



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

Citation: 2013 TMOB 205
Date of Decision: 2013-11-27

**IN THE MATTER OF AN OPPOSITION
by J David Insurance and Investment
Ltd. to application No. 1,484,823 for the
trade-mark SUNFLEX LIFESTYLE
PROTECTOR in the name of Sun Life
Assurance Company of Canada**

[1] Sun Life Assurance Company of Canada (the Applicant) filed an application on June 11, 2010 to register the trade-mark SUNFLEX LIFESTYLE PROTECTOR (the Mark) based upon proposed use in association with:

Financial Services namely, insurance services; providing, managing and administering investment plans and investment funds, including retirement savings plans, retirement income plans, segregated funds, pooled funds, registered and non-registered savings plans; investment counseling and portfolio management, financial advisory services; mutual fund services.

[2] J David Insurance and Investment Ltd. (the Opponent) has opposed the application under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[3] The application has been opposed on the grounds that: (i) it does not conform to the requirements of section 30(i) of the Act; (ii) the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act in view of the Opponent's prior use and making known in Canada of the trade-mark THE LIFESTYLE PROTECTOR, in association

with a variety of financial related services, which are similar to those of the Applicant; and (iii) the Mark is not distinctive within the meaning of section 2 of the Act.

[4] In support of its opposition, the Opponent filed the affidavit of Lynn Williams, sworn March 6, 2012. Ms. Williams was not cross-examined.

[5] The Applicant did not file any evidence.

[6] Neither party submitted a written argument.

[7] Both of the parties attended a hearing.

Onus

[8] 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 Opponent 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 CPR (3d) 293 (FCTD) at 298].

Grounds of Opposition Summarily Dismissed

Non-compliance – Section 30(i)

[9] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case. Accordingly, the section 30(i) ground is dismissed.

Analysis of the Remaining Grounds of Opposition

Non-Entitlement – Section 16(3(a))

[10] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act because it is confusing with its trade-mark THE LIFESTYLE PROTECTOR, which was previously used and made known in Canada, since at least as early as 1999, in association with:

“Financial planning, analysis, education and advice pertaining to wealth preservation, investment planning, estate planning, tax planning, succession planning, business exit planning and retirement planning; Financial analysis, education and advice pertaining to business insurance, group insurance, life insurance, health insurance, critical illness insurance and disability insurance; Financial investment analysis, education and advice pertaining to mutual funds, segregated funds and insurance; Financial portfolio management services”

[11] Despite the burden of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent’s trade-mark THE LIFESTYLE PROTECTOR, the Opponent has the initial onus of proving that its trade-mark was in use or had been made known prior to the June 11, 2010 filing date of the application for the Mark and had not been abandoned as of the January 12, 2011 date of advertisement for the Mark [section 16(5) of the Act].

[12] The definition of "made known" is set out in section 5 of the Act. The Opponent has not made any submissions to the effect that its evidence shows that its trade-mark has been "made known" within such definition, and it does not appear to me that it has. Therefore, we are left with the question of whether the Opponent's evidence shows that its mark was used in Canada pursuant to section 4 of the Act.

[13] At the oral hearing, the Applicant submitted that the evidence put forward in the Williams affidavit is insufficient for the Opponent to meet its initial burden to prove use of its trade-mark prior to the Applicant’s filing date. The Applicant further submitted that even if the

Williams affidavit were sufficient for the Opponent to meet its initial burden regarding use prior to the filing date of the application, it is not sufficient to demonstrate that the Opponent's trade-mark had not been abandoned as of the date of advertisement of the Mark. I will therefore proceed to review the evidence on this issue.

[14] Ms. Williams is the President of the Opponent. Ms. Williams states that her father initially registered the company in September of 1997 extra-provincially in the Province of British Columbia [see paras 1-3 and 7 and Exhibits 1 and 2] and then later created the name THE LIFESTYLE PROTECTOR to identify and distinguish his services from others in the insurance and financial field in 1998. Ms. Williams indicates that her father contacted a creative company to design and develop a design and logo for THE LIFESTYLE PROTECTOR for the Opponent on January 15th of 1999 [see para 10, Exhibit 4]. In the Job Confirmation which is attached as Exhibit 4, the trade-mark is shown as LIFESTYLE PROECTOR, rather than THE LIFESTYLE PROTECTOR. Shortly after contacting the creative company regarding the development and design of the logo, her father registered yet another variation (THE LIFESTYLE PROTECTOR SOLUTION) of the name with the British Columbia Registrar of Companies [see paras 8, 9 and 10 and Exhibits 3 and 4].

