



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

Citation: 2011 TMOB 89
Date of Decision: 2011-05-26

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Firefly Mobile Media International LLC
against registration No. TMA654,548 for the trade-mark
FIREFLY in the name of Heather McKenzie Anspach
Fraser**

[1] At the request of Firefly Mobile Media International LLC (the Requesting Party), the Registrar of Trade-marks forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on July 29, 2009 to Heather McKenzie Anspach Fraser, the registered owner (the Registrant) of registration No. TMA654,548 for the trade-mark FIREFLY (the Mark).

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

(1) Providing grants and funding for medical research and fellowships; providing grants and scholarships for post-secondary education; advertising and design agency services; business marketing consultation services; developing promotional campaigns for businesses and non-profit enterprises; product and service concept development; preparing and placing advertising for others; developing promotional campaigns for businesses; market analysis and research for others.

[3] 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 July 29, 2006 and July 29, 2009 (the Relevant Period).

[4] “Use” in association with services is set out in s. 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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of a s. 45 proceeding [*Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1979), 45 C.P.R. (2d) 194, aff’d (1980), 53 C.P.R. (2d) 63 (F.C.A.)]. Although the threshold for establishing use in these proceedings is quite low [*Lang, Michener, Lawrence & Shaw v. Woods Canada Ltd.* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.)], and evidentiary overkill is not required [*Union Electric Supply Co. v. Canada (Registrar of Trade Marks)* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the wares or services specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Registrant, Heather McKenzie Anspach Fraser, filed an affidavit sworn on February 25, 2010, together with Exhibits A through Y. Neither the Registrant nor the Requesting Party filed written arguments; an oral hearing was not held.

[7] In her affidavit, Ms. Fraser identifies herself as the Founder and Chair of the Board of Directors of the Firefly Foundation, and states that the Firefly Foundation is a registered charity that funds education and research in the field of neurodegenerative diseases (ND). Ms. Fraser attests that, during the Relevant Period, the Firefly Foundation continuously used the Mark under licence from her and that she controlled and continues to control the character and quality of the services provided by the Firefly Foundation in association with the Mark. I am therefore satisfied that any use of the Mark shown during the Relevant Period accrued to the benefit of the Registrant [*Gowling, Strathy & Henderson v. Samsonsite Corp.* (1996) 66 C.P.R. (3d) 560 (T.M.O.B.)].

[8] Ms. Fraser attests that during the Relevant Period, the Firefly Foundation raised funds for ND research initiatives by soliciting donations from individuals and third party organizations. She also states that the Firefly Foundation provided marketing and promotion services to third parties during the Relevant Period.

[9] With respect to the services “providing grants and funding for medical research and fellowships; providing grants and scholarships for post-secondary education”, Ms. Fraser attests that the Firefly Foundation funds research through the Centre for Research in Neurodegenerative Diseases (CRND) in the Faculty of Medicine at the University of Toronto. She states that the Firefly Foundation committed to grant five separate installments of \$100,000 in each of the years from 2007 to 2010, with two installments made in 2007. Attached at Exhibit B is a copy of the receipt for one such installment, issued on January 28, 2009. As well, Ms. Fraser states that the Firefly Foundation has also partnered with the Alzheimer Society of Ontario to create a joint research and fundraising initiative, the FIREFLY Spark Award. Ms. Fraser attests that this initiative grants up to \$200,000 over two years to a researcher in the field of ND. In support, attached as Exhibits C through F are documents relating to the Firefly Spark Award, including the memorandum of understanding between the Alzheimer Society of Ontario and the Firefly Foundation dated March 6, 2008 and a copy of a 2009 newsletter from the Firefly Foundation advertising the winner of the 2009 Firefly Spark Award.

[10] In addition to the aforementioned evidence, attached as Exhibits H through O are sample materials used for the promotion and advertising of the Firefly’s various grants and funding initiatives. These materials include brochures, buttons, cards, postcards, posters and envelope labels. I note that the Mark is displayed throughout the materials, often along with information regarding the charitable activities of the Firefly Foundation. For example, the sample poster reproduced at Exhibit L indicates that “Firefly is a charitable organization that funds research in neurodegenerative diseases...” and that “for more information or to make a donation visit *fireflyfoundation.org*”. I note that the Mark is prominently displayed at the bottom of the poster in a stylized font with the trade-mark symbol.

[11] As indicated, some of the above-mentioned materials also direct consumers to the Firefly Foundation’s website, *fireflyfoundation.org* for more information. Attached as Exhibit Q to Ms. Fraser’s affidavit are printouts of archived versions of the website from January 10, 2008 and March 17, 2008. These pages advertise and describe the Firefly Foundation’s fundraising efforts at the time. In addition, attached as Exhibit S are copies of screen captures of the website, which Ms. Fraser attests are representative of how the pages would have appeared between April 2007

and September 2008. The pages describe the Firefly Foundation's fundraising efforts as they relate to the aforementioned Firefly Spark Award. Ms. Fraser attests that the Mark was displayed on the website during the Relevant Period and that anyone browsing the website would have seen that the Firefly Foundation provides funding to CRND and provides information on how to make donations. I further note both sets of pages include the statement "All content is © Firefly™ 2006".

