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

Citation: 2017 TMOB 97

Date of Decision: 2017-08-15

IN THE MATTER OF A SECTION 45 PROCEEDING

Deeth Williams Wall LLP	**Requesting Party**
and	
Langham Hotels International Limited	**Registered Owner**
TMA509,590 for CHELSEA HOTEL	**Registration**

[1] At the request of Deeth Williams Wall 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 November 24, 2014 to Delta Hotels Limited/Hotels Delta Limitée, the registered owner at that time of registration No. TMA509,590 for the trade-mark CHELSEA HOTEL (the Mark).

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

> Operation of a business providing hotel and resort accommodation and related services, namely, hotel, restaurant, discotheque and entertainment services, namely live shows, piano playing and big screen events and bar services; services provided by a recreational center offering electronic arcade games, computer games, electronic and non-electronic pinball games, pool tables, table tennis, fooseball tables and television and video presentations; convention, banquet, catering and conference room services; facsimile and typing services; dry cleaning services; health spa and exercise facility services; travel arrangement and tour services; and gift and convenience store services.

[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 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.

[4] In this case, the relevant period for showing use is November 24, 2011 to November 24, 2014.

[5] The definition of use with respect to services is set out in section 4(2) of the Act, as follows:

> 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 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 and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270].

[7] Subsequent to the issuance of the notice, on December 9, 2014, the Registrar recorded a change in title of the registration to Langham Hotels International Limited (the Owner), discussed further below.

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Josef Ebner, a Regional Vice President of the Owner, sworn on October 26, 2015 in Toronto. Only the Owner filed written representations; a hearing was not requested.

THE OWNER'S EVIDENCE

[9] In his affidavit, Mr. Ebner attests that the Chelsea Hotel, located in Toronto, is the largest hotel in Canada, with 1590 guest rooms. He describes the features of the hotel as follows:

> It currently houses five restaurants offering a wide variety of food and beverages, including a pub that regularly features live music and entertainment, as well as large screen TV's for watching sport events. A "family fun zone" features a family pool and

> water slide; a teen lounge features a foosball table, pool table, air hockey table, arcade game machines, video game consoles and televisions; a kid centre features educational and artistic activities and babysitting services; and an adult pool and fitness centre features whirlpool, saunas, and strength and cardio fitness machines.

[10] He explains that the Chelsea Hotel regularly hosts weddings, conferences and business meeting and other events, and offers concierge services assisting guests with information about dining, sightseeing, entertainment and other attractions. He confirms that the hotel also provides dry cleaning, facsimile and typing services, and has a gift and convenience store located in the main lobby.

[11] In support, attached as Exhibit A to his affidavit are dozens of printouts from the hotel's website, *www.chelseatoronto.com*. The printouts provide information about the amenities and services offered by the hotel and Mr. Ebner confirms that such amenities and services are representative of those offered during the relevant period.

[12] With respect to use of the Mark, Mr. Ebner attests that, beginning in 1975, the Chelsea Hotel was managed by Delta Hotels Limited. As such, he explains that the Mark "was generally featured in a double trademark context, in combination with the DELTA trademark, to reinforce the fact that it was part of the DELTA hotel chain."

[13] Attached as Exhibit B to his affidavit are dozens of examples of such usage in signage, advertisements and other promotional materials from 2005 to 2013. I note that DELTA CHELSEA and DELTA CHELSEA HOTEL appear throughout these materials. Also appearing throughout the materials is the DELTA CHELSEA logo, including in a photograph from 2012 which shows the logo displayed on the side of the hotel. The logo consists of a stylized "D" above the word DELTA, with the word CHELSEA appearing at the bottom of the logo in a different size and font.

[14] Mr. Ebner confirms that, in January 2013, Delta Hotels assigned ownership of the Mark to the Owner and that operation and management of the Chelsea Hotel was "fully transitioned" to the Owner by July 2013. As noted above, the change in title was recorded by the Registrar on December 9, 2014. A copy of the assignment request is attached as Exhibit C to the affidavit.

[15] Mr. Ebner explains that, subsequent to its acquisition of the hotel, the Owner generally

removed references to the DELTA trade-mark, initially replacing it with the trademark EATON.

[16] The Owner then began to phase out use of the EATON trademark in 2014, "with the intention of using the CHELSEA HOTEL trademark as a stand-alone name and mark." Attached as Exhibit D are various documents and emails from September 2014 to November 2014, "showing active steps taken by [the Owner] during the Relevant Period to this effect."

[17] Mr. Ebner attests that this re-branding effort was communicated to employees and other stakeholders in December 2014. Attached as Exhibits E1 and E2 to Mr. Ebner's affidavit are the letters sent to the Owner's employees and stakeholders, respectively.

