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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 009

Date of Decision: 2022-01-26

IN THE MATTER OF A SECTION 45 PROCEEDING

**Anahée Carreau Horizon Propulsion
Inc.**

Requesting Party

and

**Spark Training & Coaching
Associates Inc.**

Registered Owner

**TMA730,299 for SPARK TRAINING
& COACHING ASSOCIATES INC.**

Registration

& Design

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. TMA730,299 for the trademark SPARK TRAINING & COACHING ASSOCIATES INC. & Design (the Mark), owned by Spark Training & Coaching Associates Inc.

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

[3] The Mark is registered for use in association with goods and services listed in Schedule “A”.

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

PROCEEDINGS

[5] At the request of Anahée Carreau Horizon Propulsion Inc. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on August 6, 2020, to Spark Training & Coaching Associates Inc. (the Owner), the registered owner of the Mark.

[6] The notice required the Owner to show whether the trademark was 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 August 6, 2017 to August 6, 2020 (the Relevant Period).

[7] The relevant definitions of use 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.

[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. The evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184]. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant* at para 9].

[9] In the absence of use, pursuant to section 45(3) of the Act, the registration 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 an affidavit of Ms. Caroline Williams, sworn on November 3rd, 2020, to which were attached nine supporting documents.

[11] Both parties submitted written representations and no oral hearing was held.

THE EVIDENCE

[12] Ms. Williams is the Director and Chief Learning Officer of the Owner since 2011. She affirms that the Owner's provides counseling, training and coaching programs as well as assessments tools to its clients either online or face to face. She also explains that the Owner's clientele includes individuals, associations and corporations from the manufacturing, financial, education, marketing and non-profit sectors, among others.

[13] Ms. Williams affirms the Owner has used the Mark in Canada during the Relevant Period in association with "printed materials namely books, guides, manuals; behavioural assessment tools and resources namely assessment tests, educational tests, tests, skill tests, development tests, answer sheets, feedback reports, information booklets, and users guides in the field of psychometric testing, personality testing, emotional intelligence, leadership impact, managerial effectiveness, working styles, workplace behaviours, and 360 assessments." (para 5).

[14] Ms. Williams affirms the Owner has offered and provided information, counselling and training in the areas listed in the registration across Canada during the Relevant Period. She explains that the Owner's programs are customized to meet specific needs of each client (paras 2, 3 and 6).

[15] Ms. Williams includes four screenshots obtained from the Internet Wayback Machine (paras 7 and 8) and affirms they are representative of the manner which the Mark was displayed on the Owner's website during the Relevant Period. The following additional relevant exhibits are attached to her affidavit:

- Exhibit 1(a) consists in excerpts from handbook/participant handouts and guides. I note that there are two different documents. The first document, dated October 2018, is entitled "DISCover Your Working Style". The second, undated, is entitled "Managing Time to Increase Personal Productivity";

- Exhibit 1(b) consists in excerpts from a personalized “Assessment/Test/Report” and tip sheet entitled “Working with DISC”, dated July 04, 2019;
- Exhibit 2(a) consists in a copy of an invoice dated November 15, 2018. I note that “DISCover Your Working Style Reboot” and “Participant materials” are specified in the body of the invoice;
- Exhibit 2(b) consists in a copy of an invoice dated October 5, 2018;
- Exhibit 2(c) consists in a copy of a workshop proposal entitled “DISCover Your Working Style”;
- Exhibit 2(d) consists in a copy of a proposal entitled “One on One Virtual Coaching Program”;
- Exhibit 2(g) consists in a copy of an invoice dated October 15, 2018. I note that “BASF Team Excellence – Instructional Design” is specified in the body of the invoice.

ANALYSIS AND REASONS FOR DECISION

Use with respect to goods (1)

[16] First, I note that the Requesting Party’s written representations makes no reference to any of the registered goods. Second, the Owner’s evidence is completely silent concerning the following goods:

“Pre-recorded audio and audio-visual recordings, namely cassettes, CD's and DVD's on business etiquette, leadership development, managerial effectiveness, personal effectiveness, professional presence, stress management, time management, executive on-boarding, emotional intelligence, presentation skills, change management, communication skills, performance management, public speaking, organization development, sales effectiveness, goal setting, team building, team engagement, decision making, work-life balance, attracting and retaining talent”.

