



# Canadian Intellectual Property Office

## THE REGISTRAR OF TRADEMARKS

**Citation:** 2024 TMOB 67

**Date of Decision:** 2024-03-28

## IN THE MATTER OF OPPOSITIONS

**Opponent:** Asset Pro Solutions Inc dba Maintenance Connection Canada

**Applicant:** Maintenance Connection, LLC

**Application:** 1,802,565 for MAINTENANCE CONNECTION

1,802,568 for MAINTENANCE CONNECTION & Design

1,907,433 for MAINTENANCE CONNECTION

1,907,427 for MAINTENANCE CONNECTION & Design

## INTRODUCTION

[1] Asset Pro Solutions Inc dba Maintenance Connection Canada (the Opponent) opposes registration of the trademarks MAINTENANCE CONNECTION that are the subject of application Nos. 1,802,565 and 1,907,433 and the trademarks MAINTENANCE CONNECTION & Design, shown below, that are the subject of application Nos. 1,802,568 and 1,907,427.



[2] Application Nos. 1,907,433 and 1,907,427 were filed by Maintenance Connection, LLC (the Applicant), and application Nos. 1,802,565 and 1,802,568 were filed by the Applicant's predecessor in title and now stand in the name of the Applicant. For ease of reference, I will generally refer to Maintenance Connection, LLC and its predecessors in title collectively as the Applicant unless it is necessary to distinguish between them.

[3] All of these applications for the trademarks MAINTENANCE CONNECTION and MAINTENANCE CONNNECTION & Design (collectively, the Marks) are generally listed for use in association with downloadable computer software for maintenance management, and related services including training in the use and operation of maintenance software and providing online non-downloadable computer software for maintenance management. A full listing of the goods and services associated with the Marks is set out in Schedule A to this decision.

[4] For the reasons that follow, the oppositions are rejected.

### **THE RECORD**

[5] The applications for the Marks were filed and opposed at two different times. Specifically:

- Application Nos. 1,802,565 and 1,802,568 for the trademarks MAINTENANCE CONNECTION and MAINTENANCE CONNECTION & Design, respectively, were filed on September 29, 2016, with a priority filing date of March 30, 2016 based on a US application in association with the same kinds of goods and services. These applications were advertised in the *Trademarks Journal* dated May 6, 2020.
- Application Nos. 1,907,433 and 1,907,427 for the trademarks MAINTENANCE CONNECTION and MAINTENANCE CONNECTION & Design, respectively, were filed on July 3, 2018, with a priority filing date of June 26, 2018, based on a US application in association with the same kinds of goods and services. These applications were advertised in the *Trademarks Journal* dated September 30,

2020, and October 21, 2020, respectively. These two applications include a claim of use in Canada since at least as early as 2006.

[6] On May 13, 2020, the Opponent filed, against the '565 and '568 applications, statements of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The Opponent filed statements of opposition against the '433 and '427 applications on November 5, 2020. The grounds of opposition pleaded against each application are identical and are based on non-entitlement to register under section 38(2)(c), non-compliance with sections 38(2)(a), 38(2)(e) and 38(2)(f), and bad faith under section 38(2)(a.1) of the Act.

[7] The Applicant filed and served counter statements denying the grounds of opposition for all four proceedings.

[8] In each proceeding, the Opponent filed the affidavit of Peter Horwood, the President of the Opponent. Mr. Horwood was cross-examined and the transcript and answers to undertakings form part of the record.

[9] The Applicant filed the affidavit of Andrew Ruse, who at the time of swearing the affidavit (November 11, 2021) was the President of Accruent, LLC (Accruent), a company which acquired the Applicant in June 2018. Prior to serving as an officer of Accruent, Mr. Ruse was executive Vice President of Sales at the Applicant from June 2017 to January 2019. Mr. Ruse was cross-examined on his affidavit; however, the Applicant takes issue with the cross-examination and the admissibility of the accompanying transcript and answers to undertakings. Notwithstanding the Applicant's objection, which is discussed below, I consider them to form part of the record.

[10] Both parties filed written representations and no hearing was held.

[11] As the issues and evidential record are effectively identical for all the cases, all four matters are discussed in this decision.

## **PRELIMINARY REMARKS**

[12] I wish to point out that while I have considered all the evidence and submissions of record, I will only be specifically referring to portions which are directly relevant to my findings.

### ***Applicant objects to the admissibility of the transcript and answers to undertakings from the cross-examination of Andrew Ruse***

[13] The Applicant, having previously objected to the admissibility of the transcript and answers to undertakings arising from the cross-examination of Mr. Ruse, maintains and repeats its objection. The Applicant submits that the Opponent should not have been permitted to conduct the cross-examination since its request for an order to cross-examine was submitted after the Registrar had issued notices for written representations. A key issue appears to be the Registrar's decision to deem the date of service of the Applicant's evidence (the Ruse affidavit) as the date the Opponent clicked on the electronic link to a file sharing platform to get the affidavit which was provided in the body of an email instead of the date the Applicant sent this email (receipt of which was promptly confirmed by the office of the Opponent's agent of record). The former date occurred after the Registrar issued a notice for written representations.

[14] As the Registrar has already declined to reconsider its ruling on this issue (per the Registrar's letter dated April 7, 2022) and such ruling is final, it will not be discussed further. In any event, I note that the inclusion of these documents does not materially affect my conclusion on any of the grounds of opposition.

### ***Hearsay objection to portions of the Horwood affidavit (Exhibit B)***

[15] Exhibit B to the Horwood affidavit includes a seven-page document, in letter format, from a Mr. Schoepfer, dated November 5, 2020 (the Schoepfer letter) (cross at Q48). Mr. Schoepfer was a founding member of the Opponent and was primarily its president until sometime in 2019 (Q49-52). The Schoepfer letter sets out his account of the history of the business relationship between the parties. The letter also provides details of conversations that Mr. Schoepfer says he had with Mr. Bucher and Mr.

Squires (founding members of Maintenance Connection, Inc, the predecessor in title of the Applicant).

