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LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2020 TMOB 62**

**Date of Decision: 2020-03-30**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**College of Podiatric Surgeons of British  
Columbia**

**Requesting Party**

**and**

**North American School of Podology  
Inc.**

**Registered Owner**

**TMA832,929 for  
C.POD**

**Registration**

INTRODUCTION

[1] At the request of the College of Podiatric Surgeons of British Columbia (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on August 29, 2017 to KvG Group Inc., the registered owner at that time of registration No. TMA832,929 for the trademark C.POD (the Mark).

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

Seminars, courses, programs, studies, training, consultation and certification of credentials relating to all aspects and applications of pedicure; accreditation of individuals who have completed mandated courses relative to pedicure techniques.

[3] Section 45 of the Act requires the registered owner of the trademark to show whether the trademark has been used in Canada in association with each of the 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 it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is August 29, 2014 to August 29, 2017.

[4] The relevant definition of use for services is set out in section 4(2) of the Act as follows:

4(2) A trademark 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 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 these proceedings is 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 trademark in association with each of the services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[6] With respect to services, the display of a trademark on advertising is sufficient to meet the requirements of use when the trademark owner is offering and prepared to perform those services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[7] Subsequent to the issuance of the notice, the Registrar recorded a change in title of the registration from KvG Group Inc. (the Registrant) to North American School of Podology Inc. (the Owner). This change of title is discussed further below.

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Murray Smith, sworn on March 26, 2018. Only the Requesting Party submitted written representations. No hearing was requested.

#### THE OWNER'S EVIDENCE

[9] In his affidavit, Mr. Smith identifies himself as the Chief Operating Officer of both the Owner (since 2002) and the Registrant (since 2006). He describes the Owner's business as a

“leading authority in foot care related education”, offering “classes that promote best practices and standards” in the field. Mr. Smith explains that the Owner offers two certification programs and one international practicum; he identifies one of the certification programs as “Certified Podologist (CPod<sup>®</sup>)”. He attests that the Owner’s services were offered to “health care practitioners” such as “pedicurists, estheticians, nail technicians, nurses, licensed Allied Health professionals with some foot care experience and trained footcare professionals of salons and spas who offer pedicure services”.

[10] With respect to the ownership and assignment of the Mark, Mr. Smith states that “My Company’s records indicate that KvG Group Inc. assigned its right to [the Mark] and the goodwill attached thereto to the North American School of Podology Inc. effective November 24, 2013”. Mr. Smith attaches, as Exhibit A to his affidavit, two documents relating to this assignment:

- a letter dated March 2018 sent by the Owner’s agent of record to the Registrar of Trademarks, in which the agent states: “We file herewith a document assigning all rights in the above trade-mark from KvG Group Inc. to North American School of Podology Inc. in Canada.” The agent further states that “The effective date of the Assignment is November 24, 2013.”
- the “Confirmatory Assignment” document referred to in the agent’s letter, detailing the assignment of the Mark to the Owner. The document is signed and dated March 2018, but includes the following:

WHEREAS KvG Group Inc. [...] (hereinafter the Assignor), did as of the 24th day of November, 2013, sell, assign and set over absolutely unto North American School of Podology Inc. [...] its successors and assigns, all its rights, title and interest in and to the trade-mark of the Assignor in Canada as covered under registration No. TMA832929 for the trade-mark C.POD, together with the goodwill associated therewith.

[11] As such, Mr. Smith asserts that the Owner offered the registered services in association with the Mark in Canada during the relevant period, with the Registrant having offered such services prior to the Owner’s acquisition of the Mark in 2013. However, as discussed further below, Mr. Smith appears to indicate that the Owner also offered such services “since 2000”.

[12] With respect to the promotion and advertisement of the registered services, Mr. Smith states the Owner distributed sales brochures to health care practitioners in Canada during the relevant period. He also states that the Owner distributed “informational brochures to health care practitioners and to those who have completed the C.POD Level 1 and Level 2 program offering them to complete the [...] Level 3 program in order to obtain the C.POD certification”. Additionally, Mr. Smith states that the Owner offered the registered services “to health care practitioner distributors by way of sending them printed announcements”. Finally, Mr. Smith states that the Owner provided a webinar presentation to health care practitioners in 2015, informing them of the registered services.

