



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 108

Date of Decision: 2025-05-13

IN THE MATTER OF AN OPPOSITION

Opponents: TELUS Corporation and TELUS Health Solutions Inc.

Applicant: DXC Technology Company

Application: 2024032 for DXC ASSURE

INTRODUCTION

[1] TELUS Corporation and TELUS Health Solutions Inc. (the Opponents) oppose registration of the trademark DXC ASSURE (the Mark), which is the subject of application No. 2024032 by DXC Technology Company (the Applicant).

[2] Per an amended application made of record on March 27, 2025, the Mark is applied for in association with the following goods (in Nice Class 9) and services (in Nice Class 42):

- 9 Downloadable software for administration of insurance products, reinsurance products, and annuity products; all the aforementioned excluding software pertaining to pharmaceutical, dental or any other health-related benefits; downloadable software for detection and handling of insurance claims fraud, for analyzing insurance data, and for insurance underwriting; all the aforementioned excluding software pertaining to pharmaceutical, dental or any other health-related benefits;

downloadable software for developing insurance products, reinsurance products, and annuity products; all the aforementioned excluding software pertaining to pharmaceutical, dental or any other health-related benefits; downloadable software for creating insurance product rates and commissions; all the aforementioned excluding software pertaining to pharmaceutical, dental or any other health-related benefits; downloadable software for insurance billing, claims processing, and claims management; all the aforementioned excluding software pertaining to pharmaceutical, dental or any other health-related benefits; downloadable software for insurance customer engagement; and for marketing insurance products and annuity products; all the aforementioned excluding software pertaining to pharmaceutical, dental or any other health-related benefits.

- 42 (1) Software as a service (SaaS) services featuring software for administration of insurance products, reinsurance products, and annuity products; all the aforementioned excluding software as a service (SaaS) services pertaining to pharmaceutical, dental or any other health-related benefits; software as a service (SaaS) services featuring software for detection and handling of insurance claims fraud, for analyzing insurance data, and for insurance underwriting; all the aforementioned excluding software as a service (SaaS) services pertaining to pharmaceutical, dental or any other health-related benefits; software as a service (SaaS) services featuring software for developing insurance products, reinsurance products, and annuity products; all the aforementioned excluding software as a service (SaaS) services pertaining to pharmaceutical, dental or any other health-related benefits; software as a service (SaaS) services featuring software for creating insurance product rates and commissions; all the aforementioned excluding software as a service (SaaS) services pertaining to pharmaceutical, dental or any other health-related benefits; software as a service (SaaS) services featuring software for insurance billing, claims processing, and claims management; all the aforementioned excluding software as a service (SaaS) services pertaining to pharmaceutical, dental or any other health-related benefits; software as a service (SaaS) services featuring software for insurance customer engagement; and for marketing insurance products and annuity products; all the aforementioned excluding software as a service (SaaS) services pertaining to pharmaceutical, dental or any other health-related benefits; implementation of insurance software; outsource service provider in the field of information technology consulting and software consulting in the fields of insurance; software development in the fields of insurance products; installation, configuration, integration, testing, and maintenance of software in the field of insurance; all the aforementioned excluding software as a service (SaaS) services pertaining to pharmaceutical, dental or any other health-related benefits.

[3] The opposition is primarily based on an allegation that that the Mark is confusing with the Opponents' ASSURE-formative trademarks, previously registered and used in Canada in association with similar good and services.

THE RECORD

[4] The application for the Mark was filed on March 10, 2020, based on International Registration No. 1496813. The application was advertised for opposition purposes on September 8, 2021.

[5] On March 8, 2022, the Opponents opposed the application by filing a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition are based on non-conformity with the requirement that the application include a statement in ordinary commercial terms of the specific goods or services, pursuant to sections 38(2)(a) and 30(2)(a) of the Act; non-registrability pursuant to sections 38(2)(b) and 12(1)(d) of the Act; non-entitlement to registration pursuant to sections 38(2)(c) and 16 of the Act; non-distinctiveness pursuant to sections 38(2)(d) and 2 of the Act; that the Applicant was not using and did not propose to use the Mark, pursuant to section 38(2)(e) of the Act; and non-entitlement to use, pursuant to section 38(2)(f) of the Act.

[6] The Applicant filed a counter statement, denying each of the grounds of opposition.