[16] The Applicant takes the position that the Schoepfer letter constitutes inadmissible hearsay, and in some cases, double hearsay. The Applicant submits that the content of Mr. Schoepfer's letter is of the type that would typically be found in an affidavit but notes that cross-examination of Mr. Schoepfer is not possible given the way the information has been adduced. The Applicant further notes that the letter contains some bare and uncorroborated statements dating back almost 18 years, and that Mr. Horwood, during his cross-examination, even disagrees with portions of Mr. Schoepfer's letter relating to his recollection of the early years of the relationship between the parties. Finally, the Applicant points out that Mr. Horwood was able to contact Mr. Schoepfer about providing evidence, that Mr. Schoepfer agreed to provide the letter (Q55, 56), and that Mr. Horwood does continue to be in contact with Mr. Schoepfer, albeit rarely (Q58).

[17] I agree that the entirety of the Schoepfer letter constitutes hearsay, and that there appears to be no reason why this letter could not have been entered into the record as an affidavit, thus providing the Applicant with an opportunity for cross-examination. Accordingly, I am disregarding the Schoepfer letter on the basis that it is inadmissible hearsay evidence.

***Awarding costs – Registrar does not have authority***

[18] In its written representations, the Opponent submits that it should be entitled to a payment of costs in an amount to be determined by the Registrar. For its part, the Applicant indicates that it intends to seek costs in these four oppositions but recognizes that the Registrar's authority to award costs in an opposition has not yet come into force at the time of submission of its written representations.

[19] I note that as of the date of this decision, the Registrar does not have authority to award costs in opposition proceedings. Accordingly, I will not discuss it further.

## **LEGAL ONUS AND EVIDENTIAL BURDEN**

[20] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the applications comply with the requirements of the Act. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all the evidence, then the issue must be decided against the Applicant. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

## **ANALYSIS OF THE GROUNDS OF OPPOSITION**

### ***38(2)(c) and 16(1)(a) ground of opposition – non-entitlement***

[21] As I understand it, the Opponent's position is that it is entitled to registration of the Marks as it is the earliest user of the applied-for Marks in Canada. The Applicant does not dispute that the Opponent is the earliest user of the Marks in Canada. Rather, the Applicant's position is that because the Opponent is its Canadian distributor, any use of the Marks by the Opponent enures to the benefit of the Applicant as the trademark owner. As such, the contentious issue is not whether the Opponent is the earlier user of the Marks in Canada, but whether it is the rightful owner of the Marks such that the Opponent's use of the Marks can be deemed to be for its own benefit. This is the focus of my analysis.

[22] The Opponent pleads that the Applicant is not the person entitled to registration of the Marks since, at the time of filing the applications, "the Applicant had direct and complete knowledge of the Opponent and the Opponent's use of the subject Marks in Canada in association with the same goods and services that are described in the subject applications."

[23] The material date under this ground of opposition is, as set out in section 16(1) of the Act, "the filing date of the application or the date of first use of the trademarks in Canada, whichever is earlier." Under this ground, the Opponent must also show that its trademarks were not abandoned at the dates of advertisement of the applications.

Evidence regarding the relationship between the parties

[24] At the outset, it is helpful to note the following individuals that feature prominently in the evidence:

- Chris Bucher and Brad Squires: they were the founders of the business that created the MAINTENANCE CONNECTION software, which was later acquired by the Applicant.
- Raymond (Ray) Schoepfer: he was a founding member of the Opponent. Up until his retirement in 2019 he was a 50% owner of the company and was its president for most of the time.
- Peter Horwood: he was a partner in the Opponent's business and became the president when Mr. Schoepfer retired in 2019.

[25] The earliest piece of evidence that speaks to the origin and nature of the parties' relationship is a set of emails dated April 16, 2003, reproduced below, from Chris Bucher to Ray Schoepfer (Exhibit A, Horwood affidavit). Mr. Schoepfer, at the time of writing these emails, was employed by an IT company in Western Canada and was leaving that company with the aim of starting a company providing asset management systems to customers in Western Canada. Mr. Schoepfer contacted Mr. Bucher to indicate his interest in Mr. Bucher's dealer program, presumably for the MAINTENANCE CONNECTION asset management system software. Mr. Bucher thanked Mr. Schoepfer for his interest in Maintenance Connection and advised that he would call him concerning becoming a dealer in his area. I note that the MAINTENANCE CONNECTION design trademark appears in the header of Mr. Bucher's reply email and reference is made to Maintenance Connection by Mr. Bucher in the text of the email and in the footer:

-----Original Message-----

**From:** Chris Bucher [mailto:cbucher@maintenanceconnection.com]  
**Sent:** April 16, 2003 10:35 AM  
**To:** Ray Schoepfer  
**Subject:** Maintenance Connection (Web-Based CMMS)

## Maintenance

Connection

Hi Ray-

Thank you for your interest in Maintenance Connection. Please provide your phone number and I will call you concerning becoming a dealer in your area.

Best regards,

Chris Bucher  
Business Development  
1-888-567-3434 ext 84  
[cbucher@maintenanceconnection.com](mailto:cbucher@maintenanceconnection.com)

Maintenance Connection  
<http://www.maintenanceconnection.com>

----- Original Message -----

**From:** "Ray Schoepfer" <[rays@arendeeco.com](mailto:rays@arendeeco.com)>  
**To:** <[sales@maintenanceconnection.com](mailto:sales@maintenanceconnection.com)>  
**Sent:** Wednesday, April 16, 2003 8:55 AM  
**Subject:** Maintenance Connection

> Hello:

>

> My name is Ray Schoepfer.

>

> I am currently employed by Hansen Information Technologies in Western  
> Canada.

>

> I will be leaving the company soon with the intention of starting a company  
> that will provide asset management systems to medium sized municipalities  
> and possibly, businesses, in Western Canada.

>

> I would be interested in your dealer program and having a chance to better  
> evaluate your product, specifically with underground assets in mind.

>

[26] With this as a starting point, a summary of the most pertinent portions of the evidence is set out below. For the purposes of this summary, please note that I generally refer to both the Applicant and its predecessor in title as the Applicant.



[27] The Horwood affidavit provides, on behalf of the Opponent, an account of the parties' relationship and the Opponent's use of the Marks, including the following.

