



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

Citation: 2019 TMOB 47

Date of Decision: 2019-05-31

IN THE MATTER OF A SECTION 45 PROCEEDING

Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l. Requesting Party

and

Workshop for Sustainable Living, Inc. Registered Owner

TMA864,848 for DIGNITI Registration

INTRODUCTION

[1] At the request of Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l. (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 June 5, 2017, to Workshop for Sustainable Living, Inc. (the Owner), the registered owner of registration No. TMA864,848 for the trade-mark DIGNITI (the Mark).

[2] The Mark is registered for use in association with the following goods and services:

GOODS

An integrated patient care system of modular design comprising an adjustable mattress for sleeping and feeding, a bed canopy, a bed frame, a toilet apparatus comprising a toilet seat, a toilet bowl and plumbing conduits, patient safety restraints, a feeding apparatus comprising a folding table, a washing apparatus comprising plumbing fixtures, fittings and conduits and an air dryer, an entertainment apparatus comprising a radio, a television and a CD player, a patient lift apparatus comprising a patient harness, a patient sling and an overhead hoist, remote monitoring apparatus comprising a camera and microphone

and telephony apparatus comprising a telephone, a computer a cellular telephone, computer cables, computer modems and telephone lines.

SERVICES

(1) Custom design and manufacture of integrated patient care systems of modular design comprising an adjustable mattress for sleeping and feeding, a bed canopy, a bed frame, a toilet apparatus comprising a toilet seat, a toilet bowl and plumbing conduits, patient safety restraints, a feeding apparatus comprising a folding table, a washing apparatus comprising plumbing fixtures, fittings and conduits and an air dryer, an entertainment apparatus comprising a radio, a television and a CD player, a patient lift apparatus comprising a patient harness, a patient sling and an overhead hoist, remote monitoring apparatus comprising a camera and microphone and telephony apparatus comprising a telephone, a computer a cellular telephone, computer cables, computer modems and telephone lines.

(2) Leasing of an integrated patient care system of modular design comprising an adjustable mattress for sleeping and feeding, a bed canopy, a bed frame, a toilet apparatus comprising a toilet seat, a toilet bowl and plumbing conduits, patient safety restraints, a feeding apparatus comprising a folding table, a washing apparatus comprising plumbing fixtures, fittings and conduits and an air dryer, an entertainment apparatus comprising a radio, a television and a CD player, a patient lift apparatus comprising a patient harness, a patient sling and an overhead hoist, remote monitoring apparatus comprising a camera and microphone and telephony apparatus comprising a telephone, a computer a cellular telephone, computer cables, computer modems and telephone lines.

[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 it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is June 5, 2014 to June 5, 2017.

[4] The relevant definitions of use for goods and services are set out in section 4 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.

4(3) A trade-mark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

[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 these proceedings is 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 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 and services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[6] Concerning services, the display of a trade-mark on advertising is sufficient to meet the requirements of section 4(2) of the Act when the trade-mark owner is offering and prepared to perform the advertised services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[7] On June 20, 2017, the Owner furnished an unsworn letter and CD-R in response to the Registrar's notice. The Owner was advised by the Registrar on August 9, 2017, that these materials could not be made of record because, pursuant to section 45 of the Act, evidence must be filed in the form of an affidavit or statutory declaration. The Owner then furnished the solemn declaration of Richard Moerman, declared on August 4, 2017 in Oliver, British Columbia. Only the Requesting Party filed written representations. Neither party requested an oral hearing.

THE OWNER'S EVIDENCE

[8] The Moerman declaration is brief, stating only the following:

THE CANADIAN INTELLECTUAL PROPERTY OFFICE (CIPO) REQUIRES EVIDENCE OF PUBLIC AND COMMERCIAL USE OF THE REGISTERED TRADE MARK "DIGNITI" DURING THE PRECEEDING [*sic*] THREE YEAR PERIOD PRIOR TO JUNE 5, 2017. THIS EVIDENTIARY SUBMISSION IS IN SATISFACTION OF THAT CIPO REQUEST. THE SUBMISSION IS IN DEFENSE OF THE HISTORICAL AND CURRENT TRADE MARK USE BY THE OWNER OF

SAID TRADE MARK, RICHARD MOERMAN, WORKSHOP FOR SUSTAINABLE LIVING, INC.

[9] Included with the declaration are a number of documents identified as Exhibits 1 to 21. These documents appear to be electronic presentations, pamphlets, and other informational materials pertaining to the Owner's business. These documents are arranged in a binder and divided by a number of tabs labeled 2011, 2012, 2013, 2014, 2015, 2016, 2017, and MISCELLANEOUS. Many of the documents bear handwritten notes, usually on the front pages of the documents, and these notes appear to provide context as to the documents' origins. The exhibits are not endorsed by the commissioner who received the declaration and are not referenced in the text of the declaration.

