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| RIDOUT & MAYBEE LLP  5500 North Service Road  Suite 101  Burlington  ONTARIO L7L 6W6 | | |
| Attention: Steven H. Leach | | |
| RE: | Trademark: | CANADIAN SAFE BOATING COUNCIL |
|  | Applicant: | Canadian Safe Boating Council |

This examiner's report concerns the above identified application. To avoid abandonment proceedings, a proper response must be received by this office by January 10, 2021. All correspondence respecting this application must indicate the file number.

The applicant’s correspondence dated October 10, 2019 is acknowledged.

The evidence furnished by the applicant in order to show that the trademark was distinctive at the time of filing the application has been reviewed by the undersigned. It is respectfully submitted that the evidence filed thus far does not establish that the subject trademark has become distinctive across Canada at the time of filing the application.

Please note that all the evidence provided should fall within the relevant timeframe, namely at least as early as March 10, 2005 and August 8, 2017. Any current and future evidence presented that is outside of this timeframe was not and will not be considered.

The affidavit has not shown use of the trademark in association with the services. The reasons for this are:

* Exhibits F, G, K and P do not show use of the trademark in association with the services because the use of the trademark as shown in the specimens do not show the trademark as applied-for, as there is additional wording and design components. Furthermore, use of the trademark within the rest of the text does not show use as a source identifier but only as a descriptive phrase used to describe the applicant’s services.
* With regard to Exhibit H, please note that third-party ‘mentions’ of the applicant is not considered use of the trademark by the applicant in association with the applied-for services, nor is it considered advertising of the applicant’s services (see *Bedessee Imports Ltd v Demerara Distillers Limited*, 2014 TMOB 101 (CanLII) and *Williams Companies Inc. et al v William Tel Ltd* (2000), 4 CPR (4th) 253 (TMOB)). Where specimens of advertisement by the applicant are shown, it does not show the trademark as applied-for as there is additional wording and design components.
* Exhibits I, J and L cannot be accepted as specimens of advertisement because they are dated after the filing date of the application, namely August 8, 2017 and it does not show the trademark as applied-for as there is additional wording and design components.

The Vollmer affidavit is further deficient in the following manner:

* The statements provided in Exhibit E are not acceptable as they are not in affidavit form. Furthermore, third party affidavits or declarations should include a statement to the effect that the affiant or declarant has come to see the trademark as distinguishing the services of the applicant form those of others.
* The number of members of the applicant, from each province per year within the relevant timeframe may be provided to aid the examiner in determining acquired distinctiveness. The information provided under Exhibit C is not acceptable as it falls outside of the relevant timeframe.
* The number of attendees at the applicant’s seminars per year within the relevant timeframe may be provided.
* Sales figures broken down by year and geographical distribution for the service, “online retail store services featuring videos and printed publications in the field of boating safety” are not provided.
* No evidence of use of the trademark in the territories, namely Northwest Territories, Nunavut, and Yukon, are provided.

In summary, for a specimen to be acceptable as showing use of the applied-for trademark, the use of the specimen must fall within the relevant timeframe, namely at least as early as March 10, 2005 and August 8, 2017. Additionally, the specimen must show the trademark as applied-for without any additional wording or design elements. When a specimen shows use of the trademark within a text, generally it cannot be considered as showing use as a source identifier. This is because the trademark is considered to be clearly descriptive and inclusion of the phrase within a longer piece of text only works to describe the services mentioned. The inclusion of an IP symbol such as ® | © | TM would assist in educating the public that the phrase is used as a trademark that acts as a single source identifier. Such specimens may assist the examiner in determining the acquired distinctiveness of the trademark.

As such, it is respectfully submitted that the evidence presented falls short of establishing that the applicant’s clearly descriptive mark has acquired a secondary meaning sufficient to support a claim under subsection 12(3) of the *Act*.

The applicant may wish to file supplemental evidence that address the above noted deficiencies and shows that the trademark had become distinctive with respect to the services across all of Canada at the time of filing the application.

