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C I P O

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

Citation: 2017 TMOB 135

Date of Decision: 2017-09-29

IN THE MATTER OF A SECTION 45 PROCEEDING

Gowling Lafleur Henderson LLP

Requesting Party

and

**Institut Européen des Normes de
Télécommunication**

Registered Owner

TMA778,074 for LTE

Registration

[1] At the request of Gowling Lafleur Henderson 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 April 28 2015, to Institut Européen des Normes de Télécommunication (the Owner), the registered owner of registration No. TMA778,074 for the trade-mark LTE (the Mark).

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

Appareils et instruments scientifiques, nommément appareils et instruments pour l'enseignement scientifique et de laboratoire, appareils et instruments optiques, nommément, transmetteurs de signaux infra rouges et lasers, appareils et instruments de mesurage, nommément, récepteurs pour recevoir, analyser et mesurer, signaux de fréquence radio et de puissance; appareils pour l'enregistrement, la transmission, la reproduction de messages, spécifiquement le son et l'image; appareils de radiodiffusion; appareils de télévision, nommément transmetteurs de signaux digital et analogique, récepteur et convertisseurs, radio, télévision; appareils et instruments de télécommunications, nommément, émetteurs de télévision et de téléphone, récepteurs et

serveurs; appareils et instruments électriques, notamment, émetteurs radio et de télécommunications, d'alimentation électrique; téléphones mobiles; appareils de communication, ou instruments, pour la transmission, et/ou le stockage et/ou la reproduction de texte, son, images et données, notamment, dispositifs de communications mobiles normalisés et équipements pour dispositifs de communications mobiles normalisés; récepteurs de données mobiles, notamment, dispositifs de communications mobiles normalisés et équipements pour dispositifs de communications mobiles normalisés; logiciels permettant la transmission de photographies vers des téléphones mobiles; matériel informatique et de périphérique de traitement et de transmission de données et d'informations; supports d'informations impressionnés ou non, notamment programmes d'ordinateurs; logiciels et progiciels sur tous supports matériels, notamment, logiciels informatiques, notamment logiciels utilisés pour l'opération de télécommunication mobiles cellulaires, systèmes de communication de données, et gestion de bases de données; supports vierges de données optiques, supports vierges de données magnétiques; supports électroniques et magnétiques codés avec des programmes informatiques pour l'exploitation des technologies de télécommunication mobile cellulaire et des systèmes de communication de données et données, notamment, documents électroniques dans le domaine des télécommunications; puces à circuits intégrés de mémoire électroniques; cartes à puce pour systèmes de téléphonie mobile; cartes à mémoire; supports et systèmes de télécommunications, notamment, câbles de télécommunication et commutateurs; bandes, disques, câbles et cartes encodées avec des programmes informatiques et/ou des données; Documentation imprimée liée aux normes techniques dans le domaine des télécommunications, de la technologie de l'information, de la diffusion audio et vidéo, et leur combinaison; documentation imprimée, y compris rapports techniques, livres, revues, magazines, manuels, journaux et photographies; cahiers techniques; articles pour reliure, notamment, reliures; photographies; matériel imprimé d'instruction et d'enseignement dans le domaine des télécommunications.

[3] The Mark is also registered in association with the following services:

(1) Conseils, informations et renseignements d'affaires, notamment, aide aux entreprises industrielles ou commerciales dans la conduite de leurs affaires; étude et élaboration des normes techniques nécessaires à la réalisation d'un marché européen unifié des télécommunications; études statistiques; comptabilité; reproduction et distribution de documents, notamment, distribution de prospectus, stockage et reproduction des textes, images et données; fourniture d'accès à des bases de données; compilation des données et systématisation d'une base de données dans le domaine des télécommunications; services de communications et de télécommunications, notamment, transmission de diffusions sur le Web et des services téléphoniques sans fil, services liés aux télécommunications et à la transmission de l'information et de transmission de données de communication, notamment, location d'équipement de télécommunication; communications radiophoniques, téléphoniques; transmission, stockage et reproduction de texte, images et données; services de communications de données par courrier électronique; transmission d'informations par télégraphe, téléphone, téléphone mobile, télex, télécopie, services postaux et câbles; communications par radio portable; conférences et communications vidéo; services d'envoi et de livraison de messages, notamment, services d'envoi et de réception de messages; services impliquant la communication par téléphone et

