



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 157

Date of decision: 2022-08-15

**[UNREVISED ENGLISH
CERTIFIED TRANSLATION]**

IN THE MATTER OF A SECTION 45 PROCEEDING

Nexus Law Group LLP

Requesting Party

and

Société des Loteries du Québec

Registered Owner

TMA892,106 for NÉON

Registration

[1] This is a decision concerning a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA892,106 for the trademark NÉON (the Mark).

[2] The Mark is registered in association with the following goods and services: “games of chance and money” and “management of games of chance and money”.

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

The Record

[4] On February 2, 2021, at the request of Nexus Law Group LLP (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the Act to the *Société des Loteries du Québec* (the Owner), the owner of the Mark. The notice required the Owner to show whether the Mark was 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, that the Owner specify the date when the Mark 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 from February 2, 2018, to February 2, 2021.

[5] The relevant definitions of “use” are set out in section 4 of the Act and read 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.

[6] In the absence of use as defined above, a trademark registration is liable to be expunged, unless the absence of use is due to special circumstances.

[7] In response to the Registrar’s notice, the Owner furnished the statutory declaration of Isabelle Beaudoin, declared on May 3, 2021, to which was attached Exhibit A.

[8] Only the Requesting Party submitted written representations. The parties did not request a hearing.

The Evidence of Record

[9] In her declaration, Ms. Beaudoin explains that she has been [translation] “Counsel, Corporate Secretariat Branch” for the Owner since 2004. According to Ms. Beaudoin, the Owner is a Crown corporation that is responsible, among other things, for conducting and managing lottery systems in Quebec.

[10] In paragraph 4 of her declaration, Ms. Beaudoin defines the “Goods” and “Services” and states the following:

[TRANSLATION]

[The Owner] markets and administers many games of chance and money, including the game bearing the [Mark] in association with the following goods and services:

“Games of chance and money”

“Management of games of chance and money”

(the “Goods” and “Services”).

[11] Ms. Beaudoin also states that [TRANSLATION] “the Mark was used in Quebec by [the Owner] in the normal course of trade in association with the aforementioned Goods and Services during the period from February 3, 2018, to February 3, 2021” [para 5].

[12] Ms. Beaudoin explains that the Goods are offered and sold by the Owner’s sales network, consisting of over 8,000 retailers in Quebec, such as convenience stores, grocery stores, pharmacies and the Owner’s sales kiosks in various commercial spaces [para 6].

[13] With respect to sales during the relevant period, Ms. Beaudoin states that about 2,040,000 Goods were sold in Quebec by the Owner’s various retailers [para 7]. In support, Ms. Beaudoin included with her declaration a copy of the front and back of a [TRANSLATION] “sample of Goods, namely a sample of a scratch ticket” that she describes as being [TRANSLATION] “representative of the Goods sold in Quebec during the relevant period” [para 7, Exhibit A]. The Mark is displayed on the front of the scratch ticket, followed by the French symbol for registered trademark, “MD”.

[14] Exhibit A also includes a copy of an email dated July 28, 2020, with the subject line [TRANSLATION] “New tickets to discover”. Ms. Beaudoin describes that document as a [TRANSLATION] “copy of the newsletter emailed to [the Owner]’s subscribers to promote the NÉON game in 2020” [para 7].

[15] The email in Exhibit A shows four scratch tickets. They have different names: *Casino rouge*, *Néon*, *777* and *Nain de jardin*. Under the image of the *Néon* ticket is the following promotional text: [TRANSLATION] “The *Néon* ticket will have you seeing all the colours! Find it (easily!) in the display case.”

[16] With respect to the registered services, Ms. Beaudoin states that the Owner [TRANSLATION] “manages games of chance and money displaying the Mark”. For example, she explains that the Owner [TRANSLATION] “meets regularly with retailers to support them in their sales activities, including the sale of the Goods displaying the Mark” [para 8].

[17] Ms. Beaudoin also explains that the Owner’s telesales team supplies retailers with Goods. According to Ms. Beaudoin, that team contacts retailers to take their orders for scratch tickets, including the Goods, and ensures that the orders suit their needs [para 9]. Ms. Beaudoin indicates that she attached as Exhibit B samples of advertising materials used by retailers for the sale of the Goods during the relevant period, but no such exhibit is attached to her declaration.

