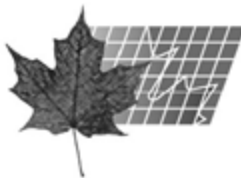


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C I P O

**LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS**

Citation: 2022 TMOB 173

Date of Decision: 2022-08-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Gowling WLG (Canada) LLP

Requesting Party

and

140077 Canada Inc.

Registered Owner

TMA929,293 for ESSETRICS

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. TMA929,293 for the trademark ESSETRICS (the Mark).

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

GOODS

- (1) Audio recordings, video recordings and audio-visual recordings, namely pre-recorded cassette tapes, pre-recorded compact discs, pre-recorded DVDs, pre-recorded phonograph records, pre-recorded audio and video tapes, all featuring fitness and health club related programs, training materials and music related to fitness programs.
- (2) Computer database management software used for fitness and health club related programs and training materials.
- (3) Electronic publications, namely magazines, manuals and newsletters featuring content related to physical fitness instruction and consulting in the field of health

and wellness.

(4) Exercise equipment, namely an apparatus with a movable carriage for use in stretching and strengthening exercises, chairs, stretch bars, exercise cords and bands, handles and straps for exercise equipment.

(5) Clothing, namely, athletic wear.

(6) Instructional and teaching material, namely user manuals, instructional books, questionnaires, pamphlets, periodicals, reports, manuals, guides, handbooks, notepads and postcards.

(7) Applications for mobile and tablet devices, namely operating systems featuring exercise programs and providing information on health and fitness.

(8) Gymnastic and sporting articles, namely fitness and yoga mats, exercise balls and balance balls, exercise blocks, bags and straps specifically adapted for sports equipment, gym bags and tote bags, neck pillows, backpacks and water bottles.

(9) Fitness journals that provide individuals with customized pages to track their progress and achieve fitness goals.

SERVICES

(1) Education services, namely conducting health and fitness courses, seminars, lectures, conferences and tradeshows.

(2) Electronic mail services through wired and wireless access, wireless digital messaging services.

(3) Franchising services namely, offering business management and technical assistance in the establishment, operation and marketing of exercise studios, training and retraining of teachers, providing on-going advice on the teaching of the program of the applicant's exercise methods.

(4) Health club services; fitness club services; exercise instruction, producing and conducting personal training programs and services.

(5) Instructor certification services and programs, namely teacher training workshops in the field of physical fitness instruction.

(6) On-line retail store services featuring DVDs; providing online registration for fitness certification programs, seminars and workshops.

(7) Operating a website providing information, news, editorials and opinions in the fields of health, nutrition, physical fitness and lifestyle.

(8) Producing and conducting exercise programs and classes.

(9) Providing materials pertaining to exercise classes, namely class schedules, class cards and business cards.

(10) Recreation services, namely providing classes, programs, personal training and retreats in the field of health, nutrition and physical fitness.

(11) Sporting activities, namely the organization, supervision and administration of running clubs and clinics.

(12) The operation of exercise studios.

(13) Webcasts, podcasts and newscasts pertaining to consulting services in the field of physical fitness instruction and health and wellness.

(14) Web hosting services, namely designing websites and creating social media accounts.

(15) Consulting services in the fields of health, nutrition, physical fitness and

well-being.

(16) Electronic distribution of information namely, creation, production and providing access to online databases and information via internet and wide area computer networks on health and fitness.

(17) On-line retail store services featuring fitness apparel, books, exercise equipment and membership to website contents; providing online registration services for health and fitness coaching and personal training services.

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

THE PROCEEDING

[4] At the request of Gowling WLG (Canada) LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on May 19, 2020 to the registered owner of the Mark, 140077 Canada Inc. (the Owner).

[5] The notice required the Owner to show whether the Mark was used in Canada in association with each of the goods and services listed 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 May 19, 2017 to May 19, 2020.

[6] The relevant definition of use in the present case is 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 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. Nevertheless, sufficient evidence must still be provided to allow the Registrar to conclude that the trademark was used in association with each of the registered goods and services [see *Uvex*

Toko Canada Ltd v Performance Apparel Corp, 2004 FC 448, 31 CPR (4th) 270]. Furthermore, mere statements of use are insufficient to prove use [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 1980 CanLII 2739 (FCA), 53 CPR (2d) 62 (FCA)].

[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.

[9] In response to the Registrar's notice, the Owner furnished the affidavit of Melissa Tran, sworn on December 18, 2020 in Montreal, to which were attached Exhibits A to P.

[10] Only the Requesting Party submitted written representations. No hearing was held.

EVIDENCE SUMMARY

[11] In her affidavit, Ms. Tran identifies herself as Chief Operating Officer of both the Owner and 6228755 Canada Inc. [paras 1 and 4]. She explains that 6228755 Canada Inc. is the exclusive licensee of the Owner (the Licensee) and confirms that the Owner controls the character and quality of goods and services offered or provided by the Licensee in association with the Mark in Canada [para 4].

[12] Ms. Tran states that "The Licensee is in the fitness business and creates DVD, has an online workout streaming platform, fitness and health TV programming, consumer books as well as fitness instructor training for teachers in gyms, studios, community centers and personal training" [para 6].

