



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 214
Date of Decision: 2021-09-29

IN THE MATTER OF A SECTION 45 PROCEEDING

**BURNET, DUCKWORTH & PALMER
LLP**

Requesting Party

and

Alex Dordevic

Registered Owner

TMA598,185 for TRIBE

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA598,185 for the trademark TRIBE (the Mark), owned by Alex Dordevic (the Owner) for only the Goods and Services below:

Goods:

- (1) Printed publications, namely consumer magazines in the fields of fashion, music and entertainment.

Services:

- (1) Providing on-line magazines accessible through the global computer network;

[2] For the reasons that follow, the Goods will be deleted and the registration will be maintained in respect of the Services.

The Proceeding

[3] On October 30, 2019, the Registrar of Trademarks sent a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to the Owner. This notice was sent at the request of BURNET, DUCKWORTH & PALMER LLP (the Requesting Party).

[4] The notice required the Owner to provide evidence showing that he had used the Mark in Canada, at any time between October 30, 2016 and October 30, 2019 (the relevant period), in association with the Goods and Services. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[5] As a preliminary issue, I note that the Owner had written to the Registrar requesting that the registration be amended to delete the Goods on January 20, 2020. This amendment, however, was not actioned by the Registrar. I confirm that the registration has now been amended to delete the Goods. As the Goods have been deleted, I will not discuss the evidence of use with respect to them further.

[6] The relevant definition of use with respect to services is set out in section 4(2) of the Act:

A trademark 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 has been well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for clearing the register of “deadwood”. The criteria for establishing use are not demanding and an overabundance of evidence is not necessary; however, sufficient evidence must be provided to allow the Registrar to conclude that the trademark was used in association with the Services during the relevant period [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)]. Furthermore, mere statements of use are insufficient to prove use, and ambiguities in evidence are to be interpreted against the interests of the registered owner [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[8] In response to the Registrar’s notice, the Owner filed a statutory declaration in his name and a statutory declaration in the name of Andrew McEdwards. While Mr. Dordevic’s

declaration does not include Exhibit Sheets signed by Mr. Butt, the Barrister, Solicitor & Notary Public, the declarations both indicate that they were declared before Mr. Butt and the exhibits are clearly identified therein. As such, I am prepared to accept the evidence particularly in view of the fact no objection regarding the lack of signed Exhibit Sheets has been raised by the Requesting Party [*Little Caesar Enterprises Inc. v Flywing Wedge Pizza Co.* (1998), 85 CPR 310 (TMOB)]. Further, Mr. McEdwards' statutory declaration was attached as an exhibit to the declaration of Mr. Dordevic. Given the nature of these proceedings and the fact that Mr. McEdward's original statutory declaration is included, I do not consider it of any consequence that it was attached as an exhibit to another declaration.

[9] The Owner filed written representations. The Requesting Party filed as its written representations a letter in which it indicated that the Requesting Party agreed with the Owner's request to amend the registration to delete the Goods.

The Evidence

[10] Mr. Dordevic provides as Exhibit D to his declaration printouts of the TRIBE magazine website at *www.tribemagazine.com* during the relevant period which features screen shots of multiple issues of online magazines with the Mark (para 5). Mr. Dordevic explains that the public accesses the TRIBE online magazine and magazine content such as downloadable magazines, editorial content, event listings, live commentary and opinion, and event, music and movie reviews through this website (para 5). Mr. Dordevic also explains that he is the chief operating officer of TRIBE COMMUNICATIONS INC., a Canadian corporation using the Mark under license (para 2).

[11] In his declaration, Mr. McEdwards explains that he has been a System Administrator and Programmer for the computer servers, websites, domains and internet addresses of Alex Dordevic, TRIBE and TRIBE COMMUNICATIONS INC. since 2001 (paras 1, 3). As System Administrator, Mr. McEdwards explains that he keeps the TRIBE online magazine live, secure and publicly accessible which it was 99% of the time during the relevant period (para 5).

[12] Pursuant to section 4(2) of the Act, use of a trademark on advertising of services is deemed to be use, provided that the trademark owner is offering and prepared to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[13] Having regard to the evidence as a whole, I am satisfied that the Owner has shown use of the Mark with the Services in accordance with sections 4(2) and 45 of the Act. The evidence clearly shows downloadable magazines at www.tribemagazine.com/bboard/threads/tribe-magazine-25th-anniversary-downloads.172285/ with the Mark being featured prominently on the cover of the magazines (Dordevic declaration, para 3, Exhibit D). Although evidence of downloads are not provided for the relevant period, Mr. Dordevic does reference a photographic exhibit hosted by the magazine in Toronto during the relevant period and provides that the TRIBE magazine online contains over 4.5 million addressable webpages having first been available by a BBS Bulletin Board System in 1993 and online in Canada in 1994. As such, I am satisfied that the Services, at a minimum, were available to be performed in Canada during the relevant period. Further, given that this is a Toronto-based magazine which hosted an event in Toronto during the relevant period, I find the evidence sufficient to show that the Services were targeted at and offered to Canadians [*HomeAway.com, Inc v Hrdlicka*, 2012 FC 1467; *Unicast SA v South Asian Broadcasting Corp* 2014 FC 295 at paras 46-47, 63].

Disposition

[14] Accordingly, 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 as indicated in strikeout below:

Goods (1) ~~Printed publications, namely consumer magazines in the fields of fashion, music and entertainment.~~

Services (1) Providing on-line magazines accessible through the global computer network; providing on-line information concerning events and entertainment accessed via interconnected global computer networks; providing online and interactive access to electronic classified advertisements through a website, accessed via interconnected global computer networks; dissemination of advertising matter for others in the nature of event listing advertisements and other classified advertising via an interactive electronic telecommunications network linked with interconnected global computer networks.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

No Hearing Held

AGENTS OF RECORD

No Agent Appointed

For the Registered Owner

BURNET, DUCKWORTH & PALMER LLP

For the Requesting Party