



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

Citation: 2014 TMOB 196
Date of Decision: 2014-09-19

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Atticus Canada Inc. against registration
No. TMA675,808 for the trade-mark ATTICUS in the
name of Atticus Management LLC**

[1] At the request of Atticus Canada Inc., the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on April 20, 2012 to Atticus Management LLC (the Registrant), the registered owner of registration No. TMA675,808 for the trade-mark ATTICUS (the Mark).

[2] The Mark is registered for use in association with the following services: (1) Financial services, namely investment fund management; (2) Financial services, namely investment fund management, hedge fund services, investment fund services, investment management and investment advice.

[3] The notice required the Registrant to furnish evidence showing that the Mark was in use in Canada, in association with each of the services specified in the registration, at any time between April 20, 2009 and April 20, 2012. If the Mark had not been so used, the Registrant was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[4] The relevant definition of “use” with respect to services is set out in section 4(2) of the Act:

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 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 services specified in the registration during the relevant period.

[6] In response to the Registrar's notice, the Registrant filed the affidavit of Peter K. Miller. Neither party filed written representations; an oral hearing was not held.

[7] In his affidavit, Mr. Miller attests that he served as a Senior Advisor to the Registrant and to its successor, Atticus Management LP, starting in 2000. He states that the Registrant was incorporated in Delaware and that pursuant to a certificate of conversion to a limited partnership in September 2009, changed its name to Atticus Management LP. A copy of the certificate is attached as Exhibit 1 to Mr. Miller's affidavit.

[8] Mr. Miller states that the Registrant "was one of the leaders in the investment management business, offering a wide range of financial services", including the services as registered. Noting Mr. Miller's use of the past tense, he states that "Canadian customers invested in several Atticus funds, such as Atticus Global, Ltd. (the "Global Fund")." He explains that "the remaining capital belonging to Canadian investors in the Global Fund is still managed by Atticus Capital LP, an investment management company, which provides certain administrative and managerial services to the Global Fund."

[9] With respect to the relevant period, Mr. Miller attaches 22 "monthly unaudited net asset value reports" at Exhibit 2 of his affidavit. He explains that the Registrant communicated with Canadian investors regarding their investments through such reports. Although the reports were prepared by a third party, International Fund Services (Ireland) Limited (IFS), Mr. Miller confirms that the Registrant supervised the performance of the services provided by IFS and that

such reports were customized according to the Registrant's directives. While the exhibited reports are partially redacted, they are all dated from August to October 2009 and are addressed to Canadian addresses. The Mark appears at the top of each report.

[10] Although Mr. Miller asserts that the reports show the Mark used in association with the "financial services" of the Registrant, I note that they are simply account statements, showing information about the particular fund for the particular customer, such as "Shares held", "Beginning Balance" and "Investment Value". For the reasons below, while I accept that such reporting may constitute the services of "investment fund management", "hedge fund services", "investment fund services", and "investment management", it is not clear how such reports constitute the more particular service of "investment advice".

[11] Indeed, although he states that Atticus Capital LP continues to operate "and is entitled to use" the Mark in Canada with respect to "providing investment management or advisory services for the Global Fund", he provides no evidence of such advisory services actually being performed or advertised in Canada during the relevant period. Instead, he merely provides copies of the license agreements between the Registrant and Atticus Capital LP from January 2008 and April 2011 at Exhibits 3 and 4, respectively. In my view, these license agreements on their own do not constitute evidence of continued use of the Mark in Canada during the relevant period in association with "investment advice", much less any of the registered services.

[12] Similarly, Mr. Miller states that the Registrant "authorizes the use of [the Mark] through the license agreement dated 2008 on confidential offering memoranda and other materials used by [Atticus Capital LP] prior to use". However, he provides no examples of such materials, nor does he give any indication that such materials were actually prepared at any point during the relevant period for Canadian customers or otherwise.

[13] Lastly, Mr. Miller provides, as Exhibit 5 to his affidavit, a copy of his business card from the relevant period. The card displays the Mark, along with Mr. Miller's name, contact information and New York address. While business cards have been considered advertising in some circumstances [see *Tint King of California Inc v Canada (Registrar of Trade-marks)* (2006), 56 CPR (4th) 223 (FC)], in this case, the card itself does not contain enough information to be considered advertising, as there is no reference to any of the services on the card. Further,

Mr. Miller provides no details regarding how or when the cards were distributed in Canada. In the absence of particulars, I am unable to infer that the card would have been used in the performance of any of the particular registered services in Canada during the relevant period [see *Faskin Martineau DuMoulin LLP v Bell Canada* (2009), 74 CPR (4th) 475 (TMOB)].

[14] From the evidence as a whole, it appears that there have been no new investments in association with the Mark for some time. Mr. Miller's use of the past tense in describing the nature of the Registrant's business and with respect to the preparation of the reports at Exhibit 2 indicates that the Mark may no longer be in use even to that limited extent. However, for at least a portion of the relevant period in 2009, the evidence shows that the Owner provided some services to its Canadian customers in association with the Mark, as shown by the exhibited account reports.

[15] In *Desjardins Sécurité Financière v Sun Life Assurance Company of Canada* (2006), 50 CPR (4th) 154 (TMOB), the Registrar held that the management of existing life insurance contracts, even in the absence of new contracts, was held to constitute "life insurance services". Similarly, I accept that use of the Mark on the exhibited monthly account reports constitutes performance of the following registered services, interpreted broadly: investment fund management, hedge fund services, investment fund services and investment management.

[16] At best, however, the exhibits demonstrate only passive reporting on the status of customer investments until October 2009. Without further information regarding the nature of the Registrant's business, I am not prepared to further conclude that such reporting/management services also constitute the services of "investment advice".

Disposition

[17] Accordingly, as the Registrant furnished no evidence of special circumstances excusing non-use of the Mark, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete the following services: "investment advice".

[18] The revised statement of services will be: (1) Financial services, namely investment fund management; (2) Financial services, namely investment fund management, hedge fund services, investment fund services and investment management.

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