



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

Citation: 2015 TMOB 148
Date of Decision: 2015-08-28

IN THE MATTER OF A SECTION 45 PROCEEDING

GMAX World Realty Inc.

Requesting Party

and

RE/MAX, LLC

Registered Owner

**TMA771,851 for RE/MAX
COMMERCIAL & DESIGN**

Registration

[1] At the request of GMAX World Realty Inc. (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 November 19, 2013 to RE/MAX, LLC (the Owner), the registered owner of registration No. TMA771,851 for the trade-mark RE/MAX COMMERCIAL & DESIGN (the Mark). The Mark appears below:



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

Franchising, namely, consultation and assistance in business management, organization and promotion; franchising, namely, offering technical assistance in the establishment and/or operation of real estate brokerage offices; creating and updating advertising material; real estate advertising services; arranging and conducting trade shows in the field of real estate and real estate franchise services; referrals in the field of real estate

brokerage; real estate networking referral services, namely, promoting the goods and services of others by passing business leads and referrals; real estate auctions; real estate brokerage; real estate agencies; real estate valuation services; real estate consultancy; Real estate management; business brokerage; agencies or brokerage for renting of land and buildings; rental of office space; leasing of office space; providing real estate listings and real estate information via the Internet; providing information in the field of real estate via the Internet.

[3] The notice required the Owner to furnish evidence showing that the Mark was used in Canada, in association with each of the services specified in the registration, at any time between November 19, 2010 and November 19, 2013. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[4] The relevant definition of use with respect to services is set out in section 4(2) of the Act as follows:

4(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 mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the services specified in the registration during the relevant period.

[6] With respect to services, the display of the trade-mark in 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)].

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Elton Ash, sworn on February 18, 2014. Both parties filed written representations and were represented at an oral hearing held on May 22, 2015. The hearing was held jointly with respect to summary cancellation proceedings for three associated registrations, namely REMAX (No. TMA575,047), RE/MAX & Balloon Design (No. TMA717,554) and RE/MAX (No. TMA717,562). Separate decisions will be issued with respect to those proceedings.

[8] Two days prior to the hearing, the Owner filed an additional affidavit, sworn by Elton Ash on May 19, 2015. In its covering letter, the Owner noted that it was not asking that such "supplementary evidence" be accepted by the Registrar at that stage of the proceeding, but only that it be considered "in the event that the Registrar has doubts following the submissions of the parties" on the issue of control by the Owner during the relevant period.

[9] As noted by the Requesting Party, however, there is no provision for the filing of reply evidence or requesting leave to file additional evidence in a section 45 proceeding [see *Oyen Wiggs Mutala v Hung Gay Enterprises Ltd*, 2014 TMOB 107 at para 7, 125 CPR (4th) 238; and *Riches, McKenzie & Herbert LLP v D'Amour Bicycles & Sport Inc*, 2014 TMOB 146 at para 8, CarswellNat 1739].

[10] As such, the May 2015 affidavit of Elton Ash was not made of record and was not considered in this proceeding.

The Owner's Evidence

[11] In his February 2014 affidavit, Mr. Ash attests that he is an Executive Vice President with the Owner. He attests that he has held that position since 2005 and has been employed by the Owner since 1984.

[12] Mr. Ash explains that the Owner is in the business of franchising real estate agency services, real-estate brokerage services, and providing franchising, consulting, and other services in the real estate field. Mr. Ash attests that the services are offered through a network of sub-franchisors, franchisees, and affiliated sales associates, which he refers to as "RE/MAX Affiliates", all of which are "authorized by the Owner under license" to use the Mark. He further

explains that there are over 18,000 RE/MAX Affiliates based in Canada who handled over 7,000 commercial transactions between 2011 and 2013, valued at over \$3.5 billion in total.

[13] Mr. Ash asserts that, during the relevant period, the Owner “advertised, sold, and offered for sale all of the services” registered in association with the Mark. As discussed below, he further describes how the Mark was displayed by the Owner or its RE/MAX Affiliates in association with each of the registered services in Canada during the relevant period.

