



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

Citation: 2016 TMOB 5
Date of Decision: 2016-01-13

IN THE MATTER OF A SECTION 45 PROCEEDING

Conduit Law Professional Corporation Requesting Party

and

Michael Fridhandler Registered Owner

TMA709,525 for Registration
MYGENERALCOUNSEL.CA

[1] At the request of Conduit Law Professional Corporation, the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on March 7, 2014 to Michael Fridhandler, the registered owner of registration No. TMA709,525 for the trade-mark MYGENERALCOUNSEL.CA (the Mark). The Mark is registered for use in association with “Legal Services”.

[2] 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 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 March 7, 2011 and March 7, 2014.

[3] The relevant definition of “use” is set out in section 4(2) of the Act as follows:

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.

[4] In response to the Registrar's notice, Mr. Fridhandler furnished his own statutory declaration, declared on June 3, 2014 in Vaughn, Ontario. Neither party filed written representations; an oral hearing was not requested.

The Owner's Evidence

[5] In his statutory declaration, Mr. Fridhandler attests that he is the sole director and president of Michael A. Fridhandler Law Office Professional Corporation. Mr. Fridhandler attests that he granted a license to the Corporation to use the Mark in June 2009. A copy of the license agreement is attached as Exhibit B to his declaration. The license agreement specifies that he has direct control over the character and quality of the services offered by the Corporation. As such, I am satisfied that any use of the Mark by the Corporation described below enures to the benefit of Mr. Fridhandler.

[6] Mr. Fridhandler attests that the registered services were advertised in association with the Mark in Canada during the relevant period on the website, *maflo.ca*. In support, attached as Exhibit C to his declaration is a printout of a page from that website, retrieved in March 2014. The content of the webpage states that "under the MyGeneralCounsel.ca™ approach, Michael Fridhandler will work onsite at your offices on a part-time or project basis. It's like having your own in-house counsel."

[7] Mr. Fridhandler also attests that the registered services were advertised in association with the Mark through "its use as an Internet domain name and URL, *mygeneralcounsel.ca*." In support, attached as Exhibit G to his declaration is a printout of a Google search performed in May 2014 of "mygeneralcounsel.ca", which shows "Michael A. Fridhandler Law Office" at *www.mysgeneralcounsel.ca* as the first result. However, I note that Mr. Fridhandler does not provide any printouts from *www.mysgeneralcounsel.ca* to show the content of the website itself.

[8] Mr. Fridhandler also attests that the Mark appeared on his business cards which he distributed to clients, potential clients, and contacts. Specifically, he attests that he inserted business cards into "each new Minute Book case of newly-formed corporations for clients of the Corporation", which he attests he "personally delivered to clients during the relevant period". In support, attached as Exhibits D and E to his declaration are copies of his business cards. The

front of the card displays “Michael A. Fridhandler” above “Barrister, Solicitor, and Notary Public” as well as contact information for the Thornhill, Ontario address of “Michael A. Fridhandler Law Office”. Similar to the *maflo.ca* website, the business cards list two service models. In particular, the “mygeneralcounsel.ca” service model is described as:

- Counsel with considerable in-house experience
- Work onsite at your offices on a part-time or project basis
- Also ideal to address your Legal Department overload or in-house counsel leave of absence

[9] Mr. Fridhandler attests that only 208 of the 500 business cards he ordered in April 2010 “remain in inventory and are still used for distribution”. A copy of the order invoice for his business cards is attached as Exhibit F to his declaration.

Analysis

[10] With respect to the exhibited webpages, Mr. Fridhandler does not provide printouts from *mygeneralcounsel.ca* that would show the content of that website and, in particular, the services advertised in association with the Mark. Although he does provide printouts from the *maflo.ca* website, it is unclear whether the exhibited webpage reflects the appearance of the website during the relevant period. Furthermore, Mr. Fridhandler does not attest as to whether any Canadian customers accessed or viewed either website during the relevant period.

[11] Nevertheless, Mr. Fridhandler attests that he personally distributed business cards bearing the Mark to clients and prospective clients in Canada during the relevant period. In particular, Mr. Fridhandler attests that he personally inserted his business card into each new corporate Minute Book and then personally delivered the minute books to clients.

[12] Although Mr. Fridhandler does not provide direct documentary evidence showing actual performance of the registered services, it is well established that the purpose and scope of section 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 [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 2004 FC 448, 31 CPR (4th) 270 (FC)]. With respect to services, the display of a trade-mark on advertising is sufficient to meet the requirements of section 4(2) when the trade-mark owner is offering and

prepared to perform those services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[13] Although it may have been preferable had Mr. Fridhandler provided documentary evidence of actual clients in Canada from within the relevant period – such as invoices – statements in a statutory declaration must be accorded substantial credibility in a section 45 proceeding [*Ogilvy Renault v Compania Roca-Radiadores SA*, 2008 CarswellNat 776 (TMOB)]. In this respect, Mr. Fridhandler clearly states that he provided his business card to clients when performing the registered services in Canada during the relevant period, namely in the form of the provision of corporate Minute Books. Such business cards display the Mark and provide a description of the owner’s services, which correspond to the registered services.

[14] In the absence of representations from the Requesting Party, I am satisfied that the evidence regarding the provision of the exhibited business cards in this manner is sufficient to constitute advertising and performance of “legal services” in association with the Mark in Canada during the relevant period.

[15] In view of the foregoing, I am satisfied that Mr. Fridhandler has demonstrated use of the Mark in association with the registered services within the meaning of sections 4(2) and 45 of the Act.

Disposition

[16] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

Agents of Record

Celina Fenster

For the Registered Owner

Conduit Law Professional Corporation

For the Requesting Party