

Federal Court



Cour fédérale

Date: 20240119

Docket: T-1334-22

Citation: 2024 FC 93

Ottawa, Ontario, January 19, 2024

PRESENT: The Honourable Mr. Justice Fothergill

BETWEEN:

FINASTRA INTERNATIONAL LIMITED

Applicant

and

FENESTRAE B.V.

Respondent

JUDGMENT AND REASONS

I. Overview

[1] The Appellant Finastra International Limited appeals a decision of a Hearing Officer [Officer] of the Trademarks Opposition Board made under s 45 of the *Trademarks Act*, RSC, 1985, c T-13 [Act]. The Officer maintained certain goods and services on the register in connection with the trademark FENESTRAE, registration No TMA994069.

[2] The Respondent Fenestrae BV is the owner of the FENESTRAE mark. Based on the affidavit of Willem Hogewoning, Chief Financial Officer of Fenestrae BV, the Officer made the following findings regarding the nature of the Respondent's business (at paras 9-11):

[...] the [Respondent] is a software development company based in the Netherlands which "has since its inception in 1990 been in the business of developing, selling, and supporting enterprise messaging and communications software". According to Mr. Hogewoning, "all software development is performed at [the Owner's] offices in The Hague". Similarly, "sales and partner management" are also handled from The Hague.

Fenestrae, Inc. (the Subsidiary), a wholly-owned subsidiary of the Owner, is based in Norcross Peachtree Corners, Georgia, and "provides global technical supports for all Fenestrae products and oversees sales and partner management for the Americas and the Pacific Rim regions". Mr. Hogewoning states that, during the relevant period, the Subsidiary used the Mark and the trade name FENESTRAE under licence from the Owner, wherein the character and quality of the goods sold and the services performed in association with the Mark and trade name were under the control of the Owner.

Mr. Hogewoning states that the Owner's "software solutions" help customers improve their "business agility and reduce operating costs by eliminating paper from key business processes".

[3] The Respondent uses the FENESTRAE mark in connection with several products, primarily: (1) *Faxination*, a "secure digital business and document exchange platform" offering "intelligent data capture and digitization of paper documents, fax and email attachments"; and (2) *Udocx*, a "cloud-based solution" that "facilitates the conversion of business documents into smart digital files".

[4] The FENESTRAE mark was registered in connection with various goods and services, grouped by the Officer as: (1) goods and services pertaining to the product *Faxination*; (2)

services pertaining to the product *Udocx*; and (3) other goods and services. The Officer upheld the registration of only some of the goods and services in connection with *Faxination* and *Udocx*. The Appellant maintains that the Officer should have deleted all of the goods and services from the register.

[5] For the reasons that follow, the appeal is allowed in part.

II. Decision under Review

[6] The evidence of use of the FENESTRAE mark in Canada was contained in four Exhibits to the affidavit of Mr. Hogewoning:

- Exhibit A: user manuals, brochures, client testimonials and case studies, screenshots of software installation, and images of product boxes;
- Exhibit B: a screenshot of *Udocx* software offered for sale by PC Canada, shown as “backordered”;
- Exhibit C: a further brochure; and
- Exhibit D: invoices, order forms, and purchase orders for *Faxination* software, showing corporate and government clients in Canada.

[7] Mr. Hogewoning conceded that the mark was not used in Canada for several registered goods, generally pertaining to hardware and peripherals. These goods were deleted accordingly.

A. *Goods*

[8] The Officer found that the invoices, order forms, and purchase orders submitted by the Respondent could not be correlated to all of the registered goods. The evidence of goods all pertained to the *Faxination* digital exchange platform. The Officer accepted that the words “Replacing physical fax device” on an invoice meant replacing existing fax hardware with the *Faxination* software; however, she was not satisfied that a subscription to the software entailed provision of each of the listed goods.

[9] The description of *Faxination* provided in Mr. Hogewoning’s affidavit was in broad strokes, and amounted to a restatement of the list of Goods and Services. The Respondent’s evidence suggested that *Faxination* is modular, with components that could be “mixed and matched”. The description of *Faxination* was sufficient to establish it to be “at a minimum, computer facsimile software”.

