



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

**Citation: 2016 TMOB 46**  
**Date of Decision: 2016-03-22**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Blake, Cassels & Graydon LLP**

**Requesting Party**

**and**

**Commercial Pro, Inc.**

**Registered Owner**

**TMA721,681 for TELL THEM YOU  
MEAN BUSINESS**

**Registration**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA721,681 for the trade-mark TELL THEM YOU MEAN BUSINESS, owned by Commercial Pro, Inc.

[2] The trade-mark TELL THEM YOU MEAN BUSINESS (the Mark) is registered for use in association with “legal services” (the Services).

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

The Proceeding

[4] On March 7, 2014, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Commercial Pro, Inc. (the Owner). The notice was sent at the request of Blake, Cassels & Graydon LLP (the Requesting Party).

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between March 7, 2011 and March 7, 2014 (the Relevant Period), in association with the Services. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[6] It has been well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for clearing the register of “deadwood”. The criteria for establishing use are not demanding and an overabundance of evidence is not necessary. Nevertheless, sufficient evidence must still be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the registered goods or services specified in the registration [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270]. Any ambiguity in the evidence should be interpreted against the owner as it bears the full burden of proof [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184, 90 CPR (4th) 428 at para 16]. Furthermore, mere statements of use are insufficient to prove use [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA) (*Plough*)].

[7] The definition of use with respect to services is set out in section 4(2) of the Act which provides that 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. The display of the trade-mark in advertising is sufficient to meet the requirements of section 4(2) of the Act 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 filed the affidavit of Edward Olender, dated October 6, 2014, together with Exhibits A-1 through A-5.

[9] Only the Requesting Party filed written representations.

[10] Both parties were represented at the hearing.

## The Owner's Evidence

[11] In his affidavit, Mr. Olender states that he has been the President of the Owner, a United States corporation, since November 8, 2001 [para 1].

[12] Mr. Olender asserts that by virtue of his title, duties and position within the Owner, he is generally aware of its business; he is also familiar, having access to all the relevant documents and information, with the circumstances surrounding the use of the Mark [para 2].

[13] Mr. Olender explains that when he says in his affidavit that the Mark has been used in Canada during the Relevant Period, he means that the Mark “was used or displayed in the performance or advertising of the Services, in Canada” [para 4].

[14] In paragraph 6 of his affidavit, Mr. Olender asserts that the Owner has used the Mark in Canada, during the Relevant Period, in association with the Services through different law firms, sub-licensees of the Owner. He asserts that the Owner licenses the Mark to Market-Masters Legal, A Resonance Company, Inc. (Market-Masters), which in turn licenses the Mark to law firms. Mr. Olender goes on to assert: “Under the licenses prevailing respectively between [the Owner], Market-Masters and the licensees, [the Owner] has controlled the quality of the services in association with which the [Mark] has been used at all times during the Relevant Period.”

[15] In paragraph 7 of his affidavit, Mr. Olender specifically identifies law firms in the United States as being sub-licensees of the Owner that have all used the Mark in association with the Services during the Relevant Period. They are: the Law Offices of Joe Bornstein, in Bangor and Portland, Maine; Goodman Acker in Detroit, Michigan; Marks & Harrison in Richmond, Virginia; Keller & Keller in Indianapolis, Indiana; Hogan and Kiel in Wichita, Kansas; Metzger Wickersham in Harrisburg, Pennsylvania; the Law Offices of Mark E. Salomone in Boston, Massachusetts; and the Law Offices of Mark E. Salomone and Morelli in Hartford, Connecticut (collectively the “American Firms”).

[16] To support his assertions as to the use of the Mark by the American Firms in the promotion and advertisement of their legal services, Mr. Olender describes marketing and business activities of a few American Firms. In summary, Mr. Olender asserts that:

- Goodman Acker, in Detroit, broadcasts television advertising into Canada via its local television stations, and “receives prospects from Canadian consumers”. Exhibit A-1 to the affidavit is “a coverage map illustrating the coverage for Detroit being broadcasted in Ontario” [para 7];
- the Law Offices of Joe Bornstein, in Bangor and Portland, “regularly send mailings to Canada using the [Mark], and have represented Canadian clients during the Relevant Period “[para 7];
- the Mark is used by the Law Offices of Mark E. Salomone, in Boston, in advertisements disseminated on cable systems in Canada via rebroadcast of two Boston television stations. Exhibit A-2 to the affidavit references the television stations identified by Mr. Olender [para 8];
- use of the Mark has taken place through the websites of the sub-licensee law firms. Exhibit A-3 to the affidavit are extracts from the websites of two firms, which were obtained from the Internet Archive database (the Wayback Machine), namely:
  - extracts from the website of Keller & Keller dated from May 27, 2011, August 12, 2012, October 20, 2013, and January 23, 2014; and
  - extracts from the website of Metzger Wickersham dated from May 12, 2013 and February 13, 2014.

