



LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

**Citation: 2017 TMOB 106**

**Date of Decision: 2017-08-23**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Andrews Robichaud**

**Requesting Party**

**and**

**Entechnevision Inc.**

**Registered Owner**

**TMA807,355 for WIZARD OF OZ**

**Registration**

[1] At the request of Andrews Robichaud (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 September 26, 2014 to Entechnevision Inc. (the Owner), the registered owner of registration No. TMA807,355 for the word mark WIZARD OF OZ (the Mark).

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

(1) Jewellery, namely, rings, bracelets, necklaces, pendants, earrings, stickpins, wrist watches, clocks, keychains, hair pins, barrettes, hair clips, cufflinks, brooches, money clips.

(2) Paper goods and printed matter, namely trading cards, playing cards, stickers, stationary items, namely envelopes, announcement cards, notebooks, pads, note paper, note cards, labels, posters and greeting cards; books and pamphlets.

(3) Toys and games, namely toy action figures and accessories for use therewith; dolls, doll clothing and doll accessories, children's multiple activity toys, plush toys, stuffed toys, plastic and vinyl toy characters, toy figures, musical toys, inflatable toys, jigsaw puzzles, game equipment sold as a unit for playing board, parlor, skill and action, card, role-playing and electronic hand-held unit for playing games.

(4) Clothing, footwear, headgear, namely shirts, T-shirts, sweatshirts, sweaters, blouses, tank tops, undershirts, jackets, coats, dresses, skirts, shorts, pants, jeans, overalls, sweatpants, underwear, boxer shorts, briefs, panties, swim wear, bathing suits, night shirts, robes, night gowns, pajamas, tights, leggings, leg warmers, neckties, bow ties, ascots, pocket squares, scarves, gloves, mittens, wrist bands, belts, sashes, socks, shoes, boots, athletic shoes, slippers, hats, caps, head bands, visors, hoods, Halloween costumes, masquerade costumes, infant wear, namely booties, bibs and playsuits.

[3] The Mark is also registered in association with the following services:

(1) Entertainment services, namely, providing entertainment in the field of interactive games by means of a global computer network; providing a website featuring games, stories, activities and information;

(2) Licensing of computer software, namely software in the field of interactive games;

(3) Character and storyline licensing services, namely licensing the use of certain characters and storylines featured in interactive computer game programs;

(4) Computer services namely providing a web site on global computer network whereon children can play interactive games; interactive computer game programs featuring action and adventures and interactive video computer game programs featuring action and adventures.

[4] 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 September 26, 2011 and September 26, 2014. 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.

[5] The relevant definitions of “use” 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.

[6] 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.

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Jeff Lord, sworn on October 26, 2015 in Montreal, Quebec. Only the Requesting Party filed written representations, but both parties were represented at a hearing held on April 5, 2017.

### **Owner's Evidence**

[8] In his affidavit, Mr. Lord identifies himself as the Principal of the Owner.

[9] Mr. Lord attests that Canadians accessed the Owner's games, stories and educational materials online during the relevant period. More specifically, Mr. Lord attests that Canadians benefitted from the following services:

Entertainment services, namely, providing entertainment in the field of interactive games by means of a global computer network; providing a website featuring games, stories, and educational materials and interactive educational activities for the primary and secondary levels; computer services namely providing a web site on global computer network whereon users can play interactive games; providing access to on-line interactive computer game programs in the field of action and adventures.

[10] These services essentially correspond to services (1) and (4) in the registration.

[11] In support, at Exhibit A to his affidavit, Mr. Lord provides printouts of four webpages purportedly accessed by Canadians during the relevant period. The pages appear to be the homepage for a WIZARD OF OZ-themed website and similar homepages for JUNGLE BOOK, RAPUNZEL and SWISS FAMILY ROBINSON websites, respectively. Mr. Lord explains that the exhibited webpages were printed after the relevant period but he attests that they are representative of how the webpages appeared during the relevant period.

[12] Mr. Lord states that “I am advised by my IT staff and verily believe that the computers that accessed the sites appear to be located within Canada and thus verily believe that Canadians operated the computers and benefitted from the services delivered via the web pages”.

[13] On the exhibited WIZARD OF OZ-themed webpage, the Mark appears prominently at the top of the page in the form of a logo. It also appears in text form, followed by a “TM” symbol, near the bottom of the page.

[14] Also appearing is a “Kidoons Network” logo at the top right of the page, and the following links appear in the middle of the page: “READ STORY”, “SHOP”, “PLAY GAMES”, “SEND E-CARDS” and “DOWNLOAD STUFF”.

