



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 116

Date of Decision: 2021-05-31

IN THE MATTER OF A SECTION 45 PROCEEDING

Samir Marc Falaki

Requesting Party

and

Vudu, Inc.

Owner

TMA850,256 for VUDU

Registration

SUMMARY OF DECISION

[1] At the request of Samir Marc Falaki (the Requesting Party), the Registrar of Trademarks issued a notice to Vudu, Inc. (the Owner) under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on October 13, 2017. The notice required the Owner to show use of the trademark VUDU (the Mark) in Canada in association with each of the services specified in registration no. TMA850,256 at any time from October 13, 2014 to October 13, 2017 (the relevant period).

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

Broadcasting of music, motion picture and video content over the internet, video-on-demand transmission services, pay-per-view video and audio transmission services; providing information in the area of audio and video programming namely, the

distribution of motion pictures to retail consumers excluding interactive games and providing consumer information used in the selection and purchase of audio and video content namely, retail ordering services in the field of motion pictures excluding interactive games and providing a website featuring temporary use of non-downloadable software allowing website users to store and play audio and video content for entertainment purposes in the field of motion pictures and multi-media excluding interactive games.

[3] The Requesting Party submits that, since there is no evidence that any Canadian had purchased a movie or show or other service from the Owner, the registration should be expunged. However, when it comes to trademarks, “use” has a specific meaning. 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 [section 4(2) of the Act]. There is a caveat, however, that advertising is not sufficient to show use; some aspect of the services must be performed or delivered in Canada or be available to be performed in Canada [*Miller Thomson LLP v Hilton Worldwide Holding LLP*, 2020 FCA 134 (*Hilton*) at para 7; *Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)]. This can include the offering of ancillary services on a website where there is a material benefit to Canadians in Canada [*TSA Stores, Inc v Registrar of Trade-Marks*, 2011 FC 273; *Hilton, supra*].

[4] In this case, the Owner has shown use of the Mark in Canada for most of the services for the reasons that follow. The Owner, however, has not shown use of the Mark in Canada for the following services:

- pay-per-view video and audio transmission services;
- broadcasting of music ... over the internet;
- providing information in the area of audio programming ...
- providing a website featuring temporary use of non-downloadable software allowing website users to store and play audio content for entertainment purposes in the field of motion pictures and multi-media excluding interactive games.
- the distribution of motion pictures to retail consumers excluding interactive games; and

- retail ordering services in the field of motion pictures excluding interactive games.

THE PROCEEDING

[5] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448 at para 68]. 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)], mere assertions of use are not sufficient to demonstrate use [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Rather, sufficient facts must 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.

[6] In response to the Registrar’s notice, the Owner submitted the affidavits of Gordon Y. Allison and Gurk Singh. Both parties provided written representations. Both parties requested and attended an oral hearing.

[7] In his initial request and subsequent submissions, the Requesting Party indicates that he did extensive research which shows that the Mark has not been used in Canada. However, in this proceeding, the Registrar is only allowed to receive evidence from the Owner [section 45(2) of the Act]. Also, only the Registrar can determine whether a trademark has been in use [sections 45(3) and (4) of the Act]. Because of this, I have had no regard to the research, conclusions of use and allegations in the Requesting Party’s submissions.

THE EVIDENCE

The Affidavit of Gordon Y. Allison

[8] Mr. Allison is the Vice President and Assistant Secretary of the Owner. In this role, he is involved in all aspects of the Owner’s business, including marketing, advertising, promotions, and sales efforts related to the Mark and the Owner’s services (para 1). The Owner is a content delivery and media technology company and offers internet-based home entertainment services

that provide access to a library of films, television shows and other audio and video content (para 7).

[9] Mr. Allison states that the Mark was in use in Canada with “at least some” of the services listed in the registration (paras 11-12). He provides printouts from archived versions from the relevant period of the Owner’s website which display the Mark (Exhibits 6 to 9). The printouts have dates on them during the relevant period, and the Mark is displayed on the printouts.

[10] Mr. Allison also provides printouts from the current version of the Owner’s website (Exhibits 2 to 5). The Mark is displayed on the printouts. Although these printouts are from after the relevant period, Mr. Allison explains that they are representative of how the webpages appeared in Canada during the relevant period (paras 15, 16 and 23). He also provides information on the number of times that Canadian internet users visited the Owner’s website for each year from 2015 to 2017 (para 22).

The Affidavit of Gurk Singh

[11] Mr. Singh is an articling student at the prior trademark agent of the Owner. He visited the Owner’s website on May 10, 2018 (which is after the relevant period) and took screenshots and video screen captures using his computer in Canada. As Mr. Singh’s evidence was obtained after the relevant period and there is no evidence that the screenshots and video screen captures are as they appeared during the relevant period, I do not consider it relevant.

ANALYSIS AND REASONS FOR DECISION

[12] The Requesting Party submits that, since there is no evidence that Canadians can purchase or download the movies or TV shows that appear on the Owner’s website, even though there is evidence that Canadians have visited the website, the registration should be expunged.

Video Services

[13] I will first consider whether the Owner has shown use of the Mark with the following services:

Broadcasting of motion picture and video content over the internet, video-on-demand transmission services; providing information in the area of video programming namely, providing consumer information used in the selection and purchase of video content namely, providing a website featuring temporary use of non-downloadable software allowing website users to store and play video content for entertainment purposes in the field of motion pictures and multi-media excluding interactive games.

