



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

Citation: 2014 TMOB 172
Date of Decision: 2014-08-25

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Norton Rose Canada LLP against
registration No. TMA460,674 for the trade-mark MY
Design in the name of Dr. Leonard B. Smith Professional
Corporation**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA460,674 for the trade-mark MY Design shown below (the Mark), owned by Dr. Leonard B. Smith Professional Corporation.

The trade-mark consists of the letters 'M' and 'Y' in a bold, outlined, sans-serif font. The 'M' has a thick outline and the 'Y' has a similar style with a thick outline.

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

Wares:

- (1) Brochures, posters, packaging, business cards, magnets and outdoor signs namely, billboards, placards, sandwich boards, office signs and bus stop signs; toothbrushes, dental floss, mouthwash, toothpaste, video tapes, cassettes, pencils, pens and balloons.
- (2) Lunch kits; school bags; crayons; picture books; colouring books; comic books; children's activity books; children's books; educational books; book covers; bookmarks; toy boxes; pre-recorded compact discs containing oral health care educational software; computer mouse pads; newsletters; paper, plastic and cloth pennants; crossword, jigsaw and three-dimensional puzzles; stickers; telephone cards; vitamin and mineral supplements; chewing gum and condoms.

Services:

- (1) General dentistry namely, dental hygiene, cosmetic dentistry, implant dentistry, orthodontics, gum treatment, root canal treatment, pediatric dentistry, oral surgery and prosthetic dentistry.

[3] On January 13, 2012, at the request of Norton Rose Canada LLP (the Requesting Party), a notice was issued under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Dr. Leonard B. Smith Professional Corporation (the Owner). The notice required the Owner to provide evidence showing that the Mark was in use in Canada, at any time between January 13, 2009 and January 13, 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 provided the affidavit of Dr. Leonard B. Smith, the sole Director of the Owner, sworn on April 11, 2012, together with Exhibits A through R. Neither of the parties filed written submissions or requested an oral hearing.

[7] 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

[8] In his affidavit, Dr. Smith indicates that the Owner has one dental clinic located in Calgary, Alberta, through which it provides dental services. He goes on to state that the Owner has used the Mark in Canada during the relevant period in association with all of the registered wares and services.

[9] In support of his above-noted assertion of use, Dr. Smith attaches Exhibits A through R. In summary, the exhibits include:

- a photograph of business signage (Exhibit A);
- an image of a poster on the wall of the Owner's dental clinic (Exhibit B);
- photographs of apparel worn by employees (Exhibits C and G);
- photographs of community event and trade show materials (Exhibits D, E and F);
- images of labels on various types of media recordings as well as computer game software (Exhibits H, I, J, and K);
- copies of book covers with excerpts (including invoices for the printing of the books) (Exhibits L and M);
- a copy of an invoice from the Owner to a patient for dental services (Exhibit O);
- screenshot printouts of online videos (Exhibits P and Q);
- screenshot printouts (Exhibit N) of the Owner's website which include links to online purchasing of the Owner's CD (as shown in Exhibit K), and the Owner's book (as shown in Exhibit M); and
- a photograph of a growth chart that the Owner distributed in Canada to child patients and at trade shows (Exhibit R).

Dr. Smith attests that the Owner used all such materials either in the performance or in the advertising of dental services. The media recordings, the computer software and the books referred to above appear to target children's oral health, providing information and education to

the Owner's child patients, parents, caregivers and healthcare professionals. The community events (the puppet show depicted in Exhibit D, for example), and the trade show in which the Owner participated (the "Mom and Tot's show", as depicted in Exhibit F) also appear to reflect a focus on children's oral health.

[10] The Mark appears on all of the attached materials in various contexts including on its own, as well as followed by the words DENTAL HOME, and sometimes in addition, being accompanied by a design logo which includes the words "dental care for children".

Analysis

Wares

[11] With exception of the CDs or "pre-recorded compact discs containing oral health care educational software" (Exhibit K), the evidence concerning other types of media recordings ("video tapes" and "cassettes") is either undated (Exhibit J) or dated prior to the relevant period (Exhibits H and I). While the invoices in connection with the Owner's "educational books" are dated within the relevant period (under Exhibits L and M), they are for the printing of the books themselves and not with respect to the sale of the books to consumers.

[12] There is no evidence that the aforementioned CDs or books were the subject of a transfer in the normal course of trade. Dr. Smith simply attests that these wares were "distributed" or "provided" in Canada to the Owner's child patients, parents, healthcare professionals and caregivers. Furthermore, despite that the evidence shows that consumers could purchase these items online (Exhibit N), it has been previously held that offering for sale is not the same as selling [see *Michaels & Associates v WL Smith & Associates Ltd* (2006), 51 CPR (4th) 303 (TMOB)].

[13] Absent evidence of transfers of these wares in the normal course of trade, these wares appear to be incidental to the provision of the Owner's services; such as for the purpose of educating consumers as to the benefits of the Owner's services, thus promoting the Owner's services. This in itself does not constitute use of the Mark in association with wares under section 4(1) of the Act [see *SeaMiles LLC v Air Miles International Trading BV* (2010), 79 CPR (4th) 391 (TMOB)].

[14] Lastly, aside from Dr. Smith's bald assertion of use of the Mark in association with all of the registered wares and services, the affidavit is silent with respect to the remaining registered wares, and none of the attached exhibits relate to these wares. Furthermore, the Owner has not evidenced circumstances justifying the absence of use of the Mark in association with these wares.

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

Services

[16] In contrast to my findings with respect to the registered wares, for the reasons that follow, I am satisfied that the Owner has shown use of the Mark in association with the registered services.

[17] To begin with, the Mark is displayed on signage for the Owner's dental clinic (Exhibit A), on uniforms worn by employees in the performance and advertising of the services (Exhibits C and G), and on community event and trade show materials for the purpose of advertising the Owner's services (Exhibits D, E and F). Furthermore, the Mark also clearly appears on an invoice from the Owner to a patient for dental services (Exhibit O). Clearly, the Owner used the Mark in the advertisement of the services, as well as in the performance of the services during the relevant period.

[18] While the Mark appears in various contexts; for example, followed by the words DENTAL HOME, and sometimes in addition, being accompanied by a design logo which includes the words "dental care for children", the Mark also appears in isolation (as per the invoice for dental services shown in Exhibit O). In any event, whatever the context, the Mark is always displayed in a more prominent font, on a separate line, or visually distinguished in some other manner from the surrounding text and design elements, such that it remains recognizable and the public, as a matter of first impression, would perceive the trade-mark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984) 2 CPR (3d) 535 (TMOB); *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[19] Lastly, I am satisfied that the evidence as a whole demonstrates use of the Mark in association with each of the registered services. It is clear from the evidence that the Owner provides a broad range of dental services (as attested to by Dr. Smith at paragraph 3 of this affidavit) associated with general dentistry, including special emphasis on oral health care for children or pediatric dentistry.

Disposition

[20] Having regard to the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, registration No. TMA460,674 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