

IN THE MATTER OF AN OPPOSITION
by Central Data Systems Ltd. to
application No. 586,906 for the
trade-mark MAXIMIZER filed by
Paul Revere Life Insurance Company

On June 29, 1987, the applicant, Paul Revere Life Insurance Company, filed an application to register the trade-mark MAXIMIZER based on proposed use in Canada for the following services:

group life insurance namely, employee term life insurance, accidental death and dismemberment, long term and short term disability insurance, health care benefits, including hearing care, vision care, dental care and orthodontic benefits.

The application was advertised for opposition purposes on February 3, 1988.

The opponent, Central Data Systems Ltd., filed a statement of opposition on May 31, 1988, a copy of which was forwarded to the applicant on June 21, 1988. The grounds of opposition include, among others, that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's trade-mark THE MAXIMIZER registered under No. 260,309 for the following services:

(1) financial services, namely the operation of a combination savings/chequing account with a daily interest computation (2) combination savings/chequing account providing varying interest rates depending on the amount of money on deposit.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavits of Christa Grillmair, Donald W. Brown, J. William Sorenson, Pam Wickenheiser and Vicki T. Easingwood. The applicant did not file evidence. Only the opponent filed a written argument and no oral hearing was conducted.

As for the ground of opposition based on Section 12(1)(d) of the Act, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is as of the date of my decision: see the opposition decision in The Conde Nast Publications Inc. v. The Canadian Federation of Independent Grocers (1991), 37 C.P.R. (3d) 538 at 541-542. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The applicant's trade-mark is inherently distinctive. However, it is not a strong mark in view of the fact that it is somewhat suggestive of the applicant's proposed services. THE MAXIMIZER suggests that the applicant's various insurance services will maximize protection for the applicant's customers. There being no evidence of use from the applicant, I must conclude that its mark has not become known at all in Canada.

The opponent's trade-mark is also inherently distinctive although it, too, is not a strong mark. MAXIMIZER for use in association with a bank account suggests that the account holder's returns will be maximized.

As to the extent to which the opponent's mark has become known, it should be noted

that little weight can be given to the Easingwood affidavit since much of it is hearsay. Nevertheless, the remaining affidavits evidence fairly significant use of the opponent's mark in British Columbia and Saskatchewan in association with the registered services by various credit unions that are recorded as registered users of the opponent's registered mark. Thus, I am able to conclude that the opponent's mark has become known to some extent in those two provinces.

The length of time the marks have been in use favors the opponent. The services of the parties are not the same, the opponent's services being essentially banking services and the applicant's services being insurance services. However, the opponent has evidenced a relationship between those services and has shown an overlap in the natures of the parties' trades. The Grillmair, Brown, Sorenson and Wickenheiser affidavits all establish that different credit unions that are registered users of the opponent's mark offer insurance services through affiliated or related companies, often through the same branch locations. Furthermore, these insurance services and THE MAXIMIZER account are sometimes advertised in the same brochures.

The marks at issue are virtually identical. The only difference is the word THE.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. I have also noted that the applicant has filed neither evidence nor argument and has shown little interest in pursuing the registration of its proposed mark. In view of my conclusions above, and particularly in view of the virtual identity between the marks, the potential connection between the trades of the parties and the extent to which the opponent's mark has already become known in British Columbia and Saskatchewan, I find that the applicant has failed to satisfy the onus on it to show that its proposed mark MAXIMIZER is not confusing with the registered mark THE MAXIMIZER. The ground of opposition based on Section 12(1)(d) of the Act is therefore successful and the remaining grounds need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 30th DAY OF November, 1992.

David J. Martin,
Member,
Trade Marks Opposition Board.