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

**Citation: 2017 TMOB 80**

**Date of Decision: 2017-06-29**

**IN THE MATTER OF SECTION 45 PROCEEDINGS**

**Norton Rose Fulbright Canada  
LLP/S.E.N.C.R.L.,s.r.l.**

**Requesting Party**

**and**

**Nectar, Inc.**

**Registered Owner**

**TMA716,545 for NECTAR**

**Registrations**

**TMA717,039 for NECTAR**

[1] At the request of Norton Rose Fulbright Canada LLP/S.E.N.C.R.L.,s.r.l. (the Requesting Party), the Registrar of Trade-marks issued notices under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Nectar, Inc. (the Owner), the registered owner of registrations Nos. TMA716,545 and TMA717,039 for the trade-mark NECTAR (the Mark).

[2] With respect to TMA716,545, the notice issued on November 27, 2014, and the Mark is registered for use in association with the following services:

(1) Concept and brand development.

(2) Concept and brand development in the fields of consumer products, industrial products, medical products, interface design, product design, industrial design, web design, product packaging, and marketing.

[3] With respect to TMA717,039, the notice issued on November 19, 2014, and the Mark is registered for use in association with the following services:

Prototype fabrication of new products for others; industrial design; design and testing for new product development; product development for others; product development consultation; mechanical engineering; and design of computer programs, namely, graphical user interfaces.

[4] 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 goods 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 the trade-mark was last used and the reason for the absence of such use since that date. In this case, the relevant period for showing use with respect to TMA716,545 is between November 27, 2011 and November 27, 2014; with respect to TMA717,039 it is between November 19, 2011 and November 19, 2014.

[5] The relevant definition of “use” in association with services 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.

[6] 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. As such, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270]. A registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184, 90 CPR (4th) 428 at paragraph 2].

[7] 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 the advertised services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[8] In response to the Registrar’s notices, the Owner furnished two substantially identical statutory declarations of Darren Saravis, each declared on June 18, 2015, in Long Beach, California. Both parties filed written representations; an oral hearing was not requested.

## THE OWNER'S EVIDENCE

[9] In his statutory declarations, Mr. Saravis identifies himself as the founder, president and CEO of the Owner. He states that the Owner is a “product development company” incorporated in 2000 and based in southern California. He explains that the Owner’s product development process is “an interdisciplinary approach combining industrial design, user experience design, mechanical engineering and electrical engineering”.

[10] Mr. Saravis attests that the Owner has continuously displayed the Mark on its website at *nectardesign.com*, which he “understands” is accessible to Canadians. He attests that the Mark has also been continuously promoted on social media, including the Owner’s LinkedIn page, Facebook page, Twitter feed and YouTube channel. In addition, Mr. Saravis attests that the Mark was displayed on the Owner’s promotional materials distributed in Canada during the relevant period.

[11] As representative examples of the manner in which the Mark “is and was seen by Canadians”, Mr. Saravis attaches the following documents at Exhibits A and C to his declarations:

- a printout from *nectardesign.com* dated June 2015;
- six printouts from the Internet Archive at *web.archive.org*, showing archived webpages from *nectardesign.com* dated between December 2011 and March 2014;
- printouts of the Owner’s webpages on *linkedin.com*, *facebook.com*, *twitter.com* and *youtube.com*, dated June 2015; and
- an undated “promotional sheet”.

[12] “Nectar” is referenced throughout the exhibited webpages. In particular, “nectar” is displayed on a plain, circular background (the “Nectar Logo”) at the top of the *nectardesign.com*, *linkedin.com* and *youtube.com* pages from June 2015; at the top of the earliest archived *nectardesign.com* page; and throughout the *facebook.com* and *twitter.com* pages. In addition, “Nectar”, “Nectar Product Development” and/or “Nectar Design” are included in the title of all

but one webpage. I also note the display of “nectar product development” with the Owner’s address, under the heading “meet us” on the archived webpages.

[13] Regarding the Owner’s website at *nectardesign.com*, I note that the archived webpages reference various services, including “prototyping”, “product design”, “the complete spectrum of product development services—from initial research and analysis, to conceptual and industrial design, to validation and production”, “mechanical engineering”, “electronics & software”, “user interface” and “branding”. These pages also indicate that the Owner provides such services in various markets, such as “energy” and “medical devices, cleantech, industrial and consumer products and start-up technologies”. Some of the pages specifically refer to the Owner as a “product development firm” or “Product Design and Development Company”.

[14] The June 2015 printout from the Owner’s website references some of the same services and market areas, as well as “product development consultancy”.

