boom* (38 minutes), were filmed partly in Canada and are available on Red Bull's website at www.redbull.com/us-en/films/28-winters and www.redbull.com/us-en/films/boom [para 30].

[23] In support of his assertions of use and promotion of the trademark NITRO, Mr. Späth attaches the following exhibits to his affidavit:

- Exhibit JS-1: printouts dated March 24, 2021 from the Opponent's website at <https://nitrosnowboards.com>, which Mr. Späth states represent the entire range (*gamme complète*) of the Opponent's products sold under the trademark NITRO. In its written representations, the Applicant points out that the majority of these

printouts appear to be snowboards, snowboard boots, and snowboard bindings. However, they also do include bags and a few clothing items;

- Exhibit JS-2: the list of worldwide distributors of the Opponent's products sold under the trademark NITRO;
- Exhibit JS-3: printouts dated March 24, 2021 from Nitro Canada's website at <https://nitrosnow.ca> displaying NITRO-brand snowboards, snowboard boots, snowboard bindings, bags and a few clothing items. Mr. Späth stresses that while the trademark NITRO does not necessarily appear prominently on the top of some of the snowboards shown in this exhibit, it always appears predominantly on the underside (the one on which you slide, but also the one that is most visible when the snowboarder is in the ski lift), as can be seen in the illustrative example below [para 9]:

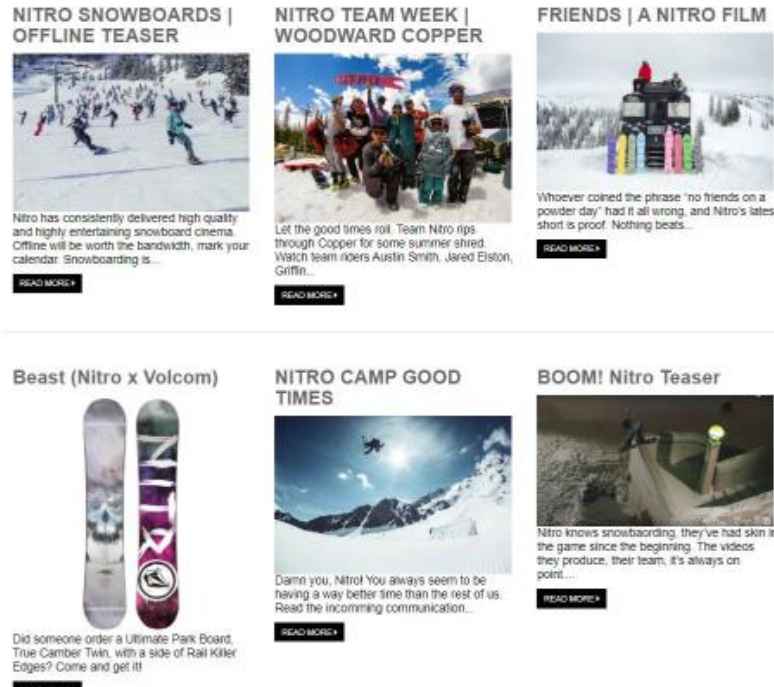


- Exhibit JS-4: the list of retailers who sell NITRO-brand products in Canada;
- Exhibit JS-8: printout of what Mr. Späth describes as an invoicing journal (in German) relating to sales of NITRO-brand products in Canada since 2011 [para 17]. While Mr. Späth asserts that this invoicing journal indicates: the distributor/client, the name of the product, the number of items sold, the unitary price of each product and the total sales in both Canadian dollars and Swiss francs, he does not, as noted by counsel for the Applicant in its written representations, correlate any of the Opponent's sales to specific items (e.g., snowboards, snowboard accessories, apparel and bags);
- Exhibit JS-9: a "typical invoice sent by the Opponent to its distributor Nitro Canada" ([TRANSLATION]: *une facture representative envoyée par [l'Opposante] à son distributeur Nitro Canada*). In its written representations, the Applicant points

out that the exhibited invoice, which is dated December 1, 2019, is actually from Nitro Canada to Comor – Go play outside, in Vancouver, BC. I note that this entity is apparently not included in the list of retailers who sell NITRO-brand products in Canada (Exhibit JS-4). In any event, I find this is of no consequence as the exhibited invoice is of no assistance to the Opponent in this case, if only because it is not possible to ascertain the nature of the products sold based on the descriptions of goods on the invoice;

- Exhibits JS-10 and JS-11: copy of press articles published by GlobalNews.ca and ici.radio-canada.ca on February 23 and December 19, 2018 respectively, referring to, among other things, the Olympic medals won by Sébastien Toutan (snowboarding big air gold medal at the 2018 Winter Olympics in PyeongChang) and Laurie Blouin (slopestyle silver medal at the same Olympic games), which include photographs of each of them in action on his/her snowboard that prominently displays the trademark NITRO on its underside. Mr. Späth asserts that the Opponent sponsors 22 high level Canadian athletes, who compete in international circuits. He further provides a table listing the names of a few of these athletes along with their ranking at some of these international competitions held between the years 2003 and 2020 [paras 22 to 24, and 29];
- Exhibit JS-12: an example of a mass email dated December 5, 2019 introducing new models of the Opponent's snowboards and snowboard bindings. Mr. Späth asserts that since September 2018, the Opponent, in collaboration with Nitro Canada, has been sending mass emails to interested people in Canada and presenting its new products as well as articles of interest to snowboard enthusiasts. Between 6 and 7 mass emails are sent per year and the distribution list for Canada consists of approximately 2000 recipients consisting of approximately 500 retailers and 1500 individuals [para 25];
- Exhibits JS-13 and JS-14: printouts dated February 25, 2020 from the online versions of *King Snow* and *Snowboard Canada* magazines containing references to the Opponent's products. Mr. Späth asserts that magazines specializing in sliding sports in general or snowboarding in particular (both those distributed worldwide and in Canada) regularly publish articles evaluating the Opponent's

products. Upon review of these printouts, I note that the full articles are not provided, but only a short introduction to the articles, as per the examples reproduced below [para 27];



- Exhibit JS-15: copy of an article published in the *Snowboard Canada* magazine about the pop-up store "Nitro Snowboard Co." that was operated by Nitro Canada in Manulife Place, in downtown Edmonton in September 2018. The article includes a photograph of the shop where we can see some of the Applicant's products offered for sale (e.g. bags, clothing items, snowboards, and snowboard boots) [paras 10 and 28].

[24] In its written representations, the Applicant contends that in most of the Opponent's alleged evidence of use of its trademark NITRO, the evidence generally shows use of the following design versions of the mark:



[25] The Applicant contends that, particularly as a matter of first impression, these design marks are likely to be perceived as “NMRO” rather than “NITRO”, and thus such evidence provides limited benefit to the Opponent in terms of the acquired distinctiveness of its mark in Canada.

[26] The Applicant’s contentions do not convince me, if only because the Späth affidavit also provides ample evidence of use and promotion of the word mark NITRO *per se*, as well as of other stylized forms of it—especially on the underside of the snowboards. I shall further add in this regard that despite the Applicant’s position, I am satisfied that the use of all of the exhibited stylized forms of the trademark NITRO is valid for the use of the NITRO word mark, which in my view preserves its identity and overall remains recognizable in the context of its use [according to *Registrar of Trade Marks v Compagnie Internationale pour l’informatique CII Honeywell Bull*, 1985 CanLII 5537, 4 CPR (3d) 523 (FCA); and *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)].

