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

Citation: 2017 TMOB 119

Date of Decision: 2017-09-06

IN THE MATTER OF A SECTION 45 PROCEEDING

Hunky Haulers Inc.

Requesting Party

and

**Friedman and Soliman Enterprises,
LLC**

Registered Owner

**TMA798,695 for COLLEGE HUNKS
MOVING**

Registration

[1] At the request of Hunky Haulers Inc. (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 June 4, 2015 to Friedman and Soliman Enterprises, LLC (the Owner), the registered owner of registration No. TMA798,695 for the trade-mark COLLEGE HUNKS MOVING (the Mark).

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

- (1) Moving services.
- (2) Franchising services, namely, offering technical assistance in the establishment and operation of moving services businesses.

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with the services specified in the registration, at any time between June 4, 2012 and June 4, 2015. 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.

[4] The relevant definition of “use” in association with services is set out in section 4(2) of the Act as follows:

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.

[5] 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].

[6] With respect to services, the display of a trade-mark on advertising is sufficient to meet the requirements of section 4(2) when the trade-mark owner is offering and prepared to perform those services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[7] In response to the Registrar’s notice, the Owner furnished the affidavit of its President, Nicolas Friedman, sworn on October 27, 2015, in Tampa, Florida. Only the Owner filed written representations. An oral hearing was not requested.

THE OWNER’S EVIDENCE

[8] In his affidavit, Mr. Friedman attests that College Hunks Moving is “one of two franchise concepts offered by the [Owner]’s affiliated corporations (and authorized licensees) in Canada and in the United States”. He explains that the Mark is licensed in Canada through the Owner’s affiliated Canadian corporation, CHHJ Franchising Canada Ltd. (the Licensee) which was incorporated on January 6, 2011 to sell College Hunks Moving and College Hunks Hauling Junk franchises in Canada.

[9] He further attests that the Mark was used in Canada “through numerous advertising channels”. In support of his assertion of use, attached to Mr. Friedman’s affidavit are the following exhibits:

- Exhibit A consists of excerpts from the Licensee’s “Franchise Disclosure Document” (FDD) dated November 1, 2012, an undated “Development Agent Agreement”, and a “Certificate of Franchisor” dated November 28, 2012.

The FDD contains “Information for Prospective Franchisees of College Hunks Hauling Junk™ / College Hunks Moving® Franchises”. Mr. Friedman attests that pursuant to the laws of Ontario, Manitoba, Alberta, PEI and New Brunswick, the FDD is required to be delivered to prospective franchisees.

The Mark appears in the FDD and the Development Agent Agreement.

- Exhibit B consists of two brochures that Mr. Friedman confirms were distributed to “approximately 25 prospects in Canada between 2012 and May 30, 2015”. The first brochure provides an overview of the “College Hunks Franchise Opportunity”, such as “World-Class Training and Support”. It indicates that the “College Hunks Franchise Model Is Now Available in Canada” and “Area Development Opportunities Are Also Available in Canada”. The Mark is displayed in the brochure on a photograph and on an image of a moving truck.

The second brochure indicates that “We’re Franchising College Hunks Hauling Junk & College Hunks Moving in Canada”.

- Exhibit C consists of a copy of a free admission pass for Canada’s Franchise and Business Opportunities Show that took place in January 2013 in Toronto. Mr. Friedman attests that these free passes were “given out to Canadian prospects to encourage them to attend” and were given to “at least 10 persons in Canada”. The Mark is displayed on the side of a moving truck depicted on the pass.
- Exhibit D is a Wikipedia article of “College Hunks Hauling Junk” mentioning that “College Hunks Hauling Junk and College Hunks Moving” provide “junk removal, local and long distance full service moving and office relocation services”. Next to “Areas served”, there is a mention of “United States and Canada”. Mr. Friedman asserts that this mention was not “altered by any representative of the [Owner] or the Licensee or by any other party, since June 4, 2008”.
- Exhibit E consists of printouts from the website, *collegehunksfranchise.com*. The printouts display links and phone numbers for “franchise information”, as well as a section detailing costs and fees. There is also a brief description of “College Hunks

Hauling Junk”. Mr. Friedman attests that such excerpts are accessible in Canada and have been “live since at least as early as 2014”. The Mark is displayed on an image of a moving truck.

