

SECTION 45 PROCEEDINGS  
TRADE-MARK: NIAGARA DAREDEVIL  
REGISTRATION NO. TMA332,763

On September 13, 2005, at the request of Digital Attractions Inc., the Registrar issued the notice prescribed by s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) to L.N.W. Enterprises Ltd., the registered owner of registration No. TMA332,763 for the trade-mark NIAGARA DAREDEVIL (the “Mark”). The Mark is registered in association with the following wares and services:

- Souvenir items, namely t-shirts, bumper stickers, post cards, and promotional pamphlets
- Souvenir plateware and souvenir mugs
- Commercial photographic services, advertising and promotion of entertainment and amusement facilities at a tourist resort area, namely Niagara Falls.

Section 45 requires the registered owner of a trade-mark to indicate whether the mark has been used in Canada in association with each of the wares and services listed in the registration at any time during the three years preceding the date of the notice, in this case between September 13, 2002 and September 13, 2005. If the mark has not been used during that time period then the registrant is required to indicate the date on which it was last used and the reason why it has not been used since that date.

What qualifies as use of a trade-mark is defined in s. 4 of the Act, which is reproduced below:

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.

Although the entire burden under s. 45 is with the registrant to satisfy the Registrar that the trade-mark is in use, in view of the purpose and scope of s. 45, the test that has to be met by the registrant is not a heavy one. [*88766 Inc .v. George Weston Ltd.* (1987), 15 C.P.R. (3d) 260; *Austin Nichols & Co. v. Cinnabon, Inc.* (1998), 82 C.P.R. (3d) 513 (F.C.A.) at 525]

In response to the s. 45 notice, the registrant filed the affidavit of its President, Louis Wolffe. Only the requesting party filed a written argument. I will take this opportunity to state that I have disregarded all portions of the requesting party's argument in which it refers to details not set out in Mr. Wolffe's affidavit.

The registrant initially requested that an oral hearing be held but later advised that it no longer desired to be heard. The registrant filed a letter seeking to correct an error in Mr. Wolffe's affidavit, but was advised that such an error could only be corrected by means of a supplementary affidavit. In the interim, the requesting party filed an amended written argument, partly in response to the registrant's attempt to correct its evidence. No supplementary affidavit was ever made of record and the amended written argument was returned to the requesting party.

Mr. Wolffe informs us that the registrant acquired the Mark from its predecessor-in-title Souvenir Photos International Limited in 1994 (the registration shows that this assignment was recorded in 1995). Mr. Wolffe attests that the registrant has used the Mark in Canada in association with all the wares and services set out in its registration from November 21, 1994 and that as of September 13, 2002, it was using and has used the Mark continuously to the date of his affidavit (March 19, 2006) in Canada in association with each of the wares and services. Annual

sales of the wares and services bearing the Mark in Canada during the relevant three-year period “were well in excess of 150,000 per year.” Mr. Wolffe also states that the use referred to has been “on the wares themselves, and or packaging and on promotional material, invoicing, letterhead, advertising and promotional materials therefor.” I will therefore assess the exhibits provided by Mr. Wolffe in order to determine if they substantiate his claims.

Exhibit “A” is identified as “a representative sample of the t-shirts sold by my Company in Canada between September 13, 2002 and September 13, 2005 (“the relevant period”) and bearing the trade-mark NIAGARA DAREDEVIL.” The contents of the exhibit is actually a photograph of a t-shirt which displays, on its front, portions of a fake newspaper report that features a photograph of an individual going over Niagara Falls in a barrel. NIAGARA DAREDEVIL appears on the barrel.

The requesting party has argued that Exhibit “A” does not show use of the Mark in association with t-shirts because NIAGARA DAREDEVIL does not appear on hang tags, labels, packaging, *etc.* It submits that NIAGARA DAREDEVIL appears on the t-shirt for decorative or ornamental purposes. It states that there is “sufficient case law that states that a trade-mark may not be decorative or ornamental”, but it does not cite any cases. It also notes that the registrant has not broken its annual sales figures down by wares and so there is no evidence as to how many t-shirts were sold during the relevant time period.

Regarding the ornamentation issue, I consider this to be an argument that exceeds the bounds of s. 45 proceedings. In any event, I need not consider this exhibit further in view of the fact that the Mark is also associated with these wares in another manner, as discussed below with respect to Exhibit “K”.

Exhibit “B” is described as “representative samples of the souvenir mugs sold by my Company in Canada during the relevant period.” A photograph has been provided of a mug that displays

the same sort of fake newspaper report as appears on the t-shirt in Exhibit “A”. The same comments apply to this exhibit as apply to Exhibit “A”.

Exhibit “C” provides a shift report dated September 10, 2005, indicating that photographic services were performed during the relevant time period.

Exhibit “D” is described as “picture mounts and pictures sold by my Company in Canada in association with the services set out in the Registration during the relevant period and bearing the trade-mark NIAGARA DAREDEVIL.” We have been provided with two pieces of printed material, designed to hold a photograph. One of these bears the registrant’s name. Both display NIAGARA DAREDEVIL ®. In addition, the photographs inserted in the photo mounts show individuals posed inside a barrel on which NIAGARA DAREDEVIL appears.

Exhibit “E” provides the registrant’s gross business figures for each of the months in 2002, 2003 and 2004, but the annotations thereon appear to indicate that these figures relate to photographs, not to souvenir items to which the photographs have been applied.

