

Federal Court



Cour fédérale

Date: 20100204

Docket: T-1055-09

Citation: 2010 FC 118

Ottawa, Ontario, February 4, 2010

PRESENT: The Honourable Mr. Justice Mainville

BETWEEN:

SIM & McBURNEY

Applicant

and

MALCOLM PARRY

Respondent

REASONS FOR JUDGMENT AND JUDGMENT

[1] This concerns an appeal by Sim & McBurney (the “Applicant”) pursuant to section 56 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) seeking to set aside a decision dated April 27, 2009 (the “Decision”) of Céline Tremblay, acting for the Registrar of Trade-marks under delegated authority as a member of the Trade-marks Opposition Board (the “Registrar”), reached pursuant to section 45 of the Act and maintaining in part only registration TMA487,486 for the trade-mark VANCOUVER LIFE in association with “editorial/advertising inserts into publications and periodicals”.

Background

[2] The trade-mark VANCOUVER LIFE (the “Mark”) was issued to registration pursuant to the Act on December 29, 1997 for the registered owner Malcolm Perry, the Respondent in this Appeal, in relation to the following wares and services:

Wares: Printed publications, namely magazines, guidebooks, books, newspapers, newsletters and editorial/advertising inserts into publications and periodicals.

Services: Promotional services, namely promoting the sale of goods and services of others through the distribution of printed material, advertising and promotional contests; fashion show services; entertainment services through the media of radio and television broadcasts and motion pictures; audio-visual program services, namely writing and producing audio-visual works for others for purposes of advertising and education; arranging and conducting trade shows and exhibitions; databases services, namely establishing, updating and maintaining computer data bases for use by subscribers.

[3] On July 6, 2007, at the request of the Applicant, the Registrar forwarded to the Respondent the notice provided by subsection 45(1) of the Act with respect to the Mark. In response to this notice, the Respondent filed with the Registrar an affidavit and various supporting exhibits.

[4] Following oral representations from both parties, the Registrar issued a Decision dated April 27, 2009 in which she found that the evidence submitted did not show use of the Mark in association with any of the registered services, nor use with the wares “magazines, guidebooks, books, newspapers, newsletters” during the period relevant to the proceedings, nor did it demonstrate any special circumstances that could excuse the absence of use for such services and wares.

[5] However, the Registrar found that sufficient facts were provided to reach a conclusion of use of the Mark by the Respondent in association with “editorial/advertising inserts into publications and periodicals” during the relevant period.

[6] The Applicant takes issue with these last findings and thus appeals to this Court seeking orders setting aside the Decision and expunging the Mark in association with all registered wares.

[7] The Respondent did not appeal the other aspects of the Decision concerning the expunged registered services and other wares.

The Decision under Appeal

[8] The Registrar found that the Mark had not been used during the relevant period for all the registered wares and services except for the wares “editorial/advertising inserts into publications and periodicals”. This appeal is limited to use in relation to these wares.

[9] The Registrar relied on the following evidence found at pages 2 and 3 of the Decision to support her conclusion that sufficient facts had been provided to permit her to arrive at the conclusion of use of the Mark in association with “editorial/advertising inserts into publications and periodicals” during the relevant period:

I shall review the evidence introduced by the Parry Affidavit. For this purpose, I find it useful to reproduce paragraphs 3 through 5 of the Parry Affidavit.

3. The trade-mark VANCOUVER LIFE has been used by me on a column of editorial content in almost every

edition of *Vancouver* magazine since the trade-mark was granted, since at least as early as 1997.

4. *Vancouver* Magazine is published 10 times a year by Transcontinental Western Media Group Inc., the publisher of *Vancouver* Magazine. Though I am listed as a contributing editor of *Vancouver* Magazine, I am not an employee of Transcontinental Western Media Group Inc. I prepare editorial content as a contractor. I am paid by the column.

5. The column has always included my bi-line, and the title VANCOUVER LIFE. The TM symbol to show that VANCOUVER LIFE is a trade-mark has almost always been printed alongside the trade-mark as well. However, some editions in 2006 and 2007 did not include the TM symbol.

