LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2014 TMOB 63
Date of Decision: 2014-03-19

IN THE MATTER OF A SECTION 45 PROCEEDING requested by Chitiz Pathak LLP against registration No. TMA551,079 for the trade-mark THE BIG ONE in the name of Bell Media Inc.

[1] At the request of Chitiz Pathak LLP (the Requesting Party), the Registrar of Trade-marks forwarded a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on September 9, 2011 to CTV Limited, the registered owner at that time of registration No. TMA551,079 for the trade-mark THE BIG ONE (the Mark). Subsequent to the issuance of the notice, the owner filed documents with the Registrar to record a change of name to Bell Media Inc. (the Owner). This change of name is not at issue in this proceeding.

[2] The Mark is registered for use in association with the following services:

> Television broadcasting services, interactive electronic communications services namely the operation of an Internet website for the purpose of providing on-line chats, e-mail, direct sales and television webcasts; providing information pertaining to music and entertainment related topics via the media of television, satellite, computer, telephone, audio, video, and/or via the world wide web on the global Internet (including narrow band and broad band applications) or through electronic mail; production, distribution, recording and development of television programs, audio and video tapes.

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the services specified in the registration at any time within the three year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of such use since that

date. In this case, the relevant period for showing use is between September 9, 2008 and September 9, 2011.

[4] "Use" in association with services is set out in section 4(2) of the Act:

> 4(2) 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.

[5] 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)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the services specified in the registration during the relevant period.

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Neil Staite, Vice President and General Manager for Much, a division of the Owner. Both parties filed written representations; only the Owner was represented at an oral hearing.

[7] In his affidavit, Mr. Staite provides that the Owner is a large multimedia company, owning numerous television channels, radio stations and websites. In particular, he states that the Owner operates the Much television channel, which was available to viewers in Canada during the relevant period.

[8] Mr. Staite attests that the Much channel features a music selection in rotation each week called THE BIG ONE. Attached to his affidavit as Exhibit NS-3 is a DVD showing an example of a broadcast displaying the Mark in relation to a music video. Although Mr. Staite acknowledges that the selection is from after the relevant period, he attests that it accurately reflects how the Owner used the Mark during the relevant period, explaining that the Owner does not archive its music selection broadcasts.

[9] Mr. Staite further attests that in conjunction with its Much television channel, the Owner operates a website, *muchmusic.com*. Attached as part of Exhibit NS-4 to his affidavit are printouts from the Web Archive at *web.archive.org* for pages from *muchmusic.com*, from May 31, 2010 and October 9, 2010. The Mark only appears in the "Recommended" section of the webpage, displayed over a particular video. Other videos are branded in this section of the web page in a similar manner, including videos that are labelled "Vibe Rated" and "Loud Tested".

[10] In view of the display of the Mark in association with music videos broadcast by the Owner during the relevant period, I am satisfied that it has demonstrated use of the Mark in association with the following services within the meaning of sections 4 and 45 of the Act: "television broadcasting services" and "distribution of television programs".

[11] Similarly, in view of the aforementioned evidence of display of the Mark in association with such music videos on the Owner's website during the relevant period, I am satisfied that it has demonstrated use of the Mark in association with "interactive electronic communications services namely the operation of an Internet website for the purpose of providing television webcasts" within the meaning of sections 4 and 45 of the Act.

[12] With respect to the remaining services as registered, however, I consider the evidence inadequate for the reasons set out below.

Production, recording and development services

[13] With respect to the services "production … recording and development of television programs, audio and video tapes", the Owner submits that the evidence – in particular the DVD at Exhibit NS-3 – should be considered sufficient to support the registration in association with this "basket of services". In support, the Owner cites *Boughton Law Corporation v CTV Limited*, 2011 TMOB 37 regarding the Owner's trade-mark ON TOUR, as a case involving the same services and similar evidence.

[14] However, I respectfully note that the requesting party in that case made no submissions and there was no analysis of the nature of the services in the decision. In this case, as noted by the Requesting Party, the evidence shows that the Mark appears briefly at the beginning of a

particular video broadcast by the Owner. While this may be sufficient to constitute use of the Mark in association with entertainment services or, broadly speaking, program distribution and broadcasting services, there is no evidence of use of the Mark in the production, recording or development of the program.

[15] The Owner submits that questioning the validity of the registration is not within the scope of a section 45 proceeding. However, the issue in this case is not whether "production, recording and development of television programs" constitutes valid services; indeed, they certainly can. The question in this proceeding is whether, during the relevant period in Canada, such services were performed by the Owner for the benefit of others in association with the Mark. In my view, there is no such evidence. The only relevant evidence in this case is the display of the Mark on the Owner's broadcast of certain music videos on its Much channel and website. Again, while I accept that the evidence corresponds to a generous interpretation of "television broadcasting services" and "distribution of television programs", I do not accept that such evidence demonstrates use of the Mark in association with "production, recording and development".