*The Maintenance Connection mobile product*

- Following the Opponent's appointment as dealer of the Applicant's MAINTENANCE CONNECTION software, Mr. Horwood states that the Opponent wanted to structure itself so that it could create a variety of Palm operating system applications, one of which was the Maintenance Connection mobile phone app (referring to email of June 2, 2003). It later introduced the Maintenance Connection Mobile product. Mr. Horwood refers to an email (dated November 18, 2003) from Chris Bucher and Brad Squires allegedly showing that "not only did (they) clearly know we were claiming ownership of "Maintenance Connection Mobile" but they approved it and congratulated us on it." (Exhibit A)
- Mr. Horwood refers to an email from Chris Bucher flagging a bug in the Maintenance Connection Mobile Product (email dated 2003.11.26). Mr. Horwood submits this shows that "he (Mr. Bucher) accepted us calling it "Maintenance Connection Mobile" because he expressed no concern about it..." (Exhibits A, B)

*Asset Pro's adoption of Maintenance Connection Canada and the MAINTENANCE CONNECTION CANADA logo (MCC logo)*

- Mr. Horwood refers to an email (dated October 26, 2004) from Mr. Schoepfer to Mr. Bucher where reference is made to the "first attempt at a logo". In the email, Mr. Schoepfer proposes that:
  - "- we still maintain Asset Pro as the legal identity but start using Maintenance Connection Canada as the trade name with the MCC logo (some version that everybody is happy with) as the only logo (APS [Asset Pro Solutions] logo below will be phased out). We will have to figure out how we want to structure websites and general marketing to present a single unified brand to all prospects world wide.
  - as MCC, we will take full responsibility for all marketing, dealers, agents, technical support, training, etc for everything that happens in Canada...
- Mr. Horwood refers to an email dated November 2, 2004, from Ray Schoepfer to Chris Bucher and Brad Squires with the subject line "logos". It sets out three

logos for MAINTENANCE CONNECTION CANADA and asks “which one do you guys like, 1, 2, or 3?” (Exhibit A). Mr. Horwood notes that “not only did Chris Bucher approve of us having a Maintenance Connection logo, he helped make it look even more like the US version that was in use from 2003 to 2010.”

- Mr. Horwood notes that Mr. Bucher’s version changed the word “Canada” to orange.
- Mr. Horwood notes that “in both the design we showed (sent) Chris Bucher, and the one he returned with his changes, the “Maintenance Connection” part had a symbol claiming it was our trademark.” ... “Chris Bucher raised NO objection then, or at any time in the future, to our clearly marking it showing that we considered that our trademark...”

*MC Everywhere Product (by Opponent) – Review of product by Applicant*

- My understanding is that the MC Everywhere product, created by the Opponent, is an extra or ‘add-on’ product to the Applicant’s MAINTENANCE CONNECTION software system that supplements its functionality. Specifically, MC Everywhere is designed to facilitate access for technicians that require offline access (from product overview at Exhibit A)
- Mr. Horwood refers to an email from Arlene Roberg, a project manager with the Applicant to Mr. Schoepfer and Mr. Horwood. Mr. Bucher is cc’d on the email. Ms. Roberg attaches a document with a list of suggestions (highest and lowest priority) compiled by the Applicant for the Opponent’s MC Everywhere product.
- Mr. Horwood flags that among the high priority suggestions from the Applicant is that “it would be optimal to add some branding (Maintenance Connection or MC Everywhere logo/naming displayed). E.g. logo on menu dropdown.” Mr. Horwood notes that “so, as of 2013.11.19, they still didn’t object to our use of the trademark as ours and encouraged us to use it even more openly and boldly.” (Exhibit B).

[28] Exhibit D includes copies of invoices from the Opponent to various customers dated between April 12, 2005, and October 10, 2006. The April 12, 2005, invoice covers the sale of: 'Maintenance Connection Concurrent licenses' and 'Support services.' Mr. Horwood states that this exhibit shows several examples of invoices in the name of MAINTENANCE CONNECTION CANADA being the tradename or business name employed by and used by the Opponent since at least as early as 2003.

[29] Exhibit E is described as a true copy of an invoice issued by the Applicant to the Opponent dated March 6, 2014, for sale commissions owing by the Applicant to the Opponent for the 3rd and 4th quarter of 2013. Mr. Horwood states that "[t]he Opponent acted as the true and lawful sales agent/representative of the Applicant since at least as early as 2003 in Canada" and that this exhibit is "but one example of the full knowledge and acceptance that the Applicant had of the Opponent's use of the trademark MAINTENANCE CONNECTION CANADA come up through the relationship between the Applicant and the Opponent." (para 8).

[30] Exhibit H is described as a copy from the Way back Machine "confirming that the claim by the Applicant to the use of the trademark MAINTENANCE CONNECTION AND DESIGN as early as 2006 is a false statement" (para 11). The exhibits appear to include archived snapshots from the *maintenanceconnection.com* website dated 2006 and 2010, with the applied-for design mark appearing only in the 2010 snapshots.

[31] Mr. Horwood states that the Opponent has invested considerable effort, time, and expense in using and promoting the use of the trademark MAINTENANCE CONNECTION in Canada all with the full and complete knowledge and consent of the Applicant, and that at no time did the Applicant ever question or object to the use by the Opponent of the said trademark. Mr. Horwood further states that the Applicant encouraged the Opponent to begin using the trademark MAINTENANCE CONNECTION in Canada at least as early as 2003 as the authorized representative and agent in Canada of the Applicant (para 13). Exhibit I is described as a copy of a letter sent by Mr. Horwood to the Applicant on March 12, 2020 giving the history of the use by the Opponent of the trademark MAINTENANCE CONNECTION in Canada with

the consent of the Applicant. I note that in this letter, the Opponent makes reference to the dispute between the parties and proposes some options for moving forward.

[32] Mr. Horwood states that “since at least as early as 2003, the Applicant and the Opponent have carried on business in a cooperative fashion, each using the trademark which is the subject of this application. Specifically, the Applicant has installed their software on the Opponent’s servers and the Opponent has installed the Applicant’s software on the Applicant’s servers, all with the express consent of the Applicant and the Opponent.” (para 14).

[33] Mr. Horwood states that the Applicant has throughout this period sold the Opponent’s software and paid the Opponent a license fee as negotiated between the Applicant and the Opponent and the Opponent has likewise sold the Applicant software and paid the Applicant a license fee as negotiated between the Applicant and the Opponent (para 15).

