



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 017

Date of Decision: 2022-02-01

IN THE MATTER OF A SECTION 45 PROCEEDING

CLARK WILSON LLP

Requesting Party

and

7299362 Canada Inc.

Registered Owner

TMA897,557 for

Registration

ALEXA TRANSLATIONS

Introduction

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA897,557 for the trademark ALEXA TRANSLATIONS (the Mark).

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

GOODS

(1) Downloadable software for language translation; language interpretation machine, namely an electronic device that accepts spoken input from the user, translates that input into one or more languages, and then produces either a written or audible output.

SERVICES

(1) Translation services.

(2) Language interpretation services.

(3) Consulting services, namely, in the fields of business management, organizational restructuring, corporate finance, law.

(4) Cultural consulting services, namely, training and educating cultural competence on how to conduct business with a diverse workforce or international client, training and educating cultural understanding from the perspective of different cultures and/or other countries.

(5) Web development services.

(6) Notary services.

(7) International document verification services, namely, providing opinions as to the legitimacy of foreign issued documents.

(8) Software as a service (SAAS) provider in the field of language translation; providing telephone call centre and contact centre services.

[3] For the reasons that follow, I conclude that the registration ought to be amended to delete the entirety of the goods, as well as “providing telephone call centre and contact centre services” from services (8).

The Proceeding

[4] On September 5, 2018, at the request of Clark Wilson LLP (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to 7299362 Canada Inc. (the Owner). The notice required the Owner to show whether the Mark was used in Canada in association with each of the goods and 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 the Mark 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 between September 5, 2015 and September 5, 2018.

[5] The relevant definitions of use in the present case are set out in sections 4(1) and 4(2) of the Act as follows:

4(1) A trademark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

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.

[6] In response to the Registrar's notice, the Owner submitted the affidavit of Gerjon Kalaci, Chief Executive Officer of the Owner, sworn on April 4, 2019.

[7] Both parties submitted written representations and were represented at an oral hearing.

Overview of the Owner's Evidence

Preliminary remarks regarding the trademark in evidence

[8] Before proceeding with summarizing the Owner's evidence, I note here that the following two stylized versions of the Mark appear in the exhibits to Mr. Kalaci's affidavit:



[9] It is well established that a registration for a word mark can be supported by use of that mark in any stylized form, as long as the registered mark retains its identity and remains recognizable [see *Stikeman, Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB); see also *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA), and *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)]. In my view, that is the case here.

[10] Accordingly, I am satisfied that any evidenced use of either of the two trademarks reproduced above constitutes use of the Mark as registered and I will refer to both stylized marks as "the Mark" in the remainder of this decision.

Overview of the Owner's evidence

[11] Generally speaking, the voluminous Kalaci affidavit describes how the Owner advertised and provided its services to clients in Canada during the relevant period. The affidavit is silent with respect to any goods.

[12] In his affidavit, Mr. Kalaci explains that the Owner, doing business under the name ALEXA TRANSLATIONS, was founded in 2009 and provides its translation and interpretation services along with other services related to translation, such as “consulting, web development and multicultural design, notarial, and international document verification services” [para 8]. He provides statements confirming that, in Canada and during the relevant period, the Owner provided each of the specific registered services, with the exception of one, “providing telephone call centre and contact centre services” for which he provides no such statement.

[13] In support, Mr. Kalaci attaches a number of invoices to his affidavit, all displaying the Mark. The specific invoices on which I rely were issued during the relevant period to customers in Canada, and will be identified in the relevant sections of the analysis below. However, because the Owner often advertised multiple services at once, I will summarize some of the most relevant advertising evidence here.

[14] First, Mr. Kalaci provides webpage printouts from different versions of the Owner's website located at *www.alexatranslations.com*, as archived by the WayBack Machine during the relevant period [Exhibits 2 and 8]. Some of the exhibited webpages advertise the Owner and its services, and include specific pages relating to “Translation”, “Interpretation”, “Cultural Consulting”, “Integrated Services”, as well as “Web Development and Multicultural Design”. The Mark appears on each exhibited webpage.

