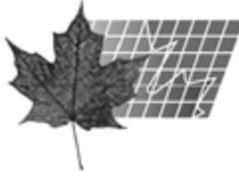


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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 112

Date of Decision: 2019-10-15

IN THE MATTER OF A SECTION 45 PROCEEDING

Keenan Ferguson

Requesting Party

and

Comcast Corporation

Registered Owner

TMA730,645 for COMCAST

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA730,645 for the trademark COMCAST (the Mark), owned by Comcast Corporation.

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

(1) Streaming of audio and video material on the internet; internet broadcasting services; providing multiple use access to global computer information networks for the transfer and dissemination of a wide range of information.

(2) Distribution of programming to cable television systems; Production of cable television programs; Entertainment services in the nature of basketball games, basketball exhibitions, hockey games and hockey exhibitions rendered live in stadiums and via voice and video transmissions; Providing facilities for sports competitions and

exhibitions, namely, basketball games, basketball exhibitions, hockey games, hockey exhibitions, and for musical concerts and other entertainment events.

(3) Cable television transmission services; Cable radio transmission services; Telecommunications services, namely, voice, video and data transmissions provided through the use of cable television distribution facilities; High speed electronic data interchange services provided via modems, hybrid fiber coaxial cable networks, routers and servers.

(4) Communication services - namely transmission of foreground and background music; cable television services.

[3] For the reasons that follow, I conclude that the registration ought to be maintained with respect to only certain of the services.

THE PROCEEDINGS

[4] On June 23, 2016, the Registrar of Trademarks sent a notice under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Comcast Corporation (the Owner). The notice was sent at the request of Keenan Ferguson (the Requesting Party).

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between June 23, 2013 and June 23, 2016, in association with each of the services specified in the registration. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

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

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

[7] With respect to services, the display of a trademark on advertising is sufficient to meet the requirements of section 4(2) of the Act when the trademark owner is offering and prepared to perform the advertised services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[8] 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. As

such, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd* (2004), 31 CPR (4th) 270 (FC)] and “evidentiary overkill” is not required [*Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the trademark was used in association with each of the services specified in the registration [*Uvex Toko and John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[9] In response to the Registrar’s notice, the Owner furnished the affidavit of Marc A. Rockford, the Vice President and Senior Deputy General Counsel of the Owner, sworn on April 24, 2017, together with Exhibits A to E.

[10] While only the Owner filed written representations, both parties made submissions at an oral hearing.

THE EVIDENCE

[11] Mr. Rockford describes the Owner as a global media and technology company which is one of the world’s largest broadcasting and cable television companies.

[12] Mr. Rockford states that during the relevant period in Canada, the Owner used the Mark in association with:

- Streaming of audio and video material on the Internet;
- Internet broadcasting services;
- Production of cable television programs;
- Entertainment in the nature of basketball games, basketball exhibitions, hockey games and hockey exhibitions rendered live in stadiums and via voice and video transmissions; and
- Cable television services.

[13] In particular, Mr. Rockford attests that the Mark was prominently displayed during the relevant period in sports programming produced and disseminated into Canada by the Owner. In support, he attaches as Exhibit A to this affidavit, screenshots from sports programming

broadcasts (hockey and basketball) which he attests show the manner in which the Mark was displayed during the relevant period. The Mark is displayed followed by the term SPORTSNET, both with and without the peacock logo of the NBC. He further explains that such sports programming is available to Canadians through subscription cable channels offered by Rogers and Bell, as well as through digital streaming devices wherein Canadians can stream such sports programming broadcasts directly to their computer, mobile phone, tablet or television. He provides, as Exhibits B and C to his affidavit respectively, website printouts from Rogers and Bell promoting these subscription cable channels, and printouts from iTunes App Store providing information on apps to stream such content. While the Mark does not appear on these printout advertisements, Mr. Rockford clearly attests that sports programming broadcasts featuring the Mark per Exhibit A were shown on these subscription channels and streamed through such apps in Canada during the relevant period.

[14] Mr. Rockford attests that due to the manner in which the Owner provides the sports programming broadcasts in Canada, the Owner does not have direct access to the specific number of Canadians that would have viewed the above-noted sports programming broadcasts. However, he states that based on information and belief, such sports programming broadcasts (both hockey and basketball), prominently displaying the Mark per Exhibit A, would have been viewed by hundreds if not thousands of customers in Canada during the relevant period.

