



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

Citation: 2015 TMOB 237
Date of Decision: 2015-12-31

IN THE MATTER OF SECTION 45 PROCEEDINGS

McMillan LLP

Requesting Party

and

Orange Brand Services Limited

Registered Owner

TMA540,151 for ORANGE & DESIGN
TMA545,600 for ORANGE

Registrations

[1] This is a decision involving summary expungement proceedings with respect to registration Nos. TMA540,151 for the trade-mark ORANGE & DESIGN (shown below), and TMA545,600 for the trade-mark ORANGE (the Marks), owned by Orange Brand Services Limited.



[2] The Marks are currently registered in association with a variety of telecommunications related goods and services. A complete list of the registered goods and services associated with

the Marks can be found in the attached Schedules A (with respect to registration No. TMA540,151) and B (with respect to registration No. TMA545,600).

[3] For the reasons that follow, I conclude that the registrations ought to be maintained in part.

The Proceedings

[4] On October 1, 2013, the Registrar of Trade-marks sent notices under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Orange Brand Services Limited (the Owner). The notices were sent at the request of McMillan LLP (the Requesting Party)

[5] The notices required the Owner to furnish evidence showing that it had used the Marks in Canada, at any time between October 1, 2010 and October 1, 2013, in association with each of the goods and services specified in the respective registrations. If the Marks had not been so used, the Owner was required to furnish evidence providing the date(s) when the Marks were last in use and the reasons for the absence of use since that date.

[6] The relevant definitions of use are set out in sections 4(1) and (2) of the Act as follows:

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

(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.

[7] It has been well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for clearing the register of “deadwood”. The criteria for establishing use are not demanding and an overabundance of evidence is not necessary. Nevertheless, sufficient evidence must still be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the registered goods and services [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th)]

270]. Furthermore, mere statements of use are insufficient to prove use [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[8] In response to the Registrar's notices, the Owner furnished substantially identical affidavits of Helen Jane Stanwell-Smith, sworn April 25, 2014, together with Exhibits 1 through 53 (hereafter referred to singularly as the affidavit).

[9] Both parties filed written representations; however, only the Owner was represented at an oral hearing held jointly with hearings for summary expungement proceedings with respect to three other registrations owned by the Owner. Separate decisions will be issued for these other proceedings, which pertain to registration Nos. TMA392,593, TMA583,274, and TMA773,863.

The Evidence

[10] In her affidavit, Ms. Stanwell-Smith attests that she is the Senior Legal Counsel employed by Orange Corporate Services Limited, an affiliated company to the Owner and its predecessors-in-title.

[11] Ms. Stanwell-Smith states that the Owner and/or its licensees have used the Marks in association with the registered goods and services in Canada during the relevant period. More particularly, she narrows her statement of use with respect to the following registered goods:

telephone handsets;

parts and fittings for telecommunications apparatus and instruments, namely, adapters, desk top charging stands, loud speakers for use with telephones;

headsets for use with telephones, brackets for use with telephones, hand-free;

fax and data magnetic cards;

smart cards for use with mobile telephone apparatus;

computer software for facilitating the transfer of information to a personal computer via a mobile link;

adapters allowing connection to a personal computer;

answerphones, visual display units, microphones with loud speaker units all for use with telephone handsets;

magnetic data carriers;

computer programmes and computer software for the operation and management of telecommunications equipment, apparatus and installations and the operation and management of a telecommunications network service;

micro-processors;

[12] With respect to the Owner's background, Ms. Stanwell-Smith explains that the Owner is 100% owned by Orange SA, a French company that is also parent to a global group of companies whose activities span the telecommunications, media, advertising, healthcare and financial services sectors. She attests that the Owner licenses its rights in the Marks to over 200 subsidiaries and related companies of Orange SA (the "Orange Group"), who use the Marks in their corporate identity and for their goods and services. She attaches, as Exhibit 2 to her affidavit, an extract from a 2012 document published by Orange SA listing the members of the Orange Group. The list includes, among other subsidiaries and members, Equant BV. She notes that the list does not specify the more than 80 international subsidiaries of the Equant sub-group which provide business-to-business services globally, as only the parent company "Equant" is referred to in this document. I note that later in her affidavit, Ms. Stanwell-Smith attests that one such Equant subsidiary, Equant Canada Inc. changed its name to Orange Business Services Canada, Inc. (OBSC) in December 2012.

[13] In terms of licensed use of the Marks in Canada, Ms. Stanwell-Smith specifically identifies the following licensees of the Owner: OBSC; Orange International Carriers and shared services, *a.k.a.* International Wholesale Solutions, a division of the Orange Group (International Carriers); Silicomp Canada Inc. (Silicomp); and Etrali North America Inc. (Etrali). I note that all of these entities are listed as members of the Orange Group per Exhibit 2. She attests that throughout the relevant period, the Owner exercised direct control over the character and quality of the goods and services provided and promoted by these licensees in Canada in association with the Marks. In addition, she provides examples of how such control was exercised, including through enforcement of extensive global guidelines published on the Internet, an excerpt of which she attaches as Exhibit 7 to her affidavit.

[14] Each of the aforementioned licensees are stated by Ms. Stanwell-Smith to provide “certain, or some” of the registered goods and services in association with the Marks to customers in Canada. She states that such goods and services are described on the following websites, excerpts of which she attaches as Exhibits 3-6 to her affidavit: *www.orange-business.com* (with respect to OBSC), *wholesalesolutions.orange.com* (with respect to International Carriers), and *www.itlabs.en.orange-business.com* (with respect to Silicomp).