[15] Second, Mr. Kalaci explains that, in addition to advertising on its website, marketing materials were “widely distributed” to clients and prospective clients in Canada during the relevant period [para 21]. Exhibit 3 consists of samples of such materials, all displaying the Mark, including:

- a brochure entitled “Synopsis of Alexa’s Translation, Interpretation and Culturla [sic] Consulting Services”;
- multiple flyers – described as “one-pagers” by Mr. Kalaci – which present the Owner’s services, notably “Translation”, “Interpretation”, “Cultural Consulting”, “Desktop Publishing”, “Multilingual Web Development” and “Legal Opinion” (presented as “*Avis (juridique) sur la traduction*” in the French version of a one-pager); and
- a pamphlet which reads “We take care of all your language needs, from translations to proofreading to web development and design” and also offers “in-house certification of translations and legal notarization of documents”.

[16] The remaining relevant evidence, specifically relating to each of the registered services, will be described in the appropriate sections of the analysis below.

Analysis

[17] The Requesting Party generally submits that, while Mr. Kalaci describes the services in evidence as the registered services, such characterizations exceed the Owner’s actual commercial activities. In its representations, the Requesting Party also submits that, having distinguished various goods and services in its registration, the Owner “implicitly claimed that these goods and services differed from translation and interpretation services” and, consequently, that it is improper for the Owner to rely on performance of its translation and interpretation services in order to preserve the other services in the registration.

[18] I first note that the Owner conceded at the hearing that it had not used the Mark in association with any of the registered goods. There is no evidence of special circumstances which would excuse the absence of use of the Mark and, therefore, the entirety of the goods will be deleted from the registration.

[19] As for the services, it is important to bear in mind that a statement of services may contain overlapping and redundant terms in the sense that the performance of one service would

necessarily imply the performance of another [*Gowling Lafleur Henderson LLP v Key Publishers Co*, 2010 TMOB 7 at para 15; see also *Provent Holdings Ltd v Star Island Entertainment, LLC*, 2014 TMOB 178 at para 22; *GMAX World Realty Inc v RE/MAX, LLC*, 2015 TMOB 148 at para 69].

[20] Having said that, I will address each of the registered services in turn below, together with the relevant evidence of the specific services offered by the Owner.

Services (1) and (2) – Translation services and Language interpretation services

[21] Mr. Kalaci attests that each year during the relevant period, the Owner completed between 3,000 and 5,000 translation projects, and invoiced more than \$2 million for such services in Canada [para 32]. Mr. Kalaci also attests the Owner provided interpretation services to approximately 20 different clients, mostly in Canada, generating revenues of approximately \$20,000 [para 37]. In support, Mr. Kalaci provides representative invoices for translation and interpretation services, both displaying the Mark [Exhibits 13 and 15].

[22] Consequently, and as conceded by the Requesting Party, the Owner has shown that it performed translation and language interpretation services in association with the Mark in Canada, during the relevant period. I am therefore satisfied that the Owner has shown use of services (1) and services (2) within the meaning of sections 4(2) and 45 of the Act.

Services (3) – Consulting services

[23] In the context of services (3), “Consulting services, namely, in the fields of business management, organizational restructuring, corporate finance, law”, Mr. Kalaci attests that the Owner performed consulting services for about 50 clients in Canada during the relevant period, earning revenues of about \$100,000 [para 42]. He also explains that because these services were “often provided in the course of general retainers with large clients”, the Owner did not always invoice them and, therefore, the evidenced figure for the Owner’s consulting business revenues “underestimates its size” [para 42].

[24] Mr. Kalaci does provide one invoice for services listed as “English/French - Preparation of TM”, which Mr. Kalaci refers to as an invoice for “consulting services” for translation memory “which involves importing and analyzing previous translation work to ensure consistency between translation work that is outsourced rather than managed internally” [para 42, Exhibit 17].

[25] In his affidavit, Mr. Kalaci also gives two examples of consulting services performed by the Owner, namely advising clients on the setup and management of their internal translation departments (including organization and optimization of such departments) and providing legal opinions on translations of securities documents [paras 39 and 41]. He explains that the Owner “advertised these services on its website as part of its ‘Integrated Services’ offering” [para 40].

