



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

**Citation: 2013 TMOB 23**  
**Date of Decision: 2013-02-08**

**IN THE MATTER OF SECTION 45 PROCEEDINGS  
requested by Brownlee LLP against registration  
Nos. TMA671,489 and TMA675,678 for the trade-marks  
SPHERE ENTERTAINMENT and SPHERE  
ENTERTAINMENT Design in the name of 555,129  
Ontario Limited**

[1] At the request of Brownlee LLP (the Requesting Party), the Registrar of Trade-marks issued notices under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on June 21, 2010 to 555,129 Ontario Limited (the Registrant), the registered owner at that time of registration No. TMA671,489 for the trade-mark SPHERE ENTERTAINMENT and registration No. TMA675,678 for the trade-mark SPHERE ENTERTAINMENT Design, shown below:



[2] Subsequent to the issuance of the notices, the registrations were assigned and now stand in the name of Sphere Entertainment Limited. These assignments are not at issue in this proceeding.

[3] With respect to registration No. TMA671,489, the trade-mark is registered for use in association with the following wares and services:

Wares:

(1) Promotional materials, namely, advertisements and flyers.

- (2) Buttons.
- (3) T-shirts.
- (4) Phonograph records, read-along books, pre-recorded tapes, pre-recorded magnetic tapes, pre-recorded discs and pre-recorded cassettes.
- (5) Pre-recorded music videos, pre-recorded video cassettes and pre-recorded video discs.
- (6) Posters, note pads, memo pads, concert tour programs, photographs, pamphlets artists' biographical material.
- (7) Lyrics and poetry in printed form.
- (8) Magazines; badges; clothing namely, sport shirts and knit shirts; compact discs; adhesive stickers and decals; folders; brochures; souvenir items, namely booklets; printed matter, and stationery, namely cards, writing paper, post cards; pencils; felt tip pens, diaries, memo pads, paper weights, cups; and illustrations on record covers, namely graphics.

Services:

- (1) Operation of a website on the world wide web offering pre-recorded music for sale and providing information on music.
- (2) Entertainment services, namely, providing live performances or events, namely musical performances, sport events, impersonators, magic events, clown performances, animal events, t. v. star performances, character performances and full-length shows.
- (3) Consulting for creation of live performances or events, namely, musical performances, sport events, impersonators, magic events, clown performances, animal events, t. v. star performances; character performances and full-length shows.
- (4) Planning promotions of live performances or events, namely musical performances, sport events, impersonators, magic events, clown performances, animal events, t. v. star performances; character performances and full-length shows.

[4] With respect to registration No. TMA675,678, the trade-mark is registered for use in association with the following wares and services:

Wares:

- (1) Tote bags.
- (2) Sound and/or video recordings, all in the form of video tapes and digital compact discs.
- (3) Publications, namely, catalogs, newsletters and books.
- (4) Printed matter, namely, appointment books, banners, adhesive stickers, decals, post cards, daily planners, pencils and pens.
- (5) Souvenir items, namely, concert tour programs, photographs, pamphlets and artists' biographical material, namely, brochures, flyers and posters.

Services:

- (1) Management of recording artists, personalities and other performers, namely the rendering of advice and counseling for and in the entertainment business.
- (2) Finding engagement for performers; negotiation of terms of engagement and contracts on behalf of performers; and issuance of contracts with respect to such engagements.

(3) Operation of a website on the world wide web offering pre-recorded music for sale and providing information on music and performing artists.

[5] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares and services specified in the registration at any time within the three year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of such use since that date. With respect to both registrations in this case, the relevant period for showing use is between June 21, 2007 and June 21, 2010 (the Relevant Period).

[6] The definition of “use” is set out in section 4 of the Act as follows:

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

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

[7] 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 quite 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 wares and services specified in the registration during the relevant period.

[8] With respect to both registrations, only the Requesting Party filed written representations; however, both parties attended an oral hearing.

[9] In response to the Registrar's notices, the Registrant filed statutory declarations of Patricia Benay Silver, sworn January 7, 2011. I note that the evidence filed with respect to both registrations is largely identical, as discussed below.

[10] In her declarations, Ms. Silver identifies herself as the sole shareholder, officer and director of the Registrant. She attests that the Registrant was incorporated in 1983 and that, in association with the Marks, the Registrant offers, plans, promotes and provides entertainment services in the nature of "musical performances, sports events, impersonators, magic events, clown performances, animal events, television star performances, character performances and full length shows particularly containing and oriented towards family entertainment and children's entertainment".

Use with respect to the services

[11] In support of her assertion of use with respect to all of the registered services, attached as Exhibits 4-1 to 4-8 to her declaration are screen captures and printouts from the Registrant's website, *www.sphereentertainment.com*. Ms. Silver attests that the printouts are accurate reproductions and representative of how the website appeared during the Relevant Period. I note in particular that Exhibits 4-5 and 4-7 list and describe the Registrant's various management and entertainment-related activities, which correspond to the services as registered for both registrations.

[12] I also note that the website printouts at Exhibit 4-8 indicate that the Registrant can be contacted for more information regarding sales of pre-recorded music, which I consider sufficient to constitute the advertising of services (1) for registration TMA671,489 and services (3) for registration TMA675,678.

[13] In addition to the aforementioned advertising, Ms. Silver provides representative evidence of the performance of the Registrant's services during the Relevant Period at Exhibits 6-1 and 6-2 of her declarations. Exhibit 6-1 is an internal document listing some of the entertainment acts and events provided by the Registrant and Exhibit 6-2 are several representative contracts and invoices related to various entertainment acts organized by the

Registrant in Canada during the Relevant Period. I note that the Marks appear at the top of the invoices and contracts.

