

IN THE MATTER OF AN OPPOSITION by Commercial Union Assurance Company plc to application No. 555,780 for the trade-mark CU 55 PLAN filed by Canadian Co-operative Credit Society limited

On January 17, 1986, the applicant, Canadian Co-operative Credit Society Limited, filed an application to register the certification mark CU 55 PLAN based upon use in Canada of the certification mark by the licensee of the applicant in association with "the provision of financial services" since December 27, 1985.

The applicant subsequently amended its application to cover "the provision of financial services, namely, services including the provision of special account services, money order services, travellers' cheque services, bill paying services, certified cheque services, safety deposit box services, personalized cheque services, automated teller service, and term deposit services, to persons 55 years of age and older". The applicant disclaimed the right to the exclusive use of the elements 55 and PLAN apart from its trade-mark.

The opponent, Commercial Union Assurance Company plc, filed a statement of opposition on April 27, 1987 in which it alleged that the applicant's trade-mark is not registrable in that the applicant's trade-mark CU 55 PLAN is confusing with the opponent's registered trade-mark CU ASSURANCE, registration No. 194,742. The opponent also alleged that the applicant is not the person entitled to registration of the trade-mark CU 55 PLAN in that the applicant's trade-mark is confusing with the opponent's trade-marks CU ASSURANCE and CU previously used and made known in Canada in association with life and general insurance, investment in stocks, shares, properties, loans and mortgages. Finally, the opponent alleged that the applicant's trade-mark is not distinctive.

The applicant served and filed a counter statement in which it denied the allegations of confusion set forth in the statement of opposition. The applicant also asserted that its certification mark is used only by its licensees in Canada and that the certification mark CU 55 PLAN is used for the purpose of distinguishing and so as to distinguish services that are of the standard defined in its application from services that are not of such a defined standard.

The opponent filed as its evidence the affidavit of Ian H. Dryer who was cross-examined on his affidavit, the transcript of the cross-examination and the undertakings furnished by the opponent subsequent to the cross-examination forming part of the record in this opposition. The applicant filed as its evidence the affidavit of Genny Castiglione.

Both parties filed written arguments and both parties were represented at an oral hearing.

The opponent's first ground of opposition is based on s. 12(1)(d) of the Trade-marks Act, the opponent alleging that there would be a likelihood of confusion between the applicant's trade-mark CU 55 PLAN and its registered trade-mark CU ASSURANCE & Design, registration No. 194,742. In determining whether there would be a reasonable likelihood of confusion between the applicant's certification mark and the opponent's trade-mark as of the date of opposition, the material date in respect of a s. 12(1)(d) ground of opposition, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the applicant's trade-mark and the opponent's certification mark as of the material date.

Both the applicant's certification mark CU 55 PLAN and the opponent's registered trade-mark CU ASSURANCE & Design as applied to the respective services of the parties are weak marks in that each is comprised of elements which themselves add little inherent distinctiveness to the trade-mark and certification mark at issue. In this regard, the initials CU add little inherent distinctiveness to either of the marks and the elements ASSURANCE, 55 and PLAN have been disclaimed by the parties from their respective marks, thus confirming the descriptive nature of these components as applied to the services associated with the trade-mark and certification mark at issue.

No evidence of use of the certification mark by its licensees has been adduced by the applicant and its mark must therefore be considered as not having become known to any extent in Canada as of the date of opposition. The Dryer affidavit does establish that the registered trade-mark CU ASSURANCE & Design had become known in Canada in association with general insurance services. However, there is no evidence to establish that the trade-mark CU ASSURANCE & Design had become known to any extent in Canada in association with any of the other services covered in the opponent's registration. Indeed, the Dryer cross-examination appears to support the conclusion that the opponent may never have used its registered trade-mark CU ASSURANCE & Design in Canada in association with services relating to "investment in stocks, shares, properties, loans and mortgages". Rather, the opponent appears to have offered such services solely to its employees as opposed to the public.

The length of time that the respective marks of the parties have been in use favours the opponent in this opposition.

As for the nature of the respective services of the parties, I consider there to be little similarity between the various financial services associated with the applicant's certification mark and the insurance services covered by the opponent's registration. On the other hand, the opponent's loan and mortgage services are related to the types of financial services as are covered in the applicant's application and could be offered through the same types of financial institutions. As a result, I consider the channels of trade associated with these services to be overlapping.

The applicant argued that the absence of any evidence of use by the opponent of its registered trade-mark in association with the loan and mortgage services is such that these services should be given little consideration in assessing the issue of confusion in respect of the Section 12(1)(d) ground of opposition. While evidence of use might well have resulted in broader protection being accorded to the opponent's registration in respect of mortgage and loan services, I do not consider that absence of such use means that these services should be virtually ignored for the purposes of assessing the issue of confusion. Further, I do not consider that, for the purposes of considering a Section 12(1)(d) ground of opposition, the mortgage and loan services should be considered as ancillary to the insurance services covered in the opponent's registration, there being no limitation restricting the loan and mortgage services in the registration in this manner (see, in this regard, Henkel Kommanditgesellschaft Auf Aktien v. Super Dragon Import Export Inc., 12 C.P.R. (3d) 110).

