



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

Citation: 2013 TMOB 84
Date of Decision: 2013-05-09

**IN THE MATTER OF A SECTION 45
PROCEEDING requested by Star Island
Entertainment LLC against registration
No. TMA699,038 for the trade-mark MANSION in
the name of Provent Holdings Ltd.**

[1] On November 4, 2010, at the request of Star Island Entertainment LLC, the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 to Provent Holdings Ltd. (the Registrant). The notice required the Registrant to show that its trade-mark MANSION (registration No. TMA699,038) had been used in Canada in association with each of the registered wares and services within the previous three years.

[2] In the present case, it is clear that the Registrant's evidence does not show use of the trade-mark in association with any of the registered wares, or with the registered services "screening of movies and shows; bingo hall services; betting on horses; cruise ship entertainment services; providing on-line publications featuring travel, sports, entertainment, fashion, leisure activities; publication of electronic books and journal on-line". Furthermore, the Registrant has not asserted any special circumstances to excuse such non-use.

[3] Thus, the determination left to be made is whether the Registrant has shown use of its trade-mark MANSION with respect to the following registered services:

Providing casino gambling facilities; operation of a casino; gaming machines entertainment services; entertainment services relating to amusement machines; electronic games services provided by means of the Internet; provision of games by means of computer based system. [the Services]

[4] In respect of services, section 4(2) of the Act sets out the meaning of use:

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] In response to the Registrar's notice, the Registrant furnished the affidavit of Mr. Andrew Tait, General Counsel of the Registrant's licensee, Mansion Online Casino Ltd. (Mansion Casino). Both parties filed written submissions and were represented at an oral hearing.

[6] In response to the Registrant's evidence, the main submissions of Star Island Entertainment LLC (the Requesting Party) were the following:

- (a) The use shown is not by the Registrant, nor is it use that enures to the Registrant's benefit;
- (b) The trade-mark used is not the trade-mark *as registered*; and
- (c) The trade-mark has not been used with the Services *in Canada*.

[7] I will now discuss the evidence and arguments with respect to each of these issues in turn.

Does the evidence show use of the registered trade-mark that enures to the Registrant's benefit pursuant to section 50 of the Act?

[8] The evidence must show use of the trade-mark by the Registrant, or use by a proper licensee satisfying the requirements of section 50 of the Act. In this regard, the requirements of section 50(1) of the Act can be met if it is established that the Registrant had, under license, direct or indirect control of the character or quality of the Services.

[9] It is clear from the evidence that the Registrant does not provide the Services directly itself in Canada; instead, Mr. Tait attests that Mansion Casino provides the Services, and that Mansion Casino is licensed by the Registrant to use the trade-mark in association with these Services in Canada and internationally.

[10] On this issue, the Requesting Party submitted that the evidence is insufficient, as the Registrant failed to produce a copy of the license agreement, identify the terms of the license, or provide actual evidence to show that the Registrant exercised control over the Services provided by Mansion Casino in association with the trade-mark.

[11] However, it is well established that filing a copy of a license agreement is not mandatory in a section 45 proceeding provided that the evidence establishes that the registrant had control over the character and quality of the services bearing the trade-mark. It has also been held that a clearly sworn statement is a sufficient method by which a registrant can demonstrate requisite control [*Empresa Cubana Del Tabaco v Shapiro Cohen*, 2011 FC 102 (FC) aff'd 2011 FCA 340].

[12] In this case, Mr. Tait provides a sworn statement to the fact that the Registrant controls the character and quality of the Services in association with which the trade-mark is used. Accordingly, I am satisfied that the requirements of section 50 of the Act have been met, and that any use shown by Mansion Casino enures to the Registrant's benefit.

Does the evidence show use of the trade-mark as registered?

[13] In paragraph 4 of his affidavit, Mr. Tait explains that the Services provided by Mansion Casino in association with the trade-mark are offered primarily through the websites *www.mansion.com*, *www.masioncasino.com*, and *www.mansionpoker.com*. He further explains that through these websites, consumers from Canada and around the world were able to access the Services offered by Mansion Casino during the relevant period.

[14] Mr. Tait provides, as exhibits to his affidavit, print outs of screen shots from the above-noted websites to show the manner in which the trade-mark was used in association with the Services. He attests that these screen shots are representative of what was available to Canadian consumers during the relevant period.

[15] The screen shots at Exhibits A1, A2, and B list and show several types of gambling/casino games, including live games, slot games, as well as card and table games. Exhibit C consists of a print out from the *www.mansioncasino.com* website showing a listing of recent winners, including one Canadian. Lastly, Exhibit D consists of a print out from the *www.mansioncasino.com* website showing a listing of various payment options that were available to Canadian consumers during the relevant period.

[16] Upon review, I note that the trade-mark appears within the domain name *mansioncasino.com*, which is also displayed in a stylized form as part of the page content on some of the exhibited screen shots. The incorporation of a trade-mark in a domain name can constitute use in association with services if immediately linked to substantial information about the services, as in the present case [see *Salam Toronto Publications v Salam Toronto Inc*, 2009 CarswellNat 171 (FC)].