[15] At the bottom of the page is the following notation: “TM/MC EnTechneVision, Inc., lic. use/usager lic. KIDOONS Inc.”

[16] With respect to the registered goods, Mr. Lord attests that “Sales of goods bearing the trademarks commenced shortly before the declaration[s] of use were filed”, but he indicates that such sales “ceased” at an unspecified point in time.

[17] Mr. Lord states that the “original vision was to activate all of the trade-marks at once” but that “in 2010, Disney released its Rapunzel-themed film ‘Tangled’ which smothered that market and rendered the entire exercise as originally envisioned unsustainable”. He states that he decided to “recalibrate” his strategy as a result.

[18] He explains that, by 2012, he had begun implementing a new strategy of interlinking the Mark with studio productions and was successful in securing a commission to produce *Twenty Thousand Leagues Under the Sea*. He indicates that the play premiered in Toronto in July 2015 at PANAMANIA, the Arts and Cultural Festival of the Pan American Games. Photographs from a PanAm press conference in April 2014 and an excerpt from a third-party website describing the production are attached as Exhibit B to Mr. Lord’s affidavit.

[19] Mr. Lord attests that, prior to the premiere of *Twenty Thousand Leagues Under the Sea* in Toronto, he experienced severe medical issues which ultimately led to two surgeries. Following the premiere, Mr. Lord also suffered from another serious medical condition, resulting in a third

surgery from which he is still recovering. Attached as Exhibit C is an unsigned letter that Mr. Lord identifies as a “true copy of a note from my trusted employee Craig Francis”. The note describes the challenges in achieving Mr. Lord’s “vision”, noting the producing of “an ambitious stage production”, Mr. Lord’s absences for medical reasons, and efforts to make contacts with various non-profit organizations.

[20] Mr. Lord states that it has always been his “intention to establish an incredible, Canadian-based network that has as its mandate to educate, entertain, and empower Canadian youth” and to use the Mark in a socially positive and ethically sound manner.

#### **Analysis – Use with respect to Goods**

[21] With respect to the registered goods, Mr. Lord provides no evidence of transfers of any goods during the relevant period or otherwise. Furthermore, Mr. Lord provides no evidence of the manner of association between the Mark and any of the registered goods.

[22] Accordingly, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered goods within the meaning of sections 4 and 45 of the Act.

[23] Whether special circumstances existed to excuse such non-use of the Mark will be discussed below.

#### **Analysis – Use with respect to Services (1) & (4)**

[24] In its representations, the Requesting Party questions several aspects of the Owner’s evidence. Generally, it alleges various contradictions and gaps in the evidence, arguing that Mr. Lord’s affidavit is, at best, vague and ambiguous.

[25] In particular, with respect to services (1) and (4), the Requesting Party notes that the evidence for the WIZARD OF OZ mark is limited to a single webpage, at Exhibit A. It submits that, “Other than this single page, the Affiant presents no further evidence or commentary as to what the further content of the website is, if any, and has improperly left such details to the Registrar’s assumption and imagination.” Furthermore, the Requesting Party submits that Mr. Lord “has no personal knowledge of who might have accessed the web page”, and instead

merely speculates that the webpage “might have been accessed from computers located in Canada”, “that Canadians might have been operating the computers”, and that “those who accessed the single page benefitted from the services delivered”.

[26] The Requesting Party further criticizes Mr. Lord’s affidavit, in part, for having “nothing more than a bare ‘copy and paste’ verbatim listing” of services (1) and (4) in paragraph 3 of the affidavit.

[27] However, in my view, there is nothing problematic *per se* regarding the affiant having essentially copied “verbatim” the services from the registration. Pursuant to section 30 of the Act, a statement of services should be in “ordinary commercial terms”. In this case, there is nothing unusual or difficult to understand in the articulation of services (1) and (4). In any event, Mr. Lord confirms that the sites shown at Exhibit A were active during the relevant period and in the same form as presented.

[28] On the issue of whether Canadians accessed the Owner’s WIZARD OF OZ website during the relevant period, Mr. Lord states that he “verily believe[s] that Canadians operated the computers and benefitted from the services delivered via the web pages, namely [services (1) and (4)]”. Although he may be mistaken, I am not prepared to draw a negative inference from his having spoken to the means by which he came about this belief. As “Principal” of the Owner, Mr. Lord would have knowledge of the Owner’s business, and I accept his statement at face value.

[29] In this respect, it is well established that the evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at paragraph 2]. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant* at paragraph 9].