Mr. Parry goes on to specify that his column was not published in late 2003 and early 2004 when he was being treated for cancer. He provides a table showing the number of times his column was published in the magazine *Vancouver* for the years 2002 to 2007. He files photocopies of various columns written by him [Exhibit "B"]. He also files excerpts from the September 2007 issue of the magazine *Vancouver*, which featured Mr. Parry [Exhibit "C"].

[10] The Registrar also noted that she was not required to decide within proceedings under section 45 of the Act if use of a mark as a column published in a magazine constituted trade-mark use (at page 3 of her Decision):

Further to my review of the Parry Affidavit, I wish to first address the requesting party's submissions that VANCOUVER LIFE used as the title of a column in a magazine does not amount to trade-mark use. In my view, the requesting party's contention that the consumer would not recognize VANCOUVER LIFE as a trade-mark is tied to the issue of distinctiveness, which is not an issue in section 45 proceedings. In any event, it is not incumbent on me in these proceedings to evaluate whether VANCOUVER LIFE would be perceived as a trade-mark [see *United Grain Growers Ltd. v. Lang Michener*, (2001), 12 C.P.R. (4th) 89 (F.C.A.)]. What is to be

determined is whether or not sufficient facts have been provided to permit me to arrive at a conclusion of use of the Mark by the Registrant, within the meaning of s. 4 of the Act, in association with the registered wares and services during the relevant period.

[11] The Registrar considered the nature of the registered wares to find that use as advertising inserts had not been shown (at pages 6-7 of the Decision):

Insofar as the wares "editorial/advertising inserts into publications and periodicals" are concerned, I should first remark that I believe the most common use of a slash (/) is to replace the hyphen or en dash to make clear a strong joint between words or phrases. Yet, the slash (/) is very often used to represent the concept "or". Under these circumstances, I wish to clearly indicate that I find it reasonable to interpret "editorial/advertising inserts into publications and periodicals" as "editorial inserts or advertising inserts into publications and periodicals". While Mr. Parry himself refers to his column as a "column of editorial content" and his column is not what I would consider an advertising insert, I note that the Registrar does not have the authority to redefine or amend the wares for which use has been shown. Although s. 45(4) of the Act gives the Registrar the power to amend, this section must be read in conjunction with s. 45(3) which provides that the registration can be amended if it appears that the Mark is not in use with the specified wares [see *Carter-Wallace Inc. v. Wampole Canada Inc.* (2000), 8 C.P.R. (4th) 30 (F.C.T.D.)].

[12] The Registrar did not however explain why she considered a column of editorial content published in a magazine as being included in the wares defined as "editorial/advertising inserts into publications and periodicals". The Registrar appears to have simply assumed that such a column was included in the wares as so defined.

[13] The Registrar finally dealt with the argument of the Applicant that the Respondent had not shown use of the Mark by himself, but only showed use by the publisher of *Vancouver* magazine in which his column appeared. Having failed to adduce evidence of his relationship with the publisher of *Vancouver* magazine through a licensing agreement or otherwise, the Applicant argued that the Respondent had failed to meet his evidentiary burden before the Registrar. The Registrar explained as follows why she did not accept these arguments (at pages 7 and 8 of her Decision):

It is not disputed that the Registrant, a contractor, is the author of the column content published in the *Vancouver* magazine. With the exception of one, the columns filed as Exhibit "C" identify Mr. Parry's authorship. Also, the columns published between October 2004 and Jan/Feb 2007, which were filed as Exhibit "C", all displayed the Registrant's name at the bottom of the page of the magazine. Although the requesting party argues that the bi-line does not indicate the ownership of the Mark, this is not detrimental to the Registrant's case. Considering the particular facts of this case, it seems to me that the function of the publisher of the magazine is somewhat akin to the function of a distributor acting as a link between a manufacturer and the ultimate consumer. Given the nature of section 45 proceedings, I am inclined to accept the Registrant's submissions that s. 50(1) of the Act is not relevant in considering the use of the Mark in association with the wares "editorial/advertising inserts into publications and periodicals". I wish to add that this is not a finding that s. 50(1) of the Act would not have been relevant in considering the use of the Mark in association with the other wares and the services if satisfactory evidence of use had been provided.

