



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2016 TMOB 153**  
**Date of Decision: 2016-09-21**

**Parkinson Society Canada**

**Opponent**

**and**

**Parkinson Society Alberta**

**Applicant**

**1,625,387 for STEP 'N STRIDE**

**Application**

[1] On May 3, 2013 Parkinson Society Alberta (the Applicant) filed an application to register the trade-mark STEP 'N STRIDE (the Mark) based on the following:

1. Use in Canada since at least as early as January, 2013 in association with the goods “printed publications, namely, newsletters and brochures featuring information about fundraising events and services, programs and information about Parkinson’s disease”;
2. Use in Canada since at least as early as March, 2013 in association with the services “fundraising; providing a website featuring information about fundraising events and services, programs and information about Parkinson’s disease”; and
3. Proposed use in Canada in association with the goods “clothing, namely t-shirts, sweatshirts and jackets; headwear, namely, hats, caps, sun visors and toques; bags, namely backpacks, carry-all, cooler and sports; cloth towels; water bottles” and the services “conducting fundraising events to raise money to fund services, programs, and research related to Parkinson’s disease.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 19, 2014.

[3] On September 18, 2014, Parkinson Society Canada (the Opponent) filed a statement of opposition against the application. The grounds of opposition can be summarized as follows:

- The application does not comply with section 30(a) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) because the application does not contain a statement in ordinary commercial terms for all of the specific goods and services in association with which the Mark has been used and is proposed to be used.
- The application does not comply with section 30(b) of the Act because the Applicant has not used the Mark in association with the goods and services since the dates claimed.
- The application does not comply to the requirements of section 30(e) of the Act in that the Applicant used the Mark prior to the date of filing the application in association with the goods based on proposed use.
- The application does not comply with section 30(i) of the Act because the Applicant could not state that it was satisfied that it was entitled to use the Mark in association with the applied for goods and services, in view that the Applicant was aware of or should have been aware of each and all of the Opponent's trade-marks and trade-name that had been previously used or applied for by the Opponent, the particulars of which are set out in the attached Schedule A and the Opponent's previously used trade-names, namely Parkinson Society Canada, with which the Mark is confusing, and as such the application was filed with the intent to cause confusion with the Opponent's trade-marks and trade-name, and the Applicant could not have been satisfied that it was entitled to use or register the applied for trade-mark because such use is contrary to sections 7(b), 19, 20 and 22 of the Act.
- The Mark is not registrable pursuant to section 12(1)(b) because when depicted, written or sounded it is clearly descriptive of the character and quality of the associated goods and services in that the associated goods and services related to a walking event in which participants "step and stride".
- The Mark is not registrable pursuant to section 12(1)(d) of the Act because it is confusing with the Opponent's registered trade-marks set out in Schedule A.
- The Mark is not registrable pursuant to section 12(1)(e) of the Act because it is a mark of which the adoption is prohibited by section 9 in light of the following prohibited marks owned by the Opponent: 908,236 for the mark SUPERWALK FOR PARKINSON and 908,235 for the mark LA GRANDE RANDONNE POUR LE PARKINSON.
- The Applicant is not entitled to registration of the Mark pursuant to section 16(1)(a) of the Act because at the alleged date of first use, the Mark was

confusing with the Opponent's trade-marks that had been previously used or made known by the Opponent in Canada, the particulars of which are set out in Schedule A.