[13] In support, Mr. Smith attaches the following exhibits to his affidavit:

- Exhibit D is a brochure titled “Educate, Differentiate, Elevate... your business from pedicures to *PediCARE!*” that Mr. Smith attests is from 2015. The Owner’s name and website (*www.podology.net*) are displayed on the brochure, which otherwise describes the Owner’s “Training Modules” and programs and provides details on “pedicure instruments” used by students during training. A variation of the Mark appears in the list of programs offered by the Owner as “CPod (I)”.
- Exhibit E is a single-page advertisement for a “Level 3 – Comprehensive Foot & Leg Evaluation” course offered by the Owner in Mississauga, Ontario in October 2015. The advertisement includes a description of the course content, benefits of the course and comments on the course by past students. Listed under the benefits of the course is “eligibility to apply for the designation C.Pod (Certified Podologist)”. At the bottom of the advertisement, the Owner’s e-mail address, phone number and a link to its website are provided for course registration purposes.
- Exhibit F is an “announcement” letter from the Owner’s founder to the Owner’s “distributors”, offering them an “opportunity to generate a profit from hosting these classes”. In particular, the letter states that “the distributor would pay a flat fee of \$5000.00 to host the NASP Level 1 C.Pod class.”

- Exhibit J is a printout of a webinar presentation titled “Start Your Year off with a Bang!” which includes a slide titled “Advanced Education”. The slide includes the following: “[The Owner] has developed Educational Programs offering Advanced Certifications for pedicurists” and is followed by a slide which refers to “Certified Podologist (C.Pod)®” as one of the possible certifications.

[14] With respect to the training services actually performed by the Owner in Canada during the relevant period, Mr. Smith explains that, through the Owner’s website, sales brochures and advertisements, health care practitioners interested in the Owner’s educational services were directed to register for these services online, by phone or by e-mail. In particular, Mr. Smith attests that the Owner maintained a website where “candidates can complete the online application form to register for the Levels 1, 2 and 3 programs” and he asserts that the Mark is prominently featured on the website. Mr. Smith also asserts that, through the Owner’s “registry of health care practitioners”, students “registered for, and were provided with [the Owner’s] C.POD Services during the relevant period”.

[15] In particular, Mr. Smith references two “course materials”. First, Mr. Smith asserts that a slideshow of course materials titled “Level 1 Advanced Pedicure Let’s Talk Feet” is offered by the Owner to health care practitioners and displays the Mark. He confirms that this course material was distributed by the Owner to health care practitioners during the relevant period. Second, Mr. Smith asserts that relevant pages from a student workbook provided as course materials to students displays the Mark.

[16] In support, Mr. Smith attaches the following exhibits to his affidavit:

- Exhibit B consists of webpage printouts from the Owner’s website that Mr. Smith describes as “current”. The webpages describe the Owner’s program and curriculum, and indicates that the Owner has given 20 years of instruction in foot care-related education. Again, one of the designations offered by the Owner is identified as “Certified Podologist (CPod®)”.

- Exhibit C consists of archived webpage printouts from July 2015, February 2016, August 2016, October 2016 and August 2017. These webpages contain the same information as Exhibit B.
- Exhibit H consists of six spreadsheet printouts, which Mr. Smith describes as “a sample registry of health care practitioners (students) who registered for, and were provided with, [the Owner’s] C.POD Services during the Relevant Period”. Each spreadsheet contains the full names and locations of individuals that appear to be “Registered” in a course.
- Exhibit I is a printout of a 62-page slideshow presentation titled “North American School of Podology, Level 1 Advanced Pedicure, Let’s Talk Feet”, which Mr. Smith describes as “course material”. In particular, the slide for “Level 1 – Advanced Pedicure” contains the following description: “This level will enable the participant to acquire a comprehensive understanding of the theory and practical techniques to perform a para-medical pedicure and will qualify the student to apply for the designation ‘C.Pod’.” This is followed by a slide describing “C.Pod – ‘Certified Podologist’” as a “Legal Designation administered by the Canadian Examining Board of Health Care Practitioners”.
- Exhibit K contains three pages from a student workbook titled “NASP Level Three Comprehensive Foot and Leg Evaluation”. The third page has a description of the “Certified Podologist (C.Pod) Program” as follows:

What is a C.Pod – The designation was created in North America to help distinguish the professional who has advanced training and knowledge, from the standard salon technician [...] A C.Pod has been trained in Advanced Pedicure techniques, Infection Control in a salon environment, Gait Analysis and Biomechanics of the foot and lower limb. The student must complete and achieve over 80% on the final exam in Level 1, 2 and 3. Students are then eligible to apply for the ‘Certified Podologist (International)’ C.Pod (I) certification.

