



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

Citation: 2014 TMOB 155
Date of Decision: 2014-07-30

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Fetherstonhaugh & Co. against registration
No. TMA597,571 for the trade-mark SUPERSHUTTLE
in the name of Supershuttle International, Inc.**

[1] At the request of Fetherstonhaugh & Co., the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on February 14, 2012 to Supershuttle International, Inc. (the Registrant), the registered owner of registration No. TMA597,571 for the trade-mark SUPERSHUTTLE (the Mark).

[2] The Mark is registered in association with the services “airport passenger ground transportation 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 the 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 between February 14, 2009 and February 14, 2012.

[4] The relevant definition of “use” is set out in section 4(2) of the 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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53

CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], 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 services specified in the registration during the relevant period.

[6] In response to the Registrar's notice, the Registrant filed the affidavit of Judy Robertson, Vice-President of Regulatory Affairs of the Registrant. Both parties filed written representations and attended an oral hearing.

[7] In her affidavit, Ms. Robertson states that the Registrant operates one of the largest ground transportation services in the United States in association with the Mark, providing ground transportation to and from airports for airport passengers. She attests that the Registrant provides its transportation services in numerous metropolitan areas in the United States and France, with approximately 1200 SUPERSHUTTLE vans in the U.S. Attached as Exhibit A to her affidavit are copies of photographs of such SUPERSHUTTLE vans displaying the Mark. She attests that the Registrant provides its transportation services to approximately 8 million customers per year, averaging about 2200 customers each day.

[8] The Registrant concedes that it does not operate its vans in Canada and did not do so during the relevant period. However, the Registrant asserts that it used the Mark in association with the registered services during the relevant period through promotion and sales through its website, travel agency websites and tour operators in Canada. In this respect, the following exhibits are also attached to Ms. Robertson's affidavit.

[9] Exhibit E consists of pages from the Registrant's website, *www.supershuttle.com* (the Website), which Ms. Robertson attests was in continuous operation during the relevant period and available to Canadians. The Website provides information about the Registrant's shuttle services, including a reservations booking page. She attests that there were over 19 million Canadian visitors to the Website during the relevant period. Data regarding these visits, broken down by province, is provided as an attachment at Exhibit F to her affidavit.

[10] Ms. Robertson attests that at least 61,000 Canadian individuals booked reservations for the Registrant's shuttle services through the Website during the relevant period. Individual details regarding some of these bookings are provided as an attachment at Exhibit G to her affidavit.

[11] Ms. Robertson also attests that some Canadian tour operators booked trips for Canadian citizens and included the Registrant's shuttle services as part of their tour packages. In such cases, the tour operators typically issued a pre-paid voucher to its customers. Ms. Robertson attests that once the voucher was redeemed by the customer, the Registrant would provide the transportation service and then bill the tour operator. Attached as Exhibit H are copies of billing history reports regarding such billings from the Registrant to Canadian tour companies. Ms. Robertson attests that, in total over the relevant period, there were over 2000 billings by the Registrant to Canadian tour guide companies, representing over 10,000 individual reservations for the Registrant's SUPERSHUTTLE services.

[12] Ms. Robertson also attaches to her affidavit advertisements for the SUPERSHUTTLE service placed in US Airways Magazine (Exhibit D), and excerpts from third party travel websites, Expedia and Orbitz, advertising and promoting the Registrant's SUPERSHUTTLE services (Exhibits B and C, respectively). I accept that these advertisements would have been seen by Canadians during the relevant period and provided information to them regarding the Registrant's SUPERSHUTTLE services.

[13] In short, while the Registrant did not have "wheels on the ground" in Canada during the relevant period, its SUPERSHUTTLE service was advertised in Canada, with many Canadians availing themselves of the ability to purchase and make reservations of the Registrant's services directly or through Canadian tour guide operators. The issue, then, is whether this is sufficient to constitute use of the Mark in association with the services *as registered* within the meaning of sections 4 and 45 of the Act.

Analysis

[14] Generally, advertising in Canada alone is insufficient to demonstrate use with respect to services; at the very least, the services have to be available to be performed in Canada [*Wenward*

(*Canada*) *Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)]. In *Marineland Inc v Marine Wonderland and Animal Park Ltd* (1974), 16 CPR (2d) 97 (FCTD), the Federal Court reasoned that where performance of services offered by a trade-mark owner, by necessity, could only be completed by travelling abroad, the sale of admission vouchers in Canada could not be considered performance of services in Canada. Similarly, in *Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD) and *Porter v Don the Beachcomber* (1966), 48 CPR 280 (Ex Ct), it was held that where a trade-mark is associated with advertising in Canada for services that can only be benefitted from outside of Canada, proper use of the trade-mark has not been shown.

[15] In this case, the Registrant clearly does not operate its airport shuttle vans in Canada. Instead, the Registrant submits that “airport passenger ground transportation services” should be given a broad interpretation and should encompass the “airport passenger ground transportation reservations and ticketing services” that has been evidenced in Ms. Robertson’s affidavit.

