



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

Citation: 2018 TMOB 148
Date of Decision: 2018-11-30
[UNREVISED ENGLISH
CERTIFIED TRANSLATION]

IN THE MATTER OF A SECTION 45 PROCEEDING

Smart & Biggar

Requesting Party

and

ESC Corporate Services Ltd.

Registered Owner

TMA709,582 pour
CPI-IPC VOS EXPERTS EN
MARQUES DE COMMERCE
YOUR TRADE-MARK EXPERTS

Registration

[1] On May 13, 2016, at the request of Smart & Biggar (the Requesting Party), the Registrar sent the notice stipulated in section 45 of the *Trade-marks Act*, RSC 1985, c. T-13 (the Act) to ESC Corporate Services Ltd. (the Owner), the registered owner of registration no. TMA709,582 for the trade-mark CPI-IPC VOS EXPERTS EN MARQUES DE COMMERCE YOUR TRADE-MARK EXPERTS (the Mark).

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

Printed and electronic publication namely, bulletin.

(the Goods)

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

Providing services in the area of intellectual property namely: performing trade-mark clearance and registrability searches from various databases, performing trade-mark watching and surveillance services, providing corporate and business name searches, prior use investigation services, filing formal documents for registration of trade-marks or copyrights; obtaining copies of official documents relating to trade-marks, copyrights, industrial designs and patents; providing domain name searches; trade-mark agent consulting services. Operation of a website containing information to intellectual property.

(the Services).

[4] This notice enjoined the Owner to provide an affidavit or a statutory declaration proving that its Mark was used in association with each of the Goods and Services in Canada at any time between May 13, 2013 and May 13, 2016, and, in the negative, indicating the date when the Mark was used for the last time and the reason for its failure to use it since that date.

[5] The relevant definitions of “use” are stated in sections 4(1) and 4(2) 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 to whom the property or possession is transferred.

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.

[6] Concerning services, the presentation of the trade-mark in the advertisement of the services is sufficient to satisfy the requirements of section 4(2) of the Act, from the time the owner of the trade-mark offers and is ready to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[7] It is well established that section 45 of the Act has the object and scope of offering a simple, summary and expeditious procedure to clear “dead wood” from the register. Thus, the level of evidence required to establish the use of the mark is low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270]. The registered owner only has to adduce *prima facie* evidence of the use of the Mark within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184, 90 CPR (4th) 428 at paragr. 2].

[8] In response to the Registrar’s notice, the Owner filed an affidavit made on December 13, 2016 by Pierre Bilodeau, the Managing Director of its Quebec Division. The parties did not file written representations and did not request a hearing.

THE EVIDENCE

[9] In his affidavit, Mr. Bilodeau declares that the Owner is a national corporate service provider, operating its establishments in Toronto and Montréal since 2009, and also doing business under the names CRAC, C.R.A.C., and CRAC CENTRE DE RECHERCHES ET D’ANALYSES SUR LES CORPORATIONS (hereinafter collectively CRAC). He affirms that the Owner offers [TRANSLATION] “various bilingual search, filing and registration services, as well as accessories, to a clientele composed overall of law firms and legal professionals, corporations and national institutions across Canada, including due diligence services and services in the intellectual property field”.

[10] Concerning the Mark, Mr. Bilodeau explains that between 2011 and May 2014 it was held by D + H Limited Partnership (D + H), which assigned it to the owner on May 9, 2014, as evidenced by the trade-marks register. A copy of the TRANSLATION “confirmation of assignment document” is attached to his affidavit in Exhibit 2. I also find that one of the web pages attached to his affidavit (in Exhibit 4, described below) indicates that CRAC, the Quebec corporate services division of D + H, became a division of the Owner the same day. Mr. Bilodeau confirms that, in May 2014, the Owner indeed acquired the [TRANSLATION] “activities” of this division relating to the Mark.

[11] Mr. Bilodeau admits that the use of the Mark in association with the Goods was discontinued in 2010. However, he affirms that between 2011 and May 9, 2014 D + H used the Mark [TRANSLATION] “uninterruptedly” in association with the Services in the normal course of trade, and that after May 9, 2014, the Owner [TRANSLATION] “made continual efforts to use the Mark in association with all the Services, without interruption to this day”.

