



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 262

Date of Decision: 2022-12-21

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Future Living Developments Ltd.

Registered Owner: International Living Future Institute

Registration: TMA826,089 for LIVING FUTURE

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. TMA826,089 for the trademark LIVING FUTURE (the Mark).

[2] The statement of goods and services is reproduced below:

GOODS

(1) Printed materials, namely, booklets, programs, flyers, newsletters, brochures and pamphlets, and promotional materials, namely, binders, notepads, postcards, and writing instruments, and other items, namely, novelty items, namely, coffee mugs, in the field of consultancy and academic / educational services relating to sustainable development including design, construction, maintenance, and operations, energy efficiency in buildings, energy consumption and energy management, environmental quality of buildings, namely, environmental and building assessment, compliance, and planning,

engineering and / or architectural design, and the research and development of standards and technology thereof; apparel and clothing, namely, t-shirts, sweatshirts, jackets, and hats, in the field of consultancy and academic / educational services relating to sustainable development including design, construction, maintenance, and operations, energy efficiency in buildings, energy consumption and energy management, environmental quality of buildings, namely, environmental and building assessment, compliance, and planning, engineering and / or architectural design, and the research and development of standards and technology thereof.

(2) Apparel and clothing, namely, t-shirts, sweatshirts, jackets, and hats.

SERVICES

(1) Consultancy and academic / educational training and instruction relating to sustainable development including design, construction, maintenance, and operations, energy efficiency in buildings, energy consumption and energy management, environmental quality of buildings, namely, environmental and building assessment, compliance, and planning, engineering and / or architectural design, and the research and development of standards and technology thereof; consultancy and academic / educational services relating to sustainable development including design, construction, maintenance, and operations, energy efficiency in buildings, energy consumption and energy management, environmental quality of buildings, namely, environmental and building assessment, compliance, and planning, engineering and / or architectural design, and the research and development of standards and technology thereof.

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

THE PROCEEDING

[4] At the request of Future Living Developments Ltd. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on December 20, 2019, to Cascadia Region Green Building Council (Cascadia), the registered owner of the Mark at that time.

[5] The notice required the registered owner to show whether the Mark was 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 the Mark 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 December 20, 2016 to December 20, 2019.

[6] Use is defined 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.

4(3) A trademark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

[7] Where the registered owner has not shown “use”, the registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[8] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although 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)], 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)].

[9] Subsequent to the issuance of the notice, the Registrar recorded a change in title of the registration from Cascadia to International Living Future Institute (the Owner), as noted further below.

[10] In response to the Registrar’s notice, the Owner furnished the affidavit of Alexandra Stoneham, sworn January 19, 2021 in Portland, Oregon.

[11] Neither party filed written representations. Only the Owner was represented at an oral hearing.

EVIDENCE SUMMARY

[12] Ms. Stoneham identifies herself as the Executive Assistant to the CEO of the Owner. She states that Cascadia assigned the Mark to the Owner on April 28, 2015, and attaches a Confirmatory Assignment Agreement dated January 15, 2021 [para 2 and Exhibit A]. Although Ms. Stoneham does not describe the Owner or its activities directly, I note that the Owner is profiled in one of the exhibits, in part, as follows:

[The Owner] offers global strategies for lasting sustainability, partnering with local communities to create grounded and relevant solutions, including green building and infrastructure solutions on scales ranging from single room renovations to neighbourhoods or whole cities. [Exhibit D]

[13] Ms. Stoneham attests that, since at least as early as December 2006, the Mark has been in use continuously in Canada, either by the Owner or Cascadia, in association with all of the registered services and, of the registered goods, “Printed materials, namely, booklets, programs, flyers, newsletters, brochures and pamphlets ...” only [paras 4 and 5]. Ms. Stoneham does not assert use of the Mark with respect to any of the “promotional items”, “novelty items” or “apparel and clothing” goods specified in the registration.

