

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

Citation: 2015 TMOB 217
Date of Decision: 2015-12-01

IN THE MATTER OF A SECTION 45 PROCEEDING

Lavery de Billy

Requesting Party

and

Canadian Sport Institute Pacific Society

Registered Owner

**TMA732,339 for
SPIN: SPORT INNOVATION**

Registration

[1] At the request of Lavery de Billy, the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on May 14, 2014 to Canadian Sport Institute Pacific Society, the registered owner of registration No. TMA732,339 for the trade-mark SPIN: SPORT INNOVATION.

[2] The trade-mark SPIN: SPORT INNOVATION (the Mark) is registered for use in association with services relating to athlete nutrition, training and performance. I reproduce the statement of services as it reads in registration No. TMA732,339:

[(1)] Development and arranging for the distribution of clothing worn and sport equipment technology used by athletes to assist and enhance athlete training and performance; (2) development and arranging for the distribution of computer software to record and measure athlete training and competition performance (3) testing of athlete performance in training and competition environments; (4) testing of clothing worn and sport equipment and sport equipment technology used by athletes for training and competition purposes (5) development of curriculum for

colleges and universities relating to athlete nutrition, athlete training, athlete training and performance testing, and marketing (6) operation of a website, workshops, seminars, conferences and the publication of a newsletter relating to athlete nutrition, athlete training, athlete training and performance testing, and marketing.

[3] The notice required Canadian Sport Institute Pacific Society (the Owner) to furnish evidence showing that the Mark was used in Canada, in association with each of the services specified in the registration, at any time between May 14, 2011 and May 14, 2014 (the Relevant Period). If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[4] In response to the Registrar's notice, the Owner filed the affidavit of Gurkamal Loodu.

[5] Only the Owner filed written representations. A hearing was not held.

[6] For the reasons that follow, I conclude that the registration ought to be expunged.

Evidentiary Onus

[7] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. The threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)]. Evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)]. Still, sufficient facts must be provided to permit the Registrar to arrive at a conclusion of use of the Mark in association with each of the services specified in the registration during the Relevant Period. Any ambiguity in the evidence should be interpreted against the Owner as it bears the full burden of proof [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184, 90 CPR (4th) 428 at para 16].

[8] The definition of use with respect to services is set out in section 4(2) of the Act which provides that a trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[9] The display of the trade-mark in advertising is sufficient to meet the requirements of section 4(2) when the trade-mark owner is offering and prepared to perform those services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)]. Furthermore, the evidence as a whole must be considered, and focusing on individual pieces of evidence is not the correct approach [*Kvas Miller Everitt v Compute (Bridgend) Limited*, 2005 CanLII 78281, 47 CPR (4th) 209 (TMOB)].

Preliminary Observations

[10] The footnotes of registration No. TMA732,339 disclose changes of name of the Owner. More particularly, they show that:

- the Owner was formerly known as “PacificSport BC Society”;
- the name “PacificSport BC Society” was changed to “Canadian Sport Centre Pacific Society” on December 7, 2007; and
- the name “Canadian Sport *Centre* Pacific Society” was changed to “Canadian Sport *Institute* Pacific Society” (emphasis added), the Owner’s name of record, on March 7, 2013.

[11] The change of name of March 7, 2013 is germane to the Relevant Period, thus germane to the following review of the Owner’s evidence provided by the affidavit of Mr. Loodu, including its Exhibits “A” to “K”.

Review of the Owner’s Evidence

[12] Mr. Loodu is the Business Development Advisor of the Owner. At the date of his affidavit, i.e. August 8, 2014, he had held that position since June 2012 [para 1 of the affidavit].

[13] Mr. Loodu affirms that the Owner has used the Mark in Canada “in its registered form” during the Relevant Period “in association with the services set out in the application for registration” of the Mark [para 8 of the affidavit]. He lists those services as follows, subsequently referring to them collectively as the “Services”:

- (1) development and arranging for the distribution of clothing worn and sport equipment technology used by athletes to assist and enhance athlete training and performance;
- (2) development and arranging for the distribution of computer software to record and measure athlete training and competition performance;
- (3) testing of athlete performance in training and competition environments;
- (4) testing of clothing worn and sport equipment and sport equipment technology used by athletes for training and competition purposes;
- (5) development of curriculum for colleges and universities relating to athlete nutrition, athlete training, athlete training and performance testing, and marketing; and
- (6) operation of a website, workshops, seminars, conferences and the publication of a newsletter relating to athlete nutrition, athlete training, athlete training and performance testing, and marketing.

