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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 161

Date of Decision: 2021-01-15

IN THE MATTER OF A SECTION 45 PROCEEDING

Borden Ladner Gervais LLP

Requesting Party

and

TLN Media Group Inc.

Registered Owner

TMA728,327 for GOAL

Registration

INTRODUCTION

[1] At the request of Borden Ladner Gervais (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on August 31, 2017, to Telelatino Network Inc. (TLN), the registered owner at the time of registration No. TMA728,327 for the trademark GOAL (the Mark).

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

GOODS

Printed publications namely magazines, calendars and pen sets; desk ornaments namely mouse pads; tote bags; coffee mugs.

SERVICES

(1) Entertainment services namely the production, broadcast, recording, transmission and distribution of television programs, the operation of television networks and the promotion and organization of live performances and festivals.

(2) Multimedia services, namely the provision of sports, news and information offered by the way of multimedia applications, namely databases, the Internet, computers, and television.

(3) Internet services, namely the provision of sports, news and information to the public offered through the medium of the Internet namely on a website, through on-line publications, and in newsletters delivered on a computer network by e-mail.

[3] On May 28, 2020, the Registrar updated the registration to record an amalgamation. The current owner of the Mark is TLN Media Group Inc. (the Owner).

[4] For the reasons that follow, I conclude that the registration ought to be maintained in part.

[5] The notice required the Owner to show whether the Mark has been used in Canada in association with the registered goods and services 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 August 31, 2014, to August 31, 2017.

[6] The relevant definitions of use are set out in section 4 of the Act as follows:

4(1) A trademark 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 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] It is well established that bare statements that a trademark is in 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 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 trademark in association with each of the goods and services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA) (*John Labatt*)].

[8] The display of the trademark in the advertisement of the services is sufficient to satisfy the requirements of section 4(2) of the Act, from the time the owner of the trademark offers and is ready to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB) (*Dynaturf*)].

[9] In response to the Registrar's notice, the Owner furnished the affidavit of Aldo DiFelice, President of the Owner, sworn March 29, 2018. Both parties submitted written representations and were represented at an oral hearing.

EVIDENCE

[10] Mr. DiFelice states that during the relevant period, TLN broadcast television programming and content in English, Italian, and Spanish on its television networks, which were available in six million homes in Canada during the relevant period. He explains that TLN's programming includes three Spanish-language digital TV channels, three Italian-language TV channels, and an all-sports TV channel. He states that TLN is a broadcaster and re-broadcaster of soccer games, and also acquires and produces other soccer-related content. In addition, he states that TLN operates websites and online channels, including a YouTube channel called "Goal: the Soccer Fanatic's Channel" (the GOAL YouTube channel), and that such channels generate revenue for TLN through advertising.

[11] With respect to the registered goods "Printed publications namely magazines, calendars and pen sets; desk ornaments namely mouse pads; tote bags; coffee mugs", Mr. DiFelice states that during the relevant period, TLN has "sold and/or distributed Goods" displaying the Mark, including mouse pad covers, coffee mugs, pen sets, newsletters and magazines, and tote bags. As Exhibit C, he attaches photographs of a mouse pad, clock, pen, key chain, tote bag, jersey, and t-shirt bearing the Mark, along with what appear to be screenshots or printed publications. The publications advertise TLN's programming and refer to the 2014 FIFA World Cup, which was held in June and July 2014. The only appearance of the word "goal" on these publications is in

the formulation “GOAL POST” and in a reference to a “TLN GOAL CRAZY” contest. The latter is in plain text, while the former appears in the following configuration:



[12] Mr. DiFelice states that during the relevant period, TLN distributed its goods “in various ways”, including “selling such Goods and the other products at events which were held or sponsored by TLN and also distribut[ing] through such events and others”, as well as “distribut[ing] such Goods and the other products to assist in making known the [Mark]”. With respect to the publications, Mr. DiFelice adds that they “had also been available though websites operated by TLN, including the TLN website.”