[12] To substantiate his allegation of use, Mr. Bilodeau first provides various printed matter and photographs presenting the services offered by the Owner and showing how the Mark was displayed in the advertising of such services during the relevant period. On this basis, the following exhibits are attached to his affidavit:

- Exhibit 3 contains excerpts from the CRAC website at *www.crac.com*, representing the home page, as well as those explaining [TRANSLATION] “some of the services offered under the Mark in the intellectual property field”. Indeed, all the Services are promoted there. Moreover, it includes information concerning intellectual property: in particular the web page entitled [TRANSLATION] “Relevant links and FAQ” provides various information on this subject/ However, the Mark does not appear in the excerpts produced. In addition, the printing date of the excerpts is not indicated.
- Exhibit 4 contains excerpts from the *www.crac.com* website dated between June 2013 and April 2016, obtained with the assistance of the Internet Archive search engine at *www.archive.org*, which retains archives of the appearance of websites over the years. First, Mr. Bilodeau points out that the excerpts include the downloadable versions of a [TRANSLATION] “2013 price list”, which he attests remained in force and available for viewing and downloading during the year 2014. He adds that this price list was also distributed to the clients by email and in person in 2013–2014, during their presence at [TRANSLATION] “conventions and special events promoting the Services in particular”. A French unilingual version of the Mark is shown above the French advertisement of trade-mark search and registration services; an English unilingual version is shown above the same advertisement in English. I note, in particular, that the “COMMERCIALE PLUS” (COMMERCIAL PLUS) service mentioned there uses several databases concerning marks, business names, domain names and computerized directories—and includes the offer of written comments and a verbal report.

- Second, Mr. Bilodeau points out that the archived pages, which are found in Exhibit 4, include the downloadable versions of an advertising brochure relating to the intellectual property services. The brochure is articulated around a theme based on sheep. The Mark is shown on the first and last page. The advertised services include trade-mark availability search, trade-mark watching and surveillance, trade-mark and copyright registration, [TRANSLATION] “due diligence in intellectual property (marks, patents, copyrights and industrial designs)”, ordering official documents, trade-mark agent consulting services, and the website *www.cpi-ipc.com*. Mr. Bilodeau affirms that the advertising brochure was found on this site since at least as early as February 8, 2008, and on the website *www.crac.com* since at least as early as 2009—including between May 2013 and May 2016—for viewing and downloading as a reference tool and as advertising.
- Mr. Bilodeau attests the visitors to the website *www.cpi-ipc.com* have been redirected to *www.crac.com* since at least 2013. Exhibit 5 contains excerpts from the website *www.cpi-ipc.com* dated between May 17, 2014 and February 11, 2015, obtained with the Internet Archive search engine, illustrating this reference.
- Exhibit 6 contains, according to Mr. Bilodeau, [TRANSLATION] “a representative and non-exhaustive sample of promotional items already distributed, including photos of a stuffed toy sheep bearing the Mark, as well as print advertising (brochure and bookmarks) bearing the Mark”. The brochure is a printed version of the above-mentioned downloadable brochure. The four bookmarks exploit the same sheep theme to promote trade-mark protection, with emphasis on availability search and registration. The Mark is shown on each bookmark, as is the address “WWW.CPI-PIC.COM”. Finally, the photographed stuffed sheep toy wears a jersey displaying the Mark above the address “www.cpi-ipc.com”, without other mentions. Mr. Bilodeau attests that this advertising was used in the relevant period.

[13] Mr. Bilodeau enumerates by way of example [TRANSLATION] “some of the conventions, trade shows and other events which [the Owner] participated in or sponsored between 2013 and 2016 and during which the Services were promoted and promotional items

bearing the Mark could have been distributed”. According to this list of fourteen events aimed at lawyers, paralegals and notaries, all were held in Canada during the relevant period.

[14] Concerning the performance of the services, Mr. Bilodeau provides examples of correspondence and a sample of invoices addressed to clients in Canada. These letters, reports and invoices pertain to all the services provided in Canada during the relevant period.

- Exhibit 7 contains two sheets of letterhead and one backing. Each item is in the name of CRAC and bears the Mark. Mr. Bilodeau attests that, during the relevant period, the letterhead was used for correspondence with the clients and the Canadian Intellectual Property Office and the backing for trade-mark and business name search reports.
- Exhibit 8 contains, according to Mr. Bilodeau, [TRANSLATION] “a representative and non-exhaustive sample of copies of correspondence [partially redacted] illustrating how the Services are provided in association with the Mark and [were during the relevant period]”. The exhibit contains dozens of letters, all dated during the relevant period and printed on the same letterhead produced in Exhibit 7. Each letter is addressed either to a Canadian client or to the Canadian Intellectual Property Office. The letters account for the performance of services in the area of trade-mark watching and surveillance, filing formal documents for registration of trade-marks, obtaining official documents relating to trade-marks, and trade-mark agent consulting services.
- Exhibit 8 also includes three search reports on behalf of CRAC, showing the Mark in the signature block, all dated during the relevant period. The reports indicate which databases, sources and search tools were used. These include the federal trade-marks register, enterprise registers, a telephone directory, information sources on domain names, and a search engine for Internet pages.
- Exhibit 9 contains a [TRANSLATION] “representative and non-exhaustive” sample including dozens of copies of invoices (partially redacted) covering the years 2013 to 2016 and showing the sale and performance of various Services for Canadian clients. Most of the invoices indicate that they come from CRAC, and the rest indicate they come from ESC Corporate Services Ltd. The Mark does not appear on the invoices. However, I

note that several of the letters bearing the Mark filed in Exhibit 8 indicate that they include an attached invoice.

