

TRADUCTION/TRANSLATION

SECTION 45 PROCEEDINGS TRADE-MARK: ADVANTAGE REGISTRATION NO.: TMA 373,008

On January 23, 1999, at the request of Anissimoff & Associates, the Registrar forwarded a Section 45 notice to Stentor Resource Centre Inc., the registered owner of the above-referenced trade-mark registration.

The trade-mark ADVANTAGE is registered for use in association with the following services: "telecommunication services".

Section 45 of the *Trade-marks 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 and/or services listed on 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 use since that date. The relevant period in this case is any time between January 23, 1996 and January 23, 1999.

In response to the notice, the affidavits of Kenneth J. Hadfield and Roxanne Pearce have been furnished. The registrant alone filed a written argument. An oral hearing has not been held in this case.

In his affidavit, Mr. Hadfield states that he is Director of Business Communications at Bell Canada, the predecessor-in-title of the trade-mark and a licensee of the trade-mark. He indicates that under the license the registrant has control over the character and quality of the services provided under the trade-mark ADVANTAGE. He states that Bell Canada has been using the trade-mark for over ten years, including continuously over the last four years (his affidavit was sworn July 23, 1999). He explains that his company uses the

trade-mark in association with a wide range of telecommunication services in Ontario and Quebec including calling card services, long distance telephone services, call centre services, internet related services, tele-conferencing and video-conferencing services, toll-free telephone communication services and voice mail services.

As Exhibit "A" he provides a sample of the type of print advertisement which his company has distributed continuously over the last four years. He indicates that the advertisements have been distributed in magazines, newspapers and through direct mail in Ontario and Quebec. He adds that his company has also promoted the ADVANTAGE services using television and radio advertisements, and through the Internet.

As Exhibit "B" he provides an advertisement spending summary for his company. He states that the summary lists in millions of dollars, the amount expended during the years 1994 through 1998 advertising its services in Ontario. He adds that the advertising expenditures in Quebec are approximately half of those of Ontario. He explains that almost 100% of the business advertising conducted during these years was for services advertised and provided under the trade-mark ADVANTAGE. He concludes by stating that in 1998 his company provided services under the trade-mark to over 400,000 customers.

Ms. Pearce attests that her company, BCT.Telus Communications Inc. has used the trade-mark under licence, first from Bell Canada and then from the registrant. Under both licences, first Bell and then Stentor Resource Centre Inc. maintained direct and indirect control over the character and quality of the services provided under the trade-mark ADVANTAGE. Ms. Pearce describes the telecommunication services that have been advertised and performed by her company in association with the trade-mark namely calling card services, long distance telephone services, pay-per-use 1-900 services and tele-conferencing services. As Exhibit "A", she provides a 1997-1998 communications media summary for advertising of BCTel's ADVANTAGE services. As Exhibit "B" she provides a bundle of sample direct mail advertisements which were distributed

throughout British Columbia during the relevant period. She concludes by stating that in 1998 her company provided services under the trade-mark to over 143,000 customers.

Having considered the evidence, I conclude that it shows use of the trade-mark ADVANTAGE “per se” in Canada in association with “telecommunication services” in a manner complying with subsection 4(2), section 45 and section 50 of the *Trade-marks Act*. The affiants have clearly defined the broad range of telecommunication services that have been provided to customers in Quebec, Ontario and British Columbia during the relevant period in association with the trade-mark ADVANTAGE and have provided clear samples of the manner the trade-mark has been used during the relevant period in the advertising of the various telecommunication services.

Concerning the fact that the use of the trade-mark is by licensees, as the affiants have sworn that the registrant has control over the character or quality of the services being provided by the licensees then, for purposes of Section 45, I accept that the use by the licensees is use accruing to the registrant in compliance with the provisions of subsection 50(1) of the Act (see *Fitzsimmons, MacFarlane v. Caitlin Financial Corp. N.V.*, 79 C.P.R. (3d) 154 at 157 and *Sim & McBurney v. LeSage Inc.*, 67 C.P.R. (3d) 571).

As use of the trade-mark in association with telecommunication services (the registered wares) has been shown, I conclude that the trade-mark registration ought to be maintained as is on the register. I would add here that the fact that “telecommunication services” may be a broad term is not an issue to be dealt with in a Section 45 proceeding (see *Lander Co. Canada Limited v. Scott Paper Company*, Section 45 decision dated June 12, 1997, Regn. No. 377,051, TM - SCOTT & Design and *Carter-Wallace Inc. v. Wampole Canada Inc.*, 8 C.P.R. (4th) 30).

Registration No. TMA 373,008 will be maintained in compliance with the provisions of Section 45(5) of the *Trade-marks Act*.

DATED AT GATINEAU, QUEBEC, THIS 24TH DAY OF NOVEMBER 2004.

D. Savard
Senior Hearing Officer
Section 45 Division