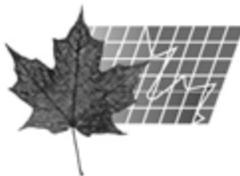


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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 234

Date of Decision: 2021-10-22

IN THE MATTER OF A SECTION 45 PROCEEDING

Wilson Lue LLP

Requesting Party

and

Bookmasters Limited

Registered Owner

TMA260,155 for CITY BOOKS

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. 260,155 for the trademark CITY BOOKS (the Mark), owned by Bookmasters Limited.

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

Services of providing a retail outlet for printed publications of all types and the services of publishing all types of printed publications.

[3] At the request of Wilson Lue LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on October 18, 2019, to Bookmasters Limited (the Owner), the registered owner of the Mark.

[4] The notice required the Owner to show whether the Mark was used in Canada in association with each of the 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 October 18, 2016 to October 18, 2019.

[5] The relevant definition of use in the present case is set out in section 4(2) of the Act as follows:

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.

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

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

[8] In response to the Registrar's notice, the Owner furnished the affidavit of J. Frans Donker sworn October 15, 2020 in Toronto, Ontario.

[9] Neither party submitted written representations and no oral hearing was held.

THE EVIDENCE

[10] In his affidavit, Mr. Donker states that he is employed by the Owner as an adviser, having been the Chief Executive Officer and President of the Owner from 1976 until his retirement in 2014.

[11] Mr. Donker attests that the Owner operated four CITY BOOKS retail bookstores in Toronto during the relevant period. In support, attached as Exhibits A to F are photographs of banners showing the Mark, which Mr. Donker confirms were displayed at the front entrances of each store during the relevant period.

[12] Mr. Donker states that during the relevant period sales of publications at the bookstores, "...were about \$5 million per year, with about 80% being sales of books, 10% being sales of magazines and newspapers and 8% greeting cards, mugs and other book related paraphernalia."

[13] Also attached to the affidavit, as Exhibits G and H, are photographs of shopping bags bearing the Mark. Mr. Donker explains that approximately 400,000 such shopping bags were provided to customers at the Owner's bookstores during the relevant period.

ANALYSIS

[14] In this case, it is clear that the Owner's evidenced display of the Mark on signage and on bags during the relevant period correlates to the registered services, "Services of providing a retail outlet for printed publications of all types."

[15] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with "Services of providing a retail outlet for printed publications of all types" within the meaning of sections 4 and 45 of the Act.

[16] There is, however, no evidence of use of the Mark in association with "the services of publishing all types of printed publications." As such, I am not satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act in association

with such remaining services. Furthermore, there is no evidence of special circumstances before me. The registration will be amended accordingly.

DISPOSITION

[17] In compliance with the provisions of section 45 of the Act and pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete “the services of publishing all types of printed publications” from the statement of services.

[18] The amended statement of services will be as follows:

Services of providing a retail outlet for printed publications of all types.

Tracey L Mosley
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

AGENTS OF RECORD

McMillan LLP

For the Registered Owner

Wilson Lue LLP

For the Requesting Party