



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 126

Date of Decision: 2021-06-21

IN THE MATTER OF A SECTION 45 PROCEEDING

Richard Naranowicz

Requesting Party

and

**Mandrake Management Consultants,
a partnerships**

Registered Owner

TMA605,676 for SKATE FOR KIDS

Registration

INTRODUCTION

[1] On February 16, 2018, at the request of Richard Naranowicz (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to Mandrake Management Consultants, a partnerships (the Owner), the registered owner of Registration No. TMA605,676 for the trademark SKATE FOR KIDS (the Mark). The Mark is registered for use in association with the following services: “Organizing and sponsoring ice hockey games to raise money for various charities with a focus on children’s charities.”

[2] The notice required the Owner to show use of the Mark in Canada in association with each of the services specified in the registration at any time from February 16, 2015 to February 16, 2018 (which is the relevant period for showing use in this case). In the absence of use, the

notice required the Owner to provide the date when it was last in use and the reason for the absence of such use since that date.

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

THE PROCEEDING

[4] Section 45 of the Act provides a summary procedure for clearing “deadwood” from the trademark register. The threshold for establishing “use” is quite low and the Owner is not required to provide evidentiary overkill; however, sufficient facts must still be provided so that the Registrar can conclude that the Mark has been in “use” in association with each of the registered services during the relevant period [per *Miller Thomson LLP v Hilton Worldwide Holding LLP*, 2020 FCA 134 (*Hilton*) at paras 9 and 10].

[5] When it comes to trademarks, “use” has a specific meaning. 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 [section 4(2) of the Act]. However, advertising is not sufficient to show use; some aspect of the services must be performed or available to be performed in Canada [*Hilton* at para 7; *Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB) (*Wenward*) at para 9; *Sea Tow Services International, Inc v Trademark Factory International Inc*, 2021 FC 550 (*Sea Tow*) at paras 10 and 43]. The Act does not define “services” and it does not distinguish between primary, incidental or ancillary services; as a result, “services” should be liberally construed – it is a service as long as some members of the public (consumers or purchasers) receive a material benefit from the activity in question [*Hilton* at paras 107 to 110 and 112 to 115].

[6] In the absence of use as described above, the Mark is liable to be expunged unless the absence of use is due to special circumstances that excuse the absence of use [section 45(3) of the Act].

[7] In response to the Registrar’s notice, the Owner provided the affidavit of its Vice-President and Chief Financial Officer, Robert Sjolín, sworn on August 28, 2018. Both parties submitted written representations. Only the Requesting Party attended an oral hearing.

THE EVIDENCE

About the Owner

[8] The Owner is an executive search and human resources consultancy firm with its head office in Toronto (Sjolin affidavit, para 2). In 1991, the Owner founded and launched an all-day ice hockey tournament called SKATE FOR KIDS, which was hosted annually by the Owner in Toronto from 1991 to 2014 in order to raise money for charity (paras 4 and 5). During this time, the Owner's event raised \$861,570 for a list of charities that Mr. Sjolin provides at para 4 of his affidavit.

[9] Mr. Sjolin attests that there is an agreement between the Owner and a registered charity called Skate for Kids Inc. (SFK) allowing SFK to use the Mark as part of its corporate name (para 7). Mr. Sjolin explains that he is a director of SFK and he incorporated SFK to handle and distribute funds raised by the Owner's event (para 7).

Use of the Mark

[10] Mr. Sjolin attests that the Mark has been in continuous use by the Owner over the past decade on advertising and promotional materials (para 12).

Display of the Mark

[11] Mr. Sjolin provides a printout of the current version of the event's website (para 5; Exhibit A). The Mark appears on the website along with the words "Stay Tuned!" and "Something Exciting is coming!". The printout also provides a brief description about the event. Mr. Sjolin states that the Owner has maintained and controlled this website since October 2004 and has used the website to promote the Owner's SKATE FOR KIDS ice hockey event (para 5). Mr. Sjolin provides a copy of the domain name registration, which shows that the domain name was created in October 2004 and registered by the Owner (Exhibit B).