[34] Additional facts and admissions obtained during Mr. Horwood’s cross-examination are noted below:

- The Applicant registered the business name ‘Maintenance Connection Canada’ with the Government of Alberta on January 26, 2012, and identifies the commencement date of use of the trade name as June 10, 2003 (Q30-37). Mr. Horwood is not aware of any earlier business name registrations for Maintenance Connection Canada registered by the Applicant (Q38).
- Mr. Horwood agrees that the Opponent, in one capacity, acts as the Applicant’s Canadian dealer (Q67). In its other capacity, the Opponent develops products that are compatible with the software product that it acts as dealer for (Q69).
- Mr. Horwood acknowledges that the Opponent would probably not have chosen a name for one of its products that the Applicant objected to (Q88).
- Mr. Horwood agrees with the statement, posted on the Opponent’s website, *maintenanceconnection.ca*, that “Maintenance Connection Canada is the

exclusive Canadian distributor of Accruent LLC's 'Maintenance Connection' line of software.", and understands Accruent LLC to be the owner of the Applicant in this proceeding (Q122-124, Exhibit 10).

- Mr. Horwood agrees with the statement, posted on the Opponent's website, *maintenanceconnection.ca*, that "Maintenance Connection Canada is the exclusive Canadian Distributor of Tigre de Soleil Inc.'s 'Maintenance Connection Everywhere', 'Maintenance Connection LoginHub' and 'Maintenance Connection DataHub' lines of software." (Q125, 126: Exhibit 7). Mr. Horwood explains that Tigre de Soleil is the company that owns these products, and that the Opponent is not only the exclusive Canadian distributor, but is the exclusive worldwide distributor of those products (Q128, Exhibit 10).
- There were a few points in time where the Applicant offered to make the Opponent shirts to wear at various conferences (Q236). The Opponent wore them in conferences in the US (Q239). They were also worn to trade shows and conferences in Canada after Maintenance Connection, Inc. made the shirts for the Opponent through the years starting in 2004 (AU to Q241).
- With respect to Mr. Horwood's note that "not only did Chris Bucher approve of us having a Maintenance Connection logo, he helped make it look even more like the US version that was in use from 2003 to 2010.", he confirms that Mr. Bucher: shrunk portions of the proposed Canadian logo (namely the word Canada) to bring the logo into more similarity with the US logo (Q248) and made changes in color (adding orange) to make the logo more similar to the US logo (Q249).
- The domain name *maintenanceconnection.ca* was registered by the Opponent on November 4, 2004 (Q265) and prior to this, the Opponent did not operate a website at any domain name that included the words "Maintenance Connection" in its domain name address (Q267). Also, prior to November 3, 2004, no one at the Opponent used an email address that was at a Maintenance Connection domain name (Q268).

- With respect to the Opponent's MC Everywhere product, Mr. Horwood agreed that at the time of building the product, the Opponent agreed to align the preferences, colours, buttons, etc., between the products (meaning the Opponent's MC Everywhere product and the Applicant's MC Express product) (Q281).
- With respect to the Applicant's review of the Opponent's MC Everywhere product, among the listed lower priority recommendations was "UI" changes. Mr. Horwood explains that the UI means 'user interface' which consists of everything that is visual or impacts the way a user is working with software, so things like button sizes and text sizes, colours, sounds, if there's input of sound, access to cameras, signature input... (Q292). The specific recommendation was that the parties explore more consistent colours for the MC Everywhere product, to bring that user interface into more similarity with the [Applicant's] MAINTENANCE CONNECTION product (Q293).
- Mr. Horwood acknowledged that from June 2003 to sometime in the middle of 2004, the Opponent operated under the name Asset Pro, but it may have provided products or services in association with the words "Maintenance Connection" (Q315). Only after the middle of 2004 did the Opponent begin operating as an entity called Maintenance Connection in any capacity (Q316).
- In its answers to undertakings, the Opponent provided copies of various invoices dated prior to June 17, 2005 issued by "Asset Pro Solutions Inc." to Canadian customers for "Maintenance Connection Concurrent license". Most of the invoices are dated in the year 2004.

[35] With respect to the Applicant's evidence, the Applicant filed the affidavit of Andrew Ruse. At the time of swearing of the affidavit, Mr. Ruse was the president of Accruent, LLC (Accruent). Prior to this, he acted as Accruent's Chief Revenue Officer from January 2019 – December 2019. Accruent acquired Maintenance Connection, LLC (the Applicant in these proceedings) in June 2018. Prior to serving as an officer of Accruent, Mr. Ruse was Executive Vice President of Sales at Maintenance Connection

from June 2017 to January 2019. At his cross-examination, Mr. Ruse advised that he left Accruent in February 2022 (cross at pg 5).

[36] Mr. Ruse's affidavit provides information on the Applicant's history and business, the Opponent's relationship to the Applicant, and the dispute between the parties. The most pertinent portions of the Ruse affidavit are summarized below.

*History of the Applicant and the Applicant's business*

[37] Maintenance Connection's genesis was in a software development project that began in the US in 1999, led by Chris Bucher and Brad Squires. They launched version 1.0 of the MAINTENANCE CONNECTION computerized maintenance management system (CMMS) software at a trade show in Chicago in early 2003. Mr. Ruse provides a chronology of the corporate history which began with the creation of the business called Maintenance Connection, Inc. and culminated in the title of the current Applicant, Maintenance Connection, LLC. As noted above, for ease of reference, where applicable I refer to the Applicant and its predecessors in title collectively as the Applicant.

[38] Accruent acquired Maintenance Connection, LLC on April 27, 2018. Accruent itself was then acquired by Fortive Corporation. Mr. Ruse states that notwithstanding these changes in ownership, the Applicant remains a distinct legal entity which continues to own and use the MAINTENANCE CONNECTION Marks in Canada (para 13).

[39] The Applicant has been in the business of providing facility management and asset management software to companies across different industries since its launch of the MAINTENANCE CONNECTION CMMS software in 2003. Mr. Ruse explains that a CMMS helps maintenance workers do their jobs more effectively. For example, it helps workers determine which machines need maintenance and which storerooms contain the spare parts they need. It also helps management make informed decisions. For example, it helps managers calculate the cost of machine breakdown repair versus preventive maintenance for each machine, which hopefully leads to better allocation of resources (para 16). The MAINTENANCE CONNECTION CMMS software can also be used by clients to manage work orders, track inventory, and schedule maintenance

operations, from one centralized platform in real-time (para 17). Exhibit D is described as printouts from the Applicant's website at *website.maintenanceconnection.com* that provide further details about the MAINTENANCE CONNECTION software offering. I note that the MAINTENANCE CONNECTION & design mark appears at the top of the webpage.