Position of the Applicant

[14] The Applicant argues that the Respondent had to show that the Mark had been used by him, or his licensee under subsection 50(1) of the Act, during the period relevant to section 45 of the Act. Moreover, such use had to meet the requirements of subsection 4(1) of the Act which entails use of

the Mark on the wares in a manner such that notice of association with the Mark is brought to the attention of consumers at the time of transfer.

[15] The Applicant asserts that the Respondent failed to meet his burden of evidence. No proof of sales of the wares bearing the Mark was submitted, nor did the Respondent submit his contractual terms with the publisher of the magazine in which the column was published, and consequently there was no evidence of a licence allowing the publisher to use the Mark. The Applicant thus argues that the Registrar erred in finding that there was use of the Mark by the Respondent. The Applicant further asserts that the Registrar erred in finding that a publisher of a magazine is somewhat akin to a distributor acting as a link between a manufacturer and the ultimate consumer.

[16] The Applicant further argues that the Respondent failed to submit additional evidence on these matters in this appeal, and that consequently an adverse inference should be drawn on the basis of *Sim & McBurney v. Majdell Manufacturing Co.* (1986), 11 C.P.R. (3d) 306, 7 F.T.R. 54, [1986] F.C.J. No. 547 (QL) and *Aerosol Fillers Inc. v. Plough (Canada) Ltd* (1979), 45 C.P.R. (2d) 194, [1980] 2 F.C. 338, [1979] F.C.J. No. 250 (QL), affirmed by *Plough (Canada) Ltd. v. Aerosol Fillers Inc.*, [1981] 1 F.C. 679, [1980] F.C.J. No. 198.

[17] The Applicant also asserts that a column of editorial content published in a magazine does not constitute “editorial/advertising inserts into publications and periodicals” as set out in the list of wares associated with the Mark.

Position of the Respondent

[18] The Respondent's counsel admits that no use of the mark for "advertising inserts" had occurred during the relevant period, and consequently the only wares associated with the Mark concern editorial inserts into publications and periodicals.

[19] The Respondent argues that the applicable standard of review in this appeal is reasonableness *simpliciter*, and that since the matters at issue in this appeal concern essentially findings of fact or of mixed law and fact relating to the use of the Mark, the Registrar's Decision should not be disturbed unless these findings are found to be unreasonable.

[20] The Respondent adds that the findings made by the Registrar were, *inter alia*, that the Respondent was a contractor, that he was the author of the column bearing the Mark, that this column was published in a magazine on many occasions during the relevant period, and that the column displayed his name. The Registrar found that this was sufficient to show use of the Mark for the purposes of section 45 of the Act, and this decision was reasonable in light of the evidence submitted and all the circumstances.

[21] The Respondent adds that the definition of the word "insert" includes to "introduce (letter, word, article, advertisement, in or into written matter, newspaper, etc.)" according to the *Concise Oxford Dictionary*, and consequently the Respondent's column of editorial content published in *Vancouver* magazine is a ware included under "editorial/advertising inserts into publications and periodicals".

Pertinent Provisions of the Act

[22] The most pertinent provisions of the Act which will be referred to for the purposes of this appeal are the following:

2. In this Act,

2. Les définitions qui suivent s'appliquent à la présente loi.

“use”, in relation to a trade-mark, means any use that by section 4 is deemed to be a use in association with wares or services

« emploi » ou « usage » À l'égard d'une marque de commerce, tout emploi qui, selon l'article 4, est réputé un emploi en liaison avec des marchandises ou services.

“wares” includes printed publications;

« marchandises » Sont assimilées aux marchandises les publications imprimées.

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

4. (1) Une marque de commerce est réputée employée en liaison avec des marchandises si, lors du transfert de la propriété ou de la possession de ces marchandises, dans la pratique normale du commerce, elle est apposée sur les marchandises mêmes ou sur les colis dans lesquels ces marchandises sont distribuées, ou si elle est, de toute autre manière, liée aux marchandises à tel point qu'avis de liaison est alors donné à la personne à qui la propriété ou possession est transférée.