[14] In support of her assertion of use, the following relevant exhibits are attached to Ms. Stoneham’s affidavit:

- Exhibit B consists of four screenshots from the Owner’s website, *living-future.org*. Ms. Stoneham explains that these screenshots show sustainability “Case Studies of Certified Projects” in Canada for the “Eco-Sense Residence Victoria”, “VanDusen Botanical Garden Visitor Centre”, “UniverCity Childcare Centre” and “Bill Fisch Forest Stewardship and Education Centre” [para 6]. Ms. Stoneham provides the date of publication of each of these case studies; I note that only the “Bill Fisch Forest Stewardship and Education Centre” project was published during the relevant period, whereas the other three were first published prior to the relevant period. The exhibited screenshot relating to the Bill Fisch Forest project describes that case study as “designed to be an integral part of one of the most successful forest regeneration projects in the world with the purpose of

helping residents of York-Region”. I note that the webpage header of each case study displays the Mark as part of the logo shown below (the Living Future Logo):



- Exhibits D, E, G and H relate to a book titled “Building Community: Defining, Designing, Developing UniverCity”, including a one-page printout from the book; a “Press/Pitch” promotional document; a printout from the Owner’s bookstore, *www.store.living-future.org*, showing the book available for sale; and an invoice issued to the Owner for “printing 838 copies” of the book. The Living Future Logo appears on the printout, promotional material and website; however, I note that there is no evidence or statement relating to any sales or transfers of the book.
- Exhibits J, K and L consist of “printed program booklets” for three “Living Future” conferences which took place in United States during the relevant period, including copies of several documents which “were used to advertise” each of these conferences, as well as samples of printed signage that “were posted throughout the conferences” and records of registrants “who lived and/or worked in Canada and attended the conferences” [paras 14 to 16]. For illustrative purposes, Exhibit J relates to the Living Future conference held in Seattle in May 2017. “Living Future®” is displayed on the first page of the exhibited program booklet and throughout the exhibited advertising and promotional material related to the conference. The exhibited materials show that the conference included education sessions on topics such as “The ILFI Net Zero Energy Program Reboot”, and “Getting to Net Positive Water Summit: Innovative Strategies and Policy for Cascadia and Beyond”. Additionally, the last two pages of Exhibit J lists 41 Canadians as having attended the conference.
- Exhibit M relates to an October 2017 symposium co-organized by the Owner and Passive House Canada at the University of British Columbia, and includes the following materials: a copy of the Memorandum of Understanding between both

entities for the delivery of the “Net Positive Symposium 2017”; a media kit which Ms. Stoneham attests was distributed to advertise the symposium; a flyer for prospective sponsors of the symposium; a copy of a sign that was printed and displayed at the event; and a list of attendees who registered for the event [para 17]. The memorandum references and describes the Owner’s “Living Building Challenge” certification program as a “unified tool for regenerative design” comprised of seven performance areas, including site, water, energy, health, materials, equity and beauty. The Living Future Logo appears on the memorandum, media kit, flyer and sign. In addition to the Living Future Logo, the memorandum and the flyer also display the logo of the symposium’s co-organizer, Passive House Canada.

- Exhibit N relates to a November 2019 symposium co-organized by the Owner and Passive House Canada at the University of British Columbia, including a screenshot from the Owner’s website and printouts of the symposium’s keynote presentation. The exhibited screenshot displays details of the “Net Positive Symposium 2.0”, describing the goal of the symposium as addressing “the rapidly changing state of the building industry through the lens of Passive House Canada and the International Living Future Institute”. A “Register Now” button is shown on the page, which also displays the Living Future Logo. Ms. Stoneham attests that the symposium was advertised on the Owner’s website in October 2019 [para 18]. The exhibited presentation printouts generally refer to the Owner’s “Living Building Challenge” as well as “Zero Energy Certification” and “Zero Carbon Certification”, and display the Living Future Logo. In addition to the Living Future Logo, the presentation printouts also display the logos of the symposium’s co-organizer, Passive House Canada.
- Exhibit O consists of a copy of a January 2017 invoice for the Owner’s “Living Building Challenge Certification Fee”, billed to the Regional Municipality of York, in Ontario. The Living Future Logo appears at the top of the invoice.
- Exhibit S consists of a list of webpage links to the Owner’s website, which Ms. Stoneham attests are for programs “promoted and marketed worldwide, including Canada, under the ‘Living Future’ umbrella” and were made available

