



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

Citation: 2015 TMOB 192
Date of Decision: 2015-10-28

IN THE MATTER OF A SECTION 45 PROCEEDING

Jensen & Company

Requesting Party

and

**ITPA-Independent Telecommunications
Providers Association**

Registered Owner

TMA603,964 for ALTO

Registration

[1] At the request of Jensen & Company, the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on November 13, 2013 to Ontario Telecommunications Association, the registered owner at that time of registration No. TMA603,964 for the trade-mark ALTO (the Mark).

[2] The Mark is registered in association with “Long distance telephone services”.

[3] Subsequent to the issuance of the notice, the Registrar registered a change in name of the registered owner to ITPA-Independent Telecommunications Providers Association (the Owner). This change of name is not at issue in this proceeding.

[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 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 November 13, 2010 and November 13, 2013.

[5] The definition of “use” with respect to services is set out in section 4(2) of the Act as follows:

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), 2004 FC 448, 31 CPR (4th) 270].

[7] With respect to services, where the trade-mark owner is offering and prepared to perform the services in Canada, use of the trade-mark on advertising of those services meets the requirements of section 4(2) of the Act [*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 Jonathan Holmes, Executive Director of the Owner, sworn May 6, 2014 in Newmarket, Ontario. Only the Owner filed written representations; an oral hearing was not requested.

The Owner’s Evidence

[9] In his affidavit, Mr. Holmes asserts that the Owner licenses the Mark for use in association with long distance telephone services to three companies that operate in Canada: Mornington Communications, Lansdowne Telephone Company and WTC Communications.

[10] With respect to the issue of control, Mr. Holmes attests that the Owner organizes and conducts meetings with its licensees to discuss marketing and advertising strategies for their telecommunications services. Further, he explains that he is personally in contact with the licensees on a monthly basis, and is aware of how the Mark is used by each licensee and the types of long distance telephone plans each licensee offers in association with the Mark. Lastly, Mr. Holmes confirms that the Owner ensures that the licensees perform the long distance

telephone services in accordance with the Owner's standards of quality. In this respect, Mr. Holmes attests that the Owner has the authority to terminate a license should the licensee use the Mark in a manner that is inconsistent with the standards of the Owner.

[11] Mr. Holmes asserts that the Owner's licensees are permitted to use the Mark as a word mark, as part of a logo, or in combination with particular codes or names used to designate long distance telephone plans being offered. Further, he explains that display of the Mark is only permitted in association with the advertisement and performance of long distance telephone services, and licensees are not allowed to use the Mark in association with any other type of telephone service.

[12] In support of his assertion of use of the Mark, attached to Mr. Holmes' affidavit are various photographs and printouts showing how the Mark was displayed by the Owner's licensees during the relevant period. The exhibits show the Mark displayed on store front windows (Exhibit B), service trucks (Exhibit C), websites (Exhibit D), telephone service agreements (Exhibit E), application forms for telephone service plans (Exhibit F), and long distance calling cards (Exhibit G). Mr. Holmes also provides the names of different long distance telephone plans offered by licensees that incorporate the Mark, such as "ALTO 250" or "ALTO 750" (per Exhibit H).

[13] With respect to performance of the registered services, Mr. Holmes provides a sampling of telephone bills issued to customers of Mornington Communications (Exhibit I), Lansdowne Telephone Company (Exhibit J), and WTC Communications (Exhibit K). As asserted by Mr. Holmes, these bills appear to be for the provision of ALTO long distance telephone services during the relevant period in Canada. For example, invoices in Exhibit I display the names of telephone plans "ALTO 250" or "ALTO 750" with their respective charges. The numbers "250" and "750" appear to be descriptive of the particular long distance plan, *i.e.*, the number of minutes available each month. Although customer information is generally redacted from the invoices, I note that many of the invoices still show that they are for telephone numbers with Ontario and Quebec area codes.

Analysis

[14] As described above, the Owner has furnished ample evidence showing the Mark advertised by its licensees in association with the registered services during the relevant period.

[15] Furthermore, the Owner furnished evidence indicating that its licensees were prepared to perform and did, in fact, perform the registered services in Canada during the relevant period. For example, the printouts from one of the licensee's websites (at Exhibit D) includes a number of indicia demonstrating that the services were available to customers in Canada during the relevant period, such as displaying prices, displaying various telephone plans, and providing a toll-free number and email address, all in association with the Mark. In addition, the exhibited invoices demonstrate that the Owner's licensees performed the registered services for customers in Canada during the relevant period and in association with the Mark.

[16] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered services within the meaning of sections 4(2) and 45 of the Act.

Disposition

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

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

Hearing Date: No Hearing Held

Agents of Record

Macera & Jarzyna LLP

For the Registered Owner

Jensen & Company

For the Requesting Party