[16] In support of its position, the Registrant cites *TSA Stores, Inc v Canada (Registrar of Trade-marks)* (2011), 91 CPR (4th) 324 (FCTD). In *TSA Stores*, the Federal Court reversed in part the decision of the Registrar to expunge various SPORTS AUTHORITY trade-marks in association with retail store services. In that case, the owner operated a retail website; however, there was no evidence that it shipped its products to Canada and there was no evidence of sales to Canadians, whether in Canada or otherwise. The Court, however, made the following observations at paragraphs 16-17:

16 The word “services” is not defined in the Act. It has therefore been held that “services” should be given a liberal interpretation and that each case should be decided on its own facts (see *Kraft Ltd v Registrar of Trade-marks*, [1984] 2 FC 874, 1 CPR (3d) 457 at paras 8-9).

17 It has also been recognized that the Act makes no distinction between primary, incidental or ancillary services. As long as some members of the public, consumers or purchasers, receive a benefit from the activity, it is a service (see *Société Nationale des Chemins de fer Français SNGC v Venice Simplon-Orient-Express Inc*, 9 CPR (4th) 443...).

[17] The Court went on to find that Canadians made use of the website and, in particular, identified certain aspects of the website, such as the “Shoe Finder” service, as being of benefit to Canadians. Accordingly, since the trade-marks in question appeared in connection with these

“ancillary retail store services” on TSA’s website, the Court concluded that there was evidence of use of the trade-marks in Canada during the relevant period. In particular, the Court stated that “[i]n my view, visiting this service on the Website is akin to visiting a bricks and mortar store and benefitting from a discussion with a knowledgeable salesperson” [at paragraph 19].

[18] The Registrant compares itself favourably to the registered owner in *TSA Stores*, noting that the services provided on the Website in this case “far exceed” the services provided to Canadians in that case.

[19] Similarly, the Registrant compares itself favourably to the registered owner in the Federal Court decision *Venice Simplon-Orient-Express Inc v Société Nationale des Chemins de Fer Français SNCF* (2000), 9 CPR (4th) 443 (FC) [*Orient Express*], cited in *TSA Stores*. *Orient Express* dismissed an appeal of the Registrar’s decision [(1995), 64 CPR (3d) 87 (TMOB)], where the Registrar found that the services in question, “travel services, namely railway passenger services”, encompassed services such as “train ticketing and train reservations”.

[20] In that decision, the Registrar drew on the language of “ancillary” and “incidental” services from *Kraft Ltd v Registrar of Trade-marks* (1984), 1 CPR (3d) 457 (FCTD) to give a broad interpretation to the registered services, stating that “the expression, in my view, conveys several ideas and I can see no reason why such an expression should be given a restrictive interpretation” [at page 90].

[21] However, the Federal Court’s decision in *Orient Express*, while dismissing the appeal of the Registrar’s decision, did not overturn the principles enunciated in *Marineland* and *Motel 6*, *supra*, with respect to what constitutes performance of services in Canada. Indeed, more recently, the Federal Court has cited *Marineland* favourably while giving *Orient Express* a narrow interpretation [see *Express File Inc v HRB Royalty Inc* (2005), 39 CPR (4th) 59 (FC)].

[22] Further, I do not consider *Orient Express* to stand for the principle that the ability to reserve, book or pay for certain services from Canada constitutes performance of such services in Canada. Rather, it only stands for the reasonableness of the Registrar’s conclusion with respect to a particular articulation of services in the context of particular evidence of use. In this respect,

I note that the Federal Court in that case did not adopt the Registrar's reasoning *per se*. Instead, it states the following at paragraph 10:

The term "services" was interpreted broadly in *Saks & Co. v. Canada (Registrar of Trade Marks)* (1989), 24 C.P.R. (3d) 49 (F.C.T.D.). In that case Saks did not have a Canadian store but did receive mail and telephone orders from Canada for merchandise. The services in that case were performed without the Canadian customer having to leave Canada. In my view the words "travel services, namely passenger rail services" should not be given any more limited scope. Thus, it was reasonable to find that the performance in Canada by a travel agency of booking, reservation and ticketing services constitutes the performance in Canada of such services by the registrant.

[23] In my view, the Court did not explicitly endorse the Registrar's reasoning in that case, only accepting that "travel services, namely passenger rail services" could be interpreted broadly to encompass the travel agency-type services actually in evidence.

[24] Nonetheless, the Registrant submits that "airport passenger ground transportation services" should be given a similarly broad interpretation and should encompass the "airport passenger ground transportation reservations and ticketing services" that has been evidenced in Ms. Robertson's affidavit. It argues that the ability to make reservations for this service from Canada should fall within the scope of the registered services, such ability to make reservations via a website or by telephone being a service of benefit to the public.

[25] Although *Orient Express* is often cited for the principle that services should be interpreted broadly, the principle from *Kraft* that services should be interpreted liberally is regarding what activities can constitute a service, not that any activity can constitute the performance of a particular service. Indeed, the Federal Court of Appeal has acknowledged that interpreting services broadly has limits [see, for example: *Boutique Limité Inc v Limco Investments, Inc* (1998) 84 CPR (3d) 164 (FCA), in which a U.S. store providing refunds to Canadians was insufficient to justify a registration of "retail women's clothing store services" in Canada].

