



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 40

Date of Decision: 2024-03-06

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Baker & McKenzie LLP

Registered Owner: Canadian National Railway Company

Registration: TMA102,252 for C.N.

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. TMA102,252 for the trademark C.N. (the Mark).

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

(1) Transportation of persons and goods by railway, ship, aircraft, trucks, buses, automobiles.

(2) Transmission of messages by wire and wireless.

(3) Hotel services.

(4) Transfer of valuables and monies.

(5) Sale of express money orders.

(Services (1), (2), (3), (4) and (5). Collectively, the Services)

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

PROCEEDING

[4] At the request of Baker & McKenzie LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on February 20, 2023, to Canadian National Railway Company (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 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 February 20, 2020 to February 20, 2023.

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

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 Doug MacDonald, the Owner’s Executive Vice-President and Chief Marketing Officer, executed on May 11, 2023, together with Exhibits DM-1 to DM-21.

[9] Only the Owner submitted written representations. Although both parties requested to be heard, only the Owner was represented at a hearing.

PRELIMINARY COMMENTS: THE TRADEMARK IN EVIDENCE

[10] I note that while the Mark is registered as a word mark, a stylized version (the CN Design) of the Mark appears in the affidavit and exhibits. I reproduce below the CN Design in different colours as it repeatedly appears throughout the evidence:



[11] In considering whether the display of a trademark constitutes display of the trademark as registered, the question to be asked is whether the trademark was displayed in such a way that it did not lose its identity and remained recognizable, in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see whether the dominant features of the registered trademark have been preserved [*Promafil Canada Ltée v Munsingwear Inc.* (1992), 44 CPR (3d) 59 (FCA); *Pizzaiolo Restaurants Inc v Les Restaurants La Pizzaiolle Inc*, 2016 FCA 265]. This is a question of fact to be determined on a case-by-case basis.

[12] In the present case, comparing the registered word mark with the CN Design reproduced above, I find that the Mark did not lose its identity and remains recognizable. In my view, the omission of the periods between the letters C and N does not change the identity of the Mark. In my view the dominant feature of the Mark are the letters C and N. As these letters remain and can be read within the CN Design, I find that the dominant feature of the Mark is preserved [for similar conclusions see *Coastal Trademark Services v American Automobile Association*, 2010 TMOB 137 at para 19; and *Lomic Law and B.B. Dakota, Inc.*, 2022 TMOB 266 at para 25]. Furthermore, in my view, the differences between the registered word mark and the CN Design are so unimportant that an unaware customer or potential customer would be likely to infer that both, in spite of their differences, identify services having the same origin [per *Honeywell, supra*].

[13] In view of the above, I consider the CN Design to constitute display of the Mark as registered for the purpose of this proceeding.

EVIDENCE AND ANALYSIS

[14] Although I have reviewed all of the evidence, this summary focuses on the portions which are relevant to my findings.

[15] In his affidavit, Mr. MacDonald states that he joined the Owner in 1989 and held diverse roles in Marketing, Sales, Information Technology and Operations prior to becoming the Owner's Executive Vice-President and Chief Marketing Officer in 2022 [paras 1 to 4].

[16] Mr. MacDonald describes the Owner as the largest Canadian transportation and logistics company servicing, among others, car manufacturers, petroleum and mining companies, as well as distributors and retailers. In particular, he states that the Owner's core business is to provide transportation of goods by railway, ships and trucks, and to provide the related logistics services [paras 5 to 7].

[17] As part of the transportation and logistics services, the Owner operates its private telecommunication network in Canada. Mr. MacDonald states that this telecommunication network includes various technologies relying on the transmission of data, messages or pictures through different means, including the Owner's fiber optic network, installed along its rail network, and other telecommunications equipment. He also states that the telecommunication network enables the Owner to provide customer and technical support services, as well as online information services by means of a digital platform (the Platform). For example, the Platform's tools enable customers to submit shipping instructions to the Owner and to schedule shipment reports confirmations to be send directly to them by email. According to Mr. MacDonald, these tools are either connected to the Owner's fiber optic network or comprised of telecommunications equipment, thus allowing the transmission of messages by wire and wireless [paras 21 to 24].

[18] With respect to the use of the Mark, Mr. MacDonald generally states that it has been associated with the Owner's transportation and logistics services from as early as 1940. In particular, he asserts that the Mark has been continuously used in the performance of the Owner's "transportation of goods by railway, ships, and trucks and with [the Owner's] transmission of messages by wire and wireless" during the relevant period [para 12, and 14 to 46].

[19] In support to his statement of use of the Mark in association with Services (1), Mr. MacDonald attaches as Exhibit DM-5, 24-page excerpts of the "Our Services" webpage located on the Owner's website *www.cn.ca* (the Website), which he states were printed during the relevant period [para 14]. The Mark is displayed on the top of each excerpt. The first page shows four tabs, among which the "Rail", "Trucking" and "Marine" tabs. The following pages show these tabs' content. The first page of the Rail tab refers to the Owner's 20,000 mile transcontinental railway network, which spans from Canada to Mid-America connecting three coasts, the Atlantic, the Pacific and the Gulf of Mexico. On the first page of the Trucking tab, I read: "[The Owner] pairs the efficiency of rail with the added flexibility of trucking to better serve our local and regional customers". Under the "Maps and Network" heading, a map shows a total of nine ports, from coast to coast, across Canada. On the first page of the Marine Tab, I read:

[The Owner's] marine services extend beyond where trucks and track stop, offering our customers marine shipping in regions like the Great Lakes and Newfoundland and Labrador.

