



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 063

**Date of Decision:** 2023-03-31

## **IN THE MATTER OF AN OPPOSITION**

**Opponent:** Planet Fitness Inc.

**Applicant:** Planet Fitness Franchising LLC

**Application:** 1782788 for PLANET FITNESS

## **INTRODUCTION**

[1] Planet Fitness Inc. (the Opponent) opposes registration of the trademark PLANET FITNESS (the Mark), which is the subject of application No. 1,782,788 (the Application), by Planet Fitness Franchising LLC (the Applicant).

[2] The Application was filed on May 17, 2016, in association with the services as reproduced below, together with the associated Nice class (CI):

CI 44 (1) Health spa services including tanning and massage.

CI 44 (2) Hair salon services and hair cutting.

[3] Services (1) are applied for on the basis of use in Canada since at least as early as December 15, 2014. Services (2) are applied for on the basis of use and registration

in the United States (under application No. 87/035,080), with a claim to a priority filing date of May 12, 2016 based on the aforementioned registration in association with the same kind of services.

[4] The Application was advertised in the *Trademarks Journal* of July 15, 2017. On September 18, 2017, the Opponent filed a statement of opposition against the Application pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). Numerous amendments to the Act came into force on June 17, 2019. However, as the Application was advertised prior to such amendments, pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read immediately before June 17, 2019.

[5] The original statement of opposition raised grounds of opposition based non-compliance with sections 30(b), 30(d), and 30(i), non-entitlement under section 16, and non-distinctiveness under section 2 of the Act.

[6] On January 24, 2018, the Applicant requested an interlocutory ruling with respect to the relevancy and sufficiency of particular paragraphs of the statement of opposition. The interlocutory ruling was issued on April 15, 2018, and struck the section 30(i) ground in its entirety, as well as partially struck the sections 30(b) and 30(d) grounds, to remove the allegation which referred to use in association with “goods”. Lastly, in the interlocutory ruling, the word “including” was replaced with “namely”, with respect to the non-entitlement grounds.

[7] The Applicant filed and served its counter statement on March 21, 2018, denying the grounds of opposition.

[8] In support of its opposition, the Opponent filed a certified copy of the present Application, and the affidavit of Shawn Freeborn, the Owner and President of the Opponent, sworn January 18, 2019, together with Exhibits A to H. Mr. Freeborn was cross-examined on his affidavit, and the transcript and responses to undertakings form part of the record.

[9] In support of its Application, the Applicant filed the affidavit of Justin Vartanian, General Counsel for the Applicant, sworn February 3, 2020, together with Exhibits A to Q; and the affidavit of Glenda O'Brien, Senior Library Reference Technician, employed by the agent for the Applicant, also sworn February 3, 2020, together with Exhibit A. Only Mr. Vartanian was cross-examined on his affidavit, and the transcript and responses to undertakings form part of the record.

[10] Both parties filed written representations and made representations at a hearing.

[11] For the reasons that follow, I refuse the Application.

## **EVIDENCE SUMMARY**

### ***Opponent's Evidence***

#### **Summary of the Freeborn Affidavit**

[12] In his affidavit, Mr. Freeborn attests to the following:

- In 1984, he was a partner in purchasing a health club called "Spa Olympia" located in a large hotel in Red Deer, Alberta (para 3);
- In 1988, he bought out his partner and acquired the Spa Olympia health club entirely. The health club offered members access to fitness equipment, fitness classes, fitness training, a racquet ball court, indoor golf, and full spa amenities, including tanning facilities, massage therapy, a dry sauna and a soaking tub (para 3);
- In 1991, he created a promotional division of Spa Olympia using the name Planet Fitness and started selling memberships (para 4);
- In 1992, he incorporated the company Olympia Fitness Ltd., operating as PLANET FITNESS, of which he is the sole owner, director and shareholder. This entity was the owner and user of the Planet Fitness trademarks, which include PLANET FITNESS, PLANET FITNESS CENTRE, THE PLANET FITNESS AND HEALTH SPA, THE PLANET FITNESS AND HEALTH CLUB and PLANET

MASSAGE (collectively, the “Planet Fitness Trademarks”) This entity licensed use of the Planet Fitness Trademarks to authorized licensees having indirect or direct control over the character and quality of the services advertised and performed in association with the licensed trademarks (paras 5 and 13);

