



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 220

Date of Decision: 2023-12-18

IN THE MATTER OF SECTION 45 PROCEEDINGS

Requesting Party: Gowling WLG (Canada) LLP

Registered Owner: Cornerstone Architecture Incorporated

Registrations: TMA804,115 for CORNERSTONE COLLABORATIVE DESIGN SYSTEM, and
TMA809,737 for CORNERSTONE COLLABORATIVE DESIGN SYSTEM & Design

INTRODUCTION

[1] This is a decision involving summary expungement proceedings under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration Nos. TMA804,115 for CORNERSTONE COLLABORATIVE DESIGN SYSTEM (the Word Mark), and TMA809,737 for CORNERSTONE COLLABORATIVE DESIGN SYSTEM & Design (the Design Mark; collectively, the Marks), owned by Cornerstone Architecture Incorporated (the Owner). The Design Mark is shown below:



[2] For the reasons that follow, I conclude that the registrations ought to be amended.

THE RECORD

[3] At the request of Gowling WLG (Canada) LLP (the Requesting Party), the Registrar of Trademarks issued notices to the Owner under section 45 of the Act on December 1, 2022. The notices required the Owner to show whether the Marks had been used in Canada in association with each of the services specified in the corresponding 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 December 1, 2019, to December 1, 2022.

[4] Each of the Marks is registered for use in association with an identical list of registered services, with the sole exception of a typographical error in the registration for the Design Mark in which the word “analyzing” is misspelled. I am satisfied that this typographical error is not at issue in this proceeding. The registered services consist of the following:

Architectural services; analysis, conceptualization, technical and construction consultation services for buildings namely analyzing customer requirements, conceptual design and technical and feasibility studies for building construction; planning, design, engineering coordination, contract administration and construction services for building construction.

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

(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.

[6] It is well accepted 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 services specified in the registration during the relevant period.

[7] In response to the Registrar's notices, the Owner furnished statutory declarations of Richard Hammond, the sole director of the Owner, declared on February 16, 2023. Only the Requesting Party submitted written representations; no oral hearing was held.

EVIDENCE

[8] The two statutory declarations filed by Mr. Hammond contain largely the same material, with differences as noted below.

[9] In the statutory declaration filed in support of the Word Mark, Mr. Hammond explains that the Owner is an architectural services firm providing services including those set out in the registration. He states that the Word Mark "has been routinely used by [the Owner] in the performance and advertising of the services associated with the [Word] Mark in the three-year period preceding the Notice in Canada for business related purposes". As Exhibit A, he attaches "an example of one such use of the [Word] Mark". Exhibit A is a document which Mr. Hammond describes as "an excerpt of one page from a proposal booklet routinely provided to clients of [the Owner] at the inception of an engagement". The document displays the Word Mark and appears to describe the various phases of the Owner's provision of its services.

[10] As Exhibit B, he attaches a document displaying the Design Mark (which includes the Word Mark) and including an acrostic, which Mr. Hammond describes as a "process handout used by [the Owner] in interacting with clients and potential clients to analyze and conceptualize the building that the clients may require [the Owner] to design for them". He adds that the document is part of the Owner's "service and

planning process to analyze needs and conceptualize concepts with a view to designing buildings to meet those needs for a specific project”.

[11] As Exhibit C and D, he attaches screenshots of web search results conducted on February 14, 2023, on Google and Microsoft Bing for “CORNERSTONE COLLABORATIVE DESIGN SYSTEM”. The search results for each include a “website operated and maintained by [the Owner]”, the contents of which are not shown, and a YouTube video which is discussed below.

[12] In the statutory declaration filed in support of the Design Mark, Mr. Hammond provides largely the same substantial information regarding the Owner. The proposal booklet excerpt attached as Exhibit A to the declaration supporting the Word Mark is not attached to this declaration; instead, the “process handout” containing the acrostic is attached as Exhibit A. As Exhibit B, he attaches a screen shot of a video “prepared and used by [the Owner] in social media marketing campaigns, namely on YouTube and other internet based services, for the purpose of advertisement and customer acquisition”. The Design Mark appears in the screenshot; I note that the video is dated November 26, 2013. As Exhibit C to this statutory declaration, Mr. Hammond attaches the same Google search results showing the video and website as were attached as Exhibit C to the declaration filed in support of the Word Mark.

ANALYSIS

[13] The Requesting Party submits that the Owner’s evidence does not establish that the Marks were used in association with any of the registered services in Canada during the relevant period. In general, the Requesting Party submits that there is no information as to the nature of the Owner’s business, including its services, its clients, and where it does business. The Requesting Party notes that the Owner’s evidence does not contain evidence of a single sale, or any evidence showing that the Owner’s services were offered to Canadians or performed during the relevant period, in association with the Marks or otherwise.

[14] With respect to the video screenshot attached as Exhibit B to the Design Mark declaration and the search results attached to both declarations, I agree with the Requesting Party that these materials are of no assistance to the Owner as they appear to be dated outside the relevant period and do not show use of the Marks in association with any particular registered services.

