



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2022 TMOB 209

**Date of Decision:** 2022-10-31

**UNREVISED ENGLISH**

**CERTIFIED TRANSLATION**

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

**Requesting Party:** Miller Thomson LLP

**Registered Owner:** Technicolor Trademark Management

**Registration:** TMA973,219 for PULSE

### **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. TMA973,219 for the trademark PULSE (the Mark).

[2] The statement of goods or services, including the Nice Classification (NCL), is reproduced below:

[translation]

Goods

CI 9 (1) Workflow management software for creating digital content, namely films, music, video recordings, animated films for entertainment services in the fields of television programming, live performance production, and filmmaking (para 14, CV-2); computer software for providing digital workflow solutions, integrated and automated from start to finish, from script development, pre-production, production, post-production, distribution to theatres and consumers, through to archiving, all while making it possible for clients/partners to participate and collaborate all along the development process and for capturing and developing film sequences, music, video recordings, animated films in order to provide adequate solutions to the problems identified, said software having a portal with a single point of access and being accessible through a digital platform.

## Services

CI 38 (1) Digital content transmission services, namely films, music, video recordings, animated films for entertainment services in the fields of television programming, live performance production, and filmmaking by electronic means and through data transmission networks, in particular via an Internet-type global telecommunications network or a private- or limited-access network through multi-user platforms; transfer, migration, and distribution services for digital content and metadata, namely films, music, video recordings, animated films for entertainment services in the fields of television programming, live performance production, and filmmaking; management of the digital distribution and storage of digital content, namely films, music, video recordings, animated films for entertainment services in the fields of television programming, live performance production, and filmmaking; provision of a computer workflow management platform for creating digital content, namely films, music, video recordings, animated films for entertainment services in the fields of television programming, live performance production, and filmmaking.

CI 42 (2) Provision of a computer workflow management software service for creating digital content, namely films, music, video recordings, animated films for entertainment services in the fields of television programming, live performance production, and filmmaking, computer software services for providing digital workflow solutions, integrated and automated from start to finish, from script development, pre-production, production, post-production, distribution to theatres and consumers, through to archiving, all while making it possible for clients/partners to participate and collaborate all along the development process; provision of a software service for capturing and developing film sequences, music, video recordings, animated films in order to provide adequate solutions to the problems identified.

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

## **THE PROCEEDING**

[4] At the request of Miller Thomson LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on September 22, 2020, to Technicolor Trademark Management, the registered owner of the Mark (the Owner). Following this notice, on June 7, 2021, the Registrar updated the registration to record Finale Post Production Inc. as the current owner of the Mark, effective April 27, 2021. This change of title is not at issue in this proceeding.

[5] The notice required the Owner to show whether the Mark was used in Canada in association with each of the goods and services listed 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 file, the relevant period for demonstrating use is September 22, 2017 to September 22, 2020.

[6] 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.

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

[8] In response to the Registrar’s notice, the Owner furnished the statutory declaration of Claire Villeneuve, sworn on March 2, 2021, in Paris, France, together with Exhibits CV-1 to CV-11.

[9] Both parties submitted written representations and were both represented at the hearing that was held.

## **OVERVIEW OF THE OWNER'S EVIDENCE**

[10] In her statutory declaration, Ms. Villeneuve identifies herself as both President of the Owner, a French company that manages the Mark, and as Vice President of Trademark Licensing of Technicolor SA (Technicolor), which she describes as follows:

[TRANSLATION]

Technicolor, formerly known as Thomson and Thomson Multimedia, is a French company specializing in the design, manufacture, and distribution of digital content and home access products such as decoders and residential gateways and is a major supplier of state-of-the-art services in the areas of special effects, animation, and postproduction for theatre, television, and the media industry [para 7].

[11] Ms. Villeneuve explains that the Owner licensed Technicolor and its Canadian subsidiary, Technicolor Canada, to use the Mark in Canada. She also states that the Owner controls, directly or indirectly, the characteristics or quality of the goods sold and the services rendered by its licensees [at paragraphs 1, 6, to 9]. For the sake of simplicity, and unless specific reference is made to a particular Licensee, I will now collectively designate Technicolor and Technicolor Canada as “the Licensees.”

[12] Ms. Villeneuve describes the Owner's clients as audiovisual companies or producers, directors, and other digital professionals [at paragraphs 13 and 30].

