



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 105

Date of Decision: 2022-05-27

IN THE MATTER OF A SECTION 45 PROCEEDING

Meighen Haddad LLP

Requesting Party

and

Flyp Technologies Inc.

Registered Owner

TMA877,279 for UBERFLIP

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. TMA877,279 for the trademark UBERFLIP (the Mark).

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

THE PROCEEDINGS

[3] At the request of Meighen Haddad LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on June 10, 2019, to Flyp Technologies Inc. (the Owner), the registered owner of the Mark.

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

Goods

(1) Computer software for converting print and electronic content into online digital publications; computer software to help enhance, distribute and track engagement in digital publications; software programs for computer desktop and mobile devices to distribute digital publications; computer software program for analyzing and measuring usage of online publications; computer software program for accumulating, displaying and selling media content online.

Services

(1) Internet content delivery service to assist marketers, publishers, professionals, educators and corporations; developing marketing strategies and marketing concepts for others; e-commerce services for selling online digital content; market research and analysis services; online publishing services; digital publishing services; advertising for others via electronic communication networks; marketing services, namely, assisting with promoting the products and services of others via electronic communication networks; facilitating the publication of software applications by third party software providers; training and consulting services for publishers.

[5] The notice required the Owner to show whether the Mark was used in Canada, in association with each of the registered goods and services, 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 between June 10, 2016, and June 10, 2019.

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

(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 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 and “evidentiary overkill” is not required [see *Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448

and *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the Mark was used in association with the registered goods and services.

[8] In the absence of use, pursuant to section 45(3) of the Act, a trademark is liable to be expunged, unless the absence of use is due to special circumstances that excuse the absence of use.

[9] In response to the Registrar's notice, the Owner furnished the affidavit of Randy Frisch, sworn on August 26, 2019, with Exhibits A to Q.

[10] Both parties submitted written representations and were represented at a hearing.

THE EVIDENCE

[11] Mr. Frisch is the Co-Founder, President, and Chief Marketing Officer of the Owner and, as such, he is responsible for corporate development, operations, talent management, facilitating company growth, and sales and marketing strategy in Canada and internationally. He describes the Owner's mission as to "put control back in the hands of marketing teams to deliver high-converting experiences, that put the customer front and center".

[12] According to Mr. Frisch, the Owner provides "content marketing automation software solutions", which he described as "tools to manage content, generate leads, and automate fuel marketing; aggregates content and organizes it into custom streams for specific buyer personas, topics, events, and prospects; offers filters and scheduled tasks that let users to automate curation and publishing to serve the right content experience to the right audiences at the right; offers marketing automation; integrates with marketing ecosystem; transforms PDFs into interactive flipbooks; and offers Content Score, which gives views on performance of content and call-to-actions".

[13] Mr. Frisch states that the registered goods and services have been offered and sold in Canada since 2012 through a website, *www.uberlfip.com*. Attached as Exhibit B are copies of the webpages from this website "showing the extensive products and services provided under the

UBERFLIP brand”, including “the full description of features and functions of the software [...] and professional service”. These copies are dated August 20, 2019.

[14] Attached as Exhibit C is a “Copy of an Order Form executed by the customer on January 31, 2017, for the purchase of the software”. The title of this document is *Uberflip Services Agreement*. The services and products sold and listed are “Exclusive Pack Subscription”, “250 Target Streams (January promotion)”, and “Exclusive Onboarding”. Under the section *Exclusive Features*, there are different heading, such as *Content Management*, *Design*, *Lead Generation*, and *Metrics*.

[15] Mr. Frisch explains that customers can access the software through a web portal at <https://app.uberflip.com/login>. Attached as Exhibit D, is a “screen grab of customer login page at <https://app.uberflip.com/login> to access the software as on February 10, 2017”. The Mark appears on that login page. Attached as Exhibit E is the “UBERFLIP Terms of Use for software as of February 7, 2017”. The Mark appears on it. The Terms of Use describe the licences granted by the Owner as licenses to “access and use the Platform over the Internet and through the then available standard interface for the Platform” and to “copy, use, reproduce and modify any Derivative Data provided to Customer for Customer’s internal business purposes”.

[16] Mr. Frisch states that the Owner advertised the registered goods and services in Canada during the relevant period and that the Mark appeared on those advertisements. Attached to his affidavit are the following exhibits representing examples of advertisements bearing the Mark:

- Exhibit F consists of a copy of a “magazine Advertisement published in Chief Content Officer (CCO) magazine February 2018 issue”. This advertisement refers to “Create personalized content experience at scale”, “Create engaging content hubs”, “Design ABM experiences”, “Accelerate lead generation”, and “Fuel sales conversations”.
- Exhibit G consists of a copy of a “Facebook Advertisement, September 7, 2018”.
- Exhibit H consists of a copy of a “Linkedin Advertisement, March 25, 2019”. This advertisement refers to “Unbox your thinking. Learn new way to use Uberflip” followed by a “Show Me” button.

