



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

**Citation: 2011 TMOB 224**  
**Date of Decision: 2011-11-23**

**IN THE MATTER OF OPPOSITIONS  
by Hockey Puck Gum, LLC to  
application Nos. 1,393,904 and 1,393,905  
for the trade-marks HOCKEY PUCK  
and RONDELLE DE HOCKEY in the  
name of 3641082 Manitoba Inc., doing  
business as Alantra Foods**

[1] On May 2, 2008, 3641082 Manitoba Inc., doing business as Alantra Foods, (the Applicant) filed applications to register the trade-marks HOCKEY PUCK and RONDELLE DE HOCKEY, under Nos. 1,393,904 and 1,393,905 respectively. Both applications are based upon proposed use of the subject trade-mark in Canada in association with the following wares: frozen confections with flavored coatings and flavored fillings; non-frozen confections, namely: candy; biscuits; chocolate bars; candy bars; chocolate confections and toffee confections with flavored coatings and flavored fillings.

[2] Both applications were advertised for opposition purposes in the *Trade-marks Journal* of May 20, 2009.

[3] On October 20, 2009, Hockey Puck Gum, LLC (the Opponent) filed a statement of opposition against each application. The Applicant responded by filing and serving counter statements in which it denied the Opponent's allegations.

[4] In support of each opposition, the Opponent filed affidavits of Sazia Aftab and Ellen Silk.

[5] In support of each application, the Applicant filed an affidavit of Brian Derrick Donnelly.

[6] None of the affiants were cross-examined.

[7] Neither party filed a written argument or requested that an oral hearing be held.

[8] In each opposition, the Opponent has pleaded that the Applicant is not the person entitled to registration under s. 16(3)(a) the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) because the applied for trade-mark was, as of the date of filing the application, confusing with the marks HOCKEY PUCK or HOCKEY PUCK GUM which had been previously used or made known in Canada by or on behalf of the Opponent. I will first address this ground insofar as it relates to the Applicant's trade-mark HOCKEY PUCK (the Mark).

[9] There is an initial onus on the Opponent to evidence that it had used or made known HOCKEY PUCK or HOCKEY PUCK GUM in Canada prior to May 2, 2008 and had not abandoned such marks as of May 20, 2009 (see s. 16(5)).

[10] Ms. Silk, the managing member and founder of the Opponent, attests that the Opponent has sold gum products prominently marked HOCKEY PUCK GUM in Canada since before May 2, 2008. As Exhibits D and F, she has provided examples of labels for products sold in Canada prior to May 2, 2008. These labels prominently display HOCKEY PUCK GUM™. Ms. Silk also provides as Exhibit A copies of representative invoices, which include invoices to Canadian buyers in 2006, 2007 and 2008. Each of these invoices display the HOCKEY PUCK GUM product at the top, i.e. there is a photo of an open container of gum, clearly showing HOCKEY PUCK GUM on its lid. Ms. Silk attests that the Opponent's sales of HOCKEY PUCK products to Canada were approximately as follows: 2005 - \$1000; 2006 - \$54,000; 2007 - \$3500; 2008 - \$2700; 2009 – \$35,000.

[11] The Opponent's evidence satisfies its initial burden insofar as the pleaded mark HOCKEY PUCK GUM is concerned. Therefore, the question becomes whether the Applicant has met the legal onus that lies on it to establish, on a balance of probabilities, that its application complies with the requirements of the Act. To that end, I must assess if there is a reasonable likelihood of confusion between the Mark and HOCKEY PUCK GUM.

[12] 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 wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[13] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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 wares, 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 C.P.R. (4th) 321 (S.C.C.), *Veuve Cliquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401 (S.C.C.) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C).]

*6(5)(a) - the inherent distinctiveness of the trade-marks and the extent to which they have become known*

[14] Both marks are inherently distinctive.

[15] Only the Opponent has provided evidence that its mark has been used or promoted in Canada.

*6(5)(b) - the length of time each mark has been in use*

[16] When the Applicant's proposed-use application was filed, the Opponent had already been using its mark for approximately three years.

[17] I note that Mr. Donnelly attests that he has not encountered the Opponent's mark in the marketplace. However, the Opponent's evidence satisfies me that its mark was in use in Canada. It was open to the Applicant to cross-examine Ms. Silk if it harboured doubts as to the veracity of her evidence, but it chose not to.

*6(5)(c) and (d) - the nature of the wares, services, business and trade*

[18] The parties' wares are not identical but they are similar food items and gum is typically associated with candy and other confections. There is no reason to expect that the parties' wares would travel different channels of trade. Ms. Silk informs us that the Opponent sells its wares at hockey rinks, sporting goods stores, and as fundraisers for youth hockey teams. Mr. Donnelly informs us that the Applicant sells its wares through retailers, wholesalers and fundraisers.

*6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them*

[19] Clearly the distinctive part of the Opponent's mark is the term HOCKEY PUCK, since GUM identifies the associated product. Therefore the distinctive parts of each party's mark are identical and the degree of resemblance between the marks in appearance, sound and ideas suggested is high.

*conclusion*

[20] Each of the s. 6(5) circumstances favours the Opponent and the Applicant has not satisfied me that confusion between the marks is not reasonably likely. The s. 16(3)(a) ground of opposition therefore succeeds with respect to application No. 1,393,904 based on the Opponent's prior use of HOCKEY PUCK GUM.

[21] An analysis of the likelihood of confusion between HOCKEY PUCK GUM and RONDELLE DE HOCKEY is similar to that conducted above with respect to the Applicant's HOCKEY PUCK mark, given that the evidence and the material dates do not differ. As discussed in *Pierre Fabre Médicament v. SmithKline Beecham Corp.* (2001), 11 C.P.R. (4th) 1 (F.C.A.) at para. 15, the test for confusion has three prongs: is there a risk of confusion in the average Francophone consumer, the average Anglophone consumer or, in some special instances, the average bilingual consumer? [See also *Mattell* at para. 58 and *Four Seasons Hotels Ltd. v. Four Seasons Television Network Inc.* (1992), 43 C.P.R. (3d) 139 (T.M.O.B.).] As RONDELLE DE HOCKEY is an exact translation of HOCKEY PUCK, it is appropriate to

consider the average bilingual consumer and I conclude that such a consumer is likely to be confused.

[22] The s. 16(3)(a) ground of opposition therefore succeeds with respect to application No. 1,393,905 based on the Opponent's prior use of HOCKEY PUCK GUM.

Disposition

[23] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject both applications pursuant to s. 38(8) of the Act.

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Jill W. Bradbury  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office