Provision of Goods and Services by OBSC

[15] Ms. Stanwell-Smith identifies OBSC as the primary licensee of the Marks in Canada, and explains that OBSC has two categories of customers and prospective customers: (i) Canadian companies operating nationally or internationally to whom OBSC offers goods and services directly itself or through other international members of the Orange Group; and (ii) International companies headquartered outside of Canada conducting business operations within Canada. She explains that, during the relevant period, OBSC maintained a staff of around 90 employees based in Toronto, Vancouver, and Montreal.

[16] Ms. Stanwell-Smith further attests that during the relevant period, OBSC had over 170 customers (both Canadian and International) to which it provided goods and services in association with the Marks in Canada. She identifies several of these customers, which include large entities such as Bell Canada and Akzo Nobel. She provides annual revenue figures generated by OBSC during the relevant period, including approximate annual revenues attributable to the provision of goods and services in Canada, including those specific to telecommunications and IT services. Ms. Stanwell-Smith attests however, that due to the complex nature of OBSC’s packages of business solutions, OBSC does not separate out revenues generated between activities in Canada and those generated by OBSC which are conducted outside of Canada for Canadian clients. She further explains that OBSC does not individually account for each of the specific registered goods and services provided as customers are invoiced instead according to the business package provided. However, she provides a schedule of revenues for specific business packages (which incorporate both goods and services) attributable to each Canadian client over 2012 at Exhibit 12, which she states is representative of annual

revenues during the relevant period. She explains that for confidentiality purposes, the names of the clients have been redacted.

[17] As evidence of display of the Marks and further evidence of sales regarding the provision of goods and services to Canadian customers during the relevant period, Ms. Stanwell-Smith provides sample invoices (Exhibits 17, 19, 22, 25, 28, 31, 36, 37, and 43), brochures and sales presentation documents regarding the various business packages provided (Exhibits 13, 15, 16, 18, 20, 21, 23, 24, 26, 27, 29, 30, 38, and 39), and associated representative sales revenues.

[18] In addition, Ms. Stanwell-Smith provides website printouts and case studies with respect to services provided by OBSC specific to the healthcare industry (Exhibits 32 and 33), a sample contract (Exhibit 35), and an image of a sample SIM card bearing the Marks used by OBSC's customers in connection with such services (Exhibit 34). She explains that the SIM cards bearing the Marks are inserted into customer medical devices to connect them to the Rogers Communications mobile network in Canada. The medical devices are then enabled to send electronic signals and reports back to the customer's computer so that the customer can monitor the patient, something Ms. Stanwell-Smith states is known as "Machine to Machine" or "M2M" connectivity.

[19] With respect to the invoices, Ms. Stanwell-Smith explains that as they were regenerated from the finance systems of OBSC, they do not appear on the Orange-branded letterhead on which they were originally printed when sent to customers. However, she does provide, at Exhibit 11, a scanned copy of an invoice from 2007, bearing the Marks, which she attests is representative of invoices sent during the relevant period, demonstrating the prominence of the Marks on the invoices. As with the Exhibit 12 revenue schedule, the invoices refer to general services or business packages provided such as audio conferencing, "integrated videopresence" maintenance services, telecommunications services (specifically, fixed voice services), "business together" maintenance services, telecommunications services (specifically, "IP VPN", "DSL Premier", and "professional services"), "professional services", "machine 2 machine" services, and telephone, "GSM" and "Parix" services.

[20] The brochures, website printouts, and sales presentation documents, which also clearly bear the Marks, describe the portfolio of services/packages provided by OBSC. Ms. Stanwell-

Smith attests that these documents are representative of those that were accessed by and provided/circulated to Canadian consumers and prospective consumers by OBSC during the relevant period (see paras 33 and 63 of her affidavit and Exhibit 14, re: website traffic statistics).

[21] In addition, Ms. Stanwell-Smith details a selection of the business packages provided by OBSC in Canada in association with the Marks, and explains how each corresponds with the various goods and services in the registrations. Attached as Schedule C to this decision is a chart which summarizes the various business packages referred to by Ms. Stanwell-Smith and the registered goods and services to which she attests they correspond, as well as associated representative sales revenues.

Telephony Services Provided in Canada by International Carriers

[22] Ms. Stanwell-Smith attests that the activity of International Carriers encompasses the wholesale trading in voice, internet, data capacity, as well as content, audience and healthcare related activities among telecommunications network operators. She provides, as Exhibit 40, a brochure bearing the Marks, which details the services offered by International Carriers to customers in Canada and around the world. She states that this brochure was distributed by International Carriers to Canadian consumers during the relevant period.

[23] In addition to the brochure, Ms. Stanwell-Smith attests that the services offered by International Carriers are advertised on the global corporate website of the Orange Group and includes printouts representative of those pages published during the relevant period at Exhibit 5. She indicates that these webpages include a map of key network coverage, which she states includes Canada.

[24] Ms. Stanwell-Smith attests that pursuant to “roaming” agreements with International Carriers, Canadian customers of network operators in Canada are able to use their mobile telephones and fixed line telephones for data and voice services when visiting foreign countries through the Orange Group’s networks. She attests that such networks are identified with the Marks on the mobile phones of such Canadian users, and that the Orange Group then invoices the Canadian operators in Canada for those services (sample invoices of which are attached at Exhibit 43). She further attests that the Orange Group has arrangements with Canadian

telecommunication network operators to enable the provision of voice telecommunication services in Canada through third party mobile networks as part of the Orange-branded packages of products and services for multinational corporations.

