

**IN THE MATTER OF AN OPPOSITION  
by Roland Battistini, trading as Third  
Verse, to application No. 1,216,224 for the  
trade-mark THIRD VERSE in the name of  
Tom Chatzidimos**

On May 10, 2004, Tom Chatzidimos filed an application to register the trade-mark THIRD VERSE (the “Mark”). The application is based upon use of the Mark in Canada in association with:

1. Musical sound recordings namely compact discs and CD ROMS featuring music and inserts containing information about performances, recordings, appearances, the biography, and other information about musical performers and recording artists since at least as early as December 1998;
2. Providing a website on a global computer network featuring information about performances, recordings, appearances, the biography, and other information about musical performers and recording artists since July 2002;
3. Entertainment, namely, live music concerts since March 1999.

The application was advertised for opposition purposes in the Trade-marks Journal of September 29, 2004.

On November 29, 2004, Roland Battistini, trading as Third Verse, (the “Opponent”) filed a statement of opposition against the application. I am disregarding those portions that attempt to introduce evidence or argument.

The Applicant filed and served a counter statement. I am disregarding those portions that attempt to introduce evidence or argument.

The Opponent filed evidence pursuant to r. 41 of the *Trade-marks Regulations (1996)*, namely an affidavit of Roland Battistini.

The Applicant filed evidence pursuant to r. 42, namely an affidavit of Tom Chatzidimos.

The Opponent also filed evidence pursuant to r. 43, namely a further affidavit of Roland Battistini.

Each of the affidavits includes argument, conjecture, hearsay, and irrelevant facts and allegations. I am disregarding all such portions. I also take this opportunity to state that the affidavits of third parties attached as exhibits to Mr. Chatzidimos' affidavit are inadmissible hearsay.

No cross-examinations were conducted.

Only the Opponent filed a written argument. An oral hearing was not requested.

### Issues

The parties are clearly involved in a vindictive dispute concerning who owns the rights to the name and music of a band called THIRD VERSE. Given their conflicting evidence, it is often difficult to assess which version of the contested facts is correct. However, the majority of the points contested by them are not relevant to the issues to be dealt with in these proceedings. The issues to be dealt with in the present proceedings are as follows:

1. Did the Applicant use the Mark as of the dates claimed in his application?
2. Could the Applicant have been satisfied that he was entitled to use the Mark in association with the applied-for wares and services?
3. Did the Opponent use THIRD VERSE before the Applicant?
4. Is the Applicant's Mark not distinctive in view of the reputation acquired by the Opponent in association with THIRD VERSE?

The above four issues form the basis of pleadings under. s. 38(2)(a)-s. 30(b), s. 38(2)(a)-s. 30(i), s. 38(2)(c)-s. 16(1) and s. 38(2)(d)-s. 2 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the "Act").

The material dates at which each of the aforementioned issues must be assessed are:

1. the filing date of the application [*Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
2. the filing date of the application [*Georgia-Pacific Corp. v. Scott Paper Ltd.*, *supra*];

3. the Applicant's claimed dates of first use [s.16]; although, if the Opponent succeeds in challenging the Applicant's claimed date of first use under its s. 30(b) ground of opposition, the material date for assessing the s. 16 ground of opposition may become the Applicant's filing date [*American Cyanamid Co. v. Record Chemical Co. Inc.* (1972, 6 C.P.R. (2d) 278 (T.M.O.B.); *Everything for a Dollar Store (Canada) Inc. v. Dollar Plus Bargain Centre Ltd.* (1998), 86 C.P.R. (3d) 269 (T.M.O.B.)]; and
4. the filing of the opposition [*Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)].

### Onus

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. [*John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]

### Summary of Portions of Opponent's Evidence

The Opponent has known the Applicant since 1999; they were in a band called "Third Verse" from 1999 to 2003 and parted ways "on bad terms" in 2003.

Paragraphs 21-22 of the Opponent's affidavit read as follows:

"As of May 1, 2003, the Applicant had never used the name THIRD VERSE in relation to income tax statements, business registration documents, vendor permits, live performance contracts, or any real and regular commercial activity.

Since 1998, the Applicant has only used the name "Third Verse" in a way that can best be described as a hobby. In terms of releasing music and selling that music through live performances and websites, the Applicant has never engaged in these activities in any significant way or with any regularity. Attached hereto, as Exhibit "J" to my affidavit, are

charts I prepared, outlining, year by year, the approximate activities of the Applicant's band."

