



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

Citation: 2017 TMOB 70

Date of Decision: 2017-06-19

IN THE MATTER OF A SECTION 45 PROCEEDING

Feltmate/Delibato/Heagle LLP

Requesting Party

and

In Publications Inc.

Registered Owner

TMA820,994 for WHAT'S INSTORE

Registration

design

[1] At the request of Feltmate/Delibato/Heagle LLP (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 August 27, 2015, to In Publications Inc. (the Owner), the registered owner of registration No. TMA820,994 for the trade-mark WHAT'S INSTORE design (the Mark), shown below:

what's **INSTORE**

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

GOODS

Printed material, namely, magazines and magazine supplements to newspapers.

SERVICES

(1) Advertising services, namely, advertising the wares and services of others, preparing

advertising for others, direct mail advertising and selling the wares and services of others by mail and by door-to-door distribution.

(2) Promotional services, namely, promoting the goods and services of others through the distribution of printed material and magazines and promoting the sale of goods and services of others through the distribution of printed material and magazines.

[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 goods 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 the trade-mark was last used and the reason for the absence of such use since that date.

[4] In this case, the relevant period for showing use is between August 27, 2012 and August 27, 2015.

[5] The relevant definitions of “use” are set out in sections 4(1) and 4(2) of the Act as follows:

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

4(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] 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 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 goods and services specified in the registration during the relevant period [*John Labatt Ltd v Rainer Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)].

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Janice Steeles, Director of the Owner, sworn on November 3, 2015 in Richmond Hill, Ontario. Only the Requesting Party filed written representations; an oral hearing was not requested.

The Owner's Evidence

[8] In her brief affidavit, Ms. Steeles states the following:

1 THAT I am a Director of In Publications Inc. (the "Registered Owner"), and as such have direct personal knowledge of the matters hereinafter referred to.

2 THAT the Registered Owner has used the registered trade-mark in Canada at least monthly during the three-year period immediately preceding August 27th, 2015 (the date of the Notice) with respect to each of the goods and services specified in the registration. Evidence of such use is included in Schedule "A" attached hereto.

[9] Schedule A consists of a list of the attachments to the affidavit. They are listed in the schedule as follows:

- (i) September, 2012 Edition of WHAT'S INSTORE Magazine
- (ii) January, 2013 Edition of WHAT'S INSTORE Magazine
- (iii) June, 2013 Edition of WHAT'S INSTORE Magazine
- (iv) February, 2014 Edition of WHAT'S INSTORE Magazine
- (v) August, 2014 Edition of WHAT'S INSTORE Magazine
- (vi) December, 2014 Edition of WHAT'S INSTORE Magazine
- (vii) January, 2015 Edition of WHAT'S INSTORE Magazine
- (viii) various door knob flyers

[10] I note that Ms. Steeles appears to have initialled the bottom of the schedule page.

[11] The magazines themselves include articles about various subject matters, but consist primarily of advertisements for a variety of businesses located in southern Ontario. I note that the bottom of the cover for the "June 2013" issue lists several southern Ontario towns and includes the following text: "Delivered to 100,000 Households Monthly".

[12] The “various door knob flyers” all bear dates within the relevant period and each displays the Mark along with the name of a southern Ontario town at the top of the flyer. The flyers each advertise six businesses, ranging from a Thai restaurant to a car dealership.

Analysis

[13] As a preliminary matter, in its written representations, the Requesting Party submits that the affidavit should be rejected as a whole, as it fails to comply with the *Federal Court Rules*, in particular with respect to the proper endorsement of exhibits. The Requesting Party notes that “neither the ‘Schedule A’ nor any of the documents following and stapled to the Signing Page have been stamped as exhibits in accordance with Section 80(3) of the *Federal Court Rules*, SOR/98-106.” The Requesting Party submits that, as the decision of the Registrar may be appealed to the Federal Court, “it is incumbent on the Owner to submit its Affidavit in accordance with the *Federal Court Rules*.”

[14] However, the Act and associated regulations are silent as to the form of the affidavit or statutory declaration to be filed in a proceeding before the Registrar. It is well established that the Registrar does not strictly adhere to the *Federal Court Rules*, in particular with respect to the admissibility of exhibits [see, for example, *Maximilian Fur Co Inc v Maximillian for Men’s Apparel Ltd* (1983), 82 CPR (2d) 146 (TMOB); *Tension 10 Inc v Tension Clothing Inc* (2004), 45 CPR (4th) 136 (TMOB); and *Gowling Lafleur Henderson LLP v Croxall*, 2013 TMOB 1, 109 CPR (4th) 148].

[15] Indeed, the Federal Court has cautioned against technical deficiencies being a bar to a successful response to a section 45 notice [see *Baume & Mercier SA v Brown* (1985), 4 CPR (3d) 96 (FCTD)].

