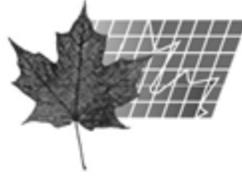


O P I C



C I P O

**LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS**

Citation: 2022 TMOB 076

Date of Decision: 2022-04-21

IN THE MATTER OF A SECTION 45 PROCEEDING

MacRae & Co.

Requesting Party

and

Ultra-Agent Industries Inc.

Registered Owner

TMA721,157 for überbabe

Registration

INTRODUCTION

[1] At the request of MacRae & Co. (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 November 28, 2019 to Ultra-Agent Industries Inc. (the Owner), the registered owner of registration No. TMA721,157 for the trademark überbabe (the Mark).

[2] The Mark is registered for use in association with the goods and services in Schedule A to this decision.

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

[4] The notice required the Owner to show whether the Mark has been used in Canada in association with each of the goods and services 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 November 28, 2016 to November 28, 2019.

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

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.

[6] In the absence of use, pursuant to section 45(3) of the Act, a trademark is liable to be expunged, unless the absence of use is due to special circumstances.

[7] It is well established that bare assertions of 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)].

[8] In response to the Registrar's notice, the Owner furnished the affidavit of its founder and President, Lise Noelle Voldeng. Both parties submitted written representations. Only the Requesting Party attended an oral hearing.

[9] In its written submissions, the Owner makes submissions about the propriety of the request for the section 45 Notice and settlement negotiations between the parties. Section 45 of the Act permits any person to request a section 45 notice. Furthermore, the Registrar only has regard to the evidence of use provided in the affidavit filed in reply to the notice. As such, I have

had no regard to the allegations in the Requesting Party's submissions insofar as they relate to issues other than whether the Owner's evidence is sufficient to maintain the registration of the Mark.

THE EVIDENCE

[10] In her affidavit, Ms. Voldeng describes the Owner as an integrated entertainment, media and technology company that develops product and service solutions across various industries for an array of customers (paras 2 and 3).

[11] Ms. Voldeng states that, due to a severe chronic pain, she has not been working full time for the Owner since 2015 (para 7) and that:

Ultra-Agent Industries Inc. sales during the previous three years have been extremely small though consistent monthly on some products, both because we are in the midst of a product development cycle, and because of my focus on my health.

[12] At paragraph 17, Ms. Voldeng further explains:

During the Relevant Period, at least 50 units of the Goods were sold in the United States, Canada and internationally and revenue related to the sales of the Goods and Services exceeded \$53 USD.

[13] Ms. Voldeng includes copies of photographs of products, advertising materials, printouts of the Owner's website, an accounting overview and a chart providing which of the registered goods are "in development and licensing development" (Exhibits A through E). While the exhibits are voluminous, in most instances these exhibits are not correlated with sales or services offered in Canada during the relevant period.

ANALYSIS AND REASONS FOR DECISION

No Special Circumstances Excusing Non-Use

[14] To the extent that I find that there has not been use of the registered goods and services below, there are not special circumstances excusing non-use pursuant to section 45(3) of the Act.

[15] Generally, a determination of whether there are special circumstances that excuse non-use involves consideration of three criteria, as set out in *Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA). The first is the length of time during which the trademark has not been in use, the second is whether the reasons for non-use were beyond the control of the registered owner and the third is whether there exists a serious intention to shortly resume use. Further, the intent to resume use must be substantiated by the evidence [*Arrowhead Spring Water Ltd v Arrowhead Water Corp* (1993), 47 CPR (3d) 217 (FCTD); *NTD Apparel Inc v Ryan* 2003 FCT 780].

[16] Even if I were to conclude that Ms. Voldeng's severe chronic pain in this case constitutes special circumstances, I would not be satisfied that the circumstances set out in the evidence excuse the Owner's failure to use the Mark with the registered goods and services. The Federal Court has previously held that "mere intention to resume use is not satisfactory and must be substantiated by factual elements such as purchase orders or, at least, a specific date of resumption" [*Lander Co Canada Ltd v Alex E Macrae & Co* (1993), 46 CPR (3d) 417 (FCTD) at paragraph 15]. There is no evidence that the Owner has a serious intention to shortly resume use in association with the registered goods and services, nor has the Owner provided a specific date of resumption.

[17] As a result, the Owner has not demonstrated special circumstances excusing non-use of the Mark in association with the registered goods and services within the meaning of section 45(3) of the Act.

No Use for Goods Listed as "in Licensing and Development" or "Not-Applicable"

[18] In Ms. Voldeng's evidence she provides a table with the headings "Goods" and "Sample Photos".