télégramme, nommément, communications par téléphone et télégramme; transmission de données par des appareils de communication contrôlés par ordinateurs ou appareils de traitement de l'information; service de communications Internet et services de diffusion radio et télévisée; recueil et systématisation de données dans un fichier central; services d'imprimerie; services de planification et publication de normes techniques dans le domaine des télécommunications; étude, élaboration et distribution de normes techniques dans le domaine des télécommunications, dans le domaine commun aux télécommunications et aux technologies de l'information, dans le domaine commun aux télécommunications et à la radiodiffusion visuelle et sonore, ou leur combinaison; conseils et consultations en matière de télécommunications; travaux d'ingénieurs; programmation pour ordinateurs; services de conseils techniques et représentations professionnelles dans le domaine des télécommunications et des technologies de l'information; service de création et d'approbation (validation et certification) de normes techniques dans le domaine des télécommunications, dans le domaine commun aux télécommunications et aux technologies de l'information, dans le domaine commun aux télécommunications et à la radiodiffusion visuelle et sonore, ou leur combinaison; conseils professionnels liés à la préparation de plans (non liés à la direction des affaires), nommément, conception et mise en œuvre de sites Web pour autrui, services de récupération de données, conception de logiciels informatiques pour autrui; conseils en matière de logiciels, matériel informatique, utilisation de logiciels et de matériel informatique, test de matériel et/ou appareils, nommément, dispositifs de communications mobiles normalisés et équipements pour dispositifs de communications mobiles normalisés; préparation, distribution et conseils (ingénierie) relatifs aux normes techniques dans le domaine des télécommunications, dans le domaine commun aux télécommunications et aux technologies de l'information, dans le domaine commun aux télécommunications et à la radiodiffusion visuelle et sonore, ou leur combinaison; conseil et assistance dans le domaine des télécommunications, dans le domaine commun aux télécommunications et aux technologies de l'information, dans le domaine commun aux télécommunications et à la radiodiffusion visuelle et sonore, ou leur combinaison.

[4] 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 goods and 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 the trade-mark was last used and the reason for the absence of such use since that date. In this case, the relevant period for showing use is April 28, 2012 to April 28, 2015.

[5] The relevant definitions of “use” are set out in sections 4(1) and 4(2) of the Act as follows:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is

in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

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.

[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 section 45 proceedings 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 specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[7] 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 the advertised services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[8] In response to the Registrar's notice, the Owner furnished the affidavit Eric Kerson, a student-at-law student employed by the Owner's agent of record, sworn on November 27, 2015. Only the Owner filed written representations; an oral hearing was not requested.

THE OWNER'S EVIDENCE

[9] Mr. Kerson states that, in his capacity as a student-at-law, he "occasionally assist[s] senior intellectual property counsel with the coordination of domestic and foreign trademark matters for various domestic and foreign clients". He explains that, for the present proceeding, he reviewed "the instant trademark application, the details of the present s.45 cancellation proceeding and a variety of materials provided by the Owner in support of the present s.45 cancellation proceeding". As such, he states that he has "knowledge of all matters deposited to" in his affidavit.

[10] In his affidavit, Mr. Kerson provides the results of various Internet searches he conducted “on the instructions of a senior intellectual property practitioner” at his firm. In this respect, he attaches the following exhibits to his affidavit.

[11] Exhibits A and B consist of printouts from the Canadian Intellectual Property Office’s “trademarks search portal”, setting out the particulars of the trade-mark registration at issue and of a third-party trade-mark application that is opposed by the Owner.

[12] Exhibits C, D and E consist of webpages from the Owner’s website, which Mr. Kerson states he found by conducting a Google search on the Owner’s name. As noted by Mr. Kerson, the webpages indicate that the Owner is a not-for-profit organization founded in 1988, with “more than 800 member organizations worldwide”, including “the world’s leading companies and innovative R&D organizations”. The webpages further indicate that the Owner “produces globally-applicable standards for Information and Communications Technologies (ICT), including fixed, mobile, radio, converged, broadcast and Internet technologies”.