[12] Mr. Sjolin also provides a copy of a promotional brochure issued by the Owner (Exhibits F and G), which contains information about the Owner's SKATE FOR KIDS ice hockey event on page 15 of the brochure. Mr. Sjolin explains that the brochure was originally prepared in 2012

and has been distributed and made available by the Owner to clients at its Toronto offices (para 14). Mr. Sjolín states that the brochure has been available on its website over the past seven years (para 15). Mr. Sjolín provides a screenshot showing the homepage of the Owner's website and a brochure available for download (Exhibit H). Information about the Owner's SKATE FOR KIDS ice hockey event is also shown in the News and Events section of the homepage of the Owner's website, including a post that is dated during the relevant period (paras 15 and 18; Exhibits H1 and M).

[13] Mr. Sjolín explains that, in every email that the Owner has sent out over the past seven years, there is an electronic signature that includes a copy and a link to the brochure (para 16). Mr. Sjolín provides a screenshot of the electronic signature (Exhibit I) and he states that he sent out hundreds of emails and he is aware that other people at his company sent out thousands of emails with the electronic signature over the past seven years (para 16). For the twelve month period ending on August 21, 2018, Mr. Sjolín attests that the Owner sent out 163,008 emails with the electronic signature (para 16) and he provides a chart showing that these emails were sent to external parties during this period (Exhibit J).

[14] Mr. Sjolín provides undated photographs of a signed jersey bearing the Mark (Exhibit K) and a bar graph showing the total amount of money raised by the Owner's SKATE FOR KIDS ice hockey event and distributed to charity (Exhibit L). Mr. Sjolín explains that these items were displayed at the Owner's office in Toronto for the three year period prior to January 2018, which is when the Owner moved premises, and Mr. Sjolín states that the Owner has not yet been able to set up the displays at its new location (para 17).

[15] Lastly, Mr. Sjolín provides a screenshot of an advertisement for SKATE FOR KIDS on a third party website, which states "No event was held in 2016" (para 19; Exhibit N).

Performance of Services

[16] Mr. Sjolín attests that the Owner's latest SKATE FOR KIDS ice hockey event was held in April 2014 (para 9). Mr. Sjolín explains that no event was held during the relevant period because of a dispute with the Requesting Party who previously volunteered for the Owner's

event (para 9). Mr. Sjolín states that plans and meetings are underway for the next SKATE FOR KIDS ice hockey event which was expected to be held in the coming year (para 9).

[17] Mr. Sjolín states that, in April 2015, the Requesting Party was “instrumental in redirecting the URL SKATEFORKIDS.COM and using the name Skate for Kids without Mandrake’s authorization and attempting to use the Skate for Kids Inc. charitable # without the charity’s authorization” (para 10). Mr. Sjolín provides an email from a lawyer for the Owner and SFK about this situation (Exhibit E). The lawyer states that they talked to the Requesting Party and told him to contact Mr. Sjolín as soon as possible to “clarify things” and that the use of the name SKATE FOR KIDS was “a major problem” and that the Requesting Party should not use SFK’s charitable registration number.

[18] Mr. Sjolín provides an email and invoice from December 2012 and January 2013 sent by SFK for a logo design, which is now the subject of a trademark application that was filed by the Requesting Party in April 2016 (paras 20 to 22; Exhibits O to R). Mr. Sjolín states that he is “currently investigating [his] options with respect [to the Requesting Party]’s repeated alleged torturous [*sic*] interference and mark interference and the negative impact this has had on Skate for Kids” (para 23).

ANALYSIS AND REASONS FOR DECISION

[19] The Requesting Party raises three issues in this case: (1) there is no use of the Mark by the Owner; (2) there is no use of the Mark in association with the registered services; and, (3) there are no special circumstances that excuse non-use of the Mark. I will discuss each of these issues in turn.

Use of the Mark by the Owner

[20] In its written representations, the Requesting Party submits that the evidence does not show that the Owner exercised any level of control over use of the Mark by SFK as required under section 50 of the Act.

