



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 221

Date of Decision: 2023-12-21

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: 88766 Canada inc

Registered Owner: Frew Songs Inc.

Registration: TMA672,026 for OD

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. TMA672,026 for the trademark OD (the Mark).

[2] The statement of goods and services is reproduced below, together with the associated Nice classes (CI):

Goods:

CI 9 (1) Novelty items, namely, sunglasses, magnets; and musical products, namely pre-recorded compact discs, audio cassette tapes and DVD's all containing music.

- CI 14 (2) Novelty items, namely, necklaces and rings, key holders, key chains, key rings, badges.
- CI 16 (3) Novelty items, namely, decals, paperweights; temporary tattoos, heat applied appliques; printed publications namely books, newsletters and magazines.
- CI 18 (4) Novelty items, namely, coin purses and wallets.
- CI 21 (5) Novelty items, namely mugs, drinking glasses, coasters and place mats; tooth brushes.
- CI 25 (6) Clothing, namely shirts, blouses, t-shirts, skirts, pants, sweatshirts, jackets, cardigans, nightgowns, pyjamas, underwear; novelty items, namely, suspenders.
- CI 26 (7) Novelty items, namely, belt buckles, novelty buttons and pins; shoe laces.
- CI 34 (8) Novelty items, namely lighters.

(the Goods)

Services:

- CI 35 (1) Providing on-line electronic retail services featuring musical recordings, clothing, printed publications and novelty items.
- CI 41 (2) Entertainment services, namely live performances by musical bands; music recording, production, distribution and publishing services; internet services, namely the operation of a website and providing online information in the field of music via a secure content global electronic computer information network.

(the Services)

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

PROCEEDING

[4] At the request of 88766 Canada inc (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on April 13, 2022, to Frew Songs Inc. (the Owner), the registered owner of the Mark.

[5] The notice required the 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 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 April 13, 2019 to April 13, 2022.

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

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

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

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 Owner does not show “use”, the registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Alan Graham Frew, sworn on November 14, 2022, together with Exhibits A to K.

[9] Neither party filed a written representation. However, both parties were represented at a hearing.

EVIDENCE

Preliminary remarks concerning the evidence

[10] Before proceeding with summarizing the evidence, I note that while the Mark is registered as a word mark, the Owner claims use with the addition of a vertical line and the word “WEAR”, namely OD | WEAR.

[11] The Owner also claims use of the Mark through two logos reproduced below. I note that the first logo (the Logo 1) is an enlarged view of part of a t-shirt’s printing,

which close-up is reproduced in Mr. Frew’s affidavit, shown further below. Mr. Frew describes this t-shirt as the “THIS IS YOUR LIFE t-shirt” (the T-shirt). The first logo is visible on the T-shirt between the letters “F” and “E” of the word “LIFE”. As it will be noted further below, the logo 2 (the Logo 2) is displayed on the T-shirt’s right sleeve.



[12] For ease of reference in the overview of the Owner’s evidence, I will refer hereafter to OD | WEAR, Logo 1 and Logo 2. Otherwise, I will refer generally to the Mark in the overview of the Owner’s evidence and in my analysis below. The issue of whether use of the trademarks in evidence, namely OD | WEAR, Logo 1 and Logo 2 amounts to use of the Mark will be addressed further below.

Overview of the Owner’s evidence

[13] Mr. Frew is the owner and President of the Owner. He has been the lead singer of the Canadian rock band Glass Tiger (the Band) since 1983. In 1994, he began a solo singer career in parallel to the Band [paras 1 to 3].

[14] Mr. Frew states that the Owner was created in 2003 in order to facilitate Mr. Frew’s connection with fans, promote his music and develop business and merchandise lines. He also states that he is directly involved in the provision of “entertainment and other services” and in the sales of the Goods. For example, Mr. Frew personally deals and coordinates with manufacturers and distributors. He further states that the Owner operates the website *alanfrewworld.com* (the Website) to

inform fans about his projects. As part of the Website, the Owner also operates an online store at *alanfrewworldstore.com* (the Online Store) [paras 4 and 8].

[15] Regarding the use of the Mark, Mr. Frew states that the Mark has been used during the relevant period with “some of the Goods and Services, and for the remainder, special circumstances exist excusing any non-use” [para 7].

