



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

Citation: 2012 TMOB 70
Date of Decision: 2012-04-24

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Ronald S. Ade against registration
No. TMA676,490 for the trade-mark THE CAVERN
CLUB in the name of Cavern City Tours Ltd.**

[1] At the request of Ronald S. Ade (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the Trade-marks Act RSC 1985, c T-13 (the Act) on November 24, 2009, to Cavern City Tours Ltd., the registered owner (the Registrant) of registration No. TMA676,490 for the trade-mark THE CAVERN CLUB (the Mark).

[2] The Mark is registered for use in association with the following wares and services:

Wares: Articles of out-clothing; namely coats, waterproof clothing, rain coats, windbreakers, fleeces, pants, track suits, scarves, toques, caps, headbands, gloves; T-shirts, sweatshirts, hats, jackets, shirts.

Services: Night club services; cabaret services; entertainment services namely presenting musical performances, DJs, fashion shows.

[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 each of the wares and 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 use since that

date. In this case, the relevant period for showing use is between November 24, 2006 and November 24, 2009 (the Relevant Period).

[4] The definition of “use” is set out in section 4 of the Act as follows:

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

(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.

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

In this case, only sections 4(1) and (2) apply.

[5] It is well established that the purpose and scope of section 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 *Aerosol Fillers Inc v Plough (Canada) Ltd* (1979), 45 CPR (2d) 194 (FCTD)]. A recipient of a section 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 section 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 CPR (2d) 56 (FCTD)]. Furthermore, section 45 does not require a particular kind of evidence [*Lewis Thomson & Sons Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 at 486 (FCTD)].

[6] In response to the Registrar’s notice, the Registrant furnished affidavits sworn by Hal Bruce, the owner of Cavern Music Productions, and Dave Jones, a Director of the Registrant. Both parties filed written submissions and were represented at an oral hearing.

[7] At the oral hearing, the Registrant acknowledged that its evidence and written arguments related strictly to “t-shirts” and “entertainment services namely presenting musical performances”. Consequently, the following wares and services will be deleted from the registration:

Wares: Articles of out-clothing; namely coats, waterproof clothing, rain coats, windbreakers, fleeces, pants, track suits, scarves, toques, caps, headbands, gloves; sweatshirts, hats, jackets, shirts.

Services: Night club services; cabaret services; entertainment services namely DJs, fashion shows.

[8] With respect to “t-shirts”, the evidence of use is contained in the Jones affidavit. In particular, Mr. Jones explains that the Registrant has licensed use of the Mark in Canada to third parties. As an example, attached as Exhibit E to his affidavit is a copy of such a license agreement, which refers to the Mark and includes representations of t-shirts which clearly bear the Mark. Although the Requesting Party points out that the license agreement is undated and is ambiguous with respect to the names of the parties involved, I note that Mr. Jones provides sworn statements in his affidavit surrounding the term of the license agreement, as well as the names of the parties subject to the agreement. The exhibit in combination with the statements in the affidavit amount to statements of fact and are sufficient for the purposes of section 45 [*Mantha & Associes/Associates v Central Transport, Inc.* (1995), 64 CPR (3d) 354 (FCA)].

[9] The Requesting Party also argues that Mr. Jones simply states that the t-shirts evidenced in Exhibit E were sold in Canada, but provides no evidence to show that such sales took place during the Relevant Period. However, the Federal Court has stated that invoices are not necessary in section 45 proceedings [*Lewis Thomson & Sons Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 at 486 (FCTD)], and that the type of evidence necessary will vary from case to case [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270]. Bearing these principles in mind, I note that Mr. Jones provides a sworn statement identifying specific retail establishments in Canada where such wares were sold during the Relevant Period. Again, I find these statements of fact sufficient to show that sales of such wares took place in Canada during the Relevant Period.

[10] In any event, Mr. Jones provides further evidence of sales of licensed t-shirts bearing the Mark during the Relevant Period under Exhibits F and G. In this regard, Exhibit F consists of a copy of a license agreement between the Registrant and another third party for the production and sale of such wares. As in Exhibit E, this license agreement includes a representation of a t-shirt which clearly bears the Mark. Exhibit G includes copies of royalty reports regarding sales of the wares referred to in the Exhibit F license agreement. The royalty reports clearly indicate that sales of t-shirts bearing the Mark were made to a Canadian customer during the Relevant Period. In view of the foregoing, I am satisfied that the Registrant has demonstrated use with respect to “t-shirts” within the meaning of sections 4 and 45 of the Act.

[11] With respect to “entertainment services namely presenting musical performances”, the Registrant indicated at the oral hearing that it was relying on the Bruce affidavit to support such use. The Bruce affidavit pertains to evidence regarding musical performances held in Halifax, Nova Scotia.

[12] More particularly, in his affidavit, Mr. Bruce indicates that under an arrangement with the Registrant, he is authorized to use and promote The Cavern Club brand in Canada, and is allowed to operate under the name Cavern Music Productions. He indicates that Cavern Music Productions has held annual music performances in Nova Scotia every year since 2006. He states that he has always introduced these performances to the audience as “our very own Canadian Cavern Club bringing a little piece of Liverpool to you all, we hope you enjoy the show”. He also states that “during the musical performances the stage is referred to as The Cavern Club.” He attaches as Exhibit A, a photograph of the back drop of the stage which Mr. Bruce purports is representative of the brick walls, ceiling and archways of The Cavern Club. I note however, that the Mark does not appear in the photograph.

[13] In this case, the Registrant submits, the Mark is associated with the services as it is used in the announcement of the services. The Registrant argues that services are to be given a broad interpretation and that use with respect to services is not the same as use with respect to wares. Therefore, the Registrant submits, there is no requirement for the Mark to be marked or affixed to the service as with wares, and the verbal association with the services in this case is sufficient. I note however, that it has been held that oral references to a trade-mark do not qualify as use of

a trade-mark for either wares *or* services [see *Playboy Enterprises Inc. v Germain* (1987), 16 CPR (3d) 517 (FCTD), with respect to wares described as “hair-pieces”; *Waltrip v. Boogiddy Boogiddy Racing Inc* (2007), 64 CPR (4th) 357 (TMOB), with respect to “retail sales” services; and *Alex v World Wrestling Federation Entertainment Inc.* (2008), 68 CPR (4th) 244 (TMOB), with respect to evidence regarding the Opponent’s wares and services] . As such, I am not satisfied that the Registrant has demonstrated use with respect to the Services within the meaning of sections 4 and 45 of the Act.

Disposition

[14] Accordingly, having regard to the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained solely in respect of “*t-shirts*.”

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

