



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 177

Date of Decision: 2023-10-23

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Joshua Shaffer

Registered Owner: Warren Huntley

Registration: TMA942,521 for SMARTSIZING

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. TMA942,521 for the trademark SMARTSIZING (the Mark).

[2] The Mark is registered for use in association with the following goods and services:

Goods

(1) Books, booklets, manuals, brochures, pamphlets, newsletters and periodicals, all on the topic of finance, investment and real estate;

(2) audio recordings, namely pre-recorded compact disks, DVDs and CD-ROMs, all on the topic of finance, investment and real estate; video recordings, namely pre-recorded

videotapes, compact disks, DVDs and CD-ROMs, all on the topic of finance, investment and real estate

(the Goods)

Services

(1) Consulting services in the field of finance, investment and real estate;

(2) educational services, namely, instruction in the fields of finance, investment and real estate;

(3) provision of information, namely, videos, movies, pictures, photos, and digital audio recordings on the subject of finance, investment and real estate over the Internet;

(4) franchising services, namely providing, to franchisees of the applicant, instructions, advice and technical assistance in the establishment and operation of consulting service franchises in the field of finance, investment and real estate

(the Services)

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

THE PROCEEDING

[4] At the request of Joshua Shaffer (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on July 22, 2021, to Warren Huntley (the Owner), the registered owner of the Mark.

[5] The notice required the Owner to show whether the Mark 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 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 July 22, 2018 to July 22, 2021.

[6] The relevant definitions of “use” in the present case 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 does not show “use”, the registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Warren J. Huntley, sworn October 13, 2022 together with Exhibits WH-1 to WH-12.

[9] Neither party filed written representations and no oral hearing was held.

THE OWNER’S EVIDENCE

[10] Mr. Huntley is an independent financial advisor and income specialist with experience in banking, insurance and investments. He states that before the relevant period, he created a program in the field of finance, investment and real estate, which has always been identified with the Mark (the Program). According to Mr. Huntley, the Program is designed to assist individuals based in Canada with the process of trading their family home for a new home that will fit their lifestyle and goals better, and planning to ensure that they have the financial capital and cashflow required to meet their financial goals at the time of planning and in retirement [para 3].

[11] Mr. Huntley generally states that the Goods and Services were advertised and sold in association with the Mark in his normal course of trade in Canada during the relevant period. In particular, he states that the Mark was used in two ways, namely as part of a franchising model through authorized franchisees and directly by himself.

[12] With respect to the use of the Mark through a franchising model, Mr. Huntley states he concluded a licence agreement with financial advisors, real estate agents or real estate brokers (the Franchisees) allowing them to offer the Goods and Services, except for the franchising services, to their own clients in Canada during the relevant period. He confirms that, pursuant to the licence agreement, he personally controlled

the use, advertisement and display of the Mark as well as the quality and character of the Goods and Services. Mr. Huntley asserts that he provided the franchising services, Services (4), to his Franchisees. In addition, he asserts that an initial training session was included for the Franchisees during their first year of membership to the Program upon payment of a fixed fee. According to Mr. Huntley, on-site seminar presentations, group training sessions and personal consultations were also provided on demand. He further asserts that he had five Franchisees in 2018, three of which were also his Franchisees in 2019, 2020 and 2021 [para 6]. In support, he provides three documents entitled "Program Details" for the years 2018, 2019 and 2020 [Exhibits WH-2, WH-3 and WH-4, respectively]. The Mark is displayed on the top left side of each document. All the Program Details refer to case study materials and specify the membership fees as well as the options for training sessions, seminar presentations and personal consultations.

[13] In addition to the Program Details, Mr. Huntley provides other informative documents (the Informative Documents) to support his general statements of use of the Mark in the advertising of all the Services in Canada during the relevant period, namely:

- Exhibit WH-8: consists of a one-page document entitled "What is Smartsizing ®?" The document ends with: "Smartsizing® may be one of the most important decisions you make in your lifetime - Ask me about Smartsizing® and what it can do for you", followed by the Owner's phone number and email address.
- Exhibits WH-9, WH-10 and WH-11: consists of three one-page documents entitled "Smartsizing ® Overview". The first document lists the Program's benefits for real state agents. The second document lists what the Program offers to them, including a PowerPoint presentation and training sessions. Both documents end with the Owner's phone number and email address preceded by "Please contact me to learn more about the Smartsizing ® Program". The third document describes the Owner's background and ends with the "Contact us" reference followed by "to learn more, including how to

schedule an information session at your brokerage, please contact us: *info@smartsizingprogram.ca*".

