

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

Citation: 2017 TMOB 33
Date of Decision: 2017-03-27

IN THE MATTER OF A SECTION 45 PROCEEDING

Hola, S.L.

Requesting Party

and

Telelatino Network Inc.

Registered Owner

TMA708,493 for HOLA

Registration

[1] At the request of Hola, S.L. (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 February 6, 2015 to Telelatino Network Inc. (the Owner), the registered owner of registration No. TMA708,493 for the trade-mark HOLA (the Mark).

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

Goods:

Umbrellas; beach balls, flying disks, beach towels; glasses, mugs, playing cards, clocks, lapel pins, ornamental novelty buttons, ice scrapers, letter openers, paper weights, key chains, calendars, posters, pens and pencils, and television program and entertainment guides.

Services:

Entertainment services, namely radio and television programming and broadcasting services; film/movie production services

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with the goods and services specified in the registration, at any time

between February 6, 2012 and February 6, 2015 (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] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing deadwood from the register. While mere assertions of use are not sufficient to demonstrate use in the context of a section 45 proceeding [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1979), 45 CPR (2d) 194, aff'd (1980), 53 CPR (2d) 63 (FCA)], the threshold for establishing use in these proceedings is quite low [*Lang, Michener, Lawrence & Shaw v Woods Canada Ltd* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [see *Union Electric Supply Co v Canada (Registrar of Trade-marks)* (1982), 63 CPR (2d) 56 (FCTD)]. However, 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.

[5] The relevant definition of “use” in the present case is set out in sections 4(1) and (2) of the Act:

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.

(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.

[6] In response to the Registrar’s notice, the Owner furnished an affidavit of its president Aldo Difelice, sworn on September 4, 2015. Only the Owner filed written representations. However, both parties attended an oral hearing.

The Owner's evidence

[7] Mr. Difelice states that he has been the president of the Owner since 1998. He states that he has personal knowledge of the business of the Owner and the brands and trade-marks it uses, including in respect of the Mark [paras 1, 2 and 8 of the affidavit].

[8] In the first part of his affidavit, Mr. Difelice provides background information about the history and business of the Owner.

The Owner's business

[9] Mr. Difelice states that the Owner has been "Canada's #1 television destination for Italian and Spanish speaking communities since 1984." He states that the Owner broadcasts in three languages (English, Italian and Spanish) and that its family of television channels includes: 3% Spanish language digital TV channels, 3% Italian language TV Channels, and an all sports TV channel. He states that the Owner also operates websites and online channels "including tntv.com and HOLA: the Soccer Fanatics channel", and develops and produces television programming and live events including musical, sporting and artistic performances and public festivals [para 3 of the affidavit].

[10] Mr. Difelice explains that for these channels, websites and live events, the Owner produces, broadcasts, records, transmits and distributes television and audiovisual programs. He states that the Owner's broadcasts and its programming and content have been and are available in close to six million homes in Canada, through various platforms, including cable, satellite, IPTV, online and other digital media. He explains that the word "channel" is synonymous with the word "network" in the television business. He states that the Owner has been and is paid by cable, satellite and telecom operators for its broadcast services, including those bearing the Mark [para 4 of the affidavit].

[11] Mr. Difelice states that, since 1984, the Owner has extensively aired soccer programming, including soccer matches involving Italian, Spanish and other teams from around the world. He states that the Owner has broadcast television, multi-media and internet programming such as from the UEFA Champion League, UEFA Europe League, Copa America,

FIFA World Cup, UEFA European Football Championship, etc. all of which are national and international soccer leagues and tournaments [para 5 of the affidavit].

[12] Mr. Difelice adds that the Owner is not only a broadcaster and re-broadcaster of soccer games, it also has acquired and produced programming centred around soccer and soccer professionals. This soccer-related programming includes previews, specials, documentaries, reviews, profiles, commentary and other soccer-related programs. He states that this programming has been and is popular in the Spanish and Italian communities in Canada and that this has been the case throughout the relevant period [para 6 of the affidavit].

