



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 210**

**Date of Decision: 2021-09-24**

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

**Nexus Law Group LLP**

**Requesting Party**

**and**

**Barcade Holdings, LLC**

**Registered Owner**

**TMA829,032 for BARCADE**

**Registration**

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA829,032 for the trademark BARCADE (the Mark).

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

**GOODS**

(1) Beverage glassware; foam drink holders; hats; shirts; sports caps and hats; sweat shirts; t-shirts.

**SERVICES**

(1) Bars; bar services; bar services featuring snacks.

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

THE PROCEEDING

[4] On April 12, 2018, at the request of Nexus Law Group LLP (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to Barcade, LLC, the registered owner of the Mark at the time. The notice required the owner of the Mark to show whether it was 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 the Mark 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 between April 12, 2015 and April 12, 2018.

[5] I note that the subject registration was assigned to Barcade, Inc. on June 1, 2014 pursuant to a *nunc pro tunc* assignment recorded by the Registrar on April 27, 2018. The registration was subsequently assigned to Barcade Holdings, LLC (the Owner) pursuant to an assignment effective March 14, 2018, and recorded by the Registrar on September 4, 2019.

[6] In response to the Registrar's notice, the Owner submitted the affidavit of Paul Kermizian, Chief Executive Officer of the Owner, sworn on September 28, 2018.

[7] Only the Owner filed written representations. No oral hearing was held.

THE OWNER'S EVIDENCE

[8] In his relatively brief affidavit, Mr. Kermizian explains that the Owner operates a "social establishment that offers classic video games and American craft beer under one roof". According to Mr. Kermizian, the original Barcade location opened in 2004 in Brooklyn, New York and the Owner has since then opened six additional locations throughout the Eastern United States.

[9] Mr. Kermizian only asserts use of the Mark in Canada in association with the registered goods. He attests that the Owner advertises its goods to Canadians through its website located at

*www.barcade.com*. Mr. Kermizian also explains that the Owner’s website receives “significant website traffic from Canadians each year”. Mr. Kermizian attests that, for example, from April 30, 2017 to April 30, 2018, the website received more than 1,600 visits from Canadians.

[10] Mr. Kermizian states that in Canada, the Owner “generally sells its goods under [the Mark] through the Barcade website”. In support, he attaches a single invoice from an online purchase made by a Canadian customer (Exhibit B). He attests that the exhibited invoice is representative of those issued by the Owner to customers “for the sale of its Barcade goods in Canada”. The invoice is dated December 9, 2017 and its heading displays the Mark together with a design element. The invoiced good is listed as a “Barcade® New York Men’s Black T-Shirt”. The billing and shipping addresses for the customer are located in Whistler, British Columbia.

[11] Finally, Mr. Kermizian attests that during the relevant period the Mark was prominently displayed on the Owner’s goods. In support, he attaches photographs of goods displaying the Mark (Exhibit A). These photographs show the Mark displayed on a t-shirt, a drinking glass, a hat and a hooded sweatshirt.

#### ANALYSIS AND REASONS FOR DECISION

[12] At the outset, I note that the Mr. Kermizian does not assert use in association with the registered services. As there is no evidence before me of special circumstances excusing non-use of the Mark, the entirety of the registered services will be deleted from the registration.

[13] The issue before me is therefore to determine whether the Owner has shown use in association with each of the registered goods.

[14] The relevant definition of “use” 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.

[15] In view of the exhibited photograph showing the Mark displayed on a t-shirt, as well as the Exhibit B invoice, there is no question that the Owner has demonstrated use of the Mark in association with “t-shirts” within the meaning of sections 4 and 45 the Act.

[16] With respect to the remaining goods, in its written representations, the Owner submits that the affidavit “provides clear and unambiguous evidence of use of the Mark by the [Owner] in association with the Registered Goods during the Relevant Period” and essentially argues that it is only required to establish a *prima facie* case of use. The Owner also submits that there is no requirement that invoices be filed in a section 45 proceeding and contends that “no quantitative amount of sales is required to sustain a registration”.

[17] Although I agree that direct documentary evidence of transfers – such as invoices – are not required for each registered good, some evidence of transfers is still necessary. Such evidence can be in the form of documentation like invoices, sales reports, but can also be through clear sworn statements regarding volumes of sales, dollar value of sales, or equivalent factual particulars [see, for example, *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79]. In other words, while the evidentiary threshold is low in section 45 proceedings, the registered owner must still provide sufficient facts to permit the Registrar to arrive at a conclusion of use of the trademark in association with *each* of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA); see also *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[18] In this case, the Owner is essentially arguing that Mr. Kermizian’s general allegations of use and one representative invoice are sufficient to maintain the registration in association with all of the registered goods. I disagree.

[19] First, 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)].

[20] Second, the evidence provides no factual basis from which I could conclude that the remaining goods were sold or transferred in the normal course of trade in Canada during the relevant period or otherwise [per *John Labatt*]. In particular, regarding sales in Canada, Mr. Kermizian only states that the Owner “generally sells its goods... through the Barcade website”, but provides no statement or factual particulars regarding actual sales of specific goods in Canada.

[21] Third, while certain registered goods are depicted in the Exhibit A photographs, I am not prepared to infer that such goods were sold in Canada during the relevant period in the absence of a clear statement or supporting evidence in this regard.

[22] Accordingly, I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the remaining goods within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances before me which would excuse non-use of the Mark in association with the remaining registered goods, these goods will be deleted.

#### DISPOSITION

[23] 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 entirety of the services as well as the following registered goods: “Beverage glassware; foam drink holders; hats; shirts; sports caps and hats; sweat shirts;”.

[24] The Mark will now be registered in association with “t-shirts.”

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Eve Heafey  
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**

Moffat & Co.

For the Registered Owner

Nexus Law Group LLP

For the Requesting Party