



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 121

Date of Decision: 2025-06-03

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Darick Battaglia

Registered Owner: The Corporation of the City of Barrie

Registration: TMA335,326 for KEMPENFELT KELLY

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. TMA335,326 for the trademark KEMPENFELT KELLY (the Mark), owned by The Corporation of the City of Barrie (the Owner).

[2] For the reasons that follow, the registration will be amended.

THE RECORD

[3] At the request of Darick Battaglia (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on July 19, 2024. The notice required the Owner to show whether the Mark had been used in Canada in association with 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 use since that date. In this case, the relevant period for showing use is July 19, 2021, to July 19, 2024.

[4] The Mark is registered for use in association with the following goods and services:

Goods: (1) T-shirts and caps.

Services: (1) Restaurant, tavern and lounge services; the operation of carnivals, fairs; sporting activities, namely water related sports such as motor boat racing, sailing, canoeing, water skiing, wind surfing and fishing; curling, skating and broomball; retail stores.

[5] The relevant definitions of “use” in the present case are set out in section 4 of the Act:

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.

[6] In response to the Registrar’s notice, the Owner furnished the affidavit of Stephanie Schlichter, its Director of Economic and Creative Development.

[7] Both parties filed written representations; no oral hearing was held.

ANALYSIS

[8] 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 [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at para 9].

[9] However, it is not enough to merely assert that a trademark has been used in association with goods or services; the registered owner must still establish a *prima facie* case of use of the trademark in association with *each* of the goods and services specified in the registration [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)]. In other words, 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* at para 11; see also *Smart & Biggar v Curb*, 2009 FC 47].

No Evidence of Use with Goods

[10] In this case, there is no evidence of the Mark on t-shirts and caps or associated with t-shirts and caps. While the Owner provides evidence of camp t-shirts bearing the image of the Kempenfelt Kelly monster, the Mark does not appear on them (para 5, Exhibits B and C). The Owner also provides evidence that an individual was granted the right to use the trademark and likeness, however, there is no evidence that any goods were transferred to consumers by Ms. Kennedy (para 8). As there is no evidence of special circumstances before me, the goods will be deleted from the registration pursuant to section 45(3) of the Act.

Evidence of Use with Some Services

[11] I am satisfied that the display of KEMPENFELT KELLY on a City of Barrie Waterfront Heritage Sign at the City’s Tiffin Boat Launch (Schedule A) constitutes trademark use for the purposes of section 45 for some of the services. I infer from the evidence that the display of the Mark on a sign by a boat launch (as shown in part below) is use in performance or advertising of the services: sporting activities, namely water related sports such as motor boat racing, sailing, canoeing, water skiing, wind surfing and fishing. The operation of a boat launch is ancillary to these services as a boat launch could be used to access the water for all of these and in particular, this is suggested by the map at Exhibits A and D.



[12] The Requesting Party submits that KEMPENFELT KELLY is not being used as a trademark to distinguish the source of the associated services. *In United Grain Growers Ltd v Lang Michener*, 2001 FCA 66 [United Grain Growers] the Federal Court of Appeal found that it is unnecessary to consider issues of distinctiveness in section 45 proceedings:

No words in section 45 direct the Registrar to re-examine whether the registered trade-mark is used for the purpose of distinguishing, or so as to distinguish, wares. Rather, the Registrar's duty under section 45 is only to determine, with respect to the wares specified in the registration, whether the trade-mark, as it appears in the Register, has been used in the three years prior to the request.

[13] While the Owner has also included a map with KEMPENFELT KELLY on it, I do not find that the sign or map is sufficient to maintain the registration with respect to the remaining services listed below. There is no evidence that the Owner or a licensee performs these services or has advertised them and is willing to perform them in association with the Mark.

Restaurant, tavern and lounge services; the operation of carnivals, fairs; curling, skating and broomball; retail stores.

With respect to "retail stores", the Owner submits that its arrangement with Ms. Kennedy is sufficient to maintain the registration. It is not. There is no evidence that the

Mark appeared in association with the advertising or performance of these services or that Ms. Kennedy offered them or was prepared to offer them.

[14] While the Owner's evidence is that the shape of the Kempenfelt Kelly sea monster is lit up at the Rotary Festival and it has plans to use the Mark at an upcoming Halloween festival (paras 7 and 9), neither of these facts constitutes use of the Mark in association with any of the services, nor would constitute special circumstances which would excuse non-use of the Mark. As such the services listed in paragraph 13 will be deleted from the registration.

DISPOSITION

[15] In view of all of the foregoing, 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 amended to delete the goods and services below:

Goods: (1) T-shirts and caps.

Services: (1) Restaurant, tavern and lounge services; the operation of carnivals, fairs; curling, skating and broomball; retail stores.

[16] The amended registration is:

Services: (1) sporting activities, namely water related sports such as motor boat racing, sailing, canoeing, water skiing, wind surfing and fishing.

Natalie de Paulsen
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: SISKINDS LLP

For the Registered Owner: MIMI R. PALMER