



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 23

Date of Decision: 2025-02-03

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Yates IP

Registered Owner: True Glow Inc.

Registration: TMA1063025 for LUMIX

INTRODUCTION

[1] At the request of Yates IP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act), on June 27, 2023, to True Glow Inc. (the Owner), the registered owner of registration No. TMA1063025 for the trademark LUMIX.

[2] The Mark is registered for use in association with the following goods and services (grouped by their assigned Nice Class):

Goods:

- 11 Accent lights for indoor use; aquarium led underwater lights; light diffusers; lighting fixtures. (the Goods)

Services:

- 35 Online advertising for others via a computer communications network; online sales of lighting supplies and fixtures. (the Services)

[3] The notice required the Owner to show whether the Mark was used in Canada in association with each of the Goods and Services at any time within the three-year period immediately preceding the date of the notice and, if not, the date when the Mark was last so used and the reasons for the absence of use since that date. In this case, the relevant period for showing use is June 27, 2020 to June 27, 2023.

[4] The relevant definitions of “use” are set out in sections 4(1) and 4(2) 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.

[5] In the case of services, the display of a trademark in advertising suffices to meet the requirements of section 4(2) of the Act, as long as the owner is able and prepared to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[6] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in section 45 proceedings is quite 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 Canada*

(*Registrar of Trade Marks*) (1982), 63 CPR (2d) 56 (FCTD)], 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 goods and services specified in the registration during the relevant period [*John Labatt Ltd v Rainer Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[7] Where a registered owner does not show use of the trademark, the registration is liable to be expunged or amended pursuant to section 45(3) of the Act, unless the absence of use was due to special circumstances that excuse it.

[8] In response to the Registrar's notice, the Owner furnished the affidavit of its president and sole shareholder, David Michaels, affirmed on March 27, 2024.

[9] Neither party filed written representations or requested an oral hearing.

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

THE OWNER'S EVIDENCE

[11] In his affidavit, Mr. Michaels states that he has been the president of the Owner, which is a Canadian corporation, since about 2008, and is its sole shareholder. He further states that he used the Mark under licence from the Owner on a website he built at *lumix.ca*, which provided "[o]nline advertising for others via a computer communications network", during the relevant period.

[12] Mr. Michaels notes that one of the ways in which such advertising is generally performed is through the use of "Javascript code embedded on websites that enable third party advertisers to programmatically insert

image and text ads". He states that, in this case, the website at *lumix.ca* provided online advertising for others "by displaying programmatically generated third-party ads" using "Google AdSense code". He specifies that "Google generated the ads using a snippet of JavaScript code embedded in the LUMIX Website" and adds that the advertisements "often re-targeted products and services based on the viewer's web page browsing history" or were "ads that Google felt were relevant to the viewers based on the text on the website".

[13] In support of his assertions, Mr. Michaels attaches two exhibits to his affidavit:

- Exhibit A is a screen capture from the Wayback Machine tool at *archive.org*, showing an archived webpage from *lumix.ca* saved during the relevant period. The Mark is displayed at the top of the archived webpage. The body of the webpage lists the Goods under the heading "Lumix lighting Products", followed by the notation "Coming soon" and then an empty space. Mr. Michaels attests that this empty space is where "third party ads were programmatically inserted into a 300x250px Google AdSense box ad". The bottom of the webpage displays the notation "© LUMIX" and provides the designer, David Michaels', Toronto telephone number.
- Exhibit B contains two screen captures showing the source code of the *archive.org* webpage (with embedded *lumix.ca* webpage) that is attached as Exhibit A. Mr. Michaels attests that this code includes "the Google AdSense code for the 300x250px ad spot below the list of lighting products that third parties used to programmatically insert their ads onto the LUMIX Website during the relevant period". Two passages of code are highlighted. The first is the code "enable_page_level_ads: true" below a reference to "adsbygoogle";

however, it appears to be amid code for the *archive.org* website and its Wayback Machine toolbar. The second is the word “adsbygoogle” in the passage “<ins class=“adsbygoogle” style=“display:inline-block;width:300px;height:250px” data-ad-client=“ca-pub-03...” data-ad-slot=“35...”>” (my ellipses), below the coding for the list of products.

[14] I note that the affidavit has only two headings: “Background Information” and “Online advertising for others via a computer communications network Via Ads”. Furthermore, although Mr. Michaels mentions that the subject registration includes both goods and services, and he then lists the two Services, he does not actually assert use of the Mark in association with any of the Goods or with the Service “online sales of lighting supplies and fixtures”. He also does not specify whether any of the “Lumix lighting Products” characterized on the exhibited webpage as “Coming soon” became available for sale or were sold during the relevant period.