[13] At paragraph 11 of his affidavit, Mr. Difelice attests that the Owner has used the Mark during the relevant period in association with the Goods and Services, including through:

...the *distribution* of its Goods and the provision of its Services, in its literature, at its website (*www.tlntv.com*) and in its marketing and advertising for its Services and continues to do so as of today and will continue in the future. [My emphasis]

Use of the Mark with respect to the Goods

[14] With respect to the Goods, at paragraph 13 of his affidavit, Mr. Difelice states that the Owner “has distributed and/or sold” the following goods bearing the Mark:

- a) glasses, including sun glasses;
- b) mugs, including coffee and thermos mugs;
- c) clocks;
- d) calendars including diaries;
- e) posters; and
- f) television program and entertainment guides.

[15] He attaches, as Exhibit C to his affidavit, “photographs and/or images of these products (other than (f) above)”. He also attaches, as Exhibit G, “two pages, one of which is a page taken from [the Owner]’s press folder for its video-on-demand services and the second page displays some of the television programming available for distribution via video-on-demand” [paras 13 and 19 of the affidavit].

[16] Commenting on item (e), posters, Mr. Difelice states that in addition to being sold and distributed as posters, posters of the type shown in Exhibit C have been displayed and distributed from 2010 to the present in the advertising of the Services. He states that, for example, one such poster is mounted on one of the walls of the main entry to the Owner's premises. He attests that anyone entering the premises of the Owner from 2010 to the present would have viewed this poster [Exhibit C includes a photograph of the poster on that wall].

[17] At paragraph 14 of his affidavit, Mr. Difelice states that, during the relevant period, the Owner "also distributed and sold other goods, including T-shirts, back packs, neck identification holders, clip and stationary cards which bear the [Mark]". He attaches, under Exhibit D to his affidavit, photographs and/or images of examples of these products.

[18] Mr. Difelice further states, at paragraph 15 of his affidavit, that:

[The Owner] has *distributed* these Goods and other such products across Canada in various ways, annually. Its inventory of Goods and other products has changed from time to time, but based on my knowledge of [the Owner's] business, it has had all of the Goods in its inventory and/or in public circulation during the Relevant Period. It has sold such Goods and other such products at events which were held or sponsored by [the Owner] and also *distributed* them through such events and others. It also *distributed* such Goods and other such products to assist in making known the [Mark]. These activities occurred during the Relevant Period and shall continue. [My emphasis]

Use of the Mark with respect to the Services

[19] With respect to the Services, Mr. Difelice states that the Owner has many pieces of literature which display the Mark and which are used in the promotion and development of its Services. He states that this material was distributed during the relevant period and continues to be distributed. He lists examples of this type of literature, which includes what he describes as:

- a) a stationary card [Exhibit D]. Mr. Difelice states that cards and postcards of this type have been distributed by the Owner from 2010 to the present [para 17 of the affidavit];
- b) a presentation folder [Exhibit E];

c) a banner [Exhibit F]. Mr. Difelice states that this banner has been displayed at numerous locations throughout the relevant period. These locations include festivals, public appearances and events arranged or sponsored by the Owner to advertise and promote its television programming and broadcasting services [para 18 of the affidavit];

d) a page taken from the Owner's press folder for its video-on-demand services and a page displaying some of the television programming available for distribution via video-on-demand [Exhibit G]. Mr. Difelice explains that the Owner entered into contracts with Videotron, Bell and Rogers for the purchase of video-on-demand television programming during the relevant period [para 19 of the affidavit];

e) the "HOLA Espanol Station Id" [Exhibit H]. Mr. Difelice explains that this Station Id was broadcast every half hour every day between 2010 and December 2013 [para 20 of the affidavit].

