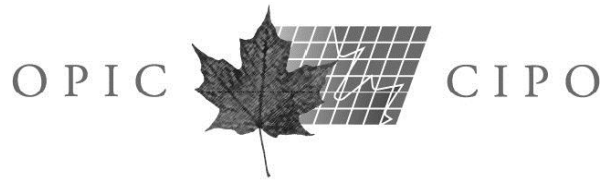


Translation



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

Reference: 2013 TMOB 30
Date of Decision: 18/02/2013

**IN THE MATTER OF THE SECTION 45
PROCEEDINGS, undertaken at the request of Norton
Rose OR S.E.N.C.R.L., s.r.l. regarding Registration
No. TMA526,959 of the ILLICO COMMUNICATION
trade-mark in the name of Illico Communication Inc.**

[1] On November 14, 2011, at the request of Norton Rose OR S.E.N.C.R.L., s.r.l. (the Requesting Party), the registrar sent the notice stipulated in Section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Illico Communication Inc. (the Registered Owner) in order to prove use of the ILLICO COMMUNICATION trade-mark (the Mark) in association with:

Publishing graphics, corporate graphics and promotional and communication graphics, specifically advertising, magazines and signs, design of Internet showcases and photographs, and related services, specifically writing, translation and proofreading (the Services).

[2] Section 45 of the Act requires the Registered Owner to show that it has used its Mark in Canada in association with each of the Services specified in the registration at any given time during the three years preceding the date of the notice or, if not, provide the date on which it was last used and the reason for its absence of use since this date. The relevant period in this case is therefore from November 14, 2008 to November 14, 2011 (the Relevant Period).

[3] The procedure pursuant to Section 45 is simple and expeditious, and serves to clear “deadwood” from the register. Accordingly, the threshold to establish use of the Mark, within the

meaning of Section 4 of the Act, during the Relevant Period is not very high [see *Woods Canada Ltd v. Lang Michener* (1996), 71 CPR (3d) 477 (CF 1st inst.)].

[4] A simple claim of use of the Mark in association with the Services is not sufficient to establish its use within the meaning of Section 4(2) of the Act. There is no requirement to produce abundant evidence. However, any ambiguity in the evidence will be interpreted against the Registered Owner of the Mark [see *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980) 53 CPR (4th) 62 (CAF)].

[5] In reply to the notice, the Registered Owner submitted the affidavit of Jean-Yves Côté, attorney, founder, president and sole shareholder of the Registered Owner. The Requesting Party alone submitted written representations. No hearing was requested. In fact, I have to stress that the registrar had sent a notice to the Registered Owner on April 3, 2012 informing it that it had four months to produce written representations or to inform the registrar that written representations would not be submitted. However, the Registered Owner did not reply to this notice although there had been correspondence addressed to the registrar on April 5, 2012 but unrelated in any way to the said notice.

[6] Pursuant to the practice notice entitled *Practice in Section 45 Proceedings* and more specifically Section VII.1, the party wishing to be heard must send the registrar a written request to do so within a period of one month following expiration of the final deadline for submitting written representations by the registered owner. Accordingly, the parties had until September 3, 2012 to submit such a request to the registrar. There had been no request submitted by either one of the parties to this end. My decision will therefore be based on the content of Mr. Côté's affidavit and I will take into account the written representations of the Requesting Party. However, I will ignore the comments made in paragraphs 10, 11, 12, 14, 49 and 67 to 70 of the written representations of the Requesting Party. I deem these remarks irrelevant and they do not stem from the evidence submitted in this file.

[7] Mr. Côté provided information concerning the chain of titles regarding the Mark. Since the alleged facts concerning acquisition of the Mark by the Registered Owner occurred before the Relevant Period, they are at most informative but certainly not relevant.

[8] I reproduce below the relevant passages of Mr. Côté's affidavit relating to the use of the Mark:

5. My company writes, formats and publishes, under the ILLICO COMMUNICATION mark, the newsletter *Le Rechercheur*, with a circulation of 25,000 copies. This newsletter was circulated to the public during the period relevant to this affidavit, i.e. between November 2008 and November 2011. I attach as evidence exhibit **JYC-3**, in support of my affidavit, the issue of the newsletter *Le Rechercheur* that covers the election of Pierre Chagnon, attorney, as president of the Barreau du Québec for the period 2009-2010;

