



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

Citation: 2014 TMOB 51
Date of Decision: 2014-03-06

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by McMillan LLP against registration
No. TMA611,362 for the trade-mark SPORTSLINE in
the name of SportsLine.com, Inc.**

[1] At the request of McMillan LLP (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on November 14, 2011 to SportsLine.com, Inc. (the Registrant), the registered owner of registration No. TMA611,362 for the trade-mark SPORTSLINE (the Mark).

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

- (1) Providing sports-related information via a global computer network; providing games and contests which may be accessed via a global computer network by subscribers.
- (2) Providing computer bulletin board services and real-time chat sessions in the field of sports.

[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. In this case, the relevant period for showing use is between November 14, 2008 and November 14, 2011.

[4] The relevant definition of “use” in association with services is set out in section 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 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 services specified in the registration during the relevant period.

[6] In response to the Registrar's notice, the Registrant filed the affidavit of Rebecca Borden, Vice President and Assistant Secretary of the Registrant, sworn on June 21, 2012. Both parties filed written representations and attended an oral hearing.

[7] Ms. Borden attests that the Registrant, a subsidiary of CBS Interactive Inc., and its related companies provide news and information services in the field of sports over the Internet to users in the United States, Canada, and elsewhere, by distributing news, scores, player and team statistics, photos, and audio and video clips. She attests that the Registrant produces and offers fantasy league products, contests, and other games, while also producing and distributing interactive programming, such as editorials and analyses, online commentary, and internet chat forums. She further explains that the Registrant offers content to wireless users of digital cellular phones, Web-enabled cellular phones, and personal digital assistant devices.

[8] Ms. Borden explains that the website *www.SportsLine.com* was launched in June 1995 and that in 2004, Viacom, a predecessor of CBS, purchased *www.SportsLine.com*, attracting a "huge" user base. In 2007, CBS subsequently re-named the website to "CBS Sportsline". Ms. Borden attests that since 2009, the URL for Registrant's website has been *www.CBSSports.com*; however, "due to consumers' reliance" on SPORTSLINE, the website retained reference to the Mark.

[9] In support of the Registrant's assertion of use of the Mark in association with the registered services, the following exhibits are attached to Ms. Borden's affidavit:

- Exhibit A consists of sixteen samples of archived webpages of *www.SportsLine.com* and *www.CBSSports.com* dated between October 26, 1996 and March 7, 2011. Ms. Borden states that these webpages display the name of the website and also display a “sample of references” to the Mark on the website during each of these years. She states that during the three-year period ending on November 14, 2011, and continuing until now, the domain name *www.SportsLine.com* resolved to a website providing news, scores, player and team statistics, photos, and audio and video clips and other services associated with the Mark. In this respect, the printout from March 21, 2008 (prior to the relevant period), is the last printout to use the URL *www.SportsLine.com*; the printouts from April 22, 2009, and afterward are for the URL *www.CBSSports.com*. I note that among the webpage printouts from the relevant period, the only reference to the Mark is in the notice at the bottom of each webpage printout as follows: “SportsLine is a registered service mark of SportsLine.com, Inc.”
- Exhibit B consists of a list of 25 domain names that include the term SPORTSLINE, such as *sportslines.us*, *cbssportslines.fr*, *ccbssportslines.com* and *cbssportslines.net*, that “were registered and are maintained” by CBS. Ms. Borden explains that in order to protect the SPORTSLINE brand, CBS registered these domain names before and during the relevant period.
- Exhibits C1, C2, and C3 consist of printouts of over 4000 SPORTSLINE search terms that Ms. Borden attests were used by people visiting *www.google.com* and who subsequently visited the Registrant’s website in 2009, 2010, and 2011 respectively. Ms. Borden states that in each of these years, there have been in excess of seven million visits to the website after a search for a SPORTSLINE term on Google. She states that for those visits to the Registrant’s website that are generated by searches on Google, “a significant proportion of those visits emanate from Canada.” More specifically, Ms. Borden states that from 2009 to 2011, visits to the Registrant’s website from Canada via Google searches made up approximately three to four percent of total visits annually.
- Exhibits D1 and D2 consist of printouts showing “Sportsline Domain Redirects” from February 8, 2012 to February 21, 2012, and from May 12, 2012 to June 12, 2012. Ms.

Borden explains that URLs that contain SPORTSLINE generate traffic for the Registrant's website and that users may enter many different URL addresses that include the Mark, such as *www.cbssportsline.com*, *www.baseball.sportsline.com*, *www.football.sportsline.com* and *www.hockey.sportsline.com*. While she confirms that such records were not kept until after the relevant period, she attests that redirects from such URLs containing the Mark accounted for approximately 550,000 to 750,000 daily visits to *CBSsports.com* from May 12, 2012 to June 12, 2012.