[14] In view of the foregoing, with respect to all of the registered services, I am satisfied that the registrant has demonstrated use of the Marks in association with such services within the meaning of sections 4 and 45 of the Act.

#### Use with respect to the wares

[15] With respect to the registered wares, Ms. Silver attaches photographs of various items, which she attests display the Mark and were distributed in the normal course of trade by the Registrant during the Relevant Period, as follows: copies of representative promotional material, including advertisements, flyers, catalogues, brochures and pamphlets providing information regarding the Registrant's activities and services (Exhibit 9); a button (Exhibit 10); shirts (Exhibit 11); a poster (Exhibit 12); note pads and memo pads (Exhibit 13); representative stationery (Exhibit 14); a paperweight (Exhibit 15); writing utensils (Exhibit 16); a daily planner (Exhibit 17-1); a diary (Exhibit 17-2); a cup (Exhibit 18); decals and stickers (Exhibit 19); a CD-ROM of pre-recorded music and video (Exhibit 20); a tote bag (Exhibit 24); and copies of lyrics and poetry in print form (Exhibit 25).

[16] I would note, however, that with respect to these exhibited items, Ms. Silver provides no evidence of sales nor does she attest to any sales. Based on the evidence as a whole, these items appear to be of a promotional nature and not the object of trade in and of themselves. Indeed, in its written representations, the Registrant submits that these items "were distributed with, or as part of, the performance of the services or in anticipation of securing orders and sales for such services and in many cases to promote the services of the various entertainers, artists and performers." However, it has been held that the free distribution of wares is not in the normal course of trade except in particular circumstances, such as where it was for the purpose of soliciting orders of the wares and subsequent sales have been demonstrated [see *Riches, McKenzie & Herbert LLP v Park Pontiac Buick GMC Ltd* (2005), 50 CPR (4th) 391 (TMOB); *Premier School Agendas Ltd v Styles* (2007), 62 CPR (4th) 66 (TMOB); *Smart & Biggar v Sutter Hill Corp* (2012), 103 CPR (4th) 128 (TMOB)]. In this case, it is apparent that any distribution of the abovementioned wares was for the purpose of promoting the Registrant's services only.

Accordingly, I cannot conclude that the Registrant has demonstrated use of the Marks in association with such wares.

[17] In contrast, Ms. Silver attaches, as Exhibit 21 to her declaration, copies of extracts from a recipe collection book entitled “*Sphere’s Cookin’*”, which she attests was “distributed, *offered for sale and sold* in the normal course of trade by the Registrant during the Relevant Period” (emphasis added). Similarly, attached as Exhibit 22 are photographs of a phonograph record, compact disc, pre-recorded videocassette and pre-recorded audiocassette, all of which Ms. Silver attests displayed the Marks and were sold during the Relevant Period. As for the normal course of trade, she attests that these particular products were sold “off-stage in the form of cash sales at the various events organized by [the Registrant]” and that she is “personally aware” that such sales occurred during the Relevant Period.

[18] Accordingly, with respect to registration No. TMA671,489, in view of Exhibits 21 and 22 and the accompanying statements in Ms. Silver’s declarations, I am satisfied that the Registrant has demonstrated use of the Marks within the meaning of sections 4 and 45 of the Act in association with the following wares only: “phonograph records, pre-recorded tapes, pre-recorded magnetic tapes, pre-recorded discs and pre-recorded cassettes”, “pre-recorded music videos, pre-recorded video cassettes and pre-recorded video discs”, “compact discs” and “souvenir items, namely booklets”.

[19] Similarly, with respect to registration TMA675,678, I am satisfied that the Registrant has demonstrated use of the Marks within the meaning of sections 4 and 45 of the Act in association with the following wares only: “sound and/or video recordings, all in the form of video tapes and digital compact discs” and “publications, namely, books”.

[20] With respect to the remaining wares in both registrations, as noted above, I am not satisfied that the Registrant has demonstrated use of the Marks in the normal course of trade within the meaning of sections 4 and 45 of the Act. Furthermore, no special circumstances excusing non-use of the Marks in association with such wares is before me. The registrations will be amended accordingly.

Disposition for registration No. TMA671,489

[21] In view 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, registration No. TMA671,489 will be maintained with respect to the all of the registered services and amended to delete wares (1), (2), (3), (6), (7) as well as “read-along books” from wares (4) and “Magazines; badges; clothing namely, sport shirts and knit shirts; ... adhesive stickers and decals; folders; brochures; ... printed matter, and stationery, namely cards, writing paper, post cards; pencils; felt tip pens, diaries, memo pads, paper weights, cups; and illustrations on record covers, namely graphics” from wares (8).

[22] The amended statement of wares will be as follows:

Phonograph records, pre-recorded tapes, pre-recorded magnetic tapes, pre-recorded discs and pre-recorded cassettes; pre-recorded music videos, pre-recorded video cassettes and pre-recorded video discs; compact discs; souvenir items, namely booklets.

Disposition for registration No. TMA675,678

[23] Furthermore, 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, registration No. TMA675,678 will be maintained with respect to the all of the registered services and amended to delete wares (1), (4), (5) and “catalogs, newsletters” from wares (2).

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

Sound and/or video recordings, all in the form of video tapes and digital compact discs;  
Publications, namely, books.

---

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