[14] I note that the listed services correspond to the registered services. Also, although Mr. Loodu collectively refers to these services throughout his affidavit, he also explicitly states which of them are “addressed” by Exhibits “A” to “K” to his affidavit. In fact, Mr. Loodu essentially introduces the evidence by references to those exhibits. Thus, I will continue my review of the affidavit by discussing Exhibits “A” to “K” and commenting thereon in anticipation of my analysis of the issues.

➤ *Exhibit “A”*

[15] Exhibit “A” is introduced at paragraph 10.a. of the affidavit reading as follows:

The Services are provided at the facilities located at Camosun College. A description of this relationship, which includes reference to SPIN and “Sport Innovation”, is set out at PISE’s website <http://piseworld.com/about-spin/> (updated in 2014) and is attached to this my affidavit as Exhibit “A”.

[16] In my view, it would have been a fairly simple matter for Mr. Loodu to clearly explain in his affidavit the “relationship” between the Owner and PISE. However, since Mr. Loodu has chosen not to do so, I have reviewed the information contained in the four pages of the website filed as Exhibit “A”; the information found under “History” at the second page caught my attention. This website page is reproduced at Schedule 1 to my decision.

[17] What I understand from the “History” part of Exhibit “A” is that the Services are provided at the Sport Innovation Centre operated by the Pacific Institute of Sport Excellence, i.e. PISE, a partnership of Camosun College and Canadian Sport Centre Pacific. Absent further explanation from Mr. Loodu, it seems to me that all that I may infer from Exhibit “A” is that PISE is a separate entity from the Owner. I also stress that “Canadian Sport Centre Pacific” is identified as a partner of PISE whereas the name of the Owner is “Canadian Sport *Institute Pacific Society*”. Also, as discussed in my preliminary observations, the Owner was previously known as “Canadian Sport Centre Pacific *Society*” (emphasis added). I will return to these comments in my analysis of the issues.

[18] At paragraph 10.b. of his affidavit, Mr. Loodu references sentences found under “Aims” at the second page of PISE’s website filed as Exhibit “A” [see Schedule 1 to my decision]. He affirms that this addresses the Services listed under (1) and (4).

[19] According to Mr. Loodu’s statements, Exhibit “A” also shows media coverage of the Services by CHECK News and SHAW Daily that are posted at PISE’s website, “both of which were broadcasted on November 19, 2009”; this evidence addresses the Services listed under (1) to (4) [para 10.c. of the affidavit].

[20] I have reproduced at Schedule 2 to my decision the third website page found in Exhibit “A” that seems to be the “media coverage” referenced by Mr. Loodu. All that I may infer from this website page is that the black squares are the media coverage of November 19, 2009 by CHECK News and SHAW Daily that could be viewed on the website on August 8, 2014 (the date shown at the top left corner). Besides the fact that media coverage of November 19, 2009 falls outside the Relevant Period, absent images of the broadcast this evidence does not assist the Owner. I would add that had the Owner provided proper evidence of media coverage, I would still have found this evidence of no assistance to the Owner because I am of the view that media

coverage does not qualify as advertising. [See by way of analogy *Williams Companies Inc v William Tel Ltd* (1999), 4 CPR (4th) 253 (TMOB) where it was held that references to trademarks in newspaper articles do not qualify as advertising.]

➤ *Exhibit “B”*

[21] According to Mr. Loodu’s statements, Exhibit “B” shows additional media coverage and YouTube videos of the Services posted at <https://www.youtube.com./user/SPINCentre>. The media coverage and videos posted “over the past 2 to 4 years” address the Services listed under (1) to (6) [paragraph 10.d. of the affidavit].

[22] I have reproduced at Schedule 3 to my decision the two website pages, seemingly from YouTube’s website, filed under Exhibit “B”. I acknowledge the display of the logo shown below (the SPIN Logo).