Mr. Olender attests that these webpages “were available” to Canadian consumers during the Relevant Period [para 10]; and

- the Law Offices of Mark E. Salomone and Morelli uses the Mark on a publication dated from May 7, 2013 on its Facebook webpage. Exhibit A-4 to the affidavit is the extract of the Facebook webpage. Mr. Olender attests that this page “was accessible” by Canadian consumers during the Relevant Period [para 11].

[17] Mr. Olender asserts that the promotional campaign for the Mark has been the subject of coverage in the media. He files copies of two articles, one published on August 9, 2010 on the website *www.richmondbizsense.com* (first published in July 2008) and the other one published

on January 15, 2014 on the website *blogpennlive.com*, as examples of media coverage [para 14, Exhibit A-5].

[18] I reproduce below paragraphs 9, 12 and 13 of Mr. Olender's affidavit:

9. Although the law firms using the [Mark] under license during the Relevant Period are located in the United States, the Services were, at all time (*sic*), performed or offered and prepared to be performed to Canadian consumers.

[...]

12. Canada is a valuable current marketplace for [the Owner]. [The Owner] has been actively pursuing law firm clients in Canada including clients in Toronto, Ontario and Calgary, Alberta.
13. The law firms of Joe Bornstein, Mark E. Salomone and Morelli, Mark E. Salomone, Keller & Keller and Metzger Wickersham which have, amongst other firms, used the [Mark], offer legal services in the areas of personal injury as well as car, motorcycle or trucks accidents. These law firms could therefore perform said legal services to Canadians who would have had encountered incidents requiring said legal services, in the United States. The law firms of Joe Bornstein and Mark E. Salomone and Morelli have in fact represented clients in Canada, some of whom have contacted them via their advertisements. The Services associated to the [Mark] were available at all times to Canadian consumers during the Relevant Period, without requiring that the Canadian consumers leave Canada.

[19] Mr. Olender concludes his affidavit by affirming that the Owner has not abandoned its Mark in Canada and continues to use it [para 15].

### Analysis

[20] The Requesting Party's representations can be summarized as follows:

- (a) the evidence consists almost entirely of inadmissible hearsay and bald assertions lacking corroborating facts and documentation;
- (b) the evidence fails to demonstrate that the Owner actually exercised any control over the character or quality of the Services in Canada; and
- (c) the evidence fails to show that any of the entities named in the affidavit either actually used the Mark in Canada during the Relevant Period, or performed or were capable of performing the Services in Canada during the Relevant Period.

[21] I have identified three issues arising from the Requesting Party's representations in the present case. They are:

1. Does the affidavit of Mr. Olender consist of hearsay evidence?
2. Does the evidence show use of the Mark that enured to the Owner's benefit?
3. Does the evidence establish use of the Mark pursuant to section 4(2) of the Act during the Relevant Period?

[22] I will consider each of these issues in turn.

1. Does the affidavit of Mr. Olender consist of hearsay evidence?

[23] I note that the Requesting Party made extensive representations in support of its contention that Mr. Olender's evidence concerning the license, the sub-licenses, and the use of the Mark by the American Firms constitutes inadmissible hearsay and must be disregarded.

[24] To effectively reflect and summarize the Requesting Party's representations, I first reproduce the following excerpt of its written representations:

21. Mr. Olender indicates that he is the President of the Registrant and that, by virtue of this position, he is "generally aware of its business" (see paragraph 2). He states that he has "access to all the relevant documents and information, with the circumstances surrounding the use of the Trade-mark". He does not state that he has in fact reviewed any documents or records of the Registrant in preparing his affidavit. More importantly, he does not indicate that he has: (a) any personal knowledge respecting the business or operation of Market-Masters; (b) any personal knowledge respecting the business or operations of any American Firm; (c) access to any documents or records of Market-Masters; or (d) access to any documents or records of any American Firm. Accordingly, it must be concluded that Mr. Olender has no such personal knowledge or access to documents. This is consistent with the fact that he produced no documents from Market-Masters or any American Firm.