[12] In view of the ample evidence provided, I am satisfied that Registrant has demonstrated use of the Mark in association with the services "providing grants and funding for medical research and fellowships; providing grants and scholarships for post-secondary education" within the meaning of s. 4(2) and s. 45 of the *Trade-marks Act*.

[13] I turn now to the advertising and marketing related services, namely, "advertising and design agency services; business marketing consultation services; developing promotional campaigns for businesses and non-profit enterprises; product and service concept development; preparing and placing advertising for others; developing promotional campaigns for businesses; market analysis and research for others". In her affidavit, Ms. Fraser provides four examples of the Foundation's provision of such services to other businesses.

[14] First, Ms. Fraser attaches as Exhibit U to her affidavit copies of presentations given by the Firefly Foundation in 2008 to a third party organization that manufactures and sells confectionary products. (In the affidavit and attached exhibits, the name of the third party has been redacted for reasons of confidentiality.) The presentations are with respect to a proposed partnership between the third party and the Firefly Foundation to promote the Foundation's activities and the third party's products together through various means. Ms. Fraser attests that the Firefly Foundation conducted market research and analysis to assist the third party in determining whether a partnership with the Foundation would be beneficial to its business. I note that the Mark appears prominently throughout the presentation materials.

[15] For the second example, related to the first, Ms. Fraser attests that the Firefly Foundation also offered product and website development concepts to the third party as potential means of marketing and promoting itself and the Foundation. In support, attached as Exhibit V are

pictures of sample packaging concepts that were offered to the third party for their confectionary products during the Relevant Period. I note that although the third party's name or logo is blacked out to protect confidential information, the sample packaging displays the Mark. Ms. Fraser further attests that website concepts advertising the third party's name or logo were also provided.

[16] With respect to the third example provided by Ms. Fraser, attached to her affidavit as Exhibits W and X are materials related to the development and implementation of a holiday cards sales campaign. The holiday cards display the Mark and also advertise the name or logo of a third party partner that distributes the cards, thus generating positive advertising and goodwill for the third party, while raising awareness of the Firefly Foundation. The attached exhibits relate to the "Firefly Holiday Card Initiative 2008" program implemented in conjunction with KPMG LLP during the Relevant Period. Exhibit W is a copy of a mock-up holiday card and corresponding order sheet prepared for KPMG LLP. In addition to copies of the holiday cards themselves, Exhibit X includes copies of the proposal presentation made by the Firefly Foundation to KPMG, a press release, information sheets and pledge sheets all related to the distribution of Firefly holiday cards by KPMG LLP in 2008. Again, I note that the Mark appears prominently throughout the materials.

[17] Finally, Ms. Fraser attaches as Exhibit Y a memorandum of understanding between the Firefly Foundation and Lumos Labs, Inc. dated November 26, 2007 as further evidence of the promotion and marketing services offered in association with the Mark. The agreement is for the advertisement and promotion of Lumos Labs, Inc.'s products on the Firefly Foundation's website, which Ms. Fraser attests began around 2007 and continues to the present day. Included in Exhibit T is an example of the means of advertising and promoting such products, namely an advertisement for Lumos Labs Inc.'s "Lumosity", which is advertised on the site as a "premier brain fitness program". Users of the website are invited to sign up for an annual subscription, with a percentage of the proceeds donated to the Firefly Foundation.

[18] In determining whether the above amounts to advertisement or performance of the advertising and marketing related services as registered, I note that services are generally granted a generous interpretation [*Aird & Berlis v. Virgin Enterprises Ltd.* (2009) 78 C.P.R. (4th) 306

(T.M.O.B.)). Statements of services may contain overlapping terms, in that the advertising or performance of one service implies the advertising or performance of another, such as, in the present case, “advertising and design agency services” and “developing promotional campaigns for businesses” [*Gowling Lafleur Henderson LLP v. Key Publishers Company Ltd*; 2010 CarswellNat 579 (T.M.O.B)]. With these principles in mind, I am prepared to accept that the remaining services were advertised and performed in Canada in association with the Mark through the Firefly Foundation’s above-exemplified advertising and marketing activities during the Relevant Period.

[19] Accordingly, in view of the evidence as a whole, I am satisfied that there is sufficient evidence before me to conclude that the Mark was used in association with the services within the meaning of s. 45 and s. 4(2) of the Act during the Relevant Period in Canada.

[20] In view of all of the foregoing, pursuant to the authority delegated to me under s. 63(3) of the Act and in compliance with the provisions of s. 45 of the Act, the registration will be maintained.

P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office