[13] Ms. Tran asserts that "The Goods and Services were promoted and sold in Canada by the Licensee between May 19, 2017 and May 19, 2020" [para 5].

[14] In terms of promotion and advertisement of the registered services by the Licensee, Ms. Tran asserts that "Approximate expenditures on promotional and advertising activities are in excess of \$3.3 Million during the relevant period" [para 30].

[15] As for the normal course of trade, Ms. Tran attests that "Sales and services in Canada are conducted through a mix of retail, e-commerce, business to business, direct to business for gyms, fitness centers and boutique studios, as well as direct to consumer, live group fitness sessions"

[para 8]. She further attests that the e-commerce activities are conducted through the Licensee's websites available at *www.essentric.com*, *www.essentricstv.com* and *www.essentricstudio.com* [para 8].

[16] In support of the foregoing, Ms. Tran provides the following relevant exhibits:

- Screen captures from *www.essentric.com* depicting DVDs (Exhibit A) as well as invoices for DVDs issued to Canadian customers during the relevant period (Exhibit A-1). Ms. Tran attests that the screen captures attached as Exhibit A “are representative of the manner in which the [Mark] appeared on ‘Audio recordings, video recordings and audio-visual recordings, namely pre-recorded cassette tapes, pre-recorded compact discs, pre-recorded DVDs, pre-recorded phonograph records, pre-recorded audio and video tapes, all featuring fitness and health club related programs, training materials and music related to fitness programs’ that were sold and distributed during the relevant period” [para 9]. I note that two of the DVDs listed in the Exhibit A-1 invoices, namely “Rebalance and Reboot Your Body” and “Essentric DVD bundle” correspond to the products shown in the Exhibit A screenshots. The Mark is displayed on the depicted DVDs.
- Screen captures from *www.essentric.com* (Exhibit B) which Ms. Tran describes as showing “a database user interface that certified instructors use to create their listings for live and virtual workout classes and for maintaining their certifications”, and attests “are representative of the manner in which the [Mark] appeared on ‘computer database management software used for fitness and health club related programs and training materials’ that were available to the Licensee’s clients during the relevant period” [para 11]. The first two screenshots prominently display the following texts under the “Instructor Training” tab of the website: “Class Profile Account”, “Log In”, “Create A Class Profile Account”, “Grant of Teaching License”, “Live Virtual Class Terms”, “Maintaining Your Active Teaching License”. The Mark appears at the top of the depicted webpages.
- Screen captures of “blog and newsletters” from *www.essentric.com* (Exhibit C) as well as “a representative list of emails distributed to newsletter subscribers” (Exhibit P). Ms.

Tran attests that the screen captures attached as Exhibit C “are representative of the manner in which the [Mark] appeared in association with ‘Electronic publications, namely magazines, manuals and newsletters featuring content related to physical fitness instruction and consulting in the field of health and wellness’ that were promoted by client outreach emails sent to the Licensee’s clients during the relevant period” [para 12]. As for the representative list of emails distributed to newsletter subscribers, Ms. Tran explains that “The Licensee’s websites welcome approximately 75,000 monthly visitors and that there are over 100,000 subscribers to newsletters that are sent out by email several times each month” [para 29]. She attests that the list is “representative of the manner in which the [Mark] is used in advertising in association with ‘Electronic distribution of information namely, creation, production and providing access to online databases and information via internet and wide area computer networks on health and fitness’ during the relevant period” [para 29]. I note that the depicted newsletters are for the years 2016, 2017, 2018 and 2019, and that the titles of the newsletters of July 2017, November 2017 and January 2018 are respectively the following: “Summertime – Every Stretch You Need”, “Meet The Makers”, “Health Challenge”.

- Images of (i) “an instructional package comprised of a handbook and accompanying instructional videos & DVD, access to online comprehensive Training Resource webpage, support documents, videos, exam package, and learning tools”; (ii) “an instructional starter bundle comprised of instructional DVDs, handbook and workout guide”; (iii) “an instructional workout plan”; (iv) “promotional pamphlet and promotional postcard” (Exhibit D); as well as invoices pertaining to sales of “Pre-Choreographed Workout 11 Strength & Flexibility Balance”, “Pre-Choreographed Workout 10 Shoulder Release & Mobility”, “Pre-Choreographed Workout 9 Age Reversing Essentrics”, “Essentrics Certification Level 2 Package” and “Aging Backwards: Starter Bundle” (Exhibit D-1). I note that two of the products listed in the Exhibit D-1 invoices, namely “Essentrics Certification Level 2 Package” and “Aging Backwards: Starter Bundle” correspond to the first and second products shown in the Exhibit D screenshots. The Mark is displayed on all of the depicted products.

