



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 49
Date of Decision: 2020-03-31

IN THE MATTER OF A SECTION 45 PROCEEDING

McCarthy Tetrault LLP

Requesting Party

and

Star Television Productions Limited

Registered Owner

**TMA837,535 for INDIA STAR PLUS
(STYLIZED) & STAR Design**

Registration

[1] At the request of McCarthy Tetrault LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act* RSC 1985, c T-13 (the Act) on February 6, 2017 to Star Television Productions Limited (the Owner), the registered owner of registration No. TMA837,535 for the trademark INDIA STAR PLUS (STYLIZED) & STAR Design set out below (the Mark).



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

Services

(1) Television and radio broadcasting services; digital television services; diffusion of television programmes; operation of earth-to-satellite television transmitters for transmission of signals to satellite; relaying of television

programmes by satellite; operation of satellite-to-earth receiver aerials and frequency conversion of microwave signals relayed by satellite to transmit television and radio broadcasts and cable television broadcasting services; dissemination of television programmes relayed by satellite receiver aerials by cable or by microwave link to television receivers of users; provision and operation of radio, telephone, satellite and of cable network communications systems for television, telephone and radio broadcasting services; transmission of audio, video, voice and entertainment related information by computer, cable, television, microwave and communications satellite; and all related to channels and programming, such channels and programming that are provided only primarily in, or dubbed or subtitled into, an Asian language (but excluding any channels or programming that is originally primarily in certain European languages and dubbed or subtitled into an Asian language).

(2) Television and radio entertainment services provided by means of the Internet; planning, production and distribution of television programs and films; production and distribution of programs featuring sports, music, culture, lifestyle and news transmitted via wireless communication devices, namely mobile telephones, MP3 players, handheld and desktop computers; news reporting; providing online information in the fields of sports, music, culture, lifestyle and news via the Internet; education and entertainment information services, namely, providing information on motion pictures and television programs, education information services in the field of entertainment; providing an interactive website in the field of entertainment to allow consumers to download information related to films or videos; television programming and motion picture information provided on-line from a computer database or from the internet; and all related to channels and programming, such channels and programming that are provided only primarily in, or dubbed or subtitled into, an Asian language (but excluding any channels or programming that is originally primarily in certain European languages and dubbed or subtitled into an Asian language).

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with each of the services specified in the registration, at any time between February 6, 2014 and February 6, 2017. If the Mark had not been so used, the Owner is 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 is set out in section 4(2) of the Act:

A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[5] With respect to services, the display of a trademark on advertising is sufficient to meet the requirements of section 4(2) when the trademark owner is offering and prepared to perform those services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[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 trademark in association with each of the services specified in the registration during the relevant period.

[7] Moreover, it is well established that the evidence as a whole must be considered [*Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)], and while the word “services” is not defined in the Act, services are generally granted a generous or broad interpretation [*Aird & Berlis v Virgin Enterprises Ltd* (2009), 78 CPR (4th) 306 (TMOB)]. As long as some members of the public receive a benefit from the activity, it is a service [*Renaud Cointreau & Co v Cordon Bleu International Ltd* (2000), 11 CPR (4th) 95 (FCTD), *aff’d*, 2002 FCA 11, 18 CPR (4th) 415].

[8] In response to the section 45 notice, the Owner furnished the affidavit of Kate E. Bright, a Director of Star Television Productions Limited. Both parties filed written representations and were represented at a hearing.

Assessment of the Evidence

Use Does Not Enure to the Owner

[9] Ms. Bright's evidence shows use of the Mark by Star India Private Limited, a related company to the Owner, with some but not all of the Services. Since, however, the Owner's entire evidence of use is based on that of Star India Private Limited, it is necessary to determine whether such use enures to the benefit of the Owner pursuant to section 50 of the Act. Section 50 states:

- (1) For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trademark to use the trademark in a country and the owner has, under the licence, direct or indirect control of the character or quality of the goods or services, then the use, advertisement or display of the trademark in that country as or in a trademark, trade name or otherwise by that entity has, and is deemed always to have had, the same effect as such a use, advertisement or display of the trademark in that country by the owner.
- (2) For the purposes of this Act, to the extent that public notice is given of the fact that the use of a trademark is a licensed use and of the identity of the owner, it shall be presumed, unless the contrary is proven, that the use is licensed by the owner of the trademark and the character or quality of the goods or services is under the control of the owner.

