



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 085

Date of Decision: 2022-04-27

IN THE MATTER OF A SECTION 45 PROCEEDING

Finastra International Limited

Requesting Party

and

Fenestrae B.V.

Registered Owner

TMA944,069 for FENESTRAE

Registration

Introduction

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA944,069 for the trademark FENESTRAE (the Mark).

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

GOODS

Computer programs namely, backup hard drives for computers for use in Internet protocol and for use in Application Programming Interfaces (API) for connecting computer software to computer hardware, computer peripheral devices, namely, mouse, keyboard, computer printer, computer monitor, computer scanners, photocopiers, optical character readers and mobile communication apparatus, namely, personal digital assistant, cellular phone, mobile phone for sending, recording, transmitting, receiving or reproducing sound or images; computer facsimile software for transmission, receipt,

storage, conversion, editing and analysis of text, audio, graphics, still images and moving pictures across local area networks, wide area networks, IP networks, wireless networks and global networks; computer software for authorization and identification of credit cards and for payment processing; network servers for webhosting; facsimile machines, scanners; photocopiers; computer hardware; computer peripheral devices namely, mouse, keyboard, computer printer, computer monitor; data processing equipment, namely, computers; magnetic and optical equipment and apparatus, namely, blank digital storage media, namely, DVDs, USB flash drives; modems; computer monitors; computer storage devices, namely, blank flash drives; telephones; apparatus and equipment for transmission, receipt, and storage of sound, images and other information, in digital format or otherwise, namely, Personal Digital Assistants (PDA), tablet computers and mobile computers.

SERVICES

Telecommunication access services, namely wireless facsimile mail services; providing telecommunication connections, namely, wireless facsimile mail services to a global computer network for transmitting, receiving, retrieving, configuring, translating, converting and organizing facsimile messages via wireless and computer networks; electronic mail and facsimile messaging services; providing access to local area networks (LAN), wide area networks (WAN), IP networks, wireless networks and global networks; electronic facsimile transmissions for the receipt and delivery of facsimile messages, written documents, still images, audio, photographs, and moving pictures; design and development of computer hardware and software; computer programming of electronic data processing applications for use in association with facsimile machines, for others; rental of computer hardware and software; consultancy and providing technical information in the field of computers, computer networks, software and software for digital document management; web site hosting; providing user access to temporary use of non-downloadable computer facsimile software that provides on-demand network access to a pool of configurable computing resources, namely, networks, servers, storage and applications; cloud computing provider services for general storage of data and for database management.

[3] For the reasons that follow, I conclude that the registration ought to be amended.

The Proceeding

[4] On December 12, 2019, at the request of Finastra International Limited (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to Fenestrae B.V. (the Owner). The notice required the Owner to show whether the Mark 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 (making the relevant period for showing use from December 12, 2016 to December 12, 2019) and, if the Mark had not been so used, the Owner was required to provide the date when the Mark was last in use and the reason for the absence of such use since that date.

[5] In response to the Registrar's notice, the Owner submitted the affidavit of Willem Hogewoning, the Chief Financial Officer of the Owner, sworn on July 8, 2020.

[6] Both parties submitted written representations. No oral hearing was requested.

Conceded Non-Use

[7] In his affidavit, Mr. Hogewoning defines the following registered goods as "the Hardware and Peripheral Goods":

network servers for webhosting; facsimile machines, scanners; photocopiers; computer hardware; computer peripheral devices namely, mouse, keyboard, computer printer, computer monitor; data processing equipment, namely, computers; magnetic and optical equipment and apparatus, namely, blank digital storage media, namely, DVDs, USB flash drives; modems; computer monitors; computer storage devices, namely, blank flash drives; telephones; apparatus and equipment for transmission, receipt, and storage of sound, images and other information, in digital format or otherwise, namely, Personal Digital Assistants (PDA), tablet computers and mobile computers.

[8] Mr. Hogewoning states that the Owner does not sell, and has not "within the last few years", sold the Hardware and Peripheral Goods in Canada and, as a result, the Owner acknowledges that these goods may be deleted from the registration. As there is no evidence of special circumstances excusing non-use, the registration will be amended accordingly.

The Owner's Evidence

[9] Mr. Hogewoning states that the Owner is a software development company based in the Netherlands which "has since its inception in 1990 been in the business of developing, selling, and supporting enterprise messaging and communications software". According to Mr. Hogewoning, "all software development is performed at [the Owner's] offices in The Hague". Similarly, "sales and partner management" are also handled from The Hague.

