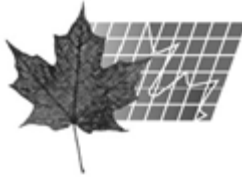


O P I C



C I P O

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

Citation: 2019 TMOB 40

Date of Decision: 2019-04-30

IN THE MATTER OF A SECTION 45 PROCEEDING

**Perley-Robertson, Hill & McDougall
LLP**

Requesting Party

and

Window World International, LLC

Registered Owner

**TMA837,996 for
WINDOW WORLD**

Registration

[1] At the request of Perley-Robertson, Hill & McDougall LLP (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) on November 18, 2016, to Window World International, LLC (the Owner), the registered owner of registration No. TMA837,996 for the trade-mark WINDOW WORLD (the Mark).

[2] The Mark is registered in association with the services “Installation of vinyl replacement and new construction windows” (the Registered Services).

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the goods and services specified in the registration at any time within the three-year period immediately preceding the date of the notice and, if not, the date when the trade-mark was last used and the reason for the absence of

such use since that date. In this case, the relevant period for showing use is November 18, 2013 to November 18, 2016.

[4] 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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in section 45 proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)], 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 goods or services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[6] In response to the Registrar’s notice, on February 17, 2017, the Owner furnished the affidavit of its corporate counsel, Charles F. Bauer, sworn on February 16, 2017, in North Carolina.

[7] On August 8, 2017, the Owner furnished a “re-executed” version of the Bauer affidavit, which will be addressed below.

[8] Both parties filed written representations. A hearing was requested, but was not attended by either party.

PRELIMINARY REMARKS

[9] In its written argument, the Requesting Party challenges the admissibility of the exhibits to the original Bauer affidavit, sworn on February 16, 2017, on the basis that the exhibits are not endorsed by the notary public who administered the oath, as required by section 80(3) of the Federal Courts Rules. The requesting party cites *Perley-Robertson Panet Hill & McDougall v Early Morning Productions Inc* (1998), 87 CPR (3d) 347, and *Beiersdorf AG v Future*

International Diversified Inc (2002), 23 CPR (4th) 555 (TMOB), in support of its position that the exhibits should be disregarded.

[10] In response, on August 8, 2017, the Owner furnished a “re-executed” version of the affidavit. The Owner states that this version is identical to the original, but for the addition of (i) an August 2, 2017 jurat; (ii) endorsements on the exhibits’ cover pages (by the notary public who administered the original oath); and (iii) page numbers. The Owner requested a retroactive extension of time pursuant to section 47(2) of the Act to file this evidence and paid the prescribed fee.

[11] On September 7, 2017, in response to an invitation from the Registrar dated August 17, 2017, the Requesting Party filed submissions objecting to the requested extension of time. The Owner responded on September 8, 2017. On September 20, 2017, the Registrar informed the parties that, as both parties had filed written submissions and requested an oral hearing, the admissibility of the re-executed affidavit would be decided when the Registrar renders her final decision pursuant to section 45(4) of the *Trade-marks Act*.

[12] The Requesting Party cites the Registrar’s practice notice *Practice in Section 45 Proceedings* for the proposition that the Registrar will generally not grant an extension of time for filing additional evidence after the requesting party has filed its written representations. The Requesting Party further submits that the Owner’s failure to file admissible evidence was reasonably avoidable, as “it is the responsibility of the person furnishing the affidavit to ensure that it complies with Canadian legal requirements”.

[13] However, the Owner claims that it “assumed that the evidence would not be objected to as the affidavit was correctly sworn according to the local execution requirements in the affiant’s place of residence”. In this respect, the Owner submits that the Registrar does not strictly adhere to the rules of practice of the Federal Court relating to the admissibility of exhibits and that the Federal Court’s standards in this respect would be inappropriate to apply where an objection to the exhibits was not raised in a timely manner. The Owner further submits that, in keeping with the purpose and summary nature of section 45 proceedings, there should be a mechanism for it to correct a technical deficiency in its evidence.

