OPIC CIPO

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 142

Date of Decision: 2022-07-29

IN THE MATTER OF A SECTION 45 PROCEEDING

Lomic Law	**Requesting Party**
and	
Dakota Dunes Golf Links Limited Partnership	**Registered Owner**
TMA757,498 for DAKOTA DUNES GOLF LINKS & Design	**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. TMA757,498 for the trademark DAKOTA DUNES GOLF LINKS & Design (the Mark), owned by Dakota Dunes Golf Links Limited Partnership (the Owner) and shown below:

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

THE PROCEEDING

[3] At the request of Lomic Law (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on July 27, 2020.

[4] The notice required the Owner to show whether the Mark had been used in Canada in association with each of the goods and 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 July 27, 2017, to July 27, 2020.

[5] The Mark is registered for use in association with the following goods and services:

> GOODS
>
> Clothing namely, shirts, sweaters, jackets and outerwear, hats, knit caps, golf gloves; merchandise namely, golf bags, golf balls, divot repair tools, golf towels, ball markers, keychains, money clips, wallets, bag tags, coffe [*sic*] mugs.
>
> SERVICES
>
> (1) Operation of a golf course; operation of a restaurant and lounge; catering services.
>
> (2) Operation of a recreational resort; hotel services; casino services.

[6] The relevant definitions of use in the present case are set out in section 4 of the Act as follows:

> 4(1) A trademark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.
>
> 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 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 Registrar of Trade Marks* (1982), 63

CPR (2d) 56 (FCTD)]. However, 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 goods and services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA) (*John Labatt*)].

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Michael Kyle Jacobs, sworn on February 26, 2021. Both parties submitted written representations; no oral hearing was held.

THE EVIDENCE

[9] Mr. Jacobs is the general manager of Dakota Dunes Golf Links, a recreational resort comprising a golf course, shop, restaurant, and lounge, owned and operated by the Owner and located on the historical Whitecap Dakota First Nation lands near Saskatoon, Saskatchewan. He states that a Dakota Dunes casino, owned and operated by the Saskatchewan Indian Gaming Authority (SIGA) is located "next door" to the golf course, and that a Dakota Dunes hotel, operated by Dakota Dunes Hotel Ltd. (DDH) and located adjacent to the casino, opened on October 8, 2020. Mr. Jacobs explains that both the Owner and DDH are wholly owned by the Whitecap Dakota First Nation.

[10] With respect to the services "operation of a golf course", Mr. Jacobs explains that the 18-hole golf course opened in 2004 and was in operation during the relevant period. As Exhibit B, he attaches a number of screenshots from the Internet Archive's Wayback Machine captured on January 10, 2020, showing screenshots from the owner's website, as well as a promotional brochure and business card "which circulated during the Relevant Period" and tee time reports and invoices for green fees and golf cart rentals, dated during the relevant period. I note that the screenshots, brochure, and business card display the Mark but the tee time reports and invoices do not.

[11] With respect to the registered goods, Mr. Jacobs refers to a "pro shop retail space" located at the resort's club house. As Exhibit C, Mr. Jacobs attaches archived screenshots of the Owner's website dated during the relevant period and advertising the pro shop. The webpage displays the Mark in the top and bottom left corners. As Exhibit D, he attaches photographs of a

golf bag, vest, mug, and hat, all displaying the Mark, along with invoices dated mostly during the relevant period and showing the sales of various items. The invoices do not display the Mark, but Mr. Jacobs states that these invoices relate "to the sale of golf equipment and merchandise bearing the [Mark]". Despite the photographs and invoices only relating to "select merchandise", he "affirm[s] that all of the goods recited in the registration bore the [Mark] and were sold to customers in Canada during the Relevant Period".

[12] With respect to the services "operation of a restaurant and lounge", Mr. Jacobs states that the resort's clubhouse includes a restaurant and lounge offering food and beverages. As Exhibit E, he includes archived screenshots from the Owner's website dated within the relevant period and showing the restaurant's menu, as well as an undated scan of the menu and invoices dated mainly during the relevant period and showing sales of food. The webpage and the menu display the Mark; the invoices do not.

[13] With respect to "catering services", Mr. Jacobs states that the golf club offers catering services for tournaments, golf outings and business meetings. As Exhibit F, he includes a brochure displaying the Mark and entitled "TOURNAMENT PLANNER 2019", which advertises various catering options for groups making use of the golf course. I note that unlike the Exhibit B golf course brochure, Mr. Jacobs does not state that this Tournament Planner brochure was circulated during the relevant period.

