



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2024 TMOB 101

**Date of Decision:** 2024-05-29

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

**Opponent:** All Star C.V.

**Applicant:** Allstar Marketing Group, LLC

**Application:** 1,883,817 for ALLSTAR

## **INTRODUCTION**

[1] Allstar Marketing Group, LLC (the Applicant) applied to register the trademark ALLSTAR (the Mark) based on its proposed use in Canada. The services currently specified in the application are:

CI 35 Business management and administration in the field of online retail sales; Organization and administration, for third parties engaged in featuring a variety of household products and consumer products excluding footwear and apparel; Online and telephone ordering services in the nature of business management, organization and administration using media such as infomercials in the field of general consumer merchandise; Advertising, marketing and promotion services.

[2] All Star C.V. (the Opponent) opposes registration of the Mark pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The opposition is based on allegations of non-registrability, non-entitlement and

non-distinctiveness owing to the Opponent’s prior registration, use and promotion of its trademarks and trade names.

[3] The following registrations (Opponent’s Registered Trademarks) support the non-registrability ground:

Trademark	Registration No.	Goods
ALL STAR	TMA346,110	(1) Footwear, namely, athletic shoes. (2) Wearing apparel, namely, t-shirts and sweatshirts. (3) Clothing, namely, shirts and footwear, namely athletic shoes of rubber and fabric.
	TMA965,980	(1) Athletic footwear, sport shoes, basketball shoes, running shoes, court shoes, skateboarding shoes, casual footwear, sandals. (2) Athletic clothing; clothing, namely, T-shirts, shorts, tank tops, sweatsuits, vests, pants, jackets, swimwear, sweaters, jeans; and outerwear, namely, lined jackets, insulated snow mobile suits and nylon jackets. (3) Clothing namely, t-shirts. (4) Clothing, namely, T-shirts, shorts, tank tops, sweatsuits, vests, pants, jackets, swimwear, sweaters, jeans; and outerwear, namely, lined jackets, insulated snow mobile suits and nylon jackets. (5) Shoes.
	TMA267,998	(1) Sportswear, namely sports shirts, racquet shirts, polo shirts and T-shirts.
	TMA966,016	(1) Athletic footwear, sport shoes, basketball shoes, running shoes, skateboarding shoes, casual footwear. (2) Shirts, t-shirts, tank tops, shorts, crop tops, sweat shirts, work out pants, athletic clothing; headwear, namely caps and visors.
	TMA158,420	(1) Canvas-topped, rubber-soled athletic shoes. (2) Footwear namely, athletic and casual shoes and boots.

[4] In support of its non-entitlement ground, the Opponent relies on prior use of the Opponent's Registered Trademarks, along with the trademark CONVERSE ALL STAR shown below, all in association with the following goods and services:



(i) goods including casual clothing, athletic clothing, headwear, footwear, athletic footwear, bags, fashion accessories, bags, eyewear;

(ii) services including online retail store services; business management and administration in the field of online retail sales; operation of a website to promote brand awareness, boost merchandise sales, announce product launches and provide product information in the field of clothing, footwear, bags and fashion accessories; promoting brand awareness, announcing product launches and providing product information in the field of clothing, footwear, bags and fashion accessories; promoting brand awareness, announcing product launches and providing product information in the field of clothing, footwear, bags and fashion accessories through social media; providing information about merchandise and new products in the field of clothing, footwear, bags and fashion accessories to customers via the internet and by email advertising, marketing and promotion services; product development service.

[5] The Opponent also relies on the trade names All Star and All Star C.V. in support of the Opponent's non-entitlement ground.

[6] Both parties submitted written representations and were represented at a hearing.

[7] For the reasons that follow, the application is refused with respect to the following services:

Business management and administration in the field of online retail sales; Online and telephone ordering services in the nature of business management, organization and administration using media such as infomercials in the field of general consumer merchandise; Advertising, marketing and promotion services;

The opposition is, however rejected with respect to the services:

Organization and administration, for third parties engaged in featuring a variety of household products and consumer products

### ***Opponent's Evidence***

[8] The Opponent relied initially upon the affidavits of Mr. Per J. Enfield (First Enfield Affidavit) and Ms. Susan Trimble. It sought and was ultimately granted, leave to file a second affidavit of Mr. Enfield (Second Enfield Affidavit) containing more current sales figures.

