



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 277

Date of Decision: 2021-12-14

IN THE MATTER OF A SECTION 45 PROCEEDING

Borden Ladner Gervais LLP

Requesting Party

and

DAC Group (Holdings) Limited

Registered Owner

TMA657,148 for C.O.O.L.

Registration

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA657,148 for the trademark C.O.O.L. (the Mark), currently owned by DAC Group (Holdings) Limited.

[2] All references are to the Act as amended June 17, 2019 unless otherwise noted.

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

Advertising services, namely online artwork, preview and placement services for the viewing and ordering of directory advertising by others. (the Services).

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

THE PROCEEDINGS

[5] At the request of Borden Ladner Gervais LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act May 19, 2020, to DAC Group (Holdings) Limited (the Owner), the registered owner of the Mark.

[6] The notice required the Owner 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 May 19, 2017 to May 19, 2020 (the Relevant Period).

[7] The relevant definition of use 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.

[8] 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), 1980 CanLII 2739 (FCA), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in a section 45 proceeding is quite low [*Woods Canada Ltd v Lang Michener* (1996), 1996 CanLII 17297 (FC), 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 goods or services specified in the registration during the relevant period.

[9] In response to the Registrar's notice, the Owner furnished an affidavit of Kiran Prashad, sworn on December 21, 2020 to which was attached Exhibits A to D inclusive.

[10] Only the Owner submitted written representations. No hearing was held.

THE EVIDENCE AND ANALYSIS

[11] Mr. Prashed is the Vice President of the Owner since 2017 and has been employed by the Owner since 1984.

[12] Mr. Prashad affirms that the Owner is a digital media agency that provides marketing, advertising, technical, professional and creative services.

[13] Mr. Prashad states that the Owner has used the Mark in the ordinary course of its operation in association with the Services including customized advertising directory services through C.O.O.L. external portal in the manner detailed below.

[14] Mr. Prashad affirms that the C.O.O.L. Extranet portal is a feature of the services the Owner provides to its clients. Exhibit A to his affidavit is a screenshot illustrating how the Owner's website access to the C.O.O.L. portal appeared as of October 2, 2018 and is representative of what the Owner's clients would see when accessing the C.O.O.L. external portal from the Owner's website throughout the Relevant Period.

[15] Mr. Prashad states that Exhibit "B" are screenshots taken on December 16, 2020 of what the Owner's client can access through the C.O.O.L. portal by entering their User Name and Password to sign in from the Owner's website. He further explains that, following sign on, the Owner's client is linked to the C.O.O.L. portal within the client's internal computer system or Intranet. Once the client or their employees enters the C.O.O.L. portal it is brought to its customized Homepage where it can access its account information, review various reports related to its microsite and Search Engine Marketing (SEM) programs, learn about the Owner's advertising programs, watch videos about the Owner's advertising programs, sign up and approve its orders for SEM, Social Media and advertising coaching programs, and print its order.

[16] Mr. Prashad confirms that the screenshots attached as Exhibit "B" are representative of what the Owner's clients were seeing when accessing the C.O.O.L. portal from their internal intranets during the Relevant Period.

[17] Mr. Prashad describes Exhibit “C” as screenshots taken on December 21, 2020 of the steps taken by a client once it has entered the C.O.O.L. portal to create its online artwork, preview the artwork and place its order.

[18] Mr. Prashad explains that once the client or their employees logs into the C.O.O.L. portal and is brought to its customized Homepage, the client then selects its order to be placed in a directory from the Home Screen as shown on the first screenshot of Exhibit C. The client is then brought into the order screen where it can open and view its custom artwork by hovering its computer mouse over the artwork icon and then click on the icon to open the artwork as shown by the hand symbol pointing to the artwork icon on the second screenshot. Once the client clicks on the artwork icon, it is brought to a screen where it can view its artwork as shown on the third screenshot.

[19] Mr. Prashad further states that the client may then either approve the artwork, request revised artwork, or cancel and delete the artwork as shown on the third screenshot. The client clicks to submit its approval and a pop-up appears to submit its order where it can either click OK to accept the order or Cancel to cancel the order. By clicking OK, the client then receives a Confirmation advising that its final approval for the order has been sent.

[20] Mr. Prashad confirms that the screenshots Exhibit C represent how a client would be able to review artwork, approve and place its orders for directory placements through the C.O.O.L. portal as of October 2, 2018. They are representative of how the clients use the C.O.O.L. portal to review their custom created artwork, request edits or delete the artwork, and move to the next stage where the advertisement is placed in the applicable directory during the Relevant Period.

[21] Mr. Prashad affirms that the C.O.O.L. Extranet is part of the service provided by the Owner to its clients when they pay for advertising coaching and/or SEM system services.

[22] Nmr. Prashad affirms that Exhibit “D” is a copy of an invoice to a Toronto area client issued during the Relevant Period for the Owner’s services generated and approved through the C.O.O.L. Extranet interface.

[23] Mr. Prashad concludes his affidavit by providing the Owner's gross annual sales figures for its advertising agency services during the Relevant Period.

[24] In view of all the foregoing, and given the absence of written representations from the Requesting Party, I am satisfied that the Owner has demonstrated use of the Mark in Canada during the Relevant Period, within the meaning of sections 4 and 45 of the Act, in association with the registered services.

DISPOSITION

[25] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained on the register in compliance with the provisions of section 45 of the Act.

Jean Carrière
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

Dentons Canada LLP

For the Registered Owner

Borden Ladner Gervais LLP

For the Requesting Party