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

Citation: 2018 TMOB 139

Date of Decision: 2018-11-15

IN THE MATTER OF A SECTION 45 PROCEEDING

**ENERGI INSURANCE SERVICES,
INC.**

Requesting Party

and

**ECONOMICAL MUTUAL
INSURANCE COMPANY**

Registered Owner

TMA758,885 for ENERGIE

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA758,885 for the trade-mark ENERGIE (the Mark), owned by Economical Mutual Insurance Company.

[2] The Mark is currently registered in association with the services:

(1) Provision of property and casualty insurance.

[3] For the reasons that follow, I conclude that the registration ought to be maintained.

THE PROCEEDINGS

[4] On October 4, 2016, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Economical Mutual Insurance Company (the Owner). The notice was sent at the request of Energi Insurance Services, Inc. (the Requesting Party).

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between October 4, 2013 and October 4, 2016, in association with each of the services specified in the registration. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[6] The relevant definition of use is set out in section 4(2) of the Act as follows:

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.

[7] It is well established that the purpose and scope of section 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 [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270]. While “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at para 3], sufficient facts must nevertheless be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the registered services.

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Lisa Powell, a Vice President of the Owner, sworn May 3, 2017, together with Exhibits A to T.

[9] Only the Owner filed written submissions. An oral hearing was not requested.

THE EVIDENCE

[10] In her affidavit, Ms. Powell attests that the Owner sells some of its insurance products and services to individuals and businesses through independent brokers who access and service such insurance products and services through the Owner's web-based policy administration system called ENERGIE. She attests that property and casualty insurance services provided to broker clients through the Owner's ENERGIE policy administration system include auto insurance, and various types of property insurance. Further to this, she attests that the system is used in the performance of selling property and casualty insurance in Canada and the system prominently displays the Mark on the top right side of each page and/or screen of the system.

[11] In support, Ms. Powell attaches a number of exhibits to her affidavit, including press releases describing and promoting the ENERGIE system; training documents, reference guides, presentations, and videos showing the Mark in ENERGIE system screenshots and elsewhere in the text of the documents; and electronic bulletins and memos sent to independent brokers explaining various aspects of the ENERGIE system during the relevant period.

[12] In addition, Ms. Powell attests that approximately 16,000 independent brokers use the ENERGIE system, and she provides representative invoices showing sales of property and auto insurance during the relevant period which would have been conducted using the ENERGIE system. She states that the Mark was displayed on the ENERGIE system at the time of sale of these policies, and that estimated gross premiums in Canada from the sale of insurance by the Owner during the relevant period totaled more than \$6 billion.

ANALYSIS AND REASONS FOR DECISION

[13] Having reviewed the evidence in its entirety, I am satisfied that the Owner's ENERGIE policy administration system was active in Canada during the relevant period and that the Owner's evidence demonstrates that the Mark was used and displayed in the performance of its services in Canada during the relevant period.

[14] Specifically, the evidence demonstrates that the Mark was clearly displayed on the Owner's ENERGIE policy administration system and supporting training and reference

documents that were used by independent brokers in the course of providing both property and casualty insurance services to end consumers. That the Mark did not come to the attention of the ultimate consumer in this case, but rather to independent brokers, does not preclude a finding of use pursuant to section 4(2) of the Act, as any use of the Mark along the distribution chain is sufficient to show use [see *Philip Morris Inc v Imperial Tobacco Ltd (No 2)* (1987), 17 CPR (3d) 237 at page 241 (FCA)].

[15] Furthermore, in view of Ms. Powell's statement as to the large number of independent brokers who use the ENERGIE system, the invoice evidence demonstrating sales, and the significant estimated gross premium figures provided (a portion of which I accept include services provided through the ENERGIE system), I accept that the services were performed in association with the Mark during the relevant period.

[16] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered services pursuant to sections 4(2) and 45 of the Act.

DISPOSITION

[17] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

AGENTS OF RECORD

Gowling WLG (Canada) LLP

FOR THE REGISTERED OWNER

Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l.

FOR THE REQUESTING PARTY