[13] With respect to the registered services “Multimedia services, namely the provision of sports, news and information offered by the way of multimedia applications, namely databases, the Internet, computers, and television” (the Multimedia Services), Mr. DiFelice states that TLN operated the GOAL YouTube channel, which was initially made available from May 1 to June 30, 2014. At this time, the channel was operated in association with the 2014 FIFA World Cup, showing the matches themselves as well as previews, interviews, and the like. He states that TLN continued to operate this channel during the relevant period and states that more than 6,500 of the channel’s videos were viewed across Canada during the relevant period. As Exhibit D, he attaches a pair of screenshots from the GOAL YouTube channel and a screenshot from TLN’s website promoting that channel. The Mark is displayed on each screenshot in the formulation “GOAL™: The Soccer Fanatic’s Channel”. The videos on the GOAL YouTube channel are entitled “Italian Football Fans Going Crazy!”, “Italy 2006 World Cup Victory Funny Fan Interview”, “Italy vs. England 2014 World Cup Italian Goal Reaction!”, and “Netherlands Fans Dressed Up and Partying!”. Each video appears to have been uploaded before the relevant period. Mr. DiFelice states that these screenshots accurately reflect how the pages would have appeared during the relevant period.

[14] Further, Mr. DiFelice attaches as Exhibits E and F screenshots from the WayBackMachine internet archive of TLN's website, dated September 24, 2015, and February 24, 2016, respectively. The content of the web pages includes a link to the GOAL YouTube channel displaying the Mark. Mr. DiFelice states that a significant number of members of the public used this link to access the GOAL YouTube channel.

[15] Mr. DiFelice states that beginning in May 2014 and continuing during the relevant period, TLN's television channels broadcast television commercials for the GOAL YouTube channel. As Exhibit G, Mr. DiFelice attaches video clips of television advertisements and screen graphics advertising the GOAL YouTube channel and displaying the Mark. He states that each of these advertisements reached 1.37 million homes in Canada and ran from May 28 to July 31, 2014, with "Continued Use... Intermittently throughout the Relevant Period on the same basis as above and more frequently in respect of major sporting events". He adds that "[i]n my view, most persons who have watched any of the TLN television channels or visited the websites will have been exposed to promotion for the GOAL channel during the Relevant Period."

[16] In addition, Mr. DiFelice states that TLN also developed an "instant video replay system" in association with the Mark, which would deliver instant notifications and links relating to the 2014 FIFA World Cup and the Toronto 2015 Pan-Am Games. He states that these digital media services were marketed to business clients during those sporting events, but "did not come to commercial fruition." Nevertheless, he states that TLN intends to proceed with this type of service in association with the Mark in the future.

[17] With respect to "Internet services, namely the provision of sports, news and information to the public offered through the medium of the Internet namely on a website, through on-line publications, and in newsletters delivered on a computer network by e-mail" (the Internet Services), Mr. DiFelice reiterates that TLN operated its website during the relevant period, which included a hyperlink to the GOAL YouTube channel and conducted an online promotional campaign for that channel beginning on May 28, 2014. As Exhibit I, Mr. DiFelice attaches several screenshots from TLN's website, showing advertisements for the GOAL YouTube channel. He states that according to Google Analytics for the period between May 28, 2014, and July 31, 2014, the number of "page visits" was in the tens of thousands, and that "[t]he number

of visits during the Relevant Period were at least in this amount”. He states that he is “of the view that the availability and access details set out above are accurate and that many members of the public accessed these services during the Relevant Period.”

[18] Mr. DiFelice also states that TLN ran a “TLN GOAL Crazy Contest” between June 12 and July 13, 2014, on its website and television channels, to promote the GOAL YouTube channel. As Exhibit J, he attaches a copy of the rules for this contest.

[19] Finally, Mr. DiFelice states that during the relevant period, TLN published newsletters and blogs concerning sports, news, and information “through its TLN website and the internet”. As Exhibit M, he attaches screenshots from TLN’s website which show links to “TLN GOAL CRAZY: THE SOCCER FANATIC’S BLOG”, dated during the relevant period, and “GOAL POST NEWSLETTER”, which are undated. He states that in his opinion, such documents would have been accessed by more than 100,000 people during the relevant period.

