



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

Citation: 2015 TMOB 157
Date of Decision: 2015-08-24

IN THE MATTER OF AN OPPOSITION

Spin Master Ltd.	Opponent
and	
George & Company, LLC	Applicant
1,395,147 for the trade-mark LEFT, CENTER, OR RIGHT-DON'T LOSE YOUR CHIPS!	Application

Introduction

[1] Spin Master Ltd. (the Opponent) opposes registration of the trade-mark:

**LEFT, CENTER, OR RIGHT -
DON'T LOSE YOUR CHIPS!** (the Mark)

[2] The application was filed on May 12, 2008 by George & Company, LLC (the Applicant) on the basis of proposed use in Canada in association with:

Playing cards; playing cards and card games; card games; equipment sold as a unit for playing card games (the Goods).

[3] The Applicant claimed priority under section 34 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) on the ground that an application for registration of the same or substantially the same trade-mark for the same kind of goods as the Goods was filed in or for the United States of

America by the Applicant. The application was filed in the United States of America on January 14, 2008 under No. 77370618.

[4] The Opponent filed a statement of opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) wherein the grounds of opposition pleaded are based on sections: 30, 16(1)(a) and 2 (distinctiveness). The main issues to be addressed in this opposition are the non-fulfillment of the requirements under section 30 and the likelihood of confusion with the Opponent's trade-mark LEFT CENTER RIGHT.

[5] For the reasons explained below, I reject the opposition.

The Record

[6] The application was advertised in the *Trade-marks Journal* on November 24, 2010. The Opponent filed its statement of opposition on April 21, 2011. The Applicant filed and served a counter statement on July 15, 2011 in which it denied each ground of opposition pleaded by the Opponent.

[7] The Opponent filed as evidence the affidavits of Ms. D. Jill Roberts sworn November 22, 2011 and Mr. Chris Harrs sworn November 18, 2011.

[8] The Applicant filed as its evidence the affidavits of Mr. Peter Smilanich sworn on January 31, 2013 and Ms. Patti Terry sworn on January 29, 2013.

[9] The Opponent filed as reply evidence a second affidavit of Ms. Roberts sworn on April 2, 2014.

[10] Mr. Smilanich, Ms. Terry and Mr. Harrs were cross-examined and their transcripts are part of the record.

[11] Both parties filed a written argument and were represented at the hearing.

The parties' respective burden or onus

[12] The legal onus is on the applicant to show that its application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* 2002 FCA 291, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company* 2005 FC 722, 41 CPR (4th) 223].

Preliminary remarks

[13] I wish to point out that, in reaching my decision, I have considered all the evidence in the file but I will only refer in my reasons for this decision to the relevant portions of the evidence filed by the parties.

[14] At the outset of the hearing, I listed a number of questions, mainly directed to the Opponent since it had the initial burden. Despite the responses furnished by the Opponent, I am not convinced that the Opponent has met its initial burden as it will appear from a reading of my decision.

[15] During its reply at the hearing, the Opponent made a verbal request to amend its statement of opposition directed to the wording of its ground of opposition based on the lack of distinctiveness of the Mark. I dismissed the Opponent's request at the hearing indicating that I would provide more fulsome reasons in my decision. My reasons will be discussed when I assess that ground of opposition.

[16] This opposition was heard with three other opposition files (1395145; 1397736; and 1455655) involving the same parties and containing the same evidence. Since the basis of each of these other applications differs from one file to another as well as the lists of goods and/or

services, the relevant dates and the grounds of opposition, I indicated to the parties that I would issue distinct decisions in each of the four files grouped together.

[17] The Opponent started its argumentation at the hearing with a chronology of the events that took place both in Canada and the United States. The exercise was informative, but it remains that I must determine if the application met the requirements of section 30 of the Act, if the Applicant is entitled to the registration of the Mark, and if the Mark was distinctive within the meaning of section 2 of the Act.

The Opponent's evidence

The Roberts affidavit

[18] Ms. Roberts is an Assistant Bailiff with Cease Bailiff Services Inc. On November 22, 2011 she accessed the Opponent's website located at *www.spinmaster.com*. While there, she accessed the 'Games' page, then located the link to the 'Left Center Right' game, viewed that page and filed it as exhibit A. She also opened, while on that page, the 'Where to Buy' link and filed it as exhibit B. It is mentioned, on that page, that the 'Left Center Right' game is available for sale at Kmart, Target, Toys 'R' Us and Walmart.

[19] On the same date, she conducted a Google search for the term 'left center right'. She obtained an excess of 710,000,000 hits. The first hit was 'Left Right Center dice' on eBay. She accessed that page and filed a printout as exhibit C. She states that the search indicated there were 174 results found for 'left right center' on eBay, and showed the Opponent's game entitled 'Left Center Right Dice' available for sale.