[15] As for the promotional sheet, this three-page document depicts and describes various products showcasing the Owner’s work in three categories: “consumer product development”, “medical device development” and “industrial equipment”. The work described includes, for example, a “concept design” for an infant ventilator and “fully working prototypes” for an industrial printer casing. The Nectar Logo is displayed at the top of each page, next to “Nectar Product Development” and the Owner’s address. The URL *www.nectardesign.com* also appears on each page and “Nectar” is referenced throughout the text.

[16] With respect to performance of the Owner’s services, Mr. Saravis asserts use of the Mark in Canada during the relevant period, in association with the provision of the services set out in the registrations. In this respect, he gives two “representative” examples of services “provided directly in Canada” during the relevant period.

[17] First, Mr. Saravis states that the Owner provided a B.C. company with “product design and development services, including prototype fabrication, design and testing for new products, and product development consultation services as well as engineering and concept and brand development services for a new product line of furniture ... which was referred to as the ‘TuffLink’ project.”

[18] Second, Mr. Saravis states that the Owner provided an Ontario company with “all aspects of product development, including concept and brand development, prototype fabrication, industrial design, design and testing of the new products, product development and product development consultation as well as mechanical engineering services and creation of website interface designs, all for a new product line of nano-bubble technology products for water oxygenation”.

[19] Mr. Saravis further states that the Owner provides its services to “international companies that have offices in Canada”. In this respect, he gives the example of “mechanical engineering and industrial design services” provided to two international clients, each with an office in Mississauga. He also refers to an international client with a Vancouver office.

[20] Additionally, Mr. Saravis states that the Owner provides “design and development services” for products *distributed* in Canada. By way of example, he lists five clients whose products were distributed, installed or sold in Canada. The products include a “thermal printer”, “Carousel Drawers”, a “medical supply dispensing system”, “water systems” and “furniture connectors”.

[21] In support of the foregoing, Mr. Saravis attaches to his declarations various “representative” invoices from the Owner and related “time audit sheets”. Mr. Saravis attests that such invoices “are sent out at regular intervals during the performance of the services”. The Nectar Logo is displayed at the top of each exhibited invoice. These invoices do not itemize the services performed; however, as Mr. Saravis attests, the time audit sheets identify various services for each invoiced project and indicate the date when each such service was provided. The exhibited invoices and time audit sheets comprise the following:

- Exhibits B and D together contain a series of 10 invoices dated during the relevant period, addressed to the Owner’s client in Richmond, British Columbia. The first nine invoices are for an “Item” identified as “Tufflink”, with a “Description” listing the following articles in various quantities: “Connector”, “Screw Pin Stud”, “Lockout Key”, “Csnk Screw” and “Wrench”. The tenth invoice is for an “Item” identified as “S&H”, with the description “S&H”. Mr. Saravis explains that, although “the invoice description appears to refer to hardware”, the invoices were actually for the Owner’s “product

development, engineering and design services related to the prototype fabrication, design and testing of a new furniture product line ... that incorporated the Tufflink connection hardware". He further states that the invoices "were not for the sale of the hardware itself, but included the above recited design services, which also included concept and brand development and website interface designs".

- Exhibit E consists of a time audit sheet for "Tufflink Prototype Design, Fabrication, Testing and Brand Development". Most of the dates are within the relevant period; a few entries predate it, but by no more than two months. The entries identify various services, for example, "prototype design and testing", "prototype dev", "images and patent report", "concept and brand development", "website", "sales planning, brand development" and "package for shipping". I note that many of the services are identified as "Type" Eng s1 or Eng s2. Mr. Saravis explains that those designations mean "a senior engineer level 1" and "a senior engineer level 2", respectively.
- Exhibit F contains an invoice addressed to the Owner's client in Oakville, Ontario, and a corresponding time audit sheet. The dates of the invoice and of the services listed in the time audit sheet are all within the relevant period. The invoice specifies the number of hours worked at three different rates, identified as "Eng s1", "Eng s2" and "Shop". The time audit sheet contains entries for services such as "concept and brand development", "vortex improvements", "testing full assembly", "fab and assembly of leak check mockup", "sprinkler, branding" and "artwork for name plate".
- Exhibit G contains three invoices with corresponding time audit sheets, which Mr. Saravis attests confirm the provision of "mechanical engineering and industrial design services" to the two "international" clients with offices in Mississauga. In this respect, Mr. Saravis states, "Although the invoices for these services are addressed to an office in the United States, I understand from my Company's correspondence with these companies that my Company's services are being provided in Canada, for the benefit of the Canadian offices of these companies." The first of these invoices is for "services rendered" in June 2011 and as such predates the relevant period by several months; however, the remaining two invoices are for "services rendered" within the relevant

period. The corresponding time audit sheets list services such as “Packaging Concepts”, “Packaging refinement sketching”, “Client review/presentation” and “Mid-Phase Review with Client”.

