



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2024 TMOB 107

**Date of Decision:** 2024-06-03

## **IN THE MATTER OF A SECTION 45 PROCEEDING**

**Requesting Party:** Aird & McBurney LP

**Registered Owner:** Envirobusiness Directions Inc.

**Registration:** TMA465,016 for VISIONS OF UTOPIA

## **INTRODUCTION**

[1] This decision involves a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA465,016 for the trademark VISIONS OF UTOPIA (the Mark).

[2] The Mark is registered for use in association with the following:

### Goods

(1) Caps, stationery, namely, greeting cards, calendars, writing paper, envelopes and notepads; glasses and mugs.

(2) Sweatshirts and t-shirts.

### Services

(1) Advertising services for others and promoting the goods and services of others through the distribution of printed, audio-visual and electronic materials, through promotional contests, by rendering sales promotion advice

and by developing promotional campaign for businesses, all involving environmental messages and themes.

(the Goods and Services)

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

### **RECORD**

[4] At the request of Aird & McBurney LP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on February 3, 2023, to Envirobusiness Directions 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. The relevant period for showing use here is February 3, 2020 to February 3, 2023.

[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.

(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] Where an 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.

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Susan Antler, dated July 14, 2023, and accompanying Exhibits A through H. The relevant portions of Ms. Antler's evidence are summarized below and further discussed in my reasons for decision.

[9] Both parties submitted written representations and participated in an oral hearing. I wish to point out at this juncture that I have considered all of the parties' submissions including the cited authorities, however I will only be referring to those or portions of those directly and most relevant to my findings. As mentioned at the hearing, I also wish to remind the parties that consulting jurisprudence is an appropriate exercise of the Registrar's discretion and that the Registrar may rely on all relevant authorities, whether or not they are identified by the parties.

#### **EVIDENCE SUMMARY**

[10] Ms. Antler is the President of the Owner, which she founded in 1992. She states that the Owner's business is to assist others to advance and promote environmental issues and community causes related thereto. As such, it provides services to various non-profit organizations [paras 1, 3].

[11] Ms. Antler states that the Owner has used the Mark in Canada in association with the Goods and Services during the relevant period [paras 2, 4-5 and 13].

[12] Specifically with respect to use of the Mark in association with the Goods, Ms. Antler states that the Owner both develops designs for goods for its customers, as well as sells the Goods bearing the Owner's designs to its customers. She states that when the Owner provided the Goods to a consumer during the relevant period, such Goods clearly bore the Mark in some capacity [paras 4-5].

[13] Ms. Antler states that the Goods are sold through various avenues, including through orders from its main clients, or through being on display for sale at community events hosted by the Owner. She states that the Owner also puts on concerts and rents out a hall that it owns for other community events, that the Goods are on display for sale at such hall during all events and that individuals who purchase the Goods often pay for them in cash. Ms. Antler further states that paper receipts accompanied the Goods at the time of sale when sold to individuals at the hall [paras 9-11].

[14] Ms. Antler also states that Mark was used in Canada during the performance of the Services during the relevant period

[15] In support, Ms. Antler notably attaches:

- Sample photos of goods displaying the Mark, including directly on cards and on a t-shirt [para 6, Exhibit A];
- Sample photos of goods bearing a tag displaying the Mark that is stated to have been attached and visible at the time of sale, including on mugs, glasses, hats, shirts, a sweater, and notepad [para 7, Exhibit B];
- Examples of commissioned designs used on clothing and stationery, and an image of a 2021 calendar stated to have been created by the Owner for one of its customers, all displaying the Mark [para 8, Exhibit C];
- Sample receipts/invoices for the Goods and Services [paras 11-12, Exhibit D; and para 16, Exhibit G];
- A sample brochure template stated to have been created for the Owner's clients and displaying the Mark [para 14, Exhibit E]; and
- Sample promotional materials relating to environmental themes (including posters, lawn signs, logos, artwork, advertising, and

promotional messages, among other things) stated to have been created for the Owner's clients [para 15, Exhibit F].

### **REASONS FOR DECISION**

[16] The Requesting Party submits that the Mark has not been used in Canada throughout the relevant period and that it is "deadwood" that should be removed from the register. More specifically, the Requesting Party raises reliability issues with the Owner's evidence (including on sales and course of trade) and argues that there is no evidence of use in association with all the Goods and Services (notably because the Owner's way of displaying the Mark on tags and invoices is not use; Ms. Antler did not correlate the goods described in the affidavit—including those appearing on the exhibited photos—with the invoices; and the description of services in the invoices is broad and vague).

