

# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 028

**Date of Decision:** 2023-02-16

## **IN THE MATTER OF AN OPPOSITION**

**Opponent:** Nitro SA

**Applicant:** Nitro Circus IP Holdings LP, Limited Partnership Delaware

**Application:** 1,798,660 for NITRO CIRCUS

### **INTRODUCTION**

[1] Nitro SA (the Opponent) opposes registration of the trademark NITRO CIRCUS (the Mark), which is the subject of application No. 1,798,660 (the Application), standing in the name of Nitro Circus IP Holdings LP, Limited Partnership Delaware (previously named Nitro Circus IP Holdings LP) (the Applicant) and based on proposed use of the Mark in Canada in association with the following goods, as revised by the Applicant: “skateboards; ramps and jumps for skateboarding, inline skating, and pogo sticks” (the Goods).

[2] The main issue in this proceeding is whether there would be a likelihood of confusion between the Mark in association with the Goods and the Opponent’s trademark NITRO, which is registered under Canadian trademark registration No. TMA397323 in association with “sporting goods and equipment, namely

snowboards” as well as the subject of a pending Canadian trademark application bearing Serial No. 1,794,248 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”.

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

### **THE RECORD**

[4] The Application was filed on August 26, 2016 and claims the priority of a corresponding application filed on February 26, 2016 in the United States of America. The Application was advertised for opposition purposes in the *Trademarks Journal* on July 10, 2019.

[5] On September 6, 2019, 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). The grounds of opposition raised by the Opponent are based on non-registrability of the Mark under section 12(1)(d) of the Act; non-entitlement of the Applicant under sections 16(1)(a), 16(1)(b) and 16(1)(c) of the Act; non-distinctiveness of the Mark under section 2 of the Act; and non-compliance of the Application with section 38(2)(e) of the Act.

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

[7] In support of its opposition, the Opponent filed, as evidence in chief, an affidavit of its Managing Director (“*directeur-gérant*”), Johannes Späth, sworn March 6, 2020 (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 December 16, 2020 (the Edwards affidavit) and an affidavit of Wayne Covell, a solicitor of the Supreme Court of New South Wales and an Australian Trade Marks Attorney, sworn December 17, 2020 (the Covell affidavit). The Opponent thereafter filed as evidence in reply an affidavit of Kimberly Sévigny, a paralegal employed by the agent for the Opponent, sworn January 22, 2021 (the Sévigny 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 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 Goods 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.

[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 as the fanciful combination of the words NITRO and CIRCUS would likely be understood as connoting that the Applicant's extreme sports related Goods 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, 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 January 30, 2020, approximately 140 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 11];
- 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 7.5 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. 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. As a result, Mr. Späth asserts that the actual consumer sales figures in Canada for NITRO-brand products are higher than the figures shown in the aforementioned table [paras 13 to 15];

- in terms of advertising and marketing, Mr. Späth provides a table showing the Opponent's 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 18 and 19];
- 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 19 to 27]; 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](http://www.redbull.com/us-en/films/28-winters) and [www.redbull.com/us-en/films/boom](http://www.redbull.com/us-en/films/boom) [para 28].

[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 February 21, 2020 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 from what Mr. Späth describes as Nitro Canada’s website displaying NITRO-brand snowboards, snowboard boots, snowboard bindings, bags and a few clothing items. Mr. Späth stresses that while [TRANSLATION] “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 8]:



- 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 Canadian dollars, 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 included in the list of retailers who sell NITRO-brand products in Canada



(Exhibit JS-4). However, 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 20 to 22, and 27];
- 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 23];
- 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 25];

**NITRO SNOWBOARDS |  
OFFLINE TEASER**



Nitro has consistently delivered high quality and highly entertaining snowboard cinema. Critique will be worth the bandwidth, mark your calendar. Snowboarding is...

[READ MORE >](#)

**NITRO TEAM WEEK |  
WOODWARD COPPER**



Let the good times roll. Team Nitro rips through Copper for some summer shred. Watch team riders Austin Smith, Jared Elston, Griffin...

