TRADUCTION/TRANSLATION

SECTION 45 PROCEEDINGS
TRADE-MARK: OASIS PYRAMIDALE & dessin
REGISTRATION NO: TMA 462,010

On August 31, 2004, at the request of Pouliot Mercure, whose name following a merger was changed to Miller Thomson Pouliot (the "requesting party"), the Registrar issued the notice prescribed by s. 45 of the *Trade-marks Act,* R.S.C. 1985, c. T-13 (the "Act") to Oasis Pyramidale Inc., the registered owner of registration No. TMA 462,010 for the following trade-mark (the "Mark"):

The Mark is registered for use in association with "Services d'éducation et de divertissement, nommément cours de massage, de yoga, de danse, de relaxation, de musique, d'arts martiaux et de méditation, exploitation d'une librairie; services d'exploitation d'un centre d'éducation physique et de loisir ainsi que de location de locaux devant être utilisés à des fins d'éducation physique; services de restaurant, de bar, de discothèque et d'hôtellerie; services de communication, nommément la production de vidéogrammes et de publications périodiques".

[TRANSLATION] « Educational and entertainment services, namely massage, yoga, dance, relaxation, music, martial arts and meditation courses, operation of a bookstore; operation of a physical education and recreation centre as well as the rental of premises to be used for the purposes of physical education; restaurant, bar, discotheque and hotel services; communication services, namely the production of videographs and periodical publications ».

Section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, 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/or services listed on 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 any time between August 31, 2001 and August 31, 2004.

"Use" in association with services is set out in subsection 4(2) of the *Trade-marks Act*:

> (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.

In response to the Registrar's notice, the registered owner furnished the sworn declaration of Georges Cardinal, president, administrator and majority stakeholder of Oasis Pyramidale Inc. Subsequently the supplementary sworn declaration of Alexandra Bélec, lawyer with Goudreau Gage Dubuc (the firm representing the registered owner), was filed. Both the requesting party and the registered owner filed a written argument. Neither party requested an oral hearing.

I will begin by commenting on whether use of the Mark is by the proper owner. Mr Cardinal has stated in his sworn declaration that the registered owner's business registration was cancelled on May 5, 2000 for administrative reasons. This cancellation was revoked and the business revived on February 24, 2005. This fact is evidenced by the supporting documents submitted in Exhibit GC-1 accompanying the first sworn declaration as well as the Exhibit submitted with the supplementary sworn declaration of Ms Bélec, each referring to either the *Canada Business Corporations Act* or la *Loi sur la publicté légale des enterprises individuelles, des sociétés et des personnes morales*. Furthermore, the declarant asserts that the reinstatement has a retroactive effect.

I do not believe these proceedings are the appropriate venue to decide whether or how the *Canada Business Corporations Act* or la *Loi sur la publicté légale des enterprises individuelles, des sociétés et des personnes morales* apply to the present situation. Given the purpose and intent of Section 45 of the *Act*, I am prepared to give regard to the sworn statement made by the declarant that the reinstatement of the business name had a retroactive effect. In any event, of primary significance for Section 45 purposes is the fact that the registered owner was in fact carrying on business during the relevant period. The requesting party made no substantive submissions in regards to this issue.

Next, I shall discuss whether the evidence demonstrates that the services were performed at anytime during the relevant period. Mr Cardinal states that during the relevant period, the registered owner offered, in association with the Mark, massage, relaxation, meditation and yoga courses. I take the opportunity here to note that these particular services are the only ones mentioned throughout the evidence in regards to use. The declarant states that the services were offered in a rented space in Longueuil until June 2003. He offers as exhibit GC-2 a copy of the rental agreement. The services continued to be offered privately, in clients' homes, until November 2003. Mr Cardinal states that during the period between September 2002 and September 2003, the registered owner had sales of approximately $16,400 for the services rendered in association with the Mark.

In support of the foregoing, the declarant has attached as exhibit CG-4 flyers that refer to sessions in 2002-2003 for services including yoga and relaxation seminars. While two of the flyers clearly refer to yoga and relaxation seminars, it is not entirely clear to what type of seminar the third refers. However, coupled with Mr Cardinal's statements in the sworn declaration referring to "meditation" courses together with statements referred to in the flyer in question such as "'Decouvrir ses Richesses' est le pilier de ta démarche intérieur, un séminaire à vivre, revivre, approfondir en soi, un bijou dont tu auras toujours de nouveaux secrets à révéler" and the subtitle "DÉCOUVRIR SES RICHESSES—Pour votre mieux-être et le développement de vos pouvoirs intérieurs", I am prepared to infer that the services referred to in this flyer are those of meditation seminars. Mr Cardinal

also states that the flyers were posted in the rental space where the courses were offered until June 2003. Based on this evidence, I am prepared to conclude that the services referred to in the registration as relaxation, meditation and yoga courses were offered during the relevant period. I note that there are no flyers furnished regarding massage courses.