- Exhibit E consists of a printout of the log in page from *www.cbs.com/eye-lerts*, which invites users to register and create a log in. Ms. Borden attests that users may create a single log-in ID that is valid across all CBS websites, which also allows viewers to create news alerts ("EYE-LERT") that will notify them of a delayed start time for television programs when a sporting event runs long. She states that "*CBSSportsline.com* is also the URL used on other related CBS websites to identify the sports pages and redirect users to the sports content." In this respect, I note that the word "SportsLine" appears once on this webpage as part of a notice to users: "If you have an existing CBS Log-in ID, click here to log-in. (This is the ID you use on CBS.com, CBSNews.com, CBS SportsLine.com, and CBSGames.com)". Even if I were to accept this as display of the Mark, I am not satisfied it constitutes display of the Mark in association with any of the registered services. In any event, it would appear that the exhibited webpage was printed in July 2012, after the relevant period, and no information is given as to how the page appeared during the relevant period.
- Exhibit F consists of a copy of the mobile version of the webpage identified by Ms. Borden as *http://wap.sportsline.com*. Ms. Borden attests that the mobile version of the sports webpage "has been accessible since at least as early as 2002 in the current form." Links to game scores, fantasy sports news, and videos appear on the webpage. Although she states that "many users access this wap page by reference to *wap.sportsline.com*", it is not clear whether users are first redirected to a mobile version of *CBSSports.com* as with the Registrant's main website. The Mark does not appear in the content of the webpage and, in any event, I note that the printout appears to have been printed after the relevant period. As with Exhibit E, the Registrant furnishes no clear evidence regarding

how the webpage and in particular the URL containing the Mark would have appeared during the relevant period.

- Exhibit G is comprised of a sample printout of the *CBSSports.com* webpage. Ms. Borden attests that the Mark appears on *CBSSports.com*, “where a trailer at the bottom of many of the web pages indicates that ‘SportsLine is a registered service mark of SportsLine.com, Inc.’” Although the exhibit was printed in July 2012, Ms. Borden states that the notice has been included on the Registrant’s website since as early as 1995.
- Exhibit H consists of a printout of a webpage from *www.CBSSports.com/fantasy*. Ms. Borden explains that the Mark appears on the webpages for the Registrant’s fantasy league services. She explains that the fantasy league services include bulletin boards for fantasy participants, contests, as well as information services in the field of sports. She states that these fantasy leagues have been operating on the web since at least 1997. The exhibited webpage displays sign up links for various games and sports such as “Fantasy Football Games”, including “Fantasy Football Commissioner” and “Fantasy Football Premium Games”. Headings and links for various baseball, basketball and hockey games also appear listed on the exhibited webpage. I note that a “SportsLine.com” logo appears at the bottom of the page along side other logos or links for what appear to be other websites such as *mvp.com* and *commissioner.com*; but, as explained below, it does not appear to be associated with any services. As well, it is not self-evident which, if any, of the links are for the Registrant’s bulletin board or chat services. Furthermore, the webpage was printed in July 2012 and no information is provided as to how the webpage would have appeared during the relevant period.
- Exhibit I consists of a copy of the webpage *www.CBSSports.com/fantasy/apps*. Ms. Borden states that sports apps are available for use with the fantasy sports leagues and are hosted on this website. As with Exhibit H, a “SportsLine.com” graphic appears at the bottom of the webpage. However, I note once more that the webpage was printed in July 2012 and Ms. Borden makes no clear statements regarding how the page appeared during the relevant period.

[10] As noted above, the only archived webpage printouts furnished by the Registrant that are from the relevant period are those in Exhibit A dated April 22, 2009, July 27, 2010 and March 7, 2011. The Requesting Party submits that these archived webpages do not demonstrate any use of the Mark as the only reference to the Mark is in fine print as part of the legal notice “trailer” at the bottom of the webpages.

[11] In its written submissions, the Registrant relies on *HomeAway.com, Inc v Hrdlicka*, 2012 CarswellNat 5339 (FC) at paragraph 22, where the Federal Court stated that “a trade-mark which appears on a computer screen website in Canada regardless where the information may have originated from or be stored, constitutes for *Trade-marks Act* purposes, use and advertising in Canada.” In that case, the Court was addressing the issue of whether display of a trade-mark (or other information) via a computer screen located in Canada constitutes display of a trade-mark in Canada, even if the data is stored or originates from a server outside of Canada. The Court reasonably found that it does; however, whether such display constitutes use of that trade-mark by its registered owner, in association with particular services, within any relevant period of time and otherwise within the meaning of sections 4 and 45 of the Act must still be determined based on the particular facts of the case. In this case, the issue remains whether such display on a computer screen in Canada constitutes use of the Mark in association with the particular registered services.