[10] Fenestrae, Inc. (the Subsidiary), a wholly-owned subsidiary of the Owner, is based in Norcross Peachtree Corners, Georgia, and “provides global technical supports for all Fenestrae products and oversees sales and partner management for the Americas and the Pacific Rim regions”. Mr. Hogewoning states that, during the relevant period, the Subsidiary used the Mark and the trade name FENESTRAE under licence from the Owner, wherein the character and quality of the goods sold and the services performed in association with the Mark and trade name were under the control of the Owner.

[11] Mr. Hogewoning states that the Owner’s “software solutions” help customers improve their “business agility and reduce operating costs by eliminating paper from key business processes”.

[12] In particular, at paragraph 7 of his affidavit, Mr. Hogewoning explains that FENESTRAE FAXINATION is a “secure digital business and document exchange platform” offering “intelligent data capture and digitization of paper documents, fax and email attachments”. He attests that *Faxination* is “used [by over 9,000 users in 40 countries] to scan and facilitate the secure exchange of more than 450,000 documents daily”.

[13] He further explains that the *Faxination* platform is “[m]odular in design” and that “components can be mixed and matched to meet any deployment requirements”. He describes the features of the platform by essentially reproducing large portions of the statement of goods, including some of the above-defined Hardware and Peripheral Goods (emphasized in italics below):

“The platform comprises computer hardware and software for use in facsimile transmissions and for computers for use in Internet protocol and for use in Application Programming Interfaces (API) for connecting computer software to computer hardware, computer peripheral devices, namely, mouse, keyboard, computer printer, computer monitor, computer scanners, photocopiers, optical character readers and mobile communication apparatus, namely, cellular phone, mobile phone for sending, recording, transmitting, receiving images; computer facsimile software for transmission, receipt, storage, conversion, editing and analysis of text, graphics and images across local area networks, wide area networks, IP networks, wireless networks and global networks, *network servers for webhosting, facsimile machines, scanners, photocopiers, computer*

peripheral devices including keyboards, printers, monitors, data processing equipment, magnetic and optical equipment and apparatus, modems, computer storage devices as well as apparatus and equipment for transmission, receipt, and storage of images and other information, in digital format or otherwise.”

[14] In the same paragraph, Mr. Hogewoning adds, this time reproducing portions of the statement of services, that the *Faxination* platform:

“...also permits the user to access wireless facsimile mail services and facilitates telecommunication connections in the form of wireless facsimile mail services to a global computer network for transmitting, receiving, retrieving, configuring, translating, converting and organizing facsimile messages via wireless and computer networks, electronic mail and facsimile messaging services, accessing local area networks (LAN), wide area networks (WAN), IP networks, wireless networks and global networks, electronic facsimile transmissions for the receipt and delivery of facsimile messages, written documents, images, and photographs.”

[15] At paragraph 8 of his affidavit, Mr. Hogewoning states that the Owner’s other key offering is its *Udocx* software, a “cloud-based solution” which “facilitates the conversion of business documents into smart digital files”. Loosely reproducing portions of the statement of services, Mr. Hogewoning states that:

“The [*Udocx*] software platform also provides users with access to computer software for scanning by way of photocopiers and computers that provide on-demand network access to a pool of configurable computing resources (networks, servers, storage and applications) and access to Fenestrae’s cloud computer provider serves for general storage of data and for database management.”

[16] Mr. Hogewoning asserts that the Owner offered for sale and sold “FENESTRAE Computer Software Goods” in the normal course of trade, and advertised, performed and sold “FENESTRAE Services”, in Canada during the relevant period. He defines the term “Services” as all of the services specified in the registration, and the term “Computer Software Goods” as the following registered goods:

Computer programs namely, backup hard drives for computers for use in Internet protocol and for use in Application Programming Interfaces (API) for connecting computer software to computer hardware, computer peripheral devices, namely, mouse, keyboard, computer printer, computer monitor, computer scanners, photocopiers, optical character readers and mobile communication apparatus, namely, personal digital

assistant, cellular phone, mobile phone for sending, recording, transmitting, receiving or reproducing sound or images; computer facsimile software for transmission, receipt, storage, conversion, editing and analysis of text, audio, graphics, still images and moving pictures across local area networks, wide area networks, IP networks, wireless networks and global networks; computer software for authorization and identification of credit cards and for payment processing;

[17] Mr. Hogewoning states that many of the Owner's customers are "institutional or government agencies" who contract for Services on an annual subscription basis and have been "longstanding users" of the Owner's Services.

