



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

**Citation: 2015 TMOB 74**  
**Date of Decision: 2015-04-20**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Investment Planning Counsel Inc. against  
registration No. TMA532,514 for the trade-mark  
FINANCIAL SOLUTIONS FOR LIFE in the name of  
The Equitable Life Insurance Company of Canada**

[1] At the request of Investment Planning Counsel Inc. (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on April 16, 2013 to The Equitable Life Insurance Company of Canada (the Owner), the registered owner of registration No. TMA532,514 for the trade-mark FINANCIAL SOLUTIONS FOR LIFE (the Mark).

[2] The Mark is registered for use in association with the following services: insurance services, lending services, investment services and pension services.

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of 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 such use since that date. In this case, the relevant period for showing use is between April 16, 2010 and April 16, 2013.

[4] The relevant definition of “use” in association with services is set out in section 4(2) of the Act:

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.

[5] It is well established that 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)]. Although the threshold for establishing use in section 45 proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required, sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with the services specified in the registration during the relevant period.

[6] With respect to services, where the trade-mark owner is offering and prepared to perform its services in Canada, use of the trade-mark on advertising of those services meets the requirements of section 4(2) of the Act [see *Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (RTM)].

[7] In response to the Registrar’s notice, the Owner furnished the affidavit of Randy Howell, Vice-President, Legal & Corporate Secretary of the Owner, sworn on July 16, 2013 in Kitchener, Ontario. Both parties filed written representations; an oral hearing was not held.

#### The Owner’s Evidence

[8] In his affidavit, Mr. Howell states that the Owner’s principal place of business is in Waterloo, Ontario, and asserts that the Owner has used the Mark in Canada in association with insurance services, lending services, and investment services since 2000. He does not assert use in association with the registered pension services.

[9] Although he provides little in the way of substantive details regarding the nature of the Owner’s business, Mr. Howell does attest that the Owner operates a website, *www.equitable.ca*, and did so throughout the relevant period. According to Mr. Howell, this website has a secure portion, known as Equinet, “for its independent sales agencies and sales agents”. He attests that

the Mark was used on the Owner's website and Equinet during the relevant period to promote the Owner's services.

[10] In this respect, attached to Mr. Howell's affidavit are only two exhibits, being printouts from the website.

[11] Exhibit A is a printout that Mr. Howell simply attests is "a copy of a page from the Equinet which was in existence during the Relevant Period showing use of the Trademark in advertising the Services."

[12] The printout appears to be a news release entitled "Great News – Equitable Life of Canada® is partnering with TD Canada Trust" and announces in part the following:

Beginning March 15, 2010, The Equitable Life Insurance Company of Canada and TD Investment Lending Services have partnered to bring you access to TD's flexible loan program ... when you call, you will reach an expert on our investment lending team.

[13] While the Mark does appear at the bottom of the page, I note that the referenced March 15, 2010 date is prior to the relevant period, indicating that the webpage also predates the relevant period.

[14] Furthermore, consistent with Mr. Howell's description of Equinet, a footnote on the webpage states that "EquiNet is a secure information site ... available only to those contracted Equitable Life producers, advisors, MGAs, Group Plan Administrators and Equitable Life employees who have registered with the Company for access."

[15] As for Exhibit B, it too is a printout that Mr. Howell simply attests is "a copy of a page taken from the Website which was in existence during the Relevant Period showing use of the Trademark in advertising the Services."

[16] The webpage is entitled "Savings & Retirement" and states in part the following:

Equitable Life has a complete range of investment and annuity products designed to meet the savings, accumulation and income needs of clients. The wide investment selection provides you with the tools you need to achieve Financial Solutions for Life ... Equitable Life also offers outstanding RRSP and Investment Loan programs for those clients who wish to take advantage of any accumulated RRSP room or top up their non-registered

savings ... Use the Interactive Investor Profile to find out which investment mix is right for you!

[17] As noted by the Requesting Party, the phrase “Financial Solutions for Life” is only used in the text as part of a sentence. The phrase is capitalized in a manner similar to the terms “Investment Loan” and “Interactive Investor Profile”.

