



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 115

Date of Decision: 2023-07-10

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Wendy D. Riel

Registered Owner: Creative Sampling Solutions Inc.

Registration: TMA954,711 for LIVEWELL MARKETING

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. TMA954,711 for the trademark LIVEWELL MARKETING. The registration covers the following services:

Business marketing and consulting services and advertising services for others, namely, creating corporate and brand identity and strategies for health and wellness products, expressly excluding the provision of any such services for the real estate industry or in respect of any and all types of real estate properties; promotion services for others, namely, by organizing, promoting and conducting exhibitions, events, sponsorships, and demonstrations in the fields of corporate and brand identity for health and wellness products, expressly excluding the provision of any such services for the real estate industry or in respect of any and all types of real estate properties; event marketing services for others, namely the development, implementation and management of event marketing plans provided as part of business marketing and consulting services, expressly excluding the provision of any such services in the field of real estate.

[2] The owner of the registration is Creative Sampling Solutions Inc. (the Owner).

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

PROCEEDING

[4] At the request of Wendy D. Riel (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on November 10, 2021, to the Owner.

[5] The notice required the Owner to show whether the Mark was used in Canada in association with each of the services specified in the registration at any time within the three-year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is November 10, 2018 to November 10, 2021.

[6] The relevant definition of “use” is set out in section 4(2) of the Act as follows:

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[7] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the Register. As such, the evidentiary threshold that a registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448 at para 68] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at para 3]. That said, 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)], and 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)]. With respect to services, the display of a trademark on

advertising is sufficient to meet the requirements of section 4(2) when the trademark owner is offering and prepared to perform those services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[8] Where the 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.

[9] In response to the Registrar’s notice, on January 10, 2022, the Owner filed the statutory declaration of Peter Wright declared in Mississauga, Ontario on January 10, 2022 (the Wright Declaration). Mr. Wright identifies himself as a “director or officer” of the Owner.

[10] Both parties submitted written representations. No hearing was held.

[11] I note that the Owner’s written representations - filed by Mr. Wright directly without an agent - contained substantial amounts of additional evidence which was not filed on January 10, 2022 as part of the Wright Declaration. Such additional evidence in the Owner’s written representations included a business registry document as well as further descriptions of the nature of the Owner’s business and customers. This additional evidence was not in the form of an affidavit or statutory declaration as required by section 45 of the Act, and was not filed in accordance with the Owner’s deadline for submitting evidence in this proceeding. Further, it is well established that the Registrar may not consider additional evidence included with a party’s written representations [see *Ridout & Maybee LLP v Encore Marketing International Inc* (2009), 72 CPR (4th) 204 (TMOB)]. Thus, none of the additional evidence included in the Owner’s written representations is admissible and it has not been considered in deciding this proceeding.

EVIDENCE

[12] The body of the Wright Declaration is brief and is reproduced in its entirety below:

I, Peter Wright, of the City of Mississauga in the Province of Ontario, DO SOLEMNLY DECLARE that:

1. I am a director or officer of Creative Sampling Solutions Inc., an incorporated corporation and owner of the LiveWell Marketing trademark, and I have personal knowledge of the matters herein deposed to.
2. I am satisfied that our use of the aforementioned trademark since its inception in March, 2015 is:
 1. Thorough and within the intended and granted declaration of use;
 2. Our use has been “Business marketing and consulting services and advertising services for others, namely, creating corporate and brand identity and strategies for health and wellness products, EXPRESSLY EXCLUDING THE PROVISION OF ANY SUCH SERVICES FOR ANY AND ALL TYPES OF THE REAL ESTATE INDUSTRY.
 3. We have used, as the attached documents will attest, to our trademark on a daily basis since 2015.

AND I make this solemn declaration conscientiously believing it to be true, and knowing that it is of the same force and effect as if made under oath.

[13] The Wright Declaration is signed by a Commissioner and Mr. Wright; however, the documents which are attached to the declaration do not have exhibit cover pages signed by the Commissioner and are not otherwise notarized. The documents attached to the Wright Declaration include a letter from Mr. Wright dated November 26, 2021 which lists and includes examples of the display of the Mark, including display of the Mark during the relevant period on social media pages such as Instagram, on a response to requests for proposals, and on an advertising campaign presentation. Also included is a photograph of the Owner’s participation in an event identified as the “Toronto Women’s Show, Nov ‘19” .