In order to support the applicant’s claim that the subject trademark has become distinctive across Canada, the applicant may also wish to supply the following additional evidence:

* Secondary affidavits from distributors and/or end consumers attesting to the fact that they are familiar with and can readily and easily recognize the trademark alone as applied for and not in connection with any designs or additional word elements, specifically the words CANADIAN SAFE BOATING COUNCIL alone without reference to the boat design, as being that of the applicant.
* In addition, the applicant may wish to adduce survey evidence.  Please note, if a market survey is to be used as evidence, and in order to be worthwhile, it must be carried out by a person who can file an affidavit which attests to the fact that this person is an expert in designing, organizing, implementing and interpreting survey results. A qualified surveyor will set out the strategy and statistical basis of the survey and will explain the form of the questions asked and the manner in which the survey is conducted. All the results of the survey must be reported – both negative and positive – and the interpretation of the results fully explained.

**You are advised that this application may be refused under subsection 37(1) of the *Act* if your next response does not overcome the objection under paragraph 12(1)(b) of the *Act*.**

Additionally, as this application was filed prior to, and not advertised as of June 17, 2019, it has been re-examined under the provisions of the amended *Trademarks Act* and the new *Trademarks Regulations*.

Pursuant to paragraph 37(1)(d) of the *Trademarks Act*, it appears that the trademark is not distinctive.

It is the Registrar’s preliminary view that the trademark is not inherently distinctive when considered in association with its applied-for services, since the expression CANADIAN SAFE BOATING COUNCIL only serves to describe a characteristic of these services, namely, that the services pertain to safe boating and are provided by a council that emanates from Canada.Trademarks which describe a characteristic of a service cannot inherently act as a source identifier. Since the trademark only serves to describe a characteristic of its services and therefore cannot act as a source identifier, it is considered that other traders should be able, in the ordinary course of their business, to use it in association with the same services. Please note that, pursuant to paragraph 32(1)(b) of the *Act*, the objection can be overcome by relying on the evidence furnished by the applicant in response to the objection under paragraph 12(1)(b) of the *Act*.

Moreover, whereas the services are considered to comply with paragraph 30(2)(a) of the *Trademarks Act* and section 29 of the *Trademarks Regulations*, further specificity is required in order to group them according to the classes of the Nice Classification, pursuant to subsection 30(3) of the *Act*. Accordingly, amendment of the following services is required:

1. Delivering seminars and workshops in the field of boating safety; **operating a website that provides online access to training videos and printed publications in the field of boating safety**; operating a membership-based organization that lobbies governments with a view to the promotion of safe and responsible boating and the prevention of boating injuries and drownings; online retail store services featuring videos and printed publications in the field of boating safety.

By way of example only, the following would be deemed acceptable. Please note the Nice classes provided:

* Providing access to a website that provides online access to training videos and printed publications in the field of boating safety: **Class 38**
* Providing online access to training videos and printed publications in the field of boating safety via a website: **Class 38**
* Hosting a website that provides online access to training videos and printed publications in the field of boating safety: **Class 42**

If this example is not an accurate description of the applicant’s services, it can be used as a guide to the specificity and ordinary commercial term requirements.

Additionally, applications filed prior to, and not advertised as of, June 17, 2019 must, pursuant to subsection 30(3) of the *Trademarks Act*, group the goods and services according to the classes of the Nice Classification, each group being preceded by the number of the class of the Nice Classification to which that group of goods or services belongs and presented in the order of the classes of the Nice Classification. Please consider the following classes:

* Delivering seminars and workshops in the field of boating safety: **Class 41**
* operating a website that provides online access to training videos and printed publications in the field of boating safety: **see examples above**
* operating a membership-based organization that lobbies governments with a view to the promotion of safe and responsible boating and the prevention of boating injuries and drownings: **Class 35**
* online retail store services featuring videos and printed publications in the field of boating safety: **Class 35**

The applicant is required to file an amended application, using the e-service on the CIPO website at [www.cipo.ic.gc.ca](http://www.cipo.ic.gc.ca/), by fax at 819-953-2476 or by mail at the following address:

Registrar of Trademarks

Place du Portage I

50 Victoria Street, room C-114

Gatineau, QC K1A 0C9

If the applicant has any specific questions in respect of this Office action, please contact the assigned examiner. Please note that for general inquiries, including assistance with filing of the revised application, queries about the status of an application or receipt of correspondence, you may contact our Client Service Centre toll free at 1-866-997-1936.

Yours truly,



Damith Silva

Examination Section

819-360-8702

fax: 819-953-2476