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

Citation: 2017 TMOB 171

Date of Decision: 2017-12-15

IN THE MATTER OF A SECTION 45 PROCEEDING

**True Ultimate Standards Everywhere,
Inc. AKA TRUSTe**

Requesting Party

and

Everlink Payment Services Inc.

Registered Owner

TMA804,637 for E DESIGN

Registration

[1] At the request of True Ultimate Standards Everywhere, Inc. AKA TRUSTe (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 July 28, 2015 to Everlink Payment Services Inc. (the Owner), the registered owner of registration No. TMA804,637 for the trade-mark E DESIGN (the Mark), shown below:



[2] The Mark is registered in association with the following services:

(1) Providing electronic financial transactions switching services, namely transaction switching and routing services, issuer financial authorization services, PIN-activated debit processing services, payment card (signature debit) processing services, settlement

services, reconciliation and dispute processing services, access to foreign networks (gateway) services.

(2) Providing electronic financial transactions services, namely, ATM terminal driving services, ATM monitoring services and card management services.

(3) Providing electronic financial transactions services, namely, conversion planning and implementation services.

[3] 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 the 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 it was last in use and the reason for the absence of use since that date. In this case, the relevant period for showing use is between July 28, 2012 and July 28 2015.

[4] The relevant definition of “use” is set out in section 4(2) of the Act as follows:

(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 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].

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

[7] In response to the Registrar’s notice, the Owner furnished the affidavit of Mark Ripplinger, President and CEO of the Owner, sworn on February 22, 2016 in Markham, Ontario. Both parties filed written representations, but only the Owner was represented at an oral hearing held on November 27, 2017.

THE OWNER'S EVIDENCE

[8] In his affidavit, Mr. Ripplinger attests that the Owner is “a provider of payment solutions and services for credit unions, banks, independent sales organizations (ISO, ATM and POS financial service providers) and merchants across Canada”. He attests that, in association with the Mark, the Owner promotes the registered services to such customers through various means.

[9] Attached as Exhibit C to his affidavit is a list of the Owner's clients that Mr. Ripplinger attests received advertising and promotional materials from the Owner during the relevant period. He attests that such materials are circulated through emails, the Owner's *Connector* newsletter and press releases, all of which depict the Mark as registered. Mr. Ripplinger also provides a list of the various tradeshows and conferences where representatives of the Owner attended to promote the Owner's services during the relevant period in Canada.

[10] In support, attached as Exhibit D are numerous examples of the Owner's emails, newsletters and press releases which Mr. Ripplinger attests were used to promote the registered services in Canada during the relevant period. For example, the exhibit includes a press release dated January 20, 2015 which describes the Owner's “IQ INSTA Prepaid Interac Debit card [that] can be used for secure CHIP and PIN transactions in Canada at any Interac accepting POS terminal or ATM.”

[11] Mr. Ripplinger also attaches copies of advertisements published in the *Payments Business* magazine (Exhibit E), screenshots from the Owner's website (Exhibit F), screenshots from the Owner's social media accounts (Exhibit G) and photographs of signage from around the Owner's office and building (Exhibit H). Each of these exhibits displays the Mark, and Mr. Ripplinger attests that they are examples of such display during the relevant period.

[12] Lastly, Exhibit I consists of copies of multi-page presentations that Mr. Ripplinger attests were given to the Owner's customers during the relevant period. The presentations are entitled *Delivering Payment Innovations*, *Corporate Profile 2014*, and *Corporate Profile 2015*. The Mark appears throughout the presentations.

ANALYSIS

[13] In its brief written representations, the Requesting Party submits that i) the evidence does not show use of the Mark in association with *each* of the registered services and ii) that there is no evidence that any of the services were actually available “in the ordinary course of trade”.

[14] However, as noted by the Owner in its representations, there is no requirement that the evidence needs to show actual performance of the services. In any event, Mr. Ripplinger speaks to the Owner’s Canadian clients and, at a minimum, I accept that each of the registered services were offered in association with the Mark and available to be performed in Canada during the relevant period.

[15] In this respect, in reviewing the exhibited material, I am able to identify references to each of the registered services, as indicated below. While some of the registered services necessarily overlap with other services, I am nonetheless able to identify advertisement of each of the services as articulated in the registration. As such, I do not consider it necessary to decide whether, for example, performance of “settlement services” also constitutes “reconciliation and dispute processing services”, as both are referenced in the exhibited presentations.

[16] With respect to services (1), at a minimum, the services are advertised in the exhibited materials as follows: “transaction switching and routing services” (Exhibit D, October 23, 2012 newsletter); “issuer financial authorization services” (Exhibit I, *Corporate Profile 2014* presentation at page 6); “PIN-activated debit processing services” (Exhibit D, January 20, 2015 press release and Exhibit I, *Delivering Payment Innovations* presentation at page 22); “payment card (signature debit) processing services” (Exhibit I, *Corporate Profile 2014* presentation at page 24); “settlement services” (Exhibit I, *Delivering Payment Innovations* presentation at pages 24-25), “reconciliation and dispute processing services” (Exhibit I, *Delivering Payment Innovations* presentation at pages 24-25); and access to foreign networks (gateway) services (Exhibit I, *Delivering Payment Innovations* presentation at page 20).

[17] With respect to services (2), “Providing electronic financial transactions services, namely, ATM terminal driving services, ATM monitoring services and card management

services”, at a minimum, all such services are advertised in the *Delivering Payment Innovations* presentation at page 20 in Exhibit I.

[18] Finally, with respect to services (3), “conversion planning and implementation services”, such services are advertised in the *Corporate Profile 2014* presentation at page 34 in Exhibit I.

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

DISPOSITION

[20] 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 registration will be maintained.

Andrew Bene
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: 2017-11-27

APPEARANCES

Simon Hitchens	For the Registered Owner
No one appearing	For the Requesting Party

AGENTS OF RECORD

Fasken Martineau Dumoulin LLP	For the Registered Owner
Moffat & Co.	For the Requesting Party