[10] The Officer divided the goods into two classes: (1) Computer Facsimile Software; and (2) Remaining Computer Software Goods.

[11] The Computer Facsimile Software consisted of:

computer facsimile software for transmission, receipt, storage, conversion, editing and analysis of text, audio, graphics, still

images and moving pictures across local area networks, wide area networks, IP networks, wireless networks and global networks;

[12] There was no evidence to demonstrate the exchange of “audio” or “moving pictures” via the *Faxination* platform. The Officer therefore deleted these entries from the registered list, while upholding the rest.

[13] The Appellant argued there was no evidence that the images of installation windows reproduced in Mr. Hogewoning’s affidavit were viewed in Canada. One of the documents clearly indicated the “Account” to be located in the Netherlands, despite the affidavit describing the screens as displaying FENESTRAE in Canada.

[14] The Officer nevertheless found that the presence of the FENESTRAE mark on the images of the software installation windows provided sufficient notice of association between the mark and the *Faxination* subscription.

[15] The Remaining Computer Software Goods consisted of:

Computer programs namely, backup hard drives for computers for use in Internet protocol and for use in Application Programming Interfaces (API) for connecting computer software to computer hardware, computer peripheral devices, namely, mouse, keyboard, computer printer, computer monitor, computer scanners, photocopiers, optical character readers and mobile communication apparatus, namely, personal digital assistant, cellular phone, mobile phone for sending, recording, transmitting, receiving or reproducing sound or images; ... computer software for authorization and identification of credit cards and for payment processing;

[16] The Officer agreed with the Appellant that the “underlying goods” in this description were “backup hard drives”. There was no evidence of sale at any time during the relevant period of hard drives, and these goods were deleted accordingly.

[17] Mr. Hogewoning described the registered term “backup hard drives for computers” as “computer hardware and software for use in facsimile transmissions and for computers”. The Officer found that association of the FENESTRAE mark with “Backup hard drives for computer” was unsupported by the affidavit.

[18] There was no evidence relating to “computer software for authorization and identification of credit cards and for payment processing”, nor were these goods included in Mr. Hogewoning’s description of *Faxination*. References to “computer hardware and software” and “sales of FENESTRAE Computer Software Goods” were found to be overly general, and were deleted.

B. *Services*

[19] The Officer grouped the registered services as “Software Solutions” and “Remaining Services”. The software solutions were further divided into those relating to *Faxination* and those relating to *Udocx*.

[20] The Officer was satisfied that the descriptions of *Faxination* in the materials correlated to the following registered services:

Telecommunication access services, namely wireless facsimile mail services; providing telecommunication connections, namely, wireless facsimile mail services to a global computer network for transmitting, receiving, retrieving, configuring, translating, converting and organizing facsimile messages via wireless and computer networks; electronic mail and facsimile messaging services; providing access to local area networks (LAN), wide area networks (WAN), IP networks, wireless networks and global networks; electronic facsimile transmissions for the receipt and delivery of facsimile messages, written documents, still images, ... photographs ...;

[21] The goods “audio” and “moving pictures” were not included in any description of *Faxination*, and were accordingly deleted from the registered services.

[22] The Officer found that a subscription to *Faxination* encompassed performance by the Respondent of the *Faxination* services. Moreover, Exhibit A to Mr. Hogewoning’s affidavit included promotional brochures featuring client testimonials in which the FENESTRAE mark was prominently displayed.

[23] Mr. Hogewoning described *Udocx* as a cloud-based solution allowing users to convert documents into “smart digital files”. According to the promotional materials, *Udocx* “transport[s], converts and delivers the document to your application”, after which the document is “removed”. The Officer concluded that *Udocx* was correlated with the following registered services:

providing user access to temporary use of non-downloadable computer facsimile software that provides on-demand network access to a pool of configurable computing resources, namely, networks, servers, storage and applications; cloud computing provider services for general storage of data and for database management.

[24] Despite the absence of subscriptions for *Udocx*, the Officer accepted that the *Udocx* services were advertised and available to persons in Canada during the relevant period.

