



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2022 TMOB 250

**Date of Decision:** 2022-12-09

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

**Requesting Party:** Norton Rose Fulbright Canada LLP/S.E.N.C.R.L.,S.R.L.

**Registered Owner:** Victor Ng

**Registration:** TMA950,193 for EXOCLOUD

### **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. TMA950,193, for the trademark EXOCLOUD (the Mark).

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

(1) Cloud computing services, namely, cloud hosting in the nature of scalable and interoperable hosting of: computer software, Internet websites, Internet web software applications, electronic databases, digital content, general storage of data, and business computer software applications of others that are accessible via the Internet (Services 1);

(2) Technical support services in the field of cloud computing services, namely, administration, management and troubleshooting in the nature of service desk/help desk services, providing dedicated service desk/help desk personnel, troubleshooting of

computer software and network problems, and diagnosing of computer hardware problems (Services 2);

(3) Customer service in the nature of providing advice and information concerning solutions to business problems or concerns in the field of cloud computing (Services 3).

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

### **THE PROCEEDING**

[4] On September 2, 2021, at the request of Norton Rose Fulbright Canada LLP/S.E.N.C.R.L.,S.R.L., the Registrar of Trademarks issued a notice pursuant to section 45 of the Act to Mr. Victor Ng (the Owner).

[5] The notice required the Owner to show whether the Mark was used in Canada in association with 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 the Mark was last in use and the reason for the absence of use since that date. In this case, the relevant period for showing use is between September 2, 2018 and September 2, 2021 (the Relevant Period).

[6] The relevant definition of “use” in the present case 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.

[7] In response to the Registrar’s notice, Mr. Ng submitted an affidavit that he swore on December 1, 2021.

[8] Only the Owner submitted written representations and no hearing was held.

### **THE OWNER’S EVIDENCE**

[9] The owner of the Mark, Mr. Ng, is also the Founder and CEO of Amplus Innovations Inc. (Amplus) [para 1] as well as its sole director and shareholder,

President, Secretary and Treasurer [paras 5 and 6, Exhibits B and C]. Both the Owner [Exhibit A] and Amplus [Exhibit B] are located in Ontario.

[10] Mr. Ng has licensed the Mark to Amplus by signing a “Trademark Authorization Letter” [para 7 and Exhibit D]. Mr. Ng states that he has day to day control and supervision of the services offered by Amplus, including those offered in association with the Mark during the Relevant Period [paras 6, 8 and 9].

[11] During the Relevant Period, Amplus provided various cloud computing services that it described as a “managed hybrid cloud platform that allows users to build their IT systems on a virtual environment” and “access their IT systems from any device anywhere with internet access” [para 18 and Exhibit G].

[12] Mr. Ng provided exhibits showing how the services were advertised during the Relevant Period, and a sample invoice:

- (a) Printouts of the website *exocloud.ca*: Exhibit F consists of printouts from the website operated by Amplus from the Wayback Machine dated during the Relevant Period. The pages describe and advertise features of Amplus’ services including virtual servers, files sharing portal, online backup and disaster recovery, virtual desktop, Microsoft exchange hosting, dedicated Microsoft server as well as list various packages of services it offers (secure file sharing, collaboration, value start, business). The Mark appears numerous times in the description of the services and in the service tag line “EXOCLOUD – Reach New Heights”. Mr. Ng states that these web pages promote the service 1 and 3 [paras 14 and 15]. Exhibit G consists of printouts also from *exocloud.ca*, the FAQ and Support sections, from the Wayback Machine dated during the relevant period. The printouts explain that EXOCLOUD is a managed hybrid cloud platform, describe and list the various package of support packages it offers with pricing, and explain how to reach its help desk services. The Mark appears several times on each printout. Mr. Ng

states that “this shows the use of EXOCLOUD in association with Services 1, 2 and 3” [paras 18, 19 and 20].