[16] With respect to the Goods, Mr. Frew states that his fans purchased t-shirts from the Online Store from 2019 through 2022, and calendars in 2019 and 2020. He asserts that to the date of signature of his affidavit, more than 90 customers purchased t-shirts from the Online Store, and that over \$4500 calendars and \$3000 t-shirts were sold during the relevant period [paras 15 and 17].

[17] With respect to the Services, Mr. Frew states that he wore the T-shirt in live musical performances during the Band’s tour across Canada in 2019. He also wore the T-shirt at music recording sessions in August and December 2020 [paras 11 and 12].

[18] As for the special circumstances, Mr. Frew states that in early 2015, when an initial group of Goods was in the process of being created, he experienced a series of significant health issues. Only after the beginning of 2019, he was able to concentrate efforts on the development of Goods and Services in association with the Mark. According to Mr. Frew, such efforts were ongoing until March 2020, when the COVID-19 global pandemic hit. Mr. Frew further states that the entertainment services were impacted as live musical performances were cancelled and/or rescheduled as a result of the pandemic. As the Goods are sold at live performances or via the Online Store, before or after such performances, sales of the Goods, and the related Internet and on-line electronic retail services, were also adversely impacted. In addition, he states that the pandemic’s associated lockdowns resulted in numerous delays in the design and launch of the Goods as most of them were to be manufactured in Asia [paras 9 to 10, 12 and 14].

[19] Nevertheless, Mr. Frew asserts:

During the relevant period [the Owner] intended, and is continuing to pursue, the full development and launch of the Goods and Services associated with [the Mark], and but for COVID-19, the launch would have been completed by now [para 19].

[20] More particularly, regarding the Goods, Mr. Frew states that the Owner has designed and is in the process of having new products bearing the Mark manufactured to sell via the Online Store and at live performances. As for the Services, he states that the Owner has begun marketing its music production services and that it will implement its plans, made in 2020 and 2021, by booking solo tour dates in association with the Mark [paras 13 and 16].

[21] In support, the following relevant exhibits are attached to Mr. Frew's affidavit:

- Exhibit A: consists of several news' articles and social media accounts screenshots that Mr. Frew states are representative. The Band's YouTube, Facebook, Instagram and Grammy Awards accounts are included in this exhibit along with two unidentified social media accounts featuring CD's for sale. A single entitled "THIS IS YOUR LIFE" appears among the "popular uploads" of the Band on its YouTube account. The Mark does not appear on any of the pages part of Exhibit A.
- Exhibit B: consists of three screenshots of the Website and Online Store, which Mr. Frew states are representative. The first screenshot shows the sign up page of the Website in which Mr. Frew wears the T-shirt. The Website's tabs, which include "Music" and "Events", appear on the top of the screenshot. The second and third screenshots show the Online Store with several t-shirts, including the T-shirt and t-shirts displaying the Logo 2 and OD | WEAR on their front. These screenshots also show a book and an item identified as "Artwork Print". On the second screenshot, OD | WEAR is displayed as part of the t-shirts' description and as a text link.
- Exhibits E and F: consist of several screenshots of Mr. Frew's Instagram account with posts dated during the relevant period. The posts show photographs and stills of videos in which Mr. Frew wears the T-shirt.

- Exhibit G: consists of several screenshots of Mr. Frew’s Instagram account with posts dated during the relevant period. The posts show photographs of fans wearing the T-shirt. One of the posts, dated December 30, 2019, shows a calendar. A photograph of Mr. Frew wearing the T-shirt appears on one of the calendar’s page.
- Exhibit H: consists of a photograph of the T-shirt’s right sleeve displaying the Logo 2, and an email regarding an order of t-shirts sold by the Innisbrook Golf Course in Ontario. Mr. Frew asserts that the email is dated November 20, 2021 [para 15].
- Exhibit I: consists of a printout from the Online Store, which Mr. Frew states is dated early 2022 [para 17]. The printout shows six t-shirts. OD | WEAR is displayed on the left side of the printout, and as part of each of the t-shirts’ description.
- Exhibit K: consists of four representative designs displaying the Mark, which Mr. Frew states were developed in April 2019 for use in association with the Goods.

