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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 64

Date of Decision: 2019-06-28

IN THE MATTER OF A SECTION 45 PROCEEDING

Robinson Sheppard Shapiro S.E.N.C.R.L./L.L.P.	**Requesting Party**
and	
Ineat Canada Inc.	**Registered Owner**
TMA792,177 for SOLUTEO	**Registration**

[1] At the request of Robinson Sheppard Shapiro S.E.N.C.R.L./L.L.P. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on March 30, 2017, to Soluteo Inc. (the Owner), the registered owner at that time of registration No. TMA792,177 for the trademark SOLUTEO (the Mark).

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

> Computer software, namely smartphone software, telecommunication software, software for the configuration and management of handheld communication devices and smartphones, software for the configuration and management of back ends of handheld communication devices and smartphones and software for data analytics of smartphones and handheld communication devices (the Goods).

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

> Computer software development services; computer programming services; smartphone software development services; development of customized business solutions and integration, namely smartphone and software development services, telecommunication software and software for the configuration of handheld communication devices; consulting and analysis services relating to computer software, namely smartphone software, telecommunication software, software for the configuration and management of handheld communication devices and smartphones, software for the configuration and management of back ends of handheld communication devices and smartphones and software for data analytics of smartphones and handheld communication devices; design, implementation, installation, integration, maintenance, training and support of computer software, namely smartphone software, telecommunication software, software for the configuration and management of handheld communication devices and smartphones, software for the configuration and management of back ends of handheld communication devices and smartphones and software for data analytics of smartphones and handheld communication devices; technical deployment of computer software, namely smartphone software, telecommunication software, software for the configuration and management of handheld communication devices and smartphones, software for the configuration and management of back ends of handheld communication devices and smartphones and software for data analytics of smartphones and handheld communication devices (the Services).

[4] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with the each of the goods and services specified in the registration, at any time between March 30, 2014 and March 30, 2017. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reason for the absence of such use since that date.

[5] The relevant definitions of "use" are set out in sections 4(1) and 4(2) of the Act as follows:

> 4(1) A trademark 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 trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[6] 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 [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270]. A registered owner need only establish a *prima facie* case of use 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 paragraph 2].

[7] In response to the Registrar's notice, the Owner furnished the affidavit of its president and co-founder, Sigisbert Ratier, sworn on June 29, 2017. Only the Requesting Party filed written representations; a hearing was not requested.

[8] On April 26, 2019, the Registrar recorded Ineat Canada Inc. as the registered owner of the Mark. That change in title is not at issue in this proceeding.

THE OWNER'S EVIDENCE

[9] In his affidavit, Mr. Ratier states that the Owner creates and develops web and mobile applications, both for the general public and as enterprise solutions for various operations. He asserts use of the Mark in association with the Goods and Services in the normal course of trade since at least as early as November 2004 and, in particular, states that the Goods and Services were offered continuously under the Mark in Canada during the relevant period.

[10] With respect to the Goods, Mr. Ratier states that, in 2015-2016, the Owner created a mobile app called "EN PISTE" for La Fédération Québécoise de ski alpin (Ski Quebec). He states that the app is available on the iOS and Android platforms and updated in accordance with the contract between the Owner and Ski Quebec. As the first part of Exhibit SR-1 to his affidavit, he attaches an excerpt from this contract, dated September 17, 2015. The excerpted portion of the contract indicates that the Owner is to design, develop and update a mobile app—referred to in the contract as "*Grand Public Échauffement*" (general public warm-up)—to be distributed in mobile app stores on behalf of Ski Quebec and the Owner. The excerpt indicates that Ski Quebec is to recognize the Owner as its sponsor and display the Mark in various ways in connection with the sponsored programmes, including on event signage and online.

[11] As the remainder of Exhibit SR-1, Mr. Ratier attaches iTunes Preview and Google Play webpages promoting the "En Piste" app as a tool for the maintenance and sharing of good warm-up practices for skiers of all levels, featuring athletes from Ski Quebec in a series of instructional

videos. Both webpages indicate that the En Piste app is powered by the Owner and was last updated on October 20, 2016. The attribution "By Soluteo" is displayed immediately below the name "En Piste" at the top of the iTunes Preview page, which also identifies "Soluteo Canada" as the seller and "Soluteo Inc." as the copyright holder. The Mark is displayed without "By" immediately below the name "En Piste" at the top of the Google Play page, which also displays the website address *soluteo.com* among the app details. Screenshots from the app are displayed on both webpages, but the depicted screens do not show the Mark.

