



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

**Citation: 2014 TMOB 147**  
**Date of Decision: 2014-07-22**

**IN THE MATTER OF A SECTION 45  
PROCEEDING requested by Joli-Coeur Lacasse  
S.E.N.C.R.L. against registration No. TMA572,876  
for the trade-mark EDUCATING THE WORLD  
in the name of CyberU, Inc.**

[1] On May 17, 2012, at the request of Joli-Coeur Lacasse S.E.N.C.R.L., the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 to CyberU, Inc. (the Registrant). The notice required the Registrant to show that its trade-mark EDUCATING THE WORLD (registration No. TMA572,876)(the Mark) had been used in Canada in association with each of the registered services within the previous three years.

[2] In respect of services, section 4(2) of the Act sets out the meaning of use:

4(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.

[3] The trade-mark is registered for use in association with the following services (the Services):

- (1) Online educational services, namely, providing online access to information concerning available courses of instruction, and the operation of a website therefor.
- (2) Online educational services, namely, providing online registration to available courses of instruction, and the operation of a website therefor.

[4] In response to the Registrar's notice, the Registrant furnished the affidavit of Mr. Adam L. Miller, the President and CEO of Cornerstone OnDemand, Inc. (Cornerstone). Both parties filed written submissions and were represented at an oral hearing.

[5] In response to the Registrant's evidence, the main submissions of Joli-Coeur Lacasse S.E.N.C.R.L. (the Requesting Party) were the following:

- (a) The affidavit of Mr. Miller is inadmissible;
- (b) The trade-mark has not been used with the Services *in Canada*.

[6] I will now discuss the evidence and arguments with respect to each of these issues in turn.

*Is the affidavit of Mr. Miller admissible?*

[7] The last page of the Miller affidavit bears Mr. Miller's signature; however, the jurat on this page has not been completed, as there is no seal or signature of a notary public, and the date of swearing is incomplete (referring only to August, 2012). Attached to Mr. Miller's affidavit are seven tabbed exhibits. Each exhibit contains a page with a completed jurat, dated September 7, 2012, followed by another page which includes an incomplete jurat dated August 16, 2012. I note however, that Exhibit 1 contains two completed jurat pages, dated September 7, 2012, followed by an incomplete jurat page.

[8] The Requesting Party submits that the affidavit of Mr. Miller does not appear to be dated or properly sworn before a notary public. The Requesting Party submits that this is a technical deficiency that cannot be waived by a Hearing Officer as without the swearing/declaring or commissioning, an affidavit or a statutory declaration does not exist [citing *Performance Apparel v Uvex Toko Canada* (2002), 25 CPR (4th) 284 at para 7 (TMOB)]. Lastly, the Requesting Party submits that the Registrant had an opportunity

to correct this situation, but chose not to do so. Accordingly, it is the position of the Requesting Party that the Miller affidavit should be deemed inadmissible in this proceeding.

[9] The Registrant submits that the affidavit was properly commissioned in accordance with the laws of California. In this regard, the Registrant submits that it is the practice of California (the jurisdiction in which the Miller affidavit was sworn) for notaries to attach a sheet with a completed jurat, as set out in the California Government Code Section 8202. Furthermore, the Registrant submits that pages bearing a completed jurat in the approved form are included in the Miller affidavit, and replace the blank, unsigned placeholders for the affidavit and exhibit cover pages.

[10] In reply to the Registrant's submissions, the Requesting Party submitted at the oral hearing that when dealing with affidavits sworn abroad, there should be evidence filed to support what is accepted practice in that jurisdiction, and that the Registrant's written submissions on this point do not constitute evidence. In any event, the Requesting Party submits that even if it were the law in California that it is acceptable to attach a sheet with a completed jurat to the affidavit, that law has not been followed here; there is no jurat page attached to the Miller affidavit, but only jurat pages attached to the exhibits.

[11] As previously indicated, Exhibit 1 to the Miller affidavit includes two completed jurat pages. I find it reasonable to accept the Registrant's submission that a simple binding or photocopying error occurred, and that the first jurat page at Exhibit 1 was intended to immediately follow the last page of Mr. Miller's affidavit. As such, I find that the misplaced tab is a mere technical deficiency and that the affidavit was properly commissioned. Lastly, I agree with the Registrant that the Registrar's practice is to accept, as *prima facie* admissible, affidavits made in accordance with the rules of the jurisdiction in which they were sworn [*Russell & Dumoulin v Guangdong Cereals & Oils Import & Export Corp* (2000) 17 CPR (4th) 283 (TMOB); and *San Tomo Partners v Companhia Industrial de Conservas Alimenticias/CICA* (1994), 53 CPR (3d) 560 (TMOB)]. I do not accept, as the Requesting Party has suggested, that it is incumbent

upon a registered owner to furnish evidence concerning the laws in foreign jurisdictions regarding the commissioning of affidavits or statutory declarations. Section 45 proceedings are to be summary in nature and evidentiary overkill is not required. Furthermore, the Registrant has made sufficient submissions on this matter.

