



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 118

Date of Decision: 2023-07-12

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Smart & Biggar LLP

Registered Owner: Canadian Tire Corporation, Limited

Registration: TMA435,774 for ROGUE

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. TMA435,774 for the trademark ROGUE (the Mark), owned by Canadian Tire Corporation, Limited (the Owner).

[2] The Mark is registered for use in association with “Bicycles”.

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

THE PROCEEDING

[4] At the request of Smart & Biggar LLP (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on December 9, 2020.

[5] The notice required the Owner to show whether the Mark had been used in Canada in association with the goods 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 use since that date. In this case, the relevant period for showing use is December 9, 2017 to December 9, 2020. In the absence of use, the registration is liable to be expunged, unless the absence of use is due to special circumstances.

[6] The relevant definition of use is set out in section 4(1) 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.

[7] It is well accepted 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 Mark in association with the goods specified in the registration during the relevant period.

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Brendon Arnold, the Associate Vice President, Brand Management of the Owner, sworn on July 7, 2021, together with Exhibits A to K.

[9] Both parties filed written representations and were represented at the hearing.

THE EVIDENCE

[10] Mr. Arnold explains that the Owner acquired the registration for the Mark and numerous other bicycle brands from Raleigh Canada Limited (Raleigh), an unrelated entity, on or around July 26, 2019 pursuant to the terms of “an arms length asset purchase transaction” (the Acquisition). The change of title was recorded by the Registrar on September 11, 2019. Mr. Arnold states that the Owner does not have any records relating to the use of the Mark by Raleigh during the relevant period prior to the Acquisition [para 4].

[11] Mr. Arnold states that the Owner’s Canadian Tire brand is one of Canada most recognized and iconic retailers. There were 504 Canadian Tire retail stores located across Canada at the end of 2020 [para 5].

[12] Mr. Arnold explains that Canadian Tire retail stores are operated by independent third parties known as associate dealers (the Dealers). The relationship between the Owner and each of the Dealers is governed by a contract whereby the Dealers agree to comply with policies, marketing plans and operating standards and trademark licence prescribed by the Owner, which include purchasing merchandise primarily from the Owner. The Owner performs a variety of functions to support the Dealers, including category business management, marketing and product curation and distribution [paras 6-7].

[13] Mr. Arnold further explains that many of the products curated and distributed by the Owner are its own private label branded products (the Owned Brands) including private label bicycle products such as the ROGUE bicycles. He states that as part of the normal course of trade for the Owned Brands, the Owner’s in-house product team works with external consultants and contractors to design, develop and manufacture products. The Dealers order the Owned Brands products from the Owner, who in turn orders products from its product suppliers and coordinates distribution of the products to individual Dealers for sales at Canadian Tire stores [para 8].

[14] Mr. Arnold states that the Owner also offers online shopping through its website, at *www.canadiantire.ca*, and its mobile application. The fulfilment of online orders is

performed out of Canadian Tire retail stores and out of the Owner's owned distribution centres [para 9].

[15] Mr. Arnold states that at all times after the Acquisition, the Owner has had and maintained the intention to use the Mark in association with bicycles. He explains that the scale of the Acquisition required a significant time investment to review each asset and incorporate it into the Owner's existing intellectual property portfolio and brand strategy [para 10].

[16] Mr. Arnold outlines in his affidavit the steps taken by the Owner during the relevant period in respect of the research and design, development, manufacturing, marketing, and sales of ROGUE bicycles. In summary, Mr. Arnold asserts the following [paras 11 to 19]:

- In or around February 20, 2020, the Owner's internal product development team commenced development of bicycles bearing the Mark.
- On or around March 3, 2020, the Owner worked with its third party supplier (the Supplier) to have an existing bicycle model that was already in development to instead be branded with the Mark. A redacted and excerpted copy of relevant correspondence is attached as Exhibit C to the affidavit.
- The COVID-19 pandemic significantly impacted the Owner's standard timelines for the manufacturing of bicycles. For instance, the April 2020 sourcing trip of the product development team to China needed to be delayed, which in turn delayed the Owner's product development cycle. The Owner also struggled to stay in-stock as the Chinese government extended factory closures for an additional two months after the Chinese New Year. A redacted excerpt of the Owner's seasonal deal letter dated October 7, 2020 (the Deal Letter) referencing the Owner's stay in-stock difficulties is attached as Exhibit D to the affidavit. The COVID-19 pandemic also prevented the Owner from holding in 2020 its annual "product parade", which is an exhibition trade show where Dealers are invited to view, order

and purchase goods. Third-party suppliers are also typically invited to the annual “product parade”.

