



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 81

Date of Decision: 2021-04-30

IN THE MATTER OF A SECTION 45 PROCEEDING

John H. Simpson (Shift Law)

Requesting Party

and

Wreck Beach Preservation Society

Registered Owner

TMA871,979 for WRECK BEACH

Registration

INTRODUCTION

[1] At the request of John H. Simpson (Shift Law) (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 December 13, 2018, to Wreck Beach Preservation Society (the Owner), the registered owner of registration No. TMA871,979 for the trademark WRECK BEACH (the Mark).

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

Goods

- (1) Clothing, namely t-shirts and jackets.
- (2) Canvas carry-all bags.
- (3) Postcards, bumper stickers, and posters.

Services

- (1) Promoting and raising public awareness and understanding relating to nature conservation, environmental and ecological development, namely identifying areas of ecological significance and consulting with the public, private and government sectors to preserve and protect ecologically sensitive areas.
- (2) Operation of an online website for the sale of postcards, canvas bags, and clothing, namely t-shirts and jackets.
- (3) Retail sales of wine, beer and spirits.
- (4) Providing recreational and entertainment events, namely performances featuring live music, and organizing running, volleyball and nude swimming events.
- (5) Distribution of printed newsletters in the field of nudism.
- (6) Providing an Internet website featuring news, community events, recreational and educational content in the field of nudism.

[3] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between December 13, 2015 and December 13, 2018 (the Relevant Period), in association with the goods and 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.

[4] The relevant definitions of use are set out in section 4 of the Act as follows:

4(1) A trademark 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 trademark 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 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)].

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Judy Williams dated June 12, 2019 (the Affidavit).

[7] Both parties submitted written representations. A hearing was not requested.

OVERVIEW OF THE OWNER'S EVIDENCE

[8] The Affidavit can be summarized as follows:

- Ms. Williams is a Director and the Chair of the Owner. The Owner is a Society incorporated under the British Columbia *Societies Act* [paras 1 and 2].
- The Owner was established to preserve the foreshore park area near Vancouver, British Columbia, commonly known as Wreck Beach, to assist authorities who have jurisdiction over the cliffs surrounding the area, to provide a means for public input relating to the environment, wildlife and usage of the area and to provide a forum for educating the general public in the use and preservation of this wilderness area [para 6].
- The affiant states that the Mark has been extensively used by the Owner during the Relevant Period by selling the registered goods and advertising and performing the registered services in Canada [para 4 to 6]. In this regard, Exhibit A to the Affidavit is a table listing the registered goods and services, and describing how the Mark has been used in association with each of them. There are eight schedules included as part of Exhibit A. These schedules include, *inter alia*, photographs of goods, screen captures of the Owner's website at www.wreckbeach.org, emails relating to the sale of goods, and various receipts [para 6].
- Exhibit B to the Affidavit is comprised of three financial statements of the Owner regarding three fiscal years (May 2015 to April 2016, May 2016 to April 2017 and May 2017 to April 2018). These statements show the revenues and expenses of the Owner. They do not identify the revenues from the sale of specific goods, but the affiant indicates

that revenues from the sale of goods are included in line items such as “Bare Buns Run”, which is a specific event where goods were sold by the Owner [para 7].

- The Affidavit indicates that many of the registered services are provided through the Owner’s website. Exhibit C is a statement of account from Sedona Sky, LLC, representing the hosting fees for the Owner’s website from 2015 to 2019 [para 10].

ANALYSIS

Preliminary Matter

[9] After receiving the Requesting Party’s written representations, the Owner filed a letter dated August 2, 2019 stating that due to a “technology error” an enclosed photograph of a good described as “canvas bags” was not included with its evidence. The Owner requested that the Registrar consider the photograph in the letter as part of the evidence.

[10] By letter dated August 30, 2019, the Registrar ruled on the issue, stating that the Registrar could not consider the photograph as evidence because it was filed after the expiry of the time limit to do so and the document was not in the form of an affidavit or statutory declaration as required by section 45 of the Act. The Registrar noted the possibility of the Owner requesting a retroactive extension of time in which to submit evidence in the proper form; however, no steps were taken by the Owner in this regard.

[11] Therefore, for the purposes of the analysis below, the photograph enclosed with the Owner’s letter of August 2, 2019 will not be taken into consideration.

Registered Goods

[12] There are photographs of various goods in Schedules 1 and 3 of Exhibit A to the Affidavit, including multiple t-shirts, a jacket, multiple postcards and posters. The Mark appears on each of these goods. The affiant states that these goods were sold during the Relevant Period in Canada.

