



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

Citation: 2015 TMOB 178
Date of Decision: 2015-09-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Alec Szibbo

Requesting Party

and

1772887 Ontario Limited

Registered Owner

**TMA351,245 for THE ESSENTIAL
VANCOUVER**

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 7, 2014 to 1772887 Ontario Limited (the Owner), the registered owner of registration No. TMA351,245 for the trade-mark THE ESSENTIAL VANCOUVER (the Mark).

[2] The Mark is registered in association with the following goods: printed publications, namely magazines.

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with the goods 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.

[4] In this case, the relevant period for showing use is between January 7, 2011 and January 7, 2014.

[5] The relevant definition of “use” in association with goods is set out in section 4(1) 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.

[6] 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 and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270].

[7] In response to the Registrar’s notice, the Owner filed the affidavit of Deborah Trepanier, sworn on March 31, 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 identifies herself as the Group Publisher of *Where* magazine, a publication of the Owner doing business as St. Joseph Communications Media. She explains that the Owner publishes a number of magazines in Canada, including *Where* magazine’s *ESSENTIAL VANCOUVER* (the Magazine).

[9] Ms. Trepanier states that the Magazine has been published and distributed in Canada continuously since June 1987. As described by Ms. Trepanier, the Magazine is a publication “devoted to providing local information as to shopping, dining, cultural attractions and entertainment in Vancouver and province of British Columbia.” She states that the Magazine is published annually and is distributed to select hotels and resorts in the Vancouver area. She asserts that “well in excess of” 20,000 copies of the Magazine were published each year during the relevant period and that a digital version of the Magazine is also available to Canadians on the Owner’s website at www.where.ca/digital-editions.

[10] Although there is no evidence that the Magazine is sold to customers, the evidence indicates that it is distributed for free and that the Owner generates revenue through selling advertisements in the Magazine. To this effect, Ms. Trepanier attests that advertising and promotional revenues obtained through the Magazine averaged \$125,000 per year during the relevant period.

[11] In support of her assertion of use, Ms. Trepanier attaches the following exhibits to her affidavit:

- Exhibit B consists of copies of the Magazine’s cover, masthead, and representative advertising pages for the years 2010/2011, 2011/2012, 2012/2013, and 2013/2014. The title of the Magazine, *ESSENTIAL VANCOUVER*, is displayed in large font on the cover of each issue. I further note that, “THE **ESSENTIAL VANCOUVER**” is displayed in small font in the footer of each page (other than advertising pages).
- Exhibit C is a copy of the “media kit” for the 2014/2015 edition of the Magazine. A list of 33 hotels and resorts appears on one of the pages, which Ms. Trepanier identifies as a list of “select 4 & 5 diamond hotels and resorts” at which the Magazine is distributed.
- Exhibit D is a “representative” printout of the webpage from the Owner’s website that provides digital access to the Magazine, “as accessed on March 7, 2014”.

Analysis

[12] As a preliminary matter, although not raised as an issue by the Requesting Party, the Owner submitted that the title of the Magazine, *ESSENTIAL VANCOUVER*, is a minor deviation from the Mark as registered.

[13] In applying the principles set out by the Federal Court of Appeal [per *Canada (Registrar of Trade Marks) v Cie Internationale pour l’informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)], I agree with the Owner that the dominant feature of the Mark, being the words **ESSENTIAL VANCOUVER**, is retained in the trade-mark displayed on the cover of the Magazine. The omission of the definite article **THE** is a minor deviation in this case.

[14] In any event, I note that this issue is moot. As noted above, the Mark as registered is displayed at the bottom of each content page of the Magazine. In view of *United Grain Growers Ltd v Lang Michener*, 2001 FCA 66, 12 CPR (4th) 89, for the purposes of this proceeding, such display of the Mark on several pages of the Magazine constitutes display of the Mark in association with magazines.

Exhibits from after the Relevant Period

[15] In its written representations, the Requesting Party submits that Exhibit D, the printout from the Magazine's website, should be disregarded since it is dated after the relevant period. Likewise, the Requesting Party submits that Exhibit C (the 2014/2015 media kit) should be disregarded because it is unclear whether it postdates the relevant period.

[16] However, with respect to Exhibit D, I note that Ms. Trepanier attests that the Owner's website has provided access to the Magazine since 2012. She explains that Exhibit D is "representative" and, indeed, the cover displayed on the webpage is the same as the 2013/2014 magazine cover included in Exhibit B.

[17] With respect to Exhibit C, although it may post-date the relevant period, I accept that, at a minimum, it supports Ms. Trepanier's assertion with respect to the scope of distribution for the magazine to various hotels and resorts during the relevant period.

Use in the Normal Course of Trade

[18] In its written representations, the Requesting Party submits that, since the Magazine 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, the evidence shows that the Magazine promotes other businesses and provides information about local sites of interest. The use of the Mark in this instance is more than self-promotion. Furthermore, Ms. Trepanier attests to significant advertising revenues from the Magazine.

[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 Magazine by the Owner during the relevant period constituted transfers of the registered goods in the normal course of trade pursuant to section 4(1) of the Act.

[24] As such, and in view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act.

Disposition

[25] Accordingly, 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 maintained.

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

Hearing Date: No Hearing Held

Agents of Record

Miller Thomson LLP

For the Registered Owner

Alec Szibbo

For the Requesting Party