[20] Finally, still on the same day, she conducted another Google search for the term 'left center right imagination' and it resulted in 3,570,000 hits. Included in the first ten hits was an article from iP Frontline, an IP technology magazine. The article was entitled 'Bean Kinney Wins Trademark Case for Left Center Right', dated June 29, 2009 and she filed a copy of the article as exhibit D.

The Harrs Affidavit and his cross-examination

[21] Mr. Harrs is VP General Counsel of the Opponent. He states that Imagination Holdings Pty Ltd (Imagination) is a corporation of Australia that produces and sells games.

[22] Mr. Harrs alleges that since 2007 Imagination produced and sold a dice game under the mark LEFT CENTER RIGHT in at least Canada, the United States, the European Community and Australia. He asserts that Imagination secured trade-mark rights in the European Community and in the United States.

[23] Mr. Harrs states that the Applicant was fully aware of the adoption and use of the trade-mark LEFT CENTER RIGHT by Imagination since as early as May 21, 2007 when the Applicant commenced a trade-mark infringement action against Imagination in the United States. He asserts that it is his understanding that the Applicant was not successful in such action. He further states that Imagination continued to produce and sell its dice game under the trade-mark LEFT CENTER RIGHT in the United States, Canada and elsewhere.

[24] Mr. Harrs asserts that in 2010, the Opponent purchased Imagination's trade-mark LEFT CENTER RIGHT and he filed as exhibit A copies of the United States and CTM registrations of the trade-mark LEFT CENTER RIGHT which have been assigned to the Opponent. He also filed a copy of the Opponent's Canadian application 1,524,103 for the trade-mark LEFT CENTER RIGHT.

[25] Mr. Harrs states that, following the assignment of the trade-mark LEFT CENTER RIGHT to the Opponent, it has advertised and sold a dice game in Canada bearing the trade-mark LEFT CENTER RIGHT. He asserts that thousands of such games have been sold by the Opponent and he filed as exhibit C a specimen showing the manner in which the trade-mark LEFT CENTER RIGHT is used on the packaging of the Opponent's games which are sold in Canada.

[26] During his cross-examination:

- Mr. Harrs stated that he started working for the Opponent in 2004 (p 7);

- He mentioned that in August 2010 the Opponent acquired the rights in the trademark LEFT CENTER RIGHT. So prior to 2010 the Opponent was not selling the LEFT CENTER RIGHT dice game. (p 14) Therefore, sales of that game prior to August 2010 were done by Imagination (p 14);
- On pages 21 and following he was questioned on exhibit B to Ms. Roberts' affidavit, which refers to the Opponent's website and more particularly, on the page listing the stores where the Opponent's dice game LEFT CENTER RIGHT can be purchased. It refers to stores in the US as some of those listed retail stores are not located in Canada or are not selling that game in Canada;
- Exhibit C to his affidavit is evidence of the style of packaging bearing the trademark LEFT CENTER RIGHT that is sold in Canada. However there appears to be words in Spanish and no French text (p 29-30);
- In re-examination he stated that exhibit C shows the style of the packaging used in Canada. It might not be this exact packaging as it varies from one country to another in view of the content of the warnings and age grading that vary from one country to another (p 33).

The Applicant's evidence

The Terry Affidavit and her cross-examination

[27] Ms. Terry is an investigator with Integra Investigation Services Ltd (Integra). She states that on January 14, 2013 she visited the websites located at *www.spinmaster.ca* and *www.spinmaster.com* and conducted a search of their products using the key words 'LEFT', 'LEFT CENTER', 'LEFT CENTER RIGHT' and 'LCR' and filed as exhibit A the printouts of the results of these searches.

[28] On January 14, 2013 Ms. Terry visited the website located at *www.toysrus.ca* and conducted an online search of the products sold therein and filed the printout results as exhibit B. She then called and spoke with a Customer Relations Representative for Toys R Us Canada who conducted an 'in store' database search for LEFT CENTER RIGHT and LCR. She was informed that no current or historical records for a product of this name were located on the 'in store' database.

[29] On the same day, she visited the website located at *www.walmart.ca* and conducted the same online search as before and filed printouts of the results. There is no indication that a game

bearing the trade-mark LEFT CENTER RIGHT is available for sale. She then called and spoke with a Customer Relations Representative of Walmart who informed her that the *walmart.ca* website contains all the products sold within the Walmart retail stores, plus additional online products.

[30] Then, Ms. Terry conducted an online search for information pertaining to the opening of TARGET stores in Canada. The information obtained was that they would be opening in 2013. She filed as exhibit D printouts of the results of that search, including an article published in the *Financial Post*.

[31] Ms. Terry filed as exhibit G printouts of the *Consumer Packaging and Labelling Act and Regulations* from the Government of Canada website; as exhibit H a printout of the *Toys Regulations* from the Government of Canada website; and finally as exhibit I a printout of the *Industry Guide to Health Canada Safety Requirements for Children's Toys and Related Products, 2012*, from Health Canada website.

