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

Citation: 2022 TMOB 196

Date of Decision: 2022-10-06

IN THE MATTER OF SECTION 45 PROCEEDINGS

BCF s.e.n.c.r.l./BCF LLP

Requesting Party

and

Nitro Circus IP Holdings LP, Limited

Registered Owner

Partnership Delaware

TMA877,589 for NITRO CIRCUS

Registrations

and TMA889,571 for NITRO

CIRCUS & DESIGN

INTRODUCTION

[1] This a decision involving summary expungement proceedings under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration Nos. TMA877,589 and TMA889,571 for the trademarks NITRO CIRCUS (the Word Mark) and NITRO CIRCUS & DESIGN shown below (the Design Mark; collectively, the Marks):



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

GOODS

(1) Downloadable films provided via video-on-demand, prerecorded digital video disks, prerecorded compact disks, pre-recorded CD's, video tapes, laser disks and DVD's all featuring action sports and events for on and off road car and truck racing, motorcross, supercross, racing, skydiving, cliff jumping, cliff diving, snowboarding, bmx, skateboarding, skiing, surfing, wakeboarding, and other sports.

(2) Clothing, namely, shirts, t-shirts, hooded sweatshirts, sweatshirts, jackets, beanies, caps, hats, and tanktops.

SERVICES

(1) Entertainment services, in the nature of organizing, performing and competing in action sporting events, namely, on and off road car and truck racing, motorcross, supercross, racing, skydiving, cliff jumping, cliff diving, snowboarding, bmx, skateboarding, skiing, surfing, wakeboarding competitions and events; film distribution and editing; motion picture film production; production of video disks.

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

GOODS

(1) Downloadable films provided via pre-recorded digital video disks and DVD's featuring action sports and events for on and off road car and truck racing, motocross, supercross, racing, skydiving, cliff jumping, cliff diving, snowboarding, bmx, skateboarding, skiing, surfing, wakeboarding, and other sports.

(2) Clothing, namely, shirts, t-shirts, hooded sweatshirts, sweatshirts, jackets, beanies, caps, hats, and tanktops.

(3) Downloadable films provided via video-on-demand, pre-recorded compact disks, pre-recorded CD's, video tapes, laser disks all featuring action sports and events for on and off road car and truck racing, motocross, supercross, racing, skydiving, cliff jumping, cliff diving, snowboarding, bmx, skateboarding, skiing, surfing, wakeboarding, and other sports.

SERVICES

(1) Entertainment services, namely, organizing, performing and competing in action sporting events, namely, on and off road car and truck racing, motocross, supercross, racing, skydiving, cliff jumping, cliff diving, snowboarding, bmx, skateboarding, skiing, surfing, wakeboarding competitions and events; film distribution and editing; motion picture film production; production of video disks.

[4] For the reasons that follow, I conclude that the registrations ought to be amended.

THE PROCEEDINGS

[5] At the request of BCF s.e.n.c.r.l./BCF LLP (the Requesting Party), the Registrar of Trademarks issued two notices to Nitro Circus IP Holdings LP, Limited Partnership Delaware (the Owner) pursuant to section 45 of the Act on May 14, 2020, with respect to the Word Mark, and May 19, 2020, with respect to the Design Mark.

[6] The notices required the Owner to show whether the Marks were used in Canada in association with each of the goods and services specified in the registrations at any time within the three-year period immediately preceding the dates of the notices and, if not, the date when the Marks were last in use and the reason for the absence of use since that date. In these cases, the relevant periods for showing use are May 14, 2017 to May 14, 2020, with respect to registration No. TMA877,589, and May 19, 2017 to May 19, 2020, with respect to registration No. TMA889,571 (collectively, the Relevant Periods).

[7] The relevant definition of use in these cases is 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.

[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 clearing the register of “deadwood”. The criteria for establishing use are not demanding and an overabundance of evidence is not necessary. Nevertheless, sufficient evidence must still be provided to allow the Registrar to conclude that the trademark was used in association with each of the registered goods and services [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270]. Furthermore, mere statements of use are insufficient to prove use [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 980 CanLII 2739 (FCA), 53 CPR (2d) 62 (FCA)].

