

Federal Court



Cour fédérale

Date: 20240306

Docket: T-1484-21

Citation: 2024 FC 382

Ottawa, Ontario, March 6, 2024

PRESENT: Madam Justice McDonald

BETWEEN:

VERMILLION NETWORKS INC.

Applicant

and

ESSILOR GROUP CANADA INC.

Respondent

JUDGMENT AND REASONS

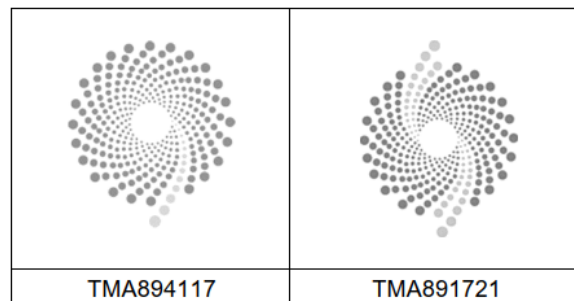
[1] Vermillion Networks Inc. [VNI] brings this appeal under section 56 of the *Trademarks Act*, RSC 1985, c T-13 [Act] from two decisions of the Registrar of Trademarks [Registrar] to amend the VNI trademark registrations to delete certain goods and services. The Registrar found there was a lack of evidence of use of those descriptions during the Relevant Periods.

[2] On this appeal, VNI filed new evidence. The Respondent takes no position on this appeal and did not participate in the hearing.

[3] For the reasons below, in light of the new evidence of use, I am allowing this appeal in part.

I. Background

[4] VNI is the owner of registration No. TMA 894,117 [Mark 1] Cooperation Emblem/swirl design and registration No. TMA 891,721 [Mark 2] Sustainability Emblem [collectively the Marks].



[5] VNI is a not-for-profit corporation that provides goods and services promoting sustainability. It provides licenses to businesses to use VNI's Marks. The license holders, referred to as Affiliates, include: Levantas, Vermillion Institute, and Vermillion Communities Incorporated. The Affiliates sell goods and offer services displaying the Marks.

[6] The Respondent, Essilor Group Canada Inc. [Essilor] provides eye care goods and services. They did not participate in these proceedings.

[7] On December 13, 2017 and January 23, 2018, the Registrar of the Trademarks Opposition Board (TMOB) issued notices under section 45 of the *Act* requiring VNI to show use of the Marks in Canada in association with the registered goods and services in the three-year

period preceding the date of the notices. The relevant period for Mark 1 is January 23, 2015 to January 23, 2018 [Relevant Period 1]. The relevant period for Mark 2 is December 13, 2014 to December 14, 2017 [Relevant Period 2] [collectively the Relevant Periods].

[8] In response to the section 45 notices, VNI provided two affidavits of Wade Ferguson for each of the Marks, both sworn on January 31, 2019. Mr. Ferguson has been the director of VNI since 2007.

II. Decisions of the Registrar

[9] On July 26, 2021, the Registrar released the decisions for Mark 1, *Essilor Group Canada Inc v Vermillion Networks Inc*, 2021 TMOB 183, and Mark 2, *Essilor Group Canada Inc v Vermillion Networks Inc*, 2021 TMOB 184 [the Decisions]. The Registrar determined that Mark 1 and Mark 2 are so similar that the use of one Mark would constitute use of the other Mark.

[10] In the Decisions, the Registrar did not maintain the registrations for the goods and services for which there was no evidence of use. The Registrar identified the non-use goods and services by use of a “~~strike through~~” in Schedule A descriptions attached to the Decisions.

[11] The Registrar noted that the owner of a trademark must provide sufficient facts for the Registrar to find use of trademark in association with each of the goods and services specified in the registration for the relevant period. The Registrar noted that bare statements of whether a trademark is in use is not sufficient to demonstrate use in section 45 proceedings, but also noted that there is a low threshold to establish use and evidentiary overkill is not required.

[12] The Registrar was satisfied that evidence of use of the Marks by VNI's Affiliates and other licensees would qualify as use for VNI's benefit.

[13] The Registrar found large portions of Mr. Ferguson's affidavit evidence to be limited or of no relevance, as much of his evidence was dated outside the Relevant Periods or referred to events that took place outside the Relevant Periods. The Registrar only considered the evidence dated within or otherwise connected to the Relevant Periods.

[14] Further, the Registrar noted that Mr. Ferguson's affidavit contained only a few references to any of the particular registered goods or services. The Registrar found that Mr. Ferguson's affidavit and VNI's written representations did not explain the connection to registered goods or services in question. The Registrar noted that it is not for the Registrar to speculate as to the nature of the registered goods or services.

[15] The Registrar was able to determine that VNI used the Marks in association with a number of goods and services, noting that goods and services are to be construed liberally and reasonable inferences can be made from the evidence.

[16] For both Marks, the Registrar was not satisfied that there was evidence of use of certain "goods" within the meaning of sections 4 and 45 of the *Act* being pamphlets and printed guides in the field of best practices and techniques for businesses, organizations, people and societies in the areas of "management, financial performance... sustainability reporting, economics, marketing and sales (except in the field of sales and marketing skills for mortgage and home

equity loans), media relations, communication and advertising, cultural activities, fair trade, public policy, leadership, environment, social affairs and public affairs” and “postcards” and “bumper stickers”.

[17] With respect to the “services” descriptions, the Registrar did not accept evidence outside the Relevant Periods and did not accept evidence of use outside of Canada. The Registrar did accept that past performance of a service was an indicator of VNI’s ability to perform such services otherwise advertised and offered during the Relevant Periods.