[20] In support to his statement of use of the Mark in association with Services (2), Mr. MacDonald attaches, as Exhibit DM-14, a copy of an internal PowerPoint document entitled "Information & Technology" (the Document). He asserts that the information contained in this Document is representative of the Owner's telecommunication network during the relevant period [para 21]. The Document refers to 7,000 miles of fiber optic cable network, to "476 wireless devices (Wi-fi)" and to 1,200 radio base stations available to ensure the Owner's operations and services. Mr. MacDonald also attaches, as Exhibit DM-15, several representative screen captures of the Platform that is

accessible through the Website. The Mark is displayed on the top of each screen capture. The second screen capture shows several options under the “Recent Tools” tab, among which “My Shipments”, “My Reports” and “My Rail Service”.

[21] Lastly, Mr. MacDonald provides yearly revenues earned by The Owner and its affiliated companies from 2020 to 2022, which is reproduced below. He asserts that these revenues are attributable to Services (1) and (2), and that more than 60% of them are attributable to the Owner’s operations in Canada [para 47].

	2020	2021	2022
TOTAL REVENUES (in millions)	13,819	14,477	17,107
TRANSPORTATION (RAILWAY, TRUCKS AND SHIPS) AND TRANSMISSION OF MESSAGE BY WIRE AND WIRELESS REVENUES (in millions)	13,218	13,888	16,569

[22] In a section 45 proceeding, the burden of proof is on the registered owner of the trademark to demonstrate “use” in order to maintain the registration of the mark. It is clear from the jurisprudence that this burden is not a stringent one. The owner must only establish a *prima facie* case of use within the meaning of section 4 of the Act [*Brouillette Kosie Prince v Orange Cove-Sanger Citrus Association*, 2007 FC 1229 at para 7].

[23] In the present case, the Website excerpts [Exhibit DM-5] displaying the Mark, show how the Owner advertised its ability to transport a whole host of products, through trains, trucks and ships, from overseas to end consumers located in remote regions of Canada. They therefore demonstrate that the Owner used the Mark in the advertising of transportation of goods by railway, ship and trucks, as specified in Services (1), to Canadians during the relevant period.

[24] As for Services (2), from a fair reading of the Document, I find it reasonable to conclude that the wireless devices and the radio base stations referred thereto are part of the Owner’s telecommunications equipment. I therefore conclude that the

transmission of messages by wireless was made through these devices and stations. In addition, the Document specifies that the Owner's fiber optic network is a cable network. In view of the foregoing, and given that the Platform's tools, which display the Mark, were either connected to the Owner's fiber optic network or comprised of its telecommunications equipment, I conclude that these tools were available by wire and wireless. Given that the tools were available on the Platform during the relevant period, I can conclude that the Owner was able to transmit and receive messages by wire and wireless to and from its Canadian customers during such period.

[25] Further, the Owner's Canadian revenues, earned from 2020 to 2022, show that the Owner performed the transportation of goods by railway, ship and trucks, specified in Services (1), and the Services (2) in Canada during the relevant period.

[26] In view of all the above, I am satisfied that the Owner has demonstrated use of the Mark in association with transportation of goods by railway, ship and trucks of Services (1), and with Services (2) within the meaning of sections 4(2) and 45 of the Act.

[27] As for the remaining services (1), the Owner conceded at the hearing, that it does not claim use of the Mark in association with transportation of persons. The Owner does claim use in association with transportation of goods by aircraft, buses and automobiles either. Further, the evidence does not allow me to infer the use of the Mark in association with transportation of persons and with transportation of goods by aircraft, buses and automobiles. As the Owner has not provided any evidence of special circumstances excusing the non-use of the Mark with respect to these services, the registration will be amended to delete "persons" and "aircraft, buses, automobiles" from the registration.

[28] As for Services (3), (4) and (5), the Owner does not claim use of the Mark in association with them, and such use cannot be otherwise inferred from the evidence. As the Owner has not provided evidence of special circumstances either, the registration will be amended to delete "hotel services", "transfer of valuables and monies" and "sale of express money orders" 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 the following services:

- (3) Hotel services.
- (4) Transfer of valuables and monies.
- (5) Sale of express money orders.

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

- (1) Transportation of goods by railway, ship, trucks.
- (2) Transmission of messages by wire and wireless.

Maria Ledezma
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2024-02-14

APPEARANCES

For the Requesting Party: No one appearing

For the Registered Owner: Jean-Sebastien Dupont

AGENTS OF RECORD

For the Requesting Party: Baker & McKenzie LLP

For the Registered Owner: Smart & Biggar LP