



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 248

Date of Decision: 2021-11-15

IN THE MATTER OF A SECTION 45 PROCEEDING

Nexus Law Group LLP

Requesting Party

and

Hoover Services Inc

Registered Owner

TMA811,922 for the trademark

Registration

The mark consists with a tree device

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA811,922 for the following design mark (the Mark):



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

(1) Hotel management consultancy for business purposes; Business development, management and organization consulting services; Advisory services relating to business development, business organization and operation of hotels and restaurants; Advisory and consulting services relating to operating and franchising of restaurants and hotels.

(2) Passenger air transport; Passenger rail transport ; Passenger ship transport; Guarded truck transport service; Travel management; Travel guide services; Travel agencies; Escort services; Car transport; Vehicle rental; Coach rental; Truck rental; Car parking; Parking place rental; Garage rental; Chauffeur services; Car rental; Arranging of tours; Arranging of cruises; Sightseeing [tourism]; Travel reservation; Tours (Arrangement); Reservation (Travel).

(3) Providing banquet hall facilities; Providing convention hall facilities; Hotel services; Motel services; Restaurant services; Restaurant; Hotel and rooms reservation; Catering services; Bar services; Cafés; Rental of meeting rooms; Snack-bars.

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

THE PROCEEDING

[4] At the request of Nexus Law Group LLP (the Requesting Party), the Registrar of Trademarks issued a notice on May 2, 2019, pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to Hoover Services Inc (the Owner).

[5] The notice required the Owner to show whether the Mark was used in Canada in association with 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 between May 2, 2016 and May 2, 2019.

[6] In response to the Registrar's notice, the Owner submitted the affidavit of Woo Wei Chun, Joseph, Group Financial Controller of the Owner, sworn on November 22, 2019.

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

SUMMARY OF THE EVIDENCE

[8] The evidence provided by the Owner relates to the Empire Landmark Hotel, located in Vancouver, British Columbia. The affiant explains that, during the relevant period, the hotel consisted of guestrooms, meeting and convention spaces, and food and beverage outlets such as the “Cloud 9” revolving restaurant and the “C9 Live Lounge” serving tapas and beverages, with a “full bar service”.

[9] The affiant also explains that, during the relevant period, Global Gateway Corp. (Global) was the operations company of the Empire Landmark Hotel in Vancouver and was licensed by the Owner to use the Mark. He attests that, at all material times, the Owner “controlled the character and quality of the products and services provided in association with [the Mark], as well as the use, advertisement, and display of [the Mark] in Canada.” I note here that while the affiant also provides details regarding the corporate ownership of the Owner and Global, those details are beyond the scope of this proceeding; the affiant’s clear sworn statement regarding control is sufficient to conclude that any use of the Mark by Global in the course of operating the Empire Landmark Hotel enures to the benefit of the Owner pursuant to section 50 of the Act.

[10] With respect to use of the Mark during the relevant period, the affiant states at paragraph 7 of his affidavit that “the [Owner] and/or its licensees used the [Mark] in association with the Registered Services in Canada” and, at paragraph 10 of his affidavit, that:

“10. During the Relevant Period, the Empire Landmark Hotel website was located at *www.empirelandmarkhotel.com* and prominently displayed the [Mark] in association with the Registered Services which were offered and performed in Canada (including restaurant services, hotel services, restaurant and hotel booking and reservations, parking, amenities, transportation, tourist and travel attractions, arrangement of tours, fitness services, car rentals, rental of meeting rooms, banquet rooms and convention facilities).”

[11] In support, the affiant provides webpage printouts from the Empire Landmark Hotel website dated during the relevant period (Exhibit A). The webpages provide information which

is typical of a hotel website, such as descriptions of the hotel and the guestrooms, including guestroom and hotel amenities (such as flat-screen televisions, coffee makers, a fitness center, daily dry cleaning service, covered parking, and business center), a listing of nearby tourist attractions, a hotel contact information page and a room reservations page. There are also webpages providing details on meeting and conference rooms available to rent, including a link to catering menus and a description of event packages, such as wedding packages. The Mark is displayed in the banner at the top of each exhibited webpage.

[12] The Cloud 9 restaurant is featured in certain exhibited webpages of Exhibit A as well as in printouts provided as Exhibit G, namely webpages printed from the internet archive WayBack Machine for the website located at *www.cloud9restaurant.ca* archived in June 2017. The Mark is displayed in the banner at the top of each of those webpages as well.

