



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

Citation: 2014 TMOB 175
Date of Decision: 2014-08-26

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by MyLife.com Inc. against registration
No. TMA659,472 for the trade-mark myLife in the name
of Peter Grbic**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA659,472 for the trade-mark myLife (the Mark), owned by Peter Grbic.

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

Wares:

- (1) Computer software application for use as an electronic personal organizer.
- (2) Computer software application for use as an electronic personal organizer accessible through the Internet by third parties.

Services:

- (1) Operation of a website for use as an online planner/organizer by third parties.
- (2) Operation of a website for use by third parties, consisting of an online organizer/planner with interactive WebPages including: (i) a personal health monitor page to assist the user in tracking their meals and exercise routines; (ii) a contact list page; (iii) a to-do list page; (iv) a general income and expense monitor page; (v) personal notes pages for general notes, recipes and daily events; (vi) the distribution of user's reminder items through electronic-mail; (vii) a calendar; and (viii) a list of, and links to, most commonly used Internet sites (a.k.a. "favourites") page.

[3] On August 1, 2012, at the request of MyLife.com Inc. (the Requesting Party), a notice was issued under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Mr. Peter Grbic (the Owner). The notice required the Owner to provide evidence showing that the Mark was in use in Canada, at any time between August 1, 2009 and August 1, 2012 (the relevant period), in association with each of the wares and services included in the registration. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[4] The relevant definitions of use are set out in sections 4(1) and 4(2) of the Act as follows:

4(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

(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 has been well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for clearing the register of “deadwood”. The criteria for establishing use are not demanding and an overabundance of evidence is not necessary; however, sufficient evidence must be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the registered wares and services during the relevant period (see *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)). Furthermore, mere statements of use are insufficient to prove use [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[6] In response to the Registrar’s notice, the Owner furnished his own affidavit, sworn on October 31, 2012, as well as the affidavits of three purported users of his “myLife” website at *www.my-life.ca*, namely, the affidavits of Mr. Winston Chow, Mr. Joe Neayem, and Mr. Warren Woodcroft.

[7] Neither party to the proceeding filed written submissions or made representations at an oral hearing.

[8] For the reasons that follow, I conclude that the registration ought to be amended to delete all of the wares, but be maintained with respect to the services in their entirety.

The Evidence

[9] In his affidavit, Mr. Grbic states that he has personally operated the website associated with the Mark since at least July 10, 2003, for use as an online planner/organizer by third parties.

[10] He explains that shortly after he acquired the domain name *my-life.ca* in 2004, his “myLife” website was then accessible through the website address *http://www.my-life.ca*. Once this occurred, Mr. Grbic attests that his website was substantially redesigned, including prominently displaying the Mark on nearly all pages of the website, usually centered at the top of each page. He further attests that the form and content of his redesigned website has since remained substantially the same, including during the relevant period, subject to minor corrections and improvements.

[11] To illustrate, he attaches as Exhibit A to his affidavit, a printout from the Internet archive *WaybackMachine*, to show the form and content of the home page of his website as at December 4, 2004. He further attaches as Exhibit B, screenshot printouts showing the form and content of his website, taken on or about October 1, 2012, which he states is substantially the same form and content of the website during the relevant period. The Mark is displayed prominently on the webpage screenshots in both exhibits.

[12] Mr. Grbic states that all “myLife services” made available through his website have been rendered free of charge and that anyone wishing to use [the myLife services available through] the website could immediately obtain a free account, which has been electronically and automatically made available to all users, including all users in Canada.

[13] He explains that the specific “myLife services” made available through his website continuously since at least 2004 (including during the relevant period) include access to specific pages entitled *myHealth*, *myMeals*, *myWorkouts*, *myContacts*, *myToDoList*, *myIncome*, *myExpenses*, *myNotes*, *myRecipes*, *myEvents*, *myReminders*, *myFavorites*, and a calendar. Exhibit B includes screenshot printouts of these specific pages.

[14] Mr. Grbic states that users in Canada have used all of the above-noted web pages in various combinations, including during the relevant period. As evidence of such use, as previously indicated, Mr. Grbic has provided the affidavits of three Canadian customers, namely, Mr. Chow, Mr. Neayem, and Mr. Woodcroft.

[15] Each affiant clearly attests to being a user of Mr. Grbic's website *www.my-life.ca* during the relevant period, with each affiant detailing the specific services used, as well as listing those services to which they had access to in Canada. Additionally, each affiant provides exhibit evidence in the form of screenshot printouts as a result of accessing the services on Mr. Grbic's website. For example, Mr. Chow has used the *myIncome*, *myExpenses*, *myContacts*, *myReminders*, *myLife calendars* and *myNotes* applications, while Mr. Neayem has used the *myContacts*, *myReminders*, *myFavorites*, *myHealth*, *myNotes* and *myLife calendars*. The evidence of all three affiants is consistent with that of Mr. Grbic.

Analysis

Wares

[16] While the services appear to employ various software applications which function as interactive personal organization tools available to users online, there is no evidence that the software was ever the subject of a transfer in the normal course of trade.

[17] Indeed, the evidence is silent with respect to the registered wares; rather instead focusing on the operation of the website as it relates to the provision of the services. Furthermore, no special circumstances justifying the absence of use of the Mark in association with the wares have been brought forth.

[18] Accordingly, having regard to the foregoing, the wares will be deleted from the registration.

Services

[19] However, for the reasons that follow, I am satisfied that the Owner has shown use of the Mark in association with the registered services.

[20] The Mark is clearly displayed on Mr. Grbic's website in association with an interactive online organizer/planner. Furthermore, the evidence shows that the online organizer/planner includes many features that permit a user to manage a variety of activities/areas of life, all of which are consistent with those described in the statement of services. Lastly, it is clear that users in Canada accessed and used the services, or at the very minimum, that each of the services were offered and available to be performed during the relevant period [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[21] While the services are rendered for free, a service does not need to be performed for money in order for it to be within the scope of section 4(2) of the Act [*War Amputations of Canada v Faber-Castell Canada Inc.*, (1992), 41 CPR (3d) 557 at 562 (TMOB)]. Indeed, services should be given a generous or broad interpretation; as such, it is sufficient that the public receives a benefit from the service.

[22] Additionally, while the evidence consists of a limited number of users of the Owner's services, there is nothing to suggest that the evidence was contrived or deliberately manufactured, or that it was mere token use designed to protect the registration.

[23] The threshold for establishing use in a section 45 proceeding is quite low (*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD) at 480), and evidentiary overkill is not required in order to properly reply to a section 45 notice. Consequently, having regard to the evidence as a whole, I find the Owner has succeeded in establishing a *prima facie* case of use of the Mark in association with the registered services.

Disposition

[24] Having regard to the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, registration No. TMA659,472 will be amended to delete all of the wares from the registration; however, the services will be maintained in their entirety in compliance with the provisions of section 45 of the Act.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office