

# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2024 TMOB 026

**Date of Decision:** 2024-02-12

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

**Opponent:** Spartan Race, Inc.

**Applicant:** Pascal Déry

**Application:** 1,890,872 for SpartanFit & Snake Warrior Design

### **INTRODUCTION**

[1] Pascal Déry (the Applicant) has applied to register the trademark SpartanFit & Snake Warrior Design (the Mark), reproduced below, which is the subject of application No. 1,890,872 (the Application) in association with the following services, as revised by the Applicant (the Services):



Services (Nice class & Statement):

35(1) Promoting public awareness of the benefits of physical activity

41(2) Conducting fitness classes; developing fitness programs; fitness training; personal fitness training services; physical education; physical education services; physical fitness consulting services; physical fitness instruction; providing information in the field of exercise via an interactive website; providing obstacle course training gym facilities; teaching physical fitness

44(3) Physical examination services; physical rehabilitation; physical therapy; physical therapy services; providing physical rehabilitation facilities

Claims:

Used in CANADA since January 15, 2016 on services (1),(2)  
Proposed Use in CANADA on services (3)

[2] Spartan Race, Inc. (the Opponent) opposes the Application based on several grounds, including (i) alleged confusion with the Opponent's family of common law trademarks, applied-for trademarks and registered trademarks comprising the word SPARTAN in Canada (collectively referred to as the "Spartan Race Trademarks"), including common law trademarks for SPARTAN, SPARTAN SGX, and SPARTAN RACE which have been used in Canada by the Opponent in association with obstacle and endurance races and fitness training since at least as early as 2015; and (ii) alleged bad faith of the Applicant in attempting to register the Mark in view of the Applicant's prior relationship with the Opponent as a certified SPARTAN SGX trainer.

[3] For the reasons that follow, the opposition succeeds.

**THE RECORD**

[4] The Application was filed on March 29, 2018, and was advertised for opposition purposes in the *Trademarks Journal* on January 1, 2020.

[5] On February 26, 2020, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The Act was amended on June 17, 2019. As the Application was advertised after this date it is the Act, as amended, that applies [section 69.1 of the Act].

[6] The Opponent raises grounds of opposition based on registrability under section 12(1)(d) of the Act, entitlement under section 16(1)(a), 16(1)(b) and 16(1)(c) of the Act, distinctiveness under section 2 of the Act, and non-compliance with sections 38(2)(a.1), 38(2)(e), 38(2)(f), and section 38(2)(a) in conjunction with sections 30(2)(a) and 30(2)(d) of the Act.

[7] On May 7, 2020, the Applicant filed and served a counter statement denying the grounds of opposition.

[8] Both parties filed evidence and written representations; no hearing was held.

### **THE PARTIES' RESPECTIVE BURDEN OR ONUS**

[9] The Opponent has the initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155].

### **OVERVIEW OF THE EVIDENCE**

[10] The parties' evidence is briefly summarized below and is discussed further in the analysis of the grounds of opposition.

#### ***Opponent's evidence in chief***

[11] The Opponent's evidence in chief is comprised of five affidavits. None of the Opponent's affiants were cross-examined on their affidavits.

#### **The Affidavit of Deanna Sheridan**

[12] At the time of swearing her affidavit on September 4, 2020, Ms. Sheridan was the General Counsel, Vice President and Corporate Secretary of the Opponent since July 1, 2018. She began working with the Opponent on August 22, 2016 in the role of Assistant General Counsel and Vice President.

[13] The Sheridan Affidavit speaks to the issue of use and promotion of the Opponent's Spartan Race Trademarks in Canada and the past dealings between the Opponent and the Applicant as a certified SPARTAN SGX trainer.

#### The Affidavit of Michael Stephan

[14] At the time of swearing his affidavit on September 5, 2020, Mr. Stephan was a Senior Investigator with Xpera Risk Mitigation & Investigation, an investigative firm that was retained by the Opponent's agent to determine if the Applicant's applied-for Mark and other applied-for trademark SpartanFit (that is the subject of Canadian application No. 1,966,977) are used as claimed in the Application and the Applicant's aforementioned other application, and to establish how long the trademarks have been in use. Mr. Stephan was also asked to determine if these marks are in use with the services of "*entraînement sur parcours d'obstacles*" and "providing obstacle course training gym facilities".

[15] The results of his investigations reveal two businesses in the province of Quebec associated with the Applicant and the Mark. One identified as SpartanFit, in Sainte-Julie, and a second location, Karaté Sunfuki Longueuil Inc., in Longueuil.

#### The Affidavit of Jessica Ferrier

[16] At the time of swearing her affidavit on September 2, 2020, Ms. Ferrier was an investigator with Xpera Risk Mitigation & Investigation. Ms. Ferrier was instructed to attend at the premises of the two businesses revealed by Mr. Stephan's aforementioned searches.

[17] The Ferrier Affidavit provides the results of her visits to these two locations.

#### The Affidavit of Avery Lee

[18] At the time of swearing his affidavit on September 1, 2020, Mr. Lee was a lawyer with the Opponent's agent. Mr. Lee ordered a copy of the prosecution file history of the Application from the Canadian Intellectual Property Office and attaches a copy of the file history to his affidavit.

### The (First) Affidavit of Suzy Torres

[19] At the time of swearing her affidavit on August 29, 2020, Ms. Torres was a Trademark Research Analyst with the intellectual property research firm Thomson CompuMark. Ms. Torres conducted two Canada Owner Searches, one for “SPARTAN RACE INC” and one for “PASCAL DÉRY” and attaches the results of her searches to her affidavit.

### ***Applicant’s evidence***

[20] The Applicant filed three affidavits of his own.

[21] An initial affidavit (in French), sworn on January 8, 2021, with exhibits the Opponent contended were ineligible, was later replaced by the Applicant with leave of the Registrar (the First Dery Affidavit (also in French), ultimately sworn on September 3, 2021). The First Dery Affidavit speaks to the issue of adoption and use of the Mark by the Applicant and his dealings with the Opponent.

[22] The Applicant was cross-examined by the Opponent (and re-examined by the Applicant’s counsel), with simultaneous interpretation, on his First Affidavit on October 13, 2021 and the transcript of the cross-examination and responses to undertakings form part of the record.

[23] On December 14, 2021, the Applicant sought leave to file a further affidavit of his own (the Second Déry Affidavit (also in French), ultimately sworn on February 10, 2022 (i.e. after leave granted by the Registrar on February 3, 2022).

[24] The Second Déry Affidavit provides, *inter alia*, the results of Internet searches using the Google search engine for “spartan training” [Exhibits PD-01 and PD-02]; a copy of an email from the Opponent to one of Applicant’s acquaintances dated February 13, 2020 titled “Meet your new favorite free workout” noting the Spartan Workout Tour of the Opponent being held at the SpartanFit location of the Applicant in March 2020 [Exhibit PD-03]; a copy of an email from the Opponent to the Applicant dated June 26, 2020 titled “Your guide to the Spartan Fit App” [Exhibit PD-04]; and a

copy of the Opponent's U.S. registration No. 6437652 for the trademark SPARTAN FIT & Design.

### ***Opponent's evidence in reply***

[25] The Opponent filed two affidavits as evidence in reply. Neither of the Opponent's affiants were cross-examined on their affidavits.

#### The Affidavit of Scott Nilson

[26] At the time of swearing his affidavit on August 22, 2022, Mr. Nilson was the Sr. Vice President, Global Events of the Opponent and held this position since 2020. From 2015 to 2020, Mr. Nilson was the General Manager, International, of the Opponent in which position he had direct management and oversight of the Opponent's international business.

[27] The Nilson Affidavit purports to, *inter alia*, contradict the Applicant's testimony in respect of the parties' past dealings and the alleged widespread use of the term "spartan" in association with fitness training and sport challenges. I am satisfied that the relevant parts of it, expressly discussed below, constitute proper evidence in reply. Besides, I note that the Applicant has not raised the issue in his written representations.

#### The (Second) Affidavit of Suzy Torres

[28] In her second affidavit, sworn August 17, 2022, Ms. Torres provides the results of a dilution search she carried out on the Canadian trademarks register for the term "spartan" in association with all services in international classes 35, 41 and 44 for active marks only. Again, I am satisfied that it constitutes proper evidence in reply as it purports to contradict the Applicant's testimony on the commonality of the term "spartan" in association with such services.