[18] The Registrar found insufficient evidence with respect to the following service categories for which the descriptions are common to both Marks:

- various association services
- political action committee services
- accounting services
- business process consulting
- market research services collection of data central to the field of social affairs, leisure, cultural activities procurement services
- computer and ICT services
- human resources services
- online recruiting and recruitment services
- advertising agency services
- charitable, not-for-profit services
- mediation services

[19] The Registrar did not accept VNI’s position that as a not-for-profit corporation, there should be a lower standard for excusing non-use compared to other entities. The Registrar found that Mr. Ferguson made a business decision not to retain a qualified trademark agent and instead tracked the use of each registered good and service himself, for which his ability to do so was impacted by other trademark litigation. The Registrar noted that VNI was still able to

demonstrate use for many goods and services despite the litigation and VNI's ability to choose which goods and services to prioritize are voluntary business decisions rather than special circumstances excusing non-use. The Registrar ultimately found that VNI did not demonstrate special circumstances excusing non-use.

III. Issue

[20] The only issue raised on this appeal are the Registrar's findings of non-use of certain goods and services.

[21] The issues to be determined are:

- A. what is the appropriate standard of review?
- B. is the new evidence material?
- C. does the new evidence demonstrate use of the Marks during the Relevant Periods for those descriptions struck out by the Registrar?
 - (1) Is there evidence of use of "goods" during the Relevant Periods?
 - (2) Is there evidence of use of "services" during the Relevant Periods?
 - (3) Are there "services" for which there is no evidence of use?

IV. Analysis

A. *What is the appropriate standard of review?*

[22] In assessing the new evidence filed under subsection 56(1) of the *Act*, the Court engages in a *de novo* or correctness review of the Decisions. The Court must assess if the new evidence

is material and if it would have affected the Registrar’s finding of fact or exercise of discretion (*Miller Thomson LLP v Hilton Worldwide Holding LLP*, 2020 FCA 134 at paras 45 and 47 [*Hilton*]; *Clorox Company of Canada, Ltd v Chloretec SEC*, 2020 FCA 76 at para 21 [*Clorox*]; *Vivo Mobile Communication Co, Ltd v Garmin Switzerland GmbH*, 2022 FC 1410 at para 16 [*Vivo*]).

[23] Material new evidence is evidence that is “sufficiently substantial and significant” and “of probative value” (*Clorox* at para 21; *Hilton* at para 53).

[24] The materiality of new evidence is a question of mixed fact and law, so findings of this nature will stand in the absence of a palpable and overriding error or an extricable error of law (*Clorox* at para 19; *Hilton* at para 54). As noted in *Vivo* at paragraph 21:

Evidence may be “material” where it enhances the overall cogency of the record in a way that may have influenced the TMOB’s conclusions on a finding of fact or exercise of discretion (*Seara* at para 24; *Tokai* at para 23) or fills gaps or remedies a deficiency identified by the TMOB (*Corona* at para 38-39). Evidence is not “material” if it relates to facts after the relevant date, merely supplements or confirms the findings of the TMOB, or is repetitive of evidence that was already before the decision-maker: *Corona* at paras 38-39; *Seara* at para 24; *Hawke & Company Outfitters LLC v Retail Royalty Company*, 2012 FC 1539 [*Hawke*] at para 31.

[25] With respect to portions of the Registrar’s Decisions for which no new evidence has been provided, the standard of review is described in *Hilton* at paragraph 48 as follows:

Where the standard of review applicable to Registrar’s decisions has changed as a result of *Vavilov* is where there is no new evidence before the Federal Court that would materially have affected the decision under appeal: *Clorox*, above at para. 22. The standards of review to be applied by the Federal Court in such cases are the appellate standards of correctness and palpable and

overriding error that were prescribed by the Supreme Court in *Housen: Clorox*, above at paras. 22–23.

[26] Palpable and overriding error is a highly deferential standard of review (*Mahjoub v Canada (Citizenship and Immigration)*, 2017 FCA 157 at para 61 [*Mahjoub*]). “Palpable” means an obvious error and “overriding” means an error that affects the outcome of the case (*Mahjoub* at paras 62-64).

B. *Is the new evidence material?*

[27] In support of this appeal, VNI filed the following new evidence:

(a) Affidavit of Wade Ferguson affirmed February 22, 2023 [*Ferguson Affidavit*].

Mr. Ferguson is a director of VNI, and claims to have knowledge of all aspects of VNI’s lines of businesses including sales and marketing of goods and services using the Marks.

(b) Affidavit of Rebecca Walker affirmed on November 15, 2022 [*Walker Affidavit*].

Ms. Walker was employed with a TELUS Mobility dealership in Calgary [*Telus*].

[28] The *Ferguson Affidavit* includes detailed information from Levantas that he explains was not available for consideration by the Registrar, as VNI had not obtained permission to use this evidence until September 2021. The lack of evidence from Levantas was addressed by the Registrar who noted as follows in the decision, 2021 TMOB 184 at para 76:

... In this case, Mr. Ferguson does not clearly state or provide evidence to demonstrate that Levantas performed, or was offering and prepared to perform, any of the advertised services in Canada during the relevant period.

