



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

**Citation: 2019 TMOB 22**

**Date of Decision: 2019-03-18**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Norton Rose Fulbright Canada LLP**

**Requesting Party**

**and**

**Solomon Kennedy trading as**

**Registered Owner**

**Luv Life Productions**

**TMA655,013 for LUV LIFE & Design**

**Registration**

INTRODUCTION

[1] At the request of Norton Rose Fulbright Canada 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 June 28, 2017 to Solomon Kennedy trading as Luv Life Productions (the Owner), the registered owner of registration No. TMA655,013 for the trade-mark LUV LIFE & Design (the Mark). The Mark is depicted below.



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

Goods: Albums, cassettes, C.D.'S, D.V.D.'S; bandanas, hats, sweatbands, socks, undergarments, belts, toothbrushes, bathing suits, shirts, sweatshirts, pants, shorts, skirts, shoes, coats, umbrellas, collecting cards, and posters.

Services: Production of films, music videos, audio recordings, albums and promotional clothing.

[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 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 June 28, 2014 to June 28, 2017.

[4] The relevant definitions of use are set out in section 4 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.

[5] 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 in these proceedings is 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 Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[6] Pursuant to the Registrar's notice, the Owner had a deadline of September 28, 2017 in which to file its evidence. In response to the Registrar's notice, on August 11, 2017, the Owner filed the statutory declaration of Solomon Kennedy dated August 10, 2017 (the Kennedy Declaration). Both parties filed written representations. An oral hearing was not requested.

[7] In the written representations filed by the Owner on April 30, 2018, the Owner sought to include additional evidence (identified as Exhibits 1 through 4 to the Owner’s written representations), namely, the following:

- Exhibit 1 - Affidavit of Dr. Paul Chan dated April 23, 2018;
- Exhibit 2 - Affidavit of Solomon Kennedy dated April 25, 2018;
- Exhibit 3 – T5 Statement of Investment Income;
- Exhibit 4 - Affidavit of Jeremy Allen dated April 25, 2018.

(I will refer to the above Exhibits collectively as the “Additional Evidence”)

[8] The Additional Evidence included with the Owner’s written representations was filed more than six months after the deadline for filing the Owner’s evidence had expired, and was filed after the Owner received the Requesting Party’s written representations. In this respect, I note that there is no provision for the filing of reply evidence in a section 45 proceeding. Consequently, the Additional Evidence included with the Owner’s written representations is not admissible and was not made of record as evidence in this proceeding [see *Sim & McBurney v Home Management Systems Inc* (2003), 31 CPR (4th) 393 (TMOB); *Gowling Lafleur Henderson LLP v Parkland Industries Ltd*, 2017 TMOB 142, 156 CPR (4th) 478; *Gowling Lafleur Henderson LLP v Netlease Inc*, 2018 TMOB 33, 156 CPR (4th) 82].

[9] In any event, as discussed in further detail, below, even if the Additional Evidence had been admissible, I would have found that this Additional Evidence did not demonstrate use of the Mark during the relevant period and did not demonstrate special circumstances excusing the absence of use.

## THE EVIDENCE

### **(a) Kennedy Declaration dated August 10, 2017**

[10] The Kennedy Declaration is brief; the substantive portion reads in its entirety as follows:

1. Luv Life Productions is still using its trade “name” and “design” primarily for film and video as recently as May 2017 to present, currently in production of a film/video entitled Son of (wo)Man. Upon completion of this current project there

will be a whole new line of merchandise including but not limited to all the registered goods associated with the Luv Life Trade “Name” and “Design”.

2. Please see attached certificate of insurance for this current Production with certificate #17228 dated May 1, 2017.

[11] Attached to the Kennedy Declaration is a document entitled “Certificate of Insurance” dated May 1, 2017. This document identifies “Luv Life Productions, Solomon Kennedy” as the Production Company at the top left of the document. “Luv Life Productions, Solomon Kennedy” is also identified as the insured party in two locations in the body of the document.

[12] While the Certificate of Insurance included with the Kennedy Declaration is not separately notarized as an exhibit, I accept it as admissible evidence in this proceeding because it is described in paragraph 2 of the body of the Kennedy Declaration [see *Gowling Lafleur Henderson LLP v Croxall*, 2013 TMOB 1, 109 CPR (4th) 148].

**(b) Additional Evidence**

[13] As discussed above, the Additional Evidence included in the Owner’s written representations is **not** admissible. Nevertheless, I have briefly summarized its contents below.

***Exhibit 1 - Affidavit of Dr. Paul Chan dated April 23, 2018***

[14] Dr. Chan, a physician, indicates that on or about March 24, 2015, the father of the Owner, as a result of kidney failure, had surgery to prepare him for hemodialysis.

