



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

Citation: 2015 TMOB 147
Date of Decision: 2015-08-28

IN THE MATTER OF A SECTION 45 PROCEEDING

GMAX World Realty Inc.	Requesting Party
and	
RE/MAX, LLC	Registered Owner
TMA717,554 for	Registration
RE/MAX & BALLOON DESIGN	

[1] At the request of GMAX World Realty Inc. (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 November 19, 2013 to RE/MAX, LLC (the Owner), the registered owner of registration No. TMA717,554 for the trade-mark RE/MAX & BALLOON DESIGN (the Mark). The Mark is shown below:



[2] The Mark is registered for use in association with the following services:

(1) Franchising, namely consultation and assistance in business management, organization and promotion; franchising, namely, offering technical assistance in the

establishment and/or operation of real estate brokerage offices; creating and updating advertising material; real estate advertising services; distribution and dissemination of advertising materials.

(2) Advertising via electronic media and specifically the internet; arranging and conducting trade shows in the field of real estate and real estate franchise services; business services, namely, registering, screening, credentialling and organizing third-party vendors, suppliers and contractors on behalf of others; promoting the goods and services of others by providing hypertext links to the web sites of others; promoting public aware of the need for breast cancer screening; providing consumer information in the field of real estate; real estate marketing services, namely, on-line services featuring tours of residential and commercial real estate; referrals in the field of real estate brokerage; real estate networking referral services, namely, promoting the goods and services of others by passing business leads and referrals; subscription to a television channel; real estate auctions.

[3] The notice required the Owner to furnish evidence showing that the Mark was used in Canada, in association with each of the services specified in the registration, at any time between November 19, 2010 and November 19, 2013. 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.

[4] The relevant 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.

[5] 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 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the services specified in the registration during the relevant period.

[6] With respect to services, the display of the trade-mark in 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)]. Furthermore, the evidence as a whole must be considered, and focusing on individual pieces of evidence is not the correct approach [*Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)].

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Elton Ash, sworn on February 18, 2014. Both parties filed written representations and were represented at an oral hearing held on May 22, 2015. The hearing was held jointly with respect to summary cancellation proceedings for three associated registrations, namely REMAX (TMA575,047), RE/MAX (TMA717,562), and REMAX COMMERCIAL & Design (TMA771,851). Separate decisions will be issued with respect to those proceedings.

[8] Two days prior to the hearing, the Owner filed an additional affidavit, sworn by Elton Ash on May 19, 2015. In its covering letter, the Owner noted that it was not asking that such "supplementary evidence" be accepted by the Registrar at that stage of the proceeding, but only that it be considered "in the event that the Registrar has doubts following the submissions of the parties" on the issue of control by the Owner during the relevant period.

[9] As noted by the Requesting Party, however, there is no provision for the filing of reply evidence or requesting leave to file additional evidence in a section 45 proceeding [see *Oyen Wiggs Mutala v Hung Gay Enterprises Ltd*, 2014 TMOB 107 at para 7, 125 CPR (4th) 238; *Riches, McKenzie & Herbert LLP v D'Amour Bicycles & Sport Inc*, 2014 TMOB 146 at para 8, CarswellNat 1739]. As such, the May 2015 affidavit of Elton Ash was not made of record and was not considered in this proceeding.

The Owner's Evidence

[10] In his February 2014 affidavit, Mr. Ash attests that he is an Executive Vice President with the Owner. He attests that he has held that position since 2005 and has been employed by the Owner since 1984.

[11] Mr. Ash attests that the Owner is in the business of franchising real estate agency services, real-estate brokerage services, and providing franchising, consulting, and other services in the real estate field. He further attests that the Owner's services are offered through a network of sub-franchisors, franchisees, and affiliated sales associates, which he refers to as "RE/MAX Affiliates", all of which are "authorized by the Owner under license" to use the Mark. He explains that RE/MAX Affiliates in Canada handled over 900,000 real estate transactions valued at over \$300 billion between 2011 and 2013.