as digital booklets on the Owner's website during the relevant period [para 23]. I note, for example, that Ms. Stoneham explains that the "Zero Carbon Certification" program was developed by the Owner in 2018 "to directly address the building sector's role in the global climate crisis" and to establish "a scalable pathway to a carbon-positive building sector to reverse climate change and ensure global communities thrive" [para 23].

- Exhibit T consists of two copies of newsletters relating to the "Living Future 20" conference. Ms. Stoneham states that these newsletters were sent to the Owner's mailing list, and confirms that, as of December 2019, such mailing list included 2,813 recipients in Canada [para 24].

[15] In addition, Ms. Stoneham provides a Google Analytics report for the Owner's website showing that 91,858 visitor sessions were from users in Canada during the relevant period [Exhibit R].

[16] Finally, with respect to advertising of the educational events and programs available on the Owner's website, Ms. Stoneham states that, between August 2018 and December 2019, the Owner spent over \$6,200 on LinkedIn to drive traffic to such events and programs, and she attaches a screenshot from a LinkedIn webpage showing that 3% of the Owner's LinkedIn audience was from users located in Canada [para 20 and Exhibit P].

ANALYSIS AND REASONS FOR DECISION

[17] At the outset, I note that I accept the display of LIVING FUTURE in the Living Future Logo reproduced above as constituting display of the Mark as registered. In this respect, LIVING FUTURE appears in greater prominence, different font style and colour than the surrounding matter [see *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)].

Use of the Mark in association with the Registered Services

[18] At the hearing, the Owner submitted that, in view of the Canadians who attended the Living Future conferences in the United States, it is fair to say that they would have

registered from, and received program materials and related information, in Canada before crossing the border to attend the conferences. Additionally, the Owner identified the Exhibit M memorandum and the Exhibit N presentation printouts relating to the symposiums held at the University of British Columbia as illustrative of the nature and scope of the services performed by the Owner during the relevant period.

[19] In the present case, Ms. Stoneham does not provide clear details regarding the Owner's business and normal course of trade, nor does she clearly correlate the evidenced activities with particular registered services. Rather, the exhibits are largely left to speak for themselves. Nevertheless, I am mindful of the principle that services are to be construed liberally in a section 45 proceeding, and that reasonable inferences can be made from the evidence provided [*Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64]. As such, I accept that, at a minimum, the exhibited material relating to the symposiums held at the University of British Columbia show that the Owner provided expertise and training on various programs it has put in place pertaining to sustainable development in order to, for example, "establish a scalable pathway to a carbon-positive building sector" [para 23; Exhibits M, N and S].

[20] As such, I am satisfied that the evidenced services fall within the ambit of the services as registered, namely "Consultancy and academic / educational training and instruction relating to sustainable development ..." and "consultancy and academic / educational services relating to sustainable development ...", relating to the areas further specified in the statement. In this respect, I interpret the statement of services to encompass "consultancy and academic/educational training and instruction services", and the nominally broader "consultancy and academic/educational services", both relating to various aspects of sustainable development. In addition, I do not interpret the statement of services as the provision of, for example, "research and development of standards and technology" *per se*, but rather simply the provision of consultancy and/or educational services related to such, in the field of "sustainable development".

