



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 125

Date of Decision: 2024-07-04

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: CSI DANISMANLIK VE DESTEK HIZMETLERI ANONIM
SIRKETI

Registered Owner: Motel One GmbH

Registration: TMA930,560 for MOTEL ONE & Design

OVERVIEW

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA930,560 for the trademark MOTEL ONE & Design reproduced below (the Trademark), owned by Motel One GmbH (the Owner).



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

Accommodation [*sic*] reservation services in respect of accommodation in hostels, motels and hotels situated outside of Canada and the United States.

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

THE RECORD

[4] On December 16, 2022, at the request of CSI DANISMANLIK VE DESTEK HIZMETLERI ANONIM SIRKETI (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T 13 (the Act) to the Owner.

[5] The notice required the Owner to show whether the Trademark 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 the Trademark was last in use and the reason for the absence of such use since that date. The relevant period for showing use is therefore between December 16, 2019 and December 16, 2022.

[6] In response to the Registrar's notice, the Owner submitted the affidavit of Stefan Florian Lenze, director and co-Chief Executive Officer of the Owner, sworn on July 14, 2023, together with Exhibits A to L.

[7] Only the Owner filed written representations and was represented at a hearing.

THE EVIDENCE

[8] In his affidavit, Mr. Lenze states that the Owner, to which he refers as "Motel One", is a hotel chain and operates hotels in Germany, Austria, Belgium, the Netherlands, Czech Republic, Denmark, France, Poland, Spain, Switzerland, and the United Kingdom. For the sake of simplicity, I note here

that while Mr. Lenze often references the Owner's "hotels/motels", I will refer to "establishments" in this decision.

[9] Mr. Lenze attests that, during the relevant period, Motel One used the Trademark in association with the services listed in the registration. With respect to use in Canada, Mr. Lenze states as follows [para 7]:

There are many ways in which Canadian consumers can, and could during the Relevant Period, make accommodation reservations at one of Motel One's hotels/motels:

- a. through the Motel One website found through the URL *motel-one.com* (the "Website");
- b. through the Motel One application entitled "Motel One App";
- c. through third party booking websites including: *booking.com*, *expedia.ca*, and through other HRS (hotel reservation services) and GDS (global distribution systems) channels; or
- d. by calling, faxing, emailing or simply walking into a Motel One hotel.

[10] Mr. Lenze states that the Owner operates and controls its online accommodation reservation system. He further states that "when a consumer makes an online booking through the Website or Motel One App, information on availability and price is retrieved directly from the accommodation reservation system" [para 8].

[11] In support of the above, Mr. Lenze provides a "screenshot of the reservation page found through the Website, which displays a reservation being made from a computer in Canada" [Exhibit A]. Mr. Lenze describes the exhibited webpage as "representative of how the reservation page appeared and functioned during the relevant period for Canadian customers" [para 9]. The Trademark is displayed in the header of the exhibited webpage.

[12] Mr. Lenze also provides “a screenshot of the Motel One App” [Exhibit B]. He states that the app was available through the App Store and the Google Play Store in Canada during the relevant period. Exhibit B appears to be a screenshot of a webpage providing links to download the Motel One App; the Trademark is displayed in the header of that webpage.

[13] In further support, Mr. Lenze attaches a sample confirmation email which he explains is sent to customers when they finalise a reservation [Exhibit C]. Mr. Lenze describes the exhibited email as “representative of the emails that Canadian customers would have received during the Relevant Period” [para 11]. The Trademark is displayed in the exhibited email.

[14] Mr. Lenze attests that 2,641 reservations for the Owner’s establishments were made through the Website from within Canada during the relevant period, amounting to over 1 million Euros in revenue. He also attests that, during the relevant period, there were over 45,800 web sessions from Canadian users and, in support, provides web analytics for the Website [Exhibit D].

[15] According to Mr. Lenze, reservations made through the Motel One App, by phone, fax, email, or through third party reservation services are not easily tracked, but “happen often” [para 13]. Mr. Lenze provides a list of the total number of clients with a Canadian billing address who reserved and stayed at an establishment owned by the Owner, the number of rooms, and net sales for each such establishment during the relevant period [Exhibit E]. Each row of the Exhibit E list refers to one of the Owner’s establishments. According to the list, more than 20,000 Canadian clients, in over 13,900 rooms, attended the Owner’s establishments relevant period, totaling revenue exceeding 2 million Euros.

[16] Mr. Lenze also provides what appears to be an internal document, which he describes as showing reservations made through the Owner's accommodation reservation system by Canadians between December 2017 and August 2022 [Exhibit F]. The exhibited document contains entries for specific reservations, including customer names and addresses in Canada, many of them dated within the relevant period.

[17] In addition to the above, Mr. Lenze provides invoices [Exhibit G], which Mr. Lenze states are representative of invoices provided to Canadian consumers at the time of purchase of the services. The Trademark is displayed on each of the exhibited invoices, most of which are dated within the relevant period and are issued to customers with Canadian addresses.

[18] In his affidavit, Mr. Lenze also provides details regarding the Owner's loyalty program [Exhibit H]; the Owner's promotional efforts such as website advertising [Exhibit I], marketing emails [Exhibit J], and social media advertising [Exhibit K]; and online reviews of the Owner's services from Canadian customers [Exhibit L].

REASONS

[19] 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.

[20] The evidence furnished by the Owner is clear and thorough, and without the benefit of representations from the Requesting Party, I agree with the Owner that the evidence meets the burden imposed by the Registrar's notice.

[21] Notably, the evidence clearly shows that, during the relevant period, customers from Canada accessed the Owner's Website and made reservations for the Owner's establishments through the Website. The evidence also shows that the Trademark was displayed on the Website.

[22] As such, I find that the Owner has shown that the Trademark was displayed in the performance of "Accommodation [*sic*] reservation services in respect of accommodation in hostels, motels and hotels situated outside of Canada and the United States" and I am therefore satisfied that the Owner demonstrated use of the Trademark in Canada within the meaning of sections 4(2) and 45 of the Act.

DISPOSITION

[23] 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.

Eve Heafey
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2024-07-03

APPEARANCES

For the Requesting Party: No one appearing

For the Registered Owner: Meika Ellis

AGENTS OF RECORD

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

For the Registered Owner: Smart & Biggar LP