



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 48

Date of Decision: 2020-05-25

IN THE MATTER OF SECTION 45 PROCEEDINGS

Trademark Factory International Inc. Requesting Party

and

Sea Tow Services International, Inc. Registered Owner

TMA870,561 for SEA TOW & Design Registrations

and

TMA870,562 for SEA TOW

[1] At the request of Trademark Factory International Inc. (the Requesting Party), the Registrar of Trademarks issued notices under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on February 13, 2017, to Sea Tow Services International, Inc. (the Owner), the registered owner of registration No. TMA870,561 for the trademark SEA TOW & Design (the Design Mark) and registration No. TMA870,562 for the trademark SEA TOW (the Word Mark) (collectively, the Marks). The Design Mark is shown below:



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

(1) Association services, namely, promoting the interests of boaters; membership services, namely, providing discounts to members for the services of others, and arranging for network of franchisees and authorized partners to provide members access to discounted and pre-paid insurance services, travel services, namely rental car and hotel discount services, financial services, namely loan financing and commercial and consumer lending services, marina services, environmental remediation services, namely containment and clean-up of spilled hydrocarbons, namely spilled engine oil, diesel fuel and other engine fluids upon the water or land, educational services, namely boating safety education, marina charting services, on-line information services, namely boating safety information, publications, namely magazines covering issues of interest and news relating to the boating and nautical community, communication services, namely registration of Maritime Mobile Safety Identity numbers for DSC-VHF radios and marine and boat related products.

(2) Marine electrical contracting services and repair and installation of marine electrical apparatus.

(3) Marine charting and consulting services.

(4) Diving and underwater salvage; marine salvage; vessel salvage; marina services, namely, floating dockage; delivery of fuel and other supplies by boat.

[3] Although not articulated identically, with the exception of services (2) above, the Word Mark is registered in association with largely the same services, as follows:

(1) Association services, namely, promoting the interests of boaters; membership services, namely, providing discounts to members for the services of others, and arranging for network of franchisees and authorized partners to provide members access to discounted and pre-paid insurance services, travel services, namely rental car and hotel discount services, financial services, namely loan financing and commercial and consumer lending services, marina services, environmental remediation services, namely containment and clean-up of spilled hydrocarbons, namely spilled engine oil, diesel fuel and other engine fluids upon the water or land, educational services, namely boating safety education, marina charting services, on-line information services, namely boating safety information, publications, namely magazines covering issues of interest and news relating to the boating and nautical community, communication services, namely registration of Maritime Mobile Safety Identity numbers for DSC-VHF radios and marine and boat related products.

(2) Marine, oil, environmental, and hazard services, namely, substance containment, and clean up, and providing equipment for the foregoing; diving and underwater salvage; marine salvage; vessel salvage; marina services, namely, floating dockage; delivery of fuel and other supplies by boat; Marine charting and consulting services.

[4] The notices required the Owner to furnish evidence showing that it had used the Marks in Canada, at any time between February 13, 2014 and February 13, 2017, in association with the services specified in the registrations. If the Marks had not been so used, the Owner was required to furnish evidence providing the date(s) when the Marks were 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(2) 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 notices, the Owner furnished substantially identical affidavits of Joseph Frohnhoefer III, sworn September 12, 2017 in Southold, New York, U.S.A. (the Affidavit).

[9] Both parties filed written representations; however, only the Owner made representations at an oral hearing.

OVERVIEW OF THE OWNER'S EVIDENCE

[10] The Affidavit can be summarized as follows:

- Mr. Frohnhoefer is the Chief Executive Officer of the Owner [para 1].
- The Owner provides a variety of services related to boater assistance, safety and training [para 2]. The Owner's on-water boater assistance services include towing, fuel drops, jump starts, disentanglements, and covered ungroundings, as well as access to experts and navigational assistance [paras 5 to 7].
- The Owner offers memberships that grant members access to such on-water assistance; the Owner had over 200 members with Canadian addresses as of the end of the relevant period [paras 7, 10, 22 to 24, Exhibits A to D, H].
- Memberships are subject to a SEA TOW Membership Agreement (the Agreement) [paras 8 and 9, Exhibit B].
- All members are issued membership cards that display the Marks as well as contact information to obtain assistance [para 10].
- The Owner sent out membership renewal reminders to members during the relevant period, including to members located in Canada [para 13]. These renewal reminders included an overview of membership benefits [Exhibit D].
- The Owner operates a website (*www.seatow.com*) and a downloadable mobile application, through which the Owner describes and advertises its services and membership benefits [paras 7, 15, 16, 25 to 30, Exhibits A, E, F, I to K]. The Marks are displayed throughout the website and app.
- The mobile application in particular offers weather forecasts, tide forecasts, compass and speedometer functions, longitude and latitude location, and "One-Tap on-water assistance directly through Sea Tow's 24-hour Dispatch Center" [para 30].

- SEA TOW members are eligible for third-party discounts and special offers, such as Budget car rental discounts [para 18, Exhibit G].
- During the relevant period, the Owner advertised its services, including boating-related webinars and other educational programs, to its members through emails and electronic newsletters [paras 31 and 32, Exhibit K].

ANALYSIS

[11] At the outset, I agree with the Owner that the Marks were displayed throughout the Owner’s membership materials, website, mobile application and other e-communications and further that such materials were accessed or distributed in Canada during the relevant period.

[12] The main issue in this case is whether, at a minimum, the services advertised in association with the Marks were offered and available to be performed *in Canada* [per *Wenward, supra*].

[13] In this respect, I note that Mr. Frohnhoefer refers to the Owner’s services being available to “Canadian members” throughout his affidavit. For example, Mr. Frohnhoefer attests that, in addition to towing disabled boats for SEA TOW members, the Owner “offers, and did offer and provide to and perform *for Canadian members* during the Relevant Period, the following assistance services [...] a. Salvage and recovery; b. Vessel recovery; c. Spill and environmental clean-up; and d. Catastrophe response” [para 14, emphasis added].

[14] Mr. Frohnhoefer’s phrasing leaves it unclear whether such assistance services aside from towing were actually provided in Canadian waters, given that he focuses on who the services were offered or provided to (*i.e.*, “Canadian members”) rather than the more salient point of where the services were performed or available to be performed (*e.g.*, “in Canadian waters”).

[15] This does not appear to be a case where “Canadian members” is used as shorthand for “members in Canada”, as Mr. Frohnhoefer makes the distinction between “Canadian members” and “persons in Canada” elsewhere in his affidavit [for example, at paragraph 29 in reference to persons who downloaded the SEA TOW mobile application during the relevant period].

[16] This issue is discussed further below in the context of my analysis with respect to each of the registered services. Where relevant and necessary, I will expand on the above overview of the Owner's evidence.

[17] I note that, as there is no evidence of special circumstances before me, the registrations will be amended to delete those registered services for which use has not been demonstrated.

Educational services; On-line Information services

[18] The Requesting Party made no representations specific to the registered "educational services, namely boating safety education" or "on-line information services, namely boating information".

[19] I agree with the Owner that it provided such services through the provision of educational and other information by various means, such as via its website, mobile application and e-communications. Further, these means displayed the Marks and were accessible from Canada during the relevant period.

[20] As such, I am satisfied that the Owner has demonstrated use of the Marks in association with these services within the meaning of sections 4 and 45 of the Act.

Publications, namely magazines

[21] With respect to "publications, namely magazines covering issues of interest and news relating to the boating and nautical community", the Requesting Party submits that use of the Mark has not been demonstrated as the Affidavit does not mention any "magazines".

[22] However, I agree with the Owner that the evidenced SEA TOW e-newsletters fall within the scope of such registered services. Accordingly, I am satisfied that the Owner has demonstrated use of the Marks in association with these services within the meaning of sections 4 and 45 of the Act.

Association services

[23] With respect to “Association services, namely, promoting the interests of boaters”, the Requesting Party submits that, as the Affidavit does not specifically mention these services, there is no evidence of use of the Marks in Canada.

[24] However, as services are to be interpreted broadly, I agree with the Owner that, cumulatively, the boating information services offered to members via the Owner’s website, mobile application and e-communications amounts to the performance of such “association services” during the relevant period in Canada.

