



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

Citation: 2016 TMOB 187
Date of Decision: 2016-12-13

IN THE MATTER OF AN OPPOSITION

Mitre Sports International Limited **Opponent**

and

Inaria International Inc. **Applicant**

1,530,921 for CHEVRON Design **Application**

FILE RECORD

[1] On June 8, 2011, Inaria International Inc. filed an application to register the trade-mark CHEVRON Design, shown below, based on proposed use in Canada by the applicant and through a licensee, in association with the goods and services listed below:



goods

sport equipment and accessories, namely, sport regulation cards, namely, referee cards, scorecards, flags, air pumps, cones, pylons, nets, namely, hockey nets, soccer nets; soccer pinnies; shin pads; sport socks; whistles; soccer goalie accessories, namely, soccer goalie gloves, shirts, pants and padding; athletic clothing; outerwear, namely, outerwear jackets, outdoor sports clothing;

casualwear; bags, namely, travel bags, sport bags, pouch bags, knapsacks, shoe bags, sport ball bags, and sport briefcases; sports-related uniforms and clothing; basketballs; volleyballs; footballs; soccer balls; sports first aid equipment, namely, supports, first aid kits; referee accessories, namely, whistles and bags; sport-referee tops and bottoms; heat transfer numbers; sew-on numbers; headwear, namely, hats, toques, bucket hats and visors; athletic footwear; soccer shoes.

services

screen and heat transfer printing services, and embroidery services; sublimation services; manufacturing services for others of sports-related equipment, accessories and uniforms, footwear, headgear, clothing, and clothing accessories; retail and online retail sale of sports-related equipment, accessories and uniforms, clothing, headwear, clothing accessories, footwear, first-aid kits, sports-related training equipment.

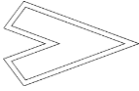
[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated May 16, 2012 and was opposed by Mitre Sports International Limited on October 16, 2012. Shortly after, on October 29, the opponent requested leave to submit an amended statement of opposition, which request was granted. The Registrar forwarded a copy of the amended statement of opposition to the applicant on November 8, 2012, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. Further references to the statement of opposition in this proceeding are to the revised statement of opposition. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[3] The opponent's evidence consists of the affidavit of Elenita Anastacio. The applicant's evidence consists of the affidavits of Dame Penney and Amy Dam, as well as a certified copy of the file wrapper for the subject application. The applicant's affiants were cross-examined on their written testimony. The transcripts of their cross-examinations, exhibits thereto and replies to undertakings form part of the evidence of record. Only the applicant filed a written argument, however, both parties attended an oral hearing.

STATEMENT OF OPPOSITION

Pleadings

[4] The opponent pleads that it is the owner of the registered marks shown below. I will refer to the marks by the nomenclature of their registrations namely, DELTA, DROP, M and V Design:



DELTA (arrowhead)
Design



DROP Design



M Design



V Design

[5] The opponent further pleads that its above referenced marks “collectively have use[sic] in Canada since at least as early as January 29, 1987.” In reviewing the registrations, I have noted that they cover a variety of goods including sports clothing, accessories and equipment.

[6] Of course, the DELTA and V Design marks may be viewed as variations of a chevron; the DROP Design mark incorporates a chevron; and the M Design mark may be viewed as two partially superimposed curvilinear chevrons.

[7] I have also noted that the opponent’s DELTA Design mark was just recently expunged, on October 14, 2016, for non-use.

Grounds of Opposition

[8] The grounds of opposition are pleaded as follows:

1(c) . . . the Applicant's mark [the applied-for mark CHEVRON Design] is not distinctive of it [the applicant] and is incapable of becoming distinctive of it.

1(d) Any use in Canada of the Applicant's trade-mark in association with the wares and services claimed is likely to result in confusion as between the Applicant's mark and the Design Marks [DELTA, DROP, M and V Design] of the Opponent contrary to Section 6[sic; s.6 merely lists factors to consider] of the Trade-marks Act, (“the Act”). Therefore, the opposed mark is not registrable being contrary to Section 12(1)(d) of the Act.

1(e) Contrary to Section 16(3)(a) of the Act the Applicant is not entitled to registration of its mark in view of the prior and continuing use of the Design Marks in Canada.

.....

1(h) At the date of application a search of the Trade-mark[sic] Register or a common-law use search would have located the Design Marks relied on herein, and therefore the Applicant could not have been satisfied under Section 30(i) of the Act of its entitlement to use the said mark.

OPPONENT'S EVIDENCE

Elenita Anastacio

[9] Ms. Anastacio identifies herself as trade-mark searcher for the firm representing the opponent. Her affidavit serves to introduce into evidence, by way of exhibits, (i) particulars of the trade-mark registrations relied on by the opponent in the statement of opposition and (ii) printouts from the applicant's website showing sports clothing sold under the mark CHEVRON Design.

