



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 146

Date of Decision: 2021-07-21

IN THE MATTER OF A SECTION 45 PROCEEDING

Carters Professional Corporation

Requesting Party

and

**Ontario Lung Association a legal
entity**

Registered Owner

TMA909,907 for BREATHE!

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. TMA909,907 for the trademark BREATHE! (the Mark), owned by Ontario Lung Association a legal entity (the Owner).

[2] For the reasons that follow, I conclude that the registration ought to be maintained with respect to the registered services only.

THE PROCEEDINGS

[3] At the request of Carters Professional Corporation (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on May 29, 2019.

[4] The notice required the Owner to show whether the Mark had been used in Canada in association with each of the goods and services 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 29, 2016, to May 29, 2019.

[5] The Mark is registered for use in association with the following goods and services:

GOODS

Mobile health and web-based computer application for facilitating management of respiratory diseases and respiratory conditions; mobile health and web-based computer application for facilitating management of asthma; mobile health and web-based computer application that allows patients to have access to their personal health information and electronic medical records.

SERVICES

Fundraising services for the advancement of lung health, lung health research, respiratory health and lung disease treatment; fundraising services to promote avoidance of lung disease; organizing and implementing fundraising programs and events.

[6] The relevant definitions of use in the present case 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 trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[7] It is well established that 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)]. However, 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 goods and services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Peter Glazier, sworn on August 20, 2019. Both parties submitted written representations; no oral hearing was held.

THE EVIDENCE

[9] Mr. Glazier is the Vice-President, Marketing, Development and Public Affairs of the Owner. He explains that every year since 2009, the Owner has organized and implemented a ticketed and sponsored fundraising gala event in Toronto entitled "BREATHE!". He states that the purpose of this gala is to raise funds for the advancement of lung health, for lung health research, for respiratory health, for lung disease treatment and to promote avoidance of lung disease. In particular, Mr. Glazier states that three such events occurred during the relevant period on January 26, 2017, January 25, 2018, and March 28, 2019, each of which was attended by over 250 people and raised over \$100,000 for the purposes noted above.

[10] Mr. Glazier attaches the following exhibits to his affidavit:

- Exhibit A: a photograph of a viewing screen displaying the word "Breathe! AN EVENING OF INSPIRATION TO BENEFIT LUNG HEALTH RESEARCH". He states that this screen was visible to all attendees at the 2017 event.
- Exhibit B: a PowerPoint slide deck displaying the word "BREATHE" on the front cover and the words "BREATHE! GALA" and "Breathe!" throughout the slides. Mr. Glazier states that this slide deck was distributed by email between November 9, 2017, and January 24, 2018, to over 100 locations in Canada, including more than 50 companies, to promote the 2018 event.
- Exhibit C: a screenshot from *support.on.lung.ca* showing the words "breathe! bash" and advertising ticket sales for the 2019 event. Mr. Glazier describes this screenshot as a Facebook post made on March 16, 2019, by the Owner to advertise ticket sales, and that the post's reach was 354.

- Exhibit D: a photograph of an individual standing in front of a screen showing the word “breathe!”. Mr. Glazier states that this presenter was visible to all attendees.
- Exhibit E: a PowerPoint slide deck showing “breathe! bash” on its front cover and throughout the slides. Mr. Glazier states that this slide deck was distributed by email between February 13, 2018, and March 28, 2019, to over 100 locations in Canada, including more than 50 companies, to promote the 2019 event.

REASONS FOR DECISION

[11] Mr. Glazier does not refer to the registered goods in his affidavit or to any special circumstances excusing non-use of the Mark. Further, in its written representations, the Owner makes no submissions regarding the registered goods and submits only that the registered services should be maintained. Accordingly, the registration will be amended to delete the registered goods.

[12] With respect to the registered services, the Requesting Party submits that the Owner’s evidence does not demonstrate use of the Mark in association with any such services. In this respect, the Requesting Party submits that a number of Mr. Glazier’s sworn statements relating to the galas amount to “bald assertions”, and submits that Mr. Glazier has not stated that any of the exhibits show use in association with the registered services. The Requesting Party further submits that the affidavit is unreliable, noting, *inter alia*, that the Exhibit C screenshot “most assuredly does not show a Facebook post” but instead, a screenshot from what appears to be the Owner’s website.

[13] In response, the Owner submits, and I agree, that evidence in a section 45 proceeding must be considered as a whole, and focusing on individual pieces of evidence in isolation is not the proper approach [see *Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB); and *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB)], and that an affiant’s statements 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]. Accordingly, while I agree with the Requesting Party that the Exhibit C screenshot does not appear to be a Facebook post, in my view, this discrepancy does not call into question the reliability of the affidavit in general.

[14] In this case, Mr. Glazier describes the Owner’s performance of the registered services in the form of fundraiser galas, and has provided evidence pertaining to those galas. I am therefore satisfied that any use of the Mark in the performance or advertising of these galas would be use in association with each of the registered services, bearing in mind the principle that “in certain cases, statements of services contain overlapping and redundant terms in the sense that the performance of one service would necessarily imply the performance of another” [*Gowling Lafleur Henderson LLP v Key Publishers Co*, 2010 TMOB 7 at para 15; see also *Provent Holdings Ltd v Star Island Entertainment, LLC*, 2014 TMOB 178 at para 22; *GMAX World Realty Inc v RE/MAX, LLC*, 2015 TMOB 148 at para 69].

[15] The Requesting Party also submits that the evidence does not show use of the Mark as registered, noting that such evidence displays stylized variations of the Mark, or use of the Mark along with additional elements. If a word mark is used in a stylized form, or in combination with additional words or features, use will be considered when the public, as a matter of first impression, would perceive the mark as being used *per se* [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB) [*Nightingale*]]. This is a question of fact which is dependent on whether the mark stands out from additional material, for example, by the use of different lettering, sizing, or whether the additional material would be perceived as clearly descriptive or as a separate trademark or tradename [*Nightingale*; see also *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)].

[16] In this case, I agree with the Owner that despite the variations to the Mark, including the use of lower case letters or the addition of “gala” or “bash”, the public would nevertheless perceive the Mark as being used *per se*. In this respect, I note that the Mark stands out from the additional material by the use of different lettering and the additional words amount to clearly descriptive material.

[17] As the Owner has demonstrated that it displayed the Mark in the performance and advertising of the registered services in Canada during the relevant period, I am satisfied that the Owner has used the Mark in association with the registered services within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[18] 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 the registered goods. The registered services will be maintained in their entirety.

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

Ridout & Maybee LLP

For the Registered Owner

Carters Professional Corporation

For the Requesting Party