



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

Citation: 2015 TMOB 32
Date of Decision: 2015-02-24

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Mata Amritanandamayi Math against
registration No. TMA657,000 for the trade-mark
WORLD EMBRACE in the name of Kathryn Mainse**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA657,000 for the trade-mark WORLD EMBRACE (the Mark), owned by Kathryn Mainse.

[2] The Mark was registered on January 20, 2006 in association with the following goods (the Goods) and services (the Services):

Goods:

Promotional items, namely, t-shirts, sweatshirts, baseball caps; stationary, namely, paper, pens, pads and envelopes; pre-recorded video-tapes and pre-recorded video and audio cassettes; printed publications, namely magazines, books, pamphlets, and instructional manuals in Christian faith and doctrine

Services:

Evangelistic, religious and ministerial services; evangelistic and ministerial services provided by television and radio; religious educational services, namely the teaching of religious doctrines and gospel; producing and broadcasting radio and television programs all dealing with matters of religion; charitable fundraising

services; missionary services; humanitarian relief services; organizing, coordinating, assisting and facilitating organizations engaged in missionary services and humanitarian relief services; posting and placing messages in an electronic format accessible over the internet.

[3] On April 19, 2013, at the request of Mata Amritanandamayi Math (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 to Ms. Mainse (the Registrant). The notice required the Registrant to provide evidence showing that the Mark was in use in Canada at any time between April 19, 2010 and April 19, 2013, in association with each of the Goods and Services. If the Mark had not been so used, the Registrant was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[4] The relevant definitions of use in the present case 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.

(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.

[5] It has been well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for clearing the register of “deadwood”. The criteria for establishing use are not demanding and an overabundance of evidence is not necessary. However, sufficient evidence must nevertheless be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the registered goods and services during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)]. Furthermore, mere statements of use are insufficient to prove use [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[6] In response to the Registrar's notice, the Registrant furnished her own affidavit, sworn June 29, 2013, together with Exhibits 1 to 15. While both parties filed written representations, only the Registrant was represented at an oral hearing.

[7] For the reasons that follow, I conclude that the registration ought to be expunged.

[8] Before discussing the reasons for my decision, I will begin with a brief summary of the evidence.

The Evidence

[9] In her affidavit, Ms. Mainse explains that the Mark was "originally conceived in the year 2001 to be used as the title given for the development of an international ministry, the activity of which was to be reflected in the trade-marked name." She further explains that following the registration of the Mark, "plans were further developed for the international ministry activity of advancing the Christian faith through an incorporated registered Canadian charity named "Heaven's Rehearsal" (the Corporation)." Incorporated on August 5, 2008, this was to be the legal structure under which the ministry activity would be conducted. Ms. Mainse indicates that since the date of incorporation to the date of swearing of her affidavit, she has been a director of the Corporation.

[10] Ms. Mainse states that prior to the inception of the Corporation, she began to develop a business plan and prepare related curriculum materials to be used by the Corporation in international ministry activities undertaken in fulfillment of the Corporation's objectives. This "World Embrace" curriculum, she explains, was developed over the course of seven years, with a formal version of the curriculum now part of the Corporation's activities being completed in January 2013.

[11] Ms. Mainse explains that the Mark is a core identifying and promotional component within the business plan, curriculum, and the future advertising of the Corporation's international ministry activity. She states that it is anticipated that the first international ministry activity under the Mark will take place in the year 2014. In

support, she provides as Exhibits 3(i)-(viii) what she describes are copies of the first five and last three pages of the draft “World Embrace” curriculum guide, which she indicates was prepared prior to the date of the section 45 notice.

[12] Ms. Mainse explains that in the years 2007 and 2008, the Corporation conducted worship celebrations at the Air Canada Centre and Rogers Centre respectively in Toronto as part of the “World Embrace” ministry. These celebrations were captured on DVD and sent out internationally.