#### First Enfield Affidavit

[9] Mr. Per J. Enfield is the Assistant General Counsel for Nike, Inc. and the Manager of the Opponent, a company he describes as a wholly owned subsidiary of Nike, Inc. He explains the Opponent owns Converse trademark property rights outside the US and Japan [First Enfield affidavit, paras 1 to 4]. He says that Converse Inc. is another wholly owned subsidiary of Nike, Inc. that is affiliated with the Opponent and collectively refers to both subsidiaries as "CONVERSE" [First Enfield affidavit, para 6].

[10] Notably, as explained in greater detail below, Mr. Enfield does not clarify whether any particular use of the Opponent's trademarks is by the Opponent or Converse, Inc., nor does he explain the extent to which any use by the latter enures to the former, for example, through proper licensing.

[11] Mr. Enfield attests that "CONVERSE" has manufactured and marketed high-end footwear for over one hundred years but does not distinguish

between manufacture and marketing by the Opponent or by Converse Inc. [First Enfield affidavit, para 8].

[12] He states that "CONVERSE" is the owner in Canada, the US and elsewhere of the trademark ALL STAR and variations thereof, including the Opponent's Registered Trademarks [First Enfield affidavit, para 9].

[13] Mr. Enfield provides historical information about the footwear branded with the Opponent's Registered Trademarks, reporting sales of more than a billion pairs worldwide since sales began in 1909 [First Enfield affidavit, para 10].

[14] Mr. Enfield provides catalogues and copies of website materials showing various examples of the Opponent's Registered Trademarks as they appear in catalogues dating back many years [First Enfield affidavit para 11 and Exhibit A]. The catalogues reference an entity whose identity Mr. Enfield does not discuss, namely Converse All Star Canada Inc., although Mr. Enfield refers to these as "CONVERSE" catalogues and web pages. It is unclear whether any sales or advertising associated with these materials is by the Opponent, or through licensing enures to the Opponent.

[15] He provides copies of articles, books, magazines and newspapers discussing the extensive reputation of the Opponent's Registered Trademarks. He includes photographs of celebrities wearing the branded products [First Enfield affidavit, paras 12 and 13 and Exhibits B and C]. He again references the collective term "CONVERSE" and is silent on whether or how the Opponent acquired the reputation.

[16] Mr. Enfield offers information about clothing sales, including a full line of athletic activewear available since 1983. It is not clear whether his references and the associated catalogues pertain to Canada or elsewhere. However, the catalogues show contact addresses in the United States [First

Enfield affidavit, para 14 and Exhibit D]. Again, he relies on the collective term referencing both the Opponent and Converse Inc.

[17] Mr. Enfield states that the trademark ALL STAR is currently in use by "CONVERSE", and that such use has been continuous in Canada since at least as early as 1940. He specifies that the trademark is displayed on boxes, labels, or hang tags as well as on other packaging and invoices and provides depictions showing the Opponent's Registered Trademarks [First Enfield affidavit, para 15 and Exhibit E]. The extent to which any such use is by the Opponent or by Converse Inc. is unclear.

[18] He provides worldwide and Canadian sales figures, with the latter ranging from 2004 to 2017. In addition, he attests that from 1984 to 1990, sales of goods bearing the Opponent's Registered Trademarks exceeded \$46,000,000 CAD. He states that for the years 2017 to "present," Canadian sales by "CONVERSE" of goods bearing "the subject trademark" exceeded twenty-five million US dollars per year [First Enfield affidavit, paras 16 and 17]. Mr. Enfield is not specific about whether the sales are by the Opponent or Converse Inc. or, indeed, what proportion of sales were associated with each of the Opponent's Registered Trademarks.

[19] Mr. Enfield describes the channels of trade through which the Opponent's goods are sold as including a range of national retail chains, including Sportchek, Foot Locker, Designer Shoe Warehouse, Softmoc, Hudson's Bay Company as well as local and independent shoe and sporting goods stores. He explains the Opponent's goods are also sold through catalogues and over the Internet [First Enfield affidavit, para 18].