[15] Lastly, with respect to “cable television services”, Mr. Rockford attests that such services associated with the Mark were offered by the Owner to Rogers during the relevant period in Canada. In this regard, he explains that the Owner licensed its “cloud-based cable television services, known as the X1 platform, to assist Rogers in implementing video services for its Canadian customers.” He states that the Owner offered these services to Rogers during the relevant period and that the Owner now currently offers these services to Rogers. In support, he provides as Exhibit D to his affidavit, a copy of the cover page of a presentation given to Rogers on February 23, 2016, with respect to a proposal to offer such services. The Mark clearly appears on the presentation. He further provides as Exhibit E to his affidavit, a copy of an online news article regarding Rogers’ licensing of the Owner’s X1 platform. The article indicates that Rogers expects to launch a version of the video service enabled by the Owner’s X1 platform in early 2018.

ANALYSIS AND REASONS FOR DECISION

[16] As a preliminary matter, I note that the affidavit and exhibit evidence are silent with respect to the following services:

- (1) [...]; providing multiple use access to global computer information networks for the transfer and dissemination of a wide range of information.
- (2) Distribution of programming to cable television systems; [...]; Providing facilities for sports competitions and exhibitions, namely, basketball games, basketball exhibitions, hockey games, hockey exhibitions, and for musical concerts and other entertainment events.
- (3) Cable television transmission services; Cable radio transmission services; Telecommunications services, namely, voice, video and data transmissions provided through the use of cable television distribution facilities; High speed electronic data interchange services provided via modems, hybrid fiber coaxial cable networks, routers and servers.
- (4) Communication services - namely transmission of foreground and background music; [...].

[17] When raised at the oral hearing, the Owner conceded that the evidence failed to show use of the Mark with respect to these services. Accordingly, and as no special circumstances have been brought forth which would excuse the absence of such use, these services will be deleted from the registration. Consequently, the services that remain at issue are those indicated above at paragraph 12, namely:

- Streaming of audio and video material on the Internet;
- Internet broadcasting services;
- Production of cable television programs;
- Entertainment in the nature of basketball games, basketball exhibitions, hockey games and hockey exhibitions rendered live in stadiums and via voice and video transmissions; and
- Cable television services.

[18] The Requesting Party submits that the evidence with respect to these remaining services is inadequate to show use of the Mark in Canada during the relevant period.

[19] More specifically and to begin with, the Requesting Party submits that Mr. Rockford does not provide a statement indicating how long the Mark was displayed during the sports broadcasts, such that it is possible that the broadcasts might only have contained a fleeting display of the Mark. The Requesting Party ties this notion of a “fleeting glimpse” of the Mark into a question of deviation. In this regard, the Requesting Party submits that the Exhibit A still shots from the sports broadcasts show an “amalgamation of design treatments” that may be viewed as the “Comcast Sportsnet” mark, rather than the Mark. To explain, the Requesting Party offers the scenario that if a similarly embodied trademark (*i.e.* a trademark appearing in conjunction with additional matter in a similar respect) were to appear on a box of cereal or on the side of a bus, anyone who has five seconds to view the trademark may very well distinguish the trademark as separate from the additional matter. However, the Requesting Party submits that in the present case, the Mark is not on the screen for long enough for anyone to see the differences in font between the Mark and the additional matter, such that the Mark would be recognizable on its own.

[20] When queried, however, the Requesting Party was unable to direct my attention to any case law regarding the duration that a Mark appears in the advertisement or performance of services and its impact on consumer perception concerning any potential deviation issues. Rather, the Requesting Party invited me to break new ground in my consideration of the facts of the present case.

[21] I will note that there are cases wherein certain contextual realities have been taken into consideration when assessing consumer perception of a trademark; however, none of these cases are factually similar to the present case, nor consider such a novel argument. Rather, such cases involve situations, for example, in which there is repetition of a mark or of the additional matter displayed with the mark, which then comes to the attention of the consumer and serves to reinforce a consumer’s perception that the trademark is distinguishable from the surrounding matter with which it is presented. See for example, *Brouillette & Associés v Constellation Brands US Operations, Inc*, 2016 TMOB 159; *Gowling Lafleur Henderson LLP v Ten Ren Tea Co*, 2012 TMOB 21; *Bennett Jones LLP v Pirelli Tyre SpA*, 2013 TMOB 37; and *Brooks v Ranpro Inc*, 2011 TMOB 74.