[7] In support of their opposition, the Opponents filed the affidavit of Lucie Falcioni, sworn June 27, 2023 in Toronto (the Falcioni Affidavit).

[8] In support of its application, the Applicant filed the affidavit of Isabella Vigliotti, sworn April 26, 2024 in Ottawa (the Vigliotti Affidavit).

[9] Neither deponent was cross-examined.

[10] Only the Opponents submitted written representations, but both parties were represented at an oral hearing, held on March 6, 2025.


[11] The day before and just prior to the hearing, the Applicant submitted correspondence relating to an amended application, to add language limiting the scope of the applied-for goods and services, e.g., "...all the aforementioned excluding software

pertaining to pharmaceutical, dental or any other health-related benefits” and similar limitations. As noted above, the amended application was subsequently made of record.

OVERVIEW OF THE OPPONENTS’ EVIDENCE

[12] TELUS Health Solutions Inc. (Telus Health), is the owner of 19 ASSURE-formative trademark registrations, including the following, which are exemplary or most relevant to the analysis of the grounds below:

Registration	Goods/Services
<p>ASSURE TMA704028</p> <p>Reg’n Date: 2008-01-08</p>	<p><i>Goods</i> Class 9: (1) Computer software package designed to manage, adjudicate and transport, via the internet or private networks, health claims; computer software package designed to allow users to perform, via the internet or private networks, electronic health records transport and database repositories; computer software package designed to allow users to perform, via the internet or private networks, online payment, online tax filing and payment, online remittance payment and debit and credit card payment; electronic data interchange computer software package for supply chain management.</p> <p><i>Services</i> Class 35: (1) The provision of services designed to allow users to perform, via the internet or private networks, online tax filing; advice to clients to develop or enhance solutions in the field of health and finance to support health claims transport, adjudication and management, via the internet or private networks; advice to clients to develop or enhance solutions to allow users to perform, via the internet or private networks, electronic health records transport and database repositories. Class 36: (2) The provision of services designed to manage, adjudicate and transport, via the internet or private networks, health claims; the provision of services designed to allow users to perform, via the internet or private networks, online payment, online tax payment, online remittance payment and debit and credit card payment. Class 38: (3) The provision of services designed to allow users to perform, via the internet or private networks, electronic health records transport and database repositories; electronic data interchange services for supply chain management; advice to clients to develop or enhance electronic data interchange solutions in relation to supply chain management. Class 42: (4) Design of solutions to respond to specific needs of clients in the field of health and finance to support health claims transport, adjudication and management via the internet or private networks; design of solutions to respond to specific needs of clients to allow users to perform, via the internet or private networks, electronic health records transport and database repositories; design of solutions to respond to specific needs of clients to allow users to perform, via the internet or private networks, online payment, online tax filing and payment, online remittance payment and debit and credit card payment; design of electronic data interchange solutions to respond to</p>

	specific needs of clients in relation to supply chain management; advice to clients to develop or enhance solutions to allow users to perform, via the internet or private networks, online payment, online tax filing and payment, online remittance payment and debit and credit card payment.
 TMA529061 Reg'n Date: 2000-06-13	<i>Services</i> (1) Provision of electronic adjudication of group health insurance claims, the provision of electronic data interchange services for health care providers including the dental profession, the pharmaceutical profession and other professions providing health care services; the reimbursement of group health insurance claims generally; the design and implementation of health rehabilitation programs; and the formulation and development of pharmaceutical formularies and the provision of statistical studies and reviews relating to pharmaceutical usage.
ASSURE CARD TMA372789 Reg'n Date: 1990-08-31	<i>Goods</i> Class 16: (1) Identification cards. <i>Services</i> Class 42: (1) Operation of a point-of-service network and system for health care claims processing.
ASSURE PAY TMA699677 Reg'n Date: 2007-10-29	<i>Goods</i> Class 9: (1) Computer software package designed to allow users to perform, via the internet or private networks, online payment, online tax filing and payment, online remittance payment and debit and credit card payment. <i>Services</i> Class 35: (1) The provision of services designed to allow users to perform, via the internet or private networks, online tax filing; design of solutions to respond to specific needs of clients in relation to online tax filing via the internet or private networks; advice to clients to develop or enhance solutions in relation to online tax filing via the internet or private networks. Class 36: (2) The provision of services designed to allow users to perform, via the internet or private networks, online payment, online tax payment, online remittance payment and debit and credit card payment; design of solutions to respond to specific needs of clients in relation to online payment, online tax payment, online remittance payment and debit and credit card payment, via the internet or private networks; advice to clients to develop or enhance solutions in relation to online payment, online tax payment, online remittance payment and debit and credit card payment, via the internet or private networks.
HEALTH ASSURE TMA535617	<i>Services</i> (1) On-line electronic service of providing verifications relating to prescriptions for drugs to determine drug usage safety.

