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

**Citation: 2017 TMOB 182**

**Date of Decision: 2017-12-27**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Legault Joly Thiffault LLP**

**Requesting Party**

**and**

**Information Builders, Inc.**

**Registered Owner**

**TMA523,347 for FOCUS**

**Registration**

[1] At the request of Legault Joly Thiffault 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 January 13, 2016 to Information Builders, Inc. (the Owner), the registered owner of registration No. TMA523,347 for the trade-mark FOCUS (the Mark).

[2] The Mark is registered for use in association with the following goods: “Computer software and programs for data base management for permitting web access to information stored in a main frame computer.”

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with the goods specified in the registration, at any time between January 13, 2013 and January 13, 2016. If the Mark had not been so used, the Owner 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” in association with goods is set out in section 4(1) of the Act as follows:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person 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. 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].

[6] In response to the Registrar’s notice, the Owner furnished the affidavit of its President and Chief Operating Officer, Gerald D. Cohen, sworn on April 4, 2016, in New York, NY. Only the Owner filed written representations and was represented at an oral hearing.

#### THE OWNER’S EVIDENCE

[7] In his affidavit, Mr. Cohen states that the Owner does business in Canada through its wholly-owned subsidiary Information Builders (Canada) Inc. (IBI Canada), which is headquartered in Toronto, with offices in multiple Canadian cities. Mr. Cohen explains that IBI Canada is responsible for direct sales, consulting services, marketing, education, and “primary support” for all of the Owner’s products in Canada. Mr. Cohen confirms that the Owner maintains control over the products sold and the services rendered by IBI Canada. Indeed, Mr. Cohen notes that he is also the President and Chief Operating Officer of IBI Canada.

[8] With respect to the registered goods, Mr. Cohen explains that the Owner’s FOCUS software “allows nonprogrammers to enter English-like commands to extract, manipulate, summarize, and display data from disparate database management systems.” He specifies that such data “can reside on remote computers and main frame computers with complete transparency to the user.”

[9] Mr. Cohen attests that the Owner sells such software by granting licences for its use. He explains that, upon purchasing a licence, the customer is provided with one or more “Site Codes” and user accounts for logging into the Technical Support Center section of the Owner’s website. He states that, once a customer logs in, the Technical Support Center’s “download” menu provides a link for “My Downloads and Shipments” and displays the words “FOCUS for Mainframe Service Pack and PTFS”. Mr. Cohen confirms that the software products available on the “My Downloads and Shipments” page are the software products covered by the customer’s licence.

[10] In support, Mr. Cohen attaches the following exhibits to his affidavit:

- Exhibit A contains two company profiles for IBI Canada printed from Innovation, Science and Economic Development Canada’s website. I note that the first profile lists Mr. Cohen as a director of the company, while the second describes the FOCUS software, promoting it as “the enterprise standard for host-based reporting and mission-critical decision support applications at thousands of the world’s leading corporations, institutions and government agencies” and as “application development and reporting tools [that] provide maximum functionality for non-technical business managers to business analyst/power users to professional developers”.
- Exhibit C contains five riders to “Master Software License” agreements between the Owner as the Licensor, IBI Canada as a “Representative”, and a Canadian business, institution or government body as the Licensee. Each rider agreement is dated during the relevant period and grants a licence from the Owner to use one or more FOCUS software products. For example, one of the riders grants a licence to use the “Mainframe FOCUS Basic Reporting Gold” software, which includes the “Database Management Bundle” comprising “FOCUS Transaction Processor”, “FOCUS DBMS Server” and “FOCUS Host Language Interface” software products.

I note that two of the riders are substantively identical but dated one year apart; the second rider appears to be a renewal of the licence granted in the first. The “Agreement No” referenced in these two riders corresponds to the Licensee’s site code, as shown at Exhibit E (discussed below).