[13] Ms. Mainse states that since the date of registration, the Mark has been an integral and actively used part of organizing, coordinating, assisting and facilitating organizations engaged in missionary services, in promotional activities, videos and audio presentations, and curriculum development for an instructional manual in Christian doctrine and faith. In support, she provides the following at Exhibits 4 to 15:

- A poster bearing the Mark, dated Friday, October 21, 2005, advertising “An Evening of Worship and Intercession” (Exhibit 4);
- The vision statement for “World Embrace”, which includes a copyright notice dated 2012 (Exhibit 5);
- A “Creative Brief”, which appears to be a marketing plan dated May 24, 2006, developed by a third party for a project or event entitled “Heaven’s Rehearsal” for a company called World Embrace (Exhibit 6);
- An e-mail dated November 12, 2009, providing information to an unidentified individual, regarding a Heaven’s Rehearsal and World Embrace event which took place in Uganda earlier that year (Exhibit 7);
- An e-mail dated February 26, 2008 to Board members of World Embrace discussing finances for upcoming projects (Exhibit 8);

- Power point presentations about World Embrace and Heaven’s Rehearsal, stated to be for planning meetings in 2008 and April 2009 respectively (Exhibits 9 and 10);
- An e-mail dated May 29, 2013 from the Registrant regarding 2010 missions activity in Kenya, Uganda, India, and Finland (Exhibit 11);
- Minutes from the March 2012 Heaven’s Rehearsal/World Embrace planning meeting (Exhibit 12); and
- An e-mail dated December 8, 2012 regarding a planning meeting for upcoming World Embrace activities.

[14] Ms. Mainse continues and states that the activities being undertaken [by the Registrant] are international in scope and have required years of planning, promotion, preparation and leadership development. Given these efforts, she anticipates an international launch of the “World Embrace” curriculum in 2014. She attaches at Exhibits 14 and 15 a copy of a logo and a photograph of a t-shirt bearing the logo respectively, which she indicates were produced and used in conjunction with a trip to Uganda undertaken by her in June 2013 for the purpose of organizing a “Heaven’s Rehearsal” worship celebration in 2014. She states that the t-shirts were made available to Ugandan organizers to promote the 2014 event.

[15] Ms. Mainse concludes her affidavit by stating that the Mark will thereafter be used in association with all of the goods and services, and that she will be launching the website *www.worldembrace.org* on July 7, 2013. Further to this, she expresses that it would be a setback to the more than 10 years of planning, expense and effort involved with the “World Embrace” international ministry, should the Mark be expunged, when the Mark is so near to being used fully as was intended upon registration.

Analysis and Reasons for Decision

[16] The Requesting Party submits, and I agree, that there is no evidence to support that the Mark was used in Canada during the relevant period. There is no evidence that any of the Goods were sold in Canada bearing the Mark, and there is no evidence that any of the Services were performed or offered in Canada in connection with the Mark during the relevant period.

[17] Indeed, the evidence provided pertains to activities outside of Canada, activities outside of the relevant period, and internal planning documents – nothing that would constitute use of the Mark in Canada during the relevant period in accordance with sections 4(1) or 4(2) of the Act.

[18] In the absence of use, a trade-mark is liable to be expunged unless the absence of use was due to special circumstances. A determination of whether there are special circumstances that excuse non-use involves consideration of three criteria: (1) the length of time during which the trade-mark has not been used; (2) whether the registered owner's reasons for not using its trade-mark were due to circumstances beyond its control; and (3) whether there exists a serious intention to shortly resume use [*Canada (Registrar of Trade Marks) v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA)].

[19] The decision in *Scott Paper Limited v Smart & Biggar et al* (2008), 65 CPR (4th) 303 (FCA), offered further clarification with respect to the interpretation of the special circumstances criteria set out in *Harris Knitting, supra*. In particular, the Court determined that the proper test when assessing whether there are special circumstances, which would excuse non-use of a mark, must refer to the cause of the absence of use, and not to some other consideration. After reviewing the case law on section 45(3) of the Act, the following conclusions were drawn by the Court:

- 1- The general rule is that absence of use is penalized by expungement.
- 2- There is an exception to the general rule where the absence of use is due to special circumstances.