[19] For the registered goods set out below, instead of identifying a sample photo in her evidence, the only evidence that Ms. Voldeng has provided is that these goods are "in Licensing and Development" or listed as "n/a" (para 16, Exhibit E). As the Owner has not provided special circumstances excusing non-use, these will be deleted from the registration:

(1) Video game console connectable to computer or television; portable video game machines for personal use; pre-recorded computer programs containing video game software; interactive computer, video and electronic game programs; pre-recorded optical discs, video discs, DVDs and magnetic cards containing video games; electronic circuits imprinted with game programs for video game machines; stereo speakers; stereo amplifiers; hard disc drives; memory devices, namely computer memory and flash memory cards and chips; computer cables; computer supportive stands; video game controllers and joysticks; headphones; rechargeable batteries for electronic devices, namely cameras, cellphones, MP3 players, computers, personal digital assistants, stereos and radios; touch panels, namely video game touch consoles; pouches, cases and bags for carrying personal electronic devices, namely cameras, cell phones, MP3 players, computers, personal digital assistants, stereos and radios; hand straps and neck straps designed for use in association with video games.

(4) Clothing, namely jeans, shorts, dresses, shirts, jackets, blazers, halter tops, vests, blouses, golf shirts, sweaters, overalls, turtlenecks, jumpsuits, sport shirts, culottes, windbreakers, gaiters, swimwear, gloves, mittens, belts, scarves, socks, shawls, capes, hats, caps, headbands, toques, hair bands, sleepwear, nightgowns, pajamas, robes, shoes, tote bags and carrying bags, namely athletic bags, sport bags, luggage, school bags, travel bags and purses.

(5) Playthings and recreational articles, namely, tabletop parlour games, namely board games, card games, word games and puzzles, arcade games, playing cards, trading cards, toy animals, inflatable toys, squeeze toys, Halloween masks, costumes and make-up kits, sponge toys, sculpture toys, wind up toys, squeezable squeaking toys, two dimensional and three dimensional woodboard, cardboard and plastic puzzles, water squirting toys, plush toys, puppets, twirling and flying tops, punching balls, musical toys, noisemakers, whistles, magic sets, marbles, water toys, bubble toys, pull toys, bean bags, skateboards, in-line skates, rubber action balls, walkie-talkies, pinball games, costumes, computer software, namely computer games, video games and parts and accessories therefor, namely controllers, joysticks, mouse, mouse pads, remote control and game specific controllers for playing video games, namely musical instruments, guns and weapons.

No Use is Shown With Respect to the Remaining Goods

[20] The remaining goods are listed below:

(1) battery chargers for electronic devices, namely cameras, cellphones, MP3 players, computers, personal digital assistants, stereos and radios.

(2) Audio and visual recorded materials, namely pre-recorded audio and visual DVDs, CDs, DVD ROMs, CD ROMs, records and tapes, containing motion pictures, animation, music, television programs, computer games and online web

based entertainment applications, namely imbedded or non-imbedded computer video gaming and social networking software for personal computers, portable computers and game consoles.

(3) Books, novels, magazines and comic strips.

(4) Clothing, namely coats, pants, t-shirts, tank tops, sweatshirts, sweatpants, sweatpants, pullovers, jogging suits, underwear.

[21] Although Ms. Voldeng asserts sales of at least 50 units of these goods in Canada, the United States and internationally (para 17) during the relevant period, the evidence is insufficient to show use of the Mark in Canada for the reasons that follow.

[22] For goods (1) listed above, there is no evidence of display of the Mark nor transfer of these goods.

[23] With respect to goods (2) “Audio and visual recorded materials, namely pre-recorded audio and visual DVDs, CDs, DVD ROMs, CD ROMs, records and tapes, containing motion pictures, animation, music”, Ms.Voldeng provides photographs at Exhibit A of her affidavit which she describes as:

Photographs of some of the überbabe ... digital and DVD animation covers, and musical CD and digital distribution album and album singles covers.

