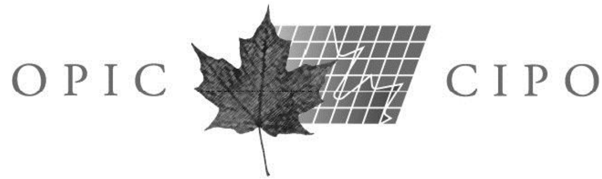

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2011 TMOB 133
Date of Decision: 2011-07-28

IN THE MATTER OF A SECTION 45 PROCEEDING requested by Sim & McBurney against registration No. TMA664,165 for the trade-mark WHERE YOU BELONG in the name of Decore Holdings Inc.

[1] On June 1, 2009, at the request of Sim & McBurney (the Requesting Party), the Registrar of Trade-marks forwarded a notice under s.45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Decore Holdings Inc., the registered owner (the Registrant) of registration No. TMA664,165, for the trade-mark WHERE YOU BELONG (the Mark).

[2] The Mark is registered in association with the following services:

> *Hotel, motel, resort and restaurant services and the operation of retail gift stores.*

[3] Section 45 of the *Trade-marks Act* requires the registered owner of the trade-mark to show, with respect to each of the wares and/or services specified in the registration, whether the trade-mark was in use in Canada at any time during 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 June 1, 2006 and June 1, 2009.

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

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

[5] It is well established that the purpose and scope of s. 45 of the Act is to provide a simple, summary and expeditious procedure for removing deadwood from the register. Assertions of use as a matter of law are insufficient to demonstrate use [see *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62 (F.C.A.)]. A recipient of a s. 45 notice must put forward evidence showing how it has used the trade-mark in order that the Registrar may assess if the facts qualify as use of the trade-mark pursuant to s. 4 of the Act. However, it has also been held that evidentiary overkill is not required when use can be shown in a simple, straightforward fashion [see *Union Electric Supply Co. v. Registrar of Trade Marks* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)].

[6] In response to the Registrar's notice, the Registrant filed the affidavit of Stefan Dolega, the Controller of Decore Hotels since October, 2000. Neither party filed written submissions; however, both parties were represented at an oral hearing.

[7] In his affidavit, Mr. Dolega explains that the Registrant owns and operates a variety of hotel properties in Alberta, and that Decore Hotels is the trade-name used by the Registrant for advertising and promotional purposes with respect to these properties.

[8] The Mark, Mr. Dolega attests, has been used regularly by the Registrant since May, 2002 in Canada to promote its various hotel, motel, and resort properties located throughout Alberta. He attaches as Exhibit C, evidence of use of the Mark in the promotion or advertising of such services in the form of a printout from the Registrant's website, *www.decorehotels.com*. The Mark is shown on this page in the lower right-hand corner beneath the words Decore Hotels, in what appears to be a link to a central corporate website. Also on this page are icons that appear

to link to specific establishments identified as the Tonquin Inn, the Maligne Lodge and Castle Mountain Chalets. I find it reasonable to infer that these properties are owned and operated by the Registrant.

[9] Mr. Dolega then explains that additional advertising of the Registrant's properties and all associated services appears in periodicals. As support, he attaches as Exhibit D, a copy of such an advertisement from the Calgary Avenue Magazine. Again, the Mark appears underneath the words Decore Hotels, situated at the bottom of the advertisement. The advertisement is in respect of the rental of log cabins/chalets at Castle Mountain Chalets.

[10] Attached as Exhibit F to the affidavit is a copy of a still frame from a television promotion that took place between August 11, 2008 and August 15, 2008. The advertisement refers to a "weekend wilderness adventure"; however, Mr. Dolega provides no explanation as to what constitutes a "weekend wilderness adventure". Thus, it is unclear how the Mark appearing in this advertisement is associated with any specific service as identified in the subject registration.

[11] Lastly, the Registrant further advertises through the use of flyers (Exhibits H and M), e-mail newsletters (Exhibit J), and billboards (Exhibit K). The flyers attached as Exhibits H and M refer to accommodation packages offered at the Registrant's various properties previously identified on the Registrant's website in Exhibit C. The Mark appears consistent with all of the advertisements furnished, beneath the words Decore Hotels, situated at the bottom of each of the flyers in Exhibit H, and on the front cover of the leaflet flyer in Exhibit M.

[12] The e-mail newsletter in Exhibit J incorporates the Mark at the top left-hand corner, and also refers to the same properties identified on the Registrant's website in Exhibit C. Again, I find it reasonable to infer that these properties are owned and operated by the Registrant, as the newsletter includes such text as "*Did you know? All our properties are pet friendly!*" and "*Each time you stay at a Decore Hotels property, you will have the chance to complete an online survey for 35% off your next stay*."

