

SECTION 45 PROCEEDINGS  
TRADE-MARK: GUARDIAN VANTAGE  
REGISTRATION NO: TMA 395,415

At the request of Gowling Lafleur Henderson LLP (the “requesting party”) the Registrar forwarded a notice under section 45 of the *Trade-marks Act* on May 3, 2005 to the Guardian Capital Group Limited, the registered owner of the above-referenced trade-mark.

The trade-mark GUARDIAN VANTAGE is registered in association with:

Financial services, namely, distribution of mutual funds.

Section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, 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 and/or services listed on 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 use since that date. In this case, the relevant period for showing use is any time between May 3, 2002 and May 3, 2005. What qualifies as use of the trade-mark in association with services is defined in s. 4(2) of the Act, which states:

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.

In response to the Registrar’s notice, the Registrant furnished the affidavit of C. Verner Christensen, the Vice-President, Finance, and Secretary of Guardian Capital Group Limited. Both parties filed written arguments. An oral hearing was not conducted.

In paragraphs 4 through 7 of the affidavit, the Registrant provides information with regard to a wholly owned division of the Registrant, namely, Guardian Capital LP. The attached exhibits referred to in these paragraphs are marked Exhibits A-1, A-2, B-1, B-2, C-1, C-2, and D. These exhibits consist of:

- pages taken from Guardian Capital LP's website which specifies the company's profile, business activities and asset statistics (**these pages do not refer to the trade-mark GUARDIAN VANTAGE**),
- pages taken from **answers.com** purporting to accurately describe the business activities of the Registrant (**these pages do not refer to the trade-mark GUARDIAN VANTAGE**),
- excerpts from a monthly publication entitled "*Guardian Monthly: Canada*" taken from Guardian Capital LP's website. (**The trade-mark GUARDIAN VANTAGE does not appear anywhere on these excerpts.**)
- a page taken from the Guardian Capital LP's website detailing the philosophy associated with five Canadian equity products provided by Guardian Capital. (**Again, the trade-mark GUARDIAN VANTAGE does not appear.**)

In paragraph 8 of the affidavit, C. Verner Christensen refers to the trade-mark GUARDIAN VANTAGE. He states that the Registrant has used the trade-mark in Canada in association with the services set forth in the registration: financial services, namely, distribution of mutual funds. C. Verner Christensen further describes a brief history of fundraising activities directed at raising funds for the distribution of mutual fund units of the **Guardian Vantage** Funds. The **Guardian Vantage** Funds are stated as consisting of five mutual funds which were formed on November 30, 1988. Exhibit "E" is a copy of the front cover of the Partnership Offering Memorandum – the Private Placement Offering Memorandum used to raise funds to finance the distribution of mutual fund units of the Guardian Vantage Funds. This memorandum is dated January 9, 1989.

In paragraph 9 of the affidavit, C. Verner Christensen refers to Exhibit "F" as true copies of a couple of pages of Annual Information Forms of the Registrant which he states make reference to the trade-mark VANTAGE. (The forms actually refer to Guardian Vantage.). Mr. Christensen states that such forms are filed with the securities regulatory authorities in all provinces of Canada, and are available to any person in Canada. The Annual Information Forms are dated September 24, 2001 and August 28, 2002.

Underlined on such forms are the words **Guardian Vantage** Equity Fund, following the terms Nov. 30, 1988 – formed by Declaration of Trust.

The requesting party's arguments can be summarized as follows:

- The Registrant did not produce evidence of a single instance of the use or display of the trade-mark in the performance or advertising of the services in the relevant period as required by ss. 4(2) of the Act.
- The use described in paragraphs 4 through 7 of the affidavit, by Guardian Capital LP, is not use and does not constitute use of the trade-mark GUARDIAN VANTAGE. Furthermore, any use described in paragraphs 4 through 7 of the affidavit is by Guardian Capital LP and such use does not accrue to the Registered owner pursuant to section 50 of the Act.
- The Partnership Offering Memorandum (Exhibit "E") and the Annual Information Forms (Exhibit "F"), which refer to GUARDIAN VANTAGE, cannot be characterized as "advertisements", but even if they could be considered as such, the Registrant has failed to file any evidence to establish performance of the services during the relevant period. It adds that in any event, regardless of how Exhibits "E" and "F" are characterized, Exhibit "F" clearly shows that the trade-mark has not been used since 1991. In this regard, it points out that it is clear from Exhibit "F" that the name of the Registrant's mutual fund was changed in 1991.
- Lastly, the requesting party argues that the Registrant has not filed any evidence of "special circumstances" to excuse the non-use of the mark during the relevant period.

The threshold for establishing use in a s. 45 proceeding is quite low (*Woods Canada Ltd. v. Lang Michener* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.) at 480), and evidentiary overkill is not required in order to properly reply to a s. 45 notice. Although invoices are not required (*Lewis Thomson & Sons Ltd. v. Rogers, Bereskin & Parr* (1988), 21 C.P.R. (3d) 483), sufficient facts must be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with the registered services during the relevant

period. A bare statement of use of the mark is not sufficient to evidence use in association with the wares and/or services [See *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (4<sup>th</sup>) 62].

Having considered the evidence, I totally agree with the requesting party that the use described in paragraphs 4 through 7 of the affidavit, is not in relation to the trade-mark GUARDIAN VANTAGE. The use of the terms **Guardian, Guardian Capital Group, Guardian Capital Group Limited**, and **Guardian Capital LP** (as evidenced in Exhibits A-1, A-2, B-1, B-2, C-1, C-2, and D) clearly does not constitute use of the mark GUARDIAN VANTAGE. Additionally, paragraphs 4 to 7 refer to use by Guardian Capital LP. Although Mr. Christensen refers to Guardian Capital LP as a “division” of the Registrant, the inclusion of “LP” (“limited partnership”) in this entity’s name denotes that of a separate legal entity. Accordingly, even if paragraphs 4 to 7 of the affidavit showed use of the trade-mark GUARDIAN VANTAGE it would be considered use by a third party and not use by the registered owner.

I am also in agreement with the requesting party that paragraphs 8 and 9 of the affidavit and Exhibits E and F thereof completely fail to show use of the trade-mark GUARDIAN VANTAGE in association with the services during the relevant period in a manner complying with the requirements of s. 4(2) of the Act.

The memorandum of Exhibit “E” provides evidence of fundraising activities and Mr. Christensen has explained that the funds raised were used to finance the distribution of mutual funds units of the “**Guardian Vantage Funds**” – five funds that were formed in November 1988. I note that the “offering period” described in this memorandum ended on February 2, 1989, more than thirteen years prior to the relevant period. Consequently, this document is not evidence of advertising or distribution of mutual funds associated with the trade-mark GUARDIAN VANTAGE during the relevant period.

As for Exhibit “F”, the Annual Information Forms which are filed annually with the securities regulatory authorities in all provinces of Canada, they refer to the **Guardian**

**Vantage** Equity Fund as the original name of the fund and they list amendments made including changes made to the name of the fund from 1991 to 2002. Mr. Christensen has not explained and I do not see how the filing of these Annual Information Forms consists of the advertising or performance of the services. Consequently, I cannot conclude that these show the use or display of the trade-mark in the advertising or performance of the services. In any event, it is clear from Exhibit “F” that “Guardian Vantage” was the original mark for the fund, which name changed in 1991. Consequently, it would seem that the display of the “historical” or “original” mark in the Annual Forms is for information purposes and is not a use of GUARDIAN VANTAGE as a trade-mark in association with services.

In view of the above, I conclude that the Registrant has failed to show use of the trade-mark GUARDIAN VANTAGE in association with the services during the relevant period and I find that there are no special circumstances that excuse such non-use.

Consequently, Registration No. 395,415 will be expunged in compliance with the provisions of Section 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 19<sup>TH</sup> DAY OF DECEMBER 2007.

D. Savard

Senior Hearing Officer

Section 45 Division