[15] At the hearing, the Applicant submitted that although the information contained in these paragraphs is useful as background information, it does not establish use of the Opponent's trade-mark THE LIFESTYLE PROTECTOR during those early years. I agree.

[16] However, for the reasons which follow, I am of the view that when taken as a whole, Ms. Williams' affidavit is sufficient to establish that the Opponent had used its trade-mark THE LIFESTYLE PROTECTOR prior to the filing date of the application for the Mark and that it had not abandoned such use prior to the date of advertisement of the Mark.

[17] In paragraph 4 of her affidavit, Ms. Williams states that the Opponent provides financial planning, estate planning, lifestyle planning, retirement planning, health, life, critical illness and income protection insurance and investment services to individuals and corporate clients. She further states that although the Opponent operates from Vancouver, British Columbia, it has a client base in Alberta and Saskatchewan as well [see para 5].

[18] In paragraphs 15 to 19, Ms. Williams identifies the companies through which the Opponent offers its clients individual and group insurance and mutual fund services. For example, in paragraph 18, Ms. Williams states that the Opponent offers “group insurance for the following insurance companies using the trade-mark THE LIFESTLYE PROTECTOR, namely Desjardins Financial Security and Great West Life”. In paragraph 19, Ms. Williams states that the Opponent offers “mutual funds, mutual fund investment analysis and review either directly or indirectly through Quadrus Investment Services Ltd. using the trade-mark THE LIFESYLE PROTECTOR”.

[19] During the hearing, the Applicant submitted that there is an inconsistency in the language used in these paragraphs which could be interpreted to mean that one of these companies owns or is using the trade-mark THE LIFESTYLE PROTECTOR, rather than the Opponent itself. In the absence of any cross-examination or evidence from the Applicant to the contrary, I am prepared to accept that these statements in Ms. Williams’ affidavit are in reference to the Opponent’s own use of its trade-mark in association with the services it provides to its clients.

[20] In paragraph 20 of her affidavit, Ms. Williams indicates that for the years of 1999 to 2008, the Opponent’s average annual gross sales using the trade-mark THE LIFESTYLE PROTECTOR are estimated to be \$125, 000. Attached as Exhibits 7 & 8 to Ms. Williams’ affidavit are photocopies of letterhead and business cards bearing the trade-mark THE LIFESTYLE PROTECTOR, which Ms. Williams states were used from March of 1999 to August of 2009 [see paras 22 and 23].

[21] Ms. Williams indicates that in August of 2009, the Opponent designed a new logo for its communication materials, upon which its trade-mark THE LIFESTYLE PROTECTOR is displayed. Attached as Exhibits 9,10, 11 and 12 to her affidavit are copies of letterhead, business cards, customer intake questionnaires and facsimile coversheets bearing the new version of the Opponent’s logo and its trade-mark.

[22] Ms. Williams indicates in paragraphs 25-28 that the materials attached as Exhibits 9, 10, 11 and 12 were in use from August of 2009 up until the time that she swore her affidavit,

namely, March 6, 2012. Ms. Williams further indicates in paragraph 21 of her affidavit that for the years of 2009 and 2010, the Opponent's average annual sales were approximately \$175, 000.

[23] At the oral hearing, the Applicant submitted that the change in the logo in 2009 amounted to an abandonment of the Opponent's trade-mark at that time and that any evidence prior to that date should not be considered. I disagree.

[24] The use of a trade-mark in combination with additional words or features constitutes use of the mark if the public as a matter of first impression would perceive the trade-mark as being used. This is a question of fact which is dependent on whether the trade-mark stands out from the additional material and whether the trade-mark remains recognizable [see *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 at 538 and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[25] I am of the view that the Opponent's trade-mark THE LIFESTYLE PROTECTOR remains recognizable and clearly stands apart from the logos used in both the pre and post August 2009 materials. I therefore conclude that the manner in which it appears on those materials would constitute use of the word mark THE LIFESTYLE PROTECTOR as asserted in the Statement of Opposition.

[26] During the oral hearing, the Applicant also submitted that there is no indication that any of the business cards, facsimile coversheets, etc. which were referred to in paragraphs 22, 23, 24, 25, 26 and 27 and attached as Exhibits 7, 8, 9, 10, 11 and 12 to Ms. Williams' affidavit were ever distributed. However, Ms. Williams clearly states in those paragraphs that the materials were "in use" and indicates the years in which they were used. In view of this and in view of the annual sales figures which Ms. Williams provided in paragraphs 20 and 21 of her affidavit, I find it reasonable to conclude that those materials featuring the Opponent's trade-mark would have been used or distributed during the normal course of the Opponent's business during those years.

