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**Citation: 2018 TMOB 156**

**Date of Decision: 2018-12-10**

**IN THE MATTER OF AN OPPOSITION**

**October's Very Own IP Holdings**

**Opponent**

**And**

**Michael Di Cosmo**

**Applicant**

**1,707,760 for 6IX**

**Application**

INTRODUCTION

[1] Michael Di Cosmo (the Applicant) is a professional disc jockey and music producer and has applied to register the trade-mark 6IX (the Mark). The Applicant claims that he has used the Mark in association with the following goods and services in Canada since April 3, 2000:

Goods: Promotional items, namely men's and women's athletic apparel, including shirts, t-shirts, pullovers, sweat shirts, hats, toques, bandanas, sweatpants, socks, wind resistant jackets, and outdoor jackets.

Services: Disc jockey services.

[2] October's Very Own IP Holdings (the Opponent) is the owner of application No. 1,743,190 for the trade-mark 6IX for use in association with a wide variety of clothing items and accessories, as well as wholesale and retail store services and entertainment services. Application for the Opponent's mark was filed on August 25, 2015 and is based on use in

Canada since at least as early as August 2014 in association with “t-shirts, hoodies and baseball caps”, use in Canada since at least as early as August 24, 2015 in association with “pin sets”, and proposed use otherwise.

[3] The Opponent opposes the Applicant’s application on several grounds, including on the basis that the application does not comply with section 30(b) of the Act because the Applicant has not used the Mark since the claimed date of first use and that the Mark is not distinctive of the Applicant’s goods and services in view of the use of 6IX by the Opponent and others.

[4] For the reasons that follow, the application is refused with respect to the Goods and the opposition is rejected with respect to the Services.

#### THE RECORD

[5] The application for the Mark was filed on December 18, 2014.

[6] The application was advertised for opposition purposes in the *Trade-marks Journal* on September 16, 2015. The Opponent opposed it on February 12, 2016, by filing a statement of opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition were based on sections 30(a), 30(b), 30(i), 16(1)(a), and 2 of the Act.

[7] The Applicant filed a counter statement denying each of the allegations in the statement of opposition.

[8] As evidence in support of its opposition, the Opponent filed the affidavit of D. Jill Roberts, a law clerk, sworn July 22, 2016 in Ottawa, Ontario.

[9] In support of his application, the Applicant filed his own affidavit, sworn November 15, 2016 in Toronto, Ontario.

[10] Neither affiant was cross-examined on their affidavits. The Opponent did not file any evidence in reply.

[11] Both parties filed written arguments and both were represented at a hearing held on November 5, 2018.

[12] At the hearing, the Opponent withdrew the grounds of opposition based on sections 30(a), 30(i) and 16 of the Act.

[13] This leaves the grounds of opposition based on section 30(b) and section 2 of the Act to consider.

#### ONUS

[14] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, the Opponent must first adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155].

#### MATERIAL DATES

[15] The material dates that apply to the grounds of opposition are:

- sections 38(2)(a)/30 with respect to non-compliance with section 30 – the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475]; and
- sections 38(2)(d)/2 with respect to non-distinctiveness – the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

#### GROUND OF OPPOSITION BASED ON COMPLIANCE WITH SECTION 30

[16] The Opponent pleads the following:

The Opponent bases its opposition on the ground set out in Section 38(2)(a), namely, that the application does not comply with the requirements of Section 30 in that the Applicant did not use the trade-mark as alleged in the application or at all. In particular, the Opponent states that the Applicant did not sell any of the wares listed in the application since the alleged date of first use or at all.

[17] This ground of opposition corresponds to section 30(b) of the Act. Although it appears to only address whether the Applicant had used its Mark in association with the Goods, at the oral hearing the Opponent made submissions with respect to whether the Applicant had used the Mark in association with its Services as well. In view that the Applicant did not raise any objections, I will consider this ground with respect to both the Applicant's Goods and the Applicant's Services.

[18] The initial burden on an opponent is light respecting the issue of non-conformance with section 30(b) of the Act, because the facts regarding an applicant's first use are particularly within the knowledge of an applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. This burden can be met by reference not only to the opponent's evidence but also to the applicant's evidence [*Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. However, the opponent may only successfully rely on the applicant's evidence to meet its initial burden if the opponent shows that the applicant's evidence puts into issue the claims set forth in the applicant's application [*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at paras 30-38].

[19] In this case, the Opponent relies on the Applicant's evidence to meet its burden under this ground.

[20] The relevant definitions of "use" in association with goods and services are set out in section 4 of the Act as follows:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

4(2) A trade-mark is deemed to be used in association with services it is used or displayed in the performance or advertising of those services.

