

SECTION 45 PROCEEDINGS
TRADE-MARK: CAMERON MCKENNA
REGISTRATION NO.: TMA548,503

[1] At the request of Norman M. Cameron Law Corporation (the “requesting party”), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the “Act”) on January 22, 2008 to CMS CAMERON MCKENNA, a partnership, the registered owner at the time of the above-referenced trade-mark registration. On May 19, 2009, the Canadian Intellectual Property Office recorded a change of name of the registered owner of the trade-mark from CMS Cameron McKenna to CMS Cameron McKenna LLP (the “registrant”).

[2] The trade-mark CAMERON MCKENNA is registered for use in association with the following services:

- (1) legal services.
- (2) legal services, and advisory services relating to legal services.

[3] Section 45 of the Act requires the registered owner to show whether the trade-mark has been used in Canada in association with each of the wares and/or 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 any time between January 22, 2005 and January 22, 2008 (the “relevant period”).

[4] “Use” in association with services is set out in subsection 4(2) of the Act:

- 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.

[5] In response to the Registrar’s notice, the registrant furnished the affidavit of Lucy Patricia Kilshaw sworn on July 15, 2008 (the “Affidavit”), together with Exhibit LPK1. Both parties filed written submissions; an oral hearing was not requested.

[6] In her affidavit, Ms. Kilshaw states that she is a solicitor of England and Wales employed by CMS Cameron McKenna LLP, and as such has personal knowledge of the matters set out in the affidavit. In describing the various Canadian clients of the firm, Ms. Kilshaw states that she has relied on business information of the registrant made in the usual and ordinary course of the registrant's business (Affidavit, pars. 1 and 3).

[7] 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 C.P.R. (2d) 62 (F.C.A.)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd. v. Lang Michener* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.) at 480], and evidentiary overkill is not required, sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with the wares/services specified in the registration during the relevant period.

[8] The first issue in this case is whether or not the trade-mark shown to be in use constitutes use of the registered trade-mark within the meaning of section 45 and subsection 4(2) of the Act.

[9] In the affidavit, Ms. Kilshaw describes the manner in which the trade-mark CAMERON MCKENNA has been used over time. Appended to her affidavit as Exhibit LPK1 are examples, which she states accurately demonstrate how the trade-mark has appeared on the registrant's communications and work product provided to Canadian clients and law firms in association with the provision of services to those clients (Affidavit, 8.4). Ms. Kilshaw describes the manner in which the trade-mark appeared as follows:

Up until approximately July 1999, the Registrant used the Trade-Mark alone without any additional design, letters or words. After approximately July 1, 1999, the Registrant caused the Trade-mark to appear together with another trade-mark consisting of the letters CMS. Further, a CMS logo was used ("the CMS Logo") consisting of the letters "cms" in brackets. The CMS initials and the CMS Logo were

used to communicate that the Registrant was participating in an international association of independent law firms, each one of which caused the CMS initials to appear in connection with their main names and trade-marks, and used the CMS Logo. (Affidavit, para. 8.1)

[10] I note that the first three documents in Exhibit LPK1, which consist of a document entitled “Intellectual Property Briefing”, an invoice and a fax cover sheet, all dated in 1998 (before the relevant period), show the trade-mark on a rectangular black and grey box. The CMS initials and logo do not appear on these documents.

[11] A fax cover sheet dated in 1999 shows the trade-mark preceded by the letters CMS. I note that the letters cms (lower case) within stylized brackets are also used independently at the bottom of the page, with the words TRANSNATIONAL LEGAL SERVICES underneath. Below these, a list of “CMS law firms” appears, listing five different law firm names, including Cameron McKenna, all preceded by the letters CMS.

[12] Similarly, on the next three documents in the Exhibit: a publication cover sheet entitled “IP for brand owners” dated November 16, 1999; a publication entitled “UK PATENTS REVIEW 2000” dated Spring 2000; and a publication entitled “Capital letter” dated September 2000, the letters CMS appear, followed by the trade-mark in upper and lower case letters. Again, displayed at the bottom of these pages are the letters cms, within stylized brackets, with the words TRANSNATIONAL LEGAL SERVICES underneath.

