



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 25

Date of Decision: 2025-02-13

IN THE MATTER OF SECTION 45 PROCEEDINGS

Requesting Party: Fasken Martineau Dumoulin S.E.N.C.R.L., s.r.l.

Registered Owner: Ally Financial Inc.

Registrations: TMA831126 for ALLY AUTO

TMA973778 for ALLY AUTO

INTRODUCTION

[1] At the request of Fasken Martineau Dumoulin S.E.N.C.R.L., s.r.l. (the Requesting Party), the Registrar of Trademarks issued notices under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on October 20, 2023, to Ally Financial Inc. (the Owner), the registered owner of registration Nos. TMA831126 and TMA973778, both for the trademark ALLY AUTO (the Mark).

[2] The Mark is registered in association with the following services in both registrations:

(1) Financing relating to automobiles.

(2) Insurance services, namely, insurance underwriting and claims administration of extended motor vehicle service contracts for the repair and maintenance of motor vehicles.

[3] The notices required the Owner to show whether the Mark was used in Canada in association with the services specified in each registration at any time within the three-year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of use since that date. In these cases, the relevant period for showing use is October 20, 2020 to October 20, 2023.

[4] 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.

[5] With respect to services, the display of a trademark on advertising is sufficient to meet the requirements of section 4(2) of the Act when the trademark owner is offering and prepared to perform those services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[6] In the absence of use, pursuant to section 45(3) of the Act, a registration is liable to be expunged, unless the absence of use is due to special circumstances.

[7] In response to the Registrar's notices, the Owner furnished substantially the same evidence in both proceedings, being the affidavit of Pat Rinaldo, sworn on March 20, 2024 in Detroit, Michigan (the Rinaldo Affidavit).

[8] An oral hearing was not requested and the parties did not submit written representations in either proceeding.

THE OWNER'S EVIDENCE AND ANALYSIS

[9] Mr. Rinaldo is the Chief Information Officer of the Owner [para 1]. He explains that the Owner is a "financial services company that offers banking services, credit and debit card services, consumer and vehicle loans, mortgages and investment advisory services", and that it is one of the "largest financial corporations in the United States" [para 5]. Although the Owner's head office is located in Detroit, Michigan [para 3], Mr. Rinaldo explains that the Owner is an e-services institution, meaning it operates "exclusively in the digital and online realm", offering its services "online, via a downloadable software application, and by telephone" [para 7].

[10] Even though some aspects of the Owner's services are offered only in the United States [para 14], Mr. Rinaldo asserts use of the Mark in association with the offering and provision of the Owner's services, including in Canada, "for many years" [para 6]. In particular, as described below, he explains how the Owner advertised, offered and performed the registered services in association with the Mark in Canada during the relevant period.

Financing services

[11] With respect to services (1), "Financing relating to automobiles", Mr. Rinaldo explains that customers could access the Owner's vehicle financing services through the Owner's ALLY website, *ally.com* [paras 8 and 9]. Mr. Rinaldo confirms that customers can apply for financing through the Owner's website, and can then access and manage their accounts through the ALLY website or the Owner's ALLY AUTO mobile application [paras 12 and 13]. In this respect, Mr. Rinaldo confirms that the Owner's website enjoyed a high volume of internet traffic from Canada during the relevant period [paras 18 and 19]. Examples of the relevant webpages are attached as Exhibits A to D of the Rinaldo Affidavit, with instances of display of the Mark highlighted.

[12] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with services (1) within the meaning of sections 4 and 45 of the Act.

Insurance services

[13] With respect to the “underwriting” and “claims administration” services at services (2), Mr. Rinaldo describes how the Owner offers such services directly to individual customers and through car dealerships [para 15]. He confirms that the Owner’s insurance services are advertised and provided online via the ALLY website, and he describes how customers in Canada can manage their plans and make transactions through the ALLY website and the ALLY AUTO mobile application [paras 16 and 17, Exhibits C to E].

[14] Again, Mr. Rinaldo confirms that the ALLY website received significant internet traffic from Canada during the relevant period, and that the website displayed the Mark in association with the Owner’s insurance services [paras 18 and 19, Exhibits C and D].

[15] Accordingly, I am satisfied that the Owner has also demonstrated use of the Mark in association with all of services (2) within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[16] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, and in compliance with the provisions of section 45 of the Act, the registrations will be maintained.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing requested

AGENTS OF RECORD

For the Requesting Party: Fasken Martineau Dumoulin LLP

For the Registered Owner: Jensen IP