



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

**Citation: 2013 TMOB 110**  
**Date of Decision: 2013-06-21**

**IN THE MATTER OF SECTION 45 PROCEEDINGS  
requested by PEI Licensing Inc. against registration  
Nos. TMA659,743 and TMA660,479 for the trade-marks  
CFLPA PRO PLAYERS LOGO and AJLCF PRO  
PLAYERS LOGO in the name of Canadian Football  
League Players Association**

[1] At the request of PEI Licensing Inc. (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 July 30, 2010 to Canadian Football League Players Association (the Registrant), the registered owner of registration No. TMA659,743 for the trade-mark CFLPA PRO PLAYERS LOGO (the CFLPA mark) and registration No. TMA660,479 for the trade-mark AJLCF PRO PLAYERS LOGO (the AJLCF mark), respectively shown below:



[2] Both registrations are registered for use in association with the following wares and services:

Wares:

Hats, caps, toques, t-shirts, golf shirts, sweatshirts, jackets, jogging and exercise suits, football jerseys, sweat shorts, sweaters, football player trading cards, footballs made of

hard rubber, tote bags, banners, magnetically encoded credit cards, photographic prints, newsletters featuring professional football players, tattoos.

Services:

(1) Licensing the services of Canadian Football League football players and alumni members of the applicant to others, namely, personal appearances and participation at exhibitions and promotional events, namely, golf tournaments, baseball and slo-pitch games, fund-raising dinners, product endorsements, autograph sessions, public appearances and keynote speeches.

(2) Services to professional football players in negotiating collective bargaining agreements which include pre-season compensation, post-season compensation, pension plan, minimum compensation, playing condition and negotiations generally relating to the terms and conditions of employment;

(3) Association services, namely, to represent and promote the interests of professional football players;

(4) Licensing the use of the names, nicknames, photographs, designs, likenesses, images, visual representations and signatures of professional football players and alumni members of the applicant to others; and

(5) Licensing the use of the name, trademarks and logos of the applicant to others.

[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 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 July 30, 2007 and July 30, 2010.

[4] The relevant definitions of “use” are set out in sections 4(1) and 4(2) 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.

[5] 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)], 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.

[6] In response to the Registrar's notices, the Registrant filed affidavits of Stuart Laird, President of the Registrant, each sworn on February 22, 2011. Both parties filed written representations and attended an oral hearing.

[7] In his affidavits, Mr. Laird describes the Registrant as an unincorporated association, formed in 1965, that represents the interests of professional football players in the Canadian Football League (CFL). The Registrant provides association services to the players and acts on their behalf to negotiate the players' collective bargaining agreement with the CFL. In 2007, the Registrant represented 612 players.

[8] Mr. Laird provides a history of the development of the two subject marks, dating back to 2004. I note, however, that such development occurred prior to the relevant period, and is therefore largely irrelevant to the present proceeding. Otherwise, Mr. Laird's affidavits focus, in large part, on various agreements that the Registrant entered into with third parties respecting the licensing of the services of CFLPA player members and of the Registrant's name, trade-marks and logos in association with various wares and services. I will focus initially, then, on the evidence submitted with respect to the Registrant's licensing services for both registrations.

#### Use with respect to Services (1), (2) and (5) - Licensing

[9] With respect to the Registrant's licensing services, attached to Mr. Laird's affidavits are copies of dozens of licensing agreements between the Registrant and other parties, each in association with various wares and/or services. The agreements, in part, provide for the licensing of the Registrant's name and trade-marks, such trade-marks being specified in schedules to each agreement. Of these agreements, only two were signed during the Relevant Period and have the subject marks appearing in the schedules.