- In or around May 2020, the Supplier completed development of its first ROGUE bicycle model; the first sample product was available for in-person review by the Owner’s product development team on or around June 19, 2020. A photograph, provided by the Supplier, and a design file used to create the product depicting the Mark on the bicycle are attached at Exhibit E to the affidavit. According to Mr. Arnold’s statement, the exhibited depiction of the Mark is an accurate representation of how the Mark appeared on the bicycles in Canada throughout the relevant period and up to the date of his affidavit.
- In or around September 2020, the Owner issued a seasonal catalogue to its Dealers which contain images and specifications of the Owner’s seasonal bicycle products. Excerpts of the catalogue “BIKES 2021 A Bike for Every Rider” containing an image and the specifications of the ROGUE bicycle model are attached as Exhibit F to the affidavit.
- On October 7, 2020, the Owner issued the Deal Letter to its Dealers soliciting their bicycle orders by November 15, 2020 in order to be fulfilled prior to Spring 2021. Redacted excerpts of the Deal Letter attached as Exhibit G to the affidavit reference the Acquisition and depict the “Raleigh Rogue 4.0 Fat Tire Hardtail Mountain Bike”.
- In response to the Deal Letter, the Owner received approximately 765 orders for the ROGUE bicycle model in October and November 2020. A listing of the total number of orders received from Dealers as of June 29, 2021 (approximately 1328) is attached as Exhibit H to the affidavit.
- Purchase orders were issued to the Supplier by the Owner during the relevant period in anticipation of and to fulfill orders received in response to the Deal Letter. Orders placed with the Supplier were delivered directly to Dealer locations and to the Owner’s distribution centers. A representative redacted purchase order dated September 10, 2020 is attached as Exhibit I to the affidavit.

[17] Finally, Mr. Arnold provides: (i) a screenshot of the Owner’s website showing the listing of the ROGUE bicycle on the Owner’s website on or around February 2021 [para 20, Exhibit J]; and (ii) excerpts of the Owner’s records detailing the volume of retail and online sales of ROGUE bicycles in Canada as of June 29, 2021 (196 bicycles sold at retail and 48 bicycles sold on-line). The first sales occurred during the week of March 15, 2021 [para 21, Exhibit K].

THE PARTIES’ REPRESENTATIONS

[18] I am providing an overview of the parties’ written and oral representations, which I will address further in the analysis below.

The Requesting Party

[19] As simply put in paragraph 3 of its written representations, the Requesting Party contends that the Owner “bought a stale trademark, failed to promptly put it in use, and is now improperly trying to mask its lack of action by relying upon COVID as a special circumstance to justify non-use of the Mark”.

[20] The Requesting Party’s supporting representations can be summarized as follows:

- Neither the orders placed by Dealers between October 7 and November 15, 2020, nor the Owner’s issuance of purchase orders to its Supplier during the relevant period constitute use of the Mark in association with bicycles.
- Contrary to the Act, the Owner did not provide the date of last use of the Mark.
- It is improper to “re-set” the date of last use to the date of the assignment.
- Special circumstances justifying non-use of the Mark during the relevant period have not been demonstrated, including from the date of the assignment.
- The COVID-19 pandemic does not qualify as a special circumstance justifying non-use. Even if the pandemic could potentially qualify as a

special circumstance, the evidence does not establish how the pandemic translated into delays justifying non-use during the relevant period.

The Owner

[21] As also simply put in paragraph 8 of its written representations, the Owner contends that the Requesting Party “is seeking to distort [section 45 of the Act] and associated legal principles, many of which are settled law, all with a view to depriving the [Owner] of trademark rights recently acquired and responsibly used”.

