

SECTION 45 PROCEEDINGS
TRADE-MARK: CAD-QUIKVIEW DESIGN
REGISTRATION NO.: TMA 442,030

On October 26, 1998, at the request of Inso Corporation, the Registrar forwarded a Section 45 notice to Alliance Technologies Inc., the registered owner of the above-referenced trade-mark registration.

The trade-mark CAD-QUIKVIEW Design (shown below) is registered for use in association with the following wares and services:

Wares: Computer software.

Services: Software instruction and orientation services; software support and maintenance services; and carrying on the business of sale or license of computer programs and supporting materials.

Cad-QuikView

In response to the notice, the registrant furnished the affidavit of Robert G. Holland together with exhibits. Each party filed a written argument. An oral hearing has not been requested in this case.

In his affidavit, Mr. Holland states that the registrant has used and continues to use the trade-mark in Canada in association with the wares and services. He explains that the registrant's wares are sold directly to the purchasers and that the services are provided through the use of manuals and user documentation in conjunction with either site visits or telephone help lines.

He indicates that the trade-mark is applied to the packaging of the wares, labels and other such user documentation associated with the software and as exhibits A, B and C he attaches a packaging specimen, a label, and a copy of the software User Guide documentation and a User Guide cover all bearing the trade-mark. He provides a list of recent Canadian purchasers and representative samples of invoices bearing dates between January 17, 1995 and November 15, 1998. He also provides copies of advertisements for publications distributed in Canada, as well as throughout North America and Europe.

The requesting party argues that any use shown is of a trade-mark that deviates substantially from the trade-mark as registered; further it submits that no evidence has been provided to demonstrate use in association with any of the services.

First, concerning the trade-mark shown to be in use, I reproduce below a representation of the trade-mark that appears on the exhibits:

I cannot agree with the requesting party that the deviation is substantial. In my view, all the elements forming the trade-mark as registered have been preserved, and although the words CAD and QUIKVIEW appear on separate lines and in a font that differs from the trade-mark as registered, these are minor modifications (see *Honey Dew, Limited v. Rudd et al.*, 1928, Ex. C.R. 83, at page 88). Concerning the addition of the box enclosing the words, I tend to agree with the registrant that this would not prevent the words CAD QUIKVIEW “per se” being perceived by the public as being used as a trade-mark (*Nightingale Interloc Ltd. v. Prodesign Ltd.*, 2 C.P.R. (3d) 535, in particular Principles 1 and 2).

In view of the above, I conclude that the use of the trade-mark shown by the evidence constitutes use of the registered trade-mark. Further, I am satisfied that sufficient facts and evidence have been produced to permit me to conclude that the trade-mark was being used in association with the registered wares “computer software” during the relevant period and that such use was in compliance with Section 4(1) of the Act. The invoices clearly show sales of the wares during the relevant period in the normal course of trade and the labels clearly show the manner the trade-mark was associated with the wares at the time of transfer in the normal course of trade.

However, I find the evidence is not as clear with respect to the use of the trade-mark in association with the registered services. Section 4(2) of the Act defines use with services 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.

In his affidavit Mr. Holland submits that the services are provided through the use of manual and user documentation in conjunction with either site visits or telephone help line. As the copies of the Software User Documentation and the User Guide enclosed as exhibit C display the trade-mark and as the User Guide clearly bears a telephone number for technical support services then as the invoices show that the software was sold or licensed during the relevant period, I am prepared to conclude that software support services were advertised by way of the User Guide and that, on a balance of probability, were also performed during the relevant period.

Consequently I conclude that the trade-mark was used in the advertisement of “software support services” and further that such services were performed or available to be performed during the relevant period. I also am prepared to conclude that the trade-mark was used in association with “software maintenance services” during the relevant period. In this regard, the invoice dated 4/28/97 displays the trade-mark in association with the upgrade of the software. In my view, the “upgrading of the software” would probably fall under “software maintenance services” and consequently I conclude that the display of the trade-mark on the invoice is use of the trade-mark in the performance of such services.

Concerning the services “software instruction and orientation services”, I note that Exhibit A refers to “on-line help” being available on the diskette, the on-line help being defined as a comprehensive user manual of instructions on how to use the software. In my view, such services would appear to be covered by the broad category “software instructions and orientation services”. As sales of the software were made in Canada, I think it is reasonable to infer that the registrant’s customers would have viewed and used the “on-line help” offered in association with the trade-mark.

Concerning the remaining services namely “carrying on the business of sale or license of computer programs and supporting materials” such services would appear to be performed under the registrant’s business name Alliance Technologies Inc. rather than under the present trade-mark. Consequently, I conclude that based on the evidence furnished, I cannot conclude to use of the trade-mark in association with such services. Consequently the services namely “carrying on the business of sale or license of computer programs and supporting materials” ought to be deleted from the trade-mark registration.

Although I have concluded that all of the other registered services ought to be maintained, I would remark here that the evidence furnished to show use with such services was barely sufficient. In my view, it would have been easy for Mr. Holland to have been more specific and to have provided more details concerning the use of the trade-mark with such services.

Registration No. TMA 442,030 will be amended by deleting the services “carrying on the business of sale or license of computer programs and supporting materials” from the statement of services of the registration, in compliance with the provisions of Section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 30th DAY OF November, 1999.

D. Savard
Senior Hearing Officer
Section 45