



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

Citation: 2015 TMOB 22
Date of Decision: 2015-01-30

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Martomagic, S.L.U. against registration
No. TMA557,725 for the trade-mark BUNGIE in the
name of Bungie, Inc.**

[1] At the request of Martomagic S.L.U. (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 November 13, 2012 to Bungie Inc. (the Owner), the registered owner of registration No. TMA557,725 for the trade-mark BUNGIE (the Mark).

[2] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with each of the goods and services specified in the registration, at any time between November 13, 2009 and November 13, 2012. 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.

[3] The Mark is registered for use in association with the services “Online computer game services” and the following goods:

- (1) Figurines made of non-precious metals.
- (2) Computer games software.
- (3) Printed publications, namely comic books, series of fiction books and strategy guides, posters, pre-printed game playing cards and instruction cards.
- (4) Wearing apparel, namely shirts, hats.

[4] The relevant definitions of use with respect to goods and services are set out in sections 4(1) and 4(2) of the Act as follows:

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.

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 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.

[6] With respect to services, the display of the Mark on 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)].

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Ondraus Jenkins, Head of Strategy and Corporate Development at the Owner, sworn June 12, 2013 in Los Angeles, California. Neither party filed written representations; an oral hearing was not requested.

The Owner's Evidence

[8] In his affidavit, Mr. Jenkins attests that the Owner is an American video game developer known for developing popular video games such as *Myth* and *Halo*. He explains that the Owner markets a variety of goods and services under the Mark, including "figurines, computer games software, various printed publications, clothing apparel and online computer game services".

[9] He attests that the Owner provides online computer game services “in the nature of making computer games available for access online and maintaining and making available a wide variety of game play statistical information for players.”

[10] Mr. Jenkins explains that during the relevant period, it was the normal course of trade for BUNGIE brand goods to be sold by the Owner to various distributors who, in turn, sold such goods via their distribution chains to various retail outlets throughout the world, including within Canada, for sale to the Canadian public. As an example, he explains that Microsoft Inc. distributed BUNGIE brand computer games to various retail outlets in Canada. He attests that such retail outlets included large scale consumer electronics retailers such as Future Shop, Best Buy and Wal-Mart. He also asserts that BUNGIE branded goods “have been sold, and continue to be sold, to Canadians through various online outlets, including *ebay.ca*, *amazon.ca* and *amazon.com*” as well as by the Owner through its own online store, *www.bungiestore.com*.

[11] In support, Mr. Jenkins attaches the following exhibits to his affidavit:

- Exhibit A is three photographs of various *Halo* video games. Mr. Jenkins explains that these photographs are representative of the packaging for video games that were available for sale and sold in Canada during the relevant period. The Mark appears on the front bottom right of the packaging.
- Exhibit B includes a photograph of a hat and two shirts that Mr. Jenkins attests is representative of the wearing apparel sold in Canada during the relevant period. The hat and shirts prominently display the Mark.
- Exhibit C consists of four photographs of printed materials that Mr. Jenkins attests are representative of BUNGIE branded printed materials that “were available for sale and sold in Canada” during the relevant period. The first picture is of “a strategy guide for the HALO 3 video game” that displays the Mark in the bottom right corner of the cover. The second picture is of “the BungieTown poster”, which displays the Mark as part of a 20th anniversary crest in the bottom right corner of the poster. Although not specifically described by Mr. Jenkins, the third photo appears to be a strategy guide for a different *Halo* game and the fourth photo is of a book entitled *The Halo Graphic Novel*. The Mark appears on the covers of both.

- Exhibit D consists of six photographs of various figurines that Mr. Jenkins attests “were available for sale and sold in Canada” during the relevant period. The Mark appears on the front and back of the figurine packaging. I note that, where visible, the copyright dates on the back of the packaging are for 2007 or earlier.
- Exhibits E and K consist of several printouts of webpages from the Owner’s game website, *bungie.net*, that Mr. Jenkins attests “is accessible to and is accessed by internet users in Canada and throughout the world, including the Relevant Period.” He attests that the webpages show “game advertising and game play statistical information” and that the Exhibit K printouts show the Owner’s game website from October and November 2010. The Mark appears at the top of the webpages.

The Exhibit E printouts appear to be from after the relevant period, bearing a copyright date of 2013. I note that the top of the two webpages showing game play statistics indicate that “The data on this page is no longer being updated. The last update was 03/31/2012.”

- Exhibit F consists of eight printouts from the Owner’s store website from June and July 2010, that Mr. Jenkins attests shows examples of some of the merchandise available for purchase during the relevant period. However, I note that nothing on the printouts indicates that the website was directed at Canadian consumers, such as prices in Canadian dollars or information regarding shipping of merchandise to Canada.
- Exhibit G is a document that Mr. Jenkins attests is “representative royalty reports documenting sales of the computer game *Halo: Reach* in Canada in the first and second quarters of fiscal year 2011.” The reports appear to indicate that thousands of *Halo* game licenses were purchased in Canada in the first two quarters of 2011.
- Exhibit H consists of two pages that Mr. Jenkins attests is “representative royalty reports from 2010 documenting game subscription sales and Bungie’s Games on Demand service in Canada”. He explains that Games on Demand is a service available through Microsoft’s Xbox360 game consoles, allowing customers to browse an online store and, upon purchase, download and install games directly to the customer’s console. However, Mr. Jenkins does not attach screenshots or any other evidence regarding the Games on

Demand service, so it is not clear whether the Mark was displayed when customers browsed or made purchases from this service.

