

Federal Court



Cour fédérale

Date: 20150209

Docket: T-738-13

Citation: 2015 FC 165

[UNREVISED ENGLISH CERTIFIED TRANSLATION]

Ottawa, Ontario, February 9, 2015

PRESENT: The Honourable Madam Justice Gagné

BETWEEN:

ILLICO COMMUNICATION INC.

Appellant

and

NORTON ROSE LLP

Respondent

JUDGMENT AND REASONS

[1] Before me is the appeal from a decision of the Registrar of Trade-marks, dated February 18, 2013, in which he expunged the registration of the trade-mark ILLICO COMMUNICATION, registered under No. TMA526,959. The Registrar was of the opinion that the appellant, Illico Communication Inc., had not provided sufficient evidence of use of the mark in association with each of the services listed in the registration over the three-year period preceding the sending of the notice at the respondent's request, in accordance with section 45 of

the *Trade-marks Act*, RSC 1985, c T-13 [Act]. The applicant is requesting that the decision of the Registrar be set aside and that the trade-mark be maintained.

[2] For the reasons set out below, I am of the view that this appeal must be dismissed.

I. Background

A. *Facts*

[3] The appellant is a small Quebec company, originally known under the company name of Illico Informatique Inc. and offering, when it started up, computer-assisted jurisprudential research products and services. It publishes the newsletters *Le Recherchiste* and the *Bulletin de Jurisprudence des Cours municipales du Québec* [BJCMQ]. Over the years, it expanded its activities by adding the design, hosting and maintenance of a few websites, and, on a few occasions, it provided promotional and communication services for candidates seeking the vice-presidency of the Barreau du Québec. Jean-Yves Côté is Illico's sole director and shareholder, and, essentially, its sole employee.

[4] In December 2003, the appellant changed its name to ILLICO COMMUNICATION INC.

[5] During the relevant period, it owned the following trade-marks:

- ILLICO, registered by the appellant on August 13, 1993, under No. TMA415,524, in association with "*Computer-assisted jurisprudential research services*";

- ILLICO COMMUNICATION, acquired by the appellant on October 18, 2001, but registered by a third party on April 25, 2000, under No. TMA526,959, in association with services in “*Publishing graphics, corporate graphics and promotional and communication graphics, specifically advertising, magazines and signs, design of Internet showcases and photographs, and related services, specifically writing, translation and proofreading*”;
- ILLICO, registered by the appellant on January 25, 2007, under No. TMA680,397, in association with the following wares: “*Stationery, namely paper supplies for use in legal professions, preprinted sheets of paper, labels, chart pads, paperboard items for use in legal professions, namely folders, portfolios, binders, sleeves, charts, bindings, dividers, tabs; printed goods, namely books, journals, periodicals, casebooks, copies of decisions, magazines*”; and the following services: “*Advice, information and business information, namely legal advice. Publishing, namely services related to the publishing of books, magazines, periodicals; publication of documents on a worldwide computer network for the exchange and distribution of a broad range of information. Research, namely research on decisions on behalf of third parties on electronic networks, development of decision research systems on behalf of third parties.*”

[6] The dispute concerns only the second of these marks (TMA526,959), which is not a design mark.

ILLICO COMMUNICATION

[7] On November 14, 2011, at the request of the respondent, Norton Rose OR LLP (now Norton Rose Fulbright Canada LLP), counsel for Vidéotron S.E.N.C., the Registrar sent the appellant a notice, under section 45 of the Act, requesting that it provide evidence of use of the mark in association with each of the services specified in the registration at any time during the three years preceding the date of the notice, that is, between November 14, 2008, and November 14, 2011.

[8] In reply to the notice, the appellant filed the affidavit of Jean-Yves Côté, supported by some evidence. It did not file any written submissions, and neither of the parties requested a hearing.

[9] On February 18, 2013, the Registrar rendered the impugned decision, expunging the mark.

B. *Affidavit evidence submitted to the Registrar*

[10] In his affidavit dated February 13, 2012, submitted to the Registrar, Mr. Côté essentially explains what his company does under the ILLICO COMMUNICATION mark, namely, writing, formatting and publishing the newsletter *Le Rechercheur*; proofreading; and providing publishing graphics, communication graphics and the graphics for the BJCMQ CD-ROM. He

also states that the appellant participated in preparing the corporate and promotional graphics of the Internet showcase www.pierrechagnon.com, and paper flyers and a promotional email for Pierre Chagnon's campaign for the vice-presidency of the Barreau du Québec; and that it provided consulting services on graphics, and the design of promotional emails with photographs and of promotional signs with photographs for Anne Lessard's campaign for the vice-presidency of the Barreau du Québec.