[29] The Exhibits attached to the Ferguson Affidavit include the following:

- Exhibit A - a series of screenshots from the Levantas website from February 2017
- Exhibit B - records of IP addresses from Canada for visitors to the Levantas website
- Exhibit C - pages from print business journals
- Exhibit D - invoices that show Levantas using the Marks in the overlap period
- Exhibit E - emails that show Levantas using the Marks in the overlap period
- Exhibit F - email with a Calgary client with Vermillion Communities Incorporated
- Exhibit G - emails involving Vermillion Communities Incorporated and a Calgary client
- Exhibit H - invoice to a Calgary client of Vermillion Communities Incorporated's ISX services
- Exhibit I - invoice to a Vermillion Communities Incorporated client
- Exhibit J - emails showing use of services relating to grants
- Exhibit K - real estate broker's feature sheet from a broker affiliated with VNI

[30] The Walker Affidavit provides new evidence of advertising installations displaying the Marks in a retail atrium for two years. The Walker Affidavit also confirms that Telus sold internet service and television subscriptions and voice over IP telephone systems, all while advertising the Marks.

[31] In my view, the Ferguson Affidavit and the Walker Affidavit do fill gaps and remedy deficiencies identified by the Registrar (*Kabushiki Kaisha Mitsukan Group Honsha v Sakura-Nakaya Alimentos Ltda*, 2016 FC 20 at para 18).

[32] I will also note that the only evidence before the Court is the evidence filed by the Applicant, VNI. As there were no cross-examinations, this evidence stands un-contradicted.

[33] I am satisfied that the new evidence provided in the Ferguson and Walker Affidavits is substantial, significant and of probative value and falls within the Relevant Periods. It provides new evidence of use from Levantas and Vermillion Calgary within sections 4 and 45 of the *Act*. Thus, I will consider this new evidence on the correctness standard (*Hilton* at paras 45 and 47).

C. *Does the new evidence establish use of the Marks during the Relevant Periods for those descriptions struck out by the Registrar?*

[34] The threshold for establishing “use” is quite low and evidentiary overkill is not required (*Hilton* at para 10; *Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD); *Union Electric Supply Co Limited v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)).

[35] The onus to demonstrate use is not a heavy burden. As Justice Fuhrer noted in *Sim & McBurney v en Vogue Sculptured Nail Systems Inc*, 2021 FC 172 at paragraphs 14-15:

Evidentiary overkill is not required (meaning not all examples of use must be evidenced). The use threshold is not stringent. Evidence of a single sale may be sufficient, depending on the circumstances, to establish use of the trademark in the normal course of trade; the owner need only establish a *prima facie* case of use. Nonetheless, sufficient facts must be provided from which the Registrar can conclude that the trademark has been used during the

relevant three-year period for each good (or service) specified in the registration. The sufficiency of the evidence in establishing use of the trademark is a question of mixed fact and law, rather than a question of law.

Drawing an inference is a matter of reasonably probable, logical deductions from the evidence. Further, the decision maker properly may draw inferences from proven facts considering the evidence as a whole which, in turn, must make it possible for the decision maker to infer every element of Section 4 of the *Trademarks Act*. [Citations omitted]

[36] As well, in *McDowell v Laverana GmbH & Co KG*, 2016 FC 1276 at paragraph 23, the Court notes that any ambiguity in the evidence should be resolved in favour of the registered owner. Further, the comments of Justice Mactavish, then of the Federal Court, in *Fairweather Ltd v Registrar of Trademarks*, 2006 FC 1248 [*Fairweather*] are instructive. At paragraph 41 of *Fairweather*, Justice Mactavish states:

Finally, any doubt there may be with respect to the evidence must be resolved in favour of the trade-mark owner, without reducing the burden on the owner to provide *prima facie* evidence of use [Citation omitted].

[37] Goods and services are to be construed liberally and reasonable inferences can be made from the evidence (*Eclipse International Fashions Canada Inc v Cohen*, 2005 FCA 64 [*Eclipse*]).

(1) Is there evidence of use of “goods” during the relevant period?

[38] Subsection 4(1) of the *Act* provides:

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.

[39] The “goods” description is identical for both Marks and states:

Novelty items, namely, mugs; Printed materials, namely, pamphlets, reports, and printed guides, all in the field of best practices and techniques for businesses, organizations, people and societies in the areas of management, financial performance, sustainability performance, sustainability reporting, economics, marketing and sales (except in the field of sales and marketing skills for mortgage and home equity loans), media relations, communication and advertising, cultural activities, fair trade, public policy, leadership, environment, social affairs and public affairs; canvas shopping bags; stationery supplies, namely, pens, notepads, postcards, bumper stickers, decals; paper napkins; Clothing, namely, T-shirts and hats.

[40] The Registrar was not satisfied that there was evidence of use of the “goods” for the descriptions: pamphlets and printed guides in the areas of “management, financial performance... sustainability reporting, economics, marketing and sales (except in the field of sales and marketing skills for mortgage and home equity loans), media relations, communication and advertising, cultural activities, fair trade, public policy, leadership, environment, social affairs and public affairs” and “postcards” and “bumper stickers.”

[41] The new evidence relied upon to establish use of the goods includes the information in the Walker Affidavit who describes the use of the Marks with images used in the form of customer facing advertising installations. These images display the Mark and included text on sustainability. Ms. Walker states:

...I also have personal knowledge of the other information set out below about the how printed materials in the nature of advertising infographics ("Advertising Installations") (shown below) were placed inside and outside the Retail Atrium of Wireless (introduced below) between June 7, 2017 and the end October of 2019 (the "Period"), save where stated to be based on information and belief.

