



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

**Citation: 2012 TMOB 73**  
**Date of Decision: 2012-04-27**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Sheehan & Rosie Limited against  
registration No. TMA612,186 for the trade-mark  
NATIONWIDE IS ON YOUR SIDE in the name of  
Nationwide Mutual Insurance Company**

[1] At the request of Sheehan & Rosie Limited (the Requesting Party), the Registrar of Trade-marks forwarded a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on August 7, 2009, to Nationwide Mutual Insurance Company, the registered owner (the Registrant) of registration No. TMA612,186 for the trade-mark NATIONWIDE IS ON YOUR SIDE (the Mark).

[2] The Mark is registered for use in association with the following services:

*Insurance services, namely underwriting life, health, annuity, property and casualty insurance; financial services, namely the sale of mutual funds, money market funds, pension plans and IRA plans.* (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 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 August 7, 2006 and August 7, 2009 (the Relevant Period).

[4] “Use” in association with services is set out in section 4(2) of the *Trade-marks Act*:

4. (2) A trade-mark is deemed to be used in association with service it is used or displayed in the performance or advertising of those services.

[5] 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. Assertions of use as a matter of law are insufficient to demonstrate use and ambiguities in the evidence are to be interpreted against the interests of the registered owner [see *Aerosol Fillers Inc v Plough (Canada) Ltd* (1979), 45 CPR (2d) 194 (FCTD)]. A recipient of a section 45 notice must put forward evidence showing how it has used the trade-mark in order that the Registrar may assess if the facts qualify as use of the trade-mark pursuant to section 4 of the Act. However, it has also been held that evidentiary overkill is not required when use can be shown in a simple, straightforward fashion [see *Union Electric Supply Co v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)].

[6] With respect to services, it is well established that the interpretation of “performance of services in Canada” for the purposes of section 4(2) is quite broad. Where the trade-mark owner is offering and prepared to perform the services in Canada, use of the trade-mark on advertising of those services meets the requirements of section 4(2) [see *Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (RTM)]. In other words, advertising in Canada alone is insufficient to demonstrate use; at the very least, the services have to be available to be performed in Canada. By way of example, use of a trade-mark on advertising in Canada of services only available in the United States does not satisfy the provisions of section 4(2) [*Porter v Don the Beachcomber* (1966), 48 CPR 280 (Ex Ct)].

[7] In response to the Registrar's notice, the Registrant filed the affidavit of Jeff D. Myer, the Director of Brand and Reputation of the Registrant. Both parties filed written submissions and were represented at an oral hearing.

[8] In his affidavit, Mr. Myer attests that the Registrant used the Mark during the Relevant Period in Canada through advertising of the Services and through the display of the Mark in regular communications with customers in Canada in the performance of the Services.

[9] With respect to such advertising, Mr. Myers states that the Registrant advertised its Services during the Relevant Period using the Mark through television commercials, print advertisements, and on the Registrant's website.

[10] Mr. Myers explains that the Registrant regularly uses television commercials to promote its Services, and that in these commercials, the actor or actress verbally refers to the Mark. He provides under Exhibit A, a DVD containing the Registrant's commercials that were broadcast during the Relevant Period. He indicates that the Registrant purchased time spots for these commercials on cable channels in several cities very close to the United States-Canada border, and provides a list of such cities. He then speculates that it is likely that Canadians would have seen these commercials during the Relevant Period.

[11] However, I agree with the Requesting Party's submission that oral reference to a trade-mark is not considered use of a trade-mark within the meaning of the Act [see *Playboy Enterprises Inc. v Germain* (1987), 16 CPR (3d) 517 (FCTD); *Waltrip v. Boogiddy Boogiddy Racing Inc* (2007), 64 CPR (4th) 357 (TMOB); and *Alex v World Wrestling Federation Entertainment Inc.* (2008), 68 CPR (4th) 244 (TMOB)].

[12] In any event, while some of the television commercials do contain a visual representation of a variant of the Mark, the Requesting Party is correct in that there is no evidence that these television commercials were received or viewed by consumers located in Canada [see *Reid Schmidt v Terminix International Company Limited* (2005), 50 CPR (4th) 454 (TMOB)].

[13] With respect to the print advertisements, Mr. Myers attaches, as Exhibits B and C to his affidavit, examples of advertisements placed by the Registrant in the *Wall Street Journal* in 2008 and 2009, as well as in 2006 and 2007, respectively. Additionally, Mr. Myers provides

circulation figures in Canada for these years, as provided to him by the *Wall Street Journal*, ranging from 5,470 to 6,743 copies sold on average each day. However, there is nothing to indicate in these advertisements that the Services are directed at Canadians, or that the Registrant is offering and prepared to perform the Services in Canada.

[14] Mr. Myers also states that the Registrant displayed the Mark on various pages of its website, and includes as Exhibit D to his affidavit, current and historical screen captures of these pages. He provides that the Registrant's records show that many individuals with Canadian IP addresses viewed these pages during the Relevant Period. Included with the Exhibit D screen captures is a summary of the number of times each of these web pages was viewed on August 1st of 2007, 2008 and 2009 respectively by Internet users with Canadian IP addresses.

