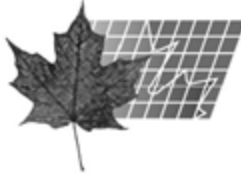


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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 53

Date of Decision: 2020-05-22

IN THE MATTER OF SECTION 45 PROCEEDINGS

Goldman, Sloan, Nash & Haber LLP

Requesting Party

and

Vancouver City Savings Credit Union

Registered Owner

TMA864,599 for RESILIENT

Registrations

CAPITAL

and

TMA864,600 for RESILIENT

CAPITAL PROGRAM

[1] This is a decision involving summary expungement proceedings with respect to registration Nos. TMA864,599 and TMA864,600, for the marks RESILIENT CAPITAL and RESILIENT CAPITAL PROGRAM (the Marks) respectively, owned by Vancouver City Savings Credit Union.

[2] Both of the Marks are registered in association with the following services:

Credit union services; term deposit services; providing equity and debt financing to the social enterprise sector; investment counselling services; investment management services; investment fund management.

[3] For the reasons that follow, I conclude that both registrations ought to be maintained in part.

THE PROCEEDINGS

[4] On November 18, 2016, the Registrar of Trademarks sent notices under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to Vancouver City Savings Credit Union (the Owner). The notices were sent at the request of Goldman, Sloan, Nash & Haber LLP (the Requesting Party).

[5] The notices required the Owner to furnish evidence showing that it had used the Marks in Canada, at any time between November 18, 2013 and November 18, 2016, in association with each of the services specified in the registrations. If the Marks had not been so used, the Owner was required to furnish evidence providing the date(s) when the Marks were 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 trademark 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 has been well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for clearing the register of “deadwood”. As such, the evidentiary threshold that the registered owner must meet is quite low [see *Woods Canada Ltd v Lang Michener et al* (1996), 71 CPR (3d) 477 (FCTD)] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the trademark was used in association with each of the services specified in the registration [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270]. Mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[8] In response to the Registrar's notices, the Owner furnished substantially identical affidavits of Mandeep Sidhu, Associate, Community Investment of the Owner, sworn June 16, 2017, together with Exhibits A to G.

[9] Both parties filed written representations. However, only the Requesting Party requested and made representations at an oral hearing.

THE EVIDENCE

[10] Ms. Sidhu explains that the Owner was founded in 1946 and is Canada's largest community credit union, with over \$21.1 billion in assets, more than 500,000 members, and more than 55 branches throughout British Columbia. She further states that during the relevant period, the Owner used the Marks in association with the registered services in the normal course of trade and as evidenced in her affidavit.

[11] With respect to background, Ms. Sidhu explains that in 2011, the Owner partnered with the Vancouver Foundation to launch the "RESILIENT CAPITAL Program"; a deposit and equity and debt financing program for the social enterprise sector under the Marks. She attests that the program, funded by term deposits that were marketed and sold by the Owner under the Marks (the "RESILIENT CAPITAL Term Deposits"), makes debt and equity investments in social enterprises with initial seed funding from the Owner and the Vancouver Foundation. She provides as Exhibit A to her affidavit, copies of news releases announcing the launch of the RESILIENT CAPITAL Program and the RESILIENT CAPITAL Term Deposits as published on various websites.

[12] Ms. Sidhu states that from June 2011 to July 2015, the RESILIENT CAPITAL Program provided equity and debt financing to 25 different social enterprises investing over \$10 million in the form of loans, equity interest, or lines of credit, and that 15 investments were made by the RESILIENT CAPITAL Program during the relevant period. She provides a list of some of the social enterprises funded by the RESILIENT CAPITAL Program under the Marks, two of which she identifies as specifically having received investments during the relevant period. Further to this, she provides as Exhibit B, articles published by the Owner with respect to two enterprises financed by the RESILIENT CAPITAL Program.

[13] Ms. Sidhu attests that since the inception of the RESILIENT CAPITAL Program, over 20 investors have purchased the RESILIENT CAPITAL Term Deposits used to fund the program, with the Owner raising about \$14 million for the program during the relevant period through sales of the term deposits. She attests that the investors included individuals, not-for-profit organizations, charitable foundations, unions, post-secondary institutions, and companies, naming specific organizations which purchased such term deposits; with term deposit purchases ranging from \$50,000 to \$1 million.

[14] Ms. Sidhu explains that the Owner marketed, under the Marks, the RESILIENT CAPITAL Term Deposits, the RESILIENT CAPITAL Program, and the registered services directly to various organizations and individuals through email, telephone, and in-person discussions. Specifically, she attests that marketing involved the distribution of fact sheets to potential depositors displaying the Marks regarding the RESILIENT CAPITAL Program and the RESILIENT CAPITAL Term Deposits. In support, she provides as Exhibit C, copies of the fact sheets, which clearly display the Marks, as distributed by the Owner between 2013 and 2014.

[15] In addition, Ms. Sidhu attests that during the relevant period the Owner operated a website at *resilientcapital.ca*. She explains that from September 2012 onwards, depositors who purchased RESILIENT CAPITAL term deposits could log in to a secure portion of this website which provides detailed information regarding the social enterprises funded by the RESILIENT CAPITAL Program. She states that the Owner also marketed the registered services, the RESILIENT CAPITAL Program and Term Deposits under the Marks on its website at *www.vancity.com*. She provides as Exhibits D and G to her affidavit, printouts of screenshots taken of the *resilientcapital.ca* and *www.vancity.com* websites as of June 2017, which she states are representative of these websites during all or part of the relevant period. The Marks clearly appear on the webpages, which include information about the RESILIENT CAPITAL Program.

