



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

Citation: 2016 TMOB 155
Date of Decision: 2016-09-23

IN THE MATTER OF A SECTION 45 PROCEEDING

Harold W. Ashenmil **Requesting Party**

and

Xylem Water Solutions AB **Registered Owner**

TMA480,730 for AQUAVIEW **Registration**

[1] At the request of Harold W. Ashenmil (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on December 19, 2014 to Xylem Water Solutions AB (the Owner), the registered owner of registration No. TMA480,730 for the trade-mark AQUAVIEW (the Mark).

[2] The Mark is registered for use in association with the goods “Computer programs for the supervision and control of and acquisition of data from water treatment plants and pump stations.”

[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 the goods 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 December 19, 2011 and December 19, 2014.

[4] The relevant definition of “use” in association with goods is set out in section 4(1) 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.

[5] 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 FC 448, 31 CPR (4th) 270].

[6] In response to the Registrar’s notice, the Owner furnished the affidavit of Lars Larsson, Marketing Manager of the Owner, sworn on May 28, 2015 in Stockholm, Sweden. Both parties filed written representations and were represented at a hearing held on July 20, 2016.

The Owner’s Evidence

[7] In his affidavit, Mr. Larsson attests that the Owner is “a world leader in water technology, providing equipment and services for water and wastewater applications with products that address the full cycle of water”. He states that the Owner operates in over 35 countries worldwide and has its Canadian office in Point-Claire, Quebec.

[8] Mr. Larsson attests that the Owner sells its products under various brand names, including in association with the Mark. Mr. Larsson explains that the target market for the Owner’s AQUAVIEW software is waste water treatment plants and pump stations. Given the nature of the software and its high cost, Mr. Larsson explains that the Owner would only sell a few software licenses each year. Nevertheless, he confirms that the Owner sold a total of four such AQUAVIEW software licenses in Canada during the relevant period and that such software corresponded to the registered goods. He further attests that the Mark “is displayed on the monitor when the software is launched and throughout the program.”

[9] In support, Mr. Larsson provides the following exhibits attached to his affidavit:

- Exhibit 1 is a screenshot from www.xylemwatersolutions.com/scs/canada, which Mr. Larsson attests was available during the relevant period. The page advertises the Owner’s

“Central Monitoring” products and services, stating that “Together with pump controllers and a communication unit, the AquaView supervision software gives a complete view of the waste water system.”

Under the “AquaView 7” subheading, the description reads in part: “AquaView is a software for monitoring and control of waste water treatment plants and entire pump stations.” As attested to by Mr. Larsson, links to a digital brochure and technical specifications are shown on the exhibited webpage.

- Exhibit 2 is a 10-page “Technical specification” document for the “AquaView 1.60 SCADA system”. Mr. Larsson attests that this document is accessible from the technical specifications link shown in Exhibit 1. The document provides various technical specifications for the AquaView software. Screenshots from the software are reproduced on the covering page and on two pages within the document. The Mark appears and is referenced throughout the document. Although the depicted software screenshots are of poor quality, I note that the Mark is also visible in the title bar of such screenshots. I further note that the document describes the AquaView software as “a complete SCADA software for water handling”. As part of its description of system configuration details and system requirements, the document provides that the AquaView software is a central control system that can be installed on and operated from various workstations.

Analysis

[10] In its representations, the Requesting Party notes several alleged ambiguities in the evidence. First, it notes that the evidence is unclear as to whether the exhibited webpage or technical documents were distributed in Canada, much less at the time of transfer.

[11] Second, it notes that there is no evidence of use of the Mark “on” the goods themselves or on their packaging, and disputes whether the Mark is visible on any of the exhibited screenshots. In any event, the Requesting Party submits that even if the Mark did appear onscreen during operation of the software, it would have been seen by the user only *after* the purchaser had acquired the software. It argues that “seeing a mark displayed, when the software is operating without proof of the mark having been used at the time of the transfer of possession of the ware, is not use of the mark as specified in [the Act].”

[12] Third, it notes that the Owner furnished no invoices, identified no particular customers and gave no address for any of its alleged four customers.

[13] Lastly, even if one were to presume that the Owner sold its software to Canadian customers, the Requesting Party questions whether the Mark as registered was displayed or whether “AquaView 1.60 Scada” or the like was displayed instead. If so, it submits that this does not constitute display of the Mark as registered.