According to Mr. Battistini's charts, between 1998 and 2006 the Applicant's band released 16 songs, 4 in December 1998, 6 in April 2002 and 6 (allegedly illegally) in November 2003. During the same period of time, it had 15 live shows, 1 in March 1999, 5 in 2000, 4 in April-June 2002, 3 in September-November 2004, and 2 in June-September 2005.

According to Mr. Battistini, the Applicant did not have a website from December 1998 to June 2004, although he was personally working on a test website in July 2002. Mr. Battistini says that the Applicant did have a website from July 2004 to November 2005, but that "not a single CD was ever sold off the website in 2004, and very few, if any, CDs were sold through the website in 2005." However, it is not clear how Mr. Battistini would have knowledge of the Applicant's website sales in 2004 and 2005 since he parted ways with the Applicant in 2003.

Under the heading "Minimal CD Sales", Mr. Battistini states that few copies of the Applicant's 1998 demo CD were ever produced or sold, that between Spring 1999 and April 2002 no CDs were available for purchase and that in April 2002, "[i]t is almost certain that fewer than one hundred and fifty (150) copies were ever sold, given the number of CDs that were given away for free and the number of copies that remained in our possession."

Mr. Battistini expresses the view that the Applicant has never engaged in live performances of any significance. In support of his view, he attaches copies of a Toronto magazine that he says lists every musical event of any significance in Toronto and he notes that the Applicant is not listed even though its website states that the THIRD VERSE band was performing on the nights in question. In his reply evidence, he says that the Applicant's band stopped using THIRD VERSE as its name in November 2005 and is now performing under another name.

Mr. Battistini obtained a Master Business License in Ontario for the business name Third Verse on May 1, 2003. He claims to have used Third Verse in Canada since May 1, 2003 in association with musical sound and video recordings; providing a website on a global computer network;

entertainment, namely live music concerts; music composition and transcription; audio recording and production; music publishing services; management of performing artists; financial consultation and advisory services; and legal services.

He provides the following evidence of his activities:

- 9 invoices dated between May 12, 2003 and January 18, 2006 issued by Third Verse for “web page design”, “website”, “hosting package” and the like
- 1 invoice dated December 30, 2005 issued by Third Verse for “The 22 Minute Primer with James M. Klotz and Ian Laird”
- 1 invoice dated January 25, 2006 issued by Third Verse for “BTEK / Starband”
- the 2005 version of his website [www.third-verse.com](http://www.third-verse.com), which he says he has maintained since 2003.

Overall, even though the Opponent’s website says that it offers “music transcription and composition, recording and production”, the invoices suggest that the Opponent’s main activity under the trade-mark THIRD VERSE has been website design.

On November 10, 2003, the Opponent filed Canadian trade-mark application No. 1,195,552 to register THIRD VERSE based on use in Canada since May 1, 2003 in association with the same wares and services that were subsequently listed in the Applicant’s application. The Opponent’s application 1,195,552 was abandoned under s. 36 on February 14, 2005.

#### Summary of Portions of Applicant’s Evidence

The Applicant attests that he has played drums in an independent musical group named “Third Verse” since May 1998. He further attests that the Opponent was “permitted” to play bass for “Third Verse” in November 1999 when the band’s original bassist left, and that the Opponent continued to play with “Third Verse” until February 2003, with a hiatus from January to May 2001.

According to the Applicant, “independent musical groups sell CDs at make-shift merchandise tables set up at the venues where they perform or out of the back seats of their cars and are paid

by bar owners in cash.” Given the nature of the business, the Applicant states that obtaining vendor permits and the like is not indicative of commercial legitimacy.

The Applicant further attests:

- “CD sales through the Internet have admittedly not been robust; we rely mainly on sales at live shows which are brisk”
- copies of a CD entitled “Behind the Blur” were sold at a CD-Release party in April 2002 as well as at a further show in June 2002
- hundreds of the band’s “We’ll Get Through” CD were sold between June 23 and December 31, 2004 at shows performed in Toronto.

Mr. Chatzidimos attests that the band has had a proper website since July 2002, although intermittent. He adds that the website was taken offline by the Opponent when the Opponent quit the band in 2003. The band subsequently created another website, which was taken offline for changes in November 2005.

#### Section 30(b) Ground of Opposition

The Opponent has pleaded that the Applicant did not provide an accurate statement regarding his date of first use.

The initial burden on the Opponent respecting this ground may be met by reference not only to the Opponent's evidence but also to the Applicant's evidence. [*Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) (F.C.T.D.) 216 at 230] However, while the Opponent may rely upon the Applicant’s evidence to meet its evidential burden in relation to this ground, the Opponent must show that the Applicant’s evidence is ‘clearly’ inconsistent with the Applicant’s claims as set forth in its application.