[16] In my view, the registered services "production, distribution, recording and development of television programs, audio and video tapes" does not correspond to the demonstrated actual use of the Mark by the Owner during the relevant period. There is no evidence of use of the Mark within the meaning of sections 4 and 45 of the Act by the Owner at these earlier stages of production. While the Owner may have engaged in these activities in order to ultimately broadcast THE BIG ONE music videos, the evidence does not show that it performed these pre-broadcast activities as services in association with the Mark in order to distinguish its services from the services of others.

<u>On-line chats, email, direct sales services</u>

[17] With respect to the services "Operation of an internet website for the purpose of providing on-line chats, e-mail, direct sales", Mr. Staite attests that on *muchmusic.com*, "there is a section called THE BIG ONE where customers can chat on-line or blog with others, view the videos through webcasts and purchase online". In addition to the aforementioned webpages from 2010, attached as part of Exhibit NS-4 to his affidavit are the following:

- A printout of the Owner's "current" website at *muchmusic.com*, showing the section called "THE BIG ONE NEWS". The printout shows four news items posted in March 2012 on music industry related topics.

- A "distribution list" of e-mail addresses that Mr. Staite attests is for "advising subscribers practicing in the music industry 'THE BIG ONE News' for the week (through the customer's email address)".

- Two "rotation lists" which list the music videos being played on Much for the weeks starting September 11, 2009 and May 28, 2010. The Much logo appears at the top of each list, and I note that of the several videos listed, one is identified as "MuchMusic The Big One". Other videos are identified with similar headings such as "VibeRated", "LoudTested" and "FreshOne".

[18] I consider Mr. Staite's assertion of use with respect to these services ambiguous, if not deliberately so; he makes no clear assertion of use with respect to the relevant period. Although the two "rotation lists" are from the relevant period, he makes no clear statement regarding their distribution. At best, these appear to be internal documents. The e-mail list he refers to is with respect to "THE BIG ONE News". However, "THE BIG ONE News" appears to be a feature of the Owner's website that post-dates the relevant period. If the rotation lists were distributed via the evidenced e-mail distribution list during the relevant period, Mr. Staite is not clear on this point.

[19] Furthermore, as noted above, the only display of the Mark on the webpages from 2010 is over one particular image in the "Recommended" section of each webpage. There is no clear association between the Mark and any on-line chat, e-mail or direct sales features of the website. Indeed, there is no clear indication of any "on-line chat" or "e-mail" services offered through the website during the relevant period at all.

[20] With respect to "direct sales" services, the Owner submits that one can see on the May 31, 2010 webpage printout that the song/video labelled as THE BIG ONE was also available as a "Top Ringtone" that website users could "Preview & Buy". However, the "Top Ringtones"

selections appear in a distinctly separate section of the webpage from the "Recommended" music videos section where the Mark appears. The Mark is not displayed in the section of the website offering links to "Preview & Buy". Accordingly, I do not consider the Mark to have been associated with any "direct sales" services that may have been offered through the Owner's website during the relevant period.

Information services

[21] With respect to the "providing information…" services, Mr. Staite attaches printouts from third party websites dated October 13, 2009 and March 9, 2010 to his affidavit at Exhibit NS-5. These webpages contain reference to THE BIG ONE in association with particular music videos. For example, the second printout appears to be a press release from March 2010 announcing the release of singer Nikki Yanofsky's album "Nikki". The second last paragraph in the article states that the Ms. Yanofsky's video *I Believe* had been "making waves and just crowned 'The Big One' on MuchMusic and 'Choice Cut' on MuchMoreMusic." Mr. Staite states that "this is further evidence that there has been continuous use of [the Mark]." However, at best, I consider such third party evidence as merely corroborative that the Owner labelled certain music videos it broadcast as "The Big One" during the relevant period, as shown in the DVD furnished at Exhibit NS-3 and the 2010 webpage printouts at Exhibit NS-4.

[22] Furthermore, as noted above, there is no THE BIG ONE NEWS section present in the webpages from 2010. The distribution list Mr. Staite describes as being for "advising subscribers practicing in the music industry [of] THE BIG ONE NEWS for the week" appears to be from after the relevant period. In view of the evidence as a whole, I cannot conclude that the Owner has demonstrated use of the Mark in association "providing information pertaining to music and entertainment related topics via the media of television, satellite, computer, telephone, audio, video, and/or via the world wide web on the global Internet (including narrow band and broad band applications) or through electronic mail" during the relevant period.

Disposition

[23] As no evidence of special circumstances excusing non-use of the Mark was furnished by the Owner, in view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete the following from the statement of services: "…on-line chats, e-mail, direct sales and …; providing information pertaining to music and entertainment related topics via the media of television, satellite, computer, telephone, audio, video, and/or via the world wide web on the global Internet (including narrow band and broad band applications) or through electronic mail; production, …, recording and development …, audio and video tapes."

[24] The services as amended will be as follows: "Television broadcasting services; interactive electronic communications services namely the operation of an Internet website for the purpose of providing television webcasts; distribution of television programs".

_____

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office