### **ANALYSIS OF THE GROUNDS OF OPPOSITION**

#### ***Non-registrability of the Mark under section 12(1)(d) of the Act***

[29] The Opponent has pleaded that the Mark is not registrable because it is confusing with the Opponent's registered trademarks set out in Schedule A to my

decision, which have been used in and throughout Canada and have not been abandoned.

[30] I have exercised my discretion to check the register and confirm that each of the Opponent's pleaded registrations remains extant [see *Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[31] As the Opponent's burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and any one of the Opponent's pleaded registrations.

[32] In this regard, I stress that the Opponent's registered marks must be reviewed individually and not collectively as a "family of marks" for the purpose of assessing the likelihood of confusion with the Mark. As discussed below, however, evidence of a family of marks is a relevant surrounding circumstance in each case.

#### The test for confusion

[33] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[34] Thus, section 6(2) of the Act does not concern the confusion of the trademarks themselves, but of the goods or services from one source as being from another. Also, where it is likely the public will assume an applicant's goods or services are approved, licensed, or sponsored by the opponent so that a state of doubt and uncertainty exists in the minds of the purchasing public, it follows that the trademarks are confusing [see *Glen-Warren Productions Ltd v Gertex Hosiery Ltd* (1990), 29 CPR (3d) 7 (FCTD) at para 21].

[35] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act. The weight to be given to each factor may vary, depending on the circumstances [see *Mattel, Inc v 3894207 Canada Inc* 2006 SCC 22, 49 CPR (4th) 321; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 for a thorough discussion of the general principles that govern the test for confusion]. These factors are considered below.

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

[36] The inherent distinctiveness of a trademark refers to its originality. Trademarks consisting wholly or in part of words descriptive of the articles to be sold or of the services to be rendered attract a more limited range of protection than does an invented, unique, or non-descriptive word or an original design [see *General Motors Corp v Bellows*, [1949] SCR 678, citing *Office Cleaning Services Ltd v Westminster Window & General Cleaners, Ltd* (1946), 63 RPC 39 at 41 (HL); and *Fairmont Properties Ltd v Fairmont Management LP*, 2008 FC 876].

[37] The Mark is not a dictionary word; however, it is comprised of two components which are dictionary terms, as acknowledged by the Applicant himself in his First Affidavit (which will be discussed in more detail below) [see paras 6 and 9 and accompanying Exhibit D-1 including excerpts from online dictionary and encyclopedia definitions making reference to the term “Spartan”].

[38] In this regard, I note that “Spartan” is defined both as a noun and as an adjective, as per the definition reproduced below that I have taken from the *Paperback Oxford Canadian Dictionary*, Second ed, 2006:

**Spartan:**

- **adj.** **1** of or relating to the city of Sparta in ancient Greece. **2 a** possessing the qualities of courage, endurance, stern frugality, etc. associated with Sparta. **b** (spartan) (of a regime, conditions, etc.) lacking comfort; austere.
- **n.** **1** a citizen of Sparta. **2** Cdn a



medium- or large-sized red eating or cooking apple, bred to withstand relatively cold winters.

[39] In his First Affidavit, the Applicant asserts that the word “Fit” is, in CrossFit, a diminutive of the term “Physical Fitness”, and that the term “Fit” was used by many fitness brands at the time of the adoption of the Mark. I am not prepared to take judicial notice of this fact. Still, I note the following definitions of the term “fit” provided in the *Paperback Oxford Canadian Dictionary*, Second ed:

**fit:**

• **adj.** **1 a** [...] well adapted or suited **b.** [...] qualified, competent, worthy [...] **2** in good health or athletic condition, esp. having excellent cardiovascular function. **3** [...]

[40] Considering the suggestive connotation of the word “spartan” in the context of the parties’ respective goods or services related to physical fitness, training, and the like, as well as the descriptive or suggestive connotation of the other word component comprising the Mark and the Opponent’s pleaded registered trademarks that are made up of two words, I assess the inherent distinctiveness of each of the parties’ trademarks as relatively weak, especially the Opponent’s pleaded word mark registrations as they do not include any design element that adds to the inherent distinctiveness of the marks.

[41] In this regard, I stress that the fact that there may be other “spartan” trademarks standing on the register of trademarks or used in the marketplace does not come into play when assessing the inherent distinctiveness of each of the parties’ trademarks *per se*. However, state of the register and/or marketplace evidence may constitute a relevant circumstance to be considered as an additional surrounding circumstance under the test for confusion. I will return to that point later.

[42] The degree of distinctiveness of a trademark may be increased by means of it becoming known through promotion or use. This brings me to turn to the evidence of use of the parties’ trademarks introduced mainly through the Sheridan Affidavit and the First Dery Affidavit respectively, in light of the parties’ representations.




The evidence of use of the Opponent’s pleaded registrations

[43] As summarized for the most part by the Opponent at paragraphs 12 to 23 of its written representations, Ms. Sheridan essentially attests to the following in her affidavit:

- The Opponent is a global leader in the sport of obstacle racing and is a global endurance sports brand and lifestyle brand. The Opponent was founded by Joe De Sena who was inspired by the warrior society of ancient Sparta to create a community of Spartans who overcome adversity, test their physical and mental fitness, and inspire each other. Spartan’s first obstacle course race was held in Vermont in 2010 and has grown to over 250 events annually across 42 countries, including Canada [Sheridan Affidavit, paras 3 & 4; Exhibit 1: excerpts from the Opponent’s websites at *www.spartanrace.ca* and *race.spartan.com*].
- The Opponent’s products and services include physical and mental fitness training apps and programs, apparel, fitness and workout equipment, nutritional products, and other types of running, endurance and fitness events and programs [Sheridan Affidavit, para 4].
- Ms. Sheridan provides a chart of the Opponent’s Canadian trademark applications and registrations containing the word Spartan (collectively the “Spartan Marks”) in association with obstacle and endurance racing and fitness training (the “Opponent’s Services”) and related exercise and nutrition goods (the “Opponent’s Goods”). The Opponent also owns trademark registrations for Spartan Race and/or Spartan for at least the services of obstacle racing in 67 countries [Sheridan Affidavit, paras 5 & 6].

I note that the chart provided by Ms. Sheridan includes two registrations and one application that have not been pleaded in the Opponent’s statement of opposition, namely:

Application / Registration No.	Trademark	Goods / Services (Nice class & Statement)
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<p>Appl'n No. 1936388</p>		<p>5(1) Vitamins; gummy vitamins. Claims: Proposed use in Canada</p>
<p>Reg. No. TMA937253</p>		<p>25.(1) Clothing, namely [...] 41 (1) Entertainment, namely, obstacle and endurance races; organizing community festivals featuring a variety of activities, namely, sporting events, [...]. Used in Canada since at least as early as May 20210</p>
<p>Reg. No. TMA1043205</p>		<p>21(1) Shaker bottles and cups sold empty. 28(2) Slam Balls, Medicine Balls, Resistance Bands, [...] Claims Proposed Use in Canada</p>

- The Opponent organizes and operates obstacle courses throughout Canada and began offering these events in 2012. The first event occurred in Montreal, Quebec on June 10, 2012. The Opponent held 14 events across Canada in 2013 alone. The Opponent also offers other services related to the operation of and training for its obstacle course events, as well as training and nutrition programs for customers [Sheridan Affidavit, paras 7-9; Exhibit 2: redacted copy of an internal presentation from 2018 showing examples of digital marketing ads used in connection with a 2018 Vancouver, B.C. event, as well as screen shots from *spartanrace.ca* which lists past Canadian races dating back to July 13, 2013].
- As early as 2012, the Opponent offered a certification program branded as Spartan SGX to license personal trainers around the world to coach participants under the Spartan Marks. A specific certification process is used to license individuals and there is a current roster of 58 personal trainers across Canada to

provide fitness coaching and training for obstacle course races [Sheridan Affidavit, para 9; Exhibit 3: copy of the *www.spartancoaches.com* website archived from August 14, 2012, which sets out the SGX coach certification process in place at the time; and Exhibit 4: copy of the license agreement template, which contains the current licensing terms for Spartan SGX coaches, and has been in place since 2017].

