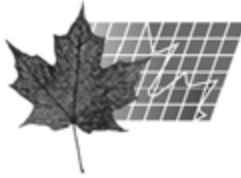


O P I C



C I P O

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

Citation: 2017 TMOB 102

Date of Decision: 2017-08-18

IN THE MATTER OF A SECTION 45 PROCEEDING

**Norton Rose Fulbright Canada
LLP/S.E.N.C.R.L., s.r.l.**

Requesting Party

and

True North Hockey Canada Inc.

Registered Owner

**TMA409,377 for TRUE NORTH
HOCKEY CANADA & Design**

Registration

[1] At the request of Norton Rose Fulbright Canada LLP/S.E.N.C.R.L., s.r.l. (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 April 10, 2015 to True North Hockey Canada Inc. (the Owner), the registered owner of registration No. TMA409,377 for the trade-mark TRUE NORTH HOCKEY CANADA & Design (the Mark), as illustrated below:



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

Operating adult ice hockey leagues, ice hockey schools and ice hockey tournaments.

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with the services specified in the registration, at any time between April 10, 2012 and April 10, 2015. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[4] The relevant definition of “use” in association with services is set out in section 4(2) of the Act as follows:

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 the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270]. With respect to services, the display of a trade-mark on advertising is sufficient to meet the requirements of section 4(2) when the trade-mark owner is offering and prepared to perform those services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[6] In response to the Registrar’s notice, the Owner furnished the affidavit of its President and Chief Financial Officer, Steven Edgar, sworn on October 20, 2015, in Toronto. Only the Requesting Party filed written representations. An oral hearing was not requested.

THE OWNER’S EVIDENCE

[7] In his affidavit, Mr. Edgar asserts that the Owner has “continuously operated adult ice hockey leagues, ice hockey schools and ice hockey tournaments [...] in Canada for over twenty-five years”. In particular, Mr. Edgar attests that the Owner operates its leagues, schools and tournaments in Ontario and in doing so, among other things, he “books ice time at arenas, organizes teams into leagues and separates teams into geographic divisions, arranges for referees to attend games and tournaments, organizes coaching at ice hockey schools and keeps statistical information of league participants”. Mr. Edgar further attests that trophies and other

merchandise are awarded to participants for “both team and personal achievements through the course of the participation”.

[8] Mr. Edgar explains that, during the 2013 hockey season, approximately 10,000 participants took part in the Owner’s adult ice hockey leagues in Canada, with 120 participants taking part in its ice hockey schools. Furthermore, the Owner organized six ice hockey tournaments. He describes the figures for 2014 as being similar.

[9] Mr. Edgar provides that prospective participants register for the Owner’s programs online through its website; however, he explains that neither hard copies of registration forms submitted online nor confirmation notices sent to participants are maintained.

[10] In support of his assertion of use, attached to Mr. Edgar’s affidavit are the following exhibits:

- Exhibit B consists of printouts and a screen capture from the Owner’s website. The screen capture, obtained from the Wayback Machine, is dated from the relevant period and shows links to further information on registration and more specifically shows links to online registration for the 2014-2015 Fall/Winter Hockey season and the 2014/2015 Winter Beginners Program. Mr. Edgar confirms that the home page of the Owner’s website “contains links to the online registration system for [the Owner’s] various services and links to information about them”. He states that the other printouts (dated October 2015) are representative of how the Mark was displayed on the Owner’s website during the relevant period.

I note that the Mark never appears on its own in the exhibited pages, but rather as a shaded background for another design mark, indicating the 25th anniversary of the True North hockey program. Mr. Edgar explains that the Mark is featured with one of the Owner’s other registered trade-marks and that “the shading of the two marks is intended to make each visible”.

- Exhibit C is a photograph of two banners, both displaying the Mark. Mr. Edgar states that these banners have been displayed prominently and permanently at the Rinx Real Entertainment Centre main hockey rink for more than twenty years. He further attests that

the banners are representative of the way the Mark was displayed at Rinx during the relevant period and that participants and prospective participants can call the phone number on the banner to obtain information about the Owner's services.

- Exhibit D is a photograph of a hockey jersey bearing the Mark. Mr. Edgar attests that the jersey has been worn by the Cretins HC, a team playing in the Owner's summer and winter leagues, since 2006. He further attests that the jersey is representative of those worn by other teams' players – albeit with different colour schemes and different team logos in the center of the jersey – who participated in the Owner's services during the relevant period.
- Exhibit E is a photograph of two individuals wearing hockey referee jerseys. Mr. Edgar attests that the depicted jerseys are representative of those worn by referees associated with the Owner's adult hockey leagues, ice hockey schools and ice hockey tournaments during the relevant period. He further explains that the Owner's referees are required to wear an official league uniform to each hockey game that they referee for the Owner. The Mark appears on both jerseys.
- Exhibit F is a photograph of a representative cheque sample. The cheque displays the Owner's corporate name and corporate address. The Mark also appears on the cheque. Mr. Edgar explains that these types of cheques were used in the management of the Owner's operations during the relevant period.
- Exhibit G consists of five photographs of t-shirts. Mr. Edgar attests that these t-shirts are representative of the promotional items distributed to league participants in the provision of the Owner's services in Canada during the relevant period and are often distributed as achievement awards. The Mark appears on the t-shirt itself or on a hang tag or label affixed to the t-shirts.
- Exhibit H is a photograph of a trophy, which Mr. Edgar describes as a "championship trophy" awarded by the Owner in the course of operating its services in Canada. I note that a minor variation of the Mark appears on the trophy, with stars instead of maple leaves appearing on either side of "TRUE NORTH".
- Exhibit I consists of four photographs. The first three photographs show a replica of the Mark on a wall in an office which Mr. Edgar identifies as the reception area of the Owner's offices.