[17] It is well established that the purpose and scope of an expungement proceeding is to provide a simple, summary, and expeditious procedure for removing "deadwood" from the register. However, there is no particular type of evidence that must be provided and the evidence need not be perfect [see *Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)]. 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].

[18] In this regard, it is also appropriate to note that an affiant's statements are to be accepted at face value and must be accorded substantial credibility. It is the evidence as a whole that must be considered and it is not the proper approach (as the Requesting Party has done in its submissions) to dissect the affidavit with an overly technical approach in its

analysis that is inconsistent with the purpose of the proceeding [*Oyen Wiggs Green & Mutala LLP v Atari Interactive, Inc*, 2018 TMOB 79 at para 25].

[19] Ms. Antler here clearly asserts use of the Mark in Canada during the relevant period in association with the Goods and Services, supported by representative photographs and images showing how the Mark appears directly on some Goods and on the hang tags of others, by invoices displaying the Mark and promotional material she confirms was created during the performance of Services. She also describes the Owner's business, including how, where and to whom it sells its Goods. Ms. Antler further provides invoices setting out Services performed by the Owner during the relevant period.

[20] So, in light of this and for the reasons below, I am satisfied that the Owner has shown use of the Mark in Canada during the relevant period, but only in association with the Goods "Caps, stationery, namely, greeting cards, calendars ... and notepads; glasses and mugs" from goods (1), "Sweatshirts and t-shirts" in goods (2) and the Services "Advertising services for others and promoting the goods and services of others ... by developing promotional campaign for businesses, all involving environmental messages and themes". As there is no evidence of special circumstances in association with the remaining Goods and Services, the registration will be amended accordingly.

[21] More specifically, with respect to the Goods, Ms. Antler provides photographs showing the Mark directly on cards, on a t-shirt (Exhibit A) and on a wine glass (Exhibit B) and asserts that they are representative of how such goods appeared when they were sold to consumers during the relevant period. She also provides photographs of mugs, wine glasses, caps, shirts, a sweater, and a notepad showing the Mark on hang tags attached to these items with twine (Exhibit B).

[22] In its submissions, the Requesting Party referenced the decisions *Coastal Trademark Services v Edward Chapman Ladies' Shop Limited*, 2014 TMOB 80; *Moffat & Co v Big Erics Inc*, 2015 TMOB 52; and *GNR Travel Centre Ltd v CWI, Inc*, 2023 FC 2 as supporting its position that the Owner's inclusion of a tag with the Mark would not be considered use in association with the goods. First, I note that the *GNR* decision is currently under appeal (Court file No. A-26-23). Second, the circumstances of all of these decisions can be distinguished from those I am considering here, notably with respect to the context of the Owner's business. It is trite law that each case must be decided on its own merits having regard to the evidence submitted. In contrast to those cases, the Owner in the present case is not in the business of, *per se*, operating a store or selling third party merchandise. The exhibited hang tags here are also not merely "some form of price tag[s]" and, in my view, in the specific context of the Owner's business, served to provide the notice of association required by section 4(1) of the Act. Even if I am wrong in so finding, to the extent that at least the handwritten invoices (further discussed below) would have accompanied the Owner's goods at the point of sale/delivery, notice of association was still nevertheless provided between the Mark and the invoiced goods.

[23] Again, evidence in a section 45 proceeding must be considered as a whole, and focusing on individual pieces of evidence in isolation is not the proper approach [see *Kvas Miller Everitt v Compute (Bridgend) Ltd* (2005), 47 CPR (4th) 209 (TMOB); and *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB)]. For example, I must not consider the hang tags or invoices alone, but together with all of the statements made in the affidavit and other exhibits filed.

[24] I should also mention at this juncture that I do not consider the issues raised by the Requesting Party in respect of the Owner's invoices (such as,

for example, the fact that Ms. Antler uses the terms invoices and receipts interchangeably) as dispositive or even as particularly problematic in the context of this proceeding.

[25] With respect to the goods sold, Ms. Antler provides invoices (mostly handwritten) from March 2020, November 2021, March 2022, June 2022, and January 2023 for caps, calendars, (post)cards, mugs, (wine) glasses, t-shirts and sweatshirts (Exhibit D). Each invoice clearly displays the Mark with an indication that the Mark is a registered trademark of the Owner. While none of the goods listed on these invoices are directly identified with the Mark, the Mark is found in up to four instances on these documents: at the top, centered and separate from general information about the business such as address or phone number; in a disclaimer near the bottom, sometimes following the “description” section; and either near the bottom as a phrase on its own with the ® symbol; and/or at the bottom in a notice stating that the Mark—again followed by the ® symbol—is a registered trademark of the Owner.

