



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

Citation: 2014 TMOB 64
Date of Decision: 2014-03-20

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Clark Wilson LLP against registration
No. TMA269,495 for the trade-mark SPEED in the name
of Genesistems, Inc.**

[1] At the request of Clark Wilson LLP, 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 23, 2011 to Genesistems, Inc., (the Owner), the registered owner of registration No. TMA269,495 for the trade-mark SPEED (the Mark).

[2] The Mark is registered for use in association with the wares “computer software”.

[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 wares 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 23, 2008 and December 23, 2011.

[4] The relevant definition of “use” with respect to wares is set out in section 4(1) of the Act:

4(1) 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.

[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), 31 CPR (4th) 270 (FC) at 282].

[6] In response to the Registrar’s notice, the Owner filed the affidavit of Eric Muench, President of the Owner, sworn on March 5, 2012. Neither party filed written representations; an oral hearing was not held.

[7] In his affidavit, Mr. Muench attests that the Owner is a U.S. company that has been “supplying its customers with long term, growth oriented hardware and software solutions” for over 34 years and that the Owner writes “complete, integrated, restaurant, distribution, professional services and manufacturing computer software systems, each with complete accounting systems”. He explains that, in 2004, the Owner acquired ownership of the Mark and since then has continuously used the Mark in Canada through its TOM Software division.

[8] In describing the Owner’s normal course of trade, Mr. Muench attests that, in Canada, the Owner typically sells its software to dealers for renewable one-year terms and allows such dealers to sell sublicenses for use to end users. He explains that these Canadian dealers issue a Software Sublicense Report to the Owner, which includes the end user’s name and the software product being resold. He further attests that the Owner also sells its software directly to end users in Canada through its Canadian dealer, Progressive Software located in Windsor, Ontario.

[9] In support of his assertion of use of the Mark during the relevant period, Mr. Muench provides the following exhibits:

- Exhibit B consists of a copy of a Software Partner Agreement between the Owner, through its TOM Software division, and A&T Systems Inc., a Vancouver-based company. Although the agreement is dated prior to the relevant period, Mr. Muench

attests that the agreement was renewed during the relevant period. In this regard, he attaches, at Exhibit C, a copy of the Software License Renewal agreement dated during the relevant period as well as a copy of a related document which lists SPEED as one of the software products subject to the agreement. The renewal is dated during the relevant period and states that the license “covers all TOM Software product lines, including SPEED”.

- Exhibit D consists of a copy of a Software Sublicense Report dated during the relevant period stamped “PAID” and references the sale of SPEED computer software in the product description. The Report is issued by the Owner’s Canadian dealer, Progressive Software and includes the name of the end user, Country Depot, located in Napanee, Ontario. Mr. Muench attests that the Report is representative of the reports issued during the relevant period. Mr. Muench also attaches, at Exhibit E, a copy of the invoice, dated within the relevant period, which he attests was issued in connection with aforementioned sale evidenced by the Exhibit D Report.
- Exhibit F consists of a copy of a Software Product Registration form which Mr. Muench attests was issued to Progressive Software and Country Depot in relation to the aforementioned sale evidenced at Exhibits D and E. I note that the Mark appears on the “Product ID” line.
- Lastly, Exhibit G consists of a sample screen shot that Mr. Muench attests would have appeared on computer screens during the relevant period when the end user opened the Owner’s software. I note that the Mark is prominently displayed on the screen shot and that the Owner is listed as the source of the software.

[10] As discussed in *BMB Compuscience Canada Ltd v Bramalea Ltd* (1988), 22 CPR (3d) 561 (FCTD), this type of institutional computer 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. In this case, as provided at Exhibits C through F, the Mark appears on the various license agreements and sublicense forms that purchasers of the software would

have seen prior to installation of the software and notice of association continues when the Mark appears on the installation screens provided at Exhibit G. As such, I am satisfied that the requisite notice of association would have been given in accordance with section 4(1) of the Act.

[11] In view of the foregoing, I am satisfied that the Owner has evidenced use of the Mark in association with “computer software” within the meaning of sections 4(1) and 45 of the Act during the relevant period.

Disposition

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

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