



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 012

Date of Decision: 2024-01-23

IN THE MATTER OF AN OPPOSITION

Opponent: G6 Hospitality IP LLC

Applicant: Sandals Resorts International 2000 Inc.

Application: 1919702 for THE WORLD'S ONLY SIX STAR LUXURY INCLUDED
VACATION & Design

INTRODUCTION

[1] Sandals Resorts International 2000 Inc. (the Applicant) has applied to register the trademark shown below (the Applied-for Mark):



[2] The Applicant seeks registration in connection with a broad range of goods and services related to travel and hotel accommodation. A complete list of these goods and services (the Applied-for Goods and Services) is included in Schedule A to this decision.

[3] G6 Hospitality IP LLC (the Opponent) owns several registered trademarks (the Opponent's Registered Marks), unregistered trademarks (the Opponent's Unregistered Marks, and collectively, the Opponent's Marks), and trade names (the Opponent's Trade Names) that consist of or include the numeral 6. The most significant example of the Opponent's Marks is the numeral 6, which is registered. Other examples of the Opponent's Marks include MOTEL 6, HOTEL 6, and STUDIO 6. The Opponent's Marks and the Opponent's Trade Names are listed in Schedule B to this decision. The Opponent asserts that it uses the Opponent's Marks and the Opponent's Trade Names in Canada in association with various services related to motel and hotel accommodation (the Opponent's Services).

[4] The Opponent opposes the registration of the Applied-for Mark on several grounds. Each of these grounds ultimately turns on the question of whether the Applied-for Mark is confusing, within the meaning of section 6 of the *Trademarks Act* (the Act), with the Opponent's trademark 6, or any of the other Opponent's Marks and Opponent's Trade Names.

[5] For the following reasons, I find that the Applied-for Mark is not confusing with any of the Opponent's Marks or the Opponent's Trade Names. The opposition is therefore rejected.

THE RECORD

[6] The Applicant filed its application on September 12, 2018. The Applicant claimed a priority filing date of September 10, 2018, pursuant to section 34(1) of the Act.

[7] The application was advertised for opposition purposes on November 24, 2021, and a statement of opposition was filed on May 20, 2022, pursuant to section 38(1) of the Act. A counterstatement was filed and served on July 11, 2022.

[8] In support of the opposition, the Opponent filed and served the affidavits of Adam Cannon, dated November 14, 2022 (the Cannon Affidavit), and Susan Trimble, dated November 1, 2022. The Applicant did not cross-examine either of the Opponent's affiants, and did not file any evidence in support of the application.

[9] Both parties filed and served written representations. No oral hearing was held.

Evidence

[10] Mr. Cannon is the Chief Brand Officer of the Opponent. He describes the Opponent's business in Canada as operating, via a master franchisee, a series of MOTEL 6 or STUDIO 6 motels [Cannon Affidavit, para 11].

[11] Mr. Cannon provides a list of the Opponent's Marks [para 7], and a description of the services in association with which the Opponent's Marks are used in Canada [paras 8-10]. Mr. Cannon also describes how the Opponent's Marks are associated with its services [para 12], and provides numerous examples such as images of the Opponent's MOTEL 6 locations in Canada and print outs of social media posts [paras 13-14, and Exhibit A].

[12] Ms. Trimble is a legal assistant employed by the Opponent's trademark agents. Her affidavit provides certified copies of the Opponent's Registered Marks.

GROUND OF OPPOSITION

[13] The Opponent's grounds of opposition can be summarized as follows:

- The Non-registrability Ground: the Applied-for Mark is not registrable under section 12(1)(d) of the Act because it is confusing with one or more of the Opponent's Registered Marks;
- The Non-entitlement Grounds: the Applicant is not the person entitled to registration of the Applied-for Mark because that trademark was confusing with one or more of the Opponent's Unregistered Marks, or one or more of the Opponent's Trade

Names, none of which had been abandoned as of the date of advertisement of the application; and

- The Non-distinctiveness Ground: the Applied-for Mark is not distinctive of the Applicant because it does not distinguish, nor is it adapted to distinguish, the Applicant's goods and services from the goods, services and business of the Opponent, in view of the registration, use and promotion by the Opponent and its predecessors of the Opponent's Marks and Trade Names.

