



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

**Citation: 2015 TMOB 105**  
**Date of Decision: 2015-06-08**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Gowling Lafleur Henderson LLP against  
registration No. TMA705,405 for the trade-mark  
CONNECTEDBROKER in the name of Canada Home  
Guide Inc.**

[1] At the request of Gowling Lafleur Henderson LLP (the Requesting Party), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on June 19, 2013 to Canada Home Guide Inc. (Canada Home), the registered owner of registration No. TMA705,405 for the trade-mark CONNECTEDBROKER (the Mark).

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

Providing web-based brand and information management and promotional services for third parties in the field of real estate within integrated communications networks; providing office management systems in the field of real estate, namely systems to manage real estate documentation, service provider lead referrals, utility hook-ups, sales contacts, marketing campaigns and remote multiple listing searches via local or global communications networks; website management services.  
(the Services)

[3] The section 45 notice required Canada Home to show whether the Mark had been used in Canada in association with each of the Services at any time between June 19, 2010 and June 19, 2013 (the Relevant Period). If the Mark had not been so used, Canada Home was required to provide the date when it was last in use and the reason for the absence of such use since that date.

[4] The relevant definition of “use” in the present case 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 has been held that where the trade-mark owner is offering and prepared to perform the services in Canada, use of the trade-mark on advertising of those services meets the requirements of section 4(2) of the Act [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (RTM)].

[6] 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 a section 45 proceeding is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], 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 goods or services specified in the registration during the relevant period.

[7] In response to the Registrar’s notice, an affidavit of Gary Richard Taylor, current President of Transcona Media Network Inc. (Transcona) and original founder and CEO of Canada Home was submitted.

[8] Only the Requesting Party filed written submissions. No hearing was held.

[9] In its written submissions the Requesting Party rightly notes that Mr. Taylor refers in his affidavit to the acquisition of Canada Home by 6995900 Canada Inc. (6995900) in July 2008 and the subsequent acquisition of 6995900 by Transcona in February 2012. However, the registered owner currently on record in the Canadian Intellectual Property Office (the Office) remains Canada Home. I shall therefore deal with this issue first.

Who may file evidence in the present proceeding?

[10] As provided for in section III.2 of the practice notice *Practice in Section 45 Proceedings*, the evidence filed in response to a section 45 notice must show use of the registered trade-mark by the registered owner, a licensee thereof, or an assignee entitled to be recorded as registered owner.

[11] In the present case, following the receipt of the section 45 notice, Canada Home's former trade-marks agent and representative for service of record advised the Registrar that they no longer represented the registered owner, Canada Home, with respect to the subject registration, and asked the Registrar to send all future correspondence "to the attention of the new representative for service, Mr. Gary Taylor, at 103 – 1600 West 6<sup>th</sup> Avenue [in] Vancouver, British Columbia [...]".

[12] The next correspondence received by the Registrar was the affidavit of Mr. Taylor, sworn September 18, 2013. No covering letter accompanied that affidavit.

[13] I am reproducing below the relevant passages of Mr. Taylor's affidavit dealing with the issue of ownership of the Mark:

I, Gary Richard Taylor, President of [Transcona], of the city of Vancouver in the province of British Columbia, MAKE OATH AND SAY THAT:

1. I am the founder and CEO of [Canada Home] which originally applied for the [Mark] on February 15<sup>th</sup>, 2005 which was registered by the [Office] on January 21<sup>st</sup>, 2008.

[...]

3. The assets, including trademarks, owned by [Canada Home] were acquired by [6995900] in July 2008. I am the founder and CEO of [6995900] [...].

[...]

6. The assets of [6995900] were acquired by [Transcona] in February 2012. I am the founder and CEO of both [6995900] and [Transcona]. [...]

[14] Thus, according to Mr. Taylor's affidavit, Canada Home was no longer the owner of the Mark at the time the present section 45 proceeding was commenced. Neither was Canada Home the owner of the Mark during the Relevant Period.