[21] In his affidavit, the Applicant identifies himself as a professional disc jockey and music producer (para 1). He states that since as early as March 2000 he has used the Mark continuously in the advertising and performance of his disc jockey services, which include performing his

services at nightclub venues and at private events and distributing recordings of his DJ mixes and CDs via the Internet (para 5).

[22] With respect to use of the Mark in association with the Goods, he states the following at paragraphs 13-14:

13. Since at least as early as April 3, 2000, I have distributed Goods marked with 6IX to patrons of my performances and to select visitors to my Facebook page. While I have not charged a specific price for these Goods, I have given [...] them to patrons in exchange for entering a contest or “liking” my Facebook page or for attending my performances for which they have typically paid a cover charge.

14. Attached hereto and marked as Exhibit E are images of t-shirts that I distributed in 2015 [in] the manner described above.

[23] I will begin by considering the Applicant’s evidence with respect to the Goods. Before I do so, however, I highlight the following excerpt from *Bremont Watch Company Ltd v Bremont Homes Corporation*, 2016 TMOB 100, wherein this Board discussed circumstances which must exist for the distribution of trademarked goods to qualify as use of a trademark within the meaning of section 4(1):

... regarding the Applicant’s practices for distributing its goods, the case of *Lin Trading Co v CBM Kabushiki Kaisha* (1985), 5 CPR (3d) 27 (TMOB), affirmed (1987), 14 CPR (3d) 32 (FC), and (1988), 21 CPR (3d) 417 (FCA), stands for the proposition that the term “normal course of trade” should be interpreted as requiring that the transfer be a part of a dealing in the goods for the purpose of acquiring goodwill and profits from the marked goods.

...

Any distribution of these goods [gift baskets] . . . was in relation to the Applicant’s services of selling homes and for no other purpose, and distribution merely for the purposes of promoting one’s own services is not use in the normal course of trade [. . . *Riches, McKenzie & Herbert LLP v Park Pontiac Buick GMC Ltd* (2005), 50 CPR (4th) 391 (TMOB); *Smart & Biggar v Sutter Hill Corporation*, 2012 TMOB 121; *Kids’ Club Media, LLC v Kyle*, 2014 TMOB 134; and *Oyen Wiggs Green v Flora Manufacturing and Distributing*, 2014 TMOB 105].

[24] In its brief written argument, the Opponent submits the following:

It is clear from the evidence that the Applicant has not sold its “promotional items” as alleged and since they are “promotional items” and not “goods for sale” distribution of same is not use of the trademark in association with wares. Accordingly, the opposition must succeed against the wares.

[25] At the hearing, the Opponent relied on the following from *Oyen Wiggs Green & Mutala v Flora Manufacturing and Distributing Ltd*, 2014 TMOB 105:

To explain, the word “trade” in section 4(1) of the Act “contemplates a type of commercial transaction (purchase, sale or rental) involving the wares in question, or contemplates the wares being the subject of transactions carried out to create goodwill for the wares and to make profits thereon” [*Renaud Cointreau & Cie v Cordon Blue International Ltd.* (1993), 52 CPR (3d) 284 (T.M.O.B.) affirmed by the Federal Court in 2000 CanLII 16251 (FC), 188 FTR 29]. While a free distribution of a publication for example, may still qualify as one that is transferred in the “normal course of trade” within the meaning of section 4 of the Act [see *Now Communications Inc v Chum Ltd* (2000), 5 CPR (4th) 275 (TMOB) and *Times Mirror Co v Transcontinental Distribution Inc* (2004), 42 CPR (4th) 1 (TMOB)], the registrant must show that the free distribution is not simply a tool to promote its other products or services, but as an object of trade in itself leading to some kind of payment or exchange for the printed materials supplied. [para 19]

[26] The Opponent further relied on the following from *Riches, McKenzie & Herbert LLP v Cosmetic Warriors Limited*, 2018 FC 63 (under appeal before the Federal Court of Appeal):

It is clear that promotional goods distributed free of charge per se do not meet the requirements of section 4(1) of the Act. Transfers of property for the acquisition of goodwill are insufficient to constitute a transfer or use in the normal course of trade. However, while free distribution of goods typically is not considered use in the ordinary course of trade under section 4(1), if such use is part of an overall course of action for a business, carried out for the purpose of deriving profits and developing goodwill for the goods, it may constitute use in the normal course of that business, particularly if the goods freely distributed are the goods in which the business normally deals. [para 18]

[27] Accordingly, the Opponent submitted that, in this case, as there was no subsequent profit from sale or exchange of the Goods, the free distribution of, for example, t-shirts at the Applicant’s performances cannot be considered to have been in the normal course of trade; the Goods were not objects of trade in themselves.

