



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2010 TMOB 127
Date of Decision: 2010-08-13

**IN THE MATTER OF A SECTION 45
PROCEEDING requested by Cassels Brock &
Blackwell LLP against registration No. TMA447,820
for the trade-mark MOMENTUM in the name of
Momentum Healthware, Inc.**

[1] On March 14, 2008, at the request of Cassels Brock & Blackwell LLP (the requesting party) the Registrar forwarded a notice under s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) to Momentum Healthware, Inc. (the registrant), the registered owner of the trade-mark MOMENTUM (the Mark), registration number TMA447,820.

[2] The Mark is registered for use in association with the following wares and services:

Computer software; printed matter, namely books, manuals, periodicals and drawings; (the Wares) and

Installation, maintenance and repair of computer software at the request or specification of others (the Services).

[3] Such notice requires the registrant to show whether the Mark has been used in Canada in association with each of the Wares and Services 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 use since that date. The relevant period in this case is any time between March 14, 2005 and March 14, 2008 (the “relevant period”).

[4] In response to the notice, the affidavit of Charles Laflèche, together with exhibits A to W, has been furnished. Both parties filed written representations and no oral hearing was requested.

[5] Section 45 proceedings are considered to be summary and expeditious for clearing the register of non-active trade-marks. The expression “clearing deadwood” has been used often to describe such proceeding [see *Philip Morris Inc. v. Imperial Tobacco Ltd.* (1987), 13 C.P.R. (3d) 289].

[6] A simple allegation of use of the Mark is not sufficient to evidence its use in association with the Wares and Services within the meaning of s. 4 of the Act. There is no need for evidentiary overkill establishing such use. [See *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980) 53 C.P.R. (4th) 62].

[7] The nature of these proceedings were described in the following terms by Mr. Justice Strayer in *Lewis Thomson & Son Ltd. v. Rogers, Bereskin & Parr* (1988), 21 C.P.R. (3d) 483:

I am not prepared to find, as the respondent has suggested, that there is some particular kind of evidence which must be provided, and that any affidavit which does not attach an invoice is presumptively useless. I believe that the affidavit here sufficiently sets out use and, within the general context of the nature of these proceedings, is quite adequate. The nature of these proceedings is such, it seems to me, that it is not considered that the facts of use are to be infinitely contestable before the Registrar or the Federal Court. It seems to me that what is required is that the registrant establish a prima facie case of use and that that is all that is expected of him. There is usually no cross-examination permitted with respect to affidavits filed either before the Registrar or before this Court in these matters, and there is no provision for respondents filing any evidence before the Registrar. It seems to me that that indicates quite clearly that these are not considered to be proceedings where there should be an infinite contestation of the facts.

[8] Finally, the evidence must be taken as a whole [see *Worldplay Ltd. v. Teachers Insurance & Annuity Assn.* (2004), 37 C.P.R. (4th) 182].

[9] As argued by the requesting party, there is no evidence aimed at explaining any non-use of the Mark in association with Wares and Services of part thereof. If I conclude to the non-use of the Mark in association with Wares and Services or part thereof, the Mark will either have to be expunged (no use of the Mark in association with Wares and Services) or

the registration will be amended if I conclude that there is evidence of use of the Mark but only in association with some of the Wares and/or some of the Services.

[10] Mr. Laflèche has been the registrant's Founder and Chief Financial Officer since January 2008. He has been employed by the registrant or its predecessors in title since 1995. He first provides in his affidavit some corporate information on the registrant. He then makes an allegation that the registrant and its predecessors in title have been using the Mark in association with the Wares and Services since at least July 10, 1995. He states that the Registrant is the owner of a family of trade-marks in which is included the Mark.

[11] He states that the registrant's business is the sale and licensing of computer software designed for healthcare facilities. He alleges that: "In the years 2005, 2006 and 2007 [the registrant] generated multi-million dollar sales directly related to its computer software programs, the installation, conversion and training of customers in relation to its computer software programs and providing maintenance and support services to customers related to those computer programs".

[12] The evidence filed shows that the registrant's software comprises various modules or components such as for example: "Financial Management System"; "Clinical System"; "Physician Orders"; "Dietary Management"; and "Decision Support Systems".

[13] In many of the documents filed, there are references to "Momentum Healthware" and "Momentum Healthware & design". In some instances the inscription "TM" follows the word "Healthware" or is located next to a vertical oval line appearing to the right of the word portion "Momentum Healthware".

[14] In *Canada (Registrar of Trade-marks) v. Cie. Internationale pour l'informatique CII Honeywell Bull, S.A.* (1985), C.P.R. (3d) 523 the Honorable Mr. Justice Pratte stated:

5 The problem to be resolved is not whether CII deceived the public as to the origin of its goods. It clearly did not. The real and only question is whether, by identifying its goods as it did, CII made use of its trade mark "Bull". That question must be answered in the negative unless the mark was used in such a way that the mark did not lose its identify and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used. The practical test to be applied in order to resolve a case of

this nature is to compare the trade mark as it is registered with the trade mark as it is used and determine whether the differences between these two marks are so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin

6 Viewing the problem in that light and applying that test, we cannot escape the conclusion that, in using the composite mark "CII Honeywell Bull", CII did not use its mark "Bull".