On information and belief, the Advertising Installations that I introduce below were products that were made available to Wireless by an organization known to me as Vermillion Calgary ("Vermillion"). I base that on having seen Advertising Installations in the Retail Atrium and attached to the front entrance to the Retail Atrium for over two years.

[42] Attached to the Walker Affidavit are images showing how the Advertising Installations appeared to clients, members of the public, and workers when they entered the Retail Atrium (Exhibit A). In these images, Mark 2 is displayed with the title "Innovators in Sustainability" on a brochure and a poster.

[43] In addition, the Ferguson Affidavit attaches Exhibit C showing the use of the Marks with the titles "Innovators in Sustainability" and "Innovation for Sustainability" on two pages of printed business journals, one from 2014 and the other from 2017.

[44] The Ferguson Affidavit also attaches Exhibit D showing stickers of Mark 1 with the title "Innovation for Sustainability" on nine invoices from Levantas dated between 2015 to 2017, which is within the relevant period.

[45] I am satisfied that the evidence summarized above demonstrates use of the Mark in association with the goods including pamphlets and printed guides on financial performance, sustainability reporting, marketing and sales, media relations, communication and advertising,

cultural activities, fair trade, public policy, leadership, environment, social affairs and public affairs. Customers would have been aware that they were viewing goods associated with the sustainability focus of the Marks.

[46] The new evidence of use of the “goods” is sufficient to establish use of the Marks in association with pamphlets and printed guides during the relevant period. Although there is no direct evidence on the use of “postcards” and “bumper stickers”, in light of the other evidence of use of the goods on printed materials, I am prepared to infer use in relation to these printed goods during the relevant period (*Eclipse* at para 7).

[47] I find there is evidence of use of the marks on the goods within the relevant period.

(2) Is there evidence of use of “services” during the Relevant Periods?

[48] Subsection 4(2) of the *Act* provides:

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.

[49] The “services” descriptions for both Marks are detailed and spread over five pages. The services claimed cover a broad range of categories and appear to be conceptually separated or organized with the use of a semicolon. Typically, the core service is described followed by an enumeration of ancillary services. For example, “[a]ssociation services, namely, promoting the interests and policy agenda of various organizations...”. However, VNI did not consistently use

this approach to all the services descriptions, and many of the services' descriptions appear to overlap and occur in multiple instances.

[50] While VNI explains that it was attempting to be as “all-inclusive” as possible in its description of services, in so doing, it also created challenges for itself in producing evidence to demonstrate use of the very broad and detailed range of services claimed. As an illustration, the following is a non-exhaustive list of some categories of services claimed in Mark 2: Association services; arranging and conducting marketing programs; promoting public interest and awareness; political action committee services; accounting services; business and management consulting services; business marketing consulting services; market research services; opinion polling; conducting profit survey; collection of data; providing demographic information and demographic consultations; data processing in the field of advertising; computerized database management; document services; procurement services; project management; analysis services; business management planning; business centre services; human resources services; online recruiting services; advertising services; publicity services; providing news; providing grants for research in international fellowship programs; providing monetary exchange services; financial sponsorship of programs; financing of venture capital; financial planning; arranging of insurance; financial research in the attainment of benefits; financial management; real estate brokerage services; construction management consultation; telecommunication services; educational services; mediation services; computer services; computers and computer systems; arranging and conducting conferences; advertising acquisition; information and entertainment services; scientific research and consultation; lawyer referral services; engineering and engineering consulting;

[51] In addition, the services are not broken down by paragraph number but contained in large continuous blocks of text. Thus in some instances below, for clarity, it has been necessary to quote blocks of text.

[52] Finally, although the “services” descriptions are not identical for both Marks, the differences are minor, and do not, in my view, impact the consideration of the new evidence against the service categories and descriptions struck by the Registrar. As well, in some cases, the evidence of use of a “service” is applicable to other service descriptions that are redundant or duplicative.

[53] The Registrar struck various “association services” descriptions that are common to both Marks. Below I will detail the information provided in the Ferguson Affidavit and Walker Affidavit as evidence in support of use of the described services during the relevant overlap period.

[54] At paragraph 17 of his Affidavit, Mr. Ferguson addresses *association services* in relation to *organizing and conducting awards programs and arranging and conducting networking opportunities and events on the subjects of inter alia business, law, technology and arranging and conducting of conferences, luncheon and dinner events and joint advertisement and promotional events in the fields of inter alia technology, fair trade, civil society, and human rights*. Mr. Ferguson states that the Marks were used in Canada dozens of times and through website traffic. He references an award ceremony that he organized and conducted. The award was presented to a company that had:

“...measuring and managing its business processes including in respect of (a) technology adoption and end-of-life stewardship of digital devices, (b) fair trade practices with respect to how it sourced various sundry accessory products it sold in its store, (c) its community involvement with civil society organizations to promote sustainable economies that elevate people, planet and prosperity (and the difficulties those groups face in succeeding), and (d) human rights impacts including in the nature of employment practices relating to accommodations and other.”

[55] In his Affidavit, Mr. Ferguson states that at an awards ceremony, he made remarks about legal compliance and measuring outcomes for benchmarking beyond legal compliance thresholds.

[56] With respect to awards ceremonies, at paragraph 9 of her Affidavit, Ms. Walker states that in June 2017 she was advised that Telus had been accepted as a participant in a working group of Vermillion's Innovators in a Sustainability project (the “Vermillion Project”) and that, in return for their commitments, Telus was awarded the use of a series of Advertising Installations, which were approved by Vermillion for placement in and around the Retail Atrium.