41. (1) The Registrar may, on application by the registered owner of a trade-mark made in the prescribed manner, make any of the following amendments to the register:

41. (1) Le registraire peut, à la demande du propriétaire inscrit d'une marque de commerce présentée de la façon prescrite, apporter au registre l'une des modifications suivantes :

(c) amend the statement of the wares or services in respect of which the trade-mark is registered;

c) la modification de l'état déclaratif des marchandises ou services à l'égard desquels la marque de commerce est déposée;

(2) An application to extend the statement of wares or services in respect of which a trademark is registered has the effect of an

(2) Une demande d'étendre l'état déclaratif des marchandises ou services à l'égard desquels une marque de commerce est

application for registration of the trade-mark in respect of the wares or services specified in the application for amendment.

45. (1) The Registrar may at any time and, at the written request made after three years from the date of the registration of a trade-mark by any person who pays the prescribed fee shall, unless the Registrar sees good reason to the contrary, give notice to the registered owner of the trade-mark requiring the registered owner to furnish within three months an affidavit or a statutory declaration showing, with respect to each of the wares or services specified in the registration, whether the trade-mark was in use in Canada at any time during the three year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of such use since that date.

(2) The Registrar shall not receive any evidence other than the affidavit or statutory declaration, but may hear representations made by or on behalf of the registered owner of the trade-mark or by or on behalf of the person at whose request the notice was given.

(3) Where, by reason of the evidence furnished to the Registrar or the failure to furnish any evidence, it appears to the Registrar that a trade-mark, either with respect to all of the wares or services specified in the registration or with respect to any of those wares or services, was not used in Canada at any time during the three year period immediately preceding the date of the notice and that the absence of use has not been due to special circumstances that

déposée a l'effet d'une demande d'enregistrement d'une marque de commerce à l'égard des marchandises ou services spécifiés dans la requête de modification.

45. (1) Le registraire peut, et doit sur demande écrite présentée après trois années à compter de la date de l'enregistrement d'une marque de commerce, par une personne qui verse les droits prescrits, à moins qu'il ne voie une raison valable à l'effet contraire, donner au propriétaire inscrit un avis lui enjoignant de fournir, dans les trois mois, un affidavit ou une déclaration solennelle indiquant, à l'égard de chacune des marchandises ou de chacun des services que spécifie l'enregistrement, si la marque de commerce a été employée au Canada à un moment quelconque au cours des trois ans précédant la date de l'avis et, dans la négative, la date où elle a été ainsi employée en dernier lieu et la raison de son défaut d'emploi depuis cette date.

(2) Le registraire ne peut recevoir aucune preuve autre que cet affidavit ou cette déclaration solennelle, mais il peut entendre des représentations faites par le propriétaire inscrit de la marque de commerce ou pour celui-ci ou par la personne à la demande de qui l'avis a été donné ou pour celle-ci.

(3) Lorsqu'il apparaît au registraire, en raison de la preuve qui lui est fournie ou du défaut de fournir une telle preuve, que la marque de commerce, soit à l'égard de la totalité des marchandises ou services spécifiés dans l'enregistrement, soit à l'égard de l'une de ces marchandises ou de l'un de ces services, n'a été employée au Canada à aucun moment au cours des trois ans précédant la date de l'avis et que le défaut d'emploi n'a pas été attribuable à des

excuse the absence of use, the registration of the trade-mark is liable to be expunged or amended accordingly.

(4) When the Registrar reaches a decision whether or not the registration of a trade-mark ought to be expunged or amended, he shall give notice of his decision with the reasons therefore to the registered owner of the trade-mark and to the person at whose request the notice referred to in subsection (1) was given.

(5) The Registrar shall act in accordance with his decision if no appeal therefrom is taken within the time limited by this Act or, if an appeal is taken, shall act in accordance with the final judgment given in the appeal.

50. (1) For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trade-mark to use the trade-mark in a country and the owner has, under the licence, direct or indirect control of the character or quality of the wares or services, then the use, advertisement or display of the trade-mark in that country as or in a trade-mark, trade-name or otherwise by that entity has, and is deemed always to have had, the same effect as such a use, advertisement or display of the trade-mark in that country by the owner.

circonstances spéciales qui le justifient, l'enregistrement de cette marque de commerce est susceptible de radiation ou de modification en conséquence.