The declarant has also furnished invoices in exhibit GC-3 that are dated in 2003, which is within the relevant period, and they refer to "yoga", "massage", "relaxation" and more generally, "seminars". The prices listed on the invoices for "yoga" and "relaxation" correspond to the prices listed on the flyers for the same services. The information listed on the invoices referring to "seminars" corresponds to the dates and price listed in the flyer that appears to relate to the meditation seminars. I am not prepared to conclude from the evidence that the "massage" services for which the invoices were prepared are necessarily the massage courses listed in the registration since it is not clear that the services referred to in the invoices were courses.

I shall turn now to the issue of whether use of the Mark was shown in a manner complying with Section 4 of the *Act* so as to satisfy the requirements of Section 45. Mr Cardinal has clearly stated in his affidavit that the registered owner has offered the services in association with the Mark. Mr Cardinal states that his services are advertised by way of flyers such as those in Exhibit CG-4 to existing and potential clients. He also states that the flyers were posted in the rented space where the classes were held up until June 2003. I note that the Mark appears on the upper left-hand corner of each of the flyers. The requesting party has submitted that it has not been demonstrated how the flyers were sent to clients and potential clients nor has the number of flyers that have been distributed been provided, thus concluding that we cannot assume that there was advertising in association with the services. Furthermore, the requesting party submits that the fact that the flyers were posted in the registered owner's rented space is, by definition, not considered to be advertising since the advertising would have been provided in a private environment only visible to those frequenting the space where the services were offered. The registered owner submitted that the flyers are attached as an

exhibit to the sworn declaration in which the declarant has specifically stated that the flyers were sent to clients. He argues that this information is sufficient for the Registrar to conclude that there was advertising in association with the services and any additional information is unnecessary. He further submits that it does not matter that the flyers were posted only in the rental space since to say this space was frequented only by the registered owner's clients is an interpretation on the part of the requesting party. The registered owner submits that it is normal in the course of trade that potential clients visit locations where this type of service is offered and even to attend a first class free of charge (which I note is an offer made on the flyer). Based on the evidence of the flyers that advertise the services together with the declarant's sworn statement and the invoices that demonstrate that the services were actually performed, I am inclined to conclude that the Mark was used in a manner complying with Section 4 of the *Act* so as to satisfy the requirements of Section 45.

As further evidence of use, the declarant has produced a letter featuring the Mark on its letterhead. The requesting party, relying on the decisions in *Analyses Conseil Informations ACI v. Dimension 4 Microcomputer Services (Canada) Inc*. (1994), 55 C.P.R. (3d) 414 (T.M.O.B.) and *Scicon Ltd. v. Sci-Com Data Services Ltd*. (1994), 54 C.P.R. (3d) 562 (T.M.H.O), has submitted that the fact that the Mark appears on the letterhead does not constitute use of the Mark. I agree with the requesting party's argument that the appearance of the Mark on a letter that is not directly related to the services does not show use of the Mark in association with the services.

In view of all of the foregoing, considering the evidence as a whole, I am prepared to conclude that the Mark was used in association with the [TRANSLATION] "yoga, relaxation and meditation courses" during the relevant period in manner satisfying Section 4(2) of the Act for the purpose of these proceedings.

With respect to [TRANSLATION] " Educational and entertainment services, namely dance, music, martial arts courses, operation of a bookstore; operation of a physical education and recreation centre as well as the rental of premises to be used for the

purposes of physical education; restaurant, bar, discotheque and hotel services; communication services, namely the production of videographs and periodical publications ", nowhere in the evidence is there any reference to these services.

Since Mr Cardinal states in his sworn declaration that the registered owner has recently undertaken steps to relaunch his services in association with the Mark and has also entered into negotiations to offer the services listed as [TRANSLATION] "rental of premises to be used for the purposes of physical education", it remains to be considered whether the non-use of the trade-mark in association with said services has been shown to have been due to special circumstances as contemplated by subsection 45(3) of the Act. The three criteria that are generally relied upon to determine whether non-use is due to special circumstances are the following: whether the registered owner's reasons for not using its marks were due to circumstances beyond its control; the length of time during which the trade-mark was not used; and whether there exists a serious intention to resume use of the Mark (*Harris Knitting Mills Ltd. v. Registrar of Trade-marks* (1985), 4 C.P.R. (3d) at 488 (F.C.A.). In the present case, I find that the facts do not show that the non-use was beyond the registered owner's control; I note that the length of time of non-use was not provided, and while it has been stated that the registered owner intends to commence use of the Mark in association with [TRANSLATION] "rental of premises to be used for the purposes of physical education", it is not clear whether there is a serious intention to do so. Consequently, I conclude that the absence of use of the trade-mark with respect to these services has not been shown to be due to special circumstances excusing the non-use as contemplated by subsection 45(3) of the *Act*.

In view of all the foregoing, it is my conclusion that registration no. TMA 462,010 for the trade-mark OASIS PYRAMIDALE & dessin ought to be amended to remove all the services with the exception of [TRANSLATION] "Educational and entertainment services, namely, yoga, relaxation and meditation courses" from the description of services. Registration No. TMA 462,010 will be amended accordingly pursuant to the provisions of subsection 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 14th DAY OF FEBRUARY 2008

C. Laine
Junior Hearing Officer
Section 45