[20] Mr. Enfield states that beyond the use of the Opponent's trademarks and its All Star and All Star C.V. trade names in association with the Opponent's goods, there has for many years been use of these trademarks

and trade names in association with a variety of services such as on-line retail sales and operation of a website [First Enfield affidavit, para 19 and Exhibit F (in respect of the claimed trademark use)]. He does not identify such use as being by or enuring to, the Opponent.

[21] The evidence does not show the use of the tradenames All Star or All Star C.V. While I note the materials in evidence include a few instances wherein the trade name Converse All Star Canada Inc. has been utilized, this trade name was not identified in support of the Opponent's section 16(1)(c) ground of opposition, and will therefore not be considered.

[22] Mr. Enfield provides worldwide promotional expenditures relating to the Opponent's Registered Trademarks dating back to 2004. He estimates that from 2009 to 2013, annual Canadian advertising and promotional expenses exceeded \$800,000USD, and that annual promotion has increased substantially since 2014 [First Enfield affidavit, para 20]. However, he claims such promotion has been by "CONVERSE" in respect of sales of "CONVERSE" ALL STAR clothing and footwear, rather than being by, or on behalf of the Opponent.

[23] Mr. Enfield provides information about print, digital and social media efforts surrounding the Opponent's Registered Trademarks [First Enfield affidavit, paras 21 and 22]. Again, the reference is to "CONVERSE" rather than the Opponent.

#### Trimble Affidavit

[24] Ms. Trimble's evidence comprises certified copies of the Opponent's Registered Trademarks [Trimble affidavit and Exhibits A to E].

## Second Enfield Affidavit

[25] In his second affidavit, Mr. Enfield specifies that his intention is to supplement and clarify information contained in the First Enfield Affidavit. He provides annual Canadian sales data from 2018 to 2022, with these sales ranging from almost eighteen million US dollars to more than forty million US dollars. These figures relate to ALL STAR branded clothing and footwear.

[26] Again, in respect of this second affidavit, Mr. Enfield defines the Opponent and Converse Inc. as affiliated companies and references them "jointly and severally" as "CONVERSE." He does not indicate whether the sales data correspond to sales by the Opponent or by Converse Inc., and if the latter, whether licensing resulted in use by Converse Inc. enuring to the Opponent.

### ***Applicant's Evidence***

[27] The Applicant relies on the affidavits of Ms. Jessica Rocha, a student, and Ms. Xinchun Wang, a patent trainee.

[28] Ms. Rocha's evidence comprises photos and screenshots taken during a "shopping expedition" involving Golden Goose boutique, Nordstrom, Holt Renfrew, Amazon.com, Ebay, Saks Off Fifth.com, Haven.com and SSence.com. She includes some screenshots of the Amazon.com site indicating shipment to Canada. The evidence includes depictions of running shoes which display a star, partial star or multiple star designs of various sorts [Rocha affidavit and Exhibits A to H].

[29] Ms. Wang puts into evidence a copy of the assignment from Converse Inc.(a Delaware Corp.) to the Opponent taken from the file wrapper pertaining to Canadian trademark registration No. TMA218,360 involving trademarks, including the Opponent's Registered Trademarks.

### ***Evidential Burden and Legal Onus***

[30] An applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, an opponent must first adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

### ***Reasons for decision***

#### ***Section 12(1)(d) Ground of Opposition***

[31] The Opponent pleads that pursuant to section 12(1)(d) of the Act, the Mark is not registrable because it is confusing with one or more of the Opponent's Registered Trademarks associated with a variety of footwear and clothing (the Opponent's Goods). I note that during the hearing, the Opponent, while explicitly stating it did not intend to withdraw the other grounds formally, focused its submissions exclusively on the registrability ground.

[32] I have exercised my discretion to check the Register and confirm that the Opponent's registrations remain extant [see *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. Consequently, the Applicant bears the legal onus of demonstrating on a balance of probabilities that there is no reasonable likelihood of confusion between the Mark and any of the Opponent's registered trademarks. I will focus my assessment primarily on the likelihood of confusion between the Mark and the Opponent's registration No. TMA346,110 for the trademark ALL STAR. The Opponent's case is strongest concerning this trademark as it is essentially identical to the Mark.

If the Opponent is not successful in relying on this trademark, then it will not succeed relying on its other registered trademarks.

