



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

Citation: 2018 TMOB 4

Date of Decision: 2018-01-16

IN THE MATTER OF A SECTION 45 PROCEEDING

Nelligan O'Brien Payne LLP

Requesting Party

and

Beacon Law Corporation

Registered Owner

TMA559,690 for BEACON LAW

Registration

[1] This is a decision involving summary expungement proceedings with respect to registration No. TMA559,690 for the trade-mark BEACON LAW (the Mark), owned by Beacon Law Corporation.

[2] The Mark is currently registered in association with “legal services”.

[3] For the reasons that follow, I conclude that the registration ought to be maintained.

THE PROCEEDINGS

[4] On January 22, 2016, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Beacon Law Centre, the registered owner at that

time of registration TMA559,690. The notice was sent at the request of Nelligan O'Brien Payne LLP (the Requesting Party).

[5] The notice required the registered owner to furnish evidence showing that it had used the Mark in Canada, at any time between January 22, 2013 and January 22, 2016, in association with the services specified in the registration. If the Mark had not been so used, the registered owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[6] Subsequent to the issuance of the section 45 notice, an assignment of the subject registration to Beacon Law Corporation was filed with the Registrar on April 21, 2016. The assignment document indicates that ownership of the Mark was transferred by Beacon Law Centre, a partnership, to Beacon Law Corporation (the Owner) on September 1, 2004. The assignment, recorded on the register on May 10, 2016, is not at issue in the present proceeding.

[7] 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.

[8] 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 FC 448, 31 CPR (4th) 270].

[9] In response to the Registrar's notice, the Owner furnished the affidavit of Delbert Elgersma, sworn April 21, 2016, together with Exhibits A to J.

[10] Both parties filed written submissions. An oral hearing was not requested.

THE EVIDENCE

[11] Mr. Elgersma is a co-founder and one of two directors of the Owner. He is also the sole director of Delbert D. Elgersma Law Corporation.

[12] Mr. Elgersma attests to details pertaining to the transfer of ownership of the Mark from the registrant ultimately to the Owner. As previously noted, the assignment of the Mark is not at issue in the current proceedings.

[13] Mr. Elgersma attests that the Owner (and its predecessors in title) have continuously offered and continues to offer the services in association with the Mark. In support, he provides annual revenue figures in excess of \$1 million in each of the Owner's three most recent fiscal years. He further attests that the Mark has been and continues to be prominently displayed and marketed in the normal course of trade in Canada, on its own and together with the word "Centre" at the end, as per the following examples:

Exhibit B – a screenshot of the *beaconlaw.ca* home page. Aside from the URL, the Mark does not appear on the screenshot.

Exhibit C – a copy of the Owner's Facebook page. The Facebook page displays "Beacon Law Centre", with reference to "Beacon Law" appearing solely in the text of messages posted on the page.

Exhibits D1-D7 – copies of newsletters issued between Winter 2012 and Autumn 2015. Mr. Elgersma states that the Owner's newsletter has a circulation by mail of over 7,500. The newsletters display "Beacon Law Centre", as well as "Beacon Law" both with respect to a bullet list of services offered and in the text of the newsletter articles.

Exhibit E – copies of advertisements published in *Seaside* magazine (formerly *Seaside Times*, a magazine with a yearly distribution of 240,000), dated 2012, 2013 and June 2015. The advertisements each display "Beacon Law Centre" and/or "Beacon Law Centre" together with a logo design. Additionally, the June 2015 advertisement displays "Beacon Law" at the top left hand side.

Exhibit F – a copy of an advertisement dated May 6, 2010 in the *Victoria Times Colonist*, Victoria's major daily newspaper. The advertisement displays "Beacon Law Centre" at the top with a logo design. The text in the advertisement also includes "Beacon Law knows you don't care about their hourly rate", as well as a reference to the website *www.beaconlaw.ca*.

Exhibit G – a copy of Mr. Elgersma's business card. The business card displays "Beacon Law Centre".

