



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 196

Date of Decision: 2021-08-31

IN THE MATTER OF A SECTION 45 PROCEEDING

Julie MacDonell

Requesting Party

and

Six Real Estate Consulting Creative

Registered Owner

Marketing Solutions Inc.

TMA726,072 for SIX & DESIGN

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. TMA726,072, currently owned by Six Real Estate Consulting Creative Marketing Solutions Inc. (the Owner), for the trademark SIX & DESIGN (the Mark), shown below:



[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 the following services:

Real estate services, market analysis services, market research services, marketing services, namely, real estate consulting services for real estate developers, namely, designing, printing and collecting market information, design, namely, graphic art and commercial art, developing promotional campaigns for real estate developers.

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

THE PROCEEDINGS

[5] At the request of Julie MacDonell (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on October 9, 2019, to the Owner.

[6] The notice required the Owner to show whether the trademark was 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 9, 2016 to October 9, 2019 (the Relevant Period).

[7] The relevant definition of use in the present case 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.

[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 all of the services.

[9] In response to the Registrar’s notice, the Owner furnished the affidavit of Norbert Park, sworn on January 7, 2020, to which were attached Exhibits A to Q.

[10] No written representations were submitted and no hearing was held.

THE EVIDENCE

[11] Mr. Park is the founder, president, director, and a shareholder of the Owner and he has been with the company since its inception in 2007. He explains that the Owner “provides real estate developers with various services including new project marketing, sales management, sales training and mentoring and property listing and selling as well as general consulting relative to the real estate industry.” He states that the marketing services include the development of strategies and tactics pertinent to a range of real estate projects and that training and mentoring includes analysis and provision of sales effectiveness programs [para 4].

[12] Mr. Park defines all of the registered services as the Consulting Services and states that during the Relevant Period, the Owner used the Mark in Canada in association with the Consulting Services [paras 3 and 9]. Mr. Park also states that the Owner used the Mark during the Relevant Period in advertising of such services and provided clients with various marketing items in print form [exhibits A to F], all of which displayed the Mark [para 10].

[13] In support, Mr. Park attaches the following relevant exhibits to his affidavit:

- Exhibit A: A 20-page marketing brochure displaying the Mark describing the services offered by the Owner titled “Real Estate Consulting – Creative Marketing Solution” along with a partial list of clients with more than 20 names. The services are defined in the brochure as follows:
 - Research, which includes market analysis, site specific reports, market & site feasibility studies, and consumer research.
 - Consulting, which includes market positioning & strategy, product refinement & recommendations, and pricing strategy.

- Marketing, which includes logo & brand ID; print, online, outdoor & radio advertising campaigns; print communication & sales collateral; sales centre concepting & display design; sales centre signage; web design & interactive email campaign; promotional items; and, event management.
- Exhibits B to F: Business card, note pad, envelope and other print materials, all displaying the Mark that were provided to clients as part of the Owner's advertising [para 10].
- Exhibit J: Copy of a consulting agreement from the Relevant Period between the Owner and Arlington Street Developments for a project located in Calgary to provide: a marketing plan; product and specifications; pricing analysis and consultation; advertising and design oversight; sales center consultation; sales launch services; and, sales management services for a monthly consulting fee. The agreement bears the Mark at the top of each page.
- Exhibit L: Copy of a consulting agreement from the Relevant Period between the Owner and 1251657 Alberta Ltd. to provide market research and marketing strategy for a set amount of \$5,000. The agreement bears the Mark at the top of each page.
- Exhibit N: Multiple invoices from the Relevant Period, with redacted client names and addresses, for: monthly consulting fees; sales training; research & marketing strategy; sales and competitive shop and analysis; and, services rendered. Each invoice bears the Mark at the top and bottom of the page.

ANALYSIS AND REASONS FOR DECISION

[14] Given that no party has submitted written representations and based on the evidence described above, the only question left to address is whether or not the evidence described above establishes that there has been use of the Mark in Canada during the Relevant Period in association with the registered services within the meaning of section 4(2) of the Act.

[15] In my view, the Owner has shown that its services were available and performed in Canada during the Relevant Period [paras 3 and 9, Exhibit N] and has shown that the Mark was displayed in the performance and advertising of such services. In particular, the Mark appeared on the marketing brochure describing the services offered by the Owner for services associated with the Mark [Exhibit A], on promotional material provided to clients [para 10, Exhibits B to F], on consulting agreements describing the services offered by the Owner to clients during the Relevant Period for services associated with the Mark [para 11, Exhibits J and L] and on invoices [para 13, Exhibit N]. Based on this, I am satisfied that the Owner has shown use of the Mark in Canada within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[16] In view of the above, 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.

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

BORDEN LADNER GERVAIS LLP

For the Registered Owner

JULIE MACDONELL

For the Requesting Party