[READ MORE >](#)

**FRIENDS | A NITRO FILM**



Whoever coined the phrase "no friends on a powder day" had it all wrong, and Nitro's latest short is proof. Nothing beats...

[READ MORE >](#)

**Beast (Nitro x Volcom)**



Did someone order a Ultimate Park Board, True Camber Twin, with a side of Rail Killer Edges? Come and get it!

**NITRO CAMP GOOD  
TIMES**



Damn you, Nitro! You always seem to be having a way better time than the rest of us. Read the incoming communication...

[READ MORE >](#)

**BOOM! Nitro Teaser**



Nitro knows snowboarding, they've had skin in the game since the beginning. The videos they produce, their team, it's always on point...

[READ MORE >](#)

- 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 9 and 26].

[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 snowboard accessories, apparel and bags may contribute to the extent known of the registered goods and because the Opponent's bags 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 these other NITRO-brand products, as the annual sales figures with respect to these goods are not broken down per category of products and could therefore be associated to sales of only one or some of these goods. Nor does Mr. Späth correlate any of the Opponent's sales provided in the invoicing journal (Exhibit JS-8) to specific items. In this regard, it is worth reminding that the Opponent's above-identified 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. As a further deficiency in the Opponent's evidence, the Späth affidavit provides no 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 13 to 21 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'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 t-shirts, jerseys, sweatshirts, jumpers, hats, beanies, hoodies, socks, gloves, 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 10 and 28];
- 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 11 to 20];
- 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 [paras 7 and 22];

- 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 23];
- currently, NITRO CIRCUS branded skateboards, ramps and related equipment covered by the Application are sold via online stores, including the Nitro Circus Online Store; Amazon.ca; The Vault Pro Scooters; and Broadway Pro Scooters [para 53];
- 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 22 and 54, 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 24];
- the Applicant has 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 since 2014. However, no breakdown is provided by year or by touring events or merchandise [para 48];
- since the launch of the Nitro Circus Online Store in approximately 2016, the Applicant has generated over USD\$100,000 in sales via such store into Canada. However, no breakdown per year and per product is provided [para 48];
- 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 [para 25]. However, no breakdown for Canada is provided;

- the NITRO CIRCUS live tour shows, including the Canadian tours, “all prominently feature various ramps and jumps for skateboards, scooters, bikes, motorcycles, skates, indeed, anything that can be put on wheels” [para 30];
- for the period from 2018 until November 2020, there have been in excess of 1.4 million visits from Canadian patrons to the Applicant’s websites *nitrocircus.com*, *shop.nitrocircus.com* and *www.nitroworldgames.com* [paras 40 and 41, which further include a breakdown per year of the number of visits to each of these three websites]. In this regard, I note that in a related opposition proceeding between the same parties concerning the Applicant’s pending application No. 1,724,719 for the trademark NITRO CIRCUS, Mr. Edwards stated at paragraph 51 of his affidavit sworn October 22, 2021, that he found “that the prior disclosures [indicated in his affidavit in the present file] did not reflect the most up-to-date numbers in [the Applicant’s] records” and that the figures in his affidavit in file No. 1,724,719 “are based on updated and/or corrected data”. More particularly, Mr. Edwards stated at paragraph 50 of that other affidavit that “for the period 2018 until 19 October 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 aforementioned websites”. However, no correction was made in the present file;
- the Applicant has also promoted its goods and services in association with the Mark in social media platforms. As of November 3, 2020:
  - the NITRO CIRCUS Facebook page had over 11 million followers of which approximately 470,000 are from Canada [para 42];
  - the NITRO CIRCUS Twitter page had 44.4K followers [para 43];
  - the NITRO CIRCUS Instagram page had 3 million followers, of which in excess of 118,000 are from Canada [para 44];
  - the official NITRO CIRCUS YouTube page had 1.38 million subscribers (of which in excess of 21,000 are from Canada) and 290,135,899 views (no breakdown for Canada is included).