I find that the Opponent has not met its initial burden with respect to this ground because its own evidence does not evidence that the claimed dates of first use are incorrect and the Applicant’s evidence is not clearly inconsistent with its claimed dates.

Regarding the musical sound recording wares identified as (1) on page one, the Opponent himself confirms that the band released a demo CD as of the claimed date of first use, December 1998. The Opponent denies that there were any sales of this CD but as he was not a member of the band in 1998, it is unclear on what basis he has made this statement. Mr. Chatzidimos attests, at paragraph 29 of his affidavit, “The Opponent joined “Third Verse” in November of 1999, as such, his statement that few, if any copies of the December 1998 demo were ever produced or sold is false.”

Regarding the website services identified as (2), Mr. Battistini attests that he was personally working on a test website for the band in July 2002. Mr. Chatzidimos attests that he fails to understand the characterization of the initial website as a “test site”; he calls the initial website “a proper band website”, and says that the THIRD VERSE band has had an Internet presence since July 2002.

Regarding the entertainment services identified as (3), the Opponent has itself confirmed that there was a live show in March 1999. Mr. Battistini’s comments regarding the shows not being “significant” or the band being merely “a hobby band” are not relevant; nor is it relevant that the Applicant may not have obtained business registrations and the like.

Since the Opponent has not met its initial burden, the Applicant is not required to positively prove its dates of first use.

The s. 30(b) ground is accordingly dismissed.

#### Distinctiveness Ground of Opposition

The Opponent meets its evidential burden with respect to this ground if it shows that as of the filing of the opposition its mark had become known sufficiently to negate the distinctiveness of the applied-for Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.); and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)].

Although the Opponent states that he started a business in association with the trade-mark THIRD VERSE on May 1, 2003, the only evidence showing use of such mark by him in accordance with s. 4 of the Act prior to the filing of the opposition are the four invoices included in his exhibit “N”, which are dated May 12/03, August 4/03, December 8/03, August 20/04, and November 23/04. Each of these invoices relates to website services.

The Master Business Licence registration obtained by the Opponent in 2003 is not evidence of use of THIRD VERSE. [*Pharmx Rexall Drug Stores Inc. v. Vitabrin Investments Inc.* (1995), 62 C.P.R. (3d) 108 (T.M.O.B.); *Opus Building Corp. v. Opus Corp.*, (1995) 60 C.P.R. (3d) 100 at 106]

Given that the Opponent had acquired some reputation in association with THIRD VERSE website services as of the material date, I must assess if the Applicant has met its legal burden to show that the Mark nevertheless served to distinguish the applied for wares and services as of the material date. I find that the Applicant has not satisfied its legal burden in so far as the website services identified as (2) are concerned. There is no evidence that the Applicant had performed any such services on behalf of other parties or was in a position to do so as of November 29, 2004. Since the marks are identical, the Applicant’s Mark is accordingly not capable of distinguishing these services from those of the Opponent. The distinctiveness ground therefore succeeds so far as the services identified as (2) are concerned. However, the ground fails regarding the remaining wares and services because there is evidence that the Applicant was using THIRD VERSE in association with such wares and services as of November 29, 2004 and no evidence that the Opponent was using THIRD VERSE in association with wares or services of that nature to any significant degree as of that date.

#### Section 16 Ground of Opposition

The Opponent meets its evidential burden with respect to this ground if it shows use of its mark in Canada prior to the Applicant’s claimed dates of first use and non-abandonment of its mark as of the date of advertisement of the Applicant’s application. [s. 16]



The Opponent has not evidenced use of THIRD VERSE prior to the dates claimed by the Applicant. Accordingly, it has not met its initial burden and this ground must be rejected.

#### Section 30(i) Ground of Opposition

The Opponent has pleaded that the application does not comply with s. 30(i) because the Applicant could not have been satisfied that he was entitled to use the trade-mark in association with the applied for wares and services.

Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155] Despite the Opponent's assertions to the contrary, I do not find that there is any relevant evidence of bad faith on behalf of the Applicant and therefore I dismiss this ground.

#### Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, pursuant to s. 38(8) I refuse the application with respect to "providing a website on a global computer network featuring information about performances, recordings, appearances, the biography, and other information about musical performers and recording artists" and reject the opposition with respect to the remaining wares and services. Authority for a split decision is set out in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 492 (F.C.T.D.).

DATED AT TORONTO, ONTARIO, THIS 24th DAY OF SEPTEMBER 2007.

Jill W. Bradbury  
Member  
Trade-marks Opposition Board