[9] In response to both of the Registrar’s notices, the Owner furnished affidavits of Andrew James Edwards, sworn on December 11, 2020, to which were attached Exhibits “A” to “AF”. Upon my review of the evidence submitted by the Owner, I note that the affidavits in response to each notice are substantively identical, and that the slight date offset of the Relevant Periods is of no consequence for the purposes of these proceedings. Unless indicated otherwise, I will make no distinction between both affidavits of Mr. Edwards in my review of the evidence and will use the singular form to refer to them.

[10] Both parties submitted written representations and were represented at a hearing.

EVIDENCE SUMMARY

[11] In his affidavit, Mr. Edwards identifies himself as President, Asia Pacific for “Thrill One Sports & Entertainment (Thrill One)”. He states that the Owner is an affiliated corporation of the “Thrill One-group” [para 1].

[12] At paragraph 9 of his affidavit, Mr. Edwards states that:

Nitro Circus Live Touring USA, Inc. [Nitro Touring], Nitro Circus Licensing, Inc. [Nitro Licensing], Nitro Circus Media Holdings, Inc. [Nitro Media Holdings], and Nitro Circus Media Productions, Inc. [Nitro Media Productions] are entities within the Thrill One group who earn revenue through the sale of various goods and services, under license from [the Owner]. [The Owner] licenses other entities in the Thrill One Group, including [Nitro Touring], [Nitro Licensing], [Nitro Media Holdings], and [Nitro Media Productions], to use Nitro Circus’ trademarks, including [the Marks]. [The Owner] exercises direct and indirect control over the character and quality of all goods and services offered and sold by its licensees.

[13] Mr. Edwards explains that the Owner is “an ‘action sport collective’ led by world famous professional motorsports competitor and stunt performer Travis Pastrana”, and that it features performances, films, videos and shows of Mr. Pastrana and his friends traveling around the world and engaging in competitions and performances in the fields of extreme sports and stunts [para 8].

[14] With respect to the Owner’s normal course of trade, Mr. Edwards states that the Owner promotes and advertises its services through its website, *www.nitrocircus.com*, and sells goods to consumers directly through its online store, *www.shop.nitrocircus.com* [para 11]. He adds that

“[the Owner] and its licensees also sell its goods to retailers, and to re-sellers who sell and distribute Nitro Circus’ goods through online stores and related channels of trade” [para 11].

[15] Mr. Edwards attests that, in the normal course of trade and during the Relevant Periods, the Owner has used the Marks in association with the goods and services covered by registration Nos. TMA877,589 and TMA889,571 [para 7].

[16] In support, Mr. Edwards provides invoices issued during the Relevant Periods to customers located in Canada showing sales of four products identified as “Action Figures DVD” [Exhibit I], as well as clothing items identified as “Nitro Circus Core Outline Hat”, “Nitro Circus Core Hat”, “Classic Logo T-Shirt”, “Allied Beanie” or “Pennant Hoodie” [Exhibit U].

Mr. Edwards attests that the invoiced products at Exhibit I were sold by Nitro Media Holdings via the aforementioned Owner’s online store, and that the ones at Exhibit U were sold by Nitro Licensing via same online store [paras 13 and 26]. I note that these invoices were in fact generated from the Owner’s online store. Mr. Edwards further attests that the Exhibit I invoices are “representative examples of invoices showing sales of pre-recorded digital video disks, DVD’s, and laser disks (namely, Blu-ray high density optical discs)” in Canada during the Relevant Periods [para 16], and that the Exhibit U invoices are representative examples of invoices for the sale of shirts, t-shirts, tanktops, hooded sweatshirts, sweatshirts, jackets, beanies, caps and hats in Canada during the Relevant Periods [paras 27 and 30].

[17] In addition to the invoices, Mr. Edwards provides copies of “redacted revenue statements” which he attests show “sales and transactions for downloadable films bearing [the Marks], provided via video-on-demand to Netflix, during [the Relevant Periods]” [Exhibit O; para 25]. As further discussed below, I note that these redacted revenue statements make no mention or reference to Netflix.