[25] Bearing the above in mind, I summarize as follows the Requesting Party's representations as to why Mr. Olender's evidence constitutes inadmissible hearsay and must be disregarded:

- general awareness of the Owner's business is insufficient to establish Mr. Olender's personal knowledge of the license with Market-Masters;

- Mr. Olender appears to have no personal knowledge or experience with Market-Masters or any of the American Firms;
- Mr. Olender provides no explanation or justification for the Owner's failure to obtain affidavits from individuals with personal knowledge of the relevant facts for the American Firms;
- Mr. Olender provides no explanation why corroborating facts or documents could not be furnished to substantiate his assertions as regards to the license, the sub-licenses and the use of the Mark in Canada by all of the American Firms; and
- there is nothing to suggest that Mr. Olender's assertions are either reliable or necessary. Therefore, no exceptions to the rule against hearsay can be applied.

[26] For its part, at the hearing, the Owner argued that Mr. Olender's affidavit meets the criterion of reliability as well as the necessity test for the purposes of section 45 proceedings. [citing *Wishbuds Inc v Sandoz GmbH*, 2013 TMOB 208; and *1459243 Ontario Inc v Eva Gabor International Ltd*, 2011 FC 18, 90 CPR (4th) 277 (*Eva Gabor*)]. In this regard, the Owner submits that:

- as President of the Owner, Mr. Olender is presumed to have personal knowledge about the workings of the Owner;
- the criterion of necessity in section 45 proceedings must be flexibly interpreted; and
- requiring affidavits from employees of all the American Firms, or only of a few, in addition to that of Mr. Olender would unnecessarily subject the Owner to evidentiary overkill. It would not be in keeping with the public interest purpose of section 45 of the Act, nor be consistent with the low threshold to establish use.

[27] Given the nature of Mr. Olender's position, I accept that he would generally have knowledge of the activities of the Owner and consequently of the licensed use of the Mark. Furthermore, the Federal Court in *Eva Gabor* has stated that "a stricter approach to hearsay evidence may be appropriate under s. 57, where adversarial proceedings are intended to determine the rights of parties", but considering the summary nature of section 45 proceedings,

“concerns with respect to the hearsay nature of evidence can go to weight, rather than admissibility” [*Eva Gabor* at paras 12 and 18].

[28] In the end, I disagree with the Requesting Party’s contention that the evidence introduced by Mr. Olender must be entirely disregarded in the present case. However, I will return below to the probative value of the evidence, where appropriate.

2. Does the evidence show use of the Mark that enured to the benefit of the Owner?

[29] As noted above, in paragraph 6 of his affidavit, Mr. Olender asserts: “Under the licenses prevailing respectively between [the Owner], Market-Masters and the licensees, [the Owner] has controlled the quality of the services in association with which the [Mark] has been used at all times during the Relevant Period.” I note in passing that I infer that Mr. Olender’s reference to “licensees” is meant as a reference to the sub-licensee American Firms.

[30] The Requesting Party submits that Mr. Olender tracks the language of section 50 of the Act asserting that the Owner has controlled the quality of the Services in association with which the Mark has been used at all times during the Relevant Period. However, the Requesting Party notes that Mr. Olender does not explain *how* the quality standard is defined, communicated, monitored or controlled. Likewise, the Requesting Party notes that Mr. Olender fails to provide an excerpt from a single sub-license. Thus, citing *Ricard v Molson Canada 2005*, 2007 CanLII 80989, 60 CPR (4th) 338 (TMOB) at 349, the Requesting Party submits that absent corroborating documents or facts, Mr. Olender’s assertions of control by themselves are insufficient to establish the Owner’s control over the character or quality of the Services.

[31] At the hearing, I pointed out to the Requesting Party that *Ricard, supra*, a decision which I rendered on behalf of the Registrar, involves an opposition proceeding, not a section 45 proceeding. In any event, a simple reading of that decision reveals that my finding with respect to the insufficiency of the affiant’s assertions in that case took into account the cross-examination of the affiant. In other words, *Ricard* is distinguishable from the present case.