[32] During her cross-examination she stated:

- She received verbal instructions to conduct an investigation with regards to LCR LEFT! CENTER! RIGHT!. The websites visited were through instructions received (p 9-10);
- She did not visit a Walmart store to see if the Opponent's games were offered for sale (p 19);
- She did not do the searches on different dates. The results obtained are good for the day the searches were performed (p 23).

The Smilanich Affidavit and his cross-examination

[33] Mr. Smilanich is the Applicant's President. He has been involved with the Applicant since 1970 and has been its President since 1997. He provides a brief history on the origin of the Applicant. It is a manufacturer of games and game supplies and operates various websites selling games and game supplies, including the website located at *www.dicegames.com*.

[34] Mr. Smilanich alleges that the Applicant's most popular game is the LEFT CENTER RIGHT dice game which he created and developed. He further states that the LEFT CENTER RIGHT game, which is also marketed under the LCR mark, is famous in most English speaking

countries and one of the best-selling dice games of all time, with sales globally in the millions of units.

[35] Mr. Smilanich asserts that from 1986 continuously to the present the Applicant has marketed and sold the LEFT CENTER RIGHT game in the United States and in Canada since as early as 1999 and continuously to the present.

[36] In his affidavit, Mr. Smilanich illustrates the packaging which shows use of both the LEFT CENTER RIGHT and LCR marks. He alleges that it is representative of the packaging used by the Applicant in Canada since at least as early as 1999. Exhibit A features additional representations of the packaging for the LEFT CENTER RIGHT game which have been used in Canada. The Mark appears on some of those packaging.

[37] Mr. Smilanich lists, in paragraph 11 of his affidavit, retailers that have been selling the LEFT CENTER RIGHT game in Canada. He filed as exhibit B copies of invoices to prove that the Applicant has shipped the LEFT CENTER RIGHT game to Canadian retailers. Some of the invoices date back to 2000.

[38] Mr. Smilanich asserts that the Applicant has multiple distributors in Canada receiving the LEFT CENTER RIGHT games from the Applicant and distributing them throughout Canada. Those distributors attend trade shows throughout Canada on a regular basis, and they promote the Applicant's LEFT CENTER RIGHT game. He affirms that to date tens of thousands of the Applicant's LEFT CENTER RIGHT game have been shipped and sold in Canada and many thousands of those were shipped and sold prior to January 1, 2007.

[39] Mr. Smilanich states that in June 2011 an employee of the Applicant went on the website of retail game stores in Ontario and British Columbia to check if the Applicant's LEFT CENTER RIGHT game was marketed and available for purchase and he filed the results of those searches as exhibit C.

[40] Mr. Smilanich explains that the Applicant is the owner of registration TMA692,218 for the trade-mark LCR covering 'dices, games, party games and board games featuring specially marked dice and chips' and based on use in Canada since at least as early as October 5, 1999. He filed a computer printout of the CIPO's website for this registration. He alleges that the

Applicant owns Internet domain names *dicegames.com* and *leftcenterright.info* and operates the related websites which also function in an e-commerce capacity enabling Canadian users to order products, including the LEFT CENTER RIGHT game directly from the Applicant's website. He filed as exhibit E printouts of the website, showing various packaging of the Applicant's LEFT CENTER RIGHT game, that are representative of how the game has appeared on the Applicant's website from at least as early as 2002 to the present. He asserts that Canadian buyers can order the LEFT CENTER RIGHT game from the Applicant's website and have products shipped directly to Canada.

[41] Mr. Smilanich states that he regularly monitors the games' market for competitive products in the United States and Canada and he never saw any reference to the advertisement or sale by the Opponent, or the Opponent's alleged predecessor-in-title Imagination, of any LEFT CENTER RIGHT products in Canada.

[42] Mr. Smilanich concludes his affidavit by stating that he is not aware of any third party game or game product sold in Canada using the trade-mark that includes 'Left', 'Center', and 'Right', least of all a dice game.

[43] During his cross-examination he stated that:

- Except for an app on iTunes for the smart phone, the Applicant does not manufacture and sell computer games or software (p 11);
- When the Applicant started selling the game, it used the block letters L, C, R but made also some games with the inscription LEFT CENTER RIGHT on them (p 21);
- There are four versions of the LEFT CENTER RIGHT game sold: one in a plastic tube that has been sold for 25 years; another one in a tin that has been sold for about 7 years since 2007. There is also a deluxe version with a cup that is also sold in a tin (p 28-30). Finally, there is a version sold as a playing card game where on the face of the cards we have the letters L, C, R and a dot (p 31). It has been sold since approximately 2008 and the other face of the cards has the Applicant's trade-marks on it but he did not specify which one (p 32-33);
- None of these versions of the game comes with a board (p 39);
- There is no distinction between the Applicant's party games and dice games (p 40);
- There is a website where the game can be played online (p 41);
- The drop down menu used to insert the address of the customer on the order form only lists the 50 states (p 44-45);
- There is no way of tracking down the number of hits on the Applicant's website originating from Canada (p. 50). However, in the answers to undertakings it was

