



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2020 TMOB 72**

**Date of Decision: 2020-06-22**

**IN THE MATTER OF SECTION 45 PROCEEDINGS**

**Stewart McKelvey**

**Requesting Party**

**and**

**Rogers Communications Canada Inc.**

**Registered Owner**

**TMA842,007 for NO WORRIES.**

**Registrations**

**TALK HAPPY. and**

**TMA842,009 for NO WORRIES**

[1] This is a decision involving summary expungement proceedings with respect to registration Nos. TMA842,007 and TMA842,009, for the marks NO WORRIES. TALK HAPPY. and NO WORRIES, respectively (the Marks), owned by Rogers Communications Canada Inc.

[2] Both registrations are registered in association with the following services:

- (1) Wireless telecommunications services, namely cellular telephone and email services, local and long distance telephone services; transmission of data and of information by electronic means, namely text messages, electronic mail, music.
- (2) Telecommunications services, namely a rate plan for wireless, voice and data transmissions through mobile internet access.
- (3) Telecommunications gateway services.
- (4) Online sales of telecommunications products, namely cellular phones and cellular phone accessories.
- (5) Conference call services.

[3] For the reasons that follow, I conclude that the registrations ought to be maintained in part.

#### THE PROCEEDINGS

[4] On October 24, 2017 and October 25, 2017, the Registrar of Trademarks sent notices under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to Rogers Communications Canada Inc. (the Owner). The notices were sent at the request of Stewart McKelvey (the Requesting Party).

[5] The notices required the Owner to furnish evidence showing that it had used the Marks in Canada, at any time between October 24, 2014 and October 24, 2017 (with respect to TMA842,007) and October 25, 2014 to October 25, 2017 (with respect to TMA842,009), in association with the services specified in the registrations. For the purposes of this decision, the difference in relevant dates of one day is immaterial, and therefore, will simply be referred to as the Relevant Period with respect to both registrations. If the Marks had not been so used, the Owner was required to furnish evidence providing the date(s) when the Marks were last in use and the reasons for the absence of use since that date.

[6] The relevant definition of use 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.

[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”. As such, the evidentiary threshold that the registered owner must meet is quite low [see *Woods Canada Ltd v Lang Michener et al* (1996), 71 CPR (3d) 477 (FCTD)] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the trademark was used in association with the services specified in the registration [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270]. Mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[8] In response to the Registrar’s notices, the Owner furnished identical affidavits of Eric Yeung, the Senior Brand Director for Chatr and Fido with the Owner, sworn May 23, 2018, together with Exhibits A to F.

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

#### THE EVIDENCE

[10] Mr. Yeung attests that prior to being promoted to Senior Brand Director for Chatr and Fido, he was the Brand Director for the Chatr brand for the Owner since March of 2015.

[11] Mr. Yeung attests that the Owner owns and manages subsidiary and associated businesses, including “Chatr”, “Chatr Mobile” and “Chatr Wireless” (collectively “Chatr”), which offers prepaid mobile wireless services to Canadian customers, as well as associated services and products, such as mobile phones and accessories. He further explains that the services offered by Chatr were launched as of July 28, 2010, and provides as Exhibit A to his affidavit an excerpt from Wikipedia describing the business model for Chatr.

[12] Mr. Yeung states that the Owner has consistently used the Marks in association with the majority of the registered services, specifically, services (1), (2), and (3) (hereafter, the Services),

in the normal course of business as a tag line related to its marketing and advertising of the Chatr services offered by the Owner to its customers across Canada.

[13] Mr. Yeung states at paragraph 8 of his affidavit, that the Owner has not consistently used the Marks during the Relevant Period in association with the remaining services due to a decline in demand by customers for such services during the Relevant Period; however, he states that the Owner intends to do so in the future.

[14] Mr. Yeung states that the Owner created and distributed point-of-sale materials, brochures and online web pages to promote and provide information about its Prepaid Mobile Services to Canadians under the Chatr brand. He states that most of the marketing materials included the Marks in close association with the branding for Chatr.

[15] Mr. Yeung states that the Owner introduced the Marks as part of its marketing to the Canadian marketplace for one of its mobile telephone service plans in 2011 and that the Owner continuously used the Marks as part of its advertising and promotional services until at least April 2, 2015. In support, he provides as Exhibit B to his affidavit, screen shots taken by the Owner's Manager of IP assets on May 20, 2018 from the Internet Archive, the Wayback Machine. He explains that the archived screen shots show advertisements produced and made public by the Owner between October 2011 and April 2015 in association with the Services. The Marks clearly appear on the web pages in association with the Chatr cellular phone service plans.