[15] The fact that as of today, the transfer of ownership has still not been recorded despite the lengthy passage of time since Transcona's acquisition of the Mark, is not by itself fatal in the present case for the following reasons.

[16] There is no obligation to record a change in ownership on the trade-mark register and the Court has held that an assignment may be valid even if not registered [*Sim & McBurney v Buttino Investments* (1996), 66 CPR (3d) 77 (FCTD)]. In addition, there is no requirement that an assignment be in writing [*Macleod Dixon LLP v Kayden Instruments Inc* (2009), 78 CPR (4th) 297 (TMOB)].

[17] An unrecorded successor-in-title may successfully respond to a section 45 notice if it satisfies the Registrar that it was the owner of the registered mark during the relevant time period. I see nothing in the evidence that on its face calls into question Mr. Taylor's sworn statements with respect to the ownership of the Mark.

[18] In any event, section 45 proceedings are not intended to provide an alternative to the usual *inter parte* attack on a trade-mark [*United Grain Growers v Lang Michener* (2001), 12 CPR (4th) 89 (FCA)]. Furthermore, the validity of the registration is not in dispute in section 45 proceedings. As such, issues of ownership are more properly dealt with by way of application to the Federal Court under section 57 of the Act [*Riches McKenzie & Hebert LLP v Set Products, Inc* 2014 TMOB 246 (CanLII)].

#### The use of the Mark shown by the Taylor affidavit

[19] I note that in paragraph 9 of his affidavit, Mr. Taylor states that his affidavit and the exhibits attached thereto "represent *highly confidential information* to our company and we request that this information not be shared with any party outside of the [Office] and [the Requesting Party]."

[20] However, under section 29 of the Act, the registers and the documents on which the entries therein are based shall be open to public inspection at the Office of the Registrar. Accordingly, the Registrar considers that it has no authority to keep the Taylor affidavit and accompanying exhibits confidential.

[21] Now, turning to the evidence submitted to demonstrate use of the Mark in association with each of the Services, Mr. Taylor states that from January 2005 to July 2008 (that is well before the Relevant Period), Canada Home “promoted [the Mark] as an online real estate broker advertising profile and media management system within the company’s website *www.CanadaHomeGuide.ca*”.

[22] More particularly, Mr. Taylor states that “ConnectedBroker™ is one of a suite of online brands that Canada Home marketed to advertisers in the real estate industry, including:

- a. Real Estate Brokers: ConnectedBroker™
- b. Real Estate Agents: ConnectedAgent™
- c. New Home Builders: ConnectedBuilder™
- d. Landlords: ConnectedLandlord™
- e. Home Improvement: ConnectedAdvertiser™”.

[23] As indicated above, Mr. Taylor states that the assets, including trade-marks, of Canada Home, were acquired by 6995900 in July 2008. Mr. Taylor states that in March 2010, for the purpose of enhancing the promotion of the Mark as an online “channel”, 6995900 re-branded *www.CanadaHomeGuide.ca*. and re-launched it as *www.CanadaHomeGuide.tv*.

[24] As indicated above, Mr. Taylor states that the assets of 6995900 were acquired by Transcona in February 2012. He states that Transcona “is currently developing and preparing to launch (within the next few months) a comprehensive online shopping network that incorporates each of the ‘Connected’ brands and trademarks listed [above]”.

[25] Mr. Taylor states that “our investment in the creation of web-based products, outbound telesales, marketing strategies, securing trademarks and web domains related to the ‘Connected’ brand concept demonstrate that we have a significant interest in protecting the

[Mark].” He adds that the Mark “has critical value to our company’s family of trademarks and to the sales and marketing strategies that our company will be targeting toward real estate brokers in 2014.”

[26] In support of his above-noted assertions of use of the Mark, Mr. Taylor attaches the following exhibits:

- Exhibit B: copy of a “CanadaHomeGuide HomeLife” PowerPoint presentation;
- Exhibit C: copy of a two-page document entitled “CanadaHomeGuide.tv (CHGTV) Features & Benefits”;
- Exhibit D: copies of emails sent to “target customers”;
- Exhibit E: copies of invoices; and
- Exhibit F: a printout from the website *https://dcc.godaddy.com* showing the creation and expiry dates of November 14, 2003 and November 14, 2013 respectively, for the domain name *connectedbroker.com*.

