

TRADUCTION/TRANSLATION



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

Citation: 2012 TMOB 102
Date of Decision: 2012-05-30

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Dagenais Jacob against registration
No. TMA263,336 for the trade-mark ÉCOLE DE
CONDUITE LAUZON & Design in the name of Groupe
Tecnic 2000 Inc. / Tecnic Group 2000 Inc.**

[1] On October 30, 2009, at the request of Dagenais Jacob (the Requesting Party), the Registrar issued a notice under section 45 of the *Trade-marks Act*, R.S.C. 1985, c T-13 (the Act), to Groupe Tecnic 2000 Inc. / Tecnic Group 2000 Inc. (the Registrant), the registered owner of registration No. TMA263,336 for the trade-mark ÉCOLE DE CONDUITE LAUZON & Design (the Mark) (shown below), registered for use in association with the services of [TRANSLATION] "automobile driving courses"(the Services):



[2] Section 45 of the Act requires the registered owner of a trade-mark to show, with respect to each of the wares or services specified in the registration, whether the trade-mark was is use in Canada at any time during the three year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of such use since

that date. In this case, the relevant period for showing use is any time between October 30, 2006, and October 30, 2009.

[3] Use in association with services is set out in subsection 2 of section 4 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.

[4] 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 "dead wood" from the register; this is why the applicable evidentiary threshold is quite low. As stated by Justice Russell in *Uvex Toko Canada Ltd v. Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC), at 282:

We know that the purpose of section 45 proceedings is to clean up the "dead wood" on the register. We know that the mere assertion by the owner that the trade-mark is in use is not sufficient and that the owner must "show" how, when and where it is being used. We need sufficient evidence to be able to form an opinion under section 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade-mark owners' business and merchandising practices.

[5] In response to the Registrar's notice, the Registrant filed an affidavit from its president, Yvan Sévigny, sworn on May 25, 2010, to which were attached Exhibits YS-1 to YS-3 inclusively. Only the Requesting Party filed written representations. Both parties participated in an oral hearing.

[6] Studying in closer detail the evidence submitted by the Registrant, Mr. Sévigny affirms that the Registrant is a company that specializes in the field of road safety training. According to Mr. Sévigny, the Registrant makes up the largest network of driving schools in Quebec.

[7] Mr. Sévigny confirms that the Registrant acquired the Mark on September 24, 1998, as evidenced by information about the Mark taken from the Canadian Trade-marks Database, filed as Exhibit YS-1 in support of his affidavit. It should be noted at this stage of my analysis that Exhibit YS-1 notably refers to the fact that the Mark was registered on October 16, 1981, by the corporation 1509-8858 Quebec Inc., and was the subject of a number of assignments, the last of

which was on September 24, 1998, in favour of the Registrant (then operating as a numbered company, 3476731 Canada Inc.) by bankruptcy trustee Jean Fortin & Associates Inc.

[8] Particularly with respect to the use of the Mark, Mr. Sévigny affirms that [TRANSLATION] "one of the [Registrant's] predecessors-in-title, granted licenses (by way of a franchising agreement) permitting use of the Mark in association with the Services to its franchisees ([...] designated the "Lauzon Franchisees"), and these licenses were never revoked." Mr. Sévigny adds that [TRANSLATION] "at all times and including the relevant period, [the Registrant] (or its predecessors-in-title) retained control, directly or indirectly, of the character and quality of the Services offered in association with the Mark in Canada, and did so, notably, pursuant to the franchise agreement".

[9] Mr. Sévigny states that one way for the Registrant to ensure the quality of the Services offered in association with the Mark, whether before, during, or after the relevant period, is to [TRANSLATION] "allow Lauzon Licensees to use its instructional manuals or other educational materials in the context of driving courses given to Lauzon Franchisee clients". Mr. Sévigny also states that [TRANSLATION] "pursuant to the franchise agreement, Lauzon Franchisees are authorized to use the Mark in Canada and offer the Services according to the teaching methods developed by [Registrant] (or its predecessors-in-title). In addition, Lauzon Franchisees must commit to respecting, in the normal course of business, the aforementioned teaching methods and the standard management approaches of [the Registrant] (or its predecessors-in-title)". Mr. Sévigny adds that the Registrant also rents vehicles and motorcycles to certain Lauzon Franchisees so that their students can take their driver's examinations.

[10] To illustrate the way in which the Mark is associated with the Services offered by the Registrant through Lauzon Licensees, Mr. Sévigny filed, as Exhibit YS-2 in support of his affidavit, [TRANSLATION] "photographs representative of the type of signs used outside of LAUZON driving schools, the latter of which were randomly chosen." Mr. Sévigny adds that these photographs are representative of the way in which the Mark was used during the relevant period. Further illustrating the Mark's association with the Services offered by the Registrant through Lauzon Licensees, Mr. Sévigny filed Exhibit YS-3, a copy of an advertisement

published in the *Yellow Pages* phone directory. Mr. Sévigny adds that this advertisement is representative of the way in which the Mark was used during the relevant period.