- The Opponent also sells a number of goods branded with the Spartan Marks in the provision of its obstacle courses and related physical fitness and nutrition programs. These include goods such as athletic and casual clothing, hats, fitness gear and water bottles. They may be purchased online at the Opponent's global e-commerce site <https://globalshop.spartan.com> and Ms. Sheridan is aware that these goods have been sold to customers in Canada. The Opponent's goods are also for sale onsite at Spartan events [Sheridan Affidavit, para 10; Exhibit 5: printout of the Opponent's aforementioned e-commerce website].
- Sales of services provided in association with the Spartan Marks in Canada were over 3 million dollars in 2017 and 2018 and were over \$500,000 in 2020 from January to September. Sales of goods branded with the Spartan Marks in Canada from 2015 to 2020 are set out in Ms. Sheridan's affidavit and in 2020 from January to September are in excess of \$900,000 [Sheridan Affidavit, paras 11 & 12]. However, no breakdown is provided per products or services.
- The Opponent owns the domain names *www.spartan.com*, *www.spartanrace.ca*, and *www.spartancoaches.com*. The *www.spartanrace.ca* domain is directed to Canadians and the obstacle course events and other events of the Opponent in Canada. The *www.spartancoaches.com* domain is directed to Spartan coaches and potential Spartan coaches to learn to teach the Spartan group training classes [Sheridan Affidavit, paras 13-15; Exhibit 6: printouts of the main page of each of these domain names].
- The Opponent advertises extensively across Canada, and annual dollar values of advertising in Canada are in excess of \$200,000. The Opponent relies heavily on digital marketing initiatives on social media websites like Facebook and Instagram to advertise its Goods and Services to customers. Spartan receives

publicity through third party publications and Ms. Sheridan attaches examples to her affidavit from Canadian Running website and Mud Run Guide [Sheridan Affidavit, paras 16 to 18; Exhibit 7: printouts of posts on the Opponent's Facebook and Instagram accounts; Exhibit 8: printout from the Canadian Running website titled "In Touch – Obstacle Racing" dated November 8, 2012, and a printout from the Mud Run Guide showing the "Montreal Spartan Race Spartan Sprint 2012"].

Upon review of Exhibit 8, I note that one can read in the article dated 9/3/2020 published by the *Canadian Running Magazine* that "obstacle course runs like TOUGH MUDDER and SPARTAN RACE are exploding in popularity" and that:

The last of the big three obstacle runs, Spartan Race, started in 2010 with four events, including one in Mont-Tremblant, Que., and a total of 5,000 participants. By 2012, the series was up to 38 events with an expected 750,000 participants. [...]

[44] In the last part of her affidavit, Ms. Sheridan describes the Opponent's previous dealings with the Applicant. Suffice it to say at this juncture that the Applicant registered for the May 25, 2014 Montreal Spartan Sprint Race using the email address *longueuil@karatesunfuki.com* and that he was designated by the Opponent as a Spartan Coach and has gone through the Spartan SGX Coach certification process set out at *www.spartancoaches.com*. More particularly, Ms. Sheridan states that the Applicant received his initial Spartan SGX Level 1 certification on April 31, 2017 and his Spartan SGX Level 2 certification on April 23, 2019 [Sheridan Affidavit, paras 19-20; above-described Exhibits 4 and 6; Exhibit 9: screenshot from the Opponent's registration database showing the Applicant's registration information for the 2014 Montreal Spartan Sprint race; Exhibit 10: copy of the SGX Levels 1 and 2 certificates awarded to the Applicant by the Opponent].

[45] Upon review of the various specimens of use provided by Ms. Sheridan, and based on a fair reading of her affidavit as a whole, I have no difficulty accepting that the Opponent has shown extensive use in Canada of the registered trademark SPARTAN RACE in association with entertainment services in the nature of obstacle and

endurance races, and that such trademark has become known to a significant extent in Canada, if not well-known among fitness enthusiasts.

[46] However, I am not prepared to accept that the same necessarily holds true with respect to the other goods and services covered by the Opponent's registrations for the trademark SPARTAN RACE. Indeed, I could not find any specimen of use of this trademark in association with the services of "organizing community festivals featuring a variety of activities" or either of the registered goods falling under Nice classes 21 (shaker bottles and cups sold empty) and 25 (clothing items and apparel) in the exhibited materials attached to the Sheridan Affidavit.

[47] With respect to each of the Opponent's remaining pleaded registered trademarks, I first note that I could not find any reference to the trademark SPARTAN UP in the exhibited materials attached to the Sheridan Affidavit. Second, while I accept that the Sheridan Affidavit does also evidence use of the Opponent's trademarks SPARTAN, SPARTAN & HELMET Logo, and SPARTAN KIDS in Canada in association with entertainment services in the nature of obstacle and endurance races, the pleaded registrations for the trademarks SPARTAN, SPARTAN & HELMET Logo, and SPARTAN KIDS do not cover services, but rather goods of either Nice classes 9 (e.g. chronometers and tachometers), 14 (e.g. sport watches), 21 (shaker bottles and cups sold empty), 25 (clothing items and apparel) and 28 (e.g. sporting articles). Here again, I could not find any specimen of use of either of the trademarks SPARTAN KIDS and SPARTAN in association with their respective registered goods. With respect to the trademark SPARTAN & HELMET Logo, I note that it is prominently displayed throughout the exhibited materials, including on the Opponent's e-commerce website printouts attached as Exhibit 5 to the Sheridan Affidavit. I note that these printouts include tabs to different categories of goods and services broadly described as "apparel", "footwear", "accessories", "training", "race", etc. and that some of these categories are further described as "training equipment", "training footwear", "women's training apparel" and "men's training apparel" together with photos of examples of products which again prominently display the SPARTAN & HELMET Logo. However, the extent to which the trademark SPARTAN & HELMET Logo has become known with

respect to each of the Opponent's registered goods falling under Nice classes 25 and 28 remain unclear. Indeed, as indicated above, the annual sales figures with respect to the Opponent's goods are not broken down per category of products and could therefore be associated to sales of only some of the Opponent's registered goods, like for example, T-shirts and headbands. As a matter of fact, the evidence includes a few photos of participants at some of the Opponent's obstacle races and training tours (including at the Opponent's Spartan Workout Tour event held at the Applicant's SpartanFit location in Sainte-Julie, as discussed below in my review of the Applicant's evidence of use of the Mark) wearing these particular kinds of apparel. At most, based on a fair reading of the Sheridan Affidavit as a whole, am I prepared to infer that the Opponent's trademark SPARTAN & HELMET Logo has become known to some extent in Canada in association with these particular kinds of derivative products.

#### The evidence of use of the Applicant's Mark

[48] I summarize below the relevant parts of the Applicant's testimony relating to the adoption and use of the Mark, considered as a whole (i.e. taking into consideration not only the evidence submitted by the Applicant by way of affidavits, but also the transcript of his cross-examination and his responses to undertakings).

[49] As summarized for the most part by the Opponent at paragraphs 37 to 49 of its written representations, the Applicant essentially attests to the following:

- The Applicant has a degree from Concordia and is self-employed. He is a third-degree black belt in karate-kenpo, a silver medalist of the World Karate Commission World Championships, a marathoner and a "proud survivor" of many extreme endurance races [First Déry Affidavit, paras 1-3].
- The Applicant has created physical fitness programs, including the group functional training program (in French: "*le programme d'entraînement fonctionnel en groupe*") he claims to have developed in 2015 under the name "SpartanFit" [First Déry Affidavit, para 4].
- The Applicant was the owner of the Karaté Sunfuki Longueuil karate school, which opened in August 2012, and served as the director and head instructor of

this school until it closed in March 2020. He states that he has provided personal coaching and physical fitness and activity training services under the SpartanFit name and under the SPARTANFIT and SPARTANFIT SNAKE WARRIOR and Design trademarks since January 15, 2016, and states that he continues to do so [First Déry Affidavit, paras 6, 7, and 11; Exhibit D-2: copy of the particulars of the Application obtained from the Canadian Intellectual Property Office Trademarks Database].

