



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2015 TMOB 186**  
**Date of Decision: 2015-10-19**

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

**Alec Szibbo**

**Requesting Party**

**and**

**1772887 Ontario Limited**

**Registered Owner**

**TMA495,094 for KIDS GUIDE TO  
VANCOUVER & Design**

**Registration**

[1] At the request of Alec Szibbo (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on January 13, 2014 to 1772887 Ontario Limited (the Owner), the registered owner of registration No. TMA495,094 for the trade-mark KIDS GUIDE TO VANCOUVER & Design (the Mark), shown below:



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

Printed publications namely books and booklets of all kinds, newspapers, brochures, pamphlets, manuals, guides, maps, posters, pictures and photographs relating to children's activities in specified locations in Canada.

[3] The Mark is also registered for use in association with the following services:

Provision of information and advisory services relating to children's activities by providing information and advice regarding specific entertainment and educational services directed to parents and children to promote and inform and advise on specified available children's activities and family entertainment services through printed publications, print advertising, tourist information booths, point of purchase signage, promotions contests and cooperative promotional efforts with content providers, in specified locations in Canada.

[4] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with each of the goods and services specified in the registration, at any time between January 13, 2011 and January 13, 2014. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[5] The relevant definitions of use with respect to goods and services are set out in sections 4(1) and 4(2) of the Act as follows:

4(1) A trade-mark 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 trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[6] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the goods and services specified in the registrations during the relevant period.

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Deborah Trepanier, sworn on April 17, 2014 in Toronto, Ontario. Both parties filed written representations; an oral hearing was not requested.

### The Owner's Evidence

[8] In her affidavit, Ms. Trepanier attests that she is the Group Publisher of *Where* magazine, *Kids' Guide Vancouver* and other publications of the Owner, doing business through incorporated divisions such as its Where business division.

[9] She attests that the Owner has been publishing the registered goods and performing the registered services continuously since September 21, 2005. In particular, Ms. Trepanier attests that *Kids' Guide Vancouver* (the Guide) is published and distributed in Canada by the Owner through its Where business division. She attests that the Guide is published annually and is distributed to select hotels and resorts, visitor information centres, attractions, restaurants and other select outlets in Canada. She further attests that the Guide has had steady distribution in Canada and that, in particular, the number of copies distributed in the relevant period was at a "select distribution average between 115,000 to 125,000".

[10] Ms. Trepanier provides that children, parents and families in the Greater Vancouver area are the primary target for the Guide. In describing the Guide, she attests that:

VANCOUVER KIDS' GUIDE provides a colourful, informative map, guide, booklet, brochure, pamphlet, pocket manual, poster containing pictures and photographs relating to children's activities, all rolled into one, in specified locations across Canada including the greater Vancouver area.

[11] Ms. Trepanier explains that the Guide provides information and advice relating to "children's activities", "educational services directed towards children", "information on family activities and entertainment services" and "contents from third party advertisers directed to children and families". I note that this explanation of the purpose of the Guide corresponds to the registered services. Ms. Trepanier further explains that since the Guide contains maps of and information on attractions in the Greater Vancouver area, many users of the Guide display it as a poster.

[12] Although there is no evidence that the Guide is sold to customers, the evidence indicates that it is distributed for free and that the Owner generates revenue through selling advertisements in the Guide. In this respect, Ms. Trepanier attests that advertising and promotional revenues obtained through the Guide averaged in excess of \$40,000 per year during the relevant period. She also asserts that, based on her position and experience in the publishing business, this revenue indicates that businesses consider the Guide to be an excellent vehicle for their advertising and promotion. She further asserts that this is particularly due to the Guide's "excellent quality and substantial distribution in the Greater Vancouver area, as well as the notoriety and reputation that the VANCOUVER KIDS' GUIDE trade-mark enjoys in the marketplace in Canada".

[13] In support of her assertion of use, attached at Exhibit B to Ms. Trepanier's affidavit are copies of the Guide from the years 2011, 2012-2013, and 2013-2014. As shown below, "Kids' Guide" is displayed in large font on the cover of each Guide with "**where VANCOUVER**" and the respective year at the top.



[14] As indicated by Ms. Trepanier, the Guide includes a map of Greater Vancouver and features photographs and information about various attractions and activities in the area. Displayed throughout the pages of each Guide are advertisements for third party goods and services, such as for the Vancouver Aquarium, McDonald's, The Candy Aisle, and Redfish Kids Clothing.

[15] As well, attached at Exhibit C to Ms. Trepanier's affidavit are the "Media Kits" for the Guide for the years 2012 to 2014. Ms. Trepanier explains that these kits show the advertising rates for listings in the Guide as well as a list of various locations where the Guide is distributed. I note that Ms. Trepanier does not provide any information on the availability or circulation of the media kits, although the content suggests they would have been distributed to potential

advertisers. In any event, an image of the previous year's Guide appears in each of the exhibited media kits, with "Kids' Guide", as shown above, visible.

