

O P I C



C I P O

LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2022 TMOB 175**

**Date of Decision: 2022-08-30**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**PCG Trading, LLC**

**Requesting Party**

**and**

**Synnex Corporation, a Delaware  
Corporation**

**Registered Owner**

**TMA980,564 for CONVERGESOLV**

**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. TMA980,564 for the trademark CONVERGESOLV (the Mark), owned by Synnex Corporation, a Delaware Corporation (the Owner).

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

THE PROCEEDING

[3] At the request of PCG Trading, LLC (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on September 16, 2020.

[4] The notice required the Owner to show whether the Mark had been used in Canada in association with each of the services specified in the registration at any time within the three-year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is September 16, 2017, to September 16, 2020.

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

(1) Business management and administration consulting services; marketing and advertising consulting services; providing marketing strategies for others; advertising the wares and services of others; value-added reseller services, namely, distributorship services in the field of computers, computer hardware, computer software, computer security and information technology products for use in providing computer and communications networking services and solutions; distributorship services in the field of computers, computer hardware and network software, computer and network components, computer and network peripherals, computer security and information technology products for use in providing computer and communications networking services and solutions; Business Process Outsourcing (BPO) services namely computer and communications networking services and solutions; supply chain management services for use in providing computer and communications networking services and solutions; business consulting in the field of business networking.

(2) Training services, namely classes and courses in the field of computers, computer hardware, computer and network software, computer and network components, computer and network peripherals and information technology products; organizing educational events, namely seminars in the field of computers, computer hardware, computer and network software, computer and network peripherals and information technology products; conducting conferences and seminars in the field of computers, computer hardware, computer and network software, computer and network components, computer and network peripherals and information technology products; educational services in the field of computers, computer hardware, computer software, computer security and information technology products.

(3) Technical consulting services in the field of computer hardware and software and computer networks; consulting services in the fields of network security, Unified Communications (UC), telecommunications networks, information and communication technology; technical support and consulting services in the fields of computer hardware and computer networks; technical support and consulting services in the fields of cloud computing, computer security and network software, Infrastructure as a Service (IAAS) featuring software for use in providing computer hard drive and computer network data sharing, computer hard drive and computer network data hosting, and computer hard drive and computer network data protection services in the fields of computer, data and network security, data storage and backup, Platform as a Service (PAAS) featuring software for use in providing computer hard drive and computer network data sharing, computer hard drive and computer network data hosting, and computer hard drive and

computer networks data protection services in the fields of computer, data and network security, data storage and backup, and Software As A Service (SAAS) featuring software in the field of business process outsourcing ('BPO'); technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems; Infrastructure as a Service (IAAS) featuring software for use in providing computer hard drive and computer network data sharing, computer hard drive and computer network data hosting, and computer hard drive and computer network data protection services in the fields of computer, data and network security, data storage and backup; Platform as a Service (PAAS) featuring software for use in providing computer hard drive and computer network data sharing, computer hard drive and computer network data hosting, and computer hard drive and computer network data protection services in the fields of computer, data and network security, data storage and backup.

[6] The relevant definition of use in the present case is set out in section 4 of the Act as follows:

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[7] It is well established that the threshold for establishing use in these proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)]. However, 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 [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[8] 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 offers and is ready to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[9] In response to the Registrar's notice, the Owner furnished the affidavit of Daniel T. Brennan, Vice President & Senior Counsel for the Owner, sworn on April 15, 2021. Only the Owner submitted written representations; no hearing was held.

## THE EVIDENCE

[10] Mr. Brennan explains that the Owner is a United States-based information technology distribution company. He refers to Synnex Canada Limited (“Synnex Canada”), a wholly-owned subsidiary of the Owner, and states that any use of the Mark by Synnex Canada is under licence from and under the control of the Owner. He states that the Owner and Synnex Canada are purchasers and distributors of information technology and electronics equipment, with clients including resellers, system integrators, and retailers; further, the Owner and Synnex Canada offer a range of professional, technical, and marketing services. In particular, the Owner’s services include “CONVERGESolv Secure Networking”, an integrated communications technology network; further services are offered to vendors and resellers through the “CONVERGESolv Community” of CONVERGESolv Secure Networking members, as well as directly through the Owner’s website, the Synnex Canada website, and through vendors and resellers.

