



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 170

**Date of Decision:** 2023-10-04

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

**Requesting Party:** Borden Ladner Gervais LLP

**Registered Owner:** Freedom Mobile Inc.

**Registration:** TMA949,438 for TRUE MOBILE FREEDOM

### **INTRODUCTION**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA949,438 for the trademark TRUE MOBILE FREEDOM (the Trademark) in the name of Freedom Mobile Inc. (the Owner).

[2] The Trademark is registered for use in association with a number of telecommunications, multimedia and interactive telecommunications and information technology equipment and services. The statement of goods and services is reproduced in its entirety in Schedule A to this decision.

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

## **RECORD**

[4] On June 9, 2021, at the request of Borden Ladner Gervais LLP (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 the Owner. The notice required the Owner to show whether the Trademark 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 and, if not, the date when the Trademark was last in use and the reason for the absence of such use since that date.

[5] The relevant period for showing use is therefore between June 9, 2018 and June 9, 2021.

[6] In this case, 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] Where the owner has not shown “use”, the registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[8] 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 *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at para 3; *Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448 at para 38].

[9] Nevertheless, bare assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings, and sufficient facts must still be provided to allow the

Registrar to conclude that the mark was used in association with the goods and services listed in the registration [*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)].

[10] In response to the Registrar's notice, the Owner submitted the affidavit of Lisa Cooke, Vice-President, Advertising of Shaw Communications Inc. (Shaw), sworn on January 6, 2022, together with Exhibits A to D.

[11] Both parties filed written representations; only the Requesting Party was represented at an oral hearing.

### **SUMMARY OF THE EVIDENCE**

[12] In her affidavit, Ms. Cooke attests that the Owner is a wholly-owned subsidiary of Shaw. She explains that the "wireless" division of Shaw, which provides wireless voice and LTE data services, is operated by the Owner.

[13] Ms. Cooke asserts that the Trademark has remained "in use" throughout the relevant period. In particular, Ms. Cooke states that the Trademark was used in the Owner's advertising of the goods and services specified in the registration.

[14] According to Ms. Cooke, evidence of such use can be found on archived pages of the Owner's website located at [www.freedommobile.ca](http://www.freedommobile.ca). She states that the website displayed the following tagline: "Freedom Mobile Gives You True Mobile Freedom With Affordable Talk, Text & Data". In support, Ms. Cooke provides screenshots from the Wayback Machine showing pages of the Owner's website archived during the relevant period [Exhibit B]. Neither the tagline referenced by Ms. Cooke nor the Trademark appear to be displayed on the portions of webpages which are visible in the exhibited screenshots. However, the HTML source code of the webpages, which is also shown in the screenshots, includes lines of code containing the tagline in question.

[15] Ms. Cooke also provides a screenshot of a "Google Search Console" for the Owner's website which displays information for the period from July 1, 2020 to June 9,

2021 [Exhibit C]. Ms. Cooke explains that the Console screenshot shows that there were more than 19 million impressions and 2 million clicks of the Owner's website in that period. She adds that an "impression" occurs when a user sees an advertisement, and a "click" occurs when a user follows through and clicks on the advertisement.

[16] Ms. Cooke attests that, during the relevant period, the Owner spent approximately \$1.6 million on the above-described advertising.

[17] Finally, Ms. Cooke attests that the Owner has "taken steps to expand its online usage of the Trademark" and intends to rebrand certain wireless services under the Trademark on its homepage and social media channels beginning February 1, 2022. In support, she provides "mock-ups" of the advertising [Exhibit D]. The exhibited mock-ups depict a webpage and social media pages, all displaying the Trademark as part of the slogan "Discover True Mobile Freedom".

## **REASONS**

### ***Goods***

[18] The Owner contends that the evidence "shows that during the Relevant Period, the Trademark was associated with the Goods at the time of sale" [Owner's written representations at para 27]. In this regard, the Owner essentially submits that its products can be purchased by consumers directly on the Owner's website.

[19] Be that as it may, for the purposes of section 4(1) of the Act, it is not sufficient that the Owner provide evidence that goods were offered during the relevant period; some evidence of transfers in the normal course of trade in Canada is necessary [see, for example, *Molson Cos v Halter* (1976), 28 CPR (2d) 158 (FCTD); and *Gowling, Strathy & Henderson v Royal Bank* (1995), 63 CPR (3d) 322 (FCTD)].

[20] Such evidence of transfers can be provided in the form of documentation like invoices and sales reports; it can also be provided through clear sworn statements regarding volumes of sales, dollar value of sales, or equivalent factual particulars [see, for example, *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79].

[21] There is no such evidence before me. I am therefore not satisfied that the Owner has demonstrated use of the Trademark in association with the registered goods within the meaning of sections 4 and 45 of the Act.

### **Services**

[22] A trademark is used in association with services where it is displayed in the performance or advertising of those services. In the present case, the Owner does not argue that the Trademark was displayed in the performance of the registered services. Instead, the Owner asserts use of the Trademark through advertising on its website.

[23] In a nutshell, the Owner essentially argues that Ms. Cooke's statement regarding the display of the "Freedom Mobile Gives You True Mobile Freedom With Affordable Talk, Text & Data" tagline on the website, together with the evidenced metadata of archived webpages from that website, is sufficient to establish that the Trademark was used [Owner's written representations at paras 33 to 45].

[24] In response to that argument, the Requesting Party takes the position that that Ms. Cooke's statement is not substantiated by the evidence because a website's metadata is not necessarily visible to visitors of the website.

