



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 74

Date of Decision: 2020-06-29

IN THE MATTER OF A SECTION 45 PROCEEDING

Aird & Berlis LLP

Requesting Party

and

Shane Wolffe

Registered Owner

TMA900,419 for FUTURE PROOF

Registration

[1] At the request of Aird & Berlis LLP (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 April 30, 2018 to Shane Wolffe (the Owner), the registered owner of registration No. TMA900,419 for the trademark FUTURE PROOF (the Mark).

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

Advice and consulting in the field of information technology and control systems to operate, track and automate equipment, sensors and computer components; Advice and consulting in the field of construction of commercial and residential buildings; Advice and consulting in the field of product development; Online based advice on renewable energy, greenhouse technologies, construction and energy efficiency; Consulting in the areas of energy and construction efficiency; Engineering consulting on industrial construction projects; Advice and consulting on gardening and greenhouses for the production of local food.

[3] The notice required the Owner to furnish evidence showing that he had used the Mark in Canada, at any time between April 30, 2015 and April 30, 2018, in association with 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.

[4] The relevant definition of use with respect to services is set out in section 4(2) of the Act as follows:

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.

[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 trademark in association with each of the services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

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

[7] In response to the Registrar's notice, the Owner furnished his own affidavit, sworn July 6, 2018 in Whitehorse, Yukon.

[8] Neither party submitted written representations; an oral hearing was not requested.

REASONS FOR DECISION

[9] Mr. Wolffe’s affidavit is structured such that each paragraph essentially correlates to one of the seven registered services and describes Mr. Wolffe’s activities in relation to such services. Five pages of unnotarized exhibits are attached to his affidavit. I will address each of the services in turn below.

Advice and consulting in the field of information technology and control systems

[10] With respect to “Advice and consulting in the field of information technology and control systems to operate, track and automate equipment, sensors and computer components”, Mr. Wolffe briefly describes his consulting work from 2012 to 2013 through his “now expired” and “insolvent” Saskatchewan-based company, Future Proof Commissioning Solutions Inc.

[11] He also states that, from July 2017 to May 2018, he provided “recommissioning services” to the Yukon government on a project through his “current” Yukon-based company, Future Proof My Building Consulting Ltd. Mr. Wolffe provides a brief description of the work involved and indicates that “This type of work will continue into the future”.

[12] I first note that the work done through Mr. Wolffe’s previous company was prior to the relevant period. With respect to his project work in 2017/2018, Mr. Wolffe provides no evidence of how the Mark was displayed in the advertisement or performance of such services. In the absence of representations, it is not clear whether perhaps the Owner is relying on a presumption that activities conducted by a business whose name includes “Future Proof” constitute use of the Mark. However, I note that the mere registration of a corporate name does not constitute use of a trademark within the meaning of section 4 of the Act [see *Schwalb v Godbout* (1987), 15 CPR (3d) 532 (TMOB)].

[13] In view of the foregoing, I am not satisfied that the Owner has established use of the Mark in association with these “advice and consulting” services within the meaning of sections 4 and 45 of the Act.

Advice and consulting in the field of construction of commercial and residential buildings

[14] With respect to the registered services “Advice and consulting in the field of construction of commercial and residential buildings”, Mr. Wolffe again references various projects conducted personally or through his previous company that predate the relevant period.

[15] Mr. Wolffe also attests that, in January 2013, he self-published the ebook, *How to Future Proof Your Home: A Guide to Building with Energy Intelligence in Cold Climates*, which is “a guidebook for consumers who wish to greatly improve the energy efficiency of their new or existing residential property”. He attests that this book was subsequently published in paperback and he indicates that it is available for purchase through *amazon.ca*. I also note that two of the exhibit pages are photographs of what appear to be interior pages of the book.

[16] However, I am not satisfied that the display of “How to Future Proof Your Home” (in the title or in uniform plain text as shown in the exhibited pages) constitutes display of the Mark as registered. In any event, as there is no indication that this publication was distributed during the relevant period or otherwise, it does not constitute evidence of use of the Mark in association with the subject services.

[17] With respect to the relevant period, Mr. Wolffe attests that he gave a paid presentation entitled “LEED V4, Passive House, Living Building Challenge Overview” to a group of Yukon housing contractors in February 2017. He attests that the presentation was regarding “residential green building standards” in the Yukon and that such standards “were presented with regards to ‘Future Proofing’ through construction”. However, no evidence of the manner of display of the Mark in the advertisement or performance of this presentation was furnished.

[18] Mr. Wolffe also attests that he was the host of “Future Proof Radio” on the Voice America Radio Network from November 2014 to February 2015. He states that the “show/podcast provides listeners with information about residential, commercial and industrial construction techniques and methods”. Although he attests that the podcast episodes are available online, neither evidence of distribution in Canada during the relevant period nor evidence of the manner of display of the Mark in the advertisement or performance of this show/podcast were furnished.

[19] Otherwise, Mr. Wolffe refers to his aforementioned work with the Yukon government on a project in 2017/2018 and attests that he “is currently in the process of acquiring new clients”.

[20] Again, absent evidence of how the Mark was displayed in the advertisement or performance of the subject services during the relevant period, I am not satisfied that the Owner has demonstrated use of the Mark in association with these “advice and consulting” services within the meaning of sections 4 and 45 of the Act.

