

**IN THE MATTER OF AN OPPOSITION by
Schwartz Levitsky Feldman, A Partnership
and SLF Realty Corp./Société Immobilière
SLF S.A.R.F. against application No. 1120056
for the trade-mark SLF in the name of Sun
Life Assurance Company of Canada**

[1] On November 2, 2001, Sun Life Assurance Company of Canada (the Applicant), filed an application to register the trade-mark SLF (the Mark). The application was based upon proposed use of the Mark in Canada in association with the following services, as advertised:

Financial services, namely, insurance services, providing, managing and administering benefit plans and group and individual investment plans and investment funds, including pension plans, retirement savings plans, segregated funds, pooled funds, registered and non-registered savings and retirement payout products; real estate services, namely real estate leasing, real estate development, real estate investment, property management, real estate appraisal, portfolio management and asset management; mutual fund services; trust company services; a securities dealer providing trading services in the nature of trading accounts and registered plans.

[2] The application was advertised for opposition purposes in the Trade-marks Journal of June 30, 2004. On August 30, 2004, Schwartz Levitsky Feldman, A Partnership (**SLF Partnership**) and SLF Realty Corp./Société Immobilière SLF S.A.R.F. (**SLF Realty**) filed a statement of opposition. I will refer to **SLF Partnership** and **SLF Realty** together as the Opponents where appropriate. The Opponents pleaded grounds of opposition under s. 38(2)(a), s. 38(2)(b), s. 38(2)(c) and s. 38(2)(d) of the *Trade-Marks Act*, R.S.C. 1985, c. T-13 (the Act). The Applicant filed and served a counter statement.

[3] In support of its opposition, the Opponents filed the affidavits of Morty Lober and William Reim. In support of its application, the Applicant filed the affidavits of Michel Leduc and Maureen Cook. As its evidence in reply, the Opponents filed the affidavit of Marie Daoud.

With the exception of Ms. Daoud, all of the affiants were cross-examined and their transcripts and replies to undertakings form part of the record.

[4] Only the Applicant filed a written argument but an oral hearing was held at which both parties were ably represented. It is regrettable that the Opponents chose not to file a written argument as it would have been particularly helpful in a case as complex as the present one. Parties should be aware that because opposition hearings are not recorded, the Board Member does not receive a transcript of submissions made orally.

Onus and Material Dates

[5] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponents to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[6] The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(a)/s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 38(2)(b)/s. 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(c)/s. 16(3) - the filing date of the application [see s. 16(3)];
- s. 38(2)(d)/non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Summary of the Evidence

Opponents' Rule 41 Evidence

Lober Affidavit and Cross-Examination

[7] Marty Lober identifies himself as a chartered accountant and partner in the accounting firm of **SLF Partnership**. Attached as Exhibit 1 to his affidavit is his company's registration for the mark SLF Design, Registration No. TMA507775 (shown below).



[8] The registration is based on use in Canada since January 1, 1997, in association with the following services: Accounting, auditing, management consulting, financial planning, estate planning, personal and corporate tax planning, corporate financial consulting, corporate reorganization and litigation support services. Mr. Lober explained on cross-examination, however, that the core business of **SLF Partnership** is the servicing of the accounting, auditing, and financial needs of small and medium sized companies and their shareholders (Lober cross-ex, p. 19).

[9] Mr. Lober states, in his affidavit, that **SLF Partnership** has used the mark SLF Design on a continuous basis since January, 1997, on its letterheads, envelopes, fax transmittal sheets, memo pads, business cards, invoices and cheques, and representative samples of such are attached as exhibits to the Lober affidavit. The SLF Design mark also appears on financial statements, folders, newsletters, brochures, seminar materials, and on various promotional items including calendars, stress balls, post-it notes, calculators, pens, drinking glasses, etc. He explains the quantities in which many of these items have been distributed to his company's clients, and third parties including financial institutions, law firms and insurance companies. For example, in 1997, 50,000 financial statements upon which the SLF Design mark appeared were used by his firm.

[10] He adds that **SLF Partnership** has also published notices and advertisements that have circulated in various Canadian newspapers between 1997 and 2005, examples of which are also attached to Mr. Lober's affidavit. The Mark has also appeared on **SLF Partnership's** website since the end of 1998.

[11] Mr. Lober admitted in his replies to undertakings that none of **SLF Partnership**'s print advertisements mention wealth management services (see Lober exhibits 37-58, and UA No. 21).

[12] **SLF Partnership** does not, and is not licensed to, consult on insurance products of any kind (Lober cross-ex, p. 47-52). Nor does **SLF Partnership** fund group pension and savings plans or provide administrative and record keeping services for group pension plans, group savings plans or group benefit plans (Lober cross-ex, Q. 182-185).

