



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

Citation: 2015 TMOB 185
Date of Decision: 2015-10-19

IN THE MATTER OF A SECTION 45 PROCEEDING

Ridout & Maybee LLP

Requesting Party

and

Residential Income Fund L.P.

Registered Owner

**TMA627,628 for MAÎTRE VENDEUR &
Design**

Registration

[1] At the request of Ridout & Maybee LLP (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 February 26, 2014 to Residential Income Fund L.P. (the Owner), the registered owner of registration No. TMA627,628 for the trade-mark MAÎTRE VENDEUR & Design (the Mark), shown below:



[2] The Mark is registered for use in association with the following services: “Real estate services, namely, real estate brokerage services, real estate agency services, advising with respect to real estate purchase and sale, and providing an incentive and awards program to real estate professionals”.

[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 use since that date. In this case, the relevant period for showing use is between February 26, 2011 and February 26, 2014.

[4] The relevant definition of “use” in association with 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 section 45 proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD) at 480], 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 a trade-mark on 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)].

[7] In response to the Registrar’s notice, the Owner furnished the affidavit of Philip Soper, sworn on May 22, 2014 in Toronto, Ontario. Both parties filed written representations and were represented at an oral hearing.

The Owner’s Evidence

[8] In his affidavit, Mr. Soper identifies himself as the President of Residential Income Fund General Partner Limited, the general partner of the Owner. He attests that the partnership – through its partners and licensees – provides the registered real estate services. Mr. Soper explains that such real estate services are provided to the public through individual real estate agents and brokers that are employed by franchisees of the partnership, operating under license and authorized to exhibit the Owner’s trade-marks. A sample copy of the licensing agreement, entitled “Royal LePage Independent Agency Agreement”, is attached as Exhibit A to his affidavit. Mr. Soper confirms that this agreement provides that the Owner has control over the services offered by the Owner’s licensees.

[9] With respect to the registered “incentive and awards” services, Mr. Soper states that the Mark “is one of a number of trade marks used by the partnership to promote its real estate services through recognition of the achievements of individual real estate agents and brokers in providing these services.” He attests that the Mark has “been awarded continuously” since 1985 and that agents and brokers who meet certain predefined sales criteria are publicly recognized by the partnership “by the award of the title MAÎTRE VENDEUR” and are given “the right to publish the trade mark in their promotions.”

[10] Mr. Soper states that agents and brokers ordinarily maintain personal websites to promote their services and their properties available for sale and, further, that awards often appear on the websites of those who receive them.

[11] He also attests that recipients of the Owner’s awards are authorized to reproduce such awards on their business cards and in other promotional materials and that recipients “frequently do so”. However, Mr. Soper provides no exhibits in support of this assertion.

[12] The only evidence of actual display of the Mark is in the form of printouts from the websites of two individuals that Mr. Soper attests are employed by licensees of the Owner.

[13] Exhibit B is a printout from *www.suzannecharpentier.com*, which Mr. Soper identifies as the website of real estate agent Suzanne Charpentier. The website displays a series of links that appear to be related to real estate services, including the following: “Accueil”, “Ma région”,

“Propriétés”, “Info”, and “Liens”. The Mark is displayed in the middle of the exhibited webpage beneath the text “ATTESTATION DE MAÎTRE - VENDEUR”.

[14] Although the exhibit appears to have been printed after the relevant period, in May 2014, there is no indication on the webpage when Ms. Charpentier received the award or when she commenced displaying the Mark. The only references to dates are an indication that Ms. Charpentier chose to live in the Eastern Townships of Quebec in 2000 and that she has been a real estate agent for more than 11 years. However, Mr. Soper states in his affidavit that “I am advised by Ms. Charpentier and verily believe that her web site has exhibited the trade-mark since 2008.” As discussed further below, it is not clear whether Ms. Charpentier received the award in 2008 and simply continued to display reference to it on her website, or whether she also received the award at some point during the relevant period.

[15] Similarly, Exhibit C is a printout from *www.jeanyvespellerin.com*, which Mr. Soper identifies as the website of real estate agent Jean-Yves Pellerin. The exhibited webpage indicates that Mr. Pellerin has been a real estate agent since 1996 and displays a series of links relating to real estate services, including the following: “Accueil”, “Propriétés”, “Informations”, “Calculatrices”, “Liens”, and “Recherché”.

