



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 174**

**Date of Decision: 2021-08-06**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Bereskin & Parr LLP/S.E.N.C.R.L.,                      Requesting Party**  
**S.R.L.**

**and**

**Yellowjacket Software Ltd.                      Registered Owner**  
**TMA869,512 for Playmaker                      Registration**

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to Registration No. TMA869,512 for the trademark Playmaker (the Mark), which is owned by Yellowjacket Software Ltd. (the Owner).

[2] The Mark is registered for use in association with the following goods: “Computer software, namely, a set of applications and features that allows users to create and run graphical sports-related simulations.”

[3] For the reasons that follow, I conclude that the registration ought to be expunged.

THE PROCEEDING

[4] At the request of Bereskin & Parr LLP/S.E.N.C.R.L., S.R.L. (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on June 22, 2018.

[5] The notice required the Owner to show use of the Mark in Canada in association with each of the goods specified in the registration at any time within the three-year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is June 22, 2015 to June 22, 2018.

[6] The relevant definitions of use in the present case 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.

...

(3) A trademark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

[7] In the absence of use as defined above, the Mark is liable to be expunged unless the absence of use is due to special circumstances that excuse the absence of use [section 45(3) of the Act].

[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 Owner must meet is quite low [*Lang Michener, Lawrence & Shaw v Woods Canada* (1996), 71 CPR (3d) 477 (FCTD) at para 9] and “evidentiary overkill” is not required [*Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at para 3]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the Mark was used in association with each of the goods specified in

the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA) at para 14].

[9] In response to the Registrar's notice, the Owner furnished the affidavit of Kevin Colton, sworn on September 18, 2018.

[10] Although neither party submitted and served written representations, on the final page of the Colton affidavit, there are two paragraphs on a page titled "Written Submission". In addition, during the course of this proceeding, both parties corresponded with the Registrar about whether the exhibits to the Colton affidavit are properly commissioned and whether they should be accepted. I will consider the admissibility of the exhibits in more detail in the analysis below.

[11] Both parties requested an oral hearing; however, only the Requesting Party submitted its request within the prescribed timeframe. A hearing was scheduled per the Requesting Party's request and the Owner was offered the opportunity to make submissions at the hearing. However, given that the Requesting Party subsequently asked for the hearing to be cancelled, no oral hearing was ultimately held.

#### THE EVIDENCE

[12] In his affidavit, Mr. Colton identifies himself as the "registered owner, director, and incorporator" of the Owner. He states that, between July 2012 and May 2018, the Owner operated a website selling Playmaker products (para 2). In support, he provides an archived version of a webpage located at [www.yellowjacket.ca/playmaker](http://www.yellowjacket.ca/playmaker) (Exhibit A). The Mark appears at the top of the webpage and throughout the text of the webpage.

[13] As Exhibit B, Mr. Colton provides an email between the Owner and a customer in Atlanta. The email shows that a licence was purchased for "Sting Playmaker" software. Mr. Colton states that the Owner made this sale on October 21, 2015 (para 3).

[14] Mr. Colton also provides invoices showing that he registered and renewed the domain name *playmaker.bz*, which he states is used to sell Playmaker software (paras 4 and 5; Exhibits C and D).

## ANALYSIS AND REASONS FOR DECISION

[15] First, with respect to whether the exhibits are properly commissioned and whether they should be accepted, I note that the Registrar has previously accepted exhibits that were not properly endorsed where the exhibits were instead identified or explained in the body of the affidavit [see, for example, *Borden & Elliot v Raphaël Inc* (2001), 16 CPR (4th) 96 (TMOB) at para 11]. In this case, given that the exhibits are identified and explained by Mr. Colton in the body of his affidavit, I am prepared to accept the exhibits and their contents for what they show.

[16] Under the heading “Written Submission” on the final page of the Colton affidavit, it is submitted that the evidence demonstrates use of the Mark in the normal course of trade in Canada during the relevant period. It is also noted that the threshold to establish use is low and only a *prima facie* case of use needs to be shown.

[17] However, I do not find that the Owner has provided sufficient facts in order for me to conclude that use has been shown. In particular, the Owner does not provide any evidence of sales to customers in Canada. The only evidence of a sale provided by Mr. Colton is the Exhibit B email correspondence between the Owner and a customer in Atlanta, which means that section 4(3) of the Act applies here [see *Sim & McBurney v International Name Plate Supplies Limited*, 2020 TMOB 27 at paras 19, 22 and 23, aff’d 2021 FC 611 at paras 42 to 45, for the requirement that the Owner must demonstrate use of the Mark in accordance with section 4(3) of the Act when the evidence shows that customers are located outside Canada]. In this respect, the Owner does not provide any evidence that the Mark appeared on the goods themselves or on the packages in which they are contained. As a result, the Owner does not show use of the Mark under section 4(3) of the Act.

[18] In addition, given that the Owner does not provide any evidence of transfers to customers in Canada, I do not find that the Owner has established use of the Mark in Canada under section 4(1) of the Act.

[19] Although the Mark is displayed on the Owner’s website at Exhibit A with options to “Download”, “Purchase” and get a “Free Trial” of the software, at best, the website shows that the Mark was displayed when the goods were offered or made available for download or

purchase. This alone does not equate to the display of the Mark at the time of transfer of the goods (or at the time of download or purchase). Without any evidence of transfers to customers in Canada, this is more akin to the display of the Mark on advertising, which is not sufficient to show use of the Mark under section 4(1) of the Act [see, for example, *Riches, McKenzie & Herbert LLP v Cleaner's Supply, Inc*, 2012 TMOB 211 at para 13].

[20] Based on the findings above, I am not satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act in association with the registered goods, and the Owner has not provided any special circumstances excusing non-use of the Mark.

[21] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be expunged.

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Bradley Au  
Hearing Officer  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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

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**HEARING DATE** No oral hearing held

**AGENTS OF RECORD**

No agent appointed

For the Registered Owner

All the trademark agents at Marks & Clerk

For the Requesting Party