[11] Mr. Brennan explains that members of the CONVERGESolv Community are offered a range of services, including “Advanced Communications”, “Advanced Networking”, and “Advanced Security” services, and that the Owner offers a range of other services including sales training, education, engagement and recruitment services. Further, he states that the Owner “leverages the CONVERGESolv Community to provide distributorship services, advertising and promotional services, sales agency and consulting services, support services, and related services to its vendor partners” who are community members. He states that more than 750 Canadian resellers, retailers, and other customers are currently signed up as users of the CONVERGESolv Community.

[12] Mr. Brennan attaches a number of exhibits to his affidavit showing the Mark displayed in various brochures, screenshots, press releases, and emails; the most notable such exhibits include the following:

- Exhibit D, which Mr. Brennan describes as a “Playbook” marketing brochure advertising services offered in association with the Mark by the Owner and its subsidiaries. This brochure advertises a wide range of services offered by the Owner, generally falling under the categories of “Advanced Communications”, “Advanced Networking”, and “Advanced Security”, and prominently

displaying the Mark on each page. He states that this brochure was distributed to Canadian vendor partners during the relevant period, and that the services listed in the playbook were offered and performed by the Owner and/or Synnex Canada during the relevant period.

- Exhibit I, which Mr. Brennan describes as a 2017 “linesheet” brochure for the CONVERGESolv Secure Networking Group, advertising services available to Canadian customers of Synnex Canada. Mr. Brennan states that this document was distributed by Synnex Canada to its vendor clients during the relevant period.
- Exhibits J and K, which Mr. Brennan describes as price lists and product offerings for 2017 and 2018 for services offered by Synnex Canada. These include a “Custom Marketing Program” for CONVERGESolv Community members. Mr. Brennan explains that prospective clients could return completed copies of these price lists to Synnex Canada to join the CONVERGESolv Community and access the listed services.

[13] Finally, Mr. Brennan explains that the Owner hosted conferences and events in Canada for its clients and offered a variety of services at these events, including sales training, education, marketing and advertising, engagement and recruitment services, networking, and related services. He attaches a number of brochures and promotional emails relating to such events; materials dated within the relevant period include emails dated in 2018 , and a layout for a 2019 event in Canada showing a dedicated CONVERGESolv booth, attached as Exhibits N and O, respectively. As Exhibits P and Q, he attaches images of the Mark displayed at events dated in October 2017 and December 2018, respectively.

#### REASONS FOR DECISION

[14] The Requesting Party did not file written representations or request an oral hearing in this proceeding; nevertheless, the Owner must still demonstrate use of the Mark in association with each of the registered services. In this respect, I note that in some instances, the Owner’s evidence shows that the Mark was displayed in association with services offered by Synnex

Canada. As Mr. Brennan has confirmed that Synnex Canada, a wholly-owned subsidiary of the Owner, used the Mark exclusively under licence from and under the control of the Owner, I am satisfied that any use of the Mark by Synnex Canada would enure to the Owner pursuant to section 50(1) of the Act [see *Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102 at para 84].

[15] In its written representations, the Owner helpfully provides a chart correlating each of the registered services with corresponding sections of Mr. Brennan's affidavit and the attached exhibits. Each registered service will be discussed in turn. In determining whether the evidence provided by the Owner demonstrates use of the Mark within the meaning of the Act, I am mindful of the principles that services are to be construed liberally in a section 45 proceeding, that reasonable inferences can be made from the evidence provided [*Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64], and that "in certain cases, statements of services contain overlapping and redundant terms in the sense that the performance of one service would necessarily imply the performance of another" [*Gowling Lafleur Henderson LLP v Key Publishers Co*, 2010 TMOB 7 at para 15; see also *Provent Holdings Ltd v Star Island Entertainment, LLC*, 2014 TMOB 178 at para 22; *GMAX World Realty Inc v RE/MAX, LLC*, 2015 TMOB 148 at para 69].

[16] As set out below, I am satisfied that the Exhibit D brochure, the Exhibit I brochure, and the Exhibit J and K price lists, when read in conjunction with Mr. Brennan's sworn statements, constitute advertisement each of the registered services. Further, Mr. Brennan confirms in his affidavit that these materials were distributed to customers and prospective customers in Canada during the relevant period. Each of the materials prominently displays the Mark, and I am satisfied from Mr. Brennan's statements and from the totality of the evidence that the Owner, either itself or through its licensee Synnex Canada, were offering and prepared to perform the services in Canada during the relevant period.