- (b) Flyer “EXOCLOUD – Reach New Heights”: Exhibit E shows many of the features of Amplus’ cloud computing services (listed above) and explains the benefits of EXOCLOUD services (minimal downtime, low and flexible cost, agile, etc.) The Mark is prominently displayed on each page of the flyer. Mr. Ng states that this flyer was distributed to potential clients in person and by email throughout the Relevant Period, and that it advertises Services 1 and Services 2 [para 10].
- (c) Invoice: An invoice from Amplus to a customer located in Newmarket, Ontario during the Relevant Period [Exhibit H] lists “Virtual Servers”, “Virtual Workstations”, Backup and Disaster Recovery”, and “Secured File Sharing Portal”, and the Mark appears alongside each of these services. The invoice also lists “Managed IT Services”. Mr. Ng states that these services correspond to Services 1 and 2 [para 23].

[13] Mr. Ng also states that “At all times during the last three years, Amplus has been ready, willing and able to offer all of services 1, 2 and 3 in Canada” [para 22].

### **ANALYSIS AND REASONS FOR DECISION**

[14] The threshold for establishing use in the context of section 45 proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)]. Evidentiary overkill is not required [*Union Electric Supply Co Ltd v Canada (Registrar of Trademarks)* (1982), 63 CPR (2d) 56 (FCTD)]. Despite this, 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)].

### ***Use Under License***

[15] As stated by the Federal Court, there are three main methods by which a trademark owner can demonstrate the requisite control pursuant to section 50(1) of the

Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of the licence agreement that provides for the requisite control [*Empresa Cubana Del Tabaco Trading v Shapiro Cohen*, 2011 FC 102 at para 84, aff'd 2011 FCA 340]. In this case, the evidence establishes that Mr. Ng has day to day control over the operations of Amplus, including the provision of the services it offers under the Mark [para 6] and that he signed a "Trademark Authorization Letter" [para 7 and Exhibit D] with Amplus.

[16] Furthermore, when considering whether the evidence demonstrates the requisite control, an inference may be drawn that such control exists, for example, where an individual is a director or an officer of both the registered owner and the alleged licensee [see *Petro-Canada v 2946661 Canada Inc* (1998), 83 CPR (3d) 129 (FCTD); *Lindy v Canada (Registrar of Trademarks)*, [1999] FCJ No 682 (FCA)]. In this case, the Owner is also the founder and CEO of Amplus [para 1] as well as its sole director and shareholder, President, Secretary and Treasurer [paras 5, 6].

[17] In view of the aforementioned, I am satisfied that any evidenced use of the Mark by Amplus in association with the services, is to the Owner's benefit.

### ***Use of the Mark***

[18] It is well established that the display of the trademark in the advertisement of the services is sufficient to satisfy the requirements of section 4(2) of the Act, from the time the owner of the trademark is willing and able to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[19] Evidence in a section 45 proceeding must be considered as a whole and focusing on individual pieces of evidence in isolation is not the proper approach [see *Kvas Miller Everitt v Compute (Bridgend) Ltd* (2005), 47 CPR (4th) 209 (TMOB); and *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB)].

[20] In this case, Mr. Ng provided evidence of advertisement of all the services on the website and with the distribution of flyers [Exhibits E, G and H], a clear statement on his ability and willingness to provide all the services [para 22], and an invoice showing a sale of some of the services [Exhibit H], all in Canada and during the Relevant Period. In view of the foregoing, I am satisfied that the Owner has shown use of the Mark in Canada within the meaning of sections 4 and 45 of the Act, in respect of all services listed in the registration.

**DISPOSITION**

[21] 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 maintained.

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Martin Béliveau  
Chairperson  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** No hearing held

## **AGENTS OF RECORD**

**For the Requesting Party:** Norton Rose Fulbright Canada

LLP/S.E.N.C.R.L.,S.R.L.

**For the Registered Owner:** Alexander J. Stack