[25] Exhibit A to Mr. Hogewoning's affidavit included brochures for "Fenestrae Udocx", which was depicted as a cloud labelled with the term UDOCX®. The FENESTRAE mark was displayed in these brochures as distinct from the term UDOCX. Each was marked with its own ® symbol and the software platform was often referred to as "Udocx". The Officer was therefore satisfied that consumers would view UDOCX and FENESTRAE as distinct marks.

[26] The Officer was not prepared to infer from the evidence that *Udocx* licences were "backordered" on the PC Canada website that the services were available during the relevant period. However, Mr. Hogewoning stated that *Udocx* was not sold exclusively through PC Canada, but also through the Respondent's direct sales to Canada. Moreover, the example of the PC Canada website was not intended to show use *per se*, but rather the manner in which the goods and services were displayed in association with the FENESTRAE mark.

[27] The Officer found that the Remaining Solutions were not addressed in Mr. Hogewoning's affidavit. They were deleted accordingly.

C. *Deletions*

[28] The Officer deleted the following goods and services (indicated by strikethrough) pursuant to s 45 of the Act:

Goods

Computer programs namely, backup hard drives for computers for use in Internet protocol and for use in Application Programming Interfaces (API) for connecting computer software to computer hardware, computer peripheral devices, namely, mouse, keyboard, computer printer, computer monitor, computer scanners, photocopiers, optical character readers and mobile communication apparatus, namely, personal digital assistant, cellular phone, mobile phone for sending, recording, transmitting, receiving or reproducing sound or images; computer facsimile software for transmission, receipt, storage, conversion, editing and analysis of text, audio, graphics, still images and moving pictures across local area networks, wide area networks, IP networks, wireless networks and global networks; computer software for authorization and identification of credit cards and for payment processing; network servers for webhosting; facsimile machines, scanners; photocopiers; computer hardware; computer peripheral devices namely, mouse, keyboard, computer printer, computer monitor; data processing equipment, namely, computers; magnetic and optical equipment and apparatus, namely, blank digital storage media, namely, DVDs, USB flash drives; modems; computer monitors; computer storage devices, namely, blank flash drives; telephones; apparatus and equipment for transmission, receipt, and storage of sound, images and other information, in digital format or otherwise, namely, Personal Digital Assistants (PDA), tablet computers and mobile computers.

Services

Telecommunication access services, namely wireless facsimile mail services; providing telecommunication connections, namely, wireless facsimile mail services to a global computer network for transmitting, receiving, retrieving, configuring, translating, converting and organizing facsimile messages via wireless and computer networks; electronic mail and facsimile messaging services; providing access to local area networks (LAN), wide area networks (WAN), IP networks, wireless networks and global networks; electronic facsimile transmissions for the receipt and delivery of facsimile messages, written documents, still images, audio, photographs, and moving pictures; design and development of computer hardware and software; computer programming of electronic data processing applications for use in association with facsimile machines, for others; rental of computer hardware and software; consultancy and providing technical information in the field of computers, computer networks, software and software for digital document management; web site hosting; providing user

access to temporary use of non-downloadable computer facsimile software that provides on-demand network access to a pool of configurable computing resources, namely, networks, servers, storage and applications; cloud computing provider services for general storage of data and for database management.

III. Issue

[29] The sole issue raised by this appeal is whether the Officer's decision to maintain the undeleted goods and services betrays a palpable and overriding error.

IV. Analysis

A. *Standard of Review*

[30] Where a legislature has provided for a statutory right of appeal from an administrative decision, the appellate standard of review applies (*Canada (Minister of Citizenship and Immigration) v Vavilov*, 2019 SCC 65 at para 37). An application under s 56(1) of the Act is therefore treated as an appeal, not an application for judicial review (*Miller Thomson LLP v Hilton Worldwide Holding LLP*, 2020 FCA 134 [*Miller Thomson*] at para 44).

[31] Questions of fact and questions of mixed fact and law are subject to review against the standard of palpable and overriding error. For questions of law, the applicable standard is correctness (*Miller Thomson* at para 42).

[32] Where the issue on appeal involves interpretation of the evidence as a whole, a decision maker's decision should not be overturned absent palpable and overriding error (*Housen v Nikolaisen*, 2002 SCC 33 at paras 10, 26, and 36). “Palpable” means an error that is obvious. “Overriding” means an error that affects the outcome of the case.

