



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2025 TMOB 28

**Date of Decision:** 2025-02-13

## **IN THE MATTER OF A SECTION 45 PROCEEDING**

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

**Registered Owner:** Ally Financial Inc.

**Registration:** TMA1016476 for ALLY

## **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 a notice 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 No. TMA1016476 for the trademark ALLY (the Mark).

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

- 35 (1) Auctions on the global computer network for used motor land vehicles
- 36 (2) Banking services, financing of loans, financing of purchases; financing of land motor vehicles
- 36 (3) Mortgage banking services; mortgage lending services; debit card services

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

[3] The notice required the Owner to show whether the Mark was used in Canada in association with the services specified in the 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 this case, 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, the registration is liable to be expunged, unless the absence of use is due to special circumstances.

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Pat Rinaldo, sworn on March 20, 2024 in Detroit, Michigan (the Rinaldo Affidavit).

[8] An oral hearing was not requested and neither party submitted written representations.

## **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 car finance companies in the United States", which also offers "vehicle auction services" [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 9].

[10] Even though some aspects of the Owner's services are offered only in the United States [paras 13 and 21], Mr. Rinaldo asserts use of its ALLY trademarks in association with the offering and provision of the Owner's services 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.

### ***Auctions for used motor land vehicles***

[11] With respect to "auctions ... for used motor land vehicles" at services (1), Mr. Rinaldo describes how car dealerships can use the Owner's online SmartAuction platform to list, view and make offers to purchase vehicles [para 27, Exhibit I]. He evidences the Owner's attendance at two trade conferences in Canada during the relevant period, where the Owner's SmartAuction services were promoted and material was distributed to promote the Owner's "ALLY vehicle auction services" [paras 31 to 34, Exhibits J to L]. Along with the SmartAuction branding, I note that the exhibited promotional materials clearly display the Mark. Furthermore, Mr.

Rinaldo confirms that, by the end of the relevant period, the Owner had approved 64 Canadian-based vehicle dealerships for access to the SmartAuction platform and services [para 34].

[12] In the absence of written representations, although the Rinaldo Affidavit does not evidence any particular “auctions” *per se*, at a minimum, I accept that the evidence shows that, during the relevant period, the Owner advertised the registered “auctions” services in association with the Mark, and was offering and able to perform such services in Canada [per *Wenward*, above].

[13] Accordingly, 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.

#### ***Banking and financing services***

[14] With respect to services (2), Mr. Rinaldo details various ways its customers could access the Owner’s banking and financing services from Canada during the relevant period [para 15]. For example, customers located in Canada could access their accounts and the Owner’s services generally through the ALLY website, *ally.com*, which prominently displayed the Mark [para 15, Exhibit D]. 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].

[15] With respect to “financing of land motor vehicles” in particular, Mr. Rinaldo explains that the Owner has a division that specializes in “financing, insurance, and extended warranty plans for new and used vehicles”, and that information on such financing services are available on the ALLY website [para 20, Exhibit F]. He confirms that customers can apply for financing through the Owner’s website, and can then manage the loan or lease

account, including the making of payments, through the website or the Owner's ALLY mobile application [para 21]. Again, Mr. Rinaldo confirms that significant numbers of customers accessed their ALLY vehicle loan or lease accounts through the ALLY website using Canadian IP addresses during the relevant period [para 22].

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

***Mortgage and debit card services***

[17] The evidence with respect to "Mortgage banking services" and "mortgage lending services" in services (3) is similar to that of services (2), discussed above. In this respect, the Mr. Rinaldo explains that the ALLY website provides information regarding the Owner's mortgage services, and that, during the relevant period, customers in Canada were able to access and manage their mortgage accounts by various means, including through the website, which prominently displays the Mark throughout [para 15, Exhibit D].

[18] In view of the evidence as a whole, I accept that, at a minimum, the Owner advertised the registered "mortgage" services in association with the Mark, and was offering and able to perform such services in Canada.

[19] With respect to "debit card services", Mr. Rinaldo explains that the Owner's bank account customers were issued debit cards that could be used to withdraw money from automatic teller machines or to make purchases in person and online, including in Canada [para 14]. Attached as Exhibit C is a photograph of a debit card bearing the Mark, that Mr. Rinaldo states is representative of debit cards issued to the Owner's customers during the relevant period [para 14].

[20] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with all of services (3) within the meaning of sections 4 and 45 of the Act.

***Insurance services***

[21] With respect to the “underwriting” and “claims administration” services at services (4), Mr. Rinaldo describes how the Owner offers such services directly to individual customers and through car dealerships, detailing an example of one of the protection plans the Owner offers [para 23]. He confirms that the Owner’s insurance services are advertised and provided online via the ALLY website, and how customers in Canada can manage their claims, coverage and other aspects of their policies [paras 24 to 26, Exhibits G and H].

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

**DISPOSITION**

[23] 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 registration 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