[27] Based on the foregoing evidence, and despite the absence of comprehensive invoices, I accept that the Opponent has shown quite extensive use of its trademark NITRO in Canada in association with its registered goods “sporting goods and equipment, namely snowboards” dating at least as far back as 2018. Based on a fair reading of the Späth affidavit as a whole, I have no reason to doubt that the Opponent’s trademark NITRO would have also been used and displayed on the Opponent’s snowboards sold in Canada between the years 2011 and 2018. However, to the extent that the Opponent’s non-registered goods may contribute to the extent known of the registered goods and because the Opponent’s non-registered goods will be relevant under the sections 2 and 16 grounds of opposition, I shall add that I am not prepared to conclude that the trademark NITRO has become known to any significant extent with respect to some or all of the Opponent’s non-registered goods, as the annual sales figures with respect to the Opponent’s non-registered goods are not broken down per category of products (except that Mr. Späth expressly states that the sales figures for each of these years include apparel), nor does the Späth affidavit provide any information as to the penetration of the Opponent’s advertising efforts, which seem to

have focused mainly on its snowboards (and incidentally its snowboard bindings). Suffice it to say that the Späth affidavit provides no website traffic information with data for Canada and that no circulation figures have been provided.

The Applicant's evidence filed through the Edwards affidavit

[28] I summarize below those portions of the Edwards affidavit that I consider to be the most pertinent regarding the extent of use and promotion of the Mark.

[29] As summarized for the most part by the Applicant at paragraphs 18 to 26 of its written representations, Mr. Edwards essentially attests to the following:

- at the time of swearing his affidavit, Mr. Edwards was the President, Asia Pacific of Thrill One Sports, of which the Applicant is one of its group companies, and was previously the President and CEO of the Applicant [para 1];
- the Applicant “is an 'action sport collective' led by world famous professional motor sports competitor and stunt performer Travis Pastrana”. The Applicant “features performances, films, videos, and shows of Mr. Pastrana and his friends traveling around the world engaging in competitions, performances and stunts in the fields of motocross, supercross, racing, skydiving, cliff jumping, cliff diving, snowboarding, BMX, skateboarding, skiing, surfing, wakeboarding, and BASE jumping, among other extreme sports and stunts” [para 5];
- the Applicant's business and use of the Mark has evolved from a small business producing DVDs in a garage in Utah, USA, in 2003 to a live action sports entertainment show that has toured across five continents [paras 5 to 10];
- in connection with its business, the Applicant and its licensees offer “an extensive range” of NITRO CIRCUS merchandise sold at the tour venues and stadiums (including shirts, t-shirts, jerseys, sweatshirts, jackets, jumpers, tank tops, hats, beanies, hoodies, socks, gloves, underwear, toys, posters and books). NITRO CIRCUS merchandise is also sold in Canada through “a variety of retail channels”, including “bricks and mortar” stores, and online (e.g. through the Nitro Circus online store (*shop.nitrocircus.com*) (Nitro Circus Online Store), Amazon.ca and Walmart.ca) [paras 11, 36 and 37];

- the Mark has been used and heavily promoted in connection with a number of films, documentaries, and live presentations, which have been recognized in a number of third party media publications. Through such extensive use and advertisement, NITRO CIRCUS has earned the title of the world's most successful action or extreme sports touring brand [paras 12 to 26 and 28];
- the Mark was first used in Canada in 2009 in connection with the NITRO CIRCUS television show distributed by MTV. The follow up TV series NITRO CIRCUS LIVE aired for 4 seasons on MTV2 from about March 27, 2012 to November 19, 2014 [para 8];
- the Applicant has licensed the use of the Mark to third party licensees in connection with the sale of goods in Canada, including books, helmets and protective equipment, scooters, ramps and rails, toys, and BMX bikes and skateboards. All such products feature the use of the Mark on the goods themselves, on the packages in which they are distributed and in connection with marketing and advertising materials for such goods [para 31];
- currently, NITRO CIRCUS branded goods, including branded clothing, accessories, DVDs and media content, skateboards, ramps and related equipment are sold via online stores, including the Nitro Circus Online Store; Amazon.ca; The Vault Pro Scooters; and Broadway Pro Scooters [para 63];
- the first NITRO CIRCUS tour of Canada was in 2014 and the Applicant has toured Canada consistently on many occasions since that date, with thousands of fans having attended NITRO CIRCUS shows [paras 30 and 64, including a table listing the dates, locations, venues, and attendance at the Opponent's shows]. The Applicant has a long-term agreement with Ticketmaster Canada for the provision of ticketing services in connection with the Applicant's Canadian tours and events [para 32];
- the NITRO CIRCUS live tour shows, including the Canadian tours referred to above, "all prominently feature various ramps and jumps for skateboards, scooters, bikes, motorcycles, skates, indeed anything that can be put on wheels" [para 38];

- the Applicant generated in excess of CAD\$13,000,000 in sales revenues in Canada with respect to its live touring events and merchandise sales at touring events from June 2015 to June 2019 [para 58, which includes a breakdown of these sales revenues per fiscal year only];
- the Applicant's revenue for sales of goods to retail customers and sales through other channels are not included in these totals. Following the launch of the Nitro Circus Online Store in approximately 2016, the Applicant has generated in excess of U.S.D \$120,000 in sales via the Nitro Circus Online Store into Canada between 2017 and 2021. These figures include sales in Canada of goods in association with the Mark, including jerseys, shirts, toys, sweatshirts, accessories, gear, and hats [para 58]. However, no breakdown per year and per product is provided;
- the Applicant also engages Canadian media distributor, Juice International Holdings, in connection with the sale of its downloadable films, including Action Figures and Action Figures 2, via major digital download and streaming platforms internationally such as Amazon Prime, Google Play and iTunes. The Applicant earned more than \$117,000 in pass-through revenues from Juice International Holdings, for sales of its downloadable films Action Figures and Action Figures 2, through these platforms from 2017 to 2020 [para 33]. However, no breakdown for Canada is provided;
- the Mark is featured in various marketing and advertising materials used to promote the goods and services provided by the Applicant and the Applicant and the Mark have been regularly promoted by third party media outlets, including in Canada [para 59];
- for the period from 2018 until October 19, 2021, there have been over 5.9 million visits worldwide, including approximately 250,000 visits from patrons verifiably based in Canada using location-enabled devices (i.e. excluding Canadian patrons whose geographic data is not available), to the Applicant's websites *nitrocircus.com*, *shop.nitrocircus.com* and *www.nitroworldgames.com* [para 50, which further includes a breakdown per year of the number of visits to each of these three websites];

- the Applicant has also promoted its goods and services in association with the Mark in social media platforms. As of October 19, 2021:
 - the NITRO CIRCUS Facebook page had 12.32 M followers of which approximately 465,000 are from Canada [para 52];
 - the NITRO CIRCUS Twitter page had 258,112 followers [para 53];
 - the NITRO CIRCUS Instagram page had 3.29 million followers, of which in excess of 98,000 are from Canada [para 54];
 - the official NITRO CIRCUS YouTube page had 1.52 million subscribers (of which in excess of 23,000 are from Canada) and 345,558,396 views (of which in excess of 17M are from Canada).