Preliminary Issues

[14] Before describing the evidence with respect to the particular services, I note that the Requesting Party submitted both in its written representations and at the oral hearing that there were two overarching issues concerning the Owner’s evidence. First, the Requesting Party submitted that much of Mr. Ash’s evidence is inadmissible hearsay. Second, it submitted that the Owner failed to show proper licensing and control over the use of the Mark, and therefore any use of the Mark did not enure to the Owner’s benefit.

[15] With respect to the hearsay issue, the Requesting Party submitted that portions of Mr. Ash’s affidavit are inadmissible hearsay because he attests to facts that he has no knowledge of and furnishes evidence on behalf of RE/MAX Affiliates. More specifically, the Requesting Party submits that Mr. Ash does not state that he had access to the business records of the RE/MAX Affiliates, nor does he explain how he came to know of their activities.

[16] I do not accept the Requesting Party’s position; rather, I agree with the Owner that the summary nature of cancellation proceedings is such that concerns regarding hearsay should generally only go to the weight given to evidence rather than admissibility [see *Derby Cycle Werke GmbH v Infinité Cycle Works Ltd*, 2013 TMOB 134, 113 CPR (4th) 412; *Eva Gabor International Ltd v 1459243 Ontario Inc*, 2011 FC 18, 90 CPR (4th) 277; and *Wishbuds Inc v Sandoz GmbH*, 2013 TMOB 208, CarswellNat 4700].

[17] In any event, given Mr. Ash’s position with the Owner and the nature of the evidence furnished, I accept that his statements are reliable and that it would be evidentiary overkill to

require the Owner to furnish multiple affidavits from its various regional affiliates and franchisees.

[18] With respect to the licensing and control issue, the Requesting Party argues that section 50(1) of the Act must be satisfied in order for use of the Mark by the RE/MAX Affiliates to enure to the Owner's benefit. In this respect, the Requesting Party submits that the requirements of section 50(1) of the Act can be satisfied in three ways: first, by making a sworn statement regarding control [citing *Empresa Cubana Del Tabaco Trading v Shapiro Cohen*, 2011 FC 102, 91 CPR (4th) 248]; second, by providing evidence demonstrating control [citing *Mantha & Associés/Associates v Central Transport Inc* (1995), 64 CPR (3d) 354 (FCA)]; or third, by providing a copy of the license itself [citing *Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64, 48 CPR (4th) 223]. The Requesting Party further submits that the Owner has done none of the above.

[19] Indeed, in the present case, the Owner has not furnished a licensing agreement and Mr. Ash does not explicitly use the term "control" in his affidavit. However, he does make the following statement at paragraph 7 of his affidavit:

The Owner provides its wares and services throughout Canada through RE/MAX Affiliates, who are authorized by the Owner under license to use its registered and common law trade-marks in connection with real estate brokerage services and related wares and services.

[20] The Requesting Party took issue with this language, arguing that "authorized by the Owner under license" is not a sufficient statement of control pursuant to section 50(1) of the Act. It argued that a *clear* statement of control is required and that, in the past, the Registrar has drawn a distinction between control over the character and quality of the goods or services versus control over the use of a trade-mark – which on its own may not satisfy section 50(1) [citing *Asima Realty Ltd v Cofely Services SA*, 2013 TMOB 69, 113 CPR (4th) 174].

[21] In response, the Owner argued that it is overly technical to require the use of the word "control" when describing a licensing arrangement. In other words, the Owner submitted that Mr. Ash's statement above was, indeed, sufficient to constitute a sworn statement of "control", notwithstanding the lack of the actual word "control". Alternatively, the Owner argued at the

oral hearing that, if necessary, control over the character and quality of the services can be inferred in this case from Mr. Ash's statements and the fact that the services were being provided in the context of a franchise system.

