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LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 212**

**Date of Decision: 2021-09-29**

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

**Kevin E. Holbeche (Holbeche Law)**

**Requesting Party**

**and**

**Brenda Yamanaka**

**Registered Owner**

**TMA886,476 for**

**Registration**

**Okinawa Goju Ryu Karatedo  
Federation**

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. TMA886,476 for

the trademark Okinawa Goju Ryu Karatedo Federation (the Mark), currently owned by Brenda Yamanaka.

[2] All references are to the Act as amended June 17, 2019 (the Act), unless otherwise noted.

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

Lapel pins, decals, medallions, martial arts uniforms, belts, flags, books, crests, certificates, documents, manuals, signs, banners, business cards, shirts, pants, sweatshirts and pants, jackets and headbands. (the Goods)

Operation of a Martial Arts Organization, namely, providing courses, gradings seminars, tournaments, and providing management expertise namely, providing business management services. (the Services)

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

#### THE PROCEEDINGS

[5] At the request of Kevin E. Holbeche (Holbeche Law) (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on June 4, 2019, to Brenda Yamanaka (the Owner), the registered owner of the Mark.

[6] The notice required the Owner to show whether the trademark has been used in Canada in association with each of the goods and 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 June 4, 2016 to June 4, 2019 (the Relevant Period).

[7] 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 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.

[8] It is well established that bare statements that a trademark is in 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 Canada (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 goods and services during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

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

[10] In response to the Registrar's notice, the Owner furnished an affidavit of Brenda Yamanaka sworn on July 6, 2019 along with photocopies of various documents and photos.

[11] Only the Requesting Party submitted written representations and no hearing was held.

#### THE EVIDENCE

[12] Ms. Yamanaka states, "That the name Okinawa Goju Ryu and the organization known as Okinawa Goju Ryu Karatedo Federation has been in use since 1986." (the Federation)

[13] Ms. Yamanaka further states, "The Okinawa Goju Ryu Karatedo Federation was established as a non profit fraternal cultural heritage body whose sole purpose was to maintain the integrity and standards as taught to Mr. Ronald Yamanaka by his grand Master in Okinawa, Eiichi Miyazato."

[14] Ms. Yamanaka then makes the following series of statements:

- (a) The Federation, "...sent a Canadian team to Japan to compete in the World Championships in 1997."
- (b) "The Track Uniforms were all emblazoned with the name Okinawa Goju Ryu Karatedo Federation."

- (c) “There were also decals, pins and an assortment of items all created to help and offset the cost of travel and accommodation for the 36 person team.”

[15] Ms. Yamanaka states that, “The Federation is currently undergoing a change of leadership and will continue to remain steadfast in its purpose to preserve the various traditions and forms of the original teachings in order to prevent fraudulent interpretations of the style.”

[16] The photocopies attached to her affidavit include:

- (i) A “Certificate of Rank Promotion” on which appears the Mark.
- (ii) A depiction of a crest that bears the Mark.
- (iii) A depiction of what appear to be the front and back of a medallion, one side of which shows the following:

OKINAWA GOJU RYU

KARATEDOH FEDERATION

JUNDOKAN

- (iv) A document dated 13 November 1993 entitled “Protocol of Friendship and Cooperation” which includes what appear to be signature lines for various entities, one of which is defined as Okinawa Goju-Ryu Karate-Doh Fed. (Canada).

- (v) A depiction of a shirt which includes the following text:

OKINAWA GOJU RYU

KARATE DOH FEDERATION

JUNDOKAN

- (vi) A photograph of a group of people. The Mark does not appear in the photograph. A handwritten note from an unidentified person appears on the back of the photocopy and states: “This is the 1997 team that represented Canada’s Okinawa Goju Ryu Karatedo Federation of the World Championship held in Okinawa Japan.”