[26] In support of the latter example, Mr. Kalaci attaches a one-page letter bearing the Mark, dated during the relevant period and addressed to a client located in Toronto [Exhibit 16]. A portion of the letter reads “In my opinion, the French versions of the Translated Material are, in all material respects, faithful, complete and accurate translations of the English version thereof”. The letter is signed by an individual identifying herself as a “Professional Lawyer-Linguist”. In this regard, I note that one of the Exhibit 10 information documents sets out the “Authentication Services” offered by the Owner, such as a “Legal Opinion of Translation”. The exhibited document describes this type of opinion as a “document signed by a lawyer-linguist who is an active member of a bar association, stating that the translation is accurate to the best of their professional ability in all material aspects”.

[27] The Requesting Party questions Mr. Kalaci’s characterizations of the Exhibit 16 letter and the Exhibit 17 invoice. In short, the Requesting Party submits that the letter describes itself as a “translation opinion” rather than a “legal opinion”, and that the invoiced preparation of “translation memory” does not fall within the ambit of “consulting services”. As a result, the Requesting Party claims, the Owner has failed to provide documentary evidence showing that it performed consulting services (3).

[28] The Requesting Party also argues that there is no indication that *Integrated Services* involve the provision of any consulting services and points to an exhibited website printout describing *Integrated Services* as “Customized translation solutions for effective multilingual communication”.

[29] With respect to the Requesting Party’s second point, I note that certain webpages included in the Exhibit 8 website printouts explain *Integrated Services* in more detail. In particular, I note the following description: “An Integrated Services Solution begins with a discussion of your current translation situation followed by a service audit. We will then work with you to build a solution that best suits your needs”. The same webpages also promise that these services “will result in substantial cost savings by lowering overhead, and improving your organization’s capacity to turn around translations while maintaining, and often improving, quality”. More than that, there is also a clear indication that the *Integrated Services* correspond to consulting services, namely the sworn statement at paragraph 40 of Mr. Kalaci’s affidavit that the Owner advertised consulting services as part of its *Integrated Services*.

[30] As for the Requesting Party’s first point, it is well established that documentary evidence is not necessarily required to establish use in the context of section 45 proceedings. For instance, in this case, the Owner furnished specific examples of the services performed, together with sworn statements that consulting services were provided during the relevant period in Canada, as well as factual particulars supporting those statements such as revenue figures and the number of clients benefitting from these services.

[31] In any event, Mr. Kalaci’s characterizations of Exhibits 16 and 17 are reasonable and consistent with the evidence. I accept them at face value [per *Oyen Wiggs Green & Mutala LLP v Atari Interactive Inc*, 2018 TMOB 79 at para 25].

[32] As for the correlation between the consulting services performed by the Owner and the registered services, I accept that providing advice to clients regarding set up, organization and optimization of internal translation departments corresponds to consulting services in the fields of *business management* and *organizational restructuring*. In addition, I accept the Owner’s

submission that providing advice to companies on cost-reducing solutions reasonably falls within the ambit of consulting services in the field of *corporate finance*. Finally, I accept that legal opinions given in relation to the accuracy of translations, such as the Exhibit 16 letter, correspond to consulting services in the field of *law*.

[33] Given that the Owner's consulting services were offered as a value-added service by the Owner, and were therefore not always invoiced, there is little evidence showing the Mark on invoices for specific consulting services. Nevertheless, having regard to the evidence as a whole, it is clear that the Mark was prominently displayed on the Owner's various materials, including invoices, e-mails, marketing materials and letterhead. In addition, the exhibited webpages show that the Mark was displayed in the advertisement of *Integrated Services* on the Owner's website.

[34] In my view, the Owner's evidence establishes that – at a minimum – it advertised its consulting services in association with the Mark and was prepared to perform those services in Canada during the relevant period [per *Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB), which held that the display of a trademark on advertising is sufficient to meet the requirements of section 4(2) when the trademark owner is offering and prepared to perform those services in Canada].

[35] As a result, I am satisfied that the Owner has shown use of the Mark in association with all of services (3) within the meaning of sections 4(2) and 45 of the Act.

Services (4) – Cultural consulting services

[36] As described in the evidence overview above, the Owner advertised its cultural consulting services, on its website and marketing materials, during the relevant period. In addition, Mr. Kalaci provides details regarding a “Cultural Training Session” offered by the Owner in December 2015 [para 44], a copy of a cultural competence presentation [Exhibit 19] and a copy of a “Culture Quiz” [Exhibit 20], both displaying the Mark, which were used in client training sessions and seminars during the relevant period.