[16] Lastly, Ms. Sidhu states that the Owner also marketed the RESILIENT CAPITAL Program, the RESILIENT CAPITAL Term Deposits, and the registered services under the Marks through various events including the 2012 International Summit of Co-operatives from October 8-11, 2012 in Quebec City, and in a webinar on August 30, 2012. In addition, Ms. Sidhu attests to awards won by the Owner for the RESILIENT CAPITAL PROGRAM, two of which also pre-

date the relevant period (Exhibits E1 and E2 – press release and a copy of award), and the third being the Premier Award evidenced under Exhibit E3, which is a screenshot taken on June 15, 2017 from video posted online on September 15, 2016 by the B.C. Public Service Agency on YouTube describing the RESILIENT CAPITAL Program and the award. Further to the above, the Ms. Sidhu attests that the RESILIENT CAPITAL Program has been mentioned and discussed in articles written and published in print and online by third parties, all prior to and during the relevant period. In support, she provides an array of such published materials under Exhibits F1-F12.

ANALYSIS AND REASONS FOR DECISION

[17] At the outset, I note that in its written submissions, the Owner concedes that the evidence may fall short of showing use of the Mark in association with “investment counselling services; investment management services; and investment fund management.”

[18] As the Owner has not presented any arguments that would convince me otherwise and has conceded that “the evidence may fall short” with respect to these services, I am in agreement with the Requesting Party that the evidence fails to show use of the Marks in association with these services. Furthermore, no special circumstances have been advanced that would excuse the absence of such use; consequently, these services will be deleted from the registrations.

[19] With respect to the remaining services, the Requesting Party concedes that the evidence shows use of the Marks in association with “providing equity and debt financing to the social enterprise sector”. I likewise am satisfied that the Owner has provided sufficient evidence of use of the Marks in association with “providing equity and debt financing to the social enterprise sector”. Additionally, while opting not to focus submissions with respect to “term deposit services”, the Requesting Party simply submits that it is questionable whether use of the Marks has been shown in association with these services. However, I am also satisfied that the Owner has provided sufficient evidence of use of the Marks in association with “term deposit services”. In this regard, the evidence clearly shows that term deposits were marketed under the Marks and used to fund the RESILIENT CAPITAL equity and debt financing program (per Exhibits C, D, and G, and Ms. Sidhu’s statements of fact surrounding investors and sales figures).

[20] Thus, the crux of Requesting the Party's submissions focus on "credit union services". As to what is encompassed by these services, the Requesting Party submits that credit unions are full service financial institutions wherein such services "would extend to banking services such as savings accounts, checking accounts, credit cards, and consumer and commercial loans." The Requesting Party submits that as the evidence only relates to "term deposit services" and "providing equity and debt financing to the social enterprise sector", this is not sufficient to demonstrate use of the Marks with respect to the broader term "credit union services"; a term that also encompasses banking services.

[21] The Owner submits that evidence of the provision of both term deposit services and equity and debt financing services, each of which fall within the ambit of "credit union services", are together sufficient to show evidence of "credit union services". The Owner further submits that it is unreasonable to require the Owner to provide evidence of use of the Marks in association with "banking services", as under the *Bank Act*, SC 1991, c 46, only banks are permitted to carry on the "business of banking" in Canada. In any event, the Owner submits that the press releases, fact sheet and website exhibits, also reference the credit union services of the Owner or identify the Owner by its full name of Vancouver City Savings Credit Union (Exhibits A, B, C, D, E1, F1, and G). As such, the Owner submits, there is a clear connection in the evidence to the use of the Marks in association with "credit union services".

[22] The Requesting Party submits however, that since the Owner has separately listed "term deposit services" and "the provision of equity and debt financing to the social enterprise sector", that these services are intended to be independent from "credit union services", which are broader in scope and extend to banking services. The Requesting Party cites two cases for the proposition that evidence of use with respect to a more specific good is not sufficient to demonstrate use of a trademark with respect to broader defined terms [see *Costello Group Inc v Teh Yor Co*, 2014 TMOB 170, 126 CPR (4th) 155; and *Sharp Kabushiki Kaisha v 88766 Canada Inc*, (1997), 72 CPR (3d) 195 (TMOB)].

[23] I note however, that these cases deal more specifically with goods. Furthermore, services are generally granted a generous or broad interpretation [*Aird & Berlis v Virgin Enterprises Ltd* (2009), 78 CPR (4th) 306 (TMOB)], and include those services which may be considered

“incidental” or “ancillary” [*Kraft Ltd v Registrar of Trade Marks* (1984), 1 CPR (3d) 457 (FCTD)], or involve overlapping terms [*Gowling Lafleur Henderson LLP v Key Publishers Co.*, 2010 TMOB 7, 2010 CarswellNat 579 (TMOB)]. As such, I do not find it necessary for the Owner to provide evidence of other aspects of credit union services that may relate to banking activities. In any event, I agree with the Owner that the evidence clearly supports that such services fall under the umbrella of “credit union services”. In this regard, it is readily apparent from the evidence that the services are being provided by the Owner, who is clearly identified throughout the evidenced advertising materials as a credit union. Consequently, I am satisfied that the Owner has shown evidence of use of the Marks in association with “credit union services” within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[24] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, registration Nos. TMA564,599 and TMA564,600 will be maintained in part, in compliance with the provisions of section 45 of the Act. Specifically, the registrations will be amended to delete the following registered services:

investment counselling services; investment management services; investment fund management.

The amended statements of services will be as follows:

Credit union services; term deposit services; providing equity and debt financing to the social enterprise sector.

Kathryn Barnett
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

APPEARANCES

No one appearing

FOR THE REGISTERED OWNER

John McKeown

FOR THE REQUESTING PARTY

AGENT(S) OF RECORD

McCarthy Tetrault LLP

FOR THE REGISTERED OWNER

Goldman Sloan Nash & Haber LLP

FOR THE REQUESTING PARTY