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

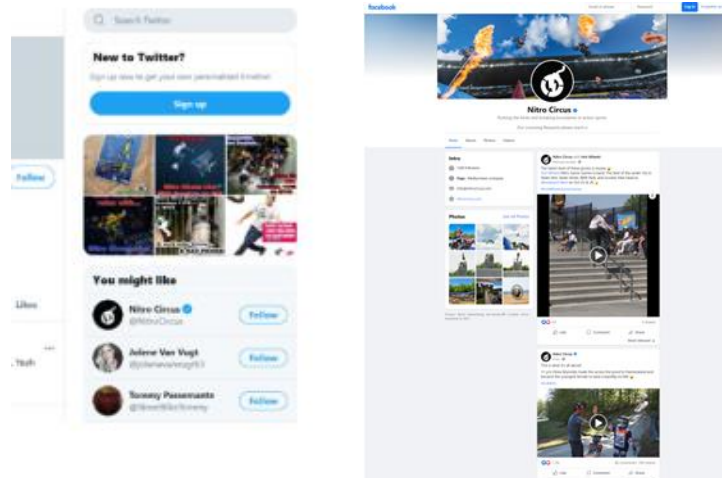
- Exhibit A: copy of an article published in Media in Canada on March 9, 2009 which refers to the launch of the new TV series, NITRO CIRCUS;
- Exhibit B: copy of an article published on December 13, 2012 in The Toronto Star, according to which *Nitro Circus: the Movie* was number 9 on iTunes Top Downloads. 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 11];
- 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 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 movie *Nitro Circus: Action Figures 2*, produced in 2019 by the Applicant for the Sony Crackle platform, which was released in the U.S. on June 28, 2018 and features the Mark and shows various action sport activities, tricks and stunts, including motocross, rallycar, racing, BMX bikes and skateboarding, was added to Netflix in Canada on or about April 1, 2019;
- Exhibit J: a photograph of the Nitro Circus Maple Leaf T-shirt. Mr. Edwards asserts that since June 2018, the Applicant has sold a Maple Leaf T-shirt through the Nitro Circus Online Store;
- 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 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 Y: screenshots from the video channel of Ryan Williams, who traveled the globe with the Applicant, displaying various images of Ryan Williams' post CRAZY FIRST SHOW with his scooter during the 2018 tour in Canada. Mr. Edwards asserts that there are many more YouTube channels featuring NITRO CIRCUS content such as Ryan Williams' channel;
- 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 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 to AI: 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 [Exhibits AG and AH], or announcing the upcoming 2021 Nitro Circus North American Tour planned to take place in some 21 outdoor arenas across the U.S., as well as in unidentified cities in Canada [Exhibit AI].

[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, which represent the core of the Applicant's business.

[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 states 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 applied-for Goods. Indeed, I find the evidence is much too vague to draw any reasonable inference in that regard in favour of the Applicant. That being said, I will return to the extent to which the Mark has become known in association with the Applicant’s core business when considering the additional surrounding circumstances.

[37] On balance, therefore, I find that this factor, which is a combination of inherent and acquired distinctiveness, favours the Opponent.

*The length of time the trademarks have been in use*

[38] In view of my findings made above, this factor also favours the Opponent.

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

[39] 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)].

[40] In its written representations, the Applicant submits that where the statement of goods associated with an earlier registration is directed to narrow and specific goods, the scope of the earlier registration should be interpreted in that regard. The Applicant further submits that while the parties' goods both fall within the same general category of sporting equipment, there are important differences in the natures of the goods. More particularly, it submits that the Opponent's snowboards are winter sporting goods, and are only useable in the winter months, whereas the Applicant's Goods are summer sporting goods and are not useable in the winter months. With respect, I do not find the Applicant's submissions persuasive.