[11] Mr. Côté recognizes, however, that, during the relevant period, the appellant did not use the mark in association with translation services. He supports his affidavit with the following evidence (to avoid confusion, the numbers are those provided in Mr. Côté's second affidavit, which I will discuss later):

- JYC-2 Contractual documents confirming the sale and the cessation of use of the mark and the company name ILLICO COMMUNICATION, and of the domain name illico.ca for the benefit of the applicant;
- JYC-3 Documents concerning the registration of the mark and the change in title for the benefit of the applicant;
- JYC-4 Newsletter *Le Recherchiste* (issue No. 34);
- JYC-5 BJCMQ (paper copy dated January-February 2011);
- JYC-6 BJCMQ (2008 CD-ROM and printed sleeves from 2010);
- JYC-7 Promotional letter concerning Pierre Chagnon's campaign accompanied by the letter delivery email and invoice No. 19359 dated April 14, 2008; and

- JYC-8 Documents concerning the organization of Anne Lessard's electoral campaign.

C. *Decision under appeal*

[12] The Registrar's main, determinative conclusions can be found in the following excerpt:

[28] Therefore, in summary, the documentary evidence shows the use of "illico Communication Inc." as a company name and does not constitute proof of the use of a trade-mark in association with services [see *Sunny Fresh Foods Inc.*]. On some documents, we find the mention "illico" but followed by "@" to indicate that this term is a registered mark. This is not a use of the Mark, since everything is followed by "Communication Inc." in order to clearly identify the Registered Owner's company name. Some of the documents submitted are from after the Relevant Period and the only invoice submitted is prior to the Relevant Period. Lastly, even if I were to conclude that exhibits JYC-3 and JYC-5 [JYC-4 and JYC-6 according to the list in paragraph 10 of these reasons] are illustrations of the fruits of services performed by the Registered Owner, these services were not offered to third-parties but were performed for the sole benefit of the Registered Owner.

[29] There remain therefore only Mr. Côté's statements regarding the use of the Mark. However, such statements not corroborated by documents, as is the current case, are insufficient to conclude in use of the Mark in association with the Services during the Relevant Period. [Emphasis added]

[13] The Registrar acknowledges Mr. Côté's admission that the mark had not been used in association with translation services and concludes from the outset that this service will be struck from the list of services. This conclusion is not being challenged in this appeal.

D. *Le Recherchiste* and *BJCMQ* newsletters

[14] The Registrar then found that the evidence presented by the appellant did not establish that the relevant services had been performed or advertised in association with the mark. For example, in Exhibit JYC-4, an issue of the *Le Recherchiste* newsletter, one can see that the appellant summarizes a few recent decisions in civil law and, because the issue contains an order form, that it offers the services of [TRANSLATION] “on-demand case law”. These services are not listed in association with the mark.

[15] The Registrar adds that, in Exhibit JYC-4, the appellant uses a mark (Illico, not Illico Communication) in association with a product (the newsletter itself) but not in association with a service. The use of the ® symbol next to the word “illico” could indicate use of a registered trade-mark, even though the Act does not require such marking. The Registrar is therefore of the view that the appellant’s use of “©illico Communication Inc.” and “illico Communication Inc.” refers to the entity that publishes this legal newsletter.

[16] The Registrar makes the same finding with respect to Exhibit JYC-6, the cover of the box containing the BJCMQ CD-ROM. The reference to Illico® Communication Inc. found on it serves to identify the publisher of the CD-ROM and represents the appellant’s company name, not the mark.

[17] Moreover, with respect to both publications, the Registrar finds that since the appellant is their publisher, the services of publishing graphics and related services were performed for the

appellant and not offered to the public or performed for the benefit of a third party (*Ralston Purina Co v Effem Foods Ltd* (1997), 81 CPR (3d) 528).

[18] Finally, the Registrar is of the opinion that the references on the newsletters *Le Recherchiste* and *BJCMQ* to “illico Inc.”, the website “www.illico.ca” and the address “illico@illico.ca” also do not constitute use of the trade-mark.