### Analysis

[18] At the outset, as noted above, Mr. Howell makes no mention of pension services in his affidavit. Further, although Mr. Howell asserts use of the Mark in association with insurance services since 2000, notwithstanding the Owner’s name, neither of the exhibits clearly reference “insurance” services. As such, the following analysis will focus on whether use of the Mark has been demonstrated in association with the remaining services, namely investment and lending services.

[19] Although Mr. Howell attests that the exhibited webpages were “advertising” the registered services, the Owner goes further in its written representations, submitting that “Exhibit A evidences the [Owner’s] use and display of the Mark in both the performance (comprising key elements thereof) and advertising of its investment services through the [Owner’s] independent sales agencies and sales agents”. The Owner also submits that “Exhibit B clearly evidences use of the Mark in association with the investment services of the [Owner]”.

[20] I would first note, however, that Mr. Howell furnishes no evidence of customers in Canada. He provides no invoices, no sales reports and, crucially, no evidence regarding whether any Canadians even accessed the exhibited webpages during the relevant period.

### *Display of the Mark in Exhibit B*

[21] With respect to Exhibit B, in its written representations, the Requesting Party argues that the manner in which the phrase “Financial Solutions for Life” appears on the Exhibit B printout is such that it would not be perceived as a trade-mark by a reader of the webpage. As such, the Requesting Party submits that the printout does not constitute display of the Mark in association with any services whatsoever.

[22] On the other hand, the Owner argues in its written representations that, as the first letter of each of the four words comprising the text of the Mark are capitalized, it draws a focus to the text and brings it to the attention of the reader as a trade-mark.

[23] However, a trade-mark is not used where it is not distinguished from surrounding text [see *Medos Services Corp v Ridout and Maybee LLP*, 2015 FCA 77, CarswellNat 576 at para 5 citing *Terrace (City) v Urban Distilleries Inc*, 2014 FC 833, 123 CPR (4th) 242]. In this case, I agree with the Requesting Party that “Financial Solutions for Life” has not been sufficiently distinguished from the surrounding descriptive text on the Exhibit B printout. As noted above, other phrases on the webpage, such as “Investment Loan” and “Interactive Investor Profile”, are capitalized in a similar manner. As well, the phrase “Interactive Investor Profile” is underlined. Accordingly, I do not find that the Mark has been displayed in a manner that allows potential consumers to visually perceive it as a trade-mark, much less associate it with the registered services.

#### *Webpage Access by Canadians*

[24] In any event, even if I were to find that there was display of the Mark on the Exhibit B printout, the main issue here is whether the Owner’s evidence demonstrates that Canadians actually accessed the Owner’s website and the exhibited webpage in particular during the relevant period. In this case, the Owner provides no evidence that the webpage was ever accessed, with Mr. Howell merely stating that the webpage was “in existence”.

[25] Analogous to this, in *Cornerstone Securities Canada Inc v Canada (Registrar of Trade Marks)* (1994), 58 CPR (3d) 417 (FCTD), the Court found that the trade-mark owner was unable to establish use of its services because the evidence did not satisfy the Court that the advertisements were actually distributed to prospective customers. In particular, the Court noted that “there is no evidence that the advertisements were distributed to anyone ... Nor were any individuals identified as to whom the advertisements were sent” [at para 8].

[26] Although the Exhibit B webpage in this case is not the same as a printed advertisement – in that it cannot be tangibly distributed in the same way – as an advertisement of the Owner’s services, it must still have been “distributed to” or accessed by the Owner’s prospective

customers in order to constitute use of the Mark. In this case, there is no evidence regarding the Owner's customer base or number of website hits, for example, from which it can be inferred that the webpage was actually accessed during the relevant period or otherwise. Mr. Howell does not even make the simple assertion that Canadians viewed the webpage during the relevant period.

[27] Moreover, although reasonable inferences can often be made regarding the distribution of advertisements, it is unclear from the evidence whether the Owner actually offered or performed any investment services during the relevant period. In this respect, I note again that the evidence does not reference any customers, much less Canadian ones. Given this lack of reference to end consumers, I am not satisfied that this webpage constitutes actual performance of "investment" services, even if understood broadly to include providing information about the availability of investment products. Furthermore, if there were actual investment services performed beyond the existence of the website, there is nothing to indicate that such services were performed in association with the Mark. As such, I cannot conclude that the Exhibit B printout evidences use of the Mark in association with the registered services.