The last photograph shows a framed and embossed replica of the Mark. Mr. Edgar explains that such framed and embossed replicas of the Mark are given as awards. He further attests that these items were “created, used and/or distributed” by the Owner in the course of operating its services in Canada.

- Exhibit J is a photograph of Mr. Edgar’s business card. The card displays the Mark with the Owner’s corporate name and contact information. Mr. Edgar attests that these business cards were used and distributed by himself as the Owner’s Director “since at least 2005”.

ANALYSIS

[11] In its written argument, the Requesting Party first questions whether the registered services were advertised in association with the Mark, submitting that the website printouts and screen capture (at Exhibit B) do not display the Mark as registered.

[12] Indeed, as noted above, the Mark does not appear by itself on the Owner’s website, but rather as a shaded background for the Owner’s 25th Anniversary logo, forming a composite mark. In my view, the dominant feature of this composite mark is the overlay of the two logos, which does not exist in the Mark as registered.

[13] In applying the principles as set out in *Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA), this substantially alters the Mark’s dominant features in appearance and in the idea suggested, such that it has lost its identity and does not remain recognizable as the Mark. As such, I am not satisfied that it constitutes display of the Mark as registered.

[14] However, even if these webpages do not display the Mark as registered, they do constitute corroborative evidence that the Owner offered and performed the registered services during the relevant period in Canada. Indeed, the website pages show links to online registration for some of the Owner’s programs, namely the “Week Night League”, the “TNHC 2014/2015 Winter Beginners Program”, and links to information about them.

[15] Otherwise, in its written representations, the Requesting Party submits that if the exhibits show any use, it would only be for the operation of ice hockey leagues, as “none of the evidence

submitted by the Affiant clearly shows use of the [Mark] in association with the operation of ice hockey schools or ice hockey tournaments”. It suggests that “little effort would have been required to provide examples of use with respect to all the Services during the relevant period” [citing *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC) and *Hudson's Bay Co v Shavel Associates Inc*, 2006 CarswellNat 2069 (TMOB)].

[16] In this respect, the Requesting Party submits that the Owner provides insufficient details regarding each exhibit as to the circumstances of their display or use during the relevant period. For example, referencing the t-shirts at Exhibit G, the Requesting Party states that Mr. Edgar fails to provide “specifics with dates, times, places or any evidence that these items were distributed during the performance or advertising of the Services in Canada during the relevant period”.

[17] However, all that is required is that the Owner furnishes *prima facie* evidence of use of its Mark in association with the registered services. In the context of a section 45 proceeding, the evidence must be considered as a whole and focusing on individual pieces of evidence, as the Requesting Party has done, is not the correct approach [*Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)]. Furthermore, reasonable inferences can be made from the evidence provided [*Eclipse International Fashions Canada Inc v Shapiro Cohen* (2005), 48 CPR (4th) 223 (FCA)].

[18] In this case, with respect to “adult ice hockey leagues”, I accept that the exhibited banners (Exhibit C) displaying the Mark would have been seen by league participants during the relevant period. I further accept that the league jerseys (Exhibit D) and the referee jerseys (Exhibit E), which Mr. Edgar attests were representative of those worn by referees associated with the Owner’s services during the relevant period, also constitute display of the Mark in the performance of the Owner’s ice hockey leagues.

[19] With respect to the operation of “ice hockey tournaments”, Mr. Edgar specifically states that, during the 2013 hockey season, six ice hockey tournaments were organized by the Owner. As such, again, I accept that that the exhibited banners displaying the Mark (Exhibit C) would have come to the attention of the participants of such tournaments at the rink where the Owner’s tournaments were held. I further accept that the framed and embossed replica of the Mark

(Exhibit I), which Mr. Edgar attests were given away as awards, and the t-shirts (Exhibit G), which Mr. Edgar attests were distributed to participants as achievement awards, constitute display of the Mark in the performance of the Owner's ice hockey tournaments.

Ice hockey schools

[20] With respect to the operation of "ice hockey schools", the evidence is not as strong as that with respect to the operation of ice hockey leagues and tournaments. However, Mr. Edgar specifically states that, during the 2013 hockey season, there were approximately 120 participants in the Owner's hockey schools. As such, again, I accept that that the exhibited banners displaying the Mark (Exhibit C) would have come to the attention of the participants of the Owner's ice hockey schools at the rink where such services were performed.

[21] Furthermore, at a minimum, I accept that the Mark would have been displayed in the performance of such services through the exhibited referee jerseys (Exhibit E). In this respect, Mr. Edgar confirms that referees participated in each of the registered services, including the operation of ice hockey schools, and were expected to wear such jerseys.

[22] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with each of the registered services during the relevant period within the meaning of sections 4(2) and 45 of the Act.

DISPOSITION

[23] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

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

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

Cassels Brock & Blackwell LLP

For the Registered Owner

Norton Rose Fulbright Canada LLP/S.E.N.C.R.L., s.r.l.

For the Requesting Party