SECTION 45 PROCEEDINGS
TRADE-MARK: GATEWAY PRO
REGISTRATION NO.: 450,851

On December 9, 1999, at the request of Deeth Williams Wall, the Registrar forwarded a Section

45 notice to World Connect Inc., the registered owner of the above-referenced trade-mark

registration.

The trade-mark GATEWAY PRO is registered for use in association with the following wares

and services:

> wares: Computer software programs that facilitate data transfer between communications
> systems.

> services: Consulting services in respect of data transfer between communications
> systems.

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.

In response to the notice, the affidavit of John Kourtoff together with exhibits was furnished.

Each party filed a written argument. The registrant alone was represented at the oral hearing.

In his affidavit, Mr. Kourtoff states that the trade-mark GATEWAY PRO is currently used in Canada by World Connect Inc. in association with the wares and services. In particular, it is used with computer software programs that facilitate data transfer between communication systems and consulting services in respect of data transfer between communication systems. He indicates that SoftBahn Inc., the predecessor-in-title, assigned the trade-mark on July 7, 1999 and that prior to the assignment, SoftBahn used the trade-mark GATEWAY PRO in Canada, the U.S., the U.K., and elsewhere in association with computer software, computer hardware, associated computer hardware peripherals, associated documentation, and related consulting services and in particular with computer software programs that facilitate data transfer between communication systems and consulting services in respect of data transfer between communication systems. He explains that the trade-mark has been displayed on computer diskette labels, manuals, and external packaging and as Exhibit A he produces samples of the computer diskette labels, manuals, and external packaging bearing the trade-mark which he states are representative of those in use in Canada by SoftBahn between December 9, 1996 and July 7, 1999. As Exhibit B, he provides copies of sample user license confirmation and user registration sheets bearing the trade-mark which are included with computer diskettes, containing the computer software programs, within software licensing packages. He states that these are representative of those in use by the predecessor from December 9, 1996 to July 7, 1999.

He also provides a number of printouts of computer screen captures featuring the trade-mark which are representative of those in use by the current owner. Further, he submits copies of representative invoices showing sales of the products and services by the predecessor and by the

current owner. All invoices prior to July 7, 1999 are in the name of the predecessor-in-title. The

last invoice dated November 17, 1999 is in the name of the current owner.

The requesting party has raised several arguments, none of which I find successful.

As has been stated by the Courts, the purpose of Section 45 proceeding is to "rid the register of

deadwood".   In the case *Lewis Thomson & Sons Ltd.* v. *Rogers, Bereskin & Parr*, 21 C.P.R. (3d)

483, the Court stated as follows at page 486:

> ... The nature of these proceedings is such, it seems to me, that it is not considered that
> the facts of use are to be infinitely contestable before the registrar or the Federal Court. It
> seems to me that what is required is that the registrant establish a prima facie case of use
> and that that is all that is expected of him. There is usually no cross-examination
> permitted with respect to affidavits filed either before the registrar; ... and there is no
> provision for respondents filing any evidence before the registrar. It seems to me that that
> indicates quite clearly that these are not considered to be proceedings where there should
> be an infinite contestation of the facts.

Having considered the evidence, I find that the registrant has established a prima facie case of

use.

Concerning use by the current owner, Mr. Kourtoff has provided an invoice dated November 17,

1999 which he states was attached to the packaging containing the wares and which was

provided as an invoice in association with the services. He clearly specifies that the invoice was

for a computer software program that facilitates data transfer between communication systems

recorded on computer diskettes bearing the trade-mark and consulting services relating to data

transfer between communication systems. The trade-mark appears in the body of the invoice in association with the description of wares and services and as it accompanied the wares, I am satisfied that it served as notice of the association between the trade-mark and the wares at the time of transfer of the wares. Further, as Mr. Kourtoff stated that the computer diskettes containing the program bore the trade-mark, I am satisfied that this manner of use also provided the notice required under Section 4(1) of the Trade-marks Act. Mr. Kourtoff has also shown the manner the trade-mark appeared on computer screens from July 7, 1999 to December 9, 1999 and this would have provided further notice. Concerning the services, the trade-mark is clearly displayed in the body of the invoice, therefore I am satisfied that this shows that the trade-mark was used when the services were performed. Consequently, this satisfies me that the current owner was using the trade-mark in association with the wares and services during the relevant period.

The remaining evidence shows the manner the trade-mark was being used by the registrant's predecessor-in-title between the period 1996 and July 7, 1999. Mr. Kourtoff has shown the manner the trade-mark appeared on packaging for the wares, on manuals, user licence confirmation and user registration sheets that were included with computer diskettes containing the software program and he has shown that sales of the registered wares and services were made by the predecessor during the relevant period. The requesting party argues that Mr. Kourtoff does not establish how he has obtained and can rely on any of the material presumably obtained from SoftBahn and as such he cannot provide any real information as to how SoftBahn was using the trade-mark. However, I am prepared to accept the evidence since, as argued by counsel for

the registrant, Mr. Kourtoff has indicated that the facts and information contained in his affidavit were known to him personally or were obtained from company files and records to which he had access. Further, considering the evidence as a whole, I am satisfied that the exhibits do corroborate the assertions he made in his affidavit (*Quarry Corp*. v. *Bacardi & Co.*, 72 C.P.R. (3d) 25).

Concerning the trade-mark shown to be in use, I agree with the registrant that having regard to the evidence as a whole, the trade-mark GATEWAY PRO as it appears on the documents furnished is clearly distinguishable from any of the additional matter that appears on the documents in question and that GATEWAY PRO "per se" would be perceived by the registrant's customers as the trade-mark being used for the wares and services. In this regard, I rely on the case *Nightingale Interloc Ltd.* v. *Prodesign Ltd.*, 2 C.P.R. (3d) at 535, Principle 1.

In view of the above, I conclude that the evidence furnished is sufficient for purposes of Section 45. The evidence shows use of the trade-mark in association with the registered wares and services by the predecessor and by the current registrant. Accordingly, the trade-mark registration ought to be maintained.

Registration No. 450, 851 will be maintained in compliance with the provisions of Section 45(5)

of the Act.

DATED AT HULL, QUEBEC, THIS   20th   DAY OF DECEMBER 2001.

D   Savard
Senior Hearing Officer
Section 45 Division