[16] As with Ms. Charpentier’s website, Exhibit C appears to have been printed in May 2014. However, in contrast to Ms. Charpentier’s website, the text on the webpage more specifically indicates that Mr. Pellerin was awarded the “maître vendeur” from 2006 to 2011. Furthermore, a variation of the Mark (with lower case lettering) appears four times at the bottom of the page along with the year it was apparently awarded (albeit only for the years 2006, 2007, 2008 and 2010). Also displayed are indications of awards for “PALME D’OR DU PRÉSIDENT GOLD AWARD” (dated 2005) and for “VENDEUR ÉMÉRITE” (dated 2009).

[17] Although Mr. Soper states that “I am advised by Mr. Pellerin and verily believe that his web site has exhibited the trade mark since 1996”, this statement appears to be inconsistent with the content of the exhibited webpage itself.

[18] In any event, Mr. Soper does not clearly attest to performance of the registered services by Ms. Charpentier or Mr. Pellerin during the relevant period, nor does he attest to access or use of the websites by customers during the relevant period.

Licensing

[19] In its representations, the Requesting Party submits that any evidenced use of the Mark by Ms. Charpentier and Mr. Pellerin does not enure to the Owner's benefit.

[20] In this respect, the Requesting Party argues that the Exhibit A agreement does not satisfy the requirements of section 50(1) of the Act because the agreement does not specifically reference the Mark. Similarly, it submits that since Ms. Charpentier and Mr. Pellerin are not themselves a licensee of the Owner, any use of the Mark by them does not satisfy the requirements of section 50(1).

[21] As stated by the Federal Court, 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 [*Empresa Cubana Del Tabaco Trading v Shapiro Cohen*, 2011 FC 102, 91 CPR (4th) 248 at paragraph 84].

[22] In this case, I am satisfied that the Owner's evidence does all three. Mr. Soper adequately explains the relationship between the Owner and Ms. Charpentier and Mr. Pellerin as each being employees of a licensee. He further provides that recipients of the subject award are given the right to publish the Mark in their promotions. Although the exhibited agreement does not refer specifically to the Mark, Mr. Soper confirms that such agreements set out the requisite control over the services offered by licensees of the Owner. For purposes of this proceeding, that is all that is required to satisfy section 50(1) of the Act. Notwithstanding the submissions of the Requesting Party, given that a clear statement of control is sufficient for purposes of a section 45 proceeding, the precise form of control or the extent to which control is actually exercised by the Owner is irrelevant to this proceeding. As such, I am satisfied that any demonstrated use of the Mark by the employees of a licensee would enure to the benefit of the Owner.

Hearsay

[23] The Requesting Party further submits that the statements in Mr. Soper's affidavit regarding the activities of the Owner's "alleged franchisees/licensees or the employees of such third parties" constitute hearsay. In this respect, it submits that there is no basis for Mr. Soper to have personal knowledge of the operations of the licensees, and of Ms. Charpentier and Mr. Pellerin in particular. Essentially, the Requesting Party submits that most of Mr. Soper's affidavit is inadmissible hearsay.

[24] The crux of the Requesting Party's representations on hearsay relate to Mr. Soper's aforementioned statements that he was "advised by Ms. Charpentier ... that her web site has exhibited the trade mark since the year 2008" and similarly that he was "advised by Mr. Pellerin ... that his web site has exhibited the trade mark since the year 1996".

[25] The Requesting Party submits that these statements are hearsay with respect to whether the Mark was displayed at all on the websites, including during the relevant period. The Owner, on the other hand, concedes that the statements are *per se* hearsay, but only with respect to when the websites were first published, and not to whether the websites displayed the Mark during the relevant period.

[26] In any event, given that Mr. Soper is an individual who operates the Owner's business, the Owner submits that his statements, including these two, are reliable.

[27] However, while the Owner's explanation is plausible with respect to Ms. Charpentier's website, I would note that the statement that Mr. Pellerin's website "has exhibited the trade-mark since the year 1996" appears to be inconsistent with the exhibited webpage itself. As noted above, while the Exhibit C webpage indicates that Mr. Pellerin has been a real estate agent since 1996, he does not appear to have been a recipient of the subject award until 2006.

[28] If Mr. Soper intended to state that he "verily believes" that Mr. Pellerin's website has been *published* since 1996 and displayed the Mark during the relevant period, that is simply not what he states in his affidavit.

[29] Of course, the evidence must be taken as a whole, and whether Mr. Soper intended to state that Mr. Pellerin's website displayed the Mark since 1996 or since 2006 is ultimately irrelevant. The exhibited webpage shows the variation of the Mark displayed along with the years 2006, 2007, 2008 and 2010. The reasonable inference is that the webpage was likely updated periodically between 2006 and 2011 to add references to Mr. Pellerin's awards.