- Exhibit H contains an additional four invoices, with corresponding time audit sheets, for “services rendered” to some of the clients whose products were distributed in Canada. All dates referenced are within the relevant period. Examples of services listed in the time audit sheets include “ID sketches”, “ID concept refinement and button layout” and “Control panel button configuration exploration” for the “thermal printer” and “Firmware design, code review” and “Coding” for the “carousel”.

#### DISPLAY OF THE MARK AS REGISTERED

[22] In its representations, the Requesting Party submits that the evidence does not show the Mark as registered, but rather, shows (i) a composite mark comprising the word “nectar” in a shaded circle, (ii) a word mark comprising the words “Nectar” and “Product Development”, (iii) a word mark comprising the words “Nectar” and “Design”, or (iv) the word “Nectar” used as a trade name rather than a trade-mark.

[23] As noted above, the Nectar Logo is displayed on each exhibited invoice, promotional sheet page and webpage, with the exception of certain archived webpages from *nectardesign.com*. However, on each of those archived pages, “nectar product development” is displayed under the heading “meet us” and, generally, “Nectar Product Development” is also displayed in the webpage title.

[24] In considering deviations from the registered form of a trade-mark, the question to be asked is whether the trade-mark was used in such a way that it did not lose its identity and remained recognizable, in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see whether the “dominant features” of the trade-mark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[25] Generally, use of a word mark in combination with additional words or design elements qualifies as use of the word mark if the public, as a matter of first impression, would perceive the word mark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); see also 88766 *Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)]. The issue is a question of fact, dependent upon such factors as whether the word mark stands out from the additional material or whether the additional material would be perceived as purely descriptive matter or as a separate trade mark or trade name [*Nightingale, supra*]. Moreover, a registration for a word mark can be supported by use of that mark in any stylized form and in any colour [see *Stikeman, Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB)].

[26] With respect to the Nectar Logo, it is clear that the Mark maintains its identity within this design. The simple circular background does not provide enough visual interest to detract from the public's perception of the Mark *per se*.

[27] In addition, I am satisfied that the Mark maintains a separate identity within "Nectar Product Development", as displayed on the archived webpages. In this respect, as noted above, each of these webpages references "product development" in describing the Owner's services and, occasionally, in describing the Owner itself. As such, I am satisfied that "Product Development" would be perceived as purely descriptive matter, despite being displayed in the same size and font as "Nectar". Accordingly, notwithstanding the Requesting Party's submissions, I do not consider the addition of "Product Development" to constitute a substantial variation that alters the dominant feature of the Mark, being the word NECTAR.

[28] To the extent that the Requesting Party submits "Nectar Product Development" would be perceived merely as a corporate or trade name, I note that "[t]rade-mark and trade name usage are not necessarily mutually exclusive" [see *Consumers Distributing Co/Cie Distribution aux Consommateurs v Toy World Ltd*, 1990 CarswellNat 1398 (TMOB) at paragraph 14]. Indeed, and especially in the limited context of a section 45 proceeding, it is hard to conclude that a trade name is not used for the purpose of distinguishing an owner's services from services performed by others, within the meaning of "trade-mark" as defined in section 2 of the Act.



[29] In view of the foregoing, it is not necessary to consider the Requesting Party's submissions with respect to "Nectar Design". In any event, since the same webpages also reference "design" in describing the Owner's services, it would be difficult to conclude that "Nectar Design" constitutes a substantial deviation from the Mark as registered.

[30] In summary, for the purposes of these proceedings, I am satisfied that the exhibited invoices, promotional sheet and webpages display the Mark.

#### ADVERTISING AND PERFORMANCE OF THE REGISTERED SERVICES

[31] With respect to advertising of the registered services in association with the Mark, Mr. Saravis attests that the Owner has continuously displayed the Mark on its website at *nectardesign.com*. He provides archived webpages from the website as representative examples of the manner in which the Mark was displayed on the website during the relevant period. These pages advertise a number of services in a variety of fields, which I accept as corresponding to each of the registered services listed in both registrations at issue.

[32] To the extent that some of the registered services, such as "product development consultation" and "concept and brand development in the fields of ... web design, product packaging, and marketing", are not explicitly articulated in the archived webpages, I accept that such services fall within the services advertised as "the complete spectrum of product development services" and "branding". The scope of such services is corroborated by the other evidence, including the current webpage, the exhibited promotional sheet, and the detailed time audit sheets.

[33] With respect to the advertising being in Canada, the Requesting Party submits that there is "no evidence that the Website was actually accessed or seen by Canadians". The Owner, for its part, submits that mere *accessibility* of the website in Canada suffices to constitute advertising.

[34] First, I agree with the Requesting Party that promotional material posted online must be "distributed to" or accessed by prospective customers in order to constitute advertising. However, as noted above, the threshold for establishing use in section 45 proceedings is quite low. There is no one particular type of evidence required [*Lewis Thomson & Sons Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)]. With respect to online advertising, evidence

from which it can reasonably be inferred that customers accessed the webpages in question can suffice [see *Ridout & Maybee LLP v Residential Income Fund LP*, 2015 TMOB 185, 136 CPR (4th) 127].