Mr. Difelice adds that the Owner had similar "Top of the Hour" on-air advertisements for the promotion of the Mark in association with its Services for a number of years prior to the relevant period. He states that this has been the case since 2001 to the present [paras 21 and 22 of the affidavit]. He includes examples of these advertisements as well as commercials which were broadcast between 2001 and 2003 under Exhibits I, J and K to his affidavit; and

f) two videos [Exhibit L], which Mr. Difelice states show typical segments from the HOLA Community television program. Mr. Difelice states that, during the relevant period, the Owner produced a community segments television program which aired on its Univision Spanish television programming, featuring local news and interest stories for the Spanish community [para 24 of the affidavit]. Mr. Difelice explains that these segments were broadcast on-air 10 to 20 times per week and were also available through the Owner's website online.

Exhibit L also includes a printout from the Owner's Univision channel website dated "9/8/2015", showing the page through which one of these videos could be viewed online.

[20] Upon review of these exhibits, I note that except for Exhibits M and L, "HOLA" is never displayed on its own. Rather, it is used along with "CIAO", as per some of the examples reproduced below, taken from Exhibits E and F:

Exhibit E - Excerpt from presentation folder

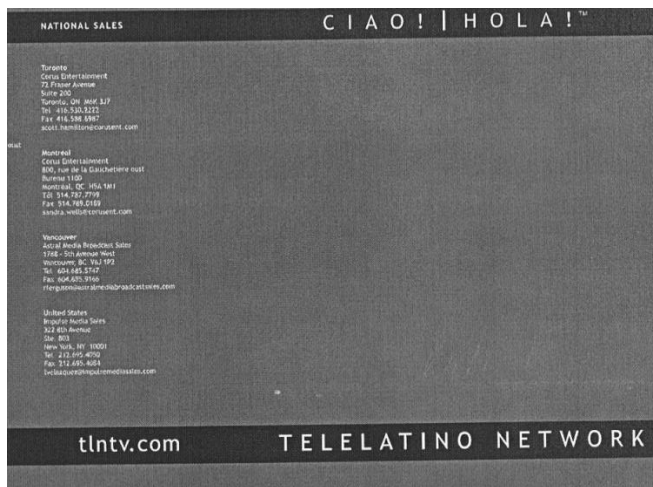


Exhibit F - Banner



[21] Hence, in the last part of his affidavit, Mr. Difelice comments on the display of HOLA “along with the CIAO mark”. He states that the Owner owns a registration for the trade-mark CIAO [as per the particulars attached under Exhibit M to his affidavit]. He explains that the Mark is directed to the Spanish community, while the CIAO trade-mark is directed to the Italian community. More particularly, he attests that:

[...] While [the Owner] has displayed such marks together on some of its materials, [the Owner] has not intended these marks to be combined. For economies of scale, etc. it has had to simultaneously display both marks on some literature and promotional materials. Such marks have been and are always separated by a vertical line. Its advertisement and promotion for each of the marks is directed to the relevant community. For the [Mark] that is the Spanish speaking community. Its use of the [Mark] has been in respect of its Services directed to such community and including its Spanish television channels.
[para 27 of the affidavit]

Analysis

Has the Owner shown use of the Mark in Canada in association with the Goods within the meaning of sections 4 and 45 of the Act?

[22] I agree with the Requesting Party that this question must be answered in the negative for the following reasons.

[23] First, Mr. Difelice does not provide any specific examples of use of the Mark in association with the following registered goods:

Umbrellas; beach balls, flying disks, beach towels; playing cards, lapel pins, ornamental novelty buttons, ice scrapers, letter openers, paper weights, key chains, pens and pencils.

[24] Second, with respect to the registered goods “calendars”, at paragraph 13(d) of his affidavit, Mr. Difelice refers to “calendars including diaries” and attaches, under Exhibit C, a photograph of the cover page of a “diary”. However, I agree with the Requesting Party that a “diary” is not necessarily synonymous with a “calendar”. While I accept that some “diaries” may be in the nature of day planners or calendars, it is not clear in this case whether the exhibited “diary” at Exhibit C is, in fact, of that nature. In this respect, only the cover page of the diary was evidenced, and Mr. Difelice provides no further particulars as to whether it was in the nature of a

calendar. In any event, as discussed in more detail below, there is no evidence of transfers in the normal course of trade of any of these goods.