[37] Consequently, and as conceded by the Requesting Party at the hearing, the evidence shows that the Owner performed and advertised cultural consulting services in association with the Mark in Canada, during the relevant period. I am therefore satisfied that the Owner has shown use of services (4) within the meaning of sections 4(2) and 45 of the Act.

Services (5) – Web development services

[38] As was the case for consulting services, Mr. Kalaci states that the Owner typically provides services (5), namely web development services, “in the course of providing translation services rather than as stand-alone services” [para 47]. Mr. Kalaci states that, during the relevant period, the Owner assisted Symbility Solutions in “web and software development projects” and provided “similar services” to another client, namely 9thCO [paras 50-51].

[39] According to Mr. Kalaci, the Owner generated earnings of about \$40,000 annually providing “web services to approximately 20 clients, mostly in Canada” [para 49]. In support, he provides invoices issued to Symbility Solutions [Exhibit 21] and to 9thCO Inc. [Exhibit 22].

[40] As one example of web development services, Mr. Kalaci explains that, in 2015, the Owner’s client Salus sought assistance in the preparation of multilingual versions of an “automotive application” and provides a bundle of documents in support [para 52, Exhibit 23]. The exhibited bundle of documents includes an e-mail sent by Jerad Acosta to Mr. Kalaci on October 19, 2015 providing information on the work to be performed by the Owner as well as “deliverable types”. The e-mail contains an example of what the sender describes as the “ideal format to work in”, namely the “JSON” programming language, as well a dozens of lines of code, presumably written in that language. The exhibit also includes a price quote issued to Salus on October 20, 2015, which mirrors information given in the e-mail, namely that “JSON uses a Key:Value system” and that Salus would like to “have all of [its] ‘Values’ for the consumer.json file translated into the covered languages”.

[41] The Requesting Party argues that there is no evidence that Owner provided services which “could even generously be interpreted as ‘web development services’”. According to the

Requesting Party, the Owner has merely shown that it translated an “existing website copy into different languages”.

[42] In my view, the services described by Mr. Kalaci as the Owner’s web development services involve more than mere translation of website content. For instance, a fair reading of the Exhibit 23 e-mail correspondence indicates that the Owner’s services include working with source code in at least one programming language.

[43] In any event, I accept Mr. Kalaci’s clear statements that the Owner provided web development services and assisted its clients with “web and software development projects” at face value [per *Oyen Wiggs Green*]. His statements are unequivocal and are consistent with the Owner’s website as well as marketing materials which advertise services identified therein as “web development” (“*création de sites Web en plusieurs langues*” in French), “web design” and “desktop publishing” services.

[44] In view of the foregoing, I am satisfied that the Owner has shown use of the Mark in association with services (5) within the meaning of sections 4(2) and 45 of the Act.

Services (6) – Notary services

[45] Mr. Kalaci attests that the Owner provided “authentication and certification services in Canada” and that these services were also often provided “in the course of providing translation services rather than as stand-alone services” [para 53]. In particular, he explains that the Owner “typically provides affidavits and notarizations of the translated documents, as may be required by governmental or judicial authorities”, and that such services are either provided “in-house or through notary publics [the Owner] engages” [para 55]. During the relevant period, the Owner provided “notarization services” to “mostly-Canadian clients” about 100 times every year, generating earnings of about \$10,000 to \$15,000 per year [para 56].

[46] In support, Mr. Kalaci provides invoices for translation services which also include the items “Affidavit of Translation with Certification” or “Affidavit with certification”. He refers to these as invoices for “notarizations”.

[47] I also note, on certain webpages advertising translation services, a section entitled “build confidence through certification and authentication”, which explains that the Owner can provide the following documents to accompany its translations: a “certificate of translation, affidavit of translation or legal opinion of translation”.

[48] According to the Requesting Party, the services in evidence do not correspond to the plain meaning of the term “notary services”. The Requesting Party argues that providing affidavits and notarizations of translated documents is not the performance of “notary services” as that description would be commonly understood, because the “Owner does not notarize its customers’ documents to verify those documents’ accuracy, but rather provides affidavits attesting to the accuracy **of its own translations**” (emphasis in original). The Requesting Party also submits that the evidence makes unclear whether the services were performed by the Owner or by a third party.

