



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

Citation: 2017 TMOB 90

Date of Decision: 2017-07-31

IN THE MATTER OF A SECTION 45 PROCEEDING

Nelligan O'Brien Payne LLP

Requesting Party

and

Shaw Satellite G.P.

Registered Owner

TMA410,929 for CANCOM

Registration

[1] At the request of Nelligan O'Brien Payne 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 April 22, 2015 to Shaw Satellite G.P. (the Owner) the registered owner of registration No. TMA410,929 for the trade-mark CANCOM (the Mark).

[2] The Mark is registered for use in association with the following services: "Satellite services for the transmission of digital data, television, radio and cable signals."

[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 April 22, 2012 to April 22, 2015.

[4] The definition of use with respect to 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 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 Owner furnished the affidavit of Rob Myatt, a Director of the Owner, sworn on October 22, 2015 in Calgary. Only the Owner filed written representations; a hearing was not requested.

THE OWNER'S EVIDENCE

[7] In his brief affidavit, Mr. Myatt explains that the Owner operates under Shaw Broadcast Services, a division of Shaw Business (Shaw). He attests that Shaw Broadcast Services is one of North America's largest full service commercial signal distribution networks, offering over 570 English, French and multilingual video and audio signals via 63 satellite transponders from three satellites. He states that, as of August 31, 2014, Shaw Broadcast Services provided satellite services for over 130 specialty and pay broadcast signals across Canada.

[8] Mr. Myatt further explains that Canadian Satellite Communications, doing business as CANCOM, was a satellite signal delivery company acquired by Shaw in September 2000. He states that, although the legal entity Canadian Satellite Corporation changed its name to Shaw Satellite Services Inc. several years after its acquisition by Shaw, the Mark remained in use by Shaw and its affiliate companies in connection with the registered services. In this respect, he asserts that "Shaw Broadcast Services' customers still closely associate the delivery of our satellite services with the CANCOM brand". He also indicates that "Shaw Business has made

plans to rebrand certain of its commercial services under the name CANCOM in 2016.”

[9] With respect to the relevant period, he attests that the Mark was used on trucks, on invoices, and in the email addresses of some Shaw employees.

[10] With respect to the email addresses, Mr. Myatt attests that “Shaw Tracking employees have had and continue to have an @cancom.ca email address” and that he is “informed by [Shaw’s] IT Department that the traffic associated with these @cancom.ca email addresses is in the range of 750 emails per week.”

[11] Otherwise, in support of his assertion of use, attached to his affidavit are the following exhibits:

- Exhibit C is a photograph of a CANCOM logo with the words “Satellite Tracked” next to it. Mr. Myatt attests that the Mark has been used “By Shaw Business customers, on trucks, a sample of which is shown in Exhibit C”.

If the exhibited logo is displayed on a truck, its location and context are not discernible as the photograph is a close up of the logo only.

- Exhibit D consists of two invoices, with respect to which Mr. Myatt simply states “the Trade-mark has been used as follows: [...] On invoices, as shown in Exhibit D”.

The first invoice is dated March 19, 2014 and appears to be for Bell television services to “Cancom Inc.”

The second invoice is dated August 7, 2015 and appears to be a “Cable TV” invoice from Videotron to “Cancom”.

ANALYSIS

[12] First, with respect to the invoices, even if I were to accept that Cancom Inc. and Cancom are trade names or affiliated companies of the Owner, the invoices themselves appear to have been issued by Bell and Videotron, respectively. In its representations, the Owner attempts to explain this by stating that the Mark was used “by customers and suppliers of the Registrant, based on the long term business relationship they’ve established originally through Cancom”.

[13] As such, even if I were to accept the appearance of “Cancom” on the invoices as display of the Mark, such display was not by the Owner or a licensee.

[14] I further note that the Videotron invoice is from after the relevant period. In its representations, the Owner asserts that “it references an ongoing delivery of services by [sic] CANCOM (as shown by the “previous invoice” section on the page), suggesting that the services were likely also delivered and billed during the Relevant Period.”

[15] However, first, this simply raises the question of why the previous invoice or an invoice from the relevant period was not furnished as evidence.

[16] Second, it also sheds no light on whether the invoice relates to the registered services of the Owner. On its face, the invoice appears to be for the provision of cable TV services by Videotron to its customer, Cancom. How this constitutes “ongoing delivery of services by CANCOM” as asserted by the Owner in its representations is unclear. Again, Mr. Myatt does not attest to the relationship between the Owner and Videotron, and I am not prepared to infer that the provision of cable television services by Videotron somehow constitutes evidence of performance of the registered services by the Owner in association with the Mark or otherwise.

[17] With respect to the display of the Cancom Satellite Tracking logo on trucks during the relevant period, curiously, Mr. Myatt states that such display was by Shaw Business *customers*. As such, it is not clear how such display during the relevant period enures to the benefit of the Owner. In any event, absent details regarding how these trucks were used in the performance of the registered services, it is not clear how display of CANCOM on such trucks constitutes display of the Mark in either the performance or advertising of the particular registered services.

[18] As for the email addresses, Mr. Myatt asserts use of the Mark through the incorporation of “cancom” into some Shaw employee’s email addresses, but without providing sufficient context. He provides no examples to show how the Mark was actually displayed in these emails, nor does he provide any context for the referenced emails, such as indicating whether they were viewed by the Owner’s customers or even if they related to any of the registered services. Although the Owner asserts in its written representations that the Mark was used in email communications “with customers and the general public”, this is not stated in Mr. Myatt’s

evidence and I am not prepared to infer such in the absence of even a single representative email from the relevant period.

[19] In this case, when viewed as a whole, an inference from the evidence is that at some point prior to the relevant period, the Owner and its affiliated companies actually transitioned away from using the Mark in association with the registered services. While Mr. Myatt indicates that the Owner is interested in “rebranding certain of its commercial services under the name CANCOM”, 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.

[20] Although Mr. Myatt attests that “customers still closely associate the delivery of our satellite services with the CANCOM brand”, for purposes of section 45 of the Act, this is not relevant when the Owner (or its licensee) does not appear to have been displaying or using the Mark itself during the relevant period or otherwise.

[21] In view of all of the foregoing, I cannot conclude that the Owner 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 Owner has provided no evidence of special circumstances excusing the absence of such use.

DISPOSITION

[22] 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

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

No Hearing Held

AGENTS OF RECORD

No Agent Appointed

For the Registered Owner

Nelligan O'Brien Payne LLP

For the Requesting Party