Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2026 TMOB 24

Date of Decision: 2026-02-11

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Shift Law Professional Corporation

Registered Owner: Sylviette Brown

Registration: TMA858,110 for MYTHICAL BIRD ROC

INTRODUCTION

[1] At the request of Shift Law Professional Corporation (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on September 4, 2024, to Sylviette Brown (the Owner), the registered owner of registration No. TMA858,110 for the trademark MYTHICAL BIRD ROC (the Mark), shown below:

[2] The Mark is registered in association with the following goods and services:

> GOODS
>
> (1) Leather and denim vests and jackets, t-shirts, hooded shirts, denim and leather skirts, leather vests; mythical jewelry including rings, earrings and pendants
>
> SERVICES
>
> (1) Manufacturing and distribution of hand crafted and custom designed clothing and jewelry.

[3] The notice required the Owner to show whether the Mark was used in Canada in association with each of the registered goods and services at any time within the three-year period immediately preceding the date of the notice. If the mark was not so used, the Owner is required to provide the date when the Mark was last in use and the reason(s) for the absence of use since that date. In this case, the relevant period for showing use is September 4, 2021 to September 4, 2024.

[4] The definitions of "use" 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.
>
> 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.
>
> 4(3) A trademark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

[5] In the absence of use, pursuant to section 45(3) of the Act, the registration is liable to be expunged, unless the absence of use is due to special circumstances.

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Sylviette Brown, sworn on November 11, 2024 (Affidavit 1).

[7] The Requesting Party submitted written representations. Thereafter, the Owner was granted a request for a retroactive extension of time to file a second affidavit of Ms. Brown, sworn on February 13, 2025 (Affidavit 2).

[8] The Requesting Party was then invited to file further written representations with respect to Affidavit 2, following which the Owner's written representations, if any, would be due. Neither party elected to file further written representations or attend a hearing.

THE OWNER'S EVIDENCE

[9] Affidavit 1 includes a description of the history and cultural significance of the Mark. Ms. Brown states that her son, a former member of the Rock Machine Motorcycle Club, designed the griffon head portion of the Mark [para 3]. She routinely refers to the griffon head portion of the Mark as the "Emblem", and often uses this term interchangeably with the Mark. The Mark is also later referred to as the "Patch" or the "Club Patch" as the entire Mark forms a patch that is worn by members of the Rock Machine Motorcycle Club [Affidavit 2, para 11].She also indicates that the griffon's head imagery was incorporated into the branding of her Little River Farm (LRF), located in the Zephyr Wetland Complex in Ontario [para 5].

[10] Ms. Brown states that the registered goods "have yet to reach the end-to-end process", since "[p]roduct refinement had to be adopted to an attainable medium and, therefore has never been brought to market from

the drafted artistic concepts" [para 8]. Nevertheless, she explains, the griffon head design is used by LRF "on farm business cards attached to charity and client food baskets, workers' clothing, reusable bags used and given, on personal and business vehicles for business tradename exposure" [para 11].

[11] As Exhibit A, she attaches photographs of the griffon head design appearing on a business card, a mug and pens, her email signature, sweatshirts, t-shirts, bags, shopping bags, an automobile decal, and jars of preserves. She also attaches photographs of the Mark as registered appearing on a leather jacket. Photographs of "Bandidos jewelry" are also attached, but it is not clear from the photograph whether the Mark appears on these goods. There is no indication in Affidavit 1 that any of these goods were transferred in Canada in the normal course of trade.

[12] In Affidavit 2, Ms. Brown provides a variety of "personal special circumstances" that contributed to non-use [paras 9 to 12]. These circumstances are:

- The fact that using the entire Mark would subject the Owner to "Biker Laws" that only permit the sale of items bearing the Mark to "full patch members" [paras 10 and 12.v];
- The president of the Rock Machine Motorcycle Club's unauthorized manufacture of goods and use of the Mark [para 11];
- The Owner's son being involved in a serious motorcycle accident in 2021 and suffering long-term injuries [para 12.i];
- Factories in Ontario failing to re-open after the Covid-19 pandemic, leaving labour shortages and unfilled contracts [para 12.ii]; and

- Chinese manufacturers abandoning offshore contracts and denying small orders [12.iii].