- A copy of “a promotional email” as well as screen captures displaying the ESSETRICS-branded workout application available for download on Apple Store and Google Play (Exhibit E) which Ms. Tran attests “are representative of the manner in which the [Mark] was associated with ‘Applications for mobile and tablet devices, namely operating systems featuring exercise programs and providing information on health and fitness’ during the relevant period” [para 15]. Ms. Tran further attests that the email attached to Exhibit E was sent to the Licensee’s clients on January 15, 2020 to promote the ESSETRICS-branded workout application [para 15].
- Copies of “a beginner’s workout guide and a 30 day workout challenge” (Exhibit F) which Ms. Tran attests are “representative of the manner in which the [Mark] was associated with ‘Fitness journals that provide individuals with customized pages to track their progress and achieve fitness goals’ during the relevant period” [para 16]. Ms. Tran further attests that a copy of the “30 Day Challenge schedule” was produced and distributed in January 2020 [para 26]. In fact, the exhibited “30 day workout challenge” appears to be a two-page document displaying daily workout schedules including a mix of “Hip & Knee Strengthening”, “Full Body Stretching”, “Calorie Burning & Lower Body Sculpting”, and several other activities with a teaching instructor. The Mark is visible at the bottom of the exhibited document.
- Copies of “promotional advertising for health and fitness courses, exercise instruction, training workshops, instructor certification services and programs and teacher training” (Exhibit G) which Ms. Tran attests were sent by email to the Licensee’s clients, and are “representative of how the [Mark] was used in association with ‘Education services, namely conducting health and fitness courses, seminars, lectures, conferences and tradeshows’ offered by the Licensee during the relevant period” [para 17]. The Mark is displayed throughout the exhibited materials.
- Screen captures from *www.essentrics.com* (Exhibit H) which Ms. Tran describes as showing “the ‘Find a Class’ search tool for locating a certified instruction or facility” as well as invoices showing sales of “Essentrics Stretch Training Canadiens – Training Camp Season 2017-2018”, amongst other class package products [para 18]. Ms. Tran

attests that the screen captures attached as Exhibit H “are representative of the manner in which the [Mark] was associated with the promotion and advertising of ‘Health club services; fitness club services; exercise instruction, producing and conducting personal training programs and services; the operation of exercise studios; Consulting services in the fields of health, nutrition, physical fitness and well-being’ ” [para 18]. Based on a fair reading of Ms. Tran’s statement, she further attests that the invoices attached as Exhibit H-1 were issued for performance of such services [para 19]. I note that the Mark is displayed throughout the Exhibit H screen captures and that the invoices attached as Exhibit H-1 are issued to customers located in Canada during the relevant period.

- Screen captures from *www.essentrics.com* (Exhibit I-1) promoting the ESSENTRICS-branded Instructor Certification Program as well as an invoice showing the sale of an item identified as “ Level 4 LTT ” (Exhibit I-2). Ms. Tran attests that the screen captures attached as Exhibit I-1 “are representative of the manner in which the [Mark] was advertised in association with ‘Instructor certification services and programs, namely teacher training workshops in the field of physical fitness instruction’ during the relevant period” [para 21]. Based on a fair reading of Ms. Tran’s statement, she further attests that the invoice attached as Exhibit I-2 was issued for performance of such services [para 22]. I note that the Mark is displayed throughout the Exhibit I-1 screen captures, that the invoice is issued to a customer located in Canada during the relevant period, and that the invoiced item correlates to the fourth level of the ESSENTRICS-branded Instructor Certification Program.
- Printouts from the website *www.store.essentrics.com* that list DVDs available for purchase on that website (Exhibit J) and teacher training workshops that were scheduled in April and May of 2020 (Exhibit J-1). Ms. Tran asserts that these printouts “are representative of the manner in which the [Mark] was displayed in advertising in association with ‘On-line retail store services featuring DVD; providing online registration for fitness certification programs, seminars and workshops; On-line retail store services featuring fitness apparel, books, exercise equipment and membership to website contents; providing online registration services for health and fitness coaching and personal training services’ during the relevant period” [para 23]. The Mark is visible

throughout the Exhibits J and J-1 printouts, either on the depicted DVDs or underneath the image of each depicted DVD and teacher training material.

- Copies of “exercise class schedules”, “30 Day Challenge schedule”, “class card” and “business card” (Exhibit M). Ms. Tran attests the exercise class schedules were distributed by email to the Licensee’s emailing list, that the 30 Day Challenge schedule was produced and distributed in January 2020, and that all of the exhibited copies “are representative of the manner in which the [Mark] was used in association with ‘Providing materials pertaining to exercise classes, namely class schedules, class cards and business cards’ during the relevant period” [para 26]. The Mark is displayed on each of the exhibited copies.
- Copies of promotional advertisement (Exhibit N) which Ms. Tran attests was sent by email to the Licensee’s emailing list, and “are representative of the manner in which the [Mark] appears in the advertising for ‘Recreation services, namely providing classes, programs, personal training and retreats in the field of health, nutrition and physical fitness; Sporting activities, namely the organization, supervision and administration of running clubs and clinics’ during the relevant period [para 27]. In fact, the promotional advertisement attached as Exhibit N depicts a weekend retreat in United States, a fitness holiday and a teacher training symposium in Mexico as well as some instructor events which took place in Toronto including a Live Teacher Training, a Pre-Choregraphed Workout Class and Exam Preparation, and a Live Exam. Again, the Mark is displayed on each of the exhibited copies.
- Screen captures from *www.essentricstv.com* (Exhibit O) displaying the ESSETRICS-branded TV streaming platform which Ms. Tran attests “are representative of the manner in which the [Mark] appears in advertising for ‘Webcasts, podcasts and newscasts pertaining to consulting services in the field of physical fitness instruction and health and wellness’ ” [para 28].