[13] Exhibit F is a printout from the Owner’s website describing the “Third Generation Partnership Project” (3GPP). This webpage indicates that 3GPP comprises seven regional Standards Development Organizations—including the Owner—as well as market associations and “several hundred companies”. As noted by Mr. Kerson, the webpage indicates that 3GPP “was established in 1998 to develop specifications for advanced mobile communications”, specifically “globally applicable reports and specifications for a third generation mobile system based on evolved Global System For Mobile communication (GSM™) core networks and the radio access technologies that they support”.

[14] Exhibits G through K are printouts from the 3GPP website; Mr. Kerson states that he accessed this site through a hyperlink on the Owner’s website. As noted by Mr. Kerson, the webpage at Exhibit I indicates that, in 2008, 3GPP introduced specifications for LTE, which stands for “Long Term Evolution”. I note the webpage indicates that LTE is a new “access network” that is “simply a network of base stations, evolved NodeB (eNB), generating a flat architecture”.

[15] As also noted by Mr. Kerson, the webpage at Exhibit J indicates that the Owner registered LTE as a trade-mark “for the benefit of the 3GPP Partners”, who have agreed that manufacturers and service providers may display the Mark on their equipment and documentation to declare that their products are based on 3GPP’s specifications. The webpage further indicates that any use of the Mark is subject the Owner’s approval and “may be monitored by [the Owner] or on its behalf”. Mr. Kerson also notes a statement on the webpage that any “misuse of [the Mark] detected by a member of the 3GPP community should be brought to the attention of the trademark holder”.

[16] Mr. Kerson asserts that the Mark must be used “under the care and control of the Owner”; however, I note that the exhibited webpages do not contain such an explicit statement in respect of the character or quality of goods and services to be provided in association with the Mark. Rather, the webpage at Exhibit J states that permission to use the Mark “does not involve or imply any certification by [the Owner] or the 3GPP community that the products or services of the manufacturers or service providers actually comply with the 3GPP specifications. It is intended simply and only to provide a basis of reference for users, network operators and other manufacturers and service providers.”

[17] The printout at Exhibit K is titled “Guidance for the use of the LTE logo” (LTE Logo Use Guide). It repeats the information provided at Exhibit J and then illustrates how to display the Mark in design form on different backgrounds “to make sure that [the logo] remains sufficiently prominent”. I note that this document does not address the character or quality of goods or services with which the Mark is to be associated.

[18] Exhibits L through V contain press releases and other promotional articles and webpages printed from several different websites. Mr. Kerson explains that he accessed the exhibited webpages by clicking on the hyperlinks in an e-mail attachment that was provided to him by “a senior practitioner” at his firm. In this respect, Mr. Kerson states, “Based on my understanding, these hyperlinks were compiled by the Owner and were provided by various 3GGP partners to the Owner and by the Owner’s marketing department in September 2015 as evidence of use of the LTE trademark in Canada pursuant to the guidelines provided at Exhibit ‘K’ above.”

[19] The specific articles and webpages attached to Mr. Kerson's affidavit in this respect are as follows:

- Exhibit L is a press release titled "Ericsson selected to build LTE network for Rogers", dated April 28, 2011, and retrieved from the website at *www.ericsson.com*. As noted by Mr. Kerson, the article refers to LTE as "the next generation of mobile communication technology". I note the article refers to "Ericsson's leadership in LTE" and states that Ericsson has four LTE contracts with "leading operators" in North America.
- Exhibit M is another press release from the Ericsson website, titled "Canadian TELUS to offer advanced multimedia experience with Ericsson" and dated November 28, 2013. The article indicates that Ericsson "has signed a key contract with TELUS for the development and deployment of an IP Multimedia Subsystem (IMS), the foundation for communication services over LTE and other accesses." The article further states that implementation of the IMS technology will enable TELUS to offer "advanced, convergent services in voice, data and video calling over both wireline and wireless networks to customers across Canada". In particular, "Voice over LTE (VoLTE)" and "video calling over LTE" are mentioned as services that TELUS will be able to offer.
- Exhibit N is a third, undated article from the Ericsson website, retrieved on November 13, 2015. The article is titled "Rogers, Canada: Innovation takes the lead" and subtitled "Rogers first in Canada to upgrade its network to LTE with an Evolved Packet Core, introducing faster mobile broadband speeds". As noted by Mr. Kerson, the article indicates that the "introduction of LTE was carried out in partnership with Ericsson, who provided an end-to-end solution, including services". The article mentions that Rogers will be able to provide its customers with "mobile broadband services over the LTE network" and "voice services on LTE smartphones" and is "looking at VoLTE" as "the next stage in the development of its LTE network".
- Exhibit O is a news release titled "Bell first in North America to introduce Tri-band LTE Advanced, the fastest mobile network technology available", from the website at *www.bce.ca*. Dated August 13, 2015, the article announces that Bell "will launch Tri-band LTE-A" in four Canadian cities.