[18] Mr. Hogewoning attests that in addition to direct sales by the Owner, Computer Software Goods were sold through distributors such as PC Canada, which distributed the Owner's *Udocx* software during the relevant period. He attaches, as Exhibit B to his affidavit, a webpage screenshot from PC Canada's website which he attests is representative of the manner in which the Owner's Computer Software Goods were offered for sale by PC Canada, including during the relevant period. The screenshot displays two purchase options for "HP Fenestrae Udocx for Office365", namely one-year and five-year licences (identified as "Subscription License – 1 License – 1 Year – Electronic" and "Subscription License – 1 License – 5 Year – Electronic", respectively). These two options are shown on the exhibited screenshot as "backordered".

[19] As for display of the Mark, Mr. Hogewoning states that the Mark "is, and has since at least 2013 been, prominently displayed on or in association with FENESTRAE Computer Software Goods and [*sic*] sold to customers in Canada". He also identifies particular instances where the Mark is displayed, namely on the screen when software is installed and accessed, on user manuals and informational brochures, and on invoices. In support, he attaches Exhibit A to his affidavit, which he describes only as "copies of materials which illustrate the manner in which [the Mark] is and has been used on or in association with FENESTRAE Computer Software Goods" which were sold during the relevant period in Canada.

[20] Exhibit A consists of a bundle of unidentified documents. Some of the documents include: copies of various user guides, copies of various promotional brochures describing the Owner's "Fenestrae Faxination Server", "Faxination Cloud Fax" and "Fenestrae Udocx"; a

screenshot from the website located at *www.gsc.fenestrae.com* which appears to correspond to the “Faxination Resource Center” webpage; and a screenshot from the website located at *www.faxination.com/en/support* which appears to correspond to the “Maintenance & Support Program” webpage for *Faxination*.

[21] Many of the Exhibit A documents prominently display the Mark, including:

- excerpts from various user guides for “Faxination 2016”, all displaying the Mark followed by the registration symbol ® on their cover pages;
- excerpts from a user guide for “Fenestrae Udocx” displaying the logo reproduced below in the upper right-hand corner of each page:



- screen captures of four “Faxination Server 2016 R2” software installation windows, all displaying the Mark in stylized font, in the upper right-hand corner of each window. Although the resolution of the screen captures is low, the Mark appears to be followed by the symbol ® in each case; and
- an image depicting a product box and compact disk case, both bearing the Mark followed by the symbol ® and, on a separate line, the product name FAXINATION SERVER.

[22] With respect to services, Mr. Hogewoning attests that, during the relevant period, the Mark was displayed in advertising and promotion of the Services, as well as on informational brochures and invoices. He attaches Exhibit C to his affidavit, which he describes as “copies of materials which illustrate the manner in which [the Mark] is and has been used to advertise and promote the FENESTRAE Services... or in the performance of the said services”, during the relevant period in Canada.

[23] The Exhibit C materials appear to consist of two promotional brochures pertaining to the *Faxination* platform. These brochures describe *Faxination* as a “single virtualized solution for all fax communications” which “offers multiple Fax-over-IP (FoIP) solutions to leverage existing Voice-over-IP (VoIP) infrastructures to include fax”. According to one brochure, “Fax-over-IP is a method for sending and receiving faxes over your IP network” and such that “[f]ax boards and servers can be replaced with pure software based faxing. When FoIP is implemented, faxes can be sent entirely via software, and existing fax hardware can be removed.” The same brochure indicates that *Faxination* can “capture paper files from [multifunction print, copy and scan devices] and route them to any email or business application”.

[24] The Mark is displayed in the final brochure sections which provide general information on the Owner and the software solutions it offers (“*About Fenestrae®*”) as well as the corporate name and contact information for the Owner (“*Fenestrae Offices*”).

[25] Finally, with respect to actual sales and performance, Mr. Hogewoning attaches Exhibit D to his affidavit, which he describes as “representative invoices, order documents and purchase orders documenting sales of [the Owner’s] FENESTRAE Computer Software Goods and subscriptions to [the Owner’s] FENESTRAE Services to customers in Canada”. I note the following documents:

- An invoice issued by the Owner to Nestlé Canada Inc. with an address in Oshawa, Canada, listing two items: “FX2016-FOIP-8 Replacing physical fax device” and “Faxination Maintenance & Support” (hereinafter, the “Nestlé Invoice”). The Mark is displayed at the top of this invoice, followed by the symbol ®.
- An order form issued by the Owner to a customer in Switzerland, with the following note: “Regarding: moving from physical fax device server to virtual device server for CANYKC0002 in Canada”. This order form lists two items: “Replacing physical fax device... for Fenestrae FoIP 8 channels for server CANYKC0002” and “Maintenance fee for Fenestrae FoIP (8 channels) – server CANYKC0002, for one year”. The Mark is displayed at the top of this order form, followed by the symbol ®.

