



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

Citation: 2018 TMOB 143

Date of Decision: 2018-11-20

IN THE MATTER OF A SECTION 45 PROCEEDING

Aird & Berlis LLP

Requesting Party

and

K W Johnston Real Estate Ltd.

Registered Owner

TMA870,363 for LIV REAL ESTATE

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA870,363 for the trade-mark LIV REAL ESTATE (the Mark), owned by K W Johnston Real Estate Ltd.

[2] The Mark is currently registered in association with the services, “real estate services; real estate brokerage services; and consulting services in the field of real estate”.

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

THE PROCEEDINGS

[4] On February 17, 2017, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to K W Johnston Real Estate Ltd. (the Owner). The notice was sent at the request of Aird & Berlis 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 February 17, 2014 and February 17, 2017, 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 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.

[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]. While “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at para 3], sufficient facts must nevertheless be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the registered services.

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Sheldon Johnston, the Director of the Owner, sworn September 13, 2017, together with Exhibits A to R.

[9] Only the Owner filed written submissions. An oral hearing was not requested.

THE EVIDENCE

[10] Mr. Johnston attests that the Owner has carried on business under the Liv Real Estate trade-name and has used the Mark as both a stylized and non-stylized word mark during the

relevant period in association with each of the registered services. The stylized versions used are depicted below:



[11] More specifically, Mr. Johnston attests that during the relevant period, the Owner advertised its registered services in Canada in association with the Mark on websites, brochures, billboards, and social media pages.

[12] With respect to the websites, Mr. Johnston indicates that during the relevant period, the Owner operated three websites: *www.livrealstate.ca*; *www.edmontonrealstate.pro*; and *www.edmontonrealstateblog.com*, with each website prominently displaying a stylized version of the Mark (as above) in the upper left-hand corner of the first page. He explains that the Owner used the *www.livrealstate.ca* and *www.edmontonrealstate.pro* websites to advertise its services to client and potential clients, while the *www.edmontonrealstateblog.com* site was used to build the Owner's brand by providing information and updates about the real estate market to clients, potential clients, and agents.

[13] In support, Mr. Johnston attaches as Exhibits B to G of his affidavit, website screen shots clearly displaying the Mark (in stylized and non-stylized forms), Google Analytics reports showing significant Canadian traffic to the respective websites during the relevant period, and printouts from the Wayback Machine, an Internet archive, which shows the appearance of the respective websites during the relevant period. A stylized version of the Mark clearly appears on the Wayback Machine printouts of the Owner's respective websites, and Mr. Johnston further attests that the printouts are an accurate and reliable representation of how those websites appeared during the relevant period. The websites *www.livrealstate.ca* and *www.edmontonrealstate.pro* provide information about the Owner and its services, listings of properties for sale, resource information for buyers, and realtor/agent information and related content.

[14] Further to the above, Mr. Johnston provides, as Exhibit H to his affidavit, brochures featuring properties for sale, which he attests roughly 4,820 were distributed in Canada to

potential buyers during the relevant period. Mr. Johnston also provides as Exhibits I, J, and K, photographs of billboard advertisements, and screenshots of the Owner's Facebook and YouTube pages, all of which were displayed during the relevant period and advertised and promoted the Owner's real estate and real estate brokerage services. As with the Owner's websites, the brochures, billboards, Facebook and YouTube pages display a stylized version of the Mark.

[15] Mr. Johnston then indicates that the Owner used the Mark in both the advertising and the performance of consulting services in the field of real estate through the distribution of brochures and emails to clients. In support, he attaches, as Exhibit N to his affidavit, copies of brochures displaying a stylized version of the Mark, advertising real estate marketing consulting services. He states that these brochures were provided to clients when negotiating Seller Representation Agreements. He further attaches as Exhibits P, Q, and R, copies of emails sent to clients and potential clients containing marketing options, proposals and status updates. He attests that the Mark appears in the signature of the email and in the attachments sent to the prospective client.

[16] Lastly, Mr. Johnston states that the Owner used the Mark in the performance of real estate services and real estate brokerage services. In support, he provides as Exhibits L, M, and O, Buyer/Seller Representation Agreements and real estate Purchase Contracts executed in Canada during the relevant period.

ANALYSIS AND REASONS FOR DECISION

[17] The Owner submits, and I agree, that the Johnston affidavit demonstrates that the Mark was displayed in the advertising and performance of each the Owner's services in Canada during the relevant period.

[18] Specifically, the Owner has provided evidence of use of the Mark on its three websites during the relevant period to advertise its services in Canada. The Google Analytics reports demonstrate that the websites were visited by a substantial number of Canadians during the relevant period.

[19] Additionally, the Owner has provided brochures, billboards, social media pages, and client emails displaying the Mark in association with each of the registered services during the

relevant period. The evidence shows that thousands of the aforementioned brochures and emails were distributed during the relevant period in Canada, and that the social media pages were visited/viewed by many Canadians as well.

[20] Lastly, the Owner has provided brokerage and purchase agreements executed by the Owner for Canadian clients during the relevant period, which demonstrate that the Owner performed real estate and real estate brokerage services in Canada. Further to this, client emails displaying the Mark demonstrate that consulting services in the field of real estate were performed in Canada during the relevant period.

[21] While the Owner's evidence predominantly shows the stylized versions of the Mark, I consider the use of the stylized versions of the Mark to constitute use of the Mark as registered [*Stikeman, Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 at 395 (TMOB)].

DISPOSITION

[22] Accordingly, 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**

No Hearing Held

AGENTS OF RECORD

RedFrame Law

FOR THE REGISTERED OWNER

Aird & Berlis LLP

FOR THE REQUESTING PARTY