



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

Citation: 2018 TMOB 131

Date of Decision: 2018-10-31

IN THE MATTER OF A SECTION 45 PROCEEDING

**MLT Aikins LLP (formerly
MacPherson Leslie & Tyerman LLP)**

Requesting Party

and

Ben Inc.

Registered Owner

TMA620,306 for I-Farm

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA620,306 for the trade-mark I-Farm (the Mark), owned by Ben Inc.

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

Creation, production of farming, ranching, and agriculture related information and programs; video production services; and operation of a website designed to host and promote farming, ranching, and agriculture issues. Dissemination of farming, ranching, and agriculture information and programs via an on-line communication network. Advertising services, namely the dissemination of advertising for others via an on-line communication network.

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

THE PROCEEDINGS

[4] On March 18, 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 Ben Inc. (the Owner). The notice was sent at the request of MacPherson Leslie & Tyerman LLP, now MLT Aikins LLP (the Requesting Party).

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between March 16, 2013 and March 16, 2016, in association with each of the services specified in the registration. If the Mark had not been so used, the 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] The relevant definitions of use are 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.

[7] 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].

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Ben Van Dyk, sworn October 17, 2016, together with Exhibits A through I.

[9] Both parties filed written submissions and attended an oral hearing in the matter.

THE EVIDENCE

[10] Mr. Van Dyk is the President of the Owner. He explains that he is a realtor and has built his business based on the marketing and promotion of residential, commercial and agricultural real estate.

[11] Mr. Van Dyk states that on April 30, 2002 and December 10, 2003 respectively, the Owner obtained registrations for the domain names *www.i-farm.ca* and *www.ifarm.ca*. (see copies of registration information for both domains under Exhibit A), through which the Owner has since been promoting various real estate, farming and agricultural services.

[12] Mr. Van Dyk then states that the Owner has used the Mark during the relevant period in association with the registered services. In support, he provides the following:

Exhibit B – a photograph of two DVD’s bearing the Mark, that Mr. Van Dyk states contain programming and content associated with agricultural initiatives and issues in and around southern Alberta and Saskatchewan. He attests that much of this programming was televised on Global or CTV (Lethbridge affiliate) until at least January 6, 2014.

Exhibit C – a screenshot from an internet archive that Mr. Van Dyk attests reflects December 17, 2014 as the date the same content and programming (as in Exh. B) was removed from the Owner’s websites due to cost.

Exhibit D – a copy of the homepage of the YouTube channel called “Farmrealestate” that the Owner launched on September 7, 2016. He explains that in the upper left corner there is reference to “Powered by I-Farm”, shown to reflect that the video production services are supplied by I-Farm. He then states the following:

Notwithstanding that the dates of the initiation and launch of the YouTube channel are subsequent to the date of the section 45 notice, I can advise that the concept of presenting online farming and agricultural videos remained an initiative of the Owner from the date the television programming ceased and the *i-farm.ca* and *ifarm.ca* websites had the content removed and not a reaction in response to the section 45 proceedings notice.

Mr. Van Dyk then states that with respect to advertising services, the Owner promoted its services in segments during farming programming television broadcasts on Global TV and CTV channels as well as sold a portion of its allotted advertising time to others.

Exhibit E – images of DVDs and DVD content displaying the Mark made available to others at trade-shows which took place during the relevant period. Titles of DVDs include, among others, “Farm Equipment Video” and “Bison Ranch”.

Exhibit F – pictures of promotional materials that Mr. Van Dyk attests were shown to attendees of trade-shows during the relevant period relating to the *ifarm.ca* website. The advertisements include a stylized version of the domain name in which the Mark is

dominant element as well as the phrases “i-Farm™ at your fingertips”, and “i-Farm™ is your online hub for farming”.

Exhibit G – a copy of the *ifarm.ca* website as it was on March 18, 2016. He states that additional real estate related information and content has since been added to the site. The page shown includes the same stylized version of the domain name as in Exhibit F and the text “i-Farm™ is your online hub for farming real estate” and “i-Farm™ is your resource for farming real estate, and to build your professional network of farming resources.”

Exhibit I – Mr. Van Dyk states that the Owner now offers farmers, ranchers and others involved in the agriculture industry the opportunity to obtain email addresses using the *ifarm.ca* and *i-farm.ca* domain names. He states that this exhibit contains examples of the opportunities being made available to interested individuals. It appears to be a website printout – the page includes the following “own a piece of i-farm.ca with a customized email address. _____@i-farm.ca.”

ANALYSIS AND REASONS FOR DECISION

[13] The Requesting Party submits that the evidence contained in Mr. Van Dyk’s affidavit is ambiguous, pertains to services that are not provided for the benefit of others, and fails to show any use of the Mark by the Owner during the relevant period in association with the *registered* services per section 4(2).

[14] To begin with, the Requesting Party submits that the evidence regarding domain name registration does not constitute use of a trade-mark for the purposes of section 4 of the Act.

