



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

Citation: 2013 TMOB 217
Date of Decision: 2013-12-12

**IN THE MATTER OF AN OPPOSITION
by London Life Insurance Company to
application No. 796,175 for the trade-
mark LIBERTÉ MUTUELLE in the
name of Liberty Mutual Insurance
Company**

I Introduction

[1] This opposition relates to an application filed by Liberty Mutual Insurance Company (the Applicant) on October 30, 1995 to register the trade-mark LIBERTÉ MUTUELLE (the Mark) based on use since December 1936 in association with insurance services, namely, property and casualty insurance, general liability insurance, and personal lines insurance, namely, auto and homeowners insurance (the Services). The Applicant has disclaimed the right to the exclusive use of the word MUTUELLE apart from the trade-mark as a whole.

[2] The grounds of opposition raised by London Life Insurance Company (the Opponent) in a statement of opposition dated December 27, 2001 and amended on October 9, 2007 are based on sections 30(b), (i), 12(1)(d) and 2 (distinctiveness) of the *Trade-marks Act* RSC 1985, c T-13, (the Act). The specific grounds of opposition are detailed in Schedule A annexed to this decision.

[3] The first issue is to determine if the Opponent has furnished sufficient evidence to support each of its grounds of opposition. I conclude for the reasons detailed hereinafter that the Opponent has met its initial burden with respect to all grounds of opposition pleaded, with the

exception of the ground of opposition based on non-compliance with section 30(i). I also conclude that the Applicant has not discharged its burden to show use of the Mark as of December 1936. Moreover I conclude that the Mark is not registrable and lacks distinctiveness.

II Preliminary Remarks

[4] This file goes back more than 18 years. It was part of a large number of applications filed by one of the parties and subsequently opposed by the other. Those applications were filed over the years. In the majority of the cases the deponents were the same and the documentary evidence similar. Consequently a decision was made to group them together and ultimately they were case managed by the undersigned. Over the years applications were abandoned and/or oppositions withdrawn, such that finally only the present opposition proceeding remains pending. Whereas there may be other pending applications being opposed involving the same parties, only those applications listed in schedule B to this decision were case managed by the undersigned.

[5] Throughout the proceedings the parties in certain files would file an original of an affidavit in one file and agree to file a copy in the other files. The file containing the original affidavit has not been the same over the years. At the cross-examination stage a deponent may have filed different affidavits in different files but only one cross-examination was held with respect to the different affidavits in different files. Answers to undertakings were provided but sometimes filed in one particular file with a copy of the covering letter only in related files. All of this created a situation where it has been very difficult to reconstitute the content of this file. However at the beginning of the hearing a consensus was reached on what was the content of this file, which will be identified under a different section of this decision.

[6] During the course of over 20 cross-examinations, countless objections were made. Questions taken under advisement were thereafter refused and finally in the written arguments a good portion of the affidavits filed were the subject of a request to strike them from the record in whole or in part. Almost all of the affidavits have been the subject of debate as to their admissibility. I do not intend to address all of the objections made but rather those that appear to me to be crucial to the outcome of this decision. If in this decision I did not address an objection

on the admissibility of an affidavit or portion of it, it is because I find the evidence to be admissible.

[7] It is easy to lose sight of the forest when you are facing a tree. In this case one must focus on the grounds of opposition pleaded, the evidence filed that could support them, and the evidence that could be used by the Applicant to demonstrate that the grounds of opposition pleaded are not an obstacle to the registration of the Mark.

[8] Since this file was case managed and given the number of files that were actually being scheduled to proceed, a few conference calls were held between the undersigned and the parties' agents. After having read the entire content of the file and the written arguments of the parties, I was able to identify what I consider to be the key issues in this file, namely:

1. Has the Opponent met its initial burden with respect to its section 30(b) ground of opposition?
2. If so, has the Applicant shown use of the Mark since the claimed date of first use?
3. Has the Mark lost its distinctiveness because of:
 - a) Lack of evidence of a proper license such that use of the Mark by other entities would not be deemed use of the Mark by the Applicant;
 - b) Use of the Opponent's trade-marks listed hereinafter;
 - c) Use of third parties' trade names and/or trade-marks.
4. Is the Mark confusing with one or more of the Opponent's trade-marks described hereinafter, taking into consideration the following:
 - a) Are the Opponent's marks known to a certain extent such that they have acquired distinctiveness?
 - b) Can the Opponent rely on the use of a family of trade-marks?
 - c) Are the parties' services and their channels of trade different?
 - d) Does the Mark resemble one or more of the Opponent's trade-marks?

e) Is the fact that the parties' marks have coexisted over an extended period of time a relevant factor in this case?

