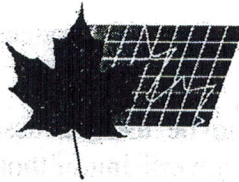


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LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

**Citation: 2014 TMOB 277**

**Date of Decision: 2014-12-15**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Shift Law against registration  
No. TMA592,397 for the trade-mark BROADVIEW in  
the name of Jefferies Group, Inc.**

[1] At the request of Shift Law (the Requesting Party), the Registrar of Trade-marks forwarded a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on October 31, 2012 to Jefferies Group, Inc., the registered owner of registration No. TMA592,397 for the trade-mark BROADVIEW (the Mark).

[2] Further to a change of name recorded by the Registrar on June 6, 2013, the subject registration currently stands in the name of Jefferies Group LLC (the Owner).

[3] The Mark is registered for use in association with the following services:

Rendering financial, merger and acquisition services to others relating to the information technology, communications and media industries, and forming operating and managing investment companies in such industries.

[4] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark 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 between October 31, 2009 and October 31, 2012.

[5] The definition of “use” in association with services is set out in section 4(2) of the Act:

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

[6] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in section 45 proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD) at 480], and evidentiary overkill is not required, sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the services specified in the registration during the relevant period.

[7] In response to the section 45 notice, the Owner furnished the affidavit of Michael J. Sharp, General Counsel of the Owner, sworn on May 30, 2013. Both parties filed written representations; an oral hearing was not requested.

[8] In his affidavit, Mr. Sharp describes the Owner as a global investment banking firm that provides a range of investment banking, sales, trading, research and strategy services across the spectrum of equities, fixed income, foreign exchange, futures and commodities.

[9] He attests that, through the Owner’s technology investment banking group, Broadview, the Owner used the Mark in association with the services as registered in Canada during the relevant period. In this respect, he states that the registered services were advertised and promoted on the Owner’s websites, *jefferies.com* and *broadview.com*. Although he furnished no screenshots from either website, he asserts that the Mark was displayed continuously on these websites during the relevant period.

[10] In support of his assertion of use, Mr. Sharp attaches two exhibits to his affidavit. Exhibit A consists of copies of four “information sheets” that Mr. Sharp attests are available on the aforementioned websites. Although Mr. Sharp is not clear as to the production date of each sheet and whether the information sheets were available during the relevant period, he does state that the information sheets “are representative of the manner in which the Trade-mark is and has been used in Canada by Jefferies during the Relevant Period.”



[11] The first two information sheets, entitled “Jefferies’ Broadview Technology Group” and “Jefferies. The Global Investment Banking Firm”, reference dates after the relevant period. The third sheet, “Jefferies Broadview Technology Group” references dates that are all prior to the relevant period. The only date appearing on the fourth sheet, “About Jefferies”, is “10/2009”, nominally the start of the relevant period.

[12] Exhibit B consists of two articles from third party online magazines that Mr. Sharp attests were “accessible in Canada during the Relevant Period”. He explains that the articles “describe or refer to Jefferies’ BROADVIEW Services.” However, I note that while the first article appears to have been posted on November 2010, the second article is dated December 19, 2003. Furthermore, neither article references services offered or performed in Canada.

### Analysis

[13] Generally, advertising in Canada alone is insufficient to demonstrate use with respect to services; at the very least, the services have to be available to be performed in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[14] In this case, the Owner furnished no evidence of actual performance of the services in Canada. Indeed, although Mr. Sharp states that the services “were provided in Canada during the Relevant Period by Jefferies’ technology investment banking group, Broadview”, he provides no particulars in this respect. There are no details regarding the manner of performance of the services in Canada, such as how the Owner’s Broadview Group interacted with Canadian customers. Even if a Canadian accessed the Owner’s website, there is no indication of how they could avail themselves of the Owner’s services.

[15] As noted by the Requesting Party, there is a conspicuous absence of any reference to Canada throughout the evidence: not in the descriptions of where the “Broadview” business operates, not in the exhibited “information sheets”, and not even in the third party media articles.

[16] As such, I consider Mr. Sharp’s statement a mere assertion and find that his affidavit lacks any salient details that would permit me to infer that the Owner’s services were even available to be performed in Canada.

[17] Even if I were to infer that the Owner's services were, at a minimum, *available* to Canadian customers during the relevant period, I find that the evidence is insufficient to demonstrate that the registered services were advertised in Canada during the relevant period in association with the Mark as registered.

[18] In this respect, as the Exhibit B articles were published by third-parties, the Owner cannot rely on them as evidence of use of the Mark for purposes of this proceeding. At best, such articles by third parties are merely corroborative of other evidence furnished. As Mr. Sharp's statements amount to mere assertions of use of the Mark in Canada, the evidence turns on whether the exhibited website information sheets show advertisement of the registered services in association with the Mark.

[19] However, there are several issues with the Exhibit A information sheets.

[20] First, there is no evidence that the Owner's websites – and the information sheets in particular – were ever accessed by Canadians during the relevant period.

[21] Second, even if there was access to the websites by Canadians, as noted above, there is nothing in those sheets to indicate that the services were targeted to or available to customers in Canada.

[22] Third, I am not satisfied that the information sheets display the Mark as registered. As noted above, only the fourth information sheet displays a date nominally within the relevant period. In reviewing that sheet, the only appearance of "Broadview" is in the footer as part of the name and address of the Owner, "Jefferies Broadview". Further, the Jefferies logo appears prominently in the right-hand corner of the sheet and the text of the sheet consistently describes the Owner's services in association with various "Jefferies" entities, with no mention of the Mark.

[23] Even if I were to consider the information sheet as advertising of the registered services, in my view, the display of "Jefferies Broadview" does not constitute display of the Mark as registered. In applying the principles set out by the Federal Court of Appeal [per *Canada (Registrar of Trade Marks) v Cie International pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR



(3d) 59 (FCA)], I find that the addition of the word JEFFERIES is not a minor variation. In this case, as the first portion of the trade-mark displayed, JEFFERIES is the dominant feature of the trade-mark in contrast to the Mark as registered, being the word BROADVIEW on its own.

[24] As this display of the word “Broadview” does not constitute display of the Mark as registered, I can make no inference favourable to the Owner from Mr. Sharp’s assertion that the information sheets are “representative” of the manner in which the Mark was used by the Owner in Canada during the relevant period. Although Mr. Sharp alludes to customers in Canada, it is not clear that the performance of services to those clients would have been in association with the Mark as registered. Indeed, as indicated above, it is not clear that the Owner has ever had any Canadian customers.

[25] In view of the foregoing, I am not 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. Furthermore, the Owner has not furnished any evidence of special circumstances that would excuse such non-use.

#### Disposition

[26] Accordingly, and pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be expunged in compliance with the provisions of section 45 of the Act.



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Andrew Bene  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office