[41] First, it is to be reminded that it is not necessary that the parties operate in the same general field or industry or that their respective goods and services be of the same type or quality for there to be a likelihood of confusion. As stated in section 6(2) of the Act, confusion may occur "whether or not the goods or services are of the same general class." Second, I find there are similarities between snowboards and skateboards, as explained by Mr. Späth at paragraph 31 of his affidavit:

[TRANSLATION]: [...] skateboarding and snowboarding are both board sports, known as "extreme sports" in which acrobatics constitute a core element for many fans of these sports and in the eyes of the general public. For example, both snowboarding and skateboarding are featured in the X Games, which is the largest extreme sports competition circuit in the world.

[42] In this regard, contrary to the Applicant's position, I do not find the fact that Mr. Späth does not expressly state that skateboarding and snowboarding events "are

held at different X Games competitions, at different times of the year”, to affect the reliability of Mr. Späth’s statement, nor to lessen the similarities existing between skateboarding and snowboarding.

[43] I further note that Mr. Späth states at paragraph 32 of his affidavit that [TRANSLATION]: “the target clientele of snowboards and skateboards is mostly teenagers and young adults who identify a lot with a marginal lifestyle and are thrill-seeking”. In the absence of evidence to the contrary, I have no reason to doubt that there is a potential overlap between the parties’ target clientele in that they may both target teenagers and young adults, whether or not they identify with an alternative lifestyle or are thrill-seeking. Besides, I note that Exhibits JS-7 and JS-16 to JS-19 attached to the Späth affidavit (discussed in further detail below) show that there are shops specializing in both snowboards and skateboards (and related accessories), such as the Empire stores referred to above in my review of the Späth affidavit. Moreover, on this point, the Opponent’s website printouts attached as Exhibit JS-1 to the Späth affidavit display, among other illustrations of the Opponent’s collection of bags, a photograph of a teenager or young adult carrying, on the back of his bicycle, a skateboard, as reproduced below:



[44] Furthermore, I note that in my decision (dated as of today’s date) in the above-mentioned related opposition proceeding concerning the Applicant’s application No. 1,724,719 [2023 TMOB 027], I have found that there is an overlap between the Applicant’s applied-for goods that were described as “wakeboards” and “surfboards” and the Opponent’s snowboards because they are both for board sports and the

evidence showed that they may be produced by the same source. No corresponding evidence is of record in the present case. Nevertheless, I am of the view that it is not unreasonable to conclude that, as board sports, skateboards and snowboards may also be perceived as coming from the same source. In the absence of evidence to the contrary, I find the same comment applies to the remaining of the Applicant's applied-for ramps and related equipment described as "ramps and jumps for skateboarding, inline skating, and pogo sticks" in that these products would allow skateboarders to perform "tricks" which is also a focus of snowboarding as shown in the evidence [see for example the photographs of Olympic athletes Sébastien Toutan and Laurie Blouin referred to above under Exhibits JS-10 and JS-11].

[45] Turning to the parties' channels of trade, the Applicant submits in its written representations that there are important differences in the natures of the trades and the establishments through which the goods are sold. More particularly, it submits that:

68. [...] Both the Opponent's goods and the Applicant's Goods are offered through their own respective specialty stores [...]. The Applicant's skateboards, ramps and related equipment are also sold via online stores, including the Nitro Circus Online Store, Amazon.ca, The Vault Pro Scooters and Broadway Pro Scooters.