[13] Ms. Kilshaw further explains that:

In around 2001 the CMS Logo was replaced by a different logo depicting the letters CMS interspersed with a series of apostrophe-like marks (“the New CMS Logo”), which has been used ever since. The CMS initials and logo have been and are licensed to the Registrant and to all other members of the association of independent law firms by a centralized entity, CMS Legal Services EEIG...(Affidavit, para. 8.2)

[14] All of the remaining documents in the Exhibit, including the ones dated during the relevant period, show the following at the top of the page:

The logo consists of the letters 'C', 'M', and 'S' in a large, bold, serif font, each with a small apostrophe-like mark above it. To the right of these letters, the words 'Cameron McKenna' are written in a smaller, sans-serif font.

[15] I note that the fax cover sheet dated July 2, 2001, also states at the bottom of the page that “CMS Cameron McKenna is a member of CMS, the transnational legal and tax services organisation”. Below this is a list of “CMS offices and associated offices worldwide”.

[16] With respect to the documents that fall within the relevant period, the publication cover sheet entitled “Establishing a company in Russia” dated September 2005, and the letterhead dated October 23, 2007, each displays the letters CMS with apostrophe-like marks followed by the trade-mark in upper and lower case letters as reproduced above. Again, I note that at the bottom of page of the letterhead, it states that “CMS Cameron McKenna LLP is a member of the CMS alliance of independent European law firms”, and lists a number of “CMS offices and associated offices worldwide”.

[17] The trade-mark appears preceded by the New CMS Logo (as reproduced above) in the last document in the Exhibit, entitled Law-Now; the document contains a copyright dated 2008; however, there is no indication that it was distributed within the relevant period (i.e. before January 22, 2008). I note that the document states: “CMS Cameron McKenna LLP and its associated offices are members of CMS, the alliance of independent European law firms. Alliance firms are legal entities which are separate and distinct from CMS Cameron McKenna LLP and its associated international offices.” It also lists various “CMS offices and associated offices worldwide”.

[18] The law is quite clear that a trade-mark should be used in the form in which it is registered. However, the courts have taken the position that the registrant may deviate from the trade-mark as registered without adverse consequences, if the same dominant features are maintained and the differences are so unimportant as not to mislead an

unaware purchaser [*Promafil Canada Ltée v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59 (F.C.A.)]. The question to be asked is whether the mark was used in such a way that the mark 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 [*Registrar of Trade Marks v. Compagnie Internationale pour l'informatique CII Honeywell Bull, Societe Anonyme* (1985), 4 C.P.R. (3d) 523 (F.C.A.)].

[19] The ruling in *Promafil* followed the reasoning of a leading case, *Honey Dew Ltd. v. Rudd* (1928), [1929] Ex. C.R. 83 (Can. Ex. Ct.). In *Honey Dew*, the form in which the trade-mark was used differed from the registration with regard to the arrangement and form of the letters. In holding that the owner of the trade mark was entitled to protection, Maclean P. said (at para. 7):

The practice of departing from the precise form of a trade-mark as registered is objectionable, and is very dangerous to the registrant. The mark as used here is not however substantially different from the mark as registered. Nobody has been deceived, no injury could occur to anybody by the deviation from the form of the registered mark, and I do not think the plaintiff should lose his right to protection because of this.

[20] In *Promafil*, the Federal Court of Appeal reversed a finding of the trial judge in regards to the difference in the use and registration of a penguin design. The trial judge had found sufficient differences in the marks as registered and used to justify the expungement of the mark based on abandonment. MacGuigan J.A. on appeal stated as follows (at pages 71-72):

Obviously, with every variation the owner of the trade mark is playing with fire. In the words of Maclean P., “the practice of departing from the precise form of a trade-mark as registered...is very dangerous to the registrant.” But cautious variations can be made without adverse consequences, if the same dominant features are maintained and the differences are so unimportant as not to mislead an unaware purchaser....The law must take account of economic and technical realities. The law of trade marks does not require the maintaining of absolute identity of marks in order to avoid abandonment, nor does it look to miniscule differences to catch out a registered trade mark owner

acting in good faith and in response to fashion and other trends. It demands only such identity as maintains recognizability and avoids confusion on the part of unaware purchasers.

[21] Similarly, in *John Labatt Ltd. v. Molson Breweries, A Partnership* (1992), 46 C.P.R. (3d) 6 (F.C.T.D.), Mr. Justice Rouleau considered the effect of deviation in use from a trade-mark as registered in section 45 proceedings (at page 12):

The basic principle to be derived is that a registered owner of a trade mark will not lose his rights to the trade mark even if the mark as used deviates from the registered mark when the deviation is such that no person would be deceived or injured by it: *Munsingwear, supra*. The jurisprudence provides that if a registered mark, as used, is not substantially different from the mark as registered, preserving the dominant features, the trade mark registration ought to be maintained: *Munsingwear, Honeywell Bull, supra*.

