



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

Citation: 2017 TMOB 23
Date of Decision: 2017-02-21
[UNREVISED ENGLISH
CERTIFIED TRANSLATION]

IN THE MATTER OF AN OPPOSITION

Manish Walia

Opponent

and

VTEC Limited

Applicant

1,499,557 for VENUM & Dessin

Application

Introduction

[1] On October 13, 2010 DRAGON BLEU, LLC (Dragon Bleu) submitted a request for registration of the VENUM & Dessin trade-mark bearing number 1,499,557, reproduced below:



[2] The request is based on future use, and Dragon Bleu claimed a priority date on September 23, 2010 based on a registration request for the same trade mark submitted in France under number 10/3768840.

[3] On December 17, 2013 Dragon Bleu assigned the said registration request to VTEC Limited (VTEC) (Dragon Bleu and VTEC will be jointly identified hereinafter as “the Applicant” without distinction, unless specifically mentioned otherwise).

[4] The registration request was amended on January 11, 2012 and currently covers the following products:

protective helmets for combat sports, clothing for combat sports and martial arts, martial arts costumes, shorts, kimonos, sports shoes, particularly for martial arts, T-shirts, Bermuda shorts, sweatshirts, sports protective items such as boxing and free fighting gloves, shin guards, elbow pads, knee pads, protective padding including shoulder pads, spine protectors, athletic cups, foot protectors, knee protectors, shin protectors: all products designed for combat sports (hereinafter sometimes referred to collectively as “the Products”).

[5] The registration application was published on May 8, 2013 in the *Trade-Marks Journal* for the purposes of opposition.

[6] On July 3, 2013 Manish Walia (the Opponent) submitted an Opposition raising grounds for opposition based on sections 30, 12(1)(d) and 16(3) of the *Trade-Marks Act*, RSC (1985), c T-13 (“the Act”).

[7] On September 16, 2013 the Applicant submitted a counter-statement denying each and every ground of opposition pleaded by the Opponent.

[8] In support of its opposition, the Opponent produced an affidavit made by Manish Walia and sworn to on April 14, 2014.

[9] The Applicant submitted no evidence.

[10] Only the Applicant filed written arguments and the two parties were represented at the hearing.

[11] For the reasons more fully described hereinafter, I reject the opposition.

Preliminary Remarks

[12] I have studied all the evidence of record. However, I will refer only to what I consider relevant for the purposes of my decision.

[13] I wish to emphasize that paragraphs 5, 7 and 9 of Mr. Walia’s affidavit are legal arguments or conclusions that I will not consider. It is up to the Registrar to determine whether there is confusion between the parties’ trade-marks on a balance of probabilities, based on the evidence in the file.

[14] I also emphasized during the hearing that there was no evidence in the file of use of the Opponent’s marks within the meaning of section 4(1) of the Act – as was alleged to support its opposition – as appears from the summary of the Opponent’s evidence.

Opponent’s Evidence

[15] Mr. Walia described himself as an individual, owner of the trade-marks listed below:

TMA 763,824		registered April 9, 2010
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TMA 763,782		registered April 9, 2010
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TMA 643,451		registered June 30, 2005
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[16] Mr. Walia referred to those marks as ‘VENOM marks’ and so will I. He produced a certified copy of each of those registrations.

[17] Mr. Walia stated that products bearing the VENOM marks have been sold by ‘registered users’ including Prabha International Inc. (Prabha) since 2010. He alleged that the VENOM marks are associated with the following products:

- 1) Cricket bats, cricket bat handles, leggings for batsmen, gloves for batsmen, cricket balls, wickets, cricket glove linings, cricket gloves, cricket shorts, athletic cups for cricket players, athletic cups with shorts for hockey players, cricket helmets, cricket chest guards, cricket elbow guards, cricket bags, cricket shoulder bags, glove linings for batsmen, lined gloves for cricket, cricket shoes, hats in cricket colours, white floppy cricket hats, white cricket shirts and trousers, coloured cricket shirts and trousers, tracksuits, fleece vests and sweaters.
- 2) Wooden field hockey stocks, composite field hockey sticks, field hockey balls, leggings and shoes for field hockey goaltenders, helmets for goaltenders, field hockey gloves, field hockey shin guards, stick bags and shoes.
- 3) Soccer balls, footballs, volleyballs, rugby footballs, basketballs, zone marker cones, flags, soccer nets and shoes.

(hereinafter collectively referred to as “the Opponent’s products”).

