



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2016 TMOB 64
Date of Decision: 2016-04-22

IN THE MATTER OF A SECTION 45 PROCEEDING

Davis LLP

Requesting Party

and

819805 Alberta Ltd.

Registered Owner

TMA574,704 for BIBLIOTECA

Registration

[1] At the request of Davis LLP (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on May 14, 2014 to 819805 Alberta Ltd. (the Owner), the registered owner of registration No. TMA574,704 for the trade-mark BIBLIOTECA (the Mark).

[2] The Mark is registered for use in association with the goods, “Computer software, namely a computer database containing information for use in the field of building design and construction”.

[3] The Mark is also registered for use in association with the services, “Providing database management services, namely preparing and updating industry directories”.

[4] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been 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 between May 14, 2011 and May 14, 2014.

[5] The relevant definitions of “use” in association with goods and services are set out in sections 4(1) and 4(2) of the Act as follows:

4(1) A trade-mark 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 trade-mark 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 and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270].

[7] With respect to services, the display of a trade-mark on advertising is sufficient to meet the requirements of section 4(2) when the trade-mark owner is offering and prepared to perform those services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Donna Devloo, President of the Owner, sworn on August 13, 2014 in Edmonton, Alberta. Both parties filed written representations; an oral hearing was not requested.

The Owner’s Evidence

[9] In her brief affidavit, Ms. Devloo attests that the Owner provides library management software and database management services to various clients. She states that, in 1999, the Owner incorporated in Alberta under the trade name “Biblioteca Technical Library Consulting” and that subsequently, in 2001, Biblioteca Inc. was incorporated.

[10] Ms. Devloo explains that Biblioteca Inc. “licenses the BIBLIOTECA library management software to its Clients, and provides a copy of such software to be loaded on Clients’ computers”. She attests that clients paid an annual subscription fee and licensing fee to use the BIBLIOTECA library management software and library consulting services.

[11] In support, Ms. Devloo provides the following exhibits attached to her affidavit:

- Exhibit A is a list of clients that Ms. Devloo identifies as the Owner’s clients, such as Santec Consulting and the City of Edmonton.
- Exhibit C consists of four printouts that Ms. Devloo attests are screenshots of the logon screen(s) of the BIBLIOTECA library management software. In the first two screenshots, the Mark appears in the title bar of the application. The first screenshot also prominently displays the text “Government of Alberta Infrastructure”. The second screenshot appears to be a database search form entitled “Archives Search”. The third and fourth screenshots are entitled “Dialog Archives”, and I note that the fourth screenshot prominently displays the Mark as well.
- Exhibit D consists of a screenshot printout from *bibliotecainc.com* that Ms. Devloo attests is of the library management software’s homepage. The Mark is displayed at various locations on the webpage.
- Exhibit E consists of a printout of a screenshot from *archive.org* which Ms. Devloo attests shows how the “Products & Services” page appeared during the relevant period on *bibliotecainc.com*. The webpage describes available services, such as “Customized Technical Libraries, Library Management System (LMS)” and “Technical Library Consulting”. The Mark is prominently displayed multiple times on the webpage.
- Exhibit F consists of five invoices, two from the Owner and three from Biblioteca Inc., addressed to clients in Canada, such as the aforementioned Santec Consulting and the City of Edmonton. The invoices are all dated within the relevant period. Ms. Devloo attests that the invoices show the Mark used in association with “the annual subscription fee and licensing fee for the BIBLIOTECA library management software and library

consulting services”. The Mark appears on some of the invoices alongside line items such as “Library Services” and “Licensing Fee for the Web Version of Biblioteca LMS”.

Analysis – Licensing

[12] In its written representations, the Requesting Party submits that the Owner’s evidence is “silent” as to the relationship between the Owner and Biblioteca Inc. Furthermore, the Requesting Party submits that the Owner’s evidence does not explain whether the software that Biblioteca Inc. licenses to clients originates from the Owner or Biblioteca Inc. Finally, the Requesting Party submits that there is no evidence that allows for an inference of a relationship between the Owner and Biblioteca Inc. As such, it argues that any use of the Mark by Biblioteca Inc. does not enure to the benefit of the Owner in accordance with section 50 of the Act.