- Exhibit L consists of seventeen invoices sent by the Owner to different individuals in Canada for payments related to the Level 3 course. Mr. Smith confirms that these are “representative samples of invoices documenting the sales of the C.POD Services provided to health care practitioners (students) during the Relevant Period”.

[17] With respect to the registered “certification of credentials” and “accreditation” services, Mr. Smith further explains that once a health care practitioner has completed the three “Levels” of the Owner’s foot care education program, they are eligible to apply for the C.Pod/Certified Podologist certification which, as noted above, is “granted by the Canadian Examining Board of Health Practitioners”.

[18] In support, attached as Exhibit G to the affidavit is a two-page “Application Form” that Mr. Smith identifies as the form used to register for the C.POD certification with the Canadian Examining Board of Health Care Practitioners. The form invites applicants to identify the “designation applied for” with C.POD (I) and C.POD (C) among the possible selections. An index at the end of the form identifies the “(I)” and “(C)” next to the C.POD designation as indicating “International” and “Canadian”, respectively. I note that the “Name of University, College, Institution, School” section in the exhibited form is pre-populated with “North American School of Podology (Advanced Foot Care)” and that the bottom of the form indicates that the form should be mailed to “North American School of Podology”. However, the header of the form displays “The Canadian Examining Board of Health Care Practitioners Inc.” and the form indicates that cheques or money orders are payable to the Board, rather than to the Owner.

#### ANALYSIS

[19] In its written representations, the Requesting Party submits that the Owner has not established the requisite use of the Mark in association with the registered services, in part due to various “inconsistencies” in the Owner’s evidence. In particular, the Requesting Party takes issue with alleged inconsistencies in the confirmatory assignment with respect to the date on which rights in the Mark were assigned to the Owner.

[20] The Requesting Party also submits that the evidence shows inconsistencies in how the Mark was displayed, such that the Mark as registered was not used.

[21] The Requesting Party further suggests that, as “C.POD” is a professional designation, it should have been registered as a certification mark.

[22] Finally, with respect to the registered services “certification of credentials relating to all aspects and applications of pedicure” and “accreditation of individuals who have completed

mandated courses relative to pedicure techniques”, the Requesting Party submits that the requisite use has been demonstrated as the Owner was not the entity with certification and accreditation powers.

[23] I will address each of these issues in turn.

### ***The Confirmatory Assignment***

[24] In its written representations, the Requesting Party suggests that the “confirmatory” assignment was backdated to November 24, 2013. It further points out that while Mr. Smith states that the *Registrant* offered the registered services in association with the Mark prior to November 13, 2013, he also states that “*since 2000 and November 24, 2013, My Company [the Owner] has been and continues to offer [the registered services]*” (emphasis added). Given this allegedly conflicting information, the Requesting Party submits that the Owner was not actually the owner of the Mark during the relevant period.

[25] While it is true that the assignment was not registered with the Registrar prior to the date of the section 45 notice, an assignment may be valid even if not registered [see *Philip Morris Inc v Imperial Tobacco Ltd* (1985), 7 CPR (3d) 254 at 267-8 (FCTD); *Sim & McBurney v Buttino Investments* (1996), 66 CPR (3d) 77 (FCTD), aff’d (1997), 76 CPR (3d) 482 (FCA); and *White Consolidated Industries, Inc v Beam of Canada Inc* (1991), 39 CPR (3d) 94 (FCTD)]. As held in *Cast Iron Soil Pip Institute v Concourse International Trading Inc* (1988), 19 CPR (3d) 393 (TMOB), once an assignment is recorded by the Registrar, it must be accepted *prima facie*.

[26] Furthermore, statements in an affidavit must be accorded substantial credibility [*Ogilvy Renault v Compania Roca-Radiadores SA*, 2008 CarswellNat 776 (TMOB)]. As such, in this case, Mr. Smith’s statements lead me to conclude that the assignment at issue occurred on November 24, 2013 and simply was not recorded at that time. Consequently, I accept that the Owner was the owner of the Mark during the relevant period for purposes of this proceeding.