APPLICANT'S EVIDENCE

Dame Penney

[10] Ms. Penney identifies herself as an employee of the firm representing the applicant. She regularly conducts computer searches of various databases. In the instant case she conducted computer searches to locate trade-mark applications and registrations which include a chevron design feature, or variations of it. She located 273 marks which are shown in Exhibit B of her affidavit; an excerpt of 60 of the marks has been collected in Exhibit A, presumably because those marks most closely resemble the parties' marks.

[11] Pages nos. 10 and 39 of Exhibit A (which consists of 46 pages) are attached as Schedule 1 to these reasons for decision. The marks shown on pages 10 and 39 are illustrative of the 273 marks located by Ms. Penney. From my inspection of Exhibits A and B it is apparent that in the majority of the marks the chevron design feature is either a non-dominant component of the mark (see page 39 in Schedule 1) or differs substantially from the straight-line chevrons comprising the parties' marks (see page 10 in Schedule 1).

[12] The applicant's submission with respect to Ms. Penney's affidavit is found at para. 27 of the applicant's written argument:

27. The Penney Affidavit serves as state of the Register evidence, demonstrating that chevron designs are commonly the subject of trademark applications and registrations owned by different parties that existed on the trademark register as of April 1, 2014.

[13] In my view the above statement is inaccurate and overreaching. It would be more accurate to state that straight-line chevron designs are not uncommon as non-dominant components of trade-marks.

Amy Dam

[14] Ms. Dam identifies herself as an articling student with the firm representing the applicant. She was requested by her employer to access numerous websites of Canadian retailers of sports clothing, footwear and equipment. The results of those searches are attached as Exhibits 1-17 of her affidavit.

[15] The applicant's submission with respect to Ms. Dam's evidence is found at para. 33 of its written argument:

33. The Dam Affidavit serves as marketplace evidence to corroborate the Denney Affidavit, demonstrating that chevron designs are commonly used in the Canadian marketplace by different parties in association with athletic apparel, shoes, equipment and related accessories.

[16] I do not agree with the above statement. From my inspection of Exhibits 1-17, the majority of the marks appearing in the exhibits deviate substantially from straight-line chevron designs.

[17] At best, the Penney and Dam affidavits show that there has been some adoption of straight-line chevron designs, in the Canadian marketplace, as a component of a mark rather than as a stand-alone mark.

[18] The transcripts of cross-examinations of Mss. Penny and Dam add little of probative value.

CONSIDERATION OF THE GROUNDS OF OPPOSITION

[19] My reasons for decision will be somewhat summary in view of the paucity of informative evidence from the parties concerning the actual use of their marks.

First Ground - Distinctiveness

[20] The first ground of opposition alleges that the applied-for mark is not distinctive of the applicant. Reading the statement of opposition as a whole, it is apparent that the opponent is relying on its use of its marks (see para. 4 above) to support this ground of opposition. In order to succeed on this ground, the opponent is required to show that one or more of its marks had acquired sufficient distinctiveness, as of the material date October 16, 2012, to negate the distinctiveness of the applied-for mark. However, the opponent has not presented any evidence to show that there has been any meaningful use of any of its marks, at any time. In other words, there is no evidence that the opponent's marks have acquired any distinctiveness. The first ground of opposition is therefore rejected.

Second Ground - Registrability

[21] The second ground of opposition turns on the issue of confusion between the applied-for mark and one or more of the opponent's registered marks. The material date with respect to the second ground of opposition is the date of my decision. As the DELTA Design registration is no longer extant, the opponent cannot rely on it.

[22] Section 6(5) of the *Trade-marks Act* sets out the factors to be considered in assessing confusion between marks. They are (1) the inherent distinctiveness of the marks and the extent to which they have become known; (2) the length of time each has been in use; (3) the nature of the goods, services or business; (4) the nature of the trade; (5) the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. The guidance given by the Court is that the degree of resemblance is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

[23] The DROP, M and V Design marks each possesses a relatively low degree of inherent distinctiveness. In this regard, a chevron design may be viewed as a variation of the letter V. The

DROP Design mark consists of a drop design and a chevron, that is, it is comprised of two relatively weak components. Together they form a relatively weak mark. The M and V Designs may be viewed as variations of the letters M and V and are therefore also weak marks. Moreover, there is no evidence that any of the marks had acquired any distinctiveness through use in the marketplace at any material date. The applicant's state of the registrar evidence indicates that the public is at least to some extent accustomed to seeing chevron designs as components of trade-marks, which further lessens the distinctiveness of the chevron designs. Similarly, the applied-for mark has little inherent distinctiveness and there is no evidence that it has acquired distinctiveness at any material time through use in the marketplace. The first factor, which is a combination of inherent and acquired distinctiveness, therefore favours neither party.