ANALYSIS

[15] Mr. Michaels asserts use of the Mark only in association with the Service “online advertising for others via a computer communications network”. Moreover, by furnishing an affidavit whose headings are restricted to “Background Information” and “Online advertising for others via a computer communications network Via Ads”, the Owner appears to concede that the Mark was not used in Canada during the relevant period in association with the Goods or with the other Service, “online sales of lighting supplies and fixtures”.

[16] Indeed, there is no evidence of sales or transfers of either the Goods or any other lighting supplies or fixtures. While the exhibited webpage appears to advertise the Goods, advertising alone is insufficient to establish

use of a trademark in accordance with section 4(1) of the Act. Furthermore, as noted above, display of a trademark in advertising for services will only suffice to meet the requirements of section 4(2) of the Act if the registered owner is able and prepared to perform the services in Canada. In the present case, the “Lumix lighting Products” were advertised only as “Coming soon”, and there is no indication that any of them, or any other lighting supplies or fixtures, became available for the Owner to sell online during the relevant period. I therefore consider the evidence insufficient to demonstrate use of the Mark in association with the Goods or with the Service “online sales of lighting supplies and fixtures”.

[17] With respect to the remaining Service, “online advertising for others via a computer communications network”, Mr. Michaels asserts use of the Mark during the relevant period on the website he built at *lumix.ca*. Since he states that he used the Mark on this website under licence from the Owner, and that he was the president of the Owner at the time, I am satisfied that the character and quality of the services he provided on the website in association with the Mark were under the Owner’s control. Any such licensed use of the Mark would thus inure to the Owner’s benefit under section 50 of the Act [see *Petro-Canada v 2946661 Canada Inc* (1998), 83 CPR (3d) 129 (FCTD), and *Lindy v Canada (Registrar of Trade Marks)*, [1999] FCJ No 682 (FCA), re: inferring the requisite control when the same person is in charge and control of both licensor and licensee].

[18] However, I am not satisfied that the evidence is sufficient to establish actual performance or advertising of this remaining Service in Canada during the relevant period.

[19] Exhibit A to Mr. Michaels’ affidavit shows the Mark’s display during the relevant period on a webpage intended to present third-party advertisements. Although the exhibited screen capture does not show an

actual advertisement, I am prepared to accept Mr. Michaels' explanation that the source code he built into the webpage, as shown at Exhibit B, generated such advertisements on the live version of the webpage when it was viewed. However, there is no evidence that the webpage was viewed from Canada—during the relevant period or otherwise—and thus no evidence that a third-party advertisement was ever actually presented in Canada. Nor is there any evidence that the space on the webpage was purchased by an advertiser from Canada or for advertisements targeting Canada.

[20] The webpage itself has at least some connection to Canada, given its .ca address and provision of a Toronto telephone number. However, in the absence of further details, I find that these particulars merely support an inference that the webpage had the potential to attract Canadian advertisers and consumers. The evidence does not go so far as to demonstrate that the service was actively being offered in Canada or that it was actually performed in Canada, by way of a visitor to the webpage triggering the generation of an advertisement, or otherwise.

[21] I am prepared to take at face value Mr. Michaels' statement that advertisements *were* generated during the relevant period; however, he provides no information on the location of the third parties whose advertisements were displayed or on the locations targeted by the advertisements. Given that the exhibited webpage appears to be for a lighting products business that is not yet active but merely "Coming soon", I am not prepared to infer that the page would necessarily have received any level of traffic that might be presumed to include at least some visitors from Canada during the relevant period. There is thus no basis for an inference that any advertisements were shown to the consuming public in Canada during the relevant period. Nor is there even any basis for an inference that the webpage as a whole was shown to Mr. Michaels' own prospective clients

in Canada during the relevant period, as a form of advertisement for the availability of his online advertising service.

[22] In this last respect, I note that, to constitute advertising, materials 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); and see e.g. *Shift Law v Jefferies Group, Inc*, 2014 TMOB 277; *Investment Planning Counsel Inc v Equitable Life Insurance Company of Canada*, 2015 TMOB 74; and *Ridout & Maybee LLP v Residential Income Fund LP*, 2015 TMOB 185; re: materials posted online]. A clear statement in this regard may suffice as evidence of “distribution” or, in the alternative, some evidence from which it can reasonably be inferred that the trademark owner’s customers or prospective customers accessed the materials in question. However, the mere existence of archived webpages is not sufficient to establish that such webpages were accessed by Canadians during the relevant period.