[24] Ms. Voldeng provides an Accounting Overview which contains the following description “below is a sampling of überbabe music album cd sales, digital streaming sales, and royalty payments during fourth quarter 2019 until February 19, 2020” (Exhibit D). In her affidavit, she describes this Accounting Overview as “providing a sampling of invoices for the sale of Goods and Services in Canada during the Relevant Period” (para 15). The Accounting Overview, however, appears to be inconsistent with Ms. Voldeng’s description of it. Multiple entries are either dated before or after the relevant period or reference countries other than Canada including “iTunes Apple Music US Sale”, “Amazon US Premium Service Sale” and “iTunes Apple Other Territories Sale”. On the basis of these inconsistencies, I am not prepared to infer that the remaining sales dated in the relevant period occurred in Canada With respect to the two items in Exhibit D dated during the relevant period and identified as “iTunes – Apple Music – Canada Sale” and “iTunes Match – Canada Sale”, I note that both of those items list the transaction

amount as “\$0.00”, and there is no explanation from the Owner as to how such a transaction was in the normal course of trade. Moreover, at best for the Owner, I could only infer that such a transaction involved the downloading or streaming of music digitally as opposed the purchase of a physical recording. Finally, there is scant evidence as to whether and how the Mark appeared in the performance or advertising of the corresponding entertainment services during the relevant period, nor with the sale of content through streaming services.

[25] With respect to the books, novels and clothing as described in goods (3) and (4), although Exhibit A shows representative photographs of print and digital books, graphic novels and clothing related items, there is no evidence that any of these products have been sold or transferred within the relevant period in Canada.

[26] Accordingly, I am not satisfied that there was use of the Mark in association with the following registered goods within the meaning of sections 4(1) and 45 of the Act. As the Owner has not provided special circumstances excusing non-use, these will be deleted from the registration:

(1) battery chargers for electronic devices, namely cameras, cellphones, MP3 players, computers, personal digital assistants, stereos and radios.

(2) Audio and visual recorded materials, namely pre-recorded audio and visual DVDs, CDs, DVD ROMs, CD ROMs, records and tapes, containing motion pictures, animation, music, television programs, computer games and online web based entertainment applications, namely imbedded or non-imbedded computer video gaming and social networking software for personal computers, portable computers and game consoles.

(3) Books, novels, magazines and comic strips.

(4) Clothing, namely coats, pants, t-shirts, tank tops, sweatshirts, sweatpants, sweatpants, pullovers, jogging suits, underwear.

No Use is Shown for the Registered Services

[27] I do not find that the Owner has shown use of the Mark with any of the registered services. In her affidavit, Ms. Voldeng describes the Owner as a service solutions provider for an

array of customers. Other than her assertion at paragraph 5 that the services are available in Canada, Ms. Voldeng is silent on whether the Owner actually offers or performs any of the registered services and, if so, in what jurisdiction.

[28] With respect to the advertising materials at Exhibit B, to constitute advertising, materials displaying the trademark must be distributed to or viewed by prospective customers in Canada [*Cornerstone Securities Canada Inc v Canada (Registrar of Trade Marks)* (1994), 58 CPR (3d) 417 (FCTD); *Shift Law v Jefferies Group, Inc*, 2014 TMOB 277]. In this case, there is no evidence that the materials displaying the Mark were distributed, nor viewed by any Canadians during the relevant period. Furthermore, for the reasons set out in paragraph 24 of this decision, I do not find that the Accounting Statement at Exhibit D is sufficient evidence to maintain registration of the entertainment services.

[29] Ms. Voldeng's statement at paragraph 14 of her affidavit that the Owner's website, printouts of which are attached as Exhibit C, was accessible to consumers located in Canada is not evidence that Canadians have viewed the website. In addition, the website materials do not correlate with any registered service *per se*. For example, the website includes the following statement:

Ultra-Agent Industries Inc. is an integrated entertainment, media and technology company. We equip individuals to lead ourselves, our organizations, and our countries with joyous, prosperous integrity. We forecast developments across every aspect of civilization. We develop product solutions for every aspect of civilization. We develop and direct teams, projects and companies. And we invest in, advise and mentor individuals and corporations. To ensure we truly shine.

Each of our brands presents a mix of product solutions, from advisory to culture to entertainment to education to experience to fashion to forecast to finance to media to mission to machine to machine technology and beyond.

We package our product and services mixes in themed series, across an array of industries, for an array of customers, from individuals to organizations.

[30] Consequently, I am not satisfied that there was use of the Mark in Canada in association with the registered services within the meaning of sections 4(2) and 45 of the Act.

Evidence is Unclear as to Who is Using the Mark

[31] The Requesting Party submits that as paragraph 8 of Ms. Voldeng's affidavit states that the Mark "has been consistently used by Lisa Noelle Voldeng and Ultra-Agent Industries Inc. in Canada, the United States and internationally since August 18, 2008", it is not clear that any evidence of use in the affidavit enures to the Owner. In view of my findings above, it is unnecessary for me to make a finding on this issue.