[17] Accordingly, whether the display of the *mansioncasino.com* domain name and its stylized version constitute use of the trade-mark as registered is an issue of deviation. Jurisprudence is clear that where the mark as used deviates from the mark as registered, the question to be asked is whether the mark was used in such a way that it did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade-marks) v Compagnie Internationale pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA) (*Honeywell Bull*)]. In deciding this issue, one must look to see if the “dominant features” have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. It is a question of fact whether the differences between the marks are “so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences identify goods having the same origin” [*Honeywell Bull, supra* at 525]. Lastly, the use of a trade-mark in combination with additional words or

features constitutes use of the registered mark if the public, as a matter of first impression, would perceive the trade-mark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)].

[18] The Requesting Party argues that the public, as a matter of first impression, would not perceive the word MANSION, *per se*, to be a separate mark, when it is displayed as part of the *mansioncasino.com* domain name or within the stylized domain name. As such, the Requesting Party submits that the evidence furnished in the exhibits does not constitute use of the trade-mark as registered.

[19] At the oral hearing, the Requesting Party cited *Farris, Vaughan, Wills & Murphy v Sav-On Drugs Ltd* (1997), 79 CPR (3d) 570 (TMOB) where the Registrar considered font style and size as relevant factors to consider when assessing whether a trade-mark as registered stands out and appears in greater prominence than the additional matter [at paragraph 10-11]. In this case, I note that “mansioncasino.com” appears in one font size and style in the domain name displayed in the screen shots and print outs; however, the words “Mansion” and “Casino” are prominent relative to the “.com” element within the stylized version of the domain name displayed in the Exhibit A1 printout.

[20] In addition, the Requesting Party made note of various trade-mark notices on the last pages of Exhibits B, C, and D. The notices state in small print:

MansionCasino.com is licensed and regulated to offer online casino gaming services under the jurisdiction of Gibraltar.
© 2011 MansionCasino.com is an internationally registered trade-mark.

[21] The Requesting Party submitted that this is relevant with respect to the issue of deviation as these notices reinforce that use shown by the Registrant is not use of the trade-mark *per se*. Rather, a consumer would likely perceive that the Services are associated with a mark that includes the additional elements.

[22] Respectfully, I am of the view that the Requesting Party has taken an overly technical approach in its analysis of the evidence. Instead, I agree with the Registrant that the addition of “Casino” and “.com” would be viewed as merely descriptive of the type of services offered by Mansion Casino and the online environment through which

the Services are offered. In my view, these additions would not be perceived as forming part of the trade-mark *per se* [See *Ching v 3416968 Canada Inc* (2008), 71 CPR (4th) 54 (TMOB)]. In other words, the word “Mansion” for casino services would be recognized as the dominant feature when displayed with additional words or elements that are merely descriptive.

[23] Such reasoning is evident in many previous cases where the Registrar has held that similar deviations do not make the trade-marks substantially different. Notably, RITZ REDHOTS was held to be use of the mark RITZ for a sandwich consisting of a sausage or weiner enclosed in a bread roll [*Ogilvy, Renault v Arbor Restaurants Inc* (1994), 55 CPR (3d) 401 (TMOB)]; PEA CAULIFLOWER CARROT CLASSIC was held to be use of the mark CLASSIC for frozen and canned vegetables [*Riches, McKenzie & Hebert v Pillsbury Co* (1995), 61 CPR (3d) 96 (TMOB)]; and NIAGARA MIST COSMETICS was held to be use of the mark NIAGARA MIST for cosmetic and toilet preparations [*Goudreau Gage Dubuc & Martineau Walker v Niagara Mist Marketing Ltd* (1997), 78 CPR (3d) 255 (TMOB)].

[24] Furthermore, with respect to the additional “.com” element, the Registrant appropriately cites *4358376 Canada Incorporated v 770879 Ontario Limited* (2012) CarswellNat 5263 (TMOB), where the Registrar held the addition of “www.” and “.ca” to be minor deviations from the mark as registered. Similarly, I view this additional element to be a minor deviation from the trade-mark, and even more so in the stylized version of the domain name, where it appears in a significantly smaller size.

[25] Thus, I am satisfied that in these instances, the dominant and essential feature of the trade-mark has been maintained, that the trade-mark has not lost its identity and remains recognizable, and that the additions to the trade-mark are not likely to mislead, deceive, or injure the public in any way. Accordingly, I do not consider these additions to be a substantial deviation from the trade-mark as registered, and that the evidence shows use of the registered trade-mark *per se*.

Does the evidence show use of the trade-mark in association with the Services in Canada?