(4) Lorsque le registraire décide ou non de radier ou de modifier l'enregistrement de la marque de commerce, il notifie sa décision, avec les motifs pertinents, au propriétaire inscrit de la marque de commerce et à la personne à la demande de qui l'avis visé au paragraphe (1) a été donné.

(5) Le registraire agit en conformité avec sa décision si aucun appel n'en est interjeté dans le délai prévu par la présente loi ou, si un appel est interjeté, il agit en conformité avec le jugement définitif rendu dans cet appel.

50. (1) Pour l'application de la présente loi, si une licence d'emploi d'une marque de commerce est octroyée, pour un pays, à une entité par le propriétaire de la marque, ou avec son autorisation, et que celui-ci, aux termes de la licence, contrôle, directement ou indirectement, les caractéristiques ou la qualité des marchandises et services, l'emploi, la publicité ou l'exposition de la marque, dans ce pays, par cette entité comme marque de commerce, nom commercial — ou partie de ceux-ci — ou autrement ont le même effet et sont réputés avoir toujours eu le même effet que s'il s'agissait de ceux du propriétaire.

The Standard of Review

[23] In this case, the matters at issue principally concern findings of fact or of mixed law and fact by the Registrar. Both the Respondent and the Applicant agree that the standard of review in this appeal is that of reasonableness *simpliciter*, and both urge me to apply this standard.

[24] Indeed, in the absence of additional evidence being adduced in appeal, the case law has generally applied a standard of reasonableness *simpliciter* to appeals from the decisions of the Registrar pursuant to section 56 of the Act: *Mattel, Inc. v. 3894207 Canada Inc.*, 2006 SCC 22, [2006] 1 S.C.R. 772, (2006) 49 C.P.R. (4th) 321 at para. 40; *Molson Breweries v. John Labatt Ltd.*, [2000] 3 F.C. 145 (C.A.), (2000) 5 C.P.R. (4th) 180, [2000] F.C.J. No. 159 (QL) at para. 51.

[25] Consequently, this standard of reasonableness *simpliciter* has also been applied in appeals from decisions of the Registrar under section 45 of the Act: *United Grain Growers Ltd. v. Lang Michener (C.A.)*, 2001 FCA 66, [2001] 3 F.C. 102, (2001) 12 C.P.R. (4th) 89, [2001] F.C.J. No. 437 (QL) at para. 8; *Marks & Clerk v. Sparkles Photo Ltd.*, 2005 FC 1012, (2005) 45 C.P.R. (4th) 236, [2005] F.C.J. No. 1250 (QL) at para. 25; *Société nationale des chemins de fer français v. Venice Simplon-Orient-Express Inc.* (2000), 9 C.P.R. (4th) 443, [2000] F.C.J. No. 1897 (QL) at para. 5; *Ridout & Maybee LLP v. Omega SA (Omega AG) (Omega Ltd.)*, 2004 FC 1703, (2004) 39 C.P.R. (4th) 261, [2004] F.C.J. No. 2086 (QL) at para 6.

[26] Nevertheless, pursuant to *Dunsmuir v. New Brunswick*, 2008 SCC 9, [2008] 1 S.C.R. 190 (“*Dunsmuir*”) at paragraphs 34, 44 and 45, reasonableness *simpliciter* has been collapsed into a

single form of reasonableness review. Consequently, I will proceed to apply a standard of reasonableness in this appeal. As noted in *Dunsmuir* at paragraph 47, in judicial review, reasonableness is concerned mostly with the existence of justification, transparency and intelligibility within the decision-making process and is also concerned with whether the decision falls within a range of possible, acceptable outcomes which are defensible in respect of the facts and law.

Issues

[27] The issues pertinent to this appeal can be stated as follows:

- a. Did the Registrar err in deciding that it was not incumbent on her in section 45 proceedings to embark in a review of the distinctiveness or validity of the VANCOUVER LIFE Mark?
- b. Did the Registrar err in finding that use of the VANCOUVER LIFE Mark in association with the wares “editorial/advertising inserts into publications and periodicals” had been shown for the relevant period?