ANALYSIS

[14] The Requesting Party's position in this case is twofold. First, it argues that the Owner has not filed any admissible evidence of use of the Mark, because the attachments to the Wright Declaration are "unsworn/unaffirmed" and therefore are not admissible. Second, the Requesting Party argues that even if the attachments to the Wright Declaration are admissible as evidence, they do not demonstrate use of the Mark by the Owner during the relevant period. I will address these issues in turn.

Are the attachments to the Wright Declaration admissible?

[15] The Owner's evidence in this case is not perfect. The Wright Declaration is brief and the attachments to the declaration are not notarized. However, there have been numerous cases in which the Registrar and the Federal Court have highlighted that section 45 proceedings should not become a "trap for the unwary" wherein a registration is cancelled for minor technical deficiencies in the owner's evidence [see *George Weston Ltd v Sterling & Affiliates* (1984), 3 CPR (3d) 527 (FCTD); *Baume & Mercier SA v Brown* (1985), 4 CPR (3d) 96 (FCTD); *Gowling WLG (Canada) LLP v Videovisions International (HSC) Inc*, 2022 TMOB 98]. I acknowledge that, in some instances, certain technical deficiencies (either individually or in the aggregate) may render a registered owner's evidence inadmissible [see, for example, *Jeunesse Global Holdings, LLC v LaFontaine Source De Jeunesse Corporation*, 2020 TMOB 88]. However, in my view, this is not such a case.

[16] In its written representations, the Requesting Party presents the Wright Declaration and the letter from Mr. Wright dated November 26, 2021 as two discrete and separate documents, and characterizes the latter as "unsworn/unaffirmed". Consequently, the Requesting Party argues that the various examples of the display of the Mark referred to in the letter are inadmissible. However, in my view, it is apparent that "the attached documents" referred to in paragraph 2.3 of the Wright Declaration include the November 26, 2021 letter and the various examples of the display of the Mark. In particular, the examples of the display of the Mark align with the description of the Owner's use of the Mark in association with the services in paragraph 2.2 of the

Wright Declaration, and all of these documents were submitted to the Registrar by the Owner at the same date and time as part of the same submission.

[17] While the attachments to the Wright Declaration are not notarized, that technical deficiency, alone, does not necessarily render the documents inadmissible [see *Smith, Lyons, Torrance, Stevenson & Mayer v Pharmaglobe Laboratories Ltd* (1996), 75 CPR (3d) 85 (TMOB) at para 7]. In this case, considering the Wright Declaration as a whole, I am satisfied that the November 26, 2021 letter and additional documents showing the display of the Mark are “the attached documents” referred to in paragraph 2.3 of the Wright Declaration and are admissible.

Is there evidence of use of the Mark by the Owner during the relevant period?

[18] The Requesting Party’s position is that even if the attachments to the Wright Declaration are admissible, the Owner has still not demonstrated use of the Mark during the Relevant Period. The Requesting Party advances multiple arguments to support that position.

[19] First, the Requesting Party points out that paragraph 2.2 of the Wright Declaration describes use of the Mark only in respect of the first set of services listed in the registration. Notably, the Wright Declaration makes no reference to use of the Mark in association with the remaining services set out below (the Omitted Services):

promotion services for others, namely, by organizing, promoting and conducting exhibitions, events, sponsorships, and demonstrations in the fields of corporate and brand identity for health and wellness products, expressly excluding the provision of any such services for the real estate industry or in respect of any and all types of real estate properties; event marketing services for others, namely the development, implementation and management of event marketing plans provided as part of business marketing and consulting services, expressly excluding the provision of any such services in the field of real estate.

[20] In its written representations, the Owner argues that the failure to include reference to the Omitted Services in the Wright Declaration was simply an inadvertent oversight, and that those services should nevertheless be maintained in the registration. However, in the context of the very brief Wright Declaration, and given that Mr. Wright

chose in that declaration to expressly refer to certain services and not others, I agree with the Requesting Party that there is no evidence in this proceeding of use of the Mark in association with the Omitted Services. In particular, paragraph 2.2 of the Wright Declaration expressly identifies certain services, and the attachments to the declaration include examples of the use of the Mark which appear to align with those expressly identified services. Given that the Omitted Services are not mentioned in paragraph 2.2 of the Wright Declaration, I see no basis to conclude that there nevertheless was use of the Mark in association with the Omitted Services as well. To be clear, I do not consider the failure to reference the Omitted Services in the Wright Declaration to constitute an admission by the Owner that there was no use of the Mark during the relevant period in association with those services, as argued by the Requesting Party. However, based on the evidence of record, I conclude that the Owner has not demonstrated use of the Mark in association with the Omitted Services.