[27] At the oral hearing, the Applicant also pointed out that in paragraph 21, Ms. Williams didn't explicitly state that the 2009 and 2010 average annual sales related to sales in connection with the trade-mark THE LIFESTYLE PROTECTOR. By contrast, in paragraph 20, where Ms. Williams provided the annual average sales for the years of 1999 to 2008, she did specify that the

sales related to the use of the trade-mark. In view of the contents of the Williams affidavit as a whole, it is reasonable to conclude that these figures would also have related to sales in connection with the Opponent's trade-mark THE LIFESTYLE PROTECTOR.

[28] As previously mentioned, Ms. Williams clearly indicates in paragraphs 25-28 that the letterhead, business cards, intake questionnaires and facsimile coversheets bearing the trade-mark which were attached as Exhibits 9, 10, 11 and 12 were in use from August of 2009 up until the time that she swore her affidavit, namely, March 6, 2012.

[29] Moreover, in paragraphs 13 and 14, Ms. Williams indicates that she joined her father's company in February of 2009. Attached as Exhibit 6 to her affidavit is a photocopy of some correspondence dated August 10, 2009, which Ms. Williams states was sent out to clients to announce that she had joined her father's company. The trade-mark THE LIFESTYLE PROTECTOR is prominently displayed thereon.

[30] In addition, Ms. Williams states that in April of 2009, the Opponent purchased the domain names *www.lifestyleprotector.ca* and *www.thelifestyleprotector.ca* [see para 30 and Exhibits 14 and 15]. She states that its website has been active since October of 2009. Attached as Exhibit 16 is a color screen print of the original web page which was posted in October of 2009. Attached as Exhibit 17, is a print out of a current webpage from the Opponent's website. Both of these printouts feature the Opponent's trade-mark THE LIFESTYLE PROTECTOR.

[31] The Applicant correctly pointed out that the Opponent is not listed as the registrant in the particulars for the domain name registrations for *thelifestyleprotector.ca* and *lifestyleprotector.ca*, which are attached as Exhibits 14 and 15 to the Williams affidavit. However, in the absence of any cross-examination or Applicant's evidence to the contrary, I am prepared to accept Ms. Williams' sworn statements in paragraphs 30 to 32 that the Opponent purchased the domain names in April of 2009 and that the website is hosted by an employee of the Opponent.

[32] Although there may be some weaknesses in the Williams affidavit, I am satisfied that based upon a fair reading of the affidavit as a whole, the Opponent has established evidence of use of its trade-mark THE LIFESTYLE PROTECTOR before June 11, 2010 and non-

abandonment as of January 12, 2011. It was open to the Applicant to cross-examine Ms. Williams if it harbored any doubts as to the veracity of her evidence, but it chose not to.

[33] I therefore find that the Opponent has succeeded in meeting its evidential burden.

[34] As the Opponent's evidentiary burden has been satisfied, I must now determine whether the Applicant has established on a balance of probabilities that there is no reasonable likelihood of confusion between its Mark and the Opponent's trade-mark.

Test for confusion

[35] 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 section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them.

[36] This list of enumerated factors is not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC)].

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[37] While the Opponent's trade-mark THE LIFESTYLE PROTECTOR does possess some degree of inherent distinctiveness, it is not a highly distinctive trade-mark. In this regard, I note that it is comprised of ordinary dictionary words, which in combination may be considered to be

somewhat suggestive of the Opponent's services. In particular, the Opponent's trade-mark suggests to consumers that using the Opponent's financial and insurance services would somehow assist them with maintaining their lifestyle. Since the Applicant's Mark SUNFLEX LIFESTYLE PROTECTOR also includes the words LIFESTYLE PROTECTOR and is used in connection with the same types of services as those of the Opponent, it is similarly suggestive. However, the addition of SUNFLEX, which appears to be a coined term, does add some measure of distinctiveness to the Applicant's Mark. In view of this, I find that the Applicant's Mark is slightly more inherently distinctive than the Opponent's trade-mark.

[38] A mark's distinctiveness can be enhanced through use and promotion. As of the filing date of the Applicant's application, only the Opponent's mark had been used. Thus, I am able to conclude that only the Opponent's mark had become known to any extent.

Section 6(5)(b) - the length of time each trade-mark has been in use

[39] The Application for the Mark is based upon proposed use. The length of time the marks had been in use when the application was filed therefore favours the Opponent.

Sections 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

[40] The parties both offer financial/insurance services and there is no reason to expect that their services would not travel through similar channels of trade.

Section 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[41] In *Masterpiece Inc v Alavida Lifestyles Inc et al.* (2011), 92 CPR (4th) 361 (SCC), the Supreme Court of Canada clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks [see also *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstering Ltd* (1980), 47 CPR (2d) 145 (FC), at 149, affirmed (1982), 60 CPR (2d) 70 (FCA)].