[25] As the Marks appear throughout the exhibited materials, I am satisfied that the Owner has demonstrated use of the Mark in association with these services within the meaning of sections 4 and 45 of the Act.

Membership services; Travel services

[26] With respect to “membership services, namely, providing discounts to members for the services of others, and arranging for network of franchisees and authorized partners to provide members access to discounted and pre-paid insurance services” and “travel services, namely rental car and hotel discount services”, Mr. Frohnhoefer states the following at paragraph 18 of the Affidavit:

Active SEA TOW members were and are eligible for discounts and special offers at third party marinas, fuel docks, repair facilities, hotels and other locations when they presented and present their membership cards. For example, SEA TOW members, including Canadian members, received and receive 20% off Budget car rentals [...]

[27] Mr. Frohnhoefer attests that member discounts were advertised through the Owner’s website and through emails sent to SEA TOW members, “including Canadian members” [paras 19 and 20, Exhibit G].

[28] At the hearing, the Owner further directed attention to the exhibited membership renewal application sent to a member with a Canadian address [Exhibit D]. Page 2 of the application references loyalty programs and discounts available to members, such as the following:

SAVINGS at local businesses and on national brands through the Sea Tow Advantage Network™. Discover where you can show your membership card [...] at seatow.com/deals.

[29] In its written representations, the Requesting Party notes that the supporting screenshot shown at paragraph 18 of the Affidavit references “National Deals”. It submits that one must infer that this term refers to discounts only available in the United States.

[30] Indeed, there is no clear indication that that the aforementioned “national brands” or “local deals” include third-party franchisees, partners or locations *in Canada*. While any need to “show your card” may not have been an in-person requirement, Exhibit D does not refute the Requesting Party’s interpretation of the evidence and I note that even the Budget car rental example leaves it unclear whether this includes discounted rentals enjoyable in Canada.

[31] In *Hilton Worldwide Holding LLP v Miller Thomson*, 2018 FC 895 [*Hilton*] (discussed further below), the evidence showed that Canadians made reservations for hotel rooms online from Canada, from which they earned reward points redeemable at hotels located in Canada [para 100]. In this case, the Owner is essentially asking the Registrar to make assumptions and speculate as to the nature of the benefits that a person may have enjoyed in Canada during the relevant period. However, it is not for the Registrar to speculate about such benefits, as the Registrar cannot be expected to make assumptions or to know the nature of the business of any trademark owner or about the practices and experiences of such business [see *SC Johnson & Son, Inc v Registrar of Trade-marks* (1981), 55 CPR (2d) 34 (FCTD) at 37].

[32] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered “membership services” and “travel services” within the meaning of sections 4 and 45 of the Act.

Financial services

[33] With respect to “financial services, namely loan financing and commercial and consumer lending services”, the Requesting Party submits that, as the Affidavit does not mention this service, there is no evidence of use of the Marks in Canada.

[34] At the hearing, the Owner again directed attention to the Exhibit D membership renewal application. In particular, one of the identified “loyalty discounts” on page 2 of the application is listed as follows:

Sea Loans® - get favorable rates, plus free U.S. Coast Guard documentation and a complimentary Sea Tow membership renewal upon closing a loan.

[35] Again, the Owner essentially asks that the Registrar speculate to some extent, as Mr. Frohnhoefer does not actually state that the listed discounts and other programs were available to members in Canada during the relevant period. Instead, Mr. Frohnhoefer simply states that the letter is representative of renewal letters sent to Canadian members and otherwise lets the exhibit speak for itself.

[36] In my view, especially in cases such as this where the availability of certain services may differ by jurisdiction, it is important that an affiant provide clear sworn details regarding the availability of its services in Canada so the Registrar may conclude whether any benefits in Canada are “tangible” and “meaningful” [see *Hilton* at para 90; and *Live! Holdings, LLC v Oyen Wiggs Green & Mutala LLP*, 2019 FC 1042 at 80 (appeal pending)].