[10] The documents in the binder include the following:

- Exhibit 1 is a printout of what appears to be an electronic slide presentation on the Owner's home-care proposals, dated April 5, 2011. A handwritten note reads "USA MEDICAL CONFERENCE + CO VENTURE GERIATRIC CARE RESEARCH". The words "DIGNITI HOME-HOSPITAL" appear at the top of each slide.
- Exhibit 2 is an informational booklet dated Wednesday, May 4, 2011, comparing "hospital care", "nursing-home care", and "Digniti home care". A handwritten note reads "Health Canada + BC, Ontario Health Ministry". The words "DIGNITI HOME CARE" appear on each slide, with the registered trade-mark symbol following DIGNITI. .
- Exhibit 3 is an informational booklet dated "11/7/12" and entitled "Digniti Care-bed Executive Summary", providing information on a mobile bed and care unit for seniors. The word "Digniti" appears throughout the presentation and on the bottom left corner of each page. A handwritten note reads "BANK + VENTURE CAPITAL PRESENTATIONS".
- Exhibit 4 includes part of a letter dated December 1, 2012, describing the "dignity care pod" – which appears to refer to the aforementioned mobile bed unit – to a supporter or prospective supporter in the United States. The word "Digniti" appears in the letterhead.

Also attached is an invoice with the word “Digniti” appearing in the letterhead. The invoice is dated “12/5/12” and lists the purchase of a “V.I.P. Reservation Fee.”

- Exhibit 5 appears to be a document from the British Columbia Legislative Assembly, dated October 2012 and entitled “Select Standing Committee on Health, Interim Report 2011-2012”. Aside from the cover, a single page of this document is included, entitled “Appendix A: Participants”. Among the participants is “Digniti Home-Hospital Project, Rees Moerman”.
- Exhibit 6 consists of two photographs of a sign showing the words “Digniti Age Lab”. A handwritten note on the first page reads, “Public Building Signage (9 years on Public Street)”.
- Exhibit 7 consists of three images of the word Digniti inside a blue oval, as well as the words “May 28, 2013, Application for commercial use” on the bottom of the page. A handwritten note reads, “TRADE MARK APPLICATION GRAPHIC STYLE – LOGO”.
- Exhibit 8 is a document listing contact information for Digniti Home-Hospital Project and identifying Rees Moerman as President. A handwritten note reads, “TRADE PRESS, BUSINESS CARDS – 2004-2015 PERIOD”. The document includes the tagline “Affordable Aging-In-Place Solutions” but offers no additional information about any potential goods or services.
- Exhibits 9-11 consist of photographs showing a seniors’ modular bed and care unit. The Mark appears on the unit. Handwritten notes read “Product in Public Demonstration + USE – MEDIA PROFILES” and explain the positioning of the Digniti logo. The final page is hand-dated “2013”.
- Exhibits 12-16 consist of brochures touting the advantages of Digniti home-care products. A handwritten note reads “TRADE BROCHURES”. The brochures are undated, but are included under the tab labelled “2014”.
- Exhibit 17 appears to be the cover page for a user’s manual for the Digniti Home-Hospital product. Handwritten notes state “EDUCATIONAL + INSTRUCTIONAL

MEDIA CLINICAL ORIENTATION PACKAGE”, “USERS MANUALS”, “SAFETY DATA”, “TROUBLE SHOOTING”, and “ELECTRONIC MEDIA – TRAINING + ORIENTATION MANUALS Publically & Commercially Disbursed”. The document is dated November 2015.

- Exhibit 18 is a document entitled “CRA – SR&ED Application for fiscal year ended February 28, 2016”, consisting of typed answers to questions regarding technological advancement and obstacles involving the Digniti product. A handwritten note reads, “Tax File: Public Documents – CRA Declarations & Annual Tax Filing + Scientific + TAX CREDITS ISSUED SINCE 2009 through 2016 PERIODS”. I note that this document includes a number of statements indicating that the Owner’s product has not yet come to market, for example, “The current technology development cycle is now in an aggressive wrap-up phase... This is a critical prelude to securing prospective Canadian and foreign commercialization/licensing opportunities”; “January 2017 preparations for commercialization commence”; and “commercial licensing agreements to be negotiated in 2017.”
- Exhibit 19 appears to be a set of slides entitled “Briefing to the BC Standing Committee on Health Care Sustainability – Written & Oral Submissions”. A handwritten note reads “Health Care Public Presentations on Digniti Care System”. The slides are dated July 2016.
- Exhibit 20 consists of instructions for placing the Digniti logo on the care apparatus. The instructions are dated December 14, 2017.
- Exhibit 21 consists of a set of slides dated 2017 explaining the Digniti product. A handwritten note reads, “Co-venture manufacturing proposal with US company for export”. I note that slide 63, entitled “Health Canada Product Licensing Status, reads “An Easy to Launch Product” and “All aspects of Digniti-Pod remain as a “Class I” Medical Device in Canada, implying a low barrier constraint for product launch and a very low liability class for patient risk.”

