OPIC CIPO

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

Citation: 2017 TMOB 111

Date of Decision: 2017-08-23

IN THE MATTER OF A SECTION 45 PROCEEDING

Equine Canada	**Requesting Party**
and	
Horseplay Niagara Inc.	**Registered Owner**
TMA723,474 for HORSEPLAY	**Registration**

[1] This is a decision involving summary expungement proceedings with respect to registration No. TMA723,474 for the trade-mark HORSEPLAY (the Mark), owned by Horseplay Niagara Inc.

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

Goods:

T-shirts and hats.

Services:

Horseback riding, lessons, demonstrations, carriage rides, horse shows, seminars, pony rides, wagon rides, party hosting and day camps.

[3] For the reasons that follow, I conclude that the registration ought to be maintained with respect to the services. However, the goods will be deleted from the registration.

THE PROCEEDINGS

[4] On November 10, 2015, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Horseplay Niagara Inc. (the Owner). The notice was sent at the request of Equine Canada.

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between November 10, 2012 and November 10, 2015, in association with each of the goods and services specified in the registration. If the Mark had not been so used, the Owner 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.

[6] The relevant definitions of use 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.

[7] 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. Nevertheless, sufficient evidence must still be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the registered goods and services [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270]. Furthermore, mere statements of use are insufficient to prove use [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[8] In response to the Registrar's notice, the Owner furnished the statutory declaration of Kathryn Buttigieg, declared on January 8, 2016, together with Exhibits A to K.

[9] Neither party filed written submissions or requested an oral hearing.

THE EVIDENCE

[10] Ms. Buttigieg is the President of the Owner.

[11] Ms. Buttigieg states that the Owner has been actively using the Mark in association with the registered goods and services in Canada since at least as early as 2000. In support, she provides the following:

> Exhibit A – an invoice dated September 1, 2015 for horseback riding services rendered to a client during the month of August 2015. The Mark does not appear on the invoice.
> Exhibit B – a copy of the Owner's telephone bill dated October 16, 2015.
> Exhibit C – a brochure advertising horseback riding excursions offered by the Owner, which Ms. Buttigieg states bears a stamp demonstrating that it was printed in 2014. The Mark is clearly displayed on the brochure, and there is a 2014 copyright notice on the brochure.
> Exhibit D – a copy of the Owner's children's day camp waiver form referring to activities which include horseback riding. The Mark does not appear on the form.
> Exhibit E – a printout from the Owner's website referring to the Owner's birthday party services.
> Exhibit F – a printout from the Owner's website referring to the Owner's day camp service, which includes horseback riding, lessons, seminars and demonstrations.
> Exhibits G and H – archived printouts of the Owner's website from the Wayback Machine showing webpages as they existed between May 2012 and August 2014, referring to pony rides and educational school trips, which specifically includes seminars, wagon rides and pony rides.
> Exhibits I and J – photographs of a hat and t-shirt respectively, both displaying the Mark, which Ms. Buttigieg states are currently available for sale to customers.

Exhibit K – an article published in *Niagara Life Magazine* on May 6, 2013 discussing the Owner's services, including lessons, riding camp, and the ability to lease a pony or ride casually on a guided trail ride.

ANALYSIS AND REASONS FOR DECISION

Services

[12] As previously indicated, in accordance with section 4(2) of the Act, 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.

[13] In the present case, the evidence clearly shows the Mark on the Exhibit C brochure which advertises horseback riding services. Furthermore, it is clear from the archived webpages that the remainder of the services were also advertised and offered during the relevant period. While I note that it is "HorsePlay Niagara" that appears on the webpages advertising such services, I accept that this is use of the Mark *per se* as, in my view, the public, as a matter of first impression, would perceive the word Niagara as simply being descriptive of the place of origin of the Owner's services, namely, the Niagara region.

[14] Indeed, the use of a trade-mark in combination with additional words or features constitutes use of the registered mark if the public as a matter of first impression, would perceive the trade-mark *per se* as being used. This is a question of fact which is dependent on whether the trade-mark stands out from the additional material, for example by the use of different lettering or sizing or whether the additional material would be perceived as clearly descriptive matter or as a separate trade-mark or trade name [see *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); and *88766 Canada Inc v National Cheese Co* (2002) 24 CPR (4th) 410 (TMOB)].

[15] Accordingly, the registration for the Mark will be maintained with respect to the services.

Goods

[16] With respect to the goods, Ms. Buttigieg provides photographs of hats and t-shirts bearing the Mark (Exhibits I and J), which she states are currently available for sale to customers. Unfortunately, however, there is no evidence that these items were sold to customers in Canada during the relevant period.

[17] Consequently, the Owner has failed to show use of the Mark in association with the goods pursuant to section 4(1) of the Act during the relevant period. Furthermore, there is no evidence of special circumstances which would excuse the absence of such use.

[18] Accordingly, the goods will be deleted from the registration.

DISPOSITION

[19] Having regard to the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained with respect to the services and the registered goods will be deleted from the registration in compliance with the provisions of section 45 of the Act.

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

TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD

HEARING DATE No Hearing Held

AGENTS OF RECORD

Lancaster Brooks & Welch	FOR THE REGISTERED OWNER
Rideout & Maybee	FOR THE REQUESTING PARTY