



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

**Citation: 2015 TMOB 163**  
**Date of Decision: 2015-09-23**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Imex Systems Inc.**

**Requesting Party**

**and**

**Pinnacle Webworx Inc.**

**Registered Owner**

**TMA710,727 for MY CITY**

**Registration**

[1] At the request of Imex Systems 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 October 22, 2013 to Pinnacle Webworx Inc. (the Owner), the registered owner of registration No. TMA710,727 for the trade-mark MY CITY (the Mark).

[2] The Mark is registered for use in association with the following services: “Operation of online databases for the listings of local businesses and organizations; advertising services, namely, placing advertisements for others”.

[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 October 22, 2010 and October 22, 2013.

[4] The relevant definition of “use” in association with services is set out in 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.

[5] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 2004 FC 448, 31 CPR (4th) 270 (FC)].

[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 Bill Vassilakopoulos, president of the Owner, sworn on April 18, 2014 in Toronto, Ontario. Neither party filed written representations; an oral hearing was not requested.

#### The Owner’s Evidence

[8] In his affidavit, Mr. Vassilakopoulos attests that the Owner has granted a license to MyCityExplorer Inc. (MCE), to use the Mark and that MCE advertised the registered services in association with the Mark in Canada during the relevant period. In this respect, Mr. Vassilakopoulos explains that he is also the president and majority shareholder of MCE. He provides a copy of the license agreement at Exhibit A to his affidavit and confirms that, pursuant to the license, the Owner has direct control of the character and quality of the services offered by MCE. As such, I am satisfied that any use of the Mark by MCE described below enures to the benefit of the Owner.

[9] Mr. Vassilakopoulos attests that MCE operates “online databases” for the listings of local businesses and organizations “across Canada and internationally”. These databases were in the form of various “MyCity” websites, such as *www.mycitykingston.com* and

*www.mycitytoronto.com*, which provided categorized links to local businesses. He asserts that MCE provided the registered services through such websites in association with the Mark.

[10] With respect to display of the Mark, Mr. Vassilakopoulos attests that “a stylized version” of the Mark – modified by the particular locality – appears on MCE’s MyCity websites. For example, this “MCE logo”, as it appears on the website *mycitykingston.com*, is shown below:



[11] In addition to the database-style listings on the MyCity websites, Mr. Vassilakopoulos attests that, since 2011, a company called Clearwater Marketing acts “as the exclusive sales agency with respect to the MY CITY websites”. He states that “MCE currently has over 1,000 advertising clients for their network of websites through Clearwater Marketing”. Based on the exhibits described below, this would appear to relate to the various banner advertisements appearing on MCE’s websites.

[12] With respect to the advertising of the websites themselves, Mr. Vassilakopoulos states that particular MCE websites were advertised in the Greater Toronto Area during the relevant period on highway billboards, on office signage, at an exposition, and via radio station commercials.

[13] In support, Mr. Vassilakopoulos provides the following exhibits attached to his affidavit:

- Exhibit B is a list of more than 120 domain names that Mr. Vassilakopoulos attests are registered by MCE. I note that all domain names listed begin with “mycity” as part of the url and many are with respect to a particular Canadian city, such as *MyCitytoronto.com* and *MyCitymontreal.com*. Cities outside of Canada are also represented, such as *MyCityabudhabi.com*, as are general areas of interest, such as *MyCityanddesigns.com*.
- Exhibit C is a printout of what appears to be the homepage of the *mycitykingston.com* website. The page includes a description of the website, indicating that it lists “16 Kingston businesses in over 360 business categories”. Beneath the description are several general categories, such as “Automotive”, “Home Interior” and “Legal Services”.

Each of these general categories has links to various subcategories of topics. Given Mr. Vassilakopolus's statement that MCE operates "online databases for the listings of local business and organizations", it would appear that these categories and subcategories link to local business listings.

The webpage also displays banner advertisements, both in the middle of the website and on the left side of the page in a coloured box. These banner advertisements appear to be unrelated to the local business listings. Also on the left side of the page is an option to "Change City".

The Kingston variant of the MCE logo, shown above, is displayed prominently near the top of the webpage.

- Exhibits D, E, and F are similar to Exhibit C, showing largely identical websites operated by MCE but with respect to Belleville, Yellowknife, and Montreal, respectively. Although Mr. Vassilakopolus attests that the exhibited printouts were obtained after the relevant period, he confirms that they are representative of the websites during the relevant period.
- Exhibit G consists of six photographs of billboards that display variations of the MCE logo. Mr. Vassilakopolus attests that these billboards were next to highways in the Toronto area in 2012 and 2013. One of the billboards displays the MCE logo with the text "*www.MyCityToronto.com* Find a Local Business".
- Exhibit H consists of eight photographs that Mr. Vassilakopolus attests were taken at an exposition held in Toronto in 2011. The photographs are of banners bearing a variation of the MCE logo with "Toronto" or "Mississauga" as the indicated locality. However, I note that ".com" does not appear on the banners and Mr. Vassilakopolus provides no further details regarding the context of the display of the banners. As such, it is not clear what services, if any, were being advertised in association with the MCE logo at this exposition.
- Exhibit I is a photograph of signage that Mr. Vassilakopolus attests was displayed on a building in Toronto during the relevant period. The exhibit and signage itself indicate that the building is MCE's head office. The signage bears a variation of the MCE logo,

with “INC.” appearing in place of a city name and “Head Office” appearing below the maple leaf. The signage is connected to another sign that displays the text “Search” and “Wherever you wanna go! Whatever you wanna know!” above “MyCity Toronto / Markham / Vaughan / Brampton / Mississauga.com”. Although indicative of various websites, the signage itself does not clearly advertise the services as registered, and Mr. Vassilakopulos does not attest to any activities that occurred at MCE’s head office during the relevant period.