[18] As for display of the Marks, Mr. Edwards attaches photographs described as “representative photographs showing copies of pre-recorded digital video disks, DVD’s, and laser disks (namely, Blu-ray high density optical discs)” that are identical to those sold in Canada during the Relevant Periods [Exhibits B through F; para 12], as well as photographs of clothing items which he describes as representative of shirts, t-shirts, tanktops, hooded sweatshirts, sweatshirts, jackets, beanies, caps, and hats [Exhibits P through S; para 27]. Upon my review of

these photographs, I note that Exhibits B through F display the Design Mark in association with products identified as “Blu-ray Disc” and “DVD”. I also note that the back cover of one of the depicted DVDs notably displays the following description: “*Action Figures 2 is the sequel to Travis Pastrana’s hit action-sports movie, Action Figures*” [Exhibit F]. With regard to the depicted clothing items at Exhibits P through S, I note that they generally display either the Word Mark or the Design Mark. As the words NITRO CIRCUS clearly stand out from the design element made of a stylized design of a bomb or explosive, I note at this point of my analysis that I find that any use of the Design Mark in the present case amounts to use of the Word Mark [see, by analogy, the decisions *Lion Global Investors Ltd v Lion Capital LLP*, 2012 TMOB 252 at para 17 and *Alpina Salami Inc v Alpina Productos Alimenticios SA*, 2011 TMOB 57 at para 16 for the principle that use of a word mark can be supported by the use of a composite design mark featuring the word mark and other elements]. Therefore, unless indicated otherwise, any finding of use of the Design Mark in the present cases would also amount to a finding of use of the Word Mark.

[19] In addition to the photographs, Mr. Edwards also attaches several screenshots showing “athletes and stunt performers engaged on and off road car and truck racing, motorcross, supercross, racing, skydiving, cliff jumping, cliff diving, snowboarding, BMX, skateboarding, skiing, surfing, wakeboarding, and other sports” [Exhibit N; para 23]. Mr. Edwards attests that these screenshots were “taken from the films *Nitro Circus: The Movie*, *Nitro Circus: Action Figures 2*, *Travis Pastrana’s Action Figures*, *Never Say Cant’t: The Bruce Cook Story*, *Pikes Peak – Bilko’s Revenge*, *Two-Stroke Week – Dirtbikes*, *Jetskis and Tubing* and *Detour: Adrenaline Junkies Get Wet & Dirty*” [para 23]. I note that Mr. Edwards attaches these screenshots in support of use of the Marks in association with “Downloadable films provided via video-on-demand featuring action sports and events”, and further note that he provides no indication as to when or where the eight films attached as Exhibit N were released.

[20] In regard to “Entertainment services”, Mr. Edwards explains that “[s]ince at least 2014, [Nitro Touring] has provided entertainment services in the nature of organizing, performing and competing in action sporting events and competitions in venues across Canada” [para 31]. In support, he provides printouts of media stories for a Canadian audience as well as screenshots from the Internet Archive at www.archive.org showing archived versions of the Owner’s

webpage from February 27, 2019, all promoting action sporting events to be held in Canada as part of the “Nitro Circus Live’s 2017 North American Tour” and the “North America You Got This 2018” tour [Exhibits V and W]. Mr. Edwards then confirms that action sporting events and competitions actually occurred in Canada during the Relevant Periods, and provides a list showing the date, venue and attendance relating to these action sporting events including, for example, the action sporting events at the Bell Centre, the AB Rogers Place or the Scotiabank Arena [para 32]. I note that both the “Nitro Circus Live’s 2017 North American Tour” and the “North America You Got This 2018” tour are referenced in the exhibited printouts and screenshots as set to feature the best athletes in FMX, BMX, scooter and inline. The Design Mark is visible throughout the exhibited printouts and screenshots.

[21] As for the services “film distribution and editing” and “motion picture film production”, Mr. Edwards states that “[the Owner’s licensees Nitro Media Holdings, and Nitro Media Productions] have also provided film production, distribution and editing services for others, within Canada” in the normal course of trade, and during the Relevant Periods [para 45]. In support, he provides screenshots displaying the Design Mark taken from videos posted during the Relevant Periods to the Rogers Place’s website and YouTube channel, and to the Scotiabank Arena’s Facebook page [Exhibits AE and AF]. Mr. Edwards attests that these videos were created, produced and edited by Nitro Media Productions for distribution by Nitro Media Holdings [paras 46 and 47].

