



# Canadian Intellectual Property Office

## THE REGISTRAR OF TRADEMARKS

**Citation:** 2024 TMOB 79

**Date of Decision:** 2024-04-22

## IN THE MATTER OF SECTION 45 PROCEEDINGS

**Requesting Party:** BCF S.E.N.C.R.L. / BCF LLP

**Registered Owner:** Uncharted Kite Sessions Ltd.

**Registrations:** TMA1,015,764 for UNCHARTED KITE SESSIONS, and  
TMA1,015,965 for UNCHARTED KITE SESSIONS & DESIGN

### INTRODUCTION

[1] This is a decision involving summary expungement proceedings under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration Nos. TMA1,015,764 and TMA1,015,965 for the trademarks UNCHARTED KITE SESSIONS and UNCHARTED KITE SESSIONS & DESIGN shown below (collectively referred to as the Marks).



[2] The Marks are registered in association with the following goods and services:

Goods

Kite surfing and water sport equipment, namely kites, kiteboards, surfboards, kite harnesses, helmets, impact vests, personal flotation devices and board leashes; adventure travel clothing and accessories, namely hats, caps, t-shirts, long-sleeved shirts, sweatshirts, hoodies; swim clothing for men and women, namely rash guards; sports mugs, travel mugs, coffee mugs and water bottles.

Services

Education, instruction, training, evaluation and coaching services all in the area of water sports, namely kite surfing, surfing, paddle boarding, stand-up paddle boarding, snorkeling and scuba diving; coaching and training consulting services through service delivery by notable water sport enthusiasts and professional athletes; private coaching and training consulting services in the area of water sports; video performance riding evaluations in the area of water sports; adventure travel tourism services; arranging, organizing and managing adventure travel tours and activities, namely boat tours, jet skiing, snorkeling, scuba diving, water sports, motor bike tours, ATV rentals, zip lining, canyoneering, scenic tours and horseback riding adventure tours.

[3] For the reasons that follow, I conclude that the registrations ought to be expunged.

**PROCEEDINGS**

[4] At the request of BCF S.E.N.C.R.L. / BCF LLP (the Requesting Party), the Registrar of Trademarks issued notices under section 45 of the Act on November 28, 2022, to Uncharted Kite Sessions Ltd. (UKS), the registered owner of the Marks.

[5] The notices required UKS to show whether the Marks were used in Canada in association with each of the goods and services specified in the registrations at any time within the three-year period immediately preceding the date of the notices and, if not, the date when they were last in use and the reason for the absence of such use since that date.

[6] For each of the Marks, the relevant period for showing use is November 28, 2019 to November 28, 2022.

[7] The relevant definitions of “use” 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.

(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.

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

[9] 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 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 Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must nevertheless 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)]. In this regard, the owner bears the full burden of proof [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[10] In both proceedings, UKS submitted the affidavit of Andreas Lagopoulos, its Founder and Owner, sworn June 28, 2023, with Exhibits A

through N (collectively, the Lagopoulos affidavit). The relevant portions of the evidence are briefly summarized below and further discussed in my reasons for decision.

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

### **EVIDENCE SUMMARY**

[12] In the opening statement of his affidavit, Mr. Lagopoulos identifies himself as currently working on assignment in Cabarete, Dominican Republic.

[13] Mr. Lagopoulos states that UKS specializes in providing education, instruction, training, evaluation and coaching services in water sports, particularly with respect to kite surfing and provides a link to its website at *www.unchartedkitesessions.com* (paras 1-2). He states that UKS has been using the Marks in association with the registered goods and services since at least as early as August 2014 in respect of services and as early as February 5, 2019 in respect of goods (para 3).

[14] Mr. Lagopoulos proceeds to provide what he describes as examples of use of the Marks in the form of:

- Samples of invoices and corresponding waiver forms signed by customers who have purchased services with respect to kiteboarding sessions (paras 5 and 8-16; Exhibits A through I);
- Pictures of goods, including t-shirts, caps, and coffee mugs, stated to have been provided as part of sales packages for customers who purchased services during the relevant period (paras 6 and 17-20; Exhibits J through M);

- A list of online links associated with YouTube and other promotional videos stated to show the Marks displayed on goods used by customers during the provision of services (paras 7 and 21; Exhibit N).

### **REASONS FOR DECISION**

[15] The Requesting Party submits that the Lagopoulos affidavit does not establish that the Marks were used in Canada in association with the goods or services listed in the registrations during the relevant period. More specifically, the Requesting Party submits that the only evidence is with respect to services described as “kiteboarding sessions” and that there is ambiguity both as to what services correspond to this description and where they may have been performed (*i.e.* in Canada or in the Dominican Republic).

[16] I agree with the Requesting Party that UKS has failed to show use of the Marks in association with goods, even if only because there is no evidence of transfers of any goods occurring in Canada during the relevant period or otherwise.