E. *Mr. Chagnon’s and Ms. Lessard’s electoral campaigns*

[19] Exhibit JYC-7 reproduces, in a bundle, a flyer promoting Mr. Chagnon’s candidacy for the vice-presidency of the Barreau du Québec, a promotional email from Mr. Chagnon dated April 24, 2008, and an invoice from the appellant for services rendered to Mr. Chagnon, dated April 14, 2008. The Registrar notes that there is no mention of the mark on the flyer and that the other two documents predate the relevant period.

[20] For the same reasons, the Registrar does not consider Exhibit JYC-8, which reproduces, in a bundle, some promotional emails and flyers concerning Ms. Lessard’s candidacy for the vice-presidency of the Barreau du Québec. This time, all the documents, except for the first email, postdate the relevant period. The only email sent during the relevant period is an invitation to a meeting sent to the members of Ms. Lessard’s campaign organizing committee, including Mr. Côté. It includes no reference to any mark, let alone that of the appellant.

F. *New evidence filed for this appeal*

[21] In accordance with subsection 56(5) of the Act, the appellant submitted new evidence for this appeal. It submitted three affidavits, namely, (i) the affidavit of Jacques Marquis dated April 24, 2013; (ii) the affidavit of Pierre Chagnon dated May 23, 2013; and (iii) the affidavit of Jean-Yves Coté dated June 6, 2013. The last affidavit is supported by Exhibits JYC-9 to JYC-22, and the Court accepted the filing of Exhibits JYC-23 and JYC-24 at the hearing. The following is a list of the exhibits:

- JYC-9 Excerpt from the Canadian trade-marks database regarding the mark ILLICO No. TMA415,524;
- JYC-10 Excerpt from the Canadian trade-marks database regarding the mark ILLICO No. TMA680,397;
- JYC-11 Legal opinion dated July 25, 2001, from law firm Lapointe Rosenstein sent to Vidéotron Ltée regarding the availability of the ILLICO marks;
- JYC-12 Information on Illico Communication Inc. from the Quebec Enterprise Register;
- JYC-13 Home page of the Illico Communication Inc. website, www.illico.ca (the same as Exhibit JYC-16);
- JYC-14 Invoices sent to various clients in relation with legal research services;
- JYC-15 Example of case law research performed by the appellant;

- JYC-16 Home page of the Illico Communication Inc. website, www.illico.ca (the same as Exhibit JYC-13);
- JYC-17 Statements and invoices from Domainsatcost.ca regarding the appellant's reservation of domain names for third parties;
- JYC-18 Invoices for the design, development and hosting of the website of a client of the appellant;
- JYC-19 A mix of correspondence with the Barreau du Québec regarding the deactivation of the website of a client of the appellant;
- JYC-20 Invoices for BJCMQ CD subscriptions and orders, in a bundle;
- JYC-21 Promotional documents for the BJCMQ, created and distributed by the appellant;
- JYC-22 Various invoices in association with the appellant's activities;
- JYC-23 Invoice from the appellant to Anne Lessard for [TRANSLATION] "design of campaign flyers and promotional emails";
- JYC-24 Contract of assignment of copyright dated July 23, 2014, between the Honourable Pierre G. Bouchard, on the one hand, and Jean-Yves Côté and the appellant, on the other, regarding the BJCMQ.

II. Issues

[22] The issues raised in this appeal are the following:

- What is the standard for intervention of this Court when sitting on appeal from a decision of the Registrar of Trade-marks?
- Has the applicant provided acceptable evidence of use of the mark, as required by section 45 of the Act?

III. Analysis

A. *Test for intervention*

[23] In the absence of new evidence, the case law informs us that the Court only intervenes if it finds the Registrar's conclusion to be unreasonable. However, when additional evidence is produced before this Court, the standard of correctness applies when the new elements of this evidence could have materially affected the Registrar's decision, and the Court must decide the issue *de novo* (*Hayes v Sim & McBurney*, 2010 FC 924 at paras 14-15; *Empresa Cubana Del Tabaco (Trading also as Cubatabaco) v Shapiro Cohen*, 2011 FC 102 at paras 46-48; *Locke v Osler, Hoskin & Harcourt LLP*, 2011 FC 1390 at paras 19-20).