- mentioned that the online order form on the *leftcenterright.info* website is capable of being filled out and used, and has indeed been used by Canadians to place orders;
- On the 25th anniversary tin packaging illustrated on exhibit E, the word ‘original’ was added since at least 2008 (p 53);
 - The only game the Applicant ships to Canada is the LEFT CENTER RIGHT game. 99% of its Canadian sales are with respect to that game (p 58);
 - It appears from the invoices filed that, starting in November 2007, in the description portion, the words ‘LEFT CENTER RIGHT’ are sometimes written, while before that date, the description used was L C R. (p 79-80);
 - There have been variations in the packaging used since 1999 as illustrated in paragraph 9 and exhibit A to his affidavit (p 86);
 - There is nothing in his affidavit that would enable a breakdown of the sales in terms of units sold per year (p 96);
 - There is also a smart phone app version and electronic handheld version of the game sold since 2011 (p 101-103).

The Opponent’s reply evidence

The Second Roberts affidavit

[44] Ms. Roberts conducted on March 25, 2014 searches using the *Wayback Machine* website on the Internet looking for evidence of the website *www.dicegames.com* for each year from 1999 to and including 2008. She filed the results as exhibit A. She also filed, as exhibit B, the results for September 13, 2008.

[45] Ms. Roberts then filed as exhibit C a copy of a Memorandum Opinion dated July 25, 2008 from the United States District Court of Eastern District of Virginia in court proceedings between the Applicant and Imagination. Finally, she filed, as exhibit D, a copy of a decision from the United States Court of Appeals for the Fourth Circuit in the matter of *George & Company, LLC v Imagination Entertainment Limited et al.* The decision is dated July 27, 2009.

The ‘First’ ground of opposition

[46] Paragraph 3(a) of the statement of opposition reads as follow:

The Opponent bases its opposition on the ground set out in Section 38(2)(a) namely, that the application does not comply with the requirements of Section 30 in that in view of the facts contained in paragraph 2, the Applicant could not have been satisfied that it was entitled to use or register its trade-mark. The Opponent further bases this ground of opposition on the fact that the Applicant did not use the trade-mark as alleged in the application or at all. The Opponent further states that the Applicant knew full well that

the Opponent's predecessor-in-title, Imagination Holdings Pty Ltd., was the rightful owner of the trade-mark LEFT CENTER RIGHT in Canada, in the United States, and elsewhere and as a result, the Applicant knew that it was not entitled to use or register this mark. The Opponent further bases this ground of opposition on the fact that the Applicant has admitted that the trade-mark LEFT CENTER RIGHT is descriptive and not registrable and accordingly the Applicant could not have been satisfied that it was entitled to register this mark.

[47] For ease of reference I reproduce paragraph 2 of the Statement of Opposition as it is referred to in the first sentence of paragraph 3(a):

2. The Opponent is the owner of the trade-mark LEFT CENTER RIGHT for use in association with dice games and which is subject of Application No. 1,524,103 filed on April 18, 2011, based upon use in Canada since at least as early as 2007.

[48] At the hearing it was conceded by the Opponent that paragraph 3(a) of its statement of opposition, as drafted, covers grounds of opposition based on section 30(i) (first, third and fourth sentences) and 30(b) (second sentence) of the Act. I will discuss later, under the distinctiveness ground of opposition, the interpretation of the fourth sentence and what has been qualified by the Opponent as an allegation that the trade-mark is descriptive.

[49] I may add that the second sentence might be viewed as a section 30(d) ground of opposition, namely that the Applicant never used the Mark in the United States. The Opponent does make specific reference to section 30(d) in its written argument. I will therefore also address that issue.

[50] I will do an analysis of these grounds of opposition in their reverse order.

Section 30(d) ground of opposition

[51] As mentioned above, no matter what the ground of opposition raised by the Opponent is, it still has the initial burden. With respect to this ground of opposition, the Opponent simply refers to the fact that Mr. Smilanich was not able to identify a precise date as to when the Applicant started selling its card game version of LEFT CENTER RIGHT. Mr. Smilanich did state that it started sometimes in 2008 (Q. 140-142). These facts are not sufficient for the Opponent to meet its initial burden. It does not contradict the fact that the Applicant has been using the Mark in the United States.

[52] In its written argument, the Opponent discuss at length the interrelationship between section 16(2) and 30(d) of the Act and argues, based on *The Thymes, LLC v Reitmans (Canada) Limited* 2013 FC 127, that the Applicant was required to show use and registration abroad. The Federal Court confirmed the Registrar's decision that the use abroad of the trade-mark applied for in Canada had to be at least from the filing date of the Canadian application. In *The Thymes*, there was contradictory evidence in the record concerning the use abroad of the trade-mark applied for as of the filing date of its Canadian application.