[17] In particular, I am satisfied that specific registered services were advertised in the Exhibit D, I, J, and K materials as follows:

## Services (1)

- *“Business management and administration consulting services;”* and *“business consulting in the field of business networking”*: the Exhibit D brochure includes references to “risk consultation and analyses”, “assessments” for networking, security, and other technological and financial matters, and training for data management and security.
- *“marketing and advertising consulting services; providing marketing strategies for others; advertising the wares and services of others”*: the Exhibit J and K price sheets advertise a “SYNNEX Custom Marketing Program” including sales training, education, and opportunities for vendor customers to network with resellers and to receive benefits from the Owner such as telemarketing programs and other forms of advertisement.
- *“value-added reseller services, namely, distributorship services in the field of computers, computer hardware, computer software, computer security and information technology products for use in providing computer and communications networking services and solutions; distributorship services in the field of computers, computer hardware and network software, computer and network components, computer and network peripherals, computer security and information technology products for use in providing computer and communications networking services and solutions”*: it is clear from the totality of the evidence, including the Exhibit D and I brochures, that distributorship services of computer hardware and software and information technology products is the Owner’s core business, and such services are advertised throughout these materials.
- *“Business Process Outsourcing (BPO) services namely computer and communications networking services and solutions”*: the Exhibit D brochure advertises “network security solutions” and other services relating to data security, including training services, while the Exhibit I brochure advertises “data infrastructure solutions”.

- *“supply chain management services for use in providing computer and communications networking services and solutions”*: the Exhibit D brochure refers to “Source[ing] a variety of WLAN products and solutions, including [...] countless wireless devices/cards/solutions” and “Source[ing] effective reliable encryption solutions for customers who share, send, and receive highly sensitive data”.

## Services (2)

- *“Training services, namely classes and courses in the field of computers, computer hardware, computer and network software, computer and network components, computer and network peripherals and information technology products; organizing educational events, namely seminars in the field of computers, computer hardware, computer and network software, computer and network peripherals and information technology products; conducting conferences and seminars in the field of computers, computer hardware, computer and network software, computer and network components, computer and network peripherals and information technology products; educational services in the field of computers, computer hardware, computer software, computer security and information technology products”*: the Exhibit J and K price sheets advertise training courses in the fields of networking and security for computers and information technology products, and the Exhibit D brochure advertises networking and security training.

## Services (3)

- *“Technical consulting services in the field of computer hardware and software and computer networks; consulting services in the fields of network security, Unified Communications (UC), telecommunications networks, information and communication technology; technical support and consulting services in the fields of computer hardware and computer networks; technical support and consulting services in the fields of cloud computing, computer security and network software, Infrastructure as a Service (IAAS) featuring software for use*



*in providing computer hard drive and computer network data sharing, computer hard drive and computer network data hosting, and computer hard drive and computer network data protection services in the fields of computer, data and network security, data storage and backup, Platform as a Service (PAAS) featuring software for use in providing computer hard drive and computer network data sharing, computer hard drive and computer network data hosting, and computer hard drive and computer networks data protection services in the fields of computer, data and network security, data storage and backup, and Software As A Service (SAAS) featuring software in the field of business process outsourcing ('BPO'); technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems; Infrastructure as a Service (IAAS) featuring software for use in providing computer hard drive and computer network data sharing, computer hard drive and computer network data hosting, and computer hard drive and computer network data protection services in the fields of computer, data and network security, data storage and backup; Platform as a Service (PAAS) featuring software for use in providing computer hard drive and computer network data sharing, computer hard drive and computer network data hosting, and computer hard drive and computer network data protection services in the fields of computer, data and network security, data storage and backup”:* the Exhibit D and Exhibit I brochures advertise the Owner’s various technical support services such as assessments for networking, security, and other technological and financial matters; training for data management and security; and support services involving “software as a service”, networking and cloud computing, data security, storage, and recovery, including assessment of software security vulnerabilities. In addition, the Exhibit I brochure discusses Unified Communications and states that “SYNNEX CONVERGESolv Secure Networking [...] is structured to uniquely position us to execute a successful and truly integrated communications strategy for your organization.”

[18] I accept that the advertised services fall within the ambit of the registered services, as set out above. Accordingly, I am satisfied that the Owner has shown use of the Mark in association with each of the registered services within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[19] In view of all of the foregoing, 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.

---

G.M. Melchin  
Member  
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**

Gowling WLG (Canada) LLP

For the Registered Owner

Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l.

For the Requesting Party