[40] Exhibit E is a representative slide deck from a sales bootcamp held in Salt Lake City, Utah in November 2017 for the Applicant's sales team (para 18). The slide deck contains information on the MAINTENANCE CONNECTION software and clients, and the history of the Applicant. On cross-examination, Mr. Ruse confirmed that he did not organize or present any boot camps in Canada (cross at pg 9).

[41] The Applicant is a global business, and in addition to the applications for the Marks in Canada, it holds registrations for the Marks in Australia, the European Union, the United Kingdom, and the United States (para 23, Exhibit G).

*The Applicant's characterization of the Opponent's relationship to the Applicant*

[42] Mr. Ruse explains that as part of the ordinary course of its business, the Applicant partners with various distributors, commonly known as resellers or dealers, who sell access to the MAINTENANCE CONNECTION software to the ultimate consumers of the goods and services. Mr. Ruse states that this is common practice in the software industry, and that it is also common practice for these resellers to provide additional services, such as support services, to supplement the resale of software products and services to ultimate consumers. Mr. Ruse further states that many resellers also develop their own software "add-ons", which complement the software they resell; this subset of resellers is commonly known in the industry as "value-added resellers."

[43] Mr. Ruse states that the Opponent acts as a reseller for the Applicant and has since the early days of the Applicant's business, beginning in 2003. Mr. Ruse states that the first Canadian customer for the MAINTENANCE CONNECTION software was in December 2003.



[44] Mr. Ruse states that the Opponent began developing add-ons for this product in spring of 2004, at which point it became a value-added reseller. In support, Mr. Ruse refers to an email from Ray Schoepfer, dated October 23, 2018 (Exhibit H). The email reads in part that “I contacted Chris Bucher in early spring 2003 and visited him in Davis California in June 2003. From that visit we established our dealership and started selling in fall of 2003 with our first Canadian customer in Dec. 2003. In spring 2004, Chris asked us to develop the first MC mobile product. In 2007, we started up sub-dealerships to help out MC US. In 2008, Chris asked us to develop the LDAP product for MC US...”

[45] Mr. Ruse states that the Opponent cross-licenses its add-ons to the Applicant, so that the Applicant can use these add-ons for direct customers (*i.e.*, customers that do not get licenses to the MAINTENANCE CONNECTION software through the Opponent). In particular, the Applicant uses the following add-ons that were developed by the Opponent:

- LoginHub, also known as “MC LDAP”, a single sign-on (or “SSO”) product that allows a user to log in to multiple interrelated products within the MAINTENANCE CONNECTION CMMS solution, without requiring that user to re-enter their authentication information; and
- MCxLE, also known as “MCe” or “MC Everywhere”, an offline mobile product that allows users to perform certain tasks, such as the creation of work orders, without being connected to the MAINTENANCE CONNECTION CMMS solution.

[46] Mr. Ruse submits that LoginHub and MC Everywhere are not “free-standing” products that would be purchased separately from the MAINTENANCE CONNECTION software. He notes that a customer does not need to include, for instance, the LoginHub add-on to be able to get a license to access the MAINTENANCE CONNECTION software, and that because the LoginHub provides no function to a customer in the absence of access to the MAINTENANCE CONNECTION solution, it would never be purchased separately (para 28). On cross-examination, Mr. Ruse stated that the Applicant would very often sell its MAINTENANCE CONNECTION software with no

need for the LoginHub application, and when a client needed these solutions, it would be presented to the client (pg 26).

[47] Mr. Ruse states that the goods and services associated with the Marks that are ultimately delivered to the Applicant's customers, including customers in Canada, consist of a bundle of software products, support services, training services, and add-ons. Exhibit I is described as a representative pricing list from December 7, 2017, showing the products and services offered at that time, including the add-on products developed by the Opponent (para 29).

[48] Mr. Ruse states that, to his knowledge, no written trademark license has ever existed between the Opponent and the Applicant, and the Applicant does not oversee the day-to-day business operations of the Opponent (para 30). Further, the ownership of the underlying software is distinct: the Applicant owns various software applications (such as the MAINTENANCE CONNECTION CMMS solution) whereas Mr. Ruse believes the Opponent's software is owned by a separate entity called Tigre de Soleil Inc. Mr. Ruse states that the Opponent and the Applicant have generally agreed to cross-license the use of each other's software to facilitate their partnership. Exhibit J is a copy of a cross-license agreement signed by the Opponent (though not by the Applicant). I note that this document addresses the mutual use of the parties' software but is silent as to ownership of trademark rights (para 30).

[49] Mr. Ruse states that with respect to trademark rights, the parties have always operated based on a "handshake" agreement whereby the Applicant permits the Opponent to use MAINTENANCE CONNECTION trademarks in association with its value-added reseller business to distribute MAINTENANCE CONNECTION products and services, as well as the Opponent's add-ons (para 31).

[50] Mr. Ruse states that during the course of this relationship, the Applicant has always exercised direct and indirect control over the Opponent's delivery of services in association with the MAINTENANCE CONNECTION Marks, including by: requesting changes to the look and feel of the Opponent's add-ons to ensure consistency with the

Applicant's software applications, and by approving variations on the MAINTENANCE CONNECTION & Design Mark for use by the Opponent in Canada (para 32).

[51] Mr. Ruse states that the Applicant has monitored the Opponent's use of the MAINTENANCE CONNECTION Marks throughout the business relationship, including by raising and addressing concerns where the Opponent's add-ons were named in a manner like the Applicant's software – for instance, as occurred in the case of MC Everywhere and MC Express. Mr. Ruse states that further, the Applicant fundamentally controls the MAINTENANCE CONNECTION CMMS solution - the Opponent is granted access to the source code for this package, but its offerings are built upon, and therefore inherently dependent on, the service offerings of the Applicant (para 33).