[14] Indeed, the Registrar generally accepts affidavits sworn in foreign jurisdictions as long as that jurisdiction's requirements are met [see *Dubuc v Montana* (1991), 38 CPR (3d) 88 (TMOB)]. In this case, there is no indication that the Bauer affidavit does not meet the requirements of North Carolina.

[15] Moreover, it is well established that technical deficiencies in evidence should not stop a party from successfully responding to a section 45 notice [see *Baume & Mercier SA v Brown* (1985), 4 CPR (3d) 96 (FCTD)]. In particular, the Registrar has accepted exhibited evidence that is not properly endorsed where the exhibits are clearly identified and explained in the body of the affidavit [see, for example, *Borden & Elliot v Raphaël Inc* (2001), 16 CPR (4th) 96 (TMOB)]. Such is the case with the exhibits here. The Registrar has also held that an improper endorsement on an exhibit will not necessarily render it inadmissible if, as here, no objection was raised when the affidavit was originally filed [see *Maximilian Fur Co, Inc v Maximilian for Men's Apparel Ltd* (1983), 82 CPR (2d) 146 (TMOB)].

[16] In this respect, the cases cited by the Requesting Party are distinguishable. In *Early Morning Productions*, the documents in question were not furnished as part of an affidavit or statutory declaration. In *Beiersdorf*, the objection to the exhibits was raised shortly after service of the evidence, yet no steps were taken to correct the deficiency.

[17] In view of the foregoing, I find that the exhibits to the original Bauer affidavit are admissible as evidence in this proceeding.

[18] Moreover, as the re-executed version of the Bauer affidavit does not contain "additional" evidence, but merely seeks to correct a technical deficiency in the identification of the exhibits (and to number the pages for convenience), I am satisfied that an extension of time to submit the affidavit as evidence in this proceeding in accordance with section 47(2) of the Act is justified. Furthermore, given the timing of the Requesting Party's objection to the exhibits, I am also satisfied that the delay in furnishing the re-executed affidavit was not reasonably avoidable. In light of the above, the re-executed version of the Bauer affidavit, sworn August 2, 2017, is also made of record as evidence in this proceeding.

THE OWNER'S EVIDENCE

[19] In his affidavit, Mr. Bauer states that he has been employed with the Owner, as corporate counsel, since November 9, 2015, and that as corporate counsel he has access to the Owner's business, financial and marketing records "particularly as they relate to Canada". He adds, "I am informed and believe the following statements [in the affidavit] regarding sales, promotion and marketing of the goods/services contained in the registration bearing the mark are true and correct, and based on the Owner's investigation, I am authorized to make this declaration on its behalf." Mr. Bauer does not claim to have personal knowledge of the facts; however, the foregoing claim would seem to indicate that his information and belief are based on the Owner's business, financial and marketing records.

[20] Mr. Bauer asserts that the Mark has been used and displayed by the Owner in "advertising/performance" of the Registered Services. More particularly, he states that the Mark is licensed to "corporations which manufacture and affix the Mark to goods set out in paragraph 2 below or which display the mark during the performance of services". Given that paragraph 2 defines "the Goods/Services" as "Installation of vinyl replacement and new construction windows", I interpret his statement in context to be that the Mark is affixed to "vinyl replacement and new construction windows", and otherwise displayed in the performance of services, which include the installation of such windows. Mr. Bauer confirms that the Owner "regulates and monitors the quality control of [these] goods/services" and "the use of the Mark affixed to the goods/displayed in the services" and that the Owner "has done so continuously since at least as early as October 31, 2012 in Canada".

[21] Mr. Bauer specifies that the Mark has been used in Canada by the Owner through a licence to Window World, Inc. and its authorized franchisees, who in turn sublicense the Mark from Window World, Inc. He describes this arrangement as "the largest home improvement franchise system in North America". He describes "[t]he normal course of trade in the Goods/Services" as the Owner advertising in Canada through various media, including television, print, and the Internet, continuously since October 2012, and servicing its customers through a sales force operating out of each licensed location. He asserts that the Owner "had and

continues to have a willingness and ability to perform the services in Canada during the Relevant Period”.