[25] In addition to International Carriers, Ms. Stanwell-Smith attests that OBSC offers network services to telecommunications operator customers in Canada, one such customer during the relevant period being Bell Canada. Such services to telecommunications operators are described in a brochure bearing the Mark, entitled “Solutions for Operators”, which she attaches as Exhibit 41 to her affidavit.

[26] With respect to the “roaming” arrangements with Canadian operators described above, Ms. Stanwell-Smith attaches, as Exhibit 42 to her affidavit, printouts from the websites of Rogers Communications and Bell Canada, showing the Orange network as being the roaming network available for its customers in a selection of countries. She states that these relationships between the Orange Group and the Canadian operators are representative of the relationships that existed during the relevant period.

Goods and Services Provided in Canada by Etrali Group

[27] Ms. Stanwell-Smith attests that during the relevant period, the Etrali Group provided services in association with the Marks in Canada. Specifically, she attests that Etrali provided specialized hardware, software, support services and consultancy packages for the financial commodities and equity trading community in Canada based around their main product called “Open Trade”. This product, she explains, is a fixed line telephony device with associated software. She attests that the Etrali Group also provided professional services in association with the Open Trade product, details of which are provided in brochures bearing the Marks, which she attaches under Exhibit 44.

[28] Ms. Stanwell-Smith states that the Marks appear on the Open Trade device, on the software packages used with the device, on marketing and sales materials, and on invoices for the device and supporting services. I note that consistent with her statement, the Mark clearly appears on the Open Trade devices in the photographs in the brochures. The Open Trade product, she attests, was a high dollar value item, designed as a “personal trading assistant” for

financial traders on the trading floor of major financial institutions. She explains that as well as multiple handsets to receive, transmit and record voice calls, the device incorporated a multimedia touch screen, a modem providing internet connectivity and software for traders to complete transactions on a single terminal. This product was supported by a team of professionals wherein during the period 2011-2012, over 30 devices were installed at client sites in Canada.

[29] Ms. Stanwell-Smith explains that Silicomp Canada acted as the distributor of the Open Trade product and associated services conducted by Etrali under the Marks in Canada during the relevant period. She attaches example invoices issued by Silicomp Canada (Exhibit 46), bearing the Mark, wherein the services being invoiced are described as “maintenance Etrali”.

Use of the Orange Marks in Canada by Orange Partner

[30] Ms. Stanwell-Smith attests that Orange Partner is a division of Orange SA. This division, she explains, works with a broad network of industry professionals worldwide (*e.g.* third-party software developer companies, academia, etc.) to develop innovative and potentially profitable software applications for use on its communications hardware. In doing so, she explains that Orange Partner provides members of its network with online support services, educational services, tools, knowledge and expertise to invent, collaborate and monetize new products through the Orange Partner website. In support, she provides printouts from the *orangepartner.com* website from 2010, bearing the Marks, which detail such services (Exhibit 47).

[31] Ms. Stanwell-Smith attests that Orange Partner provides its members with downloadable software tools (such as APIs or application programme interfaces) to assist in creating applications that operate to required standards on devices bearing the Marks. She attests that the Marks are prominently displayed on the display screen at the time these tools are downloaded from the Orange Partner website to the consumer’s computers, printouts of which she attaches as Exhibit 48. She further provides website traffic statistics with respect to unique hits to the Orange Partner website originating from Canada for the years 2010-2013.

[32] Attached as Schedule D to this decision is an additional chart which lists the specific goods and services Ms. Stanwell-Smith attests are provided by International Carriers and OBSC, the Etrali Group (via Silicomp Canada), and the Orange Partner division of the Orange Group as described above.

Promotion of the Marks

[33] Ms. Stanwell-Smith attests that OBSC offers promotional items to Canadian clients in connection with its services, including computer accessories bearing the Marks. She explains that these items are distributed free of charge at sales and marketing events, and are also available online through OBSC's sales and marketing teams. She attaches website screenshots showing images that are representative of the computer accessories, bearing the Marks, provided to customers and prospective customers in Canada during the relevant period (Exhibit 49).

[34] In addition to offering promotional items, Ms. Stanwell-Smith explains that the Owner, through OBSC and other licensees, uses the Marks to engage in promotional and marketing activities aimed at existing Canadian customers and prospective customers. She provides an article on one such event, which discusses the launch of Orange Partner's developer centre in Vancouver in 2010 (Exhibit 50).

[35] Ms. Stanwell-Smith states that due to the largely joint nature of promotional and marketing activities between Canada and the United States, it is difficult to apportion an amount of the North American budget for such events actually spent on events in Canada. Nevertheless, Ms. Stanwell-Smith estimates that the global marketing and promotional investment touching Canada is over \$100,000US annually.

[36] Lastly, Ms. Stanwell-Smith describes other means of promotion as well, including sponsorship of Cirque du Soleil performances (see Exhibit 51 – publicity materials associated with the event), e-mail marketing campaigns (Exhibit 52), and the publication of a magazine displaying the Marks distributed to subscribers in Canada during the relevant period (Exhibit 53).

Analysis and Reasons for Decision

[37] The Requesting Party's submissions can be summarized as follows:

- The evidence shows that the Marks were not used by the Owner and fails to demonstrate that the Owner actually exercised any control over the way the Marks were used during the relevant period;
- There is no evidence to show that the Marks were associated with the registered goods and services in Canada during the relevant period.

I will deal with each of these submissions in turn.