[10] Of the remaining agreements, it would appear that at some point early in 2008, the Registrant stopped licensing the use of the subject marks; the marks no longer appear in the schedules along with the Registrant's other logos. These agreements are therefore irrelevant to the present proceeding. Similarly, I consider the agreements entered into prior to the relevant period as irrelevant to the question of whether the marks were displayed in the performance of any of the registered Services. Even if I were to consider the subject marks to be displayed in those agreements, at best the display of a trade-mark in a contract is only evidence of use of that trade-mark in the performance of services at the time of the signing of the contract [see, for example, *Desjardins Sécurité Financière v Sun Life Assurance Co of Canada* (2005), 50 CPR (4th) 154 (TMOB) where the Registrar considered invoices issued during the relevant period pursuant to contracts entered into prior to the relevant period].

[11] The two exhibited agreements for which the subject marks appear in a schedule and were entered into during the relevant period are as follows:

- Exhibit O in the CFLPA affidavit/Exhibit M in the AJLCF affidavit: agreement dated October 1, 2007 with Centre 68 Incorporated regarding the manufacture and sale of bobble-head figurines. As part of the agreement, Schedule A includes the licensing of players' names and likenesses, which corresponds to Services (4) in the registrations.
- Exhibit P in the CFLPA affidavit/Exhibit N in the AJLCF affidavit: agreement dated April 1, 2008 with Evergreen Sports Programming Ltd. regarding the licensing of players appearances at public speaking engagements, which corresponds to "...public appearances and keynote speeches" in Services (1) in the registrations.

[12] Both agreements are similarly structured. In particular, the Centre 68 license agreement states, in part, the following:

The Licensor [CFLPA] grants to the Licensee [Centre 68 Incorporated] for the term of this agreement...the license to utilize the names, characters, symbols, designs, likenesses, registered trade-marks images and visual representations described in the attached Schedule "A" (collectively, the "Trade-marks") in the manufacture, promotion, distribution and sale of the products, goods, items or articles expressly described in the attached Schedule "B" (the "Licensed Product" or "Licensed Products").

[13] Schedule “A”, in turn, states the following:

1. The names, nicknames, photographs, designs, likenesses, images and visual representations of all professional football players in the Canadian Football League who are signed to Canadian Football League Standard Player Contracts during the License Period and all registered alumni members of the Canadian Football League Players’ Association.
2. The C.F.L.P.A. Pro Players logos that are attached hereto and marked as Appendix “1”.

[14] In Appendix “1”, three design logos appear, the second logo being the subject CFLPA mark and the third being the subject AJLCF mark. Also listed in the Appendix are the word marks “CFLPA PRO PLAYERS” and “AJLCF PRO PLAYERS”.

[15] Schedule “B” describes the licensed products as “Bobble-head figurines of professional football players in the Canadian Football League”, and specifically names three individuals in particular.

[16] Nothing in the license agreement requires the licensee to display any particular logo on its bobble-head figurines and, as the Requesting Party notes, there is no evidence furnished that either of the subject marks ever appeared on such products at any time.

[17] Furthermore, as noted above, the subject marks only appear in the schedules to the agreements. In association with its licensing services, the Registrant provides no other evidence of display of the subject marks, for example, by way of sample letterhead or advertising to prospective partners.

[18] The Requesting Party submits that the manner in which the subject marks are displayed in the agreements does not constitute use in association with the licensing services offered by the Registrant. In particular, the Requesting Party notes that the Registrant provides no advertising or correspondence with respect to the Registrant’s licensing services showing display of the subject marks. Essentially, it is submitted that the marks are displayed as commodities in the license agreements and are not displayed for purposes of distinguishing the services of the Registrant.

[19] Although the issue of whether licensing one's own trade-mark constitutes a service of benefit to the public was raised at the oral hearing, I note that the validity of the registration is not at issue in a section 45 proceeding [*Ridout & Maybee LLP v Omega SA* (2005), 43 CPR (4th) 18 (FCA)] and that such proceedings are not intended to resolve complex issues [see *Barrigar & Oyen v Registrar of Trade Marks* (1994), 54 CPR (3d) 509 (FCTD)]. Furthermore, whether the subject marks served to actually distinguish the Registrant's services is beyond the scope of this proceeding [see *United Grain Growers Ltd v Lang Michener* (2001), 12 CPR (4th) 89 (FCA)]. Accordingly, in my view, the unique nature of the services, being the licensing of the Registrant's own trade-marks, and the broad definition of "use" under section 4(2), allows for the display of the subject marks in this case to constitute display in association with such services.