[22] Mr. Bauer provides no information on how the services are performed or on how customers in Canada might be serviced through the licensed sales forces. However, he attests that the Owner, directly and through its authorized licensees, spent over \$4 million on advertising during the relevant period, such advertising being “available to and viewed by Canadians”.

[23] More specifically, Mr. Bauer states that the “Goods/Services” were promoted in Canada during the relevant period through television advertising on the NBC, CBS, ABC and Fox stations, which he states are viewed across Ontario. He provides, as Exhibits A and B to his affidavit, samples of such television advertising and photographs of “the Goods bearing the Mark offered for purchase during the relevant period”.

[24] Exhibit A contains two screen captures featuring a gentleman showing off a window. Displayed at the bottom of the screens and on the front of the gentleman’s shirt is a logo featuring the word “Window” above the word “World”—wherein the initial letter of both words is a single, large W—along with line drawings of windows and a slogan (the Window World Logo). The footer at the bottom of the screens provides telephone numbers and website addresses for “BUFFALO” (at *WindowWorldofBuffalo.com*) and “JAMESTOWN” (at *WindowWorldofJamestown.com*). The first screen also features a caption that states “WINDOW WORLD: \$299 PER WINDOW INSTALLED”.

[25] Exhibit B contains two photographs. The first is of a window with a label featuring the Window World Logo on the top pane. The second is of a gentleman handling a packaged window labelled with the Mark, both as a word mark and in the Window World Logo. A large Window World Logo is also displayed on the back of the gentleman’s shirt.

[26] Mr. Bauer further states that the “Goods/Services” were promoted in Canada during the relevant period through print advertising in *Good Housekeeping* magazine, which he states is distributed and sold throughout Canada. He attaches a sample of such advertising from the relevant period as Exhibit C to his affidavit. The 21-page advertisement promotes the benefits of

vinyl windows as well as several other features of various styles of Window World windows. The Mark and the Window World Logo appear throughout. I note that the advertisement refers to Window World as “America’s Largest Replacement Window and Exterior Remodelling Company” with a “nationwide network of over 200 locations”, and also displays two maps of the United States. However, there do not appear to be any references to “new construction” windows or to Canada in the advertisement.

[27] In addition, Mr. Bauer states that the “Goods/Services” were promoted in Canada during the relevant period through Internet advertising on *www.windowworld.com*. He provides, as Exhibit D to his affidavit, current screen captures that he states are “from Window World, Inc.’s website showing the Goods bearing the Mark for sale/Services offered”. He attests that the same or similar advertisements bearing the Mark appeared on “the respective websites” in Canada during the relevant period.

[28] In fact, Exhibit D contains one screen capture from each of four websites: *www.windowworld.com*, *www.windowworldofbuffalo.com*, *www.windowworldvermont.com* and *www.windowworldpugetsound.com*. Each of the exhibited webpages displays the Window World Logo and invites visitors to request a free estimate. The webpage for Puget Sound highlights “Cold Weather Installation” in particular.

[29] I note that the webpage for Window World of Buffalo advertises windows and doors “professionally installed by industry experts” under the heading “Replacement Windows & Doors Buffalo NY”. The page also offers a telephone number and a fillable form for scheduling a “Free In-Home Estimate” (not all of the form fields are legible on the exhibited printout).

[30] The text of the webpage also contains the following paragraph:

We also offer do-it-yourself fixes to common problems relating to windows in your home. To set up your free no obligation in-home demonstration contact us today through our demo request form.

[31] With respect to where the advertised services are available, the text of the page states, “We serve Buffalo Niagara Falls Erie Genesee Livingston Monroe Orleans Ontario Niagara Wayne Wyoming with [remaining text not captured]”. In the absence of any specific references to Canada on this webpage (or elsewhere in the exhibited advertisements), it is not clear whether

the references to areas such as Niagara Falls, Erie, Orleans, Ontario and Niagara refer to Canadian or New York locations. Mr. Bauer does not provide any information to assist in the interpretation of this statement.

[32] I also note that the Window World webpage at *www.windowworld.com* includes a “Store Locator” in its sidebar; however, Mr. Bauer provides no details regarding this feature.