[14] With respect to "hotel services", Mr. Jacobs states that following delays caused by the COVID-19 pandemic, DDH opened the Dakota Dunes hotel on October 8, 2020. As Exhibit H, he attaches undated printouts from DDH's website advertising the hotel. Although the image quality of the screenshot is poor, it appears that a variation of the Mark, with the arrowhead design element set between the words "DAKOTA" and "DUNES" and above some additional text, appears at the top of the webpage.

[15] Finally, with respect to "casino services", Mr. Jacobs states that "in 2007, SIGA, under license, opened the Casino next to the Dakota Dunes Golf Links Golf Course". As Exhibit G, he attaches archived screenshots from SIGA's website, dated during the relevant period and advertising the casino. The screenshots display a variation of the Mark including the arrowhead design and the text "Dakota Dunes Casino".

[16] Mr. Jacobs concludes by stating that "over the course of the Relevant Period, [the Owner], DDH and SIGA have generated millions of dollars in revenue from the operation of the golf course, pro shop, the Casino, the Hotel, restaurant, and lounge in association and with use of the [Mark]".

REASONS FOR DECISION

[17] The Requesting Party submits that the entire registration should be expunged for reasons including, *inter alia*, that the affidavit is imprecise as to who among the various entities referenced in the affidavit actually performed the services, and as to who designed or manufactured any of the goods referenced in the affidavit. In response, the Owner submits that the affidavit demonstrates use of the Mark by the Owner in association with each of the goods as well as in association with at least Services (1), namely, "operation of a golf course; operation of a restaurant and lounge; catering services". The parties' submissions will be addressed in detail below.

The Registered Goods

[18] The Requesting Party submits that the Owner's evidence does not demonstrate use of the Mark in association with any of the registered goods. In particular, the Requesting Party contends that while Mr. Jacobs states that each of the registered goods bore the Mark and was sold during the registered period, the invoice evidence merely shows sales of a number of products which may have displayed third-party trademarks rather than the Mark. In this respect, the Requesting Party observes that several of the items listed in the Exhibit D invoices appear to be associated with third-party trademarks (*e.g.*, "Levelwear Polo"; "Travis Mathew Polo"), and that the Exhibit B screenshots show a shoe displaying a third-party trademark but not the Mark on the "PRO SHOP PRODUCT" webpage. Further, the Requesting Party submits that Mr. Jacobs does not correlate the photographed items in Exhibit D with any particular items listed in the invoices, and thus does not demonstrate that the pictured items were sold during the relevant period.

[19] In response, the Owner submits that examples of all uses are not required in a section 45 proceeding, citing *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63

CPR (2d) 56 (FCTD), and *Billy Bob's Jerky Inc v Tritap Food Broker*, 2010 TMOB 76. The Owner submits that it provided more than the bare assertion of use of the sort that was found unacceptable in *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA), noting that Mr. Jacobs provided a sworn statement that all of the goods displayed the Mark as exemplified by the Exhibit D photographs, and that all the registered goods were sold during the relevant period. The Owner submits that it is irrelevant that such goods might also have displayed third-party trademarks.

[20] The pictured goods include a golf bag, a vest (referred to in Mr. Jacobs' affidavit as a "golf shirt"), a coffee mug, and a hat, all of which display the Mark. The invoiced items include polo shirts, hats, coffee mugs, driver and putter covers, umbrellas, "tour tips", and a "logo jar ball." Although the Requesting Party contends that there is no indication that the items listed in the invoices correspond to the items shown in the pictures or otherwise display the Mark, I note that Mr. Jacobs has confirmed that the invoices reflect sales of items displaying the Mark. I note that some of the pictured items display both the Mark and third-party trademarks; the fact that such items may have displayed third-party trademarks does not preclude a finding of use [*AW Allen Ltd v Canada (Registrar of Trade Marks)* (1985), 6 CPR (3d) 270 (FCTD)].