- In 1994, he opened a PLANET FITNESS gym in Medicine Hat, Alberta, as well as started advertising licensing opportunities for PLANET FITNESS health spa locations out of his Red Deer location (paras 7 and 8). The PLANET FITNESS gym in Medicine Hat, Alberta was sold in 1995 (para 8);
- In 1996, Olympia Fitness Ltd., operating as PLANET FITNESS licensed the use of the trademark PLANET MASSAGE to Rochelle Freeborn (nee McEachern), a registered massage therapist, to expand the massage therapy facilities in the Red Deer location of the PLANET FITNESS health spa (para 9);
- In 1998, the Opponent negotiated a license agreement with Planet Fitness – L.A. Inc. (PFLA), which company subsequently opened a PLANET FITNESS health club in Leduc, Alberta. The terms of the license agreement included PFLA purchasing PLANET FITNESS advertising and agreeing to PLANET FITNESS prices, staff training, and standards of service. However, PFLA was not satisfying the conditions of the agreement. PFLA then sold the health club to another party which was not financially fit to meet the Opponent’s licensing criteria and Mr. Freeborn asked that all PLANET FITNESS signage be removed from the Leduc location and that the company change its name. The gym closed soon thereafter (para 11);
- By 2009, hair salon services were being provided at the Red Deer, Alberta, PLANET FITNESS location (para 12);
- On June 9, 2010, Planet Fitness Inc. was incorporated, of which Mr. Freeborn is the sole owner, director, and shareholder. Going forward, this business would oversee all licensing of the PLANET FITNESS Trademarks, and ownership of all

the Planet Fitness Trademarks and the goodwill associated with these trademarks was transferred from Olympia Fitness Ltd. (para 13);

- In 2012, Rochelle Freeborn (nee McEachern) moved her massage therapy business to another location, but continued to use the PLANET MASSAGE trademark under license and continued to do so as of the date of Mr. Freeborn's affidavit. Despite this move, massage therapy services have since continued to be provided at the Red Deer PLANET FITNESS health spa location in association with the Planet Fitness Trademarks (para 9).

[13] Mr. Freeborn attests that sales at the Red Deer, Alberta, PLANET FITNESS health spa location between 2003 and 2011 were in excess of \$2.74 million. As evidence of use of the Planet Fitness Trademarks and sales of the associated services, he provides:

- a sampling of daily sales reports for the Red Deer PLANET FITNESS location (Exhibit B).
- copies of advertisements and marketing material that were distributed in Alberta between 1992 and the date of his affidavit (Exhibit C).
- copies of membership agreements for the Red Deer PLANET FITNESS health spa (Exhibit D).
- excerpts from the PLANET FITNESS website, including archived excerpts (Exhibit E); and
- printouts of testimonials appearing on the Planet Fitness Inc. Facebook page (Exhibit F).

[14] Mr. Freeborn explains that PFIP LLC (PFIP), the former owner of the subject Application, is an American franchisor and operator of low-cost model fitness gyms under the name PLANET FITNESS. Mr. Freeborn further states that it is his belief that

PFIP opened its first PLANET FITNESS gym location in Toronto, Ontario in December 2014.

[15] Mr. Freeborn states that he and his staff began to keep written accounts of “instances where members or potential members confused his gym with the PLANET FITNESS gyms owned or franchised by PFIP LLC” (para 21). He provides as Exhibit G to his affidavit, what he describes are copies of these written accounts, dated between January 2017 and January 2019.

[16] Lastly, as Exhibit H to his affidavit, Mr. Freeborn provides a copy of an invoice dated November 15, 2018 from a radio station which he believes is related to radio advertising for the PLANET FITNESS gyms owned or franchised by PFIP. However, the invoice is addressed to the Red Deer location of the Opponent’s PLANET FITNESS health spa.

*Summary of the Cross Examination of Mr. Freeborn and Responses to Undertakings*

[17] Mr. Freeborn was asked what services were offered at the initial Spa Olympia health club. Mr. Freeborn answered that such services are noted in para 3 of his affidavit as follows: fitness classes, aerobics, fitness equipment, fitness training, a racquetball court, and sometimes a squash court, an 18-hole pebble beach golf course, full spa amenities, tanning facilities, massage therapy, a dry sauna, and a soaking tub sometimes referred to as a spa.

[18] Mr. Freeborn was then asked what services were provided by the promotional division of Spa Olympia (i.e. Planet Fitness) that was created in 1991. He answered promotional services, membership drives, staff training, consulting, problem solving, and lease negotiation.

[19] Mr. Freeborn was asked to identify which specific Planet Fitness Trademarks were being licensed out, to whom they were being licensed, and particulars regarding the dates of such licenses and the control that was exercised through license over the use of such trademarks, following the incorporation of Olympia Fitness Limited in 1992. Mr. Freeborn undertook to provide any such license agreements dating back to 1992, to

the extent that they were available. In this regard, Mr. Freeborn provided three such license agreements: the first agreement being with Planet Fitness L.A., which took effect in 1998 (and was in effect until 2002); the second agreement being with Rochelle McEachern, which took effect in 1996; and a third agreement, once again with Rochelle McEachern, which took effect in 2011.

[20] Aside from licensing, much of the focus of the cross examination was with respect to inquiring about which specific services were offered by the Opponent and/or its licensees over the years in association with the various Planet Fitness Trademarks. Further to this, Mr. Freeborn was asked questions regarding the various promotional materials attached to his affidavit under Exhibits C and D. More particularly, he was asked when each of the promotional materials were distributed and used. In this regard, Mr. Freeborn noted where dates were provided on the sample promotional materials and otherwise provided answers to undertakings for the dates when specific promotional materials were in use, to the best of his knowledge. These dates span from 1992 to the date of providing the answers to undertakings.