[21] As noted by the Requesting Party, Mr. Sjolín states that there is an agreement between the Owner and SFK that permits SFK to use the Mark as part of its corporate name (Sjolín

affidavit, para 7). The Requesting Party submits that this does not provide sufficient information about whether the Owner controls SFK's use of the Mark or whether the agreement is written. The Requesting Party also submits that the fact that certain individuals are involved with both the Owner and SFK is not sufficient to meet the requirements under section 50 of the Act.

[22] However, a written licence agreement is not required and an inference can be drawn that the requisite control exists [*Wells' Dairy Inc v UL Canada Inc* (2000), 7 CPR (4th) 77 (FCTD) at para 38; *Petro-Canada v 2946661 Canada Inc* (1998), 83 CPR (3d) 129 (FCTD) (*Petro-Canada*) at para 30; and *Lindy v Canada (Registrar of Trade Marks)*, 1999 CarswellNat 652 (FCA) at para 9]. In this case, Mr. Sjolín attests that he is the Vice President and Chief Financial Officer of the Owner as well as a director of SFK (paras 1 and 7). He also attests that he incorporated SFK (para 7). I find that this satisfies the control requirements set out in section 50 of the Act [per *Petro-Canada* at para 30].

No Use of the Mark in Association with the Registered Services

[23] The Requesting Party submits that the evidence does not show use of the Mark in association with the registered services within the meaning of sections 4 and 45 of the Act.

[24] As noted by the Requesting Party, Mr. Sjolín states that the latest SKATE FOR KIDS ice hockey event was held in April 2014, which is prior to the relevant period (para 9). The Requesting Party submits that there is no evidence that there is advertising and performance of the registered services. On the other hand, the Owner points to its own website and promotional brochure (Exhibits F to J and M), the SKATE FOR KIDS event website (Exhibits A and B), the displays at the Owner's office in Toronto (Exhibits K and L), and advertising on third party websites (Exhibit N). The Owner submits that this constitutes use of the Mark by way of advertising under section 4(2) of the Act and, as a result, the Owner submits that some aspect of the registered services were performed during the relevant period.

[25] However, advertising is not sufficient to show use; some aspect of the services must be performed or available to be performed in Canada [*Hilton* at para 7; *Wenward* at para 9; *Sea Tow* at paras 10 and 43]. The Act does not define "services" and it does not distinguish between primary, incidental or ancillary services; as a result, "services" should be liberally construed – it

is a service as long as some members of the public (consumers or purchasers) receive a material benefit from the activity in question [*Hilton* at paras 107 to 110 and 112 to 115].

[26] In this case, there is no suggestion that the primary service has been performed during the relevant period, namely “Organizing and sponsoring ice hockey games to raise money for various charities with a focus on children’s charities”, given that no event has been held since 2014 (Sjolin affidavit, para 9). The question remains whether some incidental or ancillary aspect of the service was performed or available to be performed in Canada and whether members of the public received a material benefit from that activity.

[27] The Owner submits that some aspect of the registered services were performed during the relevant period. In particular, the Owner points out that it continued to advertise and promote the amount of funds raised from previous events and the SKATE FOR KIDS event in general even though no event was held during the relevant period. However, I find that the Owner’s activities during the relevant period amount to advertising as evidenced by the self-promotional nature of the material provided in the exhibits which highlight the Owner’s charitable activities, such as the Owner’s website and promotional brochure (Exhibits F to J and M) and the displays at the Owner’s office in Toronto (Exhibits K and L). Because the evidence is limited to the Owner’s promotion of its own past charitable activities, it is not clear that any members of the public received a material benefit from these promotional activities during the relevant period [per *Hilton* at paras 112 to 115; *Ralston Purina Co v Effem Foods Ltd* (1997), 81 CPR (3d) 528 (TMOB) at para 14]. Furthermore, in the absence of an event being held during the relevant period, I do not find that the information provided on the SKATE FOR KIDS event website (Exhibits A and B) nor the advertising on third party websites (Exhibit N) constitute a material benefit to members of the public.

