



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 89**

**Date of Decision: 2021-05-17**

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

**Bhole IP Law**

**Requesting Party**

**and**

**Enrico Valente**

**Registered Owner**

**TMA904,466 for PODIUM SPECIAL  
EVENTS MANAGEMENT & Design**

**Registration**

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13, (the Act) with respect to registration No. TMA904,466 for the trademark PODIUM SPECIAL EVENTS MANAGEMENT & Design (the Mark), shown below:



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

Advertising and promotional services for third parties, namely, advertising and promoting the wares and services others by organizing and hosting product demonstrations of the products of others, annual general meetings, team builders, corporate functions, incentive trips, trade shows, exhibitions, consumer intercepts, sporting events, and developing promotional campaigns for others; brand development; business development; data collection, namely, collecting marketing information; market research; developing promotional campaigns for others through computer-based digital media on behalf of third parties; events management; fundraising; graphics design; product packaging design services; media relations and public relations; sports marketing, namely promoting sports competitions and sporting events of others; providing marketing and communications services to third parties, namely strategic marketing planning and promotions; translation services (the Services).

[3] For the reasons that follow, I conclude that the registration ought to be maintained in part.

#### THE PROCEEDINGS

[4] At the request of Bhole IP Law (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on November 13, 2018, to Enrico Valente (the Owner).

[5] The notice required the Owner to show whether the trademark has been used in Canada, in association with each of the 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 November 13, 2015, to November 13, 2018.

[6] The relevant definition of use in the present case 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.

[7] In the absence of use as defined above, pursuant to section 45(3) of the Act, a trademark is liable to be expunged, unless the absence of use is due to special circumstances.

[8] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register. The

evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184]. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant* at para 9].

[9] In response to the Registrar’s notice, the Owner furnished his own affidavit, sworn on January 18, 2019.

[10] Only the Requesting Party submitted written representations and no oral hearing was requested.

#### THE EVIDENCE

[11] The affidavit has six pages; the first two are divided in 14 paragraphs and the signatures of the affiant and of the notary who took the oath appear below the last paragraph. The four subsequent pages are not signed, notarized, or marked as exhibits; instead, on every page, the title “PROOF OF USE OF MY IP – PODIUM SPECIAL EVENTS MANAGEMENT UNDER SECTION 45” appears and there are one or more photographs.

[12] In paragraph three of his affidavit, the Owner states that he had been using the Mark “in charitable causes to help organize events and raise funds for selected charities at essentially no cost”. He added that the costs related to these events were assumed by different sponsors including himself.

[13] In paragraph five of his affidavit, the Owner describes his role in these events as follows:  
My role as Co-Chair was to essentially coordinate all aspects of the event including Liaising with the Mayor’s Offices and their Worshipers for City of Ottawa and Gatineau, Media Relations, Social Media and support for logistics and technical were provided by the National Capital Kart Club and more recently, by the generous and caring people who operate TOP KARTING in Gatineau. Of course, all this was possible due to a generous and caring team of volunteers that form the Organizing Team.

[14] The Owner refers to two different events in his affidavit. The first event, the Mayor’s Cup of Wishes, has been held annually since 2015 and, at the time of the affidavit, was scheduled again in 2019, while the second event, the Capital Karting Grand Prix, was held in

2015 and 2016. The specific dates of these events are not mentioned, but there are photographs on which different dates appear. On the fourth page, there is a photograph of a group of people standing in front of a banner of Capital Karting Grand Prix, indicating “July/juillet 25-26 2015”. On the fifth page, a similar photograph appears for the 2016 edition of the Capital Karting Grand Prix indicating “August 6-7 août”.

[15] As mentioned above, the section “PROOF OF USE OF MY IP” of the affidavit consists of multiple photographs. The Mark appears in two photographs on what seems like dark fabric displaying the words “ORGANIZING TEAM”. In the first one, there are five other logos; some of these logos represent charities that were listed in the affidavit. In the second photograph, there are a different set of logos including the Mark.

[16] The Owner states that more photographs and videos are available on two Facebook pages, one for “PODIUM” and one for “MAYOR’S CUP”; the links to access these pages are also included.

