



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 102

Date of Decision: 2020-08-31

IN THE MATTER OF A SECTION 45 PROCEEDING

Wilson Lue LLP

Requesting Party

and

**Little Warriors (a not-for-profit
company)**

Registered Owner

**TMA795,454 for Stand Up For Our
Kids & Design**

Registration

INTRODUCTION

[1] At the request of Wilson Lue 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 August 7, 2018, to Little Warriors (a not-for-profit company) (the Owner), the registered owner of registration No. TMA795,454 for the trademark Stand Up For Our Kids & Design (the Mark), shown below:

**STAND
UP
FOR OUR
KIDS**



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

Services for children in need, namely advocacy, education in the field of child sexual abuse, counselling for victims of child sexual abuse and their families, and fundraising services.

[3] For the reasons that follow, I conclude that the registration ought to be maintained only with respect to “Services for children in need, namely advocacy, education in the field of child sexual abuse, [...] and fundraising services”.

[4] The notice required the Owner to show whether the Mark has been used in Canada in association with the registered services 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 August 7, 2015, to August 7, 2018.

[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] The display of the trademark in the advertisement of the services is sufficient to satisfy the requirements of section 4(2) of the Act, from the time the owner of the trademark offers and

is ready to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[7] It is well established that bare statements that a trademark is in 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) (*John Labatt*)].

[8] In response to the Registrar's notice, the Owner furnished the statutory declaration of Laurie Szymanski, CEO of the Owner, declared October 28, 2018. Both parties submitted written representations. No oral hearing was held.

THE OWNER'S EVIDENCE

[9] Ms. Szymanski states that the Owner is a charitable organization providing advocacy and education in the field of child sexual abuse, counselling for victims of child sexual abuse and their families, and fundraising services, which she defines collectively as the "Services". She states that during the relevant period, the Owner used the Mark on keychains and bookmarks which were made available and were given away to attendees of various community events and fundraisers, including barbecue fundraisers, community resource fairs, and the Owner's educational "Prevent It!" workshops, which she defines collectively as the "Events". As Exhibit A, she attaches a photograph of a bookmark displaying the Mark.

[10] Ms. Szymanski states that the Owner

attended or held each of the Events in order to promote its Services, and to provide advocacy, education in the field of child sexual abuse, awareness for counselling for victims of child sexual abuse and their families (ideally such that victims will attend counselling following an Event), and fundraising services.

[11] As Exhibit B, she attaches a photograph that she describes as an image of the Owner’s members and supporters attending a barbecue fundraiser in Sherwood Park, Alberta, on June 9, 2018. The image shows a number of individuals standing in front of a table displaying a “BBQ Fundraiser!” sign. Set on the table are a number of materials displaying the Owner’s name, pamphlets concerning child sexual abuse, an informational sign entitled “Prevent It!”, and a stack of bookmarks displaying the Mark as registered. Ms. Szymanski states that approximately 150 people attended this event and that the Owner provided bookmarks to approximately 60 such attendees. She further states that “[a]t the Events, members of [the Owner] either provided Services associated with the Mark, or they provided attendees with an explanation of [the Owner’s] Services, including the Services associated with the Mark”.

[12] Finally, as Exhibit C, Ms. Szymanski attaches a copy of stationery showing the Owner’s name in the letterhead and the Mark as registered in the footer. She states that this stationery was used when printing letters for the purpose of seeking donations, confirming employment with the Owner, or expressing gratitude to donors during the relevant period.

ANALYSIS

[13] The Requesting Party submits that the Owner has failed to show use of the Mark in association with any of the registered services within the meaning of the Act. With respect to the services “advocacy, education in the field of child sexual abuse, counselling for victims of child sexual abuse and their families”, the Requesting Party submits that distribution of the bookmarks at the Events described in Ms. Szymanski’s declaration does not amount to use of the Mark in association with those services. In particular, the Requesting Party states that Ms. Szymanski has provided only bare assertions that such services were provided at the Events with no details about dates, venues, lists of attendees or speakers, or promotional materials showing that such educational Events took place. Moreover, the Requesting Party notes that the bookmarks do not refer to such services.

[14] With respect to “fundraising services”, the Requesting Party submits that there is no evidence to show that the Owner performed such services to benefit a third party. Instead, the Requesting Party submits that the evidence shows that the Owner held a barbecue fundraiser to benefit itself, which it contends would not constitute “fundraising services” given that services

must provide some benefit to the public, citing *Société Nationale des Chemins de Fer Français SNCF v Venice Simplon-Orient-Express* (2000), 9 CPR (4th) 443 (FCTD). With respect to the Exhibit C stationery, the Requesting Party notes that there is no detail such as dates, recipients, or contents of the letter that would show that letters seeking donations were actually sent to members of the public.