[33] Included as the final page in Exhibit D is a Google statistical report for *www.windowworld.com*. It is broken down by Canadian province and shows over 19,000 “Sessions”—which Mr. Bauer refers to as “page views”—across Canada over the course of the relevant period. The last three columns of statistics are displayed under the heading “Conversions Goal 1: Demo Sign Up” and are titled respectively “Demo Sign Up (Goal 1 Conversion Rate)”, “Demo Sign Up (Goal 1 Completions)”, and “Demo Sign Up (Goal 1 Value)”. The highest numbers in these columns are in the row for Ontario, which shows 21 “Completions”, with a corresponding “Value” of “\$35,100.00” over the course of the relevant period.

[34] Finally, Mr. Bauer states that the Owner “contracted with Renoworks Software, located in Alberta Canada to build and maintain its configurator”. However, he provides no explanatory details with respect to this statement, which does not on its face appear to relate to the advertising or performance of the Registered Services in Canada.

ANALYSIS

[35] At the outset, I note that the Requesting Party’s written representations include submissions challenging Mr. Bauer’s knowledge of the Owner’s business during the relevant period. The Requesting Party submits that, when an affiant has been employed as corporate counsel for only a little over one year, one “has to question how he could be considered the most knowledgeable individual in the circumstances”.

[36] However, the Owner, submits that Mr. Bauer is knowledgeable by virtue of having access to and having reviewed the Owner’s records, and may even be “presumed” to have some personal knowledge of the facts. The Owner submits that Mr. Bauer, as corporate counsel, was in

“a highly responsible and important office” with the Owner, as the “highest ranking legal officer, generally responsible for all legal matters”, thus having “direct access to corporate management and supervisory boards”.

[37] Indeed, I accept that “corporate counsel” would generally have knowledge of the corporation’s intellectual property and related contractual arrangements, including with respect to trade-mark use and licensing. Moreover, although Mr. Bauer makes no claim to having personal knowledge of the facts in this case, there is no reason to doubt that his information and belief, based on business records, extends to the relevant period. Accordingly, for the purposes of this proceeding, I am prepared to take Mr. Bauer’s statements of fact at face value.

[38] Otherwise, the Requesting Party submits that the Owner’s evidence is vague, unclear, and insufficient to establish use of a trade-mark in Canada within the ambit of Section 45 of the Act. In particular, the Requesting Party submits that the evidence is vague and unclear with respect to the Owner’s normal course of trade and licensing arrangements. The Requesting Party further submits that the exhibited advertising is not clearly linked to the Registered Services or to Canada and that “there are no facts provided to demonstrate that the Owner truly had a willingness and ability to perform the services in Canada during the Relevant Period”. The Requesting Party concludes with submissions to the effect that maintenance of the registration would open the floodgates for U.S. companies to maintain Canadian registrations for trade-marks that might never be put into use in this country, “as long as the owner is able to state that there is a willingness and ability to perform the services in Canada”—which, in the Requesting Party’s submission, is “clearly not what the drafters of our legislation intended”.

[39] The Owner, for its part, submits that the burden to be met by a registered owner in section 45 proceedings is not a heavy one: the registered owner need only provide “some evidence of use of its trade-mark in association with its services through a factual description of the use of the trade-mark so as to demonstrate that the use requirements of Section 4 are met”. In this respect, the Owner notes that the Registrar may draw reasonable inferences from the facts stated in the affidavit (citing *Spirits International v BCF SENCRL*, 2012 FCA 131, 101 CPR (4th) 413). With respect to the Requesting Party’s identification of ambiguities and lack of clarity in the affidavit, the Owner submits that those objections amount to “a very technical

linguistic analysis that detracts from understanding the substance of Mr. Bauer’s words”, and that the Bauer affidavit should instead “be read in context and for what it really says”. The Owner further submits that the Requesting Party’s policy argument with respect to the opening of floodgates is irrelevant.