[9] Finally as I mentioned at the end of the hearing credit should be given to both parties' agents. Without their professionalism this file could have been a nightmare for any decision maker.

III The Evidence of Record

[10] The Opponent filed as its evidence the affidavits of:

Daniel Abbott-Cohen, Daniel Abbott-Cohen(#2), (#3), (#3b) and (#4)
André Buteau
Affidavit of Linda Gershberg (dated May 15, 2007)
Affidavit of Linda Gershberg (dated June 15, 2007)
Gladys Tibbo Witt (May 15, 2007)
Gladys Tibbo Witt(#2) (June 15, 2007)
Rachel Simone Prichard Noye (dated May 15, 2007)
Robert White

[11] Daniel Abbott-Cohen, André Buteau, Lindsay Gershberg, Gladys Tibbo Witt and Rachael Simone Prichard Noye were cross-examined. The transcripts of their cross-examinations are part of the record, as well where applicable, the answers to undertakings.

[12] The Applicant filed as its evidence the affidavits of:

Robert Clint (dated July 27 2009) (Clint#1)
Robert Clint (dated January 27, 2010) (Clint#2)
John Wintoniak
Ana Buchowsky
Jessie MacDonald
Christina I. Doria
Jo-Anne Jackson
Dina Maxwell

[13] All of the Applicant's deponents were cross-examined, with the exception of Jessie MacDonald. The transcripts of those cross-examinations are also part of the record as well as the answers to undertakings, where applicable.

[14] Finally as reply evidence the Opponent filed the affidavits of Kenneth Wong and Amanda Fickling, the latter replacing the affidavit of Susan Paige Cantle who could not be cross-examined. Mr. Wong and Ms. Fickling were cross-examined and the transcript of their cross-examinations and answers to undertakings, if applicable, are also part of the record.

IV Admissibility issues

[15] As stated earlier I will address only the issues that have a direct impact on this decision.

i) *Rules of evidence applicable before the Registrar*

[16] The following will form the foundation of my ruling on numerous objections made by both parties. For any objections made based on the hearsay argument and not dealt with specifically in this decision, they are dismissed on the basis of the ‘fairness and natural justice’ principle as detailed hereinafter.

[17] It is interesting to note that neither the Act nor the *Trade-marks Regulations* make mention of the Trade-marks Opposition Board (TMOB). Section 38 of the Act describes the procedure for an opposition before the Registrar. However, in accordance with the provisions of section 63(3) of the Act, the Registrar may delegate to any person he deems qualified any of his powers, duties and functions under the Act. It is in this context that we refer to the TMOB. In numerous decisions of the Federal Court the TMOB has been referred to as an administrative tribunal [see for example *Mövenpick Holding AG v Exxon Mobil Corp* (2011), 109 CPR (4th) 334 (FCTD)].

[18] The Registrar will issue from time to time practice notices that serve as guidelines to the procedure applicable before the TMOB. However these notices are not a detailed code of procedure. Consequently when issues arise that are not covered by the Act, the Regulations and the practice notices, it has been a practice of the TMOB to refer to the *Federal Court Rules*. This practice makes sense as any decisions of the Registrar rendered under section 38(8) of the Act are appealable to the Federal Court [see section 56 of the Act].

[19] Hearsay evidence can still be admissible if it meets the test of necessity and reliability [see *R v Khan*, [1990] 2 SCR 531 and *R v Smith* [1992] SCR 915]. However the parties disagree

as to whether the exceptions to hearsay evidence should be strictly applied by the TMOB. The Applicant cited cases where the Federal Court applied rigorously the principles of necessity and reliability when facing hearsay evidence.