- The Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(b) in that at the date that the Applicant first used the Mark, the Mark was confusing with the Opponent's trade-marks that had been previously filed by the Opponent, the particulars of which are set out in Schedule A.
- The Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(c) in that at the date that the Applicant first used the Mark, the Mark was confusing with the Opponent's previously used trade-name, namely Parkinson Society Canada.
- The Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(a) in that at the date of filing the application, the trade-mark was confusing with the Opponent's trade-marks that had been previously used or made known by the Opponent, the particulars of which are set out in Schedule A.
- The Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(b) in that at the date of filing the application, the Mark was confusing with the Opponent's trade-marks that had been previously filed by the Opponent in Canada, the particulars of which are set out in Schedule A.
- The Applicant is not the person entitled to registration of the Mark in view of section 16(3)(c), in that at the date of filing of the application, the trade-mark was confusing with the Opponent's previously used trade-name, namely Parkinson Society Canada.
- Pursuant to section 2 of the Act, the Mark is not distinctive in that it will not distinguish and is not adapted to distinguish the goods and services in association with which it is used or proposed to be used from the goods and services of the Opponent, in light of the each and all of the Opponent's trade-marks and trade-names described above, previously used in association with a variety of clothing goods, promotional items and fundraising related services.

[4] On October 20, 2014, the Applicant requested an interlocutory ruling requesting that several of the Opponent's grounds of opposition be struck as the grounds were either improper or did not contain sufficient allegations of facts to enable the Applicant to reply.

[5] On December 1, 2014, the Opposition Board issued an interlocutory ruling, and granted the Opponent leave to file its amended statement of opposition. Schedule A to this decision

includes those marks relied upon by the Opponent as set out in Schedule A attached to the statement of opposition as amended.

[6] The Applicant served and filed a counter statement on December 31, 2014.

[7] The Opponent elected not to file any evidence. In support of its application, the Applicant filed the affidavits of John Petryshen, and Katherine Dedul, as well as a certified copy of the file history for the application. Neither Mr. Petryshen nor Ms. Dedul were cross-examined on their affidavits.

[8] Only the applicant filed a written argument. An oral hearing was not requested.

#### Onus and Material Dates

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[10] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30(a), (b), (e) and (i) - the date of filing the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)].
- sections 38(2)(b)/12(1)(b) – the date of filing of the application [see *Shell Canada Limited v P.T. Sari Incofood Corporation* (2005), 41 C.P.R. (4th) 250 (F.C.T.D.); *Fiesta Barbeques Limited v General Housewares Corporation* (2003), 28 CPR (4th) 60 (FCTD)].
- sections 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].
- sections 38(2)(b)/12(1)(e) - the date of my decision [see *Canadian Council of Professional Engineers v Groupegénie Inc* (2009), 78 CPR (4th) 126 (TMOB) and *Canadian Olympic Assn v Olympus Optical Co* (1991), 38 CPR (3d) 1 (FCA)].

- sections 38(2)(c)/16(1) - the claimed date of first use [see section 16(1) of the Act].
- sections 38(2)(c)/16(3) – the filing date of the application [see section 16(3) of the Act].
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

### Summary of the Applicant's Evidence

[11] Mr. Petryshen identifies himself as CEO of the Applicant. He explains that the Applicant first started fundraising in association with the Mark in March 2013. The fundraising event is an opportunity for participants to walk or run a designated route with fellow participants in order to raise funds for the Applicant. The event takes place in various cities in Alberta including Calgary, Cochrane, Edmonton, Grand Prairie, Lethbridge, Lloydminster, Medicine Hat and Red Deer. Since the first event occurred on September 7, 2013, it has raised considerable funds for Parkinson Alberta which provides services to people afflicted and/or affected by Parkinson disease and their family and friends. For example, the 2013 STEP 'N STRIDE event received donations in excess of \$280,000 and the 2014 STEP 'N STRIDE event received donations in excess of \$360,000.

[12] Mr. Petryshen states that the public has been made aware of the event by various ways including through a publication in the Summer 2013 issue of Parkinson Pulse (a quarterly publication issued by Parkinson Alberta), through a press release dated June 4, 2013, which was posted on the Applicant's website, as well as through sponsorship brochures, postcards and posters displayed in the cities where the event was to take place, in public places, and at shared support groups in 2013, 2014 and 2015.

[13] Ms. Dedul is employed as a legal assistant of the Applicant. Attached as Exhibit A to her affidavit are the results of searches she conducted of the goods and services manual located on CIPO's website for each of the goods and services currently designated in the present application.