[40] Indeed, the sole matter to be resolved in a section 45 proceeding is whether the furnished evidence meets the requirements of sections 4 and 45 of the Act. In this respect, the registered owner need only establish a *prima facie* case [see *Cinnabon, Inc v Yoo-Hoo of Florida Corp* (1998), 82 CPR (3d) 513 (FCA); and *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184, 90 CPR (4th) 428]. Moreover, the owner’s evidence must be considered as a whole and exhibits interpreted in conjunction with the statements made in the affidavit or statutory declaration [see, for example, *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB)].

[41] Nevertheless, the owner must not merely state, but actually *show* use of the trade-mark in Canada “by describing facts from which the Registrar or the Court can form an opinion or can logically infer use within the meaning of section 4” [see *Guido Berlucchi & C Srl v Brouillette Kosie Prince*, 2007 FC 245, 56 CPR (4th) 401 at paragraph 18].

[42] In particular, with respect to services, the evidence must show that the trade-mark was displayed in the performance or advertising of the registered services in Canada during the relevant period. In the case of advertising, the evidence must also show that the owner was offering and prepared to perform the advertised services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

The Owner’s normal course of trade and licensing

[43] The Requesting Party submits that a registered owner must “clearly and unequivocally show (not state) that the trademark was in use in the normal course of trade in Canada during the relevant period and that said use enured to the benefit of the registrant”. The Requesting Party argues that Mr. Bauer’s evidence is overly broad and ambiguous in this respect: in particular, his statement that customers are “serviced” through a sales force operating out of each “licensed location” fails to specify where and how installation services are normally performed, and his

references to display of the Mark by licensees in association with goods “or” services fail to specify which parties in particular were willing and able to perform installation services in Canada during the relevant period. The Requesting Party further submits that Mr. Bauer’s statements are not supported by evidence of a proper licence agreement.

[44] I would first note that “the normal course of trade” is a concept that applies to use of a trade-mark in association with goods pursuant to section 4(1) of the Act. It is not strictly a necessary element with respect to use of a trade-mark in association with services pursuant to section 4(2). In any event, I accept that the Owner’s installation services are performed in the normal course of trade and by authorized licensees.

[45] In this respect, on a fair reading of the affidavit as a whole, Mr. Bauer’s assertion is that the Mark is licensed to manufactures of vinyl replacement and new construction windows and to franchisees that sell such windows and, at least in some cases, also offer to install the windows sold. He indicates more particularly that the Owner licenses the Mark to Window World, Inc., which in turn sublicenses it to franchisees operating in various locations. Mr. Bauer’s statements are corroborated by examples of advertisements for the sale and installation of windows by what appear to be franchisees operating in Buffalo, Jamestown and Puget Sound. Mr. Bauer confirms that these advertisements or similar ones date from the relevant period.

[46] Furthermore, as noted by the Owner, it is not necessary to furnish a written licence agreement to establish licensed use of a trade-mark [see *Wells’ Dairy Inc v UL Canada Inc* (2000), 7 CPR (4th) 77 (FCTD)]. In a section 45 proceeding, a clear statement attesting to the registered owner’s control over the character or quality of goods sold or services provided under a licence is sufficient, per *Empresa Cubana del Tabaco v Shapiro Cohen*, 2011 FC 102, 91 CPR (4th) 248. In the present case, Mr. Bauer clearly attests that the quality control of the licensed services is regulated and monitored by the Owner. Accordingly, I am satisfied that any use of the Mark in association with the Registered Services by Window World, Inc. or its authorized franchisees enures to the Owner’s benefit in accordance with section 50 of the Act.

Display of the Mark and Availability of the Registered Services in Canada

[47] The Requesting Party further submits that the exhibited advertising is not clearly linked to the Registered Services or to Canada. For example, the Requesting Party submits that the exhibited Google statistics do not indicate what information was displayed on the actual webpages viewed in Canada and, in particular, whether it was information regarding the Registered Services. In the Requesting Party's submission, advertising with respect to goods available for purchase, as opposed to installation services, is irrelevant in this case. The Requesting Party also submits that there is no evidence of the exhibited television advertisements being broadcast or viewed in Canada, or of *Good Housekeeping* magazine being distributed in Canada.

[48] The Owner, for its part, submits that Mr. Bauer's statements in this respect are clear and sufficient and that the additional evidence sought by the Requesting Party is beyond the scope of a section 45 proceeding.