### ***Confusion Analysis***

[33] 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 they have no more than an imperfect recollection of the opponent's trademark and who does not pause to give the matter detailed consideration, nor to examine closely the similarities and difference between marks [*Veuve Cliquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20]. When assessing the likelihood of confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in 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 each has 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. These enumerated factors are not exhaustive, and it is appropriate to give different weight to each circumstance in a context-specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54, *Veuve Cliquot, supra*, at para 21].

#### Inherent Distinctiveness and Extent to Which the Trademarks Have Become Known

[34] This section 6(5)(a) factor involves a consideration of both the inherent and the acquired distinctiveness of the parties' trademarks. Inherent distinctiveness refers to the originality or uniqueness of a trademark when considered in association with the goods or services. While unique or invented trademarks are recognized as deserving of extensive protection, descriptive, suggestive or laudatory terms are generally considered to do little to aid in distinction [*Puma SE v Caterpillar Inc*, 2023

FCA 4 at para 26]. Whether a trademark is distinctive is a question of fact that is determined by reference to the message it conveys to the casual consumer of the associated goods or services when the trademark is considered in its entirety as a matter of first impression [*Molson Breweries v John Labatt Ltd*, 2000 3 FCA 145 at para 61].

[35] The Applicant argues that according to the website *dictionary.com*, “all-star” means a player selected for an all-star team, adding “such as Chuck Taylor” [Applicant’s written representations, para 44]. While the Applicant’s evidence did not include this or any other dictionary definition, I may take judicial notice of dictionary definitions where the source is of indisputable accuracy [*R v Krymowski*, 2005 SCC 7 at para 22]. I note *The Canadian Oxford Dictionary*, 2 ed., defines an all-star as “a player chosen as among the finest in his or her league; a superstar”.

[36] The Applicant proceeds to argue that no person can have exclusive rights to generic terms to describe their goods or services to the detriment of other traders or manufacturers [Applicant’s written representations, para 44].

[37] The Opponent submits that to the extent the respective trademarks are identical, they possess the same degree of inherent distinctiveness and that the Opponent’s Trademarks with design components have a greater degree of inherent distinctiveness than the Mark [Opponent’s written representations, para 38]

[38] While possessing some limited degree of inherent distinctiveness, the message the Mark and ALL STAR convey to the casual consumer of the associated goods or services when the trademark is considered in its entirety as a matter of first impression is that these goods or services are aimed at

or appropriate for a “superstar”. As such, these trademarks are, minimally, tinged with suggestive or laudatory character.

[39] While I agree that design elements may add distinctiveness to a trademark, in the case of the Opponent’s Registered Trademarks these comprise stars and simple shapes and therefore add minimal, if any, distinctiveness. Overall, I find the Opponent’s ALL STAR trademark, and indeed any of its Registered Trademarks, to possess a fairly limited degree of inherent distinctiveness.

[40] The Mark also possesses limited inherent distinctiveness, if slightly less than the Opponent’s Trademarks, which include design components.

[41] Concerning acquired distinctiveness, the Opponent argues that since its trademarks have been used, advertised and promoted in Canada for more than 75 years, and because it established that its registered trademarks are very well-known in Canada, the degree of acquired distinctiveness clearly favours the Opponent [Opponent’s written representations, paras 39 and 40]. However, the Applicant argues this is not the case since the Opponent’s evidence points to ownership and use of the Opponent’s Registered Trademarks by separate entities. It submits that the Opponent has not established a single source for the associated goods and services. It adds that the Opponent has not provided evidence of appropriate licensing [Applicant’s written representations regarding the Opponent having met its initial burden, paras 34 to 41].

[42] The Applicant is correct, Mr. Enfield attests that the Opponent and Converse Inc. are wholly owned subsidiaries of Nike, Inc., and affiliated companies, and as noted above, proceeds to define both companies as “CONVERSE” [First Enfield affidavit, paras 3, 4 and 6].

[43] At the hearing, the Opponent explained that the problem with Mr. Enfield's evidence is attributable to the unintended result of his reliance on a defined term that included two entities. Indeed, this explanation is consistent with the statements in the Opponent's written representations, claiming all use of the Opponent's trademarks in Canada has been under circumstances in which the Opponent controls the character or quality of the goods produced and services performed [Opponent's written representations, para 10].