[15] Again, however, as with the *Wall Street Journal* print advertisements, I note that there is nothing on these web pages to indicate that the Services are directed at Canadians or that the Registrant is offering and prepared to perform the Services in Canada. Despite the evidence that shows that individuals with Canadian IP addresses viewed these pages during the Relevant Period, from a review of these web pages, it appears that the Services are directed only at the American market.

[16] Nevertheless, Mr. Myers explains that most of the Registrant's Services are in the nature of ongoing financial commitments, which involve regular and frequent communications with each of its customers. Mr. Myers explains that such communications take the form of printed statements sent by mail on a quarterly, bi-annual or annual basis, depending on the underlying product. Attached as Exhibit E to his affidavit are copies of representative sample statements sent to customers in Canada during the Relevant Period in respect of the Services. Mr. Myers explains that confidential customer information has been redacted from each statement; however, the customer's city, province and postal code are identified on each statement.

[17] The Requesting Party submits that the sample statements in Exhibit E do not provide any evidence of when or where the purchase or performance of the Registrant's Services occurred and merely communicating with customers residing in Canada via print statements or advertisements featuring a trade-mark does not qualify as trade-mark use in Canada. It submits that, at best, the sample statements suggest that some sort of insurance and financial services

were purchased from the Registrant in the United States at some unknown time by consumers who now reside in Canada.

[18] In any event, the Requesting Party further submits that the sample statements in Exhibit E do not feature the registered trade-mark, but merely display concurrent use of the Registrant's other trade-marks, namely, the trade-marks NATIONWIDE DESIGN, NATIONWIDE and ON YOUR SIDE as follows:



[19] To begin with, with respect to the Registrant's insurance services, I agree with the Requesting Party that it does not appear from the evidence that the Registrant signed *new* contracts for insurance in Canada. The evidence is consistent with the inference that the Registrant's insurance services were initially purchased abroad by customers now residing in Canada. However, it has been held that activities involved in managing *existing* insurance contracts, including regular exchanges with policy holders, qualifies as continuing trade-mark use in connection with insurance services [see *Desjardins Sécurité Financière v Sun Life Assurance Co of Canada* (2005), 50 CPR (4th) 154 (TMOB)]. In this decision, Senior Hearing Officer Savard reasoned as follows at pp. 156-157:

Although I agree with the requesting party that the registrant may no longer be issuing new life insurance contracts in association with the trade-mark this does not necessarily mean that the registrant no longer performs life-insurance services. The term "life insurance services" is broad and encompasses more than the sale of life insurance contracts. Here the evidence shows that the registrant still uses the trade-mark in performing the services related to the MAXIVIE policies. The registrant administers "MAXIVIE life insurance policies"...and it refers to the trade-mark on the Annual Billing Notice and on policy progress reports which it distributes to the policy holders... The above, in my view, clearly shows that the trade-mark was used during the relevant period in the performance of the services. As the registrant still manages the existing contracts and has exchanges with the policy owners, this satisfies me that the registrant still provides life-insurance services.

[20] Consequently, in view of the above, I accept that the Registrant continued to provide its insurance services to individuals residing in Canada during the Relevant Period.

[21] With respect to the Registrant's financial services, however, I note that the description of these services in the registration is more narrowly defined. In particular, the financial services in the registration are defined as follows: *financial services, namely the sale of mutual funds, money market funds, pension plans and IRA plans*. While the Registrant may continue to communicate with consumers who now reside in Canada, there is no evidence that sales of mutual funds, money market funds, pension plans and IRA plans took place in Canada during the Relevant Period. Consequently, I cannot conclude that the Registrant was offering or was prepared to offer its financial services in Canada during the Relevant Period.

[22] With respect to the Requesting Party's submissions regarding deviation of the Mark on the insurance statements in Exhibit E, the question to be asked is whether the trade-mark was used in such a way that the mark did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade-marks) v Cie International pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 at 525 (FCA)].

[23] At the very least, in the first instance above, I do not consider the omission of the word "is" from the phrase NATIONWIDE IS ON YOUR SIDE to be significant, nor do I consider the differences in font would necessarily lead a consumer to perceive the words NATIONWIDE and ON YOUR SIDE to be two separate trade-marks. Overall, the dominant features of the Mark have been preserved and the differences between the marks are "so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences identify goods having the same origin" [*CII Honeywell Bull, supra* at p 525]. As this variant of the Mark also appears in the third instance above, visually separated from the NATIONWIDE design element as a separate trade-mark [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)], my conclusion is the same. In view of my findings, I need not consider the second instance above.

[24] Having regard to the foregoing, I am satisfied that the Registrant has shown use of the Mark in association with “*insurance services, namely underwriting life, health, annuity, property and casualty insurance*” in accordance with sections 4 and 45 of the Act.

Disposition

[25] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the following services in compliance with the provisions of section 45 of the Act: “*financial services, namely the sale of mutual funds, money market funds, pension plans and IRA plans*”

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Kathryn Barnett  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

