

IN THE MATTER OF AN OPPOSITION by Desjardins Sécurité Financière,  
Compagnie d'assurance-vie to Application No. 1,096,484 MILLEA filed by  
The Tokyo Marine and Fire Insurance Co., Ltd

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On March 19, 2001, The Tokyo Marine and Fire Insurance Co., Ltd. filed an application to register the trade-mark MILLEA (the "Mark"). The application, based upon proposed use in Canada, claims priority of the corresponding Japanese application filed on December 1, 2000. The statement of services reads as follows:

"Life insurance brokerage; life insurance underwriting; insurance agency services; claims adjustment services in the field of insurance; insurance underwriting services for all types of insurance except for life insurance; insurance premium rate computing; consulting on insurance; providing information on insurance; financial services, namely lending of funds, discount of bills and acceptance of deposits; monetary exchange services; financial liability guarantee and acceptance of bills; securities lending; acquisition or transfer of monetary claims; safe deposit box services for the safekeeping of valuables namely securities and precious metals; currency exchange services; trusteeship of financial futures contracts; trusteeship of investment, securities, monetary claims, personal property, land, rights on land fixtures, surface rights or lease on land; trust company services; agency services for bond subscriptions; letter-of-credit related services, namely, issuing letters of credit for others, advising issuance of letters of credit to beneficiary, confirming letters of credit, paying funds against letters of credit; mortgage brokerage; providing information on finance; financial services namely issue of tokens of value; agencies for collecting gas or electric power utility payments; intermediation for payment of gas or electric power utility charges; intermediation for issuing a credit card; credit card services; trading of securities, securities index futures, securities options and overseas market securities futures; agencies or brokerage for trading of securities, securities index futures, securities options and overseas market securities futures; security brokerage; securities underwriting; providing stock market information; advice made orally, in writing and by any other method based on an investment counsellor contract on securities; brokerage houses for commodity futures trading; management of buildings; leasing or renting of buildings; purchase and sale of buildings; real estate agencies; appraisal or evaluation of buildings or land; land management; leasing of land; purchase and sale of land; providing information on buildings or land; consulting on land and buildings; planning and guidance on effective use of land; antique appraisal; art appraisal; precious stone appraisal; used-car appraisal; company credit investigation; providing information on tax; charitable fund raising; lease of bill/coin calculators; lease of cash dispensers/automatic depositors".

The application was advertised in the Trade-marks Journal of January 8, 2003. The Canadian Intellectual Property Office issued, on May 29, 2003, a notice confirming that Millea Holdings, Inc. had been entered as the owner of the application. Therefore, the term “Applicant” used hereafter shall be understood as a reference to the entity that owned the application at the relevant time.

Desjardins Sécurité financière, Compagnie d’assurance-vie (the “Opponent”) filed a statement of opposition on March 3, 2003. The Applicant filed a counter statement. Both parties elected not to file evidence. Only the Applicant filed a written argument. No oral hearing has been conducted.

For ease of reference, I reproduce the grounds of opposition, as pleaded at paragraph 2 of the statement of opposition. I also reproduce paragraph 3, which is one of the allegations contained in the statement of opposition in support of the pleaded grounds of opposition.

"2. *L’Opposante fonde son opposition sur les motifs de la Loi sur les marques de commerce (la « Loi »):*

a) *En vertu de l’article 38(2)(a) de la Loi, la demande ne satisfait pas aux exigences de l’article 30 de la Loi en ce que la requérante ne pouvait pas déclarer valablement qu’elle était convaincue d’avoir le droit d’employer la marque de commerce **MILLEA** au Canada en liaison avec les services décrits dans la demande eu égard aux motifs ci-après récités;*

b) *En vertu de l’article 38(2)(d) de la Loi, la marque de commerce **MILLEA** n’est pas distinctive au sens de l’article 2 de la Loi et ne distingue pas ou n’est pas adaptée à distinguer véritablement les services de la Requête des services d’autres;*

3. *Plus particulièrement, la demande de la Requête n’est pas distinctive et porte à confusion par rapport aux marques de commerce suivantes de l’Opposante :*

a) *MILLÉNIA, ENREGISTRÉE, 0865126, LMC507883*

b) *MILLÉNIA III, ENREGISTRÉE, 08655022, LMC507875*

c) *FONDS MILLÉNIA III, ENREGISTRÉE, 0865023, LMC507864*

d) *RÉGIME MILLÉRIA III, ENREGISTRÉE, 0865021, LMC507884*"

I note that the Opponent has relied specifically upon s. 38(2)(a) and s. 38(2)(d) as the basis of its grounds of oppositions. Despite identifying its registered trade-marks, the Opponent did not rely upon s. 38(2)(b) nor s. 12(1)(d) of the Act to oppose the application on the ground that the Mark is not registrable. While I am aware of the decision *Sun Squeeze Juices Inc. v. Shenkman* (1990), 34 C.P.R. (3d) 467 (T.M.O.B.) where the omission of referring to a specific section number was found not to be serious as being somewhat technical, I find that the present case is distinguishable. In the *Sun Squeeze* case, the statement of opposition did not identify any sections of the Act whereas in the present case the s. 38(2)(a) and s. 38(2)(d) have been specifically pleaded. Furthermore, the statement of opposition does not contain an allegation that the Mark is not registrable. I come to the conclusion that the grounds of opposition are set forth at paragraph 2 of the statement of opposition and that all subsequent allegations contained in the statement of opposition are in support of the pleaded grounds of opposition. I find, therefore, that the Opponent did not raise a ground of opposition based upon s. 12(1)(d) and that I am precluded from considering it [see *Imperial Developments Ltd. v. Imperial Oil Limited* (1984), 79 C.P.R. (2d) 12 (F.C.T.D.)]. I shall now revert to the grounds of opposition.

The material date for considering the circumstances with respect to the ground of opposition based upon non-compliance with s. 30 is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)]. The Opponent has essentially alleged that the Applicant falsely made the statement required by s. 30(i) in view of the Opponent's alleged prior rights. However, the Opponent has failed to plead that the Applicant was aware of the alleged trade-marks when it filed the application. Thus, the first ground of opposition is unsuccessful. I would add that even if it can be presumed that the Opponent meant to allege that the Applicant was aware of its alleged trade-marks, being aware of any of the Opponent's trade-marks would not necessarily have prevented the Applicant from truthfully making the statement required by Section 30(i).

The material date with respect to the ground of opposition based upon non-distinctiveness has been generally accepted as the date of filing of the statement of opposition [see *Metro-Goldwyn-Mayer*

*Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4<sup>th</sup>) 317 (F.C.T.D.)). To meet its initial evidential burden with respect to this ground of opposition, the Opponent must show that its alleged trade-marks had become known sufficiently to negate the distinctiveness of the Mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.)]. As there is no evidence of any of the Opponent trade-marks having acquired any reputation through use or promotion, the Opponent has not met its initial burden. Thus, this ground of opposition is also unsuccessful.

I would note that had the Opponent pleaded a ground of opposition based upon s. 12(1)(d), it would have been necessary to confirm the existence of the registrations and then consider the surrounding circumstances, including those listed at s. 6(5) of the Act, to decide whether the Applicant had satisfied the legal burden on it to establish, on a balance of probabilities, that there would not be a likelihood of confusion between the trade-marks as of the date of my decision.

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

DATED AT BOUCHERVILLE, QUEBEC, THIS 11<sup>th</sup> DAY OF OCTOBER 2005.

Céline Tremblay  
Member  
Trade-marks Opposition Board