[23] I will return to the SPIN Logo in the analysis of the issues. Still, at this juncture I find that Exhibit “B” is not of assistance to the Owner’s case.

[24] Indeed, even if I infer that it is representative evidence of videos that could have been watched on YouTube’s website during the Relevant Period, once again I note the absence of images. Also, my view that media coverage does not qualify as advertising applies to Exhibit “B”. Finally, because Mr. Loodu has been silent on the content of the YouTube videos, whether they qualify as advertising is an open question. In other words, the YouTube videos evidence is ambiguous.

➤ *Exhibit “C”*

[25] According to Mr. Loodu’s statements, Exhibit “C” is a case study dated May 24, 2013, profiling the development of a Paralympic sailor seat; this addresses the Services listed under (1) to (5) [para 10.e. of the affidavit].

[26] I find that Exhibit “C” does not assist the Owner. While the case study contains a few references to SPIN as the Sport Innovation Center, at Camosun College, such as “*When the Sport Innovation Centre (SPIN), at Camosun College, was approached...*” or “*SPIN enthusiastically accepted...*”, for examples, I did not see any references to the Mark, i.e. SPIN: SPORT INNOVATION. In any event, references to the Mark in that case study would not have qualified as advertising.

➤ *Exhibit “D”*

[27] In summary, according to Mr. Loodu’s statements, Exhibit “D” consists of pages of the website at <http://spin-centre.ca/home> specific to the technology included in the Services; this addresses the Services listed under (2) and (5) [para 10.f. of the affidavit].

[28] Despite the poor quality of the reproduction, I can see the SPIN Logo displayed on the first website page found in Exhibit “D”. As indicated before, I will return to the use of the SPIN Logo.

➤ *Exhibits “E” and “F”*

[29] Exhibits “E” and “F” consist of two news releases issued by Camosun College on May 29 and 31, 2012 respectively. They are filed in reference to Mr. Loodu’s statement that the Services provided under the Mark have been funded by “government and public authorities” [para 10.g. of the affidavit]. According to Mr. Loodu’s statements, the news release of May 29 addresses the Services listed under (1) to (5) and the one of May 31 addresses the Services listed under (1) to (4).

[30] I find that Exhibits “E” and “F” do not assist the Owner. Suffice it to say that they do not refer to the Mark. Rather, they refer to SPIN as the Sport Innovation Center, at Camosun

College. In any event, any references to the Mark in those new releases would not have qualified as advertising.

➤ *Exhibits “G” and “H”*

[31] Exhibits “G” and “H” are pages of websites filed in reference to Mr. Loodu’s statement that the “Applicant operates in partnership with the Canadian Sport Institute” under the Mark. In this regard, Mr. Loodu states that “SPIN: SPORT INNOVATION’s partnership with the Canadian Sport Institute may be found” at <http://www.csipacific.ca/about/partners/>, filed as Exhibit “G”, and at <http://spin-centre.ca/home/about-us/partners/>, filed as Exhibit “H” [para 10.i. of the affidavit].

[32] Since the term “Applicant” is arguably ambiguous, based on a fair reading of Mr. Loodu’s statements, I note that I infer that this term is meant as a reference to the Sport Innovation Centre operated by PISE. I also note that Exhibits “G” and “H” display the SPIN Logo.

➤ *Exhibits “I” to “K”*

[33] Exhibits “I” to “K” are filed in reference to Mr. Loodu’s statements concerning programs provided by “the Applicant” in conjunction with “the Canadian Sport Institute and its other partners”; they address the Services listed under (5) and (6) [para 10.j. of the affidavit]. However, none of these exhibits consisting of pages from the website www.csipacific.ca references the Mark. Thus, I will not discuss them further except to say that they do not assist the Owner’s case.

Analysis of the Issues

[34] I wish to start my analysis of the issues by stressing the generality of the Owner’s written representations in support of its contention that the registration should be maintained.