[25] Third, with respect to the registered goods “television program and entertainment guides”, Mr. Difelice indicates that these goods are depicted in Exhibits C and G. However, I agree with the Requesting Party that the Exhibit C photographs seem to depict a poster or the like, rather than a “guide”. As for the two pages at Exhibit G, these appear to be documents distributed to the press, rather than being objects of trade in themselves. In any event, as discussed in more detail below, there is no evidence of transfers in the normal course of trade of any of these goods.

[26] Fourth, with respect to the registered goods “glasses”, “mugs”, “clocks” and “posters”, while Exhibit C does include photographs of these goods bearing the Mark alone (or along with the CIAO trade-mark in the case of the poster), there is no evidence of transfers in the normal course of trade of any of these goods.

[27] As per my review above of the Difelice affidavit, there is no evidence of sales in the normal course of trade of any of the registered goods. While Mr. Difelice sometimes refers to the “sale and/or distribution” of some of the registered goods, nowhere does he unequivocally state that sales of these goods were indeed made in the normal course of trade during the relevant period. Notably, no sales figures are provided. Rather, the Difelice affidavit tends to establish that these goods were distributed as a means of promoting the Owner’s Services, and were not objects of trade themselves.

[28] It has been held that the free distribution of a good merely to promote one’s own brand does not constitute a transfer in the normal course of trade [see, for example, *Smart & Biggar v Sutter Hill Corp*, 2012 TMOB 121, 103 CPR (4th) 128; and *Riches, McKenzie & Herbert LLP v Park Pontiac Buick GMC Ltd* (2005), 50 CPR (4th) 391 (TMOB)]. For the free distribution of a good to qualify as a transfer in the normal course of trade, the evidence must show that the good was delivered, not merely as a means of promoting *other* products or services, but as an object of trade in itself, leading to some kind of payment or exchange for such goods [see *Canada Goose Inc v James*, 2016 TMOB 145; and *Oyen Wiggs Green v Flora Manufacturing and Distributing Ltd*, 2014 TMOB 105, 125 CPR (4th) 152]. In the present case, it is not clear that any of the

goods referred to by Mr. Difelice were more than promotional items to create goodwill with respect to the Owner's Services.

[29] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with the Goods during the relevant period within the meaning of sections 4 and 45 of the Act. Furthermore, the Owner provided no evidence of special circumstances excusing the absence of such use. Accordingly, the Goods will be deleted from the registration.

Has the Owner shown use of the Mark in Canada in association with the Services within the meaning of sections 4 and 45 of the Act?

[30] As rightly noted by the Requesting Party, the Difelice affidavit is totally silent as to the "radio" part of the Owner's entertainment services. "Radio programming and broadcasting services" are not referred to anywhere in the furnished evidence. Accordingly, these services will be deleted from the registration.

[31] I further agree with the Requesting Party that the Difelice affidavit does not establish use of the Mark in association with the registered services "film/movie production services" during the relevant period.

[32] While the Owner furnished evidence relating to the production of a "community segments television program" that aired on its Univision Spanish network and was also available through the Owner's website online [per Exhibit L], such segments cannot be equated to "film/movie" production *per se*. Rather, they consist of short journalistic-style reports or stories. Likewise, the advertisements and commercials of the type shown under Exhibits H to K to promote the Owner's own entertainment and broadcasting services do not establish use of the Mark in association with "film/movie production services". Accordingly, these services will also be deleted from the registration.

[33] Turning to the remaining services "entertainment services, namely television programming and broadcasting services", I agree with the Owner that it has demonstrated use of the Mark during the relevant period within the meaning of sections 4 and 45 of the Act for the following reasons.

[34] Contrary to the Requesting party's position, I find that the "Hola Espanol Station Id" under Exhibit H, when considered in connection with Mr. Difelice's description and explanations at paragraph 20 of his affidavit, does establish use of the Mark in association with the Owner's television programming and broadcasting services during the relevant period.

[35] As explained by Mr. Difelice, this on-air advertisement ran every 30 minutes in between programming on the Owner's television channels between 2010 and December 2013, with national coverage in over 6 million homes across Canada. This on-air advertisement clearly displayed the Mark on its own followed by an exclamation mark.