### ***Applicant's Evidence***

#### Summary of the Vartanian Affidavit

[21] Mr. Vartanian states that the Applicant's parent company, Planet Fitness, Inc. was founded in 1992 in Dover, New Hampshire. He explains that, currently, the Applicant is the owner of numerous PLANET FITNESS and PLANET-formative marks in Canada, and provides a list of 23 such registered trademarks at para 4 of his affidavit (which together with the Mark, comprise the Applicant's PLANET Marks), and as well as particulars of these marks under Exhibit B. He also provides particulars of the Applicant's US trademark registrations for its PLANET FITNESS and PLANET-formative marks (Exhibit C).

[22] Mr. Vartanian states that the Applicant, its predecessors-in-title (491609 B.C. Ltd. and PFIP) and/or their licensees have used the Mark in Canada since at least as early as January 1998 in association with the operation of health and fitness clubs, and since at least as early as December 15, 2014 in association with health spa services including

tanning and massage. He states that the Applicant launched its first PLANET FITNESS fitness centre in Canada on December 15, 2014, and that now the Applicant currently operates or licenses 45 Canadian fitness centres across the country (Exhibit D – a list of current Canadian PLANET FITNESS locations). He states that the Applicant diligently exercises control over the character and quality of the services offered by its licensees, and works closely with management at each PLANET FITNESS location to ensure that members can expect the same satisfying workout experience at every fitness centre.

[23] Mr. Vartanian explains that one tier of services (“Black Card” memberships) offered by the Applicant includes access to massage chair and hydromassage bed services. In support, he provides a screenshot featuring the manufacturer’s description of the hydromassage beds available to Black Card members in Canadian PLANET FITNESS fitness centres (Exhibit E), and a copy of the manufacturer’s product brochure for the hydromassage bed (Exhibit F).

[24] Mr. Vartanian states that the Applicant currently offers hair salon and haircutting services at some of its PLANET FITNESS fitness centres in the United States, and plans to commence offering these services in its Canadian fitness centres shortly.

[25] With respect to use of the Applicant’s PLANET Marks, he provides the following:

- photographs showing display of the Applicant’s PLANET Marks, including the Mark, at certain of the Applicant’s Canadian fitness centres, including on tanning beds, hydromassage beds, and massage chairs (Exhibit G). He states that these photos are representative of how the PLANET Marks, including the Mark, have been used continuously in association with the Applicant’s massage and tanning services since at least as early as December 15, 2014.
- Screenshots of current and Wayback Machine archived versions (for the dates December 31, 2019, June 2, 2017, April 6, 2016, February 28, 2015, and October 24, 2014) of the Applicant’s *planetfitness.ca* website, which he states advertises the Applicant’s Canadian PLANET FITNESS fitness centres (including specifically at the Grande Prairie, Alberta location) and the PLANET FITNESS



massage and tanning services available at the fitness centres (Exhibits H, I, and J). He states that these screenshots are representative of how the PLANET FITNESS Marks have been used in advertising the Applicant's massage and tanning services on its websites since at least as early as 2014.

- Further excerpts from the Applicant's *planetfitness.ca* website which include articles regarding the benefits of massage and of "Black Card" memberships at the Applicant's Planet Fitness gyms (Exhibits K and L).
- *Planetfitness.ca* website traffic figures for the years 2015 to 2019, including Canadian page views and Canadian users figures (para 20).
- Screenshots from the Applicant's PLANET FITNESS mobile app, which provides information regarding PLANET FITNESS memberships, exercise guides and tutorials, and activity tracking, as well as acts as a digital membership card for members (Exhibit M). He states that, as of January 31, 2020, the PLANET FITNESS app is the 78th most downloaded health and fitness app in the Apple App Store. He states that these screenshots are representative of the way in which the PLANET FITNESS Marks have appeared in the Apple App Store and in the app since its launch in 2016.
- Representative screenshots for the Applicant's PLANET FITNESS Canada Facebook page (with 4.3 million likes), Instagram page (with 7,700 followers), and Twitter page (with 3,800 followers), under Exhibits N, O, and P respectively.
- Sample flyers distributed by Canadian PLANET FITNESS fitness centres which he states are representative of the way in which the Applicant's PLANET FITNESS Marks have been used by the Applicant and its licensees in promoting the PLANET FITNESS services (Exhibit Q).
- Advertising expenditures for 2019 for Western Canada, Manitoba, and Ontario (para 25). He states that the Applicant's franchisees are required to contribute 2% of their membership fee revenue to a national Canadian advertising fund and

spend 7% of their membership fee revenue on regional or local advertising (paras 24 and 25).

- Canadian PLANET FITNESS membership figures, including Canadian “Black Card” membership figures for the years 2016 to 2019 (paras 26 and 27).

Summary of the Cross Examination of Mr. Vartanian and Responses to Undertakings

[26] Mr. Vartanian was asked questions regarding the history of the Applicant. He indicated that around 1992, two brothers purchased a Gold’s Gym in New Hampshire, which would be renamed Planet Fitness around 1993-1994. Mr. Vartanian was then asked what types of services were offered by the Applicant at the new Planet Fitness gym. He answers general fitness services, cardio equipment, strength equipment, free weights, and general gym equipment. Mr. Vartanian was then asked to provide an undertaking of samples of the use of the Applicant’s logo dating between 1992 and 1994.