[35] Indeed, apart from overall representations on the purpose and scope of section 45 proceedings and the evidentiary burden, the following constitute the Owner’s representations:

10. Additionally, it is settled law that use of a variant of a registered trade-mark will be considered use of the trade-mark if the variant is not “substantially different” from the registered trade-mark: *Registrar of Trade-marks v. Honeywell Bull, S.A.*, [1985] 1 FC 406 at page 525 and *Sols R. Isabelle Inc. v. Stikeman Elliot LLP*, 2011 FC at para. 28.
11. The evidence contained in the Exhibits attached to the affiant’s affidavit establish or corroborate *prima facie* use of the Trade-mark in association with the Services sufficient to permit the Registrar to arrive at a conclusion of use of the Trade-mark in association with the registered Services during the relevant period.
12. Additionally, the use of the Trade-mark by the Canadian Sport Centre Pacific Society was not challenged by the Requesting Party either by examining the affiant, or by written representations.
13. In our submission, having regard to the evidence as a whole, the Requesting Party’s failure to challenge such evidence, and the purposes of s. 45, the Canadian Sport Centre Pacific Society has shown use of the Trade-mark in association with the Services during the three years immediately prior to the commencement of the s. 45 proceeding pursuant to s. 4(2) and s. 45 of the *Trade-marks Act*.

[36] The Owner’s argument that the Requesting Party did not challenge the evidence by examining Mr. Loodu is irrelevant. It is trite law that the Registrar is without authority to order cross-examination on an affidavit or statutory declaration filed as evidence in section 45 proceedings [see *Burke-Robertson v Carhartt Canada Ltd* (1994), 56 CPR (3d) 353 (FCTD)]. Furthermore, I do not know, nor do I consider it appropriate to speculate, why the Requesting Party did not make any representations.

[37] The Owner broadly submits that the evidence contained in Exhibits “A” to “K” establish or corroborate *prima facie* use of the Mark in association with the Services. However, regardless of my comments with respect to their evidentiary value, I concluded from my review of Exhibits “A” to “K” that none of them displays or references the Mark as registered, namely SPIN: SPORT INNOVATION. At best, the SPIN Logo displayed on Exhibits “B”, “D”, “G” and “H” could be seen as a variation of the Mark, which may explain the Owner’s general representations with respect to the use of a variant of a registered trade-mark. Still, the Owner did not make any specific representations on this point.

[38] Because I have previously observed that the Owner was formerly known as “Canadian Sport Centre Pacific Society”, I conclude that the reference to this name in paragraph 12 of the written representations is meant as a reference to the Owner. This comment leads me to revert to my earlier comments with respect to Exhibit “A” relied upon by the Owner to describe its relationship with PISE [see paras 15-17 of my decision]. At this juncture, suffice it to reiterate that absent any explanations from Mr. Loodu himself, I understand from Exhibit “A” that PISE operates the Sport Innovation Centre where the Services were provided during the Relevant Period. Also, because PISE is identified as a partnership of Camosun College and Canadian Sport Centre Pacific, it seems to be a separate entity from the Owner.

[39] Ultimately, further to my review of the Owner’s evidence, I have identified three issues in the present case. These are:

1. Does the use of the SPIN Logo constitute use of the Mark as registered?
2. Does the evidence show use of the Mark by the Owner or use that enures to its benefit?
3. Does the evidence show use or display of the Mark in the performance or advertising of the Services?

[40] In turning to the first issue, I note that it may be determinative because if the answer to the question is “no”, then there would be no evidence *showing* use of the Mark.

Does the use of the SPIN Logo constitute use of the Mark as registered?

[41] The test for deviation, as articulated by the Federal Court of Appeal in *Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523, at 525, is as follows:

The practical test to be applied in order to resolve a case of this nature is to compare the trade mark as it is registered with the trade mark as it is used and determine whether the differences between these two marks are so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin.

[42] As the Court of Appeal noted, “That question must be answered in the negative unless the mark was used in such a way that the mark did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used” [at 525].

[43] In deciding this issue, one must look to see if the “dominant features” of the trade-mark have been preserved [see *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA) at 71]. The assessment as to which elements are the dominant features and whether the deviation is minor enough so as to permit a finding of use of the trade-mark as registered is a question of fact to be determined on a case-by-case basis.

[44] In the present case, I am of the view that the deviation between the Mark as registered and the SPIN Logo are of more than a minor nature.