[12] Mr. Ash asserts that, during the relevant period, the Owner "advertised, sold, and offered for sale all of the services" registered in association with the Mark. As discussed below, he describes how the Mark was displayed by the Owner or its RE/MAX Affiliates in association with each of the registered services in Canada during the relevant period.

Preliminary Issues

[13] Before describing the evidence with respect to the particular services, I note that the Requesting Party submitted both in its written representations and at the oral hearing that there were two overarching issues with the Owner's evidence. First, the Requesting Party argued that much of Mr. Ash's evidence is inadmissible hearsay. Second, the Requesting Party argued that the Owner failed to show proper licensing and control over the use of the Mark, and therefore any use of the Mark by RE/MAX Affiliates does not enure to the Owner's benefit.

[14] With respect to the hearsay issue, the Requesting Party submitted that portions of Mr. Ash's affidavit are inadmissible hearsay because he attests to facts that he has no knowledge of and furnishes evidence on behalf of RE/MAX Affiliates. More specifically, the Requesting Party submits that Mr. Ash does not state that he had access to the business records of the RE/MAX Affiliates, nor does he explain how he allegedly came to know of their activities.

[15] I do not accept the Requesting Party's position; rather, I agree with the Owner that the summary nature of cancellation proceedings is such that concerns regarding hearsay should generally only go to the weight given to evidence rather than admissibility [see *Derby Cycle Werke GmbH v Infinité Cycle Works Ltd*, 2013 TMOB 134, 113 CPR (4th) 412; *Eva Gabor International Ltd v 1459243 Ontario Inc*, 2011 FC 18, 90 CPR (4th) 277; and *Wishbuds Inc v*

Sandoz GmbH, 2013 TMOB 208, CarswellNat 4700]. In any event, given Mr. Ash's position with the Owner and the nature of the evidence furnished, I accept that his statements are reliable and that it would be evidentiary overkill to require the Owner to furnish multiple affidavits from its various regional affiliates and franchisees.

[16] With respect to the licensing and control issue, the Requesting Party argues that section 50(1) of the Act must be satisfied in order for use of the Mark by the RE/MAX Affiliates to enure to the Owner's benefit. In this respect, the Requesting Party submits that the requirements of section 50(1) of the Act can be satisfied in three ways: first, by making a sworn statement regarding control [citing *Empresa Cubana del Tabaco v Shapiro Cohen*, 2011 FC 102, 91 CPR (4th) 248]; second, by providing evidence demonstrating control [citing *Mantha & Associés/Associates v Central Transport Inc* (1995), 64 CPR (3d) 354 (FCA)]; or third, by providing a copy of the license itself [citing *Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64, 48 CPR (4th) 223]. The Requesting Party further submits that the Owner has done none of these.

[17] Indeed, in the present case, the Owner has not furnished a licensing agreement and Mr. Ash does not explicitly use the term "control" in his affidavit. However, he does make the following statement at paragraph 8 of his affidavit:

The Owner provides its wares and services throughout Canada through the RE/MAX Affiliates who are authorized by the Owner under license to use its registered and common law trade-marks in connection with real estate brokerage services and related wares and services.

[18] The Requesting Party took issue with this language, arguing that "authorized by the Owner under license" is not a sufficient statement of control pursuant to section 50(1) of the Act. It argued that a *clear* statement of control is required and that, in the past, the Registrar has drawn a distinction between control over the character and quality of the goods or services versus control over the use of a trade-mark – which on its own may not satisfy section 50(1) [citing *Asima Realty Ltd v Cofely Services SA*, 2013 TMOB 69, 113 CPR (4th) 174].

[19] In response, the Owner argued that it is overly technical to require the use of the word "control" when describing a licensing arrangement. In other words, the Owner submitted that

Mr. Ash's statement above was, indeed, sufficient to constitute a sworn statement of "control", notwithstanding the lack of the actual word "control". Alternatively, the Owner argued at the oral hearing that, if necessary, control over the character and quality of the services can be inferred in this case from Mr. Ash's statements and the fact that the services were being provided in the context of a franchise system.