REASONS FOR DECISION

The parties’ positions

[22] The Requesting Party submitted that the variations of the Mark in evidence, do not constitute use of the Mark as registered. It also submits that the evidence is unclear as to the transfer of any Good within the meaning of sections 4(1) and (3) of the Act. For example, it submits that as Mr. Frew refers to the date of his affidavit when attesting to the number of customers purchasing online, it is unclear whether the related sales took place specifically during the relevant period. In the alternative, the Requesting Party submits that the Owner has only demonstrated use of the Mark in association with t-shirts. Regarding the Services, it submits that there is no evidence of use within the meaning of section 4(2) of the Act. As for the alleged special circumstances, the Requesting Party submits that the reasons provided by the Owner cannot excuse the non-use of the Mark.

[23] In response, the Owner submits that the evidence supports the conclusion that the Mark was used in association with “printed publications” listed in Goods (3), with “clothing” listed in Goods (6) and with all the Services in Canada during the relevant period.

The acceptable variations of the Mark

[24] The Requesting Party submits that use of the trademark “OD | WEAR”, Logo 1 and Logo 2 does not amount to use of the Mark as registered. In particular, it submits that the additional matter, including the addition of a descriptive word, completely change the visual identity of the Mark, and that the public will not see that the Mark is being used *per se* [citing *Nightingale Interloc Ltd. v Prodesign Ltd.* (1984), 2 CPR (3d) 535 (TMOB); and *COMPO Expert GmbH v The Professional Gardener Co. Ltd.* 2018 COMC 56].

[25] In considering whether the display of a trademark constitutes display of the trademark as registered, the question to be asked is whether the trademark was displayed in such a way that it did not lose its identity and remained recognizable, in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see whether the “dominant features” of the registered trademark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. The assessment as to which elements are the dominant features and whether the deviation is minor enough to permit a finding of use of the trademark as registered is a question of fact to be determined on a case-by-case basis.

[26] In the present case, as noted by the Requesting Party, the words “OD” and “WEAR” appear in the same font size and style in OD | WEAR and in Logo 2. That said, I find that “WEAR” would be viewed as merely descriptive when associated with t-shirts listed in Goods (6), and with “providing on-line electronic retail services featuring clothing” of Services (1). In this regard, I note that the addition of descriptive words to a word mark is not necessarily fatal to a registration, even where those descriptive words

appear in the same font and size as the word mark [see, for example, *LE PEPE' SRL and PJ Hungary Kft.*, 2017 TMOB 82 at paras 18-20, cited at para 46 of *COMPO*, *supra*, relied upon by the Requesting Party]. As such, “OD” for the previously specified Goods and Services would be recognized as the dominant feature when displayed with the additional word “WEAR” that is merely descriptive. Regarding Logo 2, the dominant feature of the Mark, namely “OD”, can be read in the composite mark despite the addition of the graphic feature. Thus, given that the dominant feature of the Mark has been preserved in OD | WEAR and in Logo 2, I conclude that that a purchaser’s first impression will be that the Mark is used *per se*. As for use of Logo 1, it is well established that a registration for a word mark can be supported by use of that mark in any stylized form [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, at paras 55 and 58].

[27] Consequently, for the purpose of this proceeding, display of OD | WEAR, Logo 1 and Logo 2 constitutes display of the Mark when associated with t-shirts listed in Goods (6), and with “providing on-line electronic retail services featuring clothing” listed in Services (1).

Use is in association with the Goods

[28] 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. The evidence in a section 45 proceeding need not be perfect; indeed a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at para 9].

Use is shown in association with t-shirts

[29] From the evidence as a whole, I find that the Owner has established a *prima facie* case of use of the Mark in association with t-shirts listed in Goods (6). In this regard, Mr. Frew provides representative photographs of t-shirts displaying the Mark [Exhibits B, E, F and G]. He also provides sales figures supporting sales of this product

during the relevant period [para 15]. Specifically concerning sales in Canada, Mr. Frew provides an email confirming the delivery of t-shirts in Ontario during the relevant period [Exhibit H].

[30] I am therefore satisfied that the Owner has demonstrated use of the Mark in association with “clothing, namely t-shirts” listed in Goods (6) within the meaning of the Act.

[31] However, I come to a different conclusion with respect to the remaining Goods.