[26] Additionally, while Ms. Antler does not correlate the goods described in her affidavit (including the ones shown in Exhibit D) with those listed in the subject registration, the Owner provides some such correlations in its written representations. For example, the Owner correlates the caps in the invoices of March 17, 2020 and June 10 and 12, 2022 (Exhibit D) with that shown in one of the photographs of hang tagged items (Exhibit B). I also take this opportunity to note that there is evidence of transfers of/display of the Mark in association with cards, postcards and wine glasses, which I accept correlate with the registered goods “greeting cards” and “glasses”.

[27] All in all, in reading the evidence as a whole and accepting Ms. Antler’s statements at face value, I accept that the goods listed in the Exhibit D



invoices were sold in the normal course of trade in Canada during the relevant period.

[28] Similar invoices provided to customers further set out the following services: “Strategy design and program implementation”, “Communication including advertising and promotion design/products/implementation”, “Member services management”, “Regulatory monitoring and initiatives”, and “Budget management and revenue generation” (Exhibit G).

[29] At the oral hearing, the Requesting Party conceded—and I agree—that this listing may reflect the Owner’s registered services described as “Advertising services for others and promoting the goods and services of others ... by developing promotional campaign for businesses”.

[30] That being said, the evidence does not show use in association with “writing paper” or “envelopes” and contains no specific reference to distribution of any kind of materials, promotional contests or sales promotion advice. I am also left to speculate as to if and how any of the Services would be reflected in or connect to “Strategy design and program implementation”, “Member services management”, “Regulatory monitoring and initiatives”, and “Budget management and revenue generation” services.

[31] The Owner submits that the goods “stationary” is a general category and that similarly, there is one category of Services *i.e.* advertising services for others and promotion of others’ goods and services. Relying on *Saks & Co v Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD) and *McFadden Fincham v Produits Bébé Confort Inc* (2004), 31 CPR (4th) 388 (TMOB), the Owner submits that it is not required to furnish direct evidence of every item listed within the categories of stationary and advertising/promotional services; it is enough that the Owner has shown use

of the Mark with goods and services that fall within the respective two categories as described.

[32] Specifically with respect to the Owner's "stationary" category, I adopt the following comments of the Registrar in *McFadden* at pages 391-392:

A trade-mark holder is ... not required to furnish "either direct evidence or documentary proof" regarding every item in a given category. In my opinion, that assumes that the Registrar *can infer* from the evidence provided that there was use, in other words business transactions took place involving *each* of the wares, at some time during the three-year period immediately preceding the date of the notice. In contrast to *Saks*, there is nothing in the affidavit in this case that would allow me to make such inference. I therefore believe that the precedent applicable to this case is *John Labatt Ltd. v. Rainier Brewing Co.* (1984), 80 C.P.R. (2d) 228 (F.C.A.).

[33] More generally, I also note that the Federal Court has held that the Registrar must be able to "rely on an inference from proven facts rather than on speculation" [*Diamant Elinor, supra*, at para 11; see also *Curb v Smart & Biggar*, 2009 FC 47]. So it is not for the Registrar to speculate, but for the Owner to show the connection between the registered goods and services and those included in the evidence [*Fraser Milner Casgrain LLP v Fabric Life Ltd*, 2014 TMOB 135 at para 13].

[34] In light of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered goods "writing paper" and "envelopes", or the following from the registered services: "... through the distribution of printed, audio-visual and electronic materials, through promotional contests, by rendering sales promotion advice" within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances excusing non-use of the Mark before me, the registration will be amended accordingly.

## **DISPOSITION**

[35] 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, registration No. TMA465,016 will be amended to delete the following:

### Goods

(1) ... writing paper, envelopes ...

### Services

... through the distribution of printed, audio-visual and electronic materials, through promotional contests, by rendering sales promotion advice ...

[36] The statement of goods and services will now read as follows:

### Goods

(1) Caps, stationery, namely, greeting cards, calendars and notepads; glasses and mugs.

(2) Sweatshirts and t-shirts.

### Services

(1) Advertising services for others and promoting the goods and services of others by developing promotional campaign for businesses, all involving environmental messages and themes.

Iana Alexova  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** 2024-04-18

## **APPEARANCES**

**For the Requesting Party:** Lawrence Veregin

**For the Registered Owner:** Meika Ellis

## **AGENTS OF RECORD**

**For the Requesting Party:** Aird & McBurney LP

**For the Registered Owner:** Smart & Biggar LP