[14] As such, the Requesting Party submits that the Owner’s evidence is “unclear, ambiguous and incomplete” with respect to use of the Mark and that such ambiguities must be resolved against the Owner [per *Plough Canada v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[15] In response, the Owner submits that Mr. Larsson is not merely asserting use of the Mark, but rather that Mr. Larsson attests to facts upon which one can conclude that there has been use. Although the Owner conceded at the hearing that that the evidence in this case is less than ideal, it maintains that the evidence is not ambiguous *per se*. Rather, the Owner submits that the Registrar is able to make reasonable inferences and that, where there are some doubts as to the evidence, such doubts should be resolved in favour of the Owner [citing *Fairweather Ltd v Canada (Registrar of Trade-marks)* (2006), 58 CPR (4th) 50 (FC)].

[16] With respect to transfers of the subject software, the sale of a license to use software is akin to the leasing of goods. The leasing of goods has been recognized as a transfer of goods in the normal course of trade [see *LightSurf Technologies Inc v Lifetouch Inc* (2005), 48 CPR (4th) 75 (TMOB)]. As noted above, Mr. Larsson clearly states that, during the relevant period, the Owner sold four such licenses to use the AquaView software to customers in Canada. As such, I do not consider the absence of invoices in this case to be fatal to the Owner.

[17] With respect to display of the Mark, as discussed in *BMB Compuscience Canada Ltd v Bramalea Ltd* (1988), 22 CPR (3d) 561 (FCTD), this type of business software is not a physical object, and thus a computer software company experiences unique difficulties when attempting to associate a trade-mark with its software [see also *Fasken Martineau DuMoulin LLP v Open Solutions DTS Inc*, 2013 TMOB 68, CarswellNat 1684; and *Clark Wilson LLP v Genesisystems, Inc*, 2014 TMOB 64, CarswellNat 1392].

[18] Although I accept that the Mark appears on some of the screenshots depicted in the exhibits, I agree with the Requesting Party that, in isolation, such display within the actual software would be viewed by customers only after transfer of the computer software. Although such display could arguably constitute use of the Mark for purposes of section 4(1) of the Act in cases where a customer *renews* its license, it is not clear that any of the referenced four licenses sold during the relevant period were by existing customers familiar with the software.

[19] Nevertheless, the Owner submits that, given the nature of its customers and the large-scale nature of its AquaView software, it is a reasonable inference that such customers would have seen the Mark. In this respect, the Owner submits that the Mark, as it appears in the exhibited AquaView 1.60 SCADA system technical document, would have been seen by customers prior to installation of the AquaView software.

[20] As discussed in *BMB Compuscience Canada Ltd v Bramalea Ltd* (1988), 22 CPR (3d) 561 (FCTD), this type of industrial software is not a physical object, and thus a computer software company experiences unique difficulties when attempting to associate a trade-mark with its software [see also *Fasken Martineau DuMoulin LLP v Open Solutions DTS Inc*, 2013 TMOB 68, CarswellNat 1684; and *Clark Wilson LLP v Genesisystems, Inc*, 2014 TMOB 64, CarswellNat 1392].

[21] Furthermore, in *Inso Corp v Alliance Technologies* (2000), 4 CPR (4th) 102 (TMOB), the Registrar found it reasonable to infer that the registrant's software customers would have viewed and used the "on-line help" offered in association with the trade-mark. Similarly, in this case, I consider it reasonable to infer that, given the complicated nature of the software and its purpose, purchasers of the AQUAVIEW software would necessarily have referred to the technical specification documents prior to purchase.

[22] As such, notwithstanding that Mr. Larsson makes no clear statements regarding its distribution prior to purchase of the software, I consider display of the Mark throughout the technical specifications document to constitute display of the Mark "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".

[23] Noting that each case must be determined on its own facts [per *Kraft Ltd v Registrar of Trade-marks* (1987), 1 CPR (3d) 457 (FCTD)], in my view the evidence as a whole shows that the Owner sold its AQUAVIEW software to clients during the relevant period. As indicated above, the Mark appears throughout the AquaView technical documents.

[24] Where the Mark also appears with additional matter, such as “1.60 SCADA system”, I agree with the Owner that such additional matter is merely descriptive in nature. In this respect, in its written representations, the Owner explains that SCADA is an acronym for “supervisory control and data acquisition”. Although this particular definition does not appear in the evidence itself, it is clear from the context that SCADA is a descriptive term in the industry. For example, the exhibited technical specification document indicates that “Aquaview is *a* complete SCADA software for water handling” (emphasis added).

[25] Again, given the nature of the Owner’s customers and the scope of the subject software, I consider it reasonable to infer in this case that, in addition to viewing the Mark during the operation of the software, customers would have referenced the exhibited AquaView technical document, thus associating the Mark with the software at the time of transfer.

[26] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods within the meaning of sections 4(1) and 45 of the Act.

Disposition

[27] Accordingly, pursuant to the authority delegated to me under section 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

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

Hearing Held: 2016-07-20

APPEARANCES

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AGENTS OF RECORD

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