Advice and consulting in the field of product development

[21] With respect to “Advice and consulting in the field of product development”, Mr. Wolffe only refers to activities that predate the relevant period, including work done on developing an online service “to connect the residential housing market with ‘Future Proof’ products and service providers” through another one of his companies, Future Proof Software Solutions Ltd. One of the exhibit pages appears to be a corporate profile report of this Saskatchewan-based company. However, Mr. Wolffe attests that the company became insolvent in 2016.

[22] In any event, there is no evidence that this online service was active during the relevant period or that the Mark as registered was associated with it.

[23] Accordingly, I am not satisfied that the Owner has established use of the Mark in association with these further “advice and consulting” services within the meaning of sections 4 and 45 of the Act.

Online based advice on renewable energy, etc.

[24] With respect to the registered services, “Online based advice on renewable energy, greenhouse technologies, construction and energy efficiency”, Mr. Wolffe refers to the aforementioned “Future Proof Radio” podcasts as well as his websites *www.FutureProofCx.ca* and *www.FutureProofMyBuilding.com*. One of the exhibit pages appears to be an undated screenshot of the latter website’s home page. Although Mr. Wolffe attests that “these websites and podcast are online and receive web traffic”, there is no indication of whether there was any meaningful traffic from potential Canadian customers during the relevant period such that the websites constituted advertisement or performance of the Owner’s “online based advice”

services. Furthermore, there is no indication that the exhibited screenshot represents the appearance of the website during the relevant period. In any event, I am not satisfied that the display of “future proof” together with “my building” in the url or otherwise as shown in the exhibited screenshot constitutes display of the Mark as registered. In this respect, I would note in part that the mere registration of a domain name does not constitute use of a trademark for purposes of section 4 of the Act [see *Sun Media Corp v Montreal Sun (Journal Anglophone) Inc*, 2011 TMOB 15]

[25] Accordingly, I am not satisfied that the Owner has demonstrated use of the Mark in association with such “online based advice” services within the meaning of sections 4 and 45 of the Act.

Consulting in the areas of energy and construction efficiency

[26] With respect to the services “Consulting in the areas of energy and construction efficiency”, Mr. Wolffe relies on the aforementioned projects, presentations and related activities from 2012 through the relevant period conducted by himself personally or through one of his companies.

[27] Again, it is not clear whether perhaps the Owner is relying on a presumption that activities conducted by a business whose name includes “Future Proof” constitute use of the Mark. However, as noted above, the mere registration of a corporate name does not constitute use of a trademark within the meaning of section 4 of the Act. Some evidence of how the Mark was displayed in the advertisement or performance of the services is still required.

[28] In any event, even if the Owner had displayed one of his companies’ names in the course of his business activities, absent evidence of such, I cannot determine whether it would constitute display of the Mark as registered, given the additional material in the company names.

[29] Accordingly, and in view of my conclusions above, I am not satisfied that the Owner has established use of the Mark in association with these “consulting” services within the meaning of sections 4 and 45 of the Act.

Engineering consulting on industrial construction projects

[30] With respect to the registered services “Engineering consulting on industrial construction projects”, Mr. Wolffe again refers to the aforementioned projects that predate the relevant period. He further states that, since the completion of those projects in 2014, “the time constraints of [Mr. Wolffe’s] business activities as well as work engagement in the field of industrial construction have prevented [Mr. Wolffe] from taking on further industrial projects to date”.

[31] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with these “engineering consulting” services within the meaning of sections 4 and 45 of the Act.

Advice and consulting on gardening and greenhouses for the production of local food

[32] With respect to the registered services “Advice and consulting on gardening and greenhouses for the production of local food”, Mr. Wolffe attests that he participated in a “Permaculture Design Course” and a “Fungi Academy Mushroom Course” in Costa Rica in March 2018, “with the intent to expand knowledge of growing local food and applying this knowledge to northern residents”. One of the exhibit pages attached to the affidavit is a copy of Mr. Wolffe’s participation certificate from the “Permaculture Design Course”. He attests that, during the course, he provided related *pro bono* consulting to a classmate.

[33] I note that Mr. Wolffe does not connect these activities to any display or use of the Mark; in any event, as none of these activities occurred in Canada, they are irrelevant for purposes of this proceeding.

[34] With respect to Canada, Mr. Wolffe indicates that he has been in discussions with potential Yukon-based clients who are “interested in constructing a facility for providing fresh food year round”. Again, however, Mr. Wolffe does not refer to the Mark when describing these activities.

[35] Mr. Wolffe does refer to a video and two articles written on this topic in 2012 and 2018, available via his above-mentioned websites. For the reasons above, however, I do not find that such websites constituted advertisement or performance of the Owner’s services, in association with the Mark or otherwise.

[36] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with these further “advice and consulting” services within the meaning of sections 4 and 45 of the Act.

Special Circumstances

[37] As described above, although Mr. Wolffe alludes to possible explanations for the absence of use of the Mark with respect to some of the registered services (*e.g.* time constraints and insolvencies), I do not find that there is any evidence of special circumstances excusing the absence of such use in this case.

DISPOSITION

[38] 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 the provisions of section 45 of the Act, the registration will be expunged.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: No Hearing Held

AGENTS OF RECORD

No Agent Appointed

For the Registered Owner

Aird & Berlis LLP

For the Requesting Party