[13] In spite of these circumstances, Ms. Brown explains that more will be done "to advance direct sale to the public of the trademark emblem" [Affidavit 2 at para 12.iv)]. Ms. Brown further confirms that custom vests and jewelry were offered but no orders have been made [para 12.v], and that "product lines have been used primarily by employees of the farm business entity and not from multiple direct sales to the general public" [para 14].

[14] As Exhibits B and C, she attaches what she describes as an "internet warning" to the effect that only "patched members" of Rock Machine may wear clothing displaying the Mark.

ANALYSIS

Use of the Mark

[15] As noted above, in the photographs provided by the Owner in Exhibit A of Affidavit 1, it appears that only the griffon head imagery has been placed on some of the goods contained in the registration such as the t-shirts and hooded sweatshirts (as reproduced below). In some cases, it appears that the griffon head portion of the Mark appears alongside the words "Little River Farm" and/or a design element.

[16] As submitted by the Requesting Party, a variation of a trademark amounts to use of that trademark as registered if "the same dominant features are maintained and the differences are so unimportant as not to mislead an unaware purchaser" [*Promafil Canada Ltée v Munsingwear Inc. (*1992), 1992 CanLII 12831 (FCA), 44 CPR (3d) 59 (FCA) at 70-71]. The Requesting Party submits that the Owner has not established evidence of use of the Mark as registered given that the evidence is comprised of images of goods bearing only a portion of the Mark, namely, the griffon head design [Requesting Party submissions, para 6].

[17] I agree with the Requesting Party that the absence of the textual elements substantially changes the Mark as registered. The text components of the Mark are a dominant feature of the Mark based on the associations conveyed by the text, the visual predominance of the text, and the text serving as the distinguishing feature of the Mark.

[18] Accordingly, I do not consider the display of the griffon head design alone, absent the text elements, to amount to display of the Mark as registered. I agree with the Requesting Party's assessment that "use of the 'emblem' on its own is not sufficiently similar to the Mark so as to create the same commercial impression and to constitute use of the Mark as a whole" [Requesting Party submissions, para 10].

Transfers

[19] Further, there is no indication in either affidavit that there were any transfers of the registered goods in the normal course of trade during the relevant period. Indeed, the Owner asserts in her first affidavit that goods have "never been brought to market from the drafted artistic concepts" [Affidavit 1, at para 8]. With respect to the jewelry-related goods, the Owner concedes that the products "have yet to reach end-to-end process" [para 8]. Likewise, the clothing goods, have "initiate[d] interest", but do not appear to

have been launched [para 8]. As for the motorcycle jacket displaying the Mark that appears in Exhibit A to Affidavit 1, no context is provided with respect to this photograph, including whether it was taken during the relevant period, whether it reflects a transfer in the normal course of trade, and whether the Owner was the source of this product.

[20] With respect to the services, I also agree with the Requesting Party that the Brown affidavits are silent regarding the manufacturing and distribution of custom jewelry and clothing. At best, the Owner provides an explanation for why jewelry and clothing goods were "never brought to market" as the products remained in the "concept stage" [Affidavit 1, at para 8]. However, the Owner does not assert that the Mark was used in association with the registered services or that such services were offered to Canadians during the relevant period.

[21] I am therefore not satisfied that the Owner has demonstrated use of the Mark in association with any of the registered goods or services within the meaning of sections 4 and 45 of the Act.

SPECIAL CIRCUMSTANCES

[22] As there is no evidence of use of the Mark during the relevant period, the issue remains whether special circumstances existed to excuse the absence of use.

[23] 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].

[24] To determine whether such special circumstances have been established, the Registrar must first determine, in light of evidence, why in

fact the trademark had not been 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 123].

[25] If the Registrar determines that the reason for non-use constitute special circumstances, the Registrar must still decide whether such special circumstances excuse the period of non-use. This involves the consideration of three criteria: (i) the length of time during which the trademark has not been in use; (ii) whether the reasons for non-use were beyond the control of the registered owner; and (iii) whether there exists a serious intention to shortly resume use [*Lander Co Canada Ltd v Alex E Macrae & Co* (1993), 46 CPR (3d) 417 (FCTD) at 420, citing *Harris Knitting*].

