



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 244

Date of Decision: 2022-12-06

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Wenbo Zhang

Registered Owner: Avago Technologies International Sales PTE. Limited

Registration: TMA594,093 for BROADCOM

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. TMA594,093 for the trademark BROADCOM (the Mark) registered for use in association with the following services (the Services):

Design for others in the field of computers, integrated circuits, communications and networks.

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

THE PROCEEDING

[3] At the request of Wenbo Zhang (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on May 13, 2021 to the registered owner of the Mark, Avago Technologies International Sales PTE. Limited (the Owner).

[4] The notice required the Owner to show whether the Mark was used in Canada in association with the 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 May 13, 2018 to May 13, 2021 (the Relevant Period).

[5] The relevant definition of use in the present case is set out in section 4(2) of the Act as follows:

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.

[6] In the absence of use, the registration is liable to be expunged, unless the absence of use is due to special circumstances [section 45(3) of the Act].

[7] In response to the Registrar's notice, the Owner furnished the Affidavit of Amanda Swaim, sworn on December 7, 2021, to which were attached Exhibits A to E.

[8] Only the Owner submitted written representations. No hearing was held.

THE EVIDENCE

[9] Amanda Swaim is the Senior IP Counsel for the Owner. She has access to all of the Owner's company records and is familiar with the history, sales and marketing of the Owner's products and services.

[10] Ms. Swaim states that the Owner, a subsidiary of Broadcom Inc., is a provider of hardware, software, enterprise and network security and semiconductors (including integrated circuits, chips and switches) to markets in Canada and worldwide.

[11] Ms. Swain states that the Services were sold to Canadian customers, such as Statistics Canada, during the Relevant Period in association with the Mark via facilities and authorized distributors, by contacting the Owner's customer service team by e-mail or phone, or by submitting a request through an online portal at *www.broadcom.com*.

[12] Ms. Swain provides, as Exhibits A to D, representative images depicting the way in which the Mark was displayed in association with the Services in Canada during the Relevant Period. The exhibits consist of the following documents, each of which displays the Mark:

Exhibit A: Document entitled "Implementation, Migration and Residency Services". The document refers to the various services offered including the following:

"From network assessments and resident consulting to infrastructure specific designs ..."

"Through our Plan, Deploy and Manage initiatives, we have you covered. We value the opportunity to help you at every stage of your network lifecycle."

"Comprehensive analysis of your existing SAN environment, including a review of the architecture, device configuration, management, monitoring, availability and scalability ..."

"Design of your new SAN network, including fabric and device configuration specifications ..."

Exhibit B: Document entitled "CA Productivity Accelerator Quick Start Service". The CA Productivity Accelerator is described as

"a powerful technology solution that helps organizations to efficiently deploy, maintain and upgrade any software by covering the complete application life cycle, including design, implementation, user readiness training, along with post go-live performance support when user are working in live systems."

Exhibit C: Document entitled "Hardware Design Guidelines" which describes "the hardware design guidelines for the BCM56980 family of devices" and "the requirements for the high-speed external I/O interface used on these devices, provides a diagram of how each high-speed interface must be connected, and shows routing examples when applicable."

Exhibit D: Document entitled “5 OAuth Essentials for API Access Control” The document is described as follows:

“In this eBook, we outline five key considerations for organizations that are thinking of using OAuth as a mechanism for controlling access to enterprise APIs. These considerations will give you the basic knowledge and framework you will need in order to address the complex challenges associated with implementing OAuth and managing an OAuth provider. We also provide links to additional recourses that deliver more in-depth knowledge.”

[13] Ms. Swaim provides, as Exhibit E, representative copies of invoices issued during the Relevant Period evidencing sales of the Services by the Owner in association with the Mark to Statistics Canada. She notes that the invoices reference CA, Inc. and states that CA, Inc. is also a subsidiary of Broadcom Inc. and that CA, Inc. uses the Mark under the authorization and control of the Owner.

[14] Exhibit E consists of four invoices, each dated within the Relevant Period, from CA, Inc. to Statistics Canada in Ottawa, Ontario. Each invoice displays the Mark and is for services described as “CA Automic Workload Automation Design”.

ANALYSIS AND REASONS FOR DECISION

[15] The purpose 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, the Owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[16] Given the evidence of Ms. Swaim, and in particular the description of services offered in Exhibit A, I am satisfied that the Services were offered in association with the Mark and that the Services were provided to a Canadian customer, namely Statistics Canada, during the Relevant Period in association with the Mark, as shown by the invoices in Exhibit E.

[17] Further, given the evidence of Ms. Swaim, and in particular her statement that the use of the Mark by CA, Inc. was under the authorization and control of the Owner, I am satisfied that the Owner has demonstrated the requisite level of control pursuant to section 50 of the Act such that any evidenced use of the Mark during the Relevant Period by CA, Inc. enured to the benefit of the Owner.

[18] Accordingly, I am satisfied that the Mark was used in Canada by the Owner in association with the Services during the Relevant Period within the meaning of sections 4(2) and 45 of the Act.

DISPOSITION

[19] 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 maintained.

Robert A. MacDonald
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Requesting Party: Bayo Odutola (OLLIP P.C.)

For the Registered Owner: Amy Croll (Origins IP)