



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

Citation: 2014 TMOB 162
Date of Decision: 2014-08-06

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Nexus Law Group LLP against registration
No. TMA731,539 for the trade-mark INNOTECH
BUILDING in the name of 2129529 Ontario Inc.**

[1] At the request of Nexus Law Group LLP (the Requesting Party), the Registrar of Trade-marks forwarded a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on May 15, 2012 to 2129529 Ontario Inc. (the Owner), the registered owner of registration No. TMA731,539 for the trade-mark INNOTECH BUILDING (the Mark).

[2] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been 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 between May 15, 2009 and May 15, 2012.

[3] Although the Mark was originally registered in association with a variety of property management services, subsequent to the filing of evidence and submission of the Requesting Party's written representations, the Owner voluntarily amended the registration. The Mark is now registered in association with "leasing of office space" only. Accordingly, some of the Requesting Party's submissions are now moot, and this decision will address only this remaining service.

[4] The definition of “use” in association with services is set out in section 4(2) of the Act:

4(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[1] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[5] In response to the Registrar’s notice, the Owner furnished the statutory declaration of Adrian Conrad, Vice-President and Secretary-Treasurer of the Owner, declared on July 13, 2012. As noted above, the Requesting Party filed written representations, as did the Owner following its voluntary amendment to the registration. An oral hearing was not held.

[6] In his affidavit, Mr. Conrad states that, in 2007, the Owner acquired from the University of Waterloo a leasehold interest in certain lands located in the City of Waterloo. Subsequently, the Owner completed construction of an office building on these lands in early 2009, containing approximately 100,000 square feet of office space. The Owner named the building the “INNOTECH BUILDING” and Mr. Conrad states that it “has been continually referred to by such name during the time of construction, the time of attempted leasing and the continual time of operation of the said building.” He further asserts that the Owner has continually managed, maintained and repaired the physical plant and facilities and leased the lands and building in association with the name it bears, being the Mark.

[7] In support, attached as Exhibit A to his affidavit is a photograph of the permanent sign affixed to the building, consisting of the Mark as registered. Mr. Conrad confirms that the sign was installed at the time of completion of construction of the building and remained in place as of the date of his affidavit. As confirmation of the building’s completion in 2009, attached are copies of the “Certificate of Substantial Performance” dated April 7, 2009 (Exhibit B) and the “Final Inspection” document dated August 12, 2009 (Exhibit C).

[8] With respect to the registered services, Mr. Conrad attests that the building is “currently” sub-leased to Research in Motion Limited (RIM). Attached as Exhibit F to his affidavit is the cover page of the leasing agreement between the Owner and RIM, dated September 26, 2008. The Mark appears prominently on this page above the municipal address of the property.

[9] Mr. Conrad also attaches Exhibits D and E to his affidavit, which he attests consist of advertising material promoting office space for lease at the Innotech Building. However, he makes no statements regarding the timing or extent of distribution of these materials. I would note that Exhibit D displays the text “Summer 2008 Occupancy”, indicating that these materials likely pre-date the relevant period.

[10] Finally, Mr. Conrad attests that the City of Waterloo recently named the Innotech Building “one of eight properties as being the best urban designs of the past decade”. Attached as Exhibit G is a copy of the related City of Waterloo media release dated June 19, 2012. However, I note that this media release is largely irrelevant, as it makes no reference to the registered services and is dated after the relevant period.

[11] Indeed, all of the supporting documentation, including the lease agreement and advertising material, is from outside of the relevant period. The issue in this case, then, is whether the appearance of the Mark on the building itself is sufficient to constitute use of the Mark in association with the registered services, “leasing of office space”. In this respect, the evidence demonstrates that RIM leased the entirety of the building from the Owner for the entirety of the relevant period. There is no evidence before me of active efforts on the part of the Owner to otherwise advertise or promote its leasing services during the relevant period.

[12] However, in my view, the nature of “leasing services” is continual and such services are not performed within the meaning of the Act only at the date of signing of a lease. Contrary to the Requesting Party’s submission, I agree with the Owner that it is not required to provide *additional* leasing services during the relevant period, as its leasing services were provided continually to RIM within the Innotech Building and under the Mark throughout that period.

[13] Further, this is not a case where the trade-mark appeared only on a contract that was entered into *prior* to the relevant period and not otherwise referenced *during* the relevant period [see, for example, *PEI Licensing Inc v Canadian Football League Players Association* (2013), 115 CPR (4th) 232 (TMOB)]. In this case, RIM is the third party that benefits from the Owner's leasing services [see *Ralston Purina Co v Effem Foods Ltd* (1997), 81 CPR (3d) 528 (TMOB)] and the Mark continued to be displayed during the relevant period by virtue of its appearance on the leased building itself, as shown in Exhibit A and attested to by Mr. Conrad.

[14] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered services "leasing of office space" within the meaning of sections 4(2) and 45 of the Act.

Disposition

[15] Accordingly, pursuant to the authority delegated to me under subsection 63(3) of the Act and in compliance with section 45 of the Act, the registration will be maintained.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office