[11] This is essentially the complete evidence of use as submitted by the Registrant.

[12] The Requesting Party states that such proof of use does not establish use of the Mark in Canada in association with the Services in accordance with sections 2 and 4 of the Act. Specifically, the Requesting Party submits that the Registrant submitted no proof of use of the Mark in Canada by its registered owner, but instead gave proof of the possible use of the Mark by other businesses in an indefinite time period, with no evidence of affiliation to the Registrant. The Requesting Party claims that general affirmations made by Mr. Sévigny do not in and of themselves constitute proof of use of the Mark pursuant to section 45 of the Act, since such statements must be supported by precise facts showing use of the Mark in association with the Services. It is true that Mr. Sévigny's affidavit is not as detailed as it could be. Keeping in mind the goal of the proceedings pursuant to section 45 of the Act, I nevertheless find that the statements of fact contained therein, combined with the examples of use provided, establish use of the Mark in association with the Services to the benefit of the Registrant during the relevant period.

[13] Although the photographs representative of the type of outdoor signs, filed as Exhibit YS-2, are not dated and do not allow us to identify the exact address of the business appearing in the photographs, Mr. Sévigny expressly affirms in his affidavit that such photos illustrate the way in which the Mark *was* used *during* the relevant period, and is used in association with the Services through Lauzon Licensees. The civic number as well as the indication "RIVE SUD" accompanied by a telephone number appearing on the exterior of the business in question, make it reasonable to infer that this business is situated on the South Shore in Montreal, Quebec. These photographs make it clear that the Mark is displayed both on the sign overhanging the front of the business and on the business' storefront. Though the word "LAUZON" appears on such a sign to the right of the element of the Mark making up the figurative element and of the words "ÉCOLE DE CONDUITE" rather than below it, as appears in the Mark as it is registered, I find that this is a minor deviation; the Mark remains recognizable in and of itself and retains its identity [see leading cases *Registrar of Trade-marks v. Compagnie*

Internationale pour l'Informatique CII Honeywell Bull (1985), 4 CPR (3d) 523 (FCA); and *Promafil Canada Ltée v. Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. For the same reasons, the fact that the words "ÉCOLE DE CONDUITE" (making up the Mark) reproduced on the storefront of the business in question are in uppercase letters rather than in lowercase letters as appears in the Mark as it is registered, and that the word "LAUZON" does not appear under the figurative element and the words "ÉCOLE DE CONDUITE" (making up the Mark exactly as it is in the Mark as it is registered) but rather is centered below it, is of no consequence.

[14] Similarly, the fact that the advertising copy produced as Exhibit YS-3 consists solely of an extract from the *Yellow Pages* telephone directory and does not allow us to identify the date of the advertisement in question is not in itself fatal given that Mr. Sévigny expressly affirms in his affidavit that such an advertisement illustrates the way in which the Mark *was* used *during* the relevant period and is used in association with the Services through Lauzon Licensees. The Mark, as is registered, is prominently displayed in this advertisement, accompanied by a description of the Services. Seven specified businesses located in various municipalities on Montreal's North Shore or on the island of Montreal itself are additionally referenced. Such an advertisement constitutes use of the Mark in association with the Services pursuant to section 4 of the Act.

[15] In this respect, the fact that Mr. Sévigny filed no copies of licenses granted through the franchise agreement that oversees Lauzon Franchisees is also not fatal in itself given the explanations provided by Mr. Sévigny about the way that the Registrant ensured, both before and during the relevant period, and continues to ensure the quality of the Services offered in association with the Mark [see in particular *Shapiro Cohen Andrews Finlayson v. 1089751 Ontario Ltd* (2003), 28 CPR (4th) 124 (TMOB), 126; and *Coastal Trademark Services v. Mastey*, 2010 TMOB 145 CanLII, paragraph 16]. Though the Registrant cannot in this case benefit from the presumption outlined in subsection 50(2) of the Act, I consider that the explanations provided by Mr. Sévigny satisfy the requirements outlined in subsection 50(1) of the Act. As such, use of the Mark by Lauzon Franchisees benefits the Registrant.

[16] I would add on this point that the fact that such licenses were granted by a predecessor-in-title of the Registrant should not be held against the Registrant. Mr. Sévigny, by virtue of his

title as the Registrant's president since 1998, expressly affirms in his affidavit that these licenses were never revoked. Clearly, these statements are not based on hearsay, as these licenses are an integral part of the records of the Registrant's business as a successor-in-title to the rights to the Mark.

[17] Pursuant to the authority delegated to me under subsection 63(3) of the Act, the registration will therefore be maintained in compliance with the provisions of section 45 of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
[Jane Kuna]