[53] In the present case, there is no evidence, as discussed above, contradicting the alleged use abroad by the Applicant of the Mark as of the filing date of this application.

[54] Even if I was wrong in concluding that the Opponent has not met its initial burden under this ground of opposition, this conclusion would only affect the priority date of this application. Since this application is also based on proposed use and that a section 30(e) ground of opposition has not been raised, if the other grounds of opposition are dismissed, then the application would go through, without the priority date associated to its US application.

[55] Consequently, I dismiss this ground of opposition.

Section 30(b) ground of opposition

[56] The material date with respect to this ground of opposition is the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd*, 3 CPR (1984), (3d) 469 at 475].

[57] Section 30(b) of the Act deals with application filed on the basis of use in Canada.

[58] As mentioned above, the application is based on proposed use in Canada. Consequently, this ground of opposition is dismissed

Section 30(i) ground of opposition

[59] Section 30(i) of the Act only requires an applicant to declare itself satisfied that it is entitled to use the mark applied for in Canada in association with the goods and services described in the application. Such a statement is included in the present application. An opponent may rely on section 30(i) in specific cases such as where bad faith on the part of the applicant is

alleged [see *Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. There is no allegation of that nature in the statement of opposition, except to allege that the Applicant was aware that the Opponent's predecessor-in-title Imagination was the rightful owner of the trade-mark LEFT CENTER RIGHT in Canada, the United States and elsewhere.

[60] As it will be discussed under the ground of opposition of lack of distinctiveness of the Mark, the Opponent has not established that it had, at the relevant date, prior rights in Canada to the trade-mark LEFT CENTER RIGHT. Even if it had, the Applicant could still declare itself that it was satisfied that it was entitled to use the Mark in Canada in association with the Goods as the Mark differs from the Opponent's trade-mark LEFT CENTER RIGHT. The question about the likelihood of confusion between these marks is obviously a separate issue.

[61] Finally, the Opponent argues that the filing of this application was a strategic plan to eliminate a potential competitor from using an apt descriptor of a competing product into the Canadian market, subsequent to court proceedings and decisions rendered in the United States in favour of the Opponent's predecessor-in-title.

[62] This allegation has not been specifically pleaded in the Opponent's statement of opposition. In any event, either the Opponent had prior rights or not, and if so, it had to prove them; which it failed to do, as it will appear from my analysis of the Opponent's allegation of prior rights in Canada.

[63] The other prong, under this ground of opposition, is the allegation that the Applicant could not declare itself satisfied that it is entitled to use the Mark in Canada as the Applicant admitted that the trade-mark LEFT CENTER RIGHT is descriptive and not registrable.

[64] The Opponent conceded that there is no formal admission on the part of the Applicant that the Mark is descriptive. However the Opponent relies on the testimony of Mr. Smilanich describing how the game is played as well as the rules of the game as they appear on part of exhibit C to Mr. Smilanich's affidavit (pages 172 and 173). For ease of reference I reproduce the relevant portion of exhibit C:

LCR has to be one of the simplest and best group games ever made. The letters 'LCR' stand for 'Left, Center, Right', and refer to the letters of the three dice with

which the game is played – three of each die’s six faces contain a single pip, while the other three sport an L, a C, or an R respectively.

Players start with three chips each, and on their turn roll the three dice simultaneously. For each L rolled, pass one chip to the player at your left; for each R, pass one chip to the player on your right. For each C, one chip goes into the centre, to the pot. The pips are null, and do not affect the chips’ movement.

[65] I fail to see how the Mark is a description of the rules of the game. In any event what is prohibited by the Act is the registration of a clearly descriptive trade-mark in the English or French language of the character or quality of the goods or services. At best, the Mark might be suggestive of how the game is generally played to a person who has played the game beforehand, but certainly not to a consumer who has no knowledge of the game and sees it for the first time.

[66] Furthermore, I may add that the statement of opposition refers to the trade-mark LEFT CENTER RIGHT as being descriptive. This is not the trade-mark that is the subject of this application.

[67] The Opponent also relies on a decision rendered by the United States District Court for the Eastern District of Virginia filed (US decision) as exhibit C to Ms. Roberts’ second affidavit (reply evidence). First and foremost, I do not consider such exhibit as ‘reply evidence’, within the meaning of section 43 of the Act. Moreover the US decision was rendered in the context of a motion for summary judgment in response to an infringement action instituted by the Applicant based on common law rights in the trade-mark LEFT CENTER RIGHT and not the Mark. Additionally, the Opponent was not a party to the US decision but rather Imagination. Furthermore, the US decision was rendered, and its filing in the record of this opposition was done, after the relevant date under this ground of opposition. Finally, I have no evidence of the applicable principles under the US law governing that type of proceeding and how its end result would be applicable to this ground of opposition.