[32] For its part, the Owner submits that it is well established that filing a copy of a license agreement is not mandatory in a section 45 proceeding; the requirement to establish the control required under section 50(1) of the Act can be established, as it has in the present case, by clearly swearing to the fact that the trade-mark owner exerts the requisite control [citing, among others,



*Mantha & Associés/Associates v Central Transport Inc* (1995), 64 CPR (3d) 354 (FCA); and *Empresa Cubana Del Tabaco Trading v Shapiro Cohen*, 2011 FC 102, 91 CPR (4th) 248, aff'd 2011 FCA 340 (*Empresa Cubana*)].

[33] As stated by the Federal Court in *Empresa Cubana*, at paragraph 84, there are three main methods by which a trade-mark owner can demonstrate the requisite control pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of the license agreement that provides for the requisite control. In the present case, the first method has been satisfied.

[34] Consequently, I conclude that the evidence is sufficient to show that any demonstrated use of the Mark by the American Firms in association with the Services during the Relevant Period was licensed use that enured to the benefit of the Owner pursuant to section 50 of the Act.

3. Does the evidence establish use of the Mark pursuant to section 4(2) of the Act during the Relevant Period?

[35] The Requesting Party's representations with respect to this issue are two-pronged:

- (i) the evidence fails to establish that any of the American Firms have used or displayed the Mark in the performance or advertising of the Services in Canada; and
- (ii) the evidence is insufficient to establish that the American Firms performed or were ready to perform the Services in Canada.

[36] To begin my discussion of this issue, I note my agreement with the Requesting Party's representations that Mr. Olender's assertions that Canada is a valuable marketplace for the Owner and that the latter has been actively pursuing law firms in Canada are not of any assistance to the Owner's case [para 12 of the Olender affidavit]. To the contrary, these assertions point in the direction of a finding that the Services have not been performed or were not offered and available to be performed in Canada.

[37] I continue my discussion of this issue by considering the first prong of the Requesting Party's representations.

(i) *No use of the Mark by any of the American Firms in the performance or advertising of the Services*

[38] Further to the Owner's oral representations, it is my understanding that the Owner does not dispute that its evidence does not establish use or display of the Mark by the American Firms in the *performance* of the Services. As a matter of fact, a simple reading of the affidavit reveals that Mr. Olender only references use of the Mark in the *promotion and advertisement* of the Services by the American Firms. However, the Owner argues that it has provided sufficient evidence to allow me to conclude to the use of the Mark in the *advertising* of the Services in Canada, during the Relevant Period, by the American Firms.

[39] At the hearing, I specifically raised with the Owner some of my concerns with respect to its evidence. As a result, the Owner ultimately acknowledged that it did not provide evidence *showing* the Mark used or displayed in material that would have been mailed to Canada. For example, although referenced in paragraph 7 of the affidavit, the "mailings" sent by the Law Office of Joe Bornstein have not been exhibited. Accordingly, I am unable to conclude that such advertisements displayed the Mark.

[40] Likewise, the Owner acknowledged that it did not provide evidence *showing* the Mark used or displayed in television advertising by Goodman Acker and the Law Offices of Mark E. Salomone [paras 7 and 8 of the Olender affidavit]. Accordingly, I am unable to conclude that such advertisements displayed the Mark. Thus, there is no need for me to make a determination as to the probative value of Exhibits A-1 and A-2, which purport to evidence coverage or dissemination into Canada of alleged television advertising.

[41] With respect to the "media coverage" articles furnished as Exhibit A-5, at the hearing, I mentioned to the Owner that I did not view how this evidence was of assistance to its case. Indeed, setting aside the issue of whether these articles were viewed by Canadian consumers, in my view third-party media coverage does not qualify as advertising. [See, by way of analogy, *Williams Companies Inc v William Tel Ltd* (1999), 4 CPR (4th) 253 (TMOB) where it was held that references to trade-marks in newspaper articles do not qualify as advertising.].

[42] Based on my understanding of its oral representations, the Owner filed Exhibit A-5 to serve as evidence supporting Mr. Olender's assertions with respect to the performance of the

Services by the American Firms during the Relevant Period. In that regard, the Owner pointed out that the article published on the website *www.richmondbizsense.com* refers to the firms Marks & Harrison, Keller & Keller, Hogan and Kiel, and the Law Offices of Mark E. Salomone, whereas the article published on the website *blogpennlive.com* refers to the firm Metzger Wickersham. Still, I do not consider the evidence to be of assistance to the Owner. Even if I infer that each of the American Firms referenced in the articles was in operation on the dates the articles were published, these articles do not reference activities in Canada for any of the identified American Firms. Accordingly, I will not further discuss Exhibit A-5 when considering the second prong of the Requesting Party's representations below.