[20] With respect to “Entertainment services namely the production, broadcast, recording, transmission and distribution of television programs, the operation of television networks and the promotion and organization of live performances and festivals” (the Entertainment Services), Mr. DiFelice states that TLN used the Mark during television broadcasts which it produced, broadcast, recorded, transmitted, and distributed. As Exhibit K, he attaches three videos, which he states were used between September 2007 and May 2012, and “on multiple repeats of each match”, on one of TLN’s television channels. He states that these videos were “distributed and broadcast by TLN during the Relevant period and that many members of the public saw these during the Relevant Period.” The videos show clips from soccer matches, with animated versions of the word “GOAL” appearing after goals are scored.

[21] Mr. DiFelice states that since July 2017, TLN has been in the “concept and planning stages” with a third party for co-production of a soccer-themed television program in association with the Mark, which “may come to fruition at some point in the next year or two”.

[22] In addition, Mr. DiFelice states that TLN has broadcast soccer tournaments in the summers of 2016 and 2017 on its television channels, including the 2016 UEFA European Championship in June and July 2016 and the 2017 ICC Champions Cup in July 2017. As

Exhibit L, Mr. DiFelice attaches a video of a halftime segment discussing soccer matches and including clips from soccer matches, which begins and ends with the words “GOAL” and “HALFTIME” appearing in sequence. Mr. DiFelice states that these segments would have been broadcast in the course of the above tournaments.

ANALYSIS

[23] The Requesting Party submits that the Owner’s evidence does not demonstrate use of the Mark in association with any of the registered goods or services. In this respect, the Requesting Party submits, *inter alia*, that certain permutations of the Mark shown in evidence, including the formulations “GoalTM: The Soccer Fanatic’s Channel”, “GOAL POST”, “TLN GOAL CRAZY”, and “GOAL HALFTIME” as it appears in the Exhibit L clip, do not amount to use of the Mark as registered. As several of these permutations appear in relation to multiple goods and services, I will address this issue before I address the parties’ submissions with respect to specific goods and services.

[24] If a trademark is used in combination with additional words or features, use will be considered when the public, as a matter of first impression, would perceive the mark as being used *per se* [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB) (*Nightingale*)]. This is a question of fact which is dependent on whether the mark stands out from additional material, for example, by the use of different lettering or sizing, or whether the additional material would be perceived as clearly descriptive or as a separate trademark or trade name [*Nightingale*; see also *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)].

[25] With respect to the formulation “GoalTM: The Soccer Fanatic’s Channel”, I am satisfied that the Mark stands apart from the subsequent material by virtue of the colon separating the Mark from the descriptive words that follow, as well as by the placement of the TM symbol after the word “Goal”. As such, I am satisfied that the appearance of this formulation on TLN’s YouTube channel would amount to display of the Mark as registered.

[26] However, I am not satisfied that the formulations GOAL POST and TLN GOAL CRAZY amount to use of the Mark as registered. With respect to GOAL POST, I note that the words

appear in the same lettering and sizing. Further, I am of the view that the public would not perceive the word “POST” as being clearly descriptive or a separate trademark. Similarly, in the case of TLN GOAL CRAZY, while TLN is likely to be perceived as a separate trademark, the word “CRAZY” is presented in the same lettering and sizing as “GOAL” and would not be perceived as clearly descriptive or a separate trademark. Instead, I find that the addition of the words POST and CRAZY, respectively, substantially alter the dominant features of the trademark as registered, visually, phonetically and in the idea suggested. Accordingly, I find that the public would not find, as a matter of first impression, that the Mark *per se* is being used in these instances [for similar conclusions involving non-descriptive words added to registered trademarks, see *MacKendrick v Phoenix Brands Canada Laundry LLC*, 2013 TMOB 147 at paras 15-17; *Riches, McKenzie & Herbert v Vincor International Inc* (2004), 38 CPR (4th) 82 at para 10; *Aird & Berlis LLP v Erick Factor*, 2019 TMOB 75 at paras 21-23].

[27] Finally, I am satisfied that the appearance of the words “GOAL HALFTIME” at the beginning and end of the Exhibit L “GOAL HALFTIME” video clip amounts to display of the Mark as registered, following *Nightingale*, given that the word “HALFTIME” is descriptive of the program and that the words appear in sequence, with GOAL appearing on its own prior to the appearance of the word “HALFTIME”.

