



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 086

Date of Decision: 2022-04-27

IN THE MATTER OF A SECTION 45 PROCEEDING

Boardwalk Reit Limited Partnership

Requesting Party

and

Sawridge Management Corporation

Registered Owner

TMA910,603 for WELCOME HOME

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. TMA910,603 for the trademark WELCOME HOME (the Mark).

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

THE PROCEEDING

[3] At the request of Boardwalk Reit Limited Partnership (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on September 20, 2019, to Sawridge Management Corporation (the Owner), the registered owner of the Mark.

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

Hotel, Motel, Inn, Bar, Cafe, Restaurant, Health Club, Cocktail Lounge, Banquets, and Catering Services. Rental of rooms for holding functions, conferences, conventions, exhibitions, seminars, meetings and weddings. Operation, Maintenance and management of Hotels and the provision of Hotel and Tour Services, namely Hotel rooms, meals, spa treatments, entertainment and tour packages.

[5] The notice required the Owner to show whether the Mark was used in Canada, in association with each of the registered services, at any time within the three-year period immediately preceding the date of the notice and, if not, the date when that trademark 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 September 20, 2016, and September 20, 2019.

[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] It is well established that 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. As such, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the mark was used in association with each of the registered services.

[8] 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 that excuse the absence of use.

[9] In response to the Registrar’s notice, the Owner furnished the affidavit of its CEO, John MacNutt, sworn on October 25, 2019, with Exhibits A to D.

[10] Both parties submitted written representations and attended a hearing.

PRELIMINARY MATTER

[11] The Owner submits that the Requesting Party's written representations were not filed and served in time; therefore, they should not be considered by the Registrar.

[12] The Requesting Party had two months to file and serve his written representations. This deadline began on November 5, 2019, and ended on Sunday, January 5, 2020. Since this is a prescribed day in accordance with section 15 of the *Trademarks Regulations* (SOR/2018-227), the deadline is extended to the next non-prescribed day, in this case, January 6, 2020. As they were filed and served on that date, it was done so within the prescribed time. Therefore, the written representations of the Requesting Party will remain on the record.

THE EVIDENCE

[13] Mr. MacNutt states that, during the relevant period, the Owner operated the following three properties:

- A hotel located in Edmonton, Alberta, named the Sawridge Inn and Conference Centre (the Edmonton Hotel), operated by the Owner since 2008. According to Mr. MacNutt, this hotel has 136 rooms and suites, a dining room, a lounge, a fitness centre, banquet facilities and meeting rooms.
- A hotel located in Jasper, Alberta, named the Sawridge Inn and Conference Centre (the Jasper Hotel), owned and operated by the Owner from December 2012 until June 30, 2018. Since June 2018, the Owner has an interest in the Jasper Hotel through a partnership, and third parties have been managing this hotel. According to Mr. MacNutt, this hotel has 152 rooms and suites, a dining room, a lounge, a fitness room, banquet facilities, a café, and a day spa.
- A hotel located in Peace River, Alberta named the Sawridge Inn and Conference Centre (the Peace River Hotel), owned and operated by the Owner from 2012 until December 31, 2018. Since that date, the Owner has held a 50% interest in the Peace River Hotel through a partnership, the Sawridge MPL Peace River Limited Partnership (Sawridge Partnership), and continues to operate this hotel. According to Mr. MacNutt,

this hotel has 132 rooms, a restaurant, a billiards and sports lounge, a fitness centre, banquet facilities, and a lounge and games room.

[14] Mr. MacNutt adds that the Sawridge Partnership is a licensed user of the Mark in association with the operation of the hotel. He adds that “the terms of the license and management agreement provide [the Owner] with control over the quality and character of the Services offered at the property”.

[15] Mr. MacNutt states that the following services are offered to customers in all three properties: rentals of rooms on a nightly basis, serving of beverages, serving of cocktail beverages, serving of food and beverages, provision of fitness equipment for use by guests, provision of food and beverages for groups in a private room or other location, rentals of rooms for holding functions, conferences, exhibitions, seminars, meetings, and weddings, and offering of live entertainment and sports broadcasts. He adds that the Peace River Hotel also offers “Billiards and Gaming in the Hotel” and that the Jasper Hotel provides tour services and spa treatments. He adds that all those services were performed in association with the Mark in Canada since 2014.

[16] Mr. MacNutt adds that since January 1, 2019, the Owner has provided the following services to the Sawridge Partnership: “Operation, Maintenance and management of Hotels and the provision of Hotel [...] Services, namely Hotel rooms, meals, [...] entertainment”.