[17] Consequently, I am not satisfied that the Owner has demonstrated use of the Mark in association with them within the meaning of sections 4 and 45 of the Act. As the Owner furnished no evidence of special circumstances excusing non-use of the Mark for those goods, the registration will be modified accordingly.

[18] With respect to “printed materials namely books, guides, manuals; behavioural assessment tools and resources namely assessment tests, educational tests, tests, skill tests, development tests, answer sheets, feedback reports, information booklets, and users guides (...)”, the Mark is displayed either on the cover page or at the top of the subsequent pages of the guide [Exhibit 1(a)]. The Mark is also displayed on page 2 of the of the Assessment/Test/Report

[Exhibit 1(b)]. Ms. William affirms that those documents are representative examples of how the Owner used the Mark in association with those goods in Canada during the Relevant Period (para 5). Furthermore, the evidence shows that such materials were provided to the Owner's clients during the Relevant Period as they are referred to in the body of the invoices [Exhibits 2(a) and (b)].

[19] Given the evidence described above and that the Requesting Party has not made any representation concerning this evidence, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4(1) and 45 of the Act in association with those goods.

Use with respect to services

Use with respect to services listed in (1)

[20] The Requesting Party submits that the Owner's evidence shows use of other trademarks, not the Mark, in association with the services(1). Particularly, it is submitted that the trademarks in use are DISC, "DISCover Your Working Style" and Disc® as they appear in the body of the invoices, in the printed materials and in the proposals. The Requesting Party also submits that the Mark was not shown in the performance or in the advertising of the registered services. Although I agree that the Mark is not shown in the body of the invoices and that they were drawn up necessarily after the performance of the services, all the evidence must be considered as a whole.

[21] With respect to "Conducting psychometric assessments" and "conducting workshops", the Owner provides a workshop proposal [Exhibit 2(c)] entitled "DISCover Your Working Style" as well as its respective guide [Exhibit 1(a)]. The Mark is displayed at the top of the documents and their content expressly refers to an assessment (pages 1-2 and page 3, respectively). Furthermore, the invoice [Exhibit 2(a)] shows that the service and materials related to the "DISCover Your Working Style" workshop were provided as they appear in the body of the invoice. Finally, I note that the invoice's billing address is located in Canada.

[22] With respect to "counselling and training", it is important to consider the evidence as a whole. Ms. Williams attests that the document entitled "One on One Virtual Coaching Program" [Exhibit 2(d)] is a proposal for a coaching/training program. The Mark is displayed at the top of all the pages and the reference to the HST on page 3 supports Ms. Williams' statement that those

services were offered in Canada. As she affirms this training was held from January to September 2019 (para 6 of Williams' affidavit), I conclude the Owner used the Mark in association with those services.

[23] Finally, concerning the Requesting Party's submissions about the use of other trademarks for services (1), it has been decided that there is nothing to prevent two or more trademarks being used at the same time. [see *AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)].

Use with respect to services (2)

[24] With respect to "Online information services and training services", the Requesting Party submits that the proposal for the Virtual Coaching Program [Exhibit 2(d)] is not intended to advertise such services to the public. As indicated above, the evidence as a whole shows that these services were to be provided online. Furthermore, even if the evidence is related to a specific client, that client is part of the specific clientele described by Ms. Williams (referred in paragraph 12 above). The use of a trademark in association with services does not necessarily mean that the services need to be offered to the public in general; it could be addressed to a specific clientele. Ms. Williams refers to the document as being a representative example of a proposal presented to a targeted client.

[25] The Requesting Party also submits that the evidence is not related to online information services and training services. Furthermore, it argues that the screenshots from the Owner's website are vague and unclear. However, Ms. Williams attests that the services are provided online or face to face. Furthermore, the screenshots show several tabs enouncing the registered services. In one of the screenshots, the training tab shows a scroll down menu leading me to infer that further information is available.

[26] With respect to "Licensing of training materials and forms", Ms. Williams explains that as part of the training and assessment services, the Owner provided clients with access to materials and forms. As said above, the evidence shows the Mark prominently displayed on the printed material and on the assessment materials [Exhibits 1(a) and (b)] and they were provided

to Canadian clients [invoices Exhibits 2(a) and (b)]. I am satisfied that such evidence establishes use of the Mark in association with those services described in the registration.

