



# Canadian Intellectual Property Office

## THE REGISTRAR OF TRADEMARKS

**Citation:** 2025 TMOB 11

**Date of Decision:** 2025-01-27

## IN THE MATTER OF A SECTION 45 PROCEEDING

**Requesting Party:** Golden Delta Enterprises, Inc.

**Registered Owner:** BD MULTI-MEDIA Société anonyme

**Registration:** TMA551,737 for DEMONIA

## 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. TMA551,737 for the trademark DEMONIA (the Trademark), owned by BD MULTI-MEDIA Société anonyme (the Owner).

[2] The statement of goods and services is reproduced below:

### **Goods**

(1) Perfumes, toilet water; magnetic data carriers, namely pre-recorded video cassettes.

(2) Albums, books, catalogues, calendars, newspapers, leaflets, journals, magazines, photographs; clothing namely polo shirts, shirts, jackets.

(3) Jewellery, precious stones, booklets, handbooks, t-shirts, sports shirts, sweatshirts, tank tops.

## **Services**

(1) Radio and television broadcasting, cable television broadcasting, communications by computer terminals, namely, e-mail service, internet access service, by telegrams, by telephone, namely, the provision of long distance phone services; information relating to telecommunication, facsimile transmission, paging services (radio or telephone), publication of books and magazines, rental of cine-films, rental of sound recordings.

(2) Electronic mail; newspaper subscription.

## **PROCEEDING**

[3] At the request of Golden Delta Enterprises, Inc. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on July 5, 2023, to the Owner.

[4] The notice required the Owner to show whether the Trademark 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.

[5] The relevant period for showing use is July 5, 2020 to July 5, 2023.

[6] 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.

[7] In response to the Registrar’s notice, the Owner furnished the statutory declaration of Jim Dorra, sworn on February 2, 2024, together with Exhibits A to F.

[8] Only the Requesting Party filed written representations, and no hearing was held.

## **EVIDENCE**

[9] Mr. Dorra is the Owner's CEO. He explains that the Owner operates in various sectors of activity, including [translation] "the erotic niche market through its brand DEMONIA". He further adds that the Owner is well-known in the sector of [translation] "bondage, discipline, sadism, masochism, and fetichism" [paras 1, 3, and 4].

[10] Mr. Dorra explains that the Owner cannot demonstrate use of the Trademark in Canada during the relevant period for the following reasons:

- For the sales of goods in Canada, the Owner [translation] "has no choice but to focus on online platforms and to use the Amazon platform", for its [translation] "agility in transactions and direct contact with customers" given the nature of its business and its customers [para 9].
- To facilitate the deployment of sales through Amazon, the Owner hired the Koobiak company to act as an intermediary [para 10].
- Even though Koobiak, on behalf of the Owner, tried to upload the Owner's banking information for their Amazon's account, it encountered technical difficulties [paras 12 to 14].

[11] Attached to the Dorra declaration are the following relevant Exhibits:

- Exhibit B consists of an invoice from Amazon.com Services LLC to the Owner, dated June 30, 2021 for "Selling on Amazon Fees".
- Exhibits C, D and E consist of email exchanges between the Amazon Seller Support and Koobiak, dated November 24, 2022, December 19, 2022, and January 5, 9 and 10, 2023 about technical difficulties to upload the Owner's banking information to activate its account.

## **REASON FOR DECISION**

[12] As there is no evidence of use of the Trademark in Canada during the relevant period, the issue is whether, pursuant to section 45(3) of the Act, there were special circumstances which excused such non-use. The general rule is that absence of use will be penalized by expungement, but 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].

[13] To determine whether special circumstances have been demonstrated, the Registrar must first determine, in light of the evidence, why in fact the trademark was not used during the relevant period. Second, the Registrar must determine whether these reasons for non-use constitute special circumstances [*Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA) (*Harris Knitting*)]. The Federal Court has held that special circumstances mean circumstances or reasons that are “unusual, uncommon, or exceptional” [*John Labatt Ltd v Cotton Club Bottling Co* (1976), 25 CPR (2d) 115 (FCTD) at para 29].

[14] The only evidence provided by the Owner is three email exchanges between Koobiak and Amazon Seller Support about technical difficulties to process the Owner’s banking information. There is no indication of any problem prior to November 24, 2022, even though the Owner’s account has been opened since at least, June 30, 2021, as it appears from the Exhibit B invoice. I do not consider these technical difficulties to be unusual, uncommon or exceptional, but rather an issue that is certainly not limited or unique to the Owner.

[15] In any event, the technical difficulties do not account for the entire relevant period. In this respect, it has been held that special circumstances must apply to the entire relevant period [see *Oyen Wiggs Green & Mutala LLP v Rath*, 2010 TMOB 34 at para 12].

[16] Accordingly, I am not satisfied that the Owner has provided reasons for non-use of the Trademark amounting to special circumstances.

[17] Even if I were to accept the technical difficulties as special circumstances, I would not find these to excuse the non-use. Particularly, the focus on the Amazon platform is likely due to a voluntary decision from the Owner rather than circumstances beyond its control. Moreover, the absence of use dates back to the registration date of the Trademark in 2001; this is a lengthy period of non-use that would weigh heavily against the Owner.

**DISPOSITION**

[18] 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 expunged.

Ann-Laure Brouillette  
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:** ROBIC AGENCE PI S.E.C./ ROBIC IP AGENCY LP

**For the Registered Owner:** LAVERY, DE BILLY, LLP