- Two copies of the same purchase order, issued to the Owner by a customer in Canada, listing two items: “Replacing physical fax dev” and “Maintenance Fee for Fenestrae”.
- A purchase order issued to the Subsidiary by a customer in Canada for the item: “Fenestrae – License Renewal 2019-2020 IT&Telecom-Services-Licences”.
- A purchase order issued to the Subsidiary by a customer located in Canada for the item: “1 year Faxination Maintenance and Support renewal”.
- An invoice issued by the Subsidiary for the item: “1-year Faxination Maintenance & Support”. The Mark is displayed at the top of this invoice, followed by the symbol ®.

[26] I also note a purchase order issued by AT&T Solutions Inc. having “Bill To” and “Ship To” addresses in St. Louis, Missouri. The purchase order lists the following items: “Dialogic Silver Per Unit Plan” and “Fenestrae maintenance & support. Includes software upgrades and 5 incidents of telephone technical support”. The “Final Destination Name” identified in this purchase order is “Government of Manitoba, AT&T SOLUTIONS INC” and the “Final Destination Address” is 1 AT&T CTR, St. Louis, Missouri.

[27] The Exhibit D materials do not contain any references to “*Udocx*”.

Positions of the Parties

[28] In its written submissions, the Requesting Party raises numerous issues with respect to the evidence. For example, it alleges that the trademark in evidence is, in some cases, not the Mark as registered and, in other cases, merely used as a trade name; that the evidence relating to the use of the Mark under licence is ambiguous; that the affiant’s statements are bald assertions of use, as well as ambiguous statements concerning “unparticularized groups of goods and services”; that it is unclear whether the Mark was displayed on goods at the time of transfer; that there is no evidence relating to the Owner’s normal course of trade; and that portions of the evidence including Mr. Hogewoning’s statements are contradictory.

[29] Nevertheless, I understand the Requesting Party's core argument as being that the Owner has failed to show that the software solutions offered by the Owner in Canada include each of the Computer Software Goods and each of the Services.

[30] The Owner, in its relatively brief written submissions, summarizes the evidence and highlights descriptions of the *Faxination* and *Udocx* platforms found in the affidavit itself and in the exhibited materials. The Owner does not provide any correlations between the features of those platforms and specific registered goods and services, nor does it specifically respond to the issues raised by the Requesting Party. In short, the Owner essentially relies on the ambiguities in the evidence to broadly assert use of the Mark in association with all of the Computer Software Goods and all of the Services.

Analysis

[31] The relevant definitions of "use" in this 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.

[32] 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]. Although this burden of proof is light, it is well established that bare statements that a trademark was in use are not sufficient to demonstrate use in the context of section 45 proceedings and 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 [*Plough (Canada) Ltd v Aerosol Fillers*

Inc (1980), 53 CPR (2d) 62 (FCA); *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

The Computer Software Goods

[33] It is well established that, with respect to use of a trademark in association with goods, invoices are not mandatory in order to satisfactorily reply to a section 45 notice [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)]. However, some evidence of transfer(s) in the normal course of trade in Canada is necessary [*John Labatt, supra*]. Such evidence can be in the form of documentation like invoices, sales reports, but can also be through clear sworn statements regarding the volume of sales, the dollar value of sales, or equivalent factual particulars [see, for example, *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79].

[34] In the present case, aside from general assertions of sales, the evidence relating to transfers of goods in Canada consists of the Exhibit D invoices, order forms and purchase orders.

[35] The Owner has not correlated the products referenced in those documents with specific registered goods. Mr. Hogewoning only refers to these documents as relating to sales of Computer Software Goods and subscriptions to Services, generally. Moreover, none of the product descriptions in the Exhibit D documents clearly correlate with the registered goods.

[36] However, considering the evidence as a whole, I find it reasonable to infer that Exhibit D documents pertain, at least in part, to subscriptions to the Owner's *Faxination* digital exchange platform. In particular, I conclude that the item described as "Replacing physical fax device" (including in the Nestlé Invoice), refers to a customer replacing its existing fax hardware with the *Faxination* platform's "pure software based faxing".

