



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 090

**Date of Decision:** 2023-05-30

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

**Opponent:** Trek Bicycle Corporation

**Applicant:** Aparso (Fujian) Sportswear Co., Ltd.

**Application:** 1,955,114 for AZTREK & Design

### **INTRODUCTION**

[1] Trek Bicycle Corporation (the Opponent) opposes registration of the trademark AZTREK & Design, shown below (the Mark), which is the subject of application No. 1,955,114 (the Application) by Aparso (Fujian) Sportswear Co., Ltd. (the Applicant):

**AZTREK**

[2] The Application is based on proposed use in association with the following goods:

(1) Bags for sports; handbags; key cases; luggage and trunks; pocket wallets; rucksacks; travelling bags; trimmings of leather for furniture; umbrellas; unworked leather

(2) Bathing suits; casual clothing; girdles; gloves; hats; hosiery; layettes; scarves; shoes; waterproof jackets and pants

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent's previous use and registration of the Opponent's trademarks, including the trademark TREK.

[4] For the reasons that follow, the Application is refused as the Applicant has not met its burden to demonstrate that there is no likelihood of confusion between the parties' trademarks.

#### **THE RECORD**

[5] The Application was filed on April 3, 2019, and was advertised for opposition purposes in the *Trademarks Journal* of October 20, 2021. On December 14, 2021, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition relate to registrability under section 12(1)(d), entitlement under sections 16(1)(a) and 16(1)(c), and distinctiveness under section 2 of the Act.

[6] The Applicant filed a counter statement denying the grounds of opposition. The Opponent filed as its evidence the affidavit of Jean-Francois Blais, the Canadian Sales Manager of the Opponent (sworn May 30, 2022). The Applicant elected not to file any evidence. Only the Opponent filed written representations and no hearing was held.

#### **LEGAL ONUS AND EVIDENTIAL BURDEN**

[7] 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), 1990 CanLII 11059 (FC), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155]. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all of the evidence, then the issue must be decided against the Applicant.

## **ANALYSIS OF THE GROUNDS OF OPPOSITION**

### ***Section 12(1)(d) ground of opposition***

[8] The Opponent has pleaded that the Mark is not registrable because, contrary to section 12(1)(d) of the Act, the Mark is confusing with the Opponent's registrations for the trademarks TREK and TREK & Design (TMA618,271 and TMA843,803).

[9] The material date for this ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[10] I have exercised my discretion to check the Register and confirm that these registrations remain extant [*Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial evidential burden with respect to this ground of opposition. As a result, the Applicant bears the legal burden of demonstrating on a balance of probabilities that there is no likelihood of confusion between the Mark and one, or both, of the Opponent's registered trademarks.

[11] In considering the issue of confusion, I will focus on the Opponent's word mark registration for the trademark TREK (TMA618,271) as in my view this represents the Opponent's best case. The goods associated with this registration are "bicycling apparel, namely jerseys, shorts, socks, jackets, outer wear, leisure wear, bicycling gloves, T-shirts, hats and caps". If the Opponent does not succeed with respect to its pleading that there is a likelihood of confusion between the Mark and this registration, it would not succeed with respect to the TREK & Design trademark pleaded in the statement of opposition.

### Test for confusion

[12] In determining whether two trademarks are confusing, all the surrounding circumstances should be considered, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks, including in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 at para 54; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 49 CPR (4th) 401]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

[13] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the applicant's mark, at a time when he or she has no more than an imperfect recollection of the opponent's trademark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot, supra*, at para 20].

### Inherent distinctiveness of the trademarks and the extent to which they have become known

[14] The inherent distinctiveness of the Opponent's trademark is somewhat limited in association with the Opponent's bicycling apparel insofar as it might be considered suggestive of goods designed to withstand arduous biking trips. In this regard, I note that the Merriam-Webster Dictionary (at [merriam-webster.com](http://merriam-webster.com)) defines TREK, as a noun, to mean "a trip or movement especially when involving difficulties or complex organization: an arduous journey" [see *Tradall SA v Devil's Martini Inc*, 2011 TMOB 65 (CanLII) at para 29 which provides that the Registrar can take judicial notice of dictionary definitions]. The Applicant's Mark possesses a higher degree of inherent

distinctiveness because it is a coined word. I do not consider the stylized letters used to depict the Mark to significantly enhance its inherent distinctiveness [see *Canadian Jewish Review Ltd v The Registrar of Trade-marks* (1961), 37 CPR 89 (Ex Ct); and *John Labatt Ltd v Canada (Registrar of Trade Marks)* (1984), 79 CPR (2d) 110 (FCTD)].