Irrelevant Evidence

[17] The following documents are also attached to the affidavit:

- (a) Photocopy of an extract of the register for application 1,603,811 for the Mark as of March 3, 2014. This application matured to the registration and is the subject of these Section 45 proceedings.
- (b) Photocopy of Trade-marks Certificate of Registration for Canadian registration TMA451,782 for the trademark OKINAWA GOJU RYU KARATEDO FEDERATION which was expunged July 28, 2011.
- (c) Photocopy of Trade-marks Certificate of Registration for Canadian registration TMA484,267 for the trademark OKINAWA GOJU RYU which was expunged May 30, 2013.

[18] None of these documents are relevant to this section 45 proceeding as they cannot assist the Owner in establishing use of the Mark in Canada during the Relevant Period.

## REQUESTING PARTY'S SUBMISSIONS

[19] The Requesting Party raises numerous issues but to dispose of the matter, it will be sufficient to refer to the following arguments:

- The evidence does not explain a relationship or association between the Owner and the Federation.
- There is no evidence showing use of the Mark in Canada by the Owner or a licensee during the Relevant Period.
- The Affidavit provides no explanation of special circumstances that would excuse any absence of use of the Mark by the Owner in Canada during the Relevant Period, in accordance with section 45(3).

## ANALYSIS AND REASONS FOR DECISION

### Relationship between Owner and Federation

[20] The affidavit of Ms. Yamanaka provides no explanation of how the Owner and the Federation may be related or associated or whether the Federation was a licensed user of the Mark in Canada for the Goods and Services during the Relevant Period. Therefore, statement or evidence of use of the Mark by the Federation cannot enure to the benefit of the Owner.

### No evidence of use of the Mark during the Relevant Period

[21] The affidavit provides no sales figures or invoices for any of the Goods or Services under the Mark in Canada within the Relevant Period, regardless of whether sales may originate with the Owner or a licensee.

[22] There is no evidence of transfer of ownership of the Goods nor any advertisement of the Services in Canada during the Relevant Period.

[23] In any event, Ms. Yamanaka describes in her affidavit events that took place outside the Relevant Period.

## Non-use of the Mark - Special Circumstances

### Introduction

[24] 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 [*Smart & Biggar v Scott Paper Ltd*, 2008 FCA 129].

[25] While the Owner has made no claim of special circumstances explaining the lack of use of the Mark in Canada in association with the Goods and Services during the Relevant Period, the question is, does Ms. Yamanaka's statement that, "The Federation is currently undergoing a change in leadership...", constitute special circumstances which excuse the absence of use of the Mark pursuant to section 45(3) of the Act.

### The Test

[26] To determine whether special circumstances have been established, the Registrar must first determine, in light of the evidence, why in fact the trademark was not used during the relevant period. Second, the Registrar must determine whether these reasons for non-use constitute special circumstances [per *Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA)]. The Federal Court has held that special circumstances mean circumstances or reasons that are "unusual, uncommon, or exceptional" [*John Labatt Ltd v Cotton Club Bottling Co* (1976), 25 CPR (2d) 115 (FCTD) at para 29].

[27] In this case, I find that the reason for non-use of the Mark being that the Federation was undergoing a change in leadership is not a reason that is unusual, uncommon or exceptional such that it would constitute a special circumstance excusing the absence of use of the Mark in Canada by the Owner during the Relevant Period, within the meaning of s.45(3) of the Act.

### CONCLUSION

[28] In view of my conclusions above, I do not need to address the other issues raised by the Requesting Party.

[29] In this matter, for the reasons described herein, the Owner has not submitted evidence showing use of the Mark in Canada in association with any of the Goods or the Services in the normal course of trade during the Relevant Period, nor provided any facts that would constitute special circumstances that would excuse non-use of the Mark in association with any of the Goods or the Services in Canada during the Relevant Period.

DISPOSITION

[30] Pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be expunged in compliance with the provisions of section 45 of the Act.

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Jean Carrière  
Member  
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

Kevin E. Holbeche (Holbeche Law)

For the Requesting Party