[20] Nonetheless, as pointed out by the Opponent, the TMOB, having been considered an administrative tribunal, is the master of its own procedure. The following excerpt of Mr. Justice Harrington's judgment in *Mövenpick, supra* summarizes the applicable law:

78 Canadian courts have held that administrative tribunals are not restricted by the rules of evidence applicable to court proceedings. As explained by Mr. Justice Sopinka in *Prasad v. Canada (Minister of Employment & Immigration)*, [1989] 1 S.C.R. 560 (S.C.C.), at paragraph 46: "As a general rule, these tribunals are considered to be masters in their own house. In the absence of specific rules laid down by statute or regulation, they control their own procedures subject to the proviso that they comply with the rules of fairness and, where they exercise judicial or quasi-judicial functions, the rules of natural justice."

79 The Federal Court of Appeal has also touched upon this issue in *Canadian Recording Industry Assn. v. Society of Composers, Authors & Music Publishers of Canada*, 2010 FCA 322, 413 N.R. 176 (F.C.A.). Mr. Justice Pelletier wrote at paragraph 20:

20 In any event, the Board is not a court; it is an administrative tribunal. While many tribunals have specific exemptions from the obligation to comply with the rules of evidence, there is authority that even in the absence of such a provision, they are not bound, for example, to comply with the rule against hearsay evidence. [...]

[21] It is with this general principle in mind that I will not exclude from the record or give very little probative value to the content of various affidavits signed by staff members of the parties' agents firms wherein those people conducted searches and made phone calls. In these affidavits the deponents would summarize telephone conversations he or she had with third parties' representatives. The best evidence rule would suggest that the person to whom the deponent spoke should file an affidavit but it would impose a too cumbersome burden on the party filing such evidence as it does not control that third party. The opposing party could conduct its own investigation and, where applicable, file its own evidence to contradict that portion of the evidence.

ii) The Wong and Clint Affidavits on the extent to which the Mark is known

[22] Mr. Wong is an Associate Professor & Distinguished Professor of Marketing at Queen's University School of Business. He has been employed by Queen's University since 1983. He is responsible for conducting research and writing articles; developing curriculum and instructing MBA and B.Comm students in Advanced Business and Marketing Strategy; advising local and multinational businesses; teaching in Executive Development Programs; and providing interviews to the media, all as it relates to marketing. He is also Partner and Vice President, Knowledge Development at Level 5 Strategy Group, a marketing consulting firm based in Toronto, Ontario, which specializes in all aspects of managing, evaluating and valuing branded businesses. He filed as Exhibit A to his affidavit his *curriculum vitae*.

[23] He was asked by the Applicant, based on his education, teaching and experience in the field of marketing, to determine whether the type and amount of marketing spent by an insurance company, as detailed in Mr. Clint's affidavit (the Applicant's Chief Counsel with its Canadian branch) and his answers to undertakings subsequent to his cross-examination, would be considered 'extensive advertising', and whether on the basis of this marketing expenditure over 15 years, a particular brand would likely become 'extremely well known' in Canada as of 2010. Mr. Wong was not provided with the name of the Applicant nor the brand(s) involved.

[24] The Applicant raises two issues:

- 1) Mr. Wong is not a qualified expert as he lacks the necessary credentials and expertise to support his opinion.
- 2) Mr. Wong did not have the necessary information to provide any sort of meaningful or credible opinion with respect to the Applicant's Mark.

[25] On the first issue the Applicant's main argument is that Mr. Wong has never been qualified as an expert in a legal case before and has never given evidence in a trade-mark opposition proceeding nor as he written any articles on brand recognition. If I was to conclude in favour of the Applicant then his affidavit and his cross-examination would be excluded from the evidence of record.

[26] For the reasons detailed hereinafter I consider Mr. Wong to be qualified to provide an opinion as to whether a particular brand has become extremely well known in Canada. However I conclude that Mr. Wong did not have all the relevant information such that his opinion might have been different had such information been provided. Consequently little probative value will be given to his opinion.