[12] The iTunes Preview excerpt indicates that the app is available for free; no price is indicated on the Google Play excerpt. However, Mr. Ratier also attaches, at Exhibit SR-5 to his affidavit, a June 2016 report from Ski Quebec setting out the return on investment for the Owner's sponsorship of competitive downhill skiing programmes. The report contains images of the signage and Internet advertising featuring the Mark that was posted by Ski Quebec, and provides these displays' dollar values to the Owner.

[13] With respect to the Services, Mr. Ratier states that the Owner uses the Mark in responding to requests for proposals, with each response detailing the services offered by the Owner. He further states that the Owner uses the Mark in advertising and promotion through various media, including sponsorships, the Internet, social media, brochures, exhibitions, and trade shows. He provides examples of proposals, presentations and other marketing materials as exhibits to his affidavit, as follows:

- Exhibit SR-2 is an April 2015 presentation of a proposed mobile application for tea purchasers, prepared in response to a request for proposals from a tea retailer. The functions of the app as described in the proposal include a product finder, a loyalty points card, steeping instructions, a personal log, and a postcard maker. A logo comprising the Mark in lower case with rays around the last letter, followed by an ® symbol, is displayed prominently on the cover and last pages of the presentation and in small print at the bottom of the content pages. However, neither the presentation itself nor Mr. Ratier's brief description of it indicates whether this presentation was delivered in Canada.

- Exhibit SR-3 contains extracts of a June 2015 presentation showcasing a mobile app for the management of work orders, developed for Videotron, which Mr. Ratier attests is a major telecommunications company in Canada. The logo described above, followed by the ® symbol, is prominently displayed on the presentation's cover and last pages and is displayed in a smaller size at the bottom of the content pages.

- Exhibit SR-3 also contains two invoices from the Owner for the delivery of services to Videotron, both dated during the relevant period. The first invoice is for quarterly support services and the second is for professional services and assistance relating to "anomalies". The Mark is prominently displayed in block letters on a square background at the top of each invoice, as well as being displayed in bold face above the Owner's address.

- Exhibit SR-4 contains two responses to requests for proposals for the design and development of mobile apps: the first is for a video sharing app and the second is for a mobile game linked to a television program, to be integrated with the television station's system for managing players and other content. Both proposals are dated during the relevant period. The Mark is prominently displayed on the proposals' cover and last pages and is also displayed in the pages' footer text. It is not clear whether the video sharing app proposal was delivered in Canada; however, the television station requesting the mobile game app appears to be Canadian.

- Exhibit SR-5 contains a promotional brochure that Mr. Ratier attests was given to clients and business partners in 2016-2017. I note that partners identified in the proposal itself include Bank of Montreal, Emploi Québec, Investissement Québec and the National Research Council. The brochure advertises a complete range ("*gamme complète*") of services in the mobile app sector, from strategy development, design creation, and the development of tailored solutions to post-launch support. The brochure advertises the Owner's process as one that includes business analysis, strategic design, implementation, deployment, testing, support, and project management, and also references strategic advice. The Mark is prominently displayed in a rectangle on the cover, first and last pages of the brochure, and is also displayed in the copyright notice on each page.

- As noted above, Exhibit SR-5 also contains a report from Ski Quebec regarding advertisement of the Mark. However, aside from a reference to innovation through mobile technology on two Internet advertisements, the advertising depicted in the report does not indicate the nature of the services offered under the Mark.

- Exhibit SR-6 consists of screenshots from the Internet Archive at *www.archive.org*, showing archived webpages from *www.soluteo.com* from April 7, 2014 and February 7, 2016. The webpage from 2014 is the homepage. It advertises enterprise solutions and lifestyle apps; for example, a screenshot from a CBC NEWS app is depicted. The Mark is displayed as a logo in the banner at top of the webpage and in the background of a photograph associated with the heading "About Us". The Mark is also displayed as a word on the browser tab and in the website address *www.soluteo.com*. The webpage from 2016 advertises that the Owner's "process" includes comprehensive analysis, a tailored game plan, strategic design, development and support. On this webpage, the Mark is only displayed on the browser tab—as "Soluteo | Innovate with mob…"— and in the website address *www.soluteo.com*.

[14] The proposals at Exhibit SR-4 each include a portfolio section that identifies work done for various clients. I note that, between the two proposals, several Canadian clients are identified, such as Videotron, Via Rail, Ski Quebec, McGill University Health Centre, and CBC Radio.