[15] I consider that by adding the coined word "Healthware" to the common word "Momentum" an unaware purchaser would likely infer that the wares and/or services offered for sale in association with that trade-mark would not have the same origin as those offered in association with the Mark. The addition of the symbol "TM" in the manner described above is an additional reason to conclude that Momentum Healthware constitutes a trade-mark of its own [see *Bull, Housser & Tupper v. Bulldog Bag Ltd.* 1991 CarswellNat 1626]. Obviously the same conclusion applies to the trade-mark Momentum Healthware & design.

[16] There are instances where the word "Momentum" appears alone. The requesting party suggests that in those cases it does not constitute use of the Mark but rather it represents an abbreviated version of the registrant's trade-name. I agree with the requesting party that in some instances it is obvious that the use of the word "Momentum" represents an abbreviated version of the trade-name Momentum Healthware. I refer, as an example, to exhibit C to Mr. Laflèche's affidavit wherein Momentum is a defined term for the trade-name Momentum Healthware.

[17] Is the word "Momentum" used either alone or with other words such that it constitutes use of the Mark? There are some instances and I will refer to them hereinafter. I will also identify the wares and services associated with such use.

[18] Mr. Laflèche filed as exhibit A to his affidavit what has been identified as an engagement letter dated April 19, 2007. I reproduce the first paragraph of that letter to fully understand its meaning:

This Engagement Letter combined with the attached Software License Agreement (SLA) and Support & Maintenance Agreement (SMA) together form the contract governing the use of the software licenses, implementation and support services for the products listed below.

Also as part of exhibit A is an invoice dated April 24, 2007 setting out the license fees for the software.

[19] The letter filed as exhibit A is entitled: “Momentum Software-Engagement Letter”. Under the “Pricing Summary” heading there is reference to certain modules of the software. Also the letter refers to “License Fees”, “Implementation and Training” and “Annual Support and Maintenance fees”. In this context “Momentum” is used as a trade-mark in association with software and the services of installation, maintenance and repair of software.

[20] Another engagement letter dated March 31, 2005 was filed as exhibit C together with invoices dated April 25, July 8, July 31 and December 23, 2005 and September 28, 2006, all related also to the registrant’s computer software. As stated earlier, any reference to “Momentum” in that letter does not constitute evidence of use of the Mark. However the invoices attached as part of exhibit C constitute another example of the use of “Momentum” as a trade-mark. The various invoices, under the heading “Description”, have the inscriptions “Momentum Financial Management” and “Annual Software Support and Maintenance-Momentum Financial Management”. Those invoices reflect the license fees for the Momentum software module “Financial Management” and its support and maintenance fees.

[21] Exhibits L, M and N are promotional booklets for the products “Enterprise Solution for Healthcare”, “Solution for Canadian Long-Term Care” and “Dietary Management”. He states that these booklets were in use during the relevant period. They promote computer software products available for purchase in Canada. The heading on page 5 of the promotional booklets filed as exhibits M and N reads: “Momentum products may be implemented as a complete and integrated solution or as modular components”. Those mentions clearly refer to the Mark in association with the registrant’s software and its components.

[22] Mr. Laflèche alleges that the registrant has developed various books, manuals, periodicals and brochures for the purpose of promoting the computer software products it sells, and to support customer training and use of those computer software products.

[23] He filed as exhibit J to his affidavit an excerpt of the user manual entitled “Care Management System Care Touch’ Just the Basics’ User Guide v. 9.0” dated January 2008 and as exhibit K an excerpt of the registrant’s “Care Management System Installation Guide” dated also January 2008. He states that the latter is used by the registrant’s customers for the installation of the registrant’s computer software programs. It also contains contact information for the registrant’s Customer Support Team that provides ongoing assistance to customers in relation to the installation, maintenance and repair of computer software programs licensed by the registrant.

[24] Exhibit J does contain the following copyright notice: “The Momentum Care Management System Care Security User Guide...” while exhibit K has the following inscription: “The Momentum Care Management Install Guide...”. I consider the use of “Momentum” in this context as a reference to the Mark and used in association with books and manuals.

[25] There is no evidence of what may have constituted use of the Mark in association with periodicals and drawings in Canada during the relevant period. Therefore the registration will be amended accordingly.

[26] From this evidence I conclude that the registrant has established use of the Mark in Canada in association with: Computer software; printed matter, namely books and manuals; installation, maintenance and repair of computer software at the request or specification of others.

Disposition

[27] Pursuant to the authority delegated to me under s. 63(3) of the Act, registration TMA447,820 for the Mark will be amended to delete the following wares: “periodicals and drawings” in compliance with the provisions of s. 45 of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office