LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

**Citation: 2013 TMOB 68**
**Date of Decision: 2013-04-18**

**IN THE MATTER OF A SECTION 45 PROCEEDING requested by Fasken Martineau DuMoulin LLP against registration No. TMA365,505 for the trade-mark PROBE in the name of Open Solutions DTS, Inc.**

[1] At the request of Fasken Martineau DuMoulin LLP (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on October 21, 2010 to Prologic Corporation, the registered owner at that time of registration No. TMA365,505 for the trade-mark PROBE (the Mark).

[2] The section 45 notice required the registered owner to furnish evidence showing that it had used the Mark in Canada in association with the wares specified in the registration within the time period between October 21, 2007 and October 21, 2010.

[3] The wares specified in the registration are "computer software".

[4] The relevant definition of "use" with respect to wares is set out in section 4(1) of the Act:

> 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.

[5] 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), 31 CPR (4th) 270 (FC) at 282].

[6] In response to the Registrar's notice, the Registrant filed the affidavit of Ryan H. Murray, sworn on July 21, 2011. Neither party filed written arguments; only the Registrant attended an oral hearing.

[7] In his affidavit, Mr. Murray identifies himself as the Assistant Secretary of Open Solutions DTS, Inc., a computer software company in the field of banking systems, and the current owner of the registration. He explains that although the section 45 notice was issued to "Prologic Corporation", that company changed its name in 2001 to Fincentric Corporation. Fincentric subsequently became a subsidiary of Open Solutions in 2007; upon Fincentric's dissolution on December 30, 2009, Open Solutions became the owner of the Mark.

[8] As evidence of sales of computer software during the Relevant Period, Mr. Murray attaches, as Exhibit A to his affidavit, a copy of a representative license agreement between Fincentric and an Ontario-based financial institution, Libro Credit Union Limited, dated during the Relevant Period. Mr. Murray explains that pursuant to that agreement, Libro purchased Fincentric's computer software, and attaches as Exhibit B-1 a copy of the corresponding invoice. He also attaches as Exhibit B-2 a copy of an invoice demonstrating the sale of the same software to another Canadian financial institution, Affinity CU, also during the Relevant Period. Lastly, attached as Exhibit E is a copy of an invoice for support services between Fincentric and Ontario-based Meridian Credit Union, arising from a license agreement that predates the Relevant Period.

[9] As evidence of the association between the Mark and the computer software, I note the license agreement at Exhibit A and the support services invoice at Exhibit E include reference to the Mark. Furthermore, Mr. Murray attaches, as Exhibit F-1 to his affidavit, two sample screen

shots showing the Mark displayed on screens that would have appeared at the time of installation.

[10] As discussed in *BMB Compuscience Canada Ltd v Bramalea Ltd* (1988), 22 CPR (3d) 561 (FCTD), this type of institutional computer software is not a physical object, and thus a computer software company experiences unique difficulties when attempting to associate a trade-mark with its software. In this case, however, the Mark appeared on the license agreement that purchasers of the software would have seen prior to installation of the software and notice of association continued when the Mark appeared on the installation screens provided at Exhibit F. As such, I am satisfied that the requisite notice of association would have been given to satisfy section 4(1) of the Act.

[11] Given the foregoing, I am satisfied that the registered owner has evidenced use of the Mark in association with "computer software" within the meaning of sections 4 and 45 of the Act during the Relevant Period.

Disposition

[12] 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.

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