



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 074

Date of Decision: 2022-04-19

IN THE MATTER OF A SECTION 45 PROCEEDING

**Michelle Fleischhacker
Room Service Interiors**

Requesting Party

and

Room Service Interiors Ltd.

Registered Owner

TMA533,482 for ROOMSERVICE

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. TMA533,482 for the trademark ROOMSERVICE (the Mark).

[2] The Mark is registered for use in association with “interior design and decorating services” (the Services).

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

THE PROCEEDING

[4] At the request of Michelle Fleischhacker Room Service Interiors (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on May 29, 2020, to the registered owner of the Mark, Room Service Interiors Ltd. (the Owner).

[5] The notice required the Owner to show whether the Mark was used in Canada in association with 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 May 29, 2017 to May 29, 2020 (the Relevant Period).

[6] The relevant definition of use in the present case is set out in section 4(2) 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.

[7] The purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register. The evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[8] In response to the Registrar’s notice, the Owner furnished the Affidavit of David Kenneth De Bruce, sworn on August 18, 2020, to which were attached Exhibits A to F.

[9] Both parties submitted written representations. No oral hearing was held.

THE EVIDENCE

[10] Mr. de Bruce is the President of the Owner and has held that position since 1992.

[11] Mr. de Bruce states the Owner has promoted the Services on its:

- (a) Website *www.roomservice.ca* since it was created on March 11, 2020. Exhibit A is a printout from the website home page. The home page displays the Mark and describes the services offered as “client oriented interior design”. The home page states that the Owner’s head office is in Ottawa and provides a telephone number with a 613 area code.
- (b) Facebook page since it was created on May 8, 2020. Exhibit B is a printout from the Owner’s Facebook page. The Facebook page displays the Mark and describes the services offered as “interior design studio in Ottawa, Ontario”. The home page provides a telephone number with a 613 area code.
- (c) Instagram page since it was created in April 2020. Exhibit C is a printout from the Owner’s Instagram page. The Instagram page displays the Mark and describes the services offered as “interior design services”.

[12] Mr. de Bruce also provides as Exhibit F a proof sheet for business cards ordered by the Owner and states that approximately 30 such cards were distributed from mid-March 2020 to the end of May 2020. The business cards display the Mark and identify Mr. de Bruce as “Owner / President” of the Owner and provide a telephone number with a 613 area code.

[13] Mr. de Bruce states that the Owner has provided the Services to clients in Canada and provides in support the following:

- (a) Exhibit D consists of two representative invoices issued to Canadian clients by the Owner. Each invoice displays the Mark and is dated within the Relevant Period. Even though the Owner’s name only appears on the first invoice, Mr. de Bruce attests that both invoices were issued by the Owner. I note that one invoice refers to “initial design consultation”, “labour – installations services” and “source furnishings” and the other to “Design Fees” and “Project Management Services”.
- (b) Exhibit E is a quotation for interior design and project management services for improvements to be carried out in the Winter of 2018 and Spring of 2019. The quotation is headed “Items / Services Provided by RoomService”.

[14] Finally, Mr. de Bruce states that the provision of the Services during the Relevant Period generated revenue of over \$150,000.

PRELIMINARY ISSUES

[15] As a preliminary matter, I note that, in their written representations, both parties made reference to alleged facts not in evidence. Such alleged facts will be disregarded [*Ridout & Maybee LLP v Encore Marketing International Inc* (2009), 72 CPR (4th) 204 (TMOB)].

[16] Further, the Requesting Party made submissions concerning the motivation of the Owner. The parameters of the present proceeding are narrow and the motivation of either party is not a consideration in reaching a decision under section 45. Section 45 proceedings are not intended to be a forum for the resolution of disputes or the determination of rights as between parties [see *Vermillion Intellectual Property Corporation v Vermillion Energy Inc.*, 2017 TMOB 24].

ANALYSIS AND REASONS FOR DECISION

[17] The Requesting Party submits that the evidence is insufficient to satisfy the requirements of section 45 and that the registration must be expunged. In particular, the Requesting Party submits that the Owner has failed to adduce any examples of use of the Mark sufficient for the purposes of section 45. Further the Requesting Party submits that, if there has been use of the Mark, such use is token use.