No use is shown in association with the remaining Goods

[32] I will begin by analysing the groups of Goods for which the Owner expressly claims use, that is Goods (3) and (6), in reverse order.

[33] With respect to all Goods (6), except t-shirts, the evidence is silent not only as to their association with the Mark, but also as to their transfer in or from Canada during the relevant period.

[34] With respect to the “printed publications” listed in Goods (3), the Owner claims that as the calendar in evidence shows Mr. Frew wearing the T-shirt, use of the Mark has been demonstrated.

[35] However, display of the Mark on the T-shirt cannot be relied upon to maintain the “printed publications” listed in Goods (3). In my view, accepting that the display of the Mark on the T-shirt also constitutes display in association with the calendar on which the photographed T-shirt appears would be tantamount to accepting the same use to maintain two different and distinct goods. Section 45 clearly indicates that use is to be shown with respect to *each* of the goods specified in the registration. Accordingly, in order for the Owner to maintain its registration for printed publications, it had to show use in association with books, newsletters or magazines otherwise than by reference to evidence of use of the Mark in association with t-shirts. Thus, without further evidence, I am not prepared to accept that the display of the Mark on the t-shirt shown in the calendar’s photograph equates display of the Mark on the calendar itself. Consequently,

although Mr. Frew provides sales figures for calendars during the relevant period, the evidence does not allow me to conclude that the Mark was displayed on the calendars themselves or on their packaging at the time of transfer.

[36] With respect to the products shown through the evidence that could correlate with the “printed publications” listed in Goods (3), namely the Artwork Print and the book shown on the Online Store screenshots [Exhibit B], neither of them display the Mark on themselves.

[37] As for the remaining Goods (3), that is “novelty items, namely, decals, paperweights; temporary tattoos, heat applied appliquéés”, the evidence is silent not only with respect to the Mark being associated with such goods, but also as to their transfer in or from Canada during the relevant period.

[38] The same conclusion applies to Goods (1), (2), (4), (5), (7) and (8).

[39] In view of all the above, the Owner has not demonstrated use of the Mark in association with Goods (1) to (6), except for t-shirts, (7) and (8) within the meaning of sections 4(1), 4(3), and 45 of the Act.

Use in association with the Services

[40] It is well established that the display of the trademark in the advertisement of the services is sufficient to satisfy the requirements of section 4(2) of the Act, from the time the owner of the trademark is willing and able to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co (1976)*, 28 CPR (2d) 20 (TMOB)].

Services (1)

[41] From the evidence as a whole, I find that the Owner has established a *prima facie* case of use of the Mark in association with “providing on-line electronic retail services featuring clothing” listed in Service (1). The representative Online Store screenshots [Exhibit B, pages 2 to 3], display the Mark as a text link, suggesting that there is a webpage associated with the Mark and devoted to products displaying the Mark. The Online Store printout from early 2022 [Exhibit I], corroborates that t-shirts

bearing the Mark were offered for sale in association with the Mark on the Online Store during relevant period. Indeed, the printout displays the Mark on the top and as part of the t-shirts description, showing that the Mark was used not only in association with t-shirts, as goods, but also in association with “on-line electronic retail services featuring clothing”. I am therefore satisfied that the Owner has demonstrated use of the Mark in the advertising of “providing on-line electronic retail services featuring clothing”, specified in Services (1). Moreover, in view of my finding above regarding sales of t-shirts in Canada during the relevant period, I am satisfied that the Owner has also demonstrated that it was willing and able to provide the advertised “on-line electronic retail services featuring clothing”, specified in Services (1).

[42] I come to a different conclusion regarding the remaining goods concerned by Services (1), that is “musical recordings” and “printed publications and novelty items”.

[43] With respect to “musical recordings”, while the unidentified social media accounts [Exhibit A] feature CD’s, the Mark does not appear on any of the screenshots. Further, I note that the Owner only provided one screenshot of the Website showing a tab entitled “Music” [Exhibit B, page 1]. Even if I were to accept that music recordings could have been offered under that tab, the Owner did not provide any screenshot of the Music tab webpage. Consequently, nothing indicates that the Mark was ever used or displayed in the performance of “on-line electronic retail services featuring musical recordings” in Canada during the relevant period. Moreover, absent further evidence, I am unable to conclude that the Mark was used in the advertising of “providing on-line electronic retail services featuring musical recordings”. In any event, there is no evidence before me to show that the Owner was willing and able to perform this service in association with the Mark in Canada during the relevant period.