[30] In any event, on the issue of hearsay, 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]. Furthermore, I accept that, given the nature of his position with the Owner, Mr. Soper would generally have knowledge of the matters to which he attests.

[31] As such, I am not prepared to find that the aforementioned statements or any portion of Mr. Soper's affidavit is *inadmissible* as hearsay. However, the fact that Mr. Soper relies, in some part, on such evidence to "show" use of the Mark simply speaks to the quality of the evidence furnished.

[32] In this respect, I note that Mr. Soper provides little to no details regarding any performance of the registered "incentive and awards program" services during the relevant period. Although he attests to the purpose and general nature of the Owner's awards – topics that he would be knowledgeable of given his position – he simply states that the subject award has been awarded "continuously" since 1985, without providing any details regarding its presentation during the relevant period.

[33] With respect to the registered real estate services, again, he provides no details regarding any performance of such services by the Owner's licensees or by Ms. Charpentier and Mr. Pellerin in particular. As the evidence leaves much to supposition and inference, the issue is not so much that portions of Mr. Soper's affidavit constitute hearsay, but that in the absence of further detail, as discussed below, it fails to show a *prima facie* case of use of the Mark during the relevant period with respect to the registered services.

Awards Services

[34] First, with respect to the registered “incentive and awards program” services, as noted above, Mr. Soper attests that the “Maître Vendeur and Design has been awarded continuously since 1985”. However, he provides no exhibits showing how the “Maître Vendeur” was awarded during the relevant period, or otherwise for that matter. Although not determinative, Mr. Soper does not explain the mechanics of the program, such as whether there is a presentation ceremony or whether the award is simply “automatic” upon certain sales levels. Even then, it is not clear how agents and brokers come to be aware of the award. For example, the Owner furnished no brochures, promotional materials or other documents given to individual brokers with respect to the “Maître Vendeur” award.

[35] In this case, the only evidence of display of the Mark is on the exhibited webpages. However, notwithstanding the Owner’s assertion, I do not consider display of the Mark in the manner shown to constitute display in association with the services “providing an incentive and awards program to real estate professionals”. At most, the websites reference real estate services, not an awards program.

[36] As well, it is not clear that Ms. Charpentier or Mr. Pellerin were actually awarded the Maître Vendeur award during the relevant period. The only date mentioned on the Exhibit B webpage is 2000, and the page does not contain any reference to dates during the relevant period.

[37] Curiously, even Mr. Pellerin’s website only references dates prior to the relevant period. While the Exhibit C webpage states in text that Mr. Pellerin earned the distinction of “maitre vendeur” in 2011, the variation of the Mark does not appear in association with that date, unlike for the years 2006, 2007, 2008 and 2010. If Mr. Pellerin’s website was active during the relevant period, it is not clear why the exhibited printout from 2014 would not reflect any updates through the relevant period.

[38] While not determinative in itself, it suggests that the reference to 2011 on the webpage was either in error or possibly that while the “Maître Vendeur” title was somehow being awarded during the relevant period, the Mark itself was no longer used in association with that title.

[39] In short, if the “Maître Vendeur” award was in fact awarded during the relevant period, it is not clear from the evidence. In any event, while the Mark may have appeared on the exhibited webpages, it was not clearly displayed in association with the registered “incentive and awards program” services.

[40] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with the services of “providing an incentive and awards program to real estate professionals” within the meaning of sections 4(2) and 45 of the Act. Furthermore, the Owner furnished no evidence of special circumstances excusing the absence of such use.

Real Estate Services

[41] With respect to the registered real estate services, Mr. Soper attests that the exhibited webpages “are typical of the manner in which the trade mark has been published online from the 1990’s to the present day”. However, it is curious that, as evidence of use of the Mark, the Owner chose to rely primarily on two printouts from websites that – while printed after the relevant period – do not reference the relevant period itself.

[42] The Owner argues that evidence of use after the notice date is relevant in order to establish continuity of use. It submits that use after the relevant period is significant when viewed in conjunction with use prior to or during the relevant period [citing *Boutique Progolfe Inc v Marks and Clerk* (1993) 54 CPR (3d) 451 (FCA)].

[43] However, while it is reasonable to conclude that the two agents performed real estate services *prior* to the relevant period, it is not apparent that they continued to perform such services *during* the relevant period.

[44] Even if it is reasonable to infer that Ms. Charpentier and Mr. Pellerin may have performed real estate services during the relevant period, it is not clear to what extent they may have done so through the websites in evidence.

