Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 55

Date of Decision: 2024-03-26

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: WHC zShuttle, LLC

Registered Owner: Super Shuttle Share-A-Ride Corp.

Registration: TMA1,062,443 for BLUE VAN

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. TMA1,062,443, for the trademark BLUE VAN (the Mark), which is registered for use in association with the following services:

> Ground transportation services, namely bus transport services, limousine services and taxi services.

[2] For the following reasons, the registration will be maintained.

PROCEEDING

[3] At the request of WHC zShuttle, LLC (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on November 8, 2022, to Super Shuttle Share-A-Ride Corp. (the Owner), the registered owner of the Mark.

[4] The notice required the Owner to show whether the Mark was used in Canada in association with each of the services stated 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 November 8, 2019 to November 8, 2022.

[5] The relevant definition of "use" in the present case is set out in section 4 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.

[6] 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 [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at paras 2, 9].

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Vazken Kerametlian, sworn on June 5, 2023 (the Kerametlian Affidavit). Neither party submitted written representations, and no hearing was held.

EVIDENCE AND ANALYSIS

[8] Mr. Kerametlian is the President of the Owner [Kerametlian Affidavit, para 4]. He swears that the Mark has been used by the Owner and/or its licensees, in association with bus services, limousine services and taxi services, since at least the early 2000's and throughout the relevant period [paras 3, 7, 9]. When the Mark is used by the

Owner's licensees, Mr. Kerametlian states that the Owner exerts control over the character or quality of the services being offered in association with the Mark, and provides a description of how such control is exerted [para 10].

[9] Mr. Kerametlian's affidavit includes two emails from longstanding customers of the Owner, who both state that they used the Owner's services on several dates within the relevant period [para 13, and Exhibits H and I]. Mr. Kerametlian also swears that he believes the customers' statements to be true [para 13]. While the statements in the customers' emails are hearsay, it is well settled that a strict approach to hearsay is not appropriate in section 45 proceedings [*FCA US LLC v Pentastar Transportation Ltd,* 2019 FC 745 at para 46]. In view of Mr. Kerametlian's sworn statement that he believes the customers' statements are true, and the absence of any suggestion to the contrary in the evidence, I am prepared to give the statements in the customers' emails some weight.

[10] Mr. Kerametlian states that the Mark has been displayed during the relevant period in advertising and promotional materials for the Owner's services, including brochures, business cards, and promotional materials such as note pads and letterhead [para 11]. He also states that the Mark was displayed in print advertisements for the Owner's services appearing in concert programmes for events in Toronto, Ontario in 2019 and 2020, as well as a playbill for an event in Scarborough, Ontario in April, 2022 [paras 12(c), 12(d), and Exhibits C, D]. Mr. Kerametlian provides representative samples of the Owner's brochures, business cards, printed advertisements and letterhead, each of which bear the Mark [para 12 and Exhibits A-G]. Mr. Kerametlian also provides a blank invoice bearing the Mark, which he states is representative of the invoices that were provided to customers throughout the relevant period [para 14 and Exhibit J].

[11] I am satisfied that Mr. Kerametlian's evidence shows that the Mark was in use during the relevant period, in association with the services stated in the registration. It is well established that the display of a trademark in an advertisement of 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 services in Canada [see *Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)]. Mr. Kerametlian's evidence establishes that the Owner's services were advertised during the relevant period, at least in the print advertisements appearing in concert programmes and playbills, and that these advertisements featured the Mark [paras 12(c), 12(d), and Exhibits C, D].

[12] Furthermore, considering the evidence as a whole and the light evidentiary burden in section 45 proceedings, I am prepared to accept that the Owner was willing and able to perform its services in Canada throughout the relevant period. Mr. Kerametlian's sworn evidence that the Owner's services have been provided since at least the early 2000's, and that invoices bearing the Mark were issued to customers throughout the relevant period, both support a *prima facie* conclusion that the Owner's services were in fact provided during the relevant period. This conclusion is further supported by the statements of the Owner's longstanding customers that services were received during the relevant period.

[13] Accordingly, I am satisfied that the Owner has established at least a *prima facie* case of use of the Mark in Canada during the relevant period, in association with the services stated in the registration, as required under section 45 of the Act.

DISPOSITION

[14] 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.

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Jaimie Bordman
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: Borden Ladner Gervais LLP

For the Registered Owner: Gilbert’s LLP