[44] With respect to “printed publications and novelty items”, the Mark does not appear on the screenshots of the Online Store otherwise than associated with t-shirts. Therefore, I am not satisfied that the Owner used the Mark in the advertising of “providing on-line electronic retail services featuring printed publications and novelty items”. Furthermore, the evidence is also silent as to whether the Owner was willing and

able to perform this service in association with the Mark in Canada during the relevant period.

[45] I am therefore not satisfied that the Owner has demonstrated use of the Mark in association with the goods related to Services (1), except for t-shirts, in Canada during the relevant period.

Services (2)

[46] From a fair reading of the evidence, I find that none of the Services (2) were advertised in association with the Mark in Canada during the relevant period.

[47] First, regarding “entertainment services, namely live performances by musical bands; music recording, production, distribution and publishing services”, I am unable to conclude that the Mark was displayed in the performance or advertised in association with any of them. Although Mr. Frew states that the T-shirt is the medium on which these services were advertised, in my view, display of the Mark on the T-shirt amounts either to advertising of t-shirts or to advertising of the Band’s single “THIS IS YOUR LIFE”, shown in the Band’s YouTube account [Exhibit A]. In other words, I find such display to be insufficient on its own, and the Mark is not otherwise associated with these services through the evidence. My comments above concerning the Music tab webpage apply to the Events tab webpage. Without further evidence, I am not prepared to accept that wearing the T-shirt in live performances and music recording sessions amounts to advertisement of “entertainment services, namely live performances by musical bands; music recording, production, distribution and publishing services”.

[48] I come to a similar conclusion with respect to the remaining Service (2), that is “internet services, namely the operation of a website and providing online information in the field of music via a secure content global electronic computer information network”. None of the social media posts, either of Mr. Frew or of the Band, display the Mark elsewhere than on Mr. Frew’s T-shirt. Similarly, the Mark is not displayed on the Website elsewhere than on his T-shirt.

[49] In addition, the evidence is silent as to whether the Owner was willing and able to perform any of Services (2) in association with the Mark in Canada during the relevant period.

[50] To sum up, I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the Goods, except t-shirts listed in Goods (6), within the meaning of sections 4(1), 4(3), and 45 of the Act. I am also not satisfied that the Owner has demonstrated use of the Mark in the performance or advertising of the Services, except “on-line electronic retail services featuring clothing” listed in Services (1), within the meaning of sections 4(2), and 45 of the Act.

The special circumstances

[51] As the Owner has not demonstrated use of the Mark in association with any of the Goods, except for “clothing, namely t-shirts” listed in Goods (6), (the Remaining Goods), with any of the Services (1), except for “on-line electronic retail services featuring clothing”, and with any of Services (2) (the Remaining Services), the general rule is that absence of use should result in expungement. However, there may be an exception where the absence of use is excusable due to special circumstances [*Smart & Biggar v Scott Paper Ltd*, 2008 FCA 129]. Special circumstances means circumstances or reasons that are unusual, uncommon, or exceptional [*John Labatt Ltd v Cotton Club Bottling Co* (1976), 25 CPR (2d) 115 (FCTD)]

[52] To determine whether special circumstances have been established, I first must determine why the Mark was not used during the relevant period. Second, if I determine that the reasons constitute special circumstances, I must still decide whether such special circumstances *excuse* the absence of 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 *Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA)].

Reasons for non-use of the Mark

[53] The Owner submits that the absence of use of the Mark in association with the Remaining Goods and Services is due to Mr. Frew's health issues and the impact of the pandemic on the Owner's business.

Would the circumstances excuse the absence of use?

[54] Mr. Frew states that he was able to concentrate efforts on the development of the Remaining Goods and Services after the beginning of 2019. From his statement, taken at face value, I conclude that his health issues were behind him at the beginning of the relevant period starting on April 13, 2019.

[55] Mr. Frew also states that his efforts in developing the Remaining Goods and Services were ongoing when the pandemic hit in March 2020. However, he provides no details as to why such efforts could not materialize during the period of almost one year preceding the pandemic's restrictions.