[49] Indeed, Mr. Bauer describes advertising by the Owner "directly and through its authorized licensees" during the relevant period, stating specifically that the exhibited television advertising aired on stations "viewed across Ontario"; that the exhibited magazine advertisement ran in a publication "distributed and sold throughout Canada"; and that the exhibited Internet advertising is the same as or similar to advertising that "appeared on the respective websites ... in Canada". Mr. Bauer has confirmed that he has access to the Owner's "marketing records" and is informed that the statements in his affidavit regarding promotion and marketing are "true and correct", and I do not find anything in the evidence to be inconsistent with those statements. Accordingly, I am prepared to take Mr. Bauer's statements regarding the distribution of the exhibited advertising at face value. Furthermore, although the evidence with respect to actual viewership is less clear, the Google statistics do appear to demonstrate at least some interaction between Canadians and the Owner's Internet advertising.

[50] However, as noted above, advertising alone is insufficient to demonstrate use of a trademark in association with services; at the very least, the services must be available to be performed in Canada at the same time [*Wenward, supra*]. The main issue in this case is whether

the evidence demonstrates that installation services were actually performed or available to be performed in Canada during the relevant period.

[51] With respect to actual performance, the Owner submits that the Google statistics at Exhibit D show sales in Canada during the relevant period in Ontario, Alberta, Quebec and British Columbia, with the value of the sales being as indicated in the “Demo Sign Up (Goal 1 Value)” column.

[52] However, the title of that column appears to be inconsistent with the Owner’s interpretation. In my view, the title “Demo Sign Up” suggests that the statics in question do not relate to actual sales, but rather, to a feature of the *www.windowworld.com* website that allows visitors to sign up for a demonstration. Indeed, whereas the screen capture from *www.windowworldofbuffalo.com* invites visitors to set up a free “in-home demonstration” through a “demo request form”, none of the exhibited screen captures displays a means of purchasing windows online or of ordering their installation online.

[53] Moreover, the invitation on *www.windowworldofbuffalo.com* to sign up for a free in-home demonstration is made immediately after offering “do-it-yourself fixes”, which suggests that the term “Demo Sign Up” might relate only to demonstrations of work that clients can perform themselves. If signing up for a demonstration is advertising of, or can result in, the installation of a window by one of the authorized franchisees, then that is not indicated in the Bauer affidavit.

[54] I would also note that it is not clear whether a “Demo Sign Up” originating from Canada would necessarily involve services to be performed in Canada, as opposed to services to be performed at properties Canadians own in the United States. In this respect, in *Unicast S.A. v. South Asian Broadcasting Corp.*, 2014 FC 295, 122 CPR (4th) 409 at paragraph 46, the Federal Court noted that there is “an important distinction between services performed in Canada and services performed outside Canada, perhaps for Canadians”. That decision was cited by the Federal Court in *Supershuttle International, Inc v Fetherstonhaugh & Co.*, 2015 FC 1259, 2015 CarswellNat 8336 at paragraph 40, for the proposition that “the observation of a trademark by individuals on computers in Canada” is in itself insufficient to demonstrate use; the associated services “must still be offered in Canada”.

[55] Accordingly, in the absence of an explanation from Mr. Bauer regarding the significance of the “Value” figures for “Demo Sign Up” in the exhibited Google statistics, a conclusion that Window World, Inc. or an authorized franchisee had installed windows in Canada during the relevant period would be speculative.

[56] I also note Mr. Bauer’s statement that the Owner regulates and monitors “the quality control of [the registered] goods/services” and “the use of the Mark affixed to the goods/displayed in the services” and has done so “continuously since at least as early as October 31, 2012 in Canada”. However, given that this statement also includes goods, and would appear to cover the United States as well as Canada, it is not a clear assertion that the Registered Services were necessarily being performed in Canada during the relevant period. In the absence of evidence with respect to the nature or extent of the Owner’s regulation and monitoring in Canada, I am not prepared to accept Mr. Bauer’s statement above as evidence that the Owner performed the Registered Services in Canada.