[15] The strength of a trademark may be increased by means of it becoming known through promotion or use. The evidence of the Opponent given by Mr. Blais is that the Opponent is the largest manufacturer of bicycles in the world by market share. Since opening in 1975, its TREK product line has expanded from bicycles and bicycle parts to include a range of cycling and non-cycling specific products such as bags and apparel. These goods are sold online through the Opponent's website at [www.trekbikes.com/ca/en\\_CA](http://www.trekbikes.com/ca/en_CA) (the Opponent's website) and through a network of authorized dealers throughout Canada, consisting of independent cycle and sports shops and a few proprietary TREK stores (paras 11, 13). As of May 1, 2022, there were 242 authorized dealers of TREK goods in Canada, with at least one dealer in each Canadian province (para 15, Exhibits G1, G2).

[16] Screenshots of pages from the Opponent's website showing a representative sampling of its clothing and bags directed to Canadian consumers (with prices shown in Canadian currency) is attached at Exhibit E. I note that the Opponent's TREK trademark is prominently displayed on items including t-shirts, hoodies, jogging pants, bicycling gloves, socks and caps. While TREK is the Opponent's primary trademark and trade name, it also uses and owns other sub-brands, including BONTRAGER and ELECTRA, in association with bicycle accessories, helmets, apparel, bags and equipment. Products bearing the BONTRAGER and ELECTRA trademarks also bear the TREK trademark on product packaging or on hangtags affixed or attached to the product (paras 5, 12). In this regard, I note that there is no restriction against multiple trademarks being used together in association with the same product [*AW Allen Ltd v Warner Lambert Canada Inc* (1985), 6 CPR (3d) 270 at 272 (FCTD)].

[17] Exhibit F consists of photographs of a representative sampling of products sold in Canada bearing both the TREK and BONTRAGER trademarks, namely t-shirts, hats, jerseys, jackets, vests, balaclavas, backpacks, and seat packs (para 12). Exhibit G3 is described as a representative sampling of invoices (dated between the period May 2014 – April 2022) showing sales of TREK goods, largely apparel and bags (with specific clothing descriptors such as PANT, SHIRT, GLV, JKT (jacket), JSY (jersey) shown in acronyms on the invoices), to the Opponent's authorized dealers in Canada (para 15).

[18] Total sales of all goods associated with the TREK trademark in Canada for the years 2016-2022 (April 30) inclusive have exceeded CAD\$471 million. Annual sales of clothing bearing the TREK trademark or trade name have ranged from CAD \$1 million to \$1.5 million over the past five years, and annual sales of bags bearing the TREK trademark or trade name have ranged from CAD\$199,000 to CAD\$561,000 over the past five years (para 16).

[19] With respect to promotion and advertisement of the Opponent's TREK trademark, the Opponent has displayed various of its products including casual clothing, bags and backpacks on the Opponent's website. According to a Google Analytics printout (attached as Exhibit A2), during the period of April 1, 2021 to April 30, 2022, there were over 4.7 million visits to the Opponent's website from persons located in Canada with over 20.2 million page views (para 4). The Opponent also promotes the TREK trademark and trade name through the distribution and promotion of product catalogues and buyer guides; advertisements in both cyclist and non-cyclist focused magazines; social media namely Facebook and Twitter accounts, which feature over over 1.6 million followers and 238,000 followers, respectively, and; sponsorship of cycling teams, cyclists and race events. For the period of 2014 to 2019, the Opponent spent nearly USD\$4 million promoting Canadian cycling teams and cyclists (para 9).

[20] In the six-year period ending December 31, 2021, the Opponent's global advertisement expenditures for all manner of advertising of the TREK trademark and trade name has been in excess of USD\$280 million and has never been less than USD\$40 million annually. In the six-year period ending December 31, 2021, the

Opponent's Canadian advertising for all manner of advertising of the TREK trademark and trade name was over CAD\$3 million and grew from CAD\$116,000 in 2016 to over CAD\$1 million in 2019 (para 10).

[21] Notwithstanding that much of the evidence relating to the advertising and promotion of the Opponent's TREK trademark is not broken down to reflect specific product categories (e.g., bicycles, apparel, bags), I am satisfied that the Opponent's trademark has become known to at least some extent in Canada in association with apparel and bags. In contrast, there is no evidence to suggest that the Applicant's Mark has been used or become known at all in Canada.

[22] On balance, I find that the first factor, which is a combination of inherent and acquired distinctiveness, ultimately favours the Opponent.

