

OPIC



CIPO

LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2020 TMOB 71**

**Date of Decision: 2020-06-15**

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

**Fillmore Riley LLP**

**Requesting Party**

**and**

**Autumn Song Inc. (DBA 'Autumn  
Studios')**

**Registered Owner**

**TMA821,416 for Autumn Studios &  
Design**

**Registration**

INTRODUCTION

[1] At the request of Fillmore Riley LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on April 3, 2018 to Autumn Song Inc. (DBA 'Autumn Studios') (the Owner), the registered owner of registration No. TMA821,416 for the trademark Autumn Studios & Design, depicted below (the Mark).



[2] The Mark includes the following colour claim as identified in the registration: “Colour is claimed as a feature of the trade-mark. The letters are black and the tree is composed of orange, red, yellow and green streaks, and a predominantly black trunk.”

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

Entertainment in the form of live performances from a musical group; wholesale and retail sales of music, spiritual and wellness products, namely CDs and videos.

[4] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between April 3, 2015 and April 3, 2018 (the Relevant Period), in association with the services specified in the registration. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[5] The relevant definition of use is set out in section 4 of the Act as follows:

4(2) A trademark 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 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 trademark in association with each of the services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[7] With respect to services, the display of a trademark on advertising is sufficient to meet the requirements of section 4(2) when the trademark owner is offering and prepared to perform those services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Mark Fenster dated October 26, 2018 (the "Original Fenster Affidavit"). In the written representations filed by the Requesting Party on February 1, 2019, the Requesting Party contested the admissibility of the Original Fenster Affidavit based on alleged technical deficiencies in its swearing. In response, by letter to the Registrar dated May 29, 2019, the Owner requested a retroactive extension of time to file a re-sworn version of Mr. Fenster's affidavit dated May 22, 2019. The re-sworn version of Mr. Fenster's affidavit was identical in content to the Original Fenster Affidavit, except for technical changes to the manner in which it was sworn. In addition, in its May 29, 2019 letter, the Owner also requested a retroactive extension of time to file a Supplemental Affidavit of Mark Fenster, which included additional facts beyond those in the Original Fenster Affidavit.

[9] By ruling of the Registrar dated August 16, 2019, the Registrar granted a retroactive extension of time to the Owner to file the re-sworn version of Mr. Fenster's affidavit dated May 22, 2019, which was made of record. The Registrar denied the Owner's request for a retroactive extension of time to file the Supplemental Affidavit Mark Fenster.

[10] Consequently, it is the re-sworn version of Mr. Fenster's affidavit dated May 22, 2019 that is the evidence of record in this proceeding and which has been considered for the purpose of this decision (for ease of reference, I will refer to it simply as the "Fenster Affidavit"). The Supplemental Affidavit of Mark Fenster is not of record and has not been considered.

[11] Both the Requesting Party and the Owner submitted written representations. A hearing was not requested.

#### OVERVIEW OF THE OWNER'S EVIDENCE

[12] The Fenster Affidavit can be summarized as follows:

- Mr. Fenster is the President and sole shareholder of the Owner [para 1].
- The Owner is an entertainment and media company that produces musical artists, performances and content focusing on spirituality and wellness [para 1].

- The Owner advertised and held a live musical performance entitled “Cantoria 2 – PeaceWeaver” in Burnaby, British Columbia on June 12, 2015 [para 5]. Included as Exhibit “A” to the Fenster Affidavit is a promotional card advertising this musical performance, which bears the Mark. Included as Exhibit “B” is a program for this musical performance provided to the audience members in attendance, also bearing the Mark. Included as Exhibit “C” are sales records from an automated ticketing service showing two purchases of tickets to this musical performance (the purchases dated May 21, 2015 and June 8, 2015 respectively).
- The Owner provides CDs of music in the spiritual and wellness genre for sale on the Owner’s website [para 6]. Included as Exhibit “D” is a screenshot of the Owner’s website showing various music CDs available for sale, with the Mark visible at the top and bottom of the webpage. Mr. Fenster states that these CDs have been continuously available for sale on this webpage since at least 2014, including during the Relevant Period. Included as Exhibit “E” are two examples of CDs available for sale on the Owner’s website, each CD bearing the Mark on its packaging, and each CD being available for sale during the Relevant Period. Included as Exhibit “F” are invoices from the Owner for sales of the CDs to purchasers in Hudson, Quebec and Langley, British Columbia, dated October 9, 2015 and July 10, 2017, respectively. Each of these two invoices also bear the Mark.
- The Owner makes videos of spirituality and wellness music available to the public via the Owner’s YouTube channel [para 7]. Included as Exhibits “G” and “H” are screenshots of the Owner’s YouTube channel displaying the Mark, including videos made available on December 16, 2015, September 26, 2016 and September 30, 2017.