ANALYSIS AND REASONS FOR DECISION

[22] In its representations, the Requesting Party raises two main issues: first, that any use of the Marks cannot be deemed use by the Owner under section 50 of the Act because there exists no valid licence; and second, the evidence is insufficient to demonstrate use of the Marks in association with all of the registered goods and services.

Use of the Marks that enures to the Owner’s benefit

[23] The Requesting Party alleges that paragraph 9 of Mr. Edwards’ affidavit (reproduced above) is ambiguous as to which trademarks, as well as which goods and services are dealt with in the so-alleged licence, including whether the requisite control was exerted in Canada and

during the Relevant Periods [Requesting Party written representations at paras 9 through 15]. According to the Requesting Party, one cannot conclude in the present cases that there exists a valid licence between the Owner and its licensees, and therefore, any use of the Marks by such licensees cannot be considered use by the Owner under section 50 of the Act. I disagree.

[24] As the Owner correctly noted at the hearing, for use of a trademark by a licensee to be deemed use by a trademark owner, all that is required is the demonstration of the requisite control. In this regard, the Federal Court has held that there are three main methods by which a trademark owner can demonstrate the requisite control pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of the license agreement that provides for the requisite control [*Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102 at para 84].

[25] In these cases, considering the sworn statements of Mr. Edwards at paragraph 9 of his affidavit in conjunction with the evidence as whole, there are more than sufficient details to allow me to conclude that the Owner exerted the requisite control during the Relevant Periods over the use of the Marks by its licensees Nitro Touring, Nitro Licensing, Nitro Media Holdings and Nitro Media Productions in association with the registered goods and services.

[26] Therefore, I am satisfied that any evidenced use of the Marks by any of the above-mentioned licensees enures to the Owner's benefit pursuant to section 50(1) of the Act.

Use of the Marks in association with each of the Registered Goods and Services

The Registered Goods

[27] Aside from the alleged licensing issue, at paragraph 59 of its written representations and at the hearing, the Requesting Party essentially conceded that use of the Word Mark has been demonstrated with respect to "t-shirts" and "caps".

[28] Indeed, there is clear evidence that "t-shirts" were sold in Canada during the Relevant Periods and that such goods displayed the Word Mark at the time of their transfer. The Requesting Party submits that one cannot conclude from Mr. Edwards' statements regarding

sales of t-shirts whether such sales included t-shirts bearing the Design Mark [Requesting Party written representations at para 37]. However, as indicated above, there is evidence that “t-shirts” sold in Canada during the Relevant Periods also displayed the Design Mark. As such, I am satisfied that the Owner has demonstrated use of both the Word Mark and the Design the Mark within the meaning of sections 4 and 45 of the Act in association with the registered goods “t-shirts”.

[29] With respect to the registered goods “caps” and “hats”, I note that the Owner relies on the Exhibit U invoices referencing the “Nitro Circus Core Outline Hat” and the “Nitro Circus Core Hat” products and displaying images of such invoiced products. The Owner also relies on the Exhibit S photographs depicting two products, which Mr. Edwards attests are “[r]epresentative photographs of beanies, caps, and hats” [para 27].

[30] The Requesting Party argues that none of the evidenced products at Exhibits U and S relate to “hats”, but rather to “caps” only [Requesting Party written representations at paras 44 and 46].

[31] Considering that the term “hat” is featured in the product name of “Nitro Circus Core Outline Hat” or “Nitro Circus Core Hat”, I find that it is appropriate to accept that the invoiced products correspond to “hats” in the present cases. Having regard to the images for such invoiced products as shown on the Exhibit U invoices, I also find that it is appropriate to accept that these invoiced products correspond to the depicted product displaying the Design Mark at Exhibit S. Accordingly, I am satisfied that the Owner has demonstrated use of the Marks within the meaning of sections 4 and 45 of the Act in association with the registered goods “hats”.