[15] Mr. Bilodeau concludes by affirming that the Owner intends to continue to use the Mark and offer all the Services associated with it.

ANALYSIS

[16] The Owner admits from the outset that the Mark was not used in Canada during the relevant period in association with the Goods. Since I have no evidence of such use of the Mark or any evidence of special circumstances justifying the absence of use within the meaning of 45(3) of the Act, the Goods will be deleted from the registration accordingly.

[17] Concerning the Services, such as it appears from the foregoing description, the Owner provided substantial evidence showing its advertising of the Mark in Canada in association with the services contemplated in the registration during the relevant period.

[18] In particular, the brochure bearing the Mark on the first and last page promotes trade-mark availability search, trade-mark and copyright watching and surveillance, ordering official documents and trade-mark agent consulting services. Although the nature of the availability searches is not specified in the brochure, the price list filed in Exhibit 3 indicates that these searches included searches of registered marks, business names, domain names and prior use (in the directories) and that they involve various databases in this regard. Moreover, although the nature of the official documents that can be ordered is not specified in the brochure, it advertises a due diligence service concerning marks, patents, copyrights and industrial designs. I find it reasonable to infer from this that the official documents that can be ordered pertain to the same forms of intellectual property. This advertising also indicates that the Owner was ready to perform the services in Canada during the relevant period.

[19] Mr. Bilodeau attests to the distribution of the brochure and other advertising and gives examples of events during the relevant period when the Services were promoted.

[20] Moreover, the Owner provided evidence indicating that it performed said services in Canada during the relevant period. In particular, the correspondence filed in Exhibit 8—

displaying the Mark in the letterhead—accounts for trade-mark watching and surveillance, filing formal documents for registration of trade-marks, obtaining official documents relating to trade-marks, and trade-mark agent consulting services. The search reports filed in the same exhibit—which displayed the Mark on the backing according to Mr. Bilodeau—account for trade-mark availability searches performed with various databases, including searches of registered trademarks, business names, domain names and previous uses (in the directories and on the Internet). Thus, the correspondence provided serves as additional evidence of use of the Mark in association with such services.

[21] Concerning the operation of a website disseminating information concerning intellectual property, I recognize that the brochure, the bookmarks and the stuffed toy sheep shown in Exhibit 6 all promote the website *www.cpi-ipc.com*. Indeed, the Mark and this address are the only things mentioned on the stuffed toy sheet. However, the Internet page entitled [TRANSLATION] “Relevant links and FAQ”, as shown in Exhibit 3, provides various information concerning intellectual property. Although the excerpt from this page is not dated, a link to a page of the same name appears in the excerpts from *www.cpi-ipc.com* (referring to *www.crac.com*) in Exhibit 5, and these excerpts date from the relevant period. Moreover, nothing indicates that the content of the page [TRANSLATION] “Relevant links and FAQ” then would have differed substantially from the content shown in Exhibit 3 or that the information provided therein would no longer concern intellectual property.

[22] To sum up, the Owner showed the range of services in the intellectual property field that it offered in Canada during the relevant period in association with the Mark and it provided clear specimens of how the Mark was used during this period in the advertising and performance of these services. Having examined the evidence as a whole, I find that it is sufficient to establish the use of the Mark by the Owner in association with all the Services in Canada during the relevant period.

DECISION

[23] In view of all of the foregoing, I am convinced that the Owner has established the use of the Mark within the meaning of sections 4 and 45 of the Act in association only with the services contemplated by the registration.

[24] Consequently, in exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete the statement of goods in its entirety.

[25] However, the statement of services will be maintained in the register.

Oksana Osadchuk
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Arnold Bennett

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

No Hearing Held

AGENT(S) OF RECORD

Iana Alexova
CRAC – Corporate Research and Analysis Centre /
CRAC – Centre de Recherches et d’Analyses sur les
Corporations

FOR THE REGISTERED OWNER

Smart & Biggar

FOR THE REQUESTING PARTY