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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 140

Date of Decision: 2021-06-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Norton Rose Fulbright Canada

Requesting Party

and

Roper House Publishing Ltd.

Registered Owner

TMA694,022 for MONEY MOTTO

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. TMA694,022 for the trademark MONEY MOTTO (the Mark), owned by Roper House Publishing Ltd. (the Owner).

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

THE PROCEEDINGS

[3] At the request of Norton Rose Fulbright Canada (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on November 14, 2017.

[4] The notice required the Owner to show whether the Mark had 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 November 14, 2014, to November 14, 2017.

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

GOODS

Books.

SERVICES

Educational services in the field of financial and life planning, conducting lectures in the field of financial and life planning, conducting seminars in the field of financial and life planning and motivational consulting in the field of financial and life planning.

[6] The relevant definitions of use in the present case are set out in section 4 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.

[7] It is well established that 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)]. However, 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 goods and services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Francesco Lombardo, sworn on May 28, 2018. Both parties submitted written representations; only the Requesting Party was represented at an oral hearing.

THE EVIDENCE

[9] Mr. Lombardo is an author and a financial wealth and life planner, the President and director of the Owner, and the founding principal and director of Veritage Family Office Limited, doing business as Veritage, Authentic Family Wealthcare (“Veritage”), a licensee of the Owner. He states that he developed for the Owner “a financial analysis approach to understanding an individual’s relationship with money called ‘MONEY MOTTO’” and has applied this approach as an “integral component of financial and life planning services” provided through the Owner and Veritage.

[10] Mr. Lombardo states that, in the course of providing such services, interviews and surveys with clients are summarized into a “MONEY MOTTO Value Conversation report for each client”. The results are then compiled into a “family wealth constitution”. As Exhibits C and D, respectively, Mr. Lombardo attaches copies of such materials; the words “Money Motto” appears on the cover and/or throughout the body of each such document, often accompanied by the TM or ® symbol. Although the documents are redacted, dates within the relevant period appear on the cover of each such document. He does not explicitly state that these documents were given to the clients; however, as Exhibit E, he attaches invoices from Veritage dated during the relevant period for “Values Conversation” and “Values and Family Wealth Constitution”. Although the Mark and the addresses of the clients do not appear on these invoices, the prices are listed in Canadian dollars and a Vancouver address is provided for Veritage. Mr. Lombardo states that during the relevant period, he has provided financial and life planning services to over 20 individuals in seven family groups, but does not state whether these clients were in Canada.

[11] Mr. Lombardo states that he has also published four books that have “MONEY MOTTO” as a central element of the book. As Exhibits G through J, he attaches excerpts from these books. One is entitled *MONEY MOTTO: The Path to Authentic Wealth*, and each of the four excerpts includes a table of contents showing a chapter title incorporating “Money Motto”. He states that the Owner has printed at least 2,000 copies of each of the books, and that “when providing financial and life planning services”, he “distribute[s] copies of such books to clients”. He further states that “I am advised by my on-line book sales agent that the general public has purchased 173 copies of my books between January 1, 2015 and January 1, 2018.”

[12] As evidence of promotional materials, Mr. Lombardo attaches excerpts from a brochure “used between the period of November 14, 2014 to November 14, 2017”, along with undated screenshots from the website *www.veritage.ca* as Exhibits B and L. Exhibit L lists a number of “past events” in Canada and elsewhere during the relevant period, which Mr. Lombardo states are speaking engagements concerning financial and life planning and discussing “MONEY MOTTO”. One such speaking engagement is dated January 13-14, 2016, in Halifax, Nova Scotia, and is entitled “Money Motto and Behavioral Risk”.

[13] Mr. Lombardo also states that the Owner licenced the Mark to third parties during the relevant period, including the CPA Education Foundation of Alberta and the Sauder School of Business at the University of British Columbia. As Exhibits M and O, he attaches a screenshot from a website associated with the CPA Education Foundation of Alberta and electronic slides used by the Sauder School of Business, respectively. Each of these materials displays the Mark.