- Exhibit J consists of a letter, dated April 1, 2014, from the owner of Clearwater Marketing. Mr. Vassilakopulos explains that the letter is a summary of the services provided to MCE by Clearwater. In particular, the letter indicates that “Clearwater Marketing operates as the exclusive sales agency for ‘My City’ for the past two and a half years promoting and selling a host of products and services for MyCityExplorer ... including ... Websites.” The letter references “advertising on the ‘My City’ Local Directory Platform, Domain Hosting, Promotional Banners, etc.” and includes a list of over 30 MyCity websites for which Clearwater has been managing advertising. Although the letter is *prima facie* hearsay, the letter is consistent with Mr. Vassilakopulos statements, and appears to indicate that Clearwater manages the aforementioned banner advertisements that appear on MCE’s MyCity websites.

### Analysis

[14] First, with respect to the banner advertising on MCE’s websites, it is not clear that the banner advertising is associated with the MCE logo appearing on the websites. As described above, the banner advertisements are separate from the database-style listings associated with the MCE logo. In the absence of written representations, I am not prepared to conclude that the average consumer would necessarily associate these types of banner advertisements with a trade-mark displayed on the website, as the MCE logo is displayed in this case. Just as a trade-mark displayed in one section of a department store may not necessarily be associated with all goods or services offered throughout that store, where and how a trade-mark is displayed on a website is relevant [see, for example, *McMillan LLP v SportsLine.com, Inc*, 2014 TMOB 51, 124 CPR

(4th) 226]. Despite the nature of the websites in this case, such banner advertisements appear to be separate from the content of the website and the categorized database advertising therein.

[15] Nevertheless, for the reasons below, I accept that MCE offered the registered services of “operation of online databases for the listings of local business and organizations” and “advertising services, namely, placing advertisements for others” in association with the Mark through its websites.

[16] With respect to the list of MCE’s various “MyCity” registered domains at Exhibit B, I note that the mere registration of a domain name does not constitute use of a trade-mark [see *Sun Media Corp v Montreal Sun (Journal Anglophone) Inc*, 2011 TMOB 15, CarswellNat 940]. However, Mr. Vassilakopulos also provides representative printouts from various “MyCity” websites at Exhibits C through F. These printouts show that the websites provide online databases in the form of categorized listings for local business. By their nature, such listings also constitute “advertisements for others”. The MCE logo is prominently displayed at the top of the webpages in association with such services.

[17] Furthermore, as noted above, one of the billboards shown at Exhibit G includes the text “*www.MyCityToronto.com* Find A Local Business” below the MCE logo; in my view, this constitutes advertisement of the websites and the registered services during the relevant period.

[18] Per *Wenward, supra*, advertising alone is insufficient to demonstrate use; at the very least, the services have to be available to be performed in Canada. In this case, Mr. Vassilakopulos did not provide details as to actual performance of the services, such as evidence of visitors to MCE’s websites, customer lists or invoices. Although it would have been preferable had the Owner provided evidence of actual Canadian users of the websites, the evidence as a whole must be considered. In this respect, there is sufficient evidence that MCE was carrying on an active business during the relevant period. This is indicated by the presence of active banner advertisements on the MCE websites, as well as advertisement of the websites themselves via billboards and other signage during the relevant period.

[19] In the absence of representations from the requesting party, given the scope of advertisement of the websites during the relevant period, it is reasonable to infer that at least

some of the “MyCity” websites advertising local businesses in Canada would have received some Canadian visitors during the relevant period. In any event, I am satisfied that the evidence shows that MCE advertised and was prepared to perform the registered services during the relevant period in Canada.

[20] With regards to whether the display of the MCE logo, as shown above, constitutes display of the Mark as registered, the question to be asked is whether the trade-mark was used in such a way that it did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade-marks) v Cie International pour l’informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see if, as a question of fact, the “dominant features” of the registered trade-mark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[21] In the present case, the dominant feature of the Mark is the words MY CITY; the MCE logo incorporates this dominant feature with added design elements such as a maple leaf.

[22] With respect to the additional text at the bottom of the MCE logo, such as “Kingston.com”, it is indicative of both the url of the website and the particular city. Such text is descriptive in nature and, as displayed, is less prominent and notably smaller than MY CITY. Furthermore, the nature of the “MyCity” network of websites and, in particular, the presence of a “Change City” button on the exhibited webpages themselves, demonstrates that this descriptive text is interchangeable. As such, in my view, it does not constitute a dominant feature of the MCE logo.

[23] Accordingly, I find that the dominant feature of the trade-mark as registered, namely the words MY CITY, has been maintained, the additional design elements and descriptive text being minor variations.

[24] In view of all of the foregoing, I am 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.

#### Disposition

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

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

Hearing Date: No Hearing Held

Agents of Record

Nathan Woodruff

For the Registered Owner

Oliver Hunt

For the Requesting Party