



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

Citation: 2011 TMOB 14
Date of Decision: 2011-01-26

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Gowling Lafleur Henderson LLP against
registration No. TMA515,151 for the trade-mark MWI &
PARTNERS DESIGN in the name of Midland Walwyn
Capital Inc./Capital Midland Walwyn Inc.**

[1] At the request of Gowling Lafleur Henderson LLP (the Requesting Party), the Registrar of Trade-marks issued a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on September 24, 2008 to Midland Walwyn Capital Inc./Capital Midland Walwyn Inc. (the Registrant), the registered owner of registration No. TMA515,151 for the trade-mark MWI & PARTNERS DESIGN (the Mark).

[2] The Mark (shown below) is registered for use in association with the following services: “financial services namely investment management services and investment advisory services” (the Services).

mwi
& PARTNERS

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the services specified in the registration at any time within the three year period immediately preceding the date of the notice, and if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is between September 24, 2005 and September 24, 2008 (the Relevant Period).

[4] The definition of “Use” with respect to services is set out in s. 4(2) of the Act, which states:

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, MWI & Partners (MWI) filed the affidavit of R. Geoffrey Browne, the managing partner of MWI, sworn on March 30, 2009, together with Exhibits A through D. Both parties filed written arguments; an oral hearing was not requested.

[6] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of a s. 45 proceeding [*Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1979), 45 C.P.R. (2d) 194, aff’d (1980), 53 C.P.R. (2d) 63 (F.C.A.)]. Although the threshold for establishing use in these proceedings is quite low [*Lang, Michener, Lawrence & Shaw v. Woods Canada Ltd.* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.)], and evidentiary overkill is not required [*Union Electric Supply Co. v. Canada (Registrar of Trade Marks)* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)], 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 wares or services specified in the registration during the relevant period.

[7] In his affidavit, Mr. Browne states that he is a managing partner and one of the founders of MWI. He provides that MWI is a private equity investment firm, established in 1996 to provide equity and equity-like capital to North American companies. He states that from its establishment, MWI was partly owned, indirectly, by the Registrant and that the Registrant registered the Mark and licensed its use to MWI until July 2, 2002. On that date, the Registrant sold its interest in MWI and, as Mr. Browne goes on to state, “in conjunction with that sale,

MWI acquired any assets owned by the Registrant related to the operation of MWI, including the Mark.” I will discuss the issue of whether use of the Mark by MWI satisfies the requirements of s. 45 of the Act after reviewing the evidence provided. In support of his assertion of use during the Relevant Period in Canada, Mr. Browne attaches stationery bearing the Mark, financial statements and the cover page of an Annual Report.

[8] With respect to the stationery (at Exhibit A), I note that the business card, letterhead and envelope all display the Mark as registered. Although both the letterhead and envelope provided are blank, undated and unaddressed, Mr. Browne provides that during the Relevant Period, MWI used such stationery to communicate with clients regarding the promotion and performance of the Services in Canada. The Requesting Party submits that the business card and stationery are not evidence of use of the Mark, citing the Registrar's decision in *Stikeman & Elliott v. Living Realty Inc.* (2000), 10 C.P.R. (4th) 410 (T.M.O.B.) [*Living Realty*]. In some circumstances, however, business cards can be evidence of advertisement of services [*Tint King of California v. Canada (Registrar of Trade-marks)* (2006), 56 C.P.R. (4th) 223 (F.C.T.D.)], if there are indicia of the relevant services on the card itself or there are clear statements alleging use in the affidavit [*88766 Canada Inc. v. R.H. Lea & Associates Ltd.*; 2008 CarswellNat 4513 (T.M.O.B.) at 20]. In the present case, the exhibits are accompanied by Mr. Browne's clear statements alleging use, thus distinguishing it from *Living Realty, supra*, where the business cards had no indicia of the services offered and the deponent made no allegations of use of the subject trade-mark. The exhibits in combination with the statements in the affidavit amount to statements of fact demonstrating use and are not merely bald assertions of use [*Mantha & Associés/Associates v. Central Transport, Inc.* (1995) 64 C.P.R. (3d) 354 (F.C.A.)].

[9] Given the preceding determination, I will only comment briefly on the remaining exhibits. With respect to the financial statements at Exhibits B and C, while I note that they do not display the Mark exactly as registered and the statements indicate that they were prepared by and emanated from a third party, Ernst & Young LLP, I do accept the statements as indicators of performance of the Services by MWI during the Relevant Period. With respect to the cover page of MWI's Annual Report at Exhibit D, I note that although it does display the Mark as registered, the date of the Annual Report is after the Relevant Period. The Registrant submits that the report covers the year ending December 31, 2008, and thus covers a portion of the

Relevant Period; however, since the report was published after the relevant period, the title page in itself does not constitute advertisement of the Mark during the Relevant Period. At best, Exhibit D is acceptable merely as an indicator of performance of the Services by MWI during the Relevant Period.