ANALYSIS AND REASONS FOR DECISION

[17] In its written representations, the Requesting Party submits that the Tran affidavit fails to establish use of the Mark in Canada during the relevant period in association with a broad range of the registered goods and services. The Requesting Party generally submits that the Owner has provided no real evidence of genuine commercial sales or transfer of any of the registered goods and services for which use of the Mark is disputed; however, the Requesting Party made no representations specific to any of such goods and services.

[18] In this regard, I must note at the outset that, while the Requesting Party correctly submits that evidence of sales or transfer is required to demonstrate use of the Mark in association with the registered goods, this is not true with respect to the registered services. Indeed, as it pertains to services, a trademark is deemed to be used if it is used or displayed in the performance or advertising of those services [section 4(2) of the Act]. In the absence of actual performance of the services, the evidence must show not only that the services had been advertised but also that the owner was willing and able to perform the services in Canada during the relevant period [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[19] That being said, I will now address the sufficiency of the evidence furnished in relation to each of the goods and services as listed in the registration.

The Registered Goods and Services for which Use of the Mark is Shown

The Registered Goods

Goods (1): Audio recordings, video recordings and audio-visual recordings, namely pre-recorded DVDs

[20] As shown in the evidence summary, there is clear evidence that DVDs were sold in Canada during the relevant period and that such DVDs displayed the Mark at the time of transfer [Exhibits A-1 and A].

[21] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods “Audio recordings, video recordings and audio-visual

recordings, namely [...] pre-recorded DVDs [...] featuring fitness and health club related programs, training materials and music related to fitness programs” within the meaning of sections 4 and 45 of the Act.

Good (2) – Computer database management software

[22] It has been held that data or software available only through an Internet browser meets the requirement of showing a transfer in accordance with section 4(1) of the Act, despite no software actually being installed *per se* on a customer’s computer [*Specialty Software Inc v Bewatec Kommunikationstechnik GmbH*, 2016 FC 223 at paras 5-6].

[23] In the present case, good (2) is a “Computer database management software used for fitness and health club related programs and training materials”. As shown in the Exhibit B screen captures, the database product includes a logon screen to create listings for live and virtual workout classes including materials for maintaining training certifications. In my view, these data information are certainly transferred to a client’s computer. In order for a certified instructor to use the logon screen to access the database in order to create a listing for a live and virtual workout class, at a minimum, the digital data that comprises this screen must be transferred in some manner to the certified instructor’s computer [see also *Davis LLP v 819805 Alberta Ltd.*, 2016 TMOB 64].

[24] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered good “Computer database management software used for fitness and health club related programs and training materials” within the meaning of sections 4 and 45 of the Act.

Goods (3): Electronic publications, namely newsletters

[25] Ms. Tran relies on the Exhibit C screen captures to demonstrate use of the Mark in association with all of the electronic publications goods listed in the registration as “Electronic publications, namely magazines, manuals and newsletters featuring content related to physical fitness instruction and consulting in the field of health and wellness”. The Requesting Party, for its part, submits non-use of the Mark in association with “magazines” only. However, it would

appear from the evidence summary above that the only electronic publication featuring content related to physical fitness instruction and consulting in the field of health and wellness made available to subscribers on a regular basis was in the form of “newsletters” [para 29; Exhibits C and P].

[26] In this respect, the evidence is that Canadians purchased DVDs, instructional and teaching material including class package products and instructor certification programs offered for sale by the Licensee. The evidence is also that there are over 100,000 subscribers including licensee’s clients to which newsletters are sent out by email several times each month. Keeping in mind that reasonable inferences can be made from the evidence provided [see *Eclipse International Fashions Canada Inc v Shapiro Cohen* (2005), 48 CPR (4th) 223 (FCA)], I find it reasonable to infer in the present case that Canadians would be amongst the Licensee’s newsletter recipients as listed in Exhibit P.

[27] Further, it is well established that free distribution of goods may constitute use in the normal course of a business, particularly if the goods freely distributed are the goods in which the business normally deals [see *Riches, McKenzie & Herbert LLP v Cosmetic Warriors Limited*, 2018 FC 63 at para 18].

[28] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “Electronic publications, namely [...] newsletters featuring content related to physical fitness instruction and consulting in the field of health and wellness” within the meaning of sections 4 and 45 of the Act.