[43] Thus, I now turn to Exhibits A-3 and A-4, filed as evidence showing the display of the Mark in advertising of the Services in Canada during the Relevant Period.

[44] I begin with Exhibit A-4, described as an extract of the Facebook webpage of the Law Offices of Mark E. Salomone and Morelli [para 11 of the Olender affidavit].

[45] The Requesting Party submits that neither Exhibit A-4 nor Mr. Olender's assertions relating thereto indicate activities that took place during the Relevant Period. In the alternative, the Requesting Party submits that the evidence is of no value because the Owner failed to provide evidence to show that the Facebook webpage was accessed by Canadian consumers during the Relevant Period.

[46] The Owner contends that Mr. Olender's assertions are sufficient to allow the Registrar to accept the Facebook webpage as evidence that the Law Offices of Mark E. Salomone and Morelli used the Mark in advertising of the Services in Canada during the Relevant Period. The Owner stresses that Mr. Olender asserts that the law firm "uses" the Mark "on a publication dated from May 7, 2013" and that the Facebook webpage was accessible by Canadian consumers during the Relevant Period.

[47] Furthermore, the Owner disputes that it was required to provide evidence showing that the Facebook webpage had been accessed by Canadian consumers during the Relevant Period. I do not need to address this debate between the parties to conclude that Exhibit A-4 does not assist the Owner's case.

[48] Indeed, it is not clear whether the “publication” refers to the only feature displayed on the exhibited Facebook webpage, namely the cover photo which displays the Mark. However, there is no date for this photo. Furthermore, there are no postings observable on the exhibited Facebook webpage, much less a posting dated May 7, 2013. Also, while not determinative, the Requesting Party rightly pointed out that the exhibited webpage shows a copyright notice of 2014 (“Facebook © 2014 - Francais (France)”).

[49] In the end, whether or not the Facebook webpage constitutes advertising in Canada, in my view the most that could be inferred from the evidence is that the Facebook webpage existed when it was printed on September 30, 2014, which is subsequent to the Relevant Period.

[50] I now turn to Exhibit A-3, consisting of extracts from the websites of the firms Keller & Keller and Metzger Wickersham, which were obtained from the Wayback Machine [para 10 of the Olender affidavit].

[51] In terms of reliability, the Owner submits that webpages produced by the Wayback Machine have been found to be generally reliable [citing, among others, *ITV Technologies, Inc v WIC Television Ltd*, 2003 FC 1056, 29 CPR (4th) 182 at para 14, aff’d 2005 FCA 96, 38 CPR (4th) 481 (*ITV*)].

[52] While the Requesting Party acknowledges that there are circumstances where evidence from the Wayback Machine is admissible, it submits that in this case the evidence “holds little probative value and also constitutes hearsay”. In that regard, the Requesting Party cites *Bereskin & Parr v Movenpik-Holding* (2008), 69 CPR (4th) 243 (TMOB) where the Registrar, distinguishing the *ITV* case, held that the Wayback Machine evidence was inadmissible because it did not meet the tests of reliability and necessity. It is worth noting that the decision cited by the Requesting Party predates *Eva Gabor*. As I indicated before, in that case the Federal Court held that, considering the summary nature of section 45 proceedings, “concerns with respect to the hearsay nature of evidence can go to weight, rather than admissibility” [*Eva Gabor* at para 18].

[53] In the present case, I accept Exhibit A-3 to be of probative value as evidence showing the display of the Mark on the websites of Keller & Keller and Metzger Wickersham (collectively the Websites) on dates falling within the Relevant Period. Thus, I shall deal with the debate

between the parties with respect to the requirement for evidence showing that Canadian consumers visited the Websites during the Relevant Period.

[54] The Requesting Party contends that because the Owner failed to provide evidence showing that Canadian consumers accessed the Websites during the Relevant Period, the Wayback Machine evidence is insufficient to establish the display of the Mark in the advertising of the Services in Canada [citing *Candrug Health Solutions Inc v Thorkelson*, 2007 FC 411, 60 CPR (4th) 35 at para 21 (*Candrug*); rev'd on other grounds 2008 FCA 100, 64 CPR (4th) 431].