Reg'n Date: 2000-10-24	
<div data-bbox="207 331 358 401" data-label="Image"> </div> <p data-bbox="203 436 380 468">TMA538384</p> <p data-bbox="203 506 375 575">Reg'n Date: 2000-12-06</p>	<p data-bbox="444 331 1560 800">(1) Computer software for electronic data interchange, namely: computer programs which permit the electronic transfer of data from one computer to another; computer software for electronic messaging services; workflow software products, namely: computer programs designed to permit the storage of documents on a central computer in a local network of computers which permits each computer on the network to retrieve the document onto the monitor of a computer on the local area network to be reviewed by the computer operator and then to be forwarded onto another computer operator electronically; document image management products and associated documentation, namely: computer programs which permits the recording of a document electronically by the optical scanning of the document that is the recording of it pictorially onto an electronic medium and the documentation required to operate this pictorial recording; electronic communications network managing, namely: computer programs for the management of electronic communications in a computer network.</p> <p data-bbox="444 835 558 863">Services</p> <p data-bbox="444 869 1560 1904">(1) Electronic point of sale services and terminal programming and maintenance services, namely: credit card authorization, draft capture, daily deposit (all credit cards), daily deposit reporting, cheque authorization, inventory control, private label credit card account processing, private label credit card payment processing, daily sales reporting, debit transactions and value added reporting, namely: the embellishment of simple statistical reports with additional information of an interpretative or analytical nature; network management, namely: the provision of management services to supervise, review, direct and coordinate the operations of an electronic communication network, and network analysis; electronic cash register interface, namely the provision of the computer programs, codes and electrical wire circuits to permit messages to be transmitted from a cash register to other terminals; personal computer interface, namely: the provision of the computer programs, codes and electrical wire circuits to permit messages to be transmitted from one computer to another computer; host-to-host connections, namely: the provision of the computer programs, codes and electrical wire circuits to permit the transfer of information from the data held in one computer directly to another computer without requiring manual re-entry of the data; terminal deployment, namely: the placement of computer terminals in various locations; help desk services, namely: the provision of advice and assistance in the use of the computer systems; computer based communications, namely: the electronic dispatch and receipt of information automatically between computers, electronic data interchange network services, namely: services related to the electronic transmission of data from one computer to another computer through the facilities of a central computer which receives the data electronically from the sending computer and redirects it out to the computer to which the data is intended for; telecommunication services, namely: the electronic transmission of data and information between trading partners, electronic message services, electronic data interchange translation services, namely: the translation of data sent by one computer to another computer which data requires to be changed so that the receiving computer can accept the data in a form compatible with the operating system of the receiving computer; electronic data interchange network interconnection services, electronic data communication, education and seminar services, namely: the provision of</p>

	educational services and seminar services relating to the electronic communication of data; electronic data storage and retrieval services and remote database access services; business consulting services, namely: services rendered to advise businesses and recommend solutions to problems; computer-related business management services, file storage and retrieval services, document imaging, storing, reproducing and management services, paper flow and workflow systems management and consulting services, research and development of computer-related or assisted business management systems and problem solutions services, namely: development of computer related or assisted business management systems and engineering services required for the implementation thereof and necessary training in the use of such services.
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Falcioni Affidavit

[13] Ms. Falcioni is a Vice-President with Telus Health [para 1]. She explains that Telus Health is a wholly-owned subsidiary of the other Opponent, TELUS Corporation, and that Telus Health is a “health technology company, providing technology solutions to better serve patients and enhance the overall experience of health care providers, insurers and third party administrators/payors and employers”, offering goods and services that include “software, systems and services in the fields of electronic health records, electronic medical records, telehealth, pharmacy management, consumer health solutions and health benefits management” [para 6].