[32] Turning to the registered goods “caps”, I note that, in the *Canadian Oxford Dictionary*, 2nd Ed., the word “hat” is defined as “*noun* 1. a covering for the head, often with a brim and worn out of doors”, and the word “cap” as “*noun* 1. a close-fitting brimless head covering, often of a soft material and usu. with a visor: baseball cap”. Based on these dictionary definitions, it appears that both categories of products would generally feature a visor or a brim as shown in the representative images for the invoiced products as well as in the Exhibit S photographs. Bearing in mind that, in a section 45 proceeding, “one is not to be astutely meticulous when dealing with language used in a statement of wares” [see *Aird & Berlis LLP v*

Levi Strauss & Co, 2006 FC 654, 51 CPR (4th) 434 at para 17; see also *Jeanne Lanvin (une société anonyme) v Ascendia Brands (Canada) Ltd*, 2010 TMOB 58, 2010 CarswellNat 1953], I accept that the evidenced products also correspond to “caps” for the purposes of this analysis [see, by analogy, the decision *Osler, Hoskin & Harcourt LLP v Esprit International*, 2018 TMOB 9 where the Registrar maintained a registration for “hats and caps” on the basis of sales of “hats”]. Accordingly, I am satisfied that the Owner has demonstrated use of the Marks within the meaning of sections 4 and 45 of the Act in association with the registered goods “caps”.

[33] With respect to the remaining registered goods, the Requesting Party submits that Mr. Edwards’ affidavit does not show use of either of the Marks in association with these goods.

[34] Except for the goods “Downloadable films provided via DVD’s” and “hooded sweatshirts”, I generally concur with the Requesting Party for the following reasons.

[35] With respect to the registered goods “Downloadable films provided via prerecorded digital video disks”, “Downloadable films provided via pre-recorded compact disks”, “Downloadable films provided via pre-recorded CD’s”, “Downloadable films provided via video tapes”, “Downloadable films provided via laser disks”, “shirts”, “sweatshirts”, “jackets” and “tanktops”, I note that, although Mr. Edwards asserts use of the Marks in association with these goods, there is no evidence that such goods were transferred in the normal course of trade in Canada during the Relevant Periods.

[36] With respect to the registered goods “Downloadable films provided via video-on-demand”, I note that Mr. Edwards has attested that the redacted revenue statements attached as Exhibit O show sales and transactions for downloadable films provided via video-on-demand to Netflix during the Relevant Periods. However, while I am mindful that all information relating to the quantity and price of movie purchase, movie rental and movie streaming for the films “Action Figures 2” and “Action Figures: Nitro Circus” may have been blacked out for confidential purposes, I do not see any mention or reference whatsoever to Netflix on the exhibited revenue statements. In the absence of any clarification on this point, I am resolving this ambiguity against the interests of the Owner [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D)].

[37] With respect to the registered goods “beanies”, although I accept that, based on the plain meaning of the words, one would reasonably infer that the invoiced product “Allied Beanie” corresponds to the registered goods “beanies”, there is no evidence in the present cases that such beanie displayed the Marks at the time of transfer or any other time.

[38] With respect to the registered goods “Downloadable films provided via DVD's”, the Requesting Party submits that, although the Exhibit I invoices show sales of “Action Figures DVD” in Canada during the Relevant Periods, there is no photographs at Exhibits B through F demonstrating how the Marks appeared on such DVD during the Relevant Periods [Requesting Party written representations at para 28].

[39] However, based on Mr. Edwards' assertions that the photographs at Exhibits B through F are representative of the manner in which the Marks were displayed on DVDs sold in Canada during the Relevant Periods, and considering that the depicted Action Figures 2 DVD displaying the Design Mark at Exhibit F is the sequel to the invoiced Action Figures DVD, I am prepared to accept that the evidenced display at Exhibit F is representative of the manner in which the Marks appeared on the “Action Figures DVD” sold in Canada during the Relevant Periods. Accordingly, I am satisfied that the Owner has demonstrated use of the Marks within the meaning of sections 4 and 45 of the Act in association with the registered goods “Downloadable films provided via DVD's”.