[30] Furthermore, I note that evidence in a section 45 proceeding must be considered as a whole, and focusing on individual pieces of evidence in isolation is not the proper approach [see *Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB); and *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278

(TMOB)]. As well, reasonable inferences can be made from the evidence provided [see *Eclipse International Fashions Canada Inc v Shapiro Cohen* (2005), 48 CPR (4th) 223 (FCA)].

[31] In this case, although the evidence is not strong, it is sufficient. In this respect, the Owner furnished a website screenshot displaying the Mark and showing that activities corresponding to services (1) and (4) were available through that website. Mr. Lord confirms that the website was available during the relevant period and, given Mr. Lord's attestations and the nature of these ".ca" websites, I consider it reasonable to infer that at least some Canadians would have accessed such websites during that period.

[32] The Requesting Party also argues that any use shown was not in a commercial context. In this respect, the Requesting Party suggests that use has to be of "a normal commercial nature", one which can be said to have taken place "in the normal course of business" [citing *Cornerstone Securities Canada Inc v Canada (Registrar of Trade-marks)* (1994), 58 CPR (3d) 417 (FCTD)].

[33] In *Cornerstone*, the Federal Court stated the following at paragraph 7:

In this type of case use may be shown by evidence of the advertising of the mark provided there is also performance of those services in Canada. This use has to be of a normal commercial nature, one which can be said to have taken place "in the normal course of business": *Coscelebre v. Registrar of Trade-marks* (1991), 35 C.P.R., (3d) 74 (F.C.T.D.).

[34] First, I note that the principle cited by the Requesting Party – that "use has to be of a normal commercial nature" – appears to be qualified by the Federal Court itself, given the beginning of the previous sentence with "In this type of case...", implying that it might not apply to *all* expungement proceedings involving services. Furthermore, the disposition in *Cornerstone* does not appear to have turned on this issue, but rather turned on whether the evidence showed that the advertisements in question had been distributed and whether the registered services were ever performed.

[35] Indeed, the cited *Coscelebre* decision dealt with goods only. Therefore, the commentary from the Federal Court in that case should be viewed in the context of section 4(1) of the Act, which requires transfers of any goods in question to be "in the normal course of trade". In contrast, section 4(2) of the Act, reproduced above, does not incorporate the requirement that use

with respect to services be “in the normal course of trade”. What constitutes a “service” under the Act is to be interpreted broadly, with a key element being that there be some benefit to the public. This providing of a benefit does not necessarily require a commercial context, as demonstrated by the abundance of trade-mark registrations relating to “Charitable services ...” and the like in various fields.

[36] In any event, it would appear that the services in this case are and were offered in a commercial context. Mr. Lord’s affidavit does reference the Owner’s enterprise and business plans, and I note that advertisements appear on the exhibited website screenshots. Furthermore, the purpose of the Owner’s website and the provision of its services appears – at least in part – to be connected with the Owner’s licensing efforts and the offering (if not actual sales at this point) of related branded goods.

[37] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with services (1) and (4) of the Act within the meaning of sections 4 and 45 of the Act.

#### **Analysis – Use with respect to Services (2) & (3)**

[38] Although the exhibited webpages indicate that a licence existed between the Owner and Kidoons and that the Mark was used in association with services (1) and (4), it does not follow that the evidence shows use of the Mark in association with the registered licensing services, being (2) “Licensing of computer software ...” and (3) “Character and storyline licensing...” services.

[39] In my view, the display of the Mark in the advertising and performance of services (1) and (4) does not also constitute display of the Mark in the advertising or performance of the registered licensing services. In this respect, Mr. Lord does not speak directly to services (2) and (3) in his affidavit and does not provide a copy of any licensing agreement, letterhead, correspondence or other documentation to show that the Mark was displayed during the advertising and/or performance of the Owner’s licensing services.

[40] As such, I am not satisfied that the Owner has demonstrated use of the Mark in association with services (2) and (3) within the meaning of sections 4 and 45 of the Act.



## Analysis - Special Circumstances

[41] In the absence of evidence of use of the Mark with respect to the registered goods and services (2) and (3), the issue is whether, pursuant to section 45(3) of the Act, special circumstances existed to excuse such non-use.

[42] The general rule is that absence of use should result in expungement, but there may be an exception where the absence of use is due to special circumstances [*Scott Paper Ltd v Smart & Biggar*, 2008 FCA 129, 65 CPR (4th) 303].

[43] To determine whether special circumstances have been demonstrated, the Registrar must first determine why the trade-mark was not used during the relevant period. Second, the Registrar must determine whether those reasons for non-use constitute special circumstances [*Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA)]. Special circumstances means circumstances or reasons that are unusual, uncommon, or exceptional [*John Labatt Ltd v Cotton Club Bottling Co* (1976), 25 CPR (2d) 115 (FCTD)].