[12] In my view, the display of the Mark as part of the legal notice “trailer” as shown in the Registrant’s evidence does not constitute use of the Mark in association with any particular service that may be available on the Registrant’s website. Just as a trade-mark displayed in one section of a department store may not necessarily associate it with all services offered throughout that store, where a trade-mark is displayed on a website can be important. Whether a trade-mark is displayed in association with all, some or none of the services offered through a website will depend on the location and prominence of that trade-mark. During the relevant period, the trade-mark that appeared at the top of the Registrant’s webpages, and therefore generally in association with all of the services appearing on those pages, was *CBSSports.com*. This is not to say that other trade-marks cannot also be associated with the Registrant’s services, but the display of the notice at the bottom of the Registrant’s webpages, without reference to the Mark elsewhere on the website, is essentially a *non sequitur*.

[13] As such, I agree with the Requesting Party that the mere notice of what entity owns a trade-mark cannot be considered, in and of itself, “use” in association with services as contemplated by section 4(2) of the Act.

[14] Similarly, with respect to Exhibits H and I, the *Sportsline.com* logo appears only at the bottom of the page, and not clearly in association with any of the links or services available on the page. In any event, as noted above, these exhibits are dated after the relevant period and, unlike the Exhibit A webpage printouts, Ms. Borden makes no clear statements regarding the appearance of these webpages during the relevant period.

Analysis – Internet search terms

[15] The Registrant furnished extensive evidence showing that consumers (including from Canada) use the term SPORTSLINE as an Internet search term, generating millions of visits annually to the Registrant’s website. However, I agree with the Requesting Party that the Registrant’s evidence in this regard is largely irrelevant, as Internet searches are actions taken by users to find webpages, and do not constitute “use” by the Registrant that would enure to its benefit.

[16] The Act makes a distinction between when a trade-mark is deemed to be used (section 4) and when a trade-mark is deemed to be made known (section 5). While the Registrant’s evidence may be relevant in demonstrating that the Mark is well known in Canada, the issue in this proceeding is whether the Mark was used in Canada during the relevant period within the meaning of sections 4 and 45 of the Act. If anything, the prominent display of “CBSSports.com” on the Registrant’s website when a user is redirected there after entering an Internet search term or URL containing the Mark would be an indication by the Registrant to its customers that the Mark is no longer associated with the Registrant’s services.

Analysis – Domain names

[17] Similarly, the Registrant is attempting to show use of the Mark through the incorporation of the Mark into various registered domain names. However, the Registrar has previously found that the mere registration of a domain name does not constitute use of a trade-mark for purposes

of section 4 of the Act [see *Sun Media Corporation v The Montreal Sun (Journal Anglophone) Inc*, 2011 CarswellNat 940 (TMOB); *4358376 Canada Inc v 770879 Ontario Ltd*, 2012 CarswellNat 5263 (TMOB)]. What matters is whether the Mark is displayed in association with any particular service.

[18] As stated in Ms. Borden's affidavit at paragraph 8, however, the *www.SportsLine.com* domain name was resolved to a different URL (*www.CBSSports.com*) during the relevant period. This means that the Mark, as part of the original URL, would not be displayed in association with the services accessible via the Registrant's website after the redirect.

[19] As noted above, the webpage printout of the mobile site *wap.sportsline.com* was generated in July 2012 and I consider Ms. Borden's affidavit ambiguous at best with respect to whether the Mark would have been displayed to visitors of the site during the relevant period, either through display of the URL or on the webpage itself. The exhibited webpage does not display the Mark and the Registrant has not furnished evidence as to how or if the URL containing the Mark would have appeared in the mobile browser. The mere existence of a domain name, which in the present case does not appear on the mobile webpage itself, cannot be relied on to substantiate "use" of the Mark as contemplated by section 4(2) of the Act.

[20] In this case, even when viewed as a whole, all of the evidence demonstrates that at some point prior to the relevant period, the Registrant transitioned from using the Mark in association with its services to using the trade-mark CBS SPORTS and variations thereof. While the Registrant may be interested in protecting its registration and keeping the Mark from others, I note the following observation by the Federal Court of Appeal in *Plough, supra*, at 66:

There is no room for a dog in the manger attitude on the part of registered owners who may wish to hold on to a registration notwithstanding that the trade mark is no longer in use at all or not in use with respect to some of the wares in respect of which the mark is registered.

[21] In view of all of the foregoing, I cannot conclude that the Registrant has demonstrated use of the Mark in association with any of the registered services during the relevant period within the meaning of sections 4 and 45 of the Act. Furthermore, the Registrant has provided no evidence of special circumstances excusing the absence of such use.

Disposition

[22] Accordingly, 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, the registration will be expunged.

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