[14] For each ground of opposition, there is an initial evidential burden on the Opponent to adduce evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition are true. If this initial burden is met, then the Applicant bears the legal onus of satisfying the Registrar that, on a balance of probabilities, the ground of opposition should not prevent registration of the Mark [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)].

NON-REGISTRABILITY GROUND

[15] Since the registrations for each of the Opponent's Registered Marks are in good standing, the Opponent meets its initial evidential burden in respect of the Non-registrability Ground. Accordingly, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the Applied-for Mark is not confusing with any of the Opponent's Registered Marks. The material date for assessing confusion under this ground is the date of this decision [*Simmons Ltd v A to Z Comfort Beddings Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[16] I will focus my analysis on confusion with the Opponent's registered trademark 6 (registration No. TMA359639), since the Opponent's representations appear to focus primarily on confusion with this trademark [see e.g. Opponent's written representations, at paras 18(a) and 46)]. As well, in my view the trademark 6 represents the Opponent's strongest case, since it is included in the Applied-for Mark in its entirety, and does not include any other elements that differentiate it from the Applied-for Mark. If the Applied-

for Mark is not confusing with the Opponent's trademark 6, it will not be confusing with any of other Opponent's Registered Marks.

Test for Confusion

[17] The use of a trademark will cause confusion with another trademark if the use of both in the same area would be likely to lead to the inference that the goods or services associated with the trademarks are manufactured, sold, leased, hired or performed (as the case may be) by the same person [section 6(2) of the Act]. The test for confusion is not about confusion of the trademarks or trade names themselves. Rather, it is about confusion as to the source of goods or services.

[18] The question of confusion is a matter of first impression in the mind of a casual consumer somewhat in a hurry, who sees the applied-for trademark at a time when they have no more than an imperfect recollection of the opponent's trademark. This casual, hurried consumer does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the trademarks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[19] Applying the test for confusion is an exercise in finding facts and drawing inferences [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 102]. All surrounding circumstances of the case must be considered, including those listed at section 6(5) of the Act, namely:

- 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, 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.

Degree of Resemblance

[20] Despite being the last factor listed in section 6(5) of the Act, the degree of resemblance is the factor that often has the greatest impact on the confusion analysis. Other factors become significant only once the trademarks at issue are found to be identical or very similar [*Masterpiece* at para 49].

[21] When considering the degree of resemblance, the trademarks must be considered in their entirety as a matter of first impression. They must not be carefully analyzed and dissected into their component parts [*Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD)]. That being said, the preferable approach is to consider whether there is an aspect of each trademark that is particularly striking or unique [*Masterpiece* at para 64].

[22] I agree with the Applicant's submission (at paragraph 33 of its written representations) that, in terms of prominence and location, the words 'SIX STAR' and the numeral six and star design are the most prominent and striking aspect of the Applied-for Mark. While this aspect of the Applied-for Mark includes the Opponent's trademark 6, which necessarily gives rise to some resemblance between the trademarks, the addition of the word 'STAR' and the star design substantially changes the appearance and sound of this aspect of the Applied-for Mark. The addition of these elements also causes the Applied-for Mark to suggest the idea of "six stars", which I consider to be a substantial departure from the simple idea of the number 6, suggested by the Opponent's trademark 6. Furthermore, the differences between the trademarks become more pronounced when the Applied-for Mark is considered as a whole, relative to the Opponent's trademark 6. Nothing about the remaining elements of the Applied-for Mark bear any resemblance to the numeral 6, in appearance, sound, or ideas suggested.

[23] Overall, I consider the degree of resemblance between the trademarks in terms of appearance, sound, and ideas suggested, to be fairly low, although not absent entirely. I consider this factor to favour the Applicant.

Inherent Distinctiveness, and Extent Known

[24] Trademarks are inherently distinctive when nothing about them refers the consumer to a multitude of sources. Where a trademark may refer to many things, or is only descriptive of the goods or services at issue, less protection will be afforded the mark [*United Artists Pictures Inc v Pink Panther Beauty Corp*, 1998 CanLII 9052 (FCA), [1998] 3 FC 534, at para 23]. A greater degree of discrimination may fairly be expected from the public in respect of such trademarks, such that even relatively small differences may suffice to avert confusion [*General Motors Corp v Bellows*, 1949 CanLII 47 (SCC), [1949] SCR 678].