Licensed Use

[38] With respect to the first submission outlined above, the Requesting Party submits that the Owner has failed to demonstrate any evidence of *actual* control over the nature and quality of the goods and services offered in relation to the Marks during the relevant period [citing *Lafco Enterprises Inc v Canadian Home Publishers*, 2013 TMOB 44; *DeGrandpré Chait c Mead Products LLC*, 2013 TMOB 73]. The Requesting Party submits that the only evidence in support of the alleged control exercised by the Owner consists of a document entitled “Orange core guidelines” attached at Exhibit 7, and statements made by Ms. Stanwell-Smith that reviews are held and that brand use support is offered to licensees (per paragraph 19 of the affidavit). However, the Requesting Party submits, these allegations are not substantiated by any further evidence and do not include particulars nor any further evidence demonstrating the enforcement of the Orange core guidelines.

[39] Further to this, the Requesting Party submits that the corporate relationship between the Owner and the alleged licensees is not enough to establish a license [citing *Cheung Kong Holdings Ltd v Living Realty Inc* (1999), 4 CPR (4th) 71 (FC); and *MCI Communications Corp v MCI Multinet Communications Inc*, 61 CPR (3d) 245].

[40] In reply, the Owner submits that it is well established that filing a copy of a license agreement is not mandatory in a section 45 proceeding, provided that the evidence establishes that the registered owner has control over the character and quality of the goods bearing the trade-mark [citing *Canadian Home Publishers (Re)*, 2013 TMOB 44 at para 11]. Furthermore, the Owner submits, the requirement to establish the control required under section 50(1) of the

Act can be established, as it has in the present case, by clearly swearing to the fact that the trade-mark owner exerts the requisite control [citing *Gowling, Strathy and Henderson v. Samsonite Corp* (1996), 66 CPR (3d) 560 and *Mantha & Associés/Associates v Central Transport Inc* (1995), 64 CPR (3d) 354]. In fact, the Owner submits, the cases cited by the Requesting Party support this proposition (see for example, *De Grandpré Chait, supra*, at para 16 and *Lafco, supra* at para 11). The Owner also distinguishes *Cheung Kong, supra*, in that there was no evidence in that case, beyond a corporate relationship, that the registrant did anything to exercise control over the character and quality of the goods and services associated with the trade-mark.

[41] In any event, the Owner submits, Ms. Stanwell-Smith provides further facts and evidence supporting the Owner's control over the character and quality of the goods provided under the Mark, including statements which provide specific examples of how such control is exercised. These statements, the Owner submits, qualify as assertions of fact rather than assertions of law and are clearly acceptable in section 45 proceedings.

[42] As stated by the Federal Court, there are three main methods by which a trade-mark owner can demonstrate the requisite control pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of the license agreement that provides for the requisite control [see *Empresa Cubana Del Tabaco Trading v Shapiro Cohen*, 2011 FC 102, 91 CPR (4th) 248 at para 84]. In the present case, as can be concluded from the Owner's above-noted submissions, two such methods have been satisfied. That is, not only has Ms. Stanwell-Smith provided a clear statement attesting to such control, but she has provided sworn statements describing specific examples of how such control is exercised. Consequently, I am satisfied that any use of the Mark by the licensees identified by Ms. Stanwell-Smith, is licensed use, which enures to the benefit of the Owner pursuant to section 50 of the Act.

Were the Marks Associated with the Goods and Services in Canada during the relevant period?

[43] For ease of discussion, the following analysis will firstly be directed at the registered goods, and then secondly, aimed at the registered services, as per the Requesting Party's submissions.

The Registered Goods

[44] The Requesting Party correctly submits that use of the Marks must be shown in association with *each* of the goods specified in the registrations; that transfers in such goods in Canada must be made in the normal course of trade; and that notice of association of the Marks must be given at the time of transfer of property or possession in the goods to constitute use under section 4(1) of the Act. The Requesting Party submits that these requirements have not been met in the present case. It notes that, Ms. Stanwell-Smith attempts to justify the absence of such use of the Marks by mentioning that, due to the complexity and interrelated nature of the registered goods and services, they are sold as packages under the Marks. However, the Requesting Party submits, notice of association of the Marks should nonetheless be given. For example, the Requesting Party submits, in the case with downloadable or built-in software, the case law typically requires that the trade-mark be displayed on the computer screen when the computer program is executed [citing as support *BMB Compuscience Canada Ltd v Bramalea Ltd* (1989), 22 CPR (3d) 561 (FC)].

[45] The Owner, on the other hand, submits that the Stanwell-Smith affidavit provides evidence of use of the Marks in association with the specified registered goods during the relevant period. In this regard, the Owner submits that in accordance with section 4(1) of the Act, notice of association of a trade-mark can occur through other means (*i.e.* “in any other manner”), provided that such notice of association is given to purchasers.

[46] The Owner submits that it should be noted that the *BMB* decision relied upon by the Requesting Party was decided over 25 years ago, a fact they submit is particularly relevant given the ever-evolving nature of computers, computer software and related technologies. In any event, the Owner submits, the *BMB* decision does not stand for the proposition put forth by the Requesting Party, nor have subsequent cases interpreted it to stand for that proposition [citing in support, *Gowling Lafleur Henderson v IBM Canada Limited* (2004), 38 CPR (4th) 475 (TMOB); and *Gowling, Strathy & Henderson v Degrémont-Infilco Ltée - Degrémont Infilco Ltd* (2000), 5 CPR (4th) 550 (TMOB)].