## Grounds of opposition summarily dismissed

### *The section 16(1)(a)(c) and 16(3)(a)(c) non-entitlement grounds of opposition*

[14] The section 16(1)(a), 16(1)(c), 16(3)(a), and 16(3)(c) non-entitlement grounds of opposition can be summarily dismissed because the Opponent has failed to show that as of either the filing date of the Applicant's application or the Applicant's date of first use, one or more of the Opponent's word and/or design marks or trade-name had been previously used or made known in Canada and had not been abandoned as of the date of advertisement of the application [section 16(5) of the Act]. In fact, the Opponent did not file any supporting evidence or make any submissions with respect to any of these grounds of opposition. These grounds are accordingly dismissed.

### *The non-distinctiveness ground of opposition*

[15] The non-distinctiveness ground of opposition can be summarily dismissed because the Opponent has failed to show that as of the filing date of the statement of opposition, one or more of its word and/or design marks had a substantial, significant or sufficient reputation in Canada so as to negate the distinctiveness of the Mark [see *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. In fact, the Opponent did not file any supporting evidence or make any submissions with respect to this ground of opposition. This ground is accordingly dismissed.

### *The non-conformity grounds of opposition based on sections 30 of the Act*

[16] The section 30(a) ground alleges that the application does not contain a statement in ordinary commercial terms of the specific goods or services in association with which the Mark is proposed to be used or has been used. However, the Opponent has filed neither evidence nor argument in support of this allegation. I am therefore dismissing this ground of opposition on the basis that the Opponent has not met its evidential burden.

[17] The section 30(b) ground of opposition alleges that the Applicant had not used the Mark in association with the Goods and Services as of the dates claimed in the application (January, 2013 and March 2013 respectively). The section 30(e) ground alleges that the Applicant had

already used the Mark in association with the goods and services based on proposed use. As there is no evidence that supports either of these grounds of opposition, they are accordingly dismissed.

[18] The section 30(i) ground of opposition alleges in part that the Applicant could not have been satisfied that it was entitled to use the Mark because the Applicant must have been aware of each and all of the Opponent's previously used or applied for trade-marks and trade-name. Where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith [*Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As this application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, this part of the section 30(i) ground is dismissed.

[19] The section 30(i) ground of opposition further alleges that the Applicant could not have been satisfied it was entitled to use the Mark because such use would have been contrary to sections 7(b), 19, 20 and 22 of the Act. Neither the Registrar, nor the Federal Court has ruled on whether a section 30(i) ground of opposition based on the violation of any of these sections is a valid ground of opposition [*Parmalat Canada Inc v Sysco Corp* 2008 FC 1104 (CanLII), (2008), 69 CPR (4th) 349 (FC) at paras 38-42]. Even if I found this to be a valid ground of opposition, as there is no evidence or argument in support of this ground, the Opponent would have no chance of success. Accordingly, this part of the section 30(i) ground of opposition is also dismissed.

*The non-registrability ground based - section 12(1)(b)*

[20] The issue as to whether the Applicant's Mark is clearly descriptive must be considered from the point of view of the average purchaser of those wares as a matter of immediate impression. Character means a feature, trait or characteristic of the product and "clearly" means "easy to understand, self-evident or plain." [*Wool Bureau of Canada Ltd v Canada (Registrar of Trade Marks)* (1978), 40 CPR (2d) 25; *Atlantic Promotions Inc v Registrar of Trade Marks* (1984), 2 CPR (3d) 183; *Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29].

[21] The Opponent alleges that the Mark STEP ‘N STRIDE, when depicted, written or sounded is clearly descriptive of the character or quality of the associated goods and services in that the associated goods and services relate to a walking event in which participants “step and stride”. I do not consider this statement sufficient to meet the Opponent’s initial burden under this ground. As noted by the Applicant, if a person was instructed to “step and stride” during a fundraising event, it would not be immediately clear what action was required. The trade-mark as a whole is merely suggestive of movement, whether it be walking, jogging, skipping, riding, cross country skiing, rollerblading, etc., all of which involve taking a step or taking a stride.