[27] The fact that Mr. Wong has not testified in court or has not been qualified as an expert in a legal case previously does not automatically disqualify him as an expert in this case. Any qualified expert had to be recognized for a first time as an expert, otherwise there would be no qualified experts. His *curriculum vitae* attached as Exhibit A to his affidavit speaks for itself. He has been constantly in contact with marketing firms and their clients. He has conducted research on the valuation of brands (see question 44 of the transcript of his cross-examination).

[28] His cross-examination has revealed that relevant information was not provided to him that might have influenced his opinion such as the niche market, the target population, the sums of money spent by competitors and the actual amount spent by the Applicant on any given year. He also did not know who the Applicant's competitors were, what sort of advertising the Applicant engaged in, how many consumers saw the advertising, and what has been the Applicant's media coverage.

[29] Consequently his opinion, based on the limited facts presented to him, that the Applicant would not have spent a sufficient amount on marketing between 1995 and 2010 to be able to claim that the Mark is extremely well known in Canada will be given very little probative value.

[30] A corollary to this conclusion is that the opinion given by Mr. Clint, based on the information contained in his affidavit and provided to Mr. Wong, that the Mark has become extremely well known in Canada as a result of its 'extensive use and advertising' will also be given little probative value for the same reasons, namely that the information contained in his affidavit is not sufficient to support such contention. I may add that Mr. Clint did not provide a breakdown per year of the overall amount of money (1 million dollars) spent over 15 years to promote and advertise the Applicant's trade-marks, including the Mark. Such lack of information

is an additional element that supports my conclusion that the statement made by Mr. Clint about the fame of the Mark is to be given very little probative value.

[31] The Registrar is generally in a position to determine if the evidence filed by a party supports a contention that a given mark has become extremely well known in Canada. The factors that will be taken into consideration are: the yearly sales figures over a relevant period of time associated with such mark; the extent of the promotion and advertisement of the wares and services in association with the mark; media coverage, etc.

iii) The Fickling Affidavit

[32] Ms. Fickling is Associate Manager, Distribution Marketing with the Opponent. The content of her affidavit is essentially identical to the affidavit executed by Ms. Susan Paige Cantle, Manager, Marketing Communications with the Opponent, previously filed in these proceedings. Ms. Cantle was unable to attend her cross-examination due to medical reasons. Her affidavit is attached as Exhibit 1 to Ms. Fickling's cross-examination.

[33] The Fickling affidavit was filed as part of the Opponent's reply evidence. Through this affidavit the Opponent would like to prove that it has been policing the Canadian marketplace to discover the use of trade-marks, trade names and domain names that are or might be confusing with one or more of the Opponent's FREEDOM or LIBERTÉ trade-marks, amongst others.

[34] During her cross-examination Ms. Fickling confirmed that the content of her affidavit was identical to Ms. Cantle's affidavit. The problem is that Ms. Cantle's affidavit is based on information she obtained from Mr. Gord Peters, Senior Counsel for the Opponent. Also during her cross-examination Ms. Fickling stated that her affidavit is based on what Ms. Cantle said to her and on the content of the latter's affidavit as well as her conversations with Mr. Peters. Nowhere in their affidavits have Ms. Fickling and Ms. Cantle given reasons as to why Mr. Peters was not in a position to supply his own affidavit on facts that he reported to Ms. Cantle, which are now contained in Ms. Fickling's affidavit.

[35] Not surprisingly the Applicant objected to the content of Ms. Fickling's affidavit on the basis that it constitutes hearsay evidence. The parties seem to agree on the test to apply to

determine if evidence is hearsay. There is no doubt in the case of Ms. Fickling that the content of her affidavit is hearsay evidence. However could it be admissible hearsay evidence?

[36] In this case no reasons have been provided as to why Mr. Peters was not in a position to file an affidavit. As the necessity of the Fickling affidavit was not demonstrated, it constitutes inadmissible hearsay evidence.

iv) *The Noye's affidavit*

[37] Ms. Noye has been the Assistant Vice-President, Communications and Advertising for the Opponent and has been employed by it since 1993. She oversees the Opponent's national advertising programs and she is responsible for communication matters relating to Canadian clients, financial security advisors and administrative employees.