[12] Lastly, the Requesting Party has further questioned the reliability and admissibility of the affidavit, as the incomplete jurat pages refer to one date, while the completed jurat pages refer to a different date. The Registrant submits that even if there were a discrepancy between the unsigned portion of the affidavit (in this case, the date) and the notary's signature sheets, such a discrepancy is a mere technical deficiency. The Registrant further submits that as this objection was not brought forth when the evidence was filed, the Registrar should not allow the Requesting Party to subsequently take advantage of such a technical objection [citing as support *Russell & Dumoulin, supra; Maximillian Fur Co v Maximillian for Men's Apparel Ltd* (1983), 82 CPR (2d) 146 (TMOB)]. I agree. The Requesting Party did not raise the issue of a discrepancy in dates prior to the oral hearing and, in any event, I accept the Registrant's submission that the completed jurat pages were intended to replace the blank, unsigned placeholders for the affidavit and exhibit cover pages.

*Does the evidence show use of the trade-mark in association with the Services in Canada?*

[13] The Requesting Party submits that there is no evidence that the Registrant offered or was prepared to perform the Services in Canada during the relevant period.

[14] With respect to services, where the trade-mark owner is offering and prepared to perform its services in Canada, use of the trade-mark on advertising of those services meets the requirements of section 4(2) of the Act [see *Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (RTM)]. In other words, advertising in Canada alone is insufficient to demonstrate use; at the very least, the services have to be available to be performed in Canada without the Canadian customer having to leave Canada [*Porter v Don the Beachcomber* (1966), 48 CPR 280 (Ex Ct); *Bedwell v Mayflower* (1999), 2 CPR (4th) 543 (TMOB); and *Société Nationale des Chemins de Fer Français SNCF v Venice*

*Simplon-Orient-Express, Inc* (2000), 9 CPR (4th) 443 (FCTD) aff'g 64 CPR (3d) 87 (TMOB)].

[15] In his affidavit, Mr. Miller explains that on May 13, 2005, CyberU, Inc., the currently recorded registered owner of the Mark, changed its name to Cornerstone OnDemand, Inc. Attached as Exhibit 1 to his affidavit is a copy of the company's long form good standing certificate evidencing this change of name. He further explains that in April 2011, Cornerstone incorporated CyberU, Inc. (CyberU) as a wholly owned subsidiary. He states that from April 2011 to the date of swearing of his affidavit, CyberU has, under license from Cornerstone, used the Mark in Canada and worldwide in association with the Services. He states that Cornerstone has direct or indirect control over the character and quality of the Services performed by CyberU in association with the Mark.

[16] In support of the above-noted assertions of use, Mr. Miller states that throughout the relevant period and up to the present, sales of the Services in association with the Mark to Canadians have generated thousands of dollars of revenue. He explains that the Mark appears on websites, business cards and presentation materials. In support, he provides the following:

- Exhibits 2, 3, 6, and 7, which consist respectively of printouts of the current *cyberu.com* website, the *cyberu.net* website dated August 2009, the *cyberu.com* website taken from the Internet archive at <*archive.org*> dated May 26, 2010, and once again the current *cyberu.com* website. He states that these screenshots are representative of how the *cyberu.com* website has appeared since at least 2010 and of how the Mark itself has been displayed on these sites since at least 2010 and 2011 (in the case of *cyberu.com*) and 2009 (with respect to *cyberu.net*). I note that Exhibit 2 shows that the *cyberu.com* website provides a search mechanism for e-learning titles, and that Exhibit 7 shows a selection of courses that have been added to a "shopping cart", with means to login/register and pay for the various course titles. The Mark is clearly displayed on each of the website screenshots;

- Exhibit 4, which consists of a copy of a current business card that displays the Mark and the *cyberu.com* domain name, which Mr. Miller states is representative of how the Mark appeared on business cards from CyberU's incorporation in 2011 continuously to the present. He states that these cards are given to CyberU's customers, including Canadian customers; and
- Exhibit 5, which consists of a presentation template bearing the Mark, which he states is used in the advertising and provision of the Services and is representative of how the Mark has appeared on presentations from CyberU's incorporation in 2011 continuously to the present. He states that Canadian customers or potential customers are sent presentations displaying the Mark in the normal course of business over the Internet;

[17] In addition to the above-noted exhibits, Mr. Miller states that as of December 31, 2011, Cornerstone had 805 clients (which includes 7.5 million users) across 179 countries including Canada, in 31 languages. He further attests that Cornerstone's clients include multinationals such as: Anheuser-Busch Companies, Inc., Staples, Inc., Starwood Hotels & Resorts Worldwide, Inc., Hyatt Hotels Corporation, and Microsoft Corporation.