[15] The work done for Ski Quebec, as illustrated by Exhibit SR-1, is described in greatest detail in the first proposal at Exhibit SR-4. This description mentions in particular that the warm-up app developed for Ski Quebec "benefited [from] a great marketing campaign (TV shows, interactive ads, etc.) which resulted in hundreds of downloads in the first hours of launching the app" and that the app "has an average 5 stars rating on the Apple App Store" [at page 26].

[16] The work done for Videotron, as presented at Exhibit SR-3, is also described in greatest detail in the first proposal at Exhibit SR-4. This proposal mentions that the mobile solution developed for Videotron "encompasses many complex back-end systems built by Soluteo" and that "[t]he Soluteo middleware* abstracts all the communications with the various back-end systems from different vendors" [at page 16]. The description further mentions that this solution

"was built to manage any gain or loss of connectivity seamlessly and transparently", so that users can rely on the application "without having to worry about connection and transmission of information" [*ibid*]. "Middleware" is defined in the proposal as "the software layer that lies between the operating system and the applications on each side of a distributed computer network" [*ibid*]. Similar functionalities are also described in respect of a mobile application developed for Via Rail for on-train and station operations automation.

[17] Both proposals at Exhibit SR-4 also mention the development of a mobile news app that provides social interaction through sharing and commenting. The second proposal notes in particular that the Owner provided post production support for that app, while the first proposal specifies that the Owner also designed both phone and tablet versions of the app, as well as an Apple Watch version.

[18] I also note a brief description of work performed for CBC Radio in the second proposal at Exhibit SR-4, which states that the Owner acted as a strategic consultant with respect to mobility and mobile development for CBC Radio.

[19] Otherwise, the proposal for the video sharing app at Exhibit SR-4 describes the Owner's services as "comprehensive analysis, tailored game plan unique to each of our customers' needs, strategic design made by our team of experts in both user-experience (UX) and user-interface (UI), as well as impeccable development and support" [at page 6]. The proposal notes that "[i]ntegration testing is done at the end of every module (or feature)" [at page 39] and that "basic updates should be expected twice a year" [at page 49]. The proposal also indicates that the Owner offers "mobile strategy & consulting" [at page 4], as well as "ongoing review of data and implementation of resulting improvements" and "ongoing engagement work centred on analytics/performance improvement" [at page 50].

[20] The proposal for the mobile game app at Exhibit SR-4 notes that the majority of the Owner's solutions are mobile and that all use Web 2.0 for both front-end and back-end structure.

ANALYSIS

[21] In its written representations, the Requesting Party submits that the Owner has provided only "a limited amount of indirect and incomplete documentary evidence" that does not support

the "various assumptions and inferences" the Registrar would have to make to find use of the Mark.

[22] However, in the words of the Federal Court, the burden of proof in section 45 proceedings is "very light" [*Diamant*, *supra*, at para 9]. As noted above, a registered owner need only establish a *prima facie* case of use.

USE IN ASSOCIATION WITH THE GOODS

[23] Mr. Ratier asserts use of the Mark in association with the Goods in the normal course of trade during the relevant period. His assertion is supported by evidence that the Owner created a mobile application for warm-up exercises during the relevant period and that this application was first made available to the general public on the iTunes and Google play platforms sometime between September 15, 2017 and October 20, 2016, where it was presented as an app by "Soluteo".

[24] Although Mr. Ratier does not provide download figures, I am prepared to accept the statement regarding "hundreds of downloads in the first hours of launching the app"— in the description of the warm-up app in first proposal at Exhibit SR-4—as evidence of downloads of this app during the relevant period.

[25] The statement in the proposal is technically hearsay; however, the summary nature of section 45 proceedings is such that concerns with respect to hearsay should generally only go to the weight of the evidence, rather than its admissibility [see *Eva Gabor International Ltd v 1459243 Ontario Inc*, 2011 FC 18, 90 CPR (4th) 277]. Moreover, in the present case, I am prepared to infer from the fact that the Owner made the foregoing statement in a written proposal to a prospective client that such downloads in fact took place. In addition, given that the warm-up app features Quebec athletes and promotes the Quebec alpine ski federation, I am also prepared to infer that at least some of the downloads made during the relevant period would have been made by Canadians.