[13] In response, the Owner submits the following:

- Ms. Devloo is the Owner’s sole shareholder and director as well as the sole shareholder and director of Biblioteca Inc.
- Ms. Devloo clearly attests to her familiarity with “all aspects” of marketing, sale and distribution of the products and services bearing the Mark.
- The Owner is not required to show the terms of a license agreement or to show particulars regarding control over the character and quality of the goods under a registration.
- There is an implied license to use the Mark by Biblioteca Inc.

[14] First, I acknowledge that, indeed, Ms. Devloo does not explicitly state the relationship between the Owner and Biblioteca Inc. in her affidavit; the assertion by the Owner in its written representations that Ms. Devloo is the sole shareholder and director of both companies is not in evidence.

[15] However, contrary to the Requesting Party’s submission, I find that there is sufficient evidence in this case to infer the nature of the relationship between the Owner and Biblioteca

Inc. In this respect, I note that, in a section 45 proceeding, the evidence as a whole must be considered, and that focusing on individual pieces of evidence in isolation is not the correct approach [see *Kvas Miller Everitt v Compute (Bridgend) Ltd*, (2005) 47 CPR (4th) 409 (TMOB)].

[16] Additionally, the Federal Court has cautioned against letting technical requirements become “a trap for the unwary” where a trade-mark has been obviously in use by its rightful owner [per *Baume & Mercer SA v Brown* (1985), 4 CPR (3d) 96 (FCTD)]. Although that case dealt with technical aspects of affidavits, in view of the evidentiary threshold in a section 45 proceeding [per *Uvex, supra*], I consider the general principle apt in this case [see also *Riches Mckenzie & Herbert LLP v Chaussures M & M Inc/M & M Footwear Inc*, 2013 TMOB 222, 117 CPR (4th) 234)].

[17] Noting that each case must be determined on its own facts [per *Kraft Ltd v Registrar of Trade-marks* (1987), 1 CPR (3d) 457 (FCTD)], in my view, the lack of explicit detail in Ms. Devloo’s affidavit regarding the relationship between the Owner and Biblioteca is not fatal in this case.

[18] Applying the aforementioned jurisprudence, in my view, this is not a case where Biblioteca Inc. was a licensee of the Owner *per se*. Rather, the evidence is sufficient to support the conclusion that Biblioteca acted as an agent of the Owner in offering the registered goods and services to the Owner’s clients. In this respect, it is well established that the concept of the “normal course of trade” recognizes a continuity of actions that commence with the trade-mark owner through intervening transactions by agents or distributors to the ultimate consumer [per *Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD)]. As such, evidence of a trade-mark owner’s goods bearing the trade-mark distributed and sold through another entity can be sufficient to satisfy the requirements of section 4 of the Act.

[19] Here, I note that Ms. Devloo refers to “the Clients” interchangeably as the Owner’s and Biblioteca Inc.’s. For example, at paragraph 6 of her affidavit, she states that “The Company provides library management software and supporting services to ... the Clients” (where reference to the “Company” is to the Owner). Another such example is where she refers to screenshots of “clients of the Company” at paragraph 11 of her affidavit. Further, at Exhibit A to

her affidavit, Ms. Devloo identifies particular clients as the Owner's clients; Exhibit F includes invoices from Biblioteca Inc. to these same clients. As such, and in view of the evidence as a whole, I am prepared to infer that Biblioteca Inc. acted as an agent of the Owner in the licensing and distribution of the subject software.

[20] In view of the foregoing, evidence of a licensing agreement between the Owner and its agent is neither necessary nor applicable [for a similar finding, see also *Gowling Lafleur Henderson LLP v San Miguel Corporation*, 2015 TMOB 213, CarswellNat 7481].