[28] At best, these activities would amount to advertising of the registered services. However, display of a trademark in the context of advertising of services will only amount to use within the meaning of the Act where the services are available to be performed in Canada [*Wenward* at para 9; *Sea Tow* at paras 10 and 43]. In this case, it is clear that the services, “Organizing and sponsoring ice hockey games to raise money for various charities with a focus on children’s

charities”, were not available to performed in Canada for the reasons set out in Mr. Sjolín’s affidavit, namely, the dispute with the Requesting Party (para 9).

[29] As a result, I am not satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act.

No Special Circumstances Excusing Non-Use of the Mark

[30] As the Owner has not shown use of the Mark during the relevant period, the issue now is whether there are special circumstances that excuse such non-use [section 45(3) of the Act]. The general rule is that absence of use will be penalized by expungement, but there may be an exception where the absence of use is excusable due to special circumstances [*Scott Paper Ltd v Smart & Biggar*, 2008 FCA 129 (*Scott Paper*) at para 22].

[31] To determine whether special circumstances have been established, I must first determine, in light of the evidence, why in fact the Mark was not used during the relevant period. Second, I must determine whether the reasons for non-use constitute special circumstances [*Canada (Registrar of Trade Marks) v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA) (*Harris Knitting Mills*) at para 10; and *Scott Paper* at paras 24 and 25]. Special circumstances mean that they are “unusual, uncommon or exceptional” [*John Labatt Ltd v The Cotton Club Bottling Co* (1976), 25 CPR (2d) 115 (FCTD) (*Cotton Club*) at para 29].

[32] If I determine that the reasons for non-use constitute special circumstances, I must still decide whether such special circumstances excuse the period of non-use. This involves the consideration of three criteria: (i) the length of time during which the Mark has not been in use; (ii) whether the reasons for non-use were beyond the control of the Owner; and, (iii) whether there exists a serious intention to shortly resume use [per *Harris Knitting Mills* at para 11; *Scott Paper* at para 30; and *One Group LLC v Gouverneur Inc*, 2016 FCA 109 (*One Group*) at para 6].

[33] All three criteria are relevant, but satisfying the second criterion is essential for a finding of special circumstances excusing non-use [per *Harris Knitting Mills* at para 11; *Scott Paper* at paras 26 and 28; and *One Group* at para 7].

Special Circumstances

[34] In its written representations, the Owner submits that the Mark has not been used since 2014 because it moved premises and the Requesting Party has “engaged in activities to steal the mark” (Owner’s written submissions, page 4). The Owner points to Mr. Sjolín’s affidavit which indicates that no event was held during the relevant period because of a dispute with the Requesting Party (para 9) and options were “currently” being investigated regarding the Requesting Party’s “repeated alleged torturous [*sic*] interference” (para 23).

[35] With respect to the Owner moving premises, Mr. Sjolín does not indicate that these circumstances were special for an organization in the Owner’s industry or for business in general. Mr. Sjolín also does not provide any details as to how a move to a new location would prevent the Owner from using the Mark and performing the registered services, namely “Organizing and sponsoring ice hockey games to raise money for various charities with a focus on children’s charities”. In the absence of further information, I am not satisfied that this is the sort of “uncommon, unusual or exceptional” reasons for non-use that constitute special circumstances [per *Cotton Club* at para 29].

[36] With respect to the dispute with the Requesting Party, I note that trademark disputes and legal disputes, more generally, are not necessarily an exceptional occurrence in business [*Jose Cuervo SA de CV v Bacardi & Co*, 2009 FC 1166 (*Jose Cuervo*) at para 51, *aff’d* 2010 FCA 248; *Smart & Biggar v Achar*, 2015 TMOB 1 at para 29; *Karoun Dairies Inc v Karoun Dairies SAL*, 2013 TMOB 228 at paras 41 to 43]. However, Mr. Sjolín also states that the Requesting Party was “instrumental in redirecting the URL SKATEFORKIDS.COM ... and attempting to use the Skate for Kids Inc. charitable # without the charity’s authorization” (para 10). This aspect of the dispute with the Requesting Party appears to be rather unusual or uncommon. As a result, I conclude that these reasons for non-use of the Mark amount to special circumstances.