ANALYSIS

[11] At the outset, I note that the relationship between the Owner and the declarant, Richard Moerman, is not explained. It appears from the documents accompanying the declaration that the President of the Owner is an individual named Rees Moerman; while it may be that this is the same person as the declarant, there is no evidence before me which would allow me to draw such a conclusion. However, in view of my conclusions below, it is not necessary for me to address this matter.

[12] The Requesting Party submits that the materials filed by the Owner are inadmissible. While noting that the document signed by Richard Moerman purports to be a solemn declaration, the Requesting Party submits that “there is no relevant sworn testimony and no exhibit certificates for the accompanying bundle of materials.” The Requesting Party argues that the Registrar must reject any purported evidence that has not been sworn, affirmed, or declared, citing in support *Porsche AG v Procycle Inc* (1992), 45 CPR (3d) 432, and *Grand Lodge v Lombard Scotch Whisky* (1993), 49 CPR (3d) 394.

[13] It has been established that technical deficiencies in evidence should not stop a party from successfully responding to a section 45 notice where the evidence provided could be sufficient to show use [see *Baume & Mercier SA v Brown* (1985), 4 CPR (3d) 96 (FCTD)]. For example, the Registrar has accepted exhibited evidence that was not properly endorsed where the exhibited evidence was clearly identified and explained in the body of the affidavit [see, for example, *Borden & Elliot c Raphaël Inc* (2001), 16 CPR (4th) 96 (TMOB)].

[14] However, in the present case, while handwritten notes on the documents identify them as “exhibits” and provide some context, the documents are not referenced in the Moerman declaration, have not been endorsed by the commissioner who received the declaration, and are not otherwise part of an affidavit or statutory declaration. This amounts to more than a mere technical deficiency. Accordingly, I agree with the Requesting Party that the attached documents identified as exhibits are inadmissible in this case [for similar conclusions, see *Smart & Biggar v Terfloth Trade Marks Ltd*, 2014 TMOB 158 at para 11; *Modern Warehouse Imports Inc v Sanginesi*, 2017 TMOB 18 at paras 11-12].

[15] Even if I were to accept the documents attached to the Moerman declaration as admissible, I would not be satisfied that they show use of the Mark in association with the registered goods and services according to the definitions set out in section 4 of the Act. Most of the documents either predate or post-date the relevant period. In addition, those that are dated within the relevant period appear to depict a product that had not yet been brought to market, as indicated by the language in Exhibits 18 and 21. For example, as discussed above, the tax credit application shown in Exhibit 18 indicates that the Owner hoped to commercialize and license its product in 2017, and the manufacturing proposal slides from some time in 2017 shown in Exhibit 21 appear to reference only a prospective launch of the product. There is no indication anywhere in the materials that such commercialization or launch took place before the end of the relevant period. Moreover, there is no evidence of sales or transfers of the registered goods in Canada, or of export from Canada, during the relevant period or otherwise.

[16] Similarly, with respect to the services, while some of the materials could arguably be considered advertisements, I note that display of a mark in the pre-launch advertising of a service that is not yet available does not constitute use of the mark [*Denman Place Investments Ltd v Hefru Food Services Ltd* (1972), 8 CPR (2d) 199 at para 8; *Express File Inc v HRB Royalty Inc*, 2005 FC 542 at para 22]. Here, there is no evidence from which I can conclude that the Owner was offering and prepared to perform the registered services in Canada during the relevant period. For instance, although the handwritten note on Exhibit 6 indicates that public signage for “Digniti Age Labs” was displayed for nine years, there is no indication as to whether this extended into the relevant period, and in any event, the sign does not advertise any particular goods or services. Similarly, there is no indication as to whether, or to whom, the brochures shown in Exhibits 12-16 were distributed. At best, Exhibit 21 appears to indicate that the Owner was prepared to perform certain manufacturing services in Canada in 2017, but it is not clear whether the Owner was prepared to design and manufacture each of the products listed in the registered description of services, and the exhibited document does not indicate whether the proposal was made before the end of the relevant period.

[17] In view of all the foregoing, I am not satisfied that the registered owner has demonstrated use of the Mark in association with the registered goods and services within the meaning of sections 4 and 45 of the Act.

[18] Furthermore, there is no evidence before me of special circumstances excusing the absence of use.

DISPOSITION

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

Gregory Melchin
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

AGENTS OF RECORD

No Agent Appointed

For the Registered Owner

Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l.

For the Requesting Party