[30] In support of his assertions of use and promotion of the Mark, Mr. Edwards attaches the following exhibits to his affidavit:

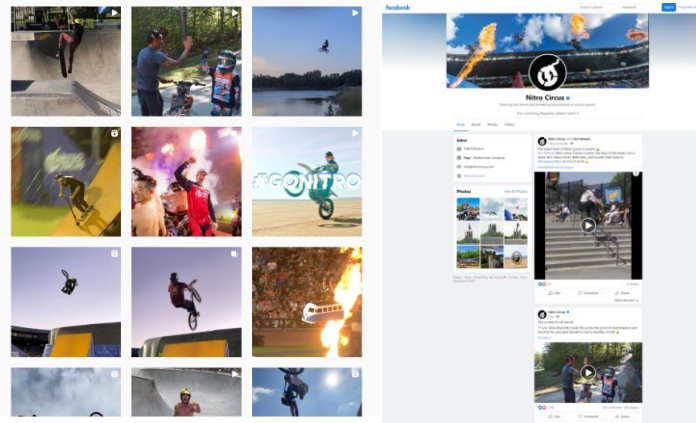
- Exhibit A: copy of an article published in Media in Canada on March 9, 2009 which refers to the launch of the new TV series, NITRO CIRCUS;
- Exhibit A-1: copies of undated printouts from Amazon.ca and Walmart.ca, showing NITRO CIRCUS merchandise (including, T-shirts, jumpers, hats, socks, gloves and toys) available for sale through those platforms;
- Exhibit B: copy of an article published on December 13, 2012 in The Toronto Star, according to which *Nitro Circus: the Movie* was number 9 on iTunes Top Downloads. Mr. Edwards asserts that the movie was released in Canada and the U.S. on or about August 8, 2012. He further asserts that the DVD was released in Canada on or about December 4, 2012 and was added to Netflix in Canada on or about June 29, 2019 [para 12];
- Exhibit C: screenshots of the Season 4, episode 3 of the NITRO CIRCUS TV series, featuring Women's Canadian Motocross National Champion Jolene Van Vugt performing for her home audience in Ontario;
- Exhibit D: copy of an online extract of the Forbes Magazine that listed the Applicant at number 22 on Forbes Magazine list of America's most promising companies in 2015;

- Exhibits E to H-5 and K: screenshots of films, documentaries, and live presentations featuring the Mark, including screenshots taken from the content platform Netflix, and copies of articles in Direct Motorcross (November 3, 2015), Global News (October 5, 2020) and Forbes (November 2, 2020) respectively, relating to same. Notably, Mr. Edwards asserts that:
 - the extended version of the documentary *Never Say Can't: The Bruce Cook Story*, which details the story of Nitro Circus Canadian FMX athlete Bruce Cook, who tragically lost the use of his legs in 2014 while attempting a World's First double front flip on a motorcycle, has attracted in excess of 40,000 views via YouTube and in excess of 625,000 views via Facebook by Canadian viewers since October 3, 2020;
 - the live presentation *Evel Live*, a three-hour live event featuring the Mark and showing the Applicant's founding star Travis Pastrana paying tribute to Evel Knievel, was broadcast internationally from Las Vegas. It premiered in the U.S. and Canada on Sunday, July 8, 2018 on the HISTORY channel, and attracted a total of 3.5 million viewers and was the #1 cable special of the year. However, no breakdown for Canada is provided;
 - the live presentation *Evel Live 2*, also a three-hour live event showing record breaking motorcycle stunts, was broadcast internationally by the HISTORY channel. It premiered in the U.S. and Canada on Sunday, July 8, 2019, and attracted a total of 1.2 million viewers. However, no breakdown for Canada is provided;
 - the films *Nitro Circus: The Movie* and *Nitro Circus: Action Figures 2* show athletes and stunt performers engaged in on and off road car and truck racing, motocross, supercross, racing, skydiving, cliff jumping, cliff diving, snowboarding, BMX, skateboarding, skiing, surfing, wakeboarding, and other sports. However, no information as to the number of Canadian viewers is provided;

- Exhibits J to J-4: representative photographs of shirts, T-shirts, tank tops, hooded sweatshirts, sweatshirts, jackets, beanies, caps and hats bearing the Mark;
- Exhibit J-5: undated printouts taken from the Nitro Circus Online Store showing examples of shirts, T-shirts, hooded sweatshirts, sweatshirts, jackets, beanies, caps, hats and tank tops bearing the Mark and available for sale through this website;
- Exhibit L: undated screenshot of examples of NITRO CIRCUS helmets sold in Canada through Amazon.ca;
- Exhibit M: undated screenshots of examples of NITRO CIRCUS merchandise (e.g. hats, beanies, face masks, jerseys, hoodies, sweatshirts, socks, underwear, gloves, scooters, bikes, books, mugs, free downloads (desktop wallpaper and mobile wallpaper), posters, stickers and patches, toys and collectibles, trailer hitch covers) offered for sale in Canada through the Nitro Circus Online Store;
- Exhibit N: undated screenshot of NITRO CIRCUS skateboards sold in Canada at Walmart and promoted through the Nitro Circus Online Store;
- Exhibit O: undated screenshots of front covers of a NITRO CIRCUS book series currently available in Canada online through Simon & Schuster, Amazon Canada and the Nitro Circus Online Store;
- Exhibit O-1: undated screenshot taken from the Applicant's website (*nitrocircus.com/kids*), showing an interactive computer game made available to visitors, including Canadian visitors, to the Applicant's website, and showing prominent use of the Mark;
- Exhibit P: undated screenshots of NITRO CIRCUS bikes and replica toy bikes sold in Canada at Walmart;
- Exhibit Q: undated screenshot of NITRO CIRCUS pogo sticks sold in Australia, which Mr. Edwards asserts is the first market in which these goods have been sold, with such goods intended to also be sold in other markets internationally;
- Exhibit R: undated screenshots of NITRO CIRCUS ramps sold in Australia for use with scooters, skateboards, skates, BMX and remote controlled cars, which Mr. Edwards asserts are also available for sale in Canada via Amazon.ca, The

Vault Pro Scooters and Broadway Pro Scooters. Exhibit R also contains an undated screenshot from Amazon.ca;

- Exhibit S: undated screenshots of NITRO CIRCUS rails sold in Canada for use with scooters, skateboards, skates and BMX which are available for sale via Amazon.ca, eBay.ca and The Vault Pro Scooters;
- Exhibit T: four sales invoices dated between November 7, 2018 and February 10, 2019 relating to NITRO CIRCUS branded merchandise (namely a few clothing items, such as hats, beanies, hoodies, shirts, T-shirts and socks; and a mug), purchased on the Nitro Circus Online Store by Canadian residents;
- Exhibits U to X and Z: screenshots of the Applicant's Facebook page, Twitter page, Instagram page, ABOUT page of the Applicant's NITRO CIRCUS YouTube page, and NITRO CIRCUS Vimeo page, respectively, generally displaying images of various stunts on wheels, as illustrated in the examples below:



- Exhibit AA: screenshot of the “ultimate holiday gift guide” published online in 2019 by the monthly magazine “Toronto Life”, featuring the Nitro Circus “Legends, Stories and Epic Stunts” Gift Book;
- Exhibit AB: screenshot of the Toronto magazine publication NOW Magazine, promoting the 2015 NITRO CIRCUS show that took place at Air Canada Centre on October 14, 2015, including the promotion of a VIP ticket price package;

- Exhibit AC: screenshot of the online travel website, To Do Canada, advertising the 2018 NITRO CIRCUS show that took place at Rogers Place in Edmonton on October 7, 2018;
- Exhibit AD: screenshot of the page advertising the release of the Ethica x Nitro Circus Collection of underwear available online at *www.ethica.com*, beginning June 28, 2017, which collection Mr. Edwards asserts continues to be available for sale in Canada and the U.S.;
- Exhibit AD-1: representative photographs that were taken during events held in Canada, showing prominent use of the Mark;
- Exhibit AE: screenshots of posts published by Rogers Place via Twitter in relation to the merchandise sales kiosks at the NITRO CIRCUS Edmonton show in 2018;
- Exhibit AF: copies of media stories promoting NITRO CIRCUS tours in Canada between the Spring 2016 and the Fall 2018; and
- Exhibits AG and AH: copies of media stories, media press releases and media articles about the NITRO CIRCUS tours that were planned in Canada in 2020 and 2021 prior to the Covid-19 pandemic.

[31] I note that in most of the Applicant's evidence of use of the Mark, the evidence generally shows use of the following design version of the Mark:



[32] As for the Opponent's trademark, I find that all use of this variant of the Mark amounts to use of the Mark as the words NITRO CIRCUS clearly stand out from the design element made of a stylized design of a bomb [see, by analogy, the decisions *Lion Global Investors Ltd v Lion Capital LLP*, 2012 TMOB 252 at para 17 and *Alpina Salami Inc v Alpina Productos Alimenticios SA*, 2011 TMOB 57 at para 16 for the principle that use of a word mark can be supported by the use of a composite design mark featuring the word mark and other elements].

[33] Based on the foregoing evidence, I accept that the Applicant has shown quite extensive use of the Mark in Canada since at least 2014 in association with the production of films, documentaries and live events, including the Nitro Circus Live tour performances and shows. As set out in the Opponent's own written representations:

[TRANSLATION]: 24. [...] *the core of the Applicant's business is to organize extreme sports shows that can be viewed live in stadiums or later in television series and films produced by the Applicant available in various formats [...] and that the Applicant then offers various merchandising products in the context of or in connection with these services [...].*

24. [...] *le cœur de l'entreprise de la Requérante est d'organiser des spectacles de sports extrêmes que l'on peut visionner en direct dans des stades ou plus tard dans des téléseries et films produits par la Requérante disponibles dans divers formats [...] et que la Requérante offre ensuite divers produits dérivés dans le contexte de ou en lien avec ces services [...].*

[34] I am also prepared to accept that the Applicant has shown use of the Mark in Canada in association with quite a broad range of NITRO CIRCUS branded merchandise (be it clothing items and mugs—for which evidence of purchase through the Nitro Circus Online Store has been provided [Exhibit T]—or books, DVDs, posters, toys, bike helmets, bikes, scooters, skateboards, ramps and rails—for which I find it reasonable to infer, based on a fair reading of the Edwards affidavit as a whole and accompanying website printouts and photographs, that sales actually did occur at the time of swearing the Edwards affidavit). However, the extent of these sales and to which the Mark has become known in association with these particular goods remain very much unclear. Indeed, as is the case with the Opponent's evidence, I am of the view that the Applicant's evidence suffers from a number of evidentiary deficiencies. For example, in terms of sales, it is not possible to ascertain what percentage of the Applicant's aggregated sales revenue of CAD\$13,000,000 is attributable to its live touring events and what revenue relates to the merchandise sales at these events. Likewise, while Mr. Edwards sates that the Applicant's revenue for sales of goods to retail customers and sales through other channels are not included in these totals, and that the Applicant has generated in excess of USD\$120,000 in sales via the Nitro Circus Online Store into Canada between 2017 and 2021, no breakdown per product is

provided, nor is there any indication as to the value and dates of the sales made through such “other channels”.

Conclusion–Overall consideration of the section 6(5)(a) factor

[35] As per my comments made above, I am of the view that the evidence of each of the parties summarized above has its share of deficiencies.

[36] In the end, notwithstanding these deficiencies, I am prepared to conclude that the Opponent’s trademark in association with snowboards has become known at least to some extent in Canada. While I also accept that the Mark has become known in Canada to a significant extent in association mainly with the production of films, documentaries and live touring events, especially those featuring “anything that can be put on wheels”, I am not prepared to conclude that the Mark has necessarily and incidentally become known to any significant extent in association with some or all of the above-described NITRO CIRCUS branded merchandise. Indeed, I find the evidence is much too vague to draw any reasonable inference in that regard in favour of the Applicant. On balance, therefore, I find that both trademarks would have acquired some distinctiveness and as such, this factor, which is a combination of inherent and acquired distinctiveness, does not significantly favour one party over the other, especially insofar as part of the Applicant’s services from CI 41 are concerned.

The length of time the trademarks have been in use

[37] In view of my findings made above, this factor favours the Opponent, especially insofar as the Applicant’s applied-for goods and services (1) and (3) are concerned.

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

[38] When considering the nature of the goods, services or business and the nature of the trade, I must compare the Applicant’s statement of goods with the statement of goods and services in the registration relied upon by the Opponent [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CanLII 8953, 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining

the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. Evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd*, 1996 CanLII 3963, 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[39] Except as otherwise indicated below, I agree with the Applicant that many of the Applicant's applied-for goods and services bear no relation to snowboarding and the Opponent's registered goods, including, simply by way of example, adhesive bandages, children safety seats, clocks, highlighter pens, dried meats, breakfast cereal, and soft drink mixes.

[40] There is a remote overlap between the Applicant's applied-for goods described as "in-line skates", "water skis", "beach balls", "soccer balls", "hockey pucks" and "flying disks" and the Opponent's snowboards in that they are all sporting and physical exercise equipment. There is a more pronounced overlap between the Applicant's applied-for goods described as "wakeboards" and "surfboards" and the Opponent's snowboards, as they are all for board sports and may be produced by the same source and target the same public, as illustrated by Exhibit JS-23 attached to the Späth affidavit, which consists of printouts from the website of Lib Tech (identified by Mr. Späth as one of the Opponent's competitors) displaying Lib Tech's products lines, comprising snowboards, skateboards, surfboards and wakesurf boards. (See also, by analogy, Exhibit JS-21, which consists of printouts from the website of Arbor (identified by Mr. Späth as another competitor of the Opponent), describing Arbor's products lines as comprising skateboards, snowboards, clothing, footwear & bags.) Likewise, there is some relationship between the Applicant's applied-for goods described as "athletic protection pads" and the Opponent's snowboards in that they may be considered complementary (protecting the human body from sports injury), as illustrated by Exhibit JS-24 attached to the Späth affidavit, which consists of printouts from the website of Rossignol (identified by Mr. Späth as another competitor of the Opponent), listing among Rossignol's snowboarding accessories various types of protection gear

for snowboarding and skiing. In the same vein, and in addition to Exhibits JS-21, JS-23 and JS-24, the Späth affidavit includes further exhibits in support of Mr. Späth's assertions that it is common for the Opponent's competitors that sell snowboards to also sell apparel under the same brand [see Exhibits JS-22 and JS-25, which consist of printouts from the websites of Burton and Salomon, respectively].