3- Special circumstances are circumstances not found in most cases of absence of use of the mark.

4- The special circumstances which excuse the absence of use of the mark must be the circumstances to which the absence of use is due.

[20] It would appear from this analysis, that the second criterion of the *Harris Knitting* test must be satisfied in order for there to be a finding of special circumstances excusing non-use of a mark. Furthermore, with respect to this criterion, “circumstances beyond the owner’s control” mean “circumstances that are unusual, uncommon or exceptional” [see *John Labatt Ltd. v. Cotton Club Bottling Co.* (1976), 25 CPR (2d) 115 (FCTD)]. This is not to say that the other two criteria are not relevant factors to consider, but just that those factors, in isolation, cannot constitute special circumstances. Indeed, the relevance of the first criterion is apparent, as reasons that may excuse a brief period of non-use, may not excuse an extended period of non-use [*Harris Knitting, supra*; *Goldwell Ltd, Re* (1974), 29 CPR (2d) 110 (TMOB)]. In any event, the intent to resume use must be substantiated by the evidence (*Arrowhead Spring Water Ltd v Arrowhead Water Corp* (1993), 47 CPR (3d) 217 (FCTD); *NTD Apparel Inc v Ryan* (2003), 27 CPR (4th) 73 (FCTD)].

[21] At the oral hearing, the Registrant made submissions regarding special circumstances. In particular, the Registrant submitted that the reasons for non-use during the relevant period were due to financial circumstances, including a shortfall in cash following the 2007-2008 worship celebrations at the Air Canada Centre in Toronto, coupled with the nature of the business being international in scope and requiring a long planning period. The Registrant submitted that the Mark had been minimally used in a promotional sense during the planning stage for the ministry between 2010 and 2013. However, as previously indicated, the only evidence in this regard relates to internal communications.

[22] With respect to the reasons brought forth for non-use of the Mark during the relevant period, I note that financial or economic circumstances have generally not been considered to be circumstances which are uncommon, usual, or exceptional [per *Harris Knitting, supra*]. Moreover, although financial hardship in very particular circumstances

may excuse a brief absence of use (see for example, *Rogers & Scott v Naturade Products Inc* (1988), 19 CPR (3d) 504 (TMOB); and *Lapointe Ronsenstein v Maxwell Taylor's Grill Inc* (2001), 19 CPR (4th) 263 (TMOB), I am not satisfied that they constitute special circumstances that excuse the absence of use for such a lengthy period of time in the present case. Indeed, at best, the date of last use of the Mark supported by the evidence in the present case is October 2005 (as per Exhibit 4). Even then, this is only in respect of certain limited services.

[23] I would add further that no details were provided surrounding the financial difficulties faced by the Registrant. Thus, even if the financial circumstances encountered by the Registrant could be shown to be unusual, uncommon or exceptional, the evidence before me in the present case only indicates that the Registrant made deliberate decisions to focus activities outside of Canada during the relevant period.

[24] As for the Registrant's submission that the nature of the business (being international in scope) requires a long planning period, I see nothing in the evidence that satisfies me that this should excuse such a lengthy period of non-use. Again, the evidence shows that the Registrant was actively engaged and focused on activities outside of Canada, including during the relevant period; this indicates that deliberate decisions were made by the Registrant not to use the Mark in Canada.

[25] In view of the above, I conclude that the Registrant has failed to establish that the absence of use of the Mark was due to special circumstances that would justify such non-use. Moreover, despite any evidence that would support an intention to resume use of the Mark shortly, this in and of itself is insufficient to maintain the registration [*Scott Paper, supra*].

Disposition

[26] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, registration No. TMA657,000 will be expunged in compliance with the provisions of section 45 of the Act.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office