[26] With respect to services, where the trade-mark owner is offering and prepared to perform its services in Canada, use of the trade-mark on advertising of those services meets the requirements of section 4(2) of the Act [see *Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (RTM)]. In other words, advertising in Canada alone is insufficient to demonstrate use; at the very least, the services have to be available to be performed in Canada without the Canadian customer having to leave Canada [*Porter v Don the Beachcomber* (1966), 48 CPR 280 (Ex Ct); *Bedwell v Mayflower* (1999), 2 CPR (4th) 543 (TMOB); and *Société Nationale des Chemins de Fer Français SNCF v Venice Simplon-Orient-Express, Inc* (2000), 9 CPR (4th) 443 (FCTD) aff'd 64 CPR (3d) 87 (TMOB)] Lastly, a registrant need not have a bricks-and-mortar operation in Canada in order to satisfy the requirements of use in association with services under section 4(2) of the Act [*Saks & Co v Canada (Register of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD)].

[27] In the present case, Mr. Tait asserts that through its online casino operations, Mansion Casino has provided Canadians with access to the Services. These Services, he explains, include more than 100 online casino games. The evidence shows that these Services are offered electronically through the medium of a website, either by downloading gaming software or playing through an “instant play feature” on the website itself.

[28] The Requesting Party argues that the evidence does not show that Canadians have in fact accessed the Mansion Casino websites from Canada during the relevant period. In this regard, at the oral hearing, the Requesting Party submitted that the print out at Exhibit C, referring to a recent Canadian winner, is dated after the relevant period. As such, the requesting party argues, Exhibit C should be disregarded.

[29] The Requesting Party also cast the evidence as ambiguous, submitting that such ambiguous evidence should be construed against the Registrant [per *Aerosol Fillers Inc v Plough (Canada) Ltd* (1980), 45 CPR (2d) 194 aff'd 53 CPR (3d) 62 (FCA)]. In

particular, the Requesting Party drew attention to the fact that Mr. Tait does not identify the means by which Mansion Casino ascertains or verifies the country of residence of its customers, nor does he provide any indication of the number of Canadians who have accessed the Mansion Casino websites.

[29] I note, however, that the Registrant need only show that it was offering and prepared to perform the Services during the relevant period in Canada. In this respect, while the printout at Exhibit C is dated after the relevant period, Mr. Tait provides further evidence of the availability of the Services at Exhibit D. As previously indicated, this exhibit consists of print outs from the *www.mansioncasino.com* website showing a listing of various payment options that Mr. Tait attests were available to Canadian users during the relevant period; I note that Canadian currency is identified as one of the payment options.

[30] In *Grafton-Fraser Inc v Harvey Nichols and Company Limited* (2010), 89 CPR (4th) 394 (TMOB), the Registrar noted various examples of indicia that might be considered relevant when determining whether services were available to consumers in Canada via a website. These included displaying prices in Canadian dollars, including contact information in Canada or for Canadians, and displaying shipping policy and information for goods to Canada. Although *Harvey Nichols* is a case regarding online retail services specifically, one of the aforementioned indicia, namely references to Canadian currency, is of relevance in this case. In my view, the display of Canadian currency payment options on the Registrant's website is a clear indication that the Services were directed, at least in part, to Canadians. Given this indicia, taken together with Mr. Tait's sworn statements, I am satisfied that the Registrant was offering and prepared to perform the Services during the relevant period in Canada.

[31] The Requesting Party also submits that even if Exhibit D is evidence that Canadians are betting money and winning money, this is solely with respect to gambling services offered over the Internet, and not "entertainment services" more generally. I must note though, that the registered Services clearly specify "*gaming machines* entertainment services" and "entertainment services relating to *amusement machines*". It

is clear from the exhibited screen shots that Mansion Casino offered slot games and arcade games on its websites. In my view, these are inherently gaming and amusement machines, and the act of playing and winning inevitably constitutes a form of entertainment.

[32] Accordingly, it is my view that the trade-mark was used in association with the Services, as the evidence supports that the Registrant's licensee was offering and prepared to perform the Services in Canada during the relevant period within the meaning of section 4(2) of the Act.

[33] On a separate note, the Requesting Party further submits that the Registrant has not filed any evidence to establish that it is, in fact, legally entitled to provide gambling services in Canada. It has been held, however, that the Registrar only has the authority to consider "lawfulness" as contemplated within the *Trade-marks Act*. Compliance with other statutes is not relevant in a section 45 proceeding, nor is it the proper forum for such determinations [see *Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)].

[34] Having regard to the foregoing and in view of the evidence as a whole, I am satisfied that the evidence is sufficient to show use during the relevant period, in Canada, of the registered trade-mark in association with the Services within the meaning of section 4 and 45 of the Act.

Disposition

[35] In view of all 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. TMA699,038 will be amended to delete the statement of wares in its entirety and the following from the statement of services:

[...] screening of movies and shows [...]; bingo hall services; betting on horses; cruise ship entertainment services; [...] providing on-line publications featuring travel, sports, entertainment, fashion, leisure activities; publication of electronic books and journal on-line [...].

[36] Accordingly, the amended statement of services will be as follows:

Providing casino gambling facilities; operation of a casino; gaming machines
entertainment services; entertainment services relating to amusement machines;
electronic games services provided by means of the Internet; provision of games
by means of computer based system.

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