[55] The Owner disputes the Requesting Party's contention. First, it submits that *Candrug* is distinguishable because: (a) that case involves an adversarial cancellation proceeding under section 57 of the Act, not a section 45 proceedings; and (b) the Wayback Machine evidence in *Candrug* was intended to show *substantial* use of third-parties' trade-marks in Canada. Second, the Owner submits that all that it is required to evidence is that the Websites *could* be viewed in Canada during the Relevant Period; Mr. Olender's assertion that these webpages "were available" to Canadian consumers during the Relevant Period provides the required evidence. In that regard, the Owner relies on *HomeAway.com Inc v Hrdlicka*, 2012 FC 1467, 2012 CarswellNat 5339 (*HomeAway*), where the Federal Court stated:

[22] [...] a trade-mark which appears on a computer screen website in Canada regardless where the information may have originated from or be stored, constitutes for *Trade-marks Act* purposes, use and advertising in Canada.

[56] This finding of the Court was addressed in *McMillan LLP v SportsLine.com, Inc*, 2014 TMOB 51, 124 CPR (4th) 226, where the Registrar commented as follows:

[11] [...] In [*HomeAway*], the Court was addressing the issue of whether display of a trade-mark (or other information) via a computer screen located in Canada constitutes display of a trade-mark in Canada, even if the data is stored or originates from a server outside of Canada. The Court reasonably found that it does; however, whether such display constitutes use of that trade-mark by its registered owner, in association with particular services, within any relevant period of time and otherwise within the meaning of sections 4 and 45 of the Act must still be determined based on the particular facts of the case [...]

[57] In the present case, even if I infer that individuals observed the Mark displayed on the Websites on computers in Canada during the Relevant Period, the issue remains whether the

evidence establishes that the American Firms performed the Services in Canada, or offered and were prepared to perform the Services to consumers in Canada, during the Relevant Period.

[58] Accordingly, I conclude my discussion of the issue by considering the second prong of the Requesting's Party's representations.

(ii) *Insufficient evidence that the American Firms performed or were ready to perform the Services in Canada*

[59] The Requesting Party acknowledges that there may be cases where legal services can be made available and performed for consumers in Canada by law firms abroad without requiring that the Canadian consumers leave Canada [see *Norman M. Cameron Law Corporation v CMS Cameron McKenna LLP*, 2009 CanLII 82159 (TMOB) (*Norman M. Cameron*); and *McCarthy Tetrault v Lawyers Without Borders Inc*, 2010 TMOB 169; 87 CPR (4th) 437 (*Lawyers Without Borders*)]. However, I agree with the Requesting Party's contention that this is not such a case.

[60] Indeed, for the reasons that follow, I find that the evidence provided by Mr. Olender concerning the performance or offering of the Services in Canada by the American Firms is of little value, if any, in the present case.

[61] First, I share the Requesting Party's concerns with respect to the reliability of Mr. Olender's mere assertions that the American Firms have performed or offered and were prepared to perform the Services in Canada during the Relevant Period.

[62] Although I accept that, as President of the Owner, Mr. Olender would have general knowledge of the licensed use of the Mark, it is unclear to me how he would have knowledge of the *clients* of the American Firms. It would have been a fairly simple matter for Mr. Olender to explain why he is in a position to assert in paragraph 9 of his affidavit that "Although the law firms using the [Mark] under license during the Relevant Period are located in the United States, the Services were, at all time (*sic*), performed or offered and prepared to be performed to *Canadian* consumers" (emphasis added). In any event, in my view, such assertion is equivalent to a bare assertion of use of the Mark of the type that was held unacceptable in *Plough*.

[63] Furthermore, not only is it trite law that each case must be decided based upon its own merit, but I agree with the Requesting Party that the present case is distinguishable from *Norman M. Cameron* and *Lawyers Without Borders*.

[64] Indeed, while the underlying facts in the present case are similar to those in *Norman M. Cameron*, the evidence in that case far surpasses the evidence in the present case. For one thing, the evidence in *Norman M. Cameron* was provided by an employee of the entity that used the trade-mark. In addition, the evidence provided by the affiant to establish the performance of the legal and advisory services in Canada included descriptions of 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.