Analysis

[28] Section 45 of the Act provides for a simplified and expeditious procedure to expunge from the register those trade-marks which are no longer in use, and to restrict the types of wares and services associated with a registered trade-mark to those for which the trade-mark is actually used. Section 45 only concerns a trade-mark which has been registered. The only question at issue in a section 45 proceeding is whether the registered trade-mark was, with respect to the wares and

services specified in the registration, in use in Canada at any time during the three year period preceding the notice provided by the Registrar pursuant to subsection 45(1) of the Act.

[29] Consequently, in this case, it was incumbent on the Respondent to show that the trade-mark VANCOUVER LIFE was used in association with the wares “editorial/advertising inserts into publications and periodicals” during the three year period preceding the notice provided to him by the Registrar.

[30] The Registrar refused to embark on a review of the distinctiveness or validity of the Mark as invited to do so by the Applicant. I find the Registrar did not err in so refusing. Indeed, the decision of the Federal Court of Appeal in *United Grain Growers Ltd. v. Lang Michener, supra*, provides a clear and cogent answer to the first issue to be addressed in this appeal.

[31] The trade-mark at issue in *United Grain Growers Ltd. v. Lang Michener* was COUNTRY LIVING, which was registered in association with “printed periodicals, namely magazines”. A regular feature section bearing the name COUNTRY LIVING was included in the magazine Country Guide. COUNTRY LIVING was not listed in the table of contents of the magazine in a manner that was any different from any other major section of the magazine. A section 45 proceeding was initiated in regard to the trade-mark. The Registrar found that what distinguished the magazine from others was the use of the words Country Guide and not that of its section COUNTRY LIVING. The Registrar consequently expunged that trade-mark from the register on

that basis. The Federal Court of Appeal overturned this decision, and in so doing made the following comments which are particularly apposite to this case (at para14 to 16):

14 In our respectful opinion, in embarking upon an inquiry as to whether the words COUNTRY LIVING were used to distinguish the appellant's magazine, the Registrar misinterpreted her function under section 45 and erred in law. No words in section 45 direct the Registrar to re-examine whether the registered trade-mark is used for the purpose of distinguishing, or so as to distinguish, wares. Rather, the Registrar's duty under section 45 is only to determine, with respect to the wares specified in the registration, whether the trade-mark, as it appears in the Register, has been used in the three years prior to the request.

15 In this case, it is undisputed that the registered trade-mark COUNTRY LIVING was marked on the magazine COUNTRY GUIDE at the time of transfer of property in or possession of the magazine in the normal course of trade. We think once it was determined that the registered trade-mark, as it appears in the Register, was used in association with the wares specified in its registration, the inquiry under section 45 was at an end.

16 As stated by Hugessen J.A. in *Meredith & Finlayson v. Canada (Registrar of Trade Marks)* (1991), 40 C.P.R. (3d) 409, at 412, with respect to section 45:

[...] it is not intended that there should be any trial of a contested issue of fact but simply an opportunity for the registered owner to show, if he can, that his mark is in use and if not, why not.

As noted by Hugessen J.A., section 45 is not intended to provide an alternative to the usual *inter partes* attack on a trade-mark. It is only a simple and expeditious method, for public purposes, of removing from the Register, marks which have fallen into disuse. If the respondent's purpose is to stop the appellant from using its registered trade-mark COUNTRY LIVING because of a potential conflict between the appellant and the respondent's client, it may pursue that objective under section 57 of the *Trade-marks Act*.

[32] It is not through a proceeding under section 45 of the Act that issues such as the distinctiveness or invalidity of a trade-mark are to be dealt with.

[33] Addressing the second issue, the Registrar found that the Respondent was the author of a column of editorial content bearing the title VANCOUVER LIFE which was regularly published in *Vancouver* magazine during the three year period prior to the notice given pursuant to subsection 45(1) of the Act. The Registrar also found that the Respondent was a contractor, that the column included his bi-line, and the TM symbol to show VANCOUVER LIFE as a trade-mark was often included with the title of the column. Though the trade-mark symbol did not clearly associate the ownership of the Mark with the Applicant, the Registrar found this fact not to be detrimental to the Respondent's case on the basis that use by the Respondent personally or through the publisher of *Vancouver* magazine constituted use for the purposes of section 45 proceedings, irrespective of whether or not evidence of a licence to the publisher under subsection 50(1) of the Act had been made out.