Analysis – Services

[21] With respect to the registered services, the Mark is clearly displayed on the website, *bibliotecainc.com*, in association with a search function. As attested to by Ms. Devloo, this search function allows clients to search for “products, publications, and companies all through one page” that is consistent with the registered database management services. Furthermore, the invoices at Exhibit F of Ms. Devloo's affidavit refer to “library services” and the like. While the evidence is not overwhelming, based on these invoices and Ms. Devloo's statements, I accept that at least some clients in Canada accessed and used the registered database management services during the relevant period.

[22] As such, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered services within the meaning of section 4(2) and 45 of the Act.

Analysis – Goods

[23] With respect to the registered “computer database” goods, the Requesting Party submits that the Owner has not demonstrated use of the Mark in association with such goods during the relevant period. In this respect, the Requesting Party asserts that the Owner has only shown use in association with “web-based hosted software solutions” as a service and not “software products” as a tangible good. In support, the Requesting Party notes that the Exhibit F invoices refer to licenses providing *access* to “online hosted software”. As such, the Requesting Party submits that “to the extent that these invoices show any use of the Mark, therefore, it is in association with services and not wares.”

[24] In response, the Owner submits that it “offers both non-downloadable and downloadable computer software that is either accessed from the Internet or the computer software is loaded directly onto [the Owner’s] clientele computer.” The Owner submits that two of the exhibited invoices, numbered 45 and 47, “clearly show a licensing fee for a non-downloadable version of the computer software”. I note that the invoice 45 is for “Licensing Fee for web based Biblioteca Library Management System” and the invoice 47 is for “Licensing Fee for Web Version of Biblioteca LMS”.

[25] As discussed in *BMB Compuscience Canada Ltd v Bramalea Ltd* (1988), 22 CPR (3d) 561 (FCTD), this type of business software is not a physical object, and thus a computer software company experiences unique difficulties when attempting to associate a trade-mark with its software [see also *Fasken Martineau DuMoulin LLP v Open Solutions DTS Inc*, 2013 TMOB 68, CarswellNat 1684; and *Clark Wilson LLP v Genesistems, Inc*, 2014 TMOB 64, CarswellNat 1392].

[26] Furthermore, as recently discussed by the Federal Court in *Specialty Software Inc v Bewatec Kommunikationstechnik GMBH*, 2016 FC 223, CarswellNat 579 [under appeal, Court File No. A-92-16], data or software available only through an Internet browser can meet the requirement of showing a transfer in accordance with section 4(1) of the Act, despite no software actually being installed *per se* on a customer’s computer.

[27] In this case, the good is a “computer database containing information”, access to which necessitates transfer of some digital data to a client’s computer through the Internet. As shown in the exhibited screenshots, in addition to the database information, this includes an interface to access the data. Although the product may be described as “online hosted software” and the database as a whole may not necessarily be transferred to clients via a physical medium, in my view, this is not required to demonstrate use in accordance with section 4(1) of the Act.

[28] Certainly, components of the Owner’s database product are transferred to the client’s computer, such as the logon screen and the “Archives Search” interface. In order for a client to use the logon and search screens to access the database, at a minimum, the digital data that comprises these screens must be transferred in some manner to the client’s computer.

[29] Noting that each case must be determined on its own facts [per *Kraft, supra*], the license to use this database software is akin to the leasing of goods. The leasing of goods has been recognized as a transfer of goods in the normal course of trade [see *LightSurf Technologies Inc v Lifetouch Inc* (2005), 48 CPR (4th) 75 (TMOB) at paragraph 10].

[30] While Ms. Devloo could have provided further details in her affidavit, given the nature of the subject database software, it cannot be said that there was no transfer of “the property in” or “possession of” the registered database goods during the relevant period. In my view, at a minimum, any client access of the database would have resulted in *some* transfer in “possession of” the registered goods in accordance with section 4(1) of the Act. Furthermore, the Mark appears at various locations of the logon and search screens of the database, as well as on some of the exhibited invoices.

[31] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods within the meaning of sections 4(1) and 45 of the Act.

Disposition

[32] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration will be maintained.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

Fasken Martineau DuMoulin LLP

For the Registered Owner

DLA Piper (Canada) LLP

For the Requesting Party