



# Canadian Intellectual Property Office

## THE REGISTRAR OF TRADEMARKS

**Citation:** 2024 TMOB 109

**Date of Decision:** 2024-06-12

## IN THE MATTER OF A SECTION 45 PROCEEDING

**Requesting Party:** Smart & Biggar, LP

**Registered Owner:** All Nations Full Gospel Church

**Registration:** TMA912,743 for ANU

### INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA912,743 for the trademark ANU (the Mark).

[2] The Mark is registered for use in association with the following Services:

Educational services of university level educational programs, namely, seminars, classroom lectures, lectures rendered via video communication and correspondence courses; Development and dissemination of university level educational materials, namely, books, catalogues, directories, instruction manuals, journals, magazines, manuals, newsletters, newspapers, pamphlets, periodicals and reports; Production of educational video and audio cassettes, CD-roms, CDs and DVDs; Publication of university level educational materials, namely, books, catalogues, directories, instruction manuals, journals, magazines, manuals, newsletters, newspapers, pamphlets, periodicals and reports; Publication of literature, namely, books.

[3] For the reasons that follow, I conclude that the registration ought to be amended.

### **PROCEEDING**

[4] At the request of Smart & Biggar, LP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on January 20, 2023, to All Nations Full Gospel Church (the Owner), the registered owner of the Mark.

[5] The notice required the Owner to show whether the Mark was used in Canada in association with each of the services 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 such use since that date. In this case, the relevant period for showing use is January 20, 2020 to January 20, 2023.

[6] The relevant definition of “use” in the present case is set out in section 4 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] Where the Owner does not show “use”, the registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Dr. Carlene Kyeremeh, the Owner’s Chief Operating Officer and it’s licensee’s, All Nations University, Vice-President of Academic and Student Affairs. Neither party filed written representations or requested a hearing.

### **EVIDENCE AND ANALYSIS**

[9] Dr. Kyeremeh’s evidence is that while All Nations University is based in Ghana, Canadians are able to take courses in Canada via on-line communication (para 9). Further, All Nations University distributes pamphlets in Canada and targets Canadians \with online advertising (paras 8-10, Exhibits A-C). During the relevant period, over 100 students in Canada were enrolled (para 9).

### ***Use Shown Enures to the Owner***

[10] Dr. Kyeremeh's evidence is that the use of the Mark by the Owner's licensee enures to the Owner who exercised direct or indirect control in respect of the character and quality of the Services (para 5).

### ***Use is Shown With Some Services***

[11] Dr. Kyeremeh's evidence shows that during the relevant period, the Owner has advertised the services listed below on its website and Facebook and Instagram accounts in association with the Mark, along with evidence that Canadians have accessed its website and follow its social media accounts (paras 8-10, Exhibits A, pages 5, 9-10; C, pages 20,22).

Educational services of university level educational programs, namely, seminars, classroom lectures, lectures rendered via video communication and correspondence courses;

[12] Dr. Kyeremeh's evidence shows that during the relevant period, the Owner's website included online journals, newsletters, pamphlets and a student handbook and catalog with the Mark displayed on these items or where they are downloaded (paras 15, 18-19; Exhibits H, pages 41, L pages 56, 59-60; M pages 62-64). As such the Owner has shown use of the Mark in association with the following services:

Development and dissemination of university level educational materials, namely, books, catalogues, directories, journals, manuals, newsletters, pamphlets, periodicals and reports; Publication of university level educational materials, namely, books, catalogues, directories, journals, manuals, newsletters, pamphlets, periodicals and reports;

### ***Deviation***

[13] In the evidence, the trademark often appears in conjunction with other words such as "Why ANU?", "ANU-Research and Publication", "ANU HelpDesk", "ANU Report", "ANU Presidential Scholarship"; and "Apply to ANU". These uses all qualify as use of the Mark. Use of a word mark in combination with additional words qualifies as use of the word mark if the public, as a matter of first impression, would perceive the word mark per se as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR

(3d) 535 (TMOB]. Further, it is well established that the addition of descriptive words to a word mark is not necessarily fatal, even where those descriptive words appear in the same font and size as the word mark [see, for example, *Riches, McKenzie & Herbert v Pillsbury Co* (1995), 61 CPR (3d) 96 (TMOB) at para 14; *LE PEPE' SRL v PJ Hungary Kft*, 2017 TMOB 82 at paras 18-20; *Smart & Biggar v Lotuspc.com Corporation*, 2019 TMOB 29 at paras 19-21].

### **No Use is Shown with the Following Services**

[14] No use of the Mark is shown with the following services:

Development and dissemination of university level educational materials, namely, instruction manuals, magazines, newspapers; Production of educational video and audio cassettes, CD-roms, CDs and DVDs; Publication of university level educational materials, namely, instruction manuals, magazines, newspapers; Publication of literature, namely, books.

[13] As there is no evidence of special circumstances which could excuse non-use of the Mark in association the above goods, the statement of services will be amended accordingly.

## **DISPOSITION**

[15] 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 amended to delete the services in strike-out below:

Educational services of university level educational programs, namely, seminars, classroom lectures, lectures rendered via video communication and correspondence courses; Development and dissemination of university level educational materials, namely, books, catalogues, directories, ~~instruction manuals~~, journals, ~~magazines~~, manuals, newsletters, ~~newspapers~~, pamphlets, periodicals and reports; ~~Production of educational video and audio cassettes, CD-roms, CDs and DVDs~~; Publication of university level educational materials, namely, books, catalogues, directories, ~~instruction manuals~~, journals, ~~magazines~~, manuals, newsletters, ~~newspapers~~, pamphlets, periodicals and reports; ~~Publication of literature, namely, books.~~

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Natalie de Paulsen  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

## Appearances and Agents of Record

**No hearing held.**

### **AGENTS OF RECORD**

**For the Requesting Party:** Smart & Biggar LP

**For the Registered Owner:** Carters Professional Corporation