Mr. Friedman explains that the website was tailored to Canada by the addition of a disclaimer indicating that the franchise, “although offered in the Canadian provinces of Alberta and Ontario, could not be constituted a legal offer without a franchisee first having received a copy of the appropriate Franchise Disclosure Document.”

- Exhibit F is a printout of an e-mail dated August 15, 2015 detailing the number of views of *collegehunksfranchise.com* for 2014 and the first half of 2015. The email mentions that the numbers represent “unique visitors” and “actual people in the areas we attracted to the site through our marketing”. I note that 439 views from Canada are indicated for 2014 and 611 views are indicated for the first half of 2015.
- Exhibit G consists of a printout of “The College Hunks” Twitter account. In the description of the page, there is mention of “College Hunks Hauling and Moving”. The Mark is displayed on an image of a truck. Mr. Friedman notes that the page refers to locations in the United States and Canada.
- Exhibit H is an online article dated September 17, 2012 retrieved from *Business World Magazine*’s website and entitled “College Hunks Hauling Junk and College Hunks Moving”. The article mentions that “College Hunks [...] are currently offering franchise opportunities in Canada”, that “College Hunks offers a wide range of training to its franchises” and that “[in] addition to a pre-opening process, which includes a seven-day on-site training, [Chris Jackson, director of Marketing] himself coaches franchisees about marketing and culture”. The article contains a photograph of a moving truck bearing the Mark.
- Exhibit I is an online article dated October 7, 2014 retrieved from *Marketwired*’s website. Although the Mark itself is not referenced, the article refers to the popularity of “College Hunks Hauling Junk” and mentions that “the franchise continues to offer opportunities across the United States and Canada”. Mr. Friedman attests that the article was distributed to “as many as 100 news outlets” in Canada.
- Exhibit J consists of copies of six e-mails, three of which are dated during the relevant period. Mr. Friedman explains that these emails are exchanges between the Licensee and

Canadian prospects for College Hunks Moving or College Hunks Hauling Junk franchises.

ANALYSIS

[10] In its written representations, the Owner confirms that no franchises had been granted in Canada during the relevant period. Indeed, while the evidence reflects some interest on the part of prospective franchisees, it would appear that no College Hunks Moving franchises have ever been established in Canada.

[11] Nevertheless, it is clear from the evidence as a whole that the Owner, through the Licensee, was offering and prepared to perform the registered franchising services in Canada in association with the Mark during the relevant period. As noted by the Owner, the present case is similar to *Brouillette Kosie Prince v Great Harvest Franchising, Inc*, 2009 FC 48. In that case, citing *Wenward, supra*, the Federal Court confirmed that the *offering* of “retail bakery” franchise services was sufficient to maintain the registrations at issue with respect to such franchising services.

[12] Accordingly, I am satisfied that the Owner has established use of the Mark in Canada in association with services (2), “Franchising services, namely, offering technical assistance in the establishment and operation of moving services businesses”, within the meaning of sections 4 and 45 of the Act.

[13] In its representations, the Owner also cites *Great Harvest* in support of its assertion that services (1), “moving services”, should also be maintained.

[14] However, a distinction exists between offering the registered franchising services and offering actual “moving services”. There is no indication that “moving services” *per se* were offered in Canada during the relevant period. In this respect, there is no indication that the Owner or the Licensee offered or were prepared to perform such services in Canada during the relevant period. Presumably, such services would have been offered and performed by a franchisee. Even if a franchise had existed in Canada, it would still have been necessary to provide some evidence of use of the Mark in association with such “moving services” beyond the abovementioned exhibits.

[15] This is in contrast to *Great Harvest*, where the evidence showed that, to some extent, the registered owner in that case had itself performed the registered “operation ... of retail bakery shops”, which were also at issue in that case. Comparable evidence is absent in this case.

[16] Accordingly, I am not satisfied that the Owner has demonstrated use of the Mark in association with “moving services” within the meaning of sections 4 and 45 of the Act.

[17] As there is no evidence of special circumstances excusing non-use of the Mark with respect to services (1) before me, the registration will be amended accordingly.

DISPOSITION

[18] In view of all the foregoing, 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 amended to delete services (1), “Moving services”, from the statement of services.

[19] The amended statement of services will read as follows:

Franchising services, namely, offering technical assistance in the establishment and operation of moving services businesses.

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

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

No Hearing Held

AGENTS OF RECORD

Boughton Law Corporation

For the Registered Owner

Drake Marks Associates

For the Requesting Party