Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 188

Date of Decision: 2025-09-18

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Smart & Biggar LP

Registered Owner: Pervinder Chawla

Registration: TMA803,156 for WORKLINX

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 no. TMA803,156 for the trademark WORKLINX (the Mark). The Mark, owned by Pervinder Chawla (the Owner), is registered in association with the following goods and services (the Goods and Services):

Goods

(1) Computer software, namely, on-line hosted software for use in human resources, time and attendance, scheduling, payroll, benefits administration and workforce management.

Services

(1) the services of hosting, supporting and maintaining said computer software.

[2] For the reasons set out below, I conclude the registration ought to be expunged.

PROCEEDINGS

[3] At the request of Smart & Biggar LP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on September 17, 2024 to the Owner in respect of the registration for the Mark.

[4] The notice required the Owner to show whether the Mark was used in Canada 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 September 17, 2021 to September 17, 2024 (the Relevant Period).

[5] The relevant definitions of "use" for a trademark in association with goods and services 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.
>
> (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 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 a registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448 at para 68] and "evidentiary overkill" is not required [see *Union Electric Supply Co v Canada (Registrar of Trade*

Marks) 1982 CanLII 5195 (FC) at para 3]. That said, 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 CanLII 2739, 53 CPR (2d) 62 (FCA)], and 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 Rainier Brewing Co*, 1984 CanLII 5833, 80 CPR (2d) 228 (FCA)].

[7] Where an owner has not shown "use", a 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 filed the affidavit of Pervinder Chawla (the Chawla Affidavit), sworn December 16, 2024.

[9] Both parties filed written representations and attended an oral hearing.

EVIDENCE

[10] Ms. Chawla, Owner of the registration for the Mark, provides, *inter alia*, the following statements, information, and exhibits in her affidavit:

- At all material times, including during the Relevant Period, Ms. Chawla granted a license and permission to use the Mark for the Goods and Services to Worklinks Inc. (the "Licensee") [para 3].
- Ms. Chawla is a shareholder and Director of the Licensee and states she has exercised direct control over the character and quality of the Goods and Services sold in Canada by the Licensee [para 3].

- The Mark has been used in Canada by the Licensee in the normal course of trade in association with the Goods and Services during the Relevant Period. The normal course of trade comprises the distribution and sale of the Goods and Services via direct online sales in Canada [para 6].
- The Licensee has used the Mark during the Relevant Period in association with the Goods and Services by means of marking the Mark on their website, on the software sign in screen, on the top banner within the software user interface, and on invoices for the software delivered to the Licensee's customers [para 7].
- Exhibit B of the Chawla Affidavit is an invoice from the Licensee dated June 21, 2023 which Ms. Chawla states evidences the sale of the Goods and Services in Canada [para 8].
- Exhibit C of the Chawla Affidavit is a screen capture of the sign in page for the Opponent's software showing the Mark as it is displayed to users [para 9].

PRELIMINARY MATTER -DESIGNATION OF GOODS AND SERVICES

[11] In its written representations and at the oral hearing, the Owner argued that the commercial reality of the software business has evolved over the nearly 20 years since the application for the Mark was filed and that the categorization and treatment of software goods and services has also changed in that time. More specifically, the Owner submits that while the Owner's "on-line hosted software" is listed in the registration for the Mark as a good, it would be more commonly considered as a service under modern trademark practices [Owner's written representations, para 34]. The Owner went on to submit that if the Board found the Owner's evidence of use of the Mark with the Goods to be insufficient because it was not sufficiently clear that the Mark was associated with the Goods at the time of transfer, the Board could still find use of the Mark under section 4(2) of the Act, basically

finding use of the Goods as services based on "an appropriately flexible interpretation" of the Owner's "Computer software, namely, on-line hosted software for use in human resources, time and attendance, scheduling, payroll, benefits administration and workforce management" [Owner's written representations, para 36].

[12] At the oral hearing, the Requesting Party argued that the validity of a registration is not at issue in section 45 proceedings and that the only "tool" the Registrar has in such proceedings is to delete goods and services, or expunge an entire registration.

[13] While it is possible to amend the statements of goods and services in a registration under section 41 of the Act, I agree with the Requesting Party that it is not something that can be entertained in the context of section 45 proceedings. The sole issue in section 45 proceedings is whether a challenged registered trademark had been used in the three year period immediately preceding the issuance of the section 45 notice and, if not, whether exceptional circumstances excusing the lack of use of the trademark is evidenced. The outcomes of such proceedings are limited to maintaining a challenged registration, in whole or in part, or expunging the challenged registration.

[14] Accordingly, the analysis below will assess whether the evidence supports maintaining the Goods and Services as they are contained in the registration for the Mark and not whether the specific items listed in the statements of goods and services are properly categorized.

ANALYSIS

Has the Owner Demonstrated Use of the Mark in Canada During the Relevant Period in association with the Goods?

[15] As noted above, the definition of "use" with goods requires a trademark to be associated with the goods at the time the goods are transferred to the consumer.

[16] The Chawla Affidavit does not contain any statement regarding whether the Mark is displayed at the time of transfer of the Goods, nor can this be inferred from the evidence of record. In fact, the screenshot provided as Exhibit C appears to be only for persons who have already purchased the Goods and/or Services given that it is a sign-in page that does not include any option to create a new account. Likewise, Exhibit D is described by Ms. Chawla as "a screen capture of the main page of the software as it is displayed to users". Presumably "users" are those who have already purchased the Goods and/or Services.