Circumstances Do Not Excuse Non-Use

[37] Although I accept that the Owner’s reasons for non-use could be considered “unusual, uncommon or exceptional”, I am not satisfied that they excuse the period of non-use.

[38] With respect to the length of non-use, Mr. Sjolín indicates that the latest SKATE FOR KIDS event was held in April 2014 (para 9). This is a relatively short period of non-use, which weighs in the Owner's favour.

[39] However, in terms of whether the reasons for non-use are beyond the Owner's control, the absence of use in this case appears to be due to a voluntary decision by the Owner. If the Owner chose to refrain from using the Mark pending the resolution of a dispute between it and the Requesting Party, then – in the absence of further details – such a decision can only be considered a voluntary decision of the Owner [per *Jose Cuervo* at para 62].

[40] Mr. Sjolín states that the Requesting Party, a former volunteer for the SKATE FOR KIDS event, was “instrumental in redirecting the URL SKATEFORKIDS.COM and using the name Skate for Kids without Mandrake's authorization and attempting to use the Skate for Kids Inc. charitable # without the charity's authorization” (paras 9 and 10). Despite this, Mr. Sjolín states that the Owner has maintained and controlled the SKATE FOR KIDS event website since October 2004 (para 5). Based on this information, it is not clear how the Requesting Party's actions prevented the Owner from using the Mark and performing the registered services, namely “Organizing and sponsoring ice hockey games to raise money for various charities with a focus on children's charities”. Mr. Sjolín simply does not provide sufficient context in this regard. As a result, without further details, I am unable to determine whether the absence of use in this case was as a result of special and unusual factors beyond the Owner's control or if it was due to voluntary or deliberate decisions on behalf of the Owner.

[41] In any event, even had the second criterion of the test for special circumstances been met, the intention to resume use of the Mark has not been satisfied. In this respect, there must be “a sufficient factual basis” that is supported by the evidence in order for an owner to show that it seriously intends to resume use of a mark [*NTD Apparel Inc v Ryan* (2003), 27 CPR (4th) 73 (FCTD) at paras 22 to 27; and *Arrowhead Spring Water Ltd v Arrowhead Water Corp* (1993), 47 CPR (3d) 217 (FCTD) at paras 9, 12 and 14].

[42] In this case, Mr. Sjolín only makes a general statement that plans and meetings are underway for the next SKATE FOR KIDS ice hockey event which was expected to be held in

the coming year (para 9). No supporting documents, corroborating evidence, nor concrete steps are provided to indicate that the Owner has a genuine intention to resume use of the Mark.

[43] In addition, it is not clear what active steps the Owner took to deal with the dispute involving the Requesting Party. Mr. Sjolín provides an email from a lawyer for the Owner and SFK regarding the dispute (Exhibit E). The lawyer states that they talked to the Requesting Party and told him to contact Mr. Sjolín as soon as possible to “clarify things” and that the use of the name SKATE FOR KIDS was “a major problem” and that the Requesting Party should not use SFK’s charitable registration number. The email appears to be from April 2015 and it is not clear what steps the Owner took to deal with the dispute since that time.

[44] The only additional information provided by Mr. Sjolín in his affidavit is that he was “currently” investigating options regarding the Requesting Party’s “repeated alleged torturous [*sic*] interference” (para 23). It is not clear why these options were not investigated earlier during the relevant period despite the dispute going on for several years and no SKATE FOR KIDS event being held during that time. In the absence of evidence of such concrete steps, I am not satisfied that the Owner has demonstrated a serious intention to shortly resume use of the Mark.

[45] As a result, although I conclude that the reasons for non-use provided by the Owner constitute special circumstances, I am not satisfied that those circumstances excuse the period of non-use.

Conclusion on Special Circumstances

[46] Accordingly, I am not satisfied that the Owner has demonstrated special circumstances excusing non-use of the Mark within the meaning of section 45(3) of the Act.

DISPOSITION

[47] Based on the findings above, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be expunged.

Bradley Au
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2021-05-17

APPEARANCES

No one appearing

For the Registered Owner

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For the Requesting Party

AGENTS OF RECORD

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For the Requesting Party