



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 104

Date of Decision: 2024-05-30

IN THE MATTER OF OPPOSITION

Opponent: Id Software LLC

Applicant: 9380-0803 Québec inc.

Application: 1,909,482 for Rage of Empires

INTRODUCTION

[1] 9380-0803 Québec inc. (the Applicant) has applied to register the trademark Rage of Empires (the Mark), in association with board games.

[2] Id Software LLC (the Opponent) distributes the RAGE computer game. It opposes this application primarily on the basis that the Mark is confusing with its use and registration of the trademarks RAGE and Rage & Design shown below.



[3] For the reasons that follow, I refuse the application.

BACKGROUND

[4] The application was filed on July 16, 2018 and advertised for opposition in the *Trademarks Journal* on January 8, 2020. The Opponent opposed the application pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on October 28, 2020. The statement of opposition was amended during the course of the proceeding to add the Opponent's successor-in-title ZeniMax Media, Inc. as a joint opponent. As nothing turns on this, references to the Opponent from this point forward will refer to both ZeniMax Media, Inc. and Id Software LLC.

[5] The Opponent filed as its evidence the affidavits of John Griffin Leshner, its Secretary, and Elizabeth Dingman, a Reference Librarian employed by the Opponent's former trademark agent. The Applicant filed as its evidence the declarations of Omar Sadek, its Co-Founder, President, and Treasurer, and Sean Cohen, its Co-Founder, Co-Owner, Vice-President, Secretary and General Counsel. The Opponent filed the affidavit of Siobhan Doody, an articling student of the Opponent's agent, as its evidence in reply. Mr. Sadek and Mr. Cohen were cross-examined. Both parties filed written representations and attended a hearing.

EVIDENTIAL BURDEN AND LEGAL ONUS

[6] Before considering the grounds of opposition, it is necessary to review some of the requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[7] With respect to (i) above, there is an evidential burden on an opponent to support the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v The Molson Companies Limited*, 30 CPR (3d) 293 (FCTD) at 298. An evidential burden on an opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which the

opponent has met its evidential burden). A legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against an applicant.

GROUND OF OPPOSITION

Grounds of Opposition Based on Confusion

[8] The determinative issue for decision in this case is the sections 16, 12(1)(d) and 2 grounds of opposition which allege the Mark is confusing with the Opponent’s trademarks including its trademarks for RAGE and RAGE & Design.



The material dates to assess the issue of confusion are: (i) the date of filing the application (July 16, 2018) with respect to the entitlement ground as the Applicant has not provided evidence of use; (ii) the date of my decision with respect to the ground of opposition alleging that the Mark is not registrable; and (iii) the date of opposition (October 28, 2020) with respect to the ground of opposition alleging that the Mark is not distinctive [for a review of material dates in opposition proceedings see *American Assn of Retired Persons v Canadian Assn of Retired Persons* (1998), 84 CPR (3d) 198 (FCTD) at 206 - 208].

Opponent Meets its Evidential Burden for all Confusion Grounds

[9] The Opponent meets its evidential burden for all of the confusion grounds for the following reasons:

- (a) Section 12(1)(d) Ground of Opposition – I have exercised my discretion [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)] and confirm that the following registrations are extant:

TMA801,781	RAGE	(1) Computer software games, and computer software game programs for entertainment uses with user manuals sold as a unit
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TMA863,958	RAGE ANARCHY	(1) Computer game software for use with computers and video game consoles; downloadable computer game software offered via the Internet and wireless devices; computer and video game user instruction manuals; magazines, books, and pamphlets concerning video games; computer and video game strategy guides.
TMA863,957		(1) Computer game software for use with computers and video game consoles; downloadable computer game software offered via the Internet and wireless devices. (2) Computer game and video game user instruction manuals; magazines, books, and pamphlets concerning video games; computer game and video game strategy guides.
TMA1,037,474		(1) Mobile phones and mobile phone accessories namely wired headsets, wireless headsets, ear phones, hand free headsets, snap-on covers, leather cases for mobile phones and electronic devices, phone holders, phone straps, replacement front panels for mobile phones and portable speakers, mobile phone cases.