[18] Mr. Ebner attests that the re-branding process, including changing of signage and website content, "was largely completed by March 2015". Attached as Exhibit F to his affidavit is "an itemized list of expenses incurred between December 12, 2014 and July 14, 2015 relating to the re-branding process."

[19] Also attached to his affidavit, at Exhibits G1 to G6, are various documents "relating to use and advertising of the CHELSEA HOTEL trademark during the period October 2014 to September 2015". These exhibits consist of the following: press releases (Exhibit G1); media mentions (Exhibit G2); advertisements (Exhibit G3); printouts from the hotel's website (Exhibit G4); photographs of external signage (Exhibit G5); and "mockups of collateral items encountered by hotel guests, including telephone keypads, and stationery" (Exhibit G6).

[20] Mr. Ebner concludes his affidavit by stating that, "While the corporate brands DELTA and EATON have been associated with the hotel at various times, the CHELSEA HOTEL trademark has always […] been the core identity of the institution and, at all relevant times, referred to and recognized in Canada as a brand and mark, in and of itself."

ANALYSIS

[21] First, I note that while the Mark does appear on its own in the website printouts at Exhibit A and in some of the advertising, signage and other materials shown at Exhibit G, it is at best not clear that any such display of the Mark occurred during the relevant period.

[22] However, I do accept Mr. Ebner's statements and supporting exhibits as demonstrating that each of the registered services was offered by the Owner or its predecessor-in-title during the relevant period. The website pages and other marketing materials show that services consistent with Mr. Ebner's statements and the registered services were offered at the hotel during the relevant period.

[23] The issue in this case is whether the Mark as registered was displayed during the relevant period.

[24] The question to be asked is whether the trade-mark was used in such a way that it did not lose its identity and remained recognizable, in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see whether the "dominant features" of the trade-mark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. As expressed in *Promafil* at paragraph 40:

> The law of trademarks does not require the maintaining of absolute identity of marks in order to avoid abandonment, nor does it look to miniscule differences to catch out a registered trademark owner acting in good faith and in response to fashion and other trends. It demands only such identity as maintains recognizability and avoids confusion on the part of unaware purchasers.

[25] Furthermore, a registration for a word mark can be supported by use of that trade-mark in any stylized form and in any colour [see *Stikeman, Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB)] and nothing prevents the display of two trade-marks together [see *AW Allen Ltd v Canada (Registrar of Trade Marks)* (1985), 6 CPR (3d) 270 (FCTD)].

[26] In this case, the Owner submits that use of the DELTA CHELSEA marks by its predecessor-in-title during the relevant period is analogous to use of BEAUMONT CHALET, as described in *Mantha & Associates v Old Time Stove Co Inc* (1990), 30 CPR (3d) 574 (TMOB). In that case, the use of BEAUMONT CHALET was considered to be use of two trade-marks – the mark BEAUMONT designating a line of stoves and the mark CHALET designating a specific model within that line. Applying a similar analysis, the Owner submits that "use of the DELTA name was intended to create an association with the international Delta hotel umbrella

chain, and the CHELSEA HOTEL Trademark was used to identify the specific Chelsea Hotel property located in Toronto, Canada".

[27] With respect to the DELTA CHELSEA logo, the Owner further submits that "the DELTA and CHELSEA HOTEL marks were clearly differentiated through the use of different fonts and sizes, and the marks appeared on separate lines." Again, the Owner submits that the manner of display reinforced the impression of two separate trade-marks being used together, "namely, the DELTA mark to designate the umbrella chain, and the CHELSEA HOTEL Trademark to identify the specific hotel property."

[28] Indeed, in the absence of representations from the Requesting Party, I agree with the Owner that, at a minimum, display of the DELTA CHELSEA logo would have been perceived as a logo, but also as display of the Mark on its own. In this respect, I also accept that the omission of the descriptive word HOTEL constitutes a minor deviation from the Mark as registered.

[29] Given the manner of display of the Mark on external signage and in the exhibited marketing materials relating to the registered services offered during the relevant period, I accept that the Mark was displayed in association with each of the registered services.

[30] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered services within the meaning of sections 4 and 45 of the Act.

[31] As such, it is not necessary to consider the Owner's representations in the alternative with respect to special circumstances. Suffice to say that, while Mr. Ebner's affidavit shows that the Owner's intention to re-brand the hotel began *during* the relevant period, this intention in itself would not constitute special circumstances excusing any non-use of the Mark. Similarly, the demonstrated use of the Mark *after* the relevant period would also not in itself suffice to show that special circumstances existed during the relevant period [see *Smart & Biggar v Scott Paper Ltd*, 2008 FCA 129].

DISPOSITION

[32] 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 maintained.

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

Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l.	For the Registered Owner
Deeth Williams Wall LLP	For the Requesting Party