[16] In this case, Ms. Steeles references Schedule A in her affidavit, which in turn lists the various exhibits provided. In the circumstances, I see no reason to revisit the Registrar’s decision to make the affidavit with attached exhibits of record in this proceeding.

[17] The issue is whether the affidavit and attached exhibits demonstrate use of the Mark in association with each of the registered goods and services.

[18] In this respect, Ms. Steeles' affidavit is remarkably brief, providing little to no explanatory details regarding the exhibited magazines and flyers.

[19] Nevertheless, although a registered owner is "playing with fire" when it allows exhibits to speak for themselves, it is the affidavit as a whole that must be considered and reasonable inferences can be made from the evidence provided [see *Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64, 48 CPR (4th) 223 (FCA)]. Indeed, for purposes of a section 45 proceeding, all that is required is that the registered owner establish a *prima facie* case of use of the trade-mark [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184, 90 CPR (4th) 428].

[20] Here, the Requesting Party submits that "there is no evidence that any printed material was ever distributed publicly". However, in *Riches, McKenzie & Herbert LLP v Park Pontiac Buick GMC Ltd*, 2005 CarswellNat 4408 (TMOB), the Registrar stated the following at paragraph 9:

... it would go against reason to conclude that none of the 25,000 automobiles and trucks were transferred during the three years in question as that would require one to accept that an active car and truck dealership was operating for three years with no sales.

[21] Similarly, I find it would go against reason to conclude that the exhibited magazines were never distributed in Canada during the relevant period. The magazines include advertisements for numerous businesses, and all bear dates within the relevant period. As noted above, one of the exhibited magazines references distribution to "100,000 households"; this supports such an inference. While it would have been better had Ms. Steeles provided at least some particulars with regards to distribution, I accept in this case that, to a degree, the exhibits do speak for themselves.

[22] Although the Requesting Party focuses on the fact that there is no evidence of "sales" of the exhibited magazines, it is important to note that section 4(1) of the Act merely requires "transfers", rather than "sales" *per se*. Given the nature of the goods, being magazines that advertise the products and services of third parties, I accept that the free distribution of such magazines constitutes a "transfer ... in the normal course of trade" within the meaning of section

4(1) of the Act [see *Now Communications Inc v Chum Ltd*, 2000 CarswellNat 3331 (TMOB) at paragraph 9, for a similar finding on similar facts].

[23] Having inferred and accepted that the magazines were distributed in Canada during the relevant period, I am satisfied that the evidence demonstrates use of the Mark in association with “Printed material, namely, magazines” within the meaning of sections 4 and 45 of the Act. However, I am unable to conclude or infer that any of the magazines were distributed as “supplements to newspapers”. In the absence of particulars from Ms. Steele or any representations from the Owner, the registration will be amended accordingly.

[24] With respect to the registered services, again, having accepted that the magazines and door knob flyers were distributed in Canada during the relevant period, it follows that such distribution satisfies use of the Mark in relation to services (2) and “advertising the wares and services of others” from services (1). Clearly, the magazines and flyers serve to advertise and promote the goods and services of others. I accept that, at a minimum, the distribution of the magazines and flyers themselves constitutes advertisement of such services and the ability to perform them in association with the Mark, if not the performance of such services directly.

[25] However, with respect to the remainder of services (1), “preparing advertising for others, direct mail advertising and selling the wares and services of others by mail and by door-to-door distribution”, in the absence of further particulars or even representations from the Owner, I am not prepared to accept that the exhibits demonstrate performance of these more particular services. In contrast to the simple aforementioned advertising and promotional services, it is not clear how the exhibited magazines or flyers constitute “*selling* the wares and services of others...” or even “*preparing* advertising for others”.

[26] As for “direct mail advertising”, in the absence of any explanation as to whether the inferred distribution constitutes *direct mail* advertising, I am not prepared to take the further step of inferring that it does in this case.

[27] As such, with respect to the registered services, I am only satisfied that the Owner has demonstrated use of the Mark in association with services (2) and “Advertising services, namely,

advertising the wares and services of others” from services (1) within the meaning of sections 4 and 45 of the Act.

[28] As there is no evidence of special circumstances excusing any non-use of the Mark before me, the registration will be amended accordingly.

Disposition

[29] 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 “magazine supplements to newspapers” from the statement of goods as well as the following from services (1): “... preparing advertising for others, direct mail advertising and selling the wares and services of others by mail and by door-to-door distribution”.

[30] The amended statement of goods and services will be as follows:

GOODS

Printed material, namely, magazines.

SERVICES

(1) Advertising services, namely, advertising the wares and services of others.

(2) Promotional services, namely, promoting the goods and services of others through the distribution of printed material and magazines and promoting the sale of goods and services of others through the distribution of printed material and magazines.

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

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

Bruce D. Margles

For the Registered Owner

Feltmate/Delibato/Heagle LLP

For the Requesting Party