*Dispute between the parties*

[52] Mr. Ruse states that on August 28, 2018, Ray Schoepfer approached Accruent to propose an acquisition of the Opponent by Accruent. At the time of Mr. Schoepfer's request, Accruent had already acquired the Applicant. While there were negotiations between the parties, they did not result in a deal. Mr. Ruse asserts that the failure of a deal resulted primarily because Accruent and/or the Applicant were not interested in acquiring the Opponent's reseller business; Accruent instead preferred an asset purchase of certain add-ons developed by the Opponent (such as LoginHub) that did not include the Opponent's operations, whereas the Opponent was not interested in selling this asset separate and apart from its overall operations (para 35). Exhibit K to the Ruse affidavit contains a bundle of emails that document the initial approach by Ray Schoepfer through to the breakdown of these negotiations (para 38).

[53] Mr. Ruse's personal view was that the Applicant "should not pay to acquire its own customers, which would have been the effect of acquiring the Opponent's reseller business." (para 36)

[54] Additional facts and admissions obtained during Mr. Ruse's cross-examination are noted below:

- In the answers to undertakings, Mr. Ruse confirmed that the Applicant does not maintain records of Canadian accounts prior to January 1, 2005 itself. However, based on documents provided on July 12, 2021, by the Opponent, in response to questions asked on cross-examination of Peter Horwood, the first Canadian customer of the MAINTENANCE CONNECTION software in December 2003 was likely the Town of Okotoks, Alberta.
- When asked if the Applicant had customers in Canada, Mr. Ruse answered that it did. He also confirmed that these customers were likely also customers of the Opponent. In particular, he states that “They (the Opponent) were a reseller. So Asset Pro – MC Canada – would contract with the customer a license agreement, and the customer would contract with us their usage agreement, what we call an SSA or software and services agreement.” (cross at pg 27).
- Mr. Ruse infers that all customers in Canada were customers of the Applicant, and that they could also potentially be the Opponent’s customers. He states that “Those customers in Canada, when they bought our software through Asset Pro, were entitled through Maintenance Connection (the Applicant) or shipped software through Maintenance Connection. We provided software updates as part of the maintenance agreement., They’re certainly our customers. They’re licensing our IP” (cross at pg 27).
- From the beginning of 2003 until 2016, any sales to Canadian customers were made by the Opponent, not by the Applicant (cross at pg 29). The Applicant did not sell directly to customers in Canada between 2003 and 2016 (AU at pg 31).
- The LoginHub and MC Everywhere products were not the only add-ons developed by the Opponent (cross at pg 38). There were others, though the two referenced were the most common.
- The LoginHub product is set on top of the MAINTENANCE CONNECTION product to provide single sign-on LDAP authentication. We (the Applicant) would

never represent that product by itself to a customer without our MAINTENANCE CONNECTION solution. (cross at pg 40)

- The LoginHub software could run with the MC Everywhere software. However, it would have zero value because these products are for two different purposes built on top of the MAINTENANCE CONNECTION product (cross at pg 41).
- The statement that the Applicant did not oversee the day-to-day operations of the Opponent, nor did it wish to, can be interpreted to mean that the Applicant allowed the Opponent to run its business the way it saw fit (cross at pg 40). Day-to-day control would be the operations associated with it, but establishing a level of services that our customers should receive on our product, certainly we would want to have direct or indirect control over that to deliver quality for our clients. Those are two different things. I don't want to get involved in their payroll. That's a day-to-day operation or business operation (cross at pg 55).
- The Applicant and the Opponent are still doing business together today. As a reseller, the Opponent still resells and renews the customers, and the Applicant still on occasion will sell MC Express and the LDAP LoginHub product. (cross at pg 50)

Analysis based on the evidence of record

[55] The Opponent acknowledges that it has been the exclusive distributor for the Applicant's MAINTENANCE CONNECTION CMMS software in Canada. The first sale of the MAINTENANCE CONNECTION software in Canada was made by the Opponent to the town of Okotoks in December 2003 and all subsequent sales of the Applicant's MAINTENANCE CONNECTION software in Canada until at least 2016 have been made through the Opponent.

[56] The Opponent did not use the words MAINTENANCE CONNECTION as part of its business name, in its software applications (such as the Maintenance Connection Mobile product or MC Everywhere product), logo, or domain name until after it became the distributor of the Applicant's MAINTENANCE CONNECTION software. The

Opponent's software applications supplement or add-on to the MAINTENANCE CONNECTION software and would not be applied separately from it.

[57] Nevertheless, the Opponent takes the position that beginning in 2003, it is the party that has used the applied-for Marks in association with the applied-for goods and services, not the Applicant, and that as the first user of the Marks in Canada it is the party entitled to registration of the Marks. The Opponent submits that the Applicant was fully aware of and in fact encouraged the Opponent's use of the Marks. In its written representations, the Opponent highlights the Applicant's "consent, cooperation, encouragement, condonement and blessing" to such use by the Opponent (see paragraphs 2, 42, 73 of the written representations).

[58] The Applicant does not dispute that the Opponent made the first and indeed all sales of the Applicant's MAINTENANCE CONNECTION software in Canada until at least 2016. Indeed, the Applicant, in its written representations, notes that the evidence of both parties – including all affidavits and transcripts from all cross-examinations – is unanimous in support for this point. Where the Applicant's position differs is that it considers that all use of the Marks by the Opponent enures to the benefit of the Applicant by virtue of the Opponent's role not as the owner but as the distributor of the software products and services provided under the Marks. The Applicant also points to a pattern of direct and indirect control over the Opponent's delivery of services in association with the MAINTENANCE CONNECTION Marks, including by: reviewing and requesting changes to the look and feel of the Opponent's add-on applications to promote consistency with the Applicant's software, and by approving variations on the MAINTENANCE CONNECTION & Design Mark for use by the Opponent in Canada. The Applicant emphasizes that it fundamentally controls the MAINTENANCE CONNECTION CMMS software.

[59] Having considered all the evidence and both parties' submissions, I find that the Opponent's actions as distributor - including selling the Applicant's MAINTENANCE CONNECTION software in Canada - qualify as use of the trademarks at issue by the Applicant. It is well established that use in Canada by a wholesaler or distributor of

goods bearing the mark of the foreign trademark owner constitutes trademark use by the foreign owner, not the Canadian importer [*Manhattan Industries Inc v Princeton Manufacturing Ltd.* (1971) 4 CPR (2d) 6 (FCTD)].