[20] Again, it is well-established that trade-mark owners are not required to evidence license agreements in a section 45 proceeding, and instead a clear statement of control can be sufficient to meet any requirements of section 50 of the Act [see *Gowling, Strathy & Henderson v Samsonite Corp* (1996), 66 CPR (3d) 560 (TMOB)]. I further note that 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 [see *Baume & Mercier SA v Brown* (1985), 4 CPR (3d) 96 (FCTD) at para 8]. Although that case dealt primarily with technical aspects of affidavits, requiring narrowly particular phrasing to satisfy section 50 of the Act in the context of a summary cancellation proceeding would seem to be contrary to the general principle.

[21] In any event, whether the aforementioned statement is on its own an adequate statement of control is moot in this case. Here, the evidenced franchisor/franchisee relationship between the Owner and its RE/MAX Affiliates is *prima facie* evidence of control given the broad control that is typical in franchising relationships. Accordingly, I accept that the evidence as a whole demonstrates that the Owner exercised the requisite level of control over the character and quality of the RE/MAX Affiliates' services offered in association with the Mark pursuant to section 50 of the Act.

[22] As such, in view of all of the foregoing, I am satisfied that that any use of the Mark described below is by the Owner or enures to the Owner's benefit.

Analysis – Use of the Mark in Association with the Services

[23] With respect to whether the Owner otherwise demonstrated use of the Mark in association with the particular registered services, the Requesting Party made representations only with respect to the services "subscription to a television channel". Before discussing those

services, I will address the other registered services, for which the evidence of use of the Mark is clear.

Franchising Services

[24] Mr. Ash attests that the Owner provides franchising services to its RE/MAX Affiliates and trainees, including through the distribution of training materials and guides. He attests that the Owner provides franchising services by offering a training and education program called “RE/MAX University” to its RE/MAX Affiliates via computers, mobile devices, and streaming video on television. He explains that the RE/MAX University programming can be accessed through a television by using a “Roku” digital media player.

[25] Mr. Ash further attests that the Owner conducted conferences, seminars, trade shows, and courses as another way of providing franchising and consulting services to its RE/MAX Affiliates. For example, he attests that, in August 2013, the Owner’s annual Broker Owner Conference was held in Ottawa. Mr. Ash also attests that the Owner promoted its franchising services through its various websites, and by providing promotional materials to real estate agents and prospective RE/MAX Affiliates.

[26] In support, Mr. Ash attaches the following exhibits to his affidavit:

- Exhibit B includes representative samples of training materials and resource guides which Mr. Ash attests were provided to prospective RE/MAX Affiliates during the relevant period. Also included in Exhibit B are copies of advertisements which Mr. Ash attests were used to attract prospective RE/MAX Affiliates. The Mark is displayed throughout the materials, including above descriptions of the franchising services offered by the Owner.
- Exhibit C is a series of screenshots from the websites *www.joinremax.ca*, *www.remaxcareer.ca*, and *www.remax.ca*, which Mr. Ash attests are representative of those used to promote the Owner’s franchising services during the relevant period. For example, one webpage describes “Franchise Opportunities” and lists eleven benefits of

becoming a RE/MAX Affiliate. The Mark is displayed on each webpage above a description of the franchising services offered by the Owner.

- Exhibit D consists of “representative samples of various advertising materials and agendas related to conferences and trade-shows held throughout Canada hosted by the Owner and its Affiliates”. Materials are included from various conferences held in Canada, including one held in Calgary and the annual conference held in Ottawa. The Mark is displayed throughout the conference materials.
- Exhibit E consists of samples of promotional materials such as brochures, which Mr. Ash attests were distributed in Canada to real estate agents and prospective RE/MAX Affiliates during the relevant period. The Mark is displayed repeatedly next to descriptions of the franchising services offered by the Owner. For example, a page entitled “Find your niche” displays the Mark and explains how the Owner helps RE/MAX Affiliates get business leads through community and charity events.
- Exhibit F includes a “RE/MAX University Catalogue” which Mr. Ash attests was distributed to RE/MAX Affiliates in Canada during the relevant period. The catalogue describes the courses and videos that are available through RE/MAX University. The Mark is displayed on the cover and throughout the catalogue.