[17] At paragraph 11 and 12 of the affidavit, the Owner states:

11. PODIUM SPECIAL EVENTS essentially has a FACEBOOK page that drives the key CHARITABLE activities & events as well as a TWITTER account. (see attached)

Originally there was a web site which was corrupted and hacked some time ago and it was decided to simply let it go due to costs of re-building and maintaining. I believe that my evalente@podiumevents.ca was also corrupted and likely no longer functioning.

12. The other reason motivating the shut-down is that there is an opposition by FORMULA ONE for use of the CAPITAL KARTING GRAND PRIX name and this opposition is still being disputed. The intention is to continue using the trademark & design in this fashion as my retirement activity which I deeply cherish.

[18] Even though the Owner states that there is an attachment concerning the Facebook page and Twitter account, the only materials attached to the affidavit are the four pages of photographs noted above.

#### ANALYSIS AND REASONS FOR DECISION

##### *Preliminary matter*

[19] As a preliminary matter, while I note that the attached photographs have not been endorsed or marked as exhibits, it has been established that technical deficiencies in evidence should not stop a party from successfully responding to a section 45 notice where the evidence provided could be sufficient to show use [see *Baume & Mercier SA v Brown* (1985), 4 CPR (3d) 96 (FCTD)]. For example, the Registrar has accepted exhibited evidence that was not properly endorsed where the exhibited evidence was clearly identified and explained in the body of the affidavit [see, for example, *Borden & Elliot c Raphaël Inc* (2001), 16 CPR (4th) 96 (TMOB)]. In this case, the Owner refers to the attached photographs in the body of the affidavit. I am therefore willing to accept these photographs as evidence in this proceeding.

[20] I note, however, that I cannot consider the contents of the Owner's Facebook or Twitter pages as evidence in this proceeding. Pursuant to sections 45(1) and (2) of the Act, I can only consider evidence submitted in the form of an affidavit or statutory declaration filed within three months of the date of the Registrar's notice, plus any extensions granted under section 47. In this case, the contents of these pages have not been attached to the Owner's affidavit in the form of screenshots; I cannot consider evidence beyond what is contained in or attached to the Owner's affidavit.

#### *Sufficiency of Evidence*

[21] The Requesting Party submits that the evidence lacks specificity regarding which Services were used in association with the Mark. It submits that the affidavit contains only bare and ambiguous assertions of use, which are insufficient to maintain the registration.

[22] In the affidavit, the Owner states that he has been using the Mark "in charitable causes to help organize events and raise funds for selected charities at essentially no cost". He specifies that "the activities have essentially been focused on the Annual MAYORS CUP OF WISHES". The Owner also described his role in these events, as set out above in the evidence section. Although the Owner does not correlate the activities he performed during the relevant period to any of the Services in the affidavit, his description of these activities is sufficiently detailed to associate them with the following two Services: "events management" and "fundraising".

[23] As described above, the Mark appears on two photographs in the section “PROOF OF USE OF MY IP” on what appears to be dark fabric. I am prepared to accept that both these photographs represent the t-shirts that were mentioned in the affidavit. The words “ORGANIZING TEAM” appear at the top of both photographs and this is consistent with the paragraph 10 statement in the affidavit referring to “Organizing Team T-Shirt”. While the Owner does not explicitly state that the items were worn by these volunteers *during the performance of the Services*, I am prepared to infer that they were, as otherwise, it raises the question as to why one would provide these t-shirts to the volunteers [for a similar conclusion, see *Titan Capital Ventures Inc v Titan Construction, Inc*, 2015 TMOB 83 at para 25].

[24] I further note that the Owner does not explicitly confirm that the two different t-shirts shown in the photographs are representative of those worn by the Organizing Team at events held *during the relevant period*. However, based on the totality of the evidence, including the fact that the Owner’s statement that “everyone helping got to keep their Organizing Team T-Shirt” immediately follows his discussion of events held during the relevant period, I am prepared to infer that at least one of the t-shirts shown in evidence was worn at one of those particular events. In making these inferences, I am mindful of the principles that “[d]rawing an inference is a matter of reasonably probable, logical deductions from the evidence” [*Sim & McBurney v En Vogue Sculptured Nail Systems Inc*, 2021 FC 172 at para 15], and that the proper approach in section 45 proceedings is to consider the evidence as a whole rather than focusing on individual pieces in isolation [see *Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB); *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB)].