[27] Aside from questions regarding the Applicant’s franchising of Planet Fitness gyms in the United States and the evolution of the services provided at these franchises to include “spa services”, Mr. Vartanian was asked when the Applicant opened its first Canadian club. In addition, Mr. Vartanian was asked about details pertaining to the acquisition and use of the trademark PLANET FITNESS (registration No. TMA489,857), stated in Mr. Vartanian’s affidavit to have been used in Canada since at least as early as 1998 in association with the operation of health and fitness clubs (Vartanian affidavit, para 6). Mr. Vartanian responded that the Applicant opened its first club in Canada in approximately December of 2014. With respect to questions surrounding the acquisition and use of TMA489,857, however, the Applicant’s agent objected to the line of questions as being unclear, impossible to answer, or irrelevant. In particular, a request to advise how the Applicant acquired an interest in the registration and provide any relevant document related to the acquisition of this registration was refused (Undertaking No. 5). However, a request was also made to provide the circumstances relating to the acquisition of this registration (Undertaking No. 9). The response was that “[O]n April 1, 2009, Planet Fitness entered into a purchase agreement under which the

trademark registration number TMA489857 was assigned to [the Applicant]”. Further to this, the Applicant was requested to provide evidence regarding the use of the Planet Fitness word mark in 1998 (Undertaking No. 6), to which the response was that Mr. Vartanian was “unable to provide a response to this particular undertaking as the requested information is unavailable.”

[28] The bulk of the remainder of the cross examination of Mr. Vartanian mainly pertains to questions surrounding the Applicant’s Planet Fitness gyms in Canada as of the opening of its first gym in 2014. In this regard, questions were asked concerning the specific services offered, any due diligence that was required of the Applicant’s franchisees or conducted by the Applicant with respect to determining the availability of the trademark Planet Fitness for use and registration in Canada, and details concerning advertising and marketing of the Mark (e.g. – national versus local, budget allocation by franchisor and franchisee, etc).

[29] Lastly, Mr. Vartanian was asked if at the time of launch of the Applicant’s first club in Canada, if the Applicant was aware of the Opponent’s Red Deer location and use of the name Planet Fitness. Mr. Vartanian answered that when the Applicant opened its first club in 2014, he believes that the Applicant was aware, but he is not sure previous to 2014, when the Applicant would have become aware. Mr. Vartanian was then asked to undertake to determine whether the Applicant was aware prior to 2014 of the Opponent’s use of the name Planet Fitness in Red Deer (Undertaking No. 12) and to advise if the Applicant was aware of the spa services offered by the Opponent at that location in 2014 (Undertaking No. 13). In response, Mr. Vartanian indicated that the Applicant was first aware of the Opponent’s use on or around February 2011, and that to the Applicant’s knowledge, there were no spa services being offered under the Planet Fitness trademark then or (currently) at the Red Deer location. Mr. Vartanian was further asked to advise how the Applicant identified the existence of 491609 B.C., the predecessor-in-title of the trademark PLANET FITNESS under registration TMA489,857 (Undertaking No. 23), and if such identification was for the purpose of acquiring the trademark (Undertaking No. 24). Mr. Vartanian answered that

491609 B.C. was identified through its ownership of TMA489,857, and that such identification was for the purpose of acquiring the trademark.

#### Summary of the O'Brien Affidavit

[30] Ms. O'Brien is a Senior Library Reference Technician employed by the agents for the Applicant.

[31] Ms. O'Brien attests that on January 30, 2020, she performed an online search using the WestlawNext Canada database for the phrase "PLANET FITNESS". She explains that the WestlawNext Canada database is a broadly used and reliable online searchable database which allows users to search the full text of several Canadian newspapers, including, The Globe and Mail, the National Post, the Toronto Star, the Windsor Star, and the Montreal Gazette. She attaches as Exhibit A to her affidavit, what she describes are selected articles obtained through her search. The articles range in date from December 2013 to December 2019.

#### **ANALYSIS**

##### ***Section 30(b) Ground of Opposition***

[32] As noted above, this ground of opposition was partially struck in the interlocutory ruling of April 15, 2018. The ground as amended now reads as follows:

The Applicant, contrary to paragraph 30(b) of the Act,

- never used, as alleged in the opposed application, [the Mark] in association with each of the services referred to in said application;
- the alleged date of first use is false, in whole or in part; and
- the Applicant failed, as the case may be, to name all of its predecessors in title.

[33] The material date with respect to a ground of opposition based on section 30(b) of the Act, is the filing date of the application; in this case, May 17, 2016 [see *Georgia-*

*Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) and *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)].

[34] Section 30(b) of the Act requires that there be continuous use of the applied-for trademark in the normal course of trade from the date claimed to the filing date of the application [*Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD) at 262]. An opponent's initial evidential burden under section 30(b) is light [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89] and can be met by reference not only to the opponent's evidence but also to the applicant's evidence [*Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230]. However, an opponent may only successfully rely upon the applicant's evidence to meet its initial burden if the opponent shows that the applicant's evidence puts into issue the claim set forth in the application [*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at paras 30-38].