[25] I consider the Opponent's trademark 6 to have no meaningful degree of inherent distinctiveness. The trademark is quite literally the numeral 6, which could refer to essentially anything. As for the Applied-for Mark, I consider it to be somewhat more inherently distinctive than the Opponent's trademark 6, on account of the 'six star' design element included therein. This element has at least some degree of originality, since stars or other characters are not ordinarily placed in the circle formed in the numeral '6'.

[26] Where a trademark does not have inherent distinctiveness it may be said to acquire distinctiveness when it becomes known to the consuming public, for example, through use or promotion of the trademark in the marketplace [see, e.g., *Mondo Foods Co Ltd v TorreMondo Industries Inc*, 2022 FC 926, at para 24].

[27] I am satisfied that the Opponent's trademark 6 has become known to Canadian consumers to a fair extent, in association with the Opponent's motels in Canada, based on the following evidence provided in the Cannon Affidavit:

- the trademark 6 has been used in Canada continuously since 1966, in association with the operation of motels and hotels, motel and hotel reservation services, business and hotel management services, hotel administration services, and advertising travel and hotel accommodations for others [para 8];
- the Opponent's first Canadian motel opened in 2000 [para 8];

- as of the date of Mr. Cannon's affidavit, the Opponent has 36 motels operating in locations across Canada [para 11];
- the Opponent's trademark 6 is displayed prominently on exterior signage at the Opponent's motels in Canada [para 13]; and
- the Opponent's trademark 6 is prominently displayed in advertising on the Opponent's website *www.motel6.com*, and on advertising appearing on Facebook and YouTube. The Opponent's website receives hundreds of thousands of annual visits from Canadian online visitors [para 14 and Exhibit A].

[28] In my view, the foregoing supports the conclusion that the Opponent's trademark 6 has become known to Canadian consumers, to a fair extent. While the evidence does not establish exactly how or to what extent the Opponent was using its trademark 6 in Canada since 1966, the evidence does establish that the Opponent has operated motels in Canada since 2000, and now has what I consider to be a substantial number of locations across Canada, prominently displaying the trademark 6. As well, while there is no evidence of the number of Canadians that have used the Opponent's Services, the evidence does establish that the trademark 6 has been used in advertising on social media, and on a website that receives hundreds of thousands of visits annually from Canadians. In my view, it is reasonable to infer from the foregoing that the Opponent's trademark 6 has been encountered by, and is known to a reasonably substantial number of Canadian consumers. Accordingly the Opponent's trademark 6 can be said to have become known to a fair extent in Canada, though not a great extent.

[29] In any event, the Opponent's trademark 6 can be said to have become known to a greater extent than the Applied-for Mark. In the absence of evidence of use, or other evidence that would suggest the Applied-for Mark has become known in Canada, there is no basis on which to conclude that the Applied-for Mark has become known in Canada to any extent.

[30] In view of the foregoing, I consider this factor to favour the Opponent. While the Opponent's trademark 6 lacks any meaningful degree of inherent distinctiveness, it has

acquired a fair degree of distinctiveness on account of becoming known to consumers in Canada, to a fair extent. As a result, I consider the Opponent's trademark 6 to be somewhat more distinctive than the Applied-for Mark.

Length of Time in Use

[31] As discussed above, the evidence shows that the Opponent has used the trademark 6 in Canada since at least 2000, when the Opponent's first motel opened in Canada. There is also evidence that the trademark 6 has been used continuously in Canada since 1966, although the evidence does not show how, or to what extent the trademark was used since this time. In any event, in the absence of evidence of any use of the Applied-for Mark in Canada, this factor favours the Opponent.

Nature of Goods, Services or Business, and Nature of the Trade

[32] I agree with the Opponent's submissions (at paragraph 31 of its written representations) that the Applied-for Goods and Services either directly overlap with the Opponent's Services, or are related in that one would generally expect them to be provided by a hotel or motel. Furthermore, since the parties' goods and services either overlap or are related in this manner, it is reasonable to infer that the parties' goods and services will likely travel in similar channels of trade.

[33] The Applicant argues that these factors favour its position, because the Opponent's business is the provision of inexpensive, economy lodging, whereas the Applied-for Goods and Services can be expected to be considerably more expensive in comparison [Applicant's written representations, at paras 63-64]. The Applicant also argues that there would be no cross-over between the Applied-for Goods and Services, and the Opponent's Services because of the differences in cost [para 70]. The Applicant's arguments in this regard are for the most part unsupported by the evidence. Even if they were supported by the evidence, it is the goods and services as stated in the application and Opponent's registration that govern [*Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CanLII 8953 (FCA)], and neither the Opponent's Services nor the Applied-for Goods and Services are limited to low-cost or high-cost services, respectively.