- Exhibit I consists of a copy of a “Website banner Advertisement, May 11, 2018”. This advertisement refers to “Create better ABM campaigns in no time” followed by a “Learn More” button.

[17] Mr. Frisch explains that the Owner also does sales presentations directly to potential customers. Exhibit Q consists of “a Sales Demo Deck presentation used in May of 2019”. In this Sales Demo Deck, the services of the “Uberflip Application” are described as “Personalized Hub Content”, “Targging and Segmenting Content”, “ABM Stream”, and “Sales Stream”. The roadmap of the application is also described and the six phases are “Collect an Initial Data Set”, “Broker and Explore Data”, “Embed BI Dashboard into Ubreflip”, “Continue growing complexity of data”, “Associate”, and “Content Experience Variants”. The prices are redacted, but there are three options for purchasing, one, two or three-year contract and the “UPDATED Features” consist of “Hubs with AI 1+1 Staging, 500 Flipbooks, 50 Marketing Streams, and 30 Recurring onBrand Hours”.

[18] Mr. Frisch states that as of June 10, 2019, there were 940 customers subscribed to the Owner’s platform. He also adds that the approximate annual sales of the registered goods and services in Canada were in excess of \$500,000 in 2016, \$900,000 in 2017, \$1,300,000 in 2018, and \$900,000 in the first six months of 2019.

PRELIMINARY MATTERS

[19] As noted by the Requesting Party, the Exhibit B is dated outside the relevant period and Mr. Frisch did not explicitly confirmed that the copies contained in this Exhibit are representative of how the website appeared during the relevant period. Therefore, Exhibit B is not relevant for this proceeding.

[20] In its written representations, the Owner attached copies of screenshots of the Owner’s website as they appear at the link provided in the Frisch Affidavit as *Annex A*. However, these facts were not provided in the evidence filed, and therefore, cannot be made of record.

ANALYSIS AND REASONS FOR DECISION

[21] The Requesting Party submits that the Owner failed to demonstrate use of the Mark in association with the registered goods and services in Canada, during the relevant period for the following reasons: i) the Owner does not correlate the evidence with the registered goods and services, but rather, provided various statements and documents without specific references to them, except for bare statements referring to all goods and services; ii) the Owner did not demonstrate use with all of the registered goods and services; and iii) there is no evidence of transfer of a single software application by the Owner in the normal course of trade.

Normal Course of Trade

[22] The Requesting Party submits that the Owner did not provide any evidence regarding its normal course of trade.

[23] There is no particular type of evidence that must be provided to show the normal course of trade in a section 45 proceeding and the evidence need not be perfect [see *Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)].

[24] Given that Mr. Frisch explained that the goods and services were sold and advertised through the Owner's website to Canadian customers and provided an order form and substantial sales figures, I consider that it is sufficient to establish the Owner's normal course of trade.

Qualification of Software

[25] The Requesting Party submits that Mr. Frisch "does not refer to one (or several) software applications, but rather to a single service accessible via a password protected Internet website to which the end-customers must transfer their data", and therefore, the Owner is not transferring property or possession of any of the registered goods. Moreover, it adds that while Mr. Frisch qualified the Exhibit C as a copy of an order form for the purchase of software, this Exhibit is a *Service Agreement*, and the evidence filed does not permit the Registrar to conclude that the platform could be described as goods.

[26] The Owner submits that it is beyond the jurisdiction of section 45 proceedings to determine whether *software* is considered a good or a service. It further submits that “it is now common to download software online or to simply access web applications via a website” and that a “license to use and access software through a login mechanism in return for a subscription fee demonstrates use in association with the goods”.

[27] As discussed by the Federal Court in *Specialty Software Inc v Bewatec Kommunikationstechnik GMBH*, 2016 FC 223, data or software available only through an Internet browser can meet the requirement of showing a transfer in accordance with section 4(1) of the Act, despite no software actually being installed *per se* on a customer’s computer.

[28] Given that the Exhibit E Terms of Use for software, as described by Mr. Frisch, refer to licenses for customers and possibilities for customers to copy and use the data from the software, I consider it could fall within the scope of good, where a customer purchase a licence to use the software, even if they do not download it on their computer.

Registered goods

[29] Mr. Frisch provided sales figures and the Exhibit C Order Form, as evidence of transfer of the registered goods. As noted by the Requesting Party, there is no distinction made between sales of services and sales of goods, only aggregate figures are provided. As for the Exhibit C Order Form, Mr. Frisch does not explain if it refers to goods or services nor correlates them with the registered goods and services.

[30] On a fair reading of the affidavit as a whole, and bearing in mind that the Owner need only establish a *prima facie* case of use, I am prepared to infer that the aggregate sales during the relevant period included the goods and services depicted in the Exhibit Q Sales Demo Deck, and Exhibits F and I advertisements [for similar conclusions, see *Gowling Lafleur Henderson LLP v Neutrogena Corp* (2009), 74 CPR (4th) 153 at para 16; *Osler, Hoskin & Harcourt LLP v Esprit International*, 2018 TMOB 9 at para 22].