Goods (6) – Instructional and teaching material

[29] As indicated above in the evidence summary, there is clear evidence that the instructional package identified as “Essentrics Certification Level 2 Package”, and comprised of a handbook and accompanying instructional videos & DVD, access to online comprehensive Training Resource webpage, support documents, videos, exam package, and learning tools, was sold in Canada during the relevant period, and that such product displayed the Mark at the time of transfer [Exhibits D-1 and D]. There is also clear evidence that the instructional starter bundle identified as “Aging Backwards: Starter Bundle”, and comprised of instructional DVDs,

handbook and workout guide, was sold in Canada during the relevant period, and that such product displayed the Mark at the time of transfer [Exhibits D-1 and D].

[30] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods “Instructional and teaching material, namely user manuals, instructional books, questionnaires, pamphlets, periodicals, reports, manuals, guides, handbooks, notepads and postcards” within the meaning of sections 4 and 45 of the Act.

Goods (7) – Applications for mobile and tablet devices

[31] As for goods (7), “Applications for mobile and tablet devices, namely operating systems featuring exercise programs and providing information on health and fitness”, although Ms. Tran could have been clearer in providing, for example, Apple Store or Google Play’s reports exhibiting Canadian downloads of the workout application during the relevant period [see, for example, *John H. Simpson (Shift Law) v WOWTOOLS.com, Inc.*, 2021 TMOB 117 at paras 16, 17 and 23], I find that the evidence is sufficient.

[32] As discussed above, given that Canadians are customers of the Licensee and would have normally received the Licensee’s email promoting the workout application sent to the Licensee’s clients on January 15, 2020 [para 15; Exhibit E], I find it reasonable to infer that such application may have been downloaded in association with the Mark by, at least, one Canadian customer during the relevant period.

[33] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods “Applications for mobile and tablet devices, namely operating systems featuring exercise programs and providing information on health and fitness” within the meaning of sections 4 and 45 of the Act.

[34] In summary, in view of the above, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4(1) and 45 of the Act in association with the following registered goods:

- Goods (1): “Audio recordings, video recordings and audio-visual recordings, namely [...] pre-recorded DVDs [...] featuring fitness and health club related programs, training materials and music related to fitness programs”;

- Goods (2): “Computer database management software used for fitness and health club related programs and training materials”;
- Goods (3): “Electronic publications, namely [...] newsletters featuring content related to physical fitness instruction and consulting in the field of health and wellness”;
- Goods (6): “Instructional and teaching material, namely user manuals, instructional books, questionnaires, pamphlets, periodicals, reports, manuals, guides, handbooks, notepads and postcards”; and
- Goods (7): “Applications for mobile and tablet devices, namely operating systems featuring exercise programs and providing information on health and fitness”.

The Registered Services

Services (1), (5), (7), (8), (9), (10), (12), (13) and 15

[35] Having reviewed all of the accompanying exhibits in conjunction with Ms. Tran’s statements regarding the nature of the Licensee’s business, the evidence in this case is that the Owner provided education, recreation, instructor certification and consulting services in the fields of health, physical fitness and well-being, and such through the provision of instructional and teaching materials including DVDs, user manuals, workout guides or plans, and by conducting workshops, courses, programs, live and virtual workout classes, amongst other things. There is also evidence that Canadians benefited from these services as a result of the Licensee’s advertisement through various means, such as via the Licensee’s website and mobile workout application, e-communications or the TV streaming platform. Further, the exhibited promotional materials display the Mark and were accessible from Canada during the relevant period.

[36] As the evidence makes no mention or reference to the terms “seminars”, “lectures”, “conferences”, “tradeshows” and “nutrition” or any words related to such terms that would reasonably lead me to infer that services provided by the Licensee also encompass services associated to these terms, I conclude, in the absence of representations from the Owner, that the registration ought to be amended to delete the terms “seminars”, “lectures”, “conferences”, “tradeshows” and “nutrition”

[37] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act in association with the following services:

- Services (1): “Education services, namely conducting health and fitness courses [...]”;
- Services (5): “Instructor certification services and programs, namely teacher training workshops in the field of physical fitness instruction”;
- Services (7): “Operating a website providing information, news, editorials and opinions in the fields of health, [...], physical fitness and lifestyle”;
- Services (8): “Producing and conducting exercise programs and classes”;
- Services (9): “Providing materials pertaining to exercise classes, namely class schedules, class cards and business cards”;
- Services (10): “Recreation services, namely providing classes, programs, personal training and retreats in the field of health, [...] and physical fitness”;
- Services (12): “The operation of exercise studios”;
- Services (13): “Webcasts, podcasts and newscasts pertaining to consulting services in the field of physical fitness instruction and health and wellness”; and
- Services (15): “Consulting services in the fields of health, [...], physical fitness and well being”.

Services (4) – Health club services; fitness club services; exercise instruction, producing and conducting personal training programs and services

[38] In the context of services (4), the Requesting Party does not take any issue with “exercise instruction, producing and conducting personal training programs and services”. Nevertheless, the Requesting Party submits non-use of the Mark with respect to “Health club services” and “fitness club services”.

[39] In this regard, it is clear from the titles of the newsletters shown in the Exhibit C screen captures as well as from the content of the “30 day workout challenge” document shown in Exhibit F that the Licensee advertised provision of health and fitness services in Canada during the relevant period. Indeed, as indicated in the evidence summary, Ms. Tran indicates that the “30 day workout challenge” was produced and distributed in January 2020, and that newsletters were sent out by email during the relevant period to over 100,000 subscribers [paras 26 and 29].

