



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2013 TMOB 150
Date of Decision: 2013-09-06

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Viator Inc. against registration
No. TMA605,294 for the trade-mark VIATOR ET
DESSIN in the name of Expert Travel Financial Security
(E.T.F.S.) Inc.**

[1] At the request of Viator Inc., the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on May 25, 2011 to Expert Travel Financial Security (E.T.F.S.) Inc. (the Registrant), the registered owner of registration No. TMA605,294 for the trade-mark VIATOR et dessin, shown below (the Mark):



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

- (1) Services of development, sales, claims, assistance and administration of insurance products namely group expatriate health insurance products.
- (2) Services of development, sales, claims, assistance and administration of insurance products namely individual expatriate health insurance products.
- (3) Services of development, sales, claims, assistance and administration of insurance products namely in-patriate health insurance and visitors to Canada products.
- (4) Services of development, sales, claims, assistance and administration of insurance products namely individual and group health insurance, travel emergency medical, baggage, trip cancellation, trip interruption, collision damage and accidental death and dismemberment insurance policies.

[3] 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 wares or 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 May 25, 2008 and May 25, 2011.

[4] The relevant definition of “use” in this case is set out in section 4(2) of the Act:

(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.

[5] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd* (2004), 31 CPR (4th) 270 (FC)]. With respect to services, the display of the Mark on advertising is sufficient to meet the requirements of section 4(2) when the trade-mark owner is offering and prepared to perform those services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)]. Furthermore, the evidence as a whole must be considered and focusing on individual pieces of evidence is not the correct approach [*Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)].

[6] In response to the Registrar’s notice, the Registrant filed the affidavit of Robert Blackwood, Vice President Legal and Human Resources of the Registrant, sworn on August 23, 2011. Both parties filed written representations and attended an oral hearing.

[7] At the oral hearing, the Registrant conceded that there was no evidence submitted with respect to the specific “in-patriate” and “expatriate” insurance products as described in services (1), (2) and (3). As well, with respect to services (4), the Registrant conceded that the evidence did not support maintenance of the registration with respect to “development” of the Registrant’s insurance products, nor is there any reference to “trip interruption, collision damage and accidental death and dismemberment” anywhere in the evidence. As there is also no evidence of

special circumstances excusing the absence of use with respect to such services before me, the registration will be amended accordingly.

Evidence with respect to “Individual Health Insurance”

[8] With respect to the remaining services, I note that the Registrant’s evidence relates mostly to “group” health insurance products. With respect to the Registrant’s “individual” health insurance products, Mr. Blackwood provides, at Exhibit C, a copy of an individual policy application that appears to have been completed in 2003. The exhibit also includes an accounting statement, which Mr. Blackwood explains “show[s] that the policy is still active and has been active in Canada during the relevant period”. I note that the Mark appears on both the policy and the statement.

[9] However, the effective date of the policy was in 2004, prior to the relevant period. Furthermore, the limited explanation provided by Mr. Blackwood would indicate that the “accounting statement” is likely merely an internal document prepared after the issuance of the section 45 notice and not submitted as evidence of use of the Mark in association with the Registrant’s services during the relevant period. In this respect, I note the statement covers the period of 2004 to 2011. There is no evidence before me that the insured would have viewed this document or one like it bearing the Mark during the relevant period.

[10] As such, I do not consider Exhibit C as demonstrating use of the Mark within the meaning of sections 4(2) and 45 of the Act. As Exhibit C is the only exhibit clearly relating to the Registrant’s “individual” insurance products, the registration will be amended accordingly.

Evidence with respect to “Group Health Insurance” and other policies

[11] With respect to the remaining services, namely, “...sales, claims, assistance and administration of insurance products namely ... group health insurance, travel emergency medical, baggage, trip cancellation ... insurance policies”, Mr. Blackwood provides the following exhibits:

- Exhibit D consists of a page printed from the Registrant’s website on July 8, 2011. Mr. Blackwood attests that the page was on the ETFs website “during the relevant period and

certainly immediately before May 25, 2011”. The page is entitled “Group Travel” and provides a summary of the benefits and coverage of “Viator™ Group Travel Insurance”. Included in the benefits summary is reference to “comprehensive emergency medical travel coverage and assistance referrals”, “trip cancellation” and “baggage insurance”. I note the Mark appears at the bottom of the page.

- Exhibit A consists in part of copies of two group travel medical emergency insurance policies. Although the policies commenced prior to the relevant period, namely July 1, 2006, Mr. Blackwood attests that the policies are still active, and in this respect, he also provides copies of five “accounting statements” for these policies. At the oral hearing it was clarified that, as the statements show amounts for “commission”, these statements were issued to brokers, rather than policyholders. The policies and statements all display the Mark as registered.
- Exhibit A also includes a copy of a group travel medical emergency insurance policy with an effective date of January 1, 2011. I note that a variation of the Mark appears at the top left corner of the first page, with VIATOR in a different font and without the design element as registered.
- Exhibit B consists of an example “summary of a VIATOR insurance policy as shown to [a] subscriber”, entitled “Out of Province/Canada Travel Medical Emergency Insurance”. As the benefit summary includes reference to “coverage period per insured person”, the document appears to be related to a group insurance policy. At the oral hearing, the Registrant confirmed that the summary is an excerpt from a larger document, as the page number, 25, appears at the bottom of the document. I note the date on the summary is “September 1, 2008” and that the Mark appears at the top left corner of the page.
- Exhibit E consists of example member cards issued to group policy subscribers, displaying their name and policy number as well as contact information for medical and other assistance. The Mark appears on the cards.

[12] Although the evidence is not overwhelming in this case, in view of the services advertised as shown in Exhibit D, and the 2011 policy at Exhibit A, I am satisfied that the

Registrant advertised and was prepared to perform the remaining services as registered. In determining whether the evidence in this case demonstrates use with respect to "...sales, claims, assistance and administration...", I note that services are to be interpreted broadly [*Venice Simplon-Orient Express Inc v Société nationale des chemins de fer français* (2000), 9 CPR (4th) 443 (FCA)] and that in some cases a statement of services will contain overlapping and redundant terms in the sense that the performance of one service necessarily implies the performance of another [*Gowling Lafleur Henderson LLP v Key Publishers Co*, 2010 CarswellNat 579 (TMOB)]. As such, I am satisfied that the evidence demonstrates use of the Mark with respect to "Services of ... sales, claims, assistance and administration of insurance products namely ... group health insurance, travel emergency medical, baggage, trip cancellation ... insurance policies" within the meaning of sections 4(2) and 45 of the Act.

Disposition

[13] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete "development" and "trip interruption, collision damage and accidental death and dismemberment" from services (4) and services (1), (2) and (3) in their entirety.

[14] The amended statement of services will be as follows: "Services of sales, claims, assistance and administration of insurance products namely group health insurance, travel emergency medical, baggage, and trip cancellation insurance policies."

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