[13] The Requesting Party alleges that even though the Mark appears on these goods, the Mark is not being used as a trademark to distinguish the Owner’s goods from those of others, but

rather the Mark is used to refer to a specific geographic area. For example, the t-shirts included in Schedule 1 to Exhibit A appear to relate to specific events hosted by the Owner. According to the Requesting Party, the intention of the Owner in displaying the Mark on these goods is to indicate a specific geographic location of an event and not to distinguish the Owner's goods from those of others. In addition, the Requesting party argues that in some instances the Mark is accompanied by the word "Canada", suggesting that the Mark refers to a location and is not used as a trademark.

[14] I am not persuaded by the Requesting Party's submissions on this point. First, given the manner in which the Mark is depicted on many of the goods (often in a different font than surrounding word matter) and the fact that in some instances the Mark is depicted in reference to events held by the Owner at different geographic locations (for example, see pages 16 and 44 of the Affidavit), I am not satisfied that the Mark is necessarily being displayed solely in a descriptive, geographic sense. In any event, the Requesting Party's contention that a consumer would not recognize the Mark as a trademark is tied to the issue of distinctiveness, which the Federal Court of Appeal has held is not an issue in section 45 proceedings [see *United Grain Growers Ltd v Lang Michener*, 2001 FCA 66]. What is to be determined is whether or not sufficient facts have been provided to permit me to arrive at a conclusion of use of the Mark by the Owner, within the meaning of section 4 of the Act, in association with the registered goods and services during the Relevant Period.

[15] In the present case, the photographs in Exhibit A demonstrate how the Mark appeared on the t-shirts, jacket, posters and postcards, and the affiant attests that these goods were sold during the Relevant Period in Canada.

[16] With respect to the transfer of goods, it is well established that invoices are not mandatory in order to satisfactorily reply to a section 45 notice [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)], but some evidence of transfer in the normal course of trade in Canada is necessary [see *John Labatt, supra*]. Such evidence can be in the form of other documentation like sales reports or statements, but can also be through clear sworn statements regarding volumes of sales, dollar value of sales, or equivalent factual particulars [see, for example, *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79].

[17] Given the photographs of the goods bearing the Mark, the clear statements made by the affiant concerning the volume of sales during the Relevant Period, and the inclusion of the financial statements of the Owner, I conclude that the Owner has shown use of the Mark in Canada during the Relevant Period in association with clothing, namely t-shirts and jackets, as well as with postcards and posters.

[18] However, the Affidavit does not include any photographs of canvas carry-all bags or bumper stickers bearing the Mark. With respect to the canvas carry-all bags, the affiant stated that at least 20 canvas carry-all bags bearing the Mark were sold during the Relevant Period in Canada. While the body of the Affidavit references a photograph of a canvas carry-all bag being included in Exhibit A, a photograph was not included with the Affidavit, as discussed above.

[19] With respect to the bumper stickers, the affiant attested that 500 bumper stickers were sold in the Vancouver area during the Relevant Period; however, no samples or photographs of the bumper stickers are provided as the affiant indicates that the Owner's inventory was sold out. Also, in contrast to the other registered goods, the Affidavit does not state that the bumper stickers displayed the Mark.

[20] In these circumstances, given the absence of photographs of the canvas carry-all bags and bumper stickers, and given the variety of ways in which the Mark was displayed on the other registered goods, I am not prepared to infer how the Mark may have appeared on the canvas carry-all bags and bumper stickers at the time of transfer, if at all. Therefore, I conclude that the Owner has not shown use of the Mark in association with canvas carry-all bags and bumper stickers, and consequently those two goods will be deleted from the registration.

[21] To summarize with respect to the registered goods, I find that the Owner has demonstrated use of the Mark in accordance with sections 4(1) and 45 of the Act in association with clothing, namely t-shirts and jackets, as well as with postcards and posters. I find that the Owner has not demonstrated use in association with canvas carry-all bags and bumper stickers.

Registered Services

[22] In its written representations, the Requesting Party submitted that the Owner has not demonstrated use of the Mark with two of the registered services, namely, "operation of an

online website for the sale of postcards, canvas bags, and clothing, namely t-shirts and jackets” and “retail sales of wine, beer and spirits.” The Requesting Party made no submissions regarding the remaining services listed in the registration.