(b) Section 16(1)(a) Ground of Opposition – the Opponent’s evidence of the RAGE trademark on copies of the computer game sold in Canada is sufficient to meet its evidential burden (Leshar affidavit, para 34, Exhibits 7-9).

(c) Section 2 Ground of Opposition – the Opponent’s evidence of sales of over 52,000 RAGE computer games in 2019 (para 34) along with the evidence that RAGE computer games have been featured in third party publications such as *The Globe and Mail* and *Toronto Star* in Canada (Dingman affidavit, Exhibit A) is sufficient to meet its evidential burden in support of the non-distinctiveness ground of opposition. The Opponent has shown that as of October 28, 2020 its trademark RAGE was known to some extent in Canada and the reputation of this trademark 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), 48 CPR (4th) 427 (FC)].

[10] I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with any of the Opponent’s trademarks at any of the material dates. As the material dates do not appear to have a significant impact on my findings under section 6(5) in this case, I propose to deal with all three of the confusion grounds of opposition together. I will focus my analysis on the Opponent’s RAGE trademark as I consider it to represent the Opponent’s strongest case. That is, if the Opponent is not successful based on this trademark, then it will not be successful based on its other trademarks.

Test for confusion

[11] The test to determine the issue of confusion is set out in section 6(2) of the Act which stipulates that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely 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.

[12] Therefore, section 6(2) of the Act does not concern confusion of the trademarks themselves, but of the goods or services from one source as being from another.

Essentially, the question here is whether a consumer, with an imperfect recollection of

the Opponent's trademark RAGE, would think that the Applicant's RAGE OF EMPIRES brand board games emanate from, are sponsored by or approved by the Opponent.

[13] In applying the test for confusion, I must take into consideration all the relevant surrounding circumstances, including those listed 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 they 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. These criteria are not exhaustive and different weight will be given to each one in a context-specific assessment [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée, supra*]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 where the Supreme Court of Canada states at para 49 that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis.

Inherent Distinctiveness

[14] A trademark is inherently distinctive when nothing about it refers the consumer to a multitude of sources [*Compulife Software Inc v CompuOffice Software Inc*, 2001 FCT 559 at para 19]. As noted by Justice Bédard in *Philip Morris Products SA v Imperial Tobacco Canada Limited*, 2014 FC 1237, citing *Apotex Inc v Canada (Registrar of Trademarks)*, 2010 FCA 31, whether a trademark is distinctive is a question of fact that is determined by reference to the message that it conveys to the casual consumer of the goods or services in question when the trademark is considered in its entirety as a matter of first impression.

[15] The Opponent's word mark has a very limited degree of distinctiveness as RAGE suggests the subject of the Opponent's first-person shooter computer game i.e. a person with rage or in a rage (see Leshar affidavit, Exhibit 2 which describes the Opponent's game). The Opponent's RAGE design mark has a slightly higher degree of distinctiveness owing to its stylization. In contrast, the trademark RAGE OF EMPIRES has a higher degree of distinctiveness, albeit still limited, as this phrase has an unusual

construction. The Mark's distinctiveness is limited by the fact, that like the Opponent, the Mark describes aspects of the Applicant's proposed board game which includes medieval empires, the art of war and the potential frustration of game players (Sadek affidavit, para 12).

Extent Known and Length of Time in Use

[16] These factours favour the Opponent as the Applicant has not yet sold its RAGE OF EMPIRES board game (although it has been play-tested).