- Exhibit I consists of nine spreadsheet pages that Mr. Jenkins attests are “order spreadsheets from *Amazon.com* from July, 2011 and December, 2012 documenting purchases of apparel and printed materials to Canadian customers.” He explains that the items identified on the order spreadsheets as “Burn Bright Bum Blue T-shirt” and “Bungie Town” poster are depicted in Exhibit J.
- Exhibit J consists of three photographs of a t-shirt, as well as one photograph of the poster also reproduced at Exhibit C. The back of the t-shirt displays the Mark, as does the poster in the bottom right corner.

Use of the Mark in Association with the Goods

[12] Unfortunately, although Mr. Jenkins asserts use of the Mark in association with most of the registered goods, I find that the Owner has failed to adequately show transfers of such goods in Canada in the normal course of trade.

[13] In this respect, while Mr. Jenkins attests that most of the goods were “available to” and sold in Canada, he provides supporting evidence only for computer games software (in the form of the Exhibit G royalty reports) and shirts and posters (in the form of the Exhibit I *amazon.com* sales reports).

[14] While he gives an example of a distribution chain to Canada for the Owner’s computer games software, it is not clear that the same distribution chain is applicable to the Owner’s other goods. Further, although some of the goods, such as figurines and comic books, appear on the Owner’s store website, Mr. Jenkins provides no evidence of actual sales to Canada. Similarly, if any of the other goods were sold to Canadians through *amazon.com* or another retail website, Mr. Jenkins provides no evidence of such sales.

[15] Although invoices are not mandatory in order to satisfactorily reply to a section 45 notice [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD); *Gowling Lafleur Henderson LLP v Neutrogena Corporation* (2009) 74 CPR (4th) 153 (TMOB)],

use must be shown in association with all of the goods as registered [*John Labatt Ltd v Rainier Brewing Co et al* (1984) 80 CPR (2d) 228 (FCA)]. As such, some evidence of transfers in the normal course of trade in Canada is necessary. Such evidence can be in the form of documentation like invoices or sales reports, but can also be through clear sworn statements. However, as in this case, it is insufficient to merely assert that goods were advertised or made available for purchase to Canadians [see *Michaels & Associates v WL Smith & Associates Ltd* (2006), 51 CPR (4th) 303 (TMOB); *Riches, McKenzie & Herbert LLP v Cleaner's Supply Inc*, (2012) TMOB 211].

[16] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act only in association with the goods “computer games software”, “posters” and “shirts”. As there is no evidence of special circumstances excusing non-use of the Mark before me, the remaining goods will be deleted from the registration.

Use of the Mark in Association with the Services

[17] With respect to the online computer game services, I would first note that it is not clear that the Exhibit H royalty reports for game subscriptions constitutes evidence of performance of the services in association with the Mark. As noted above, the Owner furnishes no screenshots or other evidence from the Xbox360 Games on Demand service to show that consumers would see the Mark when making purchases through that service.

[18] As for the Owner’s “game website” evidenced at Exhibit K, even if I were to consider making available “game play statistical information” as constituting the registered services, I note that nothing in the printouts indicates that the statistical information was available to Canadians during the relevant period or otherwise. Although he states that the website was “accessible” to Canadians, Mr. Jenkins provides no evidence of Canadian users having accessed the Owner’s website during the relevant period.

[19] More importantly, however, he makes no clear statements regarding whether the services on the website were available for performance to Canadians. Mr. Jenkins provides no specifics regarding Canadian customers’ use of the website and its gameplay statistics. If the exhibited

printouts show game play statistics for a Canadian customer, Mr. Jenkins does not simply state such. Absent a clear statement that Canadians could access the website for their gameplay statistics or use the website for gameplay purposes (in contrast to simply being able to view the website), I cannot conclude that the Owner's "online game services" were performed or available to be performed in Canada in association with the Mark.

[20] Although Mr. Jenkins attests to the Owner's production of popular computer games, I note that the dates he provides for their development date back to 1991 and are generally from well before the relevant period. Only one game series, *Halo*, is given a date range (2001-2010) that overlaps with the relevant period.

[21] As such, absent clear statements regarding Canadian consumers, the historic popularity of the Owner's computer games alone does not allow me to make favourable inferences regarding the actual availability and performance of the Owner's online computer game services during the relevant period to consumers located in Canada.

[22] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered services within the meaning of sections 4(2) and 45 of the Act. As there is no evidence of special circumstances before me, the registration will be amended accordingly.

Disposition

[23] 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 statement of services and to delete the following from the statement of goods:

- (1) Figurines made of non-precious metals; ...
- (3) ... comic books, series of fiction books and strategy guides ..., pre-printed game playing cards and instruction cards;
- (4) ...hats.

[24] The amended statement of goods will be as follows:

- (1) Computer games software;
- (2) Printed publications, namely posters;
- (3) Wearing apparel, namely shirts.

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