[24] The appellant is asking the Court for a *de novo* ruling on the basis that the additional evidence produced increases the weight of the evidence before the Registrar. The respondent submits that the applicable standard is that of reasonableness since the additional evidence would not have materially affected the Registrar's decision (*Spirits International B.V. v BCF*

S.E.N.C.R.L., 2012 FCA 131 [*Spirits International B.V.*] at para 10). The respondent argues that in order for the Court to depart from the reasonableness standard in an appeal from a decision of the Registrar, the evidence produced must be of quality and not of quantity (*Hawke & Company Outfitters LLC v Retail Royalty*, 2012 FC 1539 [*Hawke*] at para 31).

[25] I agree with the appellant on this issue and adopt the words of my colleague Justice Manson, in *CEG License Inc v Joey Tomato's (Canada) Inc*, 2012 FC 1541 at para 14:

[14] Given new evidence was filed by the opponent in this matter that was not before the Opposition Board, the Court has an unfettered discretion to consider the matter and come to its own conclusion as to the correctness of the Board's decision, if the new evidence is significant and would materially affect the underlying decision: (*Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657 [*Bojangles*]; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at paras 35, 37)[.]

[26] My colleague Justice Kane recently summarized the case law on this Court's standard for intervention, in *Gemological Institute of America v Gemology Headquarters International*, 2014 FC 1153 at para 25:

The test for new evidence

[25] In order to determine whether new evidence would have materially affected the Board's decision, the Court must consider the evidence's nature and quality, taking into account its significance, probative value and reliability (*Bojangles' International LLC et al v Bojangles Café Ltd*, 2006 FC 657 at para 10, 293 FTR 234 [*Bojangles*]; *CEG*, above, at paras 16 and 20). The test is one of quality not quantity (*London Drugs*, above, at para 35; *Bojangles*, above, at para 15; *Hawke & Company Outfitters LLC v Retail Royalty Co*, 2012 FC 1539 at para 31, 424 FTR 164 [*Hawke*]); the new evidence cannot be merely repetitive or supplementary to the material that was before the Board, but must add something of significance and enhance its cogency (*Telus Corp v Orange Personal Communications Services Ltd*, 2005 FC 590 at para 33, 273 FTR 228; *Rothmans*,

Benson & Hedges, Inc v Imperial Tobacco Products Ltd, 2014 FC 300 at para 34, 239 ACWS (3d) 473, quoting *Vivat Holdings Ltd v Levi Strauss & Co*, 2005 FC 707 at para 27, 139 ACWS (3d) 93; *Advance*, above, at paras 38 and 41; *Prince v Orange Cove-Sanger Citrus Assn*, 2007 FC 1229 at para 9, 322 FTR 212; *Chamberlain Group, Inc v Lynx Industries Inc*, 2010 FC 1287 at para 31, 379 FTR 270 [*Chamberlain Group*]).

[27] She adds the following at paragraph 62:

[62] The Court is required to put itself into the mind of the TMOB to assess whether the new evidence – had it been provided to the Hearing Officer – would have made a difference to the result. The question is whether the new evidence addresses the deficiencies noted by the TMOB which led to its findings and whether that evidence has sufficient significance or probative value that it would have changed the factual basis for the decision or otherwise materially affected the decision.

[28] I find that some of the new evidence submitted by the appellant before this Court is sufficient to displace the deferential standard of reasonableness. In light of the Registrar's reasons, it is my view that this new evidence, which I will discuss later, could have had a concrete effect on his conclusions. In assessing the significance and quality of the evidence submitted, the Court must determine whether the various factors "would materially affect [the Registrar's] findings of fact or the exercise of his discretion" (*Spirits International B.V.; Hawke*, at para 30). The Registrar states on a few occasions in his reasons that the only invoice produced under Exhibit JYC-7 predates the relevant period. In support of this appeal, the appellant filed various invoices, and, even though many of them are of no relevance to the issues under review, some are, because they relate to the relevant period and are not repetitive of the evidence submitted before the Registrar (*Vivat Holdings Limited v Levi Strauss & Co*, 2005 FC 707 at para 27). The invoices could have had an effect on one of the Registrar's findings of fact since

they corroborate some of Mr. Côté's allegations, specifically with respect to the services provided to Ms. Lessard (see *Spirits International B.V.*, at paras 22 to 24).

[29] Unlike the additional evidence submitted in *Hawke*, above, at para 39, the new evidence submitted in the present proceeding addresses several of the Registrar's concerns and could have influenced his findings. I will therefore apply the correctness standard and assess the evidence *de novo*.