[35] In the present case, although the Owner did not provide access data or other particulars for the exhibited webpages, I am prepared to infer that at least some Canadians would have viewed the pages in question, given the evidence that multiple companies with offices in Canada actually availed themselves of the Owner's services. I am therefore satisfied that the exhibited webpages were "distributed" in Canada during the relevant period.

[36] As noted above, the exhibited promotional sheet also displays the Mark in advertising specific registered services and markets. In this respect, the Requesting Party submits that there is no information as to how, to whom, or to what extent such promotional materials were distributed in Canada.

[37] However, statements made in a statutory declaration must be accorded substantial credibility in a section 45 proceeding [see *Ogilvy Renault v Compania Roca-Radiadores SA*, 2008 CarswellNat 776 (TMOB)]. As such, I am prepared to take at face value Mr. Saravis' assertion that promotional materials in the nature of the exhibited sheet were distributed in Canada during the relevant period.

[38] In view of the foregoing, I am satisfied that the Owner displayed the Mark in advertising each of the registered services in Canada during the relevant period.

[39] With respect to *performance* of the registered services in Canada, Mr. Saravis provides representative invoices addressed to Canadian companies, for two projects that he attests comprised services "provided directly in Canada". As noted above, although the exhibited invoices do not reference specific services, Mr. Saravis makes sworn statements correlating each project with specific registered services and provides time audit sheets detailing the work performed on each project.

[40] Notwithstanding the Requesting Party's submissions, although the time audit sheets appear to be internal documents, I accept that they are relevant to the extent that they clarify the

nature of the services performed on the invoiced projects and corroborate Mr. Saravis' statements in that regard.

[41] Furthermore, although the invoices for the Tufflink project appear more consistent with a sale of goods than a bill for services, Mr. Saravis adequately explains this apparent discrepancy, particularly given the inherent connection between the Owner's services on this project and the development of "goods".

[42] In view of the foregoing and the nature of the Owner's services, although more detail on the manner of their performance could have been furnished, I accept that display of the Mark on the exhibited invoices addressed to Canadian clients constitutes display in the advertisement and performance of the Owner's services in Canada.

[43] Moreover, to the extent that some of the registered services are not explicitly addressed by the evidence of services provided "directly in Canada" during the relevant period, I am satisfied that the Owner was, at a minimum, *offering and prepared to perform* such registered services in Canada during the relevant period.

[44] In particular, I note that Mr. Saravis' aforementioned correlations do not reference "concept and brand development" services in the fields of "product packaging" or "marketing". However, he furnishes time audit sheets listing services that include "packaging concepts" and "packaging refinement sketching", for one of the international clients with a Canadian office, and "sales planning, brand development" for the B.C. client. Although the time audit sheets in question indicate that such services were performed prior to the relevant period, I find it reasonable to infer that concept and brand development services in these fields would have remained available in Canada *during* the relevant period.

[45] Moreover, although Mr. Saravis' correlations do not expressly reference the "consumer products, industrial products, [and] medical products" fields, it is clear from the evidence as a whole that such fields are included in the broad scope of the Owner's "concept and brand development" services.

[46] In addition, to the extent that some of Mr. Saravis' correlations are not clearly supported by entries on the corresponding time sheets, I am nonetheless satisfied that the availability of such services in Canada is supported by the evidence as a whole.

[47] For example, with respect to the registered services relating to "industrial design", I note entries for "ID sketches" and "ID concept refinement and button layout" in one of the time audit sheets for "products distributed in Canada". I am prepared to infer that "ID" is an acronym for "industrial design" in this context. As such, this time audit sheet provides support for the availability of product design and brand development services in the nature of "industrial design" in Canada during the relevant period.

[48] Similarly, the time audit sheet referencing "Client review/presentation" services, albeit provided prior to the relevant period, nonetheless indicates the availability of "product development consultation" services in Canada *during* the relevant period.

[49] In summary, I accept that the Owner displayed the Mark in advertising each of the registered services in Canada during the relevant period, and that the Owner performed, or was at least offering and prepared to perform, those services in Canada during the same period.

#### DISPOSITION

[50] In view of all the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with all of the services in both registrations within the meaning of sections 4(2) and 45 of the Act.

[51] Accordingly, 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 registrations will be maintained.

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Oksana Osadchuk  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

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

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No Hearing Held

**AGENTS OF RECORD**

Borden Ladner Gervais LLP

FOR THE REGISTERED OWNER

Norton Rose Fulbright Canada LLP/S.E.N.C.R.L.,s.r.l.

FOR THE REQUESTING PARTY