[37] That being said, it is unclear whether a subscription actually provides customers with each of the Computer Software Goods. Mr. Hogewoning describes *Faxination* in broad strokes, by reproducing large portions of the statement of goods and services. Moreover, as highlighted by the Requesting Party, Mr. Hogewoning's description

[38] Without the benefit of submissions from the Owner on this point, I agree with the Requesting Party that the *Faxination* platform may not consist of a “single monolithic product”. Rather, Mr. Hogewoning indicates that *Faxination* is modular and that its components can be “mixed and matched”. I therefore infer that a subscription to *Faxination* does not necessarily always include each of the features identified at paragraph 7 of Mr. Hogewoning’s affidavit.

[39] Notwithstanding the above, the *Faxination* platform is consistently described by Mr. Hogewoning as well as in the exhibited materials as one which offers data capture and digitization of documents, and manages incoming and outgoing fax communications. For example, the Exhibit A promotional materials describe the *Fenestrae Faxination Server* as an “intelligent fax gateway” and a “fax server solution”, and explain that *Faxination* can be connected to multifunction printers to scan, fax and store paper files. Similarly, in Exhibit C, *Faxination* is described as “pure software based faxing” which “offers multiple Fax-over-IP (FoIP) solutions”. As such, I accept that the *Faxination* platform includes, at a minimum, computer facsimile software.

Computer facsimile software for (...)

[40] The portion of the statement of goods which relates to computer facsimile software reads as follows:

computer facsimile software for transmission, receipt, storage, conversion, editing and analysis of text, audio, graphics, still images and moving pictures across local area networks, wide area networks, IP networks, wireless networks and global networks;

[41] In his affidavit, Mr. Hogewoning correlates those registered goods, as well as others, to the *Faxination* platform. I note that Mr. Hogewoning’s correlation omits the terms “audio” and “moving pictures”.

[42] As for display of the Mark, the Owner points out that the Mark was displayed in association with software on various materials, including on invoices, user manuals and installation windows for such software.

[43] The Requesting Party raises multiple issues with respect to those materials, including (i) that the location of the term “FENESTRAE” at the top of the invoices, “adjacent to” the corporate name and address of the Owner and “remote from” the description of the items sold, suggests that the term is being used as a trade name to identify the business rather than as a trademark to distinguish goods or services; (ii) that it is not clear which of the registered goods and services are associated with the user manuals and, in any event, that there is no evidence that the user manuals accompanied the goods sold or were “otherwise contemporaneously be brought to the attention of the purchaser” at the time of transfer; and (iii) that there is no indication that the evidenced installation windows were actually available in Canada or accessible to Canadians. On the latter point, the Requesting Party submits that the “Account” field displayed in one of the installation windows corresponds to the name of the affiant, who is located in the Netherlands, and therefore that there is no evidence that the exhibited screen capture corresponds to “what an ordinary customer... would encounter” in Canada.

[44] In my view, the Requesting Party’s submissions fail to consider the evidence as whole. For example, while the Mark may arguably be “adjacent” to the Owner’s corporate name and address in the sense that this information is also at the top of the invoices, the Mark is not in close proximity to this corporate information. Rather, the Mark is prominently displayed in the upper left-hand corner of invoices in large blue font and followed by the symbol ®, whereas the Owner’s name and address are displayed in the upper right-hand corner of the page in significantly smaller black font. The Mark is therefore displayed in such a manner that it stands apart from the corporate identifier information.

[45] As for installation window screens, Mr. Hogewoning specifically identifies such screens in his affidavit as one particular instance of display of the Mark *in Canada* during the relevant period. His statement immediately precedes the introduction of Exhibit A, which comprises the “Faxination Server 2016 R2” installation windows screenshots.

[46] Although the Owner’s evidence is not perfect, I am prepared to accept that – at a minimum – the prominent display of the Mark on the exhibited software installation windows

provides the requisite notice of association between the Mark and the *Faxination* subscription referenced in the Nestlé Invoice. As a result, I am satisfied that the Owner has shown use of the Mark within the meaning of sections 4 and 45 of the Act, but – in the absence of any evidence referencing the exchange of “audio” and “moving pictures” via the *Faxination* platform or otherwise – only in association with the following registered goods:

“computer facsimile software for transmission, receipt, storage, conversion, editing and analysis of text, ... graphics, still images ... across local area networks, wide area networks, IP networks, wireless networks and global networks”.