[38] The Applicant takes the position that, from her cross-examination, much of Ms. Noye's evidence is either inadmissible hearsay, overstated, unsupported, unreliable and/or simply inaccurate [see paragraph 20 of the Applicant's written arguments]. The content of 17 paragraphs has been challenged by the Applicant. I do not intend to deal with every single objection individually. I will however make the following remarks. The fact that:

- Ms. Noye never worked in Quebec;
- The Opponent's LIBERTÉ marks were used mainly in Quebec;
- The studies/research done on the distinctiveness of the LIBERTÉ marks were specific to the French language trade-marks within Quebec only;

do not create a negative impact when assessing the weight to be given to her affidavit. Section 6(2) of the Act does state that the likelihood of confusion must be assessed in the context of possible use of the marks in issue in the same area. Consequently even if the Opponent trade-marks may have been used mainly in Quebec and not across Canada, it will not alter the test to apply to determine if there is a likelihood of confusion. Also as mentioned in *Smithkline Beecham Corporation v Pierre Fabre Médicament*, (2001) 11 CPR (4th) 1(FCTD) the likelihood of confusion needs to be established only within one of the following segments of the

population: monolingual French speaking person, monolingual English speaking person or a bilingual person.

v) Figures provided in various affidavits

[39] Both parties made numerous objections on figures provided: volume of sales, percentage of sales in Quebec, advertising budget, percentage of advertising in Quebec, percentage of advertising per trade-mark, etc... In an ideal world this type of information should be presented by a person who is personally aware of those figures and can answer questions on them during a cross-examination. Also as in this case, since both parties seem to rely on use of multiple trade-marks, a breakdown per trade-mark and per service would have been more than helpful. However I can understand that in some cases, especially when more than one trade-mark is used on the same brochure, as in this case, such detailed breakdown is most likely next to impossible to achieve.

[40] The information provided by one deponent must be assessed in the global context of all of the evidence filed. For example Ms. Noye may have not worked in the Province of Quebec and may not have been involved in the creation of each of the Opponent's LIBERTÉ marks but Mr. Buteau, a financial Security advisor with Financière Liberté 55, a division of the Opponent, has been with it for 25 years. He has been a resident of the Province of Quebec from 1959 to 2007 and has worked in the insurance industry in the province of Quebec from 1982 to 2007. He states that he has been aware of the introduction by the Opponent of its LIBERTÉ 55 trade-mark in 1984 in the province of Quebec. He states that the Opponent has since then extensively used and advertised LIBERTÉ 55. Those statements are corroborated by the volume of evidence filed by Ms. Noye and the yearly sales and advertising figures provided by her.

[41] When cross-examined on her allegation that 19% of the total individual premium income nationally originates from the province of Quebec, Ms. Noye stated that it was an approximation and that it could be off a couple of percentage points on a given year. I do not consider this admission as evidence that the Noye affidavit is unreliable. Given the exhaustive nature of the evidence filed by the Opponent on its use of the LIBERTÉ marks through different deponents I shall not ignore the sales and advertising figures contained in Ms. Noye's affidavit.

[42] However I cannot make the same inference when I combine the evidence filed by Mr. Clint with the content of Ms. Jackson's affidavit. She has been a Senior Underwriter with the Applicant and has been employed by it in Canada since 1964. The documentation she filed, which will be examined later, combined with the figures provided by Mr. Clint are, to say the least, far less impressive than what has been filed by the Opponent. Moreover as stated earlier, the Applicant has not broken down its advertising figures on a yearly basis.

V Use of the LIBERTY and/or LIBERTY MUTUAL trade-marks

[43] The Applicant has filed a great deal of evidence to establish use of the English version of the Mark. This evidence might have been relevant in other related files but not in this one. The trade-mark applied for is LIBERTÉ MUTUELLE and not LIBERTY MUTUAL. In this particular file the Liberty Mutual Insurance Company is the Applicant. This is not a situation involving an opponent relying on prior use of a confusing trade-mark where its trade-mark would be a translation of the mark applied for. Then the distinctiveness of the mark applied for could be challenged on the basis of the use by an opponent of the translation of that mark. In the present instance the Applicant cannot rely on its use of the trade-mark LIBERTY MUTUAL to support: its claimed date of first use of the Mark, its prior use of the Mark and the distinctiveness of the Mark [see *Restaurant Au Chalet Suisse Inc v Cara Operations Ltd* (1988), 20 CPR (3d) 331 (TMOB) and *2076631 Ontario Ltd (cob The Shoe Club) v 2169-5762 Quebec Inc* [2011] TMOB No 92].

