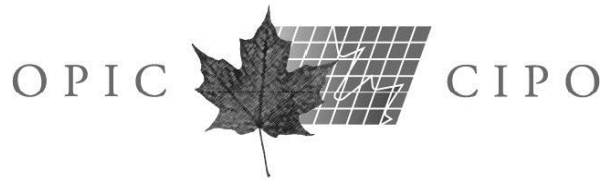


## Translation



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

**Reference: 2013 TMOB 28**  
**Date of Decision: 02/11/2013**

**IN THE MATTER OF THE SECTION 45  
PROCEEDINGS, undertaken at the request of Baker &  
McKenzie regarding Registration No. TMA577,594 of the  
IWEB trade-mark in the name of Groupe iWeb Inc.**

[1] On April 28, 2011, at the request of Baker & McKenzie LLP (the Requesting Party), the registrar sent the notice stipulated in Section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Groupe iWeb Inc. (the Registered Owner), in order to prove use of the IWEB trade-mark (the Mark), registration No. TMA577,594 in association with:

Web-based services, specifically hosting of websites, registration and management of domain names; creation of websites, hosting of web content, e-mail management, website referral services, web hosting management services and web-based training management services (the Services).

[2] Section 45 of the Act requires the Registered Owner to show that it has used its trade-mark in Canada in association with each of the Wares and/or Services specified in the registration at any given time during the three years preceding the date of the notice or, if not, provide the date on which it was last used and the reason for its absence of use since this date. The relevant period in this case is therefore from April 28, 2008 to April 28, 2011 (the Relevant Period).

[3] The procedure pursuant to Section 45 is simple and expeditious, and serves to clear “deadwood” from the register. Accordingly, the threshold to establish use of the Mark, within the meaning of Section 4 of the Act, during the Relevant Period is not very high [see *Woods Canada Ltd v. Lang Michener* (1996), 71 CPR (3d) 477 (CF)].

[4] A simple claim of use of the Mark is not sufficient to establish its use in association with the Services in compliance with provisions of sections 4(2) of the Act. There is no requirement to produce abundant evidence. However, any ambiguity in the evidence will be interpreted against the Registered Owner of the Mark [see *Plough (Canada) Ltd v. Aerosol Fillers Inc* (1980) 53 CPR (4th) 62 (CAF)].

[5] In reply to the notice, the Registered Owner submitted the affidavit of Éric Chouinard. The parties produced written representations. A hearing was not held.

[6] First, it is important to note that in its written representations the Registered Owner agrees to the web-based training management services no longer being covered by the current registration certificate. In effect, there is no evidence on the use of the Mark in association with these services. Registration No. TMA577,594 will therefore, at the least, be amended accordingly.

[7] Mr. Chouinard describes himself as being the president of the Registered Owner and of iWeb Technologies Inc. (Technologies), a wholly-owned subsidiary of the Registered Owner. He claims that the Mark had been used in Canada during the Relevant Period by the Registered Owner and Technologies in the normal course of business in Canada. However, a simple claim of use of the Mark is not sufficient in itself to respond to the notice issued by the Registrar. There is a need to examine all the evidence to determine if indeed there had been use of the Mark by the Registered Owner within the meaning of Section 4(2) of the Act in Canada during the Relevant Period.

[8] Mr. Chouinard states that the Registered Owner granted a licence to Technologies to use the Mark. He claims that the Registered Owner controls the characteristics and quality standards of services offered under the Mark in Canada, as well as the use, advertising and exposure of the Mark in Canada made by Technologies.

[9] He explains that the Services are offered or marketed in Canada essentially via the website <http://www.iweb.com>. Accordingly, he produced in bundle, as exhibit EC-1 in support of his affidavit, screenshots of “our” website showing the use of the Mark during the Relevant Period in association with the Services. There is no reference to Technologies or to the Registered Owner on the webpages submitted, other than [iweb.com](http://www.iweb.com). However, the use of the word “our” can only be taken to mean the Registered Owner or Technologies, since Mr. Chouinard does not refer to other entities in his affidavit. However, the use of the Mark by Technologies benefits the Registered Owner pursuant to the provisions of Section 50 of the Act.