[22] The Owner submits that its evidence establishes use of the Mark during the relevant period in the normal course of trade in respect of bicycles in that: (i) its normal course of trade consists of a purchasing cycle that spans over the years; (ii) the Mark was affixed to bicycles that were ordered by Dealers; (iii) the Owner committed to the manufacture and delivery of ROGUE bicycles during the relevant period; and (iv) ROGUE bicycles were delivered to Dealers and ultimately sold to end consumers.

[23] Alternatively, the Owner submits that its evidence establishes the existence of special circumstances excusing non-use of the Mark in that the Owner: (i) acquired the Mark approximately two years into the relevant period; and (ii) promptly undertook steps to use the Mark in time of a global pandemic.

ANALYSIS AND REASONS FOR DECISION

[24] I note from the outset that it is not necessary to discuss at length the Requesting Party’s representations that there is no evidence that orders were placed by Dealers during the relevant period.

[25] Indeed, as rightly argued by the Owner, absent evidence to the contrary, an affiant’s statements are to be accepted at face value and must be accorded substantial credibility in a section 45 proceeding [*Oyen Wiggs Green & Mutala LLP v Atari Interactive Inc*, 2018 TMOB 79 at para 25]. I see no reasons in this case not to accept at face value Mr. Arnold’s statement that the Owner received approximately 765 orders for the ROGUE bicycle model from the Dealers in October and November 2020.

[26] Likewise, I can conclude from the evidence that the Mark was associated with the bicycles at the time of their transfer of property, as required by section 4(1) of the Act.

[27] Thus, the first issue to be considered is whether the placing of orders by Dealers in October and November 20, 2020 followed by the sales of ROGUE branded bicycles during the week of March 11, 2021 constitute use of the Mark during the relevant period ending December 9, 2020.

Use in the Normal Course of Trade

[28] Relying upon the case of *Ogilvy Renault LLP v Trade-Link Group*, 2009 CanLII 82156 (TMOB), the Owner argues that a commitment to purchase during the relevant period has been accepted by the Registrar as sufficient to show use where the normal course of trade consists of a purchasing cycle that spans over the years. The Owner submits that the timeframe in that case is similar to the present case.

[29] In *Trade-Link*, the registered owner's licensee, Cintex, secured a purchasing commitment from a large national retailer (coincidentally the Owner) prior to the section 45 notice date and had the requisite products manufactured for delivery after the relevant period. The Owner stresses the following finding of the Registrar:

17. I am satisfied that the events described by the affiant took place in the normal course of trade. I find it entirely reasonable that large retailers such as Canadian Tire would have a purchasing cycle that spans over a year, and that suppliers such as Cintex, might not manufacture their goods without the commitment to purchase of a large retailer. Moreover, I note that the Federal Court has previously accepted use under subsection 4(1) where acceptance of an order for wares was made by the registrant during the relevant period but delivery of those wares took place outside of it (*ConAgra Foods, Inc. v. Fetherstonhaugh & Co.* (2002), 23 C.P.R. (4th) 49 (F.C.T.D.)). [...]

[30] The Requesting Party submits that *Trade-Link* was wrongly decided. It argues that the Federal Court in *Estee Lauder Cosmetics Ltd v Loveless*, 2017 FC 927, clearly stated that transfer of property in the goods is required in order to constitute use.

[31] In reply, the Owner submits that "*Estee Lauder* was decided prior to the Federal Court of Appeal's express recognition, in [*Cosmetics Warriors Limited v Riches*

McKenzie Herbert LLP, 2019 FCA 48], that section 4(1) of the Act should not rigidly or precisely interpreted outside of the appropriate commercial context”. Further, the Owner submits that neither the *Trade-Link* decision nor the relevance of a purchasing cycle that spans over the years was discussed by the Court in *Estee Lauder*.

[32] The issue in *Cosmetics Warriors Limited, supra*, was whether the transfer of trademarked goods needed to be made at a profit to constitute a transfer in the normal course of trade. I do not read that decision as suggesting that “use” of a trademark in the normal course of trade does not require transfer of property in the goods.