[47] The Owner further submits that many of its goods are not the types of goods that one expects to be sold with a label or tag bearing the Marks, particularly the computer software and

related parts and equipment. Further to this, the Owner submits, its goods are generally sold as part of a package of business solutions, which it then implements and installs for its customers. With respect to notice of association of the Marks with goods sold within these packaged “business solutions”, the Owner submits that the Marks were shown to existing and prospective customers both before and after the sale and transfer of the goods through the following means: during sales presentations, on product brochures, on sales and product documents, on invoices, and on webpages and internet portals. The Owner attaches a chart to its written representations to indicate paragraph and Exhibit number references in the Stanwell-Smith affidavit indicating where evidence of use for each specific good can be located, including identifying the licensee using the Marks with such goods.

[48] It is true that notice of association of a trade-mark with goods may be given through means other than a tag or label, or marking the trade-mark on the packaging for the goods. Particularly with respect to goods such as computer software, wherein there are inherent difficulties involved in associating a trade-mark with a product that does not constitute a physical object, there are cases involving circumstances in which notice of association of the trade-mark with such goods has been accepted. Such circumstances, for example, have involved the trade-mark appearing on a license agreement which purchasers must read prior to loading the software, as well as appearing on the computer screen at the time of loading [see *Stikeman Elliot LLP v 9105-8503 Québec Inc*, 2014 TMOB 95; *Clark Wilson LLP v Genesistems, Inc*, 2014 TMOB 64; and *Fasken Martineau DuMoulin LLP v Open Solutions DTS, Inc*, 2013 TMOB 68]. As pointed out by the Owner, another example involved the appearance of a trade-mark in training manuals that consumers were made aware of and shown prior to and after the transfer of the software [*IBM, supra*]. Nevertheless, the evidence must demonstrate that the trade-mark was associated with the goods at the time of transfer [see *Hennan Blaikie LLP v AlphaGlobal-IT Inc*, 2012 TMOB 166].

[49] I will now consider the evidence and submissions concerning each respective registered good having regard to the aforementioned case law.

[50] As per the chart attached to its written representations, the Owner relies upon the evidence concerning licensed use of the Marks by Etrali through the “Open Trade” product in support of the following registered goods:

telephone handsets;

parts and fittings for telecommunications apparatus and instruments, namely, batteries, chargers, adapters, in-car phone cradles, in-car charging cradles, desk top charging stands, antennae and antennae kits, loud speakers for use with telephones, lapel microphones, lapel microphone clips;

tie microphones, boom headsets microphones, remote microphones, ear phones, headsets for use with telephones, signalling enhancers for use with telephones, brackets for use with telephones, hand-free car kits for use with mobile telephones;

adapters allowing connection to a personal computer;

answerphones, pagers, visual display units, microphones with loud speaker units all for use with telephone handsets;

computer programmes and computer software for the operation and management of telecommunications equipment, apparatus and installations and the operation and management of a telecommunications network;

microprocessors.

[51] To begin with, I note that the above list of goods includes goods not attested to by Ms. Stanwell-Smith as being covered by the “Open Trade” product (per paragraph 91 of her affidavit, as listed in Schedule D to this decision). For example, many of the parts and fittings for telecommunications apparatus and instruments that appear in the chart attached to the Owner’s representations are not included in Ms. Stanwell-Smith’s assertion of use. In any event, as previously summarized, the evidence concerning the “Open Trade” product includes product brochures, website printouts, sales data, and invoices, as well as Ms. Stanwell-Smith’s statements concerning the nature of the “Open Trade” product.

[52] In examining the product brochures, I note that consistent with Ms. Stanwell-Smith’s attestations, the “Open Trade” product includes specialized hardware (a fixed line telephony device) and software to support the platform of functionality of the device; such product being described as a “personal trading assistant” and a “trading communications platform”. The

brochures include depictions of the “Open Trade” device and associated hardware, which includes telephone handsets, microphones, speakers, and display screens. The specialized trading device and associated hardware featured in the brochures clearly bear the Marks. In addition, I note that the display screens depict software running on the device which also features the Marks. Furthermore, consistent with Ms. Stanwell-Smith’s attestations, the brochures describe the software as enabling financial traders access to tools to complete transactions as well as to have access to a trading network that permits various forms of communications including voice, video, and instant messaging.

[53] I accept that sales were made of the Open Trade product during the relevant period having regard to the invoices and Ms. Stanwell-Smith’s sworn statement that over 30 such devices were installed at client sites in Canada in the period 2011-2012. Furthermore, I accept that the invoices reflect sales of both goods and services bundled together (the “Open Trade” product), as per Ms. Stanwell-Smith’s attestations in this regard, and her testimony with respect to the nature of the Owner’s business and inter-related goods and services; all of which are consistent with the evidence as a whole concerning the “Open Trade” product [see *Sophia Financial Group v Tigrent Learning Inc*, 2014 TMOB 124 regarding goods and services packaged and sold together].

[54] However, I do not accept that the brochures, website printouts, or the invoices provided the requisite notice of association of the Marks at the time of transfer of the Open Trade-related goods. Distinguishable from the cases relied upon by the Owner, there is no evidence that consumers consulted with the information provided in the brochures or the website, prior to and after the transfer of the Open Trade-related goods. Rather, I consider that the brochures and the website constitute evidence of advertising of the Marks in relation to the goods, which is not sufficient to show use of a trade-mark pursuant to section 4(1) of the Act [see *AlphaGlobal-IT*, *supra*; and *BMW Canada Inc v Nissan Canada Inc*, 2007 FCA 255, 60 CPR (4th) 181]. Furthermore, I do not consider that the invoices provided the requisite notice of association either as they do not refer to any specific goods, but rather only generally refer to “maintenance” services.