[10] Section 50(1) of the Act sets out two requirements: that there be a licence; and that pursuant to that licence, the licensor controls the character or quality of the licensed goods or services. As stated by the Federal Court, there are three main methods by which a trademark owner can demonstrate the requisite control pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of the licence agreement that provides for the requisite control [*Empresa Cubana Del Tabaco Trading v Shapiro Cohen*, 2011 FC 102 at para 84].

[11] While the evidence in a section 45 proceeding need not be perfect, a registered owner must still establish a prima facie case of use, meaning that the evidence must only supply facts from which a conclusion of use may follow as a logical inference [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at paras 2, 9]. In this case, the evidence falls short of establishing

that there is a prima facie case that use by Star India Private Limited enures to the benefit of the Owner pursuant to section 50. First, there is no evidence that public notice was given such that the conditions in section 50(2) are satisfied. Second, Ms. Bright's evidence that "[d]uring the relevant period ..., Star India [defined as Star India Private Limited] was licensed to use the [Mark] from the [Owner] in Canada" does not comply with section 50(1) as there is no evidence demonstrating the requisite control. Nor is the corporate relationship between the Owner and Star India Private Limited, with the Owner being a subsidiary of Star Group Limited and Star India Private Limited being a subsidiary of "Star Group" which is defined in Ms. Bright's affidavit as Star Group Limited together with other subsidiaries (paras 5, 9), sufficient to infer control [*MCI Communications Corp v MCI Multinet Communications Inc* (1995), 61 CPR (3d) 245 (TMOB); 3082833 *Nova Scotia Co v Lang Michener LLP*, 2009 FC 928 (FC); *Dynatech Automation Systems Inc v Dynatech Corp* (1995), 64 CPR (3d) 101 (TMOB)].

[12] At the hearing, the Owner submitted that some control could be inferred on the basis that Ms. Bright is a Director of the Owner and was responsible for "management and enforcement of intellectual property for [the Owner], in many countries, including in Canada and the United States, and including with respect to [the Owner's] ... [Mark]" (para 2). This, however, is insufficient for me to infer that the Owner controlled the quality of the Services provided by Star India Private Limited. This is not a situation where the president or the director of a corporate owner is also the president or the director of the user of the trademark as in *Petro-Canada v 2946661 Canada Inc* 1998 CanLII 9107 (FC), 83 CPR (3d) 129 (FCTD).

[13] The Owner also submitted that because Star Group Limited and its subsidiaries and related companies including the Owner and Star India Productions Limited are owned by global media conglomerate Twenty-First Century Fox, Inc., I could infer that proper licensing and control was in place. The Owner explained that this is because Ms. Bright's evidence is that this was a highly sophisticated operation of the type where proper licensing would exist. Ms. Bright explains at para 6 of her affidavit:

21st Century Fox owns one of the world's premier portfolios of cable, broadcast film, pay TV and satellite assets, providing services on six continents, reaching more than 1.8 billion subscribers in approximately 50 local languages every day. ... 21st Century Fox, alongside its affiliate

companies ... maintains an unrivalled reputation for creativity and excellence in the entertainment field.

[14] While I have no doubt that 21st Century Fox runs a highly sophisticated operation, in the absence of evidence of how it ensures that its subsidiaries put proper licensing regimes with sufficient control in place, I do not find that Ms. Bright's evidence is sufficient for me to find that the use of the Mark enures to the Owner pursuant to section 50 of the Act.

[15] Finally, while I agree that section 45 proceedings should not be a "trap for the unwary" where a trademark has been obviously in use by its rightful owner [*Baume & Mercier SA v Brown* (1985), 4 CPR (3d) 96 (FCTD)], I do not have enough information to infer that the requisite control existed in this case such that the evidence of use provided by Ms. Bright enures to the Owner. Accordingly, the registration will be expunged.

[16] If Ms. Bright had attested in her affidavit that, during the relevant period, the Owner controlled the character or quality of the Services, I would have maintained the registration for the Services in **bold** and expunged the Services shown in strike out below for the reasons that follow:

Services

~~(1) Television and radio broadcasting services; digital television services; diffusion of television programmes; operation of earth to satellite television transmitters for transmission of signals to satellite; relaying of television programmes by satellite; operation of satellite to earth receiver aerials and frequency conversion of microwave signals relayed by satellite to transmit television and radio broadcasts and cable television broadcasting services; dissemination of television programmes relayed by satellite receiver aerials by cable or by microwave link to television receivers of users; provision and operation of radio, telephone, satellite and of cable network communications systems for television, telephone and radio broadcasting services; transmission of audio, video, voice and entertainment related information by computer, cable, television, microwave and communications satellite; and all related to channels and programming, such channels and programming that are provided only primarily in, or dubbed or subtitled into, an Asian language (but excluding any channels or programming that is originally primarily in certain European languages and dubbed or subtitled into an Asian language.~~