[26] With respect to certain services, the decision in *Motel 6* explicitly states that "...receiving and confirming reservations for motel accommodation in the U.S.A. does not constitute use of the mark in Canada in association with motel services" [at page 57]. This is consistent with the

view that hotel services are not provided in Canada when the hotel is located in the United States [see *Maillis v Mirage Resorts Inc* (2012), 107 CPR (4th) 298 (TMOB)].

[27] This view is also consistent with the underlying importance of the concept of “use” in Canadian trade-mark law, that a trade-mark must be used in Canada in order to have the benefits of exclusivity. While foreign trade-mark owners may register their trade-marks in Canada (*e.g.*, pursuant to section 16(2) of the Act) and enjoy the benefits of registration, maintenance of one’s registration depends on use in Canada.

[28] In my view, the statement of services in this case is not an arguably nebulous statement of services beginning with the broad “travel services...”, as was apparently the case in *Orient Express*. It is clear that the Registrant does not operate an “airplane passenger ground transportation service” in Canada; it merely enables Canadians to book that service. However, airport shuttle transportation services are not analogous to retail store services, where the Registrar and courts have recognized that technology has progressed to the point where one can enjoy the retail experience without ever having to leave one’s home. To put it more simply, the presence of airport shuttles in Canada is required for a finding that such “airport passenger ground transportation services” are available to be performed in Canada. A ground transportation service cannot be operated via the Internet or a 1-800 telephone number; it is contrary to common sense to equate the ability to make reservations with the actual transportation of customers to and from airports.

[29] This is consistent with the plain meaning of the statement of services and in light of the evidence furnished. “Reservation services” are not the registered services, and the registration should not be maintained simply because the service actually available in Canada is related.

[30] Notwithstanding the use of the terms “primary”, “ancillary” or “incidental” in some outlying jurisprudence, I note that these terms are not found in the Act at all, much less defined. The point in *Kraft* was that distinguishing between “ancillary”, “incidental” or “primary” services was unnecessary in determining what constitutes a “service” under the Act. It follows that using such terms when attempting to determine whether a particular activity constitutes a particular registered service is similarly unwarranted. Such an exercise has little basis in the Act and inevitably leads to absurd arguments and results.

[31] In contrast, per section 30 of the Act, services must be stated in ordinary commercial terms and whether a trade-mark has been used in association the registered services is to be determined on a case-by-case basis [*Express File, supra*, at paragraph 23]. Accordingly, registered services should be interpreted in accordance with common sense and given their ordinary meaning.

[32] In this case, the Registrant appears to be conflating the promotion of its ground transportation services with actual performance of such services. There is evidence that the Mark is well known in Canada. However, the advertisement of one's services on a website or through travel agencies does not constitute performance of such services. While promotion of the SUPERSHUTTLE transportation service may occur in Canada, it is not use of the Mark in Canada with respect to the registered services unless the Registrant performs or is prepared to perform such services in Canada. In this case, it is clear that the ground transportation services of the Registrant are performed in the US and Europe, not in Canada.

[33] The argument that some activity is "technically" use should not be successful. In line with this, courts have generally taken a dim view of token commercial activity designed to protect intellectual property rights. I note the following observation from the Federal Court in *Plough, supra*, at paragraph 10:

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.

[34] Maintaining the registration in this case would give the Registrant an overly broad scope of protection over services that it does not actually perform in Canada. Where a trade-mark owner performs services in another jurisdiction and wishes to obtain and maintain a registration in Canada in association with the same Mark and same services, it should generally mirror the performance of those services in Canada; merely casting the shadow of those services is insufficient.

[35] The argument that the Registrant obtained a registration for its services and had a reasonable expectation that it would be able to maintain its Canadian registration through its

offering of reservation services in Canada is unconvincing. First, the Registrant obtained a registration for its ground transportation services in the United States because it operates airport shuttles in the United States, not because it offers reservation services. It does not merely offer reservation services in the United States; it offers ground transportation for passengers via airport shuttles.

[36] Second, it is not clear whether “reservation services” in respect of one’s own services, rather than those of third parties, constitutes a *bona fide* service under the Act [see *Ralston Purina Co v Effem Foods Ltd* (1997), 81 CPR (3d) 528 at 534]; in any event, this issue is beyond the scope of this proceeding.

[37] In summary, while Canadians may be able to book and reserve the services provided by the Registrant, what they cannot do is enjoy its “ground transportation services” without leaving Canada first.

[38] In view of the foregoing, I am not satisfied that the Registrant performed or was able to perform “airport passenger ground transportation services” in Canada during the relevant period. As such, I cannot conclude that the Registrant has demonstrated use in association with the registered services within the meaning of sections 4 and 45 of the Act. Furthermore, there is no evidence of special circumstances excusing non-use of the Mark before me.

Disposition

[39] Accordingly, 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 expunged.

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