Exhibit “F” is evidence of the purchase by the registrant of the photo/picture mounts shown in Exhibit “D” from a printing company during the relevant time period.

Exhibit “G” is described as “discount coupons bearing the trade-mark NIAGARA DAREDEVIL. These coupons are typical of coupons that have been distributed in Canada in the relevant period (except that my Company’s name would appear where my Company’s predecessor appears)...” No explanation has been given as to why coupons listing the current owner’s name were not provided. Given that the assignment occurred more than a decade before Mr. Wolffe’s affidavit, I am not prepared to accept that this exhibit represents coupons that were being used during the relevant time period. It should have been a simple matter for Mr. Wolffe to provide a sample of the coupon referring to the current owner.

Exhibit “H” is stated to be “samples of letterhead bearing the trade-mark NIAGARA DAREDEVIL used by my Company in the normal course of trade.” However, this evidence does not assist the registrant for two reasons: 1) the address on the letterhead is not that which appears in the registration and the registrant’s name does not appear on the letterhead; 3) the letterhead is blank and therefore it neither bears a date within the relevant time period nor makes any reference to any of the registered wares or services.

Exhibit “I” is stated to be “representative samples of the promotional materials distributed by my Company in Canada at various locations and hotels during the relevant period which bear the mark NIAGARA DAREDEVIL”. These undated promotional “pamphlets” read in part:

Niagara Daredevil can make it happen with a great photograph of you, your family and friends. ...  
Niagara Daredevil ®  
Niagara Falls, Canada  
905-356-8033

This is not use of the Mark in association with “promotional pamphlets” as these printed materials are clearly not pamphlets that are sold to others. Rather, the pamphlets serve to promote the registrant’s own business. They therefore could show use in association with “commercial photographic services”. However, I will not pursue that issue further because there is other evidence that serves to maintain “commercial photographic services”.

Exhibit “J” is “a picture from one of my Company’s locations located in Canada which operated in the relevant period and provided the services set out in the registration.” The photograph shows the exterior of a place of business, which appears to offer photographic services. NIAGARA DAREDEVIL is displayed on the exterior. The photograph bears the handwritten notation June 10, 1996 to 2003.

Exhibit “K” is “a picture from one of my Company’s locations which operated in the relevant period in Canada, which shows use of the trade-mark NIAGARA DAREDEVIL in association with pictures, t-shirts, mugs and postcards and provided the services set out in the registration.”

The photograph shows a display around a sign that displays the trade-mark NIAGARA DAREDEVIL. The display includes a t-shirt, a mug, and what appear to be photographs. I cannot tell if postcards are part of the display and I agree with the requesting party that if the registrant sold postcards, then it ought to have provided clearer evidence concerning such sales.

In *Sara Lee Corp. v. Naylor* (2006), 52 C.P.R. (4<sup>th</sup>) 412 (T.M.O.B.), the Senior Hearing Officer discussed evidence that was similar to Exhibit “K” as follows:

Concerning the appearance of the words EVOLUTION SPORTSWEAR on signage at kiosks which the affiant has indicated were set up in shopping malls in every major cities in Canada, I am satisfied that the use as shown thereon (Exhibit C to the affidavit) is use of the words EVOLUTION SPORTSWEAR both as a trade name and as a trade-mark in association with the registrant's business but also use as a trade-mark for the wares. In my view, the display of the trade-mark in such close proximity to the wares would provide the required notice of association between the trade-mark and the wares to the purchaser.

#### Conclusion

It would appear that the registrant’s business consists primarily of taking photographs of visitors to the Niagara Falls area and superimposing their photos into a picture of a barrel cascading over the falls. The composite picture is then either sold as is, or is applied to a t-shirt, mug, *etc.* that is then sold.

Based on Exhibits “C” and “D”, I am satisfied that the registrant used NIAGARA DAREDEVIL as a trade-mark in Canada in association with “commercial photography services” during the relevant time period. Exhibits “J” and “K” further support such a conclusion. I note that in *Sim & McBurney v. Gesco Industries, Inc. and The Registrar of Trade-marks* (2000), 9 C.P.R. (4<sup>th</sup>) 480 (F.C.A.) the Court of Appeal held that it does not matter whether services are independently offered to the public or are ancillary or incidental to the sale of wares; a trade-mark is deemed to be used in association with services if it is displayed in the advertising of those services.

However, there is no evidence concerning use of the Mark in association with “advertising and promotion of entertainment and amusement facilities at a tourist resort area, namely Niagara Falls”, and so those services will be removed from the statement of services.

Regarding the wares, I have concluded that the following wares should be maintained in the registration: t-shirts and souvenir mugs. After all, we do have Mr. Wolffe’s sworn statement that these wares were sold in Canada during the relevant time period, an example of each ware, and a photograph showing how the Mark was associated with such wares, which satisfies the requirements of s. 4. However, the remaining wares should be struck from the registration due to the lack of evidence showing how the Mark has been used in association with such wares.

For the foregoing reasons, the statement of wares and services in registration No. TMA332,763 will be amended to read only “commercial photographic services”, “souvenir items, namely t-shirts” and “souvenir mugs”, in accordance with the provisions of s. 45(5) of the Act.

DATED AT TORONTO, ONTARIO THIS 15th DAY OF NOVEMBER 2007.

Jill W. Bradbury  
Member  
Trade-marks Opposition Board