Exhibit F also includes screenshots from *www.remax.net*, which Mr. Ash attests show “how RE/MAX University may be accessed using mobile devices and via Roku as a television service”. The webpages include instructions for using the Roku digital media player. Mr. Ash explains that although the screenshots have a 2014 copyright notice, the individual webpages shown were available during the relevant period. The Mark is displayed at the top of the webpages.

[27] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “franchising, namely consultation and assistance in business management, organization and promotion” and “franchising, namely, offering technical assistance in the establishment and/or operation of real estate brokerage offices” within the meaning of sections 4(2) and 45 of the Act.

Arranging and Conducting Trade Shows

[28] With respect to “arranging and conducting trade shows in the field of real estate and real estate franchise services”, Mr. Ash attests that the Owner and its “Canadian Regional Sub-franchisors” conduct various conferences, seminars, trade shows, and courses for its RE/MAX Affiliates, geared towards assisting them in their real estate agency and brokerage businesses. He explains that the Owner holds global conferences for its affiliates and that its annual conference was held in Ottawa in August 2013.

[29] In support, attached as Exhibit D to his affidavit are the aforementioned advertising materials and agendas related to conferences and trade shows held throughout Canada. As noted above, materials are included from various conferences, including one held in Calgary and one held in Ottawa during the relevant period. The Mark is displayed throughout the materials.

[30] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “arranging and conducting trade shows in the field of real estate and real estate franchise services”, within the meaning of sections 4(2) and 45 of the Act.

Business Services

[31] With respect to the registered “business services”, Mr. Ash attests that the Owner approves and licenses third-party vendors, suppliers and contractors to use the Mark in association with “a variety of promotional goods and items, which are used by RE/MAX Affiliates to promote their real estate services.” He explains that the Owner screens and organizes vendors, suppliers, and contractors to ensure that they meet the Owner’s quality standards.

[32] In support, attached as Exhibit G to his affidavit are copies of “Approved Supplier Catalogues”, which Mr. Ash attests were provided to RE/MAX Affiliates during the relevant period to advertise the promotional materials available to them. The catalogues, which are dated from 2010 to 2013, list various suppliers with their contact information, and in some cases include advertisements for specific suppliers. The Mark is displayed on the cover of each catalogue.

[33] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “business services, namely, registering, screening, credentialing, and organizing third-party vendors, suppliers, and contractors on behalf of others”, within the meaning of sections 4(2) and 45 of the Act.

Advertising Services

[34] With respect to “creating and updating advertising material”, “real estate advertising services” and “distribution and dissemination of advertising materials” from services (1) and “advertising via electronic media and specifically the internet” and “promoting the goods and services of others by providing hypertext links to the web sites of others” from services (2), Mr. Ash attests that the Owner created and distributed advertising material on behalf of RE/MAX Affiliates and others during the relevant period.

[35] Mr. Ash explains that the advertising media used by the Owner included internet advertisements, print advertisements, television commercials, video tours of real estate and business cards. He also attests that the Owner advertised its services and those of RE/MAX Affiliates on its website, *www.remax.ca*, which received 305,000 visitors per month during the relevant period.

[36] In support, Mr. Ash attaches the following exhibits to his affidavit:

- Exhibit H consists of presentation slides that Mr. Ash attests are “media campaign highlights for Western Canada during the Relevant Period, detailing television spots, sports sponsorships, search engine marketing and examples of advertisements displayed online, on mobile applications and in magazines”. He further attests that the television advertisements aired during news, sports, and primetime television. The slides show how the Mark was to be displayed in various advertisements that were created to advertise the services of both the Owner and its RE/MAX Affiliates.
- Exhibit I consists of screenshots from websites belonging to RE/MAX Affiliates as well as various advertisements, third-party periodicals and brochures, all of which Mr. Ash attests are from the relevant period. The majority of the advertising materials are real

estate listings by RE/MAX Affiliates. The Mark is displayed repeatedly throughout the materials.