[14] Ms. Falcioni asserts that, since at least as early as 1988, Telus Health and its predecessors have advertised, sold and provided “insurance claims management, transportation and adjudication software, systems and services” (the Opponents’ Goods and Services) in association with the trademark ASSURE and a related family of trademarks that incorporate the element ASSURE (collectively, the ASSURE Brand) [para 12].

[15] Generally, the Falcioni Affidavit evidences the following:

- A general overview of the industry of health benefits claims management and insurance adjudication in Canada [paras 6 to 11].
- Particulars for the 19 referenced trademark registrations that form part of the Opponents’ ASSURE Brand, including TMA704028 for the word mark ASSURE [para 13, Exhibit A].

- History of the ownership of the ASSURE Brand since 1988 [paras 14 to 21].
- A description of the Opponents' Goods and Services offered in association with the ASSURE Brand since 1988 [paras 22 to 30].
- Details regarding the ASSURE cards issued to persons who are covered under a medical benefits plan that have claims adjudicated by Telus Health [paras 31 to 37].
- Details regarding Telus Health's ASSURE-branded practice management software, used by pharmacies to facilitate the process of insurance claims [paras 38 to 49, Exhibits E to I].
- Details regarding receipts issued to pharmacy customers and other insured persons in relation to the Opponents' Goods and Services and the ASSURE Brand [paras 50 to 57, Exhibit K].
- A PowerPoint presentation relating to the online portal that Telus Health offers to service providers, "where they can access reconciliation statements from certain insurance providers whose claims are adjudicated" by Telus Health [para 58, Exhibit L].
- Details regarding Telus Health invoices issued to insurance providers [paras 59 to 63, Exhibits M and N]
- Reference documents (i.e. manuals and user guides) that Telus Health provides to insurance providers regarding the Opponents' Goods and Services offered in association with the ASSURE Brand, such as representative copies of the "TELUS Health ASSURE Claims Pharmacy Manual" from 2011, 2021 and 2023 [paras 64 to 72, Exhibits O to U].
- Notices to service providers, that inform them of changes to the Opponents' Goods and Services offered in association with the ASSURE Brand [paras 73 to 77, Exhibits V to Y].

- An analytics report regarding web traffic in 2022 to the Opponents' "Documentation Centre" at the website *telus.com*, where Telus Health makes various documentation regarding its ASSURE-branded goods and services available [para 78, Exhibit Z].
- Representative printouts from *archive.org* of the public-facing websites of Telus Health and its predecessors-in-title from 2002 to 2012, together with a table correlating each exhibited printout and a short description of particular goods and services offered in association with the ASSURE Brand [para 79, Exhibits AA to ZZ and AAA to KKK]. Ms. Falcioni attests that the printouts "accurately reflect the contents of the websites as published ... and accurately describe one or more of the ASSURE Goods and Services as at each date indicated" [para 79]. For example, Exhibit HH is a printout showing the "Assure Claims Dental" page from the website *emergis.com* for December 12, 2007, and Exhibit OO is a printout showing the "Assure Pay" page from the same website and date. The latter provides details regarding "Assure Pay Tax Filing", "Assure Pay Remittance Processing" and "Assure Pay Debit and Credit Card Processing".

[16] I note that Ms. Falcioni makes no direct statements regarding the Applicant's business or the applied-for goods and services.

OVERVIEW OF THE APPLICANT'S EVIDENCE

Vigliotti Affidavit

[17] Ms. Vigliotti is a paralegal employed by the Applicant's agent of record [para 1]. In April 2024, Ms. Vigliotti ordered and conducted various online searches using specialized software, and attaches printouts of those search reports to her affidavit, as follows:

- A Canada Common Law and Canada Registry search report for the word ASSURE with the terms "healthcare; insurance; investments; pharmaceutical, medical, dental and healthcare benefits" [Paras 4 and 5, Exhibits B and C].

- Nuans online corporate and trademark search for the word ASSURE [Para 6, Exhibits D and E].
- Active trademark registrations and applications before the Canadian Trademark Office regarding the trademark element ASSURE in Nice classes 35 and 36 [para 8, Exhibits H and I].
- Active trademark registrations and applications before the Canadian Trademark Office regarding the trademark element ASSURANCE in Nice classes 35 and 36 [para 9, Exhibits J and K].
- Search results using the Google internet search engine for “assure health insurance” [para 10, Exhibit L].
- Search results using the Google internet search engine for “ASSURANCE HEALTH INSURANCE” [para 11, Exhibit M].

