



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

**Citation: 2013 TMOB 80  
Date of Decision: 2013-05-03**

**IN THE MATTER OF SECTION 45 PROCEEDINGS  
requested by Now Screen Pty Ltd against registration  
Nos. TMA631,217 and TMA631,274 for the trade-marks  
WHAT'S NEW CANADA and WHAT'S NEW CANADA  
& Design in the name of What's New Canada Inc.**

[1] At the request of Now Screen Pty Ltd (the Requesting Party), the Registrar of Trade-marks issued notices under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on March 22, 2011 to What's New Canada Inc. (the Registrant), the registered owner of registration Nos. TMA631,217 and TMA631,274 for the trade-marks WHAT'S NEW CANADA and WHAT'S NEW CANADA & Design, shown below:



[2] The section 45 notices required the Registrant to furnish evidence showing that it had used these trade-marks in Canada in association with the services specified in each registration within the time period between March 22, 2008 and March 22, 2011.

[3] The services specified in both registrations are as follows:

Advertising and marketing services and/or consultation for others, namely promoting the goods and/or services of others by way of print, radio, television, web-site, trade/consumer shows, point-of-purchase displays, direct mail and e-mail.

[4] Pursuant to the relevant definition of “use” set out in section 4(2) of the Act, the Registrant must demonstrate that the subject marks were displayed in the advertisement or performance of the services during the relevant period. In the absence of use, a trade-mark is liable to be expunged unless the absence of use has been due to special circumstances.

[5] In response to the Registrar’s notices, the Registrant filed affidavits of Donna Y. Bourgeois, President of the Registrant. Both parties filed written representations; an oral hearing was not held.

[6] I note that the affidavits furnished in response to each notice are identical and that the Registrant makes no allegation of use of the subject marks in association with the services during the relevant period. Ms. Bourgeois does note in her affidavits that the Registrant sponsored a hockey team in 2009 and a baseball team in 2010 in association with the marks. However, she acknowledges that these activities were not related to the registered services. As such, they do not show use of the marks as required pursuant to section 4(2) of the Act.

[7] Accordingly, the only issue to consider is whether there were any special circumstances excusing such non-use of the marks.

#### Analysis – Special Circumstances

[8] Generally, a determination of whether there are special circumstances that excuse non-use involves consideration of three criteria; the first is the length of time during which the mark has not been in use, the second is whether the reasons for non-use were beyond the control of the registered owner, and the third is whether there exists a serious intention to shortly resume use [per *Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA)].

[9] The decision in *Smart & Biggar v Scott Paper Ltd* (2008), 65 CPR (4th) 303 (FCA) offered further clarification with respect to the interpretation of the second criterion, with the determination that this aspect *must* be satisfied in order for there to be a finding of special circumstances excusing non-use of a mark. In other words, the other two factors are relevant but, considered by themselves in isolation, they cannot constitute special circumstances.

[10] With respect to the first criterion, Ms. Bourgeois states that the marks were last used in association with the registered services in 2005. In support, she attaches to her affidavit a printout from the Registrant's website *www.whatsnewcanada.com* dated March 8, 2005 showing the subject marks displayed in association with the promotion and sale of new products. The period of non-use is thus approximately six years, a substantial period of time.

[11] With respect to the second criterion, Ms. Bourgeois states in her affidavits that she and her husband are the sole owners of the Registrant, and are the only two people involved in its day-to-day operations. She asserts that as sole proprietors, they did not realize that the Registrant was required to continue using the marks on an ongoing basis after registration. She also explains that since the Registrant was not a revenue producing company, it was not feasible for the Registrant to continue using the marks without other sources of income at that time.

[12] Ms. Bourgeois explains that, as a result, her husband focused his efforts in 2005 on another company, YB sales Inc., a one-person operation of which he is the president. YB Sales Inc. became a commercial success to the extent that it has become an ongoing full-time job for her husband. Ms. Bourgeois, on the other hand, was also employed full-time with another company. Consequently, Ms. Bourgeois attests that she and her husband have not had any time to devote to the re-establishment of the advertising and marketing services associated with the subject marks.

[13] As the Requesting Party submits, the reasons for non-use provided by the Registrant are not due to circumstances beyond its control. In deciding to focus efforts on another business and to engage in full time employment with another company, the owners of the Registrant made a deliberate decision to not use the subject marks during the relevant period.

[14] Moreover, as noted by the Requesting Party, the fact that the Registrant was unaware that it was required to continue using the subject marks on an ongoing basis subsequent to registration is not a proper excuse, and does not in itself constitute special circumstances justifying non-use. As observed by Thurlow J. of the Federal Court of Appeal:

There is no room for a dog in the manger attitude on the part of registered owners who may wish to hold on to a registration notwithstanding that the trade-mark is no longer in use at all or not in use with respect to some of the wares in respect of which the mark is

registered. [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA) at 66]

[15] As the Registrant has failed to demonstrate that the reasons for non-use of the marks were beyond its control, I will comment on the third criteria only briefly.

[16] With respect to its intention to resume use of the subject marks in Canada, Ms. Bourgeois states in her affidavits that the Registrant intends to “re-establish use...later in 2011”. However, as the Requesting Party notes, the Registrant provides nothing more to indicate what steps, if any, have been taken to implement this intention. No further timeline is provided and no evidence of concrete steps to resume use was submitted. Absent details regarding the manner of resumption, I cannot conclude that the Registrant has provided sufficient evidence demonstrating a serious intention to resume use of the marks in Canada [per *Arrowhead Spring Water Ltd v Arrowhead Water Corp* (1993), 47 CPR (3d) 217 (FCTD); *NTD Apparel Inc v Ryan* (2003), 27 CPR (4th) 73 (FCTD)].

[17] In view of all of the foregoing, I am not satisfied that the Registrant has demonstrated use of the subject marks in association with the registered services within the meaning of sections 4 and 45 of the Act, nor am I satisfied that the Registrant has demonstrated special circumstances excusing such non-use.

#### Disposition

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

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Andrew Bene  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office