[20] In this respect, that the subject marks appeared in the schedules rather than on letterhead or covering pages is inconsequential as section 4(2) of the Act merely requires that a trade-mark be displayed in the performance of the services for use to be "deemed". In this case, the subject marks are identifiable as such and were displayed at the time the licensing services were performed – *i.e.*, they were displayed in the exhibited licensing services agreements when those agreements were signed by the parties.

[21] As such, given the nature and content of the aforementioned agreements, I am satisfied that the Registrant has demonstrated use of both marks in association with the following services within the meaning of sections 4 and 45 of the Act:

- (1) Licensing the services of Canadian Football League football players and alumni members of the applicant to others, namely, personal appearances and participation at exhibitions and promotional events, namely, ... public appearances and keynote speeches.
- (4) Licensing the use of the names, nicknames, photographs, designs, likenesses, images, visual representations and signatures of professional football players and alumni members of the applicant to others; and
- (5) Licensing the use of the name, trademarks and logos of the applicant to others.

[22] With respect to services (1), although the Registrant provided evidence of licensing agreements with respect to some of the other "exhibitions and promotional events", such agreements fell outside of the relevant period and there is no other evidence before me with

respect to such activities in association with the marks before me. Furthermore, there is no evidence of special circumstances before me that would excuse such non-use. The registrations will be amended accordingly.

#### Use with respect to Services (2) – Negotiating Collective Bargaining Agreements

[23] Although the negotiation of the players’ collective bargaining agreement is undoubtedly a significant activity of the Registrant, there is no evidence before me of the performance or advertisement of such services in association with either of the subject marks, and no evidence of special circumstances excusing such non-use is before me. The registrations will be amended accordingly.

#### Use with respect to Services (3) - Association Services

[24] With respect to the Registrant’s association services, although the evidence in this respect is not extensive, evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)]. Furthermore, services are to be given a broad interpretation [*Venice Simplon-Orient-Express Inc v Société Nationale des Chemins de Fer Français SNCF* (2000), 9 CPR (4th) 443 (FCA)]. With this in mind, attached as Exhibit E to Mr. Laird’s affidavit are copies of the Registrant’s newsletters that Mr. Laird attests were provided to player members on the activities of the Registrant and regarding issues of concern to its members. The subject CFLPA mark appears on the newsletters dated between 2004 and 2007. The Requesting Party submits that it is ambiguous whether the 2007 newsletter was published and distributed during the relevant period. However, references to the upcoming 2008 season within the newsletter corroborate Mr. Laird’s identification of the newsletter as dated “Fall 2007”; accordingly, I am satisfied that the newsletter would have been distributed to players during the relevant period.

[25] Furthermore, given the nature of the newsletters as regarding issues of concern to the Registrant’s members, I am satisfied that the foregoing is sufficient to maintain the registration for the CFLPA mark with respect to “association services”.

[26] As further support, Mr. Laird includes, at Exhibit T, a copy of an email sent to the Registrant's members informing them of a post-game party; the email includes the CFLPA mark.

[27] With respect to Mr. Laird's affidavit regarding the AJLCF mark, however, the aforementioned newsletters and email are not in evidence, as the AJLCF mark does not appear. As no evidence is before me of use of the AJLCF mark in association with Services (3), and the Registrant has provided no evidence of special circumstances excusing non-use in this respect, that registration will be amended accordingly.

Use with respect to the Wares – TMA659,743 (CFLPA mark)

[28] With respect to the Wares, although Mr. Laird provides, at Exhibit I to the CFLPA affidavit, a record of sales activity during the relevant period from its licensee Reebok with respect to "jerseys", I cannot conclude that any such sales were in association with the CFLPA mark. The only transfers of clothing bearing the CFLPA mark implied by Mr. Laird either pre-date the relevant period or do not appear to have been conducted in the normal course of trade. The registration will be amended accordingly.