[35] In the present case, this ground of opposition only applies to services (1), as services (2) are applied for on the basis of registration and use in the United States.

[36] In its written representations, the Opponent submits that there is no evidence that the Applicant's "predecessor used the trademark" and that the Applicant has "failed to provide any evidence of use of TMA489,857 by its predecessor-in-title (Applicant's response to undertaking #6)". However, the absence of evidence of use by the Applicant's predecessor-in-title concerning the services as registered in TMA489,857 for PLANET FITNESS is not a relevant consideration in the present proceeding under this ground of opposition. In the Application, services (1) are applied for on the basis of use in Canada since at least as early as December 15, 2014, not since 1998 (claim basis of TMA489,857), as per the undertaking #6 inquiry regarding evidence of use of the Planet Fitness word mark. In any event, the Applicant has provided evidence of use of the Mark itself and/or through its licensees in association with services (1) since the date of first use claimed in the application (as shown in the Vartanian affidavit, including, in Exhibits G, I, J, and Q).

[37] Consequently, as the Opponent has not met its burden to put into issue the accuracy of the Applicant's claimed date of first use, the ground of opposition based on section 30(b) of the Act is rejected.

**Section 30(d) Ground of Opposition**

[38] Noted above, this ground was partially struck in the interlocutory ruling of April 15, 2018. The ground as amended reads as follows:

The Applicant, contrary to paragraph 30(d) of the Act,

- never used and registered abroad, as alleged in the opposed application, [the Mark] in association with each of the services referred to in said application;
- the alleged date of first use or registration abroad is false, in whole or in part;
- the Applicant failed, as the case may be, to name all of its predecessors in title;
- any trademarks used or registered abroad by the Applicant (which is denied) are distinguishable from [the Mark]; and
- any trademarks used or registered abroad (which is denied) was by neither the Applicant nor its predecessor-in-title.

[39] The material date with respect to a ground of opposition based on section 30(d) of the Act, is the filing date of the application [see *Austin Nichols & Co, Inc v Cinnabon, Inc* (2000), 5 CPR (4th) 565 (TMOB)].

[40] The Opponent neither filed any evidence in support of this ground of opposition nor made any submissions with respect to the Applicant's evidence that would put into issue the claims with respect to services (2) in the Application.

[41] Consequently, as the Opponent has failed to meet its burden, the ground of opposition based on section 30(d) of the Act is rejected.

***Sections 16(1)(a) and 16(2)(a) Grounds of Opposition***

[42] With respect to both of these non-entitlement grounds, the Opponent pleads that at the filing date and at any relevant date, the Mark was confusing with the Opponent's Planet Fitness related trademarks, namely, PLANET FITNESS, PLANET FITNESS INC., PLANET FITNESS CENTRE, THE PLANET FITNESS AND HEALTH SPA, THE PLANET FITNESS AND HEALTH CLUB, and PLANET MASSAGE, which were previously used in Canada or made known in Canada by the Opponent or its predecessors-in-title (or for their benefit, by licensees), in association with health spa services, namely, massage.

[43] The material date for considering the section 16(1)(a) ground of opposition is the claimed date of use of the Mark, namely, December 15, 2014, as this ground of opposition is necessarily restricted to services (1), "health spa services including tanning and massage".

[44] The material date for considering the section 16(2)(a) ground of opposition is the Applicant's priority filing date, namely, May 12, 2016, as this ground of opposition is necessarily restricted to services (2), "hair salon services and hair cutting".

[45] Thus, the Opponent has an initial burden of establishing:

- that one or more of its trademarks alleged in support of its section 16(1)(a) ground of opposition were used or made known prior to the Applicant's claimed date of first use, namely, December 15, 2014 (with respect to services (1)), and were not abandoned at the date of advertisement of the Application (July 5, 2017) [section 16(5) of the Act]; and/or
- that one or more of its trademarks alleged in support of its section 16(2)(a) ground of opposition were used or made known prior to the Applicant's priority

filing date, namely, May 12, 2016 (with respect to services (2)), and were not abandoned at the date of advertisement of the Application.

[46] The Applicant submits that the Opponent's Planet Fitness Trademarks have not been used continuously and are not known to any extent. In this regard, the Applicant submits that, as the Opponent was only incorporated on June 9, 2010, the Opponent could not have used the relied upon trademarks prior to that date, and there is no evidence of an assignment from Olympia Fitness Ltd. to the Opponent. Furthermore, the Applicant submits that the Opponent has not provided any evidence that shows use of the Opponent's relied upon trademarks by the Opponent from June 9, 2010 to the claimed date of first use of the Applicant's Mark (or the priority filing date of the Application), other than "unsupported" statements from Mr. Freeborn.