[21] However, while evidentiary overkill is not required and representative evidence can be furnished in section 45 proceedings, the registered owner must still establish a *prima facie* case of use of the trademark in association with *each* of the goods specified in the registration [*John Labatt*; see also *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 (*Diamant Elinor*)]. In other words, the Registrar must be able to "rely on an inference from proven facts rather than on speculation" to satisfy every element required by the Act [*Diamant Elinor* at para 11; see also *Smart & Biggar v Curb*, 2009 FC 47]. Such evidence may be in the form of invoices, but can also be through clear sworn statements regarding volumes of sales, dollar value of sales, or equivalent factual particulars [see, for example, *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79].

[22] In this case, the affiant has merely provided a general statement that each of the goods listed in the registration displayed the Mark and were sold during the relevant period, while providing factual particulars in support of only some of these goods. Given that the list of goods

is relatively short, I find it reasonable to expect the registered owner to furnish *some* evidence with respect to each of the goods [for similar conclusions, see *Method Law v Boutique Jacob Inc*, 2015 TMOB 5 at paras 23-24; *Fetherstonhaugh & Co v HB Fuller Company*, 2019 TMOB 1 at paras 19-20]. Accordingly, without any corroborative evidence, Mr. Jacobs' statements that each of the goods listed in the registration displayed the Mark and was sold by the Owner during the relevant period do not, in and of themselves, provide a sufficiently detailed factual foundation upon which I could conclude that the Owner has sold each of the registered goods in the normal course of trade during the relevant period.

[23] In view of the above, I am prepared to accept that the goods listed on the invoices displayed the Mark and were transferred in the normal course of trade during the relevant period. Such goods include shirts (items listed as "polo"), hats, golf balls (the "logo jar ball"), and coffee mugs. While other items are listed in the invoices, it is not clear which, if any, of the registered goods correspond with these items; in the absence of such correlation by the Owner, it is not for the Registrar to speculate as to the nature of the goods [*Fraser Milner Casgrain LLP v Fabric Life Ltd*, 2014 TMOB 135 at para 13]. Finally, although Mr. Jacobs includes a picture of a golf bag displaying the Mark, there do not appear to be any corresponding invoices showing that such an item was sold during the relevant period. In this respect, it is not sufficient that the goods were merely offered during the relevant period; some evidence of transfers in the normal course of trade in Canada is necessary [see, for example, *Molson Cos v Halter* (1976), 28 CPR (2d) 158 (FCTD)].

[24] Accordingly, I am satisfied that the Owner has used the Mark in association with the following goods within the meaning of the Act: "Clothing namely, shirts, […] hats […]; merchandise namely, […] golf balls, […] coffee mugs." I am not satisfied that the Owner used the Mark in association with the remaining registered goods within the meaning of the Act. As there is no evidence of special circumstances excusing non-use, the registration will be amended accordingly.

Operation of a Golf Course; Restaurant and Lounge; Recreational Resort

[25] With respect to the evidence of use of the Mark in association with the service "operation of a golf course" and "operation of a restaurant and lounge" provided by Mr. Jacobs as Exhibit B

and E, the Requesting Party notes that the date of the Exhibit B website screenshots is unreadable, that the copies of the golf course brochure, business card, and menu are undated, and that the tee time reports and invoices do not display the Mark. In response, the Owner submits that Mr. Jacobs attests in his affidavit that the screenshots are dated January 10, 2020, and that the brochure and business cards were circulated during the relevant period.

[26] Given that the Exhibit B brochure displays the Mark, advertises and describes the Owner's golf course and restaurant, and was circulated during the relevant period, I am satisfied that it constitutes advertisement of the services "operation of a golf course" and "operation of a restaurant and lounge". Further, the invoices for green fees, golf cart rentals, and food sales demonstrate that the Owner was performing these services during the relevant period. Accordingly, I am satisfied that the Owner used the Mark in association with the services "operation of a golf course" and "operation of a restaurant and lounge" within the meaning of the Act.

[27] I note that services (2) includes "operation of a recreational resort"; however, neither party made submissions regarding this service. The only evidence in Mr. Jacobs' affidavit referring to this service is his characterization of Dakota Dunes Golf Links as "a recreational resort comprising a golf course, pro shop, restaurant and lounge". The Registrar has held that "in certain cases, statements of services 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 Co*, 2010 TMOB 7 at para 15; see also *Provent Holdings Ltd v Star Island Entertainment, LLC*, 2014 TMOB 178 at para 22; *GMAX World Realty Inc v RE/MAX, LLC*, 2015 TMOB 148 at para 69]. Bearing this principle in mind, I am satisfied that display of the Mark in the performance or advertising of the golf course, restaurant and lounge services would also amount to display of the Mark in the performance or advertising of the recreational resort services. Given that the Owner has provided evidence demonstrating use of the Mark during the relevant period in association with the golf course, restaurant and lounge services and with goods sold at its pro shop, I am satisfied that the Owner has also demonstrated use of the Mark in association with the service "operation of a recreational resort" within the meaning of the Act.