[60] In *Fennessy v Verb Investments Inc.* (1993) 50 CPR (3d) 477 (FCTD), a decision cited by the Applicant, Rouleau J. noted that: "... It is well established in this Court that, when foreign marks are sold in Canada through distributors, the mark is still the property of the original supplier not the distributor. The question is not *who is using* the mark but rather *whose mark is being used?* As long as the wares emanate from the owner, the mark is being used in Canada by the owner, even if no direct sales are made by him..." In this case, the MAINTENANCE CONNECTION CMMS software clearly emanates from the Applicant.

[61] As noted by the Applicant, the MAINTENANCE CONNECTION trademark – in both word and design form – appear in Chris Bucher's email of April 16, 2003 (shown above). This email started off a chain of transactions that starts with the Applicant as manufacturer and producer of the MAINTENANCE CONNECTION CMMS solution, and ends with the consumer in Canada, in which the Opponent acts as intermediary (para 108 of Applicant's representations).

[62] I do not consider that the Opponent's subsequent use of the MAINTENANCE CONNECTION trademark and variations thereof in its business name and logo, and in its add-on software applications including MC Everywhere to affect my finding, in particular considering the Applicant's evidence of control over the Marks and the Opponent's delivery of services in association with the Marks, in particular its involvement in the finalization of the MAINTENANCE CONNECTION CANADA logo to look closer to the US logo, its involvement in the naming and user-interface of the Opponent's add-on applications which run on the Applicant's MAINTENANCE CONNECTION CMMS software, and its provision of branded shirts worn by the Opponent to trade shows and conferences in the US and Canada starting in 2004. The fact that the Applicant was not involved in the day-to-day running of the Opponent's

operations, such as payroll, does not affect my finding [see *Corey Bessner Consulting Inc v Core Consultants Realty Inc*, 2020 FC 224 at para 78].

[63] With respect to the Opponent's suggestion that the prospective MAINTENANCE CONNECTION CANADA logo sent to Chris Bucher had a symbol claiming it was the Opponent's trademark, I understand this to refer to the inclusion of a ® symbol with the design. However, a ® notation simply indicates that a trademark is registered, not the identity of the registrant, and indeed, the logo is not registered. A more plausible explanation for the inclusion of this symbol, as suggested by the Applicant, is that the ® symbol also appeared in conjunction with the version of the MAINTENANCE CONNECTION design used by the Applicant at approximately the same time, which was likely the template for the MAINTENANCE CONNECTION CANADA logo and thus simply carried over from that design. In any event, when considered against all the evidence, the Opponent's suggestion is not persuasive.

[64] Finally, I would add that the ongoing cooperation, consent, and encouragement of the Applicant emphasized by the Opponent in its evidence and representations speaks more to a licensor-licensee relationship (with Applicant as owner and licensor and the Opponent as licensee) rather than to a situation whereby the Applicant ceded trademark rights in Canada in relation to a software solution that it developed, controls, and continues to control. Indeed, the Opponent's consistent references to the consent and cooperation of the Applicant to the Opponent's use of the Marks suggests that the Opponent had at least some level of awareness that it was not the owner of the Marks, as an owner would not need to seek approval, consent, or comment on the use of its own trademarks.

*Conclusion on the section 38(2)(c) and 16(1)(a) ground of opposition*

[65] Given my finding above as to the use of the MAINTENANCE CONNECTION Marks by the Opponent enuring to the benefit of the Applicant, the Opponent is not entitled to rely on its use in Canada in support of its section 16(1)(a) ground with the result that the Opponent has not met its initial burden. Accordingly, this ground of opposition is rejected.



**Section 38(2)(a.1) ground – bad faith**

[66] The material date for this ground is the filing date of the applications.

[67] With respect to the allegation of bad faith pleaded by the Opponent, I find that the Opponent has not met its initial burden. As discussed above, I find that the use of the Marks by the Opponent enures to the benefit of the Applicant. It follows that the Applicant's decision to avail itself of the procedure for registration of its Marks as set out in the Act and the *Trademarks Regulations* does not amount to bad faith.

[68] In its representations, the Opponent has questioned the timing of the filing of the applications by the Applicant, noting that they coincided with the change in its ownership and management (paras 54, 55). However, it is not for the Registrar to speculate as to the timing of such actions. Accordingly, this ground of opposition is rejected.

**Section 38(2)(a) ground**

[69] The Opponent has pleaded that the applications do not comply with section 30[1] of the Act in that at the time of the applications being filed the Applicant knew or ought to have known that it was not entitled to use the Marks in Canada in association with any of the applied for goods and services in that the Applicant had had full knowledge that the Opponent had used the name MAINTENANCE CONNECTION or MAINTENANCE CONNECTION CANADA since at least as early as 2004. The Applicant knew or ought to have known that the filing of the applications would cause confusion in the marketplace and substantial irreparable harm to the Opponent as the Opponent had used the same trademarks in Canada for at least 12 years (*i.e.*, since at least as early as 2004).

[70] This ground of opposition is improperly pleaded since section 38(2)(a) refers to non-conformity of an application with section 30(2) of the Act, not 30(1). This does not appear to be a mere typographical error as the allegations raised do not fit within any of sections 30(2)(a) through (d). Further, none of the evidence cures this deficiency. Accordingly, this ground of opposition is rejected.

**Section 38(2)(e) ground**

[71] The Opponent has pleaded that as at the date of filing of the applications in Canada (being the material date for this ground), the Applicant was not using and did not in fact propose to use the Marks in Canada in association with the applied for goods and services.

[72] The Opponent's written representations do not address this allegation but rather focus on the Opponent's position that it is the first user of the applied for Marks in Canada. As discussed above, I have determined that the Opponent's previous use of the Marks in association with the applied for goods and services enures to the benefit of the Applicant with the result that the Opponent does not meet its initial burden for this ground. Accordingly, this ground of opposition is rejected.

**Section 38(2)(f) ground**

[73] The Opponent has pleaded that as of the date of filing of the applications (being the material date for this ground), the Applicant was not the person entitled to use the Marks in Canada in association with the applied for goods and services because the Applicant, as of the relevant date, had full knowledge that the Opponent had previously used the same trademarks in Canada in association with the goods and services set out in the applications since at least as early as 2004 or 12 years prior to the filing of the applications.