REASONS FOR DECISION

[14] The Requesting Party raises the following issues: that the words “Money Motto” are not used as a trademark in the Owner’s evidence, that there is no evidence of sales of books in Canada during the relevant period, that any use in association with services by the Owner’s licensees would not enure to the Owner, and that the Mark was not used in the course of performance or advertising of any of the registered services. Each issue will be addressed in turn.

Use as a Trademark

[15] The Requesting Party submits that any use of the words “Money Motto” in evidence is in a descriptive sense and not to distinguish the Owner’s goods or services from those of others [citing *Piscitelli v Ontario (Liquor Control Board)*, 2001 FCT 868, and *Bodum USA, Inc v Meyer Housewares Canada Inc*, 2013 FCA 240 at para 155, for the proposition that a trademark is not “used” where it is used descriptively; I note that neither authority is a section 45 case]. Similarly, the Requesting Party submits that book titles are not registrable and cannot constitute use of a trademark. Further, the Requesting Party submits that the words Money Motto are not distinguished from the surrounding elements and are therefore not used as a trademark, citing

Medos Services Corp v Ridout and Maybee LLP, 2015 FCA 77 at para 5 [*Medos*]; and *Terrace (City) v Urban Distilleries Inc*, 2014 FC 833 at para 11 [*Urban Distilleries*].

[16] In response, the Owner submits that section 45 proceedings are not intended to determine substantive rights or issues such as ownership, distinctiveness, descriptiveness or abandonment of a registered trademark [see *United Grain Growers Ltd v Lang Michener*, 2001 FCA 66 [*United Grain Growers*]; *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD)]. In *United Grain Growers* at para 14, the Federal Court of Appeal wrote as follows:

No words in section 45 direct the Registrar to re-examine whether the registered trade-mark is used for the purpose of distinguishing, or so as to distinguish, wares. Rather, the Registrar’s duty under section 45 is only to determine, with respect to the wares specified in the registration, whether the trade-mark, as it appears in the Register, has been used in the three years prior to the request.

[17] In the oral hearing, the Requesting Party submitted that there is conflicting jurisprudence as to whether the Board may consider whether a trademark is being used “for the purpose of distinguishing or so as to distinguish their goods or services from those of others” as set out in section 2 of the Act. In this respect, the Requesting Party notes that the Federal Court of Appeal in *Plough* wrote that section 44 (now section 45) of the Act requires an owner to describe “use being made of the trade mark within the meaning of the definition of ‘trade mark’ in section 2 and of ‘use’ in section 4 of the Act” [emphasis added]. Similarly, the Requesting Party notes that in *Geox SPA v De Luca*, 2018 FC 855 at para 35 [*Geox*], the Federal Court wrote as follows:

The use of a trade-mark in association with goods is established when the following conditions are met at the time of transfer of the goods (*Havana House Cigar & Tobacco Merchants Ltd v Skyway Cigar Store* (1998), 81 CPR (3d) 203 (FCTD) at para 45):

1. the mark must be a trade mark as defined in s.2 [of the *Trade-marks Act*], that is, used for the purpose of distinguishing the wares;
2. the mark must be associated with the wares so that notice of the association is given; and
3. the transfer of the property or possession therein must occur in the normal course of trade.

[18] The Requesting Party notes the above passage was reproduced by the Federal Court in the section 45 case *Sim & McBurney v Gordon*, 2020 FC 710 at para 19 [*Gordon*] and by the

Federal Court of Appeal in *The Clorox Company of Canada, Ltd v Chloretec SEC*, 2020 FCA 76 [Clorox].