[33] Furthermore, as rightly argued by the Requesting Party at the hearing, the findings of Justice McKay in *ConAgra* (referenced in *Trade-Link*) were discussed in *Estee Lauder* [paras 26-31] together with the findings of Justice Annis in the section 45 case of *Ridout & Maybee LLP v HJ Heinz Company Australia Ltd*, 2014 FC 442. Ultimately, Justice Diner in *Estee Lauder* held that a substantial order placed and confirmed before the date of the section 45 notice did not constitute use because there was no evidence that the property in the goods was transferred within the relevant period. In reaching this conclusion, Justice Dinner made the following comments:

[32] On this Application, the Applicant urges me to distinguish *Heinz* and apply *ConAgra* to find that the Order Flows, which were sent to HBC before the expiry of the Relevant Period, were in and of themselves “use” at the relevant time because they were eventually followed by delivery of the ENLIGHTEN Goods in September 2014.

[33] I cannot accept the Applicant’s argument with the principles enunciated in the case law above in mind. These principles are succinctly summarized in a leading text: “[e]ntering into an agreement or placing an order for wares is not considered use; use will not occur until the wares have had a transfer of possession” (*Fox on Canadian Law of Trade-marks and Unfair Competition*, 4th ed loose-leaf Toronto: Carswell, 2002, at 3-56 ...).

[34] In the present case, the evidence is that orders for the goods were placed during the relevant period but that the transfer of possession took place outside the relevant period. Accordingly, I am not satisfied that the Owner has established use of the Mark in association with bicycles within the meaning of sections 4(1) and 45 of the Act.

[35] Thus, the next issue to be considered is whether special circumstances existed to excuse non-use of the Mark during the relevant period.

Special Circumstances

[36] The general rule is that absence of use will be penalized by expungement, but there may be an exception where the absence of use is excusable due to special circumstances [section 45(3) of the Act; *Smart & Biggar v Scott Paper Ltd*, 2008 FCA 129 [*Scott Paper 2008*].

[37] To determine whether special circumstances have been established, the Registrar must first determine, in light of the evidence, why in fact the trademark was not used during the relevant period. Second, the Registrar must determine whether these reasons for non-use constitute special circumstances [per *Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA)]. The Federal Court has held that special circumstances mean circumstances or reasons that are “unusual, uncommon, or exceptional” [*John Labatt Ltd v Cotton Club Bottling Co* (1976), 25 CPR (2d) 115 (FCTD) at para 29].

[38] If the Registrar determines that the reasons for non-use constitute special circumstances, the Registrar must still decide whether such special circumstances *excuse* the period of non-use. This involves the consideration of three criteria: (i) the length of time during which the trademark has not been in use; (ii) whether the reasons for non-use were beyond the control of the registered owner; and (iii) whether there exists a serious intention to shortly resume use [per *Harris Knitting Mills, supra*]. All three criteria are relevant, but satisfying the second criterion is essential for a finding of special circumstances *excusing* non-use [per *Scott Paper 2008, supra*].

[39] As discussed hereafter, I am satisfied that the Owner has established that there were special circumstances excusing non-use of the Mark in association with bicycles within the meaning of section 45(3) of the Act.

Length of time during which the Mark has not been in use

[40] The Requesting Party's representations with respect to this criterion may be summarized as follows:

- The Owner has failed to provide the date of last use of the Mark in Canada, as required by section 45(1) of the Act and so it has failed to adequately respond to the notice forwarded by the Registrar (citing *Fox on Canadian Law of Trade-marks and Unfair Competition*, 4th ed (Carswell: 2021) at 11.2(f)(iii); *Re Black Angus Franchise Systems, Inc* (1975), 29 CPR (2d) 171 (Registrar of Trademarks), and *Re Société de fabrication et de distribution de parfumerie et cosmétiques Diparco SA* (1975), 29 CPR (2d) 229 (Registrar of Trademarks) [*Diparco*]).
- Although there have been cases in which an assignment has been treated as a “re-set” button for the purposes of section 45(1) of the Act, this is contrary to the plain language of the Act (citing *Dentons Canada LLP v CanWhite Sands Corp*, 2020 TMOB 95 at para 31).
- Even if one were to ignore the plain language of the Act, in the circumstances of this case, the mere statement that the Owner does not have any records relating to the use of the Mark by its predecessor in title does not justify any “re-setting” of the period of non-use of the Mark to the date of the assignment (citing *Diparco, supra*, where the registration was assigned 18 months before the commencement of the relevant period and where the Registrar “criticized” the registered owner attempt to claim that it did not know when the trademark was last used by the predecessor in title).