[22] This ground is accordingly dismissed.

### Remaining Grounds of Opposition

#### *Non-registrability ground of opposition – section 12(1)(d) of the Act*

[23] An opponent’s evidential burden is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing as of the date of the opposition decision. The Registrar has discretion to check the register in order to confirm the existence of registrations relied upon by an opponent [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd.* (1986), 11 CPR (3d) 410 (TMOB)]. I have exercised this discretion and confirm that all of the Opponent’s registrations set out in Schedule A remain valid.

[24] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[25] In applying the test for 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 trade-marks 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 trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v 3894207 Canada Inc.* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc. v Alavida Lifestyles Inc.* (2011), 96 CPR (4th) 361 (SCC).]

[26] In *Masterpiece Inc.*, the Supreme Court of Canada discussed the importance of the section 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with section 6 of the Act (see para 49):

the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start... [Emphasis is mine]

The Supreme Court of Canada also advised in *Masterpiece* that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique [see *Masterpiece* at para 64].

[27] Under the circumstances of the present case, I consider it appropriate to analyze the degree of resemblance between the parties' marks first. I will focus my analysis on the Opponent's mark PARKINSON SUPERWALK, Registration No. TMA879,465, because I consider this mark to have a greater degree of resemblance to the Mark than any of the Opponent's other marks and therefore represents the Opponent's strongest case under this ground. If the Opponent is not successful based on this mark, then it will not be successful based on its other marks.

[28] Applying section 6(5)(e) to the instant case, I find that the overall visual impact of the Mark and the Opponent's mark to be quite different mostly because the dominant feature of the Mark are the words STEP 'N STRIDE whereas the most striking feature of the Opponent's mark is the word SUPERWALK.

[29] There is, however, some resemblance in the ideas suggested by the parties' marks. In this regard, the Mark, when considered in association with their respective goods and services,

suggests a fundraising physical activity for Parkinson's disease while the Opponent's mark suggests a fundraising walk for the same cause.

[30] With respect to the remaining factors under section 6(5), while I do not find the Mark to be inherently strong, I do find it to be inherently stronger than the Opponent's mark. In this regard, I do not find it as suggestive of the associated goods and services. The length of time the marks have been in use also favours the Applicant as it has shown use of the Mark in association with some of its services since as early as March 2013 while the Opponent has not provided any evidence of use of its mark.

[31] The nature of the parties' goods, services and trades are essentially the same, that is, both parties are involved in similar charitable activities or they are highly related and appear to target the same audience (i.e. those in the field of fundraising). There is therefore the potential for overlap between the parties' channels of trade.

[32] Having considered all of the surrounding circumstances, I find that the Applicant has established, on a balance of probabilities, that confusion is not likely between the Mark and the Opponent's mark. In view of the differences in the parties' marks themselves, the inherent weakness of the Opponent's mark, as well as the fact that the Opponent has not filed any evidence or argument in this proceeding, I find that the Applicant has established, on a balance of probabilities, that confusion is not likely between the Mark and the Opponent's mark. The section 12(1)(d) ground of opposition is accordingly rejected.

*Non-registrability ground of opposition – sections 12(1)(e) and 9(1)(n)(iii) of the Act*

[33] The Applicant submits that the Opponent has failed to provide any evidence to support the allegation that the Mark is confusing with any of the Opponent's official marks.

[34] However, the Applicant did not provide any evidence to challenge the adoption or use of any of the Opponent's official marks. It has been previously held that in the absence of evidence challenging the adoption and/or use of an official mark, there is no requirement on the Opponent to provide evidence of use and adoption of an official mark relied on in an opposition [see *Hope International Development Agency v Aga Khan Foundation Canada* (1996), 71 CPR (3d) 407 at

413 (TMOB) at 413 and *Canadian Olympic Assn v Allied Corp* (1989), 28 CPR (3d) 161 at 166]. I am therefore not prepared to question the Opponent's use and adoption of its official marks. As a result, the Opponent's official marks form the basis of the ground of opposition based on section 12(1)(e) and 9(1)(n)(iii) of the Act.