- (1) **Has the applicant provided acceptable evidence of use of the mark, as required by section 45 of the Act?**

[30] The context of this case is a particular one in that the appellant is a very small company that, essentially, is the *alter ego* of its sole shareholder and that does not have a large business volume. Mr. Côté argues that Vidéotron acted in a cavalier fashion in 2001 in launching its digital television service under the name of ILLICO and that, since filing various applications for trade-marks, which, to date, have been neither registered nor denied, it has been hounding the appellant.

[31] While a small company such as the appellant is entitled to the same protection of its marks as a multinational one, it is also subject to the same statutory requirements and cannot lay claim to greater protection than that offered by the Act.

[32] I have therefore painstakingly reviewed the evidence before me in light of the services specified in the registration, which can be dissected as follows:

- a. Publishing graphics and photographs and related services, specifically writing and proofreading;
- b. Corporate graphics and photographs and related services, specifically writing and proofreading;
- c. Promotional and communication graphics, specifically advertising, magazines and signs, and photographs and related services, specifically writing and proofreading;
- d. Design of Internet showcases and photographs and related services, specifically writing and proofreading.

[33] The segment “and photographs, and related services, specifically writing, translation and proofreading” may be interpreted as not applying to the service of design of Internet showcases or even as being related to the four types of services specified in the registration. For the purposes of the present reasons and since the parties have not taken a position on this issue, I have chosen the interpretation that is most favourable to the appellant, by withdrawing the related service of translation.

[34] The appellant had to establish *prima facie* that, during the relevant period, it had provided the specified services to third parties, in association with the ILLICO COMMUNICATION mark. The parties agree that *Plough (Canada) Limited v Aerosol Fillers Inc*, [1981] 1 FC 679, and *Guido Berlucchi & C. S.r.l. v Brouillette Kosie Prince*, 2007 FC 245 [*Guido Berlucchi*], apply to the treatment of evidence adduced under section 45 of the Act. However, the appellant

insists on the fact that the evidence filed in this case suffices for it to meet its lower burden, and it considers that in failing to [TRANSLATION] “remove” use of the mark from the evidence, the Registrar imposed too heavy a burden on it.

[35] The evidence before me shall be analyzed by specified service. Since the appellant did not provide any evidence that it had provided corporate graphics services in association with the mark, this issue will not be discussed.

(a) *Publishing graphics and related services*

[36] As indicated, the appellant’s first and main activity is jurisprudential research and other legal services. Both of its ILLICO marks are in association with this activity: the first was registered in 1993, and the second in 2007, in part to take into account the dramatic advance of the Internet and various research platforms.

[37] Some exhibits are related to the publication of the *Le Recherchiste* newsletter (JYC-4, JYC-12, JYC-13, JYC-14, JYC-15 and JYC-16) and others to the publication of the BJCMQ (JYC-5, JYC-6, JYC-12, JYC-20, JYC-21 and JYC-24), while one exhibit is related to various related legal services (JYC-22), such as the preparation of an appeal memorandum or the photocopying of a Superior Court docket.

[38] The fact that the appellant is both a service provider and the publisher of the *Le Recherchiste* newsletter is a determinative factor here. Since the publishing graphics services in association with this publication were not offered to or performed for the benefit of a third party,

the adduced evidence, albeit abundant, is irrelevant. Indeed, I agree with the other reasons given by the Registrar for rejecting this evidence of use of the mark.

[39] The evidence concerning the publication of BJCMQ requires a more thorough analysis. The appellant filed Exhibit JYC-24 at the hearing; it consists of a contract assigning the Honourable Pierre G. Bouchard's copyright in this publication. The only consideration provided in the contract seems to be the appellant's obligation to pursue and modernize this work, while continuing to associate it with the name of Retired Justice Bouchard. The appellant argues that the rights were assigned in 2014 because they belonged to a third party during the relevant period and that therefore the publishing graphics services had been offered to the public and performed for a third party.

[40] However, the contract under Exhibit JYC-24 sheds only little light on the terms of the agreement that allegedly prevailed between the appellant and Justice Bouchard during the relevant period. Did Justice Bouchard grant a licence to the appellant, which paid him royalties? We do not know. One thing is certain: the appellant was the publisher of the work, and, as confirmed by the many invoices produced under Exhibit JYC-20, all BJCMQ subscription fees were paid to the appellant. The information from the Quebec Enterprise Register (Exhibit JYC-12) reveals that the appellant has been using the trade name BJCMQ since 2004, and so Justice Bouchard must have certainly permitted it to do so.