[31] Given that the Exhibit C Order Form, the Exhibit D login page, where customers access the software, and the Exhibit E Term of Use, all bear the Mark, I accept that the notice of

association between the Mark and the goods was made at the time of the transfer [for similar conclusions, see *Fasken Martineau DuMoulin LLP v Open Solutions DTS, Inc*, 2013 TMOB 68].

[32] The Requesting Party submits that “while Mr. Frisch has chosen to make various statements and provide documentation regarding Flyp's business and its alleged use of the Trademark, he has not made any effort to assist the Registrar or the Requesting Party in understanding how his evidence correlates to each specific Good or Service”. Therefore, absent such correlation, it is not possible to determine which, if any, of the registered goods and services correspond to the descriptions appearing in the Exhibits.

[33] As noted by the Requesting Party, when a trademark owner leaves correlations between the evidence it provides and its registered goods and services to the Registrar, it takes a risk [*Vermillion Intellectual Property Corporation v Vermilion Energy Inc*, 2017 TMOB 24 at para 70].

[34] It is not for the Registrar to speculate as to the nature of the registered goods and services [*Fraser Milner Casgrain LLP v Fabric Life Ltd*, 2014 TMOB 135 at para 13; *Wrangler Apparel Corp v Pacific Rim Sportswear Co* (2000), 10 CPR (4th) 568 at para 12 (TMOB)]. However as noted by the Owner, reasonable inferences can be made from the evidence provided [see *Eclipse International Fashions Canada Inc v Shapiro Cohen* (2005), 48 CPR (4th) 223 (FCA)]. In making correlations between the evidence and the registered goods and services, I am mindful of the principle that when interpreting a statement of goods in a section 45 proceeding, one is not to be “astutely meticulous when dealing with [the] language used” [see *Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654 at para 17].

[35] Given Mr. Frisch’s statements and the goods described in the Exhibit C Order Form, Exhibit F and I advertisements and Exhibit Q Sales Demo Deck, I am prepared to accept that the Owner demonstrated that it had used the Mark in Canada, during the relevant period, in association with the following goods: “Computer software for converting print and electronic content into online digital publications; computer software to help enhance, distribute and track engagement in digital publications; (...) computer software program for analyzing and measuring usage of online publications”, within the meaning of sections 4 and 45 of the Act.

[36] As regards the remaining goods “software programs for computer desktop and mobile devices to distribute digital publications; computer software program for accumulating, displaying and selling media content online”, I find that there is no evidence of use of the Mark in association with these goods, except a bare statement from Mr. Frisch. Further, there is no evidence demonstrating special circumstances excusing non-use. Thus, the remaining goods will be expunged.

Registered services

[37] As indicated above, I am prepared to infer that the aggregate sales figures during the relevant period, provided by Mr. Frisch, included the goods and services depicted in the Exhibit Q Sales Demo Deck, and Exhibits F and I advertisements.

[38] Moreover, it is well established that the display of the trademark in the advertisement of the services is sufficient to satisfy the requirements of section 4(2) of the Act, from the time the owner of the trademark is willing and able to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[39] Given that the Exhibits F, G, H, and I advertisements all bear the Mark, that Exhibits F, I, and Q explain the services offered by the Owner, and given Mr. Frisch statements, I am prepared to accept that the Owner used the Mark in Canada, during the relevant period, in association with the following services: “Internet content delivery service to assist marketers, publishers, professionals, educators and corporations; developing marketing strategies and marketing concepts for others; e-commerce services for selling online digital content; market research and analysis services” within the meaning of sections 4 and 45 of the Act.

[40] As regards the remaining services “online publishing services; digital publishing services; advertising for others via electronic communication networks; marketing services, namely, assisting with promoting the products and services of others via electronic communication networks; facilitating the publication of software applications by third party software providers; training and consulting services for publishers”, I find that there is no evidence of use of the Mark in association with these services, except a bare statement from Mr. Frisch. Further, there

is no evidence demonstrating special circumstances excusing non-use. Thus, the remaining services will be expunged.

DISPOSITION

[41] 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: “software programs for computer desktop and mobile devices to distribute digital publications; computer software program for accumulating, displaying and selling media content online” and the following services: “online publishing services; digital publishing services; advertising for others via electronic communication networks; marketing services, namely, assisting with promoting the products and services of others via electronic communication networks; facilitating the publication of software applications by third party software providers; training and consulting services for publishers”.

[42] The Mark will now be registered in association with the following goods and services:

Goods

Computer software for converting print and electronic content into online digital publications; computer software to help enhance, distribute and track engagement in digital publications; computer software program for analyzing and measuring usage of online publications.

Services

Internet content delivery service to assist marketers, publishers, professionals, educators and corporations; developing marketing strategies and marketing concepts for others; e-commerce services for selling online digital content; market research and analysis services.

Ann-Laure Brouillette
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: February 7, 2022

APPEARANCES

May Cheng	For the Registered Owner
David Swayze	For the Requesting Party

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