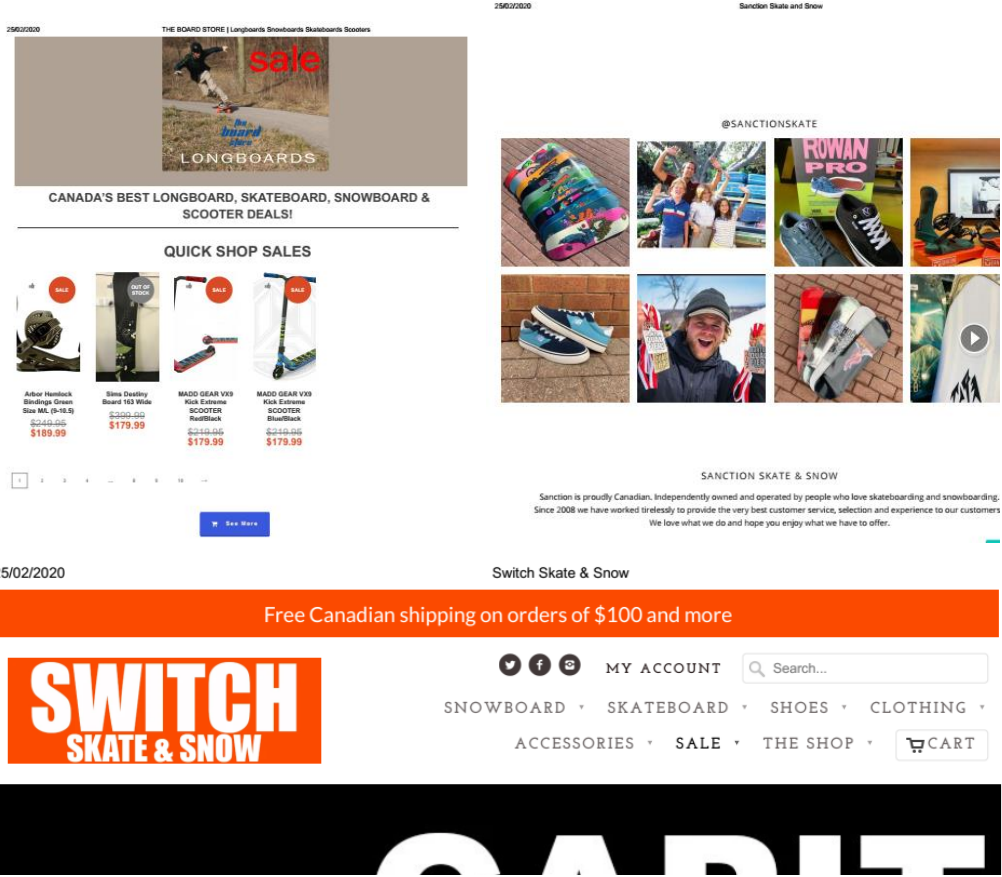
69. While the Opponent's affiant also states that there are specialist snowboarding, skateboarding, and accessories stores that are NITRO retailers stores (i.e., stores that sell both skateboards and snowboards), he only refers to four such websites [Späth affidavit, Exhibits JS-16 to JS-19], and the Applicant notes that none of the printouts of the four stores included in Mr. Späth's [a]ffidavit show offering for sale of both snowboards and skateboards. To the extent that there are such "board" shops that offer both skateboards and snowboards, the Applicant notes that the different goods would be sold at different times of the year, and in different areas of the same stores. Likewise, while the Opponent states that the Opponent's goods are sold in sports stores and in the sports department of large retail stores [Späth affidavit, at para 30], to the extent that both the Applicant's skateboards and the Opponent's snowboards would be sold in sports stores and in the sports department of large retail stores, the Applicant again notes that skateboards and snowboards would be sold at different times of the year and in different areas of the stores. The Opponent has not filed any evidence suggesting that skateboards and snowboards are sold side-by-side in the same areas of "board shops", sports stores or large retail stores, and in the absence of such evidence, the Applicant submits that the differences in the goods suggest that there would be corresponding differences in how those goods would be offered to consumers through such stores.

[46] With respect, I do not find these submissions to be persuasive.

[47] First, 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. In this regard, I note that Mr. Edwards states at paragraph 53 of his affidavit that "it is envisaged that [the Applicant's NITRO CIRCUS goods] will also be made available for sale in Canada in mass retail stores, specialty retail stores and independent stores." Furthermore, as reminded by the Supreme Court in *Masterpiece*, *supra*, at paragraphs 53 to 59, one must not lose sight of the full scope of the rights conferred by the trademark registration sought by the Applicant. The focus must be on the terms set out in the Application for the Mark and on what "the registration would authorize the [Applicant] to do, not what the [Applicant] happens to be doing at the moment." While actual use is not irrelevant, "it should not be considered to the exclusion of potential uses within the registration."