Goods

[28] The Requesting Party submits that the Owner’s evidence is not sufficient to demonstrate use in association with any of the registered goods, noting that Mr. DiFelice provides no sales figures or evidence of transfers in the normal course of trade, such as invoices. The Requesting Party submits that it may be that the goods referred to in the affidavit have been distributed for free, particularly in view of Mr. DiFelice’s statement that the goods were distributed in order to assist in making the Mark known. In this respect, the Requesting Party notes that free distribution of a good to promote a trademark owner’s brand does not constitute a transfer in the normal course of trade [citing, *inter alia*, *Smart & Biggar v Sutter Hill Corp*, 2012 TMOB 121; *Canada Goose Inc v James*, 2015 TMOB 105].

[29] In response, the Owner submits that invoices are not mandatory in a section 45 proceeding, citing *Gowling Lafleur Henderson LLP v Neutrongena Corp* (2009), 74 CPR (4th)

153 (TMOB). In that case, the Registrar found that sales figures together with photographs showing goods displaying the owner's trademark demonstrated use of that trademark despite insufficient invoice evidence. Similarly, the Owner submits that the photographs of goods displaying the Mark, when considered in combination with Mr. DiFelice's statements, are sufficient to demonstrate use within the meaning of the Act.

[30] Although I concur with the Owner that invoices are not mandatory in order to satisfactorily reply to a section 45 notice, some evidence of transfer in the normal course of trade in Canada is necessary [see *John Labatt*]. Such evidence can be in the form of documentation like invoices or sales reports, but can also be through clear sworn statements regarding volumes of sales, dollar value of sales, or equivalent factual particulars [see, for example, *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79]. In this case, Mr. DiFelice states that TLN "has sold and/or distributed" goods displaying the Mark, and refers to having sold such goods at events which were held or sponsored by TLN. However, he provides no factual particulars to support this statement, nor does he make any reference to such sales being in the normal course of trade. In the absence such evidence, I cannot conclude that such sales would amount to transfers in the normal course of trade within the meaning of the Act.

[31] Similarly, with respect to Mr. DiFelice's statement that TLN also "distributed such Goods and the other products to assist in making known the [Mark]", it has been held that free distribution of a good merely to promote one's own brand does not constitute transfer in the normal course of trade [see, for example, *Riches, McKenzie & Herbert LLP v Park Pontiac Buick GMC Ltd* (2005), 50 CPR (4th) 391 (TMOB)]. Rather, the term "trade" in this context contemplates a type of commercial transaction (such as sale or rental) involving the goods in question or at least a transaction carried out for the purpose of creating goodwill for such goods and making profits thereon. Accordingly, for the free distribution of a good to qualify as a transfer in the normal course of trade, the evidence must show that the good was delivered, not merely as a means of promoting other products or services, but as an object of trade in itself, leading to some kind of payment or exchange for such goods [see *Oyen Wiggs Green & Mutala LLP v Flora Manufacturing and Distributing Ltd*, 2014 TMOB 105]. In this case, there is insufficient evidence from which I could conclude that the goods would have been transferred as objects of trade in themselves, rather than simply as a means of promoting TLN's services.

[32] I note that Mr. DiFelice also states that the publication goods “had also been available through websites operated by TLN, including the TLN website.” However, it is well established that it is insufficient to show that goods were merely available to be sold in Canada during the relevant period. Some evidence of transfers in the normal course of trade is required. In any event, as noted above, the formulations of the word “goal” on these publications do not amount to display of the Mark as registered.

[33] In view of the above, I am not satisfied that the Owner has demonstrated use of any of the registered goods within the meaning of the Act.

