



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 78

Date of Decision: 2020-06-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Dale & Lessmann LLP

Requesting Party

and

Chun Huang

Registered Owner

**TMA722,538 for
Chinese characters design**

Registration

[1] At the request of Dale & Lessmann LLP (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 January 2, 2018 (the Notice Date) to Chun Huang (the Owner), the registered owner of registration No. TMA722,538 for the trademark “Chinese characters design” reproduced below (the Mark):

加国无忧

[2] The notice required the Owner to furnish an affidavit or statutory declaration showing that the Mark was in use in Canada in association with each of the services specified in the registration at any time within the three-year period immediately preceding the Notice Date, or,

if the Mark had not been so used, the date when the trademark 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 between January 2, 2015 and January 2, 2018.

[3] The definition of “use” in association with 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.

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

(1) Internet hosting services and intellectual property consulting services offered from a website.

(2) Publishing of books and magazines.

(3) Hosting websites on the internet, hosting internet sites for others and intellectual property consulting services offered from a website.

[5] However, the registration was amended to add services (2) and (3) on November 8, 2018 (following an application to extend the services that was filed on January 19, 2017 and subsequently advertised on June 13, 2018). As noted in the Registrar’s practice notice, *Practice in section 45 proceedings*,

II.1.2 Amended registration

Where a registration has been amended to extend the statement of goods or services under section 41(1)(c) of the Act, the Registrar considers that the three-year period for such goods/services applies **from the date of registration of the amendment**. In that regard, reference may be made to section 41(2) of the Act, which provides that an application to extend the statement of goods/services in respect of which a trademark is registered has the effect of an application for registration of a trademark in respect of the goods or services specified in the application for amendment. Accordingly, a registered owner is **not** required to furnish evidence of use in respect of goods or services that have been listed in a registration for less than three years. [emphasis in original]

[6] Accordingly, because services (2) and (3) were not registered until after the Notice Date, only services (1) are subject to this proceeding.

[7] The Requesting Party nevertheless submits that services (3) are “essentially” the same as services (1) and that comments on the sufficiency of the evidence filed in this case apply equally

well to services (3). Regardless, services (3) were advertised and registered as part of the extension of the statement of services, and an application to extend a statement of services has the same effect as an application for registration of a trademark. Had the Owner filed a fresh application to register the Mark in respect of services (2) and (3) rather than applying to extend its existing registration, the services in the resulting registration would not be subject to the present proceeding. The application to extend has the same effect. The Registrar is without authority to subject services (3) to the requirements of the section 45 notice. In this respect, section 45 is not a substitute for the proceedings to challenge a registration available under section 57 of the Act [see *United Grain Growers Ltd v Lang Michener*, 2001 FCA 66, 12 CPR (4th) 89 (FCA); and *Prince v Andrés Wines Ltd*, 2004 FC 812, 38 CPR (4th) 424].

[8] Therefore, the only matter to be resolved in the present proceeding is whether the furnished evidence regarding use of the Mark is sufficient to maintain the registration for the services listed therein on the Notice Date, namely services (1) (the Services).

[9] In response to the Registrar's notice, the Owner filed various documents—discussed further below—including his own affidavit, sworn on July 24, 2018, in Markham, Ontario. Only the Requesting Party filed written representations; a hearing was not requested.

PRELIMINARY REMARKS REGARDING ADMISSIBILITY OF EVIDENCE

[10] In response to the Registrar's notice, the Owner had originally submitted a letter dated February 5, 2018 (received February 6, 2018), with Attachments I to III. Each "Attachment" was referenced in the letter and contained one or more supporting documents behind a title page. The Owner submitted a further letter on February 19, 2018, with additional information and supporting documents. By way of office letter dated April 13, 2018, the Registrar informed the Owner that these two letters and their attached materials could not be accepted as evidence in response to the Registrar's notice because, pursuant to section 45 of the Act, evidence must be filed in the form of an affidavit or statutory declaration.

[11] On April 16, 2018, the Owner submitted a letter that combined the information from the two February letters, along with Attachments I to IV. Again, each Attachment was referenced in the letter and contained similar documents to those submitted in February. By way of office letter

dated May 4, 2018, the Registrar informed the Owner that this third letter with attached materials could not be accepted as evidence either, for the same reasons.

[12] On July 25, 2018, the Owner submitted another letter with Attachments I to IV, similar to the letter and materials filed in April, together with a one-page affidavit. The affidavit does not mention the letter, any of the Attachments, or any of the documents contained within the Attachments. Moreover, the four Attachments are neither identified as exhibits to the affidavit nor endorsed by the notary before whom the affidavit was sworn.