[22] Again, it is well-established that trade-mark owners are not required to evidence license agreements in a section 45 proceeding, and instead a clear statement of control can be sufficient to meet any requirements of section 50 of the Act [see *Gowling, Strathy & Henderson v Samsonite Corp* (1996), 66 CPR (3d) 560 (TMOB)]. I further note that the Federal Court has cautioned against letting technical requirements become “a trap for the unwary” where a trade-mark has been obviously in use by its rightful owner [see *Baume & Mercier SA v Brown* (1985), 4 CPR (3d) 96 (FCTD)]. Although that case dealt primarily with technical aspects of affidavits, in the context of a summary cancellation proceeding, requiring narrowly particular phrasing to satisfy section 50 of the Act would seem to be contrary to the general principle.

[23] In any event, whether the aforementioned statement is on its own an adequate statement of control is moot in this case. Here, the evidenced franchisor/franchisee relationship between the Owner and its RE/MAX Affiliates is *prima facie* evidence of control given the broad control that is typical in franchising relationships.

[24] Accordingly, I accept that the evidence as a whole demonstrates that the Owner exercised the requisite level of control over the character and quality of the RE/MAX Affiliates' services offered in association with the Mark pursuant to section 50 of the Act.

[25] As such, in view of all of the foregoing, I am satisfied that that any use of the Mark described below is by the Owner or enures to the Owner's benefit.

Analysis – Use of the Mark in Association with the Services

[26] With respect to whether the Owner otherwise demonstrated use of the Mark in association with the particular registered services, the Requesting Party focused on alleged deficiencies in the evidence with respect to the following registered services: “arranging and conducting trade shows in the field of real estate and real estate franchise services”, “rental of

office space”, “leasing of office space”, and “real estate consultancy”. Before discussing such services, I will address the other services, for which the evidence of use of the Mark is clear.

Franchising Services

[27] With respect to the various registered “franchising” services, in his affidavit, Mr. Ash describes the Owner’s large network of RE/MAX Affiliates and attests that the Owner offers its franchising services “to RE/MAX Affiliates and RE/MAX trainees, including through training materials and the dissemination of guides on best practices”. He attests that the Owner provides such franchising services in part through its websites and through its “RE/MAX University” program, which he describes as “a real estate training and education program for RE/MAX Affiliates in ... Canada available over the internet via computer, mobile device or streaming video on television”.

[28] Mr. Ash also attests that the Owner distributes promotional materials bearing the Mark to real estate agents and prospective RE/MAX associates in Canada, “to promote its franchising and other services within the community of real estate professionals.”

[29] In support, attached to his affidavit are the following exhibits:

- Exhibit B consists of various documents that Mr. Ash attests are “representative samples of ... training materials, guides and newsletters on best practices”. The materials are dated during the relevant period and explain the benefits of becoming one of the Owner’s franchisees. The Mark appears in a copy of a newsletter and on a page of the materials related to commercial real estate, in a section referred to as “vision 2011”.
- Exhibit C consists of screenshots from the Owner’s websites, namely www.joinremax.ca, www.remaxcareer.ca, and www.remaxcommercial.ca. The screenshots are from various dates within the relevant period. Some of the exhibited webpages offer information regarding franchising opportunities with the Owner; the Mark is displayed next to descriptions of the Owner’s services with headings such as “Specialize – and boost referrals”, “Expand your commercial opportunities”, and “Enhance your luxury-market presence”.

- Exhibit E consists of representative samples of promotional materials in the form of presentation slide printouts and a brochure, both of which Mr. Ash attests were distributed in Canada to real estate agents and prospective RE/MAX Affiliates. Both the slides and the brochure explain the various benefits of becoming a franchisee and the services offered by the Owner. The Mark is displayed repeatedly throughout the brochures and slides, often in the top right corner of the page.
- Exhibit F consists of three screenshots from *www.remax.net* that Mr. Ash attests show use of the Mark in association with its “RE/MAX University” programming. I note that the screenshots show a video player where the Mark is displayed.