[27] In any event, given Mr. Smith’s position as Chief Executive Officer of both the Owner and the Registrant during the relevant period, I accept that Mr. Smith was the controlling mind of both entities such that the existence of an oral license and the requisite control with respect to



any use of the Mark by the Owner can reasonably be inferred [for similar inferences see, for example, *Gowling Lafleur Henderson LLP v Gerald Alan Croxall*, 2013 TMOB 1, 109 CPR (4th) 148; and *Aird & Berlis LLP v Erick Factor*, 2019 TMOB 75]. As such, if the Registrant was the owner of the Mark during the relevant period, I accept that any evidenced use by the Owner would have enured to the Registrant pursuant to section 50 of the Act.

[28] Furthermore, this relationship and Mr. Smith's position as CEO of both companies would account for the alleged inconsistency where Mr. Smith appears to indicate in his affidavit that both the Owner and the Registrant offered the registered services in association with the Mark between 2000 and the date of the assignment in 2013.

### ***Use of the Mark as Registered***

[29] In its written representations, the Requesting Party takes note of the variations of the Mark shown in the evidence, such as C.Pod (C) and "C.Pod (I)" in Exhibits G and K. I would first note that, notwithstanding these variations, I accept that the Mark as registered is displayed throughout the exhibited materials, such as in Exhibits B, F and J, as described above.

[30] In any event, where the trademark displayed differs from the trademark as registered, the question to be asked is whether the trademark was used in such a way that it did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used [see *Canada (Registrar of Trade-marks) v Cie International pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see if the "dominant features" of the registered trademark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[31] Furthermore, the use of a trademark in combination with additional words or features constitutes use of the registered mark if the public, as a matter of first impression, would perceive the trademark *per se* as being used [see *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)].

[32] In the context of the evidence before me, I accept that the (I) and (C) elements in “C.POD (I)” and “C.POD (C)”, are descriptive of the “International” and “Canadian” sub-delegations. As such, I accept that such display constitutes an acceptable variation of the Mark as registered, the dominant feature of the Mark having been preserved.

### ***Professional Designation and Certification Mark***

[33] In its written representations, the Requesting Party cites *Ontario Dental Assistants Association v Canadian Dental Association*, 2013 FC 266, apparently in support of a suggestion that the Mark – registered as a word mark – should have been registered as a certification mark, as it is actually a professional designation.

[34] Although the Requesting Party’s submissions are not entirely clear on this point, it would seem to put in to question whether the Mark was validly registered as word mark. However, as noted by the Federal Court of Appeal in *Ridout & Maybee LLP v Omega*, 2005 FCA 306, 43 CPR (4th) 18, the validity of a registration is not in dispute in section 45 proceedings.

[35] In any event, in *Ontario Dental Assistants Association*, I note that the Federal Court merely states that “a professional designations *may* be a valid certification mark” [at para 25, emphasis added] – nothing in the jurisprudence *requires* a “professional designation” to be registered as a certification mark. What is relevant for purposes of this proceeding is whether the Mark was displayed in the advertisement or performance of the registered services by the Owner or a licensee.

[36] In this respect, I do agree with the Requesting Party that the registered services can be grouped into two categories. The first category consists of the training-related services, namely “seminars, courses, programs, studies, training, consultation...relating to all aspects and applications of pedicure” and the second category consists of the accreditation-related services, namely “certification of credentials relating to all aspects and applications of pedicure” and “accreditation of individuals who have completed mandated courses relative to pedicure techniques”.

### ***Training-related Services***

[37] With respect to the registered services “Seminars, course, programs, studies, training and consultation...relating to all aspects and applications of pedicure” the evidence clearly shows that the Owner offered various training courses and the like in association with the Mark during the relevant period in Canada. The evidence shows that not only were such training services offered, they were also performed by the Owner, as evidenced by the exhibited invoices and list of health care practitioners/students who took the Owner’s courses.

[38] As such, I am satisfied that the Owner has demonstrated use of the Mark in association with “Seminars, course, programs, studies, training and consultation...relating to all aspects and applications of pedicure” within the meaning of sections 4 and 45 of the Act.

