



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

Citation: 2017 TMOB 139
Date of Decision: 2017-10-06

IN THE MATTER OF A SECTION 45 PROCEEDING

Bereskin & Parr LLP/S.E.N.C.R.L

Requesting Party

and

Tridel Corporation.

Registered Owner

TMA787,893 for RÊVE

Registration

INTRODUCTION

[1] This decision pertains to a summary expungement proceeding with respect to registration No. TMA787,893 for the trade-mark RÊVE (the Mark), owned by Tridel Corporation (the Owner).

[2] The Mark is registered for use in association with “developing, designing, planning, constructing, selling, leasing and managing residential real estate projects, developments and homes” (the Services).

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

THE PROCEEDING

[4] On August 20, 2015, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to the Owner. The notice was sent at the request of Bereskin & Parr LLP/S.E.N.C.R.L. (the Requesting Party).

[5] The section 45 notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between August 20, 2012 and August 20, 2015 (the Relevant Period), in association with the registered services. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[6] 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.

[7] 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. The criteria for establishing use are not demanding and an overabundance of evidence is unnecessary. Nevertheless, sufficient facts must be presented to allow the Registrar to conclude that the trade-mark was used in association with each of the services specified in the registration at any time during the relevant period [see *Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270]. Mere statements of use are insufficient to prove use of the trade-mark [see *Aerosol Fillers Inc v Plough (Canada) Ltd* (1980), 53 CPR (2d) 62 (FCA)].

[8] In response to the Registrar’s notice, the Owner filed the affidavit of Roy Berman, sworn on November 10, 2015 with references to Exhibits A to H inclusive.

[9] Only the Requesting Party filed written representations; no hearing was held.

THE OWNER'S EVIDENCE

[10] In his affidavit, Mr. Berman identifies himself as the Owner's Vice President, Corporate Development and Control.

[11] Mr. Berman affirms that the Owner licensed to Reve Condos Inc. (RCI) and to Toronto Standard Condominium Corporation No. 2203 (TSCC), the non-exclusive use of the Mark in Canada. He alleges that each of these licensees, and the Owner, have used the Mark "in connection with some and/or all of the Services" during the Relevant Period.

[12] Mr. Berman then describes what he considers use of the Mark by RCI in the following terms:

- RCI acquired the real estate property located at 560 Front Street West, Toronto, Ontario (the Property) and completed the development, construction, and sale of units on the Property;
- Pursuant to a license agreement entered between RCI and the Owner dated March 25, 2010 (the RCI Licence), the Owner granted RCI the right to use the Mark in furtherance of business activities related to the development and marketing of the Property and filed a redacted version of such licence agreement (Exhibit A);
- Following completion of the development and construction of the Property, RCI used the Mark in connection with the marketing and sale of the unsold residential and parking/locker units, which activities continued during the Relevant Period by posting signage that prominently displayed the Mark. Attached as Exhibit B are sample photographs of signage indicating "Lockers for sale" and "For Sale" on which appears the trade-mark RÊVE KING WEST;
- RCI ran advertisements during the Relevant Period in local newspapers, delivered direct mailings to potential customers, and distributed brochures, all displaying the Mark. Attached as Exhibit C is a copy of a classified advertisement for units within the Property published in the February 4, 2012 issue of The Globe and Mail (before the Relevant

Period) and a copy of a sample brochure for suites 3B and 3BT dated February 7, 2013. Again, the trade-mark appearing on those advertisements is RÊVE KING WEST;

- RCI sold during the Relevant Period eleven residential units and six parking/locker units at the Property.

[13] Mr. Berman goes on to describe in the following words how the Owner controlled the use of the Mark:

- Sections 3, 4, and 8 of the RCI Licence provides some mechanisms for the Owner to control the quality of the Services, including the right to inspect the premises and provide any reasonable instructions concerning the display of the Mark;
- Various members of the Owner also serve as members of the board and officers of the RCI, as RCI is a corporation affiliated with the Owner.