[30] In summary, the evidence shows that the Owner advertised its franchising services in association with the Mark during the relevant period to prospective franchisees in Canada via websites, promotional material, and at conferences and tradeshows. The Mark was also displayed on training materials provided to RE/MAX Affiliates during the relevant period when the Owner provided business management and technical assistance.

[31] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “franchising, namely, consultation and assistance in business management, organization and promotion” and “franchising, namely, offering technical assistance in the establishment and/or operation of real estate brokerage offices” within the meaning of sections 4(2) and 45 of the Act.

Real Estate Brokerage and Agency Services

[32] With respect to “real estate brokerage” and “real estate agencies”, Mr. Ash attests that it was the Owner’s RE/MAX Affiliates who provided such services across Canada during the relevant period in association with the Mark. He attests that the RE/MAX Affiliates’ agency and brokerage services included “business brokerage” and “agencies or brokerage for renting of lands and buildings”, each of which is discussed in separate sections below.

[33] Mr. Ash attests that RE/MAX Affiliates provided their real estate brokerage and agency services by advertising properties for sale, including through brochures, flyers, and videos. The

Owner also provided real estate listings and a property search tool on its website. In this respect, Mr. Ash attests that, using the commercial property search function on the Owner's website at www.remaxcommercial.ca, customers can either list real estate for lease or search for real estate available for lease.

[34] In support, Mr. Ash attaches the following exhibits to his affidavit:

- Exhibit G consists of representative samples of brochures and flyers from RE/MAX Affiliates which Mr. Ash attests were produced and distributed during the relevant period. The flyers provide details regarding various commercial properties and businesses that were for sale in British Columbia and Toronto during the relevant period. The Mark is displayed prominently on the flyers.
- Exhibit H consists of a DVD containing three videos. Mr. Ash attests that two of the videos promote the RE/MAX Affiliates' commercial real estate agency and brokerage services. The first two videos are virtual tours of two real estate properties in British Columbia. The Mark appears onscreen throughout the videos. Although Mr. Ash attests that the third video is "a promotional video for commercial real estate agency and brokerage services of REMAX Affiliates posted to Youtube during the Relevant Period", the contents of the video suggest that it was created by the Owner to advertise its franchising services to prospective RE/MAX Affiliates. In any event, the Mark is displayed at the beginning and end of the video.
- Exhibit I consists of screenshots from www.remaxcommercial.ca, as well as copies of flyers, listing brochures, and "a photograph of a sale sign for leasing or renting commercial properties in Canada". The screenshots show a property search tool with the Mark displayed above it. Mr. Ash attests that although the screenshots are from February 2014, "the overall look was substantially the same and [the Mark] was similarly shown throughout the Relevant Period." The flyers, brochures, and photograph all advertise various commercial properties for rent or lease in Canada. Aside from the photograph of the sale sign, which is of poor quality, all of the materials clearly display the Mark.

- Exhibit K consists of “print and online advertisements, brochures, and screenshots of blogs” that advertise the brokerage services provided by RE/MAX Affiliates and which Mr. Ash attests are representative of the advertising materials produced by the Owner in Canada during the relevant period. The advertisements appear to focus on brokerage services, consulting, and property management. Some of the advertisements describe or list various services offered by the Owner and RE/MAX Affiliates under the heading “Brokerage Practice Areas”, including “Acquisition” and “Disposition”. The Mark is displayed above or next to the descriptions of these services.
- Exhibit L consists of screenshots of the Owner’s website, www.remaxcommercial.ca, from the relevant period. Various services are offered on the website and Mr. Ash attests that the Owner used the website to provide its real estate listings and information in the field of real estate. A search box for finding a property or agent appears on one of the pages. The Mark appears above the search box.

[35] In summary, the exhibited brochures, flyers and videos all display the Mark and advertise the real estate brokerage and agency services offered directly by the Owner or its licensed RE/MAX Affiliates. The Exhibit I and L screenshots demonstrate how the Owner provided its brokerage services in association with the Mark, through a property search tool and the publishing of real estate listings on the Internet.