- Exhibit J is a DVD containing seven videos. Mr. Ash attests that one video is a YouTube video of a television advertisement that was shown in Canada during the relevant period. The advertisement promotes the Owner's brokerage services to prospective buyers and sellers. Mr. Ash identifies four of the videos as online real estate tours that were uploaded to YouTube during the relevant period. Finally, he attests that two of the videos are "educational videos for consumer education in the field of real estate". The Mark is displayed at the beginning or end of each of the seven videos.
- Exhibit K consists of "representative" printouts from the websites of four different RE/MAX Affiliates. The webpages include contact information and hyperlinks to various third-party "service providers", such as TD Canada Trust Mortgages and the Real Estate Institute of Canada. The Mark is displayed at the top of the webpages.

[37] With respect to "advertising" services, the Registrar has held that advertising on its own may not be a *bona fide* service in cases where it is not provided to a third party and instead only benefits the registered owner, such as where a registered owner advertises their own goods [see *Ralston Purina Co v Effem Foods Ltd* (1997), 81 CPR (3d) 528 (TMOB) at 534].

[38] However, in the present case, the evidence shows that the Owner created and updated advertising materials which were then used by its licensed franchisees in conducting their own business. The evidence also shows that the Owner and its licensees created and maintained advertising for its customers in the form of real estate listings and other advertisements, including website hyperlinks.

[39] As such, I am satisfied that the Owner has demonstrated use of the Mark in association with "creating and updating advertising material", "real estate advertising services", "distribution and dissemination of advertising materials", "advertising via electronic media and specifically the internet" and "promoting the goods and services of others by providing hypertext links to the web sites of others" within the meaning of sections 4(2) and 45 of the Act.

Online Real Estate Tours

[40] With respect to “real estate marketing services, namely, on-line services featuring tours of residential and commercial real estate”, Mr. Ash attests that the RE/MAX Affiliates provided online tours of residential and commercial real estate via the Internet.

[41] In support, attached as Exhibit J to his affidavit is the aforementioned DVD containing seven videos. Mr. Ash attests that four of the videos are online tours of various properties posted to YouTube during the relevant period. For example, one video shows a home for sale in Surrey, British Columbia, along with contact information for the RE/MAX Affiliate acting as broker. The Mark appears on screen at different points in each video, most often at the beginning and end.

[42] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “real estate marketing services, namely, on-line services featuring tours of residential and commercial real estate”, within the meaning of sections 4(2) and 45 of the Act.

Networking and Referrals

[43] With respect to “referrals in the field of real estate brokerage” and the registered “real estate networking referral services”, Mr. Ash attests that the Owner provides an online tool called “RE/MAX Mainstreet” located at *www.remax.net* to RE/MAX Affiliates in Canada. He explains that the tool allows RE/MAX Affiliates to “update their profiles, exchange ideas and interact with other RE/MAX Affiliates, and provide referrals to other RE/MAX Affiliates.”

[44] Mr. Ash further attests that the Owner provides referral services through the “Find an Agent or Office” function on the Owner’s website, which provides hyperlinks to websites of individual agents or offices. He attests that referral services were also provided through the “LeadStreet” program, which he describes as “an exclusive online lead generation program connecting potential clients to RE/MAX Affiliates”.

[45] In support, Mr. Ash attaches the following exhibits to his affidavit:

- Exhibit L consists of screenshots of the RE/MAX Mainstreet website for referrals and networking, showing posts by RE/MAX Affiliates. While the screenshots are from after the relevant period, Mr. Ash attests that the webpages looked substantially similar during the relevant period. The Mark is displayed prominently at the top of each page.
- Exhibit M consists of screenshots from the websites of the Owner and a RE/MAX Affiliate in Quebec. The screenshots of the Owner’s website, *www.remax.ca*, show the “Find an Agent or Office” page, while Mr. Ash attests that the screenshot from *www.remax-quebec.com* shows hyperlinks to the websites of other RE/MAX Affiliates. Mr. Ash attests that these screenshots show the websites during the relevant period. The Mark is displayed to the right of the “Find an Agent or Office” search function and above the list of hyperlinks.
- Exhibit N consists of various promotional materials and guides that Mr. Ash attests relate to the LeadStreet program and provide information on referral events offered at conferences held in Canada during the relevant period. The promotional materials explain the benefits of LeadStreet and also explain how to use the program. The Mark is displayed throughout the materials, most often at the top of the page.

