



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

Citation: 2015 TMOB 138
Date of Decision: 2015-08-06

IN THE MATTER OF A SECTION 45 PROCEEDING

**Christopher Kingsley and Janson
Kingsley doing business in partnership**

Requesting Party

and

**Kabushiki Kaisha Sony Computer
Entertainment (also trading as Sony
Computer Entertainment Inc.)**

Registered Owner

TMA769,957 for BIOLITH REBELLION

Registration

[1] At the request of Christopher Kingsley and Jason Kingsley doing business in partnership (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on October 7, 2013 to Kabushiki Kaisha Sony Computer Entertainment (also trading as Sony Computer Entertainment Inc.) (the Owner), the registered owner of registration No. TMA769,957 for the trade-mark BIOLITH REBELLION (the Mark).

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

Video game software; Software for computer games; Computer cameras; Digital camera accessories, namely, digital photo viewer; Optical disc recorded video game software; Optical disc recorded computer game software; Optical disc recorded game programs for hand-held typed electronic games with liquid crystal display; Player-operated electronic controllers for electronic video game machines; Trading cards in the form of CD's; Trading cards recorded on computer

discs; Booklets relating to games; Cards, namely, gift cards, greeting cards, score cards, index cards, and note cards; Catalogues; Instruction manuals; Pamphlets; Pictures; Printed fine art reproductions; Pocket memorandum books; Specification manuals for video game programs; Stickers; Strategic manuals for video games; Trading cards; Trading cards bearing pictures; Playing cards; Cases for hand-held games with liquid crystal displays; Hand-held games with liquid crystal displays other than those adapted for use with television receivers; Hand held unit for playing video games; Token operated video game machines other than those adapted for use with television receivers; Trading cards card games; Video game machines incorporating a means of display and not adapted for use with television receivers. (the Goods)

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with each of the Goods, at any time between October 7, 2010 and October 7, 2013 (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] The relevant definition of use with respect to goods is set out in section 4(1) of the Act as follow:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

[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 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 goods and services specified in the registration during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp* 2004 FC 448, 31 CPR (4th) 270].

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Jennifer Leah Stecyk, a trade-mark searcher employed by the Owner's agent firm, sworn on May 1st, 2014. Both parties filed written representations; a hearing was held and attended only by the Requesting Party.

Preliminary Remarks

[7] The Owner, in its written submissions, acknowledges implicitly that, even if I was to rule the content of the affidavit of Ms. Stecyk as proper evidence of use of the Mark in Canada during the Relevant Period, it would only cover certain goods, namely:

Video game software; Software for computer games; Optical disc recorded video game software; Optical disc recorded computer game software; Optical disc recorded game programs for hand-held typed electronic games with liquid crystal display; Trading cards in the form of CD's; Trading cards recorded on computer discs; Trading cards; Trading cards bearing pictures; Trading cards card games. (the Remaining Goods)

[8] Therefore the registration ought to be amended to cover at most the Remaining Goods. However, as it will appear from the analysis of the evidence filed by the Owner, I will order that the registration be expunged.

The Owner's Evidence

[9] Ms. Stecyk describes herself as '...a trade-mark searcher employed by the firm of Osler, Hoskin & Harcourt LLP, agents for the Opponent (sic) herein, a position held since 1988. I make this Affidavit on behalf and with the permission of the [Owner] in support of its above noted [Mark].'

[10] She states that on April 23, 2014, in order to obtain information about the use of the Mark, she conducted Internet searches using the Google search engines located at *www.google.ca* and *www.google.com* by entering the terms 'biolith rebellion' or 'eoj biolith rebellion' in the search fields. She states that the Google searches revealed in excess of 30,000 hits. Exhibit A to her affidavit are copies of the first pages of some of those search results. I note that those pages are summaries of articles. On some of them, there is a reference to a date and only one of them bears a date within the Relevant Period.

[11] She also filed, as Exhibit B, copies of web pages which were downloaded and printed on April 23, 2014 from certain websites she personally visited and that were listed in the Google search results, founded at Exhibit A.

[12] Four of those web pages make reference to a date during the Relevant Period. The first one, being the third page of Exhibit B, is a printout of a YouTube video page. It bears a publishing date of December 19, 2012 and is written in a foreign language. The subject of this video is a video game, but there is no indication that the game was sold by the Owner in Canada during the Relevant Period.