[26] In particular, the expression "in the normal course of trade" has been interpreted as "requiring that the transfer of the property in or of the possession of the wares be a part of a dealing in the wares for the purpose of acquiring goodwill and profits from the marked goods"

[*Cast Iron Soil Pipe Institute v Concourse International Trading Inc* (1988), 19 CPR (3d) 393 at para 6 (TMOB)]. The evidence must show that the good in question was delivered, not merely as a means of promoting *other* products or services, but as an object of trade in itself, leading to some kind of payment or exchange for such goods [see *Distrimedic Inc v Dispill Inc*, 2013 FC 1043; and *Oyen Wiggs Green & Mutala LLP v Flora Manufacturing and Distributing Ltd*, 2014 TMOB 105].

[27] In the present case, the evidence shows that the En Piste app was distributed to the public by the Owner and Ski Quebec pursuant to a contract under which the Owner received payment or exchange for the app, in the form of advertising services provided by Ski Quebec, worth in the order of the dollar amounts set out in Ski Quebec's report at Exhibit SR-5.

[28] Furthermore, the law is clear that the use of a trademark at any point along the chain of distribution will accrue to the benefit of the owner, provided that the marked goods originate from the owner [see *Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD); *Lin Trading Co v CBM Kabushiki Kaisha* (1988), 21 CPR (3d) 417 (FCA); and *Osler, Hoskin & Harcourt v Canada (Registrar of Trade Marks)* (1997), 77 CPR (3d) 475 (FCTD)]. Accordingly, I am satisfied that distribution of the app through the iTunes and Google Play websites accrues to the Owner's benefit.

[29] Moreover, the Owner's primary business, as described by Mr. Ratier, is the creation, development and provision of web and mobile apps, including apps for the general public. Thus the En Piste app is not distributed merely as a means of promoting *other* goods or services, but as an object of trade in itself, "leading to some kind of payment or exchange" for the goods—in this case, by Ski Quebec—and the acquisition of goodwill in the marked goods themselves.

[30] In the context of this overall dealing in the goods, I am prepared to accept the free distribution of the En Piste app as a "transfer ... in the normal course of trade" within the meaning of section 4(1) of the Act.

[31] Furthermore, I accept that display of "Soluteo" or "By Soluteo" under the name of the app on the Google Play and iTunes Preview webpages provides a notice of association between

the Mark and the mobile app at the time of transfer. In this respect, I am prepared to infer that at least some consumers would view such webpages just prior to, at, or just after download.

[32] The Requesting Party submits that such display of "Soluteo" is in reference to the Owner as a "corporate entity" rather than being use of a trademark. However, "[t]rade-mark and trade name usage are not necessarily mutually exclusive" [*Consumers Distributing Co/Cie Distribution aux Consommateurs v Toy World Ltd*, 1990 CarswellNat 1398 at para 14 (TMOB)]. Furthermore, it is well established that two trademarks may be used at the same time [see *AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD) at 272]. In any event, section 4(1) of the Act is clear as to the manners in which display of a trademark in association with goods constitutes use; embarking on an inquiry as to whether a trademark so displayed actually served to distinguish the goods in association with which it was displayed from the goods of others is beyond the scope of a section 45 summary cancellation proceeding [see *United Grain Growers Ltd v Lang Michener* (2001), 12 CPR (4th) 89 (FCA)].

[33] In summary, although the evidence in this case is somewhat indirect, the evidence in a section 45 proceeding need not be perfect, and the Registrar may draw reasonable inferences from the facts provided [*Diamant*, *supra* at paras 8–9; and *Spirits International BV v BCF SENCRL*, 2012 FCA 131, 101 CPR (4th) 413]. On balance, I am satisfied that the Owner's evidence is sufficient for a *prima facie* case of use in association with the goods "computer software, namely smartphone software".

[34] However, there appears to be no indication in the evidence that the app was in the nature of "telecommunication" software or that its purposes included "configuration and management of handheld communication devices and smartphones", "configuration and management of back ends of handheld communication devices and smartphones" or "data analytics of smartphones and handheld communication devices". To the extent that the other apps referenced in Mr. Ratier's affidavit might include any such characteristics or functionalities, there is no evidence that such apps were transferred in association with the Mark in the normal course of trade in Canada during the relevant period.

[35] Accordingly, I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the remaining Goods within the meaning of sections 4 and 45 of the Act.

[36] As the Owner furnished no evidence of special circumstances excusing non-use of the Mark within the meaning of section 45(3) of the Act, the registration will be amended to delete the remaining Goods.

