



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

Citation: 2014 TMOB 225
Date of Decision: 2014-10-07
TRANSLATION

**IN THE MATTER OF A SECTION 45 PROCEEDING,
requested by 88766 Canada Inc. against Registration
No. TMA665,198 for the trade-mark PROTECTION
VITALE, in the name of Assumption Compagnie
Mutuelle d'Assurance-Vie/Assumption Mutual Life
Insurance Company.**

Translator's note: Original translated decision has been corrected so as to replace the subject trade-mark previously identified as CRITICAL PROTECTION by PROTECTION VITALE.

[1] Translator's note: Original translated decision has been corrected so as to replace the subject trade-mark previously identified as CRITICAL PROTECTION by PROTECTION VITALE.

[2] On March 12, 2013, at the request of 88766 Canada Inc. (the Requesting Party), the Registrar sent the notice stipulated in section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Assumption Compagnie Mutuelle d'Assurance-Vie/Assumption Mutual Life Insurance Company (the Registrant), registered owner of registration No. TMA665,198 for the trade-mark PROTECTION VITALE (the Mark).

[3] This notice enjoined the Registrant to show that its Mark had been used in Canada, at any given time between March 12, 2010 and March 12, 2013 (the Relevant Period), in association with each of the services specified in the registration, i.e.

Insurance services, in particular: health insurance and accidental death and dismemberment insurance; financial services, in particular: financial planning services. (Hereinafter sometimes collectively referred to as the Services).

And, in the absence of use, the date when the Mark had last been used and the reason(s) for its absence of use since this date.

[4] In response to the Registrar's notice, the Registrant has produced an affidavit from Nathalie Allaire, Director of Communications and Marketing for the Registrant, sworn in on April 22, 2013.

[5] Both parties produced written representations. Only the Registrant was represented at the hearing held in this file.

Analysis

[6] 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; this is why the applicable test is not very stringent. As stated by Judge Russell in *Uvex Toko Canada Ltd v. Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC), on p. 282:

We know that the purpose of section 45 proceedings is to clean up the "deadwood" on the register. We know that the mere assertion by the owner that his trade mark is in use is not sufficient and that the owner must "show" how, when and where it is being used. We need sufficient evidence to be able to form an opinion under section 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade mark owner's business and merchandising practices.

[7] "Use" in association with services is set out in subsection 2(4) of the Act:

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.

[8] Considering in greater depth the evidence submitted by the Registrant, Ms. Allaire basically stated the following:

- The Registrant is an insurance company created under a private bill of the province of New Brunswick. It has been operating in the financial services sector since 1903 [paragraph 2];
- The range of products provided by the Registrant includes personal life insurance, group insurance (life, health, dental, disability), investments through segregated funds and guaranteed interest accounts (and the following vehicles: individual and group RRSPs, TFSAs, RRIFs, LIFs, LIRAs, pension plans, annuities) and mortgages [paragraph 3];
- More specifically pertaining to the Mark, the latter has been held by the Registrant since it was registered on May 30, 2006 [paragraph 4];
- Since 2006, the Registrant has been using the Mark in connection with the Services [paragraph 5]; and
- As of April 16, 2013, the Registrant [TRANSLATION] “is pleased to be serving a few hundred clients who purchased this life insurance product. In communications with customers, [the Registrant refers] once again to the product using the [Mark]” [my underlining] [paragraph 9].

[9] In support of her statements related to use, Ms. Allaire has attached the following exhibits to her affidavit:

- Appendix A: copy of inserts and of information published on the Registrant’s website. Ms. Allaire’s testimony reveals that the inserts intended for the public were distributed [TRANSLATION] “mainly through the sales force” between mid-2006 and May 2012 [paragraph 6].

Upon reviewing the first page of the insert reproduced in Appendix A, I noted that the services provided under the Mark are described as [TRANSLATION] “critical illness” insurance services. More specifically, the insurance is described as [TRANSLATION] “covering the most common diseases, including certain types of cancer, stroke and heart attacks,” and including “accidental death and dismemberment insurance”;

- Appendix B: copy of a poster and promotional brochure handed out by the Registrant to her sales representatives across Canada between September 2007 and May 2012. Ms. Allaire explained that these [TRANSLATION] “marketing tools” are designed to “summarize the essential elements [of the] [Registrant’s] products, including the one called ‘PROTECTION VITALE’” [my underlining].

Upon reviewing these documents, I noticed that the services described under the Mark consist of insurance services. More specifically, these are described as follows in the brochure dated “NOV11”:

An insurance that allows your clients to focus on getting well.

[TRANSLATION] Protection Vitale, our critical illness insurance, provides essential financial protection to your clients and their families. They can thus concentrate on getting well while having peace of mind. [my underlining]

- Appendix C: copy of the telephone messages for on-hold calls that were broadcast on the Registrant’s phone lines accessible to the public. Ms. Allaire explained that these messages were broadcast in a random manner and heard by customers whose calls had been placed on hold. The Mark was referred to in the following manner:

[TRANSLATION] You will get well or recover from a critical illness without having to worry about your finances: this is what Protection Vitale provides. Talk to one of our advisors.