[15] With respect to the proposal booklet excerpt attached to the Word Mark declaration and the process handout attached to both declarations, the Requesting Party submits that these materials are undated and there is no statement as to when, if at all, they were used during the relevant period, other than Mr. Hammond's "bald statement" that the Marks were used in the three-year period preceding the relevant period. I note, however, that statements in a statutory declaration are to be accepted at face value in a section 45 proceeding. In this respect, I note that Mr. Hammond states that the Marks had been used in Canada in the three-year period preceding the section 45 notice [para 4 of the Word Mark and Design Mark declarations], and describes the proposal booklet excerpt as "an example of one such use" in the Word Mark declaration [para 5]. The process handout is described in the same manner in the Design Mark declaration [para 5]; in the Word Mark declaration, it is described as "a second example" of the Owner's use of the [Word] Mark [para 8]. Bearing in mind that evidence must be considered as a whole, and dissection of an affidavit in an overly technical manner is inconsistent with the purpose of section 45 proceedings, I am prepared to infer that both the proposal booklet excerpt and the process handout are meant to be examples of materials distributed in Canada during the relevant period. For greater clarity, I would be prepared to make this inference on the basis of the language of the Word Mark declaration, considered on its own, or the Design Mark declaration, considered on its own.

[16] The Requesting Party submits that the Owner has not shown that any use of its Marks was in the normal course of trade. However, while use in the normal course of trade is an element of section 4(1) of the Act in relation to goods, section 4(2) of the Act does not incorporate the requirement that use with respect to services be "in the normal course of trade" *per se*. As long as some members of the public receive a benefit from

the activity, it is a service [*Renaud Cointreau & Co v Cordon Bleu International Ltd* (2000), 11 CPR (4th) 95 (FCTD), aff'd 2002 FCA 11; *Live! Holdings LLC v Oyen Wiggs Green & Mutala LLP*, 2019 FC 1042, aff'd 2020 FCA 120].

[17] The Requesting Party further submits that it is unclear which of the services are being advertised in the proposal booklet excerpt, suggesting that in view of “Project Management” being part of the document’s title, the document, at best, shows use only in association with “project management” services, which are not among the registered services. Similarly, the Requesting Party submits that it is unclear which of the registered services are being performed or advertised through the process handout, and suggests that it too would show use of the Marks in association with “project management” services instead of any of the registered services.

[18] With respect to the process handout, which displays both Marks as noted above, it must be considered in conjunction with Mr. Hammond’s statements in his declarations, which indicate that the process handout is “used by [the Owner] in interacting with clients and potential clients to analyze and conceptualize the building that the clients may require [the Owner] to design for them”, and is “part of [the Owner’s] service and planning process to analyze needs and conceptualize concepts with a view to designing buildings to meet those needs for a specific project” [para 9 of the Word Mark declaration; para 6 of the Design Mark declaration]. It is well established that a declarant’s statements are to be taken at face value in a section 45 proceeding, and it is not for the Registrar to speculate about the nature of registered goods or services. In this case, I understand these statements from Mr. Hammond as confirming that the process handout was provided to clients in the course of the Owner providing its services of analyzing, conceptualizing, and designing buildings for clients. In other words, the document is not meant to be solely an example of the Owner advertising its services, but an example of how the Marks are used in the course of the Owner providing its services in Canada during the relevant period.

[19] With respect to the Requesting Party’s submission that Mr. Hammond does not provide any documentation showing “a single sale” of the Owner’s services, I note that

the absence of invoices is not fatal in a section 45 proceeding [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)], particularly in the context of section 4(2) where use of a trademark may be shown in advertising, provided an owner is offering and prepared to perform its services. In this case, Mr. Hammond has described the services provided by the Owner, attached an example of a document displaying the Marks which was distributed to the clients in the course of performance of those services, and confirmed that this document was used in this manner in Canada during the relevant period.

[20] In view of Mr. Hammond's description of the services with which the process handout was used in Canada during the relevant period, I am satisfied that the Marks were used in association with "analysis, conceptualization, technical and construction consultation services for buildings namely analyzing customer requirements, conceptual design [...] for building construction", as well as "planning, design, [...] and construction services for building construction", within the meaning of the Act. I am also satisfied that the described services would amount to "Architectural services" generally, bearing in mind 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].

[21] In reaching this conclusion, I note that the purpose of section 45 is to remove "deadwood" from the register. The evidence in a section 45 proceeding need not be perfect; a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184]. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant* at para 9]. Bearing in mind that drawing an inference is a matter of reasonably probable, logical deductions from the evidence [*Sim & McBurney v En Vogue Sculptured Nail Systems Inc*, 2021 FC 172 at para 15], I am satisfied that the Owner has demonstrated use of the above-noted registered services within the meaning of sections 4(2) and 45 of the Act.

[22] I note that other than a general recitation of the registered services at the beginning of the declaration, Mr. Hammond makes no specific mention of “technical and feasibility studies” or of “engineering coordination, contract administration”. While the proposal booklet excerpt attached to the Word Mark declaration includes some language which might correlate with some of these services, this exhibit does not, on its own, establish that the Owner provided or was able to provide any such services in association with the Word Mark or otherwise during the relevant period. As there is no evidence of special circumstances which would excuse non-use of the Marks in association with these services, the registration will be amended accordingly.

DISPOSITION

[23] In view of all of the foregoing, 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 “technical and feasibility studies” and “engineering coordination, contract administration”.

[24] The amended registration will be as follows:

Architectural services; analysis, conceptualization, technical and construction consultation services for buildings namely analyzing customer requirements, conceptual design for building construction; planning, design, and construction services for building construction.

G.M. Melchin
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: Gowling WLG (Canada) LLP

For the Registered Owner: No agent appointed