[13] While Mr. Lober identifies his firm as a "full service" firm, he explains at paragraph 9 of his affidavit that the following specialty services are furnished by affiliates of his firm as follows:

- a) insolvency, bankruptcy and trusteeship services are rendered by Schwartz Levitsky Feldman Inc.;
- b) business valuation and litigation support services are provided by Schwartz Levitsky Feldman Valuations Inc.;
- c) management consulting services are provided by Schwartz Levitsky Feldman Consultants;
- d) real estate advisory services are provided by **SLF Realty Corp.** and
- e) wealth management services are provided by Sherbrooke Financial Services (2001) Inc. (SFS) and its predecessor Sherbrooke Financial Services Inc. (defined by Mr. Lober in his affidavit as including: investment advisory services; investment reporting; retirement and compensation planning; and personal financial planning services (Lober affidavit, para. 7)).

[14] Mr. Lober states at p. 12 and 13 of his cross-examination that, although there is no written agreement in place, **SLF Partnership** has an oral licence agreement with these companies permitting their use of its SLF Design mark. He explains that all the companies share the same office space, and that there is one partner in Montreal and one partner in Toronto who approve all advertising, letterhead and business cards. Other than sharing office space, and verifying the manner in which the licensees use the mark, Mr. Lober admits on cross-

examination (at p. 13 & 14) that control is not exercised over the character or quality of the services provided by the affiliated companies in association with the mark. As for the affiliate SFS in particular, he admitted on cross-examination that SFS is not licensed to use **SLF Partnership**'s SLF Design mark (Lober cross-ex., p. 14 & 15).

[15] Mr. Lober also admitted on cross-examination that it is actually SFS that renders retirement and estate planning services to **SLF Partnership** because its personnel are trained, competent and licensed to do so (Lober cross-ex, Q. 464-474). Therefore, while **SLF Partnership** and SFS may promote themselves as working in conjunction to offer the services of a full service accounting firm, it is actually SFS that renders some of **SLF Partnership**'s registered services. This factor, along with the fact that none of **SLF Partnership**'s partners appear to be certified financial planners suggests that **SLF Partnership** may not be qualified to manage group and individual investment plans or investment funds on its own.

Reim Affidavit and Cross-Examination

[16] Mr. William Reim is President and sole employee of **SLF Realty**. He states in his affidavit that his company provides real estate advisory and general management consulting services, and has been authorized by **SLF Partnership** to use the trade-mark SLF Design in association with the services provided by his company. At the date of his cross-examination, however, the only real estate services his company was providing were property management services for two residential condo developments and one real estate development project (an office building) (Reim cross-ex, p. 16 & 17). His company was also providing consulting and advisory services in association with real estate (Reim cross-ex, p. 18, and Exhibit 1 to the Reim affidavit).

[17] At paragraphs 7, 8, 9, 10 and 11 of his affidavit, he describes **SLF Realty**'s use of its corporate name and SLF Design on a business card, letterhead, a fax transmittal sheet, a memo pad and an invoice, samples of which are attached as exhibits to his affidavit. Attached as Exhibit 7 to his affidavit is a newsletter which was allegedly sent to several hundred entities in 1999. He admits on cross-examination that his company has not produced any newsletters since 2003 (Reim cross-ex, Q. 48).

[18] Mr. Reim does not provide the sales revenues for his company, nor does he provide any information with respect to advertising expenditures.

[19] In his answers to undertakings, Mr. Reim admits that there is no written licence agreement regarding the use of SLF by **SLF Realty** (see U2, p. 13). He maintains that the partners of **SLF Partnership** are in a position to overview the manner of use of the **SLF Partnership**'s mark by **SLF Realty** because: 1) **SLF Partnership** is a 50% shareholder of **SLF Realty** and 2) **SLF Realty** operates out of the same premises as **SLF Partnership** (see U3, p. 13-14).

Applicant's Rule 42 Evidence

Leduc Affidavit and cross-examination

[20] Mr. Leduc states that he is the Vice-President, Public and Corporate Affairs of Sun Life Assurance Company of Canada, a wholly owned subsidiary of Sun Life Financial Inc. Sun Life Financial Inc. and Sun Life Assurance Company of Canada are members of the Sun Life Financial Group of Companies (Sun Life Financial). Sun Life Financial is a leading international financial services organization providing a diverse range of wealth accumulation and protection products and services to individuals and corporate customers, and has operations worldwide. As of December 31, 2005, Sun Life Financial had total assets under management of \$387 billion Canadian. The Mark is used in Canada by the Applicant or by Sun Life Financial Inc. under licence from the Applicant.

[21] Mr. Leduc states at paragraph 17 of his affidavit that the Applicant does not provide services offered by a firm of chartered accountants, such as auditing or accounting services or services relating to the preparation of income tax returns, externally. In contrast, the Applicant issues life insurance and accident and sickness insurance to both individuals and groups in Canada. The insurance is sold directly to the public through the company's distribution network of advisors, brokers and consultants. The Applicant and its affiliated companies also fund group

pension and savings plans, and provide administrative and record keeping services for group pension and savings plans and group benefit plans.