[21] That said, the evidence clearly shows that media kits and flyers were distributed to prospective attendees and sponsors in Canada, that the Owner promoted its

consultancy, training and related activities through its website, and that Canadians had access to that website, all during the relevant period [Exhibits M, N, S and R]. Each of the materials prominently displayed the Mark. As such, in view of Ms. Stoneham's sworn statements, at a minimum, I am satisfied that the exhibited materials relating to the Owner's symposiums, constitute advertisement of the registered services in association with the Mark.

[22] Finally, the evidence shows that not only were the Owner's services advertised, they were also performed in Canada by the Owner during the relevant period in association with the Mark. In this regard, in addition to organizing symposiums, the Owner also engaged in sustainability projects in Canada and provided its consultancy and training services in the course of these projects as evidenced in the Exhibit B screenshot relating to the "Bill Fisch Forest" project and the Exhibit O invoice to the Regional Municipality of York.

[23] The Owner also developed various programs intended to "address the building sector's role in the global climate crisis" and establish "a scalable pathway to a carbon-positive building sector to reverse climate change and ensure global communities thrive" [para 23; Exhibit S]. These programs were made available to Canadians through the Owner's website, and I consider such distribution to be within the scope of the provision of academic and educational training relating to sustainable development, as registered.

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

Use of the Mark in association with the Registered Goods

[25] As noted above, Ms. Stoneham does not assert use of the Mark in association with any of the "promotional materials" or "novelty items" from goods (1), or "apparel and clothing" in goods (1) or (2). Indeed, I am not satisfied that the evidence demonstrates use of the Mark in association with any such goods.

[26] With respect to the “printed materials, namely booklets” from goods (1), at the hearing, the Owner correlated such goods with the “Building Community” book referred to at Exhibits D, E, G and H.

[27] However, while Ms. Stoneham provides details regarding the publication, promotion and availability of the book during the relevant period, she does not actually state that any copies were transferred or sold to customers in Canada, nor does she provide any evidence of transfers of the book whatsoever. It is insufficient for a registered owner to show that goods were available for sale in Canada during the relevant period; some evidence of a transfer in the normal course of trade in Canada is required [see *John Labatt*, supra; see also *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79].

[28] In this case, there is insufficient evidence to permit me to draw the inference that this book was actually sold in the normal course of trade in Canada during the relevant period, nor is there any clear evidence that the book was exported from Canada during such period.

[29] With respect to the remaining “printed materials” from goods (1), namely, “programs”, “flyers”, “newsletters”, “brochures” and “pamphlets”, at the hearing, the Owner submitted that the program booklets (Exhibits J, K, L and S) and the newsletters (Exhibit T) evidence use of the Mark in association with such printed materials.

[30] However, it has been held that the free distribution of a good merely to promote one’s own brand does not constitute a transfer in the normal course of trade [see, for example, *Smart & Biggar v Sutter Hill Corp*, 2012 TMOB 12; and *Riches, McKenzie & Herbert LLP v Park Pontiac Buick GMC Ltd* (2005), 50 CPR (4th) 391 (TMOB)]. For the free distribution of a good to qualify as a transfer in the normal course of trade, the evidence must show that the good was delivered, not merely as a means of promoting other products or services, but as an object of trade in itself, leading to some kind of payment or exchange for such goods or in anticipation of securing future orders of those goods.

[31] In this case, it is at best not clear whether such printed materials were distributed as objects of trade in and of themselves [see *CHR Holdings Inc v Release the Hounds*, 2017 TMOB 170; and *Bremont Watch Company Limited v Bremont Homes Corporation*, 2016 TMOB 102].

[32] Accordingly, I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the registered goods within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances excusing such non-use of the Mark before me, the registration will be amended accordingly.

DISPOSITION

[33] In view of all 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 the statement of goods in its entirety.

[34] The statement of services will remain as registered.

Yves Cozien Papa Tchoufou
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2022-08-09

APPEARANCES

For the Requesting Party: No one appearing

For the Registered Owner: David Schnurr

AGENTS OF RECORD

For the Requesting Party: Cameron IP

For the Registered Owner: Miller Thomson LLP