[47] However, in the present case, Mr. Freeborn has clearly attested that ownership of all the Planet Fitness Trademarks and associated goodwill was transferred from Olympia Fitness Ltd. to the Opponent (Freeborn affidavit, para 13). Furthermore, Mr. Freeborn was and is the sole owner, director, and shareholder of both Olympia Fitness Ltd. and the Opponent. Consequently, I accept that Olympia Fitness Ltd. was the predecessor-in-title to the Opponent.

[48] Furthermore, insofar as "massage" services are concerned, the Freeborn affidavit shows use of the Opponent's trademarks PLANET FITNESS, PLANET FITNESS AND HEALTH SPA, PLANET FITNESS CENTRE, and PLANET MASSAGE in association with these services (Exhibit C). In this regard, the Exhibit C advertisements and marketing materials, which Mr. Freeborn states were distributed in Alberta between 1992 and the date of his affidavit, refer to these services as being part of the "Planet Massage Therapy Center" which is located at and affiliated with the Opponent's Red Deer Planet Fitness gym location. Furthermore, I am satisfied that any such use and provision of associated services by licensees inured to the Opponent's benefit pursuant to section 50 of the Act. In this regard, Mr. Freeborn has clearly attested to a license agreement with Rochelle McEachern, the registered massage therapist indicated on such advertisements to be providing massage services in



association with the trademark PLANET MASSAGE. Furthermore, he also clearly attested that, pursuant to this licensee agreement, the Opponent (or the Opponent's predecessor-in-title, as appropriate) had direct or indirect control of the character and quality of the services advertised and provided in association with the PLANET MASSAGE trademark (Freeborn affidavit, at para 9) [see *Empresa Cubana Del Tabaco v Shapiro Cohen*, 2011 FC 102 aff'd 2011 FCA 340]. In any event, he provided copies of such license agreements as an undertaking following cross examination.

[49] As such, I am satisfied that the Opponent has met its burden to show prior use of at least some of its relied upon trademarks, namely, PLANET FITNESS, PLANET FITNESS AND HEALTH SPA, PLANET FITNESS CENTRE, and PLANET MASSAGE. As such, I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with one or more such trademarks.

[50] In considering the issue of confusion, I will primarily focus on the Opponent's trademark PLANET FITNESS, as I consider this trademark to represent the Opponent's best chance of success, given that it is identical to the Mark.

### The Test for Confusion

[51] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the applicant's trademark, at a time when he or she has no more than an imperfect recollection of the opponent's trademark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée*, 2006 SCC 23 at para 20].

[52] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 6(5) of the Act, namely: a) the inherent distinctiveness of the trademarks and the extent to which they have become known; b) the length of time the trademarks have been in use; c) the nature of the goods, services or business; d) the nature of the trade; and e) the degree of resemblance between the trademarks, including in appearance or sound or in the ideas

suggested by them. This list is not exhaustive; all relevant factors are to be considered, and are not necessarily attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc* 2006 SCC 22; *Veuve Clicquot, supra*; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27].

Section 6(5)(e) - degree of resemblance in appearance, when sounded, or in idea suggested

[53] In most cases, the dominant factor in determining the issue of confusion is the degree of resemblance between the trademarks in their appearance or sound or in the ideas suggested by them, and other factors play a subservient role in the overall surrounding circumstances [see *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstering Ltd* (1980), 47 CPR (2d) 145, (FCTD), aff'd (1982), 60 CPR (2d) 70 (FCA)].

[54] In *Masterpiece, supra*, the Supreme Court of Canada considered the importance of section 6(5)(e) in conducting an analysis of the likelihood of confusion as follows at para 49:

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

[55] Bearing this in mind, I have elected to begin my analysis by considering section 6(5)(e).

[56] In this case, the parties' trademarks are identical in appearance and in sound, and therefore in ideas suggested as well. Accordingly, this factor strongly favours the Opponent.

Section 6)(5)(a) – the inherent distinctiveness and the extent to which the marks have become known

[57] The overall consideration of the section 6(5)(a) factor, involves a combination of inherent and acquired distinctiveness of the parties' trademarks.

[58] The Applicant submits that the trademark PLANET FITNESS is inherently distinctive as the dominant element PLANET is not descriptive or suggestive of the Applicant's services.

[59] As the parties' trademarks are identical, I conclude that the inherent distinctiveness of the parties' marks to be the same.

[60] The Applicant submits that, through extensive and continuous use and advertising in Canada since 1998 by the Applicant and its predecessors-in-title, the Applicant's PLANET FITNESS Mark has extensive acquired distinctiveness. The Applicant notes that it has more than 1.5 million webpage views as of 2019 by Canadians, more than 270,000 Canadian members, including more than 150,000 "Black Card" members, and has been featured in numerous Canadian newspapers. Additionally, the Applicant submits that as of 2019, it had 45 clubs across Canada and more than 13 million members in the United States.

[61] The Applicant submits that, on the other hand, the Opponent's Planet Fitness Trademarks and trade name have not been used continuously and are not known to any extent. As discussed above, the Applicant submits that as the Opponent was only incorporated on June 9, 2010, the Opponent could not have used its trademarks prior to that date, and there is no evidence of any assignment from Olympia Fitness Ltd. In any event, the Applicant further submits that the Opponent has not provided any evidence that shows use of the Opponent's trademarks from June 9, 2010 to the claimed date of first use of the Applicant's Mark, other than unsupported statements from Mr. Freeborn.