[22] In paragraph 22 of his affidavit, Mr. Leduc states that, from his personal knowledge of the industry, he is aware that accounting firms such as **SLF Partnership** would be prevented by currently existing regulations and laws from manufacturing or issuing life or accident and sickness insurance products, or from funding group pension and savings plans, and would be unlikely to have the required expertise to administer pension, savings or benefit plans, per se. In contrast, the Applicant's advisors and brokers are licensed by provincial insurance regulators and provincial securities regulators to sell insurance products, mutual funds and other investment products (Leduc affidavit, para. 18) .

[23] Mr. Leduc explains that the real estate services that the Applicant proposes to perform in association with the Mark are "for the benefit of Sun Life Assurance Company of Canada's own investment portfolio, in support of its insurance operations" (Leduc affidavit, para. 21). He further states that the expertise gained by Sun Life's internal real estate personnel in managing its own real estate assets may also be provided to third parties in the future.

[24] On cross-examination, Mr. Leduc states that the Applicant began using the Mark in April, 2003 (Leduc cross-ex., Q. 103, 106 and 240). Exhibits A and C to Mr. Leduc's affidavit are indicative of the nature of the use of "SLF" in all of his exhibits. These exhibits are copies of Sun Life Financial Inc.'s Annual Reports, which refer to "SLF" as the company's stock ticker symbol, and as an abbreviation for Sun Life Financial. Attached as Exhibits D, E, F and G to his affidavit are printouts of slide presentations made at various financial services conferences, marketing meetings and the June 2003 Annual General Meeting of Sun Life Financial Services of Canada Inc. which all reference the SLF mark. The SLF mark has also appeared on the www.SunLife.com website since June 12, 2005. The Applicant's tracking information shows that during the months of April and May 2007, 40% of individuals accessing the Applicant's website were doing so from Canada (Leduc UA-14).

[25] When asked on cross-examination whether the Mark was used in promotional material related to the relevant services, Mr. Leduc repeatedly acknowledged the following: “Sun Life Financial Inc. and its subsidiaries have not yet commenced a formal marketing campaign to use the trade-mark SLF.” He further states “SLF may appear on various written documentation describing the products and services offered by Sun Life Assurance Company of Canada and its subsidiaries in a limited manner, primarily as a short-form for “Sun Life Financial” or as a symbol for the organization, or as Sun Life Financial Inc.’s stock ticker symbol” (see, for example, Leduc UA-23).

Cook Affidavit and cross-examination

[26] In her affidavit, Ms. Cook identifies herself as a Senior Corporate Law Clerk employed by the Applicant. The search conducted by Ms. Cook was submitted to show the co-existence in Canada of numerous companies with business names containing the letter combination SLF, for a variety of wares and services. Ms. Cook’s lack of knowledge regarding the nature of the businesses she located or whether or not they were still active was revealed on cross-examination.

Opponent’s Rule 43 Evidence

Daoud Affidavit

[27] Marie Daoud is a legal secretary employed by the trade-mark agents for the Opponents. Her evidence consists of searches she conducted using the CIPO database, the Systeme Cidreq database (which contains information on businesses operating in the province of Quebec) and the WHOIS database operated by Webnames for companies that have registered trade-marks, corporate names and domain names that contain the letter combination SLF.

[28] The reply affidavit of the Opponents’ affiant Ms. Daoud reveals those trade-marks mentioned in the search filed as Exhibit A to the affidavit of Ms. Cook which have been expunged or abandoned, and also shows which business names mentioned by Ms. Cook are no longer in use.

Preliminary Issues

Amended Application

[29] At the oral hearing, the Applicant filed an amended application, wherein the services were revised as follows:

Financial services, namely, insurance services, providing, managing and administering benefit plans and group and individual investment plans and investment funds, including pension plans, retirement savings plans, segregated funds, pooled funds, registered and non-registered savings and retirement payout products; real estate services, namely real estate leasing, real estate development, real estate investment, property management, real estate appraisal, portfolio management and asset management *for buildings owned in whole or in part by the applicant or an affiliated company*

[30] The Opponents' agent requested and was given the opportunity to provide his comments on the amendment even though the Registrar does not typically request the comments of the other party when considering an amended application. The Opponents' agent stated that he did not consent to the application as amended, and that his oral argument would be the same whether or not the amendment was permitted.

[31] In view that the proposed amendment restricts the Applicant's services, I am satisfied that the application as amended complies with Rule 32 of the *Trade-mark Regulations*, SOR/96-195 and should be made of record.

Applied for services

[32] The Opponents' agent also asserted at the outset of the oral hearing that it would not be objecting to the following applied for services:

- mutual fund services
- trust company services
- a securities dealer providing trading services in the nature of trading accounts and registered plans

[33] These services will therefore not be considered in my analysis of any of the grounds of opposition. Each of the grounds is therefore rejected with respect to these services.