B. *Statutory Provisions*

[33] The following provisions of the Act are relevant to this appeal:

4 (1) 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.

(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.

...

45 (3) Where, by reason of the evidence furnished to the Registrar or the failure to furnish any evidence, it appears to the Registrar that a trademark, either with respect to all of the goods or services specified in the registration or with respect to any

4 (1) Une marque de commerce est réputée employée en liaison avec des produits si, lors du transfert de la propriété ou de la possession de ces produits, dans la pratique normale du commerce, elle est apposée sur les produits mêmes ou sur les emballages dans lesquels ces produits sont distribués, ou si elle est, de toute autre manière, liée aux produits à tel point qu'avis de liaison est alors donné à la personne à qui la propriété ou possession est transférée.

(2) Une marque de commerce est réputée employée en liaison avec des services si elle est employée ou montrée dans l'exécution ou l'annonce de ces services.

...

45 (3) Lorsqu'il apparaît au registraire, en raison de la preuve qui lui est fournie ou du défaut de fournir une telle preuve, que la marque de commerce, soit à l'égard de la totalité des produits ou services spécifiés dans

of those goods or services, was not used in Canada at any time during the three year period immediately preceding the date of the notice and that the absence of use has not been due to special circumstances that excuse the absence of use, the registration of the trademark is liable to be expunged or amended accordingly.

l'enregistrement, soit à l'égard de l'un de ces produits ou de l'un de ces services, n'a été employée au Canada à aucun moment au cours des trois ans précédant la date de l'avis et que le défaut d'emploi n'a pas été attribuable à des circonstances spéciales qui le justifient, l'enregistrement de cette marque de commerce est susceptible de radiation ou de modification en conséquence.

C. *Guiding Principles*

[34] In *Sim & McBurney v en Vogue Sculptured Nail Systems Inc*, 2021 FC 172 [*en Vogue*], Justice Janet Fuhrer provided the following helpful summary of the guiding principles to be applied in appeals of decisions made under s 45 of the *Trademarks Act* (at paras 12-16, citations omitted):

- (a) Section 45 proceedings are summary. They are intended to clear the register of trademarks that are no longer in use (“dead wood”) while at the same time providing safeguards against unwarranted expungement attempts;
- (b) Contentious commercial interests should be resolved in expungement proceedings under s 57 of the Act;
- (c) To maintain the challenged registration, the trademark owner must make assertions of fact showing “use” within the meaning of ss 2 and 4 of the Act, as opposed to mere or bald assertions of use;

- (d) 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;
- (e) 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;
- (f) 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;
- (g) 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 Act; and
- (h) The role of an appellate court is not to consider whether other inferences reasonably may have been drawn from the evidence, but rather whether the decision maker made any palpable and overriding errors in drawing the inferences that were drawn from the evidence. Although it is open to an appellate court to find that an inference of fact made by the decision maker is clearly wrong, an appellate court will be hard pressed to find a palpable and overriding error where evidence exists to support the inference.

[35] Accordingly, the question before the Court is whether the Officer made any palpable and overriding errors drawing the inferences that the Officer drew, having regard to the evidence as a whole including the statements contained in Mr. Hogewoning's affidavit and the documentary exhibits attached to that affidavit (*en Vogue* at para 17).

D. *Adverse Inference*

[36] The Appellant asks the Court to draw an adverse inference from the Respondent's failure to adduce new evidence on appeal. According to the Appellant, the Respondent was aware of deficiencies in its evidence yet chose not to offer additional evidence demonstrating that sales were in the normal course of trade. An adverse inference is therefore justified (citing *International Name Plate Supplies Limited v Marks & Clerk Canada*, 2021 FC 611 at para 32).

[37] An adverse inference may be available when a trademark owner appeals a ruling by the Trademarks Opposition Board and neglects to adduce new evidence despite the hearing officer's finding that the existing evidence was insufficient. That is not the case here. The Respondent does not contest any factual deficiencies found by the Officer.

[38] The Officer found the remaining evidence offered by the Respondent to be sufficient. The Appellant in this appeal is the party seeking expungement of the trademark, and bears the onus of demonstrating palpable and overriding error in the Officer's decision. There is therefore no basis upon which to draw an adverse inference against the Respondent.

