



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 147

Date of Decision: 2021-07-21

IN THE MATTER OF A SECTION 45 PROCEEDING

Smart & Biggar

Requesting Party

and

**Harrison-Hoge Industries, Inc. (a New
Jersey corporation)**

Registered Owner

**TMA222,431 for SEA EAGLE &
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. TMA222,431, for the trademark SEA EAGLE & DESIGN (the Mark), shown below:



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

THE PROCEEDING

[3] At the request of Smart & Biggar (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on May 24, 2019, to Harrison-Hoge Industries, Inc. (a New Jersey corporation) (Harrison NJ), listed as the registered owner of the Mark.

[4] The notice required the registered owner to show whether the Mark had been used in Canada in association with each of the goods specified in the registration 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 May 24, 2016, to May 24, 2019.

[5] The Mark is registered for use in association with the goods “Inflatable boats, and canoes”.

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

[7] In response to the Registrar’s notice, the affidavit of Cecil C. Hoge Jr., sworn on December 18, 2019, was furnished. Neither party submitted written representations. No oral hearing was held.

EVIDENCE & REASONS FOR DECISION

[8] Mr. Hoge explains that he is the President of Harrison Hoge Industries Inc., a New York corporation (Harrison NY), and of Sea Eagle Boats, Inc. (SEB). He explains that Harrison NJ, the registered owner, was merged into Harrison NY on December 13, 1999, with the surviving company being Harrison NY, and that Harrison NY and SEB share common ownership and a common business address. He further explains that Harrison NY sold its inflatable boat, canoe and kayak line of business and the Mark to SEB on December 14, 2007. As Exhibits A and B, he

attaches documentation confirming these changes. While I note that SEB has not requested to record this assignment with the Registrar's Assignment and Renewal Section, such changes do not need to be recorded by the Registrar to be valid [see *Sim & McBurney v Buttino Investments Inc/Les Investissements Buttino Inc* (1996), 66 CPR (3d) 77 (FCTD) aff'd (1997), 76 CPR (3d) 482 (FCA)]. Accordingly, I accept that SEB is the owner of the Mark. I note that even if I were not prepared to draw such a conclusion, I would be satisfied that any use by SEB would enure to Harrison NY, the successor to the registered owner following the merger between the two, given that Harrison NY and SEB have the same president, common ownership, and the same business premises [see *Petro-Canada v 2946661* (1998), 83 CPR (3d) 129 (FCTD)].

[9] Mr. Hoge explains that SEB's normal course of trade for the sale of the registered goods in Canada has been to sell directly to Canadian customers through SEB's website, or through dealers located in Canada. He states that the Mark is displayed directly on SEB's goods. As Exhibits C and E, respectively, he attaches photographs of an inflatable boat and a canoe. Each displays a variation of the Mark; the boat displays a variant in which a similar, but not identical, design element is positioned after the text instead of before it, while the canoe displays the words "SEA EAGLE.com" with a further variation of the design element above the text. Mr. Hoge describes the latter variation as the "updated mark" used since January 2000, and confirms that these photographs are representative of how the Mark was displayed on these goods during the relevant period.

[10] In this respect, where a trademark in use differs from the mark as registered, the question to be asked is whether the trademark was used 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 mark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[11] More particularly, the Registrar and courts have found on numerous occasions that the dominant element of a design mark is a word [see, for example, *Rogers Media Inc v La Cornue*, 2019 TMOB 63 at para 44; *Smart & Biggar v. Canadian Tire Corporation, Limited*, 2020

TMOB 89 [*Canadian Tire*] at paras 29-31], and that the dominant word element of a design mark is preserved despite changes in font or capitalization [see, for example, *Gowling Lafleur Henderson LLP v Henry Company, LLC*, 2017 TMOB 51 at paras 23-24; *Antler Limited v Atom SpA*, 2020 TMOB 4 at para 11], despite the addition of “.com” [see *Star Island Entertainment LLC v Provent Holdings Ltd*, 2013 TMOB 84 at para 24; *Kestenberg Siegal Lipkus LLP v Patty Djan Inc*, 2018 TMOB 68 at para 16], or despite the omission of small design elements [see *Lapointe Rosenstein Marchand Melançon LLP v American Dairy Queen Corp*, 2014 TMOB 185 at para 14; *Canadian Tire* at paras 29-31].

[12] In this case, the dominant element of the Mark is the words “SEA EAGLE”, and these are preserved in both variations of the Mark despite changes in font and in the design element, and despite the addition of “.com” in the updated Mark. Accordingly, I am satisfied that display of either variation amounts to display of the Mark.

[13] As Exhibit D, Mr. Hoge attaches an invoice dated during the relevant period showing a sale by SEB’s Toronto-based distributor of an inflatable boat displaying the Mark as shown in Exhibit C. He states that the Owner’s goods were sold during the relevant period through at least five such dealers in Canada during the relevant period, and confirms that canoes such as the one shown in Exhibit E were also sold to Canadians during the relevant period.

[14] As SEB has demonstrated that it sold inflatable boats and canoes displaying the Mark in Canada in the normal course of trade during the relevant period, I am satisfied that SEB has used the Mark within the meaning of sections 4 and 45 of the Act in association with each of the registered goods.

DISPOSITION

[15] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

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

Moffat & Co.

For the Registered Owner

Smart & Biggar LLP

For the Requesting Party