[49] I do not accept the Requesting Party’s argument that “notary services” are limited to the verification of the accuracy of documents. In my view, “notary services” can be understood to include authentication and certification services, such as certifying the authenticity of a document copy, or authentication of the identity of a person making statements in an affidavit. This is consistent with the Owner’s evidence, including Mr. Kalaci’s description of notary services as “authentication and certification” as well as the Owner’s pamphlet advertising “in-house certification of translations” and “legal notarization of documents”.

[50] I therefore accept that the Owner not only advertised notary services, but also that such services were provided to the Owner’s clients in Canada during the relevant period. Further, in my view, there is no reason to conclude that these services were provided by third parties; Mr. Kalaci’s statement is clear that the Owner provides notary services “in-house” or through notary publics the Owner “engages” (*i.e.* hires).

[51] As such, I am satisfied that the Owner has shown use of the Mark in association with services (6) within the meaning of sections 4(2) and 45 of the Act.

Services (7) – International document verification services

[52] With respect to services (7), “International document verification services, namely, providing opinions as to the legitimacy of foreign issued documents”, Mr. Kalaci attests that the Owner “was engaged approximately 50 times in verifying the authenticity of foreign students’ credentials” during the relevant period [para 60]. In particular, the Owner translated and verified the authenticity of foreign-issued documents as part of its responsibilities as an agent for the University of Windsor in recruiting international students [paras 57-58].

[53] In support, Mr. Kalaci provides invoices issued to the University of Windsor [Exhibit 25] and to George Brown College [Exhibit 26]. At paragraph 57 of his affidavit, he also provides an excerpt of a contract with the University of Windsor setting out the Owner’s responsibilities, including to advise the University if the Owner detects or suspects any fraudulent documentation submitted by student applicants. According to Mr. Kalaci, the Owner entered into “a similar arrangement” with George Brown College in 2017 [para 59].

[54] The Requesting Party focuses its submissions on the following points: (i) the Owner failed to include a copy of the complete contract with the University of Windsor; (ii) in the absence of such a copy, it is not possible to “assess the accuracy” of the contract text excerpted in Mr. Kalaci’s affidavit, or whether the documentary evidence furnished (such as e-mails between the Owner and the University) actually relate to the services provided by the Owner under that contract; and (iii) notwithstanding the previous points, even the existence of a contract does not prove that the services were provided, and the Owner failed to furnish evidence that document verification services “were ever performed for any customer in Canada during the relevant period, including the University of Windsor”. At the hearing, the Requesting Party also indicated that if any services were performed by the Owner for the academic institutions, these were student recruitment services and not “document verification” services.

[55] In my view, the Requesting Party takes the incorrect approach of isolating individual pieces of evidence, such as the contract excerpt and the exhibited e-mails. Given the relatively low evidentiary threshold in section 45 proceedings, such focusing on individual pieces of

evidence in isolation is not the proper approach [see *Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB); and *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB)].

[56] I find that, when considered as a whole, the evidence before me is sufficient to establish use of the Mark in association with services (7). In this respect, it was unnecessary to provide a full copy of the contract with the University of Windsor.

[57] In this case, Mr. Kalaci attests that, during the relevant period, the Owner “translated and verified the authenticity of foreign-issued documents” and explains that this service was provided in the context of its responsibilities as a student recruiting agent. He not only provides an excerpt of the contract with the University of Windsor, setting out some of the Owner’s responsibilities, he also provides the approximate number of times the Owner verified the authenticity of foreign students’ credentials during the relevant period.

[58] That evidence, together with the Exhibit 25 and 26 invoices, are sufficient for me to conclude that the Owner has shown use of the Mark in association with services (7) within the meaning of sections 4(2) and 45 of the Act.

Services (8) – Software as a service (SAAS) provider in the field of language translation; providing telephone call centre and contact centre services.

[59] With respect to services (8), I first note that the Owner conceded non-use with respect to “providing telephone call centre and contact centre services”. As no special circumstances have been evidenced which would excuse the absence of use of the Mark, those services will be deleted from the registration.