[13] At paragraph 13 of her declaration, Ms. Villeneuve describes the products bearing the Mark as follows:

[TRANSLATION]

These products are intended for the creation (including integration, acquisition, and development) of digital content, such as films, music, video recordings, and animated films. These Products enable an integrated and automated digital production flow for all steps in creating this digital content (script development, preproduction, production, post-production, distribution, and archiving). The products are collaborative software and are available in Canada through a digital platform for a fee.

[14] With respect to use of the Mark in general, Ms. Villeneuve states that, through its Licensees, the Owner sold the goods and rendered the services in association with the Mark in Canada in the normal course of trade throughout the relevant period. She also

states that the goods bore the Mark during their transfer of possession in Canada and that the same applies to all the services when offered or rendered in Canada [at paragraphs 10 to 12].

[15] In particular, concerning the use of the Mark in association with the goods, Ms. Villeneuve correlates the goods specified in the registration with the invoices she attached to support her statutory declaration.

[16] With regard to “Workflow management software for creating digital content, namely films, music, video recordings, animated films for entertainment services in the fields of television programming, live performance production, and filmmaking,” Ms. Villeneuve attached the following relevant exhibit:

- Ten sales invoices dated between May and June 2019 [Exhibit CV-2]. The invoices were issued by Technicolor Canada’s Vancouver office to NF Productions Canada ULC of Vancouver. The Mark appears in the body of the invoice, followed by the words “VFX Pull.” Ms. Villeneuve states that these invoices correspond to a 10-episode television series [at paragraphs 14 and 15].

[17] With respect to “computer software for providing digital workflow solutions, integrated and automated from start to finish, from script development, pre-production, production, post-production, distribution to theatres and consumers, through to archiving, all while making it possible for clients/partners to participate and collaborate all along the development process and for capturing and developing film sequences, music, video recordings, animated films in order to provide adequate solutions to the problems identified, said software having a portal with a single point of access and being accessible through a digital platform,” Ms. Villeneuve attached the following relevant exhibit:

- Two sales invoices dated between July and August 2020 [Exhibit CV-3]. The invoices were issued by Technicolor Canada’s Vancouver office to Switch 2 Productions Inc. of Vancouver: The Mark appears in the body of

the invoices, followed by the words “VFX Plate Pull.” Ms. Villeneuve states that these invoices relate to various phases of a film project [at paragraph 17].

[18] Ms. Villeneuve explained that the words “VFX Pull” and “Plate Pull” in the invoice specification refer to a type of visual effect. She states that these invoices accompanied each of the goods at the time of the transfer of possession to the users [paragraphs 14 and 16].

[19] With respect to the use of the Mark in respect of services, Ms. Villeneuve claims the sales invoices, provided as evidence of use with respect to the goods, as proof of the provision of software services specified in the registration [paragraph 22]. In addition, she attached the following relevant exhibits to support her declaration:

- A copy of a service offering dated June 21, 2018 [Exhibit CV-8]:  
Ms. Villeneuve states that this offer was made to NF Productions Canada ULC of Vancouver for a television series project [at paragraph 26]. The Mark appears in the title of the offer, followed by the words “Unlimited VFX Pulls.” I note that the services and prices are explained on two pages. I also note that under the heading “Description of Services,” it states:  
[TRANSLATION] “Editing will be done in the camera raw editor, followed by the final colouring, captioning, and creation of final deliverables to SGS at Technicolor Vancouver”;
- A copy of a service offering dated June 21, 2018 [Exhibit CV-10].  
Ms. Villeneuve states that this offer was made to the same Vancouver company [at paragraph 28]. The Mark appears with the name of the Owner in the form of a logo on the upper-left part of the offer. The Mark also appears in the main service heading, followed by the words “Storage with File Access”;
- Several screenshots of a general offer of goods and services from the *www.technicolor.com* website and screenshots of the animation included in this offering [Exhibit CV-11]. Ms. Villeneuve states that this offering and

animation are identical to those that were available on the Owner's website during the relevant period. She also states that the general offering explains the goods and services and their interrelationship [at paragraph 29]. The Mark appears with the name of the Owner in the form of a logo on screenshots of the offering and on a screenshot of the animation. In addition, it appears as a word mark on several screenshots of the offering. One of the screenshots reads: [TRANSLATION] "A software solution for managing, storing, and disseminating centralized and collaborative content from anywhere in the world";

- A copy of a brochure [Exhibit CV-12]. Ms. Villeneuve states that this brochure, designed around 2015, explains the Owner's services and their interrelationship. She also states that the brochure was distributed in Canada during the relevant period by the Owner and its Licensees to producers, directors, and other digital professionals [at paragraph 30]. The Mark appears with the Owner's name in the form of a logo on each page. I note that the brochure, written in English, sets out and explains the services on two pages. I also note that the following is written at the bottom of the first page: [TRANSLATION] "Contact your local Technicolor account manager to plan a demo *www.pulse.technicolor.com/contact*."