[36] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “real estate brokerage” and “real estate agencies” within the meaning of sections 4(2) and 45 of the Act.

Business Brokerage Services

[37] In addition to the evidence of real estate brokerage services described above, Mr. Ash also provided evidence of use of the Mark more specifically in association with “business brokerage services” during the relevant period in Canada. In this respect, some of the flyers and brochures at Exhibit G advertise business brokerage services offered by RE/MAX Affiliates. For example, one of the Exhibit G flyers advertises a greenhouse business for sale. The Mark is displayed next to photographs of the business.

[38] As such, I am satisfied that the Owner has demonstrated use of the Mark in association with “business brokerage” within the meaning of sections 4(2) and 45 of the Act.

Agencies or Brokerage for Renting Land and Buildings

[39] In addition to the agency and brokerage services described above, Mr. Ash asserts that the Owner “uses [the Mark] in association with leasing and renting services for commercial real estate.” In particular, he attests that the ‘Commercial Property Search’ function of the Owner’s website at www.remaxcommercial.ca allows a lessor to list or a lessee to search specifically for property that is ‘For Lease’.

[40] In support, Mr. Ash attaches the following exhibits to his affidavit:

- Exhibit I, as noted above, includes screenshots from www.remaxcommercial.ca, as well as copies of flyers and listing brochures. The flyers and brochures provide details regarding properties available for lease or rent. Mr. Ash attests that the brochures and flyers were produced during the relevant period and that the website looked the same as it is shown in the screenshots during the relevant period. The Mark appears throughout the materials.
- Exhibit K, as noted above, consists of representative screenshots and copies of print publications advertising various services offered by the Owner and RE/MAX Affiliates. Under the heading “Brokerage Practice Areas” there is a listing for “Leasing services”. The Mark is displayed above or next to the descriptions of the services.

[41] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “agencies or brokerage for renting of land and buildings” within the meaning of sections 4(2) and 45 of the Act.

Real Estate Advertising Services & Creating and Updating Advertising Material

[42] With respect to the Owner’s advertising and marketing services, namely “creating and updating advertising material” and “real estate advertising services”, Mr. Ash attests that the Owner “created, updated, published and distributed advertising materials in Canada pertaining to

real estate agency and brokerage services, in association with [the Mark].” These advertising materials included listing signs, business cards, newspapers, billboards, banners, brochures, and blogs produced for customers of the Owner and RE/MAX Affiliates seeking to sell or lease property. He also attests that the Owner provided advertising services, marketing services, and real estate listings for others through its website www.remaxcommercial.ca.

[43] In support, Mr. Ash attaches the following exhibits to his affidavit:

- Exhibit J consists of presentation slides that Mr. Ash attests are “copies of presentations summarizing media campaign highlights for Western Canada in 2011”. The presentation slides describe how the Mark was to be displayed in television, online, and print advertisements. I note that one of the slides explains that the Owner’s advertisements were to appear in “targeted business oriented magazines”, as well as on the magazines’ websites.
- Exhibit K, as noted above, consists of blog screenshots and copies of print publications, which Mr. Ash attests are representative of the advertising materials produced by the Owner in Canada during the relevant period. Some of the advertisements describe or list various services offered by the Owner and RE/MAX Affiliates, while others simply display the Mark along with a short tagline or slogan. The Mark is displayed throughout.
- Exhibit L, as noted above, consists of screenshots from the Owner’s website, where the Owner offered various services including providing real estate listings and information on real estate. A search box for finding a property or agent appears on one of the pages. The Mark appears above the description of services as well as above the search box.

[44] In summary, the exhibited slide printouts detail the Owner’s media campaign during the relevant period and describe how and where the Mark was displayed in the Owner’s advertisements. The intended audience of the slides appears to be the Owner’s franchisees, which would in turn use the advertisements created by the Owner. Mr. Ash also attached samples of print and online advertisements which show how the Owner’s advertisements appeared during the relevant period.