[18] I note that Ms. Vigliotti makes no substantive statements regarding the relevance or significance of any of these search results.

EVIDENTIAL BURDEN AND LEGAL ONUS

[19] In accordance with the usual rules of evidence, there is an evidential burden on the Opponents to prove the facts inherent in their allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)]. The presence of an evidential burden on the Opponents with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

[20] For those allegations for which the Opponents have met their evidential burden, the legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. The presence of a legal onus on the Applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against it.

NON-CONFORMITY WITH SECTION 30(2) – SECTION 38(2)(A) GROUND

[21] Pursuant to sections 38(2)(a) and 30(2)(a) of the Act, the Opponents plead that the application does not include a statement in ordinary commercial terms of the specific goods or services in association with which the Mark is proposed to be used, adding that “The facts supporting this claim are within the knowledge of the Applicant and will be the subject of further evidence”.

[22] The material date for a ground based on section 38(2)(a) of the Act is the filing date of the application.

[23] However, the pleading is deficient for two reasons. First, the pleading does not identify which of the applied-for goods or services are alleged to not be specified in ordinary commercial terms. Second, an opponent must plead sufficient material facts to enable the applicant to know the case against it and reply. Pleading that the facts “are within the knowledge of the Applicant” is inherently vague and improperly leaves one to speculate what material facts (e.g., the particular applied-for goods or services) are being alluded to by the Opponent.

[24] Furthermore, nothing in the evidence cures these deficiencies. In this respect, I note that the Opponents’ evidence does not appear to address this ground, that the Opponents’ written representations regarding this ground [paras 31 to 47] do not reference the evidence, and that the Opponents made no submissions regarding this ground at the hearing.

[25] Accordingly, this ground of opposition is rejected.

NON-REGISTRABILITY – SECTION 12(1)(D) GROUND

[26] Pursuant to sections 38(2)(b) and 12(1)(d) of the Act, the Opponents plead that the Mark is not registrable since it is confusing, within the meaning of section 6(2) of the Act, with the Opponents’ trademark registrations ASSURE, ASSURE CLAIMS, ASSURE PAY, ASSURE CARD and the other trademarks listed in Schedule B of the statement of opposition (the Opponents’ Registered Trademarks).

[27] The material date for a ground of opposition based on sections 38(2)(b) and 12(1)(d) of the Act is the date of this decision.

[28] For purposes of this analysis, I consider it sufficient to focus on Telus Health's registration No. TMA704028 for the word mark ASSURE, as it constitutes the Opponents' strongest case under this ground.

Test for Confusion

[29] The test to determine the issue of confusion is set out in section 6(2) of the Act, which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[30] The test to be applied is a matter of first impression in the mind of a casual consumer "somewhat in a hurry" who sees the Mark in association with the applied-for goods or services at a time when they have no more than an imperfect recollection of the Opponents' trademark and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[31] In making such an assessment, all the relevant surrounding circumstances must be taken into consideration, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods, services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[32] The criteria or factors in section 6(5) of the Act are not exhaustive and different weight will be given to each one in a context-specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54]. In *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, the Supreme Court of Canada stated that section 6(5)(e), the resemblance

between the trademarks, will often have the greatest effect on the confusion analysis [at para 49] and that, while the first word in the trademark may be the most important in some cases, the preferable approach is to consider whether there is an aspect of the trademark that is particularly “striking or unique” [at para 64].

Degree of Resemblance

[33] In its written representations, the Opponents note that the one element of its trademark, ASSURE, is identical to the word ASSURE in the Mark [para 70]. The Opponents further note that the Mark is similar in configuration to Telus Health’s registered trademark SNS ASSURE & DESIGN (TMA538384), i.e., a three-character string that is not a common English word, followed by the word ASSURE [para 70].

[34] In addition to the visual similarities, the Opponents submit that there is a high degree of resemblance in idea suggested given the common ASSURE element, namely, “to make sure or certain, to give confidence to” [para 71].

[35] At the hearing, the Applicant emphasized that the DXC element distinguished the Mark from the Opponents’ ASSURE Brand of trademarks, submitting that the Opponents do not and should not have a monopoly on the word ASSURE in the field of insurance-related goods and services. The distinctiveness of the parties’ trademarks and related surrounding circumstances will be addressed below.