- The idea for the “invented term” (in French: “*terme inventé*”) “SpartanFit” was influenced firstly by the Applicant’s desire to offer a functional fitness class and that he was looking for a name that would represent the “martial” aspects of karate, which the Applicant states is related to militarism and is associated with warriors, and that would also appeal to fitness enthusiasts. The Applicant states that he was inspired by the popular epic movie “300” about Sparta and the Spartan ritual trials and CrossFit’s use of the abbreviation “Fit” for “Physical Fitness”. The Applicant states that he created the fused term (in French: “*l’expression fusionnée*”) “SpartanFit” and notes that the “warrior snake” design of the Mark serves as a tribute to the snake, which is a traditional martial arts icon representing the inner strength of each individual, while the helmet is a direct reference to Spartan warrior culture [First Déry Affidavit, para 9; Exhibit D-1: excerpts from online dictionary and encyclopedia definitions making reference to the term “spartan” and to the movie “300”].
- The Applicant further details the process through which he selected each of the elements of the Mark and provides under Exhibit D-3, screenshots of posts from his personal Facebook account showing posters with individual elements of the Mark in December 2015 (with respect to the SNAKE WARRIOR Design element) and January 2016 (with respect to the stylized term “SpartanFit”), but not the trademark in its entirety. I further note that each of these posts merely refer to [TRANSLATION] “my karaté school” (in French: “*mon école de karaté*”) [First Déry Affidavit, para 12, Exhibit D-3].
- The Applicant states that the first SPARTANFIT SNAKE WARRIOR DESIGN fitness class (in French: “*le premier cours de fitness SPARTANFIT SNAKE*”) was held on January 15, 2016, at the applicant’s gym in Montreal, Quebec.



*WARRIOR DESIGN*”) took place on January 15, 2016 in a room borrowed from the karate school Sunfuki in Longueuil (in French: “*dans un local emprunté de l’école de karaté Sunfuki à Longueuil*”) [First Déry Affidavit, para 14; Exhibit D-4: photos the Applicant alleges were taken during the launch day and the first class; and Exhibit D-5: copies of the Sunfuki karate schools monthly newsletters, dated March 2016, April 2017 and May 2016, which show the Mark in association with the advertising of “*un cours spécialisé [ouvert à tous] sur les courses à obstacles offerts tous les vendredis soirs*”].

As stressed by the Opponent in its written representations, the date stamp at the top of the photos at Exhibit D-4 shows the date of 20200209. During cross-examination, the Applicant claimed that this date was “The last date from Photoshop, following the last edit” and not the date the photos were taken [Cross-examination of First Déry Affidavit, Questions and Answers 108-110]. What is more, the image of the interior of the gym of the photos tendered by the Applicant look identical to the interior of the gym taken by the Opponent’s investigator at the SpartanFit gym in Sainte-Julie Quebec in 2020 [Ferrier Affidavit, Exhibit 2]. In any event, only the words “SpartanFit” appear on the photos tendered by the Applicant in support of the date of first use, and not the trademark in its entirety with the Snake Warrior design element.

I further note at this juncture that the Applicant also provided as Undertakings 1 and 3, a copy of the visual allegedly posted on the public bulletin board during the first class on January 15, 2016 (in French: “*le visuel affiché sur le babillard public lors du premier cours du 15 janvier 2016*”) displaying the Mark together with the following description:



However, as noted by the Opponent in its written representations, the Applicant did not mention a public bulletin board during his cross-examination.

- The Applicant obtained the Opponent's Spartan SGX Level 1 certification on May 10, 2017, which he alleges is 18 months after the creation of his SpartanFit courses [First Déry Affidavit, para 14, Exhibit D-6 (which matches Exhibit 10 to the Sheridan Affidavit)].

I note at this juncture that in answers to questions asked during his cross-examination, the Applicant indicated that he first attended a Spartan Race in 2012 at Mont-Tremblant. The Applicant attended 11 Spartan Races of the Opponent between 2012 and 2019. The Applicant received t-shirts and medals for participating in these races, and he signed up for them online through the Opponent's website [Déry Cross-examination, Questions and Answers 98-107]. The Applicant also confirmed having obtained the Opponent's Spartan SGX Level 2 Coach certification [Déry Cross-examination, Questions and Answers 139-146; Undertaking No. 4 (which matches Exhibit 10 to the Sheridan Affidavit)].

- The Applicant incorporated the Centre d'entraînement fonctionnel SpartanFit inc/SpartanFit Functional Training Center Inc. in July 2018 with the goal of setting up the service at an independent location; the centre opened its doors on February 9, 2020 [First Déry Affidavit, paras 16 & 17; Exhibit D-7: copy of extract from the *Registre des entreprises du Québec* with respect to this company (located in Sainte-Julie, and which matches the Spartan Fit location referred to in

the Stephan and Ferrier Affidavits); and Exhibit D-8: copy of advertisement on Facebook announcing the grand opening (in French: “*Grande ouverture*” of the centre and free “Spartanfit” group training classes)].

- The Applicant alleges that the “Spartan” aspect is universally used in relation to sport and physical endurance. He attaches under Exhibit D-9, the particulars of three Canadian trademark registrations containing the word “Spartan”, owned by third parties. I will return to this point when considering the additional surrounding circumstances.
- The Applicant states that at no time was he approached because the Mark was confusing. He refers to the Workout Tour event held by the Opponent at his SpartanFit centre in Sainte-Julie in March 2020 and states that no questions or comments regarding the potential for confusion were raised by the Opponent’s representatives or by the participants at the event. The Applicant states that the idea for the event came from his own initiative which was accepted and encouraged by one of the directors of the Opponent [First Déry Affidavit, para 20; Exhibit D-10: copy of the relevant page of the Opponent’s website that provides details of the event, as well as photos taken inside the centre with the participants wearing the t-shirts (displaying the SPARTAN & HELMET Logo trademark) provided by the Opponent itself]. I will return to this point when considering the additional surrounding circumstances.
- The Applicant states that [TRANSLATION]: “more than 1,500 clients and potential clients have used his services promoted under the Mark” and that the services offered by his company in Canada in connection with the Mark have generated an average net income of \$7000 per year for the years of 2016 to 2019, and approximately \$25,000 in 2020. [First Déry Affidavit, paras 21 & 22; Exhibit D-11: computer-generated and non-exhaustive list of the Applicant’s clients]. On cross-examination and in reply to Undertaking No. 5, the Applicant was not able to provide the income generated from the Mark in each of the years 2016-2019. The Applicant asserted that the figure communicated covers all the years in question, but it is not possible, to the best of the Applicant's knowledge, to make a breakdown of these amounts which would be related only to the use of his

Mark. I further note at this juncture that the average net income of approximately \$25,000 apparently coincides to the year during which the Applicant held one of the Opponent's Workout Tour events at his SpartanFit location in Sainte-Julie.

- The Applicant states that the Mark is clearly displayed in the performance and advertising of his services. In support, he provides a copy of SpartanFit's standard service contract displaying the Mark, printouts of Facebook and Instagram accounts and a sample of undated photos showing the Mark at the SpartanFit Functional Training Centre Inc., in unidentified public places during sporting events (including apparently one local arena) and on the side of unidentified public transit buses. He also provides a copy of publications (including a copy of the May 2020 local shopping bulletin of Sainte-Julie) and flyers having the Mark, and a sweater and protective mask [First Déry Affidavit, paras 23—32; Exhibits D-12-D-19].

Upon review of these exhibits, I note that they all essentially relate to the "*Cours de groupe / Obstacles*" offered through the Applicant's SpartanFit Centre in Sainte-Julie (including virtual workouts offered through Facebook during the temporary closure of the Centre during the Covid-19 pandemic). Not much information is provided as to the penetration of the Applicant's advertising efforts, which appear to have been mainly focussed within the area of Sainte-Julie.

- The annual expenses incurred for promotion and advertising of the Mark in Canada in connection with the Applicant's services were at least \$8,000 from 2016 to 2019 and \$15,000 in 2020 [First Déry Affidavit, para 32].

[50] Based on the foregoing evidence, I consider that the extent to which the Mark has become known in Canada is very limited and appears to be restricted to people living on the South Shore of Montreal, more particularly in the area of Sainte-Julie (and arguably, Longueuil, between the years 2016 and 2020, i.e. until the closure of the Karaté Sunfuki Longueuil karate school in March 2020), where the Applicant's group functional training program and physical fitness and activity training services would have been offered so far.