[34] It is not necessary to determine if evidence of a licence under subsection 50(1) was required to show use of the Mark through the publisher. Indeed, in this case there was sufficient evidence submitted by the Respondent, including his affidavit and numerous extracts of various editions of *Vancouver* magazine, to allow the Registrar to reasonably conclude that use of the mark VANCOUVER LIFE had occurred through the form of a column of editorial content published in that magazine.

[35] However, the crux of the issue here is whether such use was one in association with wares contemplated by the registration. In other words, was it reasonable for the Registrar to assume that columns of editorial content published in a magazine constitute “editorial/advertising inserts into publications and periodicals”? I have come to the conclusion that it was not reasonable for the Registrar to make such an assumption for the reasons which follow.

[36] The argument submitted by the Respondent in this case is that the noun “inserts” in the list of wares associated with the Mark should be interpreted to mean the verb “insert”, and consequently the registered use is not limited to distinct and separate physical documents inserted into publications and periodicals, but also includes material “inserted” into a magazine by way of a column. Fundamentally, the issue here is if the expression “editorial/advertising inserts into publications and periodicals” can reasonably be understood as extending to “editorials inserted into publications and periodicals”. I find that it cannot. In so finding, I point out that I am not deciding here if a trade-mark can be registered under the Act for use as an editorial column published in a magazine or newspaper, an issue the resolution of which is beyond the scope of proceedings under section 45. I simply find that the wares contemplated by the registration in this case do not extend to such use.

[37] The list of wares set out in the registration as associated with the Mark must be read in the full context of the original registration, which is set out as follows: “[p]rinted publications, namely magazines, guidebooks, books, newspapers, newsletters and editorial/advertising inserts into publications and periodicals”.

[38] The noun “insert” is defined in *The New Oxford Dictionary of English*, Oxford University Press, 1998 as “a thing that has been inserted, in particular a loose page or section, typically one carrying an advertisement, in a magazine or other publication.” *Webster’s Ninth New Collegiate Dictionary*, 1987, defines this noun as “something that is inserted or for insertion; *esp.*: written or printed material inserted (as between the leaves of a book)”. I find it noteworthy, that the French language version of the Registrar’s Decision uses the noun “encarts” to translate the noun “inserts”, but my decision does not rest on this translation.

[39] The noun “insert” and its plural “inserts” thus refer to a type of publication which is loose in form and which is inserted in a magazine, most often than not for advertisement or promotional purposes.

[40] In these proceedings, the Respondent is attempting to transform the expression “editorial/advertising inserts into publications and periodicals” into the expression “editorials inserted into publications and periodicals” in order that the registration correspond to the actual use of the Mark by the Respondent. This he cannot do within the ambit of a proceeding under section 45 of the Act. An amendment pursuant to paragraph 41(1)(c) of the Act would be required for such purposes. Such an amendment would have the effect, pursuant to subsection 41(2) of the Act, of an application for registration of the trade-mark in respect of the wares specified, and require examination and advertisement, and it could be opposed pursuant to section 38 of the Act.

[41] Consequently, I find that it was not reasonable for the Registrar to assume that the wares “editorial/advertising inserts into publications and periodicals” included a column of editorial content published in a magazine.

JUDGMENT

THIS COURT ORDERS AND ADJUDGES that:

1. The appeal is granted with costs to the Applicant;
2. Trade-mark registration No. TMA487,486 is to be expunged in compliance with the provisions of subsections 45(3) and (5) of the *Trade-marks Act*.

"Robert M. Mainville"

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-1055-09

STYLE OF CAUSE: SIM & MCBURNEY v. MALCOLM PARRY

PLACE OF HEARING: Ottawa, Ontario (by videoconference)

DATE OF HEARING: January 20, 2010

**REASONS FOR JUDGMENT
AND JUDGMENT:** Mainville J.

DATED: February 4, 2010

APPEARANCES:

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FOR THE APPLICANT

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