



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

Citation: 2010 TMOB 124
Date of Decision: 2010-08-10

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Ronald S. Ade Law Corporation against
registration No. TMA481,145 for the trade-mark
RENAISSANCE in the name of Renaissance Hotel
Holdings, Inc.**

[1] At the request of Ronald S. Ade Law Corporation (the Requesting Party), the Registrar of Trade-marks forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on June 19, 2008 to Renaissance Hotel Holdings, Inc. (the Registrant), the registered owner of the above-referenced trade-mark registration.

[2] The trade-mark RENAISSANCE (the Mark) is registered for use in association with the following services:

Transportation and storage services, namely arranging travel tours, travel guide services, travel booking services, travel agency services and travel information services, excluding cruise ship services, which services are provided in connection with the applicant's hotel services.

[the registered services]

[3] Section 45 of the Act requires the registered owner to show whether the trade-mark has been used in Canada in association with each of the wares or 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 such use since that date. In this

case, the relevant period for showing use is any time between June 19, 2005 and June 19, 2008 (the Relevant Period).

[4] “Use” in association with services is set out in s. 4(2) of the Act:

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 mere assertions of use are not sufficient to demonstrate use in the context of s. 45 proceedings [*Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62 (F.C.A.)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd. v. Lang Michener* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.)], and evidentiary overkill is not required [*Union Electric Supply Co. Ltd. v. Registrar of Trade Marks* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the wares or services specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Registrant furnished the affidavit of Mark Ive, together with Exhibits “A” through “Q”. Mr. Ive states that he is the General Manager of the Renaissance Toronto Hotel Downtown (the Hotel) and that he has held that position since January 2005. Only the Registrant filed written submissions; an oral hearing was not requested.

[7] At the outset of his affidavit, Mr. Ive explains that the Hotel is operated by a licensee pursuant to a licence agreement, dated November 1999, which provides that the Registrant controls, directly or indirectly, the character and quality of all of the services offered by the Hotel under the Mark, including the registered services offered during the Relevant Period. He adds that “such control is exercised through scheduled visits to the Hotel and by guidelines provided to the licensee”.

[8] Use of a trade-mark by a licensee is deemed to be use by the registered owner if the requirements of s. 50(1) of the Act are met. Specifically, the registered owner or the licensee needs to clearly state in the affidavit or the statutory declaration that the control required by s. 50 exists [see *Gowling, Strathy & Henderson v. Samsonite Corp.* (1996), 66 C.P.R. (3d) 560 (T.M.O.B.) and *Mantha & Associates. v. Central Transport Inc.* (1995), 64 C.P.R. (3d) 354

(F.C.A.)). Alternatively, a description of the control or a copy of the licence agreement containing provisions pertaining to control would also suffice. In the present case, Mr. Ive's statement clearly provides such confirmation. Therefore, any use of the Mark in association with the registered services by the Hotel during the Relevant Period enures to the benefit of the Registrant pursuant to s. 50(1) of the Act.

[9] With respect to the provision of services, Mr. Ive explains that many of the services are performed by the Concierge or the staff working for the Concierge, whose desk is located at the lobby of the Hotel. In particular, the affiant states that during the Relevant Period, the Concierge offered and provided travel information to hotel guests such as local attractions, outdoor exercise options, and third party sightseeing tours; and also arranged for taxi and limousine services to the airport, tour reservations, car rentals, and spa reservations, among other services. In support, an extract of the Guest Services Directory, representative of the one distributed during the Relevant Period, is attached as Exhibit "C". Under the tab "Hotel Services", it provides a list of services offered by the Concierge and the rest of the hotel staff including airline and airport information, airport transportation information, auto rental reservations, church/religious locations, golf course locations, hair salon/nail care locations and reservations, limousine reservations, as well as references to additional sightseeing information under the "Discover & Delight" tab, and spa reservations and information under the "Fitness Centre & Pool" tab. I note, in reference to these entries, that the Guest Services Directory indicates that guests can get in touch with the Concierge and/or Guest Services for additional information or to make arrangements for an appointment or a reservation. In light of the evidence, I am satisfied that the Hotel has offered and provided all of the registered services in Canada during the Relevant Period.

[10] With respect to the manner in which the Mark was associated with the registered services, Mr. Ive explains that the Mark was on display for guests when the services were provided. Specifically, business cards bearing the Mark have been placed on the Concierge's desk located in the Hotel lobby continuously since 2005, including during the Relevant Period. Photographs of the Concierge's desk, representative of how the business cards were placed during the Relevant Period, are attached as Exhibit "D"; a representative sample business card is also attached as Exhibit "E". I note that in the representative photographs, the business cards are placed in a card holder on the Concierge's desk, next to the sign "CONCIERGE", facing where

the guest would be. The notation “RENAISSANCE ®” appears in a relatively large font above the words “TORONTO HOTEL DOWNTOWN” on the business cards, followed by the name of the employee, the title “Concierge” and address of the Hotel in Toronto. In addition, the card appears to serve as an appointment card as well since the back of the card contains the following inscriptions: “place: _____”, “date: _____”, “time: _____” and “# ppl: _____”.

[11] In terms of the Guest Services Directory, Mr. Ive states that the Mark is prominently featured on the front cover of the directory. I note that the term “RENAISSANCE ®” appears in a relatively larger font above the words “HOTELS & RESORTS” at the bottom of the front cover of the representative copy of the Guest Services Directory attached as Exhibit “C”. The affiant adds that a copy of the Guest Services Directory was placed in each guest room at the Hotel during the Relevant Period.

[12] When the documentary evidence is considered in conjunction with Mr. Ive’s assertions regarding the manner in which the Mark was associated with the services provided by the Concierge, as well as the distribution of the Guest Services Directory to hotel guests during the Relevant Period, I am satisfied that the Mark was displayed in the performance and advertising of the registered services during the Relevant Period.

[13] In view of the foregoing, I am satisfied that there was use of the Mark within the meaning of s. 45 and 4(2) of the Act on “transportation and storage services, namely arranging travel tours, travel guide services, travel booking services, travel agency services and travel information services, excluding cruise ship services, which services are provided in connection with the applicant's hotel services” during the Relevant Period. Accordingly, and pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be maintained in compliance with the provisions of s. 45 of the Act.

P. Fung
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office