~~(2) Television and radio entertainment services provided by means of the Internet; planning, production and distribution of television programs and~~

~~films; production and distribution of programs featuring sports, music, culture, lifestyle and news transmitted via wireless communication devices, namely mobile telephones, MP3 players, handheld and desktop computers; news reporting; providing online information in the fields of sports, music, culture, lifestyle and news via the Internet;~~ **education and entertainment information services, namely, providing information on motion pictures and television programs, education information services in the field of entertainment; providing an interactive website in the field of entertainment to allow consumers to download information related to films or videos; television programming and motion picture information provided on-line from a computer database or from the internet; and all related to channels and programming, such channels and programming that are provided only primarily in, or dubbed or subtitled into, an Asian language (but excluding any channels or programming that is originally primarily in certain European languages and dubbed or subtitled into an Asian language.**

Television Broadcasting, Distribution, Diffusion and Digital Television Services

[17] Ms. Bright's evidence of use of the Mark by Star India Private Limited in association with the following services is sufficient to meet the requirements of section 45:

Television broadcasting services; digital television services; diffusion of television programmes; and all related to channels and programming, such channels and programming that are provided only primarily in, or dubbed or subtitled into, an Asian language (but excluding any channels or programming that is originally primarily in certain European languages and dubbed or subtitled into an Asian language.

Notably, Ms. Bright provides the following evidence.

- Star India Private Limited ("Star India") is one of the leading Hindi entertainment companies in India, boasting a wide variety of television, radio and digital shows. Star India's portfolio of channels includes its flagship Hindi language general entertainment channels. Star Plus programming is distributed in Canada on the Star India Plus Channel (para 9). Star India is a subsidiary of Star Group which is defined directly below (para 9).
- Star Group (which includes the Owner's parent Star Group Limited and other subsidiaries) achieves its broad global reach by using third-party distributors for the Star

branded channels in each region (paras 5, 12). In Canada, Star India's major distributor for its Star Plus Channel is the Asian Television Network ("ATN") (paras 12-13). I accept Ms. Bright's evidence of invoices from Star India to Asian Television Network Int'l. Ltd. during the relevant period for "STAR Plus India" (Exhibit K) with the amount paid redacted to preserve confidentiality (para 22) as being sufficient proof of this. As such, it is unnecessary for me to discuss the programming schedules for Star Plus US (Exhibits D-I).

- The Mark appears on Star India's paid advertising taken out in Canadian magazines and newspapers circulated in Canada promoting the programming available on the Star India Plus Channel during the relevant period (para 21; Exhibit J - advertisements dated April 25, 2014 and January 6, 2017).

[18] At the hearing, the Requesting Party submitted that there was no evidence that ATN was licensed to use the Mark. With respect to the advertisements, I do not find that a license is required since Ms. Bright's evidence is that the advertisements placed at Exhibit J are "samples of Star India's paid advertising". Further, with respect to the airing of the Star Plus channel itself, Ms. Bright's evidence is that Star India controls the quality since (para 12):

... Star India coordinates and provides the transmitters to its distributors for the transmission of signals and operates satellite-to-earth receiver aerials and frequency conversions in order to offer its television ... and digital broadcasting services.

Finally, it appears that there is on-going collaboration between Star India and its broadcast distributors (para 14).

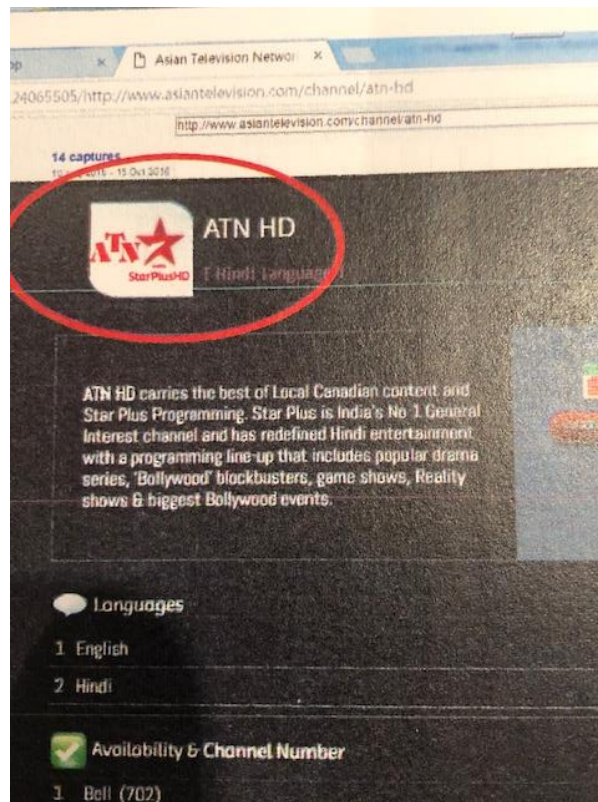
providing information on motion pictures and television programs, education information services in the field of entertainment;