[28] In its written representations, the Applicant, submits the following:

The Di Cosmo Affidavit contains uncontradicted evidence that since at least as early as April 3, 2000, the Applicant distributed all of the Goods, including, for example, those evidenced at Exhibit E, marked with the Mark in consideration for patron’s purchase of tickets to his performances and in exchange for visitors entering contests on or “liking” his Facebook page”. (para 20)

[29] At the oral hearing, the Applicant further submitted that the jurisprudence referenced by the Opponent did not apply to the facts of the present case. In this respect, the Applicant argues that this type of exchange of goods as consideration for attendance to performances, for entering contests, or for Facebook “likes” has not been considered by the Registrar or the courts in the jurisprudence.

[30] In my view, the free distribution of t-shirts and other Goods for attending a performance, entering a contest or “liking” the Applicant’s Facebook page described by the Applicant was no doubt for the purpose of acquiring goodwill. What is not apparent, however, is how liking a Facebook page, entering a contest or attending a DJ performance equates to making a payment for a t-shirt from which the Applicant could make a profit. These exchanges suggest to me that the t-shirts being distributed are not goods in which the Applicant’s business normally deals but rather are tools to promote the Applicant’s DJ services. As noted in the jurisprudence set out above, this does not qualify as use of a trade-mark within the meaning of section 4(1).

[31] I am therefore satisfied that the Opponent has put into issue the Applicant’s claimed date of first use with respect to the Goods. As the Applicant has not met the onus on it to show continuous use of the Mark in association with the Goods since the claimed date of first use, the Opponent succeeds on the section 30(b) ground of opposition in respect of the Goods.

[32] With respect to the Services, at the oral hearing, the Opponent argued that the Applicant’s evidence does not show use of the Mark since April 3, 2000 but, rather, shows an evolution of different trade-marks used by the Applicant from “SIK 6IX” to “DJ SIX” to “6IX”.

[33] In its oral representations, the Applicant argued that the Exhibit A advertisement displaying “SIK 6IX” is dated before the claimed date of first use and that the remaining advertisements displaying “DJ 6IX” and “6IX” support the “uncontradicted” statement by the Applicant that he has been using the Mark since April 3, 2000.

[34] Indeed, in his affidavit, the Applicant states the following:

7. Since March 2000, I have performed as 6IX on more than 200 occasions for many thousands of patrons at nightclub venues and special events throughout southern Ontario. My Services at such events have been associated with 6IX by, among other things, flyers

identifying me as 6IX that have been used to advertise the events ahead of time and be signage identifying me as 6IX at the venues where I have performed the Services.

8. Over the years, nightclubs and event promoters have typically booked me weeks in advance of engagements to provide my Services. These engagements have been advertised online and on tens of thousands of flyers distributed at or outside the venues themselves or at retail locations such as music stores or clothing stores. These flyers have identified me as 6IX, often with the names of other DJs performing at the same or other events.

9. Attached hereto and marked as Exhibit “A” is a selection of some of the flyers that have been distributed over the years for events where I have performed my Services as 6IX. Some these flyers are event specific. Others are general advertisements for my Services, including live performances and the distribution of my pre-recorded DJ mixes.

[35] I agree with the Applicant that, on its face, the Exhibit A advertisements do not contradict the Applicant’s statements in his affidavit, on which the Applicant was not cross-examined. In this respect, I note that the Applicant identifies the exhibited advertisements as a “selection” of the advertisements distributed over the years. Further, I agree with the Applicant that use of the mark “DJ 6IX” is an acceptable variation of the Mark, as “DJ” is merely descriptive of the Applicant’s disc jockey services.

[36] In my view, the Opponent’s allegations are insufficient to put into issue the Applicant’s claimed date of first use with respect to the Services.

[37] As such, with respect to the Services, I am not satisfied that the Opponent has met its evidential burden under this ground. This ground therefore does not succeed with respect to the Services.

#### GROUND OF OPPOSITION BASED ON NON-DISTINCTIVENESS

[38] The Opponent pleads the following:

The Opponent bases its opposition on the ground set out in Section 38(2)(d), namely, that the trade-mark claimed in the application is not distinctive in view of the facts alleged in this Statement of Opposition and also since it is not adapted to distinguish the wares in association with which it is alleged to be used by the Applicant from the wares of others including the wares/services of the Opponent and the Applicant’s trade-mark is not adapted to distinguish them. The Opponent has extensively sold and advertised its goods and services in Canada in association with its trade-mark 6IX and accordingly, the Applicant’s mark is not distinctive of the Applicant.