[18] Mr. Walia stated that the Opponent has sold and promoted products bearing the VENOM marks. He alleged that the mark – without specifying which one – appeared on the uniforms and websites of sports teams. He produced as examples:

- Exhibit B: Brampton and Etobicoke District Cricket League website
- Exhibit C: The Canadian Softball Cricket Association
- Exhibit D: Mississauga Ramblers Cricket Sports and Cultural Club
- Exhibit E: Toronto Field Hockey Club
- Exhibit F: The Pan American Hockey Federation

[19] I wish to emphasize that none of those exhibits is evidence that any VENOM mark is being used within the meaning of section 4(1) of the Act. The exhibits do not prove that ownership has transferred for any of the products listed above. Those photos or website extracts only show VENOM marks on posters or websites. I would add that no dates are given for any of those exhibits.

[20] Mr. Walia alleged that the Opponent acted as a sponsor at several sporting events, including field hockey tournaments. He added that the VENOM mark – without specifying which one – appeared on posters on the arena walls, officials’ uniforms, on the field hockey sticks given to players, and he produced photos illustrating those facts as Exhibit G. However, no dates were given for any of those photos.

[21] Mr. Walia stated that authorized users had been selling sports accessories, uniforms and clothing for about 10 years. He added that Prabha made the VENOM marks known and therefore they (without identifying which VENOM marks) would be distinctive of the products they were placed on due to direct sales to sports associations, sports teams and sport-related vendors (without specifying which sport(s)). However, there is no evidence of such sales in the file.

[22] Mr. Walia produced copies of photographs showing the VENOM marks on products including sports shirts, sweaters, trousers, hats, field hockey sticks, field hockey balls and shin guards as Exhibit H. He also produced copies of photographs of sports teams wearing outfits connected to the VENOM marks as Exhibit I. Lastly, he produced photographs of boxes used to package products with VENOM marks on them as Exhibit J. However, no date is given for those photos and there is no evidence of ownership transfer for any of the products.

Evidentiary Burden

[23] The legal onus is on the Applicant to show that the registration application does not contravene the provisions of the Act. Nevertheless, the Opponent had the initial burden of proving the facts on which its allegations were based. The fact that an initial burden of proof is laid on the Opponent means that opposition arguments will only be considered if there is sufficient evidence to reasonably conclude that the facts alleged in support of such arguments exist [see: *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FC 1st inst); *Dion Neckwear Ltd v Christian Dior, SA et al* 2002 FCA 29, 20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* 2005 FC 722, 41 CPR (4th) 223].

Ground of opposition based on section 30 of the Act

[24] It is relevant to cite that argument here:

«The application does not conform to the requirements of s. 30 of the Trade-marks Act»;

[25] The Applicant argues that that opposition argument was not pleaded sufficiently, and I agree. The Opponent did not specify in its Opposition statement or present any facts in evidence that might indicate which subparagraph(s) of the section it was referring to.

[26] For those reasons I reject that opposition argument.

Ground of opposition based on section 16(3) of the Act

[27] The relevant date for analyzing the argument based on section 16(3) of the Act is the date the registration request was submitted [see section 16(3) of the Act]. However, since the Applicant is claiming a priority date under section 34 of the Act, that will be the relevant date (September 23, 2010).

[28] In his Opposition statement the Opponent argued that the Applicant could not be entitled to obtain registration of the Mark under the provisions of section 16 of the Act, but without giving any further details. I note, however, that there is an allegation of confusion between the parties' marks in the Opposition statement. Given the evidence in the file [see *Novopharm Ltd v Astrazeneca AB* 2002 FCA 387], I interpret the whole as meaning that the argument is that the Applicant did not have the right to register the Mark because it led to confusion with the Opponent's VERNOM marks previously used or made known in Canada by the Opponent.

[29] In order to satisfy its initial burden of proof under section 16(3) of the Act, the Opponent should therefore have shown the use or making known in Canada of one of its VERNOM marks before the relevant date and that he had not abandoned them as of the date the Applicant's registration request was announced (May 8, 2013) [see *Optic Nerve Art & Design Ltd v Optic Nerve Design*, 2005 CanLII 78205, 2005 CarswellNat 4726 (TMOB)].

[30] In light of the Opponent's evidence described above, I believe the Opponent did not discharge his initial burden of proof. I have no evidence that the Opponent used the VERNOM marks within the meaning of section 4(1) of the Act. Nor is there any evidence establishing that any of the VERNOM marks was made known in Canada within the meaning of the definition of "deemed to be made known" in section 5 of the Act.

[31] In the circumstances, the Opposition argument based on section 16(3) of the Act is rejected because the Opponent did not discharge his initial burden of proof.