[41] However, the fact that most of the Applicant's applied-for goods from CI 9 and services from CI 41 are related, directly or indirectly, to the performance of "action sports" broadly speaking, is not sufficient to render these goods and services overlapping with the Opponent's snowboards or complementary. They have different intended purposes—the Opponent's snowboards are intended for engaging in physical exercise, while the Applicant's goods and services from CI 9 and 41 are intended to entertain. I shall add in this regard that the mere fact that the Opponent has collaborated with Red Bull to produce short films showing the snowboarding lives and achievements of members of the NITRO team is insufficient to alter this finding.

[42] With respect to the channels of trade, and in addition to Exhibits JS-21 to JS-25 discussed above, the Späth affidavit includes printouts taken from the websites of five retailers in Canada (namely Sports Experts—Atmosphère, Oberson, Décathlon, La Cordée, and Ski Town) in support of Mr. Späth's statements at paragraphs 31 and 32 of his affidavit to the effect that "clothing, namely, bandanas, gloves, scarves, socks, underwear, pajamas, wristbands, shorts, costumes, shoes for men, women and children, in-line skates, wakeboards, toy scooters, toy weapons, water toys, surfboards, water skis, beach balls, soccer balls, hockey pucks, flying disks" [TRANSLATION] "are all commonly sold in sports stores and the sports department of large retail stores". As noted by the Applicant in its written representations, none of these printouts contain, among other goods, any wakeboards, toy weapons, water toys, surfboards, water skis, or beach balls. However, as there is no restriction in either the Application or the Opponent's registration, it is possible the goods could travel through the same channels of trade and even at the same stores, even though the extent of overlap is not clear. In this regard, I note that Mr. Edwards states at paragraph 63 of his affidavit that "it is envisaged that [the Applicant's NITRO CIRCUS goods, including branded clothing,

accessories, DVDs and media content, skateboards, ramps and related equipment] will also be made available for sale in Canada in mass retail stores, specialty stores and independent stores”.

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

[43] When considering the degree of resemblance between trademarks, they must be considered in their totality; it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trademarks [*Veuve Clicquot, supra*, at para 20].

[44] In *Masterpiece, supra* at paragraph 64, the Court further advised that, while in some cases, the first word or syllable of a trademark will be the more important for the purpose of distinction, the preferable approach to considering resemblance “is to first consider whether there is an aspect of the trademark that is particularly striking or unique”.

[45] Applying these principles to the present case, I find that the parties’ trademarks are about as alike as they are different.

[46] With respect to the Mark, I do not find either of the words NITRO or CIRCUS to be more striking or dominant. While the Mark incorporates the whole of the Opponent’s trademark NITRO appearing in the first position of the Mark, the presence of the word CIRCUS in the Mark creates, when the Mark is considered as a whole as a matter of first impression, some visual and phonetic differences (i.e. a phrase or conceptual unit made up of two words vs the single word NITRO), and also somewhat alters the ideas suggested between the parties’ marks. Indeed, in the context of the Applicant’s applied-for goods and services, especially those relating to action sports, the word CIRCUS introduces the idea of a lively and chaotic activity or show. Still, the Mark as a whole also connotes, like the Opponent’s trademark, that the Applicant’s applied-for goods, especially those relating to action sports, are suitable for explosive movements by reason of the word NITRO. In this regard, the Applicant submits that while the word NITRO would be viewed by consumers as a noun in the context of the Opponent’s

goods, the word NITRO in the context of the entire Mark would be viewed as an adjective modifying the word CIRCUS, and thus takes on a somewhat different connotation and less importance in the perception of the Mark as a whole. However, I do not find that these types of grammatical considerations would occur as a matter of first impression.

[47] Before turning to the additional surrounding circumstances, I note that the Applicant submits in its written representations that there is little resemblance between the parties' marks, "particularly between the Applicant's [Mark] and the design version of the Opponent's NITRO trademark depicted in evidence [...]". However, one must not lose sight of the full scope of rights conferred by the Opponent's registration of the NITRO word mark. Indeed, in accordance with the principle set out in paragraph 55 of the *Masterpiece* case, *supra*, the registration of the NITRO word mark allows the Opponent to use it "in any size and with any style of lettering, color or design," it being understood, however, that "one should be careful not to give the principle set out at paragraph 55 of *Masterpiece* too great a scope for there would no longer be any need to register a design mark when one has a word mark. [...]When comparing the marks, one is always limited to a 'use that is within the scope of a registration' (*Masterpiece*, at para 59)" [*Pizzaiolo Restaurants inc v Les Restaurants La Pizzaiolle inc*, 2016 FCA 265 (CanLII), para 33].

Additional surrounding circumstances

State of the register evidence

[48] State of the register evidence favours an applicant when it can be shown that the presence of a common element in marks would cause consumers to pay more attention to the other features of the marks, and to distinguish between them by those other features [*McDowell v Laverana GmbH & Co KG*, 2017 FC 327 at para 42]. Inferences regarding the state of the marketplace may be drawn from such evidence in two situations: where a large number of relevant registrations are located; and/or where there is evidence of common use in the marketplace of relevant third party marks [*Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA); *McDowell v Laverana GmbH & Co KG*, *supra*, at paras 41-46; and *Cie Gervais Danone*

v Astro Dairy Products Ltd (1999), 87 CPR (3d) 262 (FC)]. Relevant trademarks include those that (i) are registered or are allowed and based on use; (ii) are for similar goods and services as the marks at issue; and (iii) include the component at issue in a material way [*Sobeys West Inc v Schwan’s IP, LLC*, 2015 TMOB 197].

[49] In the present case, the Applicant relies on the results of the trademark searches of the Canadian Trademarks Database conducted by Ms. Buckingham on October 13, 2021 attached as Exhibit A to her affidavit. More particularly, the Applicant points out that Ms. Buckingham located about 50 trademarks containing the word NITRO in association with different goods and services, including goods in classes 5, 9, 12, 14, 16, 18, 21, 24, 25, 28, 29, 30, 32, and services in classes 35 and 41, all of which are registered, and include the following third party trademarks:

Trademark	Reg. No./ Reg. Date	Owner	Goods/Services
NITRO GAMES	TMA1101437 2021-06-04	Nitro Games Oyj	Goods, including: “Video game machines for use with televisions, action skill games, board games, action figure toys, accessories for action figure toys, electronic action toys, plush toys, plastic toys, toy robots, hand-held units for playing electronic games, playing cards, all of the foregoing excluding use in connection with game software that features automobile racing”
NITRO	TMA800203 2011-06-17	Lloyd IP Limited	“Motorcycle helmets; motorcycle boots; [various types of protective wear for motorcyclists, such as] protective body equipment, namely, eye shields, face shields, elbow and knee pads, body pads for motorcyclists; Motorcycle clothing, footwear and headwear; motorcycle riding suits; motorcycle jackets; motorcycle trousers; motorcycle waterproof clothing”
NITRO	TMA501991 1998-10-07	NitroGolf, LLC	“Golf balls; Golf equipment, namely golf clubs and parts and accessories therefor, bags, tees, golf

			accessories, shag bags, ball markers, divot repair tools, golf clothing, namely golf gloves and hats”
NERF NITRO	TMA1050431 2019-08-21	Hasbro, Inc.	“Toy projectile shooters that launch foam cars, toy foam darts and foam toy balls; toy vehicles; toy playsets for use with toy vehicles and toy projectile shooters that launch foam cars, toy foam darts and foam toy balls”
NITRO GRINDER; and NITRO GRINDERS & Design	TMA958353 2016-12-19; and TMA958376 2016-12-19	BOTI Europe B.V.	Goods including: “Toys, games and playthings namely game figurines, modeled fabric figurines, modeled plastic toy figurines, soft toys and soft puppets, plush toys, cuddly toys, board games, jigsaw puzzles, toy scale models, toy vehicles; toy playing sets; toy action figurines; card games namely trading cards; gameboards for trading card games”
TOMMY NITRO	TMA681541 2007-02-12	Spin Master Ltd	“Instructional videos, DVDs, and tapes for children's activities and sports activities; instructional mats, sports apparatus and related clothing, namely, inflatable heavy bags, rebreakable boards and karate outfits and karate belts”
NYTRO TECH NUTRITION & Design	TMA584581 2003-07-07	Northern Innovations Holding Corp	Goods including: <i>“Poids; Haltères; Bancs d'exercices; Machine d'entraînement pour le conditionnement physique et culturisme soit des barres à disques, poids d'exercice, appareils à contre-poids; Machine d'entraînement pour le conditionnement cardio-vasculaire; Pantalons de sport; Short de sport; T-shirt; Sweatshirt; Veste de sport”</i>
MERKUR NITRO GAME; and MERKUR	TMA1064146 2019-11-25; and TMA1064151 2019-11-25	adp Gauselmann GmbH	Goods including various types of “Gaming machines”; “Games for amusement arcades”; “Gaming tables, in particular for table football, billiards, sliding games; Quoits (playthings) and darts”; “LCD games consoles”.

NITRO JACKPOT			
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[50] I note that registration No. TMA681541 was expunged for failure to renew on September 1, 2022. That said, I am prepared to accept that the existence of the remaining registrations may amount to a surrounding circumstance in the Applicant's favour. However, I am reluctant to give it significant weight or to consider it to be determinative in this case. Indeed, I am unable to infer that consumers would necessarily pay more attention to the word CIRCUS in the Applicant's Mark in order to distinguish it from the Opponent's trademark because of the relatively low number of relevant registrations found and the absence of evidence of common use in the marketplace of any of these third party trademarks.

Other registrations owned by the Applicant in Canada and foreign jurisdictions and additional application owned by the Opponent in Canada

[51] In paragraphs 71 to 73 of his affidavit, Mr. Edwards states that the Applicant is the owner of numerous trademark registrations throughout the world (more than 60 countries) incorporating the words NITRO CIRCUS and that the Applicant's NITRO CIRCUS trademarks coexist with registrations for the trademark NITRO owned by the Opponent in many countries, including Australia, Canada, the United States of America, the United Kingdom and in Europe.

[52] However, the fact that the parties' marks may coexist on foreign trademarks registers is not binding upon the Registrar. Suffice it say that registrations in other jurisdictions have their basis in foreign law and procedure [*Sun-Maid Growers of California v Williams & Humbert Ltd* (1981), 54 CPR (2d) 41 (FCTD)].

[53] With respect to the Applicant's existing Canadian registration Nos. TMA877589 and TMA889571 for its NITRO CIRCUS word mark and design mark respectively, I first note that they were amended by the Registrar on October 6, 2022 in the context of section 45 proceedings [per the decision *BCF s.e.n.c.r.l./BCF LLP v Nitro Circus IP Holdings LP, Limited Partnership Delaware*, 2022 TMOB 196]. More particularly, the statements of goods and services covered by these registrations now read as follows:

TMA877589

(1) Downloadable films provided via DVD's featuring action sports and events for on and off road car and truck racing, motorcross, supercross, racing, skydiving, cliff jumping, cliff diving, snowboarding, bmx, skiing, surfing, wakeboarding, and other sports.

(2) Clothing, namely, t-shirts, hooded sweatshirts, caps and hats.

(1) Entertainment services, in the nature of organizing, performing and competing in action sporting events, namely, motorcross and bmx competitions and events; film distribution and editing; motion picture film production.

TMA889571

(1) Downloadable films provided via DVD's featuring action sports and events for on and off road car and truck racing, motocross, supercross, racing, skydiving, cliff jumping, cliff diving, snowboarding, bmx, skateboarding, skiing, surfing, wakeboarding, and other sports.

(2) Clothing, namely, t-shirts, hooded sweatshirts, caps and hats.

(1) Entertainment services, in the nature of organizing, performing and competing in action sporting events, namely, motorcross and bmx competitions and events; film distribution and editing; motion picture film production.

[54] Second, while many of the Applicant's applied-for goods and services are related in some way to the Applicant's registered goods and services and could be viewed as an extension of same, I am reluctant to afford significant weight to the existence of these two registrations as it is well established that section 19 of the Act does not give the owner of a registration an automatic right to obtain any further registrations no matter how closely they may be related to the original registration [see *Groupe Lavo Inc v Procter & Gamble Inc* (1990), 32 CPR (3d) 533 at 538 (TMOB); *Coronet-Werke Heinrich Schlerf GmbH v Produits Menagers Coronet Inc* (1985), 4 CPR (3d) 108 at 115 (TMOB)] and since the evidence of the extent of use of the Mark in association with the above registered goods is inconclusive as further discussed below in my review of the additional surrounding circumstance relating to the absence of instances of actual confusion.

[55] Finally, the fact that Mr. Späth states in paragraphs 36 and 37 of his affidavit that the Opponent owns a pending Canadian application for the trademark NITRO based on proposed use in association with [TRANSLATION]: “backpacks; sport bags; sports shoe bags; leather and leather imitations; travel cases and suitcases; saddlery; snowboard bags; skateboard bags” (bearing application No. 1,794,248) and that such application is the subject of an objection by the examination section of the Trademarks Office, based on the likelihood of confusion with the subject Application, is of no assistance to the Opponent in the present case. Suffice it to say that a decision by the examination section is not binding on this Board and does not have a precedential value for this Board if only because the examination section does not have before it evidence that is filed by the parties in an opposition proceeding.

Absence of instances of actual confusion

[56] The Applicant submits in its written representations that there is no evidence of actual confusion that has been adduced by the Opponent in this case, and that Mr. Edwards states at paragraph 74 of his affidavit that he is unaware of any instances of actual confusion caused by use of the Mark and the Opponent’s trademark NITRO in Canada or any other country.

[57] An adverse inference concerning the likelihood of confusion may be drawn when evidence of concurrent use of the parties’ trademarks is extensive and no evidence of confusion has been given by an opponent [*Christian Dior SA v Dion Neckwear Ltd*, 2002 FCA 29 (CanLII), 2002, 20 CPR (4th) 155 at para 19]. In view of the imprecisions noted above in my review of the Späth and Edwards affidavits, I am not convinced that there is evidence of extensive concurrent use in this case insofar as the Opponent’s non-registered goods and the Applicant’ applied-for goods and services (1) and (3) are concerned. Accordingly, I am not prepared to accord significant weight to this surrounding circumstance, especially insofar as the Applicant’s applied-for goods are concerned.

