



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

Citation: 2012 TMOB 262
Date of Decision: 2012-12-07

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Sim & McBurney against registration
No. TMA685,656 for the trade-mark PARTS NOW!
KEEPING BUSINESS PRINTING & Design in the name
of Parts Now! LLC.**

[1] At the request of Sim & McBurney, the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on June 21, 2010 to Parts Now! LLC (the Registrant), the registered owner of registration No. TMA685,656 for the trade-mark PARTS NOW! KEEPING BUSINESS PRINTING & Design, shown below (the Mark):



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

- Distributorships for computer printers, multifunction printers, telefacsimile machines, photocopiers, computers, magnetic and optical data storage drives, optical scanners, computer network routers, computer network hubs, computer network cards, computer power supplies, computer batteries, toner cartridges, ink cartridges, and subassemblies and components thereof;
- Installation, maintenance, and repair of computer printers, computer printer subassemblies, multifunction printers, multifunction printer subassemblies, telefacsimile machines, photocopiers, computers, magnetic and optical data storage drives, optical scanners, computer network routers, computer network hubs, computer network cards, computer power supplies, computer batteries, toner cartridges, and ink cartridges;

- Educational and training services, namely, courses, seminars, and workshops regarding the installation, operation, maintenance and repair of computer printers, computer printer subassemblies, multifunction printers, multifunction printer subassemblies, telefacsimile machines, photocopiers, computers, magnetic and optical data storage drives, optical scanners, computer network routers, computer network hubs, computer network cards, computer power supplies, computer batteries, toner cartridges, and ink cartridges;
- Technical support and consultation, namely, consultation regarding the installation, operation, maintenance, and repair of computer printers, computer printer subassemblies, multifunction printers, multifunction printer subassemblies, telefacsimile machines, photocopiers, computers, magnetic and optical data storage drives, optical scanners, computer network routers, computer network hubs, computer network cards, computer power supplies, computer batteries, toner cartridges, and ink cartridges.

[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 or 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 June 21, 2007 and June 21, 2010.

[4] The relevant definition of “use” in this case is set out in section 4(2) of the Act:

(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 the purpose and scope of s. 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 [*Performance Apparel Corp v Uvex Toko Canada Ltd* (2004), 31 CPR (4th) 270 (FC)]. With respect to services, the display of the Mark on advertising is sufficient to meet the requirements of section 4(2) when the trade-mark owner is offering and prepared to perform those services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)]. Furthermore, the evidence as a whole must be considered and focusing on individual pieces of evidence is not the correct approach [*Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)].

[6] In response to the Registrar's notice, the Registrant filed the affidavit of Patrick Beaudoin, sworn on January 19, 2011. Only the Registrant filed written representations and attended an oral hearing.

[7] In his affidavit, Mr. Beaudoin attests that he is the Controller of Parts Now! ULC (Parts Now), a wholly owned subsidiary of Parts Now! Holding company, which is in turn a wholly owned subsidiary of the Registrant. He provides that at all material times, Parts Now was a licensed user of the Mark and that the Registrant maintained control over the quality of the services sold in association with the Mark. As such, I am satisfied that any demonstrated use of the Mark by Parts Now enures to the benefit of the Registrant pursuant to section 50 of the Act.

[8] Mr. Beaudoin states that the Registrant is the largest distributor of laser printer parts in North America and that its Parts Now subsidiary has three locations offering its services in Quebec, British Columbia and, as of 2010, Ontario.

[9] In support of his assertion of use with respect to all of the Services, Mr. Beaudoin provides numerous exhibits, all of which prominently display the Mark as registered. Of particular note are the following:

- Exhibits A and F-8 consist of printouts from the Registrant's website, *www.partsnow.com*, dated within the Relevant Period. I note that the Mark is clearly displayed at the top of each page and that the website includes links for "Training and Printer Repair", "Tech Support", and "Parts Specials", amongst others. The website includes references to Canada and content is available in both English and French.
- Exhibit C consists of a printout of a FAQ from the Registrant's website, dated August 10, 2007, providing information about the Registrant's "core return program"; this relates to the Registrant's "installation, maintenance and repair" services, as Mr. Beaudoin explains that the purchase of some parts requires a "core return", which involves the customer sending their previous part to Parts Now so that it can be repaired and/or installed as part of a larger component.

- Exhibit D consists of a printout of the Registrant’s course offerings obtained from the Registrant’s website on March 6, 2009; with respect to the Registrant’s “educational and training services”, Mr. Beaudoin further attests that Canadians attended the Registrant’s online and in person training courses, seminars and workshops on topics related to the installation of the Registrant’s products.
- Exhibit F-4 consists of a promotional handout setting out the various brands and types of “IT service parts” sold by Parts Now, discussed in further detail below.
- Exhibit F-9 consists of screenshots from an online seminar on “Image Formation for HP Printers”, that Mr. Beaudoin attests is representative of the electronic and print materials associated with the Registrant’s in person and online training seminars offered in Canada during the Relevant Period.
- Exhibit G consists of 16 sample invoices for the sale of parts, which Mr. Beaudoin attests are distributed with the ordered parts. He further attests that sales figures for product parts and training courses during the Relevant Period to customers in Canada exceeded CDN\$20 million.

[10] The other exhibits [Exhibits B-1, B-2, E, F-1, F-2, F-3, F-5, F-6, F-7 and F-10] consist of various brochures, newsletters and other documents, which Mr. Beaudoin attests were distributed to Canadian customers during the Relevant Period; these documents all provide further information regarding, or otherwise relate to, the Services offered by Parts Now during the Relevant Period.

[11] With respect to the Registrant’s “technical support and consultation” services during the Relevant Period, Mr. Beaudoin further attests that Parts Now customer service representatives and technical support department personnel were available to answer questions from Canadian customers undertaking field installation, maintenance or repair of Parts Now products.

[12] In determining whether the evidence in this case demonstrates use with respect to all of the Services, I note that services are to be interpreted broadly [*Venice Simphon-Orient Express Inc v Société nationale des chemins de fer français* (2000), 9 CPR (4th) 443 (FCA)] and that in

some cases a statement of services will contain overlapping and redundant terms in the sense that the performance of one service necessarily implies the performance of another [*Gowling Lafleur Henderson LLP v Key Publishers Co*, 2010 CarswellNat 579 (TMOB)]. With these principles in mind, and in view of the nature of the Registrant's business, I consider it reasonable to conclude that the Registrant's "installation, maintenance and repair" services, "educational and training" services and "technical support and consultation" services are all with respect to the products for which the Registrant is a "distributorship".

[13] Although most of the exhibits emphasize the Registrant's distributorship and other services with respect to printers and parts thereof, I note that Exhibit F-4 in particular references the following: IT service parts, system boards, hard drives, batteries, power supplies, microprocessors, memory, CD and DVD drives, input drives, display monitors and network products. In combination with Mr. Beaudoin's statements and viewing the evidence as a whole, I am satisfied that the Registrant's services are with respect to all of the products listed in the statement of services in the registration, with the exception of "telefacsimile machines". At the oral hearing, the Registrant conceded that there was no evidence of use of the Mark with respect to "telefacsimile machines". Furthermore, no evidence of special circumstances excusing such absence of use is before me. Accordingly, for each of the four categories of Services, reference to "telefacsimile machines" will be deleted from the registration.

Disposition

[14] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete the four references to "telefacsimile machines" from the statement of services.

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