



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

Citation: 2011 TMOB 75
Date of Decision: 2011-04-29

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Gowling Lafleur Henderson LLP against
registration No. TMA652,041 for the trade-mark GO in
the name of Randy Wall.**

[1] At the request of Gowling Lafleur Henderson LLP (the Requesting Party), the Registrar of Trade-marks issued a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on December 8, 2008 to Randy Wall (the Registrant), the registered owner of registration No. TMA652,041 for the trade-mark GO (the Mark).

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

(1) Real estate sales and services, namely, real estate advertising services, real estate agency services, real estate appraisal services, real estate brokerage services, real estate listing services, real estate management services, real estate relocation services, referral of providers of contracting and contracting work related to real property, referral of inspection companies, insurance providers, land surveyors, lawyers, mortgage providers, moving companies and rental companies that provide services related to real property; and (2) Mortgage services, namely, mortgage lending services, mortgage brokerage services [the Services].

[3] Section 45 of the 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 services specified in 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 such use since that date. In this case, the relevant period for showing use is between December 8, 2005 and December 8, 2008 (the Relevant Period).

[4] The definition of “Use” with respect to services is set out in s. 4(2) of the Act, which states:

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.

[5] It is well established that the purpose and scope of s. 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register and as such, the evidentiary threshold that the registered owner must meet is quite low. As stated by Mr. Justice Russell in *Performance Apparel Corp. v. Uvex Toko Canada Ltd.* (2004), 31 C.P.R. (4th) 270 (F.C.) at 282:

[...] We know that the purpose of s. 45 proceedings is to clean up the "dead wood" on the register. We know that the mere assertion by the owner that the trade mark is in use is not sufficient and that the owner must “show” how, when and where it is being used. We need sufficient evidence to be able to form an opinion under s. 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade-mark owners’ business and merchandising practices.

[6] In response to the Registrar’s notice, the Registrant, Randy Wall, filed an affidavit sworn on June 1, 2009, together with Exhibits A through L. Both Parties filed written arguments; an oral hearing was not requested.

[7] In his affidavit, Mr. Wall states that he has been using the Mark in association with the real estate services continuously since at least as early as June 3, 2002 and in association with the mortgage services continuously since at least as early as April 10, 2002. In support of these statements, Mr. Wall provides sample business cards, sample promotional notepads, screen captures of three websites and copies of various agreements, forms and contracts. He also provides evidence regarding the creation and development of the business cards, promotional pads and websites, though I do not consider these to be evidence of use of the Mark.

[8] Mr. Wall attaches to his affidavit as Exhibit C two different styles of business cards and states that he has been using the cards “continuously to date, from December 12, 2007 to the present” and that the cards “are distributed directly to new and past clients”. One of the

business cards displays the Mark as follows: “GO® MORTGAGE” along with the website *www.gomortgage.ca* and Randy Wall’s name. The reverse side of this card displays “GO® REAL ESTATE” along with the website *www.gomortgage.ca* and includes a REALTOR MLS design trade-mark. The second card displays the trade-mark GO® with additional design elements, includes the term “Mortgage Specialist” underneath Randy Wall’s name along with the website *www.gomortgage.ca*. However, this second card also includes reference to an unidentified corporate entity namely Prolink Mortgage Inc. and includes a small notation at the bottom of the card as follows: “GO®, gomortgage.ca™ and GO® MORTGAGES™ are trade-marks used under license.” No information regarding licensing of the Mark was furnished in evidence and the Registrant did not provide any details regarding the normal course of his trade. In view of the foregoing, I am not prepared to accept the second business card as evidence of use of the Mark by the Registrant or licensed use that inures to the benefit of the Registrant.

[9] In some circumstances, including where the cards have indicia of the relevant services on them or there are clear statements alleging use in the affidavit [*88766 Canada Inc. v. R.H. Lea & Associates Ltd.*; 2008 CarswellNat 4513 (T.M.O.B.)], business cards can be considered evidence of the advertisement of services [*Tint King of California v. Canada (Registrar of Trade-marks)* (2006), 56 C.P.R. (4th) 223 (F.C.T.D.)]. In this case, the business card displays the REALTOR MLS design trade-mark and contains a reference to “Real Estate” and “Mortgage”. Although it would have been preferable if Mr. Wall had provided more details regarding the normal course of his trade, I accept that the cards display sufficient indicia amounting to the advertising of real estate and mortgage services.

[10] Mr. Wall also deposes that promotional notepads were distributed via Canada Post on various dates between 2005 and 2007 and that these notepads “direct potential clients to *gohome.ca* whereby clients can choose either real estate or mortgage services”. A sample promotional notepad is attached to the Wall affidavit and displays the following: “GOHOME.ca” with design elements, Randy Wall’s name, the word REALTORS (as part of the company name CIR REALTORS) and the phrase “BUY OR SELL ON THE TOP REALTY WEBSITES” appears at the bottom of the notepads along with a reference to the website *www.gohome.ca*.