[41] The Owner submits that the Registrar has repeatedly held that showing a date of last use is not a condition precedent to avail of special circumstances. The Owner particularly notes the following comments of the Registrar in *Molson Breweries v Brasseries & Glacières Internationales (BGI) SA* (1996), 71 CPR (3d) 109 (TMOB) at 113:

... Although it is arguable that the wording of s.45(1) of the Act makes a showing of a date of last use a condition precedent to the consideration of the issue of special circumstances, it has been repeatedly held that such an approach is overly technical and not consistent with the overall intent and purpose of Section 45...

[42] The Owner also submits that the *Black Angus* and *Diparco* cases are not only distinguishable, but they also have been addressed in the case of *GPS (UK) Ltd v Rainbow Jean Co* (1984), 58 CPR (3d) 535 (TMOB) where the Registrar stated, at page 539:

... In my view, it would be an overly technical approach to require the new registered owner in the present case to justify the absence of use of the mark for almost eight years when it only acquired the mark two months prior to the date of the notice and was not in a position to attest to the use or absence of use of the mark by the previous owner.

[43] At the hearing, the Requesting Party argued that both *Molson Breweries, supra*, and *GPS (UK) Ltd, supra*, were “off-base” and urged me to disregard them. The Requesting Party did not convince me to do so.

[44] Indeed, as rightly argued by the Owner, that Registrar has repeatedly held that it is an overly technical approach to require a new owner to justify the absence of use of the mark by its predecessor(s) [see, for instances, *PNC IP Group Professional Corp v Mark Anthony*, 2021 TMOB 268 at para 29 [*PNC*]; *Life Maid Right - 2799232 Ontario Inc and Maid Right LLC*, 2022 TMOB 104 at para 33 [*Life Maid*]; *Scott Paper Co v Lander Co Canada* (1996), 67 CPR (3d) 274 (TMOB) at 277 [*Scott Paper 1996*].

[45] Finally, it is true that the Registrar in *Dentons Canada LLP, supra*, declined to consider the assignment date as the relevant date to assess the length of non-use. However, as stated by the Registrar in *PNC*, at para 30, “each case must be assessed on its own facts and as this was acknowledged in *Dentons*, it may be appropriate to accept the acquisition date to assess the length of non-use in some cases” [see also *Life Maid* at para 34]. In my view, this is one of those cases.

[46] Accordingly, I consider the period of non-use to begin at the date of the assignment, July 26, 2019, and run to December 9, 2020.

Non-use beyond the Owner's control

[47] The Requesting Party submits that even from the date of the assignment, special circumstances have not been demonstrated for the entire period of time. The Requesting Party's representations are two-pronged:

1. During the eight-month period between the July 2019 assignment and the COVID-19 pandemic, the Owner clearly took no steps whatsoever in relation to using the Mark.
2. The COVID-19 pandemic does not justify the non-use of the Mark. Even if it could qualify as a special circumstance, the evidence does not establish how the pandemic translated into delays justifying non-use during the relevant period.

[48] As regards the first prong, the Requesting Party submits that Mr. Arnold's bald statement that the Owner needed time to review each asset and to incorporate the Mark into the Owner's existing intellectual property portfolio and brand strategy is self-serving. It contends that the Owner has failed to provide the necessary facts, such as by failing to provide any details of the asset purchase agreement and by heavily redacting the assignment document, to allow the Registrar to decide whether this statement is reasonable and substantiated by the facts.

[49] As regards the second prong, in summary, the Requesting Party in its written representations submits that the COVID-19 pandemic was a common and worldwide issue that was certainly not limited or unique to the Owner. It submits that the invocation of the pandemic by the Owner is akin to invoking a recession, or poor market conditions, as "special circumstances". Yet these situations are not considered special circumstances justifying non-use (citing *Lander Co Canada Ltd v Alex E Macrae & Co* (1993), 46 CPR (3d) 417 (FCTD); and *Harris Knitting Mills*, *supra*).