[19] Ms. Bright's evidence of use of the Mark during the relevant period is sufficient for me to find that there was use of the Mark with:

education and entertainment information services, namely, providing information on motion pictures and television programs, education information services in the field of entertainment; and all related to channels and

programming, such channels and programming that are provided only primarily in, or dubbed or subtitled into, an Asian language (but excluding any channels or programming that is originally primarily in certain European languages and dubbed or subtitled into an Asian language.

[20] I find this based on the pages dated August 10, 2015 and January 24, 2016 from Exhibit B which are from ATN's webpage *asiantelevison.com* which provides programming information and includes the following design consisting of the ATN trademark beside the Mark along with HD as shown below:



[21] I find the descriptive adjective HD to be a non-material deviation of the Mark. Furthermore, with respect to ATN and the Mark being displayed side by side, nothing prevents the display of two trademarks together [*Osler, Hoskin & Harcourt LLP v Esprit International*, 2018 TMOB 9 at para 35 citing *AW Allen Ltd v Canada (Registrar of Trade Marks)* (1985), 6 CPR (3d) 270 (FCTD)]. While the ATN trademark and Mark are displayed side-by-side, I find that they are distinguishable from each other. In this regard, while the colour of the marks is the same, the fonts and sizing of the lettering are not. Furthermore, the difference between the marks is emphasized by the accompanying description on the page:

ATN HD carries the best of Local Canadian content and Star Plus Programming. Star Plus is India's No. 1 General Interest channel and has redefined Hindi entertainment ...

[22] Even though there is no evidence of a license between ATN and Star India, I do not find this prevents me from finding that Star India used the Mark. Ms. Bright's evidence is that Star India and the broadcast distributors, collaborate and manage the Star Plus pages of the distributors' websites with the goal of educating Canadian consumers by providing them with information about the various movies and programs available through Star branded channels (para 14). Finally, having accepted the evidence of advertising on ATN's website, it is not necessary for me to discuss whether the evidence of use of the Mark on Star India's US website (Exhibit C) constitutes use of the Mark in Canada.

Services for Which No Evidence of Use in Canada is Shown

[23] In assessing the remaining services, I consider that services must be stated in ordinary commercial terms, and whether a trademark has been used in association with the services as registered is to be determined on a case-by-case basis [*Express File Inc v HRB Royalty Inc*, 2005 FC 542, 39 CPR (4th) 59]. Further, if an owner has made a distinction in its statement of services between different but related services, the Owner is required to furnish evidence showing use of *each* of these services [*Continental Tire de Mexico S.A. de C.V. v Eurosport Société Par Actions Simplifiée*, 2016 TMOB 62 at para 40 adopting *John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)].

[24] The table below summarizes the reasons as to why no use has been found with each of the remaining services. Further, no evidence of special circumstances excusing non-use has been provided for any of these services.

radio and telephone related services	Aside from the general assertions of use in paragraphs 11-12, Ms. Bright's affidavit makes no particular reference to these services at all. Nor do any of the documents provided as exhibits reference them.
operation of earth-to-satellite	While the Mark may have been displayed on the ATN

