



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 066

Date of Decision: 2023-04-05

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Starlight Distributors Inc.

Registered Owner: HRC Canada Inc.

Registration: TMA857,301 for ROCK SHOP

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. TMA857,301 for the trademark ROCK SHOP (the Mark) registered for use in association with: “Retail store services featuring apparel, headgear, collectible pins, games, jewellery and watches, glassware and mugs, dolls, teddy bears, duffle bags, keychains, drumsticks and lighters” (the Services).

[2] For the reasons that follow, I conclude that the registration ought to be maintained.

THE PROCEEDING

[3] At the request of Starlight Distributors Inc. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on November 5, 2020 to the registered owner of the Mark, HRC Canada Inc. (the Owner).

[4] The notice required the Owner to show whether the Mark was used in Canada in association with the Services 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 5, 2017 to November 5, 2020 (the Relevant Period). In the absence of use, the registration is liable to be expunged, unless the absence of use is due to special circumstances.

[5] The relevant definition of use in the present case is set out in section 4(2) of the Act as follows:

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] 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. The evidence need not be perfect; the Owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[7] In response to the Registrar's notice, the Owner furnished the Affidavit of John Eder sworn on October 19, 2021, together with Exhibits A to P.

[8] Only the Owner submitted written representations and attended a hearing.

THE EVIDENCE

[9] Mr. Eder is the Chief Financial Officer and Executive Vice President of Hard Rock Cafe International (USA), Inc., part of the Hard Rock Group (HRG) which includes

the Owner. He is responsible for the trademarks and trade names of HRG, including the Mark.

[10] Mr. Eder states that HRG owns and operates HARD ROCK restaurants, hotels, casinos, live performance venues and ROCK SHOP retail stores in over sixty-five countries. The ROCK SHOP retail stores, which are located in HARD ROCK cafes, hotels and casinos, sell “authentic rock and roll inspired merchandise”.

[11] Mr. Eder states that, throughout the Relevant Period, Music Legends Limited (Music Legends) was licensed to use the Mark in Canada in connection with the Services and that the Owner had direct or indirect control of the character and quality of the Services in association with which Music Legends used the Mark.

[12] Mr. Eder states that Music Legends advertised, promoted and performed the Services in Canada throughout the Relevant Period. In particular, Music Legends operated a ROCK SHOP store located at the HARD ROCK cafe in Niagara Falls, Ontario where the Services were performed throughout the Relevant Period.

[13] As Exhibit B, Mr. Eder provides a screenshot from *hardrockcafe.com* which promotes the HARD ROCK cafe in Niagara Falls and which lists the ROCK SHOP store hours of operation. Mr. Eder states that the screenshot is representative of how the website appeared during the Relevant Period.

[14] As Exhibit C, Mr. Eder provides a screen shot of a November 2, 2020 post from the Music Legends Facebook page for the Niagara Falls location which states “ROCK SHOP Open” and refers to “signature t-shirts, pins, souvenirs, and special merchandise collections”.

[15] As Exhibits D to P, Mr. Eder provides copies of screenshots of various posts from the Music Legends Facebook page for the Niagara Falls location, all but one of which fall within the Relevant Period. One post shows the Mark displayed on the exterior of the store. The other posts show the interior of the store and the variety of items for sale including apparel, glassware, collectible pins, keychains, headgear, drumsticks, teddy

bears, games, dolls, bags. Mr. Eder states that the screenshots are representative of how the Music Legends Facebook page appeared during the Relevant Period.

ANALYSIS AND REASONS FOR DECISION

[16] As noted above, Mr. Eder states that Music Legends advertised, promoted and performed the Services in Canada during the Relevant Period from its store located in Niagara Falls. In support of his statement, he provides representative posts from the Music Legends Facebook page which show the display of the Mark on the exterior of the store and the variety of items available in the store. While the posts show some but not all of the items listed in the registration, I am satisfied, based on the evidence as a whole, that the Services were advertised and performed in association with the Mark in Canada during the Relevant Period.

[17] To the extent that the Mark was displayed in the performance and advertising of the Services by Music Legends, Mr. Eder states the Music Legends was licensed to use the Mark and that the Owner had direct or indirect control of the character and quality of the Services offered in association with the Mark. I am satisfied that the use of the Mark by Music Legends enures to the Owner's benefit pursuant to section 50 of the Act.

[18] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with the Services during the Relevant Period within the meaning of sections 4(2) and 45 of the Act.

DISPOSITION

[19] 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 maintained.

Robert A. MacDonald
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-03-28

APPEARANCES

For the Requesting Party: No one appearing

For the Registered Owner: Mark Evans

AGENTS OF RECORD

For the Requesting Party: Mark W. Timmis

For the Registered Owner: Smart & Biggar LP