Section 50 – Licence to Use Trade-mark

[34] With respect to the Opponents' evidence, while Mr. Lober has stated that **SLF Partnership** licenses its mark to other parties, in my view he has not adduced evidence which shows that his company exercises the requisite control over the services used in association with the SLF Design mark [see *Loblaws Inc. v. Tritap Food Broker* (1999), 3 C.P.R. (4th) 109 (T.M.O.B.) at 112]. Section 50(1) of the Act reads as follows:

50. (1) For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trade-mark to use the trade-mark in a country and the owner has, under the licence, direct or indirect control of the character or quality of the wares or services, then the use, advertisement or display of the trade-mark in that country as or in a trade-mark, trade-name or otherwise by that entity has, and is deemed always to have had, the same effect as such a use, advertisement or display of the trade-mark in that country by the owner.

50. (1) Pour l'application de la présente loi, si une licence d'emploi d'une marque de commerce est octroyée, pour un pays, à une entité par le propriétaire de la marque, ou avec son autorisation, et que celui-ci, aux termes de la licence, contrôle, directement ou indirectement, les caractéristiques ou la qualité des marchandises et services, l'emploi, la publicité ou l'exposition de la marque, dans ce pays, par cette entité comme marque de commerce, nom commercial -- ou partie de ceux-ci -- ou autrement ont le même effet et sont réputés avoir toujours eu le même effet que s'il s'agissait de ceux du propriétaire.

[35] In the present case, while Mr. Lober states that there is an oral licence agreement in place, he has not provided any particulars of the licence arrangement or details of the existence and exercise of any control by **SLF Partnership** over the character or quality of the services sold by the affiliated companies in association with the mark SLF. Consequently, any use of **SLF Partnership's** mark shown by the alleged licensees does not accrue to the benefit of **SLF Partnership**. I therefore conclude that **SLF Partnership** has not shown that it is entitled to the benefit of s. 50 for those services used by the licensees in association with the SLF Design mark. It should be noted that this conclusion is based on the evidence filed in the present case, and is not a finding with respect to the validity of the **SLF Partnership's** registered trade-mark (see *Creations Meandres Inc. v. Xentel DM Inc.*, 2005 CarsewellNat 1309 (T.M.O.B.)).

[36] With respect to the use of SLF Design mark by **SLF Realty**, Mr. Reim states in his affidavit that his company has been authorized by **SLF Partnership** to use the SLF Design mark in association with the services provided by it. It was revealed on cross-examination, however, that no written licence agreement exists between **SLF Partnership** and **SLF Realty**. Further, I agree with the Applicant that the evidence does not support the claim that **SLF Partnership** controls the character and quality of the real estate services offered by **SLF Realty**. In this regard, the only reference to the question of **SLF Partnership**'s control of the character and quality of the real estate services provided by **SLF Realty** is an answer to undertaking where Mr. Reim claims that **SLF Partnership** is "in a position to overview the manner of use of the trademark SLF by SLF Realty Corp." and that it does so "on a continuous basis." (Reim UA-3, p. 13-14)

[37] Such control, however, is control over the use of the SLF Design mark as opposed to control over the character or quality of the services offered by **SLF Realty** in association with the SLF Design mark as provided by s. 50. Further, I disagree that control over the character and quality of the services by **SLF Partnership** can be inferred based on **SLF Partnership**'s 50% ownership of **SLF Realty** and/or the fact that the two companies share the same premises. In this regard, the case law is clear that control by share ownership, on its own, is insufficient to satisfy the requirements of s. 50. There needs to also be evidence of actual control of the character or quality of the services (see *Dynatech Automation Systems, Inc. v. Dynatech Corp.* (1995), 64 C.P.R. (3d) 101 at 106 and *MCI Communications Corp. v. MCI Multinet Communications Inc.* (1995), 61 C.P.R. (3d) 245 (T.M.O.B.) at 254 (para. 22). Further, while a common controlling individual may be able to satisfy the requirements of s. 50 (see *Petro Canada v. 2946661 Canada Inc.* (1998), 83 C.P.R. (3d) 129 (F.C.T.D.)), in the present case, the fact that an owner and licensee share the same office premises does not in and of itself demonstrate control by the owner over the character and quality of the services sold by the licensee.

[38] With respect to the Applicant's evidence, Mr. Leduc explained how the Mark has been used by the Applicant, and under licence by Sun Life Financial Inc. and other members of the Sun Life Financial Group of Companies. While he confirmed on cross-examination that the

licence is a verbal licence, he explains that use of the Mark with the related goods and services are at all times under the control of the Applicant. Control is exercised via reports from the management of each licensee to the Applicant, and through the normal reporting and management structures of the Applicant and its licensees. In my view, this evidence is sufficient to show that the Applicant has the requisite control over the character or quality of the wares or services used in association with the Mark.

Grounds of Opposition

Section 30(i) Ground

[39] The Opponents' agent withdrew the s. 30(i) ground of opposition at the oral hearing.