[14] I find that use has been shown for these services. 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 [section 4(2) of the Act]. Mr. Allison provides printouts from the Owner's website where the Mark appears in the top left corner (Exhibits 2 to 9). The same printouts from Mr. Allison show that the Owner's website provides information about movies and TV shows (para 14; Exhibits 2 to 4) as well as trailers for movies and TV shows (para 15; Exhibits 4 and 5). According to Mr. Allison, the Owner's website was visited by Canadian internet users over 650,000 times from April to December 2015, over 700,000 times in 2016, and over 950,000 times in 2017, and Canadians could view the information and trailers on the Owner's website (paras 15 and 22).

[15] As a result, I am satisfied that use of the Mark, as defined in sections 4(2) and 45 of the Act, has been shown in association with the following services:

Broadcasting of motion picture and video content over the internet, video-on-demand transmission services; providing information in the area of video programming namely, providing consumer information used in the selection and purchase of video content namely, providing a website featuring temporary use of non-downloadable software allowing website users to store and play video content for entertainment purposes in the field of motion pictures and multi-media excluding interactive games.

Pay-Per-View Services

[16] Because the description "pay-per-view video and audio transmission services" suggests that purchase is required, I do not find that use has been shown for these services. Although I agree with the Owner's submission that services do not need to be performed for money as a general principle, the wording of the services above including "pay-per-view" suggests that purchase is required for these services to be performed.

[17] Even though Mr. Allison provides the number of times that Canadian internet users visited the Owner's website and the printouts from Mr. Allison display prices for renting or owning movies or TV shows, the evidence is completely silent when it comes to any Canadian sales or orders for movies or TV shows through the Owner's website. Because there is no evidence of sales in this case, I am unable to conclude that these pay-per-view services were performed in Canada.

[18] Further, there is no evidence showing that these services were targeted to Canadians or available to be performed in Canada. The display of a trademark on the website does not suffice when there is no evidence that the services were actually targeted at, advertised to or effectively offered to Canadians [*HomeAway.com, Inc v Hrdlicka*, 2012 FC 1467; *Unicast SA v South Asian Broadcasting Corp* 2014 FC 295 at paras 46-47, 63 (*Unicast*)]. I do not find Mr. Allison's statement that advertising is "accessible" to Canadians to equate to advertising which targets Canadians (paras 24-29). In particular, there are no Canadian currency options or website information specific to Canadians with respect to the pay-per-view services [*Star Island Entertainment LLC v Provent Holdings Ltd*, 2013 TMOB 84 at para 30; *McCarthy Tétrault v Lawyers Without Borders Inc*, 2010 TMOB 169 at para 21; *Unicast, supra* at para 64]. In view of the foregoing, I am unable to conclude that there was use of the Mark in Canada, as defined in sections 4(2) and 45 of the Act, in association with "pay-per-view video and audio transmission services". As the Owner has not provided any special circumstances excusing non-use of the Mark in association with these services, they will be deleted from the registration [section 45(3) of the Act].

Distribution to Retail Consumers and Retail Ordering Services

[19] Mr. Allison's evidence is silent on the following services: "the distribution of motion pictures to retail consumers excluding interactive games;" and "retail ordering services in the field of motion pictures excluding interactive games". In the absence of information as to the retail consumers or retail ordering services and as Mr. Allison has explained that the Owner offers internet-based home entertainment services, I do not find that use has been demonstrated with respect to these "retail" services. As the Owner has not provided any special circumstances

excusing non-use of the Mark in association with these services, they will be deleted from the registration [section 45(3) of the Act].

Music and Audio Services

[20] Although Mr. Allison makes passing reference to music (at para 4) and audio services (at paras 17 and 18), I do not find these statements to be sufficient to show use for music or audio services. At the hearing, the Owner submitted that the trailers for movies and TV shows include music, audio, and video. However, when discussing the exhibits, Mr. Allison explains that the exhibits show video content/trailers and information about movies and TV shows (for example, at paras 14 to 16). He does not connect the trailers to music or audio services. As a result, in the absence of further information from Mr. Allison, I am unable to conclude that there was use of the Mark in association with music or audio services. As the Owner has not provided any special circumstances excusing non-use of the Mark in association with these services, they will be deleted from the registration.

CONCLUSION

[21] 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 amended to delete the following services shown ~~struck out~~ below:

Broadcasting of ~~music~~, motion picture and video content over the internet, video-on-demand transmission services, ~~pay per view video and audio transmission services~~; providing information in the area of ~~audio and~~ video programming namely, ~~the distribution of motion pictures to retail consumers excluding interactive games and~~ providing consumer information used in the selection and purchase of ~~audio and~~ video content namely, ~~retail ordering services in the field of motion pictures excluding interactive games and~~ providing a website featuring temporary use of non-downloadable software allowing website users to store and play ~~audio and~~ video content for entertainment purposes in the field of motion pictures and multi-media excluding interactive games.

[22] The registration will now read as follows:

Broadcasting of motion picture and video content over the internet, video-on-demand transmission services; providing information in the area of video programming namely, providing consumer information used in the selection and purchase of video content namely, providing a website featuring temporary use of non-downloadable software allowing website users to store and play video content for entertainment purposes in the field of motion pictures and multi-media excluding interactive games.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2021-03-25

APPEARANCES

Jonathan Colombo	For the Registered Owner
Samir Marc Falaki	For the Requesting Party

AGENTS OF RECORD

Marks & Clerk	For the Registered Owner
Samir Marc Falaki	For the Requesting Party