



LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2017 TMOB 180

Date of Decision: 2017-12-20

[UNREVISED ENGLISH

CERTIFIED TRANSLATION]

IN THE MATTER OF A SECTION 45 PROCEEDING

Shift Law

Requesting Party

and

Côté Tonic inc.

Registered Owner

TMA699,568 for TONIC

Registration

THE RECORD

[1] On May 10, 2016, at the request of Shift Law (the Requesting Party), the Registrar sent the notice stipulated in section 45 of the *Trade-marks Act*, RSC 1985, c. T-13 (the Act) to Côté Tonic inc. (the Owner), holder of Registration No. TMA699,568 for the TONIC trade-mark (the Mark).

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

[TRANSLATION] Marketing communication services, namely media placement planning and purchasing services, production of print advertising material, sales and marketing and direct marketing promotional services, namely development and management of advertising campaigns for third parties, promotion of goods and services for third parties, graphic design and creative services related to newspaper, electronic, radio and television promotions and advertising, technical, consulting and advisory services in relation to marketing and communications; services for market information gathering and storage of market information in databases.

[3] This notice enjoined the Owner to provide an affidavit or a statutory declaration that its Mark was used in Canada at any time between May 10, 2013, and May 10, 2016, in association with the services specified in the registration, and, in the negative, the date when the Mark was used for the last time and the reason for its failure to use it since that date.

[4] In response to the Registrar's notice, the Owner filed a statutory declaration by its founder, president and sole director, Jean Côté, made on July 22, 2016.

[5] Neither of the parties filed written representations or a request for a hearing.

ANALYSIS

[6] It is well established that the purpose and the scope of section 45 of the Act are to provide for a simple, summary and expeditious procedure for removing "deadwood" from the register. Although mere allegations of use are insufficient to establish use in the context of such proceedings [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1979), 45 CPR (2d) 194, upheld by (1980), 53 CPR (2d) 63 (FCA)], the level of evidence required is low [see *Lang, Michener, Lawrence & Shaw v Woods Canada Ltd* (1996), 71 CPR (3d) 477 (FCTD)], and it is unnecessary to file an overabundance of evidence [see *Union Electric Supply Co v Canada (Registrar of Trade-marks)* (1982), 63 CPR (2d) 56 (FCTD)]. However, sufficient facts nonetheless must be presented to allow the Registrar to conclude that the trade-mark was used in association with each of the goods or services specified in the registration during the relevant period.

[7] In the present case, section 4(2) of the Act defines use in association with services as follows:

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.

[8] This leads me to review the evidence provided by the Owner.

Jean Côté's statutory declaration

[9] Mr. Côté affirms that the Owner is a firm that offers marketing communication services, namely the services described in the registration. [paragraph 3 of the declaration]

[10] Mr. Côté affirms that the Owner developed the Mark in the framework of its offer of services. In this regard, he affirms that the Owner has used the Mark uninterruptedly in Canada since at least June 7, 2005, and particularly during the relevant period, in the normal course of business. Mr. Côté specifies that in the normal course of its business, the Owner offers its services to businesses that require marketing communication services, as described in the registration. [paragraphs 4 to 6 of the declaration]

[11] In support of his statements related to use, Mr. Côté has attached the following exhibits to his affidavit:

- Exhibit JC-1: [TRANSLATION] “a sample of invoices and the final results of [the Owner’s] work corresponding to these invoices, as delivered to its clients during the relevant period”. Mr. Côté specifies that this sampling is illustrative of the Owner’s marketing communication services, sold under the Mark to its various clients in Canada during the relevant period. [paragraph 7 of the declaration]
- Exhibit JC-2: [TRANSLATION] “other samples of invoices concerning the marketing communication services sold by [the Owner] to its clients during the relevant period”. Mr. Côté specifies that this sampling is [TRANSLATION] “still intended to illustrate the use of the [Mark] in Canada in relation to [the Owner’s] services”. He also adds that the invoices under Exhibits JC-1 and JC-2 [TRANSLATION] “are printed on an invoice template used by [the Owner] and its subsidiaries, on which several marks

appear, including the [Mark] used by [the Owner], such as it appears at the lower right-hand corner on said invoices”. [paragraphs 8 to 9 of the declaration]