[13] The affiant also provides webpage printouts dated during the relevant period, from the Empire Hotel and Resorts website located at *www.empirehotelsandresorts.com*, all displaying the Mark (Exhibit B). Although the Vancouver Empire Landmark Hotel is featured on one webpage as part of a listing of other “Empire Hotels”, the exhibited webpages primarily relate to Empire Hotels located in Hong Kong.

[14] As for other types of display of the Mark, the affiant explains that stationery displaying the Mark was distributed during the relevant period. In support, he provides examples of such stationery, all bearing the Mark, namely:

- letterhead and envelopes distributed by sales staff in relation to “conference, weddings and large group bookings” (Exhibit C);
- invoices for “services performed in Canada during the relevant period” (Exhibit D);
- key card covers “distributed to hotel guests upon check-in when they received their room key” (Exhibit E); and
- business cards “distributed to guests, prospective guests, and conference organizers” (Exhibit F).

[15] I note that Exhibit D consists not only of invoices but also account statements, all dated within the relevant period. The invoices include itemized charges described in the invoices as “Room Charge”, “Parking – Guest” and “Tel – Local”, along with associated provincial and federal taxes. The exhibited statements list multiple invoices being charged to a single entity.

[16] Finally, the affiant attests that “a significant portion of the [Owner’s] sales are in association with travel agencies and travel reservation services” and provides approximate yearly “room revenue” figures, based on an average room rate of \$100 per night and an approximate 60% occupancy rate over the past 20 years. The affiant also specifically states that the total hotel room sales for “the fiscal years of 2016-2017 ... were more than CA\$4,777,000.”

[17] As for the remaining services, the affiant explains, at paragraph 20 of his affidavit, that in addition to hotel and restaurant services, the Empire Landmark Hotel also offered:

“20. ... a wide variety of other hospitality, business, and tourism related services in Canada during the Relevant Period. To name a few, the Hotel Lobby featured a car rental desk, tour desk, concierge desk, jewelry store, hair salon, gift shop, business center and automated banking machine during the Relevant Period. The hotel also featured a well-equipped fitness room, five levels of covered parking with over 200 stalls, daily dry cleaning and laundry valet service, coin-operated self-serve washers and dryers, vending machines, safety deposit boxes, as well as fax and photocopy services during the Relevant Period.”

[18] In support, the affiant simply indicates that the Exhibit A webpage printouts show examples of use of the Mark in association with those additional “services and amenities” during the relevant period.

ANALYSIS AND REASONS FOR DECISION

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

4(2) 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.

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

No special circumstances excusing non-use

[21] At the outset, it is worth briefly commenting on the question of excusable non-use. Indeed, although the Owner does not provide any submissions regarding the existence of special circumstances, I note that the Woo Wei Chun affidavit explains that the Empire Landmark Hotel closed in approximately September 2017 for the “demolition of the existing building and redevelopment” by the corporate group that owns the Owner and Global. The demolition of the hotel could therefore explain the absence of use of the Mark for a portion of the relevant period.

[22] That being said, there is nothing in the evidence from which to conclude that the demolition of the hotel was an “unusual, uncommon, or exceptional” circumstance or that it was beyond the control of the Owner [*John Labatt Ltd v Cotton Club Bottling Co* (1976), 25 CPR (2d) 115 at 123 (FCTD); *Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA)].

[23] As such, without submissions or further evidence on this point, I find that there is no evidence demonstrating the existence of special circumstances excusing non-use of the Mark.

Use shown only in association with some of the Registered Services

[24] The Owner asserts use of the Mark in association with all of the services listed in the registration. However, I am only satisfied that the Owner has demonstrated use of the Mark in association with some of those services [per *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 at 236 (FCA) where the Court set out the now well-established principle that sufficient facts must 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].

Services (1)

[25] I note that – aside from the recitation of the statement of services from the registration – I can find no reference to advisory services or to services relating to consulting and business development in the evidence. In addition, the Owner’s written representations do not specifically address these services.

[26] As a result, I am not satisfied that the Owner has demonstrated use of the Mark in association with services (1) within the meaning of sections 4(2) and 45 of the Act. As there is no evidence of special circumstances, these services will be deleted.