Multimedia Services and Internet Services

[34] With respect to the Owner’s evidence regarding its services, I note that the Owner’s evidence and submissions correlate the GOAL YouTube channel with both the Multimedia Services and the Internet Services. The Registrar has previously held that “in certain cases, statements of services contain overlapping and redundant terms in the sense that the performance of one service would necessarily imply the performance of another” [*Gowling Lafleur Henderson LLP v Key Publishers Co*, 2010 TMOB 7 at para 15; see also *Provent Holdings Ltd v Star Island Entertainment, LLC*, 2014 TMOB 178 at para 22; *GMAX World Realty Inc v RE/MAX, LLC*, 2015 TMOB 148 at para 69]. In view of this principle, I find that the Owner’s evidence regarding the GOAL YouTube channel would support both “Multimedia services, namely the provision of sports, news and information offered by the way of multimedia applications, namely the Internet, computers”, and “Internet services, namely the provision of sports, news and information to the public offered through the medium of the Internet namely on a website”.

[35] The Requesting Party raises a number of issues with respect to the Owner’s evidence of use in association with the Multimedia Services and Internet Services. In particular, the Requesting Party submits that the Exhibit D screenshots suggest that no content was produced on the GOAL YouTube channel during the relevant period; that the content featured on the channel does not constitute sports, news, or information; and that the channel only has a miniscule number of subscribers and views. With respect to the Exhibit E and F archived screenshots, the Requesting Party submits that the mere fact that the GOAL YouTube channel was advertised on

TLN's webpage does not establish that the channel was actively providing news, sports, or information during that time, or that it was accessed by members of the public. In this respect, the Requesting Party observes that, although Mr. DiFelice provides Google analytics figures relating to TLN's website for a period predating the relevant period, little weight should be given to Mr. DiFelice's views on access during the relevant period in the absence of information on page visits and views for the GOAL YouTube channel.

[36] With respect to the Exhibit G television advertisements and promotional graphics, the Requesting Party notes that these were aired prior to the relevant period, and that Mr. DiFelice's statement that the video was aired intermittently during the relevant period is unclear and ambiguous.

[37] Finally, with respect to the instant video replay system promoted by TLN in 2015, the Requesting Party notes that this system did not come to commercial fruition.

[38] As such, the Requesting Party submits that the Owner's evidence does not demonstrate that TLN was offering and prepared to perform any of services (2) or (3) during the relevant period.

[39] In response, the Owner submits that the evidence is sufficient to demonstrate use of the Mark in association with the Multimedia Services and Internet Services through the GOAL YouTube channel and the instant video replay system. The Owner further submits that even if these services were not actually performed during the relevant period, if a trademark owner is advertising services in association with a trademark and is making such services available in Canada, use of the trademark will be found in association with those services, even in the absence of evidence that the services have actually been performed [citing *Bedwell Management Systems Inc v Mayflower Transit Inc* (1999), 2 CPR (4th) 543 (TMOB); *Smith Lyons v Vertrag Investments Ltd* (2000), 7 CPR (4th) 557 (TMOB)].

[40] With respect to the instant video replay system, I note that Mr. DiFelice states that this service was "developed and marketed" during the relevant period and that it "was to be available to any mobile phone user", but that "it did not come to commercial fruition". Although the Exhibit H promotional materials show that the Mark was displayed in the course of advertising

this service, it is not sufficient that the service was merely advertised during the relevant period; TLN must also have been offering and prepared to perform the service [*Dynaturf*]. In this respect, I note that Mr. DiFelice does not explain why the service never came to commercial fruition. It is unclear whether the service was ready to come to commercial fruition but did not receive sufficient interest from TLN's clients, or whether it had not been developed to the point that it was ready to come to commercial fruition. Mr. DiFelice's statements that the service was "developed" by TLN and "was to be available to any mobile phone user" do not sufficiently clarify the matter such that I could conclude that TLN was in fact offering and prepared to perform this service. Further, in the absence of any explanation as to why the service never came to commercial fruition, I cannot conclude that there have been special circumstances excusing non-use of the Mark with respect to the instant video replay service.

[41] With respect to the GOAL YouTube channel, it is unusual that Mr. DiFelice chose to provide broadcast figures for the Exhibit G television advertisements, and Google Analytics figures for page visits, only for the period immediately preceding the relevant period, and then an estimation that viewership or page access would have been in approximately the same amount during the relevant period. However, I am satisfied that at minimum, the Owner's evidence shows that the GOAL YouTube channel displayed the Mark and was accessible to Canadians during the relevant period, and that this channel was promoted on TLN's website for a significant amount, if not all, of the relevant period. I reach this conclusion for the reasons that follow.