Why the Mark was not used during the relevant period

[26] In Affidavit 2, Ms. Brown asserts that non-use of the Mark during the relevant period can be attributed to the following:

- Unauthorized persons selling the "patch" via the internet and manufacturing it abroad [para 11].
- Personal circumstances including the Owner's son's motorcycle accident on September 21, 2021 [para 12].
- Factories failing to re-open post-Covid, causing unfilled contracts, and contract abandonment [para 12].
- "Biker rules" restricting use of products displaying the Mark to "full patch" members of the Rock Machine Motorcycle Club [paras 9-12].

Do the reasons for non-use constitute special circumstances

[27] In order for the reasons for non-use to constitute special circumstances, they must have the hallmarks of being unusual, uncommon or exceptional and beyond the control of the Owner.

[28] With respect to the Owner's son's motorcycle accident, I note that neither affidavit provides any information with respect to the Owner's son's involvement with her business, other than having created the griffon head design. Accordingly, there is no information to indicate why her son's injuries would have prevented her from using the Mark.

[29] With respect to unauthorized use of the "Patch" incorporating the Mark and the risk of a "trade war", I am not satisfied that this circumstance is either unusual, uncommon, or exceptional. Unauthorized use of a trademark does not preclude the Owner from using their trademark. The Owner electing not to use her Mark while unauthorized use exists amounts to a voluntary business decision.

[30] With respect to the Owner's submissions regarding pandemic-related factory closures, absent further context, it does not appear that these would amount to special circumstances justifying non-use. In particular, the Owner attests that on March 9, 2022, many factories in Ontario closed, and that on December 7, 2022, offshore contracts with Chinese factories were abandoned or ignored and would not take small orders [para 12]. However, it is not clear that the Owner would have used the Mark in association with any of its goods or services if not for these manufacturing disruptions, particularly in view of the other reasons for non-use cited in its evidence. As such, I do not find that the Owner has provided sufficiently specific evidence demonstrating that use of the Mark would have resumed during the relevant period if not for the COVID-19 pandemic [see *The Wonderful Company LLC v Fresh Trading Limited*, 2023 TMOB 8].

[31] Finally, with respect to the "biker rules" described by the Owner, it is not clear that she would have used the Mark but for these restrictions. In this respect, I note that the totality of the evidence indicates that the Owner's business is the Little River Farm, and that goods and promotional material relating to this business display the griffon head design rather than the Mark as registered. It is not clear from the affidavits whether the Owner also intended to sell clothing or jewellery to members of Rock Machine, whether in the course of LRF's activities or separately.

[32] In any event, even if I considered the "biker rules" issue to amount to a special circumstance beyond the control of the Owner, I would not find that it would excuse non-use pursuant to the *Harris Knitting* test. In this respect, the date of first use of the Mark is not clear from the evidence. As noted above, the griffon head design is not the Mark as registered, and as for the jacket displaying the Mark as registered, there is no evidence as to when this product was transferred in the normal course of trade, or even that it originated from the Owner as opposed to the Owner's son or a third party. Where there is no date of first use, the length of time that the Mark has not been in use is calculated from the date of registration, which in this case is August 20, 2013 [see *Oyen Wiggs Green & Mutala LLP v Rath*, 2010 TMOB 34]. This lengthy period of non-use weighs heavily against the Owner.

[33] Furthermore, in order to determine whether non-use of the Mark can be excused, the Registrar must be satisfied that there is a serious intention to shortly resume use. In this case, the evidence is insufficient to infer that there is a serious intention to shortly resume use. Instead, the evidence suggests that the Owner has prioritized use of the griffon head design, rather than the Mark as registered. This appears to be supported by the Owner's statement that "the intended mark has always primarily been the 'Mythical Bird Roc' therefore the product line was designed and developed as

a marketable and identifiable Trademark made to apply to the live and ongoing business of 'Little River Farm'" [Affidavit 2, para 13]. In any event, the intention to shortly resume use must be substantiated by "a sufficient factual basis" [*NTD Apparel Inc v Ryan*, 2003 FCT 780; see also *Arrowhead Spring Water Ltd v Arrowhead Water Corp* (1993), 47 CPR (3d) 217 (FCTD)]; in this case, there is no evidence on the record to indicate any concrete steps and a timeline for the resumption of use of the Mark.

[34] As such, the reasons for non-use in this case do not constitute special circumstances.

DISPOSITION

[35] 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.

Gregory Melchin
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Requesting Party: Shift Law Professional Corporation

For the Registered Owner: No agent appointed