[29] As well, although Mr. Laird provides evidence of the distribution of newsletters bearing the CFLPA mark during the relevant period, he provides no evidence of sales nor does he attest to any sales. 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, for example, *Riches, McKenzie & Herbert LLP v Park Pontiac Buick GMC Ltd* (2005), 50 CPR (4th) 391 (TMOB)]. The free distribution of a publication is not, generally, considered to be in the normal course of trade [*Joseph E Seagram & Sons Ltd v Corby Distilleries Ltd* (1978), 42 CPR (2d) 264 (TMOB)]. In this case, it is apparent that any distribution of the newsletters was for the purpose of performing the Registrant's association services only. Accordingly, I cannot conclude that the Registrant has demonstrated use of the subject marks in association with "newsletters".

[30] Similarly, with respect to the remaining registered wares, Mr. Laird provides no evidence of sales during the relevant period in association with the CFLPA mark. The exception is with respect to "football player trading cards". At Exhibit F of the CFLPA affidavit, Mr. Laird



provides colour copies of various player cards manufactured by the Registrant's licensee, Jogo Novelties Inc. Some of the cards are dated "2007", and attached as Exhibit G are sales summaries from Jogo showing sales of player cards in 2007 and in particular during the relevant period.

[31] Accordingly, with respect to the CFLPA mark, I find that the Registrant has demonstrated use of the Mark during the relevant period in association with the wares "football player trading cards" only.

Use with respect to the Wares - TMA660,479 (AJLCF mark)

[32] As with the registration for the CFLPA mark, with respect to the registration for the AJLCF mark, the Registrant generally provides no evidence of sales of the Wares during the relevant period. With respect to "football player trading cards", Mr. Laird attests to the same licensing agreement with Jogo, and provides the same Jogo sales summaries with respect to the sale of player cards. However, Mr. Laird does not provide any exhibits showing the AJLCF mark displayed on any cards.

[33] At the oral hearing the Registrant conceded that there was no evidence of the AJLCF mark displayed on any of the registered wares. As the Registrant has provided no evidence of special circumstances excusing such non-use, the registration for the AJLCF mark will be amended to delete the statement of wares accordingly.

Disposition for registration No. TMA659,743 (CFLPA mark)

[34] 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. TMA659,743 will be amended to delete all of the registered wares with the exception of "football player trading cards"; furthermore, the registration will be amended to delete services (2) as well as "...golf tournaments, baseball and slo-pitch games, fund-raising dinners, product endorsements, autograph sessions..." from services (1).

[35] The amended statement of wares will be as follows: "Football player trading cards".

[36] The amended statement of services will be as follows:

- (1) Licensing the services of Canadian Football League football players and alumni members of the applicant to others, namely, personal appearances and participation at exhibitions and promotional events, namely, public appearances and keynote speeches.
- (2) Association services, namely, to represent and promote the interests of professional football players.
- (3) Licensing the use of the names, nicknames, photographs, designs, likenesses, images, visual representations and signatures of professional football players and alumni members of the applicant to others.
- (4) Licensing the use of the name, trademarks and logos of the applicant to others.

Disposition for registration No. TMA660,479 (AJLCF mark)

[37] 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. TMA660,479 will be amended to delete the statement of wares in its entirety; furthermore, the registration will be amended to delete services (2) and (3) as well as "...golf tournaments, baseball and slo-pitch games, fund-raising dinners, product endorsements, autograph sessions..." from services (1).

[38] The amended statement of services will be as follows:

- (1) Licensing the services of Canadian Football League football players and alumni members of the applicant to others, namely, personal appearances and participation at exhibitions and promotional events, namely, public appearances and keynote speeches.
- (2) Licensing the use of the names, nicknames, photographs, designs, likenesses, images, visual representations and signatures of professional football players and alumni members of the applicant to others.
- (3) Licensing the use of the name, trademarks and logos of the applicant to others.

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