

O P I C



C I P O

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 5

Date of Decision: 2020-01-23

IN THE MATTER OF A SECTION 45 PROCEEDING

BCF S.E.N.C.R.L./BCF LLP

Requesting Party

and

Daniel A. Burns

Registered Owner

TMA574,405 for

Registration

BRAVE NEW WORLD

BACKGROUND

[1] At the request of BCF S.E.N.C.R.L./BCF LLP, the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on July 21, 2017 to Daniel A. Burns and Gregory L. Belzberg, a Partnership, the registered owner at that time of the registration No. TMA574,405 for the trademark BRAVE NEW WORLD (the Mark).

[2] On April 25, 2018, the registration was updated when the Registrar recorded a July 23, 2003 assignment of the Mark from Daniel A. Burns and Gregory L. Belzberg, a Partnership, to Daniel A. Burns, the current registered owner.

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

Retail and wholesale travel agency services.

[4] The notice requires the registered 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 July 21, 2014 and July 21, 2017 (the Relevant Period). If the Mark had not been so used, the registered 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 definition of “use” in association with services is set out in section 4(2) of the Act as follows:

4(2) A trademark 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 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, Mr. Burns furnished his own affidavit, sworn on February 16, 2018, together with Exhibits A to E. Neither party filed written representations. An oral hearing was not requested.

USE OF THE MARK BY A LICENSEE

[8] In his affidavit, Mr. Burns states that he is the owner and CEO of BNW Travel Management Ltd. (BNW) which is in the business of offering travel and tourism related services to Canadian consumers on behalf of suppliers such as airlines, cruise lines, travel insurance and package tours. Mr. Burns further states that BNW is licensed to use the Mark in Canada and that it has continuously used the Mark in the performance and advertisement of retail and wholesale travel agency services during the Relevant Period.

[9] Section 50(1) of the Act requires the owner of a trademark to control, either directly or indirectly, the character or quality of the goods or services sold under that trademark in order to benefit from the use of its trademark by a licensee.

[10] There are three main methods by which a trademark owner can demonstrate the requisite control pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of a licence agreement that provides for the requisite control [*Empresa Cubana del Tabaco v Shapiro Cohen*, 2011 FC 102 at para 84].

[11] In the present case, there is no clear statement that Mr. Burns exerts the requisite control and no licence agreement between Mr. Burns and BNW was provided. Thus, the question becomes whether the evidence demonstrates that Mr. Burns actually exerts the requisite control over the use of the Mark by BNW. An inference may be drawn that the requisite control under section 50(1) of the Act exists where an individual is a director or an officer of both the registered owner and the licensee [*Petro-Canada v 2946661 Canada Inc* [1999] 1 FC 294, 1998 CanLII 9107 (FC); *Lindy v Canada (Registrar of Trade Marks)* [1999] FCJ No 682, 1999 CanLII 7911 (FCA)].

[12] Considering that Mr. Burns is both the owner of the Mark and the owner and CEO of BNW, I am prepared to infer that Mr. Burns exercises the requisite control over the character or quality of the services provided by BNW in accordance with section 50(1) of the Act [see also *Mohammad Azhar Khan v Bar B Q TONIGHT GLOBAL PTE LTD*, 2017 TMOB 73 at para 34 where the Registrar inferred that requisite control exists where the licensor and the president of a licensee is the same person]. As such, I am prepared to accept that any use of the Mark by BNW would benefit Mr. Burns.

ADS FOR RETAIL TRAVEL AGENCY SERVICES BY BNW

[13] In terms of use of the Mark in association with retail travel agency services, attached as Exhibit “B” to Mr. Burns’ affidavit are printouts of a website located at www.bnwtravel.com as it appeared at different times during the Relevant Period, captured by the Wayback Machine at archive.org. I note that archived web pages produced by Wayback Machine indicating the state of websites in the past have been found to be generally reliable [see *ITV Technologies Inc v WIC Television Ltd*, 2003 FC 1056, affirmed 2005 FCA 96; *Cogan v EMusic.com Inc*, 2011 TMOB 34 at para 18]. I further note BNW’s copyright notices at the bottom of a number of the

screenshots provided: “Copyright © 2014 BNW Travel Management Ltd.” and “Copyright © 2017 BNW Travel Management Ltd.”

[14] The words “Brave New World Travel” can be seen prominently at the top left corner of each printout, with the word “Travel” in a lighter shade. The printouts contain advertisements for a number of travel agency services including ads for cruises, ski getaways, flights, car rentals, vacation packages, and travel insurance. A search engine for cruises also appears in the printouts. Additional printouts of web pages with the same display of the words “Brave New World Travel” at the top left corner of the pages promoting vacation packages in 2014, 2015 and 2016 are also attached as Exhibit “D” to Mr. Burns’ affidavit.

[15] In applying the principles set out in *Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canda Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), I am satisfied that the Mark is being used in such a way that it has not lost its identity and remains recognizable despite the addition of the word “Travel”, considering that it is a minor deviation given its descriptive nature.

[16] Thus, I find that the use of the words “Brave New World Travel” as shown in the printouts attached as Exhibits “B” and “D” would likely be perceived by consumers as use of the Mark.

ADS FOR WHOLESALE TRAVEL AGENCY SERVICES BY BNW

[17] In terms of use of the Mark in association with wholesale travel agency services, Mr. Burns explains that BNW has 948 travel sales agents under contract who refer travel sales to BNW in return for a share of the travel revenue generated from the referrals. Mr. Burns further states that these travel sales agents have in turn their own individual travel websites. Attached as Exhibit “A” is a blank copy of a “Brave New World Travel Consultant Contract” used by BNW with its travel sales agents.

[18] Attached as Exhibit “C” to Mr. Burns’ affidavit are promotional advertisements from BNW for vacation packages addressed to travel sales agents during the Relevant Period. In this regard, I note that the ads include contact information for “Brave New World Travel” and two of

the ads also include the following notice at the end: “Make sure your travel agency offer emails are delivered: Add marketing@travel.messges3.com to your address book.”

[19] Once again, for the same reasons as those set out above, I find that the use of the words “Brave New World Travel” as shown in these ads would likely be perceived by consumers as use of the Mark.

PERFORMANCE OF RETAIL AND WHOLESALE TRAVEL AGENCY SERVICES BY BNW

[20] In addition to the ads, Mr. Burns also provides evidence of retail and wholesale travel agency services rendered during the Relevant Period. Attached as Exhibit “E” to Mr. Burns’ affidavit are copies of paid invoices issued by BNW for flight bookings and the purchase of vacation packages, addressed to individuals in Canada during the Relevant Period. The words “Brave New World Travel” are prominently shown on the top left corner of each invoice. In three of the attached invoices, under the heading “Travel Consultant”, a travel sales agent is identified.

[21] For the same reasons as those set out above, I find that the use of the words “Brave New World Travel” as shown in these invoices would likely be perceived by consumers as use of the Mark.

[22] In the end, when the evidence is viewed in its entirety including ads for retail and wholesale travel agency services and paid invoices for services rendered, I am satisfied that Mr. Burns has demonstrated that the Mark was used in association with retail and wholesale travel agency services within the meaning of sections 4(2) and 45 of the Act during the Relevant Period.

DISPOSITION

[23] In view of all of 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 maintained.

Pik-Ki Fung
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

Fasken Martineau DuMoulin LLP

For the Registered Owner

BCF S.E.N.C.R.L./BCF LLP

For the Requesting Party