[17] Attached to Mr. MacNutt’s affidavit are the following exhibits:

- Exhibit A consists of two photographs of name tags bearing the Mark. Mr. MacNutt states that “since September 2014 the staff Name Tags have featured the mark *Welcome Home*” at all three properties. He adds that “staff name tags are worn by all staff that deal with customers in all areas of the Hotels, including but not limited to [...] front desk staff, housekeeping staff, maintenance staff, food and beverage servers, and banquet staff”.
- Exhibit B consists of photographs of buffet signs bearing the Mark. Mr. MacNutt states that, since December 2016, “buffet signs are used in the restaurant areas” of the three properties and that such signs displayed the Mark.

- Exhibit C consists of an example of “cookie signage” bearing the Mark. Mr. MacNutt explains that the signage for guest cookies offered in the guest lobby of the Edmonton Hotel has featured the Mark since December 2016.
- Exhibit D consists of an example of a welcome card bearing the Mark. Mr. MacNutt states that welcome cards are in guest rooms to “personalize the stays of some guests” and that these have displayed the Mark since January 2019.

[18] Mr. MacNutt states that each of the properties sells its services to thousands of guests each year and that these services are provided directly at the properties, located in Alberta.

ANALYSIS AND REASONS FOR DECISION

[19] The Requesting Party submits that the Owner failed to demonstrate use of the Mark in association with the registered services in Canada, during the relevant period for the following reasons: i) the Owner has failed to demonstrate the performance of the services during the relevant period, therefore the use of the Mark, and ii) the evidence does not demonstrate use of the Mark with each of the services.

Use within the relevant period

[20] The Requesting Party submits that Mr. MacNutt does not refer to the relevant period when describing the services offered by the Owner, with the exception of the services performed by the Owner to the Sawridge Partnership pursuant to the management agreement of January 2019, and that Mr. MacNutt uses the present tense, which can only be interpreted to mean at the time of the affidavit, therefore after the relevant period.

[21] The Owner submits that the affidavit terms, such as “are worn”, “are used”, and “we use”, when referring to the name tags of the employees, the signs, and the welcome cards denote continuous use of the Mark at the date specified in the affidavit until the date of the affidavit. Moreover, it adds that the affidavit must be read as a whole and that the paragraphs are separated to “make it easier to read”.

[22] In his affidavit, Mr. MacNutt refers to multiple services performed by the Owner or its licensee. I agree with the Requesting Party that he does not refer explicitly to the relevant period when describing those services. However, he provides specific periods, including in the relevant period, when the properties were operated and when the Mark appeared on various items. He states that the Owner has operated the Edmonton Hotel since 2008, therefore, at least between 2008 and the date of the affidavit, including during the relevant period. Regarding the Jasper Hotel, Mr. MacNutt confirms that the Owner operated the hotel between December 2012 and June 2018, therefore approximately 21 months of the relevant period. Even if, some statements are in the present tense and do not refer explicitly to any period of time, when reading the affidavit as a whole, while it could have been clearer, I agree with the Owner that Mr. MacNutt's statements should be interpreted to include the relevant period.

Use with each of the services

[23] The Requesting Party submits that the Owner did not demonstrate use of the Mark with at least the following services: "Motel, Inn, Health Club, Rental of rooms for holding functions, conferences, conventions, exhibitions, seminars, meetings and weddings, spa treatments, and entertainment and tour packages".

[24] Particularly, it notes that the three properties described in the affidavit are referred to as "hotels", rather than "motels" or "inns", that Mr. MacNutt does not explain how the Mark was used in association with any "health club", that aside from a bare assertion, there is no evidence that the "rentals of rooms" services were performed, and that "spa treatments, entertainment and tour packages" are nowhere referenced in the exhibited materials.

[25] The Owner submits that one or more of the properties provide each of the services contained in the registration. In particular, it submits that Mr. MacNutt described the properties's amenities and the services performed at each of these properties, and since the staff wore name tags bearing the Mark, it is sufficient to establish use of the Mark in association with all the registered services.

Hotel, Motel, and Inn Services

[26] For the hotel, motel, and inn services, the Owner submits that “the registration of the Mark for use in relationship to Hotel, Inn and Motel services represent different uses and that the registrant has provided evidence that its use of the Mark in its business includes use for the provision of each of these services”. It also submits the following definitions, all from the *Merriam-Webster Dictionary*:

- Hotel – an establishment that provides lodging and usually meals, entertainment, and various personal services for the public.
- Inn – an establishment for the lodging and entertaining of travelers.
- Motel – an establishment which provides lodging and parking and in which the rooms are usually accessible from an outdoor parking area.

[27] It is a well-established principle that when interpreting a statement of services in a section 45 proceeding, one is not to be “astutely meticulous when dealing with [the] language used” [see *Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654 at para 17], and in certain cases, a statement of services may contain “overlapping and redundant terms in the sense that the performance of one service would necessarily imply the performance of another” [*Gowling Lafleur Henderson LLP v Key Publishers Company Ltd*, 2010 TMOB 7 at para 15].

