



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 117

Date of Decision: 2021-06-00

IN THE MATTER OF A SECTION 45 PROCEEDING

John H. Simpson (Shift Law)

Requesting Party

and

WOWTOOLS.com, Inc.

Registered Owner

**TMA643,208 for THE MORTGAGE
COACH**

Registration

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA643,208 for the trademark THE MORTGAGE COACH (the Mark), currently owned by WOWTOOLS.com, Inc. (the Owner).

[2] All references are to the Act as amended June 17, 2019 (the Act), unless otherwise noted.

[3] The Mark is registered for use in association with “computer software for analyzing financial data” (the Goods).

[4] For the reasons that follow, I conclude that the registration ought to be maintained.

THE PROCEEDINGS

[5] At the request of John H. Simpson (Shift Law) (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on February 8, 2019 to the Owner of the Mark.

[6] The notice required the Owner to show whether the trademark has been used in Canada in association with each of the goods 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 February 8, 2016 to February 8, 2019 (the Relevant Period).

[7] The relevant definition of use in the present case is set out in section 4(1) 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.

[8] 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 at para 68] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at para 3]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the mark was used in association with the goods.

[9] In the absence of use as defined above, pursuant to section 45(3) of the Act, a trademark is liable to be expunged, unless the absence of use is due to special circumstances.

[10] In response to the Registrar's notice, the Owner furnished the affidavit of Greg Wexler sworn on September 6, 2019 to which were attached Exhibits A to H inclusive.

[11] None of the parties filed written representations and no hearing was held.

THE EVIDENCE

[12] Mr. Wexler describes himself as a co-founder of the Owner established in 1997 He affirms that he is familiar with the use of the Mark during the Relevant Period and has access to the Owner's records and has such he has personal knowledge of the facts described in his affidavit save and except where stated otherwise.

[13] Mr. Wexler affirms that the Owner in 1997 created and launched the Mortgage Coach, a software platform used by lenders to present multiple loan options clearly to consumers. He adds that using Mortgage Coach, lending professionals can analyze and communicate financial data in a proprietary interactive format. He explains that The Mortgage Coach application is available on every device type.

[14] Mr. Wexler affirms that The Mortgage Coach is used by thousands of mortgage brokers, from credit unions, and independent mortgage banks to create on demand visual presentations integrating audio and video narration, which are viewable on any device by the borrower.

[15] Mr. Wexler affirms that revenue is generated by the Owner from mortgage lenders. Specifically, mortgage lenders purchase access to the Mortgage Coach software platform, paying a fee to access the technology used to produce proprietary loan comparison presentations. The lender uses the Mortgage Coach software to provide information to customers who are considering obtaining lending services.

[16] Mr. Wexler explains that the Mark appears in the digital distribution platform store as the title of the application software in Google Play and Apple's App store at the time they are downloaded by the users in Canada. The Mark also appears as the device's avatar each and everytime it is used by the downloader.

[17] To illustrate the use of the Mark in Canada during the Relevant Period, Mr. Wexler attached the following exhibits:

- Exhibit B: a screenshot showcasing the application available for download on Google Play;
- Exhibit C: a screenshot showcasing the application available for download on the Apple App Store, along with confirmation that the seller is listed as the Owner of the Mark;
- Exhibit D: examples of what kind of information users of the software can access by logging into the mobile application.

[18] To support the allegation that the Mark has been used in Canada during the Relevant Period Mr. Wexler attached to his affidavit the following exhibits:

- Exhibit E: Google Play's Download Report exhibiting Canadian downloads of the Mortgage Coach application in September 2016. It was downloaded by five (5) Canadian mobile android devices;
- Exhibit F: Apple iOS's Download Report showcasing Canadian downloads of the Mortgage Coach application between September 2016 and September 2019. It shows that during this time, the application was downloaded onto 120 devices registered to Canadian users, with an average of 2-4 downloads per week during February 2016 to February 2019.

[19] Mr. Wexler identifies a Canadian potential user of the Goods as Alberta Mortgage Alliance and attached as Exhibit G is a screenshot of the Owner Hubspot page tracking interaction with Alberta Mortgage Alliance, including a record of advertising materials sent by the Owner to that company and a confirmation that communication was received by the potential client. This advertising communication started on January 14, 2019.

[20] Finally, Mr. Wexler explains that the Owner uses interchangeably Mortgage Coach and The Mortgage Coach on its website and attached as Exhibit I is a copy of the Owner's privacy policy showcasing the interchangeable language.

ANALYSIS AND REASONS FOR DECISION

Deviation from the Mark as registered

[21] In considering whether the display of a trademark constitutes display of the trademark as registered, the question to be asked is whether the trademark was displayed in such a way that it did not lose its identity and remained recognizable, in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see whether the “dominant features” of the registered trademark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. The assessment as to which elements are the dominant features and whether the deviation is minor enough to permit a finding of use of the trademark as registered is a question of fact to be determined on a case-by-case basis.

[22] Comparing the Mark to the trademark MORTGAGE COACH, in my view, the Mark did not lose its identity and remains recognizable. The dominant feature(s) of the Mark, namely MORTGAGE and COACH are still present in the trademark used by the Owner.

Use of the Mark

[23] The evidence described above shows that the Goods were downloaded in association with the Mark by Canadian customers during the Relevant Period.

[24] I conclude that the Owner has established use of the Mark in Canada in association with the Goods during the Relevant Period, within the meaning of section 4(1) of the Act.

DISPOSITION

[25] Pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

Jean Carrière
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

DAVID S. LIPKUS
(KESTENBERG SIEGAL LIPKUS LLP)

For the Registered Owner

SHIFT LAW

For the Requesting Party