[18] Finally, Ms. Beaudoin explains that the Owner’s services [TRANSLATION] “also include a retailer assistance service, which is intended to inform retailers and answer their questions, among other things, about [the Owner’s] Goods and Services, as well as policies and procedures related to sales operations” [para 10].

Analysis and Reasons

[19] The Requesting Party submits that a scratch ticket and the management of scratch tickets do not correspond to the goods and services in the statement of goods and services, which, in its opinion, describes “much broader” goods and services, namely games of chance, gambling games, including casino games such as poker, blackjack, roulette and baccarat:

A lottery scratch ticket, and the administration of lottery scratch tickets, is insufficient to establish use of the trademark in association with the much broader statement of goods and services in the Registration, namely games of chance, gambling games, and the administration of games of chance, gambling games. Games of chance and gambling games are a much broader statement of goods and includes casino games such as poker, blackjack, roulette, baccarat, and the like.

[20] The Requesting Party further submits that, given the broad definition of “Goods” in paragraph 4 of Ms. Beaudoin’s declaration, the sales figure of 2,040,000 units sold does not necessarily correspond to sales of goods displaying the Mark. The Requesting Party therefore argues that the Owner did not provide direct evidence concerning the number of Goods displaying the Mark sold in Canada (“*There appears to be no direct evidence on the approximate number of NÉON branded Products sold in Canada*”, emphasis in the original).

[21] I note first that the use of a trademark in association with specific goods, when the registration refers to a more general description, is sufficient to conclude that the mark is used for the broader category, as described in the registration [see *Clopay Building Products Company, Inc. v Portes Patio Novatech Inc.*, 2017 TMOB 53, at para 16, which cites, among others, *Mantha & Associates v Le Cravatte di Pancaldi Srl*, 1998 CanLII 8752, 84 CPR (3d) 455 (FC)].

[22] Moreover, the definition provided in paragraph 4 of Ms. Beaudoin’s declaration is clear: Ms. Beaudoin defines the “Goods” as games of chance and money displaying the Mark. I therefore find that the sales figure provided by Ms. Beaudoin in paragraph 7 of her declaration is related to such Goods.

[23] Given that sales figure, and the [TRANSLATION] “sample of Goods” provided in Exhibit A, namely a scratch ticket displaying the Mark, I find that the Owner has demonstrated use of the Mark within the meaning of sections 4(1) and 45 of the Act in association with “games of chance and money”.

[24] Although it appears from the evidence that the Owner manages games of chance and money, I have no evidence to show that the Mark was used in association with those services.

[25] In this respect, I note that Ms. Beaudoin asserts use of the Mark in association with the Services and states that the Owner [translation] “manages games of chance and money displaying the Mark”. However, she does not provide any explanation of the display of the Mark in providing those services, or any examples of such use. Indeed, there is no clear evidence of the Mark being displayed in association with the provision or advertising of the Owner’s services.

[26] Moreover, it appears from the evidence that the Owner markets many games of chance and money that do not display the Mark, such as the *Casino rouge, 777* and *Nain de jardin* scratch tickets shown in the email in Exhibit A. I am therefore not prepared to conclude, either from the sale of scratch tickets displaying the Mark or from the display of the Mark in material advertising such goods, that the Mark was used in association with the Services. Indeed, it appears instead that the Mark is used in association with a type of scratch ticket, rather than in association with the management of games of chance and money.

[27] Without the benefit of representations by the Owner, I agree with the Requesting Party that the general statements of use by Ms. Beaudoin are not sufficient to establish use of the Mark in association with services [in accordance with *Plough (Canada) Ltd v Aerosol Fillers Inc*, 1980 CanLII 2739, 53 CPR (2d) 62 (FCA)].

[28] In light of the above, I find that the Owner has not demonstrated that the Mark has been used in Canada in association with the services “management of games of chance and money” within the meaning of sections 4(2) and 45 of the Act. As there are no special circumstances excusing the non-use of the Mark, the registration will be amended accordingly.

Decision

[29] 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: “management of games of chance and money”.

[30] The Mark will be registered in association with “games of chance and money”.

Eve Heafey
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Certified translation
Gerald Woodard

WCAG Compliant

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

HEARING DATE No hearing held

AGENTS OF RECORD

Lavery, De Billy, LLP

For the Registered Owner

Nexus Law Group LLP

For the Requesting Party