[41] What we do not know is the identity of the beneficiary of the publishing graphics services. Was it the publisher, the appellant? There is no invoice for these services, which the

appellant would have offered to itself. Or was it Justice Bouchard? In this case, there would have been invoices addressed to Justice Bouchard specifically for these services. No such invoice was filed. As indicated above, the many invoices filed in association with the BJCMQ suggest rather the opposite, namely, that the appellant was providing itself, in its capacity as the publisher of the BJCMQ, with publishing graphics and related services.

(b) *Promotional and communication graphics and related services*

[42] Exhibits JYC-4 and JYC-7 (PC-1) concern the services rendered by the appellant in association with Mr. Chagnon's campaign for the vice-presidency of the Barreau du Québec. They all predate the relevant period; the services were rendered and invoiced, and Mr. Chagnon was elected, before the relevant period. This evidence is therefore of no assistance to the appellant.

[43] However, in my view, the appellant filed sufficient evidence to establish that it offered promotional and communication graphics services to Ms. Lessard during the relevant period. In his affidavit dated May 23, 2013, Mr. Chagnon explains that he contacted the appellant in early October 2011 (which is during the relevant period) in order to retain its services [TRANSLATION] "in IT, telecommunications, the design and development of promotional tools, graphics and documents in the organization and running of the campaign of Anne Lessard, who was seeking the vice-presidency of the Barreau du Québec". Exhibits JYC-8 and JYC-23 confirm that the appellant provided Ms. Lessard with promotional and communication graphics services between early October 2011 and an unknown date, and that Ms. Lessard was invoiced for these services

in July 2012. A single sale in a business's normal course of trade can suffice to establish *prima facie* that services were rendered (*Guido Berlucchi*, at para 17).

[44] Were they, however, rendered in association with the mark?

[45] On both the home page of its website and its invoices, the appellant uses a logo showing two doors between a set of columns (which could represent the entrance to a courthouse), next to which is a computer mouse. Underneath this image are the following words:

Illico®
Communication inc.

[46] In most cases, the appellant's address, telephone number and website address are right next to the logo and the words.

[47] When a company's corporate name and principal trade name are identical to the trade-mark, as in the matter at bar, there exists a rebuttable presumption that the corporation is using its trade name rather than its trade-mark (*Road Runner Trailer Manufacturing Ltd v Road Runner Trailer Co.* (1984), 1 CPR (3d) 443 [*Road Runner*]). The appellant refers to certain decisions of the Trade-marks Opposition Board that clearly show that each case must be analyzed on its own merits, but that it is up to the appellant to rebut this presumption (*Société Canadian Tire Corporation v CTC Bank of Canada*, 2005 CanLII 78207; *Bulova Watch Company Limited v Gowlings Lafleur Henderson*, (2006), 51 CPR (4th) 470; *Capri Insurance Services Ltd v Intercity Equity Corp* (2009), 74 CPR (4th) 49; *Good Earth Cafes Ltd (Re)*, 2013 TMOB 75).

[48] For its part, the respondent reiterates the arguments made by the Registrar and submits that the appellant's choosing to associate the ® symbol with the word ILLICO rather than with the expression ILLICO COMMUNICATION, and its almost always adding "Inc." to this expression, clearly confirm that the presumption is not rebutted here. Relying on *AGF Management Ltd (Re)*, (2003), 29 CPR (4th) 411, it adds that, in any event, the presence of a symbol is not sufficient to suggest use of the mark.

[49] The relevant exhibits for analyzing this issue are JYC-13 (home page of the appellant's website), JYC-14 (bundle of invoices for jurisprudential research services), JYC-16 (home page of the appellant's website), JYC-20 (bundle of invoices for BJCMQ subscription fees), JYC-22 (invoices for various legal services) and JYC-23 (invoice for promotional services rendered to Ms. Lessard).

[50] First, the appellant uses the same invoice form for each of its commercial activities. Since the form depicts the logo and words described at paragraph 45 of these reasons, this suggests that the form was developed in association with the appellant's first and main activity, namely research and other related legal services, and there is every reason to believe that the form was developed at a time when the mark the appellant wished to promote was that associated with these services, namely ILLICO. One can readily appreciate that the appellant chose to use the same invoice form when it diversified its activities. One can also appreciate that the home page of the appellant's website refers almost exclusively to these same legal research services (except for a single reference to the website design and hosting service to be discussed below). No

reference is made to the promotional and communication graphics services. The appellant therefore does not advertise these services in association with any mark whatsoever.