- Exhibit P is another news release from the BCE website, titled “Bell to launch new global 4G LTE MiFi by Novatel Wireless in Canada”. Dated May 19, 2015, the article announces that Novatel’s new mobile hotspot will launch with Bell Mobility on “Canada’s largest 4G LTE network”, specifying that “Bell 4G LTE service covers 91% of the Canadian population”.
- Exhibit Q is a third news release from the BCE website, titled “Bell acquires 2500 MHz spectrum to further accelerate mobile broadband” and dated May 12, 2015. As noted by Mr. Kerson, the article refers to “Bell’s ongoing roll out of 4G LTE (Fourth Generation Long Term Evolution) mobile services to Canadian consumers and business in urban and rural markets across the country”.
- Exhibit R is an undated article titled “Get on Canada’s largest LTE network. LTE Advanced, the world’s fastest mobile technology”, retrieved from the website at *network.bell.ca* on November 13, 2015. Although Mr. Kerson states that the article was published “approximately February 2015”, I note that the article itself references events that occurred six months later. The article indicates that Bell “launched LTE Advanced” in Canada in February 2015 and “deployed the next generation of LTE Advanced” in Canada in August 2015, and that “Bell’s LTE network now reaches over 31 million Canadians”. In addition, the webpage advertises various “LTE and LTE Advanced capable devices”, such as the “Samsung Note 5 LTE Advanced”, “Sony Xperia Z2 tablet LTE” and “HUA WEI LTE E8372 Hotspot Turbo Stick”. I note that the Mark is not displayed on the devices depicted on this webpage.
- Exhibit S is an article titled “Rogers customers will be the first in Canada to experience LTE-Advanced”, dated October 24, 2014, and retrieved from the website at *redboard.rogers.com*. The article indicates that, on the day it was published, Rogers “rolled out the next evolution of wireless technology, LTE-Advanced, to customers in 12 cities”. The article refers to “LTE-Advanced technology” as “the latest and greatest network technology available today”, noting that it will enable wireless customers to “download and live stream even faster on mobile phones and tablets”. The article is

followed by comments posted from October 24, 2014 to September 28, 2015 by several individuals who appear to be from Canada.

- Exhibit T is a webpage titled “Network Coverage” retrieved from the website at *rogers.com* on November 13, 2015. The webpage advertises the “consistent and blazing speeds of Rogers LTE” and displays a map of Canada shaded for areas with “LTE” coverage. The webpage also introduces VoLTE (Voice over LTE), stating that “Rogers customers can now experience high-quality HD voice and video calls and connect even faster”.
- Exhibit U is another article from *redboard.rogers.com*, titled “Rogers takes LTE network into high gear” and dated November 20, 2013. As noted by Mr. Kerson, the article indicates that Rogers has made “significant investments to deliver Canada’s fastest LTE network”. The article also mentions that an “LTE device” is required to “access top speeds”. I note that the article is followed by a comment posted on November 24, 2013.
- Exhibit V is a press release titled “Sierra Wireless AirPrime modules selected by Itron for smart gas metering deployments in Europe”, retrieved from the website at *www.sierrawireless.com*. Mr. Kerson states, “based on my reading of this webpage, at the time this web article was published, August 2, 2011, Sierra Wireless, a Canadian Company, was providing embedded wireless modules that were compatible with various LTE networks across the US”. However, the exhibited article actually has the dateline “Vancouver, Canada-November 04, 2015” and is about an upcoming deployment of cellular connectivity modules across Europe. The only references to LTE are in respect of “LTE-M technology” and the “LTE-M standard definition process” for “LTE-M networks” yet to become available. I also note that the website address at the bottom of the printout does not match the hyperlink cited by Mr. Kerson.

ANALYSIS

[20] In its written representations, the Owner submits that Mr. Kerson had “direct and personal knowledge of the Owner’s Evidence” because he “obtained the sworn evidence through

a series of web searches that he performed directly” and because he “fully reviewed” all the materials and information.