[14] Mr. Berman then describes the use of the Mark by its other licensee, TSCC, in relation to the same Property as above, in the following terms:

- A licence agreement was concluded between the Owner and TSCC (the TSCC Licence) in December 2014, by which the latter was authorized to use the Mark in connection with the management of the Property. A copy of such licence is attached as Exhibit D to Mr. Berman's affidavit;
- The Mark is prominently displayed on the letterhead of TSCC's blank stationary, a copy of which is attached as Exhibit E to the affidavit. However, again, I note that the trade-mark displayed is RÊVE KING WEST;
- The Mark also appeared in large font on signage outside the Property during the Relevant Period, and continues to appear on signage within the front entrance of the lobby, prominently displayed behind the concierge desk. Mr. Berman attaches, as Exhibit F to his affidavit, sample photographs showing said signage on both the exterior and interior of the Property. One of the signs depicted in the photographs of the interior of the building displays the Mark as registered.

[15] Mr. Berman explains that the Owner exercised its control over the use of the Mark by TSCC in the following manner:

- As per article 3 of their licence agreement, TSCC shall use the Mark only in association with the services (as defined in the licence agreement, attached as Exhibit D) that meet or exceed the standards of management of similar condominiums in the same geographic area as the Property;
- TSCC, as per the provisions of article 7 of their licence agreement, must comply with any instructions that the Owner provides, from time to time, concerning the manner of display of the Mark.

[16] Mr. Berman also refers to a Management Agreement entered into between TSCC and Del Property Management Inc. (Del Property) dated December 6, 2011, by which TSCC appointed Del Property to manage the Property. He adds that all aspects of the day-to-day management of the affairs of TSCC are managed by Del Property.

[17] Mr. Berman explains that Del Property is a corporation affiliated with the Owner and that he is a director and officer of Del Property. He adds that various officers of the Owner also serve as members of the board and officers of Del Property.

[18] Mr. Berman also states that Del Property is mandated “to ensure that the high standards of the [Owner] service and lifestyle are maintained in the condominiums that it manages”.

[19] Finally Mr. Berman attests that the Owner used the Mark on its own websites, *www.tridel.com* and *www.ecosuite.ca*, during the Relevant Period by advertising the Property, until the sale of the final residential unit of the Property. He attaches as Exhibit G and H to his affidavit, extracts of the Owner’s websites which contain pictures of the exterior and interior of a building depicting signage on which he alleges the Mark appears. Exhibit G includes a picture of the exterior of a building on which there is a sign. However, it is unclear if it is the Mark or RÊVE KING WEST that appears on such sign. On the extract filed as Exhibit H, the trade-mark RÊVE KING WEST appears in the top left corner of the webpage.

[20] It should be noted that, in the majority of instances where the trade-mark RÊVE KING WEST appears on the Exhibits filed, the word RÊVE is written in much larger letters and uses a different font than the words KING WEST and the latter are written on a second line underneath the word RÊVE.

[21] It is from this evidence, and considering the Requesting Party's arguments, that I have to determine if the Owner has established use of the Mark in association with the Services during the Relevant Period within the meaning of sections 4(2) and 45 of the Act.

ANALYSIS OF THE EVIDENCE

[22] The Requesting Party submits that Mr. Berman did not mention when RCI acquired the Property and completed the development and construction of the condominium building at that location. It adds that Mr. Berman does not provide any information as to when these activities occurred. Therefore, even if those services were provided, there is no indication they were performed during the Relevant Period.

[23] I agree with the Requesting Party, in so far as the construction services are concerned. As for the development services I will discuss this issue later.