[44] I note there are three primary means through which a trademark owner can demonstrate the requisite control exists pursuant to section 50(1) of the Act. The first is by clearly attesting to such control. The second means is through evidence establishing control. Third, an owner may provide a copy of a license agreement that provides for the requisite control [*Empresa Cubana Del Tabaco Trading v Shapiro Cohen*, 2011 FC 102 at para 84, *aff'd* 2011 FCA 340].

[45] While the Opponent's intention in drafting the evidence might have been otherwise, upon a fair reading of the evidence, I must agree with the Applicant. Mr. Enfield does not clearly attest to control or provide other evidence that establishes such control. He is silent on licensing relationships and does not provide an agreement providing for the requisite control. The evidence, therefore, does not establish any particular use of the Opponent's Registered Trademarks by itself or through a licensee that might allow it to benefit from the deeming provision of section 50(1).

[46] While I note Mr. Enfield states that the companies are affiliated, a corporate relationship alone will not satisfy the requirements of section 50 of the Act [*MCI Communications Corp v MCI Multinet Communications Inc* (1995), 61 CPR (3d) 245 (TMOB)].

[47] During the hearing, the Opponent argued that certified copies of its registrations support the Opponent's claim to ownership of its registered trademarks and that it has therefore met its initial burden under the section 12(1)(d) ground. While that is correct, the evidence will not support the Opponent's claims that one or more of the Opponent's Registered Trademarks have become known to some extent through extensive use and advertising. As discussed above in the summary of Mr. Enfield's evidence, it is not clear the extent to which it was the Opponent or Converse Inc. which used or promoted the Registered Trademarks in Canada. Additionally, the evidence is not specific as to the extent to which any particular one or other of the Opponent's Registered Trademarks have been used. Therefore, I am unable to conclude that the Opponent's Registered Trademarks have acquired distinctiveness in Canada and as such this factor combining inherent and acquired distinctiveness does not favour either party to any appreciable extent.

#### Length of Time the Trademarks Have Been in Use

[48] The Opponent argues it enjoys substantial Canadian sales [First Enfield affidavit, para 17; Second Enfield Affidavit, para 5]. However, for the reasons noted above, the evidence does not permit a conclusion that the Opponent's Registered Trademarks have been used, advertised and promoted in Canada for many years, as argued by the Opponent. There is also no evidence of the use of the Mark in Canada. The claims to use all refer to "CONVERSE," which by definition includes both the Opponent and Converse Inc, without any indication that use by Converse enures to the Opponent. This factor, therefore, does not favour either party.

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

[49] When considering sections 6(5)(c) and (d) of the Act, it is the statement of goods and services in the application and the statement of

goods and services in an opponent's registration that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*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)]. These are to be interpreted holistically and read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades encompassed by the wording.

[50] While the full factual context must be considered, it is well-recognized that owing to the very nature of trademarks in respect of their role and function, the similarity in the goods and services will generally be an important consideration and will, under some circumstances carry greater weight than the other factors [*Mattel, supra*, at paras 71 to 73]. Additionally, what is at issue is not what commercial activities the Parties are currently involved in but what registration would authorize the Applicant to do [*Mattel, supra*, at para 53].

[51] The Opponent's ALL STAR trademark, and indeed all the Opponent's Registered Trademarks, cover a variety of footwear and clothing.

[52] Most of the Applicant's services are broadly defined (Broadly Defined Services). These include:

- Business management and administration in the field of online retail sales
- Online and telephone ordering services in the nature of business management, organization and administration using media such as infomercials in the field of general consumer merchandise
- Advertising, marketing and promotion services

[53] As noted above, shortly before the hearing, the Applicant amended its services specification, in part, to exclude footwear and apparel. This portion now reads "organization and administration, for third parties engaged in featuring a variety of household products and consumer products excluding footwear and apparel" (Narrowly Defined Services).

*Broadly Defined Services*

[54] I agree with the Opponent that overlap exists in respect of the Opponent's Goods and the Broadly Defined Services as no restriction precludes the Applicant's use of the Mark in association with these services as they relate to the sale of apparel and footwear.