[17] There are no references to goods on invoices. There is no mention of specific goods other than “t-shirts, hats, and coffee mugs” in the body of the Lagopoulos affidavit and—although the exhibited photographs do depict t-shirts, caps and a coffee mug—there is no explanation of how, where or when exactly such goods were provided as part of sales packages for customers who purchased UKS services, nor what such sales packages even included. There is also little to no insight provided into UKS’ normal course of trade.

[18] As for the photographs showing kiteboards, these much more likely appear to be promotional items or rental equipment, rather than goods actually sold to consumers. This is consistent with the exhibited waivers

which all provide for “breakages to rental equipment during lessons or rental” and for “breakages or loss of [UKS] equipment”. In any event, again, there are no facts in evidence that these goods were transferred in Canada during the relevant period.

[19] I also agree with the Requesting Party that the evidence is deficient with respect to the registered services.

[20] As indicated above, Mr. Lagopoulos states that UKS specializes in providing education, instruction, training, evaluation and coaching services in water sports, particularly with respect to kite surfing. He then provides a link to UKS’ website, as well as invoices, waivers, undated pictures and a list of links to promotional content.

[21] First, to the extent that Mr. Lagopoulos is suggesting that I access the links provided in his affidavit, I will start by noting that if UKS wanted online content to be considered as evidence, Mr. Lagopoulos would have had to provide corresponding exhibits such as screen shots or printouts of same and attach them to his affidavit. It follows that the Requesting Party’s submissions that refer to facts not properly evidenced by UKS—including with respect to UKS’ website and video content—have been disregarded [per *Ridout & Maybee LLP v Encore Marketing International Inc* (2009), 72 CPR (4th) 204 (TMOB); see also *88766 Canada Inc v Mark Michel Enterprises Ltd*, 2011 TMOB 252 at para 6; *Fasken Martineau Dumoulin LLP v Henan Rebecca Hair Products, Inc*, 2018 TMOB 150 at para 7; and *BCF SENCRL/BCF LLP v Kazar Group Spółka z ograniczona odpowiedzialnoscia*, 2024 TMOB 51 at para 18].

[22] Second, the documents attached as Exhibits C and D are both dated and refer to events that took place outside the relevant period.

[23] While Exhibits A and B, for their part, also consist of documents dated outside the relevant period (two sets of invoices and waivers respectively of February and September of 2019), I note that the invoices contain the following item description and notes: "Jalou & Moona Camp 2020", "\$500 Deposit Due Upon Receival Of This Invoice Seat Balance Due: April 20, 2020". These invoices are addressed to Canadians and display UKS' address in Winnipeg, Manitoba.

[24] However, aside from stating that the invoices are for services "with respect to kiteboarding sessions held at the Jalou & Moona Camp in 2020", Mr. Lagopoulos does not explain how the referenced camp is organized or what it consists of or includes. This raises a question as to which of the registered services were actually performed.

[25] In addition, while the waivers notably contain references to "engaging in the sport of kite boarding, ground instruction, water instruction, jet ski instruction, boat instruction" and "kite boarding activities", they also include references to travel, including a mention that customers have to confirm having "purchased ... travel & health insurance to cover any eventualities that may arise from participating in kite surfing while attending a UKS kite camp".

[26] Mr. Lagopoulos does not explain where the referenced camp is held. He also does not specifically state that UKS sold any goods or provided any services in Canada, only mentioning that "the [registered g]oods and [s]ervices are recognized by these [M]arks across Canada". In combination with his assertion that he is working on assignment in Cabarete, Dominican Republic and the fact that some of the pictures he attaches as Exhibits J and L depict people standing on a beach or near a turquoise body of water sometimes with palm trees in the background, this raises a question as to whether UKS services were provided or performed in Canada.

[27] Lastly, I note that Exhibits E through I contain invoices and waivers respectively made out to and signed by non-Canadian customers (*i.e.* from the USA, Colombia, South Africa and Portugal). Whatever services may or may not be evidenced by these exhibits were therefore not provided to Canadians. For the same reasons outlined in my discussion of Exhibits A and B above, it is also unclear if the services were provided or performed in Canada.

[28] The Federal Court has held that the Registrar must be able to “rely on an inference from proven facts rather than on speculation” to satisfy every element required by the Act [*Diamant Elinor, supra*, at para 11; see also *Curb v Smart & Biggar*, 2009 FC 47]. In this case, UKS was obligated to show use of the Marks in association with the registered goods and services in Canada during the relevant period. As UKS has failed to provide facts demonstrating that any such use took place in Canada, there is insufficient evidence to allow me to conclude that the Marks were used in association with the registered goods and services within the meaning of sections 4 and 45 of the Act. There is also no evidence before me of special circumstances excusing the absence of use.

### **DISPOSITION**

[29] 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, both registrations will be expunged.

Iana Alexova  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office



# Appearances and Agents of Record

No hearing held

## **AGENTS OF RECORD**

**For the Requesting Party:** BCF S.E.N.C.R.L. / BCF LLP

**For the Registered Owner:** Nicole D.S. Merrick c/o Taylor McCaffrey LLP