6. My company is responsible for the formatting, graphics and publishing of the *Bulletin de Jurisprudence des Cours municipales du Québec* (BJCMQ) under the mark ILLICO COMMUNICATION. These tasks include proofreading the text and the publishing and communication graphics. This newsletter is similar to a magazine (periodical). I attach as evidence exhibit **JYC-4**, in support of my affidavit, the 2010-2011 binder in which is inserted the January-February issue of the said newsletter;

7. My company also designs, under the mark ILLICO COMMUNICATION, the graphics for electronic products, such the BJCMQ's CD-ROMs. I attach as evidence exhibit **JYC-5**, in support of my affidavit, the BJCMQ 2008 CD-ROM, which was distributed at the start of the 2009 calendar year to subscribers of this publication. A similar CD-ROM was also designed, produced and distributed in the calendar years 2009 and 2010, while that for the 2011 calendar year was in production on the signature date of this affidavit;

8. My company participated, under the mark ILLICO COMMUNICATION, in preparing the corporate graphics and Internet promotional showcase www.pierrechagnon.com, advertising brochures on paper, advertising e-mails for the electoral campaign of Pierre Chagnon, attorney, as part of the latter's candidature for vice-president of the Barreau du Québec in 2008, such as it appears in the documents submitted in bundle as exhibit **JYC-6**;

9. Again in October 2011, due to the expertise to which my ILLICO COMMUNICATION mark is associated in terms of publishing graphics and corporate, promotional and communication graphics, the campaign of Anne Lessard, attorney, candidate for vice-president of the Barreau du Québec, received consulting services associated with the mark ILLICO COMMUNICATION in terms of graphics, given the design of the publicity e-mails with her photograph, as well as for advertising signs on cardboard with her photograph and for the duration of this electoral campaign, the whole as it appears in documents submitted in bundle as exhibit **JYC-7**;

10. Regarding certain related services described in the *Registration certificate* for the mark **JYC-2** ("*specifically writing, translation and proofreading*"), I declare that my company did not provide *translation* services in relation to the mark ILLICO

COMMUNICATION during the period covered by this affidavit, but that it did, as previously indicated, provide the *writing* and *proofreading* services during this period.

[9] First, in light of the admission contained in Mr. Côté's affidavit and the absence of reasons justifying the absence of use in association with these services, there is reason, at least, to amend the registration certificate for the Mark to strike out the translation services.

[10] Before beginning analysis on this evidence, I would like to reproduce the text from Section 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.

[11] As a preliminary remark, I wish to stress that the use of a trade-mark must not be confused with the use of a company name or brand name. It can happen in very specific cases that the use of one also constitutes the use of the other when the brand name is identical to the registered trade-mark. However, if the mention of the brand name or company name is used only to identify a legal entity, this is not the use of a trade-mark within the meaning of Section 4 of the Act [see *Sunny Fresh Foods Inc. v. Sunfresh Ltd.* (2003), 30 CPR (4th) 118 (TMOB)].

[12] I note that there were no invoices submitted, except for exhibit JYC-6 but it had been issued before the Relevant Period. The absence of invoices is not fatal to the Registered Owner provided that it shows that the Services were performed or advertised in association with the Mark.

[13] As Mr. Côté indicated, exhibit JYC-3 is a legal newsletter, printed both sides, entitled *Le Recherchiste*. On the reverse side, “illico®” is followed below by “Communication Inc.” Although there is no marking requirement in the Act to identify a registered trade-mark, the ® symbol beside the word “illico” could serve as an indication to the reader of this newsletter that this is a registered trade-mark [see *Fasken Martineau DuMoulin LLP v. AGF Management Ltd.* (2003), 29 CPR (4th) 411 (TMOB)]. We also find the “® illico Communication Inc.” at several places in this newsletter. However, this note indicates that the legal entity Illico Communication Inc. owns the copyright of the text preceding this note.

[14] Accordingly, overall, the reference to “ illico Communication Inc.” on this newsletter serves to identify the entity that publishes this legal newsletter. This is not a use of the Mark in association with one of the Services within the meaning of Section 4(2) of the Act.

[15] There is also the presence of the ILLICO trade-mark below the title *Le Recherchiste*. However, I do not see how this presence could constitute the use of the Mark in association with one of the Services. Clearly, it could be the use of the ILLICO mark in association with a product, but certainly not in association with services.

[16] On the reverse side of the newsletter, there is also the reference to “ILLICO” and the e-mail address illico@illico.ca. These references do not constitute a use of a trade-mark.