[57] With respect to the *availability* of the Registered Services in Canada, Mr. Bauer asserts that the Owner “had and continues to have a willingness and ability to perform the services in Canada during the Relevant Period”.

[58] However, it is well established that mere assertions of use as a matter of law—as opposed to assertions of fact showing use—are insufficient to demonstrate use of a trade-mark in accordance with section 45 of the Act [regarding the distinction, see *Mantha & Associés/Associates v Central Transport Inc* (1995), 64 CPR (3d) 354 (FCA)]. As noted above, an owner needs to *show*, not merely state, that it was prepared to perform the registered services in Canada during the relevant period. In this respect, the Registrar must be able to “rely on an inference from proven facts rather than on speculation” to satisfy every element required by the Act [*Diamant Elinor, supra* at paragraph 11; see also *Smart & Biggar v Curb*, 2009 FC 47, 72 CPR (4th) 176].

[59] In the present case, I find that the evidence does not contain sufficient facts for me to be able to conclude that the installation of either vinyl replacement or new construction windows was available to be performed in Canada during the relevant period. Although Mr. Bauer states in general terms that the Owner had a “willingness and ability” to perform the services in Canada

and “used” the Mark in Canada through Window World, Inc. and its franchisees, the evidence provided in support does not show the offering of window installation in Canada, or that the Owner was prepared to offer such services in Canada.

[60] First, the exhibited advertising contains various references to the United States, but no clear reference to Canada. Indeed, the fact that the exhibited *Good Housekeeping* article refers to Window World as “America’s” largest replacement window and exterior remodelling company and to a “nationwide” network of over 200 locations suggests that the business operates in the United States and is not evidence that customers in Canada are targeted, although some of the Owner’s advertising may spill over into Canada. Although the Owner submits in its written representations that the Owner “did in fact spend a lot of money on advertising to break into the Canadian market”, Mr. Bauer merely states that the Owner’s advertising during the relevant period was “available to and viewed by Canadians”; there is no indication that such advertising was actually directed at Canada.

[61] With respect to the locations listed on the *www.windowworldofbuffalo.com* webpage, as discussed above, if any of the place names such as Niagara Falls, Erie, Orleans, Ontario or Niagara were meant to refer to locations in Ontario rather than the United States, there is no indication to that effect on the exhibited screen capture; nor does Mr. Bauer confirm whether this franchisee was prepared to perform the Registered Services in Canada. In addition, although the exhibited Google statistics for *www.windowworld.com* would appear to suggest that Canadians signed up for demonstrations online, it is not clear whether the demonstrations themselves took place (or could have taken place) in Canada and, more importantly, whether the franchisees offering such demonstrations were prepared to provide the Registered Services in Canada.

[62] Indeed, in the absence of further particulars regarding the Owner’s “willingness and ability” to perform the Registered Services in Canada, it is not even clear whether *franchisees* were prepared to install windows in Canada during the relevant period, or whether the Owner was merely prepared to grant franchises for Canada during that time.

[63] It should have been a simple matter for Mr. Bauer to confirm, for example, the names of any franchisees prepared to install vinyl replacement or new construction windows in Canada. Yet the affidavit provides no information in that respect, nor any details as to how installations in

Canada could be arranged or would ultimately be performed. In contrast to his evidence with respect to advertising, Mr. Bauer's statement with respect to the "servicing" of customers through a sales force provides no specifics, with respect to Canada or otherwise. In the absence of further details or supporting evidence, drawing conclusions with respect to the availability of the Registered Services in Canada would be speculative.

[64] In the circumstances, Mr. Bauer's broad statements with respect to the Owner's "willingness and ability" to perform the Registered Services in Canada and the Mark having been "used" in Canada amount to mere assertions of use, rather than assertions of fact showing use.

DISPOSITION

[65] In view of all of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered services within the meaning of sections 4 and 45 of the Act. Furthermore, there is no evidence before me of special circumstances excusing the absence of such use.

[66] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration will be expunged.

Oksana Osadchuk
Member
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

Finlayson & Singlehurst

FOR THE REGISTERED OWNER

Perley-Robertson, Hill & McDougall LLP

FOR THE REQUESTING PARTY