[24] As for the RCI Licence itself, the Requesting Party submits that:

- a) according to article 1 of the licence agreement, the right granted to RCI to use the Mark was limited to business activities related exclusively to the development and marketing of the Property. Therefore, the licence agreement does not permit the use of the Mark in association with the sale of condominium units, parking units or locker units;
- b) According to the Berman affidavit, following the completion of the development and construction of the condominium units, RCI used the Mark in connection with the marketing and sale of unsold residential and parking/locker units, which activities continued during the Relevant Period. However, such activities would not constitute use of the Mark in association with "developing, designing, planning, constructing, ... leasing residential real estate projects, developments and homes" (the Unused Services) or in

association with “managing residential real estate projects, developments and homes” at any time during the Relevant Period;

- c) The Berman affidavit does not provide the date when the Mark was last used in association with the Unused Services and the reason for the absence of its use;
- d) If the evidence shows use of the Mark by RCI during the Relevant Period, it would be at most in association with “selling...residential real estate projects, developments and homes”. However, such services were not specifically mentioned in the licence agreement and consequently, such use was not pursuant to a valid licence and cannot be deemed to be use by the Owner under section 50 of the Act;
- e) In any event, if there has been use of a trade-mark by RCI in accordance with the terms and conditions of a licence agreement with the Owner, it was not the Mark but RÊVE KING WEST.

Use of RÊVE KING WEST is use of the Mark

[25] I will deal first with the last argument. The Requesting Party relies on *Canada (Registrar of Trade-marks) v Compagnie Internationale pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 to support its argument that use of RÊVE KING WEST does not constitute use of the Mark.

[26] I disagree. As pointed out earlier, RÊVE always appears in much larger letters and in a different font than KING WEST. In the context of the nature of the Services, it is reasonable to infer that the addition of KING WEST refers to a street name. Consequently, I do not think that the Mark has lost its identity with the addition of KING WEST such that a consumer would be deceived or misled as to the source of the Services (see *CII Honeywell Bull*).

Use of the Mark by RCI

[27] As for the Requesting Party’s interpretation of the scope of RCI’s licence, I find such interpretation to be too restrictive. Those articles must be read in conjunction with the preamble of the licence.

[28] Pertinent portions of the preamble and article 1 read as follows:

(...)[RCI] wishes to continue its use of the [Mark] in respect of the wares and services in association with which the [Mark] is registered from time to time, under and pursuant to the conditions and limitations set forth therein;

1. (...)The right to use the [Mark] is strictly limited to use of the [Mark]in association with wares (“Wares”) and services (“Services”) sold or provided by [RCI] in furtherance of business activities related exclusively to the development and marketing of the Project.

[29] In this context, as opposed to the description of the Services in the registration, the word “development” encompasses all business activities that contribute to the development of the Property, including sale and marketing activities. Hence, I am of the opinion that the sale and marketing of residential units and parking/locker units within the Property, constitute use of the Mark in association with “developing and selling residential real estate projects, developments and homes”.

[30] Since such use of the Mark by RCI in Canada was within the scope of the licence agreement concluded with the Owner, it does enure to the benefit of the latter as per the provisions of section 50 of the Act.

[31] Consequently, I conclude that there has been use of the Mark in Canada by the Owner in association with “developing and selling residential real estate projects, developments and homes” during the Relevant Period, within the meaning of section 4(2) of the Act.

Use of the Mark by TSCC

[32] The Requesting Party argues that, as detailed above, the TSCC Licence provides for the use of the Mark by TSCC only in association with managing condominiums. Moreover, it submits that the licence agreement does not permit any sub-licence by TSCC of the use of the Mark.

[33] The photographs of interior and exterior signage (Exhibit F) do not prove use by TSCC or otherwise of the Mark in association with any of the Services. They were not used for the purpose of advertising any of the Services. I agree with the Requesting Party that such signage displaying the Mark also merely suggests that perhaps the name of the building is “Rêve” or “Rêve King West”. Absent context, it does not constitute use of the Mark in association with any of the particular registered Services by TSCC.

[34] As for the letterhead allegedly used by TSCC (Exhibit E), the Requesting Party points out that it contains the following notification: “NAME OF VENDOR: Rêve Condos Inc.” I note that such notification simply confirms that any sales activities have been carried out by RCI, as detailed previously, and not by TSCC.