[25] While additional trademarks are displayed on these t-shirts, there is nothing in the Act that precludes a the use of more than one trademark at the same time in association with the same goods or services [*AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD); *Sara Lee Corp v Kretschmar Inc*, 2005 CarswellNat 4474 (TMOB) at para 18; *Sharadha Terry Products Ltd v Dial Corp*, 2014 TMOB 285 at para 28]. In this respect, while the Requesting Party submits that the positioning of the Mark alongside third party trademarks suggests that the Owner was merely a sponsor of the event, I note that the Owner has explained his role in the event in his affidavit. His statements in this regard are not bare assertions, as

suggested by the Requesting Party, but sworn statements that are to be accepted at face value and must be accorded substantial credibility in a section 45 proceeding [*Oyen Wiggs Green & Mutala LLP v Atari Interactive Inc*, 2018 TMOB 79 at para 25].

#### *Use of the Mark as Registered*

[26] The Requesting Party submits that the trademark shown in evidence is not the Mark as registered, given the omission of the textual elements “Logistics – Facilitation – Sponsorships – Media”. In considering whether the display of a trademark constitutes display of the trademark as registered, the question to be asked is whether the trademark was displayed in such a way that it did not lose its identity and remained recognizable, in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see whether the “dominant features” of the registered trademark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. The assessment as to which elements are the dominant features and whether the deviation is minor enough to permit a finding of use of the trademark as registered is a question of fact to be determined on a case-by-case basis.

[27] Comparing the Mark to the trademark appearing in the photographs, in my view, the Mark did not lose its identity and remains recognizable. While the words “Logistics – Facilitation – Sponsorships – Media” have been omitted in the design, the dominant features of the Mark, namely the word “Podium” and the design element, are still present in the trademark appearing in the photographs. Given that the dominant elements of the Mark have been maintained in the Mark as shown in the photographs, I conclude that any use of the Mark in that configuration would amount to use of the Mark as registered.

#### *Services Provided Free of Charge*

[28] The Requesting Party submits use of the Mark in association with services provided free of charge cannot amount to use within the meaning of the Act. In particular, the Requesting Party submits that use of a trademark in association with services must be of a normal commercial nature, citing *Cornerstone Securities Canada Inc v Canada (Registrar of Trade Marks)* (1994),

58 CPR (3d) 417. Further, the Requesting Party submits that “charitable acts do not constitute ‘use’”, citing *Boston Pizza International Inc v Boston Chicken Inc* (1998), 87 CPR (3d) 333. Similar submissions were considered in *Andrews Robichaud v Entechnevision Inc*, 2017 TMOB 106, and were addressed by the Board as follows:

[34] First, I note that the principle cited by the Requesting Party — that “use has to be of a normal commercial nature” — appears to be qualified by the Federal Court itself [in *Cornerstone* at para 7], given the beginning of the previous sentence with “In this type of case...”, implying that it might not apply to all expungement proceedings involving services. Furthermore, the disposition in *Cornerstone* does not appear to have turned on this issue, but rather turned on whether the evidence showed that the advertisements in question had been distributed and whether the registered services were ever performed.

[35] Indeed, the cited *Coscelebre Inc v Canada (Registrar of Trade Marks)* (1991), 35 CPR (2d) 74 (FCTD)] decision dealt with goods only. Therefore, the commentary from the Federal Court in that case should be viewed in the context of section 4(1) of the Act, which requires transfers of any goods in question to be “in the normal course of trade”. In contrast, section 4(2) of the Act, reproduced above, does not incorporate the requirement that use with respect to services be “in the normal course of trade”. What constitutes a “service” under the Act is to be interpreted broadly, with a key element being that there be some benefit to the public. This providing of a benefit does not necessarily require a commercial context, as demonstrated by the abundance of trade-mark registrations relating to “Charitable services ...” and the like in various fields.