[57] This new evidence on association services is material and I accept that VNI has demonstrated use of the following association services according to section 4 of the *Act* that were previously struck out by the Registrar: *organizing and conducting awards programs and arranging and conducting of conferences, luncheon and dinner events and joint advertisement and promotional events in the fields of ...technology, fair trade,..., civil society, and human rights.*

[58] Paragraphs 18 and 19 of the Ferguson Affidavit address the various *accounting services* descriptions that were struck by the Registrar as follows:

18. Having regard to *accounting services, namely account and business auditing, sustainability auditing and business process management and business process consulting and mediation of agreements regarding the sale and purchase of goods and services and business centre services, namely, administration of customer loyalty and incentive award programs for others* within the Subset Services, as well as to *consulting in the areas of computer, computer systems and consulting in the areas of information technology and computer services, namely, computer programming services for others and computer services, namely, developing websites for others; computer services, namely, operating websites for others and human resources services, namely, providing business information on employment and careers and public relations services* and set out in (e) below, the Mark was used therewith in Canada including as follows, which are representative of in excess of thirty-five similar instances of such use in the Overlap Period:

- a) Exhibit "A"[9,13,14,15,22,26,29,30,41] lists pages displayed to prospects and clients relating to the above with remarks made by Levantas that offered *or* performed the services listed in this paragraph;
- b) Exhibit "E"[58] shows an email to a Calgary client about the results of a completed process design consulting engagement in August of 2017 (which included the advertising of ongoing services to administer customer loyalty and employee incentive award programs, which run on software that Levantas offers, which this client chose to have Levantas manage instead);
- c) Attached as Exhibit "F" is an email thread with a Calgary client of VCI, which shows a completed account and billing audit of a supplier's erroneous billing to our client (and the related offer to mediate on the client's behalf for some purchase and sale matters that would follow);
- d) Exhibit "E"[17, 18, 19] show an email to a Calgary client operating in the industrial sector

("Industrial Client") that runs its business out of a series of Canadian warehouses in and outside of Alberta (about a sustainability audit of various client processes including processes to turn over waste for special handling to suppliers, in which (i) business process management and business process consulting services as well as (ii) public relations services and (iii) providing business information about employment were also offered and/or performed), and Exhibit "O"[1] shows the use of the Mark in an invoice for sustainability audit services (an invoice that issued as a result of the services performed for this client as discussed in email cited above).

- e) Exhibit "E"[43,44,45] is an email with a Calgary client, which shows Levantas offering business audit services for the business expense accounts of travelling technical workers for the client's operation, as well as the remainder of the services listed just above. Some of the registered process services, computer consulting services, website development and operations services, and human resources services above are advertised and also performed in this email (for HR, by way of the change management services offered and the information and advice shown in the email); and
- f) In addition to the evidence above about the advertising and performing of website development and operations services for clients in the Overlap Period, and to the extent it may have been unclear in the FA, I will specifically state for an avoidance of doubt that both Vermillion Professional Network and Levantas turned up pages from their websites multiple times in the Overlap Period in the course of advertising and performing website development and operations services for clients. Their website technical workers also wore shirts bearing the Mark. The image at Tab H-29 in the FA of a worker wearing a shirt bearing the Mark is representative of another way in which the Mark was used by Affiliates with these website services in the Overlap Period. Such services are so common as part of the services provided by

companies providing advertising services such as Levantas it does not get its own dedicated page at the Levantas website.

19. Having regard to *accounting services, namely tax preparation, bookkeeping and tax consulting and business management planning, business supervision and human resources services, namely, search, recruitment and placement services and human resources services, namely, payroll services and mediation services in conclusion of commercial transactions for others and investment planning, consulting services and financial management and financial consulting services and monetary exchange services* within the Subset Services, the Mark was used therewith in Canada in the Overlap Period including as follows:

- a) Exhibit "A"[5,17,18,19,26,31,32] lists pages displayed to prospects and clients relating to the above with remarks made by Levantas that offered or performed the services listed in this paragraph;
- b) Exhibit "E"[1,2,3] shows an email to a Calgary client offering or performing all of the services listed in this paragraph except tax preparation services, and I will add that it is rare for one company to have such a broad set of service and outsourcing needs as seen in this email, the way the Mark was used in this email is representative of in excess of forty cases where the subject services were offered in various groupings to different businesses in Canada during the Overlap Period; Exhibit "D"[2,3] show *[sic]* the use of the Mark in invoices that issued *[sic]* to the same client in relation to the performance of the same relevant services, except for human resources services, namely, search, recruitment and placement services (which was an available service this client did not select) and except for tax preparation service (evidence for which is found in the next subparagraph);
- c) Exhibit "E"[5] shows an email to a Calgary client performing tax preparation services; it is representative of in excess of 85 cases of such use in Canada during the Overlap Period; and

- d) I will add that it happened routinely in the Overlap Period in Canada that - during meetings with executive teams of public companies or even small cap companies that have more than a handful of shareholders in which Exhibit "A"[5,29) among others were turned up - that Levantas workers were asked and did perform investment planning and consulting services in the nature of helping the business leadership understand they have choices they may not yet see for how to invest the next-year budget in specific areas to optimize shareholder value.

[59] The new evidence at Exhibit A to the Ferguson Affidavit includes screenshots which display the Marks in use by Levantas on their website in relation to a broad range of services including: strategic planning, governance and risk, financing growth, communications, branding, public relations, marketing, advertising, business processes, change management, information and communication technology, project engineering and rehabilitation services, project management and supervision, site management and rehabilitation, onsite financial management, project management (intellectual property), supply chain management, transaction guidance and supplier relations, business process outsourcing.