[68] Based on the foregoing, I dismiss this ground of opposition, for failure by the Opponent to meet its initial burden.

The 'Second' ground of opposition

[69] Paragraph 3(b) of the Opponent's statement of opposition reads as follow:

The Opponent bases its opposition on the ground set out in Section 38(2)(d), namely, that the [Mark] is not distinctive in view of the facts alleged in this Statement of Opposition and also since it is not adapted to distinguish the [Goods] with which it is alleged to be used by the Applicant from the wares/services of others including the wares/services of the Opponent and the Applicant's trade-mark is not adapted to distinguish them. In support of this ground, the Opponent also relies on the fact that the Opponent, and its predecessor-in-title, [Imagination] have extensively sold dice games in Canada and the United States bearing the trade-mark LEFT CENTER RIGHT since well before the date of first use alleged by the Applicant and since well before the filing date of this application. Such use continues to date and the Opponent has not abandoned its trade-mark at any time.

[70] At the hearing, the Opponent acknowledged that such ground of opposition is commonly known as the non-distinctiveness ground of opposition, which refers to the definition of 'distinctive' contained in section 2 of the Act.

[71] The parties disagreed at the hearing on the scope of that ground of opposition. The Opponent claims that one of the foundations of this ground of opposition is the fact that the Mark is descriptive, as alleged in paragraph 3(a) of the Statement of Opposition, reproduced above. The Applicant asserts that the Opponent is limited by its pleadings to the allegation that the Applicant admitted that the trade-mark LEFT CENTER RIGHT is descriptive and not registrable. Since there is no admission in the record, therefore that prong of the non-distinctiveness ground of opposition should be dismissed.

Application to amend the statement of opposition

[72] At the hearing, at the conclusion of its reply to the Applicant's verbal representations, the Opponent sought leave to amend its statement of opposition to plead that the Mark was not distinctive because it was descriptive. At the hearing, I mentioned that I intended to refuse this request namely on the grounds that it was made too late; no reasonable explanations were provided to explain the tardiness of the request; and that I would elaborate on my reasoning in this decision.

[73] I am fully aware that amendments can be made at any stage of an opposition proceeding, including during the hearing. However, the jurisprudence has established certain criteria that must be taken into consideration. I refer to the decision of Mr. Troicuk, in *Alcantara SpA v Carsilco International Ltd* (1986), 10 CIPR 27 (TMOB) where he stated:

The policy of the Trade Marks Opposition Board is to grant leave to amend a statement of opposition where it is satisfied that it is in the interests of justice to do so having regard to all the surrounding circumstances including (i) the stage the opposition proceeding has reached, (ii) whether the request for leave to amend could have been made at an earlier stage (iii) the importance of the proposed amendment to the opponent and (iv) the extent to which the applicant would be prejudiced if leave was granted.

[74] The Applicant's evidence was filed more than two years ago; the same is true with Mr. Smilanich's cross-examination. The Opponent filed its written argument in October 2014, wherein it was clear that the Opponent intended to discuss the descriptiveness of the Mark beyond the boundaries of the alleged admission made by the Applicant as pleaded in its statement of opposition (see paragraphs 52 & ff. of the Opponent's written argument). No explanation has been provided by the Opponent to explain such delay except to say that it is in response to the Applicant's argument made during the hearing that this ground of opposition is limited to the allegation that the Applicant admitted that the Mark is descriptive. I cannot accept such explanation.

[75] The Opponent knew very well when it filed its written argument what it intended to argue. Such argumentation is well beyond the simple allegation of an admission that the Mark is descriptive. Had the Opponent pleaded that the Mark is descriptive, the Applicant might have filed evidence to sustain the opposite view.

[76] Granting the amendment sought would cause prejudice to the Applicant by preventing it from filing evidence on this issue, unless a postponement of the hearing is granted, which would also cause prejudice to the Applicant. Therefore I have no other alternative but to refuse the Opponent's request.

[77] I may add that, even if I was to grant leave to amend the statement of opposition as requested by the Opponent, in view of my analysis of the descriptiveness of the Mark, or lack

thereof in this case, as detailed in paragraph 65 above, the ground of opposition as amended, would have been dismissed.

Lack of distinctiveness based on the Applicant's admission that the Mark is descriptive

[78] I discussed previously the point that there is no such admission in the record that the Mark is descriptive. The fact that the Mark might be suggestive of how the game is played does not render the Mark non-distinctive.

[79] Consequently this prong of the ground of opposition based on lack of distinctiveness of the Mark is dismissed.

Lack of distinctiveness of the Mark based on the Canadian and US sales of the Opponent's game LEFT CENTER RIGHT

[80] This ground of opposition must be assessed as of the filing date of the statement of opposition (April 21, 2011) [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* 2004 FC 1185, 34 CPR (4th) 317 (FC)].