[65] Also, based on a fair reading of *Lawyers Without Borders*, it is apparent that the Registrar in that case relied on the website (which was shown to be accessed by Canadians) combined with other evidence including, but not restricted to, a newsletter distributed to subscribers in Canada. It appears that there were passages in the newsletter and on the website which supported an inference that the registrant offered and/or provided legal services in Canada during the relevant period.

[66] While it may have been reasonable for the Registrar to conclude in *Norman M. Cameron* and *Lawyers Without Borders* that a foreign entity had performed legal services in Canada or offered and was prepared to perform such services in Canada, I disagree with the Owner that sufficient facts have been provided in the instant case for me to reach the same conclusion.

[67] In the present case, Mr. Olender does not provide documentation to support his assertions that the American Firms performed the Services in Canada during the Relevant Period.

[68] Furthermore, in my view, Mr. Olender's assertion that the Law Offices of Joe Bornstein, in Bangor and Portland "have represented Canadian clients during the Relevant Period" is ambiguous [para 7 of the Olender affidavit]. Indeed, I find it is unclear whether they have represented "Canadian clients" in Canada as opposed to "Canadian clients" in the United States.

[69] Likewise, absent further details, Mr. Olender's assertion that "the law firms of Joe Bornstein and Mark E. Salomone and Morelli *have in fact* (my emphasis) represented clients in Canada some of whom have contacted them via their advertisements" holds little value, if any

[para 13 of the Olender affidavit]. For one thing, Mr. Olender does not unequivocally state that these firms have represented clients in Canada during the Relevant Period. In addition, without any indication that lawyers of these two firms were licensed to practice law in at least one jurisdiction in Canada, it is unclear how they could have represented clients in Canadian courts. It could be that Mr. Olender meant to say that these firms have represented Canadians facing legal issues in the United States. If so, absent further details, it is unclear how the Services were performed without the clients having to leave Canada.

[70] Also, whether or not the excerpts of the Websites are reliable evidence to support Mr. Olender's assertion that Keller & Keller and Metzger Wickersham offer legal services in the areas of personal injury as well as car, motorcycle or trucks accidents, it is of note that the excerpts of the Website do not show information specific to Canadians or targeted to Canadians. Furthermore, there is an ambiguity in Mr. Olender's assertion that these firms, and the others referenced in paragraph 13 of his affidavit, "*could* therefore perform legal services to Canadians who would have had encountered incidents requiring said legal services, in the United States" (emphasis added). At most, I read such assertion as an admission that the legal services are offered in the United States.

[71] Finally, I do not afford any weight to Mr. Olender's assertion that "The Services associated to the [Mark] were available at all times to Canadian consumers during the Relevant Period, without requiring that the Canadian consumers leave Canada" [para 13 of the Olender affidavit]. In that regard, I agree with the Requesting Party that such assertion amounts to an opinion on an issue to be decided by the Registrar in the present proceeding.

[72] Although registered owners should not be subject to "evidentiary overkill", the evidence furnished must still have probative value and not amount to mere assertions of use. In this case, the Owner may have benefitted from furnishing evidence from a knowledgeable employee of one of the sub-licensee American Firms. Although not strictly necessary in view of my analysis of the alleged hearsay issue above, such evidence may have provided particulars beyond the mere assertions made by Mr. Olender and clarified the ambiguities that I have identified.

[73] In the end, for all of the reasons that I have discussed above, I ultimately agree with the Requesting Party that the affidavit of Mr. Olender is not sufficient for me to conclude that the



Owner's sub-licensees performed or offered and were prepared to perform the Services to consumers in Canada during the Relevant Period.

[74] Accordingly, I am not satisfied that the Owner has demonstrated use of the Mark in Canada in association with "legal services" within the meaning of sections 4(2) and 45 of the Act. Further, the affidavit of Mr. Olender does not put forward evidence of special circumstances to justify the absence of use.

Disposition

[75] Pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, registration No. TMA721,681 will be expunged.

---

Céline Tremblay  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

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

---

**HEARING DATE:** 2016-02-10

**APPEARANCES**

Thomas Gagnon-van Leeuwen

FOR THE REGISTERED OWNER

Anthony Prenol

FOR THE REQUESTING PARTY

**AGENT(S) OF RECORD**

ROBIC

FOR THE REGISTERED OWNER

Blake, Cassels & Graydon LLP

FOR THE REQUESTING PARTY