### Conclusion on the first factor

[51] On balance, I find that the first factor, which is a combination of inherent and acquired distinctiveness, significantly favours the Opponent to the extent that its registered trademark SPARTAN RACE in association with the Opponent's entertainment services in the nature of obstacle and endurance races, is concerned.

[52] I am also prepared to accept that this factor favours the Opponent with respect to its registered trademark SPARTAN & HELMET Logo, at least to the extent that the Opponent's collateral merchandise products in the nature of T-shirts and headbands are concerned.

[53] The first factor otherwise tends to favour the Applicant with respect to the Opponent's remaining pleaded registrations, in view of the greater inherent distinctiveness of the Mark conferred by the "Snake Warrior" design element.

### *The length of time the trademarks have been in use*

[54] In view of my comments made above, this factor also favours the Opponent to the extent that its registered trademarks SPARTAN RACE and SPARTAN HELMET & Logo are concerned.

### *The nature of the goods, services or business; and the nature of the trade*

[55] When considering the nature of the goods, services or business and the nature of the trade, I must compare the Applicant's statement of Services with the statement of goods and/or services in the registrations relied upon by the Opponent [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. Evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266

(TMOB); *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[56] In its written representations, the Opponent submits that the Services and the nature of the trade of the Applicant directly overlap with those of the Opponent and therefore, these factors favour the Opponent:

93. The services of the Applicant are either identical to or in the same field as the goods and services of the Opponent. The complete list of goods and services of the Opponent are set out in its trademark applications and registrations, but particularly pertinent to these proceedings are its services of obstacle and endurance races, as well as physical fitness and physical exercise training. The goods of the Applicant relate to fitness training services, including providing obstacle course training gym facilities and conducting fitness classes.

[...]

95. The nature of the trade of the Applicant and the Opponent directly overlap. The Opponent organizes and runs obstacle and endurance races and offers related goods and services.

96. The Opponent provided obstacle training and physical training for people to participate in the obstacle and endurance races of the Opponent. The Applicant has also started his own obstacle and endurance race he claims to operate under a different trademark. The consumers of the Opponent's goods and services are the same consumers who would use the services of the Applicant. This is evidenced from the Opponent's Workout Tour that the Opponent ran out of the Applicant's facility; the Applicant helped to run a workout for consumers who would be the same consumers that would participate in the Opponent's obstacle and endurance races.

[57] I am in general agreement with the Opponent's above submissions, not to mention that the Applicant made no submissions regarding these particular factors in his written representations.

[58] Notably, I note that Exhibit D-13 to the First Dery Affidavit expressly indicates that the Applicant's targeted audience comprises the Opponent's clientele, as per the following description:

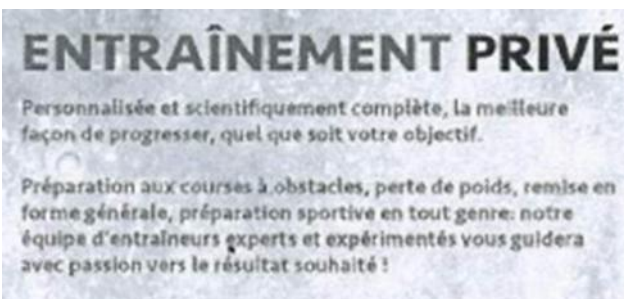
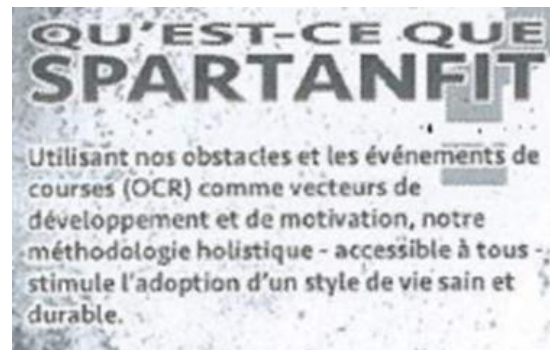
**Audience**

Men and Women, ages 14-45

Longueuil

Include people who match: Spartan, Sprint (running), Triathlons, Tough Mudder, Marathons, Obstacle course, Spartan race, Obstacle racing, Long-distance running, 10K run, Spartan Race Training, OCR World Championships, 5K run, Spartan

[59] Likewise, Exhibits D-15 and D-16 to the First Dery Affidavit expressly indicate that the Applicant's services are particularly suited for people who train for obstacle and endurance race events, as per the following descriptions:



[60] To sum up, I find that the parties' respective services and their associated channels of trade overlap. Therefore, these third and fourth factors favour the Opponent at least to the extent that its registered trademark SPARTAN RACE in association with

the Opponent's entertainment services in the nature of obstacle and endurance races, is concerned.

*The degree of resemblance between the trademarks, including in appearance or sound or in the ideas suggested by them*

[61] When considering the degree of resemblance between trademarks, they must be considered in their totality; it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trademarks [*Veuve Clicquot, supra* at para 20].

[62] In *Masterpiece, supra* at paragraph 64, the Court further advised that, while in some cases, the first word or syllable of a trademark will be the more important for the purpose of distinction, the preferable approach to considering resemblance "is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique".

[63] In this case, the Opponent submits that the Mark "very closely resembles the Opponent's SPARTAN family of marks in appearance, sound and ideas suggested by them."

[64] More particularly, the Opponent submits in its written representations that:

97. The trademarks are virtually identical in sound and ideas suggested by them; they are also very similar in appearance. The text elements of the marks both begin with the word "Spartan" and it is well established that the first part of the mark is the most important part when assessing confusion. The Applicant has integrated the word "fit" with Spartan and by his own admission it is a descriptive word to denote physical fitness and therefore does not add anything unique to the trademark. [...]

99. The design element of the Applicant's trademark is a snake wearing a spartan-style helmet. Although there is no snake element in any of the Opponent's marks, a spartan-style helmet features prominently in many of the marks of the Opponent, including TMA1042053, TMA1072734, TMA937253, and TMA1043205. As such, there is a high degree of similarity between the design elements of the marks, and the ideas suggested by the marks as they both couple the word Spartan with a spartan-style helmet. [...]

[65] I have omitted in the quotation reproduced above the Opponent's submissions relating to its "SPARTAN family of marks" and the dilution search for the word "spartan"



introduced through the second Torres Affidavit. These considerations do not come into play when assessing the degree of resemblance between the parties' trademarks, *per se*. I will return to the Opponent's submissions on these two points when considering the additional surrounding circumstances.

[66] For his part, the Applicant submits in his written representations that:

19. [...] when assessing the degree of resemblance between two trademarks to determine the likelihood of confusion, the marks must be examined as a whole, and not each element separately. To respect this principle, the applied-for Trademark must be examined as a combination of its word component "SpartanFit", and the Snake and Warrior Design. In its written argument, the Opponent refuses to use this holistic approach and chooses to separate the word element from the design element of the applied-for Trademark, which leads him to an incorrect conclusion regarding the degree of resemblance. [...]

20. Applying the appropriate holistic approach also grants a Word & Design Trademark a higher degree of inherent distinctiveness than its sole word component given its additional distinctive design elements. Thus, the made-up word "SpartanFit" becomes more distinctive when paired with the design element. This combination gives the applied-for Trademark a high degree of distinctiveness, which should be sufficient to defeat the grounds of opposition based on lack of distinctiveness and confusion with the Opponent's trademarks.

21. Looking at the word component "SpartanFit" of the applied-for Trademark, it must be noted that the Applicant has created a new word. Although it is possible to split this new word into two pre-existing words, the fact remains that the new combination forms a single lexical unit, as opposed to a sequence of words. The contested application includes "SpartanFit" as a whole, without any space separating the letters. Made-up words are generally granted a high degree of distinctiveness, as should the SpartanFit & Snake Warrior Design Trademark.

22. For the same reason, the descriptiveness analysis of the word "fit" that was brought up by the Opponent is irrelevant since "fit" is not used as a lexical unit in the Trademark.