[45] Indeed, the exhibited websites may constitute, at best, evidence of *advertisement* of real estate services in association with the Mark. However, even then, I consider the evidence as a

whole insufficient to demonstrate use of the Mark in association with the registered real estate services during the relevant period.

[46] In this respect, I note that in *Cornerstone Securities Canada Inc v Canada (Registrar of Trade Marks)* (1994), 58 CPR (3d) 417 (FCTD), the Court found that the trade-mark owner was unable to establish use of its trade-mark because the evidence did not satisfy the Court that advertisements were actually distributed to prospective customers. In particular, the Court noted that “there is no evidence that the advertisements were distributed to anyone ... Nor were any individuals identified as to whom the advertisements were sent” [at 420].

[47] Although webpages are not the same as printed advertisements – in that they cannot be tangibly distributed in the same way – they must still be “distributed to” or accessed by prospective customers in order to constitute advertising [see, for example, *Shift Law v Jefferies Group, Inc*, 2014 TMOB 277, CarswellNat 6223]. As such, for exhibited webpages to constitute advertisement of registered services, there must be some evidence of access to those webpages. A clear statement may be sufficient. In the alternative, there should be some evidence from which it can be reasonably inferred that customers accessed the webpages. Whether such evidence is then sufficient to demonstrate use of a trade-mark in association with particular services within the meaning of sections 4 and 45 of the Act will depend on the facts of each case.

[48] However, like a brochure that is printed but not distributed, the mere existence of a webpage is, in itself, insufficient to constitute advertising within the meaning of section 4(2) of the Act. Unlike, for example, with respect to a billboard next to a busy highway, a website does not presumptively receive traffic from the public.

[49] In this case, the mere existence of the exhibited webpages is not sufficient to establish that such webpages were accessed by prospective customers during the relevant period. Mr. Soper makes no statement regarding access to the webpages. Indeed, given his apparent reliance on the aforementioned “hearsay” with respect to the websites, it is questionable whether he could have made such an affirmative statement.

[50] Furthermore, the Owner furnished no evidence of access during the relevant period (or otherwise) and I am not prepared to make any inference favourable to the Owner that the

websites were so accessed during the relevant period. In this respect, I note and reiterate the following:

- Mr. Soper appears to rely on the aforementioned “hearsay” statements of Ms. Charpentier and Mr. Pellerin regarding the contents of the websites and the length of time they have existed.
- The websites were printed after the relevant period, but any dates appearing on the websites are from before the relevant period.
- Mr. Soper provides no explanation for the apparent lack of updates to the exhibited websites during the relevant period.
- Mr. Soper does not provide any statements or other evidence regarding website traffic for the exhibited websites.
- No sales volumes are presented, nor are any details furnished with respect to Ms. Charpentier’s and Mr. Pellerin’s customers during the relevant period, from which it could be inferred that the exhibited websites enjoyed at least some traffic by Canadian customers during the relevant period.
- Mr. Soper does not even assert that the websites were viewed by customers during the relevant period.

[51] In the absence of evidence indicating that the exhibited webpages were actually accessed by Canadians during the relevant period, I do not consider the exhibited webpages from Ms. Charpentier’s and Mr. Pellerin’s websites to constitute advertising of the registered real estate services.

[52] Even if the websites can be considered advertisement of real estate services (in that they were actually accessed by prospective customers), I again note that Mr. Soper and the exhibited webpages are curiously silent with respect to the agents’ activities during the relevant period. In the absence of evidence demonstrating that Ms. Charpentier and Mr. Pellerin were prepared to

perform the registered real estate services during the relevant period, any advertisement by them is insufficient for purposes of section 4(2) of the Act [per *Wenward, supra*].

[53] As such, I cannot conclude that the exhibited webpages evidence use of the Mark in association with the registered real estate services within the meaning of sections 4 and 45 of the Act.

[54] In view of the evidence as a whole, it would appear that while the Mark may have been an active part of the Owner's business prior to the relevant period, at some point it fell out of favour. Mr. Soper's affidavit lacks sufficient detail to make inferences favourable to the Owner. As such, I consider his statements that the Mark has been "continuously" awarded since 1985 and has been published online "from the 1990's" to be mere assertions of use (as a matter of law), rather than assertions of fact demonstrating use [see *Mantha & Associés/Associates v Central Transport, Inc* (1995), 64 CPR (3d) 354 (FCA)].

[55] In view of all of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered services within the meaning of sections 4(2) and 45 of the Act. Furthermore, the Owner has provided no evidence of special circumstances excusing the absence of such use.

Disposition

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

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

Hearing Date: 2015-09-09

Appearances

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