[35] The test under section 9(1)(n)(iii) is whether a person, on a first impression, knowing any of the Opponent's official marks and only having an imperfect recollection of any of them, would likely be deceived or confused by the Mark. This is not a test of straight comparison, and if, as is the case in the present opposition, the marks are not identical, then there must be consideration of whether the Mark so nearly resembles as to be likely to be mistaken for any of the Opponent's official marks. In assessing the degree of resemblance under section 9(1)(n)(iii), the test is not restricted to visual comparison. Regard may be had to the factors set out in section 6(5)(e) of the Act, namely the degree of resemblance between the marks in appearance, sound or in the ideas suggested by them [see *Techniquip Ltd v Canadian Olympic Assn* (1998), 80 CPR (3d) 225 at 230 (FCTD), aff'd 3 CPR (4th) 298 (FCA); *Big Sisters Assn of Ontario v Big Brothers of Canada* (1997), 86 CPR (3d) 504 (FCTD), and *Hope International, supra*].

[36] The test under section 9(1)(n)(iii) has a very high threshold for success and requires the Mark to be almost the same as at least one of the Opponent's official marks. The test under section 9(1)(n)(iii) differs from a standard confusion analysis such that in order to be successful there must be a likelihood that consumers will be mistaken as between the marks themselves not a likelihood that consumers will infer an association between the source of the goods or services.

[37] Under this ground, the Opponent has relied on its official marks PARKINSON SUPERWALK, application No. 908,236 and LA GRANDE RANDONNE POUR LE PARKINSON, application No. 908,235.

[38] As noted above, I find the words STEP 'N STRIDE to be the most striking elements of the Mark and the word SUPERWALK (or its French equivalent) to be the most striking element of the Opponent's official marks. While both parties' marks may suggest some kind of physical activity to support research for Parkinson's disease, in view of the visual and phonetic differences between the parties' marks, I am satisfied that the Applicant has met the onus on it to

establish that the Mark does not so nearly resemble either of the Opponent's official marks as to be mistaken therefore.

[39] Based on the foregoing, I reject the ground of opposition based on section 12(1)(e) and 9(1)(n)(iii) of the Act.

*Non-entitlement grounds of opposition – section 16(1)(b) and 16(3)(b) of the Act*

[40] In order to meet its initial burden under these grounds of opposition, the Opponent must show that, at either the Applicant's date of first use (under section 16(1)(b)) or the filing date of the application (under section 16(3)(b)), the Opponent had filed its applications and that such applications were pending when the Applicant's application was advertised, as required by section 16(4). Of those applications for which the Opponent has met its burden under one of these grounds in this case, the Opponent's strongest case again is with respect to application No. 1,618,140 for the mark PARKINSON SUPERWALK. If the Opponent is not successful based on this mark, then it will not be successful based on any of its other marks.

[41] For the most part, my conclusions above under the section 12(1)(d) ground also apply to these grounds of opposition. The only difference is that the Applicant had not shown use or making known of its Mark as of the earlier material dates. In my view, this is not enough to tip the balance of probabilities in favour of the Opponent. These grounds are accordingly rejected.

Disposition

[42] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

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Cindy R. Folz  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**No oral hearing was held.**

**AGENTS OF RECORD**



Gowling WLG (Canada) LLP

For the Opponent

Bennett Jones LLP

For the Applicant

**Schedule A**  
**Opponent's Trade-mark Applications and Registrations**

Trade-mark	Application No.	Registration No.
	1,214,598	TMA665,794
LA GRANDE RANDONNEE PARKINSON	1,618,141	TMA879470
	1,618,142	TMA879,471
PARKINSON SUPERWALK	1,618,140	TMA879,465
	1,618,143	TMA879,473
	1,214,600	TMA665,922