



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

Citation: 2019 TMOB 8

Date of Decision: 2019-01-29

IN THE MATTER OF A SECTION 45 PROCEEDING

Miller Thomson

Requesting Party

and

Thinklab Consulting Inc.

Registered Owner

TMA843,681 for THINKLAB

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA843,681 for the trade-mark THINKLAB (the Mark), owned by Thinklab Consulting Inc.

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

(1) Consulting services, namely consulting services for for-profit and non-profit organizations with respect to project management, strategic management, operations management and knowledge management.

(2) Educational services in the field of organization management and strategy for for-profit and non-profit organizations; educational services in the field of public relations; educational services in the field of law.

(3) Government relations services, namely advising and assisting others with respect to interactions with government bodies and government representatives.

(4) Public relations services.

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

THE PROCEEDINGS

[4] On August 16, 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 Thinklab Consulting Inc. (the Owner). The notice was sent at the request of Miller Thomson 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 August 16, 2013 and August 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 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. 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] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)]. Nevertheless, sufficient facts must still 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 Michael Litchfield, the Managing Director of the Owner, sworn May 3, 2017, together with Exhibits A to K.

[9] Both parties filed written representations. However, an oral hearing was not requested.

THE EVIDENCE

[10] As Exhibits A to D of his affidavit, Mr. Litchfield attaches screenshots of archived webpages which, he states, show the Owner’s website as it appeared during the relevant period. Each of these pages display the Mark prominently on the top left hand side as part of the company logo, which appears as follows:



[11] Mr. Litchfield states that the services listed in paragraphs (1) and (2) of the registration are advertised in the “Home”, “Services”, and “Our People” pages of the Owner’s website, while the services listed in paragraphs (3) and (4) are inherent in these pages and in the biographies of the Owner’s employees. I note that the “Home” page identified the Owner as a management consulting firm which provides services to a variety of public, private, and not-for-profit entities; that the “Services” page lists four service categories, including strategic management, information management, project management, and education; and that the “Our People” page includes short biographies of three employees, including Mr. Litchfield, and highlights their educational and professional backgrounds.

[12] Mr. Litchfield also attaches copies of four invoices for “Professional Services Rendered”, all dated within the relevant period. These invoices refer to a “Rural Education and Access to Lawyers Initiative”, billed to the Canadian Bar Association; “Workshop Facilitation: Landlord/Tenant Relations”, billed to the British Columbia Non Profit Housing Association;

“Enterprise Risk Management Consulting Services”, billed to St. Michael’s University School; and “Consulting Services”, billed to the British Columbia Council of Administrative Tribunals. The Mark appears as part of the company logo on the top left hand corner of each invoice. In addition, he attaches three PowerPoint cover slides entitled “McEwan and Co. Law Corporation: Strategic Planning Day Two”, “The Human Resources Challenges Facing Non Profit Housing Providers: BCNPHA Annual Conference November 23, 2015”, and “Administrative Decision Writing: Michael Litchfield July 15, 2014”. Each cover slide bears the company logo in the same form as it appears on the websites and invoices.

ANALYSIS AND REASONS FOR DECISION

[13] The first issue raised by the Requesting Party is that the company logo shown in the exhibits constitutes use of a trade name rather than use of the Mark. Given that the affidavit does not provide any other evidence of use of the Mark beyond the exhibits, the Requesting Party submits that the Mark should be expunged in its entirety. With respect to the invoice evidence in particular, the Requesting Party submits that invoices will be dismissed as evidence where the mark does not appear separately from the company name [citing *Iwasaki Electric Co Ltd v Hortilux Schreder BV*, 2012 FCA 321, 226 ACWS (3d) 205].

[14] Whether a word is used as a trade-mark or a trade-name is a question of fact. The presumption that a company name is a trade-name rather than a trade-mark is rebuttable. The question is whether the registered owner has shown use of the trade-mark in such a way that it is identifiable as a trade-mark and not merely as a corporate name or corporate identifier. As the Owner notes, relevant factors to decide whether use is as a trade-mark or trade-name include whether the trade-mark stands apart from the corporate or trade-name and other corporate identifier information to the extent that the public would perceive such use as a trade-mark and not merely identification of a legal entity [see *Road Runner Trailer Manufacturing Ltd v Road Runner Trailer Co* (1984), 1 CPR (3d) 443 (Fed TD); *Nightingale Interloc Ltd v Prodesign Ltd*, 1984 CarsellNat 1063 at para 7; and *Borden Ladner Gervais LLP v GDC Communities*, 2015 CarswellNat 1850 at para 20 (TMOB)].

[15] In this case, as the Owner submits, the word “thinklab” appears throughout the materials in the exhibit evidence above the words “CONSULTING INC.” in a significantly larger and

darker font, and is further contrasted as it is written in lower-case letters [citing *Road Runner, supra; Bereskin & Parr v Kleen-Flo Tumbler Industries Limited*, 2010 CarswellNat 3991; and *Smiths IP v Saks & Company*, 2015 CarsellNat 4311]. Accordingly, for these reasons, I am satisfied that the Mark sufficiently stands out to constitute display of the Mark as registered.

[16] Furthermore, with respect to the invoice evidence, distinguishable from *Hortilux, supra*, the present case is in respect of services; nevertheless, even an application of the factors in *Hortilux* supports a finding of use of the Mark as registered (such factors include the prominence of the trade-mark, whether the trade-mark stands apart from corporate information, whether it is clear that the goods of only one manufacturer are being sold and whether other trade-marks appear on the invoices (whether in the body or otherwise)). As discussed above, the Mark clearly stands apart from the corporate indicia; it appears in much greater prominence and creates a distinctive element in the corporate name, thus constituting trade-mark use. Furthermore, no other trade-mark appears on the invoices in association with the services and the invoices are only in respect of consulting and educational services.

[17] The Requesting Party submits that in the alternative, the evidence fails to establish use of the Mark in association with the services during the relevant period. In this regard, the Requesting Party submits that the exhibits are undated, do not reference all of the services, and do not show that the services were actually performed; rather, Mr. Litchfield only provides bald statements to this end, which are not supported by the evidence.

[18] However, I agree with the Owner that absent evidence to the contrary, an affiant's sworn statement is to be accepted at face value, and statements in an affidavit must be accorded substantial credibility in a section 45 proceeding [see *Rubicon Corp v Comalog Inc* (1990), 33 CPR (3d) 58 (TMOB)]. In the present case, Mr. Litchfield provides sworn statements regarding the dates associated with the exhibit evidence, and clearly correlates the exhibit evidence with what I consider constitutes or encompasses each of the registered services.

[19] Furthermore, it is the evidence as a whole that must be considered; that is, the exhibits should be read in conjunction with the information provided in the affidavit as a whole, and not as stand-alone documents [*Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 2009 CarswellNat 3298 (TMOB)].

[20] Consequently, having regard to the evidence as a whole, and in accordance with the aforementioned, 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

[21] 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

Thompson Cooper LLP

FOR THE REGISTERED OWNER

Miller Thomson LLP

FOR THE REQUESTING PARTY