### Analysis

[16] At the outset, I agree with the Requesting Party that the exhibited media kits do not constitute any of the registered goods. In this respect, the kits do not appear to be objects of trade in themselves. Rather, they are of a promotional nature, merely providing advertising rates and advertising information about the Guide [see also *Critchley v Kicking Horse Coffee Co*, 2015 TMOB 58, 2015 CarswellNat 2793 (TMOB) and *Brownlee LLP v 555,129 Ontario Ltd*, 2013 TMOB 23, 2013 CarswellNat 796 (TMOB)].

[17] In any event, variations of the Mark appear in the kits only in the images of the respective Guides. As this corresponds with the exhibited Guides, my analysis will focus on whether the Guides themselves, as shown above, constitute use of the Mark in association with the registered goods and services.

#### *Transfers of the Guides in the Normal Course of Trade*

[18] In its written representations, the Requesting Party submits that, since the Guide is not sold to consumers, the Mark is not used "in the normal course of trade" as required by section 4(1) of the Act. In this respect, the Requesting Party argues that the word "trade" in section 4(1) "contemplates some payment or exchange for wares supplied". Thus, it asserts that free distribution of promotional material displaying a trade-mark should not be considered use of that trade-mark in the normal course of trade.

[19] In support, the Requesting Party cites section II.5.5.1 of the *Trademarks Examination Manual* and the jurisprudence referenced there: *CIS Ltd v Sherren* (1978), 39 CPR (2d) 251 (TMOB); *Joseph E Seagram & Sons Ltd v Corby Distilleries Ltd* (1978), 42 CPR (2d) 264 (TMOB); and *Ports International Ltd v Registrar of Trade Marks* (1983), 79 CPR (2d) 191 (FCTD).

[20] However, the present proceeding is distinguishable from the cases cited by the Requesting Party. In those cases, the Registrar found that free distribution of products to promote

the trade-mark owner's *own business* did not constitute 'use' as defined in section 4(1) of the Act. Here, and in contrast to the exhibited media kits, the evidence shows that the Guide promotes other businesses and provides information about local sites of interest. The distribution of the Guide is more than self-promotion and Ms. Trepanier attests to significant advertising revenues from the Guide.

[21] Indeed, when a publication bearing a trade-mark gains revenue from selling advertising space to other businesses, its distribution to the consumer may constitute 'use' under section 4(1) of the Act [see, for example, *Now Communications Inc v Chum Ltd* (2000), 5 CPR (4th) 275 (TMOB) and *Times Mirror Co v Transcontinental Distribution Inc* (2004), 42 CPR (4th) 1 (TMOB)].

[22] As the Registrar found in *Times Mirror*:

The evidence therefore shows that the applicant's journal is distributed in association with the Mark primarily for profit through advertising sales. The case at bar is not one in which the owner of a mark is distributing a free publication (catalogue, advertising pamphlet or other publication of the same kind) for the promotion of its own products or services. [at paragraph 33]

[23] Accordingly, I am satisfied that the evidenced distribution of the Guide by the Owner during the relevant period constituted transfers of the registered goods, "printed publications ... namely, guides".

*Use with Respect to Each of the Goods*

[24] With respect to the other registered goods, the Requesting Party submits in its written representations that there is no evidence in Exhibit B of "books, newspapers, manuals or posters", although it appears to have conceded that the exhibited Guides constitute "booklets of all kinds, brochures, pamphlets, guides, maps, and pictures and photographs relating to children's activities".

[25] However, notwithstanding the Requesting Party's apparent concession, having distinguished each of the registered goods in the statement of goods, the Owner is obligated to produce evidence with respect to each of the registered goods accordingly [see *John Labatt Ltd v*

*Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA); and *Sharp Kabushiki v 88766 Canada Inc* (1997), 72 CPR (3d) 195 (FCTD)]. This is not a case where the evidence is representative of a broader category of goods [per *Saks & Co v Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD)]. Rather, Ms. Trepanier’s assertion that the Guide can be used *as* some of the remaining registered goods is insufficient to characterize the exhibited Guide as constituting such goods.

[26] For example, I am not satisfied that distribution of the Guide – that merely contains pictures or photographs within its pages – constitutes actual transfers of “pictures and photographs”. Given the evidence as a whole, not to mention the actual title of the good, the ordinary commercial term of the Guides would appear to be “guides”.

[27] Similarly, notwithstanding Ms. Trepanier’s assertions that the Guide provides a “pocket manual” and that it can be displayed as a “poster”, I do not find that distribution of the Guide itself amounts to transfers of such goods. First, there is no indication in the evidence that the Guides are marketed as such, notwithstanding that they may take on these characteristics to some [see, for example, *MAPA GmbH Gummi-und Plastikwerke v 2956-2691 Québec Inc*, 2012 TMOB 192, CarswellNat 4869]. Second, as noted above, given that the Owner itself made a distinction in its statement of goods between “guides”, “maps”, “books”, “manuals”, “posters” and so on, the Owner is required to furnish evidence of use of the Mark with respect to each of these goods other than by reference to the exhibited Guides only.