[36] In this respect, I agree with the Owner that the use of "HOLA!" constitutes use of the registered Mark. The addition of the exclamation mark does not prevent the word "HOLA" *per se* as being perceived as the trade-mark being used. The Mark has not lost its identity and remains recognizable in spite of the minor variation between the form in which it is registered and the form it is being used [see *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA); *Registrar of Trade-marks v Cie internationale pour l'informatique CII Honeywell Bull*, (1985), 4 CPR (3d) 523 (FCA); and *Nightingale Interloc Ltd v Prodesign Ltd*, (1984) 2 CPR (3d) 535 (TMOB)]. Furthermore, I do not find persuasive the Requesting Party's argument that such display could arguably be perceived as trade-name use. In any event, as stated in *Consumers Distributing Co/Cie Distribution aux Consommateurs v Toy World Ltd*, 1990 CarswellNat 1398 (TMOB), "trade-mark and trade-name usage are not necessarily mutually exclusive" [at paragraph 14].

[37] The videos and website printout at Exhibit L, which feature local news and interest stories for the Spanish community, further support Mr. Difelice's statements regarding use of the Mark in association with the Owner's television programming and broadcasting services in Canada. In this respect, the video and webpage under "L (i)" display the Mark on its own (both preceded and followed by a stylized exclamation mark), while the video under "L (ii)" displays the Mark on its own (followed by an exclamation mark) in an animated graphic in which the word "hola!" appears first and is later followed in movement by the Spanish word "español". Although Exhibit "L (i)" postdates the material date, and no date is provided for Exhibit "L (ii)", Mr. Difelice confirms that segments of this type were produced and broadcast during the relevant

period. Furthermore, I find that display of the Mark in the manner depicted in such videos and webpage constitutes display of the registered Mark. As explained above, the addition of the exclamation mark(s) does not prevent the word “HOLA” *per se* as being perceived as the trade-mark being used. The same comment applies to the display of the word “español” appearing in movement after “hola!”. By reason of the descriptive character of the word “español” (when considered from the perspective of the Spanish community to which these segments are directed), and the fact that this word only appears after the word “hola!” has moved to the right-hand side of the screen, the phrase “hola! español” would not necessarily be perceived as a single or unitary trade-mark. Rather, per the aforementioned jurisprudence, the Mark has not lost its identity and remains recognizable.

[38] It is also worth recalling that Mr. Difelice states, in paragraph 18 of his affidavit, that the Owner has advertised and promoted its television programming and broadcasting services at various locations, including festivals, public appearances and events arranged or sponsored by it during the relevant period. Contrary to the Requesting Party’s position, I find that display of the Mark along with the CIAO trade-mark in the manner depicted on the banner shown under Exhibit F (reproduced above), also constitutes display of the registered Mark. The two marks are not only separated by a vertical line, but also followed underneath by two distinct tag lines in smaller and different fonts, namely “*Le Meilleur Du Monde Latin*” for the Mark, and what seems to be “*La rep del mundo latino*” for the CIAO trade-mark. By reason of the vertical line and the two different languages used, the visual impression created by the banner is that the HOLA and CIAO trade-marks are each directed to different communities, as more fully explained by Mr. Difelice in paragraph 27 of his affidavit, reproduced above. In other words, the two marks would not necessarily be perceived as a single or unitary trade-mark. Again, per the aforementioned jurisprudence, the Mark has not lost its identity and remains recognizable.

[39] Accordingly, I find that it is not necessary to discuss further the remaining exhibits, nor is it necessary to determine whether display of “HOLA!” along with the CIAO trade-mark in the manner depicted in Exhibit E (reproduced above) also constitutes use of the registered Mark.

Disposition

[40] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete all of the registered goods as well as all the registered services except for “television programming and broadcasting”, in compliance with the provisions of section 45 of the Act. The amended statement of services will read as follows:

Entertainment services, namely television programming and broadcasting.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: 2017-02-02

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