- Exhibit JC-3: [TRANSLATION] “a service contract made with We Are Tonic Inc. on August 16, 2012, attached to which is a licensing agreement granting We Are Tonic an exclusive right to use the Mark in Canada since August 16, 2012”. Mr. Côté specifies that these contracts were in force during the relevant period and remain in force to date. [paragraph 10 of the declaration]

Sufficiency of Evidence

[12] As Mr. Côté affirms, Exhibits JC-1 and JC-2 clearly show the Mark affixed in the lower right-hand corner of the invoices. In so doing, I find that the invoices show how the Mark was used in the advertising of the services described therein during the relevant period [see *Smart & Biggar v Southam Inc*, 1995 CarswellNat 3685 (TMOB)].

[13] In this regard, I note that none of the invoices precisely identifies the Owner, but rather “Côté & Tonic”. However, I find it reasonable to infer that “Côté & Tonic” corresponds to the Owner’s trade name and to give credence to Mr. Côté’s statements that these invoices were all issued by the Owner in association with the services described therein and rendered by the Owner, given that they all bear the Owner’s address and precisely identify “Jean Côté” as [TRANSLATION] “representative”. I will add, moreover, that if “Côté & Tonic” instead had to be considered a subsidiary of the Owner, I would be prepared to infer that such use by “Côté & Tonic” benefits the Owner within the meaning of section 50 of the Act governing the use of a trade-mark under licence for the benefit of its owner, given the dual role then played by Mr. Côté as “representative” of “Côté & Tonic” and founder, president and sole director of the Owner [see *Petro-Canada v 2946661 Canada Inc*, [1999] 1 FCR 294].

[14] This having been said, I note that Mr. Côté makes no correlation between the services specified in the registration and the services as described in the invoices under Exhibits JC-1 and JC-2. In fact, none of the services specified in the registration is found identically in the invoices. In the circumstances, I find that at best for the Owner, the services described in the invoices can be understood as the services highlighted in bold in the statement of services reproduced hereinafter:

[TRANSLATION] **Marketing communication services, namely media placement planning and purchasing services, production of print advertising material,** sales and marketing and direct marketing promotional services, namely development and management of advertising campaigns for third parties, promotion of goods and services for third parties, **graphic design and creative services related to newspaper, electronic, radio and television promotions and advertising,** newspaper, **electronic, radio or television advertising, technical, consulting and advisory services in relation to marketing and communications;** services for market information gathering and storage of market information in databases.

[15] In view of all of the foregoing, I find that the Owner has not discharged the burden that was incumbent on it under the terms of section 45 of the act to prove the use of the Mark in association with the following services during the relevant period:

[TRANSLATION] [...] sales and marketing and direct marketing promotional services, namely development and management of advertising campaigns for third parties, promotion of goods and services for third parties, [...] newspaper, [...], radio or television [advertising], [...]; services for market information gathering and storage of market information in databases.

[16] Moreover, the Owner did not provide any evidence of special circumstances justifying the non-use of the Mark during the relevant period in association with such services.

DISPOSAL

[17] Consequently, in exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete the following services from the registration:

[TRANSLATION] [...] sales and marketing and direct marketing promotional services, namely development and management of advertising campaigns for third parties, promotion of goods and services for third parties, [...] newspaper, [...], radio or

television [advertising], [...]; services for market information gathering and storage of market information in databases.

[18] The amended statement of services will be worded as follows:

[TRANSLATION] Marketing communication services, namely media placement planning and purchasing services, production of print advertising material, graphic design and creative services related to electronic promotions and advertising, technical, consulting and advisory services in relation to marketing and communications.

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

Certified true translation
Arnold Bennett

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

No hearing held

AGENT(S) OF RECORD

Lavery, De Billy S.E.N.C.R.L.

FOR THE REGISTERED OWNER

Shift Law

FOR THE REQUESTING PARTY