[13] It is well established that technical deficiencies in evidence should not prevent a party from successfully responding to a section 45 notice where the evidence provided could be sufficient to show use [see *Baume & Mercier SA v Brown* (1985), 4 CPR (TMOB) 96 (FCTD)]. For example, the Registrar has on occasion accepted exhibited evidence that is not properly endorsed, where the documents are clearly identified and explained in the body of the affidavit or statutory declaration [see, for example, *Borden & Elliot v Raphaël Inc* (2001), 16 CPR (TMOB) 96 (TMOB)]. In the present case, however, the Owner's affidavit makes no reference to the documents in Attachments I to IV.

[14] Although the affidavit makes general statements with respect to certain websites, a social media application, an e-mail signature and a magazine that are depicted in the Attachments, there is no indication that any of the specific excerpts or examples in the Attachments were intended to form part of the affidavit or were before the Owner when the affidavit was sworn. This is in contrast to the letter, which contains more specifics and explicitly references each Attachment.

[15] In the circumstances, the fact that none of the documents in the Attachments are either referenced by the affiant or identified as exhibits to the affidavit amounts to more than a mere technical deficiency [for similar conclusions see *Bereskin & Parr v Teletronic Communications Ltd* (1997), 78 CPR (3d) 406 (TMOB); and *Smart & Biggar v Terfloth Trade Marks Ltd*, 2014 TMOB 158, 2014 CarswellNat 4069]. Consequently, I find that the attached documents have, again, not been presented as part of an affidavit or statutory declaration. They are thus inadmissible, and will not be considered as evidence in this case.

[16] Similarly, the additional information contained in the July letter cannot be accepted as evidence because, as noted above, the evidence in a section 45 proceeding must be filed in the form of an affidavit or statutory declaration.

[17] Therefore, in making my decision, I will consider only the contents of the Owner's one-page affidavit sworn on July 24, 2018. I would note, however, that even if I were to also consider the July letter and the Attachments, I would not find them sufficient to demonstrate use of the Mark in association with the Services within the meaning of sections 4 and 45 of the Act, for reasons that will be discussed below.

PRELIMINARY REMARKS REGARDING THE SCOPE OF THE PROCEEDING

[18] I note that the Owner's July letter also requests the Registrar's help in stopping a third-party company from using the Mark. However, as previously noted in the Registrar's letter of May 4, 2018, the Registrar cannot provide legal advice or otherwise assist parties in a dispute over a trademark. Furthermore, section 45 proceedings are limited in scope: they are not intended to resolve disputes or to determine rights as between parties with competing commercial interests [see *Meredith & Finlayson v Canada (Registrar of Trade Marks)* (1991), 40 CPR (3d) 409 (FCA)]. Therefore, again, the only matter to be resolved in the present proceeding is whether the furnished evidence is sufficient to maintain the registration for the Services.

THE OWNER'S EVIDENCE

[19] The substantive portion of the Owner's affidavit is reproduced below:

3. A trademark application was made for registration of the Chinese character design "JIA GUO WU YOU" meaning "DO NOT WORRY IN CANADA" on December 13, 2006 (application number 1328073) and was registered on August 27, 2008 (registration number TMA722538)
4. I am the sole legal owner of the trademark and the design mark has been continuously used since April 1996 in respect of the said goods and services of my immigration business

5. The said design mark was first used for my immigration firm Mogen & Kevin Corporation from April 1996 to December 2005 as my business slogan/motto
6. The design mark was again used as my business slogan/motto for my second immigration firm Royal Mont Business and Legal Consulting Ltd from March 2004 to the present July, 2018. This is further evidenced by my website WWW.ROYALMONT.CA which displays the said design mark and business signs displayed at my office
7. I took over the magazine Coupon King on September 18, 2015 and displayed the said design mark to the cover of the magazine, as well as, the website WWW.51COUPON.ca and as the logo of the business e-mail[.] Coupon King advertises services and coupons of various subjects including immigration.
8. The design mark has also been used and displayed over Wechat, a social media application, to advertise my business in the Chinese community since January 1, 2017.

ANALYSIS

[20] Section 45 proceedings are summary in nature and the evidentiary threshold to be met is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)].

Nevertheless, it is well established that a mere assertion that a trademark has been used in Canada is insufficient to meet the requirements of section 45 of the Act [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. A registered owner must not merely state, but actually *show* use of the trademark in association with each of the goods or services listed in the registration, “by describing facts from which the Registrar or the Court can form an opinion or can logically infer use within the meaning of section 4” [see *Guido Berlucchi & C Srl v Brouillette Kosie Prince*, 2007 FC 245, 56 CPR (4th) 401 at para 18].