DISPOSITION

[32] In view of all of the foregoing, 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.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Schedule A: Original Statement of Goods and Services

Goods:

(1) Video game console connectable to computer or television; portable video game machines for personal use; pre-recorded computer programs containing video game software; interactive computer, video and electronic game programs; pre-recorded optical discs, video discs, DVDs and magnetic cards containing video games; electronic circuits imprinted with game programs for video game machines; stereo speakers; stereo amplifiers; hard disc drives; memory devices, namely computer memory and flash memory cards and chips; computer cables; computer supportive stands; video game controllers and joysticks; headphones; rechargeable batteries for electronic devices, namely cameras, cellphones, MP3 players, computers, personal digital assistants, stereos and radios; battery chargers for electronic devices, namely cameras, cellphones, MP3 players, computers, personal digital assistants, stereos and radios; touch panels, namely video game touch consoles; pouches, cases and bags for carrying personal electronic devices, namely cameras, cell phones, MP3 players, computers, personal digital assistants, stereos and radios; hand straps and neck straps designed for use in association with video games.

(2) Audio and visual recorded materials, namely pre-recorded audio and visual DVDs, CDs, DVD ROMs, CD ROMs, records and tapes, containing motion pictures, animation, music, television programs, computer games and online web based entertainment applications, namely imbedded or non-imbedded computer video gaming and social networking software for personal computers, portable computers and game consoles.

(3) Books, novels, magazines and comic strips.

(4) Clothing, namely coats, pants, jeans, shorts, dresses, shirts, jackets, blazers, t-shirts, tank tops, halter tops, vests, blouses, golf shirts, sweatshirts, sweatpants, sweaters, sweatpants, overalls, pullovers, turtlenecks, jumpsuits, sport shirts, jogging suits, culottes, windbreakers, gaiters, swimwear, gloves, mittens, belts, scarves, socks, shawls, capes, hats, caps, headbands, toques, hair bands, underwear, sleepwear, nightgowns, pajamas, robes, shoes, tote bags and carrying bags, namely athletic bags, sport bags, luggage, school bags, travel bags and purses.

(5) Playthings and recreational articles, namely, tabletop parlour games, namely board games, card games, word games and puzzles, arcade games, playing cards, trading cards, toy animals, inflatable toys, squeeze toys, Halloween masks, costumes and make-up kits, sponge toys, sculpture toys, wind up toys, squeezable squeaking toys, two dimensional and three dimensional woodboard, cardboard and plastic puzzles, water squirting toys, plush toys, puppets, twirling and flying tops, punching balls, musical toys, noisemakers, whistles, magic sets, marbles, water toys, bubble toys, pull toys, bean bags, skateboards, in-line skates, rubber action balls, walkie-talkies, pinball games, costumes, computer software, namely computer games, video games and parts and accessories therefor, namely controllers, joysticks, mouse, mouse pads, remote control and game specific

controllers for playing video games, namely musical instruments, guns and weapons.

Services:

- (1) Entertainment services, namely the development, production, digital distribution, transmission and broadcast of motion pictures, animation, music and television shows; organizing and hosting of themed parties and celebrations; development, production, scheduling, advertising and conducting of live entertainment performances and personal appearances by movie stars, sports celebrities, pop stars, professional entertainers and musical bands; musical performances, dramatic performances and comedic performances by an actor or musical group; recording of live performances by vocal and instrumental groups; production of photographs, records, pre-recorded tapes, audio tapes, video tapes, video discs, DVDs, CDs, videos and cassettes containing motion picture, animation, music and television shows; production, promotion and digital distribution of songs and musical pieces of others; production and distribution of a game show; visual and audio programming via the media of computer, the Internet and mobile phone; online distribution, transmission and broadcast through computer networks and video services of information on general topics of interest and entertainment services; providing online reviews and information of movies, animation, music and computer games; providing information pertaining to show business and famous people, actors, musical groups and films.
- (2) Providing electronic media namely on-line computer games over the Internet; providing information to game players about the ranking of their scores on games through the websites; providing information about games by means of communications by computer terminals; games services provided by means of communications by computer terminals or mobile telephones; providing through the Internet customer support services for video games and for electronic publications; providing video game samples, news, hints and other video game information; operation of video game service and customer information centre, rental services for prerecorded optical and magnetic media containing video games.
- (3) Operation of a website providing access to an on-line chat room for the transmission of messages; providing access for an electronic bulletin board; electronic mail services and electronic newsletters.
- (4) Print, electronic and online publishing services of books, novels, magazines, music and comic strips.

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

HEARING DATE: 2022-03-04

APPEARANCES

No one appearing

For the Registered Owner

Kevin M. O'Brien

For the Requesting Party

AGENTS OF RECORD

No Agent Appointed

For the Registered Owner

MacRae & Co.

For the Requesting Party