



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

Citation: 2018 TMOB 154

Date of Decision: 2018-11-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Promethean Ltd.

Requesting Party

and

Active Network, LLC

Registered Owner

TMA536,881 for CLASS

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA536,881 for the trade-mark CLASS (the Mark), owned by Active Network, LLC.

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

Computer software and instruction manuals sold therewith for use in scheduling and administering classes, activities and events.

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

THE PROCEEDINGS

[4] On March 23, 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 Turfus Management Ltd., the entity recorded as the owner of the registration on the trade-mark register at that time. The notice was sent at the request of Promethean Ltd. (the Requesting Party).

[5] The notice required the registered owner to furnish evidence showing that it had used the Mark in Canada, at any time between March 23, 2013 and March 23, 2016, in association with the goods specified in the registration. If the Mark had not been so used, the registered 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] Subsequent to the issuance of the section 45 notice, documents regarding the assignment of the subject registration from Turfus Management Ltd. to The Active Network, Inc. and then to Active Network LLC., were filed with the Registrar on October 14, 2016. The assignment documents indicate that Active Network LLC acquired the registration on April 30, 2014. The successive assignments, recorded on the register on November 17, 2016, are not at issue in the present proceeding.

[7] The relevant definition of use in the present case 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 to whom the property or possession is transferred.

[8] Section 45 proceedings are considered to be summary and expeditious for clearing the register of non-active trade-marks. The expression “clearing deadwood” has often been used to describe such proceedings [*Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD)]. While it is true that the threshold for establishing use in a section 45 proceeding is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD); *Austin*

Nichols & Co v Cinnabon, Inc (1998), 82 CPR (3d) 513 (FCA)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the registered goods during the relevant period [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270]. Mere statements of use are insufficient to prove use [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[9] In response to the Registrar's notice, the Owner furnished the affidavit of Sheryl Hoskins, sworn October 21, 2016, together with Exhibits A through G.

[10] While only the Requesting Party filed written submissions, both parties attended an oral hearing in the matter.

THE EVIDENCE

[11] Ms. Hoskins is the General Manager, Communities of the Owner. She begins her affidavit by chronicling the transfer of ownership of the Mark from Turfus Management Ltd. to The Active Network, Inc., and then finally to the Owner, attaching supporting evidence in this regard under Exhibits A, B, and C. As previously indicated, the successive assignments of the Mark are not at issue in the present proceeding.

[12] Ms. Hoskins then describes the nature of the Owner's business being that of a provider of class, event, and activity registration and management software for managing races, recreation, outdoor activities, camps, ski and attraction venues, sports and athletics and schools. She attests that the Owner sometimes promotes its products and services in association with the terms "Active Community Solutions" or "Active Communities" to designate itself or its program of supplying event-related software to users. She further attests that the Owner has licensed its subsidiary, The Active Network, Ltd. to distribute the Owner's products, including the CLASS software.

[13] Ms. Hoskins attests that the CLASS software sold in Canada is delivered by download from the Owner's servers, and that when it is run, the Mark appears on the user's screen.

[14] With respect to use of the Mark during the relevant period, Ms. Hoskins identifies the YMCA-YWCA of Vancouver Island as one of the Owner's customers of its CLASS software. She explains that the Owner sometimes issues updated versions of its CLASS software, which existing customers can download and that one such updated version was downloaded together with its associated manual by the YMCA-YWCA of Vancouver Island sometime between November 4, 2015 and March 14, 2016.

[15] In support of the aforementioned, Ms. Hoskin attaches the following to her affidavit:

- Exhibit D – an email thread between the Owner and the YMCA-YWCA between November 4, 2015 and November 6, 2016 discussing the upgrade of the CLASS software and detailing the preparation and download protocols for version 8.
- Exhibit E - an email dated March 10, 2016 confirming the upgrade service associated with version 8 of the CLASS software that was downloaded by the YMCA-YWC, which went live on March 14, 2016.
- Exhibit F – 2 screenshots from the version 8 CLASS software downloaded by the YMCA-YWCA.
- Exhibit G – select pages from the CLASS software associated manual that display the Mark and that were downloaded by the YMCA-YWCA.

ANALYSIS AND REASONS FOR DECISION

[16] The Requesting Party submits that the Owner has failed to show that there was the requisite transfer of the registered goods in Canada during the relevant period as there is no evidence that shows any sale or transfer of the goods.

[17] More specifically, the Requesting Party submits that the Exhibit D emails discuss a *potential* software upgrade, and the emails make it clear that no download/transfer of the software has taken place as of the date of these emails. Further to this, the Requesting Party submits that the Exhibit E email includes the subject title “confirmation of remote services”, makes no mention of software already downloaded, and is with respect to arranging remote services to be performed at some point in the future. Thus, the Requesting Party submits that the evidence pertains to the provision of a service and not goods.

[18] In addition, the Requesting Party points to what it deems are several inconsistencies and/or ambiguities in the affidavit with respect to dates of the download of CLASS software, etc. To begin with, the Requesting Party submits that Ms. Hoskins only makes a vague assertion that

the software was downloaded sometime “between 4 November 2015 and 14 March 2016” without further support or an explanation as to why the Owner could not say with any precision when the software was downloaded or sold during the relevant period. Furthermore, the Requesting Party submits, the Exhibit E email sent on March 10, 2016 includes a proposed schedule for services that pre-date the date of the email, without any explanation. Lastly, the Requesting Party submits that Ms. Hoskins assertion that the YMCA-YWCA’s software went live on March 14, 2016 is a bald statement that is unsupported by any evidence.

[19] The Owner, on the other hand, submits that the evidence shows that the YMCA-YWCA downloaded the CLASS software which went live on March 14, 2016 when the YMCA-YWCA upgraded the software. In this respect, the Owner submits that there is a sworn statement from Ms. Hoskins confirming that the software went live on March 14, 2016. Further to this, the Owner submits that the download of the software is a “transfer” of property or possession of the goods and the Exhibit E email pertains to an upgrade service that goes with the download of the goods. As for any ambiguities in the evidence, the Owner submits that it is clear that the upgrade of software was done during the relevant period, and the Mark clearly appears on the screenshots taken from the upgraded version of the CLASS software as well as the software manual that accompanied the upgrade that went live on March 14, 2016 (Exhibits F and G).

[20] I agree with the Owner. Ms. Hoskins has provided specific details pertaining to an upgrade of the Owner’s CLASS software during the relevant period for an existing customer. The evidence shows that the Mark is associated with the goods as it clearly appears on the software upon download (Exhibit F) and the associated manual from the download of the software (Exhibit G) [see *BMB Compuscience Canada Ltd v Bramalea Ltd* (1988), 22 CPR (3d) 561 (FCTD)]. Furthermore, Ms. Hoskins has attested that upgrades are provided to existing customers, in this case the YMCA-YWCA of Vancouver Island, that went live on March 14, 2016 [see *Rubicon Corp v Comalog Inc* (1990), 33 CPR (3d) 58 (TMOB) regarding sworn statements of fact]. The evidence is not contradictory in this regard that a transfer in the software took place. Furthermore, although the upgrade for the software employs a service in assisting a customer with obtaining an updated version of the software, it is nonetheless still software that has been provided, which is a good.

DISPOSITION

[21] Having regard to the aforementioned, 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**

HEARING DATE July 10, 2018

APPEARANCES

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FOR THE REGISTERED OWNER

Michael O’Neil

FOR THE REQUESTING PARTY

AGENTS OF RECORD

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FOR THE REGISTERED OWNER

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