[35] In all, I agree with the Requesting Party, that the facts described in paragraphs 14 to 16 of the Berman affidavit concerning the use of the Mark by TSCC, and summarized above, as well as Exhibits E and F, do not provide any evidence of use of the Mark by TSCC during the Relevant Period that could enure to the benefit of the Owner pursuant to section 50 of the Act, as suggested by the Owner.

Use of the Mark by Del Property

[36] The Requesting Party submits that, while the Berman affidavit describes the relationship between the Owner and Del Property, in an attempt to show the Owner’s control, or indirect control through TSCC, of Del Property’s management activities, there is no evidence that there was a valid licence between TSCC and Del Property. It submits that the TSCC Licence does not provide the right to sublicense the Mark and there is no evidence that TSCC exercised any control over Del Property’s management activities.

[37] Del Property was acting as an agent of TSCC, with which the Owner did have a licence, and not as a licensee. However, has there been evidence of management activities by Del Property? Other than a simple affirmation by Mr. Berman that Del Property managed all aspects of the day-to-day management of the affairs of TSCC, there is no concrete evidence of use of the Mark by Del Property in association with the management of the Property during the Relevant Period.

Use of the Mark by the Owner itself

[38] I agree with the Requesting Party that the advertisement on the Owner’s website, Exhibit G, does not demonstrate any use of the Mark by the Owner during the Relevant Period. In this respect, the word “Reve” as it appears in the text on the exhibited webpage, Exhibit G, does not constitute use of the trade-mark as registered. That word is displayed in the same size and font as

in the surrounding text which reads: "...sustainable Ecosuite at the Element community 2007 and then with the 2nd generation Ecosuite at the Reve community in 2011". As such, it would be perceived, as a matter of first impression, to be used as the name of a real estate property.

[39] On Exhibit H, the trade-mark RÊVE KING WEST appears on the top left corner of the webpage. As discussed above, I accept that use of the trade-mark RÊVE KING WEST constitutes use of the Mark. There is also the following text:

The Eco Suite is sold. For more availability at Rêve and Tridel's other downtown Toronto locations [please contact the Presentation Centre.](#) (underlined as hyperlink)

[40] I agree with the Requesting Party that the reference to "Rêve" in the text itself is simply the designation of a building name. However, when taking the webpage as a whole, including the appearance of the trade-mark RÊVE KING WEST (in the manner already described) on the top left corner of the webpage, I consider its content to be an advertisement by the Owner for the sale of condo residential units in association with the Mark during the Relevant Period.

[41] Therefore, I accept that it also demonstrates use of the Mark in association with the services of "selling" residential real estate projects, developments and homes in association with the Mark as such services were advertised in Canada during the Relevant Period.

No evidence of use in association with the Unused Services

[42] I agree with the Requesting party that there is no evidence in the file of use of the Mark during the Relevant Period by the Owner and/or its licensees in association with any of the Unused Services as well as in association with "managing residential real estate projects, developments and homes". Also, the Owner has failed to provide both the date when the Mark was last used in association with each of these services and the reason for the absence of such use;

DISPOSITION

[43] In summary, I conclude that there is evidence of use of the Mark, within the meaning of sections 4(2) and 45 of the Act, by the Owner and/or its authorized licensees in association with "developing and selling" residential real estate projects, developments and homes.

[44] However, the Owner failed to establish use of the Mark in Canada during the Relevant Period in association with: “designing”, “planning”, “constructing”, “leasing” and “managing” residential real estate projects, developments and homes. Moreover, the Owner has not provided facts that would be considered special circumstances justifying the non-use of the Mark in association with those services, within the meaning of section 45(3) of the Act.

[45] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, registration TMA787,893 will be amended to cover only the following services:

developing and selling, residential real estate projects, developments and homes.

Jean Carrière,
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

No Hearing held

AGENTS OF RECORD

DelZotto, Zorzi LLP

FOR THE REGISTERED OWNER

Bereskin & Parr LLP/S.E.N.C.R.L.

FOR THE REQUESTING PARTY