[47] As there is no evidence of special circumstances excusing non-use before me, the terms “audio” and “and moving pictures” will therefore be deleted.

Remaining Computer Software Goods

[48] The remaining registered goods asserted by the Owner are as follows:

Computer programs namely, backup hard drives for computers for use in Internet protocol and for use in Application Programming Interfaces (API) for connecting computer software to computer hardware, computer peripheral devices, namely, mouse, keyboard, computer printer, computer monitor, computer scanners, photocopiers, optical character readers and mobile communication apparatus, namely, personal digital assistant, cellular phone, mobile phone for sending, recording, transmitting, receiving or reproducing sound or images; ... computer software for authorization and identification of credit cards and for payment processing;

(hereinafter, collectively, the “Remaining Computer Software Goods”).

[49] To begin, I note that – as a result of arguably incongruous terms, namely “computer programs namely, backup hard drives for computers” and multiple nested “namely” terms – the description for the first registered goods is difficult to interpret.

[50] Nevertheless, it is well established that a statement of goods should be granted a generous interpretation as opposed to a restrictive one [see *ConAgra Foods, Inc v Fetherstonhaugh & Co* (2002), 23 CPR (4th) 49 (FCTD); and *Molson Canada v Kaiserdom-Privatbrauerei Bamberg Wörner KG* (2005), 43 CPR (4th) 313 (TMOB)] and that one is not to be “astutely meticulous”

when interpreting the language used in a statement of goods or services [see *Aird & Berliss LLP v Levi Strauss & Co*, 2006 FC 654 at para 17].

[51] Having regard to those principles, and in the absence of submissions on this point from the Owner, I agree with the Requesting Party that the “underlying goods” in this description are backup hard drives and, therefore, that it is reasonable to consider the registered goods described as “Computer programs namely, backup hard drives for computers...” as corresponding to backup hard drives of some sort, such as hard drives loaded with computer software for use in IP (Internet protocol) and API (Application Programming Interfaces).

[52] There is no evidence that the Owner has sold or otherwise transferred any type of hard drive. In fact, as the Requesting Party points out, Mr. Hogewoning replaces the registered term “backup hard drives for computers” with the term “computer hardware and software for use in facsimile transmissions and for computers” in his description of the *Faxination* platform.

[53] I also note that, aside from Mr. Hogewoning’s recitation of the registered goods, the evidence is silent with respect to “computer software for authorization and identification of credit cards and for payment processing”. Moreover, these particular registered goods are not included in Mr. Hogewoning’s description of the *Faxination* platform.

[54] Without any specific evidence relating to the Remaining Computer Software Goods, I am not prepared to accept the affiant’s references to “computer hardware and software”, and his general statements regarding “sales of FENESTRAE Computer Software Goods”, as sufficient evidence to establish use of the Mark for the purposes of this proceeding. I am therefore not satisfied that the Owner has met its *prima facie* burden to show use of the Mark in association with the Remaining Computer Software Goods within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances excusing non-use, those remaining goods will be deleted.

The Services

[55] Throughout his affidavit, Mr. Hogewoning provides numerous assertions regarding the performance and advertisement of “FENESTRAE Services”. However, as was the case with the registered goods, I find it reasonable to interpret his assertions as referencing some of the Services, rather than each of them.

The Owner’s Software Solutions

[56] In terms of correlating evidenced “software solutions” and particular registered services, the Owner’s submissions provide little assistance, aside from highlighting Mr. Hogewoning’s broad descriptions of the *Faxination* and *Udocx* platforms.

[57] Nevertheless, having regard to the descriptions of the *Faxination* platform in the exhibited materials such as “pure software based faxing” and a “single virtualized solution for all fax communications”, I accept Mr. Hogewoning’s correlation of this platform to the following registered services:

Telecommunication access services, namely wireless facsimile mail services; providing telecommunication connections, namely, wireless facsimile mail services to a global computer network for transmitting, receiving, retrieving, configuring, translating, converting and organizing facsimile messages via wireless and computer networks; electronic mail and facsimile messaging services; providing access to local area networks (LAN), wide area networks (WAN), IP networks, wireless networks and global networks; electronic facsimile transmissions for the receipt and delivery of facsimile messages, written documents, still images, [audio,] photographs, [and moving pictures];

(hereinafter, collectively, the “Faxination Services”).

[58] I note here that – as was the case for “computer facsimile software” – the terms “audio” and “moving pictures” are omitted from Mr. Hogewoning’s description and are nowhere referenced in the evidence.