[42] In the present case, the Applicant has almost adopted the Opponent's trade-mark in its entirety. The only difference is that the Applicant has replaced the non-distinctive word "THE"

in the Opponent's mark with the word "SUNFLEX". It is true that the first component of a mark is often the most important for the purposes of distinction and the addition of the word "SUNFLEX" to the Applicant's mark does result in some visual and phonetic differences. However, in my view, there is still a fair degree of resemblance between the parties' respective trade-marks and as discussed previously, the marks are also very similar in terms of suggested idea.

[43] I therefore find that this last factor also favours the Opponent.

Conclusion

[44] Having considered all of the surrounding circumstances and applying the test of confusion as a matter of first impression and imperfect recollection, I arrive at the conclusion that there is a likelihood of confusion between the parties' marks. In reaching this conclusion, I have had special regard to the following facts: i) the Applicant has incorporated the whole of the dominant portion of the Opponent's mark into its Mark; ii) only the Opponent's mark had been used and become known to any extent as of the June 11, 2010 material date; and iii) both marks are for use in association with financial and insurance related services.

[45] As the legal burden is on the Applicant to establish, on a balance of probabilities, that the Mark was not confusing with the trade-mark THE LIFESTYLE PROTECTOR at the filing date of the application and it has failed to do so, the section 16(3)(a) ground of opposition succeeds.

Non-Distinctiveness – Section 2

[46] The Opponent has pleaded that the Applicant's Mark SUNFLEX LIFESTYLE PROTECTOR is not distinctive as it does not distinguish the services of the Applicant from those of the Opponent, in association with which it previously used its trade-mark THE LIFESTYLE PROTECTOR since at least 1999.

[47] The material date for assessing this ground is the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[48] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its services from those of others throughout Canada there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness [*Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[49] In the present case, the Opponent is under an obligation to show that, as of the filing date of the statement of opposition, namely, June 10, 2011, its trade-mark THE LIFESTYLE PROTECTOR had become known sufficiently in Canada to negate the distinctiveness of the Applicant's Mark. The reputation of the Opponent's trade-mark should be substantial, significant or sufficient [*Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[50] I am not satisfied that the Opponent has met its burden. According to the Williams affidavit, the Opponent's client base is restricted to the Provinces of British Columbia, Alberta and Saskatchewan [see para 5]. While I note that in paragraph 33 of *Bojangles' International LLC* the Court commented that "a mark could negate another mark's distinctiveness if it is well known in a specific area of Canada", it is not evident in the present case that the Opponent's mark was "well known" in the Provinces of British Columbia, Alberta and Saskatchewan as of the June 10, 2011 material date.

[51] Although Ms. Williams provided approximate annual sales figures for the years of 1999 to 2010, these figures are not particularly high given the nature of the Opponent's services and there is no indication as to how the Opponent charges clients for its services or how many clients it provided its services to during that time frame. In other words, depending upon how the Opponent's services are billed, the sales figures could be attributable to only a handful of clients or to many. Moreover, for the years of 1999 to 2008, there is no information regarding the extent to which the Opponent's services were advertised and promoted and no figures for annual advertising or promotional expenditures have been provided.

[52] Ms. Williams does indicate in paragraph 29 of her affidavit that the Opponent began distributing a newsletter to 488 of its clients and contacts in June of 2010. However, the

newsletter which is attached to Ms. Williams' affidavit as Exhibit 13, post dates the June 10, 2011 material date by several months.

[53] Ms. Williams also states in paragraphs 30 to 32 of her affidavit that the Opponent began operating a website in 2009. However, there is no indication as to how many views the website would have had as at the material date. Similarly, although Ms. Williams states that the Opponent opened a TWITTER® account in 2009 and started a FACEBOOK® page in January of 2011 and has provided information pertaining to the number of "followers" and "likes" it had received as at the date of swearing her affidavit, it is unclear how many "likes" it had received or "followers" it had attracted as of the June 10, 2011 material date. As of the date of swearing of the affidavit, namely, March 6, 2012, the Opponent had 3,157 followers on TWITTER® and had received 86 "likes" on FACEBOOK®. Even if the Opponent could establish that a large number of these "likes" and "followers" had occurred prior to the material date, these numbers are not sufficient to enable me to conclude that the Opponent's trade-mark was "well known" in the region of Western Canada in which it provides its services.

[54] As I am not satisfied that the Opponent's trade-mark's reputation was substantial, significant or sufficient as of the material date, I find that the Opponent has not met its initial burden in relation to its non-distinctiveness grounds of opposition.

[55] Accordingly, this ground of opposition is dismissed.

Disposition

[56] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office