[21] In particular, with respect to services, the evidence must show that the trademark was displayed in the performance or advertising of the registered services in Canada during the relevant period. In the case of advertising, the evidence must also show that the owner was offering and prepared to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[22] In the present case, there is neither a clear assertion of use of the Mark *in association with the Services* nor evidence from which such use might be inferred.

[23] First, although the Owner asserts use of the Mark, that use is not in association with the Services but rather in respect of “the said goods and services of my immigration business” and in connection with a business that “advertises services and coupons of various subjects including immigration”. There is no mention of whether or how the Owner advertises, performs, or is prepared to perform the Services, namely “Internet hosting services” and “intellectual property consulting services offered from a website”.

[24] Second, although the Owner states that the Mark was displayed on the *www.royalmont.ca* and *www.51coupon.ca* websites, on his office business signs for Royal Mont Business and Legal Consulting Ltd., on the cover of Coupon King magazine, as the logo for Coupon King business e-mails, and “over Wechat, a social media application”, the affidavit fails to show *how* the Mark was displayed in these locations. It is therefore not possible to assess whether the Mark was displayed in the form in which it is registered or whether such display was in the performance or advertisement of the specific Services listed in the registration.

[25] Third, to constitute advertising, materials displaying the trademark must be “distributed to” or accessed by prospective customers [*Cornerstone Securities Canada Inc v Canada (Registrar of Trade Marks)* (1994), 58 CPR (3d) 417 (FCTD)]. With respect to promotional material posted online, although webpages cannot be physically circulated in the same way as printed advertisements, they must still be “distributed to” or accessed by prospective customers in order to constitute advertising [see, for example, *Shift Law v Jefferies Group, Inc*, 2014 TMOB 277, 2014 CarswellNat 6223]. In the present case, the affidavit does not specify whether the websites and social media application in question were accessed from Canada during the relevant period, *i.e.* from January 2, 2015 to January 2, 2018. Likewise, although the Owner states that he “took over the magazine Coupon King on September 18, 2015”, he does not provide any information on the distribution of the magazine or on the sending of the related business e-mails during the relevant period. Nor does he provide any information regarding his customer base or level of sales during the relevant period, from which inferences favourable to the Owner might have been drawn.

[26] I would also note that the affidavit is silent as to whether any use of the Mark by Royal Mont during the relevant period was under licence from the Owner and enured to the Owner's benefit under section 50 of the Act. However, as the affidavit does not actually demonstrate any use of the Mark by Royal Mont, it is not necessary to determine whether the requirements of section 50 have been met.

[27] Even if the Attachments to the July letter were admissible as evidence, I would not be satisfied that they show use of the Mark in the performance or advertising of the Services.

[28] In this respect, I note at the outset that most of the documents in the Attachments are written primarily in Chinese characters, although the Owner has added handwritten notes pointing to where the Mark appears and translating certain phrases. My comments below are based on the documents' English text and the Owner's limited translations, as well as on the occurrences of the Mark as flagged by the Owner. In the case of documents incorporating images, like webpages, I have also had regard to the images in inferring the subject matter.

[29] First, the Certificate of Incorporation and Articles of Incorporation for Royal Mont and the WHOIS registration particulars for the domain name *royalmont.ca* (Attachment I), the printout of the registration particulars for the Mark (Attachment II), and the Changes Regarding Directors form for Maple Fujian Public Media Corporation Limited (Attachment III) do not show use of the Mark. Furthermore, although the July letter indicates that Attachment III relates to the COUPON KING magazine the Owner "took over" in 2015, neither the affidavit nor the letter explains the relationship between the Owner and Maple Fujian or specifies whether Maple Fujian has used the Mark, under licence from the Owner or otherwise.

[30] With respect to the two webpages printed from *royalmont.ca* (Attachment I), they each incorporate the Mark within their text, but the Mark does not stand out. In any event, the printouts are dated after the relevant period and the webpages in question do not appear to mention either "Internet hosting services" or "intellectual property consulting services".

[31] The two webpages from *51coupon.ca* (Attachment III) were also printed after the relevant period, although handwritten annotations indicate that two advertisements were posted during the relevant period. At the top of each webpage, a stylized version of the Mark featuring

large, brush-stroked characters is displayed above (i) a design formed by intertwining the letters C and K and (ii) the words “COUPON KING”. Again, however, the webpages do not appear to mention the Services. Nor do they appear to provide such services. Rather, the webpages appear to publish, and provide access to, online coupons—for items such as furniture and groceries. If any of the activities performed through the website constitute “Internet hosting” or “intellectual property consulting”, then that has not been explained. (In the circumstances, it is not necessary to consider whether display of the aforementioned stylized version of the Mark, together with other word and design elements, constitutes an acceptable variation of the Mark as registered, as would be required to support the registration.)