[20] Ms. Villeneuve states that all copies of service offerings were made by Technicolor Canada. She also states that these service offerings cover both Class 42 services and the four Class 38 services. In addition, Ms. Villeneuve states that the four Class 38 services and the two Class 42 services are interrelated, so that one service is required for the provision of the other [at paragraphs 26 and 28].

### **ANALYSIS AND REASONS FOR DECISION**

[21] The Requesting Party submits that the evidence is ambiguous and describes the set of statements made by Ms. Villeneuve as mere statements of use insufficient to show use of the Mark. In particular, she submits that the set of exhibits filed in support of the statutory declaration do not support the claims of use in respect of the goods and services specified in the registration, with the exception of the Class 38 digital content

transmission services. The Requesting Party's arguments concern the following areas: (i) The absence of a licence agreement and evidence of control by the Owner; (ii) A statement of goods and services specified in the registration; and (iii) The use of the Mark in association with the goods and services under the Act.

[22] The Owner submits that the evidence considered as a whole clearly shows the use of the Mark in association with the goods and services during the relevant period in Canada.

***Control of the character or quality of the goods and services***

[23] The Requesting Party considers that the Owner has not established the relationship between it and its Licensees and that, as a result, no evidence of employment can benefit it. In particular, it considers that, in the absence of having produced the licence contract and evidence of control of the nature or quality of its goods and services in association with the Mark, the Owner has not discharged its burden. However, it is not necessary to furnish a written licence agreement to establish licensed use of a trademark [see *Wells' Dairy Inc v UL Canada Inc* (2000), 7 CPR (4th) 77 (FCTD)]. The owner of a trademark may demonstrate the requisite control of the characteristics or quality of goods sold under licence under section 50(1) of the Act, either by explicitly stating that it exercises the necessary control or by providing evidence that it exercises the requisite control [*Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102, aff'd 2011 FCA 340]. In this file, Ms. Villeneuve explicitly states that the Owner did exercise the requisite control and, therefore, was not required to file additional evidence.

***The statement of the goods and services specified in the registration***

[24] The Requesting Party argues that the registration includes a [TRANSLATION] "myriad of goods and services that cannot be grouped together." As a result, it questions the correlation made by Ms. Villeneuve in her declaration. However, it should be remembered 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, and a registered owner must only establish a *prima facie* case of use within the



meaning of sections 4 and 45 of the Act. For this reason, the threshold for showing use that the registered owner must provide is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448 at para 38] and “evidentiary overkill” is not required [see *Union Electric Supply Co Ltd v Registrar of Trademarks* (1982), 63 CPR (2d) 56 (FCTD) at para 3].

[25] In this file, Ms. Villeneuve accurately correlates the goods specified in the registration with the invoices submitted in support of her declaration [Villeneuve Declaration, para 14]. She also correlates the services specified in the registration with the offerings and explains the existing interrelationship between all the services [Villeneuve Declaration, paras 26 and 28]. In this regard, it is well established that an affiant’s sworn statement is to be accepted at face value and that statements in an affidavit or statutory declaration must be accorded substantial credibility in section 45 proceedings [*Oyen Wiggs Green & Mutala LLP v Atari Interactive Inc*, 2018 TMOB 79 at para 25].

[26] Moreover, concerning the services and contrary to the goods, the Registrar has previously held that “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]. In this file, in view of the nature and scope of the Owner’s activities and the description of the goods related to the services, I find it reasonable to conclude that the performance of one service may result in the performance of another.

[27] For all these reasons, I consider the correlations and explanations provided by Ms. Villeneuve in respect of the goods and services as sufficient for the purposes of this proceeding.

***Use of the Mark in association with the goods and services under the Act***

[28] In general, the Requesting Party describes the evidence as ambiguous and insufficient to show use of the Mark in association with the goods and services; for example, it claims that the screenshots of the general service offering date from after the relevant period and that they do not show, on their face, the interrelationship between the different services.

[29] The Owner submits that the Requesting Party's approach of looking at each piece of evidence in isolation is inappropriate. I agree. Evidence in a section 45 proceeding must be considered as a whole, and focusing on individual pieces of evidence in isolation is not the proper approach [see *Kvas Miller Everitt v Compute (Bridgend) Ltd* (2005), 47 CPR (4th) 209 (TMOB); and *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB)]. In this file, Ms. Villeneuve states that this offering is representative, and she attests that the interrelationship between the services is explained therein [Villeneuve Declaration, para 29].