[46] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “referrals in the field of real estate brokerage” and “real estate networking referral services, namely, promoting the goods and services of others by passing business leads and referrals”, within the meaning of sections 4(2) and 45 of the Act.

Real Estate Auctions

[47] With respect to “real estate auctions”, Mr. Ash attests that RE/MAX Affiliates provide auctions services to consumers in Canada.

[48] Regarding the relevant period, attached as Exhibit O to his affidavit are “representative examples of marketing materials produced during the Relevant Period, including a third-party media publication and website screenshot”, which Mr. Ash attests show how RE/MAX Affiliates offered auction services. The third-party publication includes an advertisement for auction

services offered by a RE/MAX Affiliate based in Calgary. The Mark is displayed in the advertisement. The screenshot shows a website belonging to a RE/MAX Affiliate where the Affiliate offers auction services and also provides information regarding real estate auctions. The Mark is displayed at the top of the webpage.

[49] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “real estate auctions”, within the meaning of sections 4(2) and 45 of the Act.

Providing Information in the Field of Real Estate

[50] With respect to “providing consumer information in the field of real estate”, Mr. Ash attests that the Owner used various “articles, news releases, buyer’s tools and reports” produced by the Owner during the relevant period to provide consumers with information on trends in the field of real estate.

[51] In support, Mr. Ash attaches the following exhibits to his affidavit:

- Exhibit J, as referenced above, consists of a DVD containing seven videos, including two “educational videos for consumer education in the field of real estate”. Mr. Ash attests that the videos were posted to YouTube during the relevant period. Both videos give information on how to stage a home. The Mark is displayed at the beginning and end of each video.
- Exhibit P consists of printouts from the Owner’s website at *www.remax.ca*, which include printouts of an article from 2012 and a report from 2013. The article was authored by a RE/MAX Affiliate and is with respect to the state of the real estate market. The report is an analysis of different real estate markets across Canada. The Mark appears at the top of each page.

[52] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “providing consumer information in the field of real estate” within the meaning of sections 4(2) and 45 of the Act.

Promoting Public Awareness

[53] With respect to “promoting public awareness of the need for breast cancer screening”, Mr. Ash attests that the Owner promotes awareness of the need for breast cancer screening through its partnership with the Canadian Breast Cancer Foundation (CBCF). He attests that the Mark appeared on various promotional materials distributed during the relevant period.

[54] In support, Mr. Ash attaches the following exhibits to his affidavit:

- Exhibit Q consists of a screenshot from the CBCF website, which Mr. Ash attests shows that RE/MAX Affiliates in Ontario and the Atlantic Provinces raised \$36,000 for CBCF between April 2011 and March 2012. I note that the website states that “funds raised by RE/MAX are directed towards primary prevention research, which aims to stop breast cancer before it starts.” The Mark is not displayed on the page.
- Exhibit R consists of three flyers dated during the relevant period, which Mr. Ash attests were created by the Owner and RE/MAX Affiliates for events benefitting CBCF. The flyers advertise charity yard sales and charity races to raise funds for CBCF. The flyers provide information regarding particular fundraising efforts, and include statements such as “Raising Funds to Support Breast Cancer Research”. The Mark is displayed on each of the three flyers.

[55] Although the Exhibit Q screenshot is from a third-party website and does not display the Mark, the information shown on the website provides context for the Owner’s charitable activities, being fundraising for breast cancer prevention in partnership with the CBCF.

[56] As the Exhibit R flyers show the Mark, and were created and distributed by the Owner or by RE/MAX Affiliates in relation to such fundraising activities, I am satisfied that the Owner has demonstrated use of the Mark in association with “promoting public awareness of the need for breast cancer screening”, within the meaning of sections 4(2) and 45 of the Act.