[62] With respect to Applicant's submissions regarding the extent to which the Mark has become known, the Application is based on use of the Mark in Canada with respect to services (1) since December 15, 2014. While I accept that the Applicant's evidence

shows use of the Mark in Canada in association with these services since this date, there is no evidence of use of the Mark by the Applicant or the Applicant's predecessors-in-title to support the Applicant's contention of extensive and continuous use and advertising in Canada prior to this date, let alone since 1998. In this regard, the evidence only establishes the existence of a series of prior registrations that have been acquired by the Applicant. This alleged family of marks however, will be discussed below as an additional surrounding circumstance.

[63] With respect to the Applicant's submissions that the Opponent's relied upon trademarks have not been used continuously and are not known to any extent, as previously indicated, I accept that the Opponent has evidenced use of the trademark PLANET FITNESS in association with massage services since 1992. The evidence with respect to establishing the extent to which that trademark has become, however, is less clear. In this regard, the evidence of use of the Opponent's relied upon trademarks is limited to Alberta. Moreover and more specifically, with the exception of a PLANET FITNESS club which opened briefly around 1994-1995 in Medicine Hat, Alberta, and an additional PLANET FITNESS club operating through license for a brief period of time in Leduc, Alberta, in 1998, the Opponent's evidence predominantly focuses on its PLANET FITNESS location in Red Deer, Alberta. While Mr. Freeborn has provided sales figures for memberships to the Opponent's Red Deer PLANET FITNESS health spa between the years 2003 and 2011, there are no sales figures provided with respect to massage services in particular. Furthermore, no distribution figures have been provided with respect to the advertising and promotional materials attached to Mr. Freeborn's affidavit.

[64] Consequently, while the inherent distinctiveness of the parties' marks is identical, overall this factor favours the Opponent, but not to any meaningful extent, given that the extent to which both parties' trademarks have become known is unclear based on the evidence before me.

Section 6(5)(b) – the length of time in use

[65] As noted above, the Opponent has demonstrated use of its PLANET FITNESS trademark since as early as 1992. The earliest date of use supported by the Applicant's evidence is the date of first use claimed in its application, namely December 15, 2014.

[66] Consequently, this factor favours the Opponent.

Sections 6(5)(c) and (d) – the nature of the services, business, and trade

[67] The Applicant submits that the Opponent has not provided any documentary evidence that substantiates Mr. Freeborn's claims that the Opponent provides similar services to those of the Applicant.

[68] I disagree; as per my analysis under sections 6(5)(a) and (b), I accept that the Opponent has shown use of the PLANET FITNESS trademark with respect to massage services, which directly overlap with the Applicant's massage services. Furthermore, the evidence demonstrates that both parties' services are offered through health/fitness clubs which also offer tanning services, which the Applicant has indicated in the Application as falling within the realm of "health spa services". Thus, the nature of the parties' respective businesses and trades are highly similar.

[69] With respect to "hair salon and hair cutting services", I agree with the Applicant that the Opponent has not provided any evidence that such services are provided by the Opponent beyond Mr. Freeborn's statement to this effect. Nevertheless, I am of the view that such services could be a natural extension for the Opponent, as the evidence shows that the Opponent (as well as the Applicant) is engaged in the provision of other aesthetic oriented services such as tanning.

[70] Consequently, I find these factors strongly favour the Opponent.

Surrounding Circumstance – Family of Marks

[71] The Applicant relies on ownership of 23 PLANET FITNESS and PLANET-formative trademark registrations in Canada, which it submits that it has used in Canada over the past 20 years. The Applicant submits that these registrations grant to the

Applicant the exclusive right to use these marks throughout Canada in association with the associated services and grant the Applicant a broad scope of protection.

[72] It is trite law that section 19 of the Act does not give the owner of a registration the automatic right to obtain any further registrations no matter how closely they may be related to the original registration [*Coronet-Werke Heinrich Schlerf GmbH v Produits Menagers Coronet Inc*, 4 CPR (3d) 108 (TMOB); *Groupe Lavo Inc v Proctor & Gamble Inc*, 32 CPR (3d) 533 (TMOB)].

[73] Furthermore, there can be no presumption of the existence of a family of marks in opposition proceedings. A party seeking to establish a family of marks must establish that it is using more than one or two trademarks within the alleged family [*Techniquip Ltd v Canadian Olympic Assn* (1998), 145 FTR 59 (FCTD), aff'd 250 NR 302 (FCA); *Now Communications Inc v CHUM Ltd* (2003), 32 CPR (4th) 168 (TMOB)].

[74] In the present case, the Applicant has not provided any evidence of use of the trademarks within the alleged family of marks. Therefore, I am unable to conclude that consumers would already be familiar with this alleged family of marks, such that they would readily associate the Mark with the Applicant. Consequently, I find this is not a relevant surrounding circumstance in the Applicant's favour.