[19] The Requesting Party also submits that *United Grain Growers* should not be followed in view of the more recent Federal Court case of *Urban Distillers*, which I note is not a section 45 decision, and the Federal Court of Appeal decision of *Medos*, particularly paras 5 and 6:

[5] In the email communications, the word “medos” appears in two instances. The first is in the email address used by Mr. Vlasseros, which reads: alexmedossys@hotmail.com (appeal book at pp. 33 to 38). We need only say in this regard that a trade-mark is not used where it is not distinguished from surrounding text (*Terrace (City) v Urban Distilleries Inc*, 2014 FC 833 at para 11) and that in this instance, the text of the Mark has not been distinguished from any of the other elements of the address in question.

[6] The second appearance of the word “medos” is in the body of an email where “MEDOS SERVICES corp.” is identified as the firm that Mr. Vlasseros represents (appeal book at p. 37). However, use as a company name is distinct from use as a trade-mark and particularly unhelpful in proving use as a trade-mark where the mark is not distinguished from the surrounding text (*Hortilux Schreder BV v Iwasaki Electric Co*, 2011 FC 967 at para 12).

[20] Firstly, I note that the *Havana House* case relied on by the Court in *Geox* was a trademark infringement case, rather than a section 45 case. That case, in turn, referenced the earlier Federal Court case of *White Consolidated Industries Inc v Beam of Canada Inc* (1991), 39 CPR (3d) 94, which was also not a section 45 case. Similarly, the fact that *Geox* was cited approvingly by the Federal Court of Appeal in *Clorox*, an opposition proceeding, is of limited instructional value in a section 45 case.

[21] With respect to the citation of *Geox* in *Gordon*, it is important to note that *United Grain Growers* was not considered by the Court in *Geox* or *Gordon*, and neither case turned on whether use of the mark complied with section 2 of the Act. Moreover, the discussion of the limited scope of section 45 proceedings in *United Grain Growers* has been cited approvingly by the Federal Court in *Sim & McBurney v Parry*, 2010 FC 118 at paras 30-31, and by the Federal Court of Appeal in *BCF SENCRL v Spirits International BV*, 2012 FCA 131 at para 5. Accordingly, to the extent that *Geox* and *Gordon* may conflict with *United Grain Growers*, I am not prepared to depart from the binding precedent of the Federal Court of Appeal in *United Grain Growers* on the basis of these *obiter* references by the Federal Court.

[22] Furthermore, in my view, there is no conflict between *Medos* and *United Grain Growers*. The question before the Court in *United Grain Growers* was whether the Registrar had erred by considering whether the words COUNTRY LIVING would be perceived as a trademark to distinguish a magazine within the meaning of section 2, while the question in *Medos* was whether the trademark stood out from surrounding text or other elements. The question of whether a trademark stands out as a distinct trademark despite the addition of other elements is routinely considered in section 45 proceedings [see, for example, *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB); *Riches, McKenzie & Herbert v Pillsbury Co* (1995), 61 CPR (3d) 96 (TMOB) at para 14; *LE PEPE' SRL v PJ Hungary Kft*, 2017 TMOB 82 at paras 18-20], and is distinct from the question of whether a mark is being used as a trademark within the meaning of section 2 of the Act. In other words, whether use of a trademark in combination with additional words or features would be perceived as use of the mark *as registered* [per *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)] is a separate question from whether a mark is being used for the purpose of distinguishing an owner's goods or services from those of others.

[23] In any event, the present case is distinguishable from *Medos*, in which the only appearances of a word mark were as part of an email address and a trade name, and *Urban Distilleries*, where the only appearance of a word mark was in internal communications not circulated to members of the public (see below for further discussion on this point). In the present case, the evidence includes numerous instances of display of the Mark in books and other materials, including the following:

- (a) Exhibit C: the title on the report's cover page reads "Your Values. Your Money Motto®", and "Money Motto®" appears separately from other text in several instances in the body of the document.
- (b) Exhibit D: the constitution's table of contents includes a heading entitled "[redacted] and [redacted]'s Money Mottos™ (beliefs about money)", and "Money Motto™" appears in the singular and plural in headings throughout the document along with other text.

