



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

Reference: 2013 TMOB 87
Date of Decision: 03/05/2013
TRANSLATION

**IN THE MATTER OF A SECTION 45 PROCEEDING,
requested by McInnes Cooper against Registration No.
TMA618,929 for the trade-mark UNISON in the name of
National Bank of Canada.**

[1] On September 30, 2010, at the request of McInnes Cooper (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 National Bank of Canada (the Registered Owner), enjoining the latter to prove use of the UNISON trade-mark (the Mark) in association with: banking and investment management services (the Services).

[2] Section 45 of the Act requires the Registered Owner to show that it has used its Mark in Canada in association with each of the Services specified in the registration at any given time during the three years preceding the date of the notice or, if not, provide the date on which it was last used and the reason for its absence of use since this date. The relevant period is therefore from September 30, 2007 to September 30, 2010 (the Relevant Period).

[3] The procedure pursuant to Section 45 is simple and expeditious, and serves to clear “deadwood” from the register. Accordingly, the threshold to establish use of the Mark, within the meaning of Section 4 of the Act, during the Relevant Period is not very high [see *Woods Canada Ltd v. Lang Michener* (1996), 71 CPR (3d) 477 (CF 1st inst.)].

[4] A simple claim of use of the Mark in association with the Services is not sufficient to establish its use within the meaning of Section 4(2) of the Act. There is no requirement to

produce abundant evidence. However, any ambiguity in the evidence will be interpreted against the Registered Owner of the Mark [see *Plough (Canada) Ltd v. Aerosol Fillers Inc* (1980) 53 CPR (4th) 62 (FCA)].

[5] In reply to the notice, the Registered Owner submitted an affidavit by Laurie Smuk, Senior Vice-president at NBCN Inc. Only the Registered Owner submitted written representations. No oral hearing was requested.

[6] Before beginning analysis of this evidence, I would like to reproduce the text from Section 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.

[7] Ms. Smuk explains that NBCN Inc. is a subsidiary of National Bank Financial Inc., the latter being held by the Registered Owner.

[8] Ms. Smuk states that the Mark designates combined banking and investment management services in that the investment account of individual users of these services is linked electronically to their bank account, which enables them to have a single account from which they can manage their investments and have access to their bank account via a debit card. Ms. Smuk submitted an example of one of these debit cards bearing the Mark.

[9] Ms. Smuk explains that the Registered Owner is the financial institution responsible for opening bank accounts and issuing debit cards and cheques bearing the Mark. The Services are provided in Canada directly by the Registered Owner or through its licensee NBCN Inc., which is authorized to use the Mark in Canada pursuant to a licence by which the Registered Owner exercises control over the characteristics and quality of the Services.

[10] As an example of use of the Mark, Ms. Smuk submitted a copy of the form entitled "UNISON CASH MANAGEMENT ACCOUNT (CMA) OPENING." After having explained in detail how the business relationship functions between the Registered Owner, NBCN Inc., brokers and clients, she submitted excerpts from the website of a brokerage firm promoting the Services in association with the Mark.

[11] Ms. Smuk stipulates that during the Relevant Period, approximately 100 Canadian clients had opened a UNISON account with the Registered Owner. She also provided the number of annual transactions and the value of these transactions for 2008, 2009 and 2010 (up to December 22) and for December 2007.

[12] In light of this evidence, I conclude that there had been use of the Mark in Canada during the Relevant Period in association with the Services within the meaning of Section 4(2) of the Act. In effect, the Mark clearly appears on the debit card used by clients of the Registered Owner to make bank transactions. Regarding the account opening form, I deem the words CASH MANAGEMENT ACCOUNT (CMA) OPENING to be descriptive and indicative of the Services offered in association with the Mark [see *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 CPR (3d) 535 (TMOB)]. Accordingly, the addition of these words does not detract from the distinctiveness of the Mark.

[13] Pursuant to the authority delegated to me under section 63(3) of the Act, the Registration No. TMA618,929 will be maintained on the register, the whole in compliance with the provisions of Section 45 of the Act.

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

Traduction certifiée conforme
Alan Vickers