<p>television trasmitters, ... receiver aerials and frequency conversion of microwave signales relayed by satellite, ... dissmenation of television programmes relayed by satellite receiver aerials by cable or aerial links; provision and operation of radio, telephone, satellite and of cable network communications systems for television, telephone and radio broadcasting services; transmission of audio, video, voice and entertainment related information-by computer, cable, television, microwave and communications satellite;</p>	<p>channel (which may be delivered by satellite) and on ATN advertising listing satellite providers in Canada, there is no evidence that the Mark is used with the services discussed in para 12 of Ms. Bright’s affidavit:</p> <p style="padding-left: 40px;">Star India coordinates and provides the transmitters to its distributors for the transmission of signals and operates satellite-to-earth receiver aerials and frequency conversion in order to offer its television, radio and digital broadcasting services (discussed herein) during the relevant period in Canada.</p>
<p>planning, production of television programs and films; news reporting</p>	<p>There is no evidence that Star India advertised or offered planning and production of television programs and films or news reporting in Canada. Ms. Bright’s statement at para 9 of her affidavit:</p> <p style="padding-left: 40px;">Star India’s portfolio of channels including its flagship Hindi language general entertainment channel Star Plus. Star Plus is one of [sic] India’s most popular general entertainment channels. Star Plus programming is distributed in Canada on the Stare India Plus Channel.</p> <p>leads me to infer that the planning and production services occur in India. While Ms. Bright’s evidence includes a screen shot of a photo of Stephen Harper and “Dr. Shan’s Chandrasekar’s interview with Rt. Hon. Stephen Harper, Prime Minister of Canada” and reference to an interview with Rt. Hon. Justin Trudeau, Prime Minister of Canada (Exhibit B), this is not sufficient for me to find that planning, production of television programs and films; news reporting are offered in Canada. It may well be that the</p>

	interviews referenced occurred abroad.
<p>production and distribution of programs featuring sports, music, culture, lifestyle and news transmitted via wireless communication devices, namely mobile telephones, MP3 players, handheld and desktop computers;</p>	<p>There is no evidence that these services are provided or advertised and available to be performed in Canada in association with the Mark. In this regard, there is no evidence that production services occur in Canada, nor is there any evidence that programs are distributed / transmitted via wireless communication devices in association with the Mark. I do not consider Ms. Bright's statement at para 14 to be sufficient to conclude that these Services were performed in association with the Mark or were advertised in association with the Mark and available to be performed (emphasis added):</p> <p style="padding-left: 40px;">Star India and the broadcast distributors, collaborate to plan and manage the STAR PLUS pages of the distributors' websites with the goal of (c) allowing consumers who have subscribed to the Star India Plus Channel to watch the various programs from the Internet though their wired and wireless digital communication devices, including their mobile phones, handheld computers, tablets, portable and desktop computers, and digital set top boxes.</p>
<p>television services provided by means of the Internet</p>	<p>I note that the television services provided by Star India appear to be accurately described as:</p> <p style="padding-left: 40px;">education and entertainment information services, namely, providing information on motion pictures and television programs, education information services in the field of entertainment.</p> <p>There is no evidence that additional television services provided by means of the Internet are provided or</p>

	<p>advertised and available to be performed in Canada in association with the Mark. As such, I do not find that Ms. Bright has provided evidence of these specific services [<i>Eurosport, supra</i>].</p>
<p>providing online information in the fields of sports, music, culture, lifestyle and news via the Internet;</p>	<p>I note that the information services provided by Ms. Bright appear to be accurately described as:</p> <p style="padding-left: 40px;">education and entertainment information services, namely, providing information on motion pictures and television programs, education information services in the field of entertainment.</p> <p>There is no evidence that additional online information services provided by means of the Internet are provided or advertised and available to be performed in Canada in association with the Mark. As such, I do not find that Ms. Bright has provided evidence of these specific services [<i>Eurosport, supra</i>].</p>
<p>television programming and motion picture information provided on-line from a computer database or from the internet;</p>	<p>I note that the information services provided by Ms. Bright appear to be accurately described as:</p> <p style="padding-left: 40px;">education and entertainment information services, namely, providing information on motion pictures and television programs, education information services in the field of entertainment.</p> <p>There is no evidence that additional online information services are provided or advertised and available to be performed in Canada in association with the Mark. As such, I do not find that Ms. Bright has provided evidence of these specific services [<i>Eurosport, supra</i>].</p>
<p>providing an interactive website in</p>	<p>There is no evidence that any of the websites displaying the</p>

<p>the field of entertainment to allow consumers to download information related to films or videos;</p>	<p>Mark have any download capability. If these services were the only services registered, I may have maintained the registration notwithstanding the specific means of obtaining the information (ie) through downloading is set out. Given, however, that the registration also includes other information services provided over the Internet, I find it appropriate to consider “downloading” an aspect of this service which must be shown.</p>
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Disposition

[25] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be expunged in compliance with the provisions of section 45 of the Act.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

Hearing Date: 2019-12-13

Appearances

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