#### ANALYSIS

[13] With respect to the service “[e]ntertainment in the form of live performances from a musical group”, the Owner has demonstrated use of the Mark in association with this service during the Relevant Period, as the Mark was displayed in the performance and advertising of the service. Paragraph 1 of the Fenster Affidavit describes the Owner holding a live musical performance during the Relevant Period on June 12, 2015, and includes evidence of tickets

purchased to that performance. The Fenster Affidavit includes printed advertising material for the performance bearing the Mark, as well as a concert program bearing the Mark distributed to attendees at the performance. I note that this printed material bears the Mark with the words “Autumn Studios” in orange letters rather than black as in the colour claim of the registration; however, I consider this a minor deviation that nevertheless constitutes use of the Mark as registered [see *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA) at para 5].

[14] With respect to the service “wholesale and retail sales of music, spiritual and wellness products, namely CDs”, I am similarly satisfied that the Owner has demonstrated use of the Mark during the Relevant Period. The Fenster Affidavit demonstrates that the Owner offers music CDs available for sale through its website where the Mark is displayed, and did so during the Relevant Period. The CDs themselves also bear the Mark on their packaging. The Fenster Affidavit includes invoices of the sale of these CDs to customers in Quebec and British Columbia during the Relevant Period.

[15] On the specific question of whether the Owner has demonstrated that it engages in “wholesale” and “retail” sales of CDs, I am satisfied that the Owner has demonstrated use of the Mark in association with both types of sales. In particular, the invoice dated September 10, 2015 that is included in Exhibit “F” to the Fenster Affidavit relates to the sale of five copies each of the CDs identified as “Cantoria 2 – PeaceWeaver CD” and “Francis Xavier Edwards – String Poetry”, as well as an item identified as “Cantoria 2 – PeaceWeaver Display Unit & Promo Cards”. The sale of five copies of a CD, along with a display unit, in my view is sufficient to demonstrate the wholesale sale of the product for subsequent resale. The second invoice included in Exhibit “F” to the Fenster Affidavit, dated July 10, 2017, is for the sale of single copies of different CDs, which is consistent with retail sale for personal use.

[16] With respect to the service “wholesale and retail sales of music, spiritual and wellness products, namely [...] videos”, in my view, the Owner has not demonstrated use of the Mark in association with this service for the purpose of section 4. In particular, there is no evidence of record in this proceeding that the Owner has ever sold (either at the wholesale or retail level), offered for sale, or advertised for sale a video. While the Fenster Affidavit demonstrates that the

Owner has displayed music videos on the Owner's YouTube channel in association with the Mark during the Relevant Period, there is no evidence of record that such display of a video constituted a sale of the video to any party, or that the display of the video on the YouTube channel was advertising in furtherance of the subsequent sale of videos. Consequently, in my view, the Owner has not demonstrated use of the Mark in association with "wholesale and retail sales of music, spiritual and wellness products, namely [...] videos" during the Relevant Period, or indeed at any time. As there is no evidence of special circumstances justifying the absence of use, the registration will be amended accordingly to delete reference to "and videos".

#### DISPOSITION

[17] In view of the above, 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 statement of services in the registration will be amended to delete the words "and videos".

[18] The amended statement services will be as follows: "Entertainment in the form of live performances from a musical group; wholesale and retail sales of music, spiritual and wellness products, namely CDs."

---

Timothy Stevenson  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

---

**HEARING DATE** No Hearing Held

**AGENTS OF RECORD**

Taylor Oballa Murray Leyland LLP

For the Registered Owner

Fillmore Riley LLP

For the Requesting Party