



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

Citation: 2015 TMOB 50
Date of Decision: 2015-03-23

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Borden Ladner Gervais LLP against
registration No. TMA605,393 for the trade-mark GDC
COMMUNITIES in the name of GDC Communities,
organized under the laws of California**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA605,393 for the trade-mark GDC COMMUNITIES, owned by GDC Communities, organized under the laws of California.

[2] The Mark is registered for use with the following services:

Planning, engineering, development, financing and management of real property, including sites for all forms of residential, commercial, industrial and recreational real estate;

Operation of commercial and residential properties;

Marketing of residential, commercial, industrial and recreational real property, for others, by means of print media, electronic media, distribution of flyers and brochures;

Construction of homes.

[3] For the reasons that follow, I conclude that the registration ought to be expunged.

The Proceeding

[4] On April 22, 2013, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to GDC Communities, organized under the laws of California (the Registrant). The notice was sent at the request of Borden Ladner Gervais LLP (the Requesting Party).

[5] The notice required the Registrant to furnish evidence showing that it had used the trade-mark GDC COMMUNITIES (the Mark) in Canada, at any time between April 22, 2010 and April 22, 2013, in association with each of the services specified in registration No. TMA605,393. If the Mark had not been so used, the Registrant was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[6] The relevant definition of use with respect to services is set out in section 4(2) of the Act which provides that 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. It has been held that section 4(2) contemplates that the services advertised in Canada be performed in Canada [*Porter v Don the Beachcomber* (1996), 48 CPR 280 (Ex Ct)]. However, it has also been held that section 4(2) of the Act may be complied with if it is shown that the trade-mark owner is offering and is prepared to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (RTM)].

[7] It is well established that the purpose and scope of section 45 of the Act is to provide a simply, summary, and expeditious procedure for clearing the register of “deadwood”. The criteria for establishing use are not demanding and an overabundance of evidence is not necessary. However, sufficient facts must be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the services listed in the registration during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)]. Furthermore, mere statements of use are insufficient to prove use [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[8] In response to the Registrar's notice, the Registrant provided the affidavit of James Hammermeister, sworn on July 18, 2013, together with Exhibits A through G.

[9] Neither party to the proceeding filed written submissions and an oral hearing was not conducted.

The Evidence

[10] In his affidavit, Mr. Hammermeister indicates that he is the President of the Registrant and its wholly owned subsidiary Genstar Development Company. He states that the Registrant actively markets its services, and those of its subsidiary under the Mark in Canada.

[11] Mr. Hammermeister states that the Mark was used extensively in Canada during the relevant period to advertise and promote the registered services. In this regard, he states that he frequently travelled to Canada to speak with current and prospective clients for the planning, development, financing and marketing of residential and commercial real property. This was done, he explains, through formal and informal meetings, at trade shows, and other industry events. He states that at these meetings, it was always his practice to provide the current or prospective client with one of his business cards.

[12] Mr. Hammermeister then provides at Exhibit B, a copy of his current business card, which he states prominently features the Mark and has not changed over the past three years. He also details several specific meetings with clients in Canada during the relevant period discussing various services, wherein he states that he specifically recalls providing the client with his business card.

[13] The business card includes Mr. Hammermeister's name and title, below which appears "Genstar Development Company" and "GDC Communities" listed on separate lines directly above corporate contact information. The words GENSTAR GDC appear in significantly larger bolded font to the left of the aforementioned text.

[14] Mr. Hammermeister further attests that his staff regularly conducts business and promotional e-mail communications with current and prospective clients, all of which prominently feature the Mark. In support, he provides a sample of two such e-mails at Exhibit C.

As in the business cards, I note that reference to GDC Communities appears together with Genstar Development Company directly above corporate contact information. In this instance, GDC appears at the bottom of the e-mail message, in the same larger size and style of font as the words GENSTAR GDC on the aforementioned business card.

[15] Mr. Hammermeister then states that the Registrant's website, *www.gdccommunities.com*, provides a comprehensive advertisement of the services offered by the Registrant. He states that the website is regularly accessed by Canadian IP addresses, and provides website traffic statistics in support (Exhibit E). He states that the services described on the website may be performed in both Canada and the United States, and that by clicking the Canadian flag icon appearing on the website, a user is immediately linked to substantive information about Canadian provision of the services. He attaches, at Exhibit D to his affidavit, a copy of the homepage for the Registrant's website.

[16] The homepage includes information about the Registrant's business and services under the title "Welcome to GDC Communities". Additional references to the Mark on the homepage include the following:

"GDC Communities can react quickly to opportunities to participate in new ventures"

"GDC Communities has a growing portfolio of real estate projects in the United States"

"For the third year in a row, GDC Communities' Dave Walters, Director of Business Development..."

"GDC Communities has provided an equity investment for Soledad Circle, a 20 acre site in..."