[37] In any event, absent further details regarding this “Sea Loans®” program, it is not clear that it corresponds to the registered “loan financing” or “lending” services. At best, the program appears to fall under the registered “membership” discount/loyalty services. However, as with such “membership services” addressed above, it is not clear that members in Canada could benefit from such services.

[38] Absent further sworn details regarding the availability of the registered “financial services” in Canada, I agree with the Requesting Party that there is no evidence of use of the Marks with respect to such services within the meaning of sections 4 and 45 of the Act.

Marina services

[39] With respect to “marina services”, and “marina services, namely floating dockage”, the Requesting Party submits that there is no evidence of use of the Marks in Canada, as the Affidavit does not mention these services.

[40] At the hearing, the Owner submitted that “marina services” should be interpreted broadly, as “hotel services” was interpreted broadly in *Hilton*. In that decision, the Federal Court maintained Hilton’s WALDORF-ASTORIA registration in association with “hotel services”, notwithstanding that Hilton did not operate a hotel in association with that mark in Canada. The Court found that “the term ‘hotel services’ could include hotel registration services, for the purposes of determining use of a trademark for services in a s. 45 proceeding, but only if it is demonstrated that people in Canada obtained some tangible, meaningful, benefit from such use” [at para 90].

[41] In this case, the Owner did not operate any marinas in Canada. Even with a broad interpretation of “marina services”, it is not clear what benefits members enjoyed without having to leave Canada that amounted to such services, as the Affidavit provides no clear statements regarding “marina services”. If the argument is that a member could have had their boat towed from Canadian waters to a marina located in the United States, it is not clear how this would amount to “marina services”, much less “marina services” offered by the Owner in association with the Marks. To the extent that the Owner’s submission is premised on a boater in Canadian waters having been able to contact the Owner and subsequently obtain assistance services other than towing (which perhaps would be akin to services available through a marina), as discussed below in the context of “Salvage” services, I am not satisfied that the Owner offered or was able to perform such further services in Canada.

[42] In any event, it is not clear that such assistance services would fall within the scope of “marina services”. Again, it is not for the Registrar to speculate, in particular in a case such as this where the affiant has not even referenced the services at issue in any substantive manner.

[43] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with “marina services” and “marina services, namely floating dockage” within the meaning of sections 4 and 45 of the Act.

Environmental Remediation Services / Marine, Oil, Environmental, and Hazard Services

[44] The Design Mark is registered in association with “environmental remediation services, namely containment and clean-up of spilled hydrocarbons, namely spilled engine oil, diesel fuel

and other engine fluids upon the water or land”, whereas the Word Mark is registered in association with “Marine, oil, environmental, and hazard services, namely, substance containment, and clean up, and providing equipment for the foregoing.” Although worded differently, the parties’ representations appear to apply equally to both.

[45] With respect to such services, I note that the webpages at Exhibit E describe the Owner’s “Spill & Environmental Clean-Up” services and Mr. Frohnhoefer attests that the Owner offered and performed such services “for Canadian members during the Relevant Period” [para 14].

[46] However, I agree with the Requesting Party that there is no evidence that such services were provided in Canada. Again, even in the context of the evidence as a whole, “for Canadian members” does not provide a sufficient factual basis to conclude that these services were available to be performed in Canada or within Canadian waters.

[47] In fact, in the context of the evidence as a whole, the reasonable conclusion is that such services were only available to Canadian members when they were in the United States or within U.S. waters. Again, the issue of what assistance-related services were actually available to be performed in Canada is discussed further below with respect to “Salvage” services.

[48] Accordingly, I am not satisfied that the Owner has demonstrated use of the Design Mark in association with the registered “environmental remediation services” within the meaning of sections 4 and 45 of the Act.

[49] Similarly, I am not satisfied that the Owner has demonstrated use of the Word Mark in association with the registered “Marine, oil, environmental, and hazard services” within the meaning of sections 4 and 45 of the Act.

Marina charting services; Marine charting and consultation services

[50] With respect to “marina charting services” and “marine charting and consultation”, the Requesting Party submits that, as the Affidavit does not mention these services, there is no evidence of use of the Marks in Canada.