[13] Lastly, the billboard advertisement in Exhibit K shows the Mark in the bottom left-hand corner. The advertisement lists the website address for the Registrant's website, and includes the words "*Looking for adventure?*" and "*Ski & Stay – Jasper•Banff*".

[14] The Requesting Party argues that the Registrant's evidence does not show use of the Mark in association with the registered services. It argues that there is no reference anywhere on the advertisements to hotel services, motel services, restaurant services, resort services, or the operation of a retail gift store. Although there is reference to the trade-name of the Registrant, Decore Hotels, the use of the word "Hotel" in the context of the Registrant's trade-name is not use in association with services. Instead, the Requesting Party asserts, the advertisements refer to inns, lodges, and chalets, and Mr. Dolega's affidavit does not describe these services or how these services correspond to the registered services. Furthermore, the Requesting Party asserts that there is a distinction between these types of services and the registered services. In the alternative, the Requesting Party argues that at best, the evidence describes hotel services, if one infers that inns and chalets are the same thing as hotels.

[15] The Registrant, in turn, argues that it is not a huge leap to infer from the evidence that the inns, lodges, and chalets fall under the umbrella of hotel services. Furthermore, it argues that it is clear from the various exhibits attached to the Dolega affidavit what types of services are being offered to consumers – accommodations at hotels and resorts. It submits that the case law has given a fairly liberal interpretation of services, interpreting hotel services to include such things as reservation services and loyalty program services. The Registrant submits that it is not asking the Registrar to make such a jump, but simply to interpret the accommodation services as shown in the evidence to include the registered services. This, in the opinion of the Registrant, would include restaurant services and the operation of retail gift stores, typically being services offered by hotels.

[16] I agree with the Registrant that the accommodation services advertised in association with the Mark, namely, the inns, lodges, and chalets, reasonably fall within the interpretation of the registered services described as hotel, motel, and resort services [see *Molson Canada v. Kaiserdom-Privatbrauverei Bamberg Wörner KG* (2005), 43 C.P.R. (4th) 313 (T.M.O.B.); and *Levi Strauss & Co. v. Canada (Registrar of Trade Marks)* (2006), 51 C.P.R. (4th) 434 (F.C.)].

However, I am not prepared to accept that these services should be interpreted to include restaurant services and the operation of retail gift stores. This situation is distinguishable from cases that have given a fairly liberal interpretation of services [see for example: *Société Nationale des Chemins de Fer v. Venice Simplon-Orient Express* (2000), 9 C.P.R. (4th) 443 and *Borden Ladner Gervais LLP v. WestCoast Hotels, Inc.* (2006), 53 C.P.R. (4th) 361 (T.M.O.B.)], in that in the present situation, it is not an ancillary or incidental service that is being relied upon to support use in association with a primary service.

[17] With respect to the services described as "the operation of retail gift stores", there is no evidence whatsoever that the Registrant provides such services. In fact, nowhere in his affidavit does Mr. Dolega mention gift shop services or even, for that matter, restaurant services; he merely refers somewhat ambiguously to "related services" or "associated services".

[18] With regard to restaurant services, while several of the accommodation packages advertised on the flyers refer to additional offerings, including *inter alia* the provision of meals, it appears that many of these additional offerings are being provided by entities other than the Registrant. For example, some accommodation packages refer to dinner at a "great local restaurant". This being so, and as the affiant did not explicitly assert use with restaurant services, it is ambiguous as to whether the Registrant provides restaurant services itself, or if the meals referred to in the advertised accommodation packages are provided at an off-site restaurant by a third party. As ambiguities in evidence are to be interpreted against the interests of the registered owner, I cannot conclude that the evidence supports a finding that the Registrant itself is providing restaurant services in association with the Mark [*Aerosol Fillers Inc. v. Plough (Canada) Ltd.* (1980), 45 C.P.R. (2d) 194 at 198; aff'd 53 C.P.R. (3d) 62 (F.C.A.)].

[19] In view of the above, I conclude that use of the Mark has been shown for the services described as "*Hotel, motel, and resort services*"; use has not been shown in association with "*restaurant services and the operation of retail gift stores*" and there is no evidence of any special circumstances excusing the absence of use. Pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be amended to delete the following services:

"*restaurant services and the operation of retail gift stores*", in compliance with the provisions of s. 45 of the Act.

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