E. *Goods*

[39] The Appellant argues that the Officer: (1) improperly assumed the normal course of trade; (2) made inferences that were not supported by the evidence; and (3) wrongly accepted the Respondent's bald assertions of use.

(1) Normal Course of Trade

[40] The Appellant says the Officer simply accepted Mr. Hogewoning's assertions that sales of the goods were made in the normal course of trade. Mr. Hogewoning provided no detailed information regarding the volume of sales, the dollar value of sales, or equivalent particulars. He did not explain the normal course of trade for the industry in which the Respondent operates.

[41] According to the Appellant, the invoices, order forms, and purchase orders in Exhibit D to Mr. Hogewoning's affidavit did not demonstrate sales in the normal course of trade. Invoices associated with Canadian addresses did not indicate any shipping costs, and there was no evidence the goods ever arrived in this country.

[42] A sale of goods will qualify as a transfer in the normal course of trade if it is a genuine commercial transaction to a third party acting at arm's length (*JC Penney Co Inc v Gaberdine Clothing Co Inc*, 2001 FCT 1333 [*JC Penney*] at paras 88, 92). The burden to demonstrate that a sale was made in the normal course of trade is low, and may be inferred by the Officer (*Sim & McBurney v Gordon*, 2020 FC 710 at para 29).

[43] The expression “normal course of trade” was described by Justice Marc Nadon in *JC Penney* at paragraph 92:

Consequently, use of a trade-mark cannot be measured by the number of sales or the quantity of wares sold in association with the trade-mark. That is why, in my view, a single sale may suffice to prove use of a trade-mark. The sale or sales must be examined in the light of all of the surrounding circumstances. The Act does not impose any requirements concerning the length or extent of use of the trade-marks. Subsection 4(1) of the Act simply requires that the trade-mark be used in association with wares in the normal course of trade. That is the reason why, in my view, sales that have been found to be “token” sales, sales to related companies, free delivery of samples, and pro-forma transfers, do not meet the requirements of “in the normal course of trade”. The Act does not require an Appellant to show extensive use of substantial use of its trade-mark. The issue is whether the sales on which the Appellant relies are sufficient to show use by the Appellant of its trade-mark.

[Emphasis added]

[44] There was nothing in the evidence to suggest that the transactions described in Mr. Hogewoning’s affidavit were not in the normal course of trade. The Officer was entitled to rely on the documentation in combination with the explanations provided.

[45] Nor was there anything to suggest that the sales documented in Exhibit D to Mr. Hogewoning’s affidavit were not genuine commercial transactions, or fell within the excluded categories of sales described in *JC Penney*. The Respondent was only required to demonstrate that the sales followed the pattern of genuine commercial transactions.

[46] The Respondent was required to establish a *prima facie* case, nothing more. As the Federal Court of Appeal held in *Spirits International BV v BCF SENCRL.*, 2012 FCA 131, “[i]t

is always open to the Registrar, as a finder of fact, to draw reasonable inferences from the facts stated in the affidavit” (at para 8). It was open to the Officer to infer delivery from invoices with major corporate and government clients based upon the shipping addresses provided.

(2) Inferences from the Evidence

[47] The Appellant says the Officer improperly made several inferences with respect to the use of the FENESTRAE mark in relation to the goods, despite the “ambiguities” she found in the evidence. The Appellant maintains that ambiguities in the evidence must be interpreted against the owner of the mark (citing *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at para 14).

[48] The Officer’s inferences were based upon a holistic assessment of the evidence. A Nestlé invoice in Exhibit D to Mr. Hogewoning’s affidavit contained the product description “FX2016-FOIP-8 Replacing physical fax device”. Exhibit A comprised screenshots of the “Faxination Server 2016 R2” installation window. Exhibit C described the product as utilizing Fax-over-IP [FoIP]. It was open to the Officer to infer that Exhibit D pertained to Exhibits A and C, and correlated with the “computer facsimile software” goods.

