



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

Citation: 2014 TMOB 282
Date of Decision: 2014-12-15

**IN THE MATTER OF A SECTION 45
PROCEEDING requested by Comptel
Corporation against registration
No. TMA713,080 for the trade-mark
COMTEL in the name of Edgar
Frondozo**

[1] This decision pertains to a summary expungement proceeding with respect to registration No. TMA713,080 for the trade-mark COMTEL owned by Edgar Frondozo.

[2] The statement of wares and services of the registration is entirely reproduced in Schedule A, attached to my decision. Generally speaking, the wares consist of telecommunications equipment, transmission equipment, global computer, data and voice networking equipment, network managers and controllers, and operating and applications software; the services consist of engineering, installation, maintenance, and distributorship services in the field of telecommunications and the operation of a business dealing in telephones, data networking and telecommunications equipment.

[3] For the reasons that follow, I conclude that the registration ought to be expunged.

The Proceeding

[4] On October 31, 2012, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Edgar Frondozo (the Registrant). This notice was sent at the request of Comptel Corporation (the Requesting Party).

[5] The notice required the Registrant to furnish evidence showing that he had used the trade-mark COMTEL (the Mark) in Canada, at any time between October 31, 2009 and October 31, 2012, in association with each of the wares and services specified in registration No. TMA713,080. If the Mark had not been so used, the Registrant was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[6] In this case, the use of the Mark in association with the registered wares is governed by section 4(1), which reads:

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

[7] As for the use of the Mark in association with the registered services, it is governed by section 4(2) of the Act. This section provides that a trade-mark is used in association with services if it is used or displayed in the performance or advertising of those services. It has been held that section 4(2) contemplates that the services advertised in Canada be performed in Canada [*Porter v Don the Beachcomber* (1966), 48 CPR 280 (Ex Ct)]. However, it has also been held that section 4(2) of the Act may be complied with if it is shown that the trade-mark owner is offering and is prepared to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (RTM)].

[8] 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 clearing the register of “deadwood”. Mere claims of use are insufficient to show the use of the trade-mark [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the criteria for establishing use are not very demanding and an overabundance of evidence is not necessary, sufficient facts must be presented to enable the Registrar to conclude that the trade-mark has been used in association with each ware or service mentioned in the registration during the relevant period [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[9] In response to the Registrar's notice, the Registrant furnished his own affidavit, sworn on January 21, 2013, with its Exhibits 1 to 3.

[10] Neither party filed written representations, but both were represented at the hearing.

The Evidence

[11] The Registrant's affidavit is restricted to two paragraphs that I reproduce below:

1. I am the registrant of the trademark COMTEL and a director of DGNETRIX COMMUNICATIONS INC. (hereinafter DGNETRIX) and as such I have personal knowledge of the matters hereinafter deposed to except where stated to be based on information and belief and where so stated I verily believe the same to be true.
2. That from October 2009 up to the present, DGNETRIX markets and sells communication hosting services and devices under the trademark COMTEL. Attached are copies of three invoices of DGENETRIX to customers for the period covered, marked as Exhibits 1, 2 & 3.

[12] I note that the invoices are for the months of December 2010, December 2011 and October 2012. Each invoices displays "dgNetrix digital globe Network" in the left top corner. Each invoice refers to the Mark under "Plan Name", which seems to be the subject matter of the invoice.

Representations of the Parties

[13] At the hearing, the Requesting Party's agent first and foremost submitted that the Registrant had failed to furnish the evidence required under section 45 of the Act. In the event the evidence would be found sufficient to establish use of the Mark in association with any of the registered wares or services, the Requesting Party's agent made subsidiary submissions, which can be summarized as follows:

- (i) the use of the Mark by Dgnetrix does not enure to the benefit of the Registrant;
- (ii) the invoices do not establish use of the Mark in association with the registered wares and services within the meaning of the Act; and

- (iii) the use of the Mark as part of the “Plan Name” on the invoices does not amount to use of the Mark as registered.

[14] The Registrant’s representative addressed the Requesting Party’s submissions by alleging facts that had neither been introduced in evidence nor explained through the affidavit. Thus, none of these submissions was of assistance to the Registrant’s case.

Analysis of the issues

[15] There is clearly no need to address all of the Requesting Party’s submissions, including those concerning the evidentiary value of the invoices, to conclude that the Registrant has failed to furnish the evidence required under section 45 of the Act. Indeed, the affidavit fails to disclose any facts enabling me to conclude that the Mark has been used in association with any of the registered wares or services during the relevant period.

[16] Suffice it to say that besides not referencing the use of the Mark in association with the wares and services listed in the registration, the Registrant does not provide any evidence demonstrating a nexus between “communication hosting services and devices” and any of the registered wares or any of the registered services.

[17] Furthermore, the Registrant has provided no evidence of special circumstances excusing the absence of use.

Disposition

[18] Pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, registration No. TMA713,080 will be expunged.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule A

Statement of Wares and Services of Registration No. TMA713,080

Wares:

(1) Telecommunications equipment, namely, telephone switches, microwave radios, repeaters and regenerators and digital processors; transmission equipment, namely, transmitters, transceivers, receivers, repeaters, multiplexors, digital processors, transport equipment providing broadband connectivity using photonic wave division multiplexing, optical network interfaces, programmable transport terminals, cross-connect frames and fibre optic data links; global computer, data and voice networking equipment, namely, routers, bridges, hubs, ethernet switches, ethernet pc cards, servers, global computer internet appliances, namely firewalls and computer software for caching, load balancing and traffic managing; network managers and controllers; and operating and applications software developed and sold to operate all the aforesaid goods.

Services:

(1) Engineering services in the field of telecommunications; installation, maintenance and repair services in the field of telecommunications equipment, distributorship services in the field of telecommunications; operation of a business dealing in telephones, data networking and telecommunications equipment.