[22] The Owner submits, in response, that the fact that Exhibit A is presented as a still frame screen capture is irrelevant and that the evidence is submitted this way because it is on paper and was the simplest way to convey to the Board how the Mark appeared. The Owner further submits that there is no evidence that the Mark appeared in a fleeting manner and there are no temporal requirements for the display of a trademark. The Owner submits that while the affidavit does not provide guidance as to how long the Mark appeared on the screen, the Mark appears in the Exhibit A broadcast screen shots as a sort of passive watermark and there are multiple examples of different iterations of such use in the evidence.

[23] I agree with the Owner, and in any event, there is nothing in the evidence that would persuade me to infer that consumers would only be subject to a “fleeting glimpse” of the Mark, as speculated by the Requesting Party, such that perception, in this specific case, would be that the Mark does not stand out from the surrounding or additional matter. Indeed, the threshold that a registered owner must meet is quite low [*Uvex Toko*] and section 45 proceedings are not considered proceedings where there should be an infinite contestation of the facts [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)]. In the present case, the Mark is presented in a different style and size of font, such that it is discernable as a trademark on its own [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 at 538 (TMOB)].

[24] The question then becomes whether use of the Mark has been shown in association with *each* of the services.

[25] In this regard, Mr. Rockford correlates the evidence as follows: Exhibits A, B, and C pertain to “streaming of audio and video material on the Internet; Internet broadcasting services; Production of cable television programs; and, Entertainment in the nature of basketball games, basketball exhibitions, hockey games and hockey exhibitions rendered live in stadiums and via voice and video transmissions”, while Exhibits D and E pertain to “cable television services”.

[26] The Requesting Party submits that the Owner’s evidence does not provide enough information to support that the Owner produced, disseminated and broadcast the sports programming into Canada online and via cable; rather, it appears to be Bell or Apple that streamed and broadcast such programming.

[27] Additionally, the Requesting Party submits, Mr. Rockford does not provide the bases of his information and belief with respect to his statement that the sports programming displaying the Mark would have been viewed by hundreds if not thousands of customers in Canada. What is more, the Requesting Party submits, is that with the Owner's lack of direct access to Canadian viewing statistics, it may be appropriate for the Registrar to draw a negative inference from the evidence in this case.

[28] The Owner submits that Exhibit A clearly shows the nature of the entertainment services provided, as it includes images of basketball and hockey broadcasts. Furthermore, the Owner submits that the evidence shows that it provided subscription channels and streaming apps to Canadians during the relevant period, through which Canadians could view the sports broadcasts which displayed the Mark (Exhibits B and C). I agree and accept, based on Mr. Rockford's sworn statements and the evidence as a whole, that the Owner produced and broadcast entertainment in the nature of sports programming. Further to this, I accept that the Owner made such broadcasts and programming available to Canadians through cable television subscription services or online via a streaming application, as part of the chain of transactions for the provision of the services to the ultimate consumer.

[29] With respect to Mr. Rockford's statement regarding the number of customers in Canada who viewed the sports programming displaying the Mark during the relevant period, the Owner submits that it is irrelevant how many Canadians viewed the programming.

[30] The Requesting Party, in reply, agrees that it does not matter how many people tuned in, so long as it is not token use. The Requesting Party submits, however, that the affiant does not confirm that Canadians, in fact, downloaded the app; evidence that should have been easy to ask Apple to confirm. Further, the Requesting Party speculates that these apps are available in the United States and are not necessarily apps that are available in Canada.

[31] The Owner submits however, and I agree, that it is reasonable to infer due to his position and tenure within the Owner, that Mr. Rockford would be in a position to know and attest to such matters. Furthermore, I see nothing in the evidence that would cause me doubt Mr. Rockford's sworn statements of fact regarding the number of Canadians that accessed such services, or his

statement that the Exhibit C printouts pertain to apps available in Canada during the relevant period [*Oyen Wiggs Green & Mutala LLP v Atari Interactive, Inc*, 2018 TMOB 79 at para 25].