[13] The sixth page is another printout of a YouTube video page posted on June 2, 2013. Again, there is no indication that the video game that is the subject of this video, was sold by the Owner in Canada during the Relevant Period. The text on the page is also in a foreign language.

[14] The twelfth page of Exhibit B is taken from the website *amazon.com* and consists of a review dated December 22, 2010. There is no indication in the review that the author purchased the video game in Canada during the Relevant Period.

[15] Page twenty-six of Exhibit B is a customer review published on the website *amazon.com* on November 4, 2010. Again, however, there is no indication in the review that the author purchased the video game in Canada during the Relevant Period.

[16] As Exhibit C to her affidavit, Ms. Stecyk filed printouts from the Owner's website downloaded on April 23, 2014 (which is after the Relevant Period) wherein reference is made on such extracts to the Owner's goods in association with 'The Eye of Judgment-Biolith Rebellion' software, software expansion packs and trading cards. The extracts also provide information on how to download the Owner's 'The Eye of Judgment-Biolith Rebellion' game.

[17] Finally, I note that on page 64 of Exhibit B, which is an extract of the website *wikipedia.org*, it is mentioned that online support for the game BIOLITH REBELLION was discontinued on September 30, 2010, which was prior to the Relevant Period.

Analysis of the evidence

[18] The Owner, relying on the administrative nature of section 45 proceeding and the low threshold to establish use, argues that the evidence needs only to establish facts, which on balance, support the conclusion that the Mark has been used in Canada during the Relevant Period.

[19] The Requesting Party claims that the content of Ms. Stecyk's affidavit constitutes inadmissible hearsay evidence. It cites the case of *Re Jacobs Suchard Ltd.* [1996] TMOB 56 the Registrar ruled that the affidavit of a trade-mark agent employed by the law firm that submitted the affidavit on behalf of the owner, was inadmissible hearsay evidence since it was not furnished by the registered owner.

[20] Even considering Ms. Stecyk's statement that she made her affidavit on behalf and with the Owner's permission, I am not satisfied that the evidence described above is sufficient to enable the Owner to meet its burden. Ms. Stecyk is not in a position to confirm the accuracy of the contents of the websites attached to her affidavit. Very little weight can be placed on Internet evidence of this nature [see *Candrug Health Solutions Inc v Thorkelson*, 2007 FC 411 (CanLII), 60 CPR (4th) 35 (FCTD), reversed on other reasons 2008 FCA 100 (CanLII), 64 CPR (4th) 431 (FCA)]. Further, I note that no reasons were given as to why a person having direct knowledge of sales of the Remaining Goods in Canada by the Owner during the Relevant Period could not have provided such evidence [see *R v Khan* 1990 CanLII 77 (SCC), [1990] 2 SCR 531]. As a result, I am not willing to rely on these websites as evidence of the truth of the contents of the statements made thereon [see *Candrug, supra*]

[21] In any event, none of these searches prove that a sale was made by the Owner in Canada during the Relevant Period of any of the Remaining Goods. The Owner, in its written submissions, refers to reviews posted during the Relevant Period. However there is no indication if those reviews were made by Canadians and even if they were so made, there is no evidence that such Canadians bought any of the Remaining Goods in Canada during the Relevant Period.

[22] In all, there is no proof of a single sale of the Remaining Goods in Canada in association with the Mark during the Relevant Period. I am fully aware of the fact that the Owner did not

need to file invoices but it had to show the transfer of property in Canada of the Remaining Goods during the Relevant Period, which it failed to do [see *Davis LLP v Office of the Commissioner of Baseball*, 2015 TMOB 107].

[23] Finally, the Owner has not shown that there were special circumstances within the meaning of section 45(3) of the Act explaining non-use of the Mark during the Relevant Period.

Disposition

[24] Pursuant to the authority delegated to me under section 63(3) of the Act, registration TMA769,957 will be expunged in compliance with the provisions of section 45 of the Act.

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

Hearing Date: 2015-07-22

Appearances

No one appearing For the Registered Owner

Johanne Muzzo For the Requesting Party

Agents of Record

Osler, Hoskin & Harcourt For the Registered Owner

Guy & Muzzo Inc. For the Requesting Party