[27] Finally, with respect to “Providing administrative support for trainers and coaches”, the Requesting Party argues that none of the documents submitted is related to such a service. Particularly, it submits that the description in the invoice’s body [Exhibit 2(g)] does not refer to this service and that it is not intended to “trainers and coaches” but to “clients”.

[28] Ms. Williams refers to Exhibit 2(g) as being an invoice covering “the design and development of training materials for a third-party training company, which is representative of administrative services which [the Owner] provided to others during the Relevant Period”. At the outset, I accept Ms. Williams’ identification of the registered service at face value as the preparation of training materials necessarily involves a word processing associated with administrative support. Moreover, as the invoice’s description refers to “Instructional Design” it is consistent with Ms. Williams’ description of the administrative support service provided by the Owner. Finally, the invoice is consistent with the Owner’s normal course of trade as Ms. Williams expressly states that the Owner’s clientele includes not only individuals but also corporations operating in education.

[29] In view of all of the above, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4(2) and 45 of the Act in association with all the services.

DISPOSITION

[30] Accordingly, 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 following goods:

Pre-recorded audio and audio-visual recordings, namely cassettes, CD's and DVD's on business etiquette, leadership development, managerial effectiveness, personal effectiveness, professional presence, stress management, time management, executive on-boarding, emotional intelligence, presentation skills, change management, communication skills, performance management, public speaking, organization development, sales effectiveness, goal setting, team building, team engagement, decision making, work-life balance, attracting and retaining talent;

[31] The amended statement of goods and services will read as follow:

Goods

- (1) Printed materials namely books, guides, manuals; behavioural assessment tools and resources namely assessment tests, educational tests, tests, skill tests, development tests, answer sheets, feedback reports, information booklets, and users guides in the field of psychometric testing, personality testing, emotional intelligence, leadership impact, managerial effectiveness, working styles, workplace behaviours, and 360 assessments.

Services

- (1) Conducting psychometric assessments, counselling and training in the fields of networking, public relations, career counselling, personal effectiveness, sales effectiveness, leadership development, business etiquette training, personality testing, life coaching, executive coaching, group coaching; conducting workshops relating to business etiquette, business networking, goal setting and management effectiveness.
- (2) Online information services and training services in the field of executive coaching, life coaching, business etiquette, communications, personal effectiveness, leadership development, sales effectiveness, and change management; licensing of training materials and forms in the field of executive coaching, life coaching, business etiquette, communications, personal effectiveness, leadership development, sales effectiveness, and change management; providing administrative support for trainers and coaches in the field of executive coaching, life coaching, business etiquette, communications, personal effectiveness, leadership development, sales effectiveness, and change management.

Jean Carrière
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Goods described in Registration LMC730,299

- (1) Pre-recorded audio and audio-visual recordings, namely cassettes, CD's and DVD's on business etiquette, leadership development, managerial effectiveness, personal effectiveness, professional presence, stress management, time management, executive on-boarding, emotional intelligence, presentation skills, change management, communication skills, performance management, public speaking, organization development, sales effectiveness, goal setting, team building, team engagement, decision making, work-life balance, attracting and retaining talent; printed materials namely books, guides, manuals; behavioural assessment tools and resources namely assessment tests, educational tests, tests, skill tests, development tests, answer sheets, feedback reports, information booklets, and users guides in the field of psychometric testing, personality testing, emotional intelligence, leadership impact, managerial effectiveness, working styles, workplace behaviours, and 360 assessments.

Services described in Registration LMC730,299

- (1) Conducting psychometric assessments, counselling and training in the fields of networking, public relations, career counselling, personal effectiveness, sales effectiveness, leadership development, business etiquette training, personality testing, life coaching, executive coaching, group coaching; conducting workshops relating to business etiquette, business networking, goal setting and management effectiveness.
- (2) Online information services and training services in the field of executive coaching, life coaching, business etiquette, communications, personal effectiveness, leadership development, sales effectiveness, and change management; licensing of training materials and forms in the field of executive coaching, life coaching, business etiquette, communications, personal effectiveness, leadership development, sales effectiveness, and change management; providing administrative support for trainers and coaches in the field of executive coaching, life coaching, business etiquette, communications, personal effectiveness, leadership development, sales effectiveness, and change management.

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

No Hearing Held

AGENTS OF RECORD

Goodmans LLP

For the Registered Owner

Anahée Carreau Horizon Propulsion Inc.

For the Requesting Party