[18] The Requesting Party submits that the Registrant needs to show, not merely state that it was prepared to perform the Services in Canada during the relevant period [citing *Wenward, supra*]. Further to this, the Requesting Party submits that a registrant providing online services must at least show that there are some indicia on the websites to show that the services may be available to consumers in Canada. Stated differently, it is the Requesting Party's position that a certain level of interactivity with potential Canadian customers must exist on a website in order for there to be a benefit to Canadians sufficient to support a registration. Evidence of such interactivity can include references such as: displaying prices in Canadian dollars, including contact information in Canada or for Canadians, or allowing for input of a postal code rather than a zip code [citing *TSA Stores, Inc v Registrar of Trade-marks* (2011), 91 CPR (4th) 324 (FC) at paras 16-21; *Lapointe Rosenstein LLP v The West Seal, Inc* (2012), 103 CPR (4th) 136 (TMOB) at para 27; *Poltev v MMI-GOC, LLC*, 2012 TMOB 167 at para 11; and *Grafton-*

*Fraser Inc v Harvey Nichols and Company Limited* (2010), 89 CPR (4th) 394 (TMOB) at para 9]. In the present case, the Requesting Party submits that none of the website screenshots show any such indicia.

[19] The Registrant submits that with respect to indicia on websites, the case law cited by the Requesting Party all deals with the operation of websites accessible to, but not necessarily directed to, Canadians, in support of registrations for retail store services and computer consulting services. As such, the Registrant submits that the operation of a website in such a circumstance is ancillary to such services; contrary to the present case in which the operation of the Registrant's website is integral to the Services, which are themselves provided online. Regardless of whether the operation of the Registrant's websites is integral or ancillary to the Services, the Registrant must still show that the Services were performed or at least offered and available to be performed in Canada.

[20] It is true that there is nothing on the website screenshots in evidence to indicate that the Registrant directed its Services associated with the Mark at Canadians. As no nexus to Canada has been shown through the website screenshots, given that merely having a website that is accessible in Canada is not sufficient to show use within the meaning of section 4(2) of the Act, the Registrant must show that it has used its Mark with respect to services actually provided to Canadians or performed in Canada [see *Unicast SA v South Asian Broadcasting Corporation Inc*, 2014 FC 295 at paras 46-49].

[21] Indeed, the Requesting Party submits that there is no evidence that Canadians accessed the services. In this regard, the Requesting Party submits that there is no information provided showing sales data, or at a minimum, an explicit indication showing a record of visits to the websites by Canadians. The Requesting Party submits that Mr. Miller's statement that "sales of the Services in association with the Mark to Canadians have generated thousands of dollars of revenue" does not meet the minimum threshold required to show "use", as it is an unsupported claim. The Requesting Party submits that the Registrant could have offered records or orders, course registrations, attendance and payments. The Requesting Party submits that the absence of all such corroborative

materials casts sufficient doubt on the claimed revenues [citing *Smart & Biggar v Curb* 2009 FC 47 at para 21].

[22] However, the facts in the *Curb* case are clearly distinguishable. To begin with, the portion of the decision relied upon by the Requesting Party dealt with wares as opposed to services. Furthermore, the affiant's statements in that case were ambiguous with no evidence of transfers of the wares in the normal course of trade shown. The Court was asked to make certain inferences regarding the wares on the basis of the evidence taken as a whole. However, the Court found that a conclusion that the wares in that case were sold would have been "an exercise in speculation rather than a proper inference from proven facts."

[23] In the present case, Mr. Miller provides a factual statement regarding sales of the Services in association with the Mark in Canada during the relevant period. While he could have provided more detail of the various sales transactions for the Services, there is nothing ambiguous or inconsistent about his statements.

[24] Furthermore, the Mark was displayed on the *cyberu.com* and *cyberu.net* websites during the relevant period, such sites providing online access to an e-learning course catalogue as well as e-learning course registration. Additionally, as previously noted, Mr. Miller clearly attests that the websites were accessible to Canadians during the relevant period and provides a sworn statement that sales of the Services in association with the Mark to Canadians have generated thousands of dollars of revenue during that time. Having regard to the evidence as a whole, I accept that Canadians accessed the Services during the relevant period and conclude that the Services associated with the Mark were actually provided to Canadians or performed in Canada during that time. Consequently, I accept that the Registrant has established a *prima facie* case of use.



Disposition

[25] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, registration No. TMA572,876 will be maintained in compliance with the provisions of section 45 of the Act.

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