Catering Services

[28] With respect to "catering services", the Requesting Party submits that there is no evidence that catering services were performed or advertised during the relevant period. In this respect, the Requesting Party notes that Mr. Jacobs merely states that the golf club is "available for tournaments, golf outings and business meetings with catering services, playing host to over 100 special event bookings", without confirming that any such bookings took place in the relevant period or were catered. The Requesting Party further submits that there is no indication that the 2019 Tournament Planner brochure included as Exhibit F was circulated during the relevant period. In response, the Owner submits in its written representations that the Tournament Planner brochure is "directed towards customers and potential customers seeking to plan tournaments" during the relevant period, although no such language appears in Mr. Jacobs' affidavit.

[29] I concur with the Requesting Party. In the absence of clear evidence that the catering services were performed during the relevant period, or that the Tournament Planner brochure was circulated during the relevant period, I cannot determine whether the Mark was used during the relevant period in association with these services. In this respect, I note that Mr. Jacobs confirms that the brochure shown in Exhibit B, advertising the golf course itself (but with no reference to catering), was circulated during the relevant period, but Mr. Jacobs includes no such confirmation for the Exhibit F Tournament Planner brochure. As a result, I am not satisfied that the Owner used the Mark in association with "catering services" within the meaning of the Act. As there is no evidence of special circumstances excusing non-use, the registration will be amended accordingly.

Hotel and Casino Services

[30] With respect to the remaining services, in the absence of submissions from the Owner, I concur with the Requesting Party that the Owner has not demonstrated that it used the Mark within the meaning of the Act in association with the registered services "casino services" and "hotel services". Indeed, it is clear from Mr. Jacobs' affidavit that the casino and hotel in question were owned and operated by third parties, and as noted by the Requesting Party, the

affidavit offers no detail on whether, or on what terms, the Owner licenced the Mark for use by these entities.

[31] In this respect, I note that where a trademark owner asserts use of a trademark by way of a licensee, there are three main methods by which a trademark owner can demonstrate the requisite control over the character or quality of the goods or services sold under that trademark pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of the licence agreement that provides for the requisite control [*Empresa Cubana Del Tobaco Trading v Shapiro Cohen*, 2011 FC 102 at para 84].

[32] In this case, even if I were to accept that the variations of the Mark shown in Exhibits G and H amounted to use of the Mark as registered, Mr. Jacobs has provided no indication that the Owner exerts the requisite control over such use, and the Owner's submissions do not suggest that it did so. In this respect, while Mr. Jacobs attests that both the Owner and DDH are wholly owned by Whitecap Dakota First Nation, the mere fact that a registered owner and a licensee are related companies is insufficient to infer that control under licence exists pursuant to section 50 [see *MCI Communications Corp v MCI Multinet Communications Inc* (1995), 61 CPR (3d) 245 (TMOB) and *Dynatech Automation Systems Inc v Dynatech Corp* (1995), 64 CPR (3d) 101 (TMOB)]. In any event, Mr. Jacobs' affidavit is clear that the Dakota Dunes hotel did not open until after the relevant period.

[33] Accordingly, I am not satisfied that the Owner used the Mark in association with the services "casino services" and "hotel services" within the meaning of the Act. As there is no evidence of special circumstances excusing non-use, the registration will be amended accordingly.

DISPOSITION

[34] In view of all of the foregoing, 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 "sweaters, jackets and outerwear", "knit caps, golf gloves", "golf bags", and "divot repair tools, golf towels, ball markers, keychains, money clips,

wallets, bag tags" from the registered goods, as well as "catering services", "hotel services; casino services" from the registered services.

[35] The amended registration will be as follows:

GOODS

Clothing namely, shirts, hats; merchandise namely, golf balls, coffee mugs.

SERVICES

(1) Operation of a golf course; operation of a restaurant and lounge.

(2) Operation of a recreational resort.

G.M. Melchin
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

Cassan Maclean IP Agency Inc.	For the Registered Owner
Paul Lomic (Lomic Law)	For the Requesting Party