[39] In order to meet its initial evidential burden with respect to this ground, the Opponent must show that as of the filing of the opposition (February 12, 2016), the Opponent's trade-mark or the trade-marks of others had become known in Canada sufficiently to negate the distinctiveness of the Mark [*Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657].

[40] The Opponent relies on the evidence of Ms. Roberts, presumably to demonstrate that third parties have either sold or advertised their goods and services in association with the trade-mark 6IX. I note that none of the Opponent's evidence relates to the Opponent's 6IX mark or use thereof.

[41] Ms. Roberts' affidavit includes nine exhibits, consisting of printouts of instances of "6IX" found by Ms. Roberts on the Internet and printed on July 22, 2016. Of the nine exhibits, only Exhibits 4, 7 and 9 appear to relate to Canada in any meaningful way. I will therefore focus on these three exhibits.

[42] Exhibit 4 consists of printouts from the website *raisingtheroof.org*, promoting a "Sounds in the 6ix" charitable event in Toronto, described as "an interactive music event featuring local bands" to support homelessness prevention initiatives. The Opponent argues that there are peripheral indicators – such as the list of sponsors – that a "non-insignificant" number of people were aware of the event or participated in it. Even if I could infer that a number of people were aware of the event or had participated in it, the event appears to have been held on June 9, 2016, which is after the material date for this ground of opposition.

[43] Exhibit 7 is a printout of a February 10, 2016 news article from *cbc.ca* entitled "CBC Toronto's '6ix' campaign continues". The article describes a new "recurring segment" by CBC Toronto News called "6IX IN THE 6IX". It also describes the segment as part of "a larger campaign called *The 6ix* (a moniker for Toronto, popularized by Drake)", which included an "Art in the 6ix" mosaic commissioned by CBC Toronto and a "Song in the 6ix" music contest launched by CBC Toronto. There is no indication, however, of the extent this article was viewed by Canadians.

[44] Exhibit 9 is a printout of an information page for The 6IX Nightclub in Toronto, from the website *www.clubcrawlers.com*. Again, there is no evidence as to the extent Canadians were

aware of The 6IX Nightclub referenced in Exhibit 9, or whether it even operated prior to the material date.

[45] In summary, the Opponent furnishes no evidence regarding the extent to which Canadians may have viewed these website pages or were aware of the events described in them prior to the material date or otherwise. Even if it could be inferred that a number of Canadians viewed these pages or were aware of the events referenced in them prior to the material date for this ground, I would not have found this evidence to be of much assistance to the Opponent. In this regard, while some of it may relate to music generally, there is no reference to “6IX” having been used or made known in association with disc jockey or similar services in Canada.

[46] The Opponent further submitted that since late 2014, “the 6IX” has taken on a meaning such that it is “well understood” in the Toronto area to mean the 416 area code, *i.e.*, the City of Toronto. However, the Opponent has not submitted any evidence of its own to corroborate this assertion. Instead, the Opponent references the Applicant’s own evidence at paragraphs 15 and 16:

15. I am aware that in late 2014, Drake, a recording artist associated with the Opponent, announced the release of an upcoming album in late 2014 entitled “View from the Six”. In the following months, “Six” and “The Six” became a popular [moniker] for the city of Toronto where Drake lives.

16. I am also aware that, since then, others have used the [moniker] (and the phonetic equivalent “6ix”) in written works and have displayed it on various objects to refer to Toronto or as originating in Toronto.

[47] In my view, the fact that the Applicant may have been aware that “Six” or “the Six” has become a popular moniker for Toronto, and that others have used it in written works or have displayed it on various objects to refer to Toronto, is not sufficient to show that “the 6IX” is well understood to mean the 416 area code, *i.e.*, the City of Toronto. Even if I had been satisfied that “the Six” or “the 6ix” had become a well understood moniker associated with Toronto, again, I would not have found this evidence to be of much assistance to the Opponent as it does not show that 6IX has been made known in association with disc jockey or related services.

[48] In conclusion, although some of the Opponent's evidence relating to Canada appears to relate to music generally, the Opponent has not shown that any third party 6IX trade-marks had become known in Canada sufficiently to negate the distinctiveness of the Mark in association with the Services. Accordingly, as the Opponent has not met its burden, this ground of opposition is unsuccessful.

#### DISPOSITION

[49] In view of all of the foregoing, pursuant to section 38(8) of the Act and the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to the Goods and I reject the opposition with respect to the Services [see *Produits Ménagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 482 (FCTD) as authority for a split decision].

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Cindy R. Folz  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

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

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**HEARING DATE** 2018-11-05

**APPEARANCES**

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**AGENTS OF RECORD**

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