[45] I consider that all of the elements of the Mark are equally dominant. I also consider that the colon visually ties the elements “SPIN” and “SPORT INNOVATION”. More particularly, I find it reasonable to consider that the colon is a feature of the Mark used to illustrate that “SPIN” is a contraction of the phrase “SPORT INNOVATION”. In this regard, it is common knowledge that a colon is a punctuation mark with several uses, one of which is to “separate clauses when the second expands or illustrates the first” [see the *Canadian Oxford Dictionary*].

[46] By comparison, while the element “SPIN” is clearly a dominant feature of the SPIN Logo, the same cannot be said of “SPORT INNOVATION”. Moreover, not only is “SPORT INNOVATION” visually separate from “SPIN”, but it is also in a much smaller size followed by “CENTRE” in the same size and font. Contrary to the Mark, the SPIN Logo does not feature any element that visually ties the elements “SPIN” and “SPORT INNOVATION”; the latter is rather linked to the word “CENTRE”. The words “SPORT INNOVATION CENTRE” form a unitary expression. Ultimately, it is my view that the elements “SPIN” and “SPORT INNOVATION” in the SPIN Logo will not be perceived as forming a single or unitary trade-mark.

[47] Accordingly, I find that the use of the SPIN Logo does not constitute use of the Mark as registered. Thus, I conclude that there is no evidence showing use of the Mark. In other words,

the affidavit of Mr. Loodu amounts to bare assertions of use of the type that was held unacceptable in *Plough, supra*.

[48] As the first issue is determinative, I find it not necessary to consider the second and third issues.

[49] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with each of the registered services within the meaning of sections 4(2) and 45 of the Act. Further, the affidavit of Mr. Loodu does not put forward special circumstances to justify the absence of use.

Disposition

[50] Pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, registration No. TMA732,339 will be expunged.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

No Hearing Held

Agents of Record

Mark W. Timmis
(Mark Timmis Law Corporation)

For the Registered Owner

Simon Lemay
(Lavery, De Billy)

For the Requesting Party

Schedule 1

Second page of Exhibit “A”

8/8/2014

About SPIN | PISE

This facility also operates a high performance testing and monitoring lab dealing with Olympic, Paralympics, and regional athletes and assists them in powering their sport performance.

History

The Pacific Institute of Sport Excellence is a partnership initiative of Camosun College and Canadian Sport Centre Pacific, a leader in the delivery of programs, services and expertise in performance sport across the country. Excellence in education, performance and innovation are the cornerstones of PISE's activities.

Through the Institute's new Sport Innovation Centre, Dr. Tim Walzak, BC Regional Chair of Sport Technology at Camosun and the late Dr. Gord Sleivert of Canadian Sport Institute, partnered to develop performance advancing products not only for the benefit of our elite athletes but for the health and well-being of all Canadians.

Aims

- 1) At the Sport Innovation Centre our work focuses initially on high performance Olympic and Paralympics athletes. One of our mandates is to combine leading-edge technology and applied research to address various team and individual needs as they emerge in training and competitions.
- 2) Another area of SPIN focus is on product testing and prototype development. Our team has access to not only the aforementioned high performance athletes but also to world-leading sports scientists and rehabilitation experts across Canada.

We are able to establish and build connections between the ideas generated from basic sport research, the athletic performance community, and the product development business.

- 3) New textile and sensor technology developed through the SPIN Centre at the Pacific Institute for Sport Excellence will provide Victoria, and the region, a unique capability in an important new economic sector.