[59] As for *Udocx*, Mr. Hogewoning describes this platform as a cloud-based solution which allows users to convert documents into “smart digital files”. I also note descriptions of this

platform in an Exhibit A user manual, indicating that “[*Udocx*] transport [*sic*], converts and delivers the document to your application” and that once it is successfully delivered, the document is “removed” from the Owner’s service.

[60] Again, having regard to those descriptions, I accept Mr. Hogewoning’s correlation of the *Udocx* platform to the following registered services:

providing user access to temporary use of non-downloadable computer facsimile software that provides on-demand network access to a pool of configurable computing resources, namely, networks, servers, storage and applications; cloud computing provider services for general storage of data and for database management.

(hereinafter, collectively, the “*Udocx* Services”).

[61] Although the invoiced subscription to the *Faxination* platform (*i.e.* the Nestlé Invoice) supports the conclusion that the *Faxination* Services were performed, there is no such evidence of subscriptions to or sales of the *Udocx* platform. Nevertheless, considering the exhibited promotional materials displaying the Mark together with Mr. Hogewoning’s clear statement that the Mark was displayed in the advertising and promotion of FENESTRAE Services during the relevant period in Canada, I am prepared to accept that the *Faxination* Services and the *Udocx* Services were at least advertised and available to persons in Canada during the relevant period.

[62] In this respect, the Requesting Party argues that the backordered status of *Udocx* licences shown on exhibited screenshots from PC Canada’s website suggests that this platform was not available during the relevant period. In particular, the Requesting Party submits that Mr. Hogewoning’s characterization of this exhibit as “representative” of the manner in which this software was offered for sale during the relevant period is actually a tacit admission that *Udocx* was backordered during that time and therefore not available for purchase. I disagree.

[63] I first note Mr. Hogewoning’s statement that, during the relevant period, *Udocx* software was not only sold through the Owner’s distributor PC Canada, but also through direct sales by the Owner itself. In any event, although not explicitly addressed in the Owner’s submissions, I find it reasonable to interpret Mr. Hogewoning’s statement regarding the “manner” in which the

Owner's products were offered and promoted as referring to the general appearance of the PC Canada website, rather than to the backordered notice on this particular screenshot, which may have been captured after the relevant period, when Mr. Hogewoning prepared his affidavit.

[64] Finally, for the reasons that follow, I am satisfied that the Mark was displayed in the advertisement of Faxination Services and Udocx Services.

[65] First, Exhibit A includes promotional brochures which are essentially client testimonials for the Owner's "Faxination" and "Faxination Server" products. In those brochures, the Mark is prominently displayed at the top of each second page, in larger white font against the blue background of the header section. I therefore accept these brochures as evidence of display of the Mark in advertising the Faxination Services.

[66] Second, Exhibit A also includes two one-page brochures for "Fenestrae Udocx". In diagrams displayed on those brochures, the platform is depicted as a cloud, labeled with the term UDOCX®. The platform is often referenced in these brochures simply as "Udocx" (e.g. "Udocx integrates with your existing infrastructure..."). The Mark is also displayed in these brochures separate and apart from the term UDOCX, such as in the title of a section providing general information on the Owner and its products ("*About Fenestrae®*"), and in the url address of a website (*www.fenestrae.com/udocx*).

[67] It is well established that use of a trademark in combination with additional words or design features generally qualifies as use of the trademark if the public, as a matter of first impression, would perceive the trademark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)]. The issue is a question of fact, dependent upon such factors as whether the trademark stands out from the additional material, for example, by virtue of different lettering or sizing, or whether the additional material would be perceived as purely descriptive matter or as a separate trademark or trade name [*Nightingale, supra*; see also *Loro Piana SPA v Canadian Council of Professional Engineers*, 2009 FC 1096].

[68] It is also well established that two or more trademarks may be used at the same time so long as they are not combined in a way that renders the individual marks indistinguishable [see *AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD); and *Loro Piana, supra*]. The placement of trademark or registration symbols “may be considered a factor in the consumers’ perception of the mark”, but is not necessarily determinative [see *Norton Rose Fulbright Canada v Roper House Publishing Ltd*, 2021 TMOB 140 at para 24 for an overview of the relevant jurisprudence regarding the relevance of those symbols].

