



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

Citation: 2011 TMOB 37
Date of Decision: 2011-03-15

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Boughton Law Corporation against
registration No. TMA559,244 for the trade-mark ON
TOUR in the name of CTV Limited**

[1] At the request of Boughton Law Corporation (the Requesting Party), the Registrar of Trade-marks forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on November 27, 2007 to CTV Limited, the registered owner (the Registrant) of registration No. TMA559,244 for the trade-mark ON TOUR (the Mark).

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

- (1) Television broadcasting services, interactive electronic communications services namely the operation of an Internet website for the purpose of providing on-line chats, e-mail, direct sales and television webcasts;
- (2) Providing information and entertainment services via the media of television, satellite, computer, telephone, audio, video, and/or via the World Wide Web on the global Internet (including narrow band and broad band applications) or through electronic mail;
- (3) Production, distribution, recording and development of television programs.

[3] 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 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. In this case, the relevant period for showing use is between November 27, 2004 and November 27, 2007 (the Relevant Period).

[4] “Use” in association with services is set out in s. 4(2) of the Act:

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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of a s. 45 proceeding [*Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1979), 45 C.P.R. (2d) 194, aff’d (1980), 53 C.P.R. (2d) 63 (F.C.A.)]. Although the threshold for establishing use in these proceedings is quite low [*Lang, Michener, Lawrence & Shaw v. Woods Canada Ltd.* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.)], and evidentiary overkill is not required [*Union Electric Supply Co. v. Canada (Registrar of Trade Marks)* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)], 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 or services specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Registrant furnished the affidavit of Neil Staite, Director of Music Operations for MuchMusic and MuchMoreMusic, divisions of the Registrant, together with Exhibits A through G. Only the Registrant filed written submissions; an oral hearing was not held.

[7] In his affidavit, Mr. Staite provides that the Registrant and its related companies operate as one of the largest Canadian media companies, with at least 35 radio stations, 27 conventional television stations and interests in 35 specialty television channels. He further states that the Registrant is also a multimedia content provider through various distribution methods including the Internet. Mr. Staite provides information regarding the substantial reputation of the Registrant, and lists broadcasting awards won by the Registrant (under its then name CHUM).

[8] Mr. Staite explains that CTVglobemedia Inc. completed its acquisition of CHUM Limited (original registrant) on June 22, 2007. On July 31, 2007 CHUM Limited changed its name to CTV Limited (CTV). CTV is affiliated with CTV Inc. and CTVglobemedia Inc., and

has licensed both entities to use the Mark. The affiant states that the Registrant controlled and continues to control the character and quality of the services provided by said licensees in association with the Mark. I am therefore satisfied that any use of the Mark shown during the Relevant Period accrued to the benefit of the Registrant.

[9] Mr. Staite explains that during the Relevant Period, the Registrant operated and still operates its MuchMoreMusic television channel in Canada. For that channel, CTV provides broadcasting services, and the production, distribution, recording and development of television programs. More specifically, in association with the Mark, CTV produces and broadcasts “interstitials”, which are short television “program segments” (usually 30-45 seconds in length), which display the Mark and contain information on concert listings. In support, attached as Exhibit C to the affidavit is a DVD containing video clips of ON TOUR program segments. I note that this DVD does not appear to be a commercial DVD for re-sale, rather one recorded for the purpose of putting these program segments into evidence. These segments were recorded after the Relevant Period; however, Mr. Staite explains that the Registrant does not archive such records and attests that the content accurately reflects the use of the Mark during the Relevant Period. I note that the Mark is clearly displayed during the program segments, and I am satisfied that the evidence as a whole demonstrates that the Registrant used the Mark in Canada within the meaning of s. 45 and s. 4(2) in association with “television broadcasting services” in services (1), “providing information and entertainment services via the media of television” in services (2), and all of services (3) “production, distribution, recording and development of television programs.”

[10] Also attached as Exhibit E is a DVD of 10 second “opening animations” that a viewer would have seen when watching the MuchMoreMusic channel. These were created in January 1999; however, it is not clear that these continued to be broadcast during the Relevant Period. I have therefore disregarded them; I note that in any event, this Exhibit has no effect on the final determination.

[11] In my view, the “program segments”, as described by Mr. Staite and shown in Exhibit C, do not support a finding of use on the services “providing information and entertainment services via the media of [...] satellite, computer, telephone, audio, video...” in services (2). Although the

provision of information via satellite and computer may be necessary to, and provided concomitantly with, the ON TOUR program segments, there is no evidence that those services are provided by the Registrant itself in association with the Mark. In fact, the affiant makes no reference to these services at all. Similarly, with respect to the “telephone, audio, video” services, there is no evidence of provision of the ON TOUR program segments (or any other information in association with the Mark), by telephone, or through any audio or video media (such as recorded CDs or DVDs, for example). Accordingly, and as no special circumstances are advanced to excuse the absence of such use, the registration will be amended to delete the aforementioned services.

[12] I turn now to the Internet related services, namely “interactive electronic communications services namely the operation of an Internet website for the purpose of providing on-line chats, e-mail, direct sales and television webcasts” in services (1), and “providing information and entertainment services [...] via the World Wide Web on the global Internet (including narrow band and broad band applications) or through electronic mail” in services (2). In this respect, Mr. Staitte attaches archived pages (Internet Archive: *Wayback Machine*) of the website *www.MuchMoreMusic.com* (Exhibits D-1 and D-2). The affiant attests that the website has been accessible in Canada since 2001 and throughout the Relevant Period, and I accept his statements that the Exhibits accurately reflect the content of the website during the Relevant Period. I note that the pages from December 7, 2004 bear the name CHUM Limited and the pages from October 18, 2007 display the CTVglobemedia logo. On both sets of pages, the Mark is clearly displayed in a special section of the page above listings of musical artists along with dates and locations of concerts. I accept this as evidence of use of the Mark on the Internet services set out in services (2) “providing information and entertainment services... via the World Wide Web on the global Internet (including narrow band and broad band applications).”

[13] However, although the Mark appeared on the website in connection with providing information, I am not satisfied that the evidence demonstrates use of the Mark in association with the specific services of “interactive electronic communications services namely the operation of an Internet website for the purpose of providing on-line chats, e-mail, direct sales and television webcasts” in services (1) or “providing information and entertainment services [...] through

electronic mail” in services (2). I note that there appear to be menu options (such as CONNECT and MESSAGE BOARDS), that suggest interactive capability on the website; however, even if I were to conclude that these were for the purpose of providing on-line chats or e-mail, I note that the Mark itself is only displayed in a special section of each page that provides information on artists and concert listings. The Mark does not appear to be displayed in association with the operation of the whole website in general or in association with any type of interactive services. Accordingly, and as no special circumstances are advanced to excuse the absence of such use, the registration will be amended to delete the aforementioned services.

[14] In view of all of the foregoing, pursuant to the authority delegated to me under s. 63(3) of the Act and in compliance with the provisions of s. 45 of the Act, the registration will be amended to delete: “interactive electronic communications services namely the operation of an Internet website for the purpose of providing on-line chats, e-mail, direct sales and television webcasts” from services (1) and “[...] satellite, computer, telephone, audio, video [...] or through electronic mail” from services (2). The services as amended will read:

(1) Television broadcasting services; (2) Providing information and entertainment services via the media of television and/or via the World Wide Web on the global Internet (including narrow and broad band applications); (3) Production, distribution, recording and development of television programs.

P. Heidi Sprung
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Canadian Intellectual Property Office