



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

**Citation: 2011 TMOB 246**  
**Date of Decision: 2011-12-15**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Blake, Cassels & Graydon LLP against  
registration No. TMA495,453 for the trade-mark CWB 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. TMA495,453 for the trade-mark CWB (the Mark).

[2] At the time of the notice, the Mark was registered for use in association with “(1) banking services; (2) financial services, namely insurance services; and (3) financial services, namely trust company services” (the Services). I note that certain additional services were registered on June 20, 2011, subsequent to an application to extend the statement of services filed by the Registrant on June 25, 2010; these are not subject to the current proceeding.

[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 CPR (4th) 270 (FC) 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 July 20, 2009 (the Affidavit). Both parties 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, and which offers a wide range of personal and commercial financial services. Mr. Morrison asserts that the Registrant has used the Mark continuously and throughout the Relevant Period in association with banking services since at least as early as 1988, in association with trust company services since at least as early as 1996 and in association with insurance services since at least as early as October 2002.

#### Banking Services

[8] In support of the Registrant’s assertion of use with respect to banking services, attached to Mr. Morrison’s affidavit as Exhibit A is a brochure entitled “Personal Banking Services”. Mr. Morrison states that the brochure was circulated prior to the issuance of the section 45 notice,

and I note that a date (10/08) appears at the bottom of the brochure. I further note that the Mark appears throughout the brochure, in particular as a house mark in the headings of paragraphs advertising the Registrant's banking services, such as "CWB *Think*® *Western MasterCard*®", "CWB Youth and Student Accounts" and "Canadian Western Bank (CWB)".

[9] As well, attached as Exhibit B and Exhibit C are blank copies of the Registrant's personal account and business account applications, respectively. Mr. Morrison explains that the Registrant's customers must sign the appropriate agreement in order to access the Registrant's financial services. For privacy reasons, the Registrant has not provided any executed agreements, but Mr. Morrison does state in his affidavit that he is aware that new customers sign these agreements weekly. I note that on the first page of each application there is a document header that provides a form number and a date – 10/08 with respect to the personal account application and 01/09 with respect to the business account application. I further observe that the Mark appears in two instances on the first page in the body of the personal application and once on the first page of the business application.

[10] Exhibit D is a screen capture of the "About Us" webpage from the Registrant's website, *www.cwbankgroup.com*, which Mr. Morrison attests is a means by which the Registrant offers its banking services to its customers. I note that the Mark appears in the body of the text as well as one of the trade-marks at the top of the webpage. Mr. Morrison attests that the "webpage existed in virtually the same form prior to the issuance of the Section 45 Notice", and I find it reasonable to infer that the Exhibit D printout reflects the appearance of the Mark as displayed during the Relevant Period.

[11] At this point, I note that the Requesting Party objected to the Registrant alleging certain facts in its written representations, in particular with respect to the circulation dates for the exhibit documents, as they were not in evidence in this proceeding; accordingly, I have disregarded such representations [see *Ridout & Maybee LLP v. Encore Marketing International Inc.* (2009), 72 CPR (4th) 204 (TMOB)]. However, based on the totality of the evidence before me, including the dates that appear on the documents themselves, I find it reasonable to infer that the brochures and other documents furnished reflect use of the Mark during the Relevant Period, with the exception of Exhibit G, discussed below.

## Insurance Services

[12] With respect to insurance services, Mr. Morrison attests that the Registrant offers creditor life, disability and travel insurance directly to its customers and that the Registrant also offers vehicle liability and home insurance through its wholly owned subsidiary, Canadian Direct Insurance Incorporated (CDII).

[13] In support, attached as Exhibit F is a copy of the cover and two pages from the “Message to Shareholders” portion of the Registrant’s 2008 Annual Report. Although CWB is referenced throughout the document, I note that the paragraphs describing trust services and insurance services do not reference the Mark or the Registrant specifically, but rather reference its subsidiaries. Accordingly, I am unable to infer based on this document alone that the Mark would have been displayed in the advertisement or performance of the Registrant’s trust and insurance services.

[14] Similarly, the sample advertisement “stuffer” of the Registrant’s insurance services offered through CDII attached as Exhibit G cannot be relied upon as evidence of use in this case as it is undated and Mr. Morrison provides no evidence as to publication or circulation during the Relevant Period.

[15] However, attached as Exhibit E is a blank copy of the Registrant’s life insurance application form, which Mr. Morrison attests has been in use since November 2008. I note that the Mark appears multiple times on the back of the document. Accordingly, I am able to conclude that the Registrant used the Mark in association with insurance services based on Mr. Morrison’s statements in his Affidavit along with the display of the Mark in Exhibit E.

## Trust Company Services

[16] With respect to trust services, Mr. Morrison attests that the *Bank Act* prohibits chartered banks from engaging in the provision of trust company services, but allows chartered banks to own trust companies and corporations provincially registered to trade in securities; accordingly, the Registrant wholly owns Canadian Western Trust Company (CWTC) in order to deliver its trust company services.

[17] In support, Mr. Morrison references the brochure provided at Exhibit A, which in addition to advertising banking services as discussed above, also advertises trust company services. In contrast with the use of the Mark in association with the banking services described in the brochure, I note that CWB is not referenced in the two paragraphs relating to trust company services. Furthermore, the front of the brochure does not display the Mark and the brochure's general preamble only references the Registrant's name in full, Canadian Western Bank. Accordingly, on its own, this brochure does not support use of the Mark in association with trust company services.

[18] However, attached as Exhibit H to the Affidavit is a copy of the April 5, 2005 license agreement between the Registrant and CWTC. Mr. Morrison explains that CWB is one of the marks the Registrant licenses to CWTC pursuant to the agreement.

[19] Accordingly, attached as Exhibit I is a screen capture of the "About Us" webpage of CWTC's website, *www.cwt.ca*, which Mr. Morrison attests is a means by which the Registrant, through its licensee CWTC, offers its trust company services to its customers. I note that the Mark appears in the body of the text describing the Registrant's relationship with CWTC, as well as one of a number of trade-marks in the header at the top of the page. Mr. Morrison attests that the "webpage existed in virtually the same form prior to the issuance of the Section 45 Notice", and I find it reasonable to infer that the Exhibit H printout reflects the appearance of the Mark as displayed during the Relevant Period. Accordingly, I find the demonstrated use of the Mark in association with trust company services by CWTC enures to the benefit of the Registrant.

[20] 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.

[21] 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.

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