***Exhibit 2 - Affidavit of Solomon Kennedy dated April 25, 2018 (the Kennedy Affidavit)***

[15] Mr. Solomon states that he is “a professional music and video producer trading under the Luv Life & Design trade-mark”. He states that as of March 2015 he has acted as a full-time caregiver to his father.

[16] Mr. Solomon states that he “started producing a production titled “Son of Man” on July 30, 2016 under the Luv Life & Design trade-mark”, and describes multiple other individuals which he has hired to work on the production between July 2016 and May 2017.

[17] Mr. Solomon states that at various times in 2016 he received “music royalties under the Socan music platform for performances of written works produced and published by Luv Life & Design”.

[18] While the Kennedy Affidavit makes multiple references to “the Luv Life & Design trademark”, there are no exhibits or other evidence included with the Kennedy Affidavit which demonstrate the display of the specific design Mark at issue.

***Exhibit 3 – T5 Statement of Investment Income***

[19] This document is entitled “T5 Statement of Investment Income” for the year 2016 from the Canada Revenue Agency, wherein the recipient is identified as “LUV LIFE PRODUCTIONS C/O SOLOMON KENNEDY” and the payer’s name is identified as “SOCAN”.

***Exhibit 4 - Affidavit of Jeremy Allen dated April 25, 2018 (the Allen Affidavit)***

[20] Mr. Allen indicates that he is a Contractor/Associate Producer and that “on July 30, 2016 I was hired on the Luv Life & Design production, Son of Man, as an associate producer.” His affidavit describes various tasks he performed as part of that role.

[21] While the Allen affidavit makes multiple references to “Luv Life & Design”, as with the Kennedy Affidavit, there are no exhibits or other evidence included with the Allen Affidavit which demonstrate the display of the specific design Mark at issue.

**ANALYSIS**

**(a) Evidence of Record – the Kennedy Declaration**

[22] As a threshold issue, as noted by the Requesting Party in its written representations, the Kennedy Declaration filed by the Owner does not include any evidence of use of the Mark as registered. In particular, the Kennedy Declaration does not include any exhibits or other evidence which show the display of the Mark in association with any of the listed goods and services.

[23] At best, the Certificate of Insurance included with the Kennedy Declaration only demonstrates the display of the phrase “Luv Life Productions, Solomon Kennedy”. This does not

constitute use of the specific design Mark as registered. The design element of the Mark, in particular the illustration of a person between the words “LUV” and “LIFE”, in my view, is an essential and dominant feature of the Mark. In these circumstances, display of the phrase “Luv Life Productions, Solomon Kennedy”, without any of the essential design elements of the Mark, constitutes a substantial deviation that does not maintain the dominant features of the Mark, and therefore is not sufficient to constitute use of the Mark [see *Clic International Inc v Convenience Food Industries (Private) Limited*, 2011 FC 1338, 97 CPR (4th) 420 and *Bereskin & Parr v Star-Kist Foods, Inc* (2004), 37 CPR (4th) 61 (TMOB); see also *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA) for discussion of the principles regarding trademark deviation].

[24] In addition, the display of the phrase “Luv Life Productions, Solomon Kennedy” on the Certificate of Insurance does not constitute advertising or performance of the registered services in association with the Mark for the purpose of section 4(2) of the Act.

[25] Further, the Kennedy Declaration provides no evidence of sales or transfers of any goods in association with the Mark during the relevant period or otherwise. Indeed, paragraph 1 of the Kennedy Declaration indicates that “there will be a whole new line of merchandise including but not limited to all the registered goods [...]”. This statement is prospective in nature and further suggests that there was no use of the Mark in association with the listed goods during the relevant period.

[26] Ultimately, the Kennedy Declaration is the only evidence of record from the Owner in this proceeding, and it does not demonstrate use of the Mark in Canada during the relevant period in association with the registered goods and services.

[27] Furthermore, as discussed further below, there is no evidence demonstrating special circumstances excusing the absence of use.

**(b) Additional Evidence**

[28] In its written representations, the Owner sought to rely on the Additional Evidence which it contends demonstrates use of the Mark during the relevant period or special circumstances excusing the absence of use.

[29] As the Additional Evidence is not admissible, it is not necessary to consider whether it demonstrates use of the Mark or special circumstances excusing non-use. In any event, for the reasons set out below, had the Owner's Additional Evidence been admissible, I would have found that it did not demonstrate use of the Mark during the relevant period or special circumstances excusing the absence of use.