[17] The Opponent introduced its RAGE video game in Canada on a variety of platforms in 2011 (Leshar affidavit, para 10). It was available for purchase through the retailers GameStop, Best Buy, and Walmart and the online store Steam (Leshar affidavit, para 12). The trademark RAGE appears on the physical copies and on the Steam website (Leshar affidavit, Exhibits 7-9). With respect to the sales, advertising and marketing of the RAGE trademarks, the Opponent has had, under license, direct or indirect control over the character or quality of the goods and services, sold, advertised and marketed with the RAGE trademarks in Canada (Leshar affidavit, para 29). Sales of the RAGE video games ranged from 6,000 to 52,000 units between the years 2011-2019, although sales fell after with only 7000 units sold in 2021 (Leshar affidavit, para 34). In addition to the sales information, the Opponent has also evidenced that its RAGE computer game has gained a reputation in Canada through it being featured in a number of newspaper articles (Dingman affidavit, Exhibit A).

Nature of the Goods, Services and Trade

[18] The parties goods are both games albeit of different types: computer games vs board games. As such, while there is some amount of overlap in the nature of the goods as they are both in the gaming market, the risk of confusion is lessened as the parties' goods appeal to different sectors of the market.

[19] The Opponent's evidence that (i) its DOOM franchise of games was adapted into an authorized board game DOOM: The Boardgame (Leshar affidavit, para 16, Exhibit 3) and (ii) its RAGE video game has been adapted as a comic book series and novel

(Leshar affidavit, para 17, Exhibits 4-5) are not particularly persuasive as evidencing that there is significant overlap in the nature of the goods or trade as there is no evidence that Canadian consumers are familiar with any of these products.

Degree of Resemblance

[20] The degree of resemblance between the trademarks will often have the greatest effect on the confusion analysis. When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. The appropriate test is not a side by side comparison but an imperfect recollection in the mind of a consumer of an opponent's trademark [*Veuve Clicquot, supra* at para 20]. The preferable approach when comparing trademarks is to begin by determining whether there is an aspect of a trademark that is particularly striking or unique [see *Masterpiece* at para 64]. The Opponent's trademark RAGE is a single word; the Mark is a single unitary phrase with no particularly striking component.

[21] I do not find that the trademarks resemble each other to a significant degree in sound or idea suggested. In particular, the trademarks suggest different ideas – RAGE versus a war or uprising between empires.

[22] That being said, the trademarks RAGE and RAGE OF EMPIRES have a significant degree of visual resemblance as the Mark includes the entirety of the Opponent's word mark. This is further underscored by the fact that there are potential presentations of the Mark where the RAGE component could be emphasized. As set out in the Federal Court of Appeal's decision in *Pizzaiolo Restaurants Inc v Les Restaurants La Pizzaiolle Inc*, 2016 FCA 265, the Registrar should take into account that a word mark should be assessed with the understanding that future presentations could be used in any style, font or colour [see by analogy *Domaines Pinnacle Inc v Constellation Brands Inc*, 2016 FCA 302 and *Arterra Wines Canada, Inc v Diageo North America, Inc*, 2020 FC 508 at paras 62-63].

State of the Register and Marketplace Evidence

[23] The state of the Register and marketplace evidence does not favour the Applicant to any significant extent.

[24] Evidence concerning the state of the Register is relevant only to the extent that inferences may be drawn concerning the state of the marketplace [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FC)]. Furthermore, inferences concerning the state of the market may be drawn from this evidence only if a large number of relevant registrations are located [*Kellogg Salada Canada Inc v Maximum Nutrition Ltd*, 1992 CanLII 14792 (FCA)]. 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) are those that include the component at issue in a material way [*Sobeys West Inc v Schwan's IP, LLC*, 2015 TMOB 197]. The evidence of the parties in this case includes the following trademarks:

PRIMAL RAGE (TMA484,859)	Computer software for video games pre-recorded on read only memory; video game cartridges, video game computer discs, non-coin operated video games and parts therefor.
GOD EATER 2 RAGE BURST (TMA1,016,944)	Class 9: Computer games; Downloadable computer games; Computer video games downloaded via the internet; Video games. Class 41: Entertainment services, namely, providing a computer game that may be accessed network-wide by network users via mobile phones and computers; providing computer games via network between communications networks and computers