[69] Considering that the Mark is sometimes displayed separate and apart from the term UDOCX, that the registration symbol ® is displayed after both the Mark and UDOCX, and that the software platform is often identified in the brochures simply as “Udocx”, I find that the public would perceive UDOCX as a separate trademark from the Mark, and would therefore perceive the Mark as being used *per se* in these brochures. I therefore accept these brochures as evidence of display of the Mark in advertising the Udocx Services.

[70] In view of the foregoing, I am satisfied that the Owner has shown use of the Mark within the meaning of sections 4 and 45 of the Act in association with the Faxination Services and the Udocx Services. Accordingly, in the absence of evidence of special circumstances excusing non-use, the terms “audio” and “moving pictures” will be deleted from the registration.

Remaining Services

[71] I come to a different conclusion with respect to the registered services which are nowhere referenced in Mr. Hogewoning’s descriptions of the *Faxination* and *Udocx* platforms, namely:

design and development of computer hardware and software; computer programming of electronic data processing applications for use in association with facsimile machines, for others; rental of computer hardware and software; consultancy and providing technical information in the field of computers, computer networks, software and software for digital document management; web site hosting;

(collectively, the Remaining Services).

[72] It is not for the Registrar to speculate as to the nature of registered goods or services; it is the responsibility of the registered owner to show the connection between the registered goods or services and those included in the evidence [see, for example, *Fraser Milner Casgrain LLP v Fabric Life Ltd*, 2014 TMOB 135 at para 13; and *Wrangler Apparel Corp v Pacific Rim Sportswear Co* (2000), 10 CPR (4th) 568 (TMOB) at para 12].

[73] In this case, one is left to speculate as to the nature of the services which are not included in Mr. Hogewoning's descriptions of the *Faxination* and *Udocx* platforms. While one might assume, for example, that the Owner designs and develops hardware and software, or provides consultancy services to its customers, it is not clear from the evidence that (i) such services were offered during the relevant period in Canada; or (ii) that the Mark was displayed in their performance or advertisement.

[74] I am therefore not satisfied that the Owner has met its *prima facie* burden to show use of the Mark in association with the Remaining Services within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances excusing non-use, the Remaining Services will be deleted.

Disposition

[75] 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 terms:

GOODS

Computer programs namely, backup hard drives for computers for use in Internet protocol and for use in Application Programming Interfaces (API) for connecting computer software to computer hardware, computer peripheral devices, namely, mouse, keyboard, computer printer, computer monitor, computer scanners, photocopiers, optical character readers and mobile communication apparatus, namely, personal digital assistant, cellular phone, mobile phone for sending, recording, transmitting, receiving or reproducing sound or images; ... audio, ... and moving pictures ...; computer software for authorization and identification of credit cards and for payment processing; network servers for webhosting; facsimile machines, scanners; photocopiers; computer hardware; computer peripheral devices namely, mouse, keyboard, computer printer, computer

monitor; data processing equipment, namely, computers; magnetic and optical equipment and apparatus, namely, blank digital storage media, namely, DVDs, USB flash drives; modems; computer monitors; computer storage devices, namely, blank flash drives; telephones; apparatus and equipment for transmission, receipt, and storage of sound, images and other information, in digital format or otherwise, namely, Personal Digital Assistants (PDA), tablet computers and mobile computers.

SERVICES

... audio, ... and moving pictures; design and development of computer hardware and software; computer programming of electronic data processing applications for use in association with facsimile machines, for others; rental of computer hardware and software; consultancy and providing technical information in the field of computers, computer networks, software and software for digital document management; web site hosting;...

[76] The statement of goods and services will now read:

GOODS

computer facsimile software for transmission, receipt, storage, conversion, editing and analysis of text, graphics, still images across local area networks, wide area networks, IP networks, wireless networks and global networks;

SERVICES

Telecommunication access services, namely wireless facsimile mail services; providing telecommunication connections, namely, wireless facsimile mail services to a global computer network for transmitting, receiving, retrieving, configuring, translating, converting and organizing facsimile messages via wireless and computer networks; electronic mail and facsimile messaging services; providing access to local area networks (LAN), wide area networks (WAN), IP networks, wireless networks and global networks; electronic facsimile transmissions for the receipt and delivery of facsimile messages, written documents, still images, photographs; providing user access to temporary use of non-downloadable computer facsimile software that provides on-demand network access to a pool of configurable computing resources, namely, networks, servers, storage and applications; cloud computing provider services for general storage of data and for database management.

Eve Heafey
Hearing Officer
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

Osler, Hoskin & Harcourt LLP

For the Registered Owner

McMillan LLP

For the Requesting Party