

[Toronto Standard Condominium Corp. No. 1864 \(Re\), \[2019\] T.M.O.B. No. 5061](#)

Canada Trade-marks Opposition Board Decisions

Canada

Trade-marks Opposition Board

(Registrar of Trade-marks)

Panel: G.M. Melchin, Hearing Officer

Decision: June 28, 2019.

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IN THE MATTER OF A SECTION 45 PROCEEDING Between Osler, Hoskin & Harcourt LLP, Requesting Party, and Toronto Standard **Condominium** Corporation No. 1864, Registered Owner, and TMA591, 399 for SPIRE, Registration

(24 paras.)

Appearances

Osler, Hoskin & Harcourt LLP, the requesting party.

DECISION

INTRODUCTION

1 At the request of Osler, Hoskin & Harcourt (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trade-marks Act*, [RSC 1985, c T-13](#) (the Act) on July 21, 2017, to Toronto Standard **Condominium** Corporation No. 1864 (the Owner), the registered owner of registration No. TMA591, 399 for the trademark SPIRE (the Mark).

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

Construction and operation of a **condominium** building and sales of **condominium** units.

3 The notice required the Owner to show whether the trademark has been used in Canada in association with each of the services specified in the registration at any time within the three-year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is July 21, 2014 to July 21, 2017.

4 The relevant definition of use for services is set out in section 4 of the Act as follows:

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

5 It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing "deadwood" from the register. As such, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, [2004 FC 448](#)]. A registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, [2010 FC 1184](#) at para 2]. Concerning services, the display of the trademark in the advertisement of the services is sufficient to satisfy the requirements of section 4(2) of the Act, from the time the owner of the trademark offers and is ready to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* ([1976](#)), [28 CPR \(2d\) 20](#) (TMOB)].

6 On October 18, 2017, the Owner furnished the affidavit of Susan Watts, a director of the Owner, sworn on October 16, 2017, and the affidavit of Yehudi L. Hendler, the President and a director of Y.L. Hendler Ltd, also sworn on October 16, 2017. Only the Owner filed written representations. Neither party requested an oral hearing.

THE OWNER'S EVIDENCE

Watts Affidavit

7 Ms. Watts attests that the Owner is the registered owner of the "common elements" of a **condominium** property located at 33 Lombard Street, Toronto, which she refers to as "the Property". She specifies that the common elements include such elements as walkways, driveways, and elevators.

8 Ms. Watts asserts that the Owner "has been using the Mark in association with construction and operation of a **condominium** building and sales of **condominium** units in Canada" and has developed a significant reputation for doing so.

9 Ms. Watts explains that the Property is managed for the benefit of the Owner and the owners of the individual **condominium** units by YL Hendler Ltd., to whom she refers as "the Manager". As Exhibit C to her affidavit, she attaches a **condominium** management agreement between the Owner and the Manager, dated July 1, 2008. This agreement, which continues to be in effect, establishes that the function of the Manager "is to assist the [Owner] in the operation and administration" of the Property, and that the Manager shall perform its duties "subject to the direction" of the Owner's board of directors. I note that section IV of this agreement refers to "Maintenance and repair" and "Preventative maintenance". Ms. Watts explains that the Manager has been "directed to use the Mark in the course of the operation and management of the Property." She further explains that all work undertaken by the Manager under the agreement, as well as its use of the Mark, is under the supervision of the Owner through its board of directors. As Exhibit D, she attaches letters from the Manager to the Owner dated June 26, 2015, and June 26, 2016, setting the fees to be paid by the Owner to the Manager to manage the Property on its behalf for 2015-2016 and 2016-2017, respectively.

10 As Exhibits E, F, G, H, I, and M, Ms. Watts attaches a number of letters from the Owner and Manager to various entities, including the Toronto City Council, Toronto Police Services, and unit owners. These letters concern various matters relating to the maintenance and management of the Property; for instance, Exhibit I describes mandatory in-suite testing of fire detectors, while Exhibit M discusses the operating budget for the Property. Each such letter is dated within the relevant period and features the following logo on its letterhead:



11 As Exhibit J, Ms. Watts attaches various pages from issues of a newsletter entitled *inSPIRE*, dated December 2014, December 2015, October 2016, and May 2017. She states that this newsletter is published by the Manager for the benefit of unit owners. The Mark appears numerous times throughout the newsletter, which details a number of matters related to the Property, including work being done to repair damage to elevators sustained during a flood on September 17, 2014, as well as renovations to the driveway and parkette beginning in May 2017 and concluding on June 30, 2017.

12 Ms. Watts also attaches, as Exhibit K, screenshots from the website www.thespire.ca, which includes information for existing and potential unit owners and tenants. The SPIRE logo reproduced above is displayed on these screenshots. The pages reproduced in the screenshots provide contact information for the Owner and details on the location and amenities offered by the Property. As Exhibit L, she attaches a printout from the web service WHOIS, dated September 14, 2017, showing that the Owner is the registrant of the domain name www.thespire.ca and that the domain was created on October 12, 2007, and updated on February 18, 2016.