[36] For this factor, given the common ASSURE element, I agree with the Opponents that there is a high degree of resemblance between the parties’ trademarks in appearance, in sound and in the ideas suggested.

[37] Accordingly, this factor favours the Opponents.

Inherent distinctiveness and extent known

[38] In its written representations, the Opponents submit that, notwithstanding that the term ASSURE has suggestive meaning in the insurance field generally, the term is inherently distinctive with respect to the Opponents’ Goods and Services, being specialized software for insurance claims and related services [para 72]. In any event,

the Opponents rely on its ASSURE Brand having significant acquired distinctiveness in Canada by virtue of the longstanding and extensive use and promotion of the brand for over 30 years, as reflected in the evidence [paras 72 to 75]. It further submits that the Applicant's purported state of the register evidence is not sufficient to establish that the term ASSURE is common in the Canadian marketplace for the relevant software-related goods and services in particular [para 76].

[39] With respect to the applied-for Mark, there is no evidence of use or the extent to which it has become known in Canada. In its hearing representations, the Applicant submitted that the DXC element of the Mark is inherently distinctive, whereas ASSURE is a dictionary word which is commonly used in the insurance industry.

[40] However, given the extensive evidence of use of the Opponents' ASSURE trademark and the extent to which it has become known in Canada, overall, this factor favours the Opponents.

Length of time the trademarks have been in use

[41] In this case, there is no evidence of use of the Mark, whereas the Falcioni Affidavit shows use of the ASSURE trademark in association with the Opponents' Goods and Services for over 30 years, since 1988.

[42] Accordingly, this factor strongly favours the Opponents.

Nature of the goods, services, or business; Nature of the trade

[43] At the hearing, the Applicant noted that it did not take issue with the Opponents' evidence that the ASSURE trademark "has been widely used by the Opponent and its predecessors", but it argued that such use was limited to "the specific area of health insurance". As such, it submitted that the added exclusionary language in the amendment statement of goods and services should be enough to remove the Applicant's "area of use" away from the Opponents' area.

[44] In its written representations, the Opponents submit that the Applicant's applied-for goods and services are articulated in a broad enough manner that there is potential

for direct overlap with many of the goods and services set out in the Opponents' registrations [para 97]. The Opponents submit that, even if the Applicant's applied-for goods and services are "construed narrowly so as to avoid overlap, the Applicant's goods and services are highly similar to those of TELUS Health and fall within the same categories of goods and services (i.e., software and related services in the field of insurance)" [para 98].

[45] As such, at the hearing, the Opponents submitted that the Applicant's "last-minute" amendments to the applied-for goods and services to add exclusionary language (e.g., "all the aforementioned excluding software pertaining to pharmaceutical, dental or any other health-related benefits") does not impact the potential likelihood for confusion. Notwithstanding the exclusionary language, the applied-for goods and services still relate to software directed at the insurance industry (e.g., "Downloadable software for administration of insurance products, reinsurance products, and annuity products"). Furthermore, the Opponents note that the ASSURE Brand is not limited to the health insurance industry, directing attention in particular to the evidence regarding the ASSURE PAY trademark used in association with various financial services [Falcioni Affidavit at Exhibit OO].

[46] Indeed, while the amendments to the statement of goods and services were considered acceptable and made of record for purposes of section 30(2) of the Act and section 35 of the *Trademarks Regulations*, I agree with the Opponents that there remains a high degree of overlap and potential for overlap in the nature of the goods, services and businesses of the parties.

[47] I further agree with the Opponents that, at a minimum, there is potential for the parties to operate in the same channels of trade, in particular given the broad scope and variety of the Opponents' customers and users of its ASSURE-branded goods and services (e.g., insurance companies that also provide life insurance products in addition to health and dental-related products).

[48] Accordingly, these factors favour the Opponents.

