



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

Citation: 2011 TMOB 202
Date of Decision: 2011-10-26

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Blake, Cassels & Graydon LLP against
registration No. TMA496,005 for the trade-mark CWB
DIRECT in the name of Canadian Western Bank.**

[1] At the request of Blake, Cassels & Graydon (the Requesting Party), the Registrar of Trade-marks issued a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on January 23, 2009 to Canadian Western Bank., the registered owner of registration No. TMA496,005 for the trade-mark CWB DIRECT (the Mark).

[2] The Mark is registered for use in association with “banking services” (the Services).

[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 and 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 January 23, 2006 and January 23, 2009 (the Relevant Period).

[4] The definition of “use” in association with services is set out in s. 4(2) of the Act:

4. (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 s. 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. As stated by Mr. Justice Russell in *Performance Apparel Corp. v. Uvex Toko Canada Ltd.* (2004), 31 C.P.R. (4th) 270 (F.C.) at 282:

[...] We know that the purpose of s. 45 proceedings is to clean up the "dead wood" on the register. We know that the mere assertion by the owner that the 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 s. 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 owners' business and merchandising practices.

[6] In response to the Registrar's notice, the Registrant filed the affidavit of Peter Kenneth Morrison, Vice-President, Marketing & Product Development of the Registrant, sworn on April 22, 2009 (the Affidavit). Only the Registrant filed written representations; an oral hearing was not requested.

[7] In his Affidavit, Mr. Morrison states that the Registrant is a Schedule I chartered bank incorporated pursuant to the *Bank Act*, S.C. 1991, c. 46, headquartered in Edmonton, Alberta, which offers a wide range of personal and commercial financial services. Mr. Morrison explains that the Registrant's banking services have also been offered to its customers via an Internet-based interface known by the Mark, CWB DIRECT, since at least as early as 1998. Customers access their account information using the CWB DIRECT interface, which is available via the Registrant's website at www.cwbank.com.

[8] In support of the Registrant's assertion of use, attached to Mr. Morrison's affidavit as Exhibit A is a printout of the Registrant's website home page. I note that on the right hand side of the page are login links for "CWBdirect® Internet Banking" and "CWBdirect® Advanced Internet Banking".

[9] As well, attached as Exhibit B is a blank copy of the Registrant's five-page agreement "Terms and Conditions" for access to "CWBdirect® Services". I note that on each page there is a document header that provides a form number and a date - 08/08. Mr. Morrison explains that the Registrant's customers must sign the agreement in order to access and use the CWB DIRECT service. I observe that the Mark appears clearly throughout the document. For privacy reasons,

the Registrant has not provided any executed agreements, but Mr. Morrison does state in his affidavit that as of the end of 2005, a total of 11,100 customers had signed up for the CWB DIRECT service and that as of the end of 2008, the total number of such customers had increased to 24,674.

[10] Although not clearly stated in his Affidavit, I find it reasonable to infer that the Exhibit A webpage printout reflects the appearance of the website during the Relevant Period since Mr. Morrison's statements are clear regarding the volume of CWB DIRECT customers during the Relevant Period. In any event, I am satisfied that the appearance of the Mark in the Exhibit B agreement is sufficient to demonstrate use.

[11] Accordingly, I am satisfied that the Registrant has evidenced use of the Mark in association with the Services within the meaning of s. 45 of s. 4(2) of the Act during the Relevant Period.

[12] Pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be maintained in compliance with the provisions of s. 45 of the Act.

P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office