23. In addition to the aforementioned, the high degree of distinctiveness of the SpartanFit & Snake Warrior Design Trademark also results from the pronunciation of its word component "SpartanFit", that constitutes a wordplay. When pronouncing "SpartanFit", one can alternatively hear three different words: "sport and fit". The fact that those words are related to the services listed in the application, such as training programs and physical education, shows the intention of the Applicant. This wordplay contributes to the uniqueness of the word component "SpartanFit", and thus increases its degree of distinctiveness.

[67] I agree with the Opponent that the dominant aspect of each of the Opponent's pleaded registered trademarks is the word SPARTAN. This word is either the sole element of the Opponent's trademarks or the more distinctive word element of the trademarks in addition to appearing in the first position of the trademarks. While the design element comprising the Opponent's SPARTAN & HELMET Logo trademark adds to the inherent distinctiveness of the trademark when the trademark is considered visually, I find it plays a secondary role and puts emphasis on the word SPARTAN as it merely consists of a stylised representation of a Spartan warrior.

[68] Turning to the Mark, I do not find persuasive the Applicant's submission that the word component "SpartanFit" "forms a single-lexical unit, as opposed to a sequence of words". It does not matter that the Mark is nominally coined as one word, since consumers would hear it and see it as the two dictionary words SPARTAN and FIT. This is particularly true when considering the use of the capitalized letters "S" and "F", each followed by lower case lettering. That being so, I agree with the Opponent that the dominant aspect of the phrase "SpartanFit" is the word SPARTAN which appears in the first position in addition to being more distinctive than the word FIT that would readily be understood by the relevant public as relating to fitness and sports. When the Mark is viewed as a whole, that is, together with the "Snake Warrior" design element, I still find that the dominant aspect of the Mark is the word SPARTAN. Indeed, while the "Snake Warrior" design element adds to the inherent distinctiveness of the Mark when the Mark is considered visually, I find it plays a secondary role and puts emphasis on the word SPARTAN as it would likely be perceived as a fanciful representation of a Spartan warrior, albeit in animal form. Furthermore, there would be no determinate pronunciation of that design element when the Mark is sounded.

[69] In view of all the foregoing, I find the Mark bears at least some degree of similarity with each of the Opponent's registered trademarks due to the presence of the common dominant word SPARTAN. Therefore, this fifth factor tends to favour the Opponent.

## *Additional surrounding circumstances*

### State of the register and marketplace evidence

[70] The Applicant submits in his written representations that the evidence he filed “demonstrates that the word “Spartan” was widely and commonly associated with fitness training and sport challenges around the time when the Applicant selected the “spartan” portion of the [M]ark”. More particularly, the Applicant submits that:

13. Literally, the term “Spartan” designates an ancient Greek soldier with remarkable physical assets. Deeply rooted in popular culture, this word refers to the attributes of a hyper-trained warrior, whose muscular composition is the main characteristic. The term Spartan thus evokes robustness, discipline, and rigorous training. This explains why it is usually associated with physical conditioning and strength training. As demonstrated by the exhibits accompanying the Applicant's affidavit, it is a widespread reference in global and Canadian fitness culture, which makes it a “common to the trade” term. The refusal of the Applicant's registration would amount in preventing registrations of almost any trademark associated with fitness goods or services that would include the word “Spartan”, and thus would deprive the fitness industry of one of its symbols.

14. The State of the Register evidence that was filed by the Applicant also contributes to reduce the degree of distinctiveness of the word “Spartan” in association with goods and services related to fitness training and sport challenges. It shows the commonality of this word in relation to the register, and that consumers are accustomed to distinguishing trademarks including the word “Spartan” based on relatively small differences. Weak marks are not entitled to a wide ambit of protection and comparatively small differences will be sufficient to distinguish them.

[71] In support of his above submissions, the Applicant apparently relies on the following exhibits:

- Exhibit D-9 to the First Dery Affidavit: the particulars of three Canadian trademark registrations containing the word “Spartan”, owned by different third parties, namely:
  - SPARTAN NUTRITIONAL CENTRE (TMA446802) in association with the “operation of a business selling dietary and nutritional foods, vitamins, herbal products, food supplements, and books, magazines and video tapes concerning fitness and nutrition.”
  - SPARTAN: TOTAL WARRIOR (TMA692631) in association various goods and services, such as “downloadable interactive entertainment software

for playing computer games” and “entertainment services in the form of electronic, computer and video games provided by means of the Internet and other remote communications device”.

- SPARTAN FITNESS EQUIPMENT (TMA787955) in association with :  
“fitness equipment, namely exercise bikes, teradmills [*sic*], rowing machines, elliptical trainers, steppers, cross trainers, multi gyms, strength training systems, and free weight”.
- Exhibits PD-01 and PD-02 to the Second Dery Affidavit: a printout of the first page of the videos tab for a Google search for “spartan training”; and a copy of Google search results for “spartan training”. Both searches were conducted on October 13, 2021 but cover different periods of time. The first one covers the period from January 1, 2006 to December 31, 2010, and the second one, the period from January 1, 2006 to December 31, 2009. The Applicant alleges that use of the term “SPARTAN” was widespread from 2006 to 2010 in conjunction with training programs, physical and sporting challenges and it was during that period that he first considered and chose the term “spartan” to be the heart of his SpartanFit brand a few years later in 2015 with the addition of the term “FIT”.

[72] Commenting on the Google [72] search results, I first note that a few of the videos listed at Exhibit PD-01 would apparently be derived or inspired from the movie 300 referred to above in my review of the First Dery Affidavit, and that a few others would have been uploaded by the same individual. However, it is not possible to determine to what extent, if any, one or more of the videos so listed, accessible on *www.youtube.com*, were actually accessed by Canadians, be it during that period of time or at any time. In the same vein, the Google search results at Exhibit PD-02 mostly refer to the movie 300, and none of the websites so listed display a .ca URL. Here again, it is not possible to determine to what extent, if any, one or more of these websites were accessed by Canadians. Thus, Exhibits PD-01 and PD-02 do not assist the Applicant in demonstrating that there has been widespread use of the word SPARTAN in Canada by third parties in the fields of physical fitness and training.

[73] Turning to the three third party Canadian registrations, I note that the Applicant indicated in his cross-examination that:

- The Applicant ordered online omega 3 oil from Spartan Nutritional Centre, but he did not have a Spartan race or take a class there [Questions and Answers 80-83.].
- The Applicant has not purchased products from, or used the services of, Spartan Total Warrior [Question and Answer 84].
- The Applicant had a tender or submission produced for equipment for his gym from Spartan Fitness Equipment, but he did not do an endurance race or obstacle course from such company [Questions and Answers 85-87].

[74] While not without merit, I do not find the foregoing three registrations and alleged two isolated purchases (without supporting exhibits) sufficient in themselves to support in any meaningful way the Applicant's position that there has been widespread use of the word SPARTAN in Canada in the fields of physical fitness and training. I find this is so because of the low number of registrations found and in the absence of any supporting exhibit with respect to such alleged use and extent to which any of these third party trademarks would have been used in Canada.

[75] Besides, I note that the "dilution" search for the word SPARTAN in Nice classes 35, 41, and 44 (the classes of Services of the opposed Mark) provided by the Opponent through Exhibit ST-1 to the Second Torres Affidavit, shows at most six other third party registered trademarks and one official mark comprising the word SPARTAN, which number by itself remains, in my view, too low to draw any meaningful inference that could be to the Applicant's advantage in this case. Indeed, while I am mindful that there is no precise threshold of number of similar marks needed to establish that an element of a mark is commonly adopted as a component of trademarks used in association with relevant goods or services, the Federal Court cautioned in *Hawke & Company Outfitters LLC v Retail Royalty Company*, 2012 FC 1539, that a register search is not the best way to establish the state of the marketplace, since the fact that a mark appears on the register does not show that it is in use, was in use at the material

date, or is used in relation to goods or services similar to those of the parties, or the extent of any such use. [See also *Canada Bread Company, Limited v Dr Smood ApS*, 2019 FC 306]. Moreover, the Opponent also provided, through Exhibit 10 to the Nilson Affidavit, a Google search for the word SPARTAN limited to Canada, which does not suggest that SPARTAN is common to the fields of sport and physical endurance.