[17] The unique challenges of providing notice of association of a trademark with software goods has been recognised by the Federal Court [see *BMB Compuscience Canada Ltd v Bramalea Ltd* (1988), 22 CPR (3d) 561 (FCTD) where it was noted that institutional computer software is not a physical object, and thus a computer software company experiences unique difficulties when attempting to associate its trademark with its software]. Nonetheless, in similar cases involving software as goods, use of a trademark has been found where the evidence demonstrates the trademark was presented to purchasers prior to installation of the software, such as on license agreements and training manuals, and also appearing on the software interface during installation and/or when used after installation, creating a continuous notice of association of the software with the trademark prior to and after purchase [see, for example, *Fasken Martineau*

DuMoulin LLP v Open Solutions DTS, Inc, 2013 TMOB 68 at para 10, *Clark Wilson LLP v Genesistems, Inc*, 2014 TMOB 64 at para 10, and *iboss, Inc. v Waystream AB*, 2020 TMOB 81 at para 24].

[18] In the present case, there is no evidence that purchasers had been presented with any documents bearing the Mark or otherwise exposed to the Markin association with the Goods prior to purchase. Accordingly, no notice of continuous association is present in this case that would support the conclusion that the Mark had been used in association with the Goods during the Relevant Period.

[19] There is also no indication in the Chawla Affidavit that the invoice attached as Exhibit B was associated with the Goods at the time of transfer.

[20] Accordingly, I find that the Owner has failed to demonstrate use of the Mark with the Goods and has filed no evidence of special circumstances that would excuse the lack of use of the Mark with the Goods during the Relevant Period.

Has the Owner Demonstrated Use of the Mark in Canada During the Relevant Period in association with the Services?

[21] The Chawla Affidavit contains assertions of use of the Mark with the Services (collectively with the Goods) [see paras 6 and 7], but little additional evidence to support these assertions. The single invoice provided in the Chawla Affidavit refers only to the purchase of an "On Premise Software Licence" [para 8, Exhibit B]. While Ms Chawla asserts that this invoice evidences "the sale of the Registered Goods and Services to a customer in Canada", no further details were provided to support that this single sale covered any of the Services contained in the registration for the Mark.

[22] In its written representations, the Owner points to the fact that the statement of services in the registration for the Mark indicate that the Services relate specifically to "said computer software", being the software contained in the statement of Goods, and that the software is described as "on-line hosted software" [para 23]. I note that this submission by the Owner merely reiterates the statements of Goods and Services as they appear in the registration for the Mark.

[23] The Owner further submits that "[i]t is an inevitable common sense conclusion" that any sale of the Owner's "on-line hosted software" must necessarily be accompanied by the services of hosting, supporting and maintaining said software [Owner's written representations, para 28]. The Owner also argues that the Federal Court and the Federal Court of Appeal have repeatedly held that the concept of "services" is to be liberally interpreted [Owner's written representations, para 35].

[24] The Requesting Party submits that the Chawla Affidavit does not include any evidence showing that the software of the type described in the registration for the Mark was "hosted, supported and maintained" for any party in Canada. The Requesting Party further submits that screenshots that fail to clearly identify the registered services are not adequate proof of use, relying on the following quote from *Planmeca Oy v Eastman Kodak Company*, 2019 TMOB 128 at paras 23-28:

> [T]he first exhibited screenshot advertises a computer server in association with the Mark, but does not refer to any of the registered services. The second and third screenshots do not refer to the Owner or to any of the registered services, and the Mark only appears in conjunction with the search function on the webpage. As such, I cannot conclude that the Owner has put forward any evidence showing use of the Mark in association with advertisement of any of the registered services.

[25] The Requesting Party also notes that the Chawla Affidavit contains "bald assertions" of use with both the Goods and Services (always

collectively) and submits that these bald assertions are insufficient to meet the Owner's burden, particularly when there is no evidence of a single sale [Requesting Party written representations, paras 17 and 18].

[26] I agree with the Requesting Party that the Owner's evidence fails to demonstrate use of the Mark with the Services in Canada during the Relevant Period. While it is not necessary for the Owner to establish that a sale of the Services occurred during the Relevant Period, I do note that the single invoice included as Exhibit B of the Chawla Affidavit refers only to the sale on an "On premise Software License" with no specific mention of any services. While the screenshots included as Exhibits C and D do depict the Mark in a stylized form, neither of these screenshots appear to relate to the services of hosting, support or maintenance of computer software – they are merely screenshots of a computer program interface, one being a user login page and the other appears to be an interface for tracking employee absences.

[27] In order to successfully establish use of a trademark with services (or goods), an owner must *show* use of the trademark [*Star-Kist Foods Inc v Canada (Registrar of Trademarks)* (1988), 20 CPR (3d) 46 (FCA)]. While the Chawla Affidavit contains broad statements attesting to use of the Mark with the Services in Canada during the Relevant Period, it fails to actually show use of the Mark in association with the Services.

[28] I find that the Owner has failed to demonstrate use of the Mark with the Services and has filed no evidence of special circumstances that would excuse the lack of use of the Mark with the Services in Canada during the Relevant Period.

DISPOSITION

[29] 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.

Leigh Walters
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2025-09-08

APPEARANCES

For the Requesting Party: Reagan Seidler

For the Registered Owner: Jaime Holroyd

AGENTS OF RECORD

For the Requesting Party: Smart & Biggar LP

For the Registered Owner: Siskinds LLP