[56] If there were other reasons why the Owner could not have used the Mark in association with the Remaining Goods and Services between April 13, 2019 and March 2020, such reasons are not set out in the Owner's evidence.

[57] In view of my finding regarding the timing of Mr. Frew's health issues, the pandemic alone does not explain the absence of use of the Mark during the first year of the relevant period. In this respect, it has been held that special circumstances must apply to the entire relevant period [see, for example, *Oyen Wiggs Green & Mutala LLP v Rath*, 2010 TMOB 34 at para 12; and *PM-DSC Toronto Inc v PM-International AG*, 2013 TMOB 15 at para 15, and *The Wonderful Company LLC and Fresh Trading Limited*, 2023 TMOB 8].

[58] Therefore, I am not satisfied that the Owner has demonstrated special circumstances within the meaning of section 45(3) of the Act.

[59] In any case, even if I were to accept that the reasons submitted by the Owner constitute special circumstances that apply to the entire relevant period, I would not be satisfied that such circumstances excuse the absence of use of the Mark.

[60] With respect to the first criterion, as the Owner did not provide the date of last use of the Mark, I may consider the date of registration as the relevant date for purposes of assessing the length of non-use [see, for example, *Oyen Wiggs Green, supra*]. In the present case, the Mark was registered on September 6, 2006, which is more than twelve years prior to the issuance of the notice. Therefore, the total length of time during which the Mark was not in use is almost sixteen years. This lengthy period of non-use weighs against the Owner.

[61] With respect to the second criterion, the evidence shows that Mr. Frew toured with the Band across Canada in 2019, and that t-shirts were sold during that year. I therefore find that the absence of use of the Mark from April 13, 2019 to March 2020 is likely attributable, at least in part, to the Owner's voluntary business decision to prioritize the Band and sales of t-shirts over the launching of the Remaining Goods and Services. In any event, Mr. Frew's health condition and the pandemic do not explain the non-use of the Mark from the registration date to the beginning of Mr. Frew's significant health issues in early 2015. Absent reasons explaining the absence of use of the Mark for nine years, I cannot determine whether they were beyond the Owner's control. In this respect, it has been held that circumstances beyond the Owner's control for part of the relevant period are insufficient as special circumstances must apply to the entire relevant period [see *Oyen Wiggs Green, supra*, and *Norton Rose Fulbright Canada LLP v Solomon Kennedy trading as Luv Life Productions*, 2019 TMOB 22 at para 35]. Therefore, I am not satisfied that the Owner has demonstrated circumstances that were beyond its control.

[62] Finally, with respect to the third criterion, aside from the designs developed in 2019 [Exhibit K], the evidence is silent as to the progress of the Owner's efforts in launching the Remaining Goods. For example, while Mr. Frew deals with manufacturers, he provides no documentation supporting his assertion that new

products bearing the Mark were in the process of being manufactured. As such, Mr. Frew provides no particulars regarding any concrete steps being taken to bring the Remaining Goods to the Canadian market or to advertise the Remaining Services in association with the Mark. I therefore find that the Owner has not provided sufficient factual elements showing its intention to shortly resume use of the Mark [*NTD Apparel Inc v Ryan* (2003), 27 CPR (4th) 73 at para 26; see also *Arrowhead Spring Water Ltd v Arrowhead Water Corp* (1993), 47 CPR (3d) 217 (FCTD)].

[63] In view of all of the foregoing, per *Scott Paper*, I must conclude that the Owner has not demonstrated special circumstances excusing non-use of the Mark during the relevant period within the meaning of section 45(3) of the Act.

DISPOSITION

[64] 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 amended to delete the all the Goods, except for “clothing, namely t-shirts” listed in Goods (6), and all the Services, except for “Providing on-line electronic retail services featuring clothing” listed in Services (1).

[65] The amended statement of goods and services will read as follows:

Goods:

CI 25 (6) Clothing, namely t-shirts.

Services:

CI 35 (1) Providing on-line electronic retail services featuring clothing.

Maria Ledezma
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-10-30

APPEARANCES

For the Requesting Party: Catherine Bergeron

For the Registered Owner: Jonathan Colombo

AGENTS OF RECORD

For the Requesting Party: ROBIC

For the Registered Owner: Marks & Clerk