[60] Accordingly, in light of this new evidence, I am satisfied that VNI has provided evidence of use of various services including: *accounting services*, including *auditing*, *sustainability auditing*... and *business process management*; *business process consulting* and *mediation of agreements regarding the sale and purchase of goods and services* and *business centre services*, namely, *administration of customer loyalty and incentive award programs for others* and *consulting in the areas of computer, computer systems, information technology*; *computer services*, namely, *computer programming services for others*; *computer services*, namely,

developing websites for others and computer services, namely, operating websites for others and human resources services, and providing business information on employment and careers and public relations services.

[61] Further, the evidence supports use of the Marks in relation to the following services: *tax preparation, bookkeeping and tax consulting and business management planning, networking, and supervision and human resources services, namely, search, recruitment and placement services and human resources services, namely, payroll services and mediation services in conclusion of commercial transactions for others and investment planning, consulting and management services and financial management and financial planning and consulting services and providing monetary exchange services.*

[62] I accept that VNI has provided evidence of use of services listed above in accordance with section 4 of the *Act*.

[63] Paragraphs 20 and 21 of the Ferguson Affidavit address procurement services by Levantas during the Relevant Periods. Specifically, Exhibit A at pages 22 and 24 are screenshots of the Levantas' website titled "Transaction Guidance and Supplier Relations" and "Procurement" displaying the Marks. Exhibit D at pages 4 and 5 are invoices to a Calgary client for procurement services work. Exhibit E at pages 33, 34, 35, 47, 49, 50, 51 are emails from Levantas to a client displaying Mark 1 in the signature lines discussing procurement services.

[64] The information contained in Exhibits A, D, E to the Ferguson Affidavit covers the following services: *procurement services, namely, purchasing office furniture, telephone*

equipment, oilfield tools, oilfield equipment, call center equipment and security and monitoring equipment for others and... and monitoring equipment for others; waste disposal procurement, namely, purchasing of waste disposal equipment and services for others and providing advice relating to insurance issues and application service provider services, namely providing a server platform and third-party software that allows others to make fractional use of system resources and software licenses; application service provider services, namely providing integrated telephone and computer data systems for others and energy supply purchasing procurement for others and financial research in the attainment of benefits, business interruption and loss determination and rental of commercial property.

[65] I accept that VNI has demonstrated use of the services listed above, pursuant to section 4 of the Act.

[66] For “analysis services”, I accept the evidence outlined in Mr. Ferguson’s Affidavit at paragraph 22 referring to Exhibits A and E demonstrate evidence of use by its Affiliate, Levantas, during the Relevant Periods. Exhibit A at pages 18, 28, and 30 are screenshots of Levantas’ website titled “Site Management and Rehabilitation” displaying the Marks and Exhibit E at pages 7, 12, 26, 27, 29, 30, 31, 56, which are invoices to the Calgary client regarding energy audits, an insurance premium audit, renting residential properties regarding job-site supervision and financial research.

[67] The information attached to the Ferguson Affidavit in Exhibits A and E cover the following: *audit services in the fields of account auditing, auditing utility rates for others, business auditing, energy auditing, insurance premiums auditing and financial research in the*

attainment of benefits and construction management consultation, construction planning, construction supervision and project management in the fields of specification and architectural design services.

[68] This new evidence demonstrates use of services listed above according to section 4 of the *Act*.

[69] For “online recruiting services”, I find that Mr. Ferguson’s evidence, outlined at paragraph 23 of his Affidavit provides the necessary evidence of use by its Affiliate, Vermillion Communities Incorporated, during the Relevant Periods. Exhibits G and H demonstrate services being provided to workers who want to post resumes or search for posted jobs. It also shows services performed for companies who want to conduct online recruiting by use of Vermillion Communities Incorporated (VCI) services.

[70] Exhibits G and H to the Ferguson Affidavit demonstrate use of *online recruiting services, namely, providing searchable job postings and resume postings and advertising services, namely, personnel recruitment advertising and response management services and human resources services, namely, career counselling services and directory agency.*

[71] This is sufficient evidence of use of the services listed above within the meaning of section 4 of the *Act*.

[72] At paragraph 24 of his Affidavit, Mr. Ferguson addresses “advertising agency services”. He relies upon Exhibits A, D, E, H and I to demonstrate Levantas’ web pages offering the

services within this category of services. The evidence also includes information on writing advertisements for a client, creation of a corporate logo and brand identity materials, work on a public relations strategy services in the nature of mediation on the placement of advertisements, advertisement in a journal, and the preparation of a pamphlet that covers topics including fair trade in the nature of sustainability.

[73] Exhibit A at pages 6-11 are screenshots of Levantas' website titled "Mission-critical communications", "Strategic Positioning", "Branding", "Public Relations", "Marketing", "Advertising"; Exhibit D at pages 6-9 are invoices to the Calgary client for performance of services regarding public relations strategy and creating a corporate logo design and complimentary brand identity; Exhibit E at pages 37-41 are emails from Levantas to the Calgary client displaying Mark 1; Exhibit H is a Vermillion Professional Network invoice for writing an advertisement for the Calgary client with Mark 1 displayed; and Exhibit I is an invoice to a VCI client for the purchase of pamphlets .