USE IN ASSOCIATION WITH THE SERVICES

[37] Mr. Ratier asserts a continuous offering of the Services under the Mark in Canada during the relevant period. As noted by the Requesting Party, Mr. Ratier does not address each Service individually. However, he does provides several presentations and proposals to clients and prospective clients, as well as a promotional brochure and screenshots from the Owner's website, as examples of use of the Mark in association with the Services during the relevant period. These materials advertise a number of services in respect of smartphone apps and related software, which I accept as corresponding to the following registered Services:

> Computer software development services; computer programming services; smartphone software development services; development of customized business solutions and integration, namely smartphone and software development services, telecommunication software; consulting and analysis services relating to computer software, namely smartphone software, telecommunication software, software for the configuration and management of back ends of handheld communication devices and smartphones; design, implementation, installation, integration, maintenance, training and support of computer software, namely smartphone software, telecommunication software, software for the configuration and management of back ends of handheld communication devices and smartphones; technical deployment of computer software, namely smartphone software, telecommunication software, software for the configuration and management of back ends of handheld communication devices and smartphones.

[38] In particular, I am satisfied that the services described in the promotional brochure and in the proposal for the mobile game app correspond to these Services.

[39] To the extent that some of the Services, such as "installation" or "training", are not explicitly articulated in the foregoing documents, I accept that such Services fall within the promotional brochure's advertisement of a complete range of services from strategy development to post-launch support ("*une gamme de services complète, que ce soit pour l'élaboration d'une stratégie … jusqu'au support post-lancement*")— particularly in light of the brochure's specific mention of mobile app design, development, implementation, testing, deployment and support as other services in this range.

[40] The Requesting Party argues that certain descriptions in the exhibited documents read as a corporate profile summary of the Owner, unrelated to specific services to be rendered, or that they describe the Owner's approach to *executing* the services, rather than describing the nature of the services themselves.

[41] However, to the extent that such descriptions mention specific activities such as, for example, analysis, strategic advice, implementation, or deployment, I am satisfied that they advertise the Owner's willingness and ability to perform such services, as part of its process for creating and developing web and mobile apps or otherwise.

[42] Additionally, although Mr. Ratier does not expressly reference "computer software" or "computer programming", I find it clear from the exhibited evidence as a whole that such software and programming would be included in the broad scope of the Owner's web and mobile software development services for various platforms, as well as the Owner's integration of the developed software with clients' other systems and networks.

[43] With respect to distribution of the exhibited advertising, Mr. Ratier attests that the promotional brochure was given to clients and business partners in 2016-2017. Given that a large percentage of the Owner's clients and partners appear to be Canadian, I am prepared to infer that at least some of this French-language proposal's recipients would have been located in Canada. In addition, I accept that the exhibited presentations and proposals constitute targeted adverting sent directly to specific clients and prospective clients. Again, I am prepared to infer that at least some of these presentations and proposals, for example, the Videotron presentation and the proposal for the mobile game app, were delivered or given in Canada.

[44] With respect to the excerpts from the Owner's website at Exhibit SR-6, promotional material posted online must be "distributed" in order to constitute advertising. However, evidence from which it can reasonably be inferred that Canadians accessed the webpages in question can suffice [see *Ridout & Maybee LLP v Residential Income Fund LP*, 2015 TMOB 185, 136 CPR (4th) 127]. In the present case, although the Owner did not provide access data or other particulars for the exhibited webpages, I am prepared to infer that at least some Canadians would have viewed the pages in question, given the evidence that multiple Canadian entities have actually availed themselves of the Owner's services or partnered with the Owner. I am

therefore also satisfied that the exhibited webpages were "distributed" in Canada during the relevant period.

[45] The Requesting Party submits that there is no evidence that the various proposals referenced in the affidavit gave rise to commercial transactions.

[46] However, it is well established that display of a trademark in advertising services is sufficient to meet the requirements of section 4(2) of the Act, as long as the trademark owner is offering and prepared to perform the advertised services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[47] In the present case, it is clear from the evidence as a whole—including, in particular, the Owner's portfolio of work done for Canadian clients, referenced in proposals to prospective clients during the relevant period—that the Owner was willing and able to perform the advertised services in Canada during the relevant period. Moreover, although the invoices at Exhibit SR-3 do not reference specific services other than support services and assistance with "anomalies", I find that they corroborate the Owner's willingness and ability to perform Services in Canada during the relevant period.

[48] In summary, I am satisfied that the Owner was prepared to perform those Services set out above in Canada during the relevant period, and that materials advertising all of those services were distributed in Canada during the relevant period.

[49] With respect to display of the Mark in such advertising, the Mark is displayed prominently, standing on its own, often as a logo, in various locations throughout the exhibited advertising, including on the cover and last pages of the presentations, proposals and promotional brochure (Exhibits SR-2 to SR-5), at the top of the invoices (Exhibit SR-3), and in webpage titling (Exhibit SR-6).