[81] In *Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 the Federal Court did an exhaustive analysis of *Motel 6 Inc v No 6 Motel Limited*, [1982] 1 FC 638 and *E & J Gallo Winery v Andres Wines Ltd* [1976] 2 FC 3 and concluded that:

- A mark needs to be known in Canada to some extent at least to negate another mark's distinctiveness;
- Alternatively, a mark could negate another mark's distinctiveness if it is well known in a specific area of Canada.

[82] The Opponent had therefore the initial burden to prove that it, or its predecessor-in-title, sold games in Canada in association with the trade-mark LEFT CENTER RIGHT prior to April 21, 2011 such that its trade-mark LEFT CENTER RIGHT was known in Canada to some extent or it was well known in a specific area of Canada. For the reasons detailed after, I conclude that the Opponent has not demonstrated any of those situations.

[83] The only allegations of use of the trade-mark LEFT CENTER RIGHT by the Opponent or its predecessor-in-title Imagination are contained in paragraphs 3 and 8 of Mr. Harrs' affidavit. These allegations can be summarized in the following words:

- Imagination produced and sold dice games under the trade-mark LEFT CENTER RIGHT in at least Canada, the United States, the European Community and Australia since 2007;
- Following the assignment of the trade-mark LEFT CENTER RIGHT from Imagination to the Opponent in August 2010, the latter has advertised and sold thousands of dice games bearing the trade-mark LEFT CENTER RIGHT.

[84] As argued by the Applicant, Mr. Harrs described himself as the Opponent's VP General Counsel. He is not an officer, director or duly authorised representative of Imagination. Therefore any allegation on his part that Imagination sold dice games in Canada under the trade-mark LEFT CENTER RIGHT constitutes inadmissible hearsay evidence. There is no evidence of a single sale made by Imagination in Canada of games in association with the trade-mark LEFT CENTER RIGHT prior to the relevant date.

[85] As for the thousands of units sold by the Opponent as alleged by Mr. Harrs, he admitted during his cross-examination that such number was not limited to Canada (Q. 110). Therefore we have no information on the number of units sold in Canada by the Opponent between August 2010 and April 21, 2011.

[86] Mr. Harrs mentioned, during his cross-examination, that the Opponent has a 'sales and marketing' department as well as an accounting department. There has been no affidavit filed by people working in those departments to detail the sales made in Canada by the Opponent during the abovementioned period, or the marketing efforts made in Canada during the same period to promote the sale of its game LEFT CENTER RIGHT.

[87] As for the illustration of the game allegedly sold in Canada by the Opponent, some of the inscriptions on the packaging are written in a language other than French or English, raising some serious questions as to the use of that packaging in Canada. The Opponent argues that Mr.

Harris mentioned that it was an illustration of the type of game sold in Canada without stating unequivocally that it was in that particular packaging that its game was sold in Canada. The fact remains that we have no evidence of transfer of property of games in association with the trade-mark LEFT CENTER RIGHT within the meaning of section 4(1) of the Act, either from the Opponent or Imagination.

[88] With respect to the evidence of advertisement contained in Ms. Roberts' first affidavit, the Opponent conceded at the hearing that such evidence postdates the relevant date and as such cannot be used to substantiate the fact that the Opponent's games were advertised in Canada prior to the relevant date in association with the trade-mark LEFT CENTER RIGHT. The Opponent is relying on such evidence to demonstrate the non-abandonment of its trade-mark as required under section 16(5) of the Act. Therefore, I shall review, if need be, such evidence under the non-entitlement ground of opposition.

[89] Consequently, the Opponent has failed to show use, within the meaning of section 4(1) of the Act, of the trade-mark LEFT CENTER RIGHT in Canada prior to April 21, 2011 either by itself or Imagination.

[90] Even though the Opponent has not specifically pleaded that its mark LEFT CENTER RIGHT was known in Canada, I will assume it did when it pleaded that, it and its predecessor-in-title have extensively sold dice games in the United States in association with the trade-mark LEFT CENTER RIGHT. I refer to the definition of 'made known in Canada' contained in section 5 of the Act, which reads:

5. A trade-mark is deemed to be made known in Canada by a person only if it is used by that person in a country of the Union, other than Canada, in association with goods or services, and

(a) the goods are distributed in association with it in Canada, or

(b) the goods or services are advertised in association with it in

○ (i) any printed publication circulated in Canada in the ordinary course of commerce among potential dealers in or users of the goods or services, or

○ (ii) radio broadcasts ordinarily received in Canada by potential dealers in or users of the goods or services,

and it has become well known in Canada by reason of the distribution or advertising.