[29] Accordingly, the fact that the services referred to by the Owner are performed free of charge, or in the context of charitable events, does not preclude a finding of use within the meaning of section 4(2) of the Act [see, for example, *War Amputations of Canada/Amputés de Guerre du Canada v Faber-Castell Canada Inc* (1992), 41 CPR (3d) 557 (TMOB); *Laboratoires Contapharm v Origins Natural Resources Inc*, 2014 TMOB 166 at paras 30-32; *Johnston v Crazy Canucks Enterprises Ltd* (2001), 14 CPR (4th) 398 (TMOB) at para 8]. As long as some members of the public, consumers or purchasers, receive a benefit from the activity, it is a service [*Renaud Cointreau & Co v Cordon Bleu International Ltd* (2000), 11 CPR (4th) 95 (FCTD), 2002 FCA 11; *Live! Holdings LLC v Oyen Wiggs Green & Mutala LLP*, 2019 FC 1042].

[30] Accordingly, given that the Mark appeared on t-shirts worn by volunteers in the course of a fundraising event organized by the Owner, I am satisfied that the Owner has established use of the Mark in association with the registered services “events management” and “fundraising” within the meaning of sections 4 and 45 of the Act.



### *Remaining Services*

[31] With respect to the remaining Services, the Owner refers generally to “Media Relations” and “Social Media”, and discusses use of the Mark in association with a Facebook and Twitter account and a discontinued webpage. There is no evidence demonstrating how the Mark would have been displayed in association with any media services, or other remaining Services, that might have been provided in the course of the events discussed above. Further, as noted above, the Owner has not provided evidence of the contents of the Facebook and Twitter accounts; accordingly, I cannot determine whether there was any use of the Mark in association with any of the remaining Services by way of these accounts. Similarly, the Owner does not discuss what services would have been performed or advertised in association with the Mark on the Owner’s webpage. Accordingly, I am not satisfied that the Owner used the Mark in association with any of the remaining Services within the meaning of the Act.

[32] Moreover, I am not satisfied that the reasons provided by the Owner for discontinuance of the webpage would amount to special circumstances excusing non-use of the Mark in association with any of the remaining Services. In this respect, the Owner specifies in his affidavit that its website was corrupted and hacked at an undisclosed date. Because of “costs of re-building and maintaining” and an opposition by Formula One regarding the use of the trademark “CAPITAL KARTING GRAND PRIX”, he decided to “simply let it go”.

[33] The Owner’s choice to discontinue the website due to the costs of rebuilding and maintenance is a business decision within the Owner’s control, which would not amount to special circumstances excusing non-use. Similarly, the Federal Court has held that “a trade-mark dispute over a secondary mark is not an exceptional occurrence in business” [*Jose Cuervo SA de CV v Bacardi & Company Limited*, 2009 FC 1166, 78 CPR (4th) 451, aff’d 2010 FCA 248, 102 CPR (4th) 332 at para 51]. Moreover, the Owner’s choice to refrain from using the Mark because of an opposition concerning another trademark does not amount to circumstances beyond the Owner’s control.

[34] In view of the foregoing, I am not satisfied that the Owner has provided reasons for non-use of the Mark in association with the remaining Services amounting to special circumstances. The registration will be amended accordingly.

DISPOSITION

[35] In view of all 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 the registered services and the following goods:

Advertising and promotional services for third parties, namely, advertising and promoting the wares and services others by organizing and hosting product demonstrations of the products of others, annual general meetings, team builders, corporate functions, incentive trips, trade shows, exhibitions, consumer intercepts, sporting events, and developing promotional campaigns for others; brand development; business development; data collection, namely, collecting marketing information; market research; developing promotional campaigns for others through computer-based digital media on behalf of third parties; graphics design; product packaging design services; media relations and public relations; sports marketing, namely promoting sports competitions and sporting events of others; providing marketing and communications services to third parties, namely strategic marketing planning and promotions; translation services.

[36] The statement of goods will now read as follows:

Events management; fundraising.

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Ann-Laure Brouillette  
Hearing Officer  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADEMARKS 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

Bhole IP Law

For the Requesting Party