[51] At the oral hearing, the Owner directed attention to the membership renewal application (Exhibit D), which indicates that SEA TOW membership benefits include the following:

SERVICES to make boating easier and more convenient. You get exclusive access to 24/7 Directions & Navigational Assistance; Dial a PRO® to find reputable professionals near you; Where the Fish are Biting fishing reports and more.

[52] I also note that the description of the mobile application in Exhibit J-1 includes the following: “Let the Sea Tow app serve as your annual tide chart, forecasting tides one week in advance” and that Mr. Frohnhoefer confirms that the mobile application offered “hourly and 7-day Tide forecasts” during the relevant period [Affidavit, para 30].

[53] While Exhibit J-1 and paragraph 30 of the Affidavit describe the various features of the SEA TOW mobile application, Mr. Frohnhoefer does not clearly link those features to any of the registered services. Nevertheless, at a minimum, I accept that these marine/tide chart features and the evidenced availability of professional contact information broadly correlates to the registered “Marine charting and consultation services”. I further accept that such services were available to persons in Canada using the SEA TOW mobile application during the relevant period.

[54] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with “Marine charting and consultation services” within the meaning of sections 4 and 45 of the Act.

[55] I come to a different conclusion with respect to the registered “marina charting” services.

[56] In this respect, it is not for the Registrar to speculate as to the nature of registered goods or services; it is the responsibility of the registered owner to show the connection between the registered goods or services and those included in the evidence [see, for example, *Fraser Milner Casgrain LLP v Fabric Life Ltd*, 2014 TMOB 135 at para 13; and *Wrangler Apparel Corp v Pacific Rim Sportswear Co* (2000), 10 CPR (4th) 568 (TMOB) at para 12].

[57] In this case, one is left to speculate as to the nature of “marina charting” services. While one might assume that the Owner’s mobile application identifies locations of marinas, it is not clear from the evidence that i) the app actually does so or did so during the relevant period; or ii)

that such a basic location feature actually falls within the meaning or scope of “marina charting”. If this is a specific service related to the operation of marinas, as noted above, the Owner does not operate marinas in Canada. Otherwise, I am not prepared to infer that the evidenced “location information” or “directions & navigational assistance” or the like necessarily correlates to this registered service absent clear evidence of what constitutes “marina charting”.

[58] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with “marina charting” within the meaning of sections 4 and 45 of the Act.

Communication services

[59] With respect to “Communication services, namely registration of Maritime Mobile Safety Identity numbers for DSC-VHF radios and marine and boat related products”, the Requesting Party submits that this service is not provided by the Owner outside of the United States.

[60] In this respect, it notes that paragraph 16 and Exhibit F of the Affidavit indicate that the Owner issues MMSI numbers on behalf of the U.S. Coast Guard and that for international waters, boaters must get their own MMSI numbers from the Federal Communications Commission.

[61] At the hearing, the Owner submitted that paragraph 16 of the Affidavit demonstrates that the Owner helps boaters with the registration of such MMSI numbers.

[62] Again, however, absent further details regarding the availability of the registration service from Canada, it is not clear that the Owner was able to perform such communication or registration services in Canada during the relevant period.

[63] As such, I am not satisfied that the Owner has demonstrated use of the Marks in association with these services within the meaning of sections 4 and 45 of the Act.

Marine electrical contracting services and repair and installation of marine electrical apparatus

[64] With respect to services (2) in the Design Mark registration, “Marine electrical contracting services and repair and installation of marine electrical apparatus”, the Requesting

Party submits that, as the Affidavit does not mention these services, there is no evidence of use in Canada.

[65] At the hearing, the Owner acknowledged that there is no reference to such services in the Affidavit. However, the Owner submitted that this would fall under the scope of “marina services”.

[66] Consistent with my finding above with respect to “marina services”, as the Owner did not operate marinas in Canada and the Affidavit does not otherwise disclose how these particular services were offered in Canada during the relevant period, I am not satisfied that the Owner has demonstrated use of the Design Mark in association with such services within the meaning of sections 4 and 45 of the Act.