### ***Accreditation-related Services***

[39] With respect to the registered services “certification of credentials relating to all aspects and applications of pedicure” and “accreditation of individuals who have completed mandated courses relative to pedicure techniques”, the Requesting Party submits that there is “a huge unexplained inconsistency in the evidence...the relationship between the Canadian Examining Board of Health Care Practitioners Inc. and the Current Owner, and the inconsistency over which entity is doing the *certification* and *accreditation*.” Essentially, the Requesting Party argues that any “certification” and “accreditation” was not performed by the Owner, but rather by this other entity.

[40] I agree that the relationship between the Owner and the Examining Board is not clear from the evidence. In his affidavit, Mr. Smith states that successful completion of the three levels of Owner’s education program allows an individual to be “*eligible to apply* for the Certified Podologist certification (C.Pod®) which is *granted by the Canadian Examining Board of Health Practitioners*” [para 11, emphasis added]. Similarly, the Exhibit K “Student Workbook” indicates that students are “eligible to apply for the ‘Certified Podologist (International)’ C.Pod (I) certification” when they “complete and achieve over 80% on the final exam in Level 1, 2 and 3” – leaving it unclear as to whether it is the Owner or some other entity such as the aforementioned Examining Board who performs the actual accreditation and certification.

[41] Similarly, Mr. Smith notes that the application form (Exhibit G) is for individuals “to register for the C.POD certification *with the Canadian Examining Board of Health Care Practitioners*” [para 16, emphasis added]. Additionally, in the Exhibit I slideshow presentation, the Mark is described as a “Legal Designation *administered by the Canadian Examining Board of Health Care Practitioners*” [emphasis added].

[42] Although Mr. Smith asserts use of the Mark by the Owner in association with all of the registered services, this amounts to a mere assertion of law. On its face, Mr. Smith’s statements would indicate that, in fact, it is not the Owner performing the “certification” and “accreditation” services in association with the Mark or otherwise, but rather the Examining Board who performs such services.

[43] While there may be a relationship between the Owner and the Examining Board, neither Mr. Smith’s statements nor the exhibited materials explain that relationship. Furthermore, the Owner submitted no representations, despite this issue being raised by the Requesting Party. As such, one is left to speculate as to the nature of the relationship. Although I was prepared above to infer a licensing relationship between the Owner and the Registrant, I am not prepared to infer that such a relationship existed between the Owner and the Examining Board based on the evidence before me.

[44] Accordingly, while the evidence may show that the Mark was displayed in association with the registered “accreditation” and “certification” services, I find that it falls short of demonstrating that it was the Owner (or a proper licensee) who was, at a minimum, prepared to perform such services in Canada [per *Wenward, supra*].

[45] As such, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered services “certification of credentials relating to all aspects and applications of pedicure” and “accreditation of individuals who have completed mandated courses relative to pedicure techniques” within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances before me, the registration will be amended accordingly.

[46] Granted, maintaining the registration with respect to the training-related services but expunging the accreditation-related services is somewhat unsatisfying, as it leaves unanswered questions as to the nature of the C.Pod designation and the relationship between the Owner and the Examining Board.

[47] However, I note that section 45 proceedings are limited in scope. It is well established that section 45 proceedings are not intended to provide an alternative to the usual *inter partes* attack on a trademark envisaged by section 57 of the Act [see *Meredith & Finlayson v Canada (Registrar of Trade Marks)* (1991), 40 CPR (3d) 409 (FCA)]. The only matter to be resolved is whether, within the meaning of sections 4 and 45 of the Act, the evidence demonstrates use of the trademark with respect to each of the registered services in question. Similarly, whether the registration is maintained, amended or expunged, any disposition in a section 45 proceeding should not be construed as resolving any rights a person may or may not have in the trademark otherwise.

#### DISPOSITION

[48] In view of all the foregoing, pursuant to the authority delegated to me under 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 from the statement of services: "...certification of credentials...; accreditation of individuals who have completed mandated courses relative to pedicure techniques".

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

Seminars, courses, programs, studies, training and consultation relating to all aspects and applications of pedicure.

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Andrew Bene  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE:** No Hearing Held

**AGENTS OF RECORD**

Chantal St. Denis

For the Registered Owner

Cameron IP

For the Requesting Party