Conclusion on the section 12(1)(d) ground of opposition

[58] As indicated above, the Applicant bears the legal onus of establishing, on a balance of probabilities, that there is not a reasonable likelihood of confusion as to the source of the parties' goods or services. The presence of an onus on the Applicant means that if, after all the evidence is in, a determinate conclusion cannot be reached, the issue must be decided against the Applicant [see *John Labatt, supra*].

[59] Having considered all of the surrounding circumstances, I arrive at the conclusion that the probability of confusion is evenly balanced between a finding of confusion and of no confusion insofar as the Applicant's applied-for goods described as:

"wakeboards", "surfboards", "athletic protection pads" and all of the clothing items from CI 25 are concerned. Indeed, while I acknowledge that the Opponent's registration is for snowboards only, the Opponent's evidence shows that it is common for the Opponent's competitors that sell snowboards to also sell apparel (and sometimes footwear) under the same brand. As such, I find that the Applicant's applied-for goods from CI 25 may be perceived as complementary to the Opponent's snowboards or as a natural extension of the Opponent's established snowboard brand—as a matter of fact, the Opponent's evidence shows that its range of NITRO-branded products has been extended to encompass the Opponent's non-registered goods, including apparel, although the extent of use of the Opponent's trademark with respect to these goods remains unclear. In this regard, it is worth reminding that there is no restriction on the clothing covered by the Application (such as to be sold only in conjunction with the Applicant's live events or through the Nitro Circus Online Store) and that confusion may occur "whether or not the goods or services are of the same general class" [per section 6(2) of the Act]. In the same vein, as the Applicant's applied-for "athletic protection pads" are not restricted to a particular sport, they could be complementary to the Opponent's snowboards. Lastly, there is a potential overlap between the Opponent's snowboards and the Applicant's applied-for "wakeboards" and "surfboards" as illustrated by Lib Tech's website printouts (Exhibit JS-23). In view of the foregoing, and given the potential for overlap in the parties' channels of trade, I am not satisfied that the Applicant has sufficiently distinguished its Mark from the Opponent's

established snowboard brand NITRO. While I acknowledge that for those consumers familiar with the Mark in association with the Applicant's core business, the Applicant's particular applied-for goods described as "athletic protection pads", "wakeboards", "surfboards" and clothing items from CI 25 could be viewed as an extension of the Applicant's core business, I am not satisfied that the evidence of record establishes that the Mark has become known to the relevant consumers to such a significant extent so as to tip the balance of probabilities in favour of the Applicant, particularly as confusion is considered as a matter of first impression. Had the Applicant's evidence conclusively demonstrated the coexistence of the parties' trademarks, especially with respect to these particular applied-for goods of the Applicant, I might have reached a different conclusion.

[60] As the Applicant has failed to demonstrate, on a balance of probabilities, that an average consumer seeing the Mark in association with the Applicant's applied-for goods described as "athletic protection pads", "wakeboards", "surfboards" and all of the applied-for clothing items from CI 25 and having only a vague recollection of the Opponent's trademark would not, as a matter of first impression, infer that these particular goods are sold or otherwise emanate from or are licensed, approved or sponsored by the owner of the NITRO registration, the section 12(1)(d) ground of opposition is successful with respect to these goods. It is otherwise rejected with respect to the remaining applied-for goods and all of the applied-for services due mainly to the greater differences existing between these goods and services and the Opponent's goods.

Non-entitlement of the Applicant under section 16 of the Act

[61] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark because the Mark is confusing with:

- the Opponent's trademark NITRO which has been used in Canada in association with the Opponent's snowboards, snowboard accessories, apparel and bags prior to both the Application filing date and the date of first use of the Mark [section 16(1)(a) of the Act]; and

- the Opponent's trade name Nitro AG (or French version thereof Nitro SA), which has also been previously used in Canada by the Opponent [section 16(1)(c) of the Act].

[62] In order to meet its initial burden(s) under sections 16(1)(a) and (c) of the Act, the Opponent must show that as of the date of filing of the Application (in this case, the priority filing date of March 29, 2015) or the date of first use of the Mark with respect to the Applicant's applied-for services (2), its trademark and trade name had been previously used in Canada and had not been abandoned as of the date of advertisement of the Application [section 16(3) of the Act]. In this regard, and as noted by the Registrar in *Olive Me Inc, et al v 1887150 Ontario Inc*, 2020 TMOB 26, section 16 of the Act does not require that an opponent prove a certain level of use or reputation. If the opponent demonstrates that its use meets the requirements of section 4 of the Act, that such use occurred prior to the filing date, and that its trademark (or trade name) was not abandoned at the date of advertisement of the applicant's application, the opponent will have met its burden of demonstrating prior use for the purposes of an opposition under section 16 of the Act, even if that proof is limited to a single sale or single event, to the extent that such is in the normal course of trade [*7666705 Canada Inc v 9301-7671 Québec Inc*, 2015 TMOB 150].

[63] As per my review above of the Späth affidavit, I accept that the Opponent has met its burden insofar as its registered goods "snowboards" are concerned.

[64] Based on a fair reading of the Späth affidavit as a whole, including Mr. Späth's statements that the Opponent's sales figures for each of the years 2011 to 2021 do include apparel, I am prepared to accept that the Opponent has also met its burden with respect to these particular goods. However, in the absence of any clear statement to the same effect, I am not prepared to accept that the Opponent has met its burden in respect of its remaining non-registered goods, especially the Opponent's bags. In this regard, it is worth noting that the Opponent's above-mentioned application No. 1,794,248 for the trademark NITRO in association with practically all kinds of bags was filed on August 3, 2016 on the basis of proposed use of the mark in Canada.

[65] Likewise, I am not satisfied that the Opponent has evidenced conclusively the use of any of its trade names Nitro AG or Nitro SA in Canada as of April 14, 2015 or at any time.

[66] The Applicant must therefore establish, on a balance of probabilities, that there was not a reasonable likelihood of confusion between the Mark and the Opponent's trademark NITRO in association with snowboards and apparel.

[67] I consider that the difference in material dates does not materially affect my conclusion under the section 12(1)(d) ground of opposition discussed above. In this regard, while the evidence from the Opponent's competitors' webpages is dated "10/03/2021", that is after the relevant date, the Registrar may take into account such evidence as it may indicate a situation existing at the material date [see, for example, *George Weston Ltd v Corporate Foods Ltd* (1988), 19 CPR (3d) 566 (TMOB)]. That said, I note in passing that the number of relevant third party registrations referred to above in my review of the state of the register evidence is even less when considered as of the date of filing of the Application. Accordingly, for reasons similar to those expressed in the above analysis, I reach the same conclusion regarding the likelihood of confusion as under the 12(1)(d) ground of opposition.

[68] This ground of opposition therefore succeeds in part.

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

[69] The Opponent has pleaded that the Mark is not distinctive in that it is not adapted to distinguish and does not actually distinguish the Applicant's applied-for goods and services from both the Opponent's trade name Nitro AG (or French version thereof Nitro SA) and its trademark NITRO that has been used in Canada in association with snowboards, snowboard accessories, apparel and bags.