#### Opponent's SPARTAN family of marks

[76] As mentioned above under the section 6(5)(e) factor, the Opponent submits that it owns and uses a family of trademarks which each incorporate the word SPARTAN. The Applicant did not specifically comment on this point, merely submitting at paragraph 18 of his written representations that: "While the Opponent filed evidence trying to show some degree of acquired distinctiveness in association with its marks, it is submitted that it shall not be given much weight, as it shall not offset the arguments presented in the previous paragraphs" (i.e., essentially, the weak inherent distinctiveness of the word SPARTAN in the context of physical conditioning and strength training; the Applicant's state of the register evidence; and the coexistence of the parties' trademarks without confusion (discussed below)).

[77] 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)].

[78] I accept that the Opponent has demonstrated use of more than two trademarks which include the word SPARTAN and in this sense may be considered to have demonstrated the existence of a family of trademarks. More particularly, I am prepared to find that in addition to the Opponent's above discussed registered trademarks SPARTAN RACE and SPARTAN & HELMET Logo, the Opponent has evidenced use of the trademarks SPARTAN KIDS in association with kids races (per the Opponent's website extracts at [www.spartanrace.ca](http://www.spartanrace.ca) attached as Exhibits 1 and 6 to the Sheridan Affidavit), and SPARTAN SGX in association with the conducting of its certification program to license personal trainers across Canada (per aforementioned Exhibit 6, and

also copy of the SGX Levels 1 and 2 certificates awarded to the Applicant by the Opponent attached as Exhibit 10 to the Sheridan Affidavit).

[79] Thus, I find this surrounding circumstance assists the Opponent to a slight degree. However, I wish to specify that my conclusion regarding confusion would be the same even if I had not considered this surrounding circumstance to assist the Opponent.

#### Coexistence of the parties' trademarks

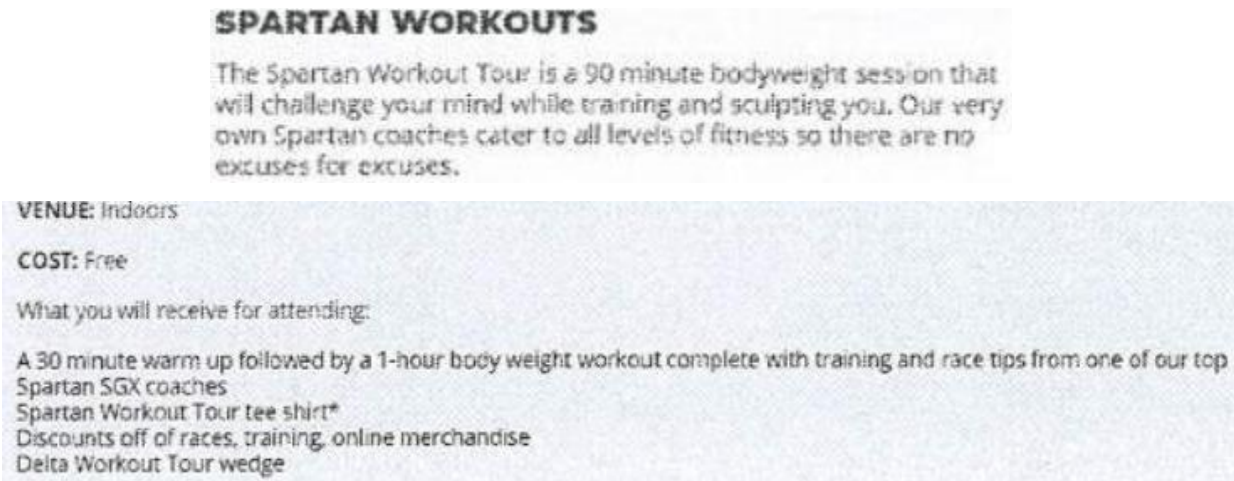
[80] The Applicant argues that the coexistence of the parties' trademarks is a surrounding circumstance which weighs in his favour. More particularly, the Applicant submits in his written representations that:

17. The fact that the [Mark] and the Opponent's trademarks have coexisted for several years also tends to point out that there is no confusion. It should be noted that there was no instance of actual confusion among consumers filed in evidence. No evidence of mislead regarding the source of the services associated with the [Mark] were found, even though the Opponent hired investigators to visit the Applicant's premise. It also appears from the evidence that the Opponent held some classes at the Applicant's premises with the SpartanFit mark well in view, without any problem being raised by anyone.

[81] Evidence of instances of actual confusion is not required in order to demonstrate a likelihood of confusion. However, concurrent use of two trademarks without such instances of actual confusion is a surrounding circumstance which can suggest an absence of a likelihood of confusion, depending on the specific nature and duration of that concurrent use [see *Christian Dior SA v Dion Neckwear Ltd*, 2002 FCA 29, 20 CPR (4th) 155 at para 19].

[82] In the present case, while the evidence of record indicates that the Applicant has used the Mark in Canada since, arguably, January 2016, the extent of that use remains, as indicated above, very limited and appears to be restricted to people living in the area of Sainte-Julie (and arguably, Longueuil, between the years 2016 and 2020), where the Applicant's group functional training program and physical fitness and activity training services would have been offered so far.

[83] Furthermore, I note that the Opponent's Workout Tour event that was held at the Applicant's SpartanFit centre in Sainte-Julie in March 2020 described the Applicant as one of the Opponent's "very own Spartan coaches" or "top Spartan SGX coaches", as per the following descriptions taken from the Opponent's website excerpt attached as Exhibit D to the First Dery Affidavit:



[84] What is more, the participants were all wearing the Opponent's Spartan Workout Tour tee shirts, prominently displaying the Opponent's SPARTAN & HELMET Logo [as per the photos provided by the Applicant, also included at Exhibit D to the First Dery Affidavit].

[85] In the same vein, I note that when Ms. Ferrier attended the premises of SpartanFit, in Sainte-Julie on February 18, 2020, she was told by the Applicant (who was wearing a black "SPARTAN Race" hoodie), that "he used to, and still is, giving courses of Spartan SGX at a karate school in Longueuil". Ms. Ferrier also noticed at the reception desk, *inter alia*, a brochure for the above-mentioned workout tour [Ferrier Affidavit, para 5; and Exhibit 1 comprising a copy of the brochure prominently displaying the Opponent's trademark SPARTAN & HELMET Logo]. When Ms. Ferrier later attended the premises at Karaté Sunfuki Longueuil Inc. on February 20, 2020, she noticed that "Spartan SGX was visible on the outdoor sign, on a brochure and on long sleeve shirts for sale" [Ferrier Affidavit, paras 8; and Exhibit 3: copies of photo images she took at this location]. To the same effect, Mr. Stephan's review of archived



webpages associated with Karate Sunfuki's website reveal that on a 2018 archived website, the Applicant's background description changed to include his certification in "Spartan SGX" and training for the "Spartan Race" [Stephan Affidavit, para 10; and Exhibit 6].

[86] In the circumstances, it may not be surprising that no questions or comments regarding the potential for confusion between the parties' trademarks were raised by the participants at the above-described workout tour event or by the Applicant's clients. Indeed, it may well be that the Applicant was perceived as a duly authorized licensee or affiliate of the Opponent.

[87] Before concluding on this factor, I shall add that I am not prepared to afford weight to Mr. Nilson's statements made at paragraphs 12 and 13 of his affidavit, according to which:

- on or about April 2020, Mr. Raymond Joseph (Business Director of Spartan Race (Canada) Inc., at the time) spoke with the Applicant who refused to cease use of trademarks confusingly similar to the Opponent's trademarks; and
- on or about July 8, 2020, Raymond Joseph and Laura Gill (Human Resources and Volunteer Manager of Spartan Race (Canada), Inc.) spoke with the Applicant about his use of trademarks confusingly similar to trademarks belonging to Spartan and the Applicant did not agree to stop using any such marks.

[88] Indeed, these allegations constitute inadmissible hearsay.

[89] To sum up, I find that this surrounding circumstance does not assist either party in any meaningful way.