Salvage services; Delivery of fuel and other supplies by boat

[67] With respect to “diving and underwater salvage”, “marine salvage”, and “vessel salvage”, the Requesting Party notes that Mr. Frohnhoefer asserts use of the Mark in association with “Salvage and recovery” services [at para 14 of the Affidavit] and further that he specifically asserts that the Owner provided “marine towing services” to Canadian members in Canadian waters [at para 24].

[68] However, the Requesting Party submits that there is no evidence offered in support of these “mere” assertions and, further, that there is no evidence offered as to how the service was performed or who performed any towing service in Canadian waters.

[69] With respect to “delivery of fuel and other supplies by boat”, the Requesting Party submits that there is no evidence that such services were available in Canada or within Canadian waters.

[70] In its written representations, the Owner emphasizes that the Agreement states that “vessels disabled in ... Canada will be serviced in accordance with the Sea Tow Membership Agreement” [para 29, referencing page 6 of the Agreement shown in Exhibit B]. I note that page 3 of the Agreement describes the areas of service under that agreement as i) within the Member’s home area; ii) out of the Member’s home area; and iii) “Out-of-All Areas”. Page 1 of the

Agreement defines “Home Area” as “The geographic area of responsibility (AOR) that a Sea Tow franchise covers in which the home port of the member’s primary vessel is located”. Page 2 of the Agreement defines “Home Port” as “A member’s marina, launching ramp, dock or mooring for the primary vessel, from which the member conducts the majority of his/her boating as specified by the member in advance of disablement”.

[71] At paragraph 24 of the Affidavit, Mr. Frohnhoefer states the following:

Now, as well as during the Relevant Period, under the SEA TOW membership agreement, when a SEA TOW member, including a Canadian member, had or has a problem and needed or needs to be towed, they contacted or will contact [the Owner], and [the Owner] coordinated or will coordinate the towing service, including having dispatched and dispatching the towing service, and including where the member’s boat was or is disabled in Canadian waters.

[72] At a minimum, it would appear that the Owner provides assistance in arranging towing of a member’s disabled vessel to a dock or port, regardless of the area. While it may not be clear whether Sea Tow captains/franchisees directly conduct the towing, I accept that the Owner’s advertised assistance in arranging such towing services, broadly construed, falls within the scope of the registered “vessel salvage” services.

[73] Accordingly, in view of the evidence as a whole, I am satisfied that the Owner has demonstrated use of the Marks in association with the registered “vessel salvage” services within the meaning of sections 4 and 45 of the Act.

[74] With respect to the remaining services, the Owner submitted that the Owner’s provision of towing services to members in Canadian waters would necessarily include the provision of the Owner’s other on-water assistance services, such as “delivery of fuel and other supplies by boat” or the aforementioned “environmental remediation services” and the like.

[75] In this respect, the Owner submitted that it is reasonable to infer that the Owner’s other assistance services would be available to be performed at the responsible assisting captain’s discretion. The Owner proffered the example of a disabled vessel in Canadian waters that, rather than requiring a tow to a U.S. port, simply needed more fuel. The assisting captain would make the reasonable decision to provide fuel to the member’s boat, rather than proceed with an expensive and time-consuming towing operation. The Owner submitted that, through this

hypothetical exercise of discretion, the services offered and available to be performed by the Owner in Canadian waters was not limited to simple towing services. In support, the Owner cited the following from page 3 the Agreement:

Sea Tow Captains: Sea Tow Captains are trained professionals with significant boating experience. Sea Tow Captains meet the standards of the United States Coast Guard as licensed Merchant Marine Officers. In the event a covered vessel becomes disabled and needs assistance towing in an [Area of Responsibility], a Sea Tow Captain will respond under the direction of the Sea Tow Franchisee, and in his/her professional discretion, determine the best course of action.

[76] However, I am not prepared to come to this conclusion based on the evidence before me.

[77] The Agreement distinguishes between areas where the Owner operates (through its franchisees) and “areas where Sea Tow is not yet operating”, being the aforementioned “Out-of-All Areas”. Service in “Out-of-All Areas” appears to be limited to “assistance in arranging, and reimbursement for assistance towing” [Agreement, page 3]. It is not clear from the evidence that any part of Canada or Canadian waters are located within any “home areas”. Notably, the only information regarding the “home port” or “home area” of any Canadian members is found in the membership renewal application shown at Exhibit D. The member’s address is in Canada, but the “home port” is identified as Port Charlotte, Florida. Indeed, at the hearing, the Owner essentially conceded that the “home area” of any Canadian member for purposes of the Agreement would be located in the United States.