[11] The Requesting Party raised the issue as to whether the Services were being advertised in association with the Mark, submitting that the notepads do not display the Mark as registered. In this respect, I note that the website address *gohome.ca* is displayed at the top and bottom of the notepads. Regarding the first instance of the website address, I am not satisfied that it constitutes display of the Mark as registered, as the word GO is incorporated into the website address without any differentiation or prominence to the word GO. The second display of the website address, however, does display the word GO in a diamond shape and different font from the words “*home.ca*”. As some effort has been made to make the word GO stand out from the remainder of the website address, I am satisfied that it constitutes display of the Mark [*Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (T.M.O.B.)].

[12] In determining whether the business cards and notepads amount to advertisement of the Services as registered, I note that services are generally granted a generous interpretation [*Aird & Berlis v. Virgin Enterprises Ltd.* (2009) 78 C.P.R. (4th) 306 (T.M.O.B.)] and that statements of services may contain overlapping or redundant terms, in that the advertising of one service may imply the advertising of another [*Gowling Lafleur Henderson LLP v. Key Publishers Company Ltd.*; 2010 CarswellNat 579 (T.M.O.B.)]. For example, “real estate agency services” may encompass “referral of providers of contracting and contract work related to real property”. With these principles in mind, I am prepared to accept that the Services were advertised in association with the Mark through the distribution of business cards and notepads during the Relevant Period in Canada.

[13] Both the business cards and the notepads displayed website addresses, and screen captures of three websites (*www.gomortgages.ca*, *gohome.ca*, and *www.activeagent.ca*) were attached as Exhibit I to the Wall affidavit. Mr. Wall deposes that these web pages demonstrate use of the GO trade-mark in association with real estate sales and services and mortgage services from December 2005 until the present. However, I note the screen captures are all dated after the Relevant Period and Mr. Wall’s affidavit is silent with respect to the content of the websites during that period.

[14] With respect to the documents at Exhibit L, Mr. Wall states that clients were directed to his website *www.activeagent.ca* through a variety of other websites maintained by the Registrant,

such as *www.gorealestate.ca* and the aforementioned *www.gomortgage.ca*, and that “marked at Exhibit L ... is evidence of the mortgage application [sic] sent to me through the websites of GO real estate and mortgage broker services...”. First, I note that the statements in the affidavit do not correspond with the exhibits provided at Exhibit L. There is no “mortgage application” document included at Exhibit L, and none of the documents appear to be completed forms for mortgage lending services or mortgage broker services, despite the assertion in the affidavit. On the other hand, the documents that do appear at Exhibit L (referral fee disclosure forms, buyer brokerage agreements, buyer brokerage contracts, residential real estate listing contracts and residential real estate purchase contracts) are not otherwise referenced in Mr. Wall’s affidavit. I further note that all of the documents indicate that Randy Wall is either a representative or associate broker of a company, CIR Realtors; the relationship between the Mr. Wall and CIR Realtors is left unexplained in the affidavit. In any event, none of these documents bear the Mark. Accordingly, for all of the foregoing reasons, these documents do not evidence use of the Mark.

[15] The documentary evidence in this case is not strong and, in particular, there is no documentary evidence before me demonstrating that the Registrant performed or secured sales of real estate and mortgage services in association with the Mark in Canada. In addition, the Registrant has provided me with very little, if any, evidence explaining his normal course of trade. However, in the context of a section 45 proceeding, the evidence as a whole must be considered and focusing on individual pieces of evidence is not the correct approach [*Kvas Miller Everitt v. Compute (Bridgend) Limited* (2005), 47 C.P.R. (4th) 209 (T.M.O.B.)]. In addition, the burden on the owner in a section 45 proceeding is not onerous and a mark will be maintained so long as there is some use within the three year period preceding the section 45 notice [*Bruillette Kosie Prince v. Great Harvest Franchising Inc.*, 59 C.P.R. (4th) 416 (T.M.O.B.)]. Accordingly, in view of the evidence as a whole and in particular, having found that the Registrant displayed the Mark in the advertising of his Services through his business cards and notepads, I accept that there is sufficient evidence before me to conclude that the Services were performed or were available to be performed by the Registrant during the Relevant Period in Canada in association with the Mark.

[16] I am satisfied that there was use of the Mark in association with the Services during the Relevant Period within the meaning of s. 4(2) and s. 45 of the Act. Accordingly, pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be maintained in compliance with the provisions of s. 45 of the Act.

Darlene Carreau
Chairperson
Trade-marks Opposition Board
Canadian Intellectual Property Office