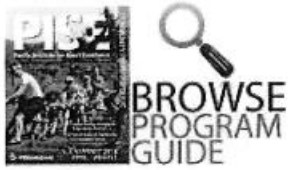
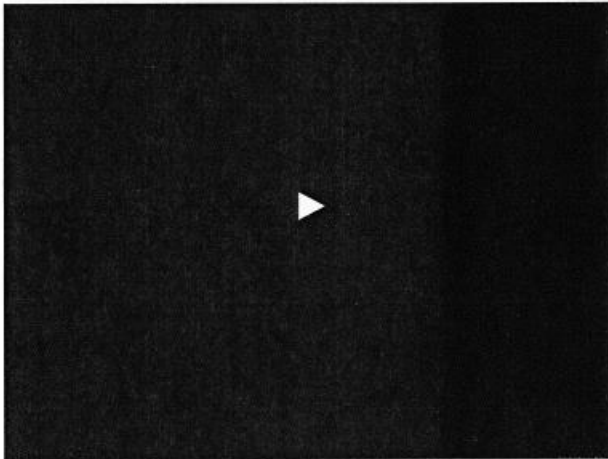
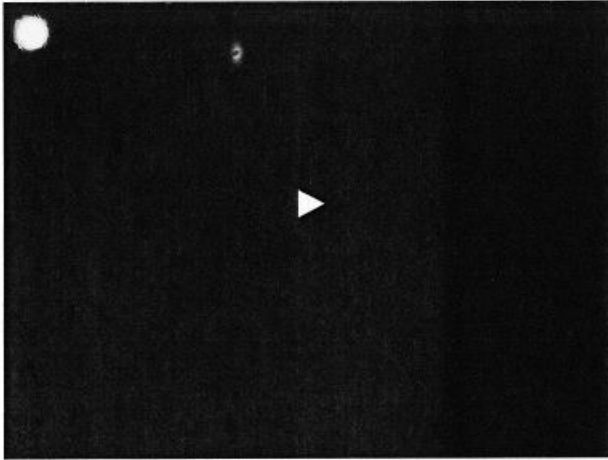
The ongoing work in advancing human performance will position Vancouver Island as a break-through leader in sport technology development throughout Canada and around the world.

Schedule 2

Third page of Exhibit "A"

8/8/2014

About SPIN | PISE



<http://piseworld.com/about-spin/>

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Schedule 3

Exhibit "B"

9/8/2014 Sport Innovation Centre (SPIN) - YouTube

Tube

[PulseWorld.com](#)

Sport Innovation Centre (SPIN)

8

[Home](#) [Videos](#) [Playlists](#) [Channels](#) [About](#)

All activities ▾

SPINCentre uploaded a video

John McRoberts - Sailing Chair
3 years ago • 291 views
Canadian Paralympian Sailor John McRoberts tells his story about overcoming extreme circumstances to winning the bronze medal at the Beijing Paralympics in 2008...

SPINCentre uploaded a video

paddle
3 years ago • 12 views

SPINCentre uploaded a video

SPIN Tour
3 years ago • 117 views
A look at the work going on at the Sport Innovation Centre (SPIN) at the Pacific Institute of Sports Excellence (PISE).

SPINCentre uploaded a video

Eighth International Meeting for Manikins and Modeling (8IM)
3 years ago • 88 Views
Eighth International Meeting for Manikins and Modeling (8IM) held at Pacific Institute for Sport Excellence (PISE). Hosted by the Sport Innovation Centre (SPIN) August 22-26, 2010.

SPINCentre uploaded a video

Xsens Motion Capture Suit/Physiotherapy & Rehabilitation
4 years ago • 1,291 views
SHAW Daily: Health and Wellness Report (Victoria BC) - Sport Innovation Centre

SPINCentre uploaded a video

SPIN at PISE Xsens 3D Motion Tracking Demonstration
4 years ago • 1,540 views
Story coverage from A-Channel in Victoria, BC.

SPINCentre uploaded a video

<https://www.youtube.com/user/SPINCentre/feed>

Popular channels on YouTube


- HolsSoyGerman**
- PewDiePie**
- OneDirectionVEVO**
- Smosh**
- RihannaVEVO**
- JennaMarbles**


1/2


Schedule 3 (cont'd)





Exhibit "B"

8/8/2014 Sport Innovation Centre (SPIN) - YouTube

 **SPIN at PISE Xsens 3D Motion Tracking Demonstration**
4 years ago · 731 views
Story coverage from CHEK TV in Victoria, BC
2:05

 **SPINCentre uploaded a video**

 **SPIN Textile Testing Introduction**
4 years ago · 774 views
Textile testing capability of the Sport Innovation Centre (SPIN) at Pacific Institute for Sport Excellence (PISE).
3:18

YouTube  Language: English  Country: Worldwide  Safety: Off  Help

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<https://www.youtube.com/user/SPINCentre/feed> 2/2