- (c) Each of the four books includes chapters entitled “The Money MottoTM: Who Is Really Running Your Life”, “The Money Motto”, “The Power of The Money Motto”, and “The Money Motto®: The Belief that Directs Your Wealth”, respectively.

[24] As the Requesting Party notes, the presence of the trademark symbol or ® symbol is not determinative in a section 45 proceeding [*Rogers, Bereskin & Parr v Canada (Registrar of Trade Marks)* (1986), 9 CPR (3d) 260 (FCTD) at para 15]. However, the presence of the symbols “may be considered a factor in the consumers’ perception of the mark” [*Legault Joly Thiffault SENCR v Harman International Industries, Incorporated*, 2019 TMOB 58 at para 17; see also *MLT Aikins LLP v Elco Systems Inc*, 2021 TMOB 42 at para 17; *Epic Aviation, LLC v Imperial Oil Limited*, 2020 TMOB 103 at para 20]. Thus, the impact of the trademark symbol is often considered in section 45 proceedings in the course of assessing whether a trademark stands out from surrounding material.

[25] In view of the foregoing, I find that in each of the above instances, the public would perceive the Mark as being used *per se* despite the addition of the definitive article “The”, pluralization of “Motto”, or the addition of the descriptive text noted above. I reach this conclusion based on the fact that the words Money Motto are the dominant element in each of the above formulations [see *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)] and are accompanied by the TM or ® symbol in many instances.

[26] Finally, although only one of the Owner’s book contains “Money Motto” in its title, all four books include a chapter title incorporating the Mark, as set out above. In *United Grain Growers*, use of the trademark “COUNTRY LIVING” was found where the registered owner furnished evidence of a magazine entitled *Country Guide* which included a regular feature section bearing the title COUNTRY LIVING. Similarly, I am satisfied in this case that the Mark was displayed on the report and constitution and on each of the books.

Sales of Books

[27] As noted by the Requesting Party, there are a number of “gaps” in Mr. Lombardo’s evidence where I am left to infer that the Owner used the Mark within the meaning of the Act. In

this respect, the Requesting Party submits that there is insufficient detail to conclude that any distribution of books in the course of Mr. Lombardo's financial and life planning services would amount to use in the normal course of trade.

[28] Although Mr. Lombardo states that he distributes his books when providing financial planning and life services, he provides no further details regarding the nature of such distribution. Nevertheless, the Owner submits that I should infer that such distribution amounts to transfers in the normal course of trade, citing *Theemes v Tigrent Learning Inc*, 2014 TMOB 124 at paras 20-21 [*Tigrent*] for the proposition that where goods and services are provided bundled together, the provision of goods bearing a trademark can be considered use of that trademark with both services and goods. I note that in *Tigrent*, the evidence indicated that in the course of performing its educational services, the owner sold educational materials which were integral to the performance of its services, and whose cost was included in the enrollment fee. On this basis, and on the basis of statements made by the affiant regarding the normal course of trade in the educational materials, the Board concluded that "a portion of the sales figures provided are attributable to the sale of the related educational wares" and that "these materials have added value and would be perceived as wares separate and apart from the educational services themselves" [para 21].

[29] *Tigrent* was distinguished by the Board in *CHR Holdings Inc v Release the Hounds*, 2017 TMOB 170 [*Release the Hounds*], in which the owner provided dog training goods to purchasers of its dog training services. Because the affiant provided no further details regarding the circumstances surrounding the provision of such goods to her customers, and because "there is no indication that customers are aware that goods form part of the transaction for the owner's services or are included as part of the purchase of such services" [para 24], the Board concluded that "any distribution of the goods appears to be for the promotion of the owner's services, rather than the goods being objects of trade in and of themselves" [para 25]. The Board reasoned that the circumstances of such distribution were less akin to *Tigrent* than to *Bremont Watch Co v Bremont Homes Corp*, 2016 TMOB 102 [*Bremont*], in which branded merchandise provided in the course of a real estate transaction was found to be "a mechanism to generate goodwill with respect to the sale of homes" and "used to promote the Owner's own services, rather than as objects of trade, in and of themselves" [para 28].