[70] In order to meet its initial burden in support of the non-distinctiveness ground of opposition, the Opponent was required to show that, as of the date of filing its statement of opposition, its aforementioned trademark or trade names were known in Canada in association with relevant goods and services to some extent, having a "substantial,

significant or sufficient” reputation to negate the distinctiveness of the Mark, or else “well known in a specific area of Canada” [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles’ International LLC v Bojangles Café Ltd*, 2006 FC 657 at para 33]. In this regard, an opponent’s evidence is not restricted to the sale of goods or services in Canada. It may also be based on evidence of knowledge or reputation of an opponent’s trademark including that spread by means of word of mouth or newspaper and magazine articles [*Motel 6, Inc v No 6 Motel Ltd, supra*, at 58-59].

[71] I have no difficulty concluding that the Opponent has met its burden insofar as its snowboards are concerned. However, given the imprecisions noted above under my review of the section 6(5)(a) factor, I am not satisfied that the Opponent’s evidence conclusively demonstrates that the Opponent’s trademark NITRO in association with each or some of its non-registered goods had a reputation that was “substantial, significant, or sufficient” in Canada to negate the distinctiveness of the Mark, or alternatively, that the Opponent’s trademark was “well known in a specific area of Canada” as required by *Bojangles, supra*. Neither has the Opponent met its initial burden with respect to either of its trade names Nitro AG or Nitro SA.

[72] The Applicant is therefore required to show that its Mark is adapted to distinguish or actually distinguished the applied-for goods and services from the snowboards of the Opponent [*Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[73] I consider that the difference in material dates does not materially affect my conclusion under the section 12(1)(d) ground of opposition discussed above. Accordingly, for reasons similar to those expressed in the above analysis, I reach the same conclusion regarding the likelihood of confusion as under the 12(1)(d) ground of opposition.

DISPOSITION

[74] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the Application with respect to all of the clothing items from CI 25 and the goods described as “athletic protection pads”, “wakeboards”, “surfboards” and I reject the

opposition with respect to the remainder of the goods and all of the services pursuant to section 38(12) of the Act.

Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Statement of goods and services covered by the Application, together with the associated Nice classes (CI)

Goods

CI 5 (1) First aid kits, adhesive bandages

CI 9 (2) Apparatus for recording, transmission or reproduction of sound or images, namely, CD players, digital audio players and recorders, audio receivers, video receivers, microphones, sound amplifiers, computer video games featuring stunts, action sports, and athletes, compact discs featuring video and computer games, downloadable multimedia news webcasts featuring stunts, action sports, and athletes, downloadable computer games, downloadable motion pictures and television shows, downloadable ring tones for mobile phones, downloadable electronic publications in the nature of books, magazines and articles on stunts, action sports and athletes, blank USB flash drives, interactive multimedia computer games featuring stunts, action sports and athletes, applications for mobile phones, mobile devices, handheld computers, computers and tablet computers in the form of downloadable games featuring stunts, action sports and athletes, prerecorded DVDs featuring stunts, action sports, and athletes, pre-recorded audio tapes featuring stunts, action sports and athletes, pre-recorded films featuring stunts, action sports and athletes, pre-recorded CDs featuring stunts, action sports and athletes, pre-recorded television shows, downloadable image files, downloadable podcasts in the field of stunts, action sports and athletes, downloadable webcasts in the field of stunts, action sports and athletes, downloadable MP3 files and MP3 recordings in the field of stunts, action sports and athletes, holograms, holographic projectors, holographic film, holographic images, digitally stored photographs, video cameras, audio speakers, headphones, mouse pads, spectacle cases, spectacle frames, sunglasses, ear buds, walkie-talkies, camcorders and digital cameras, cases and housings for cameras and camera straps, mobile phone and computer covers

CI 12 (3) Go-carts, campers, children's safety seats for vehicles, air balloons

CI 14 (4) Clocks, key rings

CI 16 (5) Collectible trading cards, sports trading cards, pens, pencils, highlighter pens, folders, notebooks, paper, paper party decorations, party goodie bags of paper or plastic, paper napkins, decals and stickers, greeting cards, posters, stickers, calendars, bumper stickers, books, magazines, colouring books, temporary tattoo transfers

CI 18 (6) Back packs, sport bags, handbags, purses, travel bags, duffel bags, tote bags, garment bags, luggage, umbrellas, messenger bags

CI 21 (7) Cups and mugs, drinking glasses, paper plates, lunch boxes, thermal insulated containers for food or beverages

CI 24 (8) Towels of textile, namely, bath towels, beach towels, bed spreads, pillow cases, curtains, draperies, bed sheets, comforters, blankets

CI 25 (9) Clothing, namely, bandanas, gloves, scarves, socks, underwear, pyjamas, wristbands, shorts, costumes, shoes for men, women and children, all of the foregoing excluding motorcycle clothing and footwear

CI 28 (10) Construction toys, bendable toys, plush toys, electric action toys, collectable toy figures, action figures, inflatable toys, toy building blocks, toy vehicles, board games, toy vehicle play sets, return type tops and strings therefor, balloons, namely, decorative party balloons, toy balloons, in-line skates, wakeboards, toy scooters, toy weapons, water toys, surfboards, water skis, beach balls, soccer balls, hockey pucks, flying disks, Christmas ornaments, playing cards, fishing tackle, poker chips, arcade video game machines, athletic protection pads, child's ride-on toy, paper party favours, paper party hats, party favours in the nature of crackers and noisemakers, plastic party hats, bean bags

CI 29 (11) Dried meats, dried fruits and nuts, candied fruit snacks

CI 30 (12) Energy bars, breakfast cereal, cereal bars, candy, chocolate, chewing gum

CI 32 (13) Energy drinks, sports drinks, water, carbonated non-alcoholic beverages, soft drinks, soft drink mixes, drink flavour enhancers used in beverage products

Services

CI 35 (1) Business organization and management consulting services, talent agency services

CI 41 (2) Film distribution, post-production editing services in the field of music, videos and film, motion picture film production, production of video disks containing sporting and entertainment events

CI 41 (3) Publication of multimedia material online, namely, non-downloadable streaming audio and video, namely, music, movies, television shows, music videos in the field of stunts, action sports and athletes transmitted online via a global computer network, entertainment services in the nature of television shows, films, sound recordings, webcasts and podcasts in the field of stunts, action sports and athletes, education services, namely, providing sports exhibitions in the field of stunts, action sports and athletes, operation of sports camps, distribution of television programs, films and audio recordings, production of television programs, films and audio recordings, photography, event management and planning services, namely, entertainment events in the nature of action sports and stunts, production of sporting events, namely, competitions and performances in the field of stunts, action sports

and athletes, entertainment in the nature of computer games, namely, providing temporary use of non-downloadable computer games, entertainment services, namely, providing temporary use of non-downloadable interactive games, entertainment services, namely, providing online games and puzzles via a website

Claims

Used in Canada since at least as early as May 2014 on services (2)

Proposed use in Canada on goods and on services (1) and (3)

Appearances and Agents of Record

No hearing held

AGENTS OF RECORD

For the Opponent: BCF S.E.N.C.R.L./BCF LLP

For the Applicant: Gowling WLG (Canada) LLP