[40] Given the Licensee’s normal course of trade, I find that a subscriber or potential client would reasonably expect that the so-advertised health and fitness services be performed or made available in clubs.

[41] Finally, Ms. Tran indicates that the Exhibit H-1 invoices were issued for the performance of “Health club services” and “fitness club services” [para 19]. This statement is consistent with the use of the terms “Essentrics Stretch Training Canadiens – Training Camp Season 2017-2018” in the Exhibit H-1 invoices.

[42] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with all services (4) within the meaning of sections 4 and 45 of the Act.

Services (6) and (17): On-line retail store services featuring DVDs and On-line retail store services featuring books and membership to website contents

[43] It has been held that, for an online retailer’s activities to support a registration for retail store services, the combination of such activities must demonstrate “a certain level of interactivity with potential Canadian customers” in order for there to be a “benefit to Canadians sufficient to support such a registration” [*Lapointe Rosenstein LLP v The West Seal, Inc*, 2012 TMOB 114 at paragraph 27].

[44] Applying this principle to the present case, it is clear from the evidence that the Licensee’s website contains indicia to suggest that retail department store services were available to consumers in Canada during the relevant period for, at least, DVDs, books and membership to website contents.

[45] As for “DVDs” and “books”, these indicia include the prices of such products displayed in Canadian dollars and the contact information in Canada or for Canadians [Exhibits D and J]. Moreover, the evidence demonstrates that the DVDs and books which were available for sale on the Licensee’s website were in fact purchased from or delivered to Canada during the relevant period [Exhibits A-1, D-1 and J-1].

[46] As for “membership to website contents”, these indicia notably include the display of the following on the Licensee’s website: “Log In” or “Create Class Profile Account” [Exhibit B].

[47] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act in association with “On-line retail store services featuring DVDs” from services (6) and “On-line retail store services featuring books and membership to website contents” from services (17).

Services (6) and (17) – Providing online registration

[48] With respect to services (6), “providing online registration for fitness certification programs, seminars and workshops” and services (17), “providing online registration services for health and fitness coaching and personal training services”, Ms. Tran relies on the Exhibit J and J-1 printouts. While I do not consider Exhibit J and J-1 printouts as sufficient evidence to demonstrate use of the Mark in association of these services, based on a fair reading of the evidence as a whole, I find that Exhibits B, H and H-1 clearly establish that Canadians had accessed to online registration services provided by the Licensee during the relevant period, and that such services associated with the Mark were actually provided to Canadians or performed in Canada during that time.

[49] As for services (6) exclusively, since the evidence makes no mention or reference to the term “seminars” as previously discussed above, I conclude that the registration ought to be amended to delete this term.

[50] As such, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act in association with “providing online registration for fitness certification programs [...] and workshops” from services (6) and “providing online registration services for health and fitness coaching and personal training services” from services (17).

Service (16) – Electronic distribution of information

[51] In the context of services (16), “Electronic distribution of information namely, creation, production and providing access to online databases and information via internet and wide area computer networks on health and fitness”, Ms. Tran indicates that the ESSETRICS-branded services are globally marketed and distributed through an online streaming platform and website

content, amongst other means. In support, Ms. Tran provides screen captures from the Licensee's website which she describes as depicting a database user interface that certified instructors use to create their listings for live and virtual workout classes which are accessible to members [Exhibit B].

[52] Given the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered services "Electronic distribution of information namely, creation, production and providing access to online databases and information via internet and wide area computer networks on health and fitness" within the meaning of sections 4 and 45 of the Act.

[53] In summary, in view of the above, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4(2) and 45 of the Act in association with the following registered services:

- Services (1): "Education services, namely conducting health and fitness courses [...]";
- Services (4): "Health club services; fitness club services; exercise instruction, producing and conducting personal training programs and services";
- Services (5): "Instructor certification services and programs, namely teacher training workshops in the field of physical fitness instruction";
- Services (6): "On-line retail store services featuring DVDs; providing online registration for fitness certification programs [...] and workshops";
- Services (7): "Operating a website providing information, news, editorials and opinions in the fields of health, [...] physical fitness and lifestyle";
- Services (8): "Producing and conducting exercise programs and classes";
- Services (9): "Providing materials pertaining to exercise classes, namely class schedules, class cards and business cards";
- Services (10): "Recreation services, namely providing classes, programs, personal training and retreats in the field of health, [...] and physical fitness";
- Services (12): "The operation of exercise studios";
- Services (13): "Webcasts podcasts and newscasts pertaining to consulting services in the field of physical fitness instruction and health and wellness";

- Services (15): “Consulting services in the fields of health, [...], physical fitness and well being”;
- Services (16): “Electronic distribution of information namely, creation, production and providing access to online databases and information via internet and wide area computer networks on health and fitness”; and
- Services (17): “On-line retail store services featuring books and membership to website contents” and “providing online registration services for health and fitness coaching and personal training services”.