[21] With respect to the first group of services listed in the registration, for the reasons discussed below, I am satisfied that the Wright Declaration, including its attachments, demonstrates use of the Mark by the Owner in association with those services. To start, the attachments to the Wright Declaration demonstrate the Owner's display of the Mark in advertising of its services during the relevant period, including on social media and a response to requests for proposals.

[22] The Requesting Party argues that there is insufficient evidence that any use of the Mark was by the Owner itself or accrued to the Owner via license pursuant to section 50 of the Act. However, I am satisfied based on the wording of the Wright Declaration that the use of the Mark was by the Owner. Mr. Wright identifies the Owner as the owner of the Mark, describes himself as a director or officer of the Owner, and refers repeatedly in the declaration to "our use" of the Mark. No other legal entities are referred to in the declaration. In these circumstances, I am satisfied that the use of the Mark described in the Wright Declaration was use by the Owner.

[23] The Requesting Party also submits that the Wright Declaration does not describe in sufficient detail the Owner's normal course of trade and the nature of the services

being provided. While the Wright Declaration is obviously brief, in my view, the attachments include sufficient information regarding the nature of the Owner's services to demonstrate that they align with the first group of services listed in the registration. For example, the image of the landing page for the website *livewellmarketing.ca* includes the phrase "Maximize how your brand is communicated with LiveWell Marketing", and the description "If you're a wellness brand that is coming to market or wishes to expand past its initial consumer base, LiveWell Marketing can help." The attachments to the Wright Declaration also include various social media posts from during the relevant period, displaying the Mark and promoting various food products, identified as "LiveWell Marketing Digital campaign June '21" and "LiveWell Marketing digital campaign Aug '20". I am satisfied that this evidence sufficiently aligns with the "business marketing and consulting services and advertising services for others" contained in the first group of services in the registration.

[24] Further, the Requesting Party submits that there is insufficient evidence that the services being advertised by the Owner in association with the Mark were available to be performed in Canada as of the date of the advertisement. I do not find this argument persuasive. The evidence as a whole, including the Owner's response to a request for proposals dated July 2021, indicates that the Owner was available to perform the services. The evidence indicates that the Owner is located in Canada and the Owner has provided evidence of attendance at a trade show in Toronto during the relevant period. In sum, I am satisfied that the Owner's evidence demonstrates that its services advertised during the relevant period in association with the Mark were available to be performed in Canada.

[25] Finally, the Requesting Party argues that the examples of the display of the term "LIVEWELL MARKETING" is use of a trade name rather than use of a trademark under section 4(2) of the Act. I disagree with that position. In my view, the display of the Mark in the various examples of advertising, often as part of a composite design and in larger font from other word matter, is use of the Mark as a trademark.

[26] Taking the above into account, I am satisfied that the Owner has demonstrated use of the Mark in Canada during the relevant period in association with the following services:

Business marketing and consulting services and advertising services for others, namely, creating corporate and brand identity and strategies for health and wellness products, expressly excluding the provision of any such services for the real estate industry or in respect of any and all types of real estate properties;

[27] However, the Owner has not demonstrated use of the Mark in Canada during the relevant period in association with the Omitted Services, nor special circumstances which would excuse the absence of use of the Mark in association with the Omitted Services.

DISPOSITION

[28] 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 services:

...promotion services for others, namely, by organizing, promoting and conducting exhibitions, events, sponsorships, and demonstrations in the fields of corporate and brand identity for health and wellness products, expressly excluding the provision of any such services for the real estate industry or in respect of any and all types of real estate properties; event marketing services for others, namely the development, implementation and management of event marketing plans provided as part of business marketing and consulting services, expressly excluding the provision of any such services in the field of real estate.

[29] The registration will be maintained in respect of the following services:

Business marketing and consulting services and advertising services for others, namely, creating corporate and brand identity and strategies for health and wellness products, expressly excluding the provision of any such services for the real estate industry or in respect of any and all types of real estate properties.

Timothy Stevenson
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Requesting Party: Wendy D. Riel

For the Registered Owner: No agent appointed