#### *Availability of Webpage during the Relevant Period*

[28] With respect to Exhibit A, the Requesting Party submits that the URL of the Exhibit A webpage indicates that it originates in an archived portion of the Owner's website and argues that "a splash page dated March 2010 that remains available for viewing in an archive does not constitute advertisement in the relevant period."

[29] In its written representations, the Owner submits that the March 15, 2010 date actually indicates the date of the commencement of the partnership program between TD Canada Trust and the Owner, and that the program was not only in place during the relevant period, but remains in effect today.

[30] As noted above, March 15, 2010 was prior to the relevant period, indicating that the webpage itself was published prior to the relevant period. It is unclear whether the webpage would have continued to be accessible in some manner during the relevant period. In any event, while I accept Mr. Howell's sworn statement that the webpage was "in existence" during the

relevant period, he does not provide any evidence that the page was actually accessed at any time during the relevant period, by Canadians or otherwise.

[31] In this respect, the Requesting Party analogizes the webpage to an old clipping from searchable newspapers archived in the public library. It submits that the mere ability of a third party to search such a newspaper archive to find the display of a trade-mark on an old clipping does not constitute advertisement of that trade-mark in a given period.

[32] I agree with the Requesting Party to the extent that an advertisement that merely remains in existence during the relevant period is not necessarily sufficient for purposes of section 4(2). Generally, there must be some evidence that the advertisement was actively distributed to prospective customers during the relevant period. This will depend on the facts of the particular case. For print advertisements, it is not necessarily sufficient that some advertisements created years ago remain in the possession of some prospective customers. A roadside billboard, on the other hand, may constitute continual advertisement through the duration of its display, if it can be inferred that some prospective customers likely viewed the billboard.

[33] In the case of a website, some evidence that the website was accessed is required. Although reasonable inferences can often be made, it is not sufficient to simply state that a webpage was “in existence”. In this case, absent any evidence regarding the Owner’s customer base, I am not prepared to make any inference that at least some customers would likely have “driven past” the particular webpage during the relevant period or otherwise.

*Services Advertised and Offered by Owner*

[34] In any event, the Requesting Party further submits that the Owner itself does not offer investment or lending services. In this respect, it notes that the Exhibit A printout refers to a service offering of TD Bank. The Requesting Party also submits that since the Exhibit A printout is taken from the secure Equinet section of the website, it would only have been visible to employees, advisors and the like, and would not have been visible to any actual consumers of any investment or lending services. This, as noted above, is supported by the footnote stating that Equinet is a “secure information site” available only to certain parties who have registered with the Owner for access. As such, the Requesting Party submits that the webpage is neither an

advertisement of the Mark in association with investment or lending services, nor does it constitute display of the Mark during the performance of these services.

[35] In its written representations, the Owner attempts to clarify that the Exhibit A webpage “advertises a partnership program between TD Canada Trust (the lending aspect of the program) and The Equitable Life Insurance Company of Canada (the investment aspect of the Program).” It further submits that the webpage is located in a portion of the Equinet site that is accessible via the Internet, albeit presumably only by those with authorized access.

[36] Nonetheless, the same reasoning above with respect to the lack of evidence of distribution in the form of access by any customers applies here. The Owner provides no evidence that Canadians actually accessed the Equinet site and the exhibited webpage in particular during the relevant period. As such, I cannot conclude that the Exhibit A printout evidences use of the Mark in association with the registered services.

[37] Overall, the evidence in this case is remarkably thin and it is not clear from Mr. Howell’s affidavit that the Owner even had an active business during the relevant period. If the Owner was in fact actively offering and performing the registered services, in association with the Mark or otherwise, it is curious that the Owner would rely only on these two webpages to demonstrate such. In the absence of further explanatory details with regards to the nature of the Owner’s business, I am unable to conclude that display of the Mark, if any, on the exhibited webpages as shown constitutes use of the Mark by the Owner in association with its investment or lending services.

[38] In view of all of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the registered services within the meaning of sections 4 and 45 of the Act. Furthermore, there is no evidence before me of special circumstances excusing the absence of use.



Disposition

[39] Accordingly, 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 expunged.

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Andrew Bene  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office