[28] Even if sometimes services overlap, I do not agree with the Owner’s submissions. Mr. MacNutt states that the three properties provide the rentals of rooms on a nightly basis, together with ancillary services, and he adds, for the motel services, that guests can park nearby. However, contrary to the Owner’s submissions, Mr. MacNutt did not establish how these services represent different services offered at the properties nor did Mr. MacNutt’s statements provided sufficient information to determine that the services described fall within the scope of motel and inn services, as he only refers to the properties as *hotels*.

[29] Therefore, I conclude that the Owner has used the Mark in association with the *hotel* services within the meaning of sections 4 and 45 of the Act.

[30] As for the motel and inn services, as there are no evidence and no special circumstances excusing the absence of use, I am not satisfied the use of the Mark in association with those services pursuant to sections 4(2) and 45 of the Act and they will be deleted from the registration.

Bar, Café, Restaurant, Cocktail Lounge services, and Banquets Services

[31] Mr. MacNutt confirms that the Edmonton Hotel has a dining room and banquet facilities, that the Jasper Hotel has a dining room, banquet facilities, a café, and a lounge, and that the Peace River Hotel has a restaurant and banquet facilities. Given that all employees dealing with customers wear a name tag, and according to Mr. MacNutt those name tags featured the Mark since 2014, I conclude that the Owner has used the Mark in association with those services within the meaning of sections 4 and 45 of the Act.

Health Club Services

[32] All three properties have a fitness centre where guests can use fitness equipment, and that falls within the scope of the *health club* service. Given that all employees dealing with customers wear a name tag, and according to Mr. MacNutt those name tags featured the Mark since 2014, I conclude that the Owner has used the Mark in association with this service within the meaning of sections 4 and 45 of the Act.

Catering Services

[33] The Owner furnished no evidence except a bare assertion regarding this service and Mr. MacNutt does not put forward special circumstances to justify the absence of use of the Mark in association with this service. Consequently, I am not satisfied the use of the Mark in association with the catering services pursuant to sections 4(2) and 45 of the Act and this service will be deleted from the registration.

Rental of rooms for holding functions, conferences, conventions, exhibitions, seminars, meetings and weddings

[34] Mr. MacNutt confirms that the Edmonton Hotel has meeting rooms. There is no evidence that these meeting rooms held all the services described in the registration. It is possible that these meeting rooms are used to hold functions, conferences, conventions, exhibitions, seminars, meetings, and weddings. However, without evidence from Mr. MacNutt to corroborate, these services can not be maintained in their entirety. Given that Mr. MacNutt described it as meeting rooms and given that all employees dealing with customers wear a name tag, and according to Mr. MacNutt those name tags featured the Mark since 2014, I conclude that the Owner has used the Mark in association with the *rental of rooms for holding meetings* service within the meaning of sections 4 and 45 of the Act.

[35] As for the remaining services regarding renting of rooms, as there are no evidence and no special circumstances excusing the absence of use, I am not satisfied the use of the Mark in association with the catering services pursuant to sections 4(2) and 45 of the Act and this service will be deleted from the registration.

Operation, Maintenance and management of Hotels and the provision of Hotel and Tour Services, namely Hotel rooms, meals, spa treatments, entertainment and tour packages

[36] Mr. MacNutt confirms that the Edmonton Hotel and the Jasper Hotel have a dining room, and that the Peace River Hotel has a restaurant, a Billiards and Sports lounge, a Lounge and Games Room, and a day spa and also offers tour services to customers. In addition, all the three properties offers the rental of rooms on a nightly basis. Given that all employees dealing with customers wear a name tag, and according to Mr. MacNutt those name tags featured the Mark since 2014, I conclude that the Owner has used the Mark in association with those services within the meaning of sections 4 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 following registered services: “Motel, Inn, (...) Catering. [Rental of rooms for holding] functions, conferences, conventions, exhibitions, seminars, (...) and weddings ”.

[38] The Mark will now be registered in association with the following services:

Hotel, Bar, Cafe, Restaurant, Health Club, Cocktail Lounge, and Banquets Services.
Rental of rooms for holding meetings. Operation, Maintenance and management of
Hotels and the provision of Hotel and Tour Services, namely Hotel rooms, meals, spa
treatments, entertainment and tour packages.

Ann-Laure Brouillette
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: February 1, 2022

APPEARANCES

Michael R. McKinney

For the Registered Owner

Eric Macramalla

For the Requesting Party

AGENTS OF RECORD

No Agent Appointed

For the Registered Owner

Gowling WLG (Canada) LLP

For the Requesting Party