[40] With respect to the registered goods “hooded sweatshirts”, the Requesting Party submits that, although the evidence demonstrates how the Word Mark was displayed on these goods, there is no evidence of transfers of such goods [Requesting Party written representations at para 40].

[41] However, I note that, in the *Canadian Oxford Dictionary*, 2nd Ed., the word “hoodie” is defined as “*noun informal* a hooded sweatshirt”, and the word “hooded sweatshirt” as “*noun* a sweatshirt with a hood, often with a front pouch”. Based on these dictionary definitions, I accept that the invoiced product identified as “Pennant Hoodie” corresponds to the registered goods “hooded sweatshirts”. Considering Mr. Edwards' assertions that the two photographs at Exhibit Q are “[r]epresentative photographs of hooded sweatshirts and sweatshirts”, I also accept that the first photograph at Exhibit Q depicts a hooded sweatshirt, and not a sweatshirt as argued by the

Requesting Party. As the depicted hooded sweatshirt at Exhibit Q displays the Design Mark, I am therefore satisfied that the Owner has demonstrated use of the Marks within the meaning of sections 4 and 45 of the Act in association with the registered goods “hooded sweatshirts”.

[42] In summary, in view of the above, I am satisfied that the Owner has demonstrated use of the Marks within the meaning of sections 4 and 45 of the Act in association with the following registered goods only: “Downloadable films provided via DVD's featuring action sports and events for on and off road car and truck racing, motorcross, supercross, racing, skydiving, cliff jumping, cliff diving, snowboarding, bmx, skateboarding, skiing, surfing, wakeboarding, and other sport” from goods (1) and “Clothing, namely, t-shirts, hooded sweatshirts, caps and hats” from goods (2). With respect to all of the remaining registered goods, as there is no evidence of special circumstances excusing non-use, these goods will be deleted from the registrations.

The Registered Services

[43] At paragraph 59 of its written representations and at the hearing, the Requesting Party essentially conceded that use of the Marks has been demonstrated with respect to “Entertainment services, namely, performing in action sporting events, namely, motocross, bmx”. Otherwise, it submits that the evidence does not show use of either of the Marks in association with the remaining registered services. I partly disagree with the Requesting Party for the following reasons.

[44] With respect to the registered services “Entertainment services [...]”, I find that the Owner not only performed action sporting events in the form of motocross and bmx but also organized and competed in action sporting events featuring these two action sports in association with the Marks. As indicated in the evidence summary, printouts of media stories and screenshots from the Owner’s webpage indicate that the action sporting events held in Canada were provided by the Owner’s licensee Nitro Circus Touring, and were set to feature athletes in FMX, BMX, scooter and inline including the lead of the Owner’s action sport collective, Mr. Travis Pastrana. In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Marks within the meaning of sections 4 and 45 of the Act in association with “Entertainment services, in the nature of organizing, performing and competing in action sporting events, namely, motorcross, and bmx”.

[45] As for the remaining action sports, namely “on and off road car and truck racing”, “supercross”, “racing”, “skydiving”, “cliff jumping”, “cliff diving”, “snowboarding”, “skateboarding” “skiing”, “surfing” and “wakeboarding”, I note that Mr. Edwards refers to these sports at paragraph 23 of his affidavit, and provides as Exhibit N, screenshots taken from eight films showing athletes and stunt performers engaged on such sports. However, as indicated in the evidence summary, this is in support of use of the Marks in association with “Downloadable films provided via video-on-demand featuring action sports and events for on and off road car and truck racing, motocross, supercross, racing, skydiving, cliff jumping, cliff diving, snowboarding, bmx, skateboarding, skiing, surfing, wakeboarding, and other sports”. As also indicated in the evidence summary, the affidavit is silent as to when and where the exhibited films at Exhibit N were released. Therefore, although not explicitly argued by the Owner, I do not consider the Exhibits N screenshots to constitute a satisfactory evidence of use of the Marks in Canada during the Relevant Periods in association with any of the entertainment services, including the remaining action sports.