[24] There is no meaningful evidence from either party concerning the length of time that their marks have been in use and therefore the second factor favours neither party.

[25] There is overlap in the nature of the goods sold under the parties' marks and, in the absence of evidence to the contrary, I assume that there will also be overlap in the parties' channels of trade. The third and fourth factors therefore favour the opponent.

[26] With respect to the opponent's mark M Design, I find that it bears little visual resemblance, if any, to the applied-for mark. I also find that the applied-for mark is substantially visually different from the opponent's mark DROP Design as the drop design is the dominant component of the mark. I also find that the applied-for mark is visually different from the opponent's V Design; the different orientations of the marks also contribute to their visual differences. The fifth factor significantly favours the applicant with respect to each of the opponent's marks DROP, M and V Design.

[27] Considering all the factors together, I find that there is no reasonable likelihood of confusion between the applied-for mark and any of the opponent's registered marks DROP, M and V Design. This is the type of case alluded to by the Court where the degree of resemblance between the marks in issue has the greatest effect in deciding the issue of confusion.

[28] The second ground of opposition is therefore rejected.

Third Ground - Entitlement

[29] With respect to the third ground of opposition, there is an evidential burden on the opponent to establish (i) use of its marks prior to June 8, 2011 (the date of filing of the subject application) and (ii) non-abandonment of its marks as of May 16, 2012 (the date of advertisement of the subject application): see s.16(3) and s.17(1) of the *Trade-marks Act*, respectively. The opponent's evidence (that is, the absence of evidence demonstrating use of the opponent's marks) is insufficient to fulfill the second requirement. The third ground is therefore rejected.

Fourth Ground - Section 30(i)

[30] The applicant's submissions with respect to the fourth ground of opposition are found at paras. 100-104 of its written argument:

100. The Opponent has alleged that the Applicant could not have been satisfied that it was entitled to use the CHEVRON DESIGN mark in Canada, because, at the filing date, a search of the Trade-marks Register or a common law use search would have located the Opponent's Design Marks (Amended Statement of Opposition, par.[sic] 1(h)). We submit that this ground of opposition is improperly pleaded.

101. Where an applicant has provided the statement required by Section 30(i), a Section 30(i) ground of opposition should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant, which is not the case here (*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155).

102. Mere knowledge of the opponent's trademarks does not, alone, support an allegation that an applicant could not have been satisfied of its entitlement to use its trademark[sic] (*Woot Inc. v Woot Restaurants Inc Les Restaurants Woof Inc* 2012 TMOB 197 at para 10).

103. The Opponent has failed to meet its initial evidentiary burden under section 30(i). There is no evidence that the Applicant has acted in bad faith. There is also no evidence that the Applicant located any of the Opponent's Design marks prior to filing its application. The present case is not one of the exceptional cases for which section 30(i) is applicable.

104. Accordingly, the Section 30(i) ground of opposition should be dismissed.

[31] I agree with the applicant's above submissions. The fourth ground is therefore rejected.

DISPOSITION

[32] As each of the grounds of opposition has been rejected, the opposition is rejected.

[33] This decision has been made pursuant to a delegation of authority by the Registrar of Trade-marks under s.63(3) of the *Trade-marks Act*.