[17] Lastly, Mr. Hammermeister states that the Registrant's employees, including himself, regularly appear and market themselves at trade shows where existing and potential Canadian clients are present. As an example, he refers to such an event held in San Diego, California. He states that the Registrant has attended this event for the past five years, and that he knows from experience that several prospective Canadian clients would be in attendance. He further states that while at this trade show, the Registrant's employees spoke with several representatives from

Canadian entities while wearing branded name tags prominently featuring the Mark. He provides at Exhibits F and G respectively a copy of the website for the aforementioned trade-show, as well as a scanned copy of the aforementioned name tags.

Analysis and Reasons for Decision

[18] As a preliminary matter, I note that Exhibits F and G are irrelevant as they do not demonstrate use of the Mark in Canada. The trade show referred to did not take place in Canada, thus any services advertised or performed by the Registrant at this trade show were not done in Canada. Indeed, in order to constitute use of the Mark in Canada pursuant to section 4(2), the services must be performed without the Canadian customer having to leave Canada (*Saks & Co v Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD); *Bedwell v Mayflower* (1999), 2 CPR (4th) 543 (TMOB); and *Société Nationale des Chemins de Fer Français SNCF v Venice Simplon-Orient-Express, Inc* (2000), 9 CPR (4th) 443 (FCTD) aff'g 64 CPR (3d) 87].

[19] The remaining evidence then consists of the business card (Exhibit B), the e-mail communications (Exhibit C), the homepage of the Registrant's website (Exhibit D) and associated Canadian website traffic statistics (Exhibit E). From a review of this evidence, the issue that arises is whether the Mark is being used as a trade-mark or as a trade-name.

Is the Mark used as a Trade-mark or a Trade-name?

[20] Whether a word is used as a trade-mark or a trade-name is a question of fact. The presumption that a company name is a trade-name rather than a trade-mark is rebuttable. The question is whether the Registrant has shown use of the Mark in such a way that it is identifiable as a trade-mark and not merely as a corporate name or corporate identifier. Relevant factors to decide whether use is as a trade-mark or trade-name include whether the trade-mark stands apart from the corporate or trade-name and other corporate identifier information to the extent that the public would perceive such use as a trade-mark and not merely identification of a legal entity [see *Road Runner Trailer Manufacturing Ltd v Road Runner Trailer Co* (1984), 1 CPR (3d) 443 (FCTD); and by example, *Bereskin & Parr v Kleen-Flo Tumbler Industries Limited* (2010), CarswellNat 3503 (TMOB); *Laboratoire Théraxem v E-Z-EM Canada Inc* (2003), CarswellNat

6264 (TMOB); *Stikeman Elliot LLP v Haydock* (2008), CarswellNat 1168 (TMOB); and *Bereskin & Parr v Red Carpet Food Systems Inc* (2007), 64 CPR (4th) 234 (TMOB)].

[21] In the present case, GDC COMMUNITIES always appears either in association with an address and corporate contact information or as an identifier of a legal entity. In all instances, GDC COMMUNITIES is not presented in a manner that sets it apart from other corporate information or in such a manner that it would be perceived as anything other than a corporate name.

[22] In the business card provided as Exhibit B, GDC COMMUNITIES immediately precedes the Registrant's corporate contact information and it appears in the same size and font. It is not set apart from the corporate identifier information, unlike the words GENSTAR GDC which are in larger bolded font to the left of the corporate identifier information.

[23] Similarly, in the e-mails provided as Exhibit C, GDC COMMUNITIES appears directly above the corporate contact information in the same size and font as the Registrant's corporate identification and contact information and the corporate name of the Registrant's Canadian subsidiary. It is not set apart from the corporate information, unlike the word GDC which appears in larger bolded font beneath the corporate information.

[24] On the printout of the Registrant's website provided in Exhibit D, the context in which GDC COMMUNITIES is used suggests it is being used to identify the Registrant, and would not be perceived as a trade-mark. Furthermore, once again, GDC COMMUNITIES is not set apart from the surrounding text, but appears in the same size and font. In addition, the copyright notice at the bottom of the web page lists the copyright owner as GDC COMMUNITIES, immediately followed by the Registrant's address, suggesting that GDC COMMUNITIES is being used to identify the legal entity that owns the copyright and is not being used as a trade-mark. This is consistent with how GDC COMMUNITIES is used in the rest of the web page.

[25] In all cases in which GDC COMMUNITIES appears in the Registrant's evidence, it is not presented in a manner which sets it apart from other corporate information or in a manner such that it would be perceived by a consumer as a trade-mark.

[26] Accordingly, I find that the Registrant has failed to rebut the presumption that the use of the corporate name is as a trade-name rather than a trademark. Thus, I cannot conclude that the Registrant has demonstrated use of the Mark in association with the registered services [see *Road Runner, supra*]. Furthermore, the Hammermeister affidavit does not put forward special circumstances to justify the absence of use of the Mark in association with the registered services.

Disposition

[27] Having regard to the above, 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.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office