[48] Second, while I acknowledge that none of the exhibits attached to the Späth affidavit show the offering for sale of both skateboards and snowboards side by side or close to one another in "brick and mortar" stores, this is not determinative. As stressed above, section 6(2) of the Act does not require the parties' goods to be sold side by side, nor does it require the goods to be of the same general class. Likewise, even if the parties' goods were to be sold at different times of the year in these stores that would not render the parties' channels of trade dissimilar. As mentioned above, the parties' goods may still target the same consumers. As a matter of fact, the printouts of the home pages of the websites of the five NITRO retailers attached as Exhibits JS-7 and JS-16 to JS-19 to the Späth affidavit do show the offering for sale of both skateboards and snowboards by these retailers, as per the examples reproduced below:





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

[49] 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].

[50] 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”.

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

[52] 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 action sports goods, 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 are suitable for explosive movements by reason of the word NITRO. In this regard, I note that 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.

[53] 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

[54] 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].

[55] In the present case, the Applicant relies on the results of the trademark searches of the Canadian Trademarks Database conducted by Mr. Covell on December 17, 2020 attached as Exhibits A to C to his affidavit. More particularly, the Applicant submits that Mr. Covell located 234 trademarks containing the word NITRO in association with different goods and services, 132 of which are pending and registered. More particularly the Applicant points out the following registered third party trademarks, registered in Nice class 28:

Trademark	Reg. No./ Reg. Date	Owner	Goods/Services
NITRO GAMES	TMA1101437/ 2021-06-04	Nitro Games Oyi	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 NITRO JACKPOT	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”.

[56] 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

[57] In paragraphs 60 to 62 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.

[58] However, the fact that the parties' marks may coexist on foreign trademarks registers is not binding upon the Registrar since registrations in other jurisdictions have their basis in foreign law and procedure as set out by the Registrar in *Quantum Instruments Inc v Elinca SA* (1995), 60 CPR (3d) 264:

As yet a further surrounding circumstance in respect of the issue of confusion, the applicant submitted evidence of registrations obtained by both parties in Great Britain and in the United States of America for the trade-marks QUANTA and QUANTUM. However as noted [...] in *Haw Par Brothers International Ltd. v. Canada (Registrar of Trade Marks)* (1979), 48 C.P.R. (2d) 65 (Fed. T.D.) at p. 68, little can be drawn from the fact that the trade-marks at issue coexist in other jurisdictions. [...] the Registrar must base his decision on Canadian standards, having regard to the situation in Canada. Further, in *Sun-Maid Growers of California v. Williams & Humbert Ltd.* (1981), 54 C.P.R. (2d) 41 (Fed. T.D.) at p. 49, [the court] pointed out that 'no significance can be attached to failure to oppose or object to registrations in other jurisdictions since such actions, of necessity, have their basis entirely in foreign law and procedure.' Additionally, while the applicant has relied upon evidence of coexistence of the trade-marks at issue on the registers in Great Britain and the United States of America, no evidence has been adduced of the coexistence of the trade-marks at issue in the market-place in either of these countries... Accordingly, I do not consider this evidence to be persuasive in this proceeding.

[59] Furthermore, as in the *Quantum* case, no evidence has been adduced of the coexistence of the trademarks at issue in the marketplace in these foreign countries.

[60] In view of the above, I do not find it necessary to discuss the submissions made by each party that relate to Exhibit D attached to the Covell affidavit, which consists of a copy of the submissions made by the Opponent to the United States Patent and Trademarks Office (USPTO) in response to an Office Action issued in respect of the Opponent's trademark application No. 79,196,163, and the Sévigny affidavit, filed as reply evidence in the present file and enclosing a copy of a further Office Action issued by the USPTO in response to the response filed by the Opponent to the Office Action dated May 17, 2017. In any event, I note that these submissions essentially relate to the degree of resemblance between the two parties' trademarks and do not alter my findings made above under the section 6(5)(e) factor [see also *Molson Breweries v Labatt Brewing Co* (1996), 68 CPR (3d) 202 (FCTD) where the Court held that regardless of the previous positions of a party I must determine confusion in accordance with law and relevant jurisprudence].

