



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

**Citation: 2012 TMOB 141**  
**Date of Decision: 2012-08-01**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Bereskin & Parr LLP against registration  
No. TMA684,463 for the trade-mark LION CAPITAL in  
the name of Lion Capital LLP.**

[1] At the request of Bereskin & Parr LLP (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on March 30, 2010 to Lion Capital LLP (the Registrant), the registered owner of registration No. TMA684,463 for the trade-mark LION CAPITAL (the Mark).

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

Insurance; investment services namely, the investing in and the management of businesses and the realisation of dividends, profits, capital gains, cash and securities from such businesses and the distribution of dividends, profits, capital gains, cash and securities; financial investments in the field of real estate, real estate investment services; financing services; leasing services namely, leasing of real estate and real property, lease financing of capital assets; private equity investment management, investments in the field of private equity, venture capital and specialized funds and other funds of any nature; managing investments namely, buying, selling and holding of securities; management of acquisitions and mergers; management of equity and debt investment portfolios; investment asset management; advisory and consultancy services relating to corporate finance and venture capital services; bank services namely those related to money services, credit and debit cards, savings, investments and insurance; capital, fund and trust investment services; investment management services; mutual fund, collective investment scheme and hedge fund services; unit trust services; financial and investment planning and research; advisory, consultancy and information services relating to all the aforesaid 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 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 March 30, 2007 and March 30, 2010 (the Relevant Period).

[4] The relevant definition of “use” with respect to services is set out in 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.

[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 and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[6] In response to the Registrar’s notice, the Registrant filed affidavits sworn by the Right Honorable Martin Brian Mulroney, advisor to the Registrant, and Janet Mary Dunlop, Chief Operating Officer of the Registrant. Although I have reviewed all of the evidence, I will only comment on the portions relevant to this proceeding. Both parties filed written representations; an oral hearing was not held.

[7] In her affidavit, Ms. Dunlop states that the Registrant is a private equity firm incorporated under the laws of England and Wales that focuses on making controlling investments in mid and large-sized, consumer-oriented businesses in Europe, the USA and Canada. She asserts use of the Mark during the Relevant Period in association with the services as registered, with the exception of the following: “insurance”, “financial investments in the field of real estate, real estate investment services”, “leasing services namely, leasing of real estate and real property, lease financing of capital assets” and “bank services namely those related to money services, credit and debit cards, savings, investments and insurance”.

[8] In their written representations, both parties note that the registration should be amended to delete these omitted services. The registration will be amended accordingly.

[9] In support of her assertion of use with respect to the Registrant's various investment, management and related consultancy services as registered, Ms. Dunlop states that the Registrant maintains a publicly-accessible website to promote the Registrant's services. Attached as Exhibit JD5 to her affidavit are extracts from the Registrant's website, *www.lioncapital.com*, which Ms. Dunlop attests has been materially the same since the adoption of the Mark, including during the Relevant Period. I note that the extracts display information regarding the Registrant's various investment, management and related consultancy services and that the Mark appears prominently on each page. Attached as Exhibit JD6 is a monthly summary of the number of unique visits to the Registrant's website from within Canada, which totalled over 120,000 visits during the Relevant Period.

[10] Ms. Dunlop also states that the Mark is featured prominently on business cards, letterhead, pens, pencils, polo shirts, ice buckets, bottle openers, gift bags and various other promotional items provided to the Registrant's clients and potential investors. Attached as Exhibit JD7 to Ms. Dunlop's affidavit are several photographs of these aforementioned items, which prominently display the Mark both on its own and in combination with a stylized lion design.

[11] Although Ms. Dunlop attests to the distribution of such items to Canadian investors during visits to the Registrant's offices and at annual investor meetings, I would note that such visits and annual meetings do not appear to have occurred in Canada. However, Ms. Dunlop does attest that these items have also been distributed in Canada on a regular basis to Canadian investors and contacts in the promotion and conduct of the Registrant's services in Canada. For example, Ms. Dunlop provides a list of 19 meetings between 2005 and 2010 where representatives from the Registrant travelled to Canada to meet with potential investors; 8 of these meetings took place during the Relevant Period. Furthermore, attached as Exhibit JD9 is a copy of a "pitch book" describing the Registrant's various services that is representative of the corporate literature and other materials that would have been distributed to potential investors during such meetings; the Mark is displayed prominently throughout.

[12] Finally, Ms. Dunlop provides specific details with respect to investments by three large Canadian-based financial institutions in funds managed by the Registrant. Ms. Dunlop attests that, as investors in the Registrant's funds, these institutions would have received extensive and regular communications in Canada from the Registrant during the Relevant Period; such communications would have included quarterly reports, *ad hoc* letters and memoranda, all bearing the Mark.

[13] In view of the foregoing, I am satisfied that the Registrant has demonstrated use of the Mark in association with the following services during the Relevant Period within the meaning of sections 4 and 45 of the Act:

...investment services namely, the investing in and the management of businesses and the realisation of dividends, profits, capital gains, cash and securities from such businesses and the distribution of dividends, profits, capital gains, cash and securities; ...; financing services; ...; private equity investment management, investments in the field of private equity, venture capital and specialized funds and other funds of any nature; managing investments namely, buying, selling and holding of securities; management of acquisitions and mergers; management of equity and debt investment portfolios; investment asset management; advisory and consultancy services relating to corporate finance and venture capital services; ...; capital, fund and trust investment services; investment management services; mutual fund, collective investment scheme and hedge fund services; unit trust services; financial and investment planning and research; advisory, consultancy and information services relating to all the aforesaid services.

[14] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete the following services: "Insurance", "financial investments in the field of real estate, real estate investment services", "leasing services namely, leasing of real estate and real property, lease financing of capital assets;" and "bank services namely those related to money services, credit and debit cards, savings, investments and insurance".

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Andrew Bene  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office