[91] So, in order to fall within the legal definition of ‘making known in Canada’, the Opponent had to establish the following:

- 1) Its goods were distributed in Canada in association with its trade-mark LEFT CENTER RIGHT (which it failed to do, as discussed previously); or
- 2) Its goods or services were advertised in association with its trade-mark LEFT CENTER RIGHT in:
 - a) any printed publication circulated in Canada (no evidence in the file); or
 - b) radio broadcasts ordinarily received in Canada (no evidence in the file); and
- 3) It has become well known in Canada by reason of such distribution and advertising (which is not the case).

[92] None of those conditions have been met. In fact, the Opponent conceded at the hearing that there was not much evidence in the record to support an allegation that the Opponent’s trade-mark LEFT CENTER RIGHT was known in Canada.

[93] In all, I conclude that the Opponent has failed to meet its initial burden to prove that on April 21, 2011 the Opponent has used in Canada the trade-mark LEFT CENTER RIGHT or that it was known to Canadians at that time such that it negated the distinctiveness of the Mark.

[94] Consequently I dismiss this ground of opposition.

The ‘Third’ ground of opposition

[95] The ‘third’ ground of opposition defined in the Opponent’s statement of opposition reads as follow:

The Opponent bases its opposition on the ground set out in Section 38(2)(c) namely, that the Applicant is not the person entitled to registration of the trade-mark claimed in the application in view of the provisions of Section 16(1)(a) in view of the facts contained in the Statement of Opposition. In particular, the Opponent relies upon prior use of the trade-mark LEFT CENTER RIGHT, as well as its pending Application No. 1,524,103 as stated in its Statement of Opposition. In addition, the trade-mark LEFT CENTER RIGHT, which is subject of

Opponent's US Registration No. 3,555,630, has been made known in Canada since well before the date of first use alleged in the application and since well before the filing date of the application.

[96] At the hearing, I raised the issue that reference to section 16(1)(a) may have been a typographical error as the application is based on proposed use. The Applicant did not raise an objection that I treat the reference to such sub-section as a reference to section 16(3)(a) of the Act.

[97] The relevant date under this ground of opposition is the priority date claimed in the application (January 14, 2008) [see section 34(1) of the Act]. In any event, as it will appear from my analysis of this ground of opposition, even if I disregard the priority date claimed by the Applicant and review this ground of opposition as of the filing date of the application (May 12, 2008) [see section 16(3) of the Act], the conclusion would be the same. I will review this ground of opposition at the more favourable date to the Opponent, namely May 12, 2008.

[98] In the ground of opposition as drafted, there is a reference to Canadian application 1,524,103 and therefore I assume that the Opponent is also raising as a ground of opposition section 16(3)(b) of the Act. I will discuss first the latter ground of opposition.

Non-entitlement under Section 16(3)(b) of the Act

[99] Even though an extract of the Canadian register has been filed with respect to application 1,524,103 (exhibit B to Mr. Harris' affidavit), still such application was filed (April 18, 2011) after the filing date of the present application (May 12, 2008).

[100] The Opponent has raised the fact that its application 1,524,103 claims an earlier date of first use, namely 2007, than the filing date of the present application. In *Canada (Attorney General) v. Effigi Inc.*, 2005 FCA 172, 41 CPR (4th) 1, the Federal Court of Appeal interpreted section 16 to mean that in order for 16(3)(b) to apply the cited application needs to be pending at the filing date of the contested application, which is not the case here. However, if an opponent wishes to rely on an earlier date of first use, it must prove such prior use in the context of a ground of opposition based on section 16(3)(a) of the Act.

[101] For these reasons, I dismiss this ground of opposition.

Non-entitlement under Section 16(3)(a) of the Act

[102] I interpret the ‘third’ ground of opposition pleaded by the Opponent to mean that the Applicant is not entitled to registration of the Mark since, at the filing date of the application (May 12, 2008), the Mark was confusing with the Opponent’s trade-mark LEFT CENTER RIGHT previously used and/or made known in Canada by the Opponent.

[103] I already concluded, under the lack of distinctiveness ground of opposition, that the Opponent failed to establish prior use of its trade-mark LEFT CENTER RIGHT in Canada or that it was known in Canada on April 21, 2011. The earlier relevant date of May 12, 2008 does not affect these findings. In fact, that earlier relevant date goes back to Imagination’s alleged use of the trade-mark LEFT CENTER RIGHT. Again, as discussed previously, I have no evidence of use of that trade-mark by Imagination in Canada prior to the relevant date.

[104] The same reasoning would apply if the priority date of January 14, 2008 is considered.

[105] Consequently, I also dismiss this ground of opposition on the basis that the Opponent failed to meet its initial burden of proof.

Disposition

[106] 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.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Hearing Date: 2015-07-23

Appearances

Susan Beaubien For the Opponent

Jonathan Columbo For the Applicant

Agents of Record

Moffat & Co. For the Opponent

Bereskin & Parr LLP For the Applicant