[74] The evidence in support of the services addressed at paragraph 24 of the Ferguson Affidavit at Exhibits A, D, E, H demonstrate evidence of use by VNI's Affiliates, Levantas and VCI, during the Relevant Periods for the following: *advertising agency services and advertising services, namely, creating corporate logos for others, creating corporate and brand identities for others and publicity services, namely, assisting others in developing public relations strategies and mediation in the placement of advertisements.*

[75] I accept this as evidence of use with respect to the services included within this category of services listed above according to section 4 of the *Act*.

[76] At paragraph 25 of his Affidavit, Mr. Ferguson addresses “association services” and, in particular, international fellowship grant programs and distribution of educational material. At Exhibit J to his Affidavit is a series of emails showing the use of these various services in conjunction with an organization called the Sustainability Curriculum Consortium (SCC). He explains that VNI provided funds to SCC and describes their work as follows:

... SCC has been working since at least 2015 to create useful curriculum for educators (including in business and law schools) in the field of sustainable development generally, and specifically in fields which include but are not limited to: economics and economic development; how educators can effectively train government workers about workable governmental and social policy, and educate about legal reform relating to unhelpful legacy regulations; how best to engage the public off campuses on subjects of public and social affairs, human and civil rights, media and communications, international affairs, and the promotion of awareness of and fostering the development of a civil society.

[77] This new evidence demonstrates use according to section 4 of the *Act*.

[78] At paragraph 29 of his Affidavit, Mr. Ferguson addresses “financing of venture capital, namely, venture capital funding services to emerging and start-up companies.” Exhibit E to his Affidavit provides sufficient evidence to the Court to conclude that use of the service has been demonstrated in accordance with section 4 of the *Act*.

[79] Mr. Ferguson, at paragraph 30 of his Affidavit, addresses the services in relation to *real estate brokerage services* and *mortgage brokerage services* and *financial planning* services. Mr. Ferguson relies upon Exhibit E which is an email thread involving Levantas in relation to mortgage broker services. Further, Exhibit K is a real estate broker’s sheet from a brokerage affiliated with VNI displaying Mark 2 for a home offered for sale in Calgary.

[80] This provides sufficient evidence of use of the following services *real estate brokerage services; mortgage brokerage services and financial planning services* within section 4 of the *Act*.

[81] At paragraph 31 of his Affidavit, Mr. Ferguson addresses the following services: *engineering in the fields of environmental remediation, waste water purification and disposal, civil engineering, thermal engineering*. In support, Mr. Ferguson relies upon Exhibit A which includes information provided to clients and prospective clients offering to perform these services in engineering and related fields. Also, Exhibit E is an email to a client in Ontario regarding review of quotes from engineering companies and construction contractors in response to a request for proposal.

[82] This new evidence of use of the service descriptions is sufficient to satisfy section 4 of the *Act*.

[83] VNI has offered sufficient evidence in support of use of the above services. Further, for the above noted services, where there is a lack of direct evidence of the service description, I am satisfied that the Court can infer evidence-based upon use of related services. Upon considering the low-evidentiary threshold, I am satisfied that the new evidence demonstrates use of the Marks within the Relevant Periods.

[84] In light of this, and considering the evidence as a whole, I am satisfied that the Applicant has met its onus to demonstrate use of its Mark in association with the goods within the three-year period.

(3) Are there “services” for which there is no evidence of use?

[85] As noted above, where no new evidence of use of services during the Relevant Periods has been provided, VNI must establish that the Registrar made a palpable and overriding error (*Clorox* at para 23).

[86] VNI did not provide new evidence for *association services, namely, making phone calls, proposing policies and legislation, and encouraging members and the public at large to take action through lobbying and other means to help shape public policy, legislation and leadership positions*. At paragraph 26 of the Ferguson Affidavit, VNI refers back to the information already considered by the Registrar.

[87] VNI has not provided new evidence for the services described as *political action committee services, namely, promoting the interests of political candidates running for elected office* but relies upon paragraph 27 of the Ferguson Affidavit which refers back to the evidence considered by the Registrar.

[88] VNI has not provided new evidence for the services described as *electronic transmission of images and data in the fields of business, law, technology, fair trade, sustainable development, civil society, and human rights via computer and a global computer network*. As noted at paragraph 28 of the Ferguson Affidavit, they rely upon Mr. Ferguson’s previous affidavit and exhibits considered by the Registrar.

[89] As there is no new evidence for consideration with respect to these services, VNI must demonstrate a palpable and overriding error with the Registrar's Decisions on these services. No such submissions were made by VNI; accordingly, there is no basis for the Court to intervene with the findings of the Registrar.

[90] In summary, no evidence was led to establish the use of the following services or partial service descriptions in Mark 1, by reference to the page number in Schedule A to the Mark 1 decision:

- Page 48 - association services, namely, making phone calls, proposing policies and legislation, and encouraging members and the public at large to take action through lobbying and other means to help shape public policy, legislation and leadership positions
- Pages 48-49 - political action committee services, namely, promoting the interests of political candidates running for elected office
- Page 50 - arranging and conducting networking opportunities and events on the subjects of... fair trade...civil society, and human rights
- Page 50 - electronic transmission of images and data in the fields of business, law, technology, fair trade, sustainable development, civil society, and human rights via computer and a global computer network
- Page 51 - educational services, namely, sponsoring and conducting...cultural, international student... exchange programs
- Page 51 - arranging and conducting debates and speeches relating to current affairs and business affairs

- Page 51 - computer services, namely, providing a computer communications database for the exchange of information and news about best practices and lessons learned between businesses, governments, non-governmental organizations and people in the areas of ... ~~insurance, human resources, employment opportunities, law... public policy... social affairs and public affairs~~