[49] The Appellant maintains there was no evidence that the image of the installation screen connected with the Nestlé invoice was viewed in Canada. The Officer accepted Mr. Hogewoning’s sworn statement that it was. There was nothing to suggest that the installation screen would have had a different appearance in the Netherlands than in Canada.

(3) Respondent's Claims of Use

[50] The Appellant argues that the Officer erred in accepting the Respondent's claims of use. Affidavits "must describe the use of the mark within the meaning of section 4 of the Act and should not simply state the use of the mark" (citing *Grapha-Holding AG v Illinois Tool Works Inc*, 2008 FC 959 at para 20).

[51] The Officer was satisfied that the Respondent had demonstrated use of the *Faxination* goods based upon the assertions contained in Mr. Hogewoning's affidavit and the evidence contained in the Exhibits. The Officer read the descriptions carefully, and identified instances where the claimed goods did not correspond with those registered. Many of the goods were deleted due to the absence of evidence of their use. The Appellant has not demonstrated palpable and overriding error.

F. *Services*

[52] The Appellant submits that the Officer improperly accepted the ambiguous evidence offered by the Respondent. According to the Appellant, the Officer relied on an overly broad description of the *Faxination* and *Udocx* platforms to interpret ambiguities in the Respondent's favour.

[53] The Appellant asserts that the invoices and description in Mr. Hogewoning's affidavit did not show that the registered services were actually performed in Canada during the relevant

period. According to the Appellant, placing an order for services does not constitute use under s 4(2); services must actually be performed (citing *Bilsom International Ltd v Cabot Corp* (TMOB), 36 CPR (3d) 92).

[54] The term “services” is not defined in the Act. The meaning of the term has, however, been considered in jurisprudence. The term should be liberally construed, and each case should be decided on its own facts. The question of whether services have been “performed” is determined by whether “persons in Canada [have] derived a tangible benefit” therefrom during the relevant period (*Miller Thomson* at para 117).

[55] The Officer found that the *Faxination* services were performed, and the *Udocx* services were at least advertised and available to persons in Canada (at para 61):

Although the invoiced subscription to the *Faxination* platform (*i.e.* the Nestlé Invoice) supports the conclusion that the *Faxination* Services were performed, there is no such evidence of subscriptions to or sales of the *Udocx* platform. Nevertheless, considering the exhibited promotional materials displaying the Mark together with Mr. Hogewoning’s clear statement that the Mark was displayed in the advertising and promotion of FENESTRAE Services during the relevant period in Canada, I am prepared to accept that the *Faxination* Services and the *Udocx* Services were at least advertised and available to persons in Canada during the relevant period.

[56] As with the goods, it was open to the Officer to infer the performance of the *Faxination* services from the evidence. Mr. Hogewoning’s affidavit specified that contracts with “institutional or government agencies” who were “longstanding users” were usually on an “annual subscription basis” (at para 17). Invoices issued to these kinds of customers were

included in Exhibit D. The Officer's careful reading of the *Faxination* services is illustrated by her decision to delete any services that were not correlated with the evidence.

[57] The evidence of the performance of the *Udocx* services is less persuasive. The Appellant points to the "backordered" status of *Udocx* licences on the exhibited screenshots from PC Canada's website, suggesting that the services were not in fact available during the relevant period. Mr. Hogewoning characterized the exhibit as "representative" of the manner in which the software was offered for sale during the relevant period.

[58] The Officer disagreed with the Appellant's assertion that this was a "tacit admission" that *Udocx* was backordered and therefore not available for purchase. She noted Mr. Hogewoning's statement that, during the relevant period, *Udocx* software was sold not only through PC Canada, but also through direct sales by the owner itself. She found it reasonable to interpret Mr. Hogewoning's statement regarding the "manner" in which the owner's products were offered and promoted as referring to "the general appearance of the PC Canada website, rather than to the backordered notice on this particular screenshot, which may have been captured after the relevant period, when Mr. Hogewoning prepared his affidavit" (at para 63).

