



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

Citation: 2012 TMOB 213
Date of Decision: 2012-11-30

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by 4358376 Canada Incorporated against
registration No. TMA643,975 for the trade-mark
IBUYTRAVEL in the name of 770879 Ontario Limited.**

[1] At the request of 4358376 Canada Incorporated (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 February 7, 2011 to 770879 Ontario Limited (the Registrant), the registered owner of registration No. TMA643,975 for the trade-mark IBUYTRAVEL (the Mark).

[2] The Mark is registered for use in association with the following wares: books, manuals, training manuals and other manuals for similar purposes, printed newsletters featuring travel opportunities (the Wares).

[3] The Mark is also registered for use in association with the following services:

Arranging and organizing travel and arranging, organizing and conducting travel tours and vacation packages, including packaged vacation and travel tours. Arranging, organizing of transportation by air, by land and by water, for individual travelers and for groups, car rental reservation services, providing and managing frequent traveler benefit programs for others. Arranging, organization of cruise travel, hotel and motel reservation services. Reservation of lodgings, coordination of travel and lodging arrangements, for individual travelers and for groups (the Services).

[4] 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 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 between February 7, 2008 and February 7, 2011.

[5] The relevant definitions of “use” are set out in section 4 of the Act:

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.

[6] 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 wares and services specified in the registration.

[7] In response to the Registrar’s notice, the Registrant filed the affidavit of Paul Massardo, an officer of the Registrant, sworn on April 4, 2011. Only the Requesting Party filed written representations; an oral hearing was not held.

[8] In his affidavit, Mr. Massardo attests that the Registrant is a travel agency operating under the business name Collins Travel American Express Travel Services, the services of which include the arranging of travel, organizing of tour packages and the managing of travel reservations. In particular, he states that since October 31, 2005, the Registrant operated a website at *www.ibuytravel.ca*, allowing its customers to “research, arrange and reserve travel of every nature and kind”. He attests that “for a brief period in 2009”, the website became non-functional due to the bankruptcy of the company which provided the website’s booking engine. However, he goes on to state that once the Registrant became aware of the problem, it entered into a booking engine agreement with another company and that “as of the date of [the affidavit], the website is fully functional”.

[9] Mr. Massardo attests that notwithstanding the aforementioned non-functionality of the website in 2009, the Registrant “continued to promote and advertise the website” and continually “used the Mark in providing travel services and travel publications” during the Relevant Period. In support of this assertion of use, Mr. Massardo attaches the following exhibits to his affidavit:

- Exhibit C is a copy of a domain report for the *www.ibuytravel.ca* URL. I note that the second page of the report appears to show the traffic history for the domain for January and February 2011; however, Mr. Massardo does not attest to the significance of the traffic usage shown.
- Exhibit D is a copy of a “Booking Engine Sublicense Agreement” dated November 16, 2010 between the Registrant and Ensemble Travel Ltd.
- Exhibit E is a “Summary Directory Advertising Contract” between the Registrant and the Yellow Pages Group, which Mr. Massardo attests show the Registrant’s purchases of advertisements during the Relevant Period.
- Exhibit F is a copy of an advertisement proof, which Mr. Massardo attests is a “Collins Travel 2009 Yellow Pages advertisement”. The advertisement displays, in part, the following: “Cruise & Travel Centre – Airfare – Sell-Offs – Rail – Tours – Corporate – Escorted Tours – Customized Vacations” and “web: *www.ibuytravel.ca*” above “email: *info@ibuytravel.ca*”.
- Exhibit G is copies of three advertisement proofs, which Mr. Massardo identifies as copies of the “Collins Travel 2008 Canpages advertisement”; the information displayed on these advertisements is similar to the information displayed in the Exhibit F advertisement.
- Exhibit H is a copy of the Registrant’s letterhead, which Mr. Massardo states has been in continuous use since 2005. Displayed in the right hand margin is the Registrant’s business name, address, telephone and facsimile numbers and its website address, *www.ibuytravel.ca*.

- Exhibit I contains copies of emails between Mr. Massardo and two customers dated within the Relevant Period. Mr. Massardo's signature includes the following: "Vacation Travel www.ibuytravel.ca" and I note that the first e-mail references a hotel and an e-ticket for a flight to San Juan.

Use with respect to the Wares

[10] With respect to the Wares, although Mr. Massardo attests that the Registrant "also provides various wares describing travel opportunities", he provides no evidence of sales in Canada with respect to any of the Wares. As mere assertions of use are not sufficient to demonstrate use [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)], I cannot conclude that the Registrant has demonstrated use of the Mark in association with the Wares within the meaning of sections 4 and 45 of the Act.

Use with respect to the Services

[11] As noted above, the Registrant provides evidence of four advertisements from the Relevant Period at Exhibits F and G to Mr. Massardo's affidavit. The Requesting Party submits that these exhibits are mere proofs and it notes that no signatures appear on the documents confirming their approval. However, Mr. Massardo specifically attests that these exhibits are 2009 Yellow Pages and 2008 Canpages advertisements and I note that three of the four advertising proof sheets are signed by Mr. Massardo, indicating the Registrant's approval of the advertisements for publication.