Additional surrounding circumstance – family of trademarks

[49] In its written representations, the Opponents submit that the Falcioni Affidavit shows use of a family of trademarks, being the evidenced use of the various trademarks that constitute the ASSURE Brand of trademarks [paras 103 to 107]. Accordingly, the Opponents further submit that “upon seeing [the Mark] it would be natural for a consumer to conclude that the Applicant’s goods and services are associated with TELUS Health’s ASSURE Brand and ASSURE Goods and Services, or at least, that [the Applicant has] a partnership or licensing agreement with the Opponents, which is not the case” [para 107]. Indeed, at the hearing, attention was directed to the evidence in respect of the aforementioned ASSURE PAY trademark as an example of the Opponents’ brand not necessarily being limited to the field of health insurance or software thereof.

[50] Accordingly, I agree with the Opponents that this is an additional surrounding circumstance in their favour.

Additional surrounding circumstance - state of the marketplace

[51] At the hearing, the Applicant attempted to argue that the Vigliotti Affidavit demonstrated that the terms ASSURANCE and ASSURE are common to the insurance industry.

[52] However, setting aside the hearsay issues regarding some of the content of the affidavit (e.g., the Exhibit L and M Google searches), I first note that, as the trademarks at issue do not include the term ASSURANCE, I do not consider the evidence or submissions in this respect to be particularly relevant in this case.

[53] In any event, at the hearing and in their written representations [paras 76 to 83] the Opponents appropriately dissected the Applicant’s state of the register evidence (and the Applicant’s evidence generally) for the proposition that, given the small (if any) number of relevant search results, “an inference of common use of the term ASSURE cannot be drawn” [para 81]. In particular, the Opponents note that the evidenced search results “did not reveal widespread use of the term ASSURE in association with goods or

services similar to those of TELUS Health, namely insurance-related software” [para 83].

[54] Indeed, I agree with the Opponents that no meaningful inference regarding the state of the marketplace can be made from the Applicant’s state of the register evidence or the Vigliotti Affidavit more generally.

[55] As such, I do not consider the Applicant’s evidence sufficient to make this an additional surrounding circumstance of assistance to the Applicant.

Conclusion

[56] Having considered all of the surrounding circumstances, I find that the Applicant has not met its legal onus to demonstrate, on a balance of probabilities, that there is no reasonable likelihood of confusion between the parties’ trademarks. I reach this conclusion in view of all of the relevant surrounding circumstances favouring the Opponents, including the Opponents’ evidenced family of trademarks.

[57] Accordingly, the non-registrability ground of opposition is successful.

NON-ENTITLEMENT TO REGISTRATION – SECTION 16(1)(A) GROUND

[58] Pursuant to sections 38(2)(c) and 16(1)(a) of the Act, the Opponents plead that the Applicant is not the person entitled to registration of the Mark because at the filing date of the application, and at all relevant times, the Mark was confusing with the Opponents’ Registered Trademarks and the trademarks ASSURE SYSTEM, CARTE ASSURE, and ASSURE CLAIMS CARD (collectively with the Opponents’ Registered Trademarks, the ASSURE Trademarks), which had been previously used in Canada by the Opponents and the Opponents’ predecessors-in-title, in association with, *inter alia*, the goods and services listed in association with the Opponents’ Registered Trademarks.

[59] The Opponents further plead that they had not abandoned any of their ASSURE Trademarks as of the date advertisement of the application for the Mark.

[60] As there is no evidence of use of the Mark, the material date for assessing confusion under this ground is the filing date of the subject application, namely March 10, 2020. In view of the Opponents' evidenced prior use of their ASSURE Brand, and the ASSURE word mark in particular since 1988, the Opponents meet their initial burden.

[61] Notwithstanding the earlier material date, the confusion analysis above does not materially differ under this ground.

[62] As such, having considered all of the surrounding circumstances, I find that the Applicant has not met its legal onus to demonstrate, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and Telus Health's word mark ASSURE. I reach this conclusion in view of all of the relevant surrounding circumstances favouring the Opponents, including the Opponents' evidenced family of trademarks.

[63] Accordingly, the non-entitlement to registration ground of opposition is successful.

REMAINING GROUNDS OF OPPOSITION

[64] As the Opponents are successful with respect to two grounds of opposition, it is not necessary to consider the remaining grounds, including with respect to the various deficiencies in the pleadings for those grounds.

DISPOSITION

[65] Pursuant to section 38(12) of the Act and the authority delegated to me under section 63(3) of the Act, I refuse the application.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2025-03-06

APPEARANCES

For the Opponents: Madeleine Hodgson

For the Applicant: Heidi Jensen

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