[30] I find the fact pattern in the present case to be more akin to *Release the Hounds* and *Bremont* than to *Tigrent*, given the lack of detail provided by Mr. Lombardo concerning the circumstances of how the books were distributed in the course of performance of the services, and particularly in the absence of evidence that the books were an object of trade in themselves or that a portion of the cost of the services was attributable to the books themselves. The Owner notes that the final page of the Exhibit C report states that “Learning materials and books are included in this session” and submits that it is reasonable to infer that some portion of the amounts charged to clients can be considered attributable to the books. However, I am not prepared to infer on the basis of this single sentence that a portion of the cost of the services was attributable to these books or that the books have added value or would be perceived as objects of trade separate from the services themselves, as was the case in *Tigrent* [see also *Brownlee LLP v 555, 129 Ontario Ltd*, 2013 TMOB 23 at para 16, regarding the distribution of promotional goods with the performance of services].

[31] As for Mr. Lombardo’s statement that he is “advised by [his] on-line book sales agent that the general public has purchased 173 copies of [the] books between January 1, 2015 and January 1, 2018”, the Requesting Party submits that any information provided by Mr. Lombardo’s agent is hearsay, and that in any event, the date range provided by Mr. Lombardo includes dates outside the relevant period and there is no confirmation that any such sales were in Canada.

[32] The Owner correctly notes that given the summary nature of section 45 proceedings, “concerns with respect to the hearsay nature of evidence can go to weight, rather than admissibility” [*Eva Gabor International Ltd v 1459243 Ontario Inc*, 2011 FC 18 at para 18]. I am willing to give weight to the statements of Mr. Lombardo’s agent; however, as noted by the Requesting Party, gaps remain in the evidence such that I am asked to infer that some of these online sales occurred during the relevant period in the absence of explicit confirmation by Mr. Lombardo.

[33] In this respect, the Owner submits that because the three-year date range provided by Mr. Lombardo differs from the relevant period by only a few weeks, it would be unreasonable to conclude that each of the 173 sales were made in the few weeks after the relevant period. In

support of this submission, the Owner cites *Alliance Laundry Systems LLC v Whirlpool Canada LP*, 2013 TMOB 218 at paras 27-30 [*Whirlpool*], in which use of a trademark was found where the affiant provided sales figures for a lengthy period including the relevant period, confirmed that some of those sales figures were from the relevant period, and provided invoices showing sales from after the relevant period. However, I note that that case was overturned by the Federal Court of Appeal [*Alliance Laundry Systems LLC v Whirlpool Canada LP*, 2015 FCA 232]; the Court held that the evidence “does not, even on a generous view of its contents, meet the low threshold of evidence required to show use of the trade-mark at issue in association with the respondent’s goods” [para 2].

[34] In this case, unlike *Whirlpool*, there is no confirmation from Mr. Lombardo that any sales took place during the relevant period. The Federal Court has held that “referring to use on dates that are contained both within and outside the relevant period does not provide clear evidence, because it cannot be determined if any use has occurred specifically during the relevant period” [*Grapha-Holding AG v Illinois Tool Works Inc*, 2008 FC 959 at para 22; see also *88766 Canada Inc v Monte Carlo Restaurant Ltd*, 2007 FC 1174 at para 9]; this principle has been followed by the Board even where only a small portion of a range of dates falls outside the relevant period [see, e.g., *BCF LLP v Conair Corp*, 2018 TMOB 81 at paras 44-45]. I would add that in a section 45 proceeding, the Owner bears the full onus to provide evidence such that the Board can rely on proven facts, rather than speculation, to satisfy each element required by the Act.