VI Legal Onus and Burden of Proof

[44] 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. This means that if a determinate conclusion cannot be reached in favour of the Applicant once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate*

Ltd (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FCTD)].

VII The Relevant Dates

[45] The parties agree that the following are the applicable relevant dates:

- i) grounds of opposition based on section 30 of the Act: the filing date of the application (October 30, 1995) [see *Georgia-Pacific Corporation v Scott Paper Ltd* (1989), 24 CPR (3d) 274(TMOB) regarding section 30(b); and *Tower Conference Management Co v Canadian Management Inc* (1990), 28 CPR (3d) 428 (TMOB) for section 30(i)];
- ii) ground of opposition based on section 12(1)(d): the date of the Registrar's decision [see *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)];
- iii) grounds of opposition based on lack of distinctiveness of the Mark: the filing date of the statement of opposition (December 27, 2001) [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FCTD)].

VIII Ground of Opposition Based on Section 30(i) of the Act

[46] Section 30(i) of the Act only requires the Applicant to declare that it is satisfied that it is entitled to use the Mark in Canada in association with the wares and services described in the application. Such a statement is included in this application. An opponent may rely on section 30(i) in specific cases such as where bad faith by the applicant is alleged [see *Sapodilla Co Ld v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. There is no allegation of that nature in the statement of opposition or any evidence in the record to that effect. Neither at the hearing nor in its written arguments did the Opponent make representations concerning this ground of opposition.

[47] Consequently the ground of opposition based on section 30(i) of the Act is dismissed.

IX Ground of Opposition Based on Section 30(b) of the Act

[48] The Opponent has an initial burden to file some evidence to support this ground of opposition. Alternatively, the Opponent may rely on the Applicant's evidence to meet its light evidential burden [see *York Barbell Holdings Ltd v ICON Health & Fitness, Inc* (2001), 13 CPR (4th) 156 (TMOB)]. However in that case the Applicant's evidence must be clearly inconsistent with the statements made by the Applicant in its application [See *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB), *Labatt Brewing Co v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) and *Williams Telecommunications Corp v William Tell Ltd* (1999), 4 CPR (4th) 107 (TMOB)].

[49] In *Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply Co* (2001), 11 CPR (4th) 489 (FCTD) it was established that in order to meet the requirements of section 30(b) of the Act, an applicant must have continuously used the mark in association with its wares and services in the normal course of trade from the date of first use to the filing date of the application.

[50] The Applicant did not state in its application a precise date during the month of December 1936 when it began using the Mark. Under these circumstances the Registrar considers the alleged date of first use to be the last day of the month: December 31, 1936. [See *Khan v Turban Brand Products Ltd* (1984), 1 CPR (3d) 388 (TMOB).]

[51] Under this ground of opposition the Opponent has raised two issues:

- i) The Applicant has not used continuously the Mark in Canada since at least as early as December 1936 in association with the Services;
- ii) To the extent there has been any use, such use was by other entities, and not in accordance with the provisions of Section 50 of the Act.

i. Use of the Mark since December 31, 1936

[52] Obviously going back to 1936 is a challenge for either party. However the Applicant has made its bed by alleging such date of first use. Ultimately if the Opponent has met its initial

onus, the Applicant must be in a position to prove continuous use of the Mark as of the claimed date of first use in association with the Services within the meaning of Section 4(2) of the Act.

[53] The Opponent filed the affidavit of Lindsay Gershberg, an administrative assistant who attended the National Library of Canada to consult telephone directories of Toronto and Montreal for various years including 1936 to 1940, then every 5 years from 1945 to 1990 looking for various listings including LIBERTÉ MUTUELLE. The earliest citation located in these phone directories is for LIBERTE MUTUELLE (I consider the use of LIBERTE MUTUELLE to be use of he Mark [see *Promafil Canada Ltd v Munsingwear Inc* (1992), 44 CPR (3d) 59]) in the Montreal phone directory of 1985. All entries in the Toronto phone directories and in the earlier versions of the Montreal Directories are under ‘Liberty Mutual’. As stated earlier the Applicant cannot rely on the use of LIBERTY MUTUAL to justify its claimed date of first use of the Mark.