[78] As such, a fair reading of the Affidavit as a whole and paragraph 24 in particular is that the Owner’s services within Canadian waters were limited to assistance in arranging for towing. If the Owner’s services did, in fact, encompass other assistance services in Canadian waters, it is not clear why Mr. Frohnhoefer did not simply say so in the body of the Affidavit.

[79] Absent such clear statement or further evidence, the conclusion must be that the Owner’s assistance services on Canadian waters were limited to assisting in the arrangement of vessel towing and subsequent reimbursement to members. While I accepted above that this activity corresponds to the registered “vessel salvage” services, I cannot conclude that the Owner was prepared to perform the remaining registered assistance or remediation-type services in Canada

during the relevant period based on the evidence before me. Again, it is not for the Registrar to speculate.

[80] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Marks in association with “vessel salvage” within the meaning of sections 4 and 45 of the Act.

[81] However, I am not satisfied that the Owner has demonstrated use of the Marks in association the registered services “delivery of fuel and other supplies by boat” or the broader “diving and underwater salvage” and “marine salvage” services within the meaning of sections 4 and 45 of the Act.

DISPOSITION FOR TMA870,561 (DESIGN MARK)

[82] 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, registration no. TMA870,561 will be amended to delete the following registered services:

(1) [...] membership services, namely, providing discounts to members for the services of others, and arranging for network of franchisees and authorized partners to provide members access to discounted and pre-paid insurance services, travel services, namely rental car and hotel discount services, financial services, namely loan financing and commercial and consumer lending services, marina services, environmental remediation services, namely containment and clean-up of spilled hydrocarbons, namely spilled engine oil, diesel fuel and other engine fluids upon the water or land, [...] marina charting services, [...] communication services, namely registration of Maritime Mobile Safety Identity numbers for DSC-VHF radios and marine and boat related products.

(2) Marine electrical contracting services and repair and installation of marine electrical apparatus.

[...]

(4) Diving and underwater salvage; marine salvage; [...] marina services, namely, floating dockage; delivery of fuel and other supplies by boat.

[83] The amended statement of services for registration TMA870,561 will be as follows:

(1) Association services, namely, promoting the interests of boaters; educational services, namely boating safety education, on-line information services, namely boating safety information, publications, namely magazines covering issues of interest and news relating to the boating and nautical community.

(3) Marine charting and consulting services.

(4) Vessel salvage.

DISPOSITION FOR TMA870,562 (WORD MARK)

[84] 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, registration no. TMA870,562 will be amended to delete the following registered services:

(1) [...] membership services, namely, providing discounts to members for the services of others, and arranging for network of franchisees and authorized partners to provide members access to discounted and pre-paid insurance services, travel services, namely rental car and hotel discount services, financial services, namely loan financing and commercial and consumer lending services, marina services, environmental remediation services, namely containment and clean-up of spilled hydrocarbons, namely spilled engine oil, diesel fuel and other engine fluids upon the water or land, [...] marina charting services, [...] communication services, namely registration of Maritime Mobile Safety Identity numbers for DSC-VHF radios and marine and boat related products.

(2) Marine, oil, environmental, and hazard services, namely, substance containment, and clean up, and providing equipment for the foregoing; diving and underwater salvage; marine salvage; [...] marina services, namely, floating dockage; delivery of fuel and other supplies by boat [...].

[85] The amended statement of services for registration TMA870,562 will be as follows:

(1) Association services, namely, promoting the interests of boaters; educational services, namely boating safety education, on-line information services, namely boating safety information, publications, namely magazines covering issues of interest and news relating to the boating and nautical community.

(2) Vessel salvage; Marine charting and consulting services.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: 2020-01-13

APPEARANCES

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For the Registered Owner

No one appearing

For the Requesting Party

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For the Registered Owner

Trademark Factory International Inc.

For the Requesting Party