[18] Evidence in a section 45 proceeding must be considered as a whole and focusing on individual pieces of evidence in isolation is not the proper approach [see *Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB); and *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB)]. As well, reasonable inferences can be made from the evidence provided [see *Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64].

[19] Further, an affiant's statements are to be accepted at face value and must be accorded substantial credibility in a section 45 proceeding [*Oyen Wiggs Green & Mutala LLP v Atari Interactive Inc*, 2018 TMOB 79].

[20] Mr. de Bruce states that the Owner provided the Services to customers in Canada during the Relevant Period. In support, he provides two representative invoices issued by the Owner to Canadian clients. Each invoice displays the Mark and is dated within the Relevant Period.

[21] The Requesting Party acknowledges that both invoices constitute a display of the Mark during the Relevant Period. However, the Requesting Party submits that the first invoice is token use and cannot support the Registration and that the second invoice was issued by Mr. de Bruce personally because the Owner is not named.

[22] Mr. de Bruce states that both invoices were issued by the Owner and, in the absence of evidence to the contrary, his statement is to be accepted at face value [*Oyen Wiggs* at para 25]. Given that the second invoice is for \$138,990, I am satisfied that the use evidenced by Mr. de Bruce is not token use. Further, there is nothing to suggest that either transaction was not authentic or that the transactions were deliberately fabricated or invented in order to protect the registration. Indeed, Mr. de Bruce states that the provision of the Services during the Relevant Period generated revenue of over \$150,000.

[23] The Requesting Party goes on to submit that, while an invoice may be evidence that services were actually performed, the evidence fails to establish that the services performed were the services listed in the Registration - interior design and decorating services. I disagree.

[24] Mr. de Bruce states that the invoices were for the performance and sale of the Services. That is consistent with the use of the language in the invoices namely “initial design consultation” and “design fees”.

[25] Further, Mr. de Bruce provides examples of promotion of the Services in association with the Mark, namely the Owner’s website (Exhibit A), Facebook page (Exhibit B) and Instagram page (Exhibit C). The Requesting Party acknowledges that these exhibits are a display of the Mark by the Owner during the Relevant Period. The Requesting Party also acknowledges that the Facebook page and the Instagram page relate to the Services but takes the position that the website does not. Given that the website refers to “client oriented interior design”, I am satisfied that all three pages relate to the Services.

[26] The Requesting Party goes on to submit that the exhibits fail to demonstrate a clear and unambiguous connection between the display of the Mark and the actual provision of interior design and decorating services by the Owner in Canada in that there is no evidence that the Services were actually performed at the time of the promotional activity shown in Exhibits A to C.

[27] Where the trademark owner is willing and able to perform its services in Canada, use of the trademark in the course of advertising those services meets the requirements of section 4(2) of the Act [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)]. Clearly, the Owner was holding itself out as being willing to perform the Services and it was able to perform the Services having done so, at the very least, earlier in the Relevant Period.

[28] The Requesting Party also submits that neither the Owner nor Mr. de Bruce are members of the Association of Registered Interior Designers of Ontario which, according to the Requesting Party, is a requirement for interior designers practicing in Ontario pursuant to the *Association of Registered Interior Designers of Ontario Act*. Compliance with statutes other than the Act is not a relevant consideration in proceedings under section 45 of the Act [see *Lewis Thomson & Sons Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD), *Renault v Comercializadora Eloro, SA*, 2012 TMOB 132]. Accordingly, even if the Owner was providing the Service without being a member of the Association of Registered Interior Designers of Ontario, that does not preclude a finding of use in a section 45 proceeding [see *Essilor Group Canada Inc v Vermillion Networks Inc.*, 2021 TMOB 184 at para 68].

[29] Accordingly, reading the evidence as a whole, and giving substantial credibility of the statements of Mr. de Bruce, I am satisfied that the Owner has established a *prima facie* case of use of the Mark in the performance and advertising of the Services in Canada during the Relevant Period within the meaning of sections 4(2) and 45 of the Act.

DISPOSITION

[30] 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 maintained.

Robert A. MacDonald
Member
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

Oyen Wiggs Green & Mutala LLP

For the Registered Owner

North & Company LLP

For the Requesting Party