[34] In view of the foregoing, these factors favour the Opponent.

Conclusion regarding confusion

[35] Having considered all of the surrounding circumstances, including each of the factors stated in section 6(5) of the Act, I conclude that the likelihood of confusion between the Opponent's trademark 6 and the Applied-for Mark is somewhat less than even. As stated above, the degree of resemblance between the trademarks is the statutory factor that often has the greatest impact on the confusion analysis. I consider this to be such a case where the degree of resemblance has the greatest impact. Given the low degree of resemblance between the trademarks in appearance, sound, and ideas suggested, I am satisfied that confusion is not likely, despite the factors that favour the Opponent. Accordingly, I am satisfied that the Applicant has met its onus in respect of the Opponent's trademark 6.

[36] In respect of the remaining Opponent's Registered Marks, as stated above I consider the trademark 6 to represent the Opponent's strongest case, since that trademark is included in the Applied-for Mark in its entirety, and does not include any other elements that could differentiate it from the Applied-for Mark. Since the likelihood of confusion with the trademark 6 is somewhat less than even, then at best for the Opponent, the likelihood of confusion with the other Opponent's Registered Marks is also somewhat less than even. Accordingly, I am satisfied that the Applicant has met its onus in respect of the other Opponent's Registered Marks as well.

[37] In view of the foregoing, the Non-registrability Ground is rejected.

NON-ENTITLEMENT GROUNDS

[38] In order to meet its initial burden in respect of these grounds, the Opponent must show that the Opponent's Unregistered Marks and the Opponent's Trade Names were used in Canada prior to the material date for these grounds of opposition, and that these trademarks and trade names had not been abandoned as of the date of advertisement of the application. The material date for these grounds is the priority filing date of the application, namely September 10, 2018, because there is no evidence that

the Applied-for Mark has been used in Canada [sections 16(1)(a) and 16(1)(c) of the Act].

[39] For the reasons stated above in respect of the extent to which the trademark 6 has become known, I am satisfied that the Opponent has met its initial burden in respect of that trademark. I am also satisfied that the Opponent has met its initial burden in respect of the remaining Opponent's Unregistered Marks, and the Opponent's Trade Names, based on Mr. Cannon's unchallenged, sworn assertion of use of these trademarks and trade names [Cannon Affidavit, para 12].

[40] I am also satisfied that the likelihood of confusion between the Applied-for Mark on the one hand, and the Opponent's Unregistered Marks and Opponent's Trade Names on the other hand, is somewhat less than even. I reach this conclusion for substantially the same reasons that are stated above in respect of the Non-registrability Ground. I do not find the differences in the evidence between the material dates for these grounds to be substantial, such that a different conclusion would be warranted. Accordingly, the Non-entitlement Grounds are rejected.

NON-DISTINCTIVENESS GROUND

[41] To meet its initial burden in respect of this ground, the Opponent must establish that, as of the material date for this ground of opposition, the Opponent's Marks had a reputation in Canada that was "substantial, significant or sufficient" to negate the established distinctiveness of the Applied-for Mark [*Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657 at para 34]. The material date for this ground of opposition is the filing date of the opposition, namely May 20, 2022 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185 at para 25].

[42] The Opponent argues that the Applied-for Mark is not adapted to distinguish the Applied-for Goods and Services from those of the Opponent, because the Applied-for Mark is confusing with the Opponent's trademark 6, and with one or more of the other Opponent's Marks [Opponent's written representations, para 47]. For the reasons stated above in respect of the Non-registrability Ground and the Non-entitlement Grounds, I disagree. I find on a balance of probabilities that the Applied-for Mark is not confusing

with any of the Opponent's Marks, as of the material date for this ground. I do not consider the evidence as of the material date for this ground to be substantially different, such that a different conclusion would be warranted. Accordingly, even if the Opponent has demonstrated a sufficient reputation to meet its initial burden in respect of this ground, I find that none of the Opponent's Marks negate the distinctiveness of the Applied-for Mark. The Non-distinctiveness Ground is therefore rejected.