[55] Nevertheless, with respect to the Open Trade product, I am prepared to accept that the Marks were affixed to the Open Trade-related goods, as depicted in images of these goods in the brochures [see *Borden Ladner Gervais LLP v Woods Industries (Canada) Inc*, 2007 CanLII 80923]. This conclusion is consistent with Ms. Stanwell-Smith’s attestation that the Marks appear on the [Open Trade] device, and on the software packages used with the device (paragraph 87 of her affidavit).

[56] However, the evidence concerning the “Open Trade” product does not show use of the Marks in association with *all* of the registered goods that Ms. Stanwell-Smith purports are covered by this product. Absent such evidence, I consider her statement of use with respect to these goods to be merely an assertion of use [per *Plough, supra*]. As discussed above, the only goods associated with the Open Trade device depicted in the evidence appear to be telephone handsets, microphones, speakers, visual display units, and software associated with the Open Trade device.

[57] I will now look to the remaining evidence and consider the parties’ submissions with respect to the remaining goods.

[58] The Owner refers to the evidence concerning promotional items given out by OBSC to Canadian clients in connection with its services (as shown on the website in Exhibit 49), as further evidence of use of the Marks in association with goods falling under the category “parts and fittings for telecommunications apparatus and instruments”. I note, however, that the mere distribution of goods without payment or exchange for the goods, for the purpose of acquiring profits from the marked goods, is generally not sufficient to constitute use within the meaning of the Act [see *Gowling, Strathy & Henderson v Royal Bank of Canada* (1995), 63 CPR (3d) 322 (FCTD); and *Renaud Cointreau & Cie v Cordon Bleu International Ltd.* (1993), 52 CPR (3d) 284 (TMOB)].

[59] With respect to use of the Marks in association with the goods “fax and data magnetic cards”, “smart cards for use with mobile telephone apparatus”, “computer software for facilitating the transfer of information to a personal computer via a mobile link” and “microprocessors”, the Owner relies on its evidence concerning the various business packages/services provided by OBSC (see Schedule C to this decision), as well as the

telecommunications services provided via International Carriers. While it may be that these packages/services involve the bundling of goods and services, as previously discussed, the Marks must nonetheless still be associated with the goods at the time of transfer [see *AlphaGlobal-IT Inc, supra*]. In this regard, the only evidence wherein the Marks are associated with any of the aforementioned goods concerns the M2M services. In particular, the Marks appear on a SIM card (Exhibit 34) that is given to healthcare customers to enable M2M connectivity. I consider that the SIM card would constitute the registered good “smart cards for use with mobile telephone apparatus”.

[60] The Requesting Party submits that the image of the SIM card in evidence is undated. Furthermore, the Requesting Party submits that there is an absence of any evidence regarding the sale or transfer of such SIM cards in Canada, since the address of the contracting party was concealed in the M2M customer service agreement (Exhibit 35).

[61] I note however, that there are multiple sample invoices in evidence (Exhibit 36), which clearly show the sale of M2M services to entities with Canadian addresses during the relevant period. Furthermore, I accept that the provision of this service included the sale of associated SIM cards, as per Ms. Stanwell-Smith’s statements regarding the packaging of these goods and related services together under the M2M services; this conclusion is further supported by the M2M customer service agreement.

[62] With respect to the image of the SIM card being undated, the evidence must not be viewed in isolation [*Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 at 213 (TMOB)]. In this regard, I note that the M2M customer service agreement is dated 2012 and also includes an image of a SIM card which clearly bears the Marks (page 20 of the agreement). While it is true that the image of the SIM card in Exhibit 34 only generally refers to the year 2013 (the relevant period ending October 1, 2013), I am able to infer, having regard to the aforementioned evidence, that this image of the SIM card bearing the Marks is representative of those sold in Canada during the relevant period. Consequently, I accept that the Owner has demonstrated use of the Marks in association with “smart cards for use with mobile telephone apparatus”.

[63] The Owner submits that the evidence concerning the M2M services and the SIM card constitutes use of the Marks in association with data magnetic cards, smart cards for use with mobile telephone apparatus, magnetic data carriers and micro-processors. However, as previously indicated, I consider that the SIM card constitutes the registered good “smart cards for use with mobile telephone apparatus”. While a SIM card includes a microchip or micro-processor, when dealing with a list of registered goods, it is the practice to consider each listed good as being somehow distinct from the others [see *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[64] Lastly, with respect to the registered goods in the nature of “computer software” and “computer programmes”, the Owner additionally relies on the evidence of use of the Marks in association with downloadable API’s (application programme interfaces) provided by Orange Partner. The webpage printouts in Exhibit 48 display the Marks in association with these downloadable software tools; however, there is no evidence that such goods were ever the subject of a commercial transaction. Consequently, this evidence is insufficient to show that there were transfers of such goods in the normal course of trade in Canada during the relevant period.

[65] Having regard to the foregoing, I accept that use of the Marks has been shown in accordance with sections 4(1) and 45 of the Act with respect to the following registered goods:

telephone handsets;

smart cards for use with mobile telephone apparatus;

visual display units, microphones with loud speaker units all for use with telephone handsets; and

computer programmes and computer software for the operation and management of telecommunications equipment, apparatus and installations and the operation and management of a telecommunications network; but not including any of the aforesaid goods coloured orange.

[66] I will now turn to a discussion of the registered services.

The Registered Services

[67] With respect to the services described as “the provision of a mobile telephone network”, the Owner relies on the evidence concerning the specific business packages “Business Talk”, “IP VPN”, and “M2M” services provided by OBSC, as well as the telephony services provided via International Carriers. With respect to the remaining registered services, the Owner also relies on the aforementioned evidence, as well as evidence concerning other business packages provided by OBSC (namely, “Integrated Videopresence” and “Business Together), as well as those services associated with the Open Trade product provided by Etrali.

