



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

**Citation: 2010 TMOB 175**  
**Date of Decision: 2010-10-14**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Michel Bigras against registration  
No. TMA410,179 for the trade-mark SIGMA in the name  
of BMO Nesbitt Burns Corporation Limited/Corporation  
BMO Nesbitt Burns Limitée**

[1] On December 30, 2008, at the request of Michel Bigras (the Requesting Party), the Registrar forwarded a notice under s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) to BMO Nesbitt Burns Corporation Limited/ Corporation BMO Nesbitt Burns Limitée (the Registrant) the registered owner of the trade-mark SIGMA registration number TMA411,551 (the Mark) covering financial services, namely, fee-based brokerage accounts (the Services).

[2] Such notice requires the Registrant to show whether the Mark has been used in Canada in association with the Services 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. The relevant period in this case is any time between December 30, 2005 and December 30, 2008 (the Relevant Period).

[3] In response to the notice, the Registrant filed the affidavit of Paul C. Adair together with exhibit A to his affidavit. Both parties filed written representations and no oral hearing was requested.

[4] Section 45 proceedings are considered to be summary and expeditious for clearing the register of non-active trade-marks. The expression “clearing deadwood” has been often used to

describe such proceeding [see *Philip Morris Inc. v. Imperial Tobacco Ltd.* (1987), 13 C.P.R. (3d) 289].

[5] A simple allegation of use of the Mark is not sufficient to evidence its use in association with the services within the meaning of s. 4 of the Act. There is no need for evidentiary overkill establishing such use. However any ambiguity in the evidence filed shall be interpreted against the owner of the Mark [See *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980) 53 C.P.R. (4th) 62 and *Footlocker Group Canada Inc. v. Steinberg* (2005), 38 C.P.R. (4th) 508]. It is with these general principles in mind that I shall now summarize the evidence filed.

[6] Mr. Adair is the Registrant's Vice-President & Managing Director, Wealth Group Product Development and Portfolio Management and has been with the Registrant since July 1998. In his capacity, amongst other functions, he oversees the team responsible for product development as well as the marketing and support of all Wealth Group products offered by the Registrant. He has access to and he is familiar with the sales, marketing and promotional history of the Wealth Group products and Portfolio Management and has knowledge of the trade channels through which the financial products and services have been provided in Canada.

[7] He states that among the Wealth Group products and services offered by the Registrant, in its normal course of trade, is the provision of investment advice to guide the varied clientele through the financial planning process and assist its clients in an effort to meet financial goals. This is accomplished primarily via the Registrant's roster of trained investment advisors with a mission to provide support, counsel and advice to help establish client investment strategy and tactics.

[8] A part of this investment advice is branded as SIGMA, a financial services account providing fee-based brokerage accounts via the Registrant's own Investment Advisors. Mr. Adair affirms that the Mark is displayed in association with those services which have been offered during the Relevant Period.

[9] A brochure sent to the Registrant's clients in Canada in its normal course of trade during the Relevant Period is attached to his affidavit to illustrate the use of the Mark in association with the Services. The brochure filed is a one page document in black and white which appears

to be a master as the inscription “< IA Name>” appears on top of the inscription “Investment Advisor”. Also the phone number of the Investment Advisor has been identified as “(XXX) XXX-XXXX”. On the brochure appears “BMO Nesbitt Burns Sigma Account ®” written with the same font and size. At the bottom of the document there is the following notice: “® BMO...[is] registered trade-mark of Bank of Montreal, used under license. Nesbitt Burns is a registered trade-mark of BMO Nesbitt Burns Corporation Limited”. In the core of the brochure the trade-mark SIGMA appears followed by the symbol ®. There is also at the bottom of the brochure the following notice: “® SIGMA is a registered trade-mark of BMO Nesbitt Burns Corporation Limited.”

[10] In its written submissions, the Requesting Party is arguing that the evidence filed falls short from showing use of the Mark in association with the Services during the Relevant Period. It argues that the deponent has not provided how and when the brochure was sent to the Registrant’s clients and that there is no document such as invoices, pictures, advertisements bearing a date that has been attached to the affidavit. Finally the services associated to the Mark have not been clearly identified in the document filed by Mr. Adair. According to the Requesting Party what is left is a simple allegation of use of the Mark during the Relevant Period which is insufficient to maintain the registration in accordance with *Plough supra*.

[11] Use of a trade-mark in association with services is defined under s. 4(2) of the Act in the following terms:

(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.

[12] While Mr. Adair’s affidavit may be brief it does allege the essential facts necessary to conclude to the use of the Mark in association with the Services during the Relevant Period, namely:

The Services were advertised during the Relevant Period (brochure Exhibit A);

The brochure was distributed in Canada during the Relevant Period, thus demonstrating that the Services were available in Canada during that period;:

The distribution of the brochure was done in the normal course of trade.

The Mark clearly appears on the brochure advertising the Services.

Disposition

[13] Pursuant to the authority delegated to me under s. 63(3) of the Act, registration No. TMA410,179 will be maintained on the register in compliance with the provisions of s. 45(5) of the Act.

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office