Ground of opposition based on section 12(1)d) of the Act

[32] The relevant date for analyzing this ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413, on page 424 (FCA)].

[33] As stated earlier, Mr. Walia produced a copy of extracts of the Register for each registration of the VENOM marks. I checked the Register and can confirm these registrations are still valid. Here, the Opponent did discharge his initial burden of proof.

[34] For the purposes of this opposition, I am of the opinion that the Opponent has a better chance of success if he refers to his VENOM and Design mark (VENOM bat) which was registered as TMA643,451 and reproduced above. That registration covers the Opponent's products. In other words, if I conclude that there was no probability of confusion between the Mark and the VENOM bat mark, I would also conclude that there was no probability of confusion between the Mark and the VENOM and Design marks registered as TMA763,824 and TMA763,782.

[35] It is therefore up to the Applicant to prove that, on a balance of probabilities, the use of the Mark in connection with the Products does not cause confusion with the Opponent's VENOM bat mark. The test to be applied to rule on this issue is stated in section 6(2) of the Act. This test does not address confusion between the marks themselves, but rather confusion regarding the source of the Products. That means I have to decide whether a consumer with an imperfect memory of the Opponent's VENOM bat mark, seeing the Mark used in connection with the Products, would believe they were offered or authorized by the Opponent.

[36] I must take into account all relevant circumstances, including those listed in section 6(5) of the Act, i.e. the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the goods, services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive and the same weight does not have to be given to each of the factors [see *Mattel Inc v 3894207 Canada Inc* 2006 SCC 22, 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques*

Cliquot Ltée [2006] 1 SCR 824, 2006 SCC 23 and *Masterpiece Inc v Alavida Lifestyles Inc et al* 2011 SCC 27, 92 CPR (4th) 361 (SCC) for a more in-depth analysis of the general principles governing the confusion test].

[37] As stated by the Supreme Court of Canada in *Masterpiece*, in most cases, the most important criterion is the degree of resemblance between the marks involved. I will therefore begin my analysis of the criteria enumerated in section 6(5) with this one.

Degree of Resemblance

[38] The Applicant argued that the marks in question have very different meanings and have very distinct visual appearances. The word VENOM in the VENOM bat mark is in current use in English and would be translated as “venin” in French. The Applicant asserted that the figurative elements are different: on the one side there is a bat and a letter V also shaped like a bat, whereas the Mark has the face of a serpent, indicating an aggressive attitude. As for the word VENUM, it uses distinct lettering analogous to the representation of a serpent. Lastly, the marks evoke different ideas. The idea associated with the VENOM bat mark is the bat, with the animal represented in two different places and the word “venom” which means “venin” in French. Whereas the Mark would be associated with a serpent.

[39] The Opponent argued that the only change to the word in the Mark was to replace the letter O in VENOM by a U to spell VENUM. He claimed that the visual aspect of each mark suggests a Gothic theme and added that the combinations of the picture part and the word part are similar, each having the visual representation directly above the word. That would make for a resemblance at both the visual and phonetic levels as well as in the ideas suggested by the marks.

[40] Although there is some resemblance in the word parts, I agree with the Applicant that, taken as a whole, the marks in question have different characteristics: the picture parts are different (a bat as opposed to a creature that looks like a serpent); the idea of a certain aggressivity evoked by the Mark’s visual aspect and the type of lettering used. Those differences are significant enough to counteract the effects of the similarities.

[41] Ultimately, I conclude that this factor slightly upholds the Applicant’s argument.

The inherent distinctiveness of the marks and the extent to which they have become known

[42] The Applicant argued that the Mark has a higher degree of inherent distinctiveness than the VENOM bat mark, since the word part is a made-up word whereas the word on the Opponent's mark is an English word. I think that each mark has a certain degree of inherent distinctiveness. As for how much weight to put on that factor, I think that in fact the Mark has a slight advantage over the Opponent's mark for the reasons stated by the Applicant. However, I do not think that very slight advantage is determinant in deciding overall whether the Mark raises confusion with the VENOM + bat mark.

[43] The distinctiveness of a mark can be enhanced by its use and the extent to which it has become known in Canada.

[44] During the hearing the Opponent made much of the absence of evidence that the Mark was used in Canada. He therefore claimed that the Applicant had not satisfied its ultimate burden of proof in demonstrating that there is no confusion between the parties' marks.

[45] Despite the fact that the ultimate burden is on the Applicant, it does not have to prove use of the Mark to discharge that burden. The registration request is in fact based on future use. The Applicant therefore has no obligation to use the Mark before it is admitted.