[14] Mr. Huntley asserts that the Program Details and the Informative Documents were provided to prospective and active Franchisees, as well as to his Clients [paras 6 and 9].

[15] With respect to the use of the Mark by himself, Mr. Huntley states that he personally provided consulting and educational services, Services (1) and (2), to financial advisors, real estate agents or real estate brokers operating in Canada (the Clients) during the relevant period [paras 6 and 7]. In support, he provides a one-page document entitled "The Smartsizing ® Program Savings Worksheet" (the Worksheet) [Exhibit WH-5]. This document lists several expenses under four headings, namely "Debt", "Automotive", "Lifestyle" and "Miscellaneous" and a column of savings. I note that the Worksheet is blank. Mr. Huntley also provides two different PowerPoint presentations (the Presentations) [Exhibits WH-6 and WH-7], which he states are representative of those used and provided in Canada during the relevant period. The Mark is displayed on the first and last page, at the bottom of each slide and throughout the Presentation. I note that five trainings sessions are listed in one of the slides of the second Presentation. I also note that some slides of both Presentations are completely redacted.

[16] Mr. Huntley asserts that the Worksheet and the Presentations were used by himself in the performance of consulting and educational services with his Clients and that he also provided them to the Franchisees, as part of the Services (4), for further use with their own clients [paras 7 and 8].

[17] Lastly, Mr. Huntley states that he used his YouTube channel, and in particular, a video to advertise the Services in Canada. In this regard, he asserts that he explains the Program and provides Services (2) and (3) on the video. He also states that the video has been viewed 124 times "in the last 8 years, including the relevant period" [para 10]. In support, he provides two screenshots of the Canadian YouTube channel [Exhibit WH-12]. I note that most of the screenshots' content is in French. The Owner's

YouTube channel's hyperlink appears on the top of both screenshots. The first screenshot shows a YouTube search result with one online video. I note that the Mark is written in the "search" text box of the YouTube channel. The video is entitled with the Mark followed by "WJH A". The video appears to last around 2 minutes as "2.03" is shown on the right corner of the video's image. Under the video's title, I read [TRANSLATION] "124 views – 8 years ago". The second screenshot shows a video paused in 0:02/2.02 showing "Welcome to SmartSizing" on the screen. The video has the same title as the video shown in the previous screenshot and the Mark is also written in the search text box. Under the video's title, I read [TRANSLATION] "124 views – March 13 2014".

ANALYSIS AND REASONS FOR DECISION

[18] 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 [*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 v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at para 3]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the mark was used in association with the Goods and Services.

The Goods

[19] At the outset, I note that aside from the general statement that the Mark was used in association with the Goods and in their recitation, Mr. Huntley only refers to them when stating that the licence granted to the Franchisees was under the requisite control pursuant to section 50(1) of the Act. The pieces of evidence submitted in support to this statement are the three copies of the Program Details [Exhibits WH-2 to WH-4]. Although they all display the Mark, I find that they do not correlate with any of Goods (1). In my view, as the documents are one page long, they do not reasonably correspond to books, booklets and manuals. More importantly, I am unable to conclude from their content that they could be on the topic of finance, investment and real estate

so as to correlate to any of Goods (1) as these pieces of evidence simply promote the Program. Similarly, given the content of the remaining pieces of evidence, I find that none of them reasonably correspond to any of Goods (1). Further, although the Program Details and one of the Informative Documents [Exhibit 9] refer to “materials”, it has been established that, generally, use of a trademark in association with goods cannot be established through the display of the trademark on advertising for those goods [*Tint King of California Inc v Canada (Registrar of Trademarks)*, 2006 FC 1440 at para 40]. Moreover, Mr. Huntley provides no evidence of transfer of Goods (1) in Canada during the relevant period.

[20] As for Goods (2), Mr. Huntley provides no evidence of the manner of association between them and the Mark. Nor does he provide evidence of transfer of these goods in Canada during the relevant period.

[21] In the absence of evidence showing use of the Mark in association with the Goods within the meaning of sections 4(1) and 45 of the Act, or special circumstances to justify the absence of use, all the Goods will be deleted from the registration.

The Services

[22] 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)].