The Registered Goods and Services for which Use of the Mark is Not Shown

The Registered Goods

Goods (1): Audio recordings, video recordings and audio-visual recordings, namely pre-recorded cassette tapes, pre-recorded compact discs, pre-recorded phonograph records, pre-recorded audio and video tapes

[54] Although the Requesting Party takes no issue with respect to “pre-recorded cassette tapes, pre-recorded compact discs, pre-recorded phonograph records, pre-recorded audio and video tapes” from goods (1), I note that Ms. Tran does not make reference to these goods in her affidavit; such being consistent with the fact that there is no evidence of transfer of such goods in Canada during the relevant period.

[55] Therefore, the Owner fails to meet its *prima facie* burden of showing use of the Mark. As there is no evidence of special circumstances excusing non-use, these goods will be deleted from the registration.

Goods (3): Electronic publications, namely magazines and manuals

[56] As previously discussed above, the only publication featuring content related to physical fitness instruction and consulting in the field of health and wellness made available to subscribers electronically was newsletters. Having distinguished both “magazines” and “manuals” from “newsletters” in the registration, the Owner had to produce evidence of use with respect to each of the listed goods [per *John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)].

[57] In this respect, although the Exhibit D images and the Exhibit D-1 invoices establish use of the Mark with respect to “manuals” or “user manuals”, I find that such manuals are to be considered printed materials as opposed to electronic publications. In this connection, except the evidence that the manuals in issue were available for sale through the Licensee’s website, there is no indication in the evidence that would lead me to infer that such manuals were also distributed in the form of e-communications as were newsletters.

[58] Based on the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act in association with “Electronic publications, namely magazines and manuals featuring content related to physical fitness instruction and consulting in the field of health and wellness”. As there is no evidence of special circumstances excusing non-use, these goods will be deleted from the registration.

Goods (4), (5) and (8) – Exercise equipment, Clothing and Gymnastic and sporting articles

[59] For “Exercise equipment, namely an apparatus with a movable carriage for use in stretching and strengthening exercises, chairs, stretch bars, exercise cords and bands, handles and straps for exercise equipment” from goods (4), “Clothing, namely, athletic wear” from goods (5) and “Gymnastic and sporting articles, namely fitness and yoga mats, exercise balls and balance balls, exercise blocks, bags and straps specifically adapted for sports equipment, gym bags and tote bags, neck pillows, backpacks and water bottles” from goods (8), the Tran affidavit is silent and does not specifically provide evidence relating to any of these goods.

[60] Accordingly, the Owner fails to meet its *prima facie* burden of showing use of the Mark. As there is no evidence of special circumstances excusing non-use, these goods will be deleted from the registration.

Goods (9) – Fitness journals

[61] With respect to goods (9), “Fitness journals that provide individuals with customized pages to track their progress and achieve fitness goals”, I find that the “30 day workout challenge” attached as Exhibits F and M is not a journal, but rather a schedule as Ms Tran referred to it herself at paragraph 26 of her affidavit.

[62] In any event, in the *Canadian Oxford Dictionary*, 2nd Ed., the word “journal” is defined as “*noun* 1. a daily record of events; a diary. 2. a periodical, esp. an academic one dealing with a specialized subject”. Neither of these descriptions, in my view, is descriptive of the “30 day workout challenge” in issue.

[63] Consequently, I am not satisfied that the Owner has demonstrated use of the Mark in association with “Fitness journals that provide individuals with customized pages to track their progress and achieve fitness goals” within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances excusing non-use, these goods will be deleted from the registration.

The Registered Services

Services (2), (3) and (14) – Electronic mail services, Franchising services and Web hosting services

[64] For “Electronic mail services through wired and wireless access, wireless digital messaging services” from services (2), “Franchising services namely, offering business management and technical assistance in the establishment, operation and marketing of exercise studios, training and retraining of teachers, providing on-going advice on the teaching of the program of the applicant's exercise methods” from services (3) and “Web hosting services, namely designing websites and creating social media accounts” from services (14), the Tran affidavit is silent and does not specifically provide evidence relating to any of these services.

[65] Accordingly, the Owner fails to meet its *prima facie* burden of showing use of the Mark. As there is no evidence of special circumstances excusing non-use, these services will be deleted from the registration.

Services (11) – Sporting activities

[66] In the context of services (11), “Sporting activities, namely the organization, supervision and administration of running clubs and clinics”, as discussed in the evidence summary, Ms. Tran relies on a promotional advertisement depicting a number of activities performed in United States, Mexico and Canada [Exhibit N].

[67] It is well established that use of a trademark on advertising in Canada of services only available elsewhere does not satisfy the provisions of section 4(2) of the Act [see *Porter v Don the Beachcomber* (1966), 48 CPR 280 (ExCt)].

[68] Applying this principle to the present case, it is clear that the evidenced activities referencing United States and Mexico do not constitute performance of the services in Canada.