13 Ms. Watts attests that the Property is regularly identified as "SPIRE" by a number of third parties, including online commentators, bloggers, and members of the real estate community. As Exhibits N and O, she attaches a number of screenshots from various websites identifying the Property as "Spire". I note that these screenshots do not appear to be dated within the relevant period.

14 In addition, as Exhibits P, Q, and R, Ms. Watts attaches invoices dated within the relevant period from the Canadian Condominium Institute and two other third parties. Each such invoice is addressed to the Owner and identifies the Property as "Spire", "The Spire", or "Spire Condo".

Hendler Affidavit

15 Mr. Hendler's affidavit is substantially similar to Ms. Watts' affidavit. It consists in large part of identical language and most of the attached exhibits are identical. Mr. Hendler adds that the Manager reports to a delegate of the Owner's board of directors on a weekly basis, and attends meetings of the board of directors at least once per quarter.

ANALYSIS

16 First, the Owner acknowledges that some of its evidence includes the formulation "The Spire" as opposed to simply "SPIRE", but the Owner submits that the public would not be misled by this variation. I concur. Use of a word mark in combination with additional words or design elements qualifies as use of the word mark if the public, as a matter of first impression, would perceive the word mark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); see also *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)]. Here, the presence of the definite article "the" is a sufficiently minor variation, such that it is reasonable to conclude that members of the public, as a matter of first impression, would consider the word mark "SPIRE" to be in use.

17 Furthermore, in some instances of the word "SPIRE" in evidence, the letter "I" is stylized in the form of a high-rise building. However, it is well established that a registration for a word mark can be supported by use of that

mark in any stylized form [see *Stikeman, Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB)]. The question to be asked is whether the trademark was displayed in such a way that it did not lose its identity and remained recognizable, in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA)]. In the present case, I find that the word mark retains its identity and remains recognizable.

18 I am also satisfied that the Owner exercised control over the character and quality of the services performed by the Manager in association with the Mark under licence, such that the Manager's use of the Mark enures to the Owner's benefit under section 50(1) of the Act. As stated by the Federal Court, there are three main methods by which a trademark owner can demonstrate the requisite control pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of the licence agreement that provides for the requisite control [*Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102 at para 84]. In this case, Ms. Watts and Mr. Hendler have clearly attested to the fact that all work done by the Manager under the property management agreement, as well as its use of the Mark, is under the supervision of the Owner through its board of directors, and that the Manager regularly reports to representatives of the Owner. Further, both affiants have attached copies of the property management agreement to their affidavits, and this agreement specifies that the Manager's performance of its duties is subject to the direction of the Owner's board of directors. Such evidence is sufficient to demonstrate the requisite control for the purposes of this proceeding.

19 In its written submissions, the Owner acknowledges that the Mark was not in use during the relevant period in association with the original construction of a **condominium** building, but submits that the Property is under constant repair and renovation, which includes construction. In this respect, the Owner points to section IV of the **condominium** management agreement attached as Exhibit C of the Watts affidavit and as Exhibit B of the Hendler affidavit, which refers to "Maintenance and repair" and "Preventative maintenance".

20 I agree that the term "construction" can encompass repair and renovation, bearing in mind that when interpreting a statement of goods and services in a section 45 proceeding, one is not to be "astutely meticulous when dealing with [the] language used" [see *Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654 at para 17]. Here, the evidence is clear that the Manager is required by the property management agreement to arrange for the maintenance and repair of the Property. Further, the newsletter attached as Exhibit J to the Watts affidavit and as Exhibit H to the Hendler affidavit indicates that repairs and renovations to the common elements of the Property occurred in late 2014 and in May and June 2017. As the unit owners were informed of these services by way of newsletters published by the Manager, which prominently display the Mark, I consider the Mark to have been displayed in advertising services that the Owner, through its licensee, was ready to perform. Accordingly, I am satisfied that the Owner has shown use of the Mark in association with the services "construction... of a **condominium** building" in Canada during the relevant period.

21 Similarly, I am satisfied that the evidence, taken as a whole, establishes use of the Mark in association with the services "operation of a **condominium** building". For instance, the letters to the Toronto City Council, Toronto Police Services, and the unit owners all prominently display the Mark. These letters describe various matters relating to the operation of the Property, including budgetary issues and in-suite testing of fire detectors. All of these matters fall within the scope of "operation of a **condominium** building" and occurred within the relevant period. I am therefore satisfied that the Owner has shown use of the Mark in the performance of this service.

22 Finally, I am satisfied that the Owner has shown use of the Mark in association with the services "sales of **condominium** units". Although the Owner has provided no evidence of any instances where a **condominium** unit was actually sold, the screenshots from *www.thespire.ca* provided as Exhibit K of the Watts affidavit show that the Owner advertised its **condominium** building to potential unit owners in association with the Mark. Although the screenshots themselves are not dated, Exhibit L to the Watts affidavit establishes that the site was created on October 12, 2007, and was updated on February 18, 2016. While it is not explicitly stated that this update led to the

website appearing as it does in the exhibit, I am prepared to infer that the Owner also used its website to advertise sales of **condominium** units in association with the Mark during the relevant period, and that it was offering and prepared to perform the services "sales of **condominium** units".

23 As such, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered services within the meaning of sections 4 and 45 of the Act.

DISPOSITION

24 Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

G.M. Melchin
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office