[61] 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, motocross, 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, motocross 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, motocross and bmx competitions and events; film distribution and editing; motion picture film production.

[62] Second, while the applied-for Goods are related in some way to the Applicant's registered services and could be viewed as an extension of the Applicant's core business, 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 for the reasons discussed below in my review of the additional surrounding circumstance relating to the extent known of the Mark in association with the Applicant's core business.

*Absence of instances of actual confusion*

[63] 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 63 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.

[64] 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 Edwards affidavit, I am not convinced that there is evidence of extensive concurrent use in this case insofar as the Applicant's applied-for Goods are concerned. Accordingly, I am not prepared to accord significant weight to this surrounding circumstance.

*Extent known of the Mark in association with the Applicant's core business*

[65] As indicated above, I 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". That being said, in the absence of more specific evidence of sales of the Goods, this factor is not determinative and does not necessarily lead to the conclusion that consumers are able to distinguish between the source of the Opponent's goods sold in association with its trademark and the Goods sold in association with the Mark given the overlap between these Goods and snowboards.



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

[66] 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. 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*].

[67] 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. Specifically, in view of the overlapping nature of the goods, channels of trade and target audience and the degree of resemblance between the Marks, the Applicant has failed to demonstrate that an average consumer seeing the Mark in association with the applied-for Goods and having only a vague recollection of the Opponent's trademark, as a matter of first impression, would not infer that the Goods are sold or otherwise emanate from or are licensed, approved or sponsored by the owner of the NITRO registration. Indeed, 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 Goods 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 with respect to the applied-for Goods, I might have reached a different conclusion.

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

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

[69] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark because at the filing date of the Application, the Mark was confusing with:

- the Opponent’s trademark NITRO which had been previously used in Canada in association with both the Opponent’s registered goods described as “sporting goods and equipment, namely snowboards” and applied-for goods described as “backpacks; sport bags; sports shoe bags; leather and leather imitations; travel cases and suitcases; saddlery; snowboard bags; skateboard bags” [section 16(1)(a) of the Act];
- the Opponent’s trade name Nitro AG (or French version thereof Nitro SA), which had also been previously used in Canada by the Opponent [section 16(1)(c) of the Act]; and
- the Opponent’s trademark NITRO in respect of which pending application No. 1,794,248 had been previously filed [section 16(1)(b) of the Act].

[70] I will address the non-entitlement grounds of opposition based on prior use first.

#### Sections 16(1)(a) and (c) grounds of opposition

[71] 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 February 26, 2016), 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].

[72] Based on my review above of the Späth affidavit, I accept that the Opponent has met its burden insofar as its registered goods “snowboards” are concerned.

[73] However, for the reasons explained above at paragraph 27 of my decision, I am not satisfied that the Opponent has met its burden with respect to its non-registered goods described as “backpacks; sport bags; sports shoe bags; leather and leather imitations; travel cases and suitcases; saddlery; snowboard bags; skateboard bags”.

[74] 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 February 26, 2016 or at any time.

[75] 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.

[76] 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 retailers’ webpages is dated “25/02/2020”, 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.

[77] This ground of opposition therefore succeeds.

### Section 16(1)(b) ground of opposition

[78] In order to meet its initial burden under section 16(1)(b) of the Act, the Opponent must establish that its application No. 1,794,248 was filed prior to the date of filing of the Application (*i.e.* February 26, 2016), and that it was not abandoned at the date of advertisement of the Application (July 10, 2019) [section 16(2) of the Act]. The Registrar has the discretion to check the register in order to confirm the existence of the application relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[79] I have exercised that discretion and confirm that the Opponent's application No. 1,794,248, filed in Canada on August 3, 2016, claims the priority of a corresponding application filed in Switzerland on February 8, 2016 (which is prior to the Applicant's priority date of February 26, 2016), and that the Canadian application is still pending.