[55] As noted by the Opponent at paragraph 45 of its written representations, the Applicant has filed no evidence that might provide the Registrar with a basis for distinguishing the parties' goods, services and businesses. I find this is the case, at least in respect of the Broadly Defined Services.

[56] I note section 6(2) of the Act contemplates the possibility of confusion even if products or services are not of the same general class. In the present case, a likelihood of confusion exists because the Applicant's Broadly Defined Services are not restricted to exclude services relating to apparel and footwear. While the application does not cover goods, a casual consumer somewhat in a hurry might associate the Applicant's services involving business management and administration in the field of online retail sales with the Opponent's Goods being similarly marked. The same is true for online and telephone ordering services in the nature of business management, organization and administration using media such as infomercials in the field of general consumer merchandise that could include clothing and footwear. The consumer mentioned above could also associate

advertising, marketing and promotion services pertaining to clothing and footwear with the Opponent's Goods.

[57] Since the Broadly Defined Services do not exclude footwear and apparel, they would authorize the Applicant's engagement in such services as they relate to the Opponent's Goods, and therefore, overlap exists.

*Narrowly Defined Services*

[58] My conclusion with respect to the Narrowly Defined Services is opposite. Because of the exclusionary wording, the Applicant is not authorized to use the Mark in association with organization and administration for third parties engaged in featuring various household products and consumer products in the nature of footwear or apparel. For this reason, overlap does not exist, and the same ordinary consumer would not presume the goods and services in question were offered by or associated with the same entity.

[59] In respect of the nature of the trade, neither party is restricted in the channels of trade through which their respective goods and services may be offered. The evidence suggests the Opponent's clothing and footwear is sold through national retail store chains, local and independent shoe and sporting goods stores, catalogues and the internet. I agree with the Opponent; there is no evidence before me from which I might conclude that the channels of trade utilized by the parties differ [Opponents written representations, para 47]. Therefore, in the absence of evidence to the contrary, and noting the wide scope of the channels of trade currently employed by the Opponent, I can assume that the channels of trade of the respective goods and services would overlap. This factor, therefore, favours the Opponent.

### Degree of Resemblance

[60] When considering the degree of resemblance between trademarks, they must be considered in their totality. It is not correct to lay the trademarks side by side and compare and observe similarities or differences among the elements or components of the trademarks [*Veuve Clicquot supra*, at para. 20]. The resemblance between the trademarks will often have the most significant effect on the confusion analysis [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 49].

[61] The parties' trademarks are, for all intents and purposes, identical in appearance, sound and idea suggested. The fact the Mark is one word while the Opponent's ALL STAR trademark comprises two words does not differentiate the parties' trademarks in any meaningful way. This factor, therefore, strongly favours the Opponent.

### **Conclusion**

[62] The Opponent need not prove that confusion is likely; instead, the Applicant must satisfy the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion. A legal onus on the Applicant means that if a determinate conclusion cannot be reached once all evidence has been considered, the issue must be decided against the Applicant.

[63] In respect of the Broadly Defined Services, having considered all surrounding circumstances, I find that at best for the Applicant the probabilities are evenly balanced between a finding of confusion between the Opponent's ALL STAR trademark and the Mark and a finding of no confusion. I reach this conclusion owing primarily to the importance of the degree of resemblance between the parties' essentially identical trademarks and the overlap in goods, services business and channels of trade. This is in spite of my not being persuaded that the Opponent has, itself or through licensed

use by Converse Inc., shown that it has used or acquired distinctiveness in its Registered Trademarks.

[64] In respect of the Narrowly Defined Services, having again considered all surrounding circumstances, I find that on balance the Applicant has satisfied me that there is no reasonable likelihood of confusion. I reach this conclusion owing primarily to the differences in the goods and services of the parties and the fact that the Opponent has not persuaded me that it has used, the ALL STAR trademark or indeed any of its Registered Trademarks, either itself or through use by a licensee that enured to it. Additionally, I am not satisfied that the ALL STAR trademark, or any other of the Opponent's Registered Trademarks has acquired distinctiveness. I reach this conclusion is despite the resemblance in the parties' trademarks and the potential overlap in the trade channels.