[35] Accordingly, I am not satisfied that the Owner used the Mark in association with the registered goods within the meaning of the Act. As there is no evidence of special circumstances excusing non-use, the registration will be amended accordingly.

Licensed Use

[36] The Requesting Party submits that any use of the Mark in association with the registered services by Veritage or the Owner’s other licensees would not enure to the Owner as Mr. Lombardo has not stated that the Owner exercises control over the character and quality of services provided by licensees in association with the Mark, provided evidence demonstrating such control such as a licence agreement, or provided evidence of a relationship between the Owner and its licensees from which such control can be inferred.

[37] In response, the Owner submits that because Veritage is identified as a licensee of the Owner, and because Mr. Lombardo is both the President and director of the Owner and the founding principal and director of Veritage, and personally provides the services through Veritage, it can be inferred that the requisite control exists [see *Petro-Canada v 2946661 Canada Inc* (1998), 83 CPR (3d) 129 (FCTD); *Lindy v Canada (Registrar of Trade Marks)*, [1999] FCJ No 682 (FCA)].

[38] I concur with the Owner that it can be inferred that the requisite control exists over the services provided in association with the Mark by Veritage. While the Requesting Party rightly notes that a corporate relationship alone is insufficient to establish use that accrues to the benefit of the owner of a trademark [*Live! Holdings, LLC v Oyen Wiggs Green & Mutala LLP*, 2020 FCA 120 at para 47], in this case, I am prepared to infer that the requisite control exists, particularly given that Mr. Lombardo, who is the President of the Owner, personally performs the services in question for the licensee.

[39] However, in the absence of any further details, I am not prepared to infer from the mere fact that a licence exists that the Owner exercises the requisite control over services performed by the CPA Education Foundation of Alberta or the Sauder School of Business. Accordingly, I am not satisfied that any use of the Mark by these entities would enure to the Owner.

Use in Association with the Registered Services

[40] With respect to the registered services, the Requesting Party submits that Mr. Lombardo does not identify which registered services are being performed or advertised in the exhibited materials. In this respect, the Requesting Party cites *Sim & McBurney v Nikita ehf*, 2015 TMOB 222 and *John Labatt* for the proposition that where a registrant provides evidence of use in association with one registered good, it cannot rely on the same evidence to show use in association with separately listed goods or services.

[41] In response, the Owner submits that Mr. Lombardo's financial and life planning sessions constitute "educational services in the field of financial and life planning", "motivational consulting in the field of financial and life planning", and "conducting seminars in the field of financial and life planning", while the 2016 Halifax "Money Motto and Behavioral Risk"

speaking engagement listing constitutes performance, or at least advertising, of “conducting lectures in the field of financial and life planning”.

[42] Given that one is not to be “astutely meticulous when dealing with [the] language used” when interpreting a statement of goods or services in a section 45 proceeding [see *Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654 at para 17], and that “in certain cases, statements of services contain overlapping and redundant terms in the sense that the performance of one service would necessarily imply the performance of another” [*Gowling Lafleur Henderson LLP v Key Publishers Co*, 2010 TMOB 7 at para 15; see also *Borden Ladner Gervais LLP v TLN Media Group Inc*, 2021 TMOB 161 at para 34; *Borden Ladner Gervais LLP v Flores*, 2021 TMOB 151 at para 24], I agree with the Owner that Mr. Lombardo’s financial and life planning services for individuals and family groups would amount to “educational services in the field of financial and life planning”, “motivational consulting in the field of financial and life planning”, and “conducting seminars in the field of financial and life planning”.