[80] The Applicant must therefore establish, on a balance of probabilities, that there was not a reasonable likelihood of confusion between the Mark in association with the Goods and the Opponent's trademark NITRO in association with the goods described as "backpacks; sport bags; sports shoe bags; leather and leather imitations; travel cases and suitcases; saddlery; snowboard bags; skateboard bags", as of the filing date of the Application.

[81] While the test for confusion remains the same, my analysis of the section 6(5) factors differs slightly in that there is no evidence that the Opponent's trademark had been used or become known to any extent in Canada in association with its applied-for variety of bags as of the filing date of the Application. With respect to the nature of the goods and the nature of the trade, I do not find persuasive the Applicant's submissions made in its written representations, according to which:

The goods covered in the Opponent's application No. 1,794,248 [...] are largely in Class 18, whereas the [Applicant's Goods] are in Class 28. With respect to the goods "skateboard bags", [...] there is no evidence as to the channels of trade through which those goods would allegedly be sold. While the Opponent invites the hearing Officer to conclude that such "skateboard bags" would be sold alongside skateboard and the other goods covered in the Application, there is no evidence to that effect, and certainly none

with respect to the Applicant's goods "ramps and jumps for skateboarding, in line skating, and pogo sticks.

[82] As stressed above, section 6(2) of the Act does not require the parties' goods to be sold side by side, nor does it require the goods to be of the same general class. Furthermore, while I acknowledge that Mr. Späth's sworn statement made at paragraph 36 of his affidavit that [TRANSLATION] "it goes without saying that skateboard bags and skateboards are typically sold alongside one another in the same shops" is not supported by corroborating exhibits, I see no reason not to afford weight to this uncontradicted statement. Rather, in the absence of evidence to the contrary, I find that the Opponent's skateboard bags are complementary to the Applicant's Goods, especially those described as skateboards, and that there is a potential overlap between the Applicant's Goods and the Opponent's skateboard bags and their corresponding channels of trade.

[83] Finally, as to the additional surrounding circumstances, my finding made above with respect to the extent known of the Mark in association with the Applicant's core business remains applicable to the present ground of opposition. That said, I find the extent known of the Opponent's trademark NITRO in association with its snowboards must also be taken into account as an additional surrounding circumstance under the present ground of opposition. Indeed, considering the Späth affidavit as a whole, including the Opponent's snowboards sales figures provided for each of the years 2011 to the date of signature of the Späth affidavit, I find the extent known of the Opponent's trademark in association with snowboards remains significant as of the material date to assess the present ground of opposition. That being so, I find this reinforces the Opponent's case considering the overlap existing between the Opponent's snowboards and the Applicant's Goods as discussed above under the section 12(1)(d) ground of opposition.

[84] In view of all of the above, I find that, at best for the Applicant, the balance of probabilities as to the likelihood of confusion between the Mark and the Opponent's trademark is evenly balanced. While I acknowledge that for those consumers familiar with the Mark in association with the Applicant's core business, the Goods 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 assessed as a matter of first impression. Had the Applicant's evidence conclusively demonstrated the coexistence of the parties' trademarks with respect to the applied-for Goods, I might have reached a different conclusion.

[85] Accordingly, the section 16(1)(b) ground of opposition succeeds.

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

[86] 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 Goods 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 the Opponent's snowboards and bags.

[87] 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].

[88] 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 under the section 12(1)(d) ground of opposition, I am not satisfied that the Opponent's evidence conclusively demonstrates that its trademark

NITRO in association with the Opponent's bags 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.

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

[90] 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**

[91] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the Application pursuant to section 38(12) of the Act.

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Annie Robitaille  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# 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