Services (2)

[27] For the reasons that follow, I find that the Owner has provided evidence showing use of the Mark within the meaning of sections 4(2) and 45 of the Act in association with some of the registered services (2).

[28] In particular, having regard to the invoiced item “Parking – Guest” as well as the reference to a “covered parking” on the Empire Landmark Hotel website, I am satisfied that the Owner has demonstrated use of the Mark in association with “Car parking; Parking place rental; Garage rental”.

[29] Similarly, having regard to the exhibited hotel room reservations webpage as well as the toll-free reservations phone number and the reservations contact e-mail shown on certain exhibited materials, I am satisfied that the Owner has demonstrated use of the Mark in association with “Travel reservation” and “Reservation (Travel)”.

[30] That being said, I am not satisfied that the Owner has shown use of the Mark in association with the remaining services (2), namely:

Passenger air transport; Passenger rail transport; Passenger ship transport; Guarded truck transport service; Travel management; Travel guide services; Travel agencies; Escort services; Car transport; Vehicle rental; Coach rental; Truck rental; ... Chauffeur services;

Car rental; Arranging of tours; Arranging of cruises; Sightseeing [tourism]; ... Tours (Arrangement); ...

[31] First, there is no reference in the evidence – aside from the recitation of the registered services – to passenger transport by air, rail, ship, car, truck or otherwise. Likewise, I can find no evidence relating to escort services.

[32] Second, with respect to the tourism-related services (2) such as “travel management”, “travel guide services”, “travel agencies”, “sightseeing [tourism]” as well as various types of vehicle rentals, and arrangement of tours and cruises, I am not prepared to accept the affiant’s bare assertions regarding the “wide variety of other hospitality, business, and tourism related services” offered by the Empire Landmark Hotel as evidence showing use of the Mark. In particular, even if the examples of “Hotel Lobby” services listed at paragraph 20 of the affidavit were offered, such as a “car rental desk”, a “tour desk”, a “concierge desk”, and an “automated banking machine” there is no evidence that they were offered *by the Owner* (or its licensee) or that the Mark was displayed in the performance or advertisement of these services.

[33] Third, despite the affiant’s assertion at paragraph 10 of his affidavit that the Mark is displayed on the Empire Landmark Hotel website in association with “tourist and travel attractions, arrangement of tours” and “car rentals”, among other services, I can find no reference to such services being offered by the Owner (or its licensee), either on the exhibited webpages or elsewhere in the evidence.

[34] As a result, I am not satisfied that the Owner has shown use of the Mark in association with the remaining services (2) listed at paragraph 30 above within the meaning of sections 4(2) and 45 of the Act. As there is no evidence of special circumstances, those services will also be deleted.

Services (3)

[35] With respect to services (3), namely those related to the hospitality industry, the affiant notably provides invoices and sales figures for hotel rooms during the relevant period, as well as

multiple webpage printouts advertising the hotel, restaurant, tapas bar, meeting and conference rooms, catering options and event packages, all in association with the Mark. In addition, the affiant provides sworn statements that stationery bearing the Mark was distributed during the relevant period in relation to, for example, “conference, weddings and large group bookings”.

[36] Considering the evidence as a whole, I am satisfied that the Owner has demonstrated use of the Mark with respect to services (3) within the meaning of sections 4(2) and 45 of the Act.

DISPOSITION

[37] 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 services (1), as well as the following from services (2):

Passenger air transport; Passenger rail transport ; Passenger ship transport; Guarded truck transport service; Travel management; Travel guide services; Travel agencies; Escort services; Car transport; Vehicle rental; Coach rental; Truck rental; ... Chauffeur services; Car rental; Arranging of tours; Arranging of cruises; Sightseeing [tourism]; ...
Tours (Arrangement); ...

[38] Consequently, the statement of services will now read as follows:

(2) Car parking; Parking place rental; Garage rental; Travel reservation;
Reservation (Travel).

(3) Providing banquet hall facilities; Providing convention hall facilities; Hotel services; Motel services; Restaurant services; Restaurant; Hotel and rooms reservation; Catering services; Bar services; Cafés; Rental of meeting rooms; Snack-bars.

Eve Heafey
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

Gowling WLG (Canada) LLP

For the Registered Owner

Nexus Law Group LLP

For the Requesting Party