[15] The Owner submits however, that its evidence goes beyond mere domain name registration as its evidence provides examples of marketing materials directing the public to its website at trade-shows. The Owner notes its registered services include the operation of a website, and the dissemination of information, programming, and advertising services for others via an on-line communication network. Further to this, the Owner submits that domain names incorporating a trade-mark substantially similar to a registered mark have supported a finding of use with respect to similar services [citing *Advance Magazine Publishers, Inc v Interpersonal Connections Inc*, 2007 CanLII 80979 (CA TMOB)].

[16] The Requesting Party questions this evidence, however, as it submits that the materials in these exhibits (Exhibits E and F) consist only of photographs of DVDs and promotional material

which includes the statement “I-FARM at your fingertips” with a photograph of an electronic handheld device. The Requesting Party submits that it is impossible identify the nature of the services from these photographs. Furthermore, the Requesting Party submits that as Mr. Van Dyk refers to promotion of real estate services throughout his affidavit, it is likely that any use of the Mark in these materials is in association with the promotion of real estate services which not within the scope of the registered services.

[17] In a similar vein, the Requesting Party submits that the Exhibit B photographs of DVDs, the Exhibit C screenshot from the Owner’s website, and the Exhibit D YouTube screenshot do not show use of the Mark in association with the *registered* services. To expand, the Requesting Party submits that despite Mr. Van Dyk’s attestations regarding the content of the programming on the DVDs and the website, the evidence is not supportive. The Requesting Party submits that the Owner has not provided viewership data, and the website merely displays the wording “@ifarm.ca. Own it today” which constitutes retail of an email domain extension, and is not use of the Mark in association with the *registered* services [citing *McMillan LLP v SportsLine.com, Inc*, 2014 TMOB 51]. Lastly, the Requesting Party submits that the Exhibit D YouTube screenshot is not dated within the relevant period and, in any event, the videos posted on the YouTube channel are for the purposes of promoting the Owner’s real estate listings which, once again, is not within the scope of the registered services.

[18] The Owner submits that the photographs of the DVDs in evidence are clearly labelled with the Mark and the farming, ranching, and agriculture related information, and programming contained therein. Furthermore, the Owner submits that such DVDs are the physical results of video production such that the DVDs are evidence that the Owner has performed “creation, production of farming, ranching, and agriculture related information and programs; video production services.”

[19] I agree with the Owner that such evidence constitutes use of the Mark in association with “creation, production of farming, ranching, and agriculture related information and programs”. Mr. Van Dyk makes clear attestations in this regard, and the labels on the DVDs reflect such content. Furthermore, even if the content relates to real estate, I would consider this to fall within the realm of such services [see *Venice Simplon-Orient Express Inc v Societe nationale des*

Chemins de fer francis (2000), 9 CPR (4th) 443 (FCA). However, I agree with the Requesting Party that there is no evidence that the Owner performs video production services for others.

[20] With respect to the services “operation of a website designed to host and promote farming, ranching, and agriculture issues. Dissemination of farming, ranching, and agriculture information and programs via an on-line communication network” I also accept that the Owner has demonstrated use of the Mark in association with these services. The Mark is clearly on the Owner’s website. Furthermore, as the screenshots in evidence include text such as “your online hub for farming real estate”, and “i-Farm™ is your resource for farming real estate, and to build your professional network of farming resources” I accept, having regard to the evidence as a whole, that such evidence encompasses the above-noted services.

[21] The Requesting Party submits that the Owner does not provide advertising services for the benefit of others, and has not provided any evidence to confirm use of the Mark in association with such services. The Requesting Party submits that the advertising in the evidence is only for the benefit of the Owner’s real estate business, not for the benefit of the public and therefore, not considered use within the meaning of section 4(2) of the Act [citing *Ralston Purina Co v Effem Foods Ltd* (1997), 81 CPR (3d) 528 (TMOB) at 534].

[22] I agree with the Requesting Party that there is nothing in the evidence to support that the Owner provides advertising services for others in association with the Mark. In this regard, the only reference to such services in the affidavit is Mr. Van Dyk’s bald statement that the Owner “had the opportunity to promote its services in segments during the [television] broadcast or to sell a portion of its allotted advertising time to others and [the Owner] did both under the I-Farm trademark”. Furthermore, in *Advance Magazine Publishers, supra* relied upon by the Owner is clearly distinguishable in that the services in question did not include advertising services.

[23] Having regard to the aforementioned, I am satisfied that the Owner has demonstrated use of the Mark in association with the following services pursuant to sections 4(2) and 45 of the Act:

Creation, production of farming, ranching, and agriculture related information and programs; [...]; and operation of a website designed to host and promote farming,

ranching, and agriculture issues. Dissemination of farming, ranching, and agriculture information and programs via an on-line communication network. [...]

DISPOSITION

[24] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the services “video production services” and “advertising services, namely the dissemination of advertising for others via an on-line communication network” in compliance with the provisions of section 45 of the Act.

[25] The amended statement of services will now read as follows:

Creation, production of farming, ranching, and agriculture related information and programs; [...]; and operation of a website designed to host and promote farming, ranching, and agriculture issues. Dissemination of farming, ranching, and agriculture information and programs via an on-line communication network. [...]

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 June 7, 2018

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