#### No use of the Mark as registered

[30] As with the Kennedy Declaration, discussed above, the Additional Evidence includes no evidence of the use of the design Mark as registered in association with the registered goods and services. While the Kennedy Affidavit and Allen Affidavit include multiple references to "Luv Life & Design", neither affidavit includes any exhibits or other evidence which actually show the display of the Mark. It is well established that mere assertions of use are insufficient in the context of a section 45 proceeding (*Plough, supra*); an owner must substantively show how the trade-mark as registered was used during the relevant period.

[31] Consequently, even if it had been made of record in this proceeding, the Additional Evidence does not demonstrate use of the Mark in Canada during the relevant period.

#### Special Circumstances

[32] In the absence of evidence of use of a trade-mark during the relevant period, the issue is whether, pursuant to section 45(3) of the Act, special circumstances existed to excuse such non-use. The general rule is that absence of use should result in expungement, but there may be an exception where the absence of use is due to special circumstances [*Scott Paper Ltd v Smart & Biggar*, 2008 FCA 129, 65 CPR (4th) 303].

[33] To determine whether special circumstances have been demonstrated, the Registrar must first determine why the trade-mark was not used during the relevant period. Second, the Registrar must determine whether those reasons for non-use constitute special circumstances [*Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA)]. Special circumstances means circumstances or reasons that are unusual, uncommon, or exceptional [*John Labatt Ltd v Cotton Club Bottling Co* (1976), 25 CPR (2d) 115 (FCTD)].

[34] If the Registrar determines that the reasons for non-use constitute special circumstances, the Registrar must still decide whether such circumstances excuse the period of non-use. This determination involves the consideration of three criteria: (i) the length of time during which the trade-mark has not been in use; (ii) whether the reasons for non-use were beyond the control of the registered owner; and (iii) whether there exists a serious intention to shortly resume use [per *Harris Knitting Mills, supra*].

[35] Circumstances beyond the control of the registered owner for part of the relevant period are not sufficient. The special circumstances must apply to the entire relevant period [*Oyen Wiggs Green & Mutala LLP v Rath*, 2010 TMOB 34, 82 CPR (4th) 77].

[36] Furthermore, the intention to shortly resume use must be substantiated by “a sufficient factual basis” [*NTD Apparel Inc v Ryan*, 2003 FCT 780, 27 CPR (4th) 73 at para 26; see also *Arrowhead Spring Water Ltd v Arrowhead Water Corp* (1993), 47 CPR (3d) 217 (FCTD)].

[37] In the present case, the Additional Evidence suggests that the Owner’s obligation to care for his ill father as of March 24, 2015 was the reason for the non-use of the Mark. However, the Additional Evidence indicates – and the Owner expressly acknowledges at paragraphs 4 and 5 of its written representations – that these circumstances did not apply to the *entire* relevant period, but only to a portion of the relevant period. In particular, there is no evidence from the Owner as to why the Mark was not in use from the beginning of the relevant period, namely, June 28, 2014, to the time when the asserted special circumstances arose. Also, the Additional Evidence describes steps taken by the Owner as of July 30, 2016 to commence production; however, as discussed above, none of that evidence demonstrated any use of the Mark.

[38] Thus, even if I were to consider the circumstances described by the Owner as special circumstances, they do not account for the entire period of non-use and do not account for the entire relevant period. Thus, the Additional Evidence would not constitute special circumstances excusing the absence of use during the relevant period.

[39] In addition, the first and third criteria from *Harris Knitting Mills, supra*, weigh against the Owner. There is no evidence whatsoever as to when use of the Mark last took place prior to the relevant period. As the Mark was registered on December 14, 2005, and the Owner has not



provided a single example of use of the Mark at any time since the issuance of the registration, this suggests that there has been no use of the Mark for a lengthy period of at least 10 years [see *Marks & Clerk v SC Prodal 94 SRL* (2005), 42 CPR (4th) 279 (TMOB)]. Further, while the Kennedy Declaration includes the forward looking statement “Upon completion of this current project there will be a whole new line of merchandise including but not limited to all the registered goods [...]”, no specifics are provided as to when this might occur, and so we are left in the dark as to whether the Owner will commence or recommence use of the Mark, and if so when that might happen.

[40] In view of the above, even if the Owner’s Additional Evidence had been made of record, I would have found that it does not demonstrate use of the Mark during the relevant period and does not demonstrate special circumstances excusing the absence of use.

#### DISPOSITION

[41] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be expunged in compliance with the provisions of section 45 of the Act.

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Andrew Bene  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

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

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**HEARING DATE** No Hearing Held

**AGENTS OF RECORD**

No Agent Appointed

For the Registered Owner

Norton Rose Fulbright Canada LLP/S.E.N.C.R.L.,s.r.l.

For the Requesting Party