Myer Herzig, Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office

APPEARANCES AND AGENTS OF RECORD

HEARING DATE: 2016-11-28

APPEARANCES

Nathan Fan FOR THE OPPONENT

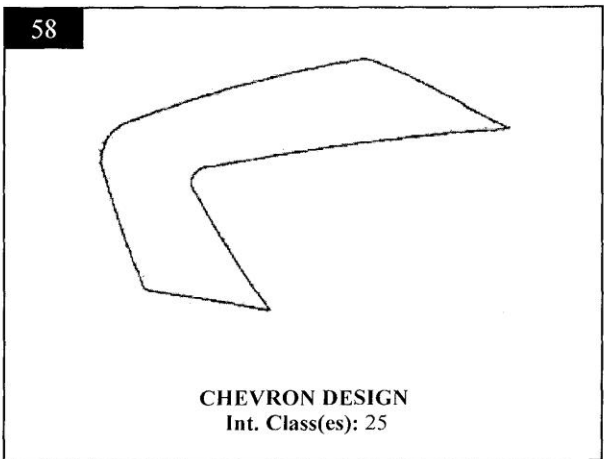
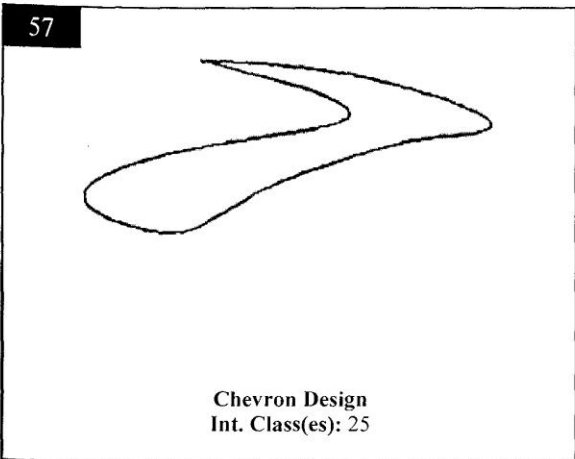
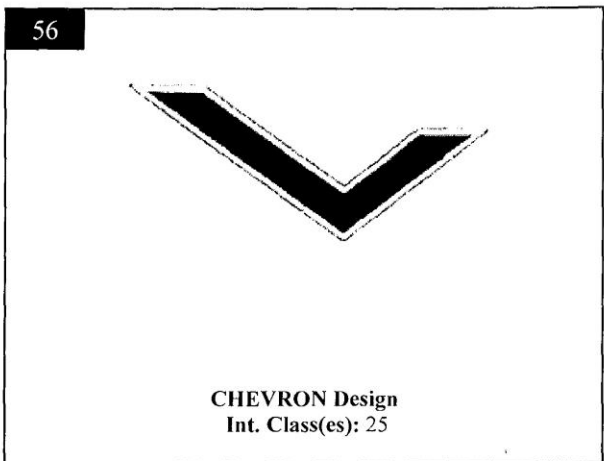
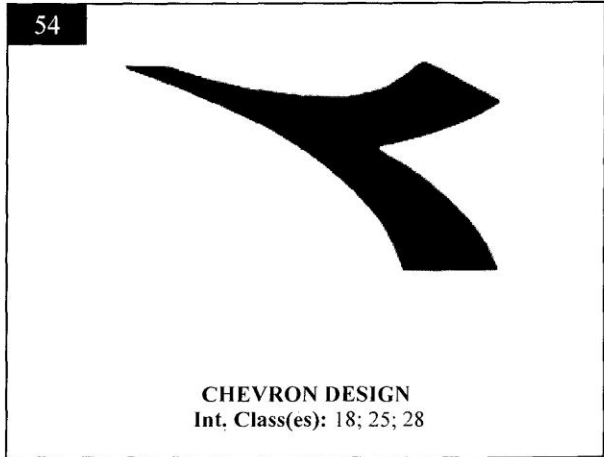
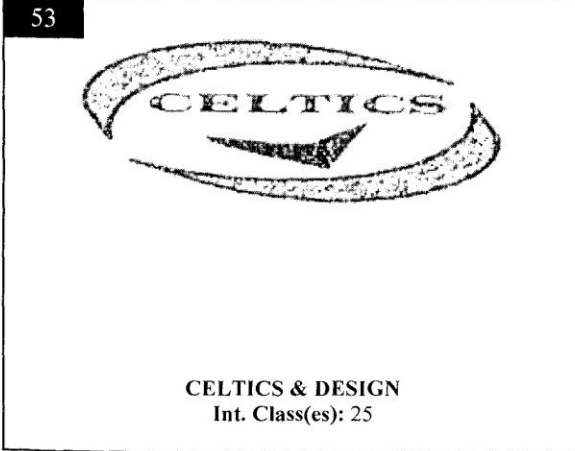
Brigitte Chan FOR THE APPLICANT

AGENTS OF RECORD

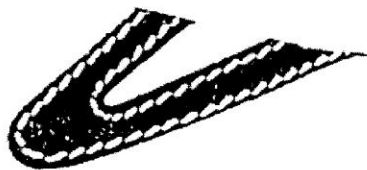
Sim & McBurney FOR THE OPPONENT

Bereskin & Parr FOR THE APPLICANT

SCHEDULE 1



227



STRIPES DESIGN
Int. Class(es): 25

228



STYLIZED CHEVRON DESIGN
Int. Class(es): 18; 25

229



SUGOI & DESIGN
Int. Class(es): 09; 12; 18; 25

230



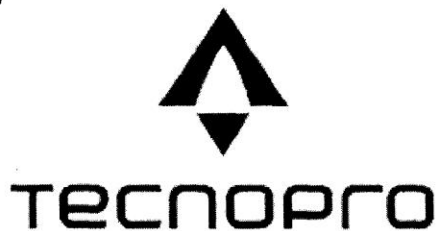
SYM Design
Int. Class(es): 07; 16; 25; 35; 42

231



TAIKIDO & DESSIN
Int. Class(es): 18; 25; 26; 28; 36; 41

232



TECNOPRO & DESIGN
Int. Class(es): 09; 18; 25; 28