[28] Given the foregoing, while the evidenced distribution of the Guide constitutes transfers in the normal course of trade, in my view, such transfers were only with respect to the registered goods, “printed publications namely ... guides ... relating to children’s activities in specified locations in Canada”.

[29] In any event, as discussed below with respect to deviation, this issue is moot.

#### *Use with Respect to Services*

[30] In its written representations, the Requesting Party appears to concede that the Owner performed some of the registered services through the distribution of the Guide during the

relevant period. Indeed, it is clear from Ms. Trepanier's statements regarding the purposes of the Guide and the contents of the exhibited Guides themselves that the Owner provided "information and advisory services relating to children's activities" through "printed publications" and "print advertising" in specified locations in Canada during the relevant period.

[31] However, I agree with the Requesting Party's submission that, as the Guide is a printed publication, use has not been demonstrated in relation to the provision of information and advisory services through the other means set out in the registration, namely through "point of purchase signage, promotions contests and cooperative promotional efforts with content providers". I note, however, that Ms. Trepanier does attest to the Guide being distributed at visitor information centres in Canada during the relevant period. As such, I would accept that the Owner has also performed or was able to perform the services through "tourist information booths".

#### *Deviation*

[32] In any event, the real issue in this case is whether the Mark *as registered* appears on the cover of the Exhibit B Guides, as shown above.

[33] It is well established that where the trade-mark as used deviates from the trade-mark as registered, the question to be asked is whether the trade-mark was displayed in such a way that it did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade-marks) v Cie International pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see if, as a question of fact, the "dominant features" of the registered trade-mark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[34] The Requesting Party submits that the trade-mark as displayed consists only of the words "Kids' Guide", which it argues is used "in a purely descriptive sense and not as a distinctive trade-mark". It submits that even if such display constitutes trade-mark use, the trade-mark as displayed lacks the "words and design elements ... integral to the distinctive aspects of the



registered mark”, namely the words TO VANCOUVER and the “complete design that is part of the registered mark”.

[35] The Owner, on the other hand, submits that the dominant features of the Mark are the words VANCOUVER and KIDS GUIDE. It further submits that the deviation in this case is only the omission of the word TO and the re-ordering of the word VANCOUVER, which is positioned before the words “Kids’ Guide” in the trade-mark as used. As such, the Owner submits that the “overall impression left with the average consumer is the same ... whether the trade-mark as actually used is VANCOUVER KIDS GUIDE, or KIDS GUIDE TO VANCOUVER”.

[36] First, I would note that, if the trade-mark displayed on the Guides is considered to include the word VANCOUVER, then it would necessarily include the additional elements “**where**” and the year, such as “2012-2013”. These elements do not appear in the Mark as registered. Although “Kid’s Guide” appears in large letters on the cover of the Guide, it is worth noting that, in its registration, the Owner disclaimed the right to the exclusive use of the words KIDS GUIDE TO VANCOUVER apart from the Mark. Although not necessarily determinative, the Owner’s disclaimer would suggest that the words forming part of the Mark, including “Kids’ Guide”, do not necessarily constitute the dominant feature of the Mark as registered in association with the registered goods.

[37] Indeed, in relation to the registered goods, given the descriptive nature of the words forming part of the Mark, the design elements of the Mark are at least equally dominant. As such, in my view, the dominant feature of the Mark is the particular combination of the words with the particular design elements – including “Kids’ Guide” and “Vancouver” displayed in a triangle and banner, respectively.

[38] In contrast, if the trade-mark as displayed is considered to include the banner “**where** VANCOUVER 2012-2013”, the dominant feature is not the Mark’s particular combination of words and design elements. In this respect, the word “**where**”, being the first part of the trade-mark displayed and not being descriptive of the goods would, in my view, constitute a dominant feature of the trade-mark displayed.

[39] In any event, I agree with the Requesting Party that the trade-mark displayed on the cover of the exhibited Guides consists only of the words “Kids’ Guide”. Although VANCOUVER does appear on the cover of the Guide, its placement in the banner heading with “**where**” and the particular year is completely separate from “Kids’ Guide”.

[40] Furthermore, again, I note that none of the design elements of the Mark, such as the triangular background, appear in the trade-mark as displayed in any of the furnished exhibits.

[41] Accordingly, in my view, the dominant feature of the Mark as registered, namely the particular combination of the words KIDS’ GUIDE TO VANCOUVER with the particular design elements has not been preserved. The omission of the design elements and the words TO VANCOUVER substantially alters the Mark visually, phonetically, and in the idea suggested, such that it has lost its identity and does not remain recognizable as the Mark.

[42] As such, I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the registered goods and services within the meaning of sections 4 and 45 of the Act. Furthermore, the Owner furnished no evidence of special circumstances excusing the absence of such use.

#### Disposition

[43] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be expunged in compliance with the provisions of section 45 of the Act.

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Andrew Bene  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

No Hearing Held

Agents of Record

Miller Thomson LLP

Alec R. Szibbo

For the Registered Owner

For the Requesting Party