[25] Mr. Cohen also attaches exhibits showing board games including the component RAGE discussed on the website BoardGameGeek ranking website with some of these board games showing as available on *amazon.ca* and *amazon.com*. I do not find that

this evidence significantly assists the Applicant since the web pages do not establish the extent to which Canadian consumers are aware of the RAGE products identified in Mr. Cohen's searches. There is no evidence that any of these goods have been sold in Canada, purchased by Canadians or are otherwise known to Canadians [see *Sally Beauty International, Inc v ADA International Beauty Inc*, 2015 TMOB 38 at para 25 for a similar conclusion]. Therefore, I am unable to conclude that there is common use of the component RAGE such that I can infer that consumers are accustomed to distinguishing between trademarks including this component by paying more attention to the differences between them [*Advance Magazine Publishers Inc. v Farleyco Marketing Inc. Eyeglasses* 2009 FC 153 at para 78].

Design of the Board Game

[26] The appearance of the trademark RAGE OF EMPIRES in the design of the game (Sadek cross-examination) does not assist the Applicant significantly since what is granted by registration of a word mark is the right to display it using any font, design or feature that the owner chooses [*Masterpiece, supra* at para 55; *Pizzaiolo Restaurants, supra* at paras 26-33].

Reconciling Jurisprudence

[27] The Applicant points to a number of cases where the Registrar has permitted registration of a trademark sharing the same component as an opponent's trademark (Applicant's written argument, para 56). The Applicant points out that it is incumbent upon the Registrar, in rejecting an application, to reconcile the inconsistencies to some extent and not rely solely on the principle that each case must be decided on its own merits [*Canadian Parking Equipment Ltd. v Canada (Registrar of Trade Marks)* (1990), 34 CPR (3d) 154 (FCTD) at 161]. First, it is difficult to draw analogies between cases where the natures of the goods are very different than the present case. Second, here the state of the Register does not demonstrate a pattern of registrability for RAGE trademarks, the state of the marketplace does not allow me to draw an inference that Canadians are able to distinguish between the parties' marks, nor is there evidence of use of the Mark by the Applicant, nor an inference that can be drawn from a lack of

confusion. If any one of these circumstances had been present, the balance of probabilities may have well tipped in the Applicant's favour.

Conclusion

[28] The question posed by section 6(2) of the Act is whether customers purchasing board games in association with the Mark would believe that these goods are provided, authorized or licensed by the Opponent owing to one of its RAGE trademarks. I have assessed this as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Mark, at a time when he or she has no more than an imperfect recollection of either of the RAGE trademarks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[29] Having considered all of the surrounding circumstances, I find that the Applicant has failed to meet the legal onus on it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's RAGE trademark registration covering computer games. While the precise nature of the goods is different, I reach this conclusion based on the degree of resemblance between these trademarks and the fact that only the Opponent's RAGE trademark has become known in Canada. I acknowledge that suggestive trademarks are more likely to be able to co-exist; with a party adopting a weak trademark being held to accept some risk of confusion [*General Motors Corp v Bellows* (1949), 10 CPR 101 (SCC) at 115-116; *Mövenpick Holding AG v Exxon Mobil Corp*, 2010 TMOB 126, 2011 FC 1397, *aff'd* 2013 FCA 6; *Culinar Inc v National Importers* (2004), 2004 CanLII 71834 (TMOB)]. While the Opponent's trademark is not the sort of mark that is typically afforded a broad scope of protection, a narrow scope of protection is not the same as having no protection at all. Accordingly, the sections 16, 12(1)(d) and 2 grounds of opposition succeed.

Remaining Grounds of Opposition

[30] Having refused the application on the basis of the sections 12(1)(d), 16(1)(a) and distinctiveness grounds of opposition, it is unnecessary for me to consider the remaining grounds of opposition.

DISPOSITION

[31] In view of the above, and 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.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2024-01-15

APPEARANCES

For the Opponent: Mark L. Robbins

For the Applicant: Ismaël Coulibaly

AGENTS OF RECORD

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For the Applicant: Benoît & Côté Inc.