#### The Remaining Grounds of Opposition

[65] The Opponent pleads that the Applicant is not entitled to registration of the Mark under section 16 of the Act because, as of the material date, the Mark was confusing with the Opponent's previously used trademarks and trade names.

[66] The Opponent also pleads that the trademark is not distinctive of the Applicant because it does not distinguish, nor is it adapted to distinguish, the services of the Applicant from the goods, services and business of the Opponent in view of the registration and the extensive and longstanding use and promotion by the Opponent and its predecessors in title, of the registered and previously used trademarks and trade names relied on in respect of the registrability and entitlement grounds.

[67] The material date to assess the section 16 grounds of opposition is February 8, 2018, the filing date of the application or the date of first use of

the Mark in Canada, whichever is earlier. As the Applicant has not filed any reliable evidence of use of the Mark, the relevant material date under these grounds is the application's filing date. The material date regarding the distinctiveness ground is the statement of opposition filing date.

[68] For the section 16 grounds of opposition, there is an initial burden on the Opponent to show use or making known of its trademarks or trade names prior to February 8, 2018, the filing date of the application. The Opponent must also prove that it had not abandoned those trademarks or trade names as of the date of advertisement of the application, namely October 27, 2021. For the distinctiveness ground, the Opponent was required to show that as of the filing of the statement of opposition on April 27, 2022, at least one of its trademarks or tradenames was known to some extent, and the reputation of this trademark or tradename in Canada was substantial, significant or sufficient [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657].

[69] The Applicant argues that the Opponent has not discharged its initial onus in respect of these grounds because its evidence refers collectively to two entities as owners of the Opponent's trademarks [Applicant's written representations, para 15]. It submits that the facts and figures led as evidence refer to the Opponent and Converse, Inc. bundled together [Applicant's written representations, para 16]. It argues that use by Converse, Inc., does not amount to use by the Opponent given that they are separate entities and notes that it is Converse, Inc. who oversees refunds and acceptance of merchandise relying on terms of sale in evidence [Applicant's written representations, para 18 and First Enfield Affidavit, Exhibit D]. The Applicant submits that there is no evidence to suggest the Opponent had direct or indirect control as required by 50(1) of the Act,

relying on the findings of the Court in *Live Holdings, LLC v Oyen*, 2020 FCA para 15 [First Enfield affidavit, para 6 and Applicant's written representations, para 19].

[70] As discussed above in the context of the confusion analysis conducted in respect of the registrability ground, under the heading *Inherent Distinctiveness and Extent to Which the Trademarks Have Become Known*, I agree with the Applicant that the Opponent's evidence does not prove it has either used its trademarks or trade names itself or exerted the requisite control over use by others that would allow it to benefit from section 50(1).

[71] In addition I note any claims to use contained in the Opponent's registrations, for example in respect of the Opponent's registration No. TMA346,110 for ALL STAR, the statement that the trademark has been used in Canada since 1940, will not satisfy its evidential burden for the entitlement and distinctiveness grounds of opposition [*Rooxs, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 TMOB, rev'd on other grounds (2004) FC 341].

[72] Thus, concerning the non-entitlement and non-distinctiveness grounds of Opposition, the Opponent has failed to provide any admissible evidence establishing the use or reputation in Canada of its pleaded trademarks and trade names. The Opponent has also failed to provide evidence that one or more of its trademarks or trade names had become known sufficiently to negate the distinctiveness of the Mark. As such, I find that the Opponent has failed to meet its evidential burden in support of these grounds and reject them accordingly.

### **DISPOSITION**

[73] In light of the preceding reasoning and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to the services:

Business management and administration in the field of online retail sales;

Online and telephone ordering services in the nature of business management, organization and administration using media such as infomercials in the field of general consumer merchandise; Advertising, marketing and promotion services.

And I reject the opposition with respect to the remainder of the services namely:

Organization and administration, for third parties engaged in featuring a variety of household products and consumer products excluding footwear and apparel;

all pursuant to section 38(12) of the Act.

Coleen Morrison  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** 2024-03-25

## **APPEARANCES**

**For the Opponent:** Donna White

**For the Applicant:** Andrea Friedman-Rush

## **AGENTS OF RECORD**

**For the Opponent:** Osler, Hoskin & Harcourt LLP

**For the Applicant:** Blaney McMurtry LLP