Section 12(1)(d) Ground of Opposition

[40] As its s. 12(1)(d) ground, the Opponents have pleaded that the Mark is not registrable pursuant to s. 12(1)(d) of the Act because it is confusing with **SLF Partnership**'s trade-mark SLF Design.

[41] **SLF Partnership** has met its evidential burden because its registration No. TMA507775 is extant.

Section 6(5) analysis

[42] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act. Each of these is discussed below.

s. 6(5)(a) the inherent distinctiveness of the trade-marks and the extent to which they have become known

[43] Both the Mark and **SLF Partnership**'s mark are comprised essentially of initials representing acronyms of their respective names and as such, are weak marks possessing relatively little inherent distinctiveness [*GSW Ltd. v. Great West Steel Industries Ltd.* (1975), 22 C.P.R. (2d) 154].

[44] With respect to the extent to which the marks have become known, the evidence is clear that the Applicant is a well known insurance provider in Canada. The issue, however, is to what extent the Applicant's SLF mark has become known in Canada in association with the applied for services.

[45] The Opponents' agent argued that if any use of the Mark in Canada had been shown by the Applicant, such use has been minimal. I agree. In this regard, I agree with the Opponents' agent that the use of SLF on the Toronto Stock Exchange does not constitute trade-mark use as defined by s. 4(2) of the Act. What it does show, however, is that Canadian investors have come to identify the Applicant (or its licensee) by its designated trading symbol and this contributes to the reputation acquired by the Applicant's SLF mark. I also agree with the Opponents' agent that the appearance of SLF on the annual reports of the Applicant's licensee, and in association with slide presentations, has mostly been use of SLF as an abbreviation for Sun Life Financial as opposed to use of SLF as a trade-mark in association with the applied for services. Therefore, while the Applicant's evidence may only show limited use of SLF as a trade-mark in Canada pursuant to s. 4(2), I consider that it is still useful in showing that the Mark has become known to some extent in Canada.

[46] As for **SLF Partnership**'s mark, the Lober affidavit establishes that the registered mark SLF Design has become known by **SLF Partnership** in Canada, and particularly in Toronto and Montreal, in association with accounting and auditing services and some other financial services including estate planning, personal and corporate tax planning, corporate financial consulting and corporate re-organization. With respect to the remaining registered services, however, **SLF Partnership** has failed to convince me that any use shown inures to its benefit. I therefore cannot conclude that the trade-mark SLF used in association with such services has become widely known as **SLF Partnership**'s mark [see *R.C. Purdy Chocolates Ltd. v. Gershkovitch*

(2005), 46 C.P.R. (4th) 71 (T.M.O.B.)). Further, use of the mark SLF Design outside of the scope of s. 50 may also have diminished the distinctiveness of **SLF Partnership**'s mark.

s. 6(5)(b) the length of time the trade-marks have been in use

[47] According to Mr. Leduc, the Applicant began use of SLF as a trade-mark in April, 2003. **SLF Partnership**, on the other hand, has shown use of its mark since January, 1997. This factor therefore favours **SLF Partnership**.

s. 6(5)(c) nature of the wares, services or business

[48] As for the services and trades of the parties, it is the Applicant's statement of services and **SLF Partnership**'s statement of services in registration No. 507,775 that govern: see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.) at 10-11, *Henkel Kommanditgesellschaft Auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.) at 112, and *Miss Universe, Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.) at 390-392. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see the decision in *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.) at 169.

[49] The Applicant has argued that since the core business of **SLF Partnership** is accounting and auditing, its other registered services are incidental to such services. In *London Life Insurance Co. v. Nesbitt Thomson Inc.* (1996), 75 C.P.R. (3d) 114, Board Member Martin made the following distinction between primary and incidental services at p. 120:

On a superficial level, the services appear to be similar but a careful examination of the opponent's statement of services reveals otherwise. As stated in the *Coffee Hut* decision, one must examine the opponent's statement of services with a view to determine the probable type of business that it would be engaged in. In this regard, the statement of services suggests that the opponent's primary services are the provision of life insurance and that its financial planning and investment services are incidental to the life insurance services. The opponent's evidence confirms this and indicates that, although the opponent does use certain financial vehicles such as RRSPs, GICs and annuities in selling and structuring life insurance plans, it does not

offer a full range of financial products associated with an investment broker. For example, the opponent does not deal in more sophisticated investment vehicles such as bonds, options, commodities, futures, coupons and the like. The opponent's own advertising stresses the primacy of insurance services in its FREEDOM 55 offering, any financial planning being a necessary and incidental part of those insurance services (e.g. -- Exhibit E2 to the Bailey affidavit).

The applicant's statement of services, on the other hand, covers only "investment services" which suggests that the applicant's trade-mark is to be used in association with the full range of financial and investment services associated with a brokerage house. The Simms affidavit confirms that this is the case and that NESBITT THOMSON FREEDOM ACCOUNT services allow for a wide range of investments including various securities. In fact, Mr. Simms confirms that the applicant is registered to offer securities to the public and is a member of all stock exchanges in Canada. The evidence (including the Ash affidavit filed by the opponent) shows that this is what the public would expect from a brokerage firm.