Exhibit H – copies of select invoices, dated January 18th, 20th and 21st, 2016 for estate planning services, real estate legal services and corporate legal services respectively. The invoices display "Beacon Law Centre".

Exhibit I – a copy of a letter dated January 18, 2016 on the Owner’s letterhead. The Owner’s letterhead displays “Beacon Law Centre”.

Exhibit J – a printout of a Google search for “beacon law”. The Google search shows a number of hits for “Beacon Law Centre”.

ANALYSIS AND REASONS FOR DECISION

[14] To begin with, the Requesting Party submits that the Owner’s evidence is undated, not sufficiently dated (and therefore ambiguous), or dated outside of the relevant period. In particular, the Requesting Party submits that Exhibits D-6, D-7, and F are dated prior to the relevant period, with no probative value, and therefore, must not be taken into consideration.

[15] While some of the evidence provided is outside of the relevant period, I note that there is sufficient evidence that clearly relates to the relevant period, such as several of the Exhibit D newsletters, one Exhibit E advertisement, and the Exhibit H invoices.

[16] In any event, the Requesting Party submits that the Mark has not been used as registered. In this regard, the Requesting Party submits that the evidence shows “Beacon Law Centre”, which is a significant alteration of the Mark as registered, as “Beacon Law” does not stand out from “Beacon Law Centre” [citing *Shapiro Cohen Andrews & Finlayson v 1089751 Ontario Limited* (2003), 28 CPR (4th) 124 (TMOB)]. The Requesting Party submits that the inclusion of a descriptive term significantly alters the character of the Mark as used [citing *Cassels Brock & Blackwell v Relton Corporation* (unreported) [2003] TMOB No.6 (January 2003)]. Further to this, the Requesting Party submits that any display of “Beacon Law” is as a shortened trade-name, and not a trade-mark.

[17] The Owner submits that while some uses contain the word “Centre”, this addition does not significantly alter the use of the Mark and the Mark does not lose its identity. I agree. In this regard, I do not find that the decision in *Shapiro Cohen, supra*, is on par with the present case, as in that case, it was not descriptive matter that was added to the trade-mark at issue, but rather corporate name indicia. Furthermore, with respect to the *Relton* case relied upon by the Requesting Party, the descriptive matter in that case appeared as a dominant and integral part of the trade-mark as used, such that the trade-mark as used was substantially different.

[18] In the present case, I am of the view that the addition of the descriptive word “CENTRE” does not amount to a substantial deviation from the trade-mark as registered. In other words, the Mark has not lost its identity and remains recognizable, and the addition of the word “CENTRE” to the Mark is not likely to mislead, deceive, or injure the public in any way.

[19] Such a finding is consistent with many previous cases wherein the Registrar has held that similar deviations do not make the trade-marks substantially different [see for example: *Ogilvy, Renault v Arbor Restaurants Inc* (1994), 55 CPR (3d) 401 (TMOB); *Riches, McKenzie & Herbert v Pillsbury Co* (1995), 61 CPR (3d) 96 (TMOB); *Goudreau Gage Dubuc & Martineau Walker v Niagara Mist Marketing Ltd* (1997), 78 CPR (3d) 255 (TMOB); *Borden & Elliot v Olin Corp*, 1999 CarswellNat 3488 (TMOB); *Star Island Entertainment LLC v Provent Holdings Ltd*, 2013 TMOB 84, and *LE PEPE' SRL and PJ Hungary Kft*, 2017 TMOB 82].

[20] In any event, I note there are instances wherein “BEACON LAW” appears without the additional word “CENTRE”, and contrary to the Requesting Party’s submissions, I note there are instances where it is not embedded with other text (e.g – Exhibit E-1).

[21] Accordingly, I am satisfied that the Owner displayed the Mark in the advertising and performance of “legal services” during the relevant period in Canada.

DISPOSITION

[22] Having regard to the aforementioned, 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.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE No Hearing Held

AGENTS OF RECORD

Beacon Law Corporation

FOR THE REGISTERED OWNER

Nelligan O'Brien Payne LLP

FOR THE REQUESTING PARTY