[21] However, there is no indication in Mr. Kerson’s affidavit that he was at any time an officer or director, or even an employee, of the Owner. There is also no indication that he was personally involved in the Owner’s activities or had access to its business records. Rather, Mr. Kerson indicates that he obtained information by searching the Internet and reading articles and advertisements found on public websites. As such, the contents of Mr. Kerson’s affidavit do not come from his own knowledge; they are based, at most, on information and belief. Although Mr. Kerson may have personal knowledge of the existence and location of the webpages he read, he does not appear to be in a position to confirm the accuracy of the websites’ contents based on his own knowledge.

[22] In the circumstances, Mr. Kerson’s statements regarding the Owner, its licensees, and their use of the Mark in association with particular goods or services constitute hearsay evidence, as does the information contained in the webpages attached to his affidavit.

[23] Such hearsay evidence is *prima facie* inadmissible, unless it satisfies the criteria of necessity and reliability [*Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. It is generally appropriate to apply these criteria less strictly in the summary context of a section 45 proceeding than in an adversarial proceeding intended to determine the rights of competing parties. Even so, I am not satisfied that the criteria of necessity and reliability have been met in the present case.

[24] Specifically, the Owner furnished no reasons as to why its evidence had to be introduced through a law student employed by its agent, or why a person having direct knowledge regarding the Owner’s activities and use of the Mark was unable to provide the evidence in question.

[25] Moreover, Mr. Kerson does not state his grounds for believing that the information he found on the Internet is reliable. Indeed, Mr. Kerson qualifies the majority of his statements about the Owner and the Mark with a phrase such as “based on my reading of this webpage” or “as I understand it”.

[26] With respect to Mr. Kerson’s “understanding” that the website addresses provided by

another “practitioner” at his firm were actually compiled by the Owner, I do not consider this explanation to support the exhibits’ reliability in the present case. In particular, Mr. Kerson’s information is that the hyperlinks he received were provided to the Owner by various 3GPP partners and by its marketing department in September 2015, as evidence of the Mark’s use in Canada pursuant to the LTE Logo Use Guide. However, Mr. Kerson does not indicate whether the Owner vetted the content of the webpages in any way, or even confirmed that such content remained unchanged from the provision of the hyperlinks in September 2015 to Mr. Kerson’s printing of the webpages two months later. Indeed, I note an apparent discrepancy between Mr. Kerson’s identification of Exhibit V and the actual contents of the pages reproduced in that exhibit.

[27] Additionally, Mr. Kerson himself would not appear to be in a position, by virtue of his office or experience, to assess the accuracy of the information presented in the webpages or to confirm that any use of the Mark demonstrated in the webpages is, indeed, authorized by the Owner.

[28] In the circumstances, the Owner has not established the necessity of submitting its evidence by way of an affidavit from its agent’s student-at-law or the reliability of the evidence furnished. I therefore find the evidence in this case to be inadmissible hearsay.

[29] In any event, even when read as a whole, the probative value of Mr. Kerson’s evidence is limited.

[30] In this respect, I first note that none of the articles or webpages furnished as “evidence of use of the LTE trademark in Canada” demonstrates a sale or other transfer of registered goods by the Owner during the relevant period.

[31] In its written representations, the Owner submits that the exhibited press releases and advertisements “clearly demonstrate that the Owner’s organizational partners were offering for sale mobile phones and telecommunication networks services branded with the Present Trademark in Canada within the relevant three year period”. In particular, the Owner directs attention to Exhibit R as a “web advertisement from the Owner’s organizational partner Bell Canada offering mobile phones ... branded with the Present Trademark in Canada”. However, it

appears that this article was published *after* the relevant period, given that it refers to Bell having deployed certain technology in August 2015. Moreover, the advertisement does not show the Mark displayed on any of the depicted mobile telephones or on their packaging.

[32] With respect to the Mark forming part of the product names listed in the advertisement, possible deviation issues aside, there is no indication that the Mark’s display in this manner was associated with any of the advertised mobile telephones or other “LTE and LTE Advanced capable devices” *at the time of transfer*. Although the collection of articles attached to Mr. Kerson’s affidavit contains references to “LTE smartphones” and “LTE devices”, the Owner furnished no evidence of how the Mark was displayed in association with such devices at the time of sale or transfer in the normal course of trade, during the relevant period or otherwise.