[32] With respect to “cable television services”, the Requesting Party submits that the Owner’s evidence does not provide adequate information regarding the nature of the “cable television services” provided to Rogers, to ascertain whether the services being offered are actually cable television services within the ordinary meaning of such services. In this regard, the Requesting Party submits that it is not clear that the Owner is offering cable television services to a consumer in their home, as the Owner describes the service as a ‘platform’ to assist Rogers in providing a service that might be cable television services. The Requesting Party submits that perhaps the service being offered is not merely related or ancillary to cable television services, but a different service altogether, which potentially could fall under an entirely different Nice class.

[33] Moreover, while the Requesting Party concedes that the Exhibit D presentation displays the Mark, it submits that Mr. Rockford’s attestations that the Owner was in discussions and now *currently* offers cable television services under the Mark to Rogers, does not mean that such services were available to be performed during the relevant period. In this regard, the Requesting Party notes that the Exhibit E news article appears to be directed at the US market, is dated ten months after the relevant period and refers to the offering of services that relate to the licensing of the XI platform, with no mention of “cable television services”. The Requesting Party further submits that the Owner’s lack of detail regarding the contract to license the ‘platform’ to Rogers, does not assist in showing the precise nature of the service being provided, nor if the services were available to be performed during the relevant period.

[34] The Owner, on the other hand, submits that Mr. Rockford clearly attests that the Owner licensed its “cloud-based cable television services, known as the X1 platform” to Rogers. The Owner submits that while these services may not be services provided directly to end consumers in their homes, they are nonetheless back end cable television services provided to Rogers. Additionally, the Owner submits that although there is nothing specific in the evidence that says that these services were available during the relevant period, such an inference is reasonable based on the evidence as a whole. More particularly, the Owner submits that this inference is

supported given that a contract to provide those services was entered into shortly after the relevant period.

[35] I agree with the Owner that the services fall within the realm of the registered services. In this regard, I note that the word “services” is not defined in the Act, and services are generally granted a generous or broad interpretation [*Aird & Berlis v Virgin Enterprises Ltd* (2009), 78 CPR (4th) 306 (TMOB)], including those services which may be considered “incidental” or “ancillary” [*Kraft Ltd v Registrar of Trade Marks* (1984), 1 CPR (3d) 457 (FCTD)]. Furthermore, the fact that the Mark did not come to the attention of the ultimate cable television viewing consumer, but rather to Rogers, does not preclude a finding of use pursuant to section 4(2) of the Act, as any use of the Mark along the distribution chain is sufficient to show use [see *Philip Morris Inc v Imperial Tobacco Ltd (No 2)* (1987), 17 CPR (3d) 237 at page 241 (FCA)].

[36] With respect to whether the services were available to be performed during the relevant period, the evidence clearly demonstrates that a presentation displaying the Mark regarding the offering of services by the Owner to Rogers was given in Canada during the relevant period. While it may be that a license was not entered into until after the relevant period, the Mark was clearly displayed in the advertising of such services, which Mr. Rockford attests were offered to Rogers in Canada during the relevant period. Once again, I have no reason to question Mr. Rockford’s sworn statements in this regard [*Atari Interactive*], or to infer that the term “offer” in this case, means an offer of services only to be available to be performed at a later undisclosed date, rather than the present availability of such proposed services.

[37] Consequently, I accept that the Owner has shown use of the Mark in the display of advertising of “cable television services” offered in Canada during the relevant period, per section 4(2) of the Act.

DISPOSITION

[38] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the following services in compliance with the provisions of section 45 of the Act:

- (1) [...]; providing multiple use access to global computer information networks for the transfer and dissemination of a wide range of information.
- (2) Distribution of programming to cable television systems; [...]; Providing facilities for sports competitions and exhibitions, namely, basketball games, basketball exhibitions, hockey games, hockey exhibitions, and for musical concerts and other entertainment events.
- (3) Cable television transmission services; Cable radio transmission services; Telecommunications services, namely, voice, video and data transmissions provided through the use of cable television distribution facilities; High speed electronic data interchange services provided via modems, hybrid fiber coaxial cable networks, routers and servers.
- (4) Communication services - namely transmission of foreground and background music; [...].

[39] As such, the revised statement of services will now read as follows:

- (1) Streaming of audio and video material on the Internet; Internet broadcasting services;
- (2) Production of cable television programs; Entertainment in the nature of basketball games, basketball exhibitions, hockey games and hockey exhibitions rendered live in stadiums and via voice and video transmissions;
- (4) Cable television services.

Kathryn Barnett
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2019-05-09

APPEARANCES

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