[75] On the other hand, as previously indicated, I accept that the Opponent has provided evidence of use of a number its PLANET FITNESS Trademarks prior to the material date under this ground of opposition. Accordingly, this factor ultimately favours the Opponent, albeit not to a significant extent, given the evidentiary issues with respect to the extent to which such trademarks have become known in Canada, discussed above.

#### Surrounding Circumstance – Actual Confusion

[76] When assessing the issue of the likelihood of confusion, evidence of actual confusion in the marketplace is a relevant surrounding circumstance. However, it is not dispositive and does not override the other factors in the confusion analysis [*Venngo Inc v Concierge Connection Inc*, 2015 FC 1338 at para 125].

[77] The Applicant submits that the Opponent's evidence of actual confusion is inadmissible hearsay evidence or from after the applicable material date(s).

[78] The Opponent's evidence in this regard consists of what Mr. Freeborn states are written accounts that he and his staff had taken of instances where members or potential members confused his gym with the Applicant's PLANET FITNESS gyms, dated between January 2017 and January 2019 (Freeborn affidavit, Exhibit G). Admissibility considerations aside, this evidence post-dates the material date(s) and thus, will not be considered under this ground of opposition.

[79] Accordingly, I do not consider this to be a relevant surrounding circumstance in favour of either party.

#### Conclusion on Confusion

[80] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection.

[81] As previously indicated, in *Masterpiece*, the Supreme Court of Canada highlighted the importance of the section 6(5)(e) factor in the analysis of the likelihood of confusion. In the present case, the parties' trademarks are identical.

[82] Further to this, I have concluded that there is both direct and indirect overlap in the nature of the parties' services and businesses and in the nature of the parties' trades, with the length of time in use of the trademark further favouring the Opponent.

[83] Having regard to the above, I find that the balance of probabilities with respect to confusion between the parties' marks is strongly in favour of the Opponent. Therefore, the Applicant has failed to establish, on a balance of probabilities that the Mark was not confusing with the Opponent's PLANET FITNESS trademark as of the applicable material dates with respect to both services (1) and services (2).

[84] Accordingly, the sections 16(1)(a) and 16(2)(a) grounds of opposition, based on non-entitlement to register, are successful. As I considered the Opponent's PLANET

FITNESS trademark to represent its strongest case for confusion, it is not necessary to address the Opponent's remaining Planet Fitness Trademarks under these grounds.

***Sections 16(1)(c) and 16(2)(c) Grounds of Opposition***

[85] With respect to these grounds of opposition, the Opponent pleads that at the filing date and at any relevant date, the Mark was confusing with the Opponent's trade name, namely, the expression "PLANET FITNESS INC." previously used in Canada by the Opponent or its predecessors-in-title (or for their benefit, by licensees).

[86] The material date for considering the section 16(1)(c) ground of opposition is the claimed date of use of the Mark, namely, December 15, 2014, as this ground of opposition is necessarily restricted to services (1), "health spa services including tanning and massage".

[87] The material date for considering the section 16(2)(c) ground of opposition is the Applicant's priority filing date, namely, May 12, 2016, as this ground of opposition is necessarily restricted to services (2), "hair salon services and hair cutting".

[88] Thus, the Opponent has an initial burden of establishing:

- that its PLANET FITNESS INC. trade name alleged in support of its section 16(1)(c) ground of opposition was used prior to the Applicant's claimed date of first use, namely, December 15, 2014 [with respect to services (1)], and was not abandoned at the date of advertisement of the Application (July 5, 2017) [section 16(5) of the Act]; and/or
- that its PLANET FITNESS INC. trade name alleged in support of its section 16(2)(c) ground of opposition was used prior to the Applicant's priority filing date, namely, May 12, 2016 [with respect to services (2)], and was not abandoned at the date of advertisement of the Application.

[89] The Applicant submits that, as the Opponent was incorporated on June 9, 2010, it could not have used this trade name prior to this date. Further to this, the Applicant



submits that the Opponent has not provided documentary evidence that substantiates Mr. Freeborn's claims of use of the Opponent's PLANET FITNESS INC. trade name after June 9, 2010.

[90] While I have accepted that the Opponent has provided evidence of prior use of a number of its relied upon trademarks, the evidence of use of the Opponent's PLANET FITNESS INC. trade name post dates the material dates under these grounds of opposition (Freeborn affidavit at Exhibits E and F – website printouts and social media post printouts respectively).

[91] Consequently, the Opponent has failed to meet its burden under these grounds of opposition. Accordingly, the grounds of opposition based on confusion with the Opponent's trade name are rejected.

### ***Section 2 Ground of Opposition***

[92] As I have already found in the Opponent's favour with respect to two of its grounds of opposition under non-entitlement, I will refrain from addressing this ground of opposition.

### **DISPOSITION**

[93] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

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Kathryn Barnett  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** 2023-02-02

## **APPEARANCES**

**For the Opponent:** Shawn Freeborn

**For the Applicant:** Martha Savoy

## **AGENTS OF RECORD**

**For the Opponent:** No agent appointed

**For the Applicant:** Gowling WLG (Canada) LLP