[32] I note that the Attachment III title page also invites the Registrar to contact the Owner’s clients whose phone numbers appear on the advertisements at *51coupon.ca*. However, the Registrar has no authority to conduct such inquiries. If the Owner wished to submit evidence from its clients, such evidence should have been filed as an affidavit or statutory declaration.

[33] With respect to the series of printed e-mails, they are identified on the Attachment III title page as “E-mail evidence to contact clients”; based on the e-mail addresses shown, the e-mail exchanges appear to be between Coupon King and Royal Mont. The first printout shows a date within the relevant period, and the Mark follows “COUPONKING” in e-mail signatures. However, again, there is no mention of the Services.

[34] The twelve issues of Coupon King magazine (Attachment III) are all from the relevant period. Two of the covers from 2017 display the Mark in large characters, above the intertwined C and K design and the words “COUPON KING”; the remaining covers from 2017 are similarly branded, but with the brush-stroked version of the Mark. The covers from 2016 display a smaller brush-stroked version of the Mark, *below* the C and K design and “COUPON KING”. Within each issue are dozens of pages of advertisements and coupons, for various goods and services, ranging from automotive tires to restaurants. However, it is not clear whether any of them are for the Services. The July letter merely states that the Owner “enlarged the business advertisement scope of the magazine ‘COUPON KING’ to immigration, real estate, investment projects, tourism, sports, etc.”, without mentioning either “Internet hosting” or “intellectual property consulting”. In any event, the magazines appear to advertise the goods and services of third

parties, rather than services offered by the Owner. At best, the Mark would be displayed on the covers in the performance of a publishing service. If the Mark is displayed on any of the many advertisements or coupons within the magazines, then this is not indicated by the Owner.

[35] I note that the magazines do include one full-page advertisement whose English text invites readers to “Professionally deal with patent trademark and copyright application registration”, with “Accurate Search” and “All-round Follow-up Services”. However, although these services relate to intellectual property, it is not clear whether they include “consulting services” and/or are “offered from a website”. Moreover, it is not clear whether they are provided by the Owner. The address indicated on the advertisement is the same as the Owner’s address of record, but without further context and in the absence of any explanation whatsoever regarding this advertisement, any inferences to be drawn regarding potential connections with the Owner would be speculative. In any event, the Mark is not displayed in this advertisement.

[36] I would also note that the magazines include a large advertisement for a real estate brokerage where the sales representative’s e-mail address suggests a connection with Royal Mont. Again, however, the Mark is not displayed in the advertisement. Moreover, if there is any connection to the Owner’s provision of “Internet hosting” or “intellectual property consulting” services, then this has not been explained.

[37] Finally, the five posts from the social media application—identified as “Wetchat” on the Attachment IV title page—each display a combination of the word “Couponking” with the Mark. However, the dates of the posts are not provided in these printouts and the posts do not appear to mention the Services. Rather, they appear to advertise lighting fixtures, eyeglasses and cookware. (In the circumstances, it is not necessary to consider whether this combination of the word “Couponking” with the Mark constitutes an acceptable variation of the Mark as registered.)

[38] In any event, as discussed above, the July letter and four Attachments are not admissible as evidence in the present case.

[39] In summary, the Owner’s affidavit amounts to a mere assertion of use of the Mark in general—or at best in connection with an immigration business— rather than statements of fact showing use of the Mark by the Owner in the performance or advertisement of the specific

services listed in the registration. In the absence of further details and admissible supporting evidence, I am not prepared to conclude that the Mark was displayed in the performance or advertising of the Services in Canada during the relevant period.

DISPOSITION

[40] In view of all the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with the Services within the meaning of sections 4 and 45 of the Act. Furthermore, there is no evidence before me of special circumstances excusing the absence of such use.

[41] Accordingly, 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 amended to delete the following from the statement of services:

(1) Internet hosting services and intellectual property consulting services offered from a website.

[42] As discussed above, services (2) and (3) are not subject to the section 45 notice. Accordingly, the amended statement of services will be as follows:

(2) Publishing of books and magazines.

(3) Hosting websites on the internet, hosting internet sites for others and intellectual property consulting services offered from a website.

Oksana Osadchuk
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

No Hearing Held

AGENTS OF RECORD

No agent appointed

FOR THE REGISTERED OWNER

Dale & Lessmann LLP

FOR THE REQUESTING PARTY