[15] In response, the Owner submits that the barbecue fundraiser described in Ms. Szymanski's declaration illustrates how the Owner used the Mark in the course of performing or advertising all of its services, and that it is reasonable to infer from the totality of the evidence that the Owner used the Mark in association with all of its services, given that a registered owner may rely on evidence of use establishing a pattern which can be used to infer use in association with each of the registered services, following *Saks & Co v Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD) (*Saks*). However, while evidentiary overkill is not required and representative evidence can be furnished in section 45 proceedings, the registered owner must still establish a *prima facie* case of use of the trademark in association with *each* of the services specified in the registration [*John Labatt*; see also *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 (*Diamant Elinor*)]. In other words, the Registrar must be able to "rely on an inference from proven facts rather than on speculation" to satisfy every element required by the Act [*Diamant Elinor* at para 11; see also *Smart & Biggar v Curb*, 2009 FC 47].

[16] With respect to the registered service "Services for children in need, namely advocacy", Ms. Szymanski stated that the Owner either performed or advertised this service at its Events, and provided bookmarks displaying the Mark in the course of doing so. Further, the Exhibit B photograph demonstrates that the Owner was offering and prepared to give out pamphlets concerning child sexual abuse at its Events. Bearing in mind that services are to be interpreted broadly in section 45 proceedings [*Renaud Cointreau & Co v Cordon Bleu International Ltd* (2000), 11 CPR (4th) 95 (FCTD), *aff'd* 2002 FCA 11], I am satisfied that the Owner has established use of the Mark in association with this service within the meaning of the Act.

[17] Similarly, with respect to the registered service "education in the field of child sexual abuse", Ms. Szymanski states that the Owner either performed or advertised this service at its Events, and provided bookmarks displaying the Mark in the course of doing so. Further, the

Exhibit B photograph shows an advertisement for the Owner’s educational “Prevent It!” workshop next to the bookmarks displaying the Mark, and Ms. Szymanski states that the Owner held such educational workshops during the relevant period. Accordingly, I am satisfied that the Owner has established use of the Mark in association with this service within the meaning of the Act.

[18] With respect to the registered service “counselling for victims of child sexual abuse and their families”, I note that Ms. Szymanski states that the purpose of the Events was to provide or promote “*awareness for counselling for victims of child sexual abuse and their families (ideally such that victims will attend counselling following an Event)*” [emphasis added]. It is not clear from this statement that such counselling would be provided by the Owner, rather than a third party. Aside from a general assertion that the Owner provides all of the registered services, Ms. Szymanski does not clearly assert in her declaration that the Owner actually provided counselling services, or was offering and prepared to perform counselling services, during the relevant period. Accordingly, I am not satisfied that the Owner has established use of the Mark in association with these services within the meaning of the Act.

[19] Finally, with respect to “fundraising services”, Exhibit B shows that the Owner displayed the Mark on the bookmarks in the course of engaging in a fundraising activity; further, Ms. Szymanski states that the Owner sent letters seeking donations on letterhead displaying the Mark during the relevant period. I am not prepared to accept the Requesting Party’s submission that the term “fundraising activities” cannot encompass the Owner raising funds for its own initiatives. While it is true that some members of the public, such as consumers or purchasers, must receive a benefit if an activity is to be considered a “service” within the meaning of the Act [*Live! Holdings LLC v Oyen Wiggs Green & Mutala LLP*, 2019 FC 1042, aff’d 2020 FCA 120], in this case, it is clear that the Owner is a not-for-profit entity whose initiatives are intended to benefit children in need and their families. Accordingly, bearing in mind that services are to be interpreted broadly in section 45 proceedings, I am satisfied that the Owner has established use of the Mark in association with this service within the meaning of the Act.

[20] In sum, the Owner has shown use of the Mark in association with the registered services “Services for children in need, namely advocacy, education in the field of child sexual abuse,

[...] and fundraising services” within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances that would excuse non-use of the Mark in association with the remaining services, the registration will be amended accordingly.

DISPOSITION

[21] In view of all of the foregoing, 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 “counselling for victims of child sexual abuse and their families” from the statement of services.

[22] The amended statement of services will be as follows:

Services for children in need, namely advocacy, education in the field of child sexual abuse, and fundraising services.

G.M. Melchin
Hearing Officer
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

DLA Piper (Canada) LLP

For the Registered Owner

Wilson Lue LLP

For the Requesting Party