[33] Second, almost all of the exhibits furnished as “evidence of use of the LTE trademark in Canada” are dated outside the relevant period. The exceptions are Exhibits M, S and U.

[34] The article at Exhibit M indicates that Ericsson will develop and deploy a multimedia subsystem that will enable TELUS to offer “voice over LTE (VoLTE)” and “video calling over LTE”. However, as noted above, advertising alone is insufficient to demonstrate use in respect of services; at the very least, the services must be available to be performed in Canada at the same time [*Porter v Don the Beachcomber* (1966), 48 CPR 280 (Ex Ct)]. In the present case, the exhibited article suggests that TELUS was not yet offering the VoLTE and video over LTE services.

[35] Exhibits S and U promote Rogers’ provision of an LTE network and of LTE-Advanced wireless network technology. However, providing a telecommunications network or telecommunications technology is not one of the services listed in the subject registration. If the provision of networks or telecommunications technology correlates with any of the registered services—such as “*location d’équipement de télécommunication*” (rental of telecommunications equipment) or “*transmission de diffusions sur le Web et des services téléphoniques sans fil*” (transmission of broadcasting on the Web and of wireless telephone services) or any one of the other registered services that involves the transmission of information or data by specific means—then that is not clear from the advertisement. Moreover, in its representations, the Owner makes no effort to correlate any specific service referenced in these articles with any of

the registered services. Accordingly, even if display of the Mark in these articles can be considered use of the Mark in advertising, I am not satisfied that such advertising is for any of the specific services listed in the registration.

[36] Furthermore, to the extent that the exhibited articles, taken as a whole, demonstrate that an LTE network was available in Canada during the relevant period, and had been extended to most Canadians by May 2015, I am not prepared to infer from such evidence alone that the Mark was used in association with any of the registered goods or services, within the meaning of the Act, during the relevant period.

[37] Finally, the evidence does not purport to demonstrate use of the Mark by the Owner itself, but rather, by other entities that the Owner identifies in its representations as “organizational partners”. However, it is not clear that any use of the Mark by such entities would enure to the Owner’s benefit.

[38] In this respect, pursuant to section 50(1) of the Act, for such organizational partners’ use of the Mark to enure to the benefit of the Owner, the Owner must maintain “direct or indirect control of the character or quality of the goods or services” provided in association with the Mark under licence.

[39] 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 a licence agreement that provides for the requisite control [per *Empresa Cubana del Tabaco v Shapiro Cohen*, 2011 FC 102, 91 CPR (4th) 248].

[40] In the present case, the evidence does not contain a clear attestation on behalf of the Owner that it maintains control of the character or quality of the goods and services provided in association with the Mark. Although Mr. Kerson states that the *Mark* must be used “under the care and control of the Owner”, he does not state that the *character or quality of the goods and services* must be under the control of the Owner.

[41] Furthermore, the Owner did not furnish a copy of any licence agreement providing for the requisite control. Although Mr. Kerson obtained a copy of the LTE Logo Use Guide from the Internet, the LTE Logo Use Guide does not address the character or quality of goods and services to be provided under the Mark.

[42] Finally, I am not satisfied that the evidence otherwise demonstrates that the Owner exerted the requisite control. In its representations, the Owner submits that its trademark use policy “clearly states that any use of the Present Trademark is subject to the Owner’s initial and ongoing approval and may be revoked”. However, there is no indication in the evidence that such approval would be contingent upon the character or quality of the licensee’s goods or services. Indeed, the disclaimer on the 3GPP website (Exhibit J), stating that permission to use the Mark does *not* involve certification of compliance with 3GPP specifications, suggests that the Owner might not have had control over the character or quality of goods and services provided under the Mark.

[43] In the circumstances, I am not satisfied that any use of the Mark by the Owner’s organizational partners enures to the benefit of the Owner.

[44] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the registered goods and services within the meaning of sections 4 and 45 of the Act.

[45] Furthermore, the Owner provided no evidence of special circumstances excusing the absence of such use.

DISPOSITION

[46] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration will be expunged.

Oksana Osadchuk
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE No Hearing Held

AGENTS OF RECORD

Nelligan O'Brien Payne LLP

FOR THE REGISTERED OWNER

Gowling WLG (Canada) LLP

FOR THE REQUESTING PARTY