[46] With respect to the registered services “film distribution and editing” and “motion picture film production”, the Requesting Party submits that the evidenced services are only for the benefit of the Owner’s business rather than for the benefit of the public, and therefore cannot be considered use within the meaning of section 4(2) of the Act [citing *Ralston Purina Co v Effem Foods Ltd* (1997), 81 CPR (3d) 528 (TMOB); Requesting Party written representations at paras 52 and 53].

[47] However, the evidence shows that third parties operating the Rogers Place and the Scotiabank Arena posted videos created, edited, produced and distributed by the Owner’s licensees to their website, YouTube channel or Facebook page to promote their entertainment venues. As such, I agree with the Owner that these third parties have benefited from the Owner’s “motion picture film production” and “film distribution and editing” services. Accordingly, I am satisfied that the Owner has demonstrated use of the Marks within the meaning of sections 4 and 45 of the Act in association with these services.

[48] Finally, with respect to the registered service “production of video disks”, the Owner has provided no evidence whatsoever relating to such service.

[49] In summary, in view of the above, I am satisfied that the Owner has demonstrated use of the Marks within the meaning of sections 4 and 45 of the Act in association with all of the registered services, except “production of video disks”. As there is no evidence of special circumstances excusing non-use, this service will be deleted from the registrations.

DISPOSITION

[50] 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 for the Word Mark will be amended to delete the following registered goods and services:

GOODS

- (1) ... video-on-demand, prerecorded digital video disks, prerecorded compact disks, pre-recorded CD's, video tapes, laser disks ...
- (2) ..., shirts, ..., ..., sweatshirts, jackets, beanies, ..., ..., and tanktops.

SERVICES

- (1) ... on and off road car and truck racing, ..., supercross, racing, skydiving, cliff jumping, cliff diving, snowboarding, ..., skateboarding, skiing, surfing, wakeboarding ...; ...; ...; production of video disks.

[51] The amended statement of goods and services for the Mark will be as follows:

GOODS

- (1) Downloadable films provided via DVD's featuring action sports and events for on and off road car and truck racing, motorcross, supercross, racing, skydiving, cliff jumping, cliff diving, snowboarding, bmx, skiing, surfing, wakeboarding, and other sports
- (2) Clothing, namely, t-shirts, hooded sweatshirts, caps and hats.

SERVICES

- (1) Entertainment services, in the nature of organizing, performing and competing in action sporting events, namely, motorcross and bmx competitions and events; film distribution and editing; motion picture film production.

[52] Similarly, 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 for the Design Mark will be amended to delete the following registered goods and services :

GOODS

- (1) ... pre-recorded digital video disks ...
- (2) ..., shirts, ..., ..., sweatshirts, jackets, beanies, ..., ..., and tanktops.
- (3) Downloadable films provided via video-on-demand, pre-recorded compact disks, pre-recorded CD's, video tapes, laser disks all featuring action sports and events for on and off road car and truck racing, motocross, supercross, racing, skydiving, cliff jumping, cliff diving, snowboarding, bmx, skateboarding, skiing, surfing, wakeboarding, and other sports.

SERVICES

- (1) ... on and off road car and truck racing, ..., supercross, racing, skydiving, cliff jumping, cliff diving, snowboarding, ..., skateboarding, skiing, surfing, wakeboarding ...; ...; ...; production of video disks.

[53] The amended statement of goods and services for the Design Mark will be as follows:

GOODS

- (1) Downloadable films provided via DVD's featuring action sports and events for on and off road car and truck racing, motocross, supercross, racing, skydiving, cliff jumping, cliff diving, snowboarding, bmx, skateboarding, skiing, surfing, wakeboarding, and other sports.
- (2) Clothing, namely, t-shirts, hooded sweatshirts, caps and hats.

SERVICES

- (1) Entertainment services, in the nature of organizing, performing and competing in action sporting events, namely, motorcross and bmx competitions and events; film distribution and editing; motion picture film production.

Yves Cozien Papa Tchoufou
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: 2022-06-07

APPEARANCES

Nelson Godfrey	For the Registered Owner
Pascal Lauzon	For the Requesting Party

AGENTS OF RECORD

Gowling WLG (Canada) LLP	For the Registered Owner
BCF s.e.n.c.r.l./BCF LLP	For the Requesting Party