[91] No evidence was led to establish use of the following services or partial service descriptions in Mark 2 as noted below by reference to the page number in Schedule A for the Mark 2 decision:

- Page 52 - association services, namely, promoting public awareness and participation regarding policy and legislative issues and leadership positions at... state... levels
- Page 52 - association services, namely providing information to members and the public at large regarding issues relating to policies, legislation and leadership positions at... state...levels
- Page 54 - arranging and conducting networking opportunities and events on the subjects of... fair trade...civil society, and human rights
- Page 55 - providing news
- Page 55 - telecommunication services, namely, electronic transmission of images and data in the fields of business, law, technology, fair trade, sustainable development, civil society, and human rights via computer and a global computer network

- Page 55 - educational services, namely, sponsoring and conducting...cultural, international student exchange programs, policy conferences, and research programs
- Page 55 - arranging and conducting debates and speeches relating to current affairs and business affairs
- Page 56 - computer services, namely, providing a computer communications database for the exchange of information and news about best practices and lessons learned between businesses, governments, non-governmental organizations and people in the areas of...accounting...financial reporting... computerized information processing...managed offices, outsourcing...auditing...insurance, human resources, employment opportunities, law...consumer market research...media relations, communication and advertising, leisure, cultural activities, fair trade, current events, world events, politics, public policy, the legislative process, government...leadership, networking...
- Page 55 – information and entertainment services, namely production of programming to be distributed via cable television, satellite television, radio
- Page 56 – lawyer referral services

V. Conclusion

[92] For the above reasons, registration No. TMA 894,117 and registration No. TMA 891,721 will be maintained.

[93] I am satisfied that the new evidence is sufficient to establish use of the Marks in association with goods during the Relevant Periods. Therefore, the goods description shall be fully restored by the Registrar.

[94] With respect to services, based upon the new evidence, I am satisfied that the majority of the services descriptions should also be restored, subject to the narrow categories identified in paragraphs 90-91 above for which I did not find evidence of use of those services.

JUDGMENT IN T-1484-21

THIS COURT'S JUDGMENT is that:

1. The Applicant's appeal under subsection 56(1) of the *Trademarks Act* is allowed in part;
2. Registrations No. TMA 894,117 and TMA 891,721 will be maintained but the statements of services will be amended to delete services noted with the strikethrough below:
 - a. Registration No. TMA 894,117:
 - Page 48 - ~~association services, namely, making phone calls, proposing policies and legislation, and encouraging members and the public at large to take action through lobbying and other means to help shape public policy, legislation and leadership positions~~
 - Pages 48-49 - ~~political action committee services, namely, promoting the interests of political candidates running for elected office~~
 - Page 50 - arranging and conducting networking opportunities and events on the subjects of... ~~fair trade... civil society, and human rights~~
 - Page 50 - ~~electronic transmission of images and data in the fields of business, law, technology, fair trade, sustainable~~

~~development, civil society, and human rights via computer and a global computer network~~

- Page 51 - educational services, namely, sponsoring and conducting...~~cultural, international student...~~ exchange programs
 - Page 51 - ~~arranging and conducting debates and speeches relating to current affairs and business affairs~~
 - computer services, namely, providing a computer communications database for the exchange of information and news about best practices and lessons learned between businesses, governments, non-governmental organizations and people in the areas of ... ~~insurance, human resources, employment opportunities, law, industry market research, marketing and sales, public policy, business, leadership, environment, social affairs and public affairs~~
- b. Registration No. TMA 891,721 will be maintained but the statement of services will be amended to delete the following services.
- Page 52 – association services, namely, promoting public awareness and participation regarding policy and legislative issues and leadership positions at... ~~state...~~ levels

- Page 52 - association services, namely providing information to members and the public at large regarding issues relating to policies, legislation and leadership positions at... ~~state~~...levels
- Page 54 - arranging and conducting networking opportunities and events on the subjects of... ~~fair trade...civil society, and human rights~~
- Page 55 - providing ~~news~~
- Page 55 - telecommunication services, namely, ...~~electronic transmission of images and data in the fields of business, law, technology, fair trade, sustainable development, civil society, and human rights via computer and a global computer network~~
- Page 55 - educational services, namely, sponsoring and conducting...~~cultural, international student~~... exchange programs...
- Page 55 - ~~arranging and conducting debates and speeches relating to current affairs and business affairs~~
- Page 56 - computer services, namely, providing a computer communications database for the exchange of information and news about best practices and lessons learned between

businesses, governments, non-governmental organizations and people in the areas of...~~accounting...financial reporting... computerized information processing, managed offices, outsourcing...auditing...insurance, human resources, employment opportunities, law...consumer market research...media relations, communication and advertising, leisure, cultural activities, fair trade, current events, world events, politics, public policy, the legislative process, government...leadership, networking...social affairs and public affairs, arbitration and mediation, and the promotion of awareness of and fostering development of a civil society~~

- Page 55 - information and entertainment services, namely production of programming to be distributed via ~~cable television, satellite television, radio~~
- Page 56 - ~~lawyer referral services~~

3. No costs are awarded.

"Ann Marie McDonald"

Judge

FEDERAL COURT

SOLICITORS OF RECORD

DOCKET: T-1484-21

STYLE OF CAUSE: VERMILLION NETWORKS INC V ESSILOR GROUP
CANADA INC.

PLACE OF HEARING: CALGARY, ALBERTA

DATE OF HEARING: OCTOBER 4, 2023

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DATED: MARCH 6, 2024

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