[44] If the Registrar determines that the reasons for non-use constitute special circumstances, the Registrar must still decide whether such circumstances excuse the period of non-use. This determination involves the consideration of three criteria: (i) the length of time during which the trade-mark has not been in use; (ii) whether the reasons for non-use were beyond the control of the registered owner; and (iii) whether there exists a serious intention to shortly resume use [per *Harris Knitting Mills, supra*].

[45] The intention to shortly resume use must be substantiated by “a sufficient factual basis” [*NTD Apparel Inc v Ryan*, 2003 FCT 780, 27 CPR (4th) 73 at paragraph 26; see also *Arrowhead Spring Water Ltd v Arrowhead Water Corp* (1993), 47 CPR (3d) 217 (FCTD)].

[46] All three criteria are relevant, but satisfying the second criterion is essential for a finding of special circumstances excusing non-use [per *Scott Paper, supra*].

[47] In this case, the Owner submits that the reason the Mark was not used during the relevant period was due to Mr. Lord’s illness, described above.

[48] However, the Requesting Party notes that Mr. Lord essentially admits, at paragraph 6 of his affidavit, that the initial decision to cease use of the Mark was due to Mr. Lord's "decision to recalibrate my strategy". The Requesting Party further notes that, while Mr. Lord alleges various personal medical issues, he still indicates that the Owner continued to operate, but he provides no clear reasons why the Owner delayed returning to the use of the Mark.

[49] Indeed, I agree with the Requesting Party that Mr. Lord's timeline is somewhat vague, given that he provides no evidence of sales of the registered goods at any time. The inference, then, is that the Owner did not have sales of any WIZARD OF OZ-branded goods, even before Mr. Lord's health problems began.

[50] It has been held that unfavourable market conditions and voluntary business decisions are not the sort of circumstances that constitute special circumstances [see *Harris Knitting, supra*; *Lander Co Canada Ltd v Alex E Macrae & Co* (1993), 46 CPR (3d) 417 (FCTD)]. In cases where the registered owner had no intent to abandon its trade-mark in Canada, but lacked any orders for its goods during the relevant period, this was found not in itself sufficient to maintain the registration in question [see *Garrett v Langguth Cosmetic GMBH* (1991), 39 CPR (3d) 572 (TMOB) and *Bereskin & Parr v Magnum Marine Corp*, 2011 TMOB 68, 93 CPR (4th) 327].

[51] As such, it would appear from the evidence that the reasons for non-use were at least in part due to the business decisions and marketing efforts of the Owner. In the present case, Mr. Lord provides evidence regarding the Owner's several other trade-marks and websites, as well as a theatrical production. Therefore, it is not clear that non-use was due to Mr. Lord's illness rather than the voluntary business decisions of the Owner, such as the Owner's choice to focus on the Owner's other trade-marks during the relevant period. As noted by the Requesting Party, Mr. Lord's reference to a theatrical production for *Twenty Thousand Leagues Under the Sea* suggests a focus on other brands of the Owner as well as on services not set out in the registration.

[52] I note the following observation from the Federal Court in *Plough, supra*, at paragraph 10:

There is no room for a dog in the manger attitude on the part of registered owners who may wish to hold on to a registration notwithstanding that the trade mark is no longer in use at all or not in use with respect to some of the wares in respect of which the mark is registered.

[53] As the reason for non-use appears to be the voluntary business decisions of the Owner, I do not find that the Owner has established that the reasons for non-use constitute special circumstances. As such, it is not necessary to consider whether such circumstances excuse the period of non-use. Suffice to say, the voluntary business decisions of the Owner that contributed to non-use of the Mark were not beyond the control of the Owner.

### **Disposition**

[54] 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 goods in its entirety as well as services (2) and (3).

[55] The amended statement of services will be as follows:

(1) Entertainment services, namely, providing entertainment in the field of interactive games by means of a global computer network; providing a website featuring games, stories, activities and information;

(2) Computer services namely providing a web site on global computer network whereon children can play interactive games; interactive computer game programs featuring action and adventures and interactive video computer game programs featuring action and adventures.

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

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

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**HEARING DATE: 2017-04-05**

APPEARANCES

Steven Leach

For the Registered Owner

Michael Andrews

For the Requesting Party

Steven Andrews

AGENTS OF RECORD

Ridout & Maybee LLP

For the Registered Owner

Andrews Robichaud

For the Requesting Party