[42] Regarding advertisement of the GOAL YouTube channel on TLN's website, I note that although webpages are not the same as printed advertisements, in that they cannot be tangibly distributed in the same way, they must still be "distributed to" or accessed by prospective customers in order to constitute advertising [see, for example, *Shift Law v Jefferies Group, Inc*, 2014 TMOB 277 at para 20; *Ridout & Maybee v Residential Income Fund LP*, 2015 TMOB 185 at paras 47-48]. As such, for exhibited webpages to constitute advertisement of registered services, there must be some evidence of access to those webpages. A clear statement may be sufficient. In the alternative, there should be some evidence from which it can be reasonably inferred that customers accessed the webpages. Whether such evidence is then sufficient to

demonstrate use of a trademark in association with particular services within the meaning of sections 4 and 45 of the Act will depend on the facts of each case.

[43] In this case, Mr. DiFelice states that “thousands of Canadians have accessed TLN’s website, including during the Relevant Period”, and that its website “had and has more than 30,000 unique visitors per month”. While the Requesting Party notes that the latter does not specify whether these unique visitors are Canadian, I am prepared to infer that at least some of these visitors were Canadian, given that TLN was a Canadian television broadcaster. With respect to the Google Analytics figures, although they pertain only to a period preceding the relevant period, Mr. DiFelice states that the “number of visits during the Relevant Period were at least in this amount”. As a result, while it would have been preferable to have Google Analytics figures encompassing the relevant period, I am satisfied, based on the totality of the evidence, that at least *some* Canadians would have accessed TLN’s website throughout the relevant period. Given Mr. DiFelice’s statement that TLN began promoting the GOAL YouTube channel prior to the relevant period and the evidence that it continued to be promoted at least as late as February 2016 (as shown in Exhibit F), I am satisfied that Canadians would therefore have seen the advertisement for the GOAL YouTube channel on TLN’s website.

[44] With respect to the GOAL YouTube channel itself, while the Requesting Party notes that each of the videos posted to the channel predates the relevant period and there is no evidence that any new content was posted or uploaded to the channel during the relevant period, I am not prepared to accept the Requesting Party’s suggestion that display of a trademark in association with multimedia content produced before the relevant period, but accessible during the relevant period, cannot support use in association with services involving the provision of multimedia content. On the facts of this particular case, it appears that the content was accessible to Canadians during the relevant period and, as stated by Mr. DiFelice, capable of generating advertising revenue. Furthermore, Mr. DiFelice states that over 6,500 Canadians accessed these videos during the relevant period, indicating that the service was actually performed by TLN during the relevant period.

[45] Given that the titles for the videos on the GOAL YouTube channel indicate that they contain a variety of soccer-related content, including what might be broadly described as soccer

news and information, I am satisfied that the Owner has demonstrated use of the Mark in association with advertisement of the registered services “Multimedia services, namely the provision of sports, news and information offered by the way of multimedia applications, namely [...] the Internet, computers”, as well as “Internet services, namely the provision of sports, news and information to the public offered through the medium of the Internet namely on a website”, and was offering and prepared to perform such services during the relevant period. As such, I am satisfied that the Owner has demonstrated use of the Mark in association with such services within the meaning of the Act.

[46] With respect to “Internet services, namely the provision of sports, news and information to the public offered [...] through on-line publications, and in newsletters delivered on a computer network by e-mail”, Mr. DiFelice’s evidence in Exhibit M shows that members of the public could subscribe to its “GOAL POST” newsletter or access its blog entitled “TLN GOAL CRAZY: THE SOCCER FANATIC’S BLOG”. However, as discussed above, these permutations do not amount to display of the Mark as registered. There is no further evidence that the newsletters or blog displayed the Mark as registered. Accordingly, I am not satisfied that the Owner has demonstrated use of the Mark in association with these additional Internet Services.