[43] While Mr. Lombardo has provided some detail regarding performance of these services, the Requesting Party submits that gaps in the evidence remain; particularly, that there is no indication that the Exhibit C and D materials were actually provided to clients in the course of performance of the services, rather than being internal documents. However, because at least some of the Exhibit C reports and the Exhibit D “constitution” appear to include materials written by the clients in the first person, and because Exhibit E includes invoices for these documents, I am prepared to interpret Mr. Lombardo’s statement that the documents were prepared “for” the clients as meaning that they were actually given to the clients in the course of performance of the services. As the Mark appears throughout these materials, I am satisfied that the Mark was displayed in the course of performance of these services. In this respect, although the Requesting Party submits that the word “Veritage” would be understood by customers as designating the source of these materials, there is nothing in the Act that prevents multiple trademarks from being used concurrently. In any event, as discussed above, the Mark was displayed on Mr. Lombardo’s books; even if books were not transferred as objects of trade in themselves, their distribution in the course of performance of services would constitute display of the Mark in association with those services.

[44] The Requesting Party also notes that there is no clear statement that the services were performed in Canada. However, the invoices for the services are listed in Canadian dollars, include GST charges, and show a Canadian address for Veritage, and the Exhibit D constitution includes a reference to Canada, all of which are consistent with performance of the services in Canada. I am therefore satisfied that there are sufficient indicia in evidence to permit me to infer that Mr. Lombardo performed his financial and life planning services in Canada during the relevant period. Given that the Mark was displayed in the course of performance of those services on the Exhibit C and D materials and Mr. Lombardo's books, I am satisfied that the Owner used the Mark within the meaning of the Act in association with the registered services "educational services in the field of financial and life planning", "motivational consulting in the field of financial and life planning", and "conducting seminars in the field of financial and life planning".

[45] With respect to the 2016 Halifax speaking engagement, the Requesting Party submits that the Board is asked to infer that the event actually took place, and that the Mark was displayed in the course of that event. The Owner submits that it is reasonable to infer that the Mark was displayed and used during this speaking engagement, and in any event, the fact that this event is listed in association with the Mark on the Owner's website constitutes use of the Mark in advertising.

[46] I concur with the Requesting Party that the past event listing does not demonstrate use of the Mark in association with "conducting lectures in the field of financial and life planning" in that it does not show *how* the Mark was used in the course of performance of those services. While it could be that "Money Motto and Behavioral Risk" was the title of the lecture and that this title was displayed on promotional materials or in the course of the presentation, it would be speculative, in my view, to draw such a conclusion on the basis of the past event listing alone. The only details Mr. Lombardo provides in this regard are that he has done "numerous speaking engagements concerning financial and life planning and discussing MONEY MOTTO"; however, verbal references are insufficient to establish use of a word mark [*Playboy Enterprises Inc v Germain* (1987), 16 CPR (3d) 517 at para 10; *Plant Products Co v Greenstar Plant Products Inc*, 2011 TMOB 220 at para 98]. While Mr. Lombardo confirms that the Exhibit K brochure was "used" during the relevant period, he provides no information regarding the

circumstances of such use, including whether such use was in Canada; in any event, the brochure does not appear to advertise the Owner's "lecture" services as opposed to the other financial and life planning services. Finally, the past event listing, and the website materials in general, do not support use of the Mark in advertising during the relevant period, given that it is not clear that the screenshots are from the relevant period or that the Mark was displayed in the manner shown during the relevant period.

[47] As there is no indication that other evidence would support use of the Mark in association with the registered services "conducting lectures in the field of financial and life planning", I am not satisfied that the Owner has used the Mark in association with this service within the meaning of the Act. As there is no evidence of special circumstances excusing non-use, the registration will be amended accordingly.

DISPOSITION

[48] 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 amended to delete the registered goods, as well as "conducting lectures in the field of financial and life planning" from the registered services.

[49] The amended statement of services will be as follows:

Educational services in the field of financial and life planning, conducting seminars in the field of financial and life planning and motivational consulting in the field of financial and life planning.

G.M. Melchin
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2021-06-10

APPEARANCES

No one appearing For the Registered Owner

Karen MacDonald For the Requesting Party

AGENTS OF RECORD

Oyen Wiggs Green & Mutala LLP For the Registered Owner

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