[50] In oral representations, the Requesting Party argued that since the filing of the parties' written representations, it has been held by the Registrar that although the pandemic could cause disruption, the pandemic on its own cannot constitute a special

circumstance (citing *Norton Rose Fulbright Canada LLP/SENCRL, srl and Mama Shelter*, 2022 TMOB 229 [*Mama Shelter*]; and *The Wonderful Company LLC and Fresh Trading Limited*, 2023 TMOB 8 [*Wonderful Company*]). In any event, the Requesting Party reiterated its written representations concerning (i) the Owner's failure to establish how the pandemic translated into delays justifying non-use of the Mark, and (ii) the Owner's evidence shows that an upsurge in demand was the cause of supply disruption; not COVID-19.

[51] For its part, the Owner submits that Mr. Arnold's statements concerning the scale of the Acquisition and the time needed to review and incorporate the assets into the Owner's existing intellectual property portfolio and brand strategy should be accepted at face value in this proceeding (citing *Oyen Wiggs Green & Mutala LLP, supra*). I agree.

[52] An assignment or change in title in itself does not constitute a special circumstance [*Toagosei Co v Servicios Corporativos De Administracion GMZ, SA De CV* (1999), 3 CPR (4th) 275 (TMOB)]. However, there are a number of cases wherein a recent assignment or the acquisition of a trademark during the relevant period was held to excuse non-use, as it was reasonable in those cases to assume that the new owner would need some time to make arrangements concerning the use of a newly acquired trademark [see, for example, *Baker & McKenzie v Garfield's Fashions Ltd* (1993), 52 CPR (3d) 274 (TMOB); *Scott Paper 1996, supra*; *Sim & McBurney v Hugo Boss AG* (1996), 67 CPR (3d) 269 (TMOB); and *Hudson's Bay Co v Bombay & Co Inc*, 2013 TMOB 159].

[53] More particularly in these cases, the reasons for non-use were not merely due to the recent acquisition of the trademark; regard was also given to individual circumstances deemed beyond the control of the registered owner which reasonably affected the timing of the reintroduction of the goods associated with the trademark at issue. For example, difficulties in finding the necessary financing to re-launch the product line, technical difficulties in manufacturing, or difficulties in finding a suitable supplier, etc. In each case, active steps were taken to resume use prior to the date of the section 45 notice.

[54] The Owner submits that the evidence establishes that the introduction of the ROGUE product on the market was a complex multi-steps process. The evidence also establishes that the Owner diligently worked to resume use of the Mark subsequently to the Acquisition and prior to the date of the section 45 notice, all of that during the COVID-19 pandemic. Moreover, the Owner argued that the facts in the present case are distinguishable from the facts in the *Mama Shelter* and *Wonderful Company* cases.

[55] In this case, I accept that the Owner needed a reasonable period of time after the acquisition of the Mark to commence use of the Mark subsequent to the Acquisition. There is also clear evidence that the Owner took significant steps after the Acquisition and prior to the section 45 notice to resume use of the Mark.

[56] While the “multi-steps process” is not completely outside the control of the Owner, I accept that both product development and purchasing cycle were necessary steps to resume the use of the Mark in Canada. Further, I find that both the period of time for completion of the first ROGUE bicycle model by the Supplier and the period of time for the fulfillment of the orders by the Supplier are circumstances beyond the control of the Owner. Accordingly, I am satisfied that the circumstances of this case puts the non-use of the Mark in Canada beyond the control of the Owner alone, akin to those cases in which the loss of a distributor, or a comparable link in the chain of commerce was accepted as a special circumstance excusing the absence of use for a certain period of time [see *Gouverneur Inc v The One Group LLC*, 2014 TMOB 18; aff'd *One Group LLC v Gouverneur Inc*, 2016 FCA 109].

[57] I wish to stress that in concluding to circumstances excusing non-use of the Mark, I did not need to consider the parties’ pandemic-related arguments.

Owner’s intention to shortly resume use

[58] It is clear from the evidence that the Owner took active steps during the relevant period to resume use of the Mark in Canada as evidenced by the fact that bicycles displaying the Mark were sold shortly after the relevant period.

DISPOSITION

[59] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be maintained.

Céline Tremblay
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-03-27

APPEARANCES

For the Requesting Party: Mark Evans

For the Registered Owner: Chelsea Nimmo

AGENTS OF RECORD

For the Requesting Party: Smart & Biggar LLP

For the Registered Owner: Norton Rose Fulbright Canada
LLP/S.E.N.S.C.R.L., S.R.L.