[10] The Requesting Party made several representations regarding the evidence submitted by the Registrant. I believe that these essentially cover the following points:

- i) Does the demonstrated use cover the relevant period?

[11] I agree with the Registrant that contrary to the Requesting Party’s representations, the period of use demonstrated by the Registrant covers a “given time” during the relevant period. The fact that part of such use began *before* the relevant period cannot be held against the Registrant. Similarly, the fact that the exhibits attached to Ms. Allaire’s affidavit do not cover the *entire* relevant period is not a problem in itself since the Registrant only needs to demonstrate use of the Mark at a “given time” during the relevant period.

ii. Is the demonstrated use equivalent to use of the Brand?

[12] I further agree with the Registrant that contrary to the Requesting Party's representations, the use demonstrated by the exhibits attached to Ms. Allaire's affidavit, more specifically the French versions of the brochures found in Appendices A and B, are equivalent to the use of the Mark. The fact that the Mark is at times used as such (i.e. as a word mark) and at other times in the form of a logo (as reproduced below), is not a problem in itself.



[13] Even in the form of a logo, the mark maintains its identity and remains recognizable. [See *Promafil Canada Ltée v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59 (F.C.A.); *Registrar of Trade Marks v. Compagnie Internationale pour l'Informatique CII Honeywell Bull, Société Anonyme et al.* (1985), 4 C.P.R. (3d) 523 (F.C.A.); and *Nightingale Interloc Ltd v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (TMOB)].

iii. Is the demonstrated use applicable for each of the Services?

[14] I agree with the Registrant that she has demonstrated use of the Mark in connection with the services described as:

Insurance services, in particular: health insurance and accidental death and dismemberment insurance.

[15] We need only recall, in this regard, that the insert reproduced in Appendix A in Ms. Allaire's affidavit describes the services provided under the Mark as insurance [TRANSLATION] "covering the most common diseases, including certain types of cancer, stroke and heart attacks," and including "accidental death and dismemberment insurance".

[16] However, I agree with the Requesting Party that the Registrant has not demonstrated use of the Mark in connection with the second category of services described in the registration, namely “financial services, in particular: financial planning services.”

[17] In her written representations and/or during the hearing, the Registrant argued that as an insurance company duly created under New Brunswick law, it is authorized to provide financial services. The Registrant also argued that the expression “financial services” is broadly construed as comprising “insurance services” and vice versa.

[18] Whether the Registrant is authorized or not to provide financial services is not the issue here. Rather, the issue is whether the Registrant has demonstrated use of the Mark in connection with such types of services.

[19] The Registrant’s position based on which the insurance services provided under the Mark also apply to the use of the Mark in connection with financial planning services due to the fact that [TRANSLATION] “any sale of an insurance product implies that the [Registrant’s] representative perform a prior assessment of the [client’s] financial services needs and that as such, financial planning services are being provided in the name of [the Registrant] when an insurance policy is sold bearing the name ‘PROTECTION VITALE’” does not stand up to scrutiny.

[20] It should first be mentioned in this regard that the Registrant attempted to introduce as evidence, through her list of authorities submitted in view of the hearing held in connection with this file, reference to the *Insurance Act*, RSNB 1973, c I-12 and reference to the definition of “*financial services*” found on *Wikipedia.org*. Suffice it to say that these references are not relevant in this case.

[21] In fact, the statement of services specifically mentions two categories of services, separated by a semi-colon, namely insurance services and financial services. These categories of services are further specifically defined as consisting of “health insurance and accidental death and dismemberment insurance” and of “financial planning services,” respectively.

[22] The product sold under the Mark is described as an insurance product by both Ms. Allaire herself and in all the exhibits attached to her affidavit. Period.

[23] The fact that such insurance is described in the “NOV11” brochure mentioned above as providing “essential financial protection” to the Registrant’s clients and to their families in the event of critical illness does not necessarily mean that the Registrant is actually providing “financial services, in particular: financial planning services” under the Mark.

[24] Note in this regard that Ms. Allaire, in the introductory paragraphs of her affidavit generally describing the Registrant’s activities, herself made a distinction between the Registrant’s insurance products and the other types of products described as including investments through segregated funds and guaranteed interest accounts and mortgages [see paragraph 3 of her affidavit]. The fact that the Registrant’s financial and insurance services can complement each other cannot be sufficient on its own to infer that the Registrant used the Mark in connection with financial planning services during the relevant period. It should be reiterated in this respect that Ms. Allaire’s affidavit makes absolutely no mention of the alleged “financial planning services” provided under the Mark.

Decision

[25] In view of the foregoing, and in the absence of exceptional circumstances that could justify the lack of use of the Mark in connection with the category of financial services, the registration will therefore be amended so as to cancel such services from the statement.

[26] In exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, the registration will therefore be maintained for the following services only:

Insurance services, in particular: health insurance and accidental death and dismemberment insurance.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Carole Biondic