[27] Mr. Taylor states that the “CanadaHomeGuide HomeLife” PowerPoint presentation referenced in Exhibit B and the “CanadaHomeGuide.tv (CHGTV) Features & Benefits” document referenced in Exhibit C provide examples of how the Mark was promoted to real estate brokers in 2010 via outbound telesales. He further states that Exhibits B and C were emailed as file attachments to the examples of emails filed under Exhibit D.

[28] Upon review of these exhibits, I note that:

- i. the only reference to the Mark in the PowerPoint presentation under Exhibit B is found at page 5 and reads as follows: “Register Your ConnectedBroker Channels”. However, no reference to each of the Services associated with the Mark is made;
- ii. the two-page document filed under Exhibit C describes the website *www.CanadaHomeGuide.tv* as follows:

[...] a social network for the housing industry to empower real estate brokers and agents to manage their social media strategies by combining features from the top social networks into our ConnectedBroker™ and ConnectedAgent™ media management system which enables members to become publishers and broadcasters in the management of their brand and property promotion strategies.

The features and benefits of “CHGTV’s ConnectedBroker™ and ConnectedAgent™ media management system” are in turn described as follows:

- *Automatic MLS Data Import*  
Direct import of real estate listings to every member’s channel and CHGTV’s searchable database
- *News Publisher*  
Status updates – enables members to publish 140 character “Twitter-style” updates  
Blog – enables agents to members a personal or company blog  
News releases – enables members to promote press-worthy announcements
- *Video Broadcaster*  
Video channel – enables members to manage a “YouTube-style” video channel for all of their personal and property videos
- *Professional & Customer Networker*  
Professional networking – enables members to build a “Linkedin-style” professional network  
Customer networking – enables members to build their “Facebook-style” fan/referral network
- *Social Media Syndicator*  
Enables members and viewers to publish all property and information content to social media networks like Facebook, Twitter and YouTube
- *Instant Messenger (Coming Fall 2010)*  
Enables members to interact with users who visit their channel using instant messaging
- *Mobile Manager (Coming Fall 2010)*  
Enables members to update personal and property listing status and promote these updates to the market real-time (updates include open houses, price reductions, sold status)
- *Market Researcher (Coming Fall 2010)*  
Enables members to use polling tools to collect market research information from people who visit their channel.

There is no evidence elsewhere in the Taylor affidavit that the features and benefits bearing the mention *Coming Fall 2010* did become available to be performed during the Relevant Period.

As for the remaining features and benefits, it is unclear to what extent they amount to each of the Services. I will return to this point later;

- iii. only one of the emails contained in Exhibit D falls within the Relevant Period, namely a July 8, 2010 email sent by Mr. Taylor as President and CEO CanadaHomeGuide.tv to Jonathan Cooper with the Exhibit C attachment. I will return to that exhibit later;
- iv. the sample invoices contained in Exhibit E all pre-date the Relevant Period and the majority do not reference the Mark. As noted by the Requesting Party, the only overlapping time frame is contained in Contract no. SR451 dated July 27, 2009, which indicates an end date of July 26, 2010 for a CONNECTEDAGENT webpage and a CONNECTEDADVERTISER webpage but does not reference the Mark; and
- v. there is no evidence as to the availability or appearance of the website referred to in Exhibit F to Canadians during the Relevant Period. As noted by the Requesting Party, it is impossible to infer use of the Mark on such website during the Relevant Period.

[29] Thus, the crux of the relevant evidence resides in the July 8, 2010 email sent by Mr. Taylor as President and CEO CanadaHomeGuide.tv to Jonathan Cooper with the Exhibit C attachment.