[25] While the Requesting Party's position is not without merit, it is a well-established principle that an affiant's statements are to be accepted at face value and must be accorded substantial credibility in a section 45 proceeding [see *Oyen Wiggs Green & Mutala LLP v Atari Interactive Inc*, 2018 TMOB 79 at para 25]. Having regard to the evidence as a whole, I am prepared to accept that the tagline referenced above was displayed on the Owner's website during the relevant period, as asserted by Ms. Cooke.

[26] The Trademark is undeniably included in the tagline. However, where a trademark is used in combination with additional words or features, use will be considered when the public, as a matter of first impression, would perceive the mark as being used *per se*. This is a question of fact which is dependent on whether the mark stands out from additional material, for example, by the use of different lettering, sizing, or whether the additional material would be perceived as clearly descriptive or as a

separate trademark or tradename [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); see also *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)].

[27] Given that the Owner has not shown how the tagline was displayed on the website, I am unable to assess whether the Trademark stands out from the additional material of the tagline. Further, even if I were to find that the Trademark was in fact displayed as registered, I would be unable to assess whether the Trademark was sufficiently associated with the services specified in the registration.

[28] As I cannot determine whether the display of the above-referenced tagline constitutes display of the Trademark *per se* in association with any registered services, I am not satisfied that the Owner has demonstrated use of the Trademark within the meaning of sections 4 and 45 of the Act.

#### **DISPOSITION**

[29] The Owner has not argued that special circumstances excuse the absence of use, nor provided sufficient evidence to support such a finding.

[30] Consequently, 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 expunged.

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Eve Heafey  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

## **SCHEDULE A**

### GOODS

(1) Telecommunications, multimedia and interactive telecommunications and information technology equipment, namely, telephones, cell phone accessories, namely, cases, pouches, microphones, adapters, headphones, headsets, batteries, chargers, faceplates, cords, smart card, memory cards, memory sticks and user manuals, modems, handheld computers, residential and business local area wireless antennas, aerials for telecommunications, prepaid phone service cards, carrying cases and pouches, microphones, adapters for use in connection with the foregoing telecommunications equipment, headsets, telephone and handheld computer mounts, batteries and chargers, faceplates, answering machines, cameras, external memory storage devices, namely computer memory cards, USB flash driver, external hard drive; user manuals, phone card, computer games.

### SERVICES

(1) Telecommunications, multimedia and interactive telecommunications, information technology services, namely, local, long-distance and international telephone and telephony services; voice activated dialing services; prepaid calling card services; e-mail services; voice e-mail services; text and picture messaging services; paging services; online text, video and data recording, storage and distribution services related to content generated by or used in connection with cell phones, said data consisting of data, namely, text messages, emails, images, namely, photos and video clips; facsimile mail services; internet browsing services; directory assistance services; call display services; cellular network services, namely, operating a cellular phone network; telecommunication services, namely, provision of pricing plans, rate plans and rate plan bundles for wireless devices, namely, wireless phones and mobile phones; providing internet access, providing search tools on the internet and providing access to a global computer information network; providing wireless reception and transmission of messages, global computer network e-mail that enables the user to keep track of or manage personal information and that synchronizes data between a remote station or unit and a fixed or remote station or unit, said data consisting of data, namely, text messages, emails, images, namely, photos and video clips; telecommunications services, namely, bundles allowing customers to reach cellular phones, voicemail and call routing between wireline and wireless phones and voicemail boxes; secure network access services, namely, internet, electronic mail services and local area network access services via a wireless device; providing access to downloadable content permitting the user to personalise the sound made when there is an incoming call to the wireless communication device; ring tone selection services; graphic image services permitting users to download graphics from the internet; picture and multimedia message services permitting the user to capture pictures, sounds or video and send those content objects using their wireless communications devices; the provision of television programs on mobile telecom devices; providing access to music downloads selected from a music catalogue or through a browser suitable for a wireless telecommunications device; developing, distributing downloadable games; providing access to a global positioning system (gps) application combined with a cellular network; supplying and advising with respect to the selection, installation, operation,

maintenance, repair, refurbishing and repurchase of wireless communications devices, namely, wireless phones, mobile phones, handheld computers and tablets; operating retail outlets and stores, websites, virtual stores, or any other centralized locations for the sale, rental, demonstration, promotion, consultation, installation, maintenance, repair, refurbishing and repurchase of wireless communications devices, namely, wireless phones, mobile phones, handheld computers and tablets, and related accessories, namely, cases, pouches, microphones, adapters, headphones, headsets, batteries, chargers, faceplates, cords, smart card, memory cards, memory sticks and user manuals; operating client care, information helplines and operations services regarding the provision of telecommunications and wireless communications devices, namely, wireless phones, mobile phones, handheld computers and tablets, and related accessories, namely, cases, pouches, microphones, adapters, headphones, headsets, batteries, chargers, faceplates, cords, smart card, memory cards, memory sticks and user manuals; operating a promotional incentive award and loyalty program allowing customers to earn and redeem points and coupons; picture and multimedia services permitting users to capture and download pictures, graphics, sounds or video and to send those content objects using their wireless communications devices, namely, wireless phones, mobile phones, handheld computers and tablets.



# Appearances and Agents of Record

**HEARING DATE:** 2023-09-18

## **APPEARANCES**

**For the Requesting Party:** Jeffrey Gordon

**For the Registered Owner:** No one appearing

## **AGENTS OF RECORD**

**For the Requesting Party:** Borden Ladner Gervais LLP

**For the Registered Owner:** Fasken Martineau DuMoulin LLP