[50] The Requesting Party submits that display of "SOLUTEO" on the first and last pages of the exhibited presentations is "without any indication of 'SOLUTEO''s meaning". However, I accept that the Mark, displayed on the presentations as a logo followed by the ® symbol, was displayed in the advertising of the services referenced in the presentation. I reach a similar conclusion with respect to display of the Mark, albeit without the ® symbol, on the first and last

pages of the proposals and brochures, and at the top of the invoices and webpage. Such display of the Mark is sufficient for the purposes of this proceeding. As discussed above, embarking on an inquiry as to a trademark's actual function when it is displayed in accordance with section 4 of the Act is beyond the scope of a section 45 proceeding [*United Grain Growers*, *supra*].

[51] I would also note that use of a word mark in combination with design elements qualifies as use of the word mark if the public, as a matter of first impression, would perceive the word mark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)] Moreover, a registration for a word mark can be supported by use of that mark in any stylized form [see *Stikeman, Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB)]. In the present case, I find that the Mark maintains its identity within the logo described above. The small rays at the end of the Mark do not provide enough visual interest to detract from the public's perception of the Mark *per se*.

[52] To the extent that the Requesting Party submits that references to SOLUTEO designate the Owner as a corporate entity, again, trademark and tradename usage are not necessarily mutually exclusive [*Consumers Distributing*, *supra*]. Indeed, a tradename may be displayed on advertising for the purpose of distinguishing or so as to distinguish an owner's services from those of others within the meaning of "trademark" as defined in section 2 of the Act.

[53] In view of the foregoing, I am satisfied that the Owner has demonstrated its display of the Mark in advertising those Services identified above in Canada during the relevant period.

[54] However, there appears to be no indication in the evidence that Services were advertised or performed in respect of software whose purposes included the configuration and management *of handheld communication devices and smartphones per se* or data analytics *of smartphones and handheld communication devices per se*. If the Owner advertised or performed Services in respect of software with such functionalities in Canada during the relevant period, Mr. Ratier does not attest to it in his affidavit. I accept that the Owner may *itself* have configured smartphones and communication devices or analyzed data from smartphones and communication devices in the course of performing Services; however, the evidence does not feature *software* for such tasks.

[55] Accordingly, I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the remaining Services within the meaning of sections 4 and 45 of the Act.

[56] As the Owner furnished no evidence of special circumstances excusing non-use of the Mark within the meaning of section 45(3) of the Act, the registration will be amended to delete the remaining Services.

DISPOSITION

[57] In view of all of the foregoing, 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 amended to delete the following from the statement of goods:

> [Computer software, namely …] telecommunication software, software for the configuration and management of handheld communication devices and smartphones, software for the configuration and management of back ends of handheld communication devices and smartphones and software for data analytics of smartphones and handheld communication devices.

and the following from the statement of services:

> … [development of customized business solutions and integration, namely …] software for the configuration of handheld communication devices; [consulting and analysis services relating to computer software, namely …] software for the configuration and management of handheld communication devices and smartphones, … and software for data analytics of smartphones and handheld communication devices; [design, implementation, installation, integration, maintenance, training and support of computer software, namely …] software for the configuration and management of handheld communication devices and smartphones, … and software for data analytics of smartphones and handheld communication devices; [technical deployment of computer software, namely …] software for the configuration and management of handheld communication devices and smartphones, … and software for data analytics of smartphones and handheld communication devices.

[58] The amended statement of goods and services will be as follows:

> **GOODS**
> Computer software, namely smartphone software.

SERVICES

Computer software development services; computer programming services; smartphone software development services; development of customized business solutions and integration, namely smartphone and software development services, telecommunication software; consulting and analysis services relating to computer software, namely smartphone software, telecommunication software, software for the configuration and management of back ends of handheld communication devices and smartphones; design, implementation, installation, integration, maintenance, training and support of computer software, namely smartphone software, telecommunication software, software for the configuration and management of back ends of handheld communication devices and smartphones; technical deployment of computer software, namely smartphone software, telecommunication software, software for the configuration and management of back ends of handheld communication devices and smartphones.

Oksana Osadchuk
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD

No Hearing Held

AGENTS OF RECORD

Miller Thomson S.E.N.C.R.L	FOR THE REGISTERED OWNER
Robinson Sheppard Shapiro S.E.N.C.R.L./L.L.P.	FOR THE REQUESTING PARTY