#### Bad faith

[90] In its written representations the Opponent argues that:

103. The Opposition Board must also consider the bad faith conduct in assessing confusion in this case. As has been set out above, the Applicant entered into a license agreement with the Opponent which set out the terms through which the Applicant was able to use the intellectual property of the Opponent in completing SPARTAN SGX

workshop and certification requirements. The license agreement was entered into before the opposed application was filed. Among other things, for the term of the license and after, the license expressly prohibited any application for registration anywhere worldwide of any trademark or copyright applications or registrations, or any domains, for or containing the licensed marks of "SPARTAN" or any word, phrase, portion or element of any of the foregoing, or any images, designs, graphics, devices, indicia, artwork, works and logos used therewith or used by Spartan, including those depicting helmets or other indicia historical or otherwise related to or associated with ancient Sparta or the ancient spartans, and/or any similar derivations, variations, or colorable imitations of the foregoing, in whole or in part, in connection with any and all goods, services and activities. The Applicant did not comply with the terms of the license he was a party to and this bad faith on behalf of the Applicant should factor into a finding of confusion by the applicant. The Applicant did not invent the Trademark for the reasons supported by internet searches after the Application was opposed.

[91] With respect, I fail to see how the alleged bad faith of the Applicant constitutes a relevant surrounding circumstance in the assessment of the likelihood of confusion *per se*. As stated above, likelihood of confusion is to be assessed as a matter of first impression and imperfect recollection from the standpoint of an average consumer. Furthermore, I note that the alleged bad faith of the Applicant is the subject of a separate ground of opposition based on section 38(2)(a.1) of the Act.

[92] In the same vein, I note that the Applicant's submits in his written representations that:

17. The fact that the Opponent launched an app (as in "telephone application"), named similarly to the word component of the Applicant's [Mark], after the Applicant has started using the [Mark], rather suggests bad faith on the part of the Opponent, as evidenced in the Applicant's additional evidence. By way of filing an Opposition to the Applicant's trademark Application, it seems clear that the Opponent is trying to put undue pressure on the Applicant and seek to appropriate the term "SpartanFit" in anticipation of the launch of its app in Canada. This should be taken into consideration when assessing the merits of the Opposition.

[93] However, here also, I fail to see how the alleged bad faith of the Opponent constitutes a relevant surrounding circumstance in the assessment of the likelihood of confusion *per se*.

[94] To sum up, I find that this surrounding circumstance does not assist either party.

*Conclusion – likelihood of confusion*

[95] As indicated above, the Applicant bears the legal onus of establishing on a balance of probabilities that there is no likelihood of confusion between the trademarks at issue. The presence of a legal onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant.

[96] Contrary to the Applicant's contention, the issue is not whether the Opponent ought to be afforded a "monopoly" over the word "SPARTAN" in Canada, but whether an individual having an imperfect recollection of either one of the Opponent's registered trademarks would conclude, as a matter of first impression and imperfect recollection, that the Applicant's Services come from the same source or are otherwise associated with the Opponent. I find this is such a case, at least insofar as the Opponent's registered trademark SPARTAN RACE in association with entertainment services in the nature of obstacle and endurance races is concerned.

[97] Indeed, I am of the view that the Opponent's evidence raises sufficient doubts as to the likelihood of confusion between the Applicant's Services and at least that one registered trademark of the Opponent. Although the parties' marks differ from each other in certain respects and are not inherently strong, the Opponent's SPARTAN RACE trademark has become known to a very significant extent in Canada, if not well-known among fitness enthusiasts, which increases its distinctiveness compared with that of the Mark. In addition, the parties' services and their respective channels of trade clearly overlap.

[98] My finding is reinforced when the Opponent's SPARTAN family of marks is factored in.

[99] Consequently, the section 12(1)(d) ground of opposition succeeds.

***Non-distinctiveness of the Mark under section 2 of the Act***

[100] The Opponent has pleaded that the Mark is not distinctive since it is neither adapted to distinguish nor does it actually distinguish the applied-for Services of the

Applicant from the goods and services of the Opponent used in association with the Opponent's Spartan Race Trademarks.

[101] In order to meet the initial evidential burden for a distinctiveness ground of opposition, an opponent must show that its trademark had a substantial, significant or sufficient reputation in Canada [see *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 at paras 33 and 34]. The material date for assessing this ground of opposition is the filing date of the opposition, namely, February 26, 2020 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317]. With this ground of opposition, an opponent's evidence is not restricted to the sale of goods or services in Canada. It may also be based on evidence of knowledge or reputation of an opponent's trademark, including that spread by means of word of mouth or newspaper and magazine articles [*Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FC) at para 45].

[102] The Opponent has demonstrated a sufficient reputation in Canada in its trademark SPARTAN RACE prior to the material date to satisfy its initial evidential burden for this ground of opposition.

[103] The legal burden then shifts to the Applicant to demonstrate that its Mark was distinctive in Canada as of February 26, 2020. For essentially identical reasons to the analysis of confusion for the ground of opposition under section 12(1)(d) of the Act, I conclude that the Applicant has not satisfied its legal burden under section 2 of the Act.

[104] Consequently, the section 2 ground of opposition succeeds.

***Remaining grounds of opposition***

[105] As the Opponent has succeeded under two grounds of opposition, it is not necessary to address the remaining grounds of opposition.

**DISPOSITION**

[106] 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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Annie Robitaille  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

## SCHEDULE A

### *Particulars of the Opponent's pleaded registrations*

Trademark	Reg. No.	Goods/Services [& Nice class]
SPARTAN RACE	TMA847366	[41] (1) Entertainment, namely, obstacle and endurance races; organizing community festivals featuring a variety of activities, namely, sporting events, art exhibitions, flea markets and ethnic dances.
SPARTAN RACE	TMA929063	[25] (1) Clothing, namely coats, hats, jackets, pants, shirts, shorts, socks, sweat shirts; tops, namely tank tops, top coats, bras, halter tops and sleeveless tops.
SPARTAN	TMA993791	[9] (1) Chronomètres, tachymètres, capteurs pour déterminer la vitesse, indicateurs de vitesse, podomètres, récepteurs pour système mondial de localisation (GPS), [...], tous les produits précité sont utilisés pour des activités sportives ou de plein air  [14] (2) Montres de sport, montres de sport avec fonction de suivi du rythme cardiaque
SPARTAN & Design 	TMA1042053*  *I note that there was an error in the registration number provided in the	(1) Tops, namely tank tops, top coats, sports bras, bras, halter tops and sleeveless tops, namely hooded tops, vests and work out tops; athletic bottoms, namely shorts, tracksuit bottoms and pants for exercise and obstacle course racing; shorts; coats;

	<p>statement of opposition in that it incorrectly read "TMA1042093". However, this error is of no consequence if not only because the correct corresponding application number was provided.</p>	<p>jackets; vests; fleece tops; fleece bottoms; sweatshirts; socks; compression garments for athletic or other non-medical use, namely, shorts, t-shirts, socks, sleeves; underwear; thermal underwear; swimwear; t-shirts; headgear, namely hats, caps, sun visors, headbands, knit hats and skull caps.</p> <p>(2) Workout gloves; weightlifting gloves; grappling gloves; kick pads; arm guards for athletic use; wrist guards for athletic use; forearm guards for athletic use; head guards for athletic use; calf guards for athletic use; shin and instep guards for athletic use; spears and spear tips; exercise equipment, namely plyometric boxes, muscle rollers, chin-up bars, weighted bags, jump ropes, weighted jump ropes, exercise ropes.</p> <p>(3) Tops, namely t-shirts, tank tops, fleece tops and sleeveless tops, namely hooded tops, vests and work out tops; athletic bottoms, namely shorts, pants and tracksuit bottoms for exercise and obstacle course racing; shorts; sweatshirts; compression garments for athletic or other non-medical use, namely, tops, namely t-shirts, tank tops, fleece tops and sleeveless tops, namely hooded tops, vests and work out tops, bottoms, namely shorts, pants and tracksuit bottoms; hats.</p>
SPARTAN KIDS	TMA1072731	[21] (1) Shaker bottles and cups sold empty.

SPARTAN	TMA1072731	[21] (1) Shaker bottles and cups sold empty.
SPARTAN RACE	TMA1072718	[21] (1) Shaker bottles and cups sold empty.
SPARTAN & HELMET Logo 	TMA1072734	[21] (1) Shaker bottles and cups sold empty.



# Appearances and Agents of Record

**HEARING DATE:** No hearing held

## **AGENTS OF RECORD**

**For the Opponent:** Method Law Professional Corporation

**For the Applicant:** Benoît & Côté Inc.