...

Thus, although there is some superficial similarity between the services of the parties, they are essentially different. The opponent's services are life insurance services with an incidental and somewhat limited financial planning and investment component. The applicant's services comprise the full range of investment services which includes dealing in various securities and does not include the sale of life insurance. The trades of the parties are also essentially different, the opponent being in the life insurance business and the applicant being an investment brokerage firm.

[50] In the present case, Mr. Lober has admitted that **SLF Partnership**'s core business is "the servicing of the accounting, auditing and financial services of small and medium sized companies and their shareholders" (Lober cross-ex., Q. 61). Further, as admitted by Mr. Lober in his replies to undertakings, **SLF Partnership**'s own print advertising stresses the primacy of its accounting and auditing services, and does not even refer to the Opponent's self defined "wealth management services" (Lober UA No. 21). While **SLF Partnership** may *advise on* various financial matters (eg. estate planning and tax planning), it does not *sell* life insurance or mutual funds, fund group pension and savings plans, or *provide administrative and record keeping services* for group pension plans, group savings plans or group benefit plans. Further, while **SLF Partnership** may promote itself as working in conjunction with the affiliated companies to offer the services of a full accounting firm, it has been shown that many of **SLF Partnership**'s registered services are actually rendered by these other companies which have not been properly licensed to use the SLF Design mark. I therefore conclude that **SLF**

Partnership's primary services are accounting and auditing and that most of its other registered services are incidental to these services.

[51] In view of the above, I consider the parties' services to be related to the extent that both parties would, generally speaking, be considered to provide financial services. The actual services applied for or already provided, however, are different. From the evidence furnished, it does not appear that **SLF Partnership** provides the same financial services in association with its SLF Design Mark as the Applicant has applied for in association with its Mark.

s. 6(5)(d) the nature of the trade

[52] **SLF Partnership** presently offers its services from two locations where the firm name appears together with the words Chartered Accountants/Comptables Agrées. It targets individuals and companies who are interested in general accountancy or tax preparation services. Other clients include financial institutions, law firms and insurance companies (Lober affidavit, para. 22).

[53] Relying on the decision in *Toronto Dominion Bank v. Evergreen Savings Credit Union* (2004), 37 C.P.R. (4th) 454 (T.M.O.B.), the Applicant submits that one should look at the business of the parties and the evidence furnished to determine what mark is being used and what services are being offered. In view that **SLF Partnership**'s mark always appears with the words Chartered Accountants/Comptables Agrées, the Applicant submits that the message given to consumers by the use of the mark in this way is that it is an abbreviation for the firm name. The Applicant also argues that use of the mark in this way emphasizes **SLF Partnership**'s reputation in the accounting field.

[54] The Applicant, on the other hand, targets individuals and businesses interested in purchasing life, accident and sickness insurance products. All advisors, brokers, and contractors are licensed by provincial regulators to sell such products. The Applicant also targets businesses that want the Applicant to provide, manage, and administer group and individual benefit and investment plans, including pension plans. The Applicant's services are offered through its network of advisors, brokers, contractors, and employees who operate from locations branded

with the SUN LIFE FINANCIAL name and mark. The Applicant has therefore submitted that the manner in which it carries on business in Canada differs from the nature of **SLF Partnership**'s business.

[55] While that may indeed presently be the case, the manner in which the parties are currently carrying on business is not determinative of the channels of trade when considering the issue of the likelihood of confusion in respect of a s. 12(1)(d) ground of opposition. As previously noted, in an opposition proceeding the Registrar must have regard to the respective services covered in the present application and in **SLF Partnership**'s registration as these statements of services determine the scope of the monopoly of **SLF Partnership** in respect of its registered trade-mark or being sought by the Applicant in relation to its mark.

[56] While both parties may presently be offering their respective services in buildings branded by their trade-names, neither the Applicant's application nor **SLF Partnership**'s registration is restricted in this regard. In other words, nothing prevents either party from offering their respective services in the future in buildings without their respective "house marks". Further, this case can be distinguished from the decision in *TD Evergreen* because in that case the applicant was a credit union which offered its services *only* to its members whereas the opponent was a bank whose relevant services were targeted to members of the public. In the present case, the applied for financial services are not so restricted. Therefore, in view that the financial services covered in the present application and **SLF Partnership**'s registration are related, I must consider that the channels of trade of the parties for these services could potentially overlap.

[57] With respect to the Applicant's real estate services, since these services in my view are not similar to the Opponent's financial services, I do not consider that the Applicant's channels of trade for these services would overlap with those of the **SLF Partnership**.

s. 6(5)(e) – *degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested*

[58] Even though the marks may represent acronyms for their respective parties' business names, when viewed without any additional matter they are practically identical. The only difference is that **SLF Partnership**'s mark includes a non-distinctive design component.