[10] Accordingly, in the following advertisements, submitted as exhibit EC-1, the Mark can be found in association with the services described below:

Page 1 of 9 is an ad appearing on the [iweb.com](http://www.iweb.com) website, dated December 2, 2008, concerning the hosting of websites;

Page 2 of 8 and page 3 of 8 show an ad appearing on the [iweb.com](http://www.iweb.com) website, dated December 2, 2008, to promote domain name registration and management services;

Page 1 of 4 is an ad appearing on the [iweb.com](http://www.iweb.com) website, dated December 6, 2008, concerning the creation of websites;

Page 2 of 8, dated December 2, 2008, and pages 13 and 14, dated February 7, 2009, appearing on the [iweb.com](http://www.iweb.com) website are ads related to the hosting of web content;

Page 5 of 8, dated December 2, 2008, and page 13 are ads on the [iweb.com](http://www.iweb.com) website to promote e-mail management services;

Page 2 of 8 (Google Adwords) is an ad on the [iweb.com](http://www.iweb.com) website to promote website referral services;

Pages 4 and 5 of 8 are ads on the [iweb.com](http://www.iweb.com) website for web hosting management services.

[11] Mr. Chouinard provides the annual sales figures for web-based services offered by the Registered Owner in association with the Mark for the years 2008 to 2011, totaling over \$80 million. He submitted as exhibit EC-2 copies of invoices and order forms to show the sale of services associated with the Mark during the Relevant Period.

[12] Mr. Chouinard also submitted as exhibit EC-3 samples of advertising to show the use of the Mark during the Relevant Period. Lastly, Mr. Chouinard submitted as exhibit EC-4 excerpts from various websites which mention the Registered Owner and on which the Mark appeared during the Relevant Period.

[13] The Requesting Party advanced three arguments:

- 1) Mr. Chouinard made sworn statements in a cross-examination on an affidavit submitted in support of an opposition to a request for registration submitted by the Requesting Party that would contradict some of the claims contained in the current affidavit.
- 2) The Mark is not distinctive due to its use by entities other than the Registered Owner;
- 3) All references to iWEB in the evidence concerns the legal name or corporate name of the Registered Owner and do not constitute a use of the Mark.

[14] Regarding Mr. Chouinard's previous statements reproduced in the Requesting Party's written representations, the latter cannot introduce them into evidence under this administrative procedure [see *Fasken Martineau DuMoulin v. In-N-Out Burgers* (2007), 61 CPR (4th) 183 (TMOB)]. Accordingly, none of the arguments founded on these excerpts from a cross-examination of Mr. Chouinard can be considered.

[15] Regarding the fact that the evidence submitted appears to show that the Mark had lost its distinctive nature due to its use by entities other than the Registered Owner, it has been determined that Section 45 proceedings is not the appropriate forum to attack the distinctive character of a registered mark [see *Sim & McBurney v. Parry* (2010), 81 CPR(4th) 262 (CFPI)].

[16] Regarding the Requesting Party's last argument, there are indeed in several ads the use of "iWeb" as the Registered Owner's corporate name and not as a trade-mark. However, it should be stipulated that the evidence submitted shows a use of the following graphic mark:



[17] The Mark is a nominal mark. The addition of a graphic portion to a nominal mark is deemed to be the use of this nominal mark [see *Stikeman, Elliott v. Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB)]. However, it remains to be determined whether the addition of the word "Technologies" to the Mark is such that it represents the use of a totally different trade-mark. In my opinion, the current situation is similar to that in the case of *Alpha Sportswear Limited v. International News, Inc* (2005), 44 CPR (4th) 372 where my colleague Myer Herzig had concluded that the use of the mark ALPHA SPORTSWEAR & Design constituted use of the nominal mark ALPHA [see also *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 CPR (3d) 535, on page 538 under the heading "Principle 1" (TMOB)]. The word "technologies" is simply suggestive of the Services. I do not believe that consumers who see the mark illustrated above and who know the Mark, will think that the services offered

[18] in association with the mark come from a source other than the Registered Owner.

[19] In light of all this evidence, I conclude that the Registered Owner has met its burden of proof of the use of the Mark during the Relevant Period in association with the Services, except for the web-based training management services. I note that, for the latter services, the Registered Owner did not provide proof of special circumstances that could justify the absence of use of the Mark during the Relevant Period [see Section 45(3) of the Act].

[20] Accordingly, in exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, the registration TMA577,594 will therefore be amended such that the statement of services reads as follows:

Web-based services, specifically hosting of websites, registration and management of domain names; creation of websites, hosting of web content, e-mail management, website referral services and web hosting management services.

the whole pursuant to the provisions of Section 45(3) of the Act.

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Traduction certifiée conforme  
Alan Vickers