Operation of an online website for the sale of postcards, canvas bags, and clothing, namely t-shirts and jackets

[23] For the first service contested by the Requesting Party, the allegation is that Exhibit A does not show that the Mark was used or displayed in the performance or advertising of the service, because the Mark did not appear on the website in a manner that a customer would associate any of the services with the Mark. Specifically, the Requesting Party submits that the display of the Mark on the Owner’s website is in reference to a geographic location and not as a trademark. In addition, the Requesting Party submits that the website did not include any links, tabs or navigation tools that permitted a customer to purchase goods directly from the website.

[24] It is well established that the display of the trademark in the advertisement of services is sufficient to satisfy the requirements of section 4(2) of the Act, from the time the owner of the trademark is willing and able to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[25] The website of the Owner advertised for sale various goods while displaying the Mark. Even though the website did not have the functionality to permit a customer to make a purchase directly via the website, the Owner’s website invites customers to contact the Owner by email. In this regard, a copy of an email order was included in Schedule 5. Although this particular customer was not from Canada, it is apparent that the website offered such services to Canadians as well. With respect to the Requesting Party’s argument that the display of the Mark in association with the services was solely a geographic reference, I reject that argument for essentially the same reasons as set out above in the discussion of the goods.

[26] As such, I am satisfied that the evidence is sufficient to conclude that there was use of the Mark during the Relevant Period in Canada by the Owner, within the meaning of sections 4(2) and 45 of the Act, in association with the operation of an online website for the sale of postcards, canvas bags, and clothing, namely t-shirts and jackets.

Retail sales of wine, beer and spirits

[27] For the second service contested by the Requesting Party, namely, “retail sales of wine, beer and spirits”, the Requesting Party submits that the Mark is not mentioned at all in Schedule 6 of Exhibit A, the relevant schedule addressing this service. The documents in Schedule 6 include invoices from alcohol purchases, a Christmas party statement of revenue and expenses, a special event permit under the British Columbia *Liquor Control and Licensing Act*, and emails concerning bartending and the special event permit.

[28] Upon reviewing Schedule 6, it appears that the Owner likely did engage in retail sales of wine, beer and spirits during the Relevant Period in Canada as part of certain fundraising events. Specifically, the Owner has provided evidence that it purchased various alcoholic beverage products from BC Liquor Stores for resale or distribution at events. However, in my view, the evidence is not sufficient to conclude that this service was performed or advertised in association with the Mark. In particular, the only document in Schedule 6 of Exhibit A which appears to refer to the Mark is the special event permit (which identifies the event name as “Wreck beach Christmas”), and there is no evidence to suggest that this event permit was displayed by the Owner in the performance or advertising of the services. None of the remaining evidence in Schedule 6, or elsewhere in the Affidavit, demonstrates the display of the Mark in association with the performance or advertising of the retail sale of wine, beer and spirits. Even while describing this service in the Affidavit, the affiant does not mention if the Mark was displayed during the performance of this service.

[29] Accordingly, I am not satisfied that the Owner has demonstrated use of the Mark in association with retail sales of wine, beer and spirits within the meaning of sections 4(2) and 45 of the Act. As such, this service will be deleted from the registration.

Remaining services

[30] As for the remaining four registered services (identified in the registration as services (1), (4), (5) and (6)), as noted above, the Requesting Party made no submissions regarding these services. In any event, with respect to these remaining services, the Affidavit includes multiple items in Schedules 4, 7 and 8, such as screen captures of the Facebook page of the Owner, screen

captures of the website of the Owner and advertisements of specific events, all bearing the Mark. Upon reviewing these documents in conjunction with the Affidavit as a whole, I can conclude that the Mark was used in association with these services during the Relevant Period.

[31] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with services (1), (4), (5) and (6) within the meaning of sections 4(2) and 45 of the Act.

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 amended to delete the following goods and services:

Goods

Canvas carry-all bags.
[...] bumper stickers.

Services

Retail sales of wine, beer and spirits.

[33] The amended statement of goods and services in the registration will be as follows:

Goods

(1) Clothing, namely t-shirts and jackets.
(3) Postcards and posters.

Services

(1) Promoting and raising public awareness and understanding relating to nature conservation, environmental and ecological development, namely identifying areas of ecological significance and consulting with the public, private and government sectors to preserve and protect ecologically sensitive areas.

(2) Operation of an online website for the sale of postcards, canvas bags, and clothing, namely t-shirts and jackets.

(4) Providing recreational and entertainment events, namely performances featuring live music, and organizing running, volleyball and nude swimming events.

(5) Distribution of printed newsletters in the field of nudism.

(6) Providing an Internet website featuring news, community events, recreational and educational content in the field of nudism.

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

Boughton Law Corporation

For the Registered Owner

John H. Simpson (Shift Law Professional Corporation)

For the Requesting Party