Entertainment Services and Multimedia Services Offered by Way of Television

[47] The Requesting Party submits that the Owner’s evidence is not sufficient to demonstrate use of the Mark in association with the Entertainment Services. In particular, the Requesting Party notes that the Exhibit K video clips are from a soccer match that was either broadcast or re-broadcast prior to the relevant period and submits that the animated word “GOAL” is not used as a trademark. I agree with the Requesting Party that these clips, which were broadcast long before the relevant period, do not provide evidence of use of the Mark in association with advertising any of the registered services during the relevant period.

[48] With respect to the Exhibit L “GOAL HALFTIME” video clip, the Requesting Party submits that there is no clear information on viewership or revenues, or other information to confirm the extent of use of this video. Further, the Requesting Party submits that the mere appearance of the word “GOAL” in the clip does not demonstrate that TLN offered broadcasting

services in association with the Mark, and that any broadcasting services are performed in association with TLN's other trademarks, such as "EUROWORLD SPORT CHANNEL".

[49] However, in view of Mr. DiFelice's sworn statement that halftime segments displaying the Mark were broadcast at least 15 times per day in the course of soccer tournaments in 2016 and 2017 on TLN's television channels, which are accessible in millions of Canadian households, I accept that the halftime segments were viewed by Canadians during the relevant period. As noted above, I am satisfied that the display of the words "GOAL HALFTIME" in this segment amounts to use of the Mark. Although the Requesting Party submits that any broadcasting services are performed in association with TLN's other trademarks, there is nothing in the Act that precludes a trademark owner from using more than one trademark at the same time in association with the same goods [*AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)].

[50] As such, I am satisfied that TLN created and aired soccer halftime segments in association with the Mark which would have been viewed by Canadians during the relevant period. Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with "Entertainment services namely the production, broadcast, recording, transmission and distribution of television programs" within the meaning of the Act. Similarly, as the segment contains material that could broadly be considered sports news and information, I am satisfied that the Owner has demonstrated use of the Mark in association with "Multimedia services, namely the provision of sports, news and information offered by the way of [...] television."

[51] However, such display of the Mark does not demonstrate use in association with "the operation of television networks" or "the promotion and organization of live performances and festivals". With respect to the former, there is nothing in evidence to suggest that TLN has used the Mark in association with the operation of television *networks*, as opposed to television programming, during the relevant period or otherwise. With respect to live performances and festivals, at the hearing, the Owner noted that there are several references to festivals operated by TLN in evidence. Such references include the Exhibit E and I screenshots of TLN's website, referring to a "Salsa in Toronto Festival" apparently operated by TLN. The Exhibit D screenshot

also shows that the GOAL YouTube channel is subscribed to a separate “Salsa in Toronto” YouTube channel. However, the fact that TLN’s website references this festival and also includes an advertisement for the GOAL YouTube channel, or that the GOAL YouTube channel may subscribe to the channel of that festival, does not demonstrate that the Mark was displayed in association with the performance or advertising of these festivals. In the absence of further evidence, I am not satisfied that the Owner has demonstrated use of the Mark in association with “the operation of television networks” or “the promotion and organization of live performances and festivals” within the meaning of the Act.

[52] As there is no evidence of special circumstances which would excuse non-use of the Mark in association with any of the registered goods or services for which the Owner has not demonstrated use, the register will be amended accordingly.

DISPOSITION

[53] In view of all of the above, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete all of the registered goods, as well as “the operation of television networks and the promotion and organization of live performances and festivals” from services (1), “databases” from services (2), and “through on-line publications, and in newsletters delivered on a computer network by e-mail” from services (3).

[54] The amended statement of services will be as follows:

- (1) Entertainment services namely the production, broadcast, recording, transmission and distribution of television programs.
- (2) Multimedia services, namely the provision of sports, news and information offered by the way of multimedia applications, namely the Internet, computers, and television.
- (3) Internet services, namely the provision of sports, news and information to the public offered through the medium of the Internet namely on a website.

G.M. Melchin
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2020-12-10

APPEARANCES

Colleen Spring Zimmerman

For the Registered Owner

Peter Cooke

For the Requesting Party

AGENTS OF RECORD

Folger, Rubinoff LLP

For the Registered Owner

Borden Ladner Gervais LLP

For the Requesting Party