Services (2) and (4)

[23] From the evidence as a whole, I find that the that the Owner advertised the franchising services, Services (4), in Canada during the relevant period and that the Mark was displayed in association with such services on the Program Details [Exhibits WH-2, WH-3 and WH-4] and the Presentations [Exhibits WH-6 and WH-7]. These pieces of evidence advertise the franchising services and were addressed to the Owner’s potential Franchisees. Further, as they refer to training sessions, I also find that the Owner advertised the educational services, Services (2), in Canada during the

relevant period. Given that Mr. Huntley also provides the number of Franchisees he had during the relevant period, I conclude that the Owner was not only willing and able to perform Services (2) and (4) but did perform them in Canada during the relevant period [per *Wenward (Canada) Ltd, supra*].

[24] I am therefore satisfied that the Owner has demonstrated use of the Mark in association with Services (2) and (4) within the meaning of sections 4(2) and 45 of the Act.

Services (1) and (3)

[25] In contrast, the evidence does not allow me to conclude that the Mark was used in the advertising of the remaining services in Canada during the relevant period. I will analyze each of them in reverse order.

[26] With respect to the provision of information on the subject of finance, investment and real estate, Services (3), I note that Mr. Huntley's statement that the YouTube video was "viewed 124 times in the last 8 years" is not supported by the documentary evidence. The second screenshot of the YouTube video [Exhibit WH-12] shows that the video was last viewed on March 13, 2014 with a total of 124 views recorded at that date. The first screenshot reports the same number of views and refers to the last viewing as having happened "eight years ago" ["il y a 8 ans"]. Given that the last viewing date recorded was in 2014, the video could not be viewed "in the last 8 years" as stated on paragraph 10 of Mr. Huntley's affidavit. As such, this piece of evidence does not cover a period which includes the relevant period and it is not of assistance to the Owner. Moreover, I note that Mr. Huntley does not expressly state that the 124 views recorded were from Canadians. Consequently, I am not satisfied that the Owner has sufficiently demonstrated that the Mark was used in the advertising of the provision of information on the subject of finance, investment and real estate through videos over the Internet. As for the remaining means of provision of information, namely movies, pictures, photos, and digital audio recordings, Mr. Huntley provides no evidence of the manner of association between the Mark and any of these means.

[27] With respect to the consulting services in the field of finance, investment and real estate, Services (1), although Mr. Huntley asserts that he “used” the Worksheet [Exhibit WH-5] with Clients, he does not state that he, or his Franchisees, distributed the Worksheet to Canadians during the relevant period. In this respect, it has been established that, to constitute advertising, materials displaying the trademark must be “distributed to” or accessed by prospective customers [*Cornerstone Securities Canada Inc v Canada (Registrar of Trade Marks)* (1994), 58 CPR (3d) 417 (FCTD)]. A similar conclusion applies to the Presentations [Exhibits WH-6 and WH-7]. Further, given the very promotional nature of the Presentations, the Program Details [Exhibits WH-2 to WH-4] and the Informative Documents [Exhibits WH-8 to WH-11], I am unable to conclude from their content that they give advice on the topics specified in Services (1). As for the YouTube video, as noted above, it does not cover a period which includes the relevant period. In any case, even if I were to accept that the Owner advertised the consulting services, there is no evidence before me to show that the Owner was willing and able to perform them in Canada during the relevant period. In this regard, I note that while the Informative Documents invite the Customers to contact Mr. Huntley for more details or to schedule an information session, they do not explain how and where Services (1) were to be provided. I also note that Mr. Huntley does not mention the number of Clients to whom he provided advice in the field of finance, investment and real estate, either directly or through his Franchisees in Canada during the relevant period.

[28] Therefore, I am not satisfied that the Owner has demonstrated use of the Mark in association with Services (1) and (3) within the meaning of the Act. As the Owner furnished no evidence of special circumstances excusing the absence of use of the Mark, these services will be deleted from the registration.

DISPOSITION

[29] Accordingly, 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 all the Goods and the following services:

(1) Consulting services in the field of finance, investment and real estate;

(3) provision of information, namely, videos, movies, pictures, photos, and digital audio recordings on the subject of finance, investment and real estate over the Internet;

[30] The amended statement of services will read as follow:

(2) educational services, namely, instruction in the fields of finance, investment and real estate;

(4) franchising services, namely providing, to franchisees of the applicant, instructions, advice and technical assistance in the establishment and operation of consulting service franchises in the field of finance, investment and real estate

Maria Ledezma
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Requesting Party: Witmart Inc.

For the Registered Owner: MLS Legal Inc.