[45] With respect to “advertising” services, the Registrar has held that advertising on its own may not be a *bona fide* service in cases where it is not provided to a third party and instead only benefits the registered owner, such as where a registered owner advertises their own goods [see *Ralston Purina Co v Effem Foods Ltd* (1997), 81 CPR (3d) 528 (TMOB) at 534].

[46] However, in the present case, the evidence shows that the Owner created and updated advertising materials which were then used by its licensed franchisees in conducting their own business. The evidence also shows that the Owner and its licensees created and maintained advertising for its customers in the form of real estate listings and other advertisements.

[47] As such, I am satisfied that the Owner has demonstrated use of the Mark in association with “creating and updating advertising material” and “real estate advertising services” within the meaning of sections 4(2) and 45 of the Act.

Referral and Networking Services

[48] Mr. Ash attests that the Owner provides referral and networking services through an online tool called “RE/MAX Mainstreet” and the “Find an Agent” referral service at its website, www.remaxcommercial.ca. He explains that RE/MAX Mainstreet is “an online tool … where RE/MAX Affiliates are able to, among other things, update their profiles, exchange ideas and interact with other RE/MAX Affiliates, and provide referrals”.

[49] In support, Mr. Ash attaches the following exhibits to his affidavit:

- Exhibit N consists of a representative sample of an “Agent Profile” page from the RE/MAX Mainstreet website. The Mark is displayed on the page and Mr. Ash attests that “there have been no substantive changes made to the [website] in recent years”.
- Exhibit O consists of screenshots from the Owner’s website, www.remaxcommercial.ca. Mr. Ash attests that the screenshot from the “Find an Agent” page shows how both buyers and sellers of commercial real estate can enter search criteria and be referred to individual offices or agents. Another screenshot shows the results of a search for a RE/MAX office. While the screenshots are from 2014, Mr. Ash attests that the pages

looked the same during the relevant period. In each screenshot, the Mark is displayed either at the top of the page or next to a description of the referral services offered.

[50] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “referrals in the field of real estate brokerage” and “real estate networking referral services, namely, promoting the goods and services of others by passing business leads and referrals” within the meaning of sections 4(2) and 45 of the Act.

Real Estate Auctions

[51] With respect to “real estate auctions”, Mr. Ash attests that RE/MAX Affiliates offer real estate auction services through their websites.

[52] In support, attached as Exhibit R to Mr. Ash’s affidavit is a screenshot of a representative example of a RE/MAX Affiliate’s profile from the Owner’s website, *remaxcommercial.ca*. He attests that the profile advertises the agent’s availability for commercial real estate auction services, including during the relevant period. I note that “Auction, Sale” is listed under the commercial activities section of the profile and the Mark appears at the top left of the page.

[53] Given that the RE/MAX Affiliate’s profile displayed the Mark and listed “Auction, sale” as one of the services offered, I am satisfied that the Owner has demonstrated use of the Mark in association with “real estate auctions” within the meaning of sections 4(2) and 45 of the Act.

Valuation Services

[54] Similarly, with respect to “real estate valuation services”, Mr. Ash attests that RE/MAX Affiliates also offered real estate valuation services on their websites throughout the relevant period.

[55] In support, attached to his affidavit at Exhibit Q are screenshots from three RE/MAX Affiliate websites that Mr. Ash attests show advertising of “property valuation services” in association with the Mark during the relevant period. Two of the websites list “Opinion on the Value of Properties” under lists of the services offered, while the third lists “Opinion sur la

valeur marchande”. In each screenshot, the Mark is displayed either at the top of the page or next to the list of services offered.

[56] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “real estate valuation services” within the meaning of sections 4(2) and 45 of the Act.

Real Estate Management

[57] With respect to “real estate management”, Mr. Ash asserts that RE/MAX Affiliates “used [the Mark] to provide commercial and residential property management services throughout the Relevant Period.”

[58] In support, attached as Exhibit P to his affidavit are screenshots from RE/MAX Affiliate websites that Mr. Ash attests show “advertising of “property management services” in association with the Mark during the relevant period.” One website lists “Property Management” in a list of commercial services provided. A paragraph on another website details various specific services offered under the heading “Rental Property Management Services”. In each screenshot, the Mark is displayed either at the top of the page or next to a description of the services offered.