Additional Surrounding Circumstances

[59] The Applicant argues that both marks have co-existed since 2002 with no evidence of confusion in the marketplace. However, in view of the limited use of the Mark, I do not consider the lack of confusion to be particularly relevant in the present case.

[60] The Applicant further submitted that the search conducted by Ms. Cook establishes the co-existence in Canada of several companies with business names containing the letter combination SLF. The Opponent's evidence, however, revealed that Ms. Cook was not aware of the nature of these businesses, or whether they were still in operation. In any case, and even if the fourteen business names highlighted by the Applicant are no longer in use, the fact that they were adopted and registered suggests that SLF is a common letter combination for businesses in general.

[61] Another surrounding circumstance the Applicant has argued is that businesses that are interested in retaining the Applicant to provide, manage and administer group and individual benefit and investment plans are sophisticated clients who are interested in specialized (and highly regulated) financial services. As such, businesses purchasing the Applicant's services would not likely purchase the Applicant's products without giving the matter a great deal of thought and spending time with the companies' representatives.

[62] While that may in fact be the case, I note that the Applicant also targets individuals interested in purchasing life, accident and sickness insurance products, or mutual fund and other investment products. I would not consider such individuals to necessarily be more sophisticated than those individuals who are interested in the **SLF Partnership**'s general accountancy or tax preparation services.

Conclusion

[63] In applying the test for confusion, the issue is whether a consumer who has a general and not precise recollection of **SLF Partnership**'s mark, will, upon seeing the Applicant's mark, be likely to think that the related services share a common source. Despite able argument by counsel for the Applicant, the Applicant has not satisfied me that, on a balance of probabilities, there would not be a reasonable likelihood of confusion between the marks as of today's date. While I agree that a mark of low inherent distinctiveness such as **SLF Partnership**'s mark should normally only be accorded a fairly restrictive ambit of protection, in the present case **SLF Partnership** has provided evidence of a considerable reputation for its SLF Design mark, particularly in Montreal and Toronto, in association with accounting and auditing services. Further, even though the financial services provided by each of the parties may actually be different, I am not sure that the average Canadian would likely know that a large financial services organization such as the Applicant would not also be able to provide financial services such as those of **SLF Partnership**, or that an accounting firm such as **SLF Partnership** would not provide other financial services, such as those of the Applicant. Even though the marks may represent acronyms for their respective parties' business names, when viewed without any additional matter, they are practically identical. As a result, I am not satisfied that a Canadian who has an imperfect recollection of the **SLF Partnership**'s accounting and auditing services offered in association with the SLF Design mark would not, as a matter of first impression, assume that the Applicant's SLF financial services emanate from or were somehow associated with **SLF Partnership**. The s. 12(1)(d) ground of opposition is therefore successful as it applies to the Applicant's financial services.

[64] I do not find this ground successful, however, with respect to the Applicant's real estate services. As noted above, I consider the Applicant's real estate services to be different from all of **SLF Partnership**'s registered services. Further, the Applicant's real estate services have been restricted to buildings owned in whole or in part by the applicant or an affiliated company. I am therefore satisfied on a balance of probabilities that there would not be a reasonable likelihood of confusion between the marks in respect of these services.

Section 16(3)(c) Ground

[65] As its s. 16(3)(c) ground, the Opponents plead that the Mark is confusing with **SLF Realty**'s trade-name, SLF Realty Corp. Société Immobilière SLF S.A.R.F., used in association with real estate investment and financial consulting services since September 29, 1988.

[66] Pursuant to s. 6(4) of the Act, the use of a trade-name causes confusion with a trade-mark if the use of both the trade-name and the trade-mark in the same area would be likely to lead to the inference that the wares or services associated with the business carried on under the trade-name and those associated with the trade-mark are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[67] In determining whether a trade-mark or trade-name is confusing, the Registrar has regard to all of the surrounding circumstances set out in s. 6(5) of the Act.

s. 6(5)(a) inherent distinctiveness of the trade-mark or trade-name and the extent to which they have become known

[68] As noted previously, the Applicant's mark does not possess much inherent distinctiveness because it is comprised of letters used as an acronym for Sun Life Financial. **SLF Realty**'s name is not inherently distinctive either, because it is also comprised of alphabet letters and it is followed by the descriptive words "Realty Corp."

[69] With respect to the extent to which **SLF Realty**'s trade-name has become known, the Applicant submits that **SLF Partnership** has not filed any evidence of a licence governing the use by **SLF Realty** of SLF Design as a trade-mark or SLF as part of its trade name. It is therefore the Applicant's submission that any use of SLF by **SLF Realty** cannot inure to the benefit of **SLF Realty**.

[70] The Opponents' agent, on the other hand, argues that the fact that there is no control or licence by **SLF Partnership** over **SLF Realty**'s trade-name is not relevant because **SLF Realty** was the first user of SLF in its trade-name. In this regard, **SLF Realty** was incorporated before **SLF Partnership** filed its trade-mark application for SLF Design.