- Exhibit D contains “a small random sampling” of invoices from IBI Canada for software licence fees. Included in the exhibit are over a dozen invoices dated during the relevant period and addressed to various customers located in Canada. Each such invoice covers at least one FOCUS product, for example, “IBI - Focus System License”, “FOCUS UNIX Subscription”, “FOCUS Mainframe”, “STAT - FOCUS STATISTICAL ANALYSIS PACKAGE” or “HLI - FOCUS HOST LANGUAGE INTERFACE”.
- Exhibit E contains three screen captures from the Owner’s website. The first depicts the “Technical Support Center webpage”; the Mark appears beside “Technical Content” and “Focal Point Forums” at the bottom of the webpage. The second screen capture provides an expanded view of the webpage’s “Download” drop down menu, where the menu items “My Downloads and Shipments” and “FOCUS for Mainframe Service Packs and PTFS” appear. Mr. Cohen identifies the third screen capture as the “My Downloads and Shipments page”. The depicted portion of the webpage is titled “Licensed Software” and provides various particulars for one of the Canadian licensees, along with links and information relating to download and installation. The Mark appears on the webpage as a heading under the licensee’s “Sitecode”, and also in the text under that heading, for example, in references to certain “FOCUS releases” and to the “FOCUS for Mainframe zOS Installation Guide”.

[11] Mr. Cohen attests that the Owner’s sales of FOCUS software in Canada were in the order of \$2 million annually during the relevant period.

#### ANALYSIS

[12] Mr. Cohen asserts use of the Mark in association with the registered goods by way of the Owner granting licences to Canadian customers to use downloadable “FOCUS software”.

[13] Having regard to Mr. Cohen’s description of the licensed software and to the product descriptions in the riders at Exhibit C, I accept that the licensed software corresponds to the registered goods.

[14] The sale of a licence to use software is akin to the leasing of goods, which amounts to a transfer of goods in the normal course of trade [see *Stikeman Elliott LLP v 9105-8503 Québec*

*Inc*, 2014 TMOB 95, 2014 CarswellNat 2845]. In the present case, as noted above, the Owner furnished evidence of several licences for FOCUS software granted during the relevant period to customers located in Canada.

[15] With respect to display of the Mark, 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 its trade-mark with such software goods [see also *Fasken Martineau DuMoulin LLP v Open Solutions DTS Inc*, 2013 TMOB 68, 2013 CarswellNat 1684; and *Clark Wilson LLP v Genesistems, Inc*, 2014 TMOB 64, 2014 CarswellNat 1392]. Accordingly, the type of evidence that will suffice to show a trade-mark's association with computer software will vary from case to case.

[16] In this case, as demonstrated at Exhibit C, the Mark was displayed in the product listings of the riders that customers signed to receive their software licence, and the notice of association continued with the Mark's display on the website menu and specific webpage used to download the software, as shown at Exhibit E. In addition, the Mark was displayed in the body of invoices sent to purchasers of the software, as shown at Exhibit D.

[17] Although the exhibited invoices were issued by IBI Canada, the Owner argued at the hearing that IBI Canada was merely acting as the Owner's agent in this respect. The Owner drew attention to the riders at Exhibit C, which indicate that licences to use the software are granted by the Owner itself, with IBI Canada acting as a "Representative". In the circumstances, I accept that the invoices in his case were issued on the Owner's behalf. Accordingly, evidence of IBI Canada having a licence to use the Mark under the Owner's control—per section 50(1) of the Act—is neither necessary nor applicable [for a similar finding, see *Davis LLP v 819805 Alberta Ltd*, 2016 TMOB 64, 2016 CarswellNat 1612].

[18] In sum, I am satisfied that the requisite notice of association between the Mark and the registered goods was given by the Owner in accordance with section 4(1) of the Act, beginning with the Mark's display on the licence documents signed by Canadian purchasers, and continuing with its display on-screen at the time of download, and on invoices at the time of billing.

DISPOSITION

[19] In view of all the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods within the meaning of sections 4(1) and 45 of the Act.

[20] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration 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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**HEARING DATE** 2017-10-12

**APPEARANCES**

Amy M. Thomas

FOR THE REGISTERED OWNER

No one appearing

FOR THE REQUESTING PARTY

**AGENTS OF RECORD**

Moffat & Co.

FOR THE REGISTERED OWNER

Legault Joly Thiffault S.E.N.C.R.L.

FOR THE REQUESTING PARTY