[59] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “real estate management” within the meaning of sections 4(2) and 45 of the Act.

Providing Listings and Information via the Internet

[60] Mr. Ash attests that the Owner “uses [the Mark] in association with the provision of consumer information, including information in the field of commercial real estate.” He also attests that the Owner provides real listings online at its website www.remaxcommercial.ca.

[61] In support, attached to his affidavit are the following exhibits:

- Exhibit L, as noted above, consists of screenshots from the Owner's website, *remaxcommercial.ca*. The website provides a search tool that customers can use to search for commercial real estate listings. The Mark is displayed above the search tool.
- Exhibit M consists of a copy of a press release and copies of commercial investor reports from the relevant period, which Mr. Ash attests were given to consumers to provide them with information and trends in the field of real estate. The press release announces the Owner's first commercial real estate franchises to launch in Canada on September 23, 2011. The reports provide information on multiple real estate markets in Canada. The Mark is displayed repeatedly throughout the documents.

[62] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with "providing real estate listings and real estate information via the Internet" and "providing information in the field of real estate via the Internet" within the meaning of sections 4(2) and 45 of the Act.

Arranging and Conducting Trade Shows

[63] With respect to "arranging and conducting trade shows", Mr. Ash attests that the Owner and its "Canadian Regional Sub-franchisors" conduct various conferences, seminars, trade shows, and courses for RE/MAX Affiliates, geared towards assisting them with their real estate agency and brokerage businesses. He explains that the Owner holds global conferences for its affiliates and that its annual conference was held in Ottawa in August 2013.

[64] In support, attached as Exhibit D to Mr. Ash's affidavit are "representative samples of various advertising materials, presentations and articles related to conferences and trade shows". I note that most of the materials relate to conferences held in the United States, but there is also a registration form for a Canadian conference that was to be held in British Columbia in May 2013 which displays the Mark.

[65] The Requesting Party argues that the evidence does not show that the Owner performed these services in Canada or that the Mark was displayed in Canada. However, while Exhibit D mostly relates to conferences and trade shows held in the United States, Mr. Ash does attest to a

conference held in Ottawa in August 2013. Although the evidence does not show how the Mark was displayed at the Ottawa conference in particular, Mr. Ash states that the Exhibit D conference materials are representative. Furthermore, Mr. Ash furnished a registration form displaying the Mark for a conference to be held in British Columbia in May 2013.

[66] Accordingly, when viewed as a whole, the evidence shows that the Mark was displayed in association with at least two trade shows or conferences hosted by the Owner in Canada during the relevant period. Therefore, I am satisfied that the Owner has demonstrated use of the Mark in association with “arranging and conducting trade shows in the field of real estate and real estate franchise services”, within the meaning of sections 4(2) and 45 of the Act.

Real Estate Consultancy

[67] With respect to “real estate consultancy”, the Requesting Party argues that the Owner has furnished no evidence of use. In this respect, the Requesting Party submits that the Owner is required to provide separate evidence for its “real estate consultancy” services from its evidence for the services of “franchising, namely consultation and assistance in business management, organization and promotion”.

[68] In support, the Requesting Party cites *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA), for the proposition that a registered owner is required to show use with respect to every registered service.

[69] However, I first note that *John Labatt* discusses goods rather than services. Indeed, the Registrar has previously held that “in certain cases, statements of services contain overlapping and redundant terms in the sense that the performance of one service would necessarily imply the performance of another” [*Gowling Lafleur Henderson LLP v Key Publishers Company Ltd*, 2010 TMOB 7, CarswellNat 1123].

[70] As such, in the present case, it is acceptable that the Owner’s evidence of use of the Mark in association with real estate consultancy overlaps with the evidence of use with respect to its other services. For example, the training materials furnished at Exhibit B describe the Owner’s “Practitioner Development Program”. The program covers business skills, marketing skills, and

specific real estate-related skills such as estimating market value. As the program provides training in the field of real estate consultancy to franchisees, it constitutes the provision of both “franchising” services and “real estate consultancy”.