[71] I do not consider the Opponents' argument persuasive. I find it confusing that the Opponents have pleaded that one opponent (**SLF Partnership**) owns rights in the SLF Design trade-mark while the other opponent (**SLF Realty**) owns rights in the trade-name SLF Realty Corp./Société Immobilière SLF S.A.R.F. In any case, at the filing date of the application (i.e. Nov. 2, 2001), **SLF Realty** did not have a licence to use **SLF Partnership's** registered mark, either alone or as part of its trade-name. I therefore agree with the Applicant that any use of **SLF Realty's** trade-name has not inured to the benefit of **SLF Realty**.

[72] With respect to the extent that the Applicant's mark has become known, it had not become made known at all in Canada at the filing date of the application.

s. 6(5)(b) the length of time the trade-marks or trade-names have been in use

[73] Any use by the Applicant of SLF as a trade-mark began in April, 2003, which was after the relevant date for this ground of opposition. As for **SLF Realty's** trade-name, from the evidence furnished I can only conclude that it has become known in Canada to a minimal extent. In any event, in view that the use shown after February 9, 1999 (i.e. the date **SLF Partnership's** SLF Design mark was registered) was not distinctive of **SLF Realty**, I do not consider the length of time the marks have been in use to be of much significance.

s. 6(5)(c) & (d) nature of the wares, services or business and nature of the trade

[74] The evidence shows that, at the relevant date, **SLF Realty** had used its trade-name in association with: 1) property management services for two residential condo developments and one real estate development project; and 2) financial consulting and advisory services in association with real estate. The Applicant's real estate services, on the other hand, include: real estate leasing, real estate development, real estate investment, property management, real estate appraisal, portfolio management and asset management.

[75] While the Applicant's property management and real estate development services appear on their face to be similar to **SLF Realty's** real estate services, the Applicant's services are restricted to buildings owned in whole or in part by the Applicant or an affiliated company. In

my view, it is clear from the restriction in the Applicant's services that the Applicant's real estate services are used for the benefit of Sun Life Assurance Company of Canada's own investment portfolio, in support of its insurance operations (as Mr. Leduc also stated at paragraph 21 of his affidavit).

[76] Therefore, although there is some similarity between the services of the parties, I do not consider that their channels of trade would overlap. Even though Mr. Leduc may have said in his affidavit that the expertise gained by the Applicant's internal real estate personnel in managing its own real estate assets may also be provided to third parties in the future, the services as now amended would not permit this to happen. In this regard, the Applicant has restricted its services to buildings owned in whole or in part by the Applicant or an affiliated company, whereas **SLF Realty**'s services are offered to third parties, including clients of **SLF Partnership**'s accounting firm, bankers, lawyers and other accounting firms.

[77] As for **SLF Realty**'s financial consulting services, I consider these to be different from the Applicant's services as it is clear from the evidence that these services of **SLF Realty** are provided specifically in association with real estate.

s. 6(5)(e) degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested

[78] As for the degree of resemblance between the Mark and trade-name, the Mark is the first component of **SLF Realty**'s trade-name. There is therefore some degree of resemblance in appearance and sound. The ideas suggested are different, however, as the Mark does not suggest any idea in particular whereas **SLF Realty**'s trade-name suggests the idea of a real estate corporation.

Conclusion

[79] The issue is whether a consumer who has a general and not precise recollection of **SLF Realty**'s trade-name will, upon seeing the Applicant's mark, be likely to think that the services share a common source. Having considered all of the surrounding circumstances, I am satisfied

that the Applicant has met its burden to show that there would not have been a reasonable likelihood of confusion as of the Applicant's date of filing.

Remaining Grounds of Opposition

[80] The s. 16(3)(a) and s. 38(2)(d) grounds of opposition essentially turn on the issue of confusion between the Mark and **SLF Partnership**'s mark SLF Design. For the most part, my conclusions respecting the s. 12(1)(d) ground of opposition also apply to these grounds. I therefore find, on a balance of probabilities, that the Applicant has failed to show that its proposed mark was not confusing with **SLF Partnership**'s mark as of the Applicant's date of filing of its application and the date of filing of the opposition. Thus, these grounds are also successful with respect to the financial services of the Applicant.

Disposition

[81] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application with respect to the services "Financial services, namely, insurance services, providing, managing and administering benefit plans and group and individual investment plans and investment funds, including pension plans, retirement savings plans, segregated funds, pooled funds, registered and non-registered savings and retirement payout products" and I reject the opposition with respect to the remainder of the services pursuant to s. 38(8) of the Act [see *Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 492 (F.C.T.D.) as authority for a split decision].

DATED AT Gatineau, Quebec, THIS 30th DAY OF March, 2010.

Cindy R. Folz
Member,
Trade-marks Opposition Board