

TRADUCTION/TRANSLATION

SECTION 45 PROCEEDING
TRADE-MARKS: MONEXCOR AND MONEXCOR & DESIGN
REGISTRATION NOS: TMA 501,595 & TMA 501,613

On August 21, 2003, at the request of Goudreau Gage Dubuc, the Registrar forwarded a notice pursuant to section 45 of the *Trade-marks Act* ("the Act") to Monexcor Inc., the registered owner of the above-referenced trade-mark registrations ("the owner").

The trade-mark MONEXCOR and the trade-mark MONEXCOR & DESIGN (illustrated below) are registered for use in association with the following services:

Automated teller machines services; financial services, namely: electronic fund transfer services via various electronic devices such as point of sales electronic terminals, telephones, automated teller machines, personal computers, electronic cash registers, interactive television or the Internet network; charge, debit and credit card services; consultant services relating to all the above-mentioned services.

[TRADUCTION] Services de guichets automatiques; services financiers, nommément : services de transfert électronique de fonds au moyen de divers dispositifs électroniques aux points de ventes tels que terminaux électroniques, téléphones, guichets automatiques, ordinateurs personnels, caisses enregistreuses électroniques, télévision interactive ou réseau Internet; services de cartes de paiement, de crédit, et de débit; services d'experts en rapport aux services susmentionnés.



Section 45 of the *Trade-marks Act* requires the registered owner to show, with respect to each of the wares or services specified in the registration, whether the trade-mark was in use in Canada at any time during the three-year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of such use since that date. Thus, the relevant period with regard to each of the registered trade-marks in this case is from August 21, 2000, to August 21, 2003.

In response to each of the notices, the affidavit of Carlos Martinez, together with exhibits, was produced. Neither party has filed a written argument. A hearing was not requested in this proceeding.

In his affidavit, Mr. Martinez claims to be a vice-president and director of Monexcor Inc. (hereinafter "Monexcor"). He explains that Monexcor is a subsidiary of the National Bank of Canada and that it is primarily engaged in the installation and management of "white-label" automated teller machines, i.e. machines not affiliated with a financial institution. Customers wishing to install such automated teller machines contact the National Bank of Canada and Monexcor looks after the installation and management of the machines.

Mr. Martinez states that since customers wishing to install such machines contact the National Bank of Canada first, the trade-marks MONEXCOR and MONEXCOR & DESSIN appear solely on the invoices issued to these customers for services rendered by Monexcor, and on

contracts between Monexcor and such customers.

In support of this assertion, Mr. Martinez produced, by way of illustration only and with no claim to exhaustiveness, Exhibit CM-1, a sample of a model contract used by Monexcor and bearing the trade-mark MONEXCOR & DESIGN. He produced Exhibit CM-2, three (3) invoices bearing the trade-mark MONEXCOR & DESIGN for services rendered under an agreement made in a contract similar to the said model contract. The invoices were issued on the following dates:

- (i) May 22, 2001
- (ii) October 23, 2003
- (iii) January 30, 2004

Subsection 4(2) of the Trade-marks Act specifies as follows with respect to use in association with services:

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.

I agree that the evidence concerning "financial services, namely: electronic fund transfer services via various electronic devices such as point of sales electronic terminals, telephones, automated teller machines, personal computers, electronic cash registers, interactive television or the Internet network; charge, debit and credit card services; consultant services relating to all the above-mentioned services" is completely silent and shows no use of the trade-marks MONEXCOR and MONEXCOR & DESIGN by the owner during the relevant period in

association with the aforementioned services. Consequently, I find that these services should be expunged from the registration.

As for "automated teller machines services", I find, based on the evidence, that the owner used the trade-mark MONEXCOR & DESIGN, and that this also constitutes used of the trade-mark MONEXCOR in association with these services during the relevant period.

In this regard, the evidence demonstrates use of the trade-marks in association with the "installation and management of automated teller machines", services which are, in my opinion, covered by the words "automated teller machines services". The owner provided a sample contract that it uses when it makes agreements with its customers. I therefore find that the contract shows the use of the trade-marks in the performance of the services.

The invoice of May 22, 2001, confirms that the services were rendered during the relevant period. Although the invoice itself contains no details regarding "automated teller machines services", Mr. Martinez states that the invoices tendered show amounts claimed by Monexcor for services rendered in accordance with an agreement made under a contract similar to the model contract (CM-1). The trade-mark MONEXCOR & DESIGN, which also consists of the use of the trade-mark "MONEXCOR", appears prominently at the top of the invoice and I agree that the use shown constitutes use as a trade-mark.

As I have concluded that the use of the trade-marks has been shown in association with the following services: "automated teller machines services", only these services shall be maintained (see *John Labatt Ltd. v. Rainier Brewing Co.*, 80 C.P.R. (2d) at 228 (F.C.A.)).

Registration Nos. TMA 501,613 and TMA 501,595 will be amended accordingly in compliance with subsection 45(5) of the *Trade-marks Act*.

DATED AT GATINEAU, QUEBEC, FEBRUARY 9, 2006.

D. Savard
Senior Hearing Officer
Section 45 Division