[59] There was no evidence of use of the *Udocx* services in Canada during the relevant period beyond Mr. Hogewoning's assertion. The Federal Court of Appeal has held that an assertion of use without supporting evidence is not enough (*Plough (Canada) Ltd v Aerosol Fillers Inc*, [1981] 1 FC 679 at para 10):

What subsection 44(1) requires is an affidavit or statutory declaration not merely stating but "showing", that is to say,

describing the use being made of the trade mark within the meaning of the definition of “trade mark” in section 2 and of “use” in section 4 of the Act. The subsection makes this plain by requiring the declaration to show with respect to each of the wares and services specified in the registration whether the trade mark is in use in Canada and if not the date when it was last used and the reason for the absence of such use since that date. The purpose is not merely to tell the Registrar that the registered owner does not want to give up the registration but to inform the Registrar in detail of the situation prevailing with respect to the use of the trade mark so that he, and the Court on appeal, can form an opinion and apply the substantive rule set out in subsection 44(3). [...].

[60] In proceedings under s 45 of the Act, the burden of proof is very light and the evidence need not be perfect. Nonetheless, the evidence must show use within the relevant three-year period, and cannot be limited to bald assertions of use (*Honeybee Enterprises Ltd (Honeybee Centre) v Marks & Clerk*, 2023 FC 1262 at para 12).

[61] Pursuant to *Miller Thomson*, it was necessary for the Respondent to demonstrate that “persons in Canada derived a tangible benefit” from the *Udocx* services. That demonstration needed to comprise “assertions of facts showing use”, not mere “assertions of use”. The Officer accepted Mr. Hogewoning’s bald assertion of use, despite the absence of supporting evidence, and found only that the *Udocx* services were “advertised and available to persons in Canada during the relevant period”.

[62] This was plainly insufficient to demonstrate use of the *Udocx* services during the relevant period. In finding otherwise, the Officer committed a palpable and overriding error.

V. Conclusion

[63] The appeal is allowed in part. The following additional services (indicated in bold strikethrough) shall be deleted from the list of registered services for the mark FENESTRAE:

Services

Telecommunication access services, namely wireless facsimile mail services; providing telecommunication connections, namely, wireless facsimile mail services to a global computer network for transmitting, receiving, retrieving, configuring, translating, converting and organizing facsimile messages via wireless and computer networks; electronic mail and facsimile messaging services; providing access to local area networks (LAN), wide area networks (WAN), IP networks, wireless networks and global networks; electronic facsimile transmissions for the receipt and delivery of facsimile messages, written documents, still images, ~~audio, photographs, and moving pictures; design and development of computer hardware and software; computer programming of electronic data processing applications for use in association with facsimile machines, for others; rental of computer hardware and software; consultancy and providing technical information in the field of computers, computer networks, software and software for digital document management; web site hosting; **providing user access to temporary use of non-downloadable computer facsimile software that provides on-demand network access to a pool of configurable computing resources, namely, networks, servers, storage and applications; cloud computing provider services for general storage of data and for database management.**~~

[64] As success in the appeal is divided, there will be no order as to costs.

JUDGMENT

THIS COURT'S JUDGMENT is that:

1. The appeal is allowed in part. The following additional services (indicated in bold strikethrough) are deleted from the list of registered services for the trademark FENESTRAE, registration No TMA994069:

Services

Telecommunication access services, namely wireless facsimile mail services; providing telecommunication connections, namely, wireless facsimile mail services to a global computer network for transmitting, receiving, retrieving, configuring, translating, converting and organizing facsimile messages via wireless and computer networks; electronic mail and facsimile messaging services; providing access to local area networks (LAN), wide area networks (WAN), IP networks, wireless networks and global networks; electronic facsimile transmissions for the receipt and delivery of facsimile messages, written documents, still images, ~~audio~~, photographs, ~~and moving pictures~~; ~~design and development of computer hardware and software; computer programming of electronic data processing applications for use in association with facsimile machines, for others; rental of computer hardware and software; consultancy and providing technical information in the field of computers, computer networks, software and software for digital document management; web site hosting;~~ **~~providing user access to temporary use of non-downloadable computer facsimile software that provides on-demand network access to a pool of configurable computing resources, namely, networks, servers, storage and applications; cloud computing provider services for general storage of data and for database management.~~**

2. No costs are awarded.

“Simon Fothergill”

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-1334-22

STYLE OF CAUSE: FINASTRA INTERNATIONAL LIMITED v
FENESTRAE B.V.

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