DISPOSITION

[43] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Jaimie Bordman
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

The Applied-for Goods and Services

Goods

- (1) Souvenir catalogues; travel and vacation magazines; printed matter, namely, discount cards (other than encoded or magnetic); photographs; posters; stationery, namely, writing paper and envelopes; pens and pencils, adhesives material for stationery and for household use; paint brushes; printer's type; printing blocks; typewriters
- (2) Luggage tags
- (3) Clothing, namely, t-shirts, tank tops, hoodies, shorts, dresses, golf wear, beach wear, casual clothing, children's clothing; footwear, namely beach, casual, evening, exercise and children's footwear; headgear, namely baseball caps, hats, bathing caps, headbands

Services

- (1) Business and hotel management and hotel administration; advertising travel and hotel accommodations for others; operation and supervision of loyalty schemes and incentive schemes to promote the sale of the goods and services of others; Providing consumer product information relating to food or drink products, namely dissemination of advertising matter for others relating to food or drink products; discount loyalty card services, namely, administration of a discount program enabling participants to obtain discounts on goods and services for travel and leisure use of a discount membership card
- (2) Discount credit and debit card services
- (3) Passenger transport by air, ship, pleasure boat, rail, train and bus; arranging of cruises; arranging of travel tours and cruises; booking of seats for travel; reservations and booking of seats for travel; organisation of sightseeing tours; organisation, booking and arrangement of excursions, day trips and sightseeing tours for honeymoons; organisation, booking and arrangement of excursions, day trips and sightseeing tours for travellers; flower delivery; holiday and honeymoon

planning services, namely booking of seats for holiday travel and flights and provision of advice in relation to the aforesaid; holiday and honeymoon planning services, namely booking of excursions, day trips and sightseeing travel tours and provision of advice in relation to the aforesaid; provision of flowers and floral arrangements, namely flower and flower arrangement delivery

(4) Nightclub services

(5) Hotels, resort hotels, motels and guest house services; hotel reservation services; provision of conference and meeting facilities, namely conference rooms for social gatherings and meetings; restaurant, bar and cafe services; catering services; cafeteria services; catering services including the supply of celebratory cakes; provision of facilities for weddings and wedding receptions, namely rental of function rooms for wedding and wedding receptions; crèche and day-nursery facilities; reservation services for booking hotel accommodation and meals, namely take out meals from restaurants; bar services and bar, wine bar, snack bar, coffee bar services, hotel-in and check-out services; holiday and honeymoon planning services, namely booking of hotel accommodation and restaurants and provision of advice in relation to the aforesaid; childcare services, namely child care centres; provision of facilities for weddings and wedding receptions, namely rental of function rooms for weddings and wedding receptions

(6) Beauty salons; facials, namely facial treatment services; hydro-therapy; manicures and pedicures; massage; mud treatments, namely facial and body treatment services; spas; hairdressing services; hairdressing salons; beautician services

(7) Personal and social services rendered by others to meet the needs of individuals, namely, babysitting services, wedding ceremony planning services; arrangement of marriage ceremonies, planning and arranging of wedding ceremonies, namely preparation of wedding guest lists, invitations, wedding scripts and place settings, arranging and coordinating of wedding present lists, hire and provision of bridal or other occasion wear and jewellery, maid and valeting services

SCHEDULE B

The Opponent's Marks and the Opponent's Trade Names

The Opponent's Registered Marks

6	(TMA359639)
MOTEL 6	(TMA275651)
STUDIO 6	(TMA574604)
HOTEL6 Logo	(TMA1078366)
HOTEL6 Logo (Horizontal Logo)	(TMA1087877)
HOTEL 6 & Design	(TMA1059150)
HOTEL6 Logo (Vertical Logo)	(TMA1078365)
ESTUDIO6 Logo	(TMA1104928)
MOTEL 6 & Design	(TMA531493)
STUDIO 6 & Design	(TMA588233)
STUIDO 6 EXTENDED STAY & Design	(TMA588044)
MOTEL 6 & Design	(TMA542121)

The Opponent's Unregistered Marks

6	STUDIO 6
MOTEL 6	STUDIO 6 EXTENDED STAY
6 MOTEL	G6 HOSPITALITY
6 MOTEL + STUDIO	My6





The Opponent's Trade Names

Motel 6

G6 Hospitality

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Opponent: Osler, Hoskin & Harcourt LLP

For the Applicant: McMillan LLP