[60] As for the remaining portion of services (8), namely “Software as a service (SAAS) provider in the field of language translation”, Mr. Kalaci attests that the Owner “provided Software as a service (SAAS) in the field of language translation in Canada” during the relevant period [para 61]. In particular, Mr. Kalaci asserts that the Owner offered “its clients in Canada the use of an online translation management tool called Plunet” which “provides clients with

credentials they can use to log on to the system, submit their translation requests and monitor their progress” [para 62]. Mr. Kalaci explains that the Owner “does not invoice Canadian clients for the use of this software interface, but it promotes it as a convenient means to interact with the [Owner]” [para 63].

[61] In support, Mr. Kalaci attaches Exhibit 27 which consists of “a screenshot of the ALEXA TRANSLATIONS-branded client interface, a typical exchange with a client offering access to this service dated November 13, 2015, and a copy of the software’s user guide” [para 62]. The Mark is displayed throughout these materials.

[62] I note that the exhibited client interface includes a “Dashboard” of the client’s requests, quotes and orders and a drop-down menu labeled “Create a request”. The exhibited e-mail provides logon credentials to access the Owner’s “Customer Portal” as well as “instructions on how to use [the Owner’s] translation management system”. Lastly, the exhibited user guide provides instructions on using the portal. For example, the guide provides the url address to access the portal, namely *alexaplunet.net*, and how to request a quote, place an order for services such as “translation”, “notarization” and “formatting”, and how to browse pending and completed orders.

[63] Although the Owner also furnished evidence regarding machine translation services and a translation memory software called Memsources, the Owner confirmed at the hearing that it only relies on the Plunet evidence to establish use of the Mark in association with the services “Software as a service (SAAS) provider in the field of language translation”.

[64] There is no dispute as to the nature of the Plunet tool, which is essentially an online client platform or portal, allowing the Owner’s clients to submit their translation project requests, receive quotes and monitor the status of orders.

[65] However, according to the Requesting Party, providing access to the portal does not constitute provision of SAAS. In this respect, it submits that the Owner’s customers are not invoiced for their access to Plunet and that there is no evidence showing that the Owner provides

software to its customers. Instead, the Requesting Party submits, the Owner is merely using third-party software in the course of conducting its business, and this software is a tool which benefits only the Owner.

[66] To begin, the fact that customers were not specifically charged for their access to the portal is inconsequential in this case. It is well established that a service does not need to be performed for money in order for it to be within the scope of section 4(2) of the Act [see *War Amputations of Canada v Faber-Castell Canada Inc* (1992), 41 CPR (3d) 557 (TMOB) at 562]. The law is also clear that so long as some members of the public, consumers or purchasers, receive a benefit from an activity, it is a service [*Miller Thomson LLP v Hilton Worldwide Holding LLP*, 2020 FCA 134].

[67] I am not prepared to accept the Requesting Party's argument that the portal only benefits the Owner. Given the evidenced functionalities of the portal, including Mr. Kalaci's reference to customers being able to "monitor the progress" of their translation requests, I am satisfied that customers receive a benefit from their access to Plunet.

[68] As for whether providing access to Plunet corresponds to the registered services, I note that Mr. Kalaci specifically correlates the Owner's activities in relation to the Plunet portal as "Software as a service (SAAS) provider in the field of language translation". In my view, this characterization is reasonable and consistent with the evidence. As was the case in relation to the other registered services, I accept Mr. Kalaci's sworn statement at face value [per *Oyen Wiggs Green*].

[69] It is settled law that the burden on the registered owner of a trademark is not a heavy one in section 45 proceedings, and that the owner need only establish a *prima facie* case of use within the meaning of section 4 of the Act [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at paras 2 and 9]. As services are to be interpreted broadly, I conclude that the Owner has met its light burden in this case.

[70] As such, for the purposes of this proceeding, I am satisfied that the Owner has shown use of the Mark in association with the first portion of services (8), namely “Software as a service (SAAS) provider in the field of language translation”, within the meaning of sections 4(2) and 45 of the Act.

Disposition

[71] 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 entirety of the registered goods, as well as “providing telephone call centre and contact centre services”.

[72] The registration will be maintained with respect to services (1) through (7), as well as the “Software as a service (SAAS) provider in the field of language translation” portion of services (8).

Eve Heafey
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: October 28, 2021

APPEARANCES

Vincent de Granpré

For the Registered Owner

David Bowden

For the Requesting Party

AGENTS OF RECORD

Osler, Hoskin & Harcourt LLP

For the Registered Owner

Clark Wilson LLP

For the Requesting Party