[23] Furthermore, Mr. Michaels does not specify how the third-party advertisers whose advertisements were generated during the relevant period were able to “programmatically insert” those advertisements. For example, there is no indication of whether the ability to have their advertisements generated on the webpage was purchased from Google or from Mr. Michaels and, in either case, whether this ability was advertised to the third parties using the Mark. Mr. Michaels provides no information whatsoever regarding his customer base for the advertising Service.

[24] As recently confirmed by the Federal Court, determining whether there has been use of a trademark in Canada in association with services is a largely fact-driven, case-by-case exercise involving an analysis of the scope of the services referred to in the trademark registration as well as the nature of the benefits delivered to people physically present in Canada [see *2K4 Inc*

(Indican Pictures) v Indiecan Entertainment Inc, 2025 FC 20 at para 50 (*Indican*), citing both *Miller Thomson LLP v Hilton Worldwide Holding LLP*, 2020 FCA 134 at paras 85, 107-117 (*Hilton FCA*), and *Hilton Worldwide Holding LLP v Miller Thomson*, 2018 FC 895 at para 51 (*Hilton FC*)]. Furthermore, the Federal Court has held that an additional element of trademark use in association with services is “the type of relationship between the owner of the trademark and the customer” [*Hilton FC* at para 99; *Indican* at para 64]. Use will not be established if the “business activity” occurring in Canada is not that of the owner—either through its direct contact with customers or through intermediary agents acting on its behalf [*Hilton FC* at paras 98-99; see also *Indican* at para 64]. In this respect, there must “at a minimum, be a sufficient degree of interactivity between trademark owner and Canadian consumer to amount to use of a mark in Canada in conjunction with services over the Internet” [*Hilton FCA* at para 147; *Indican* at para 65].

[25] In the present case, if the Owner had furnished evidence that the LUMIX webpage’s advertising space was purchased by advertisers located in Canada or targeting Canada, I might, depending on the evidenced circumstances, have been prepared to accept that a material benefit was received in Canada amounting to performance of the advertising Service. However, in this respect, Mr. Michaels merely states that advertisements were programmatically generated by *Google*, using *Google* “Adsense” code, often based on the viewer’s browsing history (which could presumably be tracked by *Google*) or on what *Google* felt would be relevant. I find that, at best, this evidence suggests a collaboration with *Google* to provide the advertising service for third parties. However, Mr. Michaels does not specify the nature of his relationship with *Google* or explain how third parties were able to use its “Adsense” code. He thus leaves unclear (i) whether his interactions with *Google* concerning the advertising service took place in

Canada and (ii) whether Google was his customer; was acting on his behalf as his agent; or was playing some other role as part of its own, independent business.

[26] In the absence of any information on how advertisers interact with either Google or Mr. Michaels to “programmatically insert” advertisements that will be “programmatically generated” by Google, any conclusions as to the nature of any benefit third-party advertisers might have received in Canada from the LUMIX advertising service during the relevant period would be speculative.

[27] In *Hilton FCA*, the Federal Court of Appeal discussed what types of evidence may help establish use of a trademark in Canada in association with services on a website. The examples it gave include the following: data on the number of visits to the website from Canada; Canadian sales figures or data on the number of Canadians having availed themselves of the services; evidence showing that the website’s content is stored on servers in Canada; evidence showing that the website is directed to consumers in Canada (such as pricing in Canadian dollars); evidence that advertising for the services targets consumers in Canada; and, in some cases, possibly evidence of compliance with industry- or sector-specific Canadian legislation [at paras 148-151]. Although *Hilton FCA* concerned a foreign trademark owner, I find that the considerations apply equally to a Canadian trademark owner (or licensee) whose website may be accessible internationally and whose business need not necessarily be conducted in Canada.

[28] In the present case, if the Owner had provided evidence of visits to the LUMIX website from Canada, purchases of the website’s ad spot by advertisers in or targeting Canada, purchases of an ad spot (on the website) that is stored on a server in Canada, or distribution of Canadian advertising

promoting the website's ad spot, during the relevant period, my conclusion might perhaps have been different.

[29] In sum, I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the registered goods or services within the meaning of sections 4 and 45 of the Act. Furthermore, there is no evidence before me of special circumstances excusing the absence of such use.

DISPOSITION

[30] 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 expunged.

Oksana Osadchuk
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

No hearing held

AGENTS OF RECORD

For the Requesting Party: Theo Yates

For the Registered Owner: No agent appointed