[10] Nevertheless, having established that the Mark was used by MWI during the Relevant Period in Canada, I will now turn to the issue of whether such use accrues to the benefit of the Registrant. The Requesting Party has questioned whether the proper party has filed evidence in this proceeding, noting that the registration remains in the name of the Registrant, rather than MWI. In the introductory section (paragraph 3) of his affidavit, Mr. Browne makes the general statement that the Registrant is MWI's predecessor-in-title. The relevant paragraphs from Mr. Browne's affidavit providing more detail concerning the transfer of ownership are reproduced below (paragraphs 6 and 7):

From its establishment until July 2, 2002, MWI was partly owned, indirectly, by MWC Inc. [Midland Walwyn Capital Inc./Capital Midland Walwyn Inc.]. On July 2, 2002, MWC Inc. sold its interest in MWI.

MWC Inc. registered the Trade-mark and licensed its use to MWI. In conjunction with the sale of MWC Inc.'s interest in MWI, MWI acquired any assets owned by MWC Inc. related to the operation of MWI, including the Trade-mark.

[11] Although an assignment may be valid even if not recorded [*Sim & McBurney v. Buttino Investments Inc.* (1996), 66 C.P.R. (3d) 77 (F.C.T.D.)], a successor-in-title may successfully respond to a s. 45 notice only if it satisfies the Registrar that it was the owner of the registered mark during the relevant time period [*MacLeod Dixon LLP v. Kayden Instruments Inc.* (2009), 78 C.P.R. (4th) 297]. Per *Mahoney J.* in *Star-Kist Foods Inc. v. Canada (Registrar of Trade Marks)* (1988), 20 C.P.R. (3d) 46 at 50:

Transactions post-dating the issue of a s. 44 [now s. 45] notice may properly be viewed with some scepticism, and when the true circumstances are peculiarly within the knowledge of one party, he should bring that evidence forward. It is unreal and unfair to lay the onus on another who, in the scheme of things, has no power to compel production of evidence.

[12] In the present case, I first note that a transfer of ownership has not been recorded, despite the lengthy passage of time since the sale of the Registrant's interest in MWI on July 2, 2002 and the indication in written submissions dated November 30, 2009, that evidence of the trade-mark assignment to MWI would be filed shortly. Nor has a request been made (pursuant to s. 47(2) of the Act) for leave to submit further evidence in this regard. While none of these steps were obligatory, they would have been helpful given the ambiguity of the evidence before me.

[13] In this respect I note that although Mr. Browne states in paragraph 6 that the Registrant sold its interest in MWI in July 2002, he does not clearly identify the party to whom such interest was sold on that date, nor does he explicitly state that MWI itself actually acquired the assets and the Mark on July 2, 2002. In paragraph 7, the affiant states that "in conjunction" with that sale, MWI "acquired any assets" of MCW related to the operation of MWI "including" the Mark. The affiant would have us infer that "in conjunction" with the sale means "directly to MWI with the Mark on July 2, 2002"; however, I fail to understand why a simple statement to that effect was not made. In my view, the language is ambiguous, the actual date and procedure by which MWI acquired rights in the MWI-related assets is unclear. This is particularly so considering that prior to July 2002, MWI was only "partly owned, indirectly" by the Registrant; thus the possibility of the involvement of third parties is raised, yet unexplained. In short, Mr. Browne's evidence does not include sufficient particulars or supporting documentation that would allow me to be satisfied that a transfer of the Mark from the Registrant to MWI had in fact occurred in conjunction with the July 2002 sale or, indeed, at any point prior to the end of the Relevant Period. Per, *Plough, supra*, any ambiguities in the evidence must be interpreted against the interests of the affiant; I am not satisfied that MWI was the proper owner of the Mark and entitled to be recorded as registered owner during the Relevant Period.

[14] Additionally, in the absence of evidence of a continuing licensing agreement between the Registrant and MWI during the Relevant Period that satisfies the requirements of s. 50(1) of the Act, I cannot conclude that use by MWI during the Relevant Period accrued to the benefit of the Registrant.

[15] As such, I am not satisfied that the evidence demonstrates use of the Mark by the Registrant in association with the Services within the meaning of s. 4(2) and s. 45 of the Act. In addition, no special circumstances have been presented excusing such absence of use.

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

P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office