[17] Although exhibit JYC-3 represents an example of the use of a trade-mark in association with services, at most, this service would be “on-demand case law”, given the nature of the document and the inclusion of an order form on the reverse of this exhibit. In any event, it is not one of the Services.

[18] Even if I were to conclude that one or other of the references to “illico” and/or “illico Communication Inc.” constituted use of the Mark in association with one or other of the Services (for example, publishing graphics), which is not the case, the execution of this service did not benefit the public, but rather the interests of the Registered Owner, since it was used for its own legal newsletter. Accordingly, this is not use of the Mark in association with the Services within the meaning of Section 4(2) of the Act [see *Ralston Purina Co. v. Effem Foods Ltd.* (1997), 81 CPR (3d) 528 (TMOB)].

[19] Exhibit JYC-4 is a case law newsletter containing summaries of decisions from municipal courts in Quebec. It is entitled *Bulletin de jurisprudence des cours municipales du Québec*. It contains the mention “illico Communication Inc.” This reference does not constitute use of the Mark in association with one of the Services. It is use of the Registered Owner’s company name.

[20] There is also reference to the website www.illico.ca. I do not see how this reference could constitute use of the Mark in association with one of the Services. The Registered Owner’s

company name is present on the last page of the newsletter, along with its contact information, to inform consumers whom they must contact to obtain this newsletter.

[21] Lastly, although exhibit JYC-4 serves as an example of the use of the Mark in association with the services, the only one possible would be “case law update”, which is not part of the Services.

[22] Exhibit JYC-5 is a CD-ROM containing the integral texts of judgments rendered by municipal courts in Quebec. The cardboard cover of the box containing the CD-ROM contains the mention: “Published by: illico Communication Inc.” Once again, this mention is used to identify the publisher of this CD-ROM. This is in no way a use of the Mark in association with one of the Services within the meaning of Section 4(2) of the Act.

[23] The cardboard back of the box contains the mention “Design, engraving and printing on CD-ROMs: “illico Communication Inc.” However, the said services were not rendered on behalf of a third-party, but rather used only for the interests of the Registered Owner. Accordingly, this cannot be use of the Mark within the meaning of Section 4(2) of the Act.

[24] Regarding the advertising brochure submitted as exhibit JYC-6, there is no reference to the Mark. Furthermore, the invoice for the design of this brochure also submitted as exhibit JYC-6, bears the mention “date of the service: April 14, 2008”, i.e. prior to the Relevant Period.

[25] There remains only exhibit JYC-7. This exhibit constitutes e-mails, photographs and advertising documents. The first e-mail is a convocation sent to Mr. Côté personally for a meeting of the “organizing committee”. From the comments contained in paragraph 9 of Mr. Côté’s affidavit, I presume this is a convocation sent to members of the organizing committee of Anne Lessard’s candidature for vice-president of the Barreau du Québec. However, I note the date of this e-mail: January 19, 2012. It cannot therefore be considered, since it is after the Relevant Period.

[26] The second and third e-mails are dated January 12 and February 1, 2012. They are also after the Relevant Period.

[27] Lastly, there is another e-mail dated February 1, 2012 containing an attachment which seems to be an ad to boost the candidature of Anne Lessard. However, there is no reference whatsoever in this exhibit to the Mark. There are also amended versions of this exhibit, but none of them contain the Mark. Finally, it appears that these documents were designed after the Relevant Period.

[28] Therefore, in summary, the documentary evidence shows the use of “illico Communication Inc.” as a company name and does not constitute proof of the use of a trade-mark in association with services [see *Sunny Fresh Foods Inc.*]. On some documents, we find the mention “illico” but followed by “®” to indicate that this term is a registered mark. This is not a use of the Mark, since everything is followed by “Communication Inc.” in order to clearly identify the Registered Owner’s company name. Some of the documents submitted are from after the Relevant Period and the only invoice submitted is prior to the Relevant Period. Lastly, even if I were to conclude that exhibits JYC-3 and JYC-5 are illustrations of the fruits of services performed by the Registered Owner, these services were not offered to third-parties but were performed for the sole benefit of the Registered Owner.

[29] There remain therefore only Mr. Côté’s statements regarding the use of the Mark. However, such statements not corroborated by documents, as is the current case, are insufficient to conclude in use of the Mark in association with the Services during the Relevant Period.

[30] In exercising the authority delegated to me pursuant to the provisions of Section 63(3) of the Act, the Registration No. TMA526,959 will be struck from the register, the whole in compliance with the provisions of Section 45(3) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Traduction certifiée conforme
Alan Vickers