[16] In addition, Mr. Yeung states that the Owner also used the Marks in association with the Services on a variety of posters displayed at retail locations across Canada, and that the Marks are also applied to packaging used in association with the sale of the Services. More specifically, he indicates that envelope sleeves are used to promote and sell SIM cards and "Top Up Cards" for distribution across Canada for purchase by customers. He states that these cards enable customers to manage their Prepaid Mobile Services under the Chatr branding. In support, he provides as Exhibit C to his affidavit: a price plan poster, a campaign poster both distributed and shown in retail locations across Canada in 2015, and two of the available Top Up Cards distributed for sale across Canada beginning in 2011. He explains that the Top Up Cards were continued to be made available until all such cards produced in 2011 were sold. The Marks clearly appear on all such materials. He states that to the best of his knowledge and belief, these

specimens are representative of those displayed in connection with the performance of the Services across Canada for the Marks within the relevant period.

[17] As further support, Mr. Yeung provides as Exhibit D to his affidavit, photographs taken on January 31, 2018 by the National Account Manager, Partner Retail Sales of Top Up Cards for the Owner at retail locations in Ontario such as Walmart. He states that to the best of his knowledge and belief, the photographs are representative of displays in connection with the performance of the Services across Canada for the Marks within the Relevant Period. The Marks clearly appear on the packaging for the Top Up Cards.

[18] Mr. Yeung states that advertising and promotion of the Services in association with the Marks are sent by the Owner to a variety of authorized distributors and dealers across Canada, in addition to being used in certain retail locations leased by the Owner. He provides as Exhibit E to his affidavit, a distribution list for the first quarter of 2015 listing the authorized distributors and dealers to whom the advertising materials using the Marks are sent. He further provides as Exhibit F to his affidavit, an example of the advertising materials distributed to authorized distributors and dealers as referenced in Exhibit E, namely, the Price Plan Poster and the Campaign Brochure utilizing the Marks in association with the Services. Once again, the Marks clearly appear on such materials.

#### ANALYSIS AND REASONS FOR DECISION

[19] To begin with, Mr. Yeung concedes in his affidavit that the Owner has not consistently used the Marks during the Relevant Period in association with services (4) and (5), namely, online sales of telecommunications products, namely cellular phones and cellular phone accessories and conference call services. Indeed, Mr. Yeung provides no evidence of use of the Marks in association with such services at any point during the Relevant Period. Rather, he simply explains that the absence of such use was due to a decline in demand by customers for such services during the Relevant Period, but that the Owner intends resume use of the Marks with these services in the future. Mr. Yeung provides no further details or information with respect to such circumstances and any efforts being made by the Owner to resume use.

[20] In the absence of further information, it would appear that the reason for non-use was due to unfavourable market conditions. It has been held that unfavourable market conditions are not the sort of unusual, uncommon, or exceptional circumstances that constitute special circumstances that excuse non-use of a mark [see, for example, *Canada (Registraire des marques de commerce) c Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA); and *Lander Co Canada Ltd v Alex E Macrae & Co* (1993), 46 CPR (3d) 417 (FCTD)]. In cases where the registered owner had no intent to abandon its trade-mark in Canada, but lacked any orders for its goods during the relevant period, this was found, not in itself, sufficient to maintain the registration in question [see *Garrett v Langguth Cosmetic GMBH* (1991), 39 CPR (3d) 572 (TMOB) and *Bereskin & Parr v Magnum Marine Corp*, 2011 TMOB 68, 93 CPR (4th) 327].

[21] Consequently, services (4) and (5) will be deleted from the registrations for failure to show use or establish special circumstances excusing the absence of use.

[22] However, with respect to the remaining services, that is, as defined in Mr. Yeung's affidavit as the Services (services (1), (2), and (3)), I am satisfied that the Owner has demonstrated use of the Marks in association with such services during the relevant period. The Marks clearly appear on advertising materials used during the Relevant Period, and it is clear that all such Services were actively being marketed and were available to be performed during the Relevant Period. Indeed, the list of authorized distributors during the Relevant Period for such Services (Exhibit E) shows that there were hundreds of such distributors at that time. Furthermore, the advertising materials describe the services being offered, and I accept that such descriptions are fully encompassed by the registered services (1), (2), and (3).

[23] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Marks as in association with the registered services (1), (2), and (3) within the meaning of sections 4(2) and 45 of the Act.

#### DISPOSITION

[24] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, registration Nos. TMA842,007 and TMA842,009 will be maintained in part in compliance with

the provisions of section 45 of the Act. That is, services (4) and (5) will be deleted from both registrations.

[25] The statement of services for both registrations will now read as follows:

- (1) Wireless telecommunications services, namely cellular telephone and email services, local and long distance telephone services; transmission of data and of information by electronic means, namely text messages, electronic mail, music.
- (2) Telecommunications services, namely a rate plan for wireless, voice and data transmissions through mobile internet access.
- (3) Telecommunications gateway services.

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Kathryn Barnett  
Member  
Trademarks Opposition Board

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

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**AGENTS OF RECORD**

Shereen Hamdy-Davidson (Rogers Communications  
Inc.)

FOR THE REGISTERED OWNER

Stewart McKelvey

FOR THE REQUESTING PARTY