[30] I shall indicate at this point of my analysis that although the relationship between CHGTV and 6995900 (or Transcona, as the case may be) is not explained, I am prepared to conclude that use of the Mark by CHGTV amounted to use by 6995900 (or Transcona, as the case may be) pursuant to section 50 of the Act since Mr. Taylor is identified as the president and CEO of all these entities [*Petro-Canada v 2946661 Canada Inc* 1998 CanLII 9107 (FC)].



[31] The Requesting Party submits that evidence of a single email sent to one prospective customer within the Relevant Period does not establish the requisite *prima facie* use of the Mark in association with the Services.

[32] More particularly, the Requesting Party submits that there is nothing in the July 8, 2010 email or elsewhere to indicate that the registrant was prepared to perform the Services or did perform such Services for Jonathan Cooper or anyone else in Canada during the Relevant Period. It submits that the Taylor affidavit refers only to Jonathan Cooper of MacDonald Realty as a “target customer” but does not specify if he is a real estate broker, agent or even located in Canada.

[33] I disagree with the Requesting Party’s position.

[34] While the body of the July 8, 2010 email contains minimal correspondence, it must be read in conjunction with the Exhibit C attachment and the Taylor affidavit as a whole.

[35] Mr. Taylor expressly states in paragraph 3 of his affidavit that the examples of emails filed under Exhibit D were sent to real estate *brokers* (my emphasis). It can be inferred from the Taylor affidavit as a whole, especially in view of Exhibit A that describes CHGTV’s markets to include local, regional, *provincial* (my emphasis) and national markets, that these real estate brokers are located in Canada.

[36] Reverting to Exhibit C, it is clear that the services described therein were available to be performed at the time of sending the July 8, 2010 email, except for the ones highlighted above bearing the mention *Coming Fall 2010*. As indicated above, it is sufficient for the Mark to be displayed in the advertising of such services for there to be use pursuant to section 4(2) of the Act.

[37] So what were the services available to be performed back in July 2010 according to the Exhibit C attachment?

[38] As indicated above, it is unclear to what extent the remaining features and benefits amount to each of the Services.

[39] Notably, nowhere does Mr. Taylor expressly state in his affidavit that the Mark was used during the Relevant Period in association with each of the Services listed in the subject registration.

[40] That said, I find that it may reasonably be understood from Exhibit C that the services described in the subject registration as: “Providing web-based brand and information management and promotional services for third parties in the field of real estate within integrated communications networks” were available to be performed at the time of sending the July 8, 2010 email.

[41] However, in the absence of any representations clarifying the nexus between the services described in Exhibit C and each of the remaining registered services, I find the evidence is ambiguous as to whether use of the Mark has been shown in association with such services during the Relevant Period; an ambiguity that I must interpret against the interests of the registrant [*Aerosol Fillers, supra*].

[42] I wish to add that the Taylor affidavit does not provide any reasons for or special circumstances excusing the non-use of the Mark in association with such remaining services during the Relevant Period. As noted by the Requesting Party, the Taylor affidavit merely mentions a future launch of a “comprehensive online network” that will incorporate the Mark as well as the affiant’s general commitment and interest in promoting and protecting the Mark and related marks in 2014. However, a stated intention to resume use of a trade-mark in the near future does not amount to a special circumstance for not using such mark [*Scott Paper Ltd v Smart & Biggar* (2008), 65 CPR (4th) 303 (FCA)].

[43] Furthermore, as noted by the Requesting Party, although Mr. Taylor may consider the Mark to be part of its company’s family of trade-marks, use of or investment in allegedly related marks or a brand family should have no bearing on the registration status of the Mark at issue.

#### Decision

[44] Pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the following services from the registration: providing office

management systems in the field of real estate, namely systems to manage real estate documentation, service provider lead referrals, utility hook-ups, sales contacts, marketing campaigns and remote multiple listing searches via local or global communications networks; website management services.

[45] The amended statement of services will accordingly reads as follows:

Providing web-based brand and information management and promotional services for third parties in the field of real estate within integrated communications networks.

The whole in accordance with the provisions of section 45(5) of the Act.

---

Annie Robitaille  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office