



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 190

Date of Decision: 2021-08-27

IN THE MATTER OF A SECTION 45 PROCEEDING

Smart & Biggar LLP

Requesting Party

and

MMG Management Consulting Inc.

Registered Owner

TMA951,963 for MITCHELL

Registration

MADISON GROUP

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. TMA951,963, owned by MMG Management Consulting Inc. (the Owner), for the trademark MITCHELL MADISON GROUP (the Mark).

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

THE PROCEEDING

[3] At the request of Smart & Biggar LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on October 24, 2019, to the Owner.

[4] The notice required the Registrant to show whether the Mark had been used in Canada in association with each of the 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 October 24, 2016 to October 25, 2019.

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

Consulting services in the field of corporate finances, namely, economic and financing forecasting, establishment of corporate and business structures and business structuring, management and operation of business, marketing and advising business in the field of distribution and retail matters; consulting and advising in the field of computers. (the Services)

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

[7] It is well established that bare statements that a trademark is in 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)].

[8] In response to the Registrar's notice, the Registrant furnished the affidavit of Hans Dau, Chief Executive Officer of the Owner, declared on May 21, 2020. No written representations were submitted and no hearing was held.

THE EVIDENCE

[9] The statutory declaration is brief, consisting of the following substantive paragraphs and image without exhibits:

3. The Registrant operates a business using the Trademark in the performance of the following services in Canada: [the Services]

4. Following is a list of Canadian traffic for the Registrant's website <https://www.mmcmc.com> for the years 2017, 2018 and 2019, which website displays the Trademark advertising the Services:

	Country	Year	Acquisition		
			Users	New Users ↓	Sessions
			387 % of Total 1.82% (21,210)	384 % of Total 1.81% (21,192)	453 % of Total 1.70% (26,617)
1.	Canada	2019	203 (52.32%)	202 (52.60%)	231 (50.99%)
2.	Canada	2018	136 (35.05%)	133 (34.64%)	158 (34.88%)
3.	Canada	2017	49 (12.63%)	49 (12.76%)	64 (14.13%)

5. During the period of 2017-2018 the Registrant provided the Services using the Trademark for a Canadian Client, which Services had a value in excess of U.S. \$6,000,000.

6. In addition, the registrant has provided the Services using the Trademarks for a number of Canadian companies.

REASONS FOR DECISION

[10] As a preliminary matter, I note that pursuant to section 45(2) of the Act, I cannot consider evidence beyond what is contained in the Owner's evidence of record. As such, despite the link to the Owner's website provided in Mr. Dau's affidavit, I cannot consider any content of that website as evidence in this proceeding.

[11] Otherwise, while Mr. Dau states that "During the period of 2017-2018 the Registrant provided the Services using the Trademark for a Canadian Client...", mere statements that a

trademark was in use during the relevant period are insufficient [Plough (Canada) Ltd v Aerosol Fillers Inc (1980), 53 CPR (2d) 62 (FCA)]; a trademark owner must provide evidence *demonstrating* that the trademark was used in association *with each* of the registered services in Canada during the relevant period. Such evidence will often be in the form of invoices, sales reports, or equivalent factual particulars. Based on the evidence provided, even if I were to infer that all of the Owner's Services were performed in Canada, it would be speculative for me to conclude that the Mark as registered was displayed in the performance or advertising of any such services.

[12] Accordingly, I am not satisfied that the Owner has demonstrated use of the Mark – as registered or otherwise – in association with any of the Services in Canada within the meaning of sections 4 and 45 of the Act.

[13] Furthermore, there is no evidence of special circumstances excusing non use of the Mark before me.

DISPOSITION

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

Martin Béliveau
Chairperson
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

Gattuso Bourget Mazzone S.E.N.C.

For the Registered Owner

Smart & Biggar LLP

For the Requesting Party