



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2013 TMOB 20
Date of Decision: 2013-02-07

**IN THE MATTER OF A SECTION 45
PROCEEDING requested by Coastal Trademark
Services against registration No. TMA599,670 for
the trade-mark BOAT DESIGN in the name of
Victoria Harbour Ferry Co. Ltd.**

[1] At the request of Coastal Trademark Services (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on January 18, 2011 to Victoria Harbour Ferry Co. Ltd. (the Registrant), the registered owner of registration No. TMA599,670 for the following trade-mark (the Mark):



[2] The Mark is registered for use in association with “*Transportation of passengers by boat; operation of tour services namely arranging and conducting tours; the provision of tourist information services*” (the Services).

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares 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 use since that date. In this case, the relevant period for showing use is between January 18, 2008 and January 18, 2011 (the Relevant Period).

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

4(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[5] 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. It is settled law that evidentiary overkill is not required in order to properly reply to a section 45 notice [*Union Electric Supply Co Ltd v Registrar of Trade-marks* (1982), 63 CPR (2d) 56 (FCTD)]. The burden that has to be met by a registrant under section 45 is not a heavy one. All the registrant has to do is establish a *prima facie* case of use [*Cinnabon, Inc v Yoo-Hoo of Florida Corp* (1998), 82 CPR (3d) 513 (FCA)]. However, sufficient facts must be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with the registered wares and services during the relevant period.

[6] In response to the Registrar’s notice, the Registrant furnished the affidavit of Barry D. Hobbis, sworn April 4, 2011. Both parties filed written representations and attended an oral hearing.

[7] As a preliminary matter, I note that on October 17, 2011, the Registrant requested leave to file additional evidence in the form of an additional affidavit of Barry D. Hobbis. By letter dated November 9, 2011, the Registrant was informed by the Registrar that

there is no provision in the Act or *Trade-marks Regulations* for the granting of leave to file additional evidence in section 45 proceedings, that the deadline for filing evidence had expired, and that the Requesting Party had already filed written arguments. For these reasons, the Registrant was advised that the additional evidence would not be made of record. Accordingly, I have disregarded those portions of the Registrant's submissions wherein the Registrant refers to this additional evidence.

[8] I note further, that in their written representations, both the Requesting Party and the Registrant make further reference to facts not in evidence. These submissions will also be disregarded [*Ridout & Maybee LLP v Encore Marketing International, Inc* (2009), 72 CPR (4th) 204 (TMOB)].

[9] In the affidavit that is of record, Mr. Hobbis identifies himself as the Vice President, Operations of the Registrant, having held this position since April 2004.

[10] Mr. Hobbis explains that the Registrant has been operating for over 20 years in the ferry business and provides boat transportation for passengers, tours and tourist information. He further states that the Registrant owns and operates a fleet of 14 boats, and is now a well-established tourist attraction, having transported over 2.5 million passengers over the ten years preceding the swearing of his affidavit.

[11] With respect to the Mark, Mr. Hobbis asserts that the Registrant has used the Mark in Canada during the Relevant Period in association with the Services. He states that the Mark is a distinguishing feature of the Registrant's business and is used on its annual operating plans, brochures (containing route maps), schedules, tickets, ticket vouchers and signage. In support, he provides Exhibits A through F.

[12] Exhibit A consists of a copy of the first page of the Registrant's 2008 operating plan. Mr. Hobbis explains that the Registrant is required to submit an operating plan to the Cities of Victoria and Nanaimo. Although the Mark does appear on this document, I agree with the Requesting Party's submissions that this document does not show use of the Mark in the performance or advertising of the Services. The operating plan is not an advertisement for the Services, and the Registrant has not explained how this document

would constitute use of the Mark in the performance of the services. I find this situation to be similar to the situation in *Gowling Lafleur Henderson LLP v Guardian Capital Group Ltd* (2007), 65 CPR (4th) 105 (TMOB), where it was held that the Annual Information Forms bearing the trade-mark filed with various security regulatory authorities did not support use or display of the trade-mark in the advertising or performance of the registered services.

[13] At the oral hearing, the Registrant clarified that this exhibit was not being relied upon to show use of the Mark in the performance or advertising of the Services, but rather was corroborative evidence that the Services were provided during the Relevant Period. To an extent, I agree. To explain, I note that the first page of the operating plan submitted as Exhibit A has mostly been redacted. What is left on the page is the header, which contains the Mark, the Registrant's name, text indicating that the document is the 2008 annual operating plan for Victoria/Nanaimo, as well as text implying that the Registrant operates a ferry business. Consequently, insofar as the Services are concerned, I find it reasonable to accept that this document corroborates that the Registrant provided the services "*transportation of passengers by boat*", at some point during the Relevant Period. The document does not refer to the remaining registered services and thus cannot be used to corroborate statements regarding use of the Mark in association with the other registered services.

[14] The remaining exhibits, all of which I note clearly display the Mark and appear to cover all of the Services, consist of the following:

Exhibit B: a brochure printed and distributed by the Registrant advertising the Registrant's ferry routes on a route map which also advertises the locations of other tourist attractions.

Exhibit C: a schedule of the Registrant's ferry services, ferry routes, route costs and tour costs printed and distributed by the Registrant.

Exhibit D: a copy of the tickets printed and provided for the Registrant's ferry and tour services.

Exhibit E: a copy of the ticket vouchers printed and provided for the Registrant's ferry and tour services.

Exhibit F: a depiction of the Registrant's signage, which Mr. Hobbis states is placed at the Registrant's ferry and tour locations.

[15] The Requesting Party argues that as these exhibits are undated, it is ambiguous as to whether the Mark was used during the Relevant Period, an ambiguity that should be held against the registered owner. In support, the Requesting Party refers to *Mendelsohn Rosentzweig Shacter v Parmalat Dairy & Bakery Inc* (2004), 40 CPR (4th) 443 (TMOB) and *Blake, Cassels & Graydon LLP v Canadian Western Bank* (2011), 98 CPR (4th) 127 (TMOB), as examples wherein undated materials have been treated negatively.

[16] I note however, that each case is to be determined on its own facts. In *Mendelsohn, supra*, the Hearing Officer determined on a fair reading of the evidence as a whole, including statements made by the affiant or the lack thereof, that no inference could be drawn with respect to associating a specific date with the disputed evidence. Similarly, in *Canadian Western Bank, supra*, the affiant provided no evidence to establish or to allow one to infer such a date of use regarding a sample advertisement.

[17] In the present case, however, Mr. Hobbis qualifies the exhibits put forth in his affidavit by stating in the paragraph immediately following his description of the exhibits, that "the Trade-mark has therefore been used in its registered form during the three years immediately prior to the commencement of the s. 45 proceeding in association with the services set out in the application for registration of the Trade-mark,...". I find it reasonable to conclude that Mr. Hobbis' use of the word "therefore" in this statement regarding the exhibits, allows the inference to be drawn that these exhibits pertain to evidence which is representative of that which was used during the Relevant Period.

[18] Furthermore, following Mr. Hobbis' initial sworn statement regarding use of the Mark in Canada during the Relevant Period, when referring to such use he uses the word "specifically" when introducing the exhibited examples of use. I find this to be a further qualification that the evidence relates to the Relevant Period.

[19] In conclusion, having regard to the evidence as a whole and bearing in mind the purpose of section 45 of the Act, I accept that the Registrant has shown use of the Mark in association with the Services, during the Relevant Period, pursuant to sections 4(2) and 45 of the Act.

Disposition

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

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office