[22] Having regard to the September 2005 and October 23, 2007 documents, I am satisfied that the trade-mark as it appeared was recognizable as the trade-mark as registered. The entire word mark was used in upper and lower case letters - and the words CAMERON MCKENNA remained the dominant features of the trade-mark.

[23] I find it reasonable to conclude that the consumer would perceive the New CMS Logo as a separate trade-mark within the context highlighted by the design features: the flared apostrophe-like marks separating the letters, and the use of all upper case letters. In my view, such use of the trade-mark is not apt to deceive the public in any way. This is further supported by the fact that CMS is also used separately in the registrant's documents in a paragraph that informs the consumer that CMS is a separate entity - the CMS alliance of independent European law firms.

[24] Furthermore, the use of two different trade-marks together is an acceptable practice [*A. W. Allen Ltd. v. Warner-Lambert Canada Inc.* (1985), 6 C.P.R. (3d) 270 (F.C.T.D.)], where the registered trade-mark stands out from the additional material [*Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (T.M. Bd.)]. In the

present case, I find that that the words CAMERON MCKENNA stand out and would create a separate impression in the minds of the public.

[25] In view of the above, I have concluded that the use shown constitutes use of the trade-mark as registered.

[26] I will now consider whether the trade-mark was used or displayed in the performance or advertising of the registered services within the meaning of subsection 4(2) of the Act.

[27] The requesting party's submissions in this regard can be summarized as follows: because the Registrant did not maintain a physical office in Canada and provided the services from its head office in London, England, it could not offer or perform the services in Canada; and because the Registrant was not registered to practice law in Canada, it is not possible for it to have offered the services in Canada. In addition, the requesting party submitted that because the exhibits attached to the Affidavit do not in and of themselves make any specific reference to Canada, they are irrelevant; and that the Affidavit is deficient because it does not provide copies of invoices billed to Canadian clients for Services supplied during the Relevant Period.

[28] Ms. Kilshaw deposed that the registrant is a major international law firm headquartered in London, England. During the relevant period, the registrant provided legal services and advisory services relating to legal services (the "registrant's services") to clients and law firms (on behalf of their clients) throughout the world, including numerous Canadian clients and Canadian law firms (Affidavit, para. 5). The registrant provided its services from its head office in London and other offices in the United Kingdom and Eastern Europe (Affidavit, para. 6).

[29] With respect to the manner in which the trade-mark was associated with the registrant's services, Ms. Kilshaw explains that the registrant used the trade-mark prominently on communications and work product provided by the registrant to Canadian clients and law firms, including in the letterhead of all communications, on business

cards, brochures, fax cover sheets, marketing materials, legal documents, invoices and reminders (Affidavit, para 8.3). She notes that Exhibit LPK1 provides examples of the kinds of items she described in paragraph 8.3, which accurately demonstrate how the Trade-mark appeared on the registrant's communications with Canadian clients (Affidavit, para 8.4).

[30] In *Porter v. Don the Beachcomber* (1966), 48 C.P.R. 280, the Exchequer Court of Canada explained use of a trade-mark in Canada in association with services as follows (at page 287):

I shall therefore hold that "use in Canada" of a trade mark in respect of services is not established by mere advertising of the trade mark in Canada coupled with performance of the services elsewhere but requires that the services be performed in Canada and that the trade mark be used or displayed in the performance or advertising in Canada of such services.

The mere advertising of a service in Canada is not sufficient to demonstrate use of a trade-mark in association with services within the meaning of s. 4 of the Act; the registrant also needs to show that it was prepared to perform the services in Canada during the relevant period [*Wenward (Canada) Ltd. v. Dynaturf Co.* (1976), 28 C.P.R. (2d) 20 (Reg. T.M.)].

[31] The requesting party's first assertion raises the interesting question of whether the fact that the registrant did not maintain a physical office in Canada precludes it from being held to be offering or performing the services in Canada. I cannot find that the Act or the jurisprudence impose such a burden on the trade-mark owner. The registrant has no obligation to show that it maintains a physical office in Canada. Under section 4(2) of the Act, it is sufficient that use of the mark in the performance or advertising of the services be shown.