[68] I am satisfied based on the evidence concerning the aforementioned business packages provided by OBSC, that such services fall within the ambit of the registered services. This much has not been contested by the Requesting Party. Rather, the Requesting Party’s submissions with respect to the evidence concerning the business packages relate mainly to whether such evidence pertains to the Canadian market.

[69] In particular, the Requesting Party submits that there is no evidence of actual circulation or distribution to Canadian clients of the brochures and sales documents associated with OBSC’s business packages. The only evidence pertaining to distribution and circulation of such documents, the Requesting Party submits, is an undated website traffic report prepared by the Owner showing hits to the *www.orange-business.com* global website from Canadian users (Exhibit 14). Such evidence, the Requesting Party submits, has questionable evidentiary value. Further to this, the Requesting Party submits that the website does not include any indicia of being directed at Canadian consumers, thus the evidence falls short of showing that such services were available to Canadian consumers.

[70] However, I note that the brochures and sales documents were not available exclusively on the website. In this regard, Ms. Stanwell-Smith makes numerous sworn statements throughout her affidavit that such documents were used by OBSC’s sales teams and circulated to consumers and prospective consumers in Canada during the relevant period. Indeed, she provides specific methods/examples of how such documents were distributed by OBSC during the relevant period, such as at “hundreds of sales pitch meetings each year to existing and prospective clients in Canada”.

[71] The Requesting Party also questioned whether certain of the brochures were dated within the relevant period. However, Ms. Stanwell-Smith clearly attests throughout her affidavit that such documents are representative of the types of documents that were circulated during the relevant period to consumers and prospective consumers in Canada by OBSC.

[72] Indeed, the evidence as a whole shows that the Marks were used in advertising of such services in Canada, as per display on the OBSC brochures and sales presentation documents, as well as used in the performance of the services in Canada, as shown on the associated invoices.

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

Disposition

[74] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registrations will be maintained with respect to the registered services in their entirety, and will be amended to delete certain goods in compliance with the provisions of section 45 of the Act.

[75] As such, the amended statements of goods in the respective registrations will read as follows:

- (1) telephone handsets; smart cards for use with mobile telephone apparatus; visual display units, microphones with loud speaker units all for use with telephone handsets;
- (2) computer programmes and computer software for the operation and management of telecommunications equipment, apparatus and installations and the operation and management of a telecommunications network; but not including any of the aforesaid goods coloured orange.

Kathryn Barnett
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Hearing Date: 2015-08-04

Appearances

Sanjukta Tole

For the Registered Owner

No one appearing

For the Requesting Party

Agents of Record

Sim & McBurney

For the Registered Owner

McMillan LLP

For the Requesting Party

SCHEDULE "A"

TMA540,151 – ORANGE & DESIGN

Goods:

(1) Telephone handsets; parts and fittings for telecommunications apparatus and instruments, namely, batteries, chargers, adapters, in-car phone cradles, in-car charging cradles, desk top charging stands, antennae and antennae kits, loud speakers for use with telephones, lapel microphones, lapel microphone clips; tie microphones, boom headsets microphones, remote microphones, ear phones, headsets for use with telephones, signalling enhancers for use with telephones, brackets for use with telephones, hand-free car kits for use with mobile telephones; fax and data magnetic cards; smart cards for use with mobile telephone apparatus; computer software for facilitating the transfer of information to a personal computer via a mobile link; adapters allowing connection to a personal computer; answerphones, pagers, visual display units, microphones with loud speaker units all for use with telephone handsets; satellite transmitters and receivers for use in the operation of a mobile telephone network but not including any of the aforesaid goods coloured orange.

(2) Computers, blank and/or pre-recorded discs, tapes, wires, all being magnetic data carriers; computer programmes and computer software for the operation and management of telecommunications equipment, apparatus and installations and the operation and management of a telecommunications network service; micro-processors; keyboards, but not including any of the aforesaid goods coloured orange.

Services:

(1) The provision of a mobile telephone network; provision of services to subscribers to a mobile telephone network, namely, customer care services, security services, messaging services, message retrieval services, message answering services, information services, and rental of telephone apparatus.

SCHEDULE "B"

TMA545,600 – ORANGE

Goods:

(1) Telephone handsets; parts and fittings for telecommunications apparatus and instruments, namely, batteries, chargers, adapters, in-car phone cradles, in-car charging cradles, desk top charging stands, antennae and antennae kits, loud speakers for use with telephones, lapel microphones, lapel microphone clips; tie microphones, boom headsets microphones, remote microphones, ear phones, headsets for use with telephones, signalling enhancers for use with telephones, brackets for use with telephones, hand-free car kits for use with mobile telephones; fax and data magnetic cards; smart cards for use with mobile telephone apparatus; computer software for facilitating the transfer of information to a personal computer via a mobile link; adapters allowing connection to a personal computer; answerphones, pagers, visual display units, microphones with loud speaker units all for use with telephone handsets; satellite transmitters and receivers for use in the operation of a mobile telephone network but not

including any of the aforesaid goods coloured orange.

(2) Blank and pre-recorded computer discs, blank and pre-recorded tapes, wires, all being magnetic data carriers; computer programmes and computer software for the operation and management of telecommunications equipment, apparatus and installations and the operation and management of a telecommunications network service; micro-processors; keyboards, but not including any of the aforesaid goods coloured orange.

Services:

(1) The provision of a mobile telephone network; provision of services to subscribers to a mobile telephone network, namely, customer care services, security services, messaging services, message retrieval services, message answering services, information services, and rental of telephone apparatus.