Subscription to a Television Channel

[57] Finally, with respect to the registered services “subscription to a television channel”, as mentioned above, Mr. Ash attests that the Owner offers its RE/MAX University programming to RE/MAX Affiliates “over the Internet via computer, mobile device or streaming video on

television”. He attests that the programming can be accessed through a television by using a “Roku” digital media player.

[58] In support, he attaches the following exhibits to his affidavit:

- Exhibit F, as referenced above, includes a “RE/MAX University Catalogue” which describes the courses and videos that are available through the Owner’s RE/MAX University program. The Mark is displayed on the cover and throughout the catalogue.

Exhibit F also includes screenshots from *www.remax.net* and *www.remax-western.ca*, which Mr. Ash attests show “how RE/MAX University can be accessed via Roku as a television service”. I note that one of the screenshots shows a page entitled “Before Adding the RE/MAX University Channel”, and explains how to add the “RE/MAX Channel” once the Roku digital media player is installed. The Mark is displayed at the top of the webpages.

- Exhibit L, also referenced above, consists of screenshots of the RE/MAX Mainstreet website from the relevant period. The screenshots show that RE/MAX Affiliates are required to sign in to an account in order to access RE/MAX Mainstreet, which in turn gives them access to RE/MAX University videos.

[59] In summary, the Owner characterizes the evidenced service as a “television channel” on its website. In particular, the Exhibit F screenshots include references to “the RE/MAX University Channel”, and explain how to add the “RE/MAX Channel” once a Roku digital media player is installed. Furthermore, based on the screenshots at Exhibits F and L, it appears that RE/MAX Affiliates gained access to RE/MAX University content by signing up for RE/MAX Mainstreet in a manner akin to signing up for a subscription.

[60] Nonetheless, the Requesting Party submitted that Mr. Ash’s affidavit does not contain any reference to “subscription services”. It argued that there is a difference between offering a subscription to a television channel and simply providing videos which *can* be streamed on a television. Essentially, the Requesting Party argued that the Owner has overstated the service that it offers.

[61] However, the Requesting Party provides no authority for the proposition that the interpretation of “subscription to a television channel” should be limited to more traditional television subscription services such as cable or satellite subscriptions. Indeed, the Owner submits that the evidenced service constitutes “subscription to a television channel” regardless of how the service is technically delivered to customers. The Owner also submits that it provides the videos directly to RE/MAX Affiliates’ televisions, and not through a separate television subscription, such as a cable or satellite subscription.

[62] As per section 30 of the Act, services must be stated in ordinary commercial terms and whether a trade-mark has been used in association with the services as registered is to be determined on a case-by-case basis [see *Express File Inc v HRB Royalty Inc*, 2005 FC 542, 39 CPR (4th) 59]. Accordingly, registered services should be interpreted in accordance with common sense and given their ordinary meaning.

[63] In view of the foregoing, I agree with the Owner that, for purposes of the Act, “subscription to a television channel” can reasonably be considered an ordinary commercial term for the evidenced service. Indeed, this is not a case of the Owner attempting to “overstate” or characterize its service as something broader than what it actually offered. The exhibited screenshots from the Owner’s website reference the service as the “RE/MAX channel” and access appears to be limited or facilitated through a login system.

[64] While the evidenced service offered by the Owner is not a traditional cable or satellite subscription, in my view the Owner has nonetheless demonstrated that it provided a “subscription to a television channel” service during the relevant period, albeit through the use of video streaming technology.

[65] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “subscription to a television channel” within the meaning of sections 4(2) and 45 of the Act.

Disposition

[66] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with sections 4(2) and 45 of the Act, the registration will be maintained.

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

Hearing Date: 2015-05-22

Appearances

Karen F. MacDonald

For the Registered Owner

Bayo Odutola

For the Requesting Party

Agents of Record

Bull, Housser & Tupper LLP

For the Registered Owner

OLLIP P.C.

For the Requesting Party