[71] In any event, “real estate consultancy” is an inherently broad term and, contrary to the Requesting Party’s suggestion, the evidence is not limited to “consultation” in the context of “franchising”. For example, the Exhibit Q screenshots, described above, advertise a number of real estate services offered by a RE/MAX Affiliate, including “Consulting and advisory service”. The Mark appears next to the list of services offered.

[72] As such, I am satisfied that the Owner has demonstrated use of the Mark in association with “real estate consultancy” within the meaning of sections 4(2) and 45 of the Act.

Rental and Leasing of Office Space

[73] With respect to the “rental of office space” and “leasing of office space”, however, I agree with the Requesting Party that the Owner has furnished insufficient evidence of use.

[74] In this respect, the Owner relies on the aforementioned photograph of a “For Lease” sign at Exhibit I and the Exhibit K brochures offering, in part, “leasing” services, as evidence of its “rental” and “leasing” services. In its written representations, the Owner submitted that the “agency and brokerage services provided by [the Owner] are closely, and to some extent indistinguishably, connected to the actual rental and leasing of office space that ultimately takes place”, and therefore the evidence of use in association with agency and brokerage can also be considered evidence of use in association with rental and leasing services.

[75] However, the Requesting Party argues that “rental of office space” and “leasing of office space” are separate and distinct services from the registered services “agencies or brokerage for renting of land and buildings”. It argues that the Owner’s activities as shown by the evidence are consistent with the intermediate actions of an agent or broker only.

[76] As per section 30 of the Act, services must be stated in ordinary commercial terms and whether a trade-mark has been used in association with the services as registered is to be determined on a case-by-case basis [see *Express File Inc v HRB Royalty Inc*, 2005 FC 542, 39

CPR (4th) 59]. Accordingly, registered services should be interpreted in accordance with common sense and given their ordinary meaning.

[77] In this case, I agree with the Requesting Party that a real estate agent finding tenants for a property owned by a third party does not constitute “renting” or “leasing” that property, but instead constitutes an agency or brokerage service. Furthermore, the Owner itself makes a distinction between such services by virtue of its registration.

[78] However, the evidence shows only that the Owner and its RE/MAX Affiliates acted as brokers or agents with respect to the rental and leasing of office space. For example, I note that the term “leasing” in the Exhibit K screenshot appears under the heading “Brokerage Practice Areas”, indicating that the Owner and its franchisees act as brokers only. Nothing in the evidence shows, for example, that the Owner owned office space which it then offered for rent or lease. It is the owner of a property who rents or leases the property, not the broker or agent.

[79] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with “rental of office space” or “leasing of office space” within the meaning of sections 4(2) and 45 of the Act.

Disposition

[80] In view of all of the foregoing, 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 amended to delete “rental of office space” and “leasing of office space” from the statement of services.

[81] The amended statement of services will read as follows:

Franchising, namely, consultation and assistance in business management, organization and promotion; franchising, namely, offering technical assistance in the establishment and/or operation of real estate brokerage offices; creating and updating advertising material; real estate advertising services; arranging and conducting trade shows in the field of real estate and real estate franchise services; referrals in the field of real estate brokerage; real estate networking referral services, namely, promoting the goods and services of others by passing business leads and referrals; real estate auctions; real estate brokerage; real estate agencies; real estate valuation services; real estate consultancy;

Real estate management; business brokerage; agencies or brokerage for renting of land and buildings; providing real estate listings and real estate information via the Internet; providing information in the field of real estate via the Internet.

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

Hearing Date: 2015-05-22

Appearances

Karen F. MacDonald For the Registered Owner

Bayo Odutola For the Requesting Party

Agents of Record

Bull, Housser & Tupper LLP For the Registered Owner

OLLIP P.C. For the Requesting Party