[30] The Requesting Party also alleges that the product specification on the invoices does not include the word "software," nor does it provide sufficient information on the software covered. Similarly, it alleges that the offerings do not contain any express indication of the services. In addition, it considers that the explanation given by Ms. Villeneuve of the words "VFX Pull" and "VFX Plate Pull," on the invoice specifications and on the service offerings, highlights their inadequacy. At the hearing, the Requesting Party alleged, and I quote, that: [TRANSLATION] "creating a visual effect is not the same as providing software."

[31] I do not consider the absence of the word "software" and/or the lack of details on the invoices to be fatal to the Owner, given the correlations made by Ms. Villeneuve. Furthermore, the notice of association was given in view of the presence of the Mark in the body of the invoices and the fact that these invoices accompanied the products at the time of transfer. Moreover, one of the screenshots of the general service offering from the Owner's website, which Ms. Villeneuve argues is representative of the one

available during the relevant period, explicitly speaks of a “software solution.” With respect to the explanation of the words “VFX Pull” and “VFX Plate Pull,” it has been established that the Registrar can make reasonable inferences from the evidence provided [see *Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64]. In this file, in view of the purpose and scope of this proceeding and the fact that the Owner identifies itself as a major supplier of state-of-the-art services in the areas of special effects and animation [Villeneuve Declaration, para 7], I find it reasonable to consider the visual effect at issue as, *prima facie*, a graphical feature that may be attributable to the software covered by the registration and to the services related to them. Therefore, I consider the invoices and offerings to be sufficient and, moreover, consistent with the correlations made by Ms. Villeneuve.

[32] In particular, with respect to the services, although the Requesting Party acknowledges that the software sales invoices show use of the Mark in respect of the digital content transfer service, as described in Class 38, it contends that these invoices do not show use in respect of the other services. In addition, it alleges that the copies of service offerings do not relate to the Owner, but rather a U.S. entity for which no licence is demonstrated. Therefore, the Requesting Party submits that any use of the Mark in association with the services does not benefit the Owner. Finally, the Requesting Party alleges that the evidence does not indicate any confirmation of the offerings, so that the performance of the other services is not demonstrated.

[33] With respect to the invoices, I do not consider the Requesting Party’s claims to be justified. In line with the principle set out in *Oyen Wiggs Green*, quoted above in paragraph 25, I give substantial credibility to Ms. Villeneuve’s statements that these invoices show the two services described in Class 42. In addition, the evidence submitted in support of the use of the Mark in association with the services is not limited to invoices.

[34] With respect to service offerings, although I agree with the Requesting Party that copies of offerings show an address in the United States, I note that the entity located at this address is “Technicolor.” In this regard, I would like to point out that Ms. Villeneuve

states that all service offerings were made by Technicolor Canada [Villeneuve Declaration, paras 26 and 28].

[35] Furthermore, although I also agree with the Requesting Party that the evidence does not indicate confirmation of the offerings, the absence of evidence of performance of services is not fatal to the Owner. It was established that in the absence of performance of the services covered by the registration, the evidence must show not only that the services were advertised, but also that the owner was ready and able to perform those services in Canada during the relevant period [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)]. In this file and as indicated above, one of the offerings indicates that certain services will be performed at the Owner's Vancouver office [Exhibit CV-8, page 43]. In addition, the reference to the local account manager on the brochure and the presence of one of the Licensees in Canada demonstrates that the Owner was ready and able to perform its services in Canada [Exhibit CV-12, page 82].

[36] Thus, in light of the evidence as a whole, I am satisfied that the Owner showed use of the Mark in association with each of the goods specified in the registration during the relevant period. I am also satisfied that the Owner was ready and able to perform all its services in Canada during the same period, the whole pursuant to subsections 4(1) and (2) and section 45 of the Act.

### **DECISION**

[37] 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.

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Maria Ledezma  
Hearing Officer  
Trademarks Opposition Board  
Canadian Intellectual Property Office

Certified translation  
Daniel Lepine

The English is WCAG compliant.

# Appearances and Agents of Record

**HEARING DATE:** 2022-09-26

## **APPEARANCES**

**For the Requesting Party:** David Schnurr

**For the Registered Owner:** Barry Gamache

## **AGENTS OF RECORD**

**For the Requesting Party:** Miller Thomson LLP

**For the Registered Owner:** ROBIC