As to the degree of resemblance between the applicant's certification mark and the opponent's trade-mark, I consider there to be at least some similarity in appearance and sounding between the certification mark CU 55 PLAN and the registered trade-mark CU ASSURANCE & Design when considered as a matter of first impression and imperfect recollection from the point of view of the average user of the respective services associated with the trade-mark and certification mark of the parties although the marks do not appear to suggest similar ideas when applied to the financial services covered by the applicant's certification mark or the opponent's insurance services or its mortgage and loan services.

As a further surrounding circumstance, the opponent relied upon the affidavit of Genny Castiglione which introduces into evidence photocopies of eighteen trade-mark registrations standing in the name of the applicant. However, as no evidence of use of any of the trade-marks has been adduced by the applicant that any of these marks were in use in Canada prior to the material date, I do not consider that any meaningful conclusions can be drawn from the applicant's evidence in respect of the issue of confusion between the applicant's certification mark CU 55 PLAN and the opponent's registered trade-mark CU ASSURANCE & Design.

Apart from there being no evidence of use of any of its registered trade-marks, I would note that six of the applicant's registrations issued subsequent to the material date, the date of filing by the opponent of its statement of opposition (April 27, 1987), and three cover such wares and services as data processing services, computer hardware systems and computer programs and computer output microfilm which are unrelated to the services covered in the applicant's application or the opponent's registration. Of the eight remaining registrations identified in the Castiglione affidavit, the design mark covered by registration No. 218,229 bears no similarity to either of the trade-mark CU ASSURANCE & Design or the certification mark CU 55 PLAN while the registered trade-marks: ICU; ICU & Design; DIVIDEND & Design as applied to the provision of a periodical publication for members of credit unions; and CUE (cancelled under s. 40(1)(b) (now 41(1)(b)) bear little similarity to the trade-marks at issue when considered as a matter of immediate impression and imperfect recollection. At the oral hearing, it was pointed out that the registered trade-mark CU-GUARD was the subject of Section 45 proceedings while the registered trade-marks CU QUARTERLY and CU-CHEK cover respectively a magazine and the provision of a system enabling credit union members to obtain goods, services or cash through use of guaranteed cheques, wares and services which are certainly not directly related to the services covered by the marks at issue. The remaining trade-mark registration referred to in the Castiglione affidavit is registration No. 290,069 for the trade-mark CU & Design which is dominated by the design of a dollar sign.

As a further surrounding circumstance, the applicant pointed to the alleged misuse in Canada of trade-marks including the mark CU by legal entities related to the opponent, such that the average user of the services of the opponent or applicant would be accustomed to seeing such trade-marks associated with other entities than the opponent, thereby limiting the scope of protection which ought to be accorded to the opponent's registered trade-mark CU ASSURANCE & Design. On the other hand, the opponent relied upon the Good Humor case [Good Humor Corp. of America v. Good Humor Food Products Ltd. et al, [1937] 4 D.L.R. 145] in support of its argument that use of the CU trade-marks by the CU Group of Companies constituted use by a single operating organization and therefore was not fatal to the distinctiveness of the CU marks. However, I agree with the following observations of Cattanach, J. in British America Bank Note Co. Ltd. v. Bank of America National Trust and Savings Association et al, 71 C.P.R. (2d) 26, at pg. 38:

I would also note that the opponent's evidence is far from clear, not only as to the extent of use by the opponent of its registered trade-mark, but also as to the extent of possible misuse by related companies of the opponent of other than its registered trade-mark CU ASSURANCE & Design. Accordingly, and while I consider that the opponent's evidence does point to use by third parties of CU trade-marks other than the registered trade-mark CU ASSURANCE & Design, it is difficult to determine whether this evidence outweighs the evidence relating to use of the opponent's registered mark in respect of which the opponent's related companies have been recorded as registered users since May of 1979. In this regard, a number of the exhibits to the Dryer affidavit were for internal use only (exhibits A, B, C, D, G, K, L, M and N) while others are either dated ten or more years prior to the date of opposition or can only be considered as of the date of the Dryer affidavit (exhibits X, Y and Z) which is subsequent to the material date.

Having regard to the above, and bearing in mind that the legal burden is upon the applicant in respect of the issue of confusion, I have concluded that the applicant has failed to discharge the legal burden upon it in this case. In particular, I consider the trade-marks CU 55 PLAN and CU ASSURANCE & Design to be similar in appearance and to a lesser extent sounding, while the loan and mortgage services covered in the opponent's registration are similar in nature to certain of the financial services covered in the applicant's application and are services which might well be rendered through the same types of financial institutions. As a result, the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act.

I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 30th DAY OF APRIL 1991.

G.W.Partington,
Chairman,
Trade Marks Opposition Board