[46] There is no evidence to show that the Mark has become known in Canada to any extent whatsoever.

[47] As for the VENOM bat mark, for the above reasons I have no evidence of its use in Canada. However, given that the evidence shows that it appeared on ads during sporting events and some websites, I am able to conclude that it is better known than the Mark. But, since I have no information as to extent of those ads, I cannot determine just how well known it has become in Canada. Nevertheless, I can deduce that it is better known in Canada than the Mark.

[48] As a whole, that factor does not favour either of the parties because on the one hand the Mark has a slightly more inherent distinctiveness than the VENOM bat mark, but on the other hand the VENOM bat mark is better known in Canada than the Mark.

The length of time the trade-marks have been in use

[49] Since I have no evidence of the use of either of the marks concerned, as pointed out above, that factor does not favour either party.

The nature of the goods and the nature of the trade

[50] In considering the nature of the products and the nature of each party's trade, I have to compare the statement of products covered by the opposed request with the statement of products covered by the registration(s) alleged in the Opposition [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA) and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[51] However, the statements of products described in the Opponent's registration certificates for the VENOM marks and in the Applicant's registration request must be read in such a way as to determine the nature of the parties' trade. Evidence of the nature of the commercial activities carried on by the parties is useful in this sense [see *McDonald's Corp v Coffee Hut Stores Ltd* 1996 CanLII 3963 (FCA), (1996), 68 CPR (3d) 168 (FCA) and *American Optical Corp v Alcon Pharmaceuticals Ltd* 2000 CarswellNat 3328, 5 CPR (4th) 110 (TMOB)].

[52] The Opponent's argument can be summed up as this: both cases deal with sports equipment, so the parties' products fall into the same general category of products. The Opponent did admit during the hearing, however, that the Products are protective products to be worn while playing combat sports. The Opponent also admitted that different distribution channels would most probably be used to sell the parties' products to consumers, due to their natures.

[53] The Applicant admitted that the Products are used for playing sports just like the Opponent's products, except that the Opponent's products are intended for team sports (including cricket and field hockey), whereas the Applicant's products are intended for combat sports. The Applicant added that those are two different categories of sports. For team sports, all members of the same team have to look alike; their clothes will have the same logos; their clothes will be made to order and cannot be found on the shelves of sports stores. Lastly, the

Applicant argued that the average consumer of the Products differs from the average consumer of the Opponent's products because there is a difference between combat sports and the team sports associated with the Opponent's products.

[54] I take into account the fact that the statement of the Products mentions specific combat sports, whereas the statement of the products associated with the VENOM bat mark identities with team sports.

[55] I agree with the Applicant's claims. In addition, the Opponent admitted during the hearing that it is very probable that the parties use different distribution channels, given the nature of the sports with which their products are associated.

[56] For all the above reasons, I conclude that those factors favour the Applicant.

Additional argument of the Opponent

[57] During the hearing the Opponent raised a counter-argument to the effect that allowing the Mark to be registered would depreciate the goodwill associated with the VENOM marks and would have the effect of diluting them. He referred to the decision in *Veuve Clicquot Ponsardin, supra*. But that decision only applies when all the conditions of section 22 of the Act are present together. In our case, I have no evidence of the goodwill associated with the Opponent's marks and there is no evidence of use of the Mark that would have the effect of reducing the goodwill associated with the Opponent's marks.

[58] In the circumstances, I do not see how the notions of loss of goodwill, dilution of the Opponent's marks and section 22 could apply to a registration request based on future use.

Conclusion

[59] In light of the analysis of the criteria set out in section 6(5) of the Act, I believe that the Applicant has discharged its burden of proving on a balance of probabilities that the Mark does not cause confusion with the Opponent's VENOM bat mark. I have arrived at that conclusion because there are more differences than similarities between the parties' marks. In addition, the parties' products are different because the Products are intended for people involved in combat

sports while the Opponent's products are intended for people who play the team sports referred to above. Lastly, they use different distribution channels.

[60] As I have stated above, I am of the opinion that comparing the Mark with the VENOM bat trade-mark registered under number TMA643,451 is sufficient to dispose of the opposition argument based on section 12(1)(d) of the Act.

[61] Therefore, I reject the ground of opposition based on section 12(1)(d) of the Act.

Disposal

[62] In exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, I reject the opposition according to the provisions of section 38(8) of the Act.

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

Certified true translation
Susan Altschul, Certified Translator

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HEARING DATE: 2016-12-12

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