[32] The requesting party also claims that because the registrant is not registered to practice law in Canada, it could not have offered or been prepared to offer the services in

Canada. I cannot agree. In my view, the question of whether the registrant is licensed to practice law in Canada is irrelevant to the question of whether or not it provided legal and advisory services to Canadians. I find it reasonable and not unexpected that legal services related to matters in other jurisdictions would be provided to Canadians in Canada. What is pertinent here is not whether the legal services provided by the registrant related to matters of Canadian law, but whether they were provided to clients in Canada. For the reasons set out below, I am satisfied that they were.

[33] The requesting party asserts that it is impossible for the registrant to perform the services in Canada from its office in London, England. In support of this position, the requesting party relies upon *Porter, supra*. In my view, the present case is distinguishable from *Porter* given the differences in the nature of the services at issue. In *Porter*, the services were restaurant services, which are very different from legal and advisory services, in that restaurant services can only be performed on site, at the operator's physical place of business. However, as the registrant notes in his submissions, "legal services and related advisory services by their very nature are delivered and received anywhere, via telephone, facsimile transmission, mail, courier, email and in person". Legal services and advisory services can be easily promoted, made available and performed for someone in Canada by someone abroad, without the client having to leave Canada [See e.g. *Saks & Co. v. Canada (Registrar of Trade Marks)* (1989), 24 C.P.R. (3d) 49 (F.C.T.D.); *Venice Simplon-Orient-Express, Inc. v. Société Nationale des Chemins de Fer Français SNCF* (2000), 9 C.P.R. (4th) 443 (F.C.T.D.)]. Therefore, I am of the view that the fact that the services were provided from the registrant's office in London, England does not preclude a finding of use within the meaning of section 4(2) of the Act.

[34] Ms. Kilshaw's affidavit confirms that there was performance of the services in Canada within the relevant period. She states that the services were provided directly to Canadian clients and to Canadian law firms. Her affidavit describes specific Canadian clients, the specific matters that were the subject of the legal and advisory services

provided by the registrant to these clients, and the fees billed by the registrant to them during the relevant period (Affidavit, pars. 7.1 through 7.7).

[35] Further, the affiant's statements confirm that within the relevant period the trade-mark was used in the performance and advertising of the registrant's services. It is noted that each communication from the registrant to Canadian clients, including opinion letters and other communications providing legal and advisory services, displayed the trade-mark. The trade-mark also appeared on legal documents, which constituted the product of legal and advisory services delivered by the registrant to Canadian clients, and on invoices and reminders sent to them in relation to fees charged on account of these services. Concerning advertising of the registered services, I note that the trade-mark was used on all business cards and marketing materials provided to Canadian clients by the registrant in connection with its services (Affidavit, para. 8.3).

[36] Although the evidence submitted by the registrant is not overwhelming, and in the examples provided only two documents fell within the relevant period, I find that taken as a whole, use of the trade-mark in association with legal services and related advisory services has been demonstrated. In response to the submission that the documents do not demonstrate use in Canada, it must be remembered that exhibits should be read in conjunction with the information provided in the affidavit as a whole, and not as stand-alone documents [*Fraser Milner Casgrain LLP v. Canadian Distribution Channel Inc.* (2009), 2009 CarswellNat 3298 (T.M. Bd.)]. In this case, the link to Canadian clients and the services provided to those clients is established by the sworn statements of the affiant. Moreover, I accept the affiant's explanation that the provision of evidence of communications was hindered by obligations of privilege, confidentiality and privacy.

[37] With respect to the requesting party's submission regarding the lack of invoices in evidence, the case law is clear that there is no one particular kind of evidence that must be provided in response to a section 45 notice [*Lewis Thomson & Sons Ltd. v. Rogers, Bereskin & Parr* (1988) 21 C.P.R. (3d) 483 (F.C.T.D.) at 486]. With respect to services, the registrant need only show that the trade-mark was used or displayed in the

performance or advertising of the services within the relevant period. I am satisfied that use was demonstrated in association with the registrant's services by the affiant's statements and the Exhibit showing use or display of the trade-mark on the registrant's communications with Canadian clients.

[38] In view of the foregoing, I am satisfied that there was use of the trade-mark within the meaning of section 45 and subsection 4(2) of the Act in association with "legal services and advisory services relating to legal services". Accordingly, and pursuant to the authority delegated to me under subsection 63(3) of the Act, registration TMA548,503 for the trade-mark CAMERON MCKENNA will be maintained in compliance with the provisions of Section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

DATED AT GATINEAU, QUEBEC THIS 16th DAY OF DECEMBER 2009.

P. Heidi Sprung

Member

Trade-marks Opposition Board