SCHEDULE "C"

Business package/service	Goods and/or Services	Average Annual Sales Revenues during Relevant Period
<i>Telephony Services:</i>		
a. Audio and Web Conferencing Solutions	<ul style="list-style-type: none"> • Computer programmes and computer software for the operation and management of telecommunications equipment, apparatus and installations and the operation and management of a telecommunications network service. 	<ul style="list-style-type: none"> • 1.3 million US\$
b. Integrated Videopresence	<ul style="list-style-type: none"> • data magnetic cards; • computer software for facilitating the transfer of information to a personal computer via a mobile link; • computer programmes and computer software for the operation and management of telecommunications equipment, apparatus and installations and the operation and management of a telecommunications network service; • provision of services to subscribers to a mobile telephone network, namely, customer care services, security 	<ul style="list-style-type: none"> • 215,000 US\$

	<p>services, messaging services, message retrieval services, message answering services, information services, and rental of telephone apparatus.</p>	
<p>c. Business Talk</p>	<ul style="list-style-type: none"> • Data magnetic cards; • Magnetic data carriers; • Computer programmes and computer software for the operation and management of telecommunications equipment, apparatus and installations and the operation and management of a telecommunications network service; • Micro-processors; • The provision of a mobile telephone network; • Provision of services to subscribers to a mobile telephone network, namely, customer care services, security services, messaging services, message retrieval services, message answering services, information services, and rental of telephone apparatus. 	<ul style="list-style-type: none"> • 650,000 US\$
<p>d. Business Together</p>	<ul style="list-style-type: none"> • Data magnetic cards; • Smart cards for use with mobile telephone apparatus; • Computer software for facilitating the transfer of information to a personal computer via a mobile link; • Magnetic data carriers; • Computer programmes and computer software for the operation and management of telecommunications equipment, apparatus, and installations and the operation and management of a telecommunications network service; 	<ul style="list-style-type: none"> • 160,000 US\$

	<ul style="list-style-type: none"> • Micro-processors; • Provision of services to a mobile telephone network, namely, customer care services, security services, messaging services, message retrieval services, message answering services, information services, and rental of telephone apparatus. 	
<i>IT Services:</i>		
a. Internet Protocol Virtual Private Network ("IP VPN") Packages	<ul style="list-style-type: none"> • Data magnetic cards; • Computer software for facilitating the transfer of information to a personal computer via a mobile link; • Computer programmes and computer software for the operation and management of telecommunications equipment, apparatus, and installations and the operation and management of a telecommunications network service; • Micro-processors; • Provision of services to a mobile telephone network, namely, customer care services, security services, messaging services, message retrieval services, message answering services, information services, and rental of telephone apparatus. 	<ul style="list-style-type: none"> • 8 million US\$
b. Hosted Server Management ("HSM")	<ul style="list-style-type: none"> • Computer programmes and computer software for the operation and management of telecommunications equipment, apparatus, and installations and the operation and management of a telecommunications network service. 	<ul style="list-style-type: none"> • 160,000 US\$
c. Services Specific to the Healthcare Industry ("Machine to Machine or M2M")	<ul style="list-style-type: none"> • Data magnetic cards; • Smart cards for use with mobile telephone apparatus; 	<ul style="list-style-type: none"> • 650,000 US\$

connectivity, ISP services, website hosting services)	<ul style="list-style-type: none"> • Computer software for facilitating the transfer of information to a personal computer via a mobile link; • Magnetic data carriers; • Computer programmes and computer software for the operation and management of telecommunications equipment, apparatus, and installations and the operation and management of a telecommunications network service; • Micro-processors; • Provision of a mobile telephone network; • Provision of services to a mobile telephone network, namely, customer care services, security services, messaging services, message retrieval services, message answering services, information services, and rental of telephone apparatus. 	
<i>Professional Services:</i>		
a. Consulting Services – Administrator Services	<ul style="list-style-type: none"> • Computer programmes and computer software for the operation and management of telecommunications equipment, apparatus, and installations and the operation and management of a telecommunications network service. 	<ul style="list-style-type: none"> • 1.5 million US\$

SCHEDULE "D"

Licensed Provider	Goods and/or Services
International Carriers and OBSC	<ul style="list-style-type: none"> • Data magnetic cards; • Smart cards for use with mobile telephone apparatus; • Computer software for facilitating the transfer of

	<p>information to a personal computer via a mobile link;</p> <ul style="list-style-type: none"> • Computer programmes and computer software for the operation and management of telecommunications equipment, apparatus and installations and the operation and management of a telecommunications network service; • Micro-processors; • Provision of a mobile telephone network; • Provision of services to subscribers to a mobile telephone network, namely, customer care services, security services, messaging services, message retrieval services, message answering services, information services, and rental of telephone apparatus.
<p>Etrali Group (via Silicomp Canada) through the "Open Trade" product</p>	<ul style="list-style-type: none"> • Telephone handsets; • Parts and fittings for telecommunications apparatus and instruments, namely, adapters, loud speakers for use with telephones; • Headsets for use with telephones; • Adapters allowing connection to a personal computer; • Answerphones, visual display units, microphones with loud speaker units all for use with telephone handsets; • Computer programmes and computer software for the operation and management of telecommunications equipment, apparatus and installations; • Micro-processors.
<p>Orange Partner division of Orange Group</p>	<ul style="list-style-type: none"> • Computer software for facilitating the transfer of information to a personal computer via a mobile link; • Computer programmes and computer software for the operation and management of telecommunications equipment and apparatus.