[74] Section 38(2)(f) does not address the type of allegation made by the Opponent in respect of this ground. Instead, this section contemplates an applicant's lawful entitlement to use the trademark involving, for instance, compliance with relevant federal legislation or other legal prohibitions regarding use of the trademark within the meaning of section 4 of the Act [see *Methanex Corporation v Suez International, société par actions simplifiée*, 2022 TMOB 155]. In my view, the facts pleaded by the Opponent cannot support a section 38(2)(f) ground of opposition.

[75] In any event, as discussed above, I have determined that the Opponent's previous use of the Marks in association with the applied for goods and services enures

to the benefit of the Applicant with the result that the Opponent would not have met its initial burden for this ground even if I had considered it a proper ground of opposition. Accordingly, this ground of opposition is rejected.

**DISPOSITION**

[76] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the oppositions pursuant to section 38(12) of the Act.

---

Jennifer Galeano  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**SCHEDULE A**

Application	Goods and Services
<p>Maintenance Connection (1,802,565)</p> <p>Maintenance Connection Design (1,802,568)</p>	<p>Goods:</p> <p>Downloadable cloud computer software for maintenance management, namely, scheduling, tracking and managing preventative and predictive maintenance, tasks, equipment inventory, and emergency repairs in the fields of industry and manufacturing, namely warehouse management, process manufacturing, power generation, oil and gas, energy delivery, metal and mining and vehicle fleets, healthcare, namely, hospitals, medical facilities, biomed facilities, senior living facilities, and medical device manufacturing, facilities management, and government, namely, local, state and federal government facilities management; Downloadable computer software for maintenance management, namely, scheduling, tracking and managing preventative and predictive maintenance, tasks, equipment inventory, and emergency repairs in the fields of industry and manufacturing, namely warehouse management, process manufacturing, power generation, oil and gas, energy delivery, metal and mining and vehicle fleets, healthcare, namely, hospitals, medical facilities, biomed facilities, senior living facilities, and medical device manufacturing, facilities management, and government, namely, local, state and federal government facilities management.</p> <p>Services:</p> <p>(1) Training in the use and operation of maintenance software, namely, software for scheduling, tracking and managing preventative and predictive maintenance, tasks, equipment inventory, and emergency repairs in the fields of industry and manufacturing, namely warehouse management, process manufacturing, power generation, oil and gas, energy delivery, metal and mining and vehicle fleets, healthcare, namely, hospitals, medical facilities, biomed facilities, senior living facilities, and medical device manufacturing, facilities management, and government, namely, local, state and federal government facilities management.</p> <p>(2) Providing temporary use of online non-downloadable computer software for maintenance management, namely, scheduling, tracking and managing preventative and predictive maintenance, tasks, equipment inventory, and emergency repairs in the fields of industry and manufacturing, namely warehouse management, process</p>

	<p>manufacturing, power generation, oil and gas, energy delivery, metal and mining and vehicle fleets, healthcare, namely, hospitals, medical facilities, biomed facilities, senior living facilities, and medical device manufacturing, facilities management, and government, namely, local, state and federal government facilities management.</p>
<p>Maintenance Connection (1,907,433)</p> <p>Maintenance Connection Design (1,907,427)</p>	<p>Goods:</p> <p>Downloadable computer software for maintenance management, namely, scheduling, tracking and managing preventative and predictive maintenance, tasks, equipment inventory, and emergency repairs in the fields of industry and manufacturing, namely warehouse management, process manufacturing, power generation, oil and gas, energy delivery, metal and mining and vehicle fleets, healthcare, namely, hospitals, medical facilities, biomed facilities, senior living facilities and medical device manufacturing, facilities management, and government, namely, local, state and federal government facilities management; downloadable computer software in the nature of a mobile application for maintenance management, namely, scheduling, tracking, and managing preventative and predictive maintenance, tasks, equipment inventory, and emergency repairs in the fields of industry and manufacturing, namely warehouse management, process manufacturing, power generation, oil and gas, energy delivery, metal and mining and vehicle fleets, healthcare, namely, hospitals, medical facilities, biomed facilities, senior living facilities and medical device manufacturing, facilities management, and government, namely, local, state and federal government facilities management</p> <p>Services:</p> <p>(1) Training in the use and operation of software for maintenance management, namely, scheduling, tracking, and managing preventative and predictive maintenance, tasks, equipment inventory, and emergency repairs in the fields of industry and manufacturing, namely warehouse management, process manufacturing, power generation, oil and gas, energy delivery, metal and mining and vehicle fleets, healthcare, namely, hospitals, medical facilities, biomed facilities, senior living facilities and medical device manufacturing, facilities management, and government, namely, local, state and federal government facilities management</p> <p>(2) Providing online, non-downloadable software for maintenance management, namely, scheduling, tracking and managing preventative and predictive maintenance, tasks, equipment inventory, and emergency repairs in the field of industry and manufacturing,</p>

namely warehouse management, process manufacturing, power generation, oil and gas, energy delivery, metal and mining and vehicle fleets, healthcare, namely, hospitals, medical facilities, biomed facilities, senior living facilities and medical device manufacturing, facilities management, and government, namely, local, state and federal government facilities management; providing online, non-downloadable software for providing information, software implementation training, technical support, and troubleshooting services in the field of maintenance management software, namely, software for scheduling, tracking, and managing preventative and predictive maintenance, tasks, equipment inventory, and emergency repairs in the fields of industry and manufacturing, namely warehouse management, process manufacturing, power generation, oil and gas, energy delivery, metal and mining and vehicle fleets, healthcare, namely, hospitals, medical facilities, biomed facilities, senior living facilities and medical device manufacturing, facilities management, and government, namely, local, state and federal government facilities management; hosting maintenance management software for use by others; computer services, namely, integration of maintenance management software into computer systems and networks; computer software support services, namely, software implementation, technical support, and troubleshooting services in the field of maintenance management software, namely, software for scheduling, tracking, and managing preventative and predictive maintenance, tasks, equipment inventory, and emergency repairs in the fields of industry and manufacturing, namely warehouse management, process manufacturing, power generation, oil and gas, energy delivery, metal and mining and vehicle fleets, healthcare, namely, hospitals, medical facilities, biomed facilities, senior living facilities and medical device manufacturing, facilities management, and government, namely, local, state and federal government facilities management

# Appearances and Agents of Record

**HEARING DATE:** No hearing held

## **AGENTS OF RECORD**

**For the Opponent:** Stemp & Company

**For the Applicant:** Clark Wilson LLP