#### Length of time the trademarks have been in use

[23] The evidence indicates that the Opponent's TREK trademark has been used by the Opponent in association with apparel and bags since at least 2017 (based on sales information for these goods). The Applicant did not file any evidence to demonstrate that use of its Mark had commenced in Canada. Therefore, this factor also favours the Opponent.

#### Nature of the goods, services or business; and the nature of the trade

[24] It is the Applicant's statement of goods as defined in the Application versus the Opponent's registered goods that governs my determination of this factor [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 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. The evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)].

[25] The Opponent's registration for the trademark TREK covers "[B]icycling apparel, namely, jerseys, shorts, socks, jackets, outer wear, leisure wear, bicycling gloves, T-shirts, hats and caps". The Application for the Mark includes a number of items of apparel, which are not restricted to bicycling, that overlap with the goods in the Opponent's registration, namely casual clothing, gloves, hats, and waterproof jackets. Most of the remaining goods listed in the Application are somewhat related to the Opponent's listed goods insofar as they are also clothing or clothing accessory items.

[26] Considering the overlap or connection between the nature of the parties' goods and in the absence of evidence to the contrary, I consider it reasonable to conclude that the parties' goods could travel through the same channels of trade [*Atlantic Promotions Inc v Warimex Waren-Import Export Handels GmbH* 2016 TMOB 179 (TMOB) at paras 44-46].

#### Degree of resemblance

[27] When considering the degree of resemblance, it is preferable to start by considering whether there is an aspect of the trademark that is particularly striking or unique [*Masterpiece, supra*, at para 64].

[28] The Opponent submits that the Applicant's Mark "bears no distinguishing visual element, and the literal element appropriates the whole of the Opponent's distinctive trademark and trade name". The Opponent further submits that the addition of the prefix AZ to the Mark only further adds to the likelihood of confusion since "the Applicant's Mark is sounded as "AS TREK" thus reinforcing the connection to the Opponent's trademark and trade name".

[29] In my view, the striking element of the Opponent's trademark, indeed its only element, is the word TREK, while the striking aspect of the Applicant's Mark is the coined term AZTREK. As the Applicant's Mark incorporates the Opponent's mark in its entirety, I find there to be a meaningful degree of resemblance between the parties' marks. While the prefix AZ- in the Applicant's Mark provides a different sound and appearance, the Applicant's Mark nonetheless contains the Opponent's mark resulting in some overall similarity in sound and appearance. With respect to ideas suggested, I

am of the view that the Applicant's Mark would likely not be understood to suggest being as or like the Opponent's TREK trademark. Rather, it would more likely be seen as a coined term, thus holding no similarity in ideas suggested with the Opponent's mark.

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

[30] Having considered all of the surrounding circumstances, in particular the degree of similarity between the marks in sound and appearance, the extent to which the Opponent's trademark has become known, and the overlap in the parties' goods and corresponding potential for overlap in the channels of trade, I find that at best for the Applicant, the probability of confusion between the Mark and the Opponent's TREK trademark is evenly balanced between a finding of confusion and no confusion. As the onus is on the Applicant to demonstrate on a balance of probabilities that there is no reasonable likelihood of confusion between the marks, I must therefore find against the Applicant.

[31] Accordingly, the section 12(1)(d) ground is successful.

***Section 16(1)(a) ground of opposition***

[32] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark because it is confusing with the Opponent's TREK trademark that had been previously used in Canada by the Opponent in association with clothing, footwear, backpacks, trunk bags, tote bags, messenger bags, all-purpose sport bags and all purpose bags, and was not abandoned on the day on which the Application was advertised.

[33] The Opponent has met its initial evidential burden by way of its evidence showing use of its TREK trademark since prior to the material date for this ground of opposition, namely April 3, 2019 (the date of filing of the Application).

[34] In my view, the earlier material date for this ground of opposition does not alter to any meaningful degree the confusion analysis for the section 12(1)(d) ground of opposition set out above. Thus, the Applicant has not met its legal burden to

demonstrate no likelihood of confusion as of the material date for this non-entitlement ground, and the section 16(1)(a) ground of opposition is also successful.

***Remaining grounds of opposition***

[35] As the Opponent has already succeeded under two grounds of opposition, it is not necessary to address the remaining grounds of opposition.

**DISPOSITION**

[36] In view of the above, 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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Jennifer Galeano  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** No hearing held

## **AGENTS OF RECORD**

**For the Opponent:** Cassan Maclean IP Agency Inc.

**For the Applicant:** No agent appointed