



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

**Citation: 2014 TMOB 71  
Date of Decision: 2014-03-26**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Stemp & Company LLP against registration  
No. TMA548,585 for the trade-mark ISOLUTIONS in the  
name of Camilla Pauls Wheeler trading as ISOLUTIONS**

[1] At the request of Stemp & Company LLP, 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 13, 2012 to Camilla Pauls Wheeler trading as ISOLUTIONS (the Registrant), the registered owner of registration No. TMA548,585 for the trade-mark ISOLUTIONS (the Mark).

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

**Wares:**

(1) Printed matter namely handbooks, manuals, guides, forms, work instructions, policies, procedures, course instructions, examinations, spreadsheets.

(2) Handbooks, manuals, guides, forms, work instructions, policies, procedures, course instructions, examinations, spreadsheets, recorded on computer disks, relating to the application, design, development, implementation, maintenance and/or improvement of quality, quality assurance, consistency and/or efficiency controls, policies, procedures, programs or systems.

**Services:**

Consulting services, business management consulting services, teaching courses, conducting seminars and distributing information relating to the application, design, development, implementation, maintenance and/or improvement of quality, quality assurance, consistency and/or efficiency controls, policies, procedures, programs or systems.

[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 wares and 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 13, 2009 and March 13, 2012.

[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 is well established that mere assertions of use are not sufficient to demonstrate use in the context of a section 45 proceeding [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener et al* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the wares and services specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Registrant furnished her own affidavit, sworn on June 4, 2012. Neither party filed written representations; an oral hearing was not held.

[7] In her affidavit, Ms. Wheeler states that she registered the business name ISOLUTIONS in 1998 for the purposes of providing consulting services, teaching courses, conducting seminars and distributing information and supporting materials relating to quality assurance in the legal

and educational sectors. She explains that the Mark is a combination of the acronym “ISO”, for the International Organization for Standardization, and the word “solutions”. She attests that, from 1999 through 2008, she used the Mark on a full-time basis in the provision of the aforementioned services and that she used and continues to use the email address *isolutions@sympatico.ca* to communicate with clients and prospective clients for the purposes of providing her services.

[8] She attests that her consulting services performed during that period consisted primarily of “the application, design, development, implementation, maintenance and/or improvement of the quality, consistency and efficiency of post-secondary and continuing education and professional development programs and courses, and policies and procedures related to assessment of student learning and curriculum mapping”. She also attests that related wares in the nature of guides, charts, forms and the like were developed in conjunction with such consulting services.

[9] However, Ms. Wheeler acknowledges that, since 2008, she continues to use the Mark only “on a part-time basis”. She gives three factors that contributed to this reduction as follows: first, she obtained full-time employment as a faculty member at George Brown College in Toronto; second, she was enrolled in a part-time online Master of Education program at Memorial University in Newfoundland and Labrador; and finally, she simply states “less outreach and demand for services and wares”.

[10] I note that no exhibits are attached to her affidavit in support of her assertions of use before or during the relevant period. As such, Ms. Wheeler’s evidence of use of the Mark during the relevant period is limited.

[11] With respect to the registered wares, she provides no evidence of transfers of the wares during the relevant period. As such, I cannot conclude that the Registrant used the Mark in association with the registered wares within the meaning of sections 4 and 45 of the Act.

[12] With respect to the registered services, she merely attests that she most recently provided consulting services in early 2010, to George Brown College, “related to ensuring that the quality and content of the curriculum for a Paralegal certificate program conformed to the requirements

of the accrediting body, the Law Society of Upper Canada”. She attests that these services were invoiced “with the registered ISOLUTIONS trademark on April 10, 2010”.

[13] In view of the affidavit as a whole, Ms. Wheeler’s assertion that she used the Mark on the April 10, 2010 invoice is the only assertion I am prepared to accept as relating to use of the Mark during the relevant period. Unfortunately, it is merely an assertion and, in my view, the Registrant has failed to *show* use of the Mark during the relevant period. Although invoices are generally not required to be furnished in a section 45 proceeding [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)], Ms. Wheeler’s evidence with respect to the relevant period relies solely on this invoice. In such a case, it is insufficient to merely assert that the Mark was displayed. It is necessary to show how the Mark was displayed, either through a copy of the actual invoice or by representative evidence. Absent such evidence, I am unable to assess whether the Mark was in fact displayed as registered and whether the Mark was sufficiently associated with the services as registered.

[14] In view of the foregoing, I cannot conclude that the Registrant has demonstrated use of the Mark in association with the registered services within the meaning of sections 4 and 45 of the Act.

#### Special Circumstances

[15] With respect to whether special circumstances existed to excuse non-use of the Mark, Ms. Wheeler does not explicitly address this issue although, as noted above, she does state that use of the Mark was reduced after she obtained full-time employment and enrolled in a part-time education degree program. She also cryptically attests that one of the factors was “less outreach and demand for services and wares.”

[16] Generally, a determination of whether there are special circumstances that excuse non-use involves consideration of three criteria, as set out in *Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA). The first is the length of time during which the trade-mark has not been in use, the second is whether the reasons for non-use were beyond the control of the registered owner and the third is whether there exists a serious intention to shortly resume use.

[17] In this case, Ms. Wheeler provides no evidence that she intends to shortly resume use of the Mark. On this criterion alone, I find that she has not demonstrated special circumstances excusing non-use of the Mark. In any event, the factors she cites for non-use of the Mark, including “less outreach”, appear to be a result of a decision to focus her career elsewhere. As such, absent further explanation, it is not clear how the factors cited by Ms. Wheeler can be considered as reasons beyond her control.

[18] Given all of the foregoing, I am not satisfied that the Registrant has demonstrated special circumstances to excuse non-use of the Mark in this case.

#### Disposition

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

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