[12] Furthermore, the Mark, as incorporated into the domain name www.ibuytravel.ca and the email address info@ibuytravel.ca appears on all the advertisements. While the Exhibit G advertisements are signed for approval on January 10, 2008, I accept that they would have appeared during the Relevant Period.

[13] I also note that the Mark, as incorporated into the aforementioned domain name, also appears on the Registrant's letterhead (Exhibit H) and in the signature portion of the Exhibit I emails between the Mr. Massardo and the Registrant's clients (Exhibit I).

[14] As noted by the Requesting Party, the mere registration of a domain name does not constitute use of a trade-mark for purposes of section 4 of the Act [see *Sun Media Corporation v The Montreal Sun (Journal Anglophone) Inc*, 2011 TMOB 15]. However, while the domain name registration at Exhibit C alone would not be sufficient to demonstrate use of the Mark, the Registrant's evidence goes beyond such mere registration, as the domain name is displayed on advertisements (Exhibits F and G), letterhead (Exhibit H) and emails (Exhibit I).

[15] As such, the Requesting Party further submits that the use of the Mark shown, as incorporated into the domain name and email address, "merely function[s] to direct consumers to the Registrant's e-mail and website addresses and do not function as a trademark to distinguish any wares or services from one trader to another". I note, however, that such a determination is beyond the scope of a section 45 proceeding. As stated by the Court of Appeal in *United Grain Growers Ltd v Lang Michener* (2001), 12 CPR (4th) 89 (FCA) at 14:

No words in section 45 direct the Registrar to re-examine whether the registered trade-mark is used for the purpose of distinguishing, or so as to distinguish, wares. Rather, the Registrar's duty under section 45 is only to determine, with respect to the wares specified in the registration, whether the trade-mark, as it appears in the register, has been used in the three years prior to the request.

[16] Accordingly, whether the display of *www.ibuytravel.ca* and the associated e-mail address constitutes use of the Mark as registered is an issue of deviation. However, in applying the principles as set out in *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA*, (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc*, (1992), 44 CPR (3d) 59 (FCA), I consider the addition of "www." and ".ca" to be a minor deviation from the Mark. In my view, the dominant features of the Mark are preserved, as the additional matter is of a descriptive nature in order to form the website address. As such, the identity of the Mark is preserved and the deviation would not, in my opinion, mislead an unaware purchaser [per *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)].

[17] The evidence in this case is not strong. In particular, it is odd that, notwithstanding Mr. Massardo's statement that the Registrant's website is "fully functional" as of the date of his affidavit, no evidence is before me as to the actual content of the website. However, the display

of the Mark on advertising is sufficient to meet the requirements of section 4(2) when the trade-mark owner is offering and prepared to perform those services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)]. Furthermore, in the context of a section 45 proceeding, the evidence as a whole must be considered and focusing on individual pieces of evidence is not the correct approach [*Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)]. The burden on the owner in a section 45 proceeding is not onerous and a trade-mark will be maintained so long as there is some use within the three year period preceding the section 45 notice [*Brouillette Kosie Prince v Great Harvest Franchising Inc* (2009), 77 CPR (4th) 247 (FC)].

[18] As such, in view of the affidavit generally and the exhibited advertisements in particular, I am satisfied that the Registrant has demonstrated use of the Mark in association with the services of a travel agency generally and the following Services as registered in particular:

- Arranging and organizing travel and arranging, organizing and conducting travel tours and vacation packages, including packaged vacation and travel tours.
- Arranging, organizing of transportation by air, by land and by water, for individual travelers and for groups.
- Arranging, organization of cruise travel, hotel and motel reservation services.
- Reservation of lodgings, coordination of travel and lodging arrangements, for individual travelers and for groups.

[19] However, notwithstanding that services are to be interpreted broadly [*Venice Simplon-Orient Express Inc v Société nationale des chemins de fer français* (2000), 9 CPR (4th) 443 (FCA)], I am not satisfied that the Registrant has provided any evidence to support the registration with respect to “car rental reservation services” and “providing and managing frequent traveler benefit programs for others”. Furthermore, notwithstanding that Mr. Massardo indicates that the Registrant’s website was non-functional for “a brief period” in 2009, there is no evidence of special circumstances to excuse non-use of the Mark before me. The registration will be amended accordingly.

Disposition

[20] 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 amended to delete all of the Wares and “car rental reservation services” and “providing and managing frequent traveler benefit programs for others” from the statement of services.

[21] The amended statement of services will be as follows:

Arranging and organizing travel and arranging, organizing and conducting travel tours and vacation packages, including packaged vacation and travel tours. Arranging, organizing of transportation by air, by land and by water, for individual travelers and for groups. Arranging, organization of cruise travel, hotel and motel reservation services. Reservation of lodgings, coordination of travel and lodging arrangements, for individual travelers and for groups.

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