[51] It is also obvious, on both the appellant's invoices and the first page of its website, that the reference there to Illico Communication or Illico Communication inc. is a reference to its trade name and not to its trade-mark. This is confirmed by the testimony of Mr. Chagnon and of Mr. Marquis, who, in their affidavits respectively refer to the company ("entreprise") ILLICO COMMUNICATION and to the firm ("firme") ILLICO COMMUNICATION, without mentioning the trade-mark.

[52] I am therefore of the opinion that the appellant has not succeeded in rebutting the presumption discussed by Justice Lemieux in *Road Runner*. The appellant did not establish that, during the relevant period, it offered and rendered to the public services in association with the mark.

(c) *Design of Internet showcases and related services*

[53] The relevant exhibits for analyzing this issue are JYC-13 and JYC-16 (home page of the appellant's website), JYC-17 (statement and invoices from Domainstatcost.ca to the appellant for hosting websites), JYC-18 (invoice for the design, development and hosting of website www.michelcyravocat.ca) and JYC-19 (exchange of emails between the appellant and the Barreau du Québec regarding the closing of the website of a disbarred advocate).

[54] As indicated earlier, the first page of the appellant's website, produced by the appellant, contains a reference to the website design and hosting services offered by the appellant.

However, below this reference is the following statement: "Site développé par !llico (illico.net)" [site developed by !llico (illico.net)]. Consequently, if the appellant offered the design of Internet showcases as a service during the relevant period, it did not do so in association with the mark but with another trade-mark that is not at issue here.

[55] The respondent filed the affidavit of Lisa Saltzman, the director of the trade-marks research department at Onscope. In this affidavit, Ms. Saltzman explained that, as part of a mandate related to the appellant's opposition to the registration of the ILLICO mark of Videotron S.E.N.C., she visited the appellant's website on December 14, 2011, and printed its first page, which she produced as Exhibit LS-2.

[56] Even though the page shows the statement "Site développé par !llico (illico.net)", there is no mention of the fact that the appellant was offering website design and hosting services. This statement was therefore added by the appellant after the relevant period, and it does not suggest that the appellant was offering such services to the public during the relevant period.

[57] The first two pages of JYC-17 contain a history of the invoices sent by Domainstatcost.ca to the appellant over the course of the relevant period. They do not contain any reference to the mark, or any details about the websites concerned or the ownership of these sites. The following pages consist of seven invoices from Domainstatcost.ca, sent to the appellant and covering the services of hosting various websites during the relevant period. A number of these sites belong to

the appellant, while two of them belong to Richard Morand and Mr. Marquis, respectively. These documents do not establish that the appellant offered its design of Internet showcases services during the relevant period, but that, at the most, and, quite incidentally, it offered website hosting services. In his affidavit, Mr. Marquis states that his site was designed by the appellant in 2005 and that it has been hosted and maintained by the appellant since, without interruption. This is not evidence that the appellant offered and rendered design of Internet showcases services to the public during the relevant period, except if one concludes that there is a design element in the maintenance services.

[58] However, and even if this were the case, for the reasons set out above, these services were not offered in association with the mark since any reference to ILLICO COMMUNICATION in the documents filed is a reference to the appellant's trade name, or a reference to the ILLICO mark.

IV. Conclusion

[59] For all of these reasons, it is my view that the appellant's appeal must be dismissed and that the trade-mark ILLICO COMMUNICATION, registered under No. TMA526,959, must be expunged from the Register in accordance with subsection 45(3) of the Act.

JUDGMENT

THE COURT ORDERS AND ADJUDGES that:

1. The appeal from the decision of the Trade-marks Registrar dated February 18, 2013, be dismissed;
2. The registration of the trade-mark ILLICO COMMUNICATION, registered under No. TMA526,959, be expunged; and
3. Costs be awarded to the respondent.

“Jocelyne Gagné”

Judge

Certified true translation
Johanna Kratz, Translator

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-738-13

STYLE OF CAUSE: ILLICO COMMUNICATION INC. v NORTON ROSE
LLP

PLACE OF HEARING: MONTRÉAL, QUEBEC

DATE OF HEARING: SEPTEMBER 8, 2014

**JUDGMENT AND REASONS
BY:** GAGNÉ J.

DATED: FEBRUARY 9, 2015

APPEARANCES:

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