[69] As for the live events which took place in Canada, I find that there is a distinction between simply organizing, supervising and administering live teacher trainings, pre-choreographed workout classes or live exams and actually engaging into “the organization, supervision and administration of running clubs and clinics”. Moreover, given the very specialized nature of activities carried out in a running club and a running clinic, nothing in the evidence leads me to infer that the Licensee would be engaged into the organization, supervision and administration of running clubs and clinics.

[70] As such, I am not satisfied that the Owner has demonstrated use of the Mark with the registered services “Sporting activities, namely the organization, supervision and administration of running clubs and clinics” within the meaning of sections 4 and 45 of the Act in association. As there is no evidence of special circumstances excusing non-use, these services will be deleted from the registration.

Services (15): Consulting Services in the field of nutrition

[71] Based on my finding at paragraph 36 above, I must conclude that the evidence does not establish use of the Mark within the meaning of sections 4 and 45 of the Act in association with “Consulting Services in the field of nutrition”. As there is no evidence of special circumstances excusing non-use, these services will be deleted from the registration.

Services (17): On-line retail store services featuring fitness apparel, exercise equipment

[72] For the principle that online retailer’s activities must demonstrate “a certain level of interactivity with potential Canadian customers” in order for there to be a “benefit to Canadians sufficient to support such a registration” [*Lapointe Rosenstein supra*], I find that no indicia was contained in the Licensee’s website to suggest that retail department store services were

available to consumers in Canada during the relevant period for fitness apparel or exercise equipment. In any event, Ms. Tran makes no mention of these goods in her affidavit.

[73] Consequently, I am not satisfied that the Owner has demonstrated use of the Mark in association with “On-line retail store services featuring fitness apparel, exercise equipment” within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances excusing non-use, these services will be deleted from the registration.

DISPOSITION

[74] Based on the above findings, 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 terms:

GOODS

- (1) ... pre-recorded cassette tapes, pre-recorded compact discs, ..., pre-recorded phonograph records, pre-recorded audio and video tapes, ...
- (3) ... magazines, manuals ...
- (4) Exercise equipment, namely an apparatus with a movable carriage for use in stretching and strengthening exercises, chairs, stretch bars, exercise cords and bands, handles and straps for exercise equipment.
- (5) Clothing, namely, athletic wear.
- (8) Gymnastic and sporting articles, namely fitness and yoga mats, exercise balls and balance balls, exercise blocks, bags and straps specifically adapted for sports equipment, gym bags and tote bags, neck pillows, backpacks and water bottles.
- (9) Fitness journals that provide individuals with customized pages to track their progress and achieve fitness goals.

SERVICES

- (1) ... seminars, lectures, conferences and tradeshow
- (2) Electronic mail services through wired and wireless access, wireless digital messaging services.
- (3) Franchising services namely, offering business management and technical assistance in the establishment, operation and marketing of exercise studios, training and retraining of teachers, providing on-going advice on the teaching of the program of the applicant's exercise methods.
- (6) ..., seminars ...
- (7) ..., nutrition, ...
- (10) ..., nutrition ...
- (11) Sporting activities, namely the organization, supervision and administration of running clubs and clinics
- (14) Web hosting services, namely designing websites and creating social media

accounts.

(15) ..., nutrition ...

(17) ... fitness apparel, ..., exercise equipment ...

[75] The statement of goods and services will now read as follows:

GOODS

(1) Audio recordings, video recordings and audio-visual recordings, namely pre-recorded DVDs featuring fitness and health club related programs, training materials and music related to fitness programs.

(2) Computer database management software used for fitness and health club related programs and training materials.

(3) Electronic publications, namely newsletters featuring content related to physical fitness instruction and consulting in the field of health and wellness.

(6) Instructional and teaching material, namely user manuals, instructional books, questionnaires, pamphlets, periodicals, reports, manuals, guides, handbooks, notepads and postcards.

(7) Applications for mobile and tablet devices, namely operating systems featuring exercise programs and providing information on health and fitness” from goods” from goods.

SERVICES

(1) Education services, namely conducting health and fitness courses.

(4) Health club services; fitness club services; exercise instruction, producing and conducting personal training programs and services.

(5) Instructor certification services and programs, namely teacher training workshops in the field of physical fitness instruction.

(6) On-line retail store services featuring DVDs; providing online registration for fitness certification programs and workshops.

(7) Operating a website providing information, news, editorials and opinions in the fields of health, physical fitness and lifestyle.

(8) Producing and conducting exercise programs and classes.

(9) Providing materials pertaining to exercise classes, namely class schedules, class cards and business cards.

(10) Recreation services, namely providing classes, programs, personal training and retreats in the field of health and physical fitness.

(12) The operation of exercise studios.

(13) Webcasts, podcasts and newscasts pertaining to consulting services in the field of physical fitness instruction and health and wellness.

(15) Consulting services in the fields of health, physical fitness and well-being.

(16) Electronic distribution of information namely, creation, production and providing access to online databases and information via internet and wide area computer networks on health and fitness.

(17) On-line retail store services featuring books and membership to website contents; providing online registration services for health and fitness coaching and personal training services.

Yves Cozien Papa Tchoufou
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

Miltons IP/P.I.

For the Registered Owner

Gowling WLG (Canada) LLP

For the Requesting Party