



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

Citation: 2015 TMOB 224
Date of Decision: 2015-12-14

IN THE MATTER OF A SECTION 45 PROCEEDING

**Graduate Management Admissions
Council**

Requesting Party

and

Attachmate Corporation

Registered Owner

TMA396,788 for REFLECTION

Registration

[1] At the request of Graduate Management Admissions Council (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 October 28, 2013 to Attachmate Corporation (the Owner), the registered owner of registration No. TMA396,788 for the trade-mark REFLECTION (the Mark).

[2] The Mark is registered for use in association with the following goods: Computer programs and instructional manuals, sold as a unit.

[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 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 October, 28, 2010 to October 28, 2013.

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

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 filed the affidavit of Brad Haque, Associate General Counsel of the Owner, sworn on May 27, 2014 in Portland, Oregon. Both parties filed written representations; an oral hearing was not requested.

The Owner’s Evidence

[7] In his affidavit, Mr. Haque attests that the Owner manufactures computer software programs and the accompanying instruction manuals for sale in Canada and elsewhere in association with the Mark. He attests that the Owner works with a variety of licensed distributors and resellers that sell the registered goods to customers through their own retail channels. He states that many such customers are large organizations, including government entities.

[8] Mr. Haque states that, historically, the registered goods were distributed on physical media, such as discs. Through various means of distribution, he attests that the registered goods have been sold in Canada continuously since 1985. However, he explains that, during the relevant period, the registered goods were purchased and distributed by way of download, with electronic manuals provided as part of the download. Specifically, he attests that the registered goods are available for download through the Owner’s website, *www.attachmate.com*, as well as “other authorized websites”. Mr. Haque attests that there were over 230,000 page views on *www.attachmate.com* and its related pages from Canadians during the relevant period.

[9] With respect to display of the Mark, Mr. Haque states that the Mark appears on the aforementioned websites that offered the registered goods for sale in Canada. He also attests that

the Mark appears within the user interface of the software, and on the accompanying electronic instruction manuals.

[10] With respect to transfers in the normal course of trade, Mr. Haque attests that, during the relevant period, total sales of the registered goods in Canada exceeded \$7,000,000. Specifically, he attests that in 2011, total sales exceeded \$1,000,000; in 2012, total sales exceeded \$3,000,000; and in 2013, total sales exceeded \$2,000,000.

[11] In support, Mr Haque attaches the following exhibits to his affidavit:

- Exhibit A consists of printouts from the Owner’s website and copies of manuals and supporting documentation, which he attests are for software sold to the Owner’s customers in Canada during the relevant period. The exhibited webpages, manuals, and supporting documentation all clearly display the Mark.
- Exhibit B consists of six invoices that Mr. Haque attests are representative of sales of REFLECTION-branded software and instruction manuals to customers in Canada from the relevant period. The Mark appears in the description of the software sold, such as “Reflection for IBM 2011 Licensed Unit”, and “Reflection X 2011 Licensed Unit”. Mr. Haque explains that the invoices show that the goods were shipped and sold by way of “electronic software delivery”. Although some customer information is redacted, I note that the “sold to” and “ship to” boxes all indicate cities in Canada.
- Exhibit C consists of printouts from the Owner’s website of various documents, including product datasheets, end user licensing agreements, and purchasing instructions, which Mr. Haque attests were accessible to Canadians during the relevant period. One of the exhibited datasheets describes the product as follows: “Reflection ® for IBM is terminal emulation software that connects Windows users to applications on IBM mainframes and AS/400 systems”.
- Exhibit D consists of a printout of a report tracking Canadian visitors for *www.attachmate.com* and various related subpages, such as the download and documentation pages during the relevant period.

Analysis

[12] In its written representations, the Requesting Party concedes that the evidence shows use of the Mark in association with “terminal emulation software and instruction manuals, sold as a unit”. However, the Requesting Party submits that the Owner has not demonstrated that it sold other types of computer programs. As such, the Requesting Party submits that the registration’s description of goods is overly broad and should be amended accordingly.

[13] In this respect, the Requesting Party refers to CIPO’s *Goods and Services Manual* in support of its assertion that the registration’s statement of goods is too broad and therefore “does not ... constitute an ordinary commercial term under section 30(a) of the *Trade-marks Act*”. Therefore, the Requesting Party submits, the registration should be amended so that the statement of goods is limited to “Terminal emulation software and instruction manuals, sold as a unit.”

[14] First, at a minimum, I agree that the Owner has evidenced use of the Mark in association with terminal emulation software and instruction manuals sold as a unit. In this respect, as summarized above, the Owner has evidenced electronic sales and transfers of its REFLECTION-branded software to Canadians during the relevant period. Such sales included electronic instruction manuals.

[15] The issue, then, is whether use of the Mark in association with the specific computer program, terminal emulation software, is sufficient to show use of the Mark in association with the broader goods as registered, “computer programs”.

[16] First, although the evidence and representations focus on “terminal emulation software”, I note that at least one of the exhibited REFLECTION software datasheets references a “suite” of products. This suite appears to include programs not limited to “terminal emulation software”, but also includes “PC X Server”, and “file transfer clients”.

[17] In any event, the Owner correctly submits that, where a registration contains a statement of goods that is general in nature, the registration will be maintained if the owner shows that the trade-mark has been used in association with goods that fall within that more general statement [citing *Empresa Cubana Del Tobacco v Shapiro Cohen*, 2011 FC 102, 91 CPR (4th) 248]. As it is

clear that “terminal emulation software” falls within the scope of “computer programs”, I agree that the Owner has demonstrated use of the Mark in association with the registered goods.

[18] As to whether the registration’s statement of goods complies with or would comply with section 30(a) of the Act, I agree with the Owner that this issue is not something the Registrar can consider in a section 45 proceeding. Indeed, as noted by the Federal Court of Appeal, the validity of the registration is not at issue in a section 45 proceeding [per *Ridout & Maybee srl v Omega SA*, 2005 FCA 306, 43 CPR (4th) 18].

[19] With respect to the Requesting Party’s request to amend the statement of goods, it is well established that the Registrar does not have the authority to redefine or amend the goods for which use has been shown [see, for example, *Carter-Wallace Inc v Wampole Canada Inc* (2000), 8 CPR (4th) 30 (FCTD); *Re Scott Paper Co*, 1997 CarswellNat 3231 (TMOB); *Gowling, Strathy & Henderson v Multibond Inc*, 2000 CarswellNat 2474 (TMOB); and *Sim & McBurney v Huit Diffusion, société anonyme*, 2009 CarswellNat 5039 (TMOB)].

[20] Finally, I note that, in its written representations, the Requesting Party indicates that it has a pending trade-mark application that was refused on the basis of confusion with the Owner’s Mark. The Requesting Party suggests that its application would be allowed if the statement of goods in the subject registration were narrowed. However, this is irrelevant to the current proceeding; it is well established that section 45 proceedings are not intended to provide an alternative to the usual *inter partes* attack on a trade-mark done by way of application to the Federal Court pursuant to section 57 of the Act [per *United Grain Growers v Lang Michener*, 2001 FCA 66, 12 CPR (4th) 89].

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

Disposition

[22] 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

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

No Hearing Held

Agents of Record

Gowling Lafleur Henderson LLP

For the Registered Owner

Norton Rose Fulbright Canada LLP/S.E.N.C.R.L., s.r.l.

For the Requesting Party