[54] The Opponent also relies on the affidavit of Daniel Abbott-Cohen (#3), a paralegal employed by the Opponent’s agent firm, dated May 14, 2007. On May 10, 2007 he was instructed to obtain a certified copy of the Quebec Enterprise Register CIDREQ report for ‘Enterprise number 1141662602’ corresponding to La Compagnie d’Assurance Liberté Mutuelle, the Applicant’s French trade name. He contacted CIDREQ, ordered the documentation and filed it. The documents revealed that:

- All information relates to ‘La compagnie d’assurance Liberté Mutuelle’ as well as its English version ‘Liberty Mutual Insurance Company’;
- It is a company from Massachusetts, U.S.A.;
- It was incorporated on January 1, 1912;
- It started using the trade name Liberty Mutual Insurance Company on December 30, 1936;
- It started using the trade name Compagnie d’assurance Mutuelle Liberte on January 1, 1970.

[55] Corporate documents do not constitute evidence of use of a trade-mark [see *Pharmx Rexall Drug Stores Inc v Vitabrin Investments Inc* (1995), 62 CPR (3d) 108 (TMOB)], but in this case the French trade name seems to have been adopted only on January 1, 1970. It would be

quite unusual to use a short version of a trade name as a trade-mark since December 1936, when the trade name was only adopted on January 1, 1970. In fact Mr. Flint in his first affidavit in paragraph 12 states:

12. [The Opponent's] LIBERTY MUTUAL and LIBERTÉ MUTUELLE trade-marks (the 'Marks') were developed because they were a short form of the [Opponent] corporate name and have consistently been used in Canada.

[56] During his cross-examination Mr. Flint said that the Mark has been used consistently in Canada since at least the early 70's, late 60's. He provided that answer based on the records of the Applicant that he has seen (see answer to Q183).

[57] From this evidence I conclude that the Opponent has met its initial burden. All these facts do raise a serious issue as to the accuracy of the Applicant's claimed date of first use of the Mark. The Applicant was fully aware that the Opponent was challenging the date of first use alleged in the application as pleaded in its statement of opposition as well as from the evidence filed. The Applicant had to prove that it has used the Mark since at least as early as December 31, 1936 in Canada on a continuous basis in association with the Services. So what evidence did the Applicant file to meet its burden?

[58] Neither Mr. Flint nor Ms. Jackson, a Senior Underwriter for the Applicant, have been with the Applicant since 1936. Mr. Wintoniak has been working with the Applicant as a broker in damage insurance in Montreal but only since 1989. Consequently none of the Applicant's representatives have personal knowledge of the use of the Mark in Canada in association with the Services since December 31, 1936. The Applicant had therefore to rely on documentary evidence to establish such date of first use.

[59] The only document in the record that goes back to 1936 is a certificate of Registry issued by the Department of Insurance, Canada dated the 30th day of December 1936 under the *Foreign Insurance Companies Act, 1932* to Liberty Mutual Insurance Company authorizing it to transact in Canada the business of various type of insurances such as insurance against bodily injury, and death by accident; insurance against liability for lost or damage from accident to employees or other persons or to property and insurance against liability for loss or damage to persons or property caused by an automobile.

[60] The Opponent argues that it would be virtually impossible for an entity to obtain its certificate dated on December 30, 1936 and to start using the Mark the next day. Although interesting, I am not convinced by this argument. Firstly I have no evidence in the record that such certificate was a prerequisite to offer the Services in Canada at the relevant date. Moreover the evidence shows that the Applicant was incorporated in the United States in 1912. It was still possible for the Applicant to prove that the Services were being offered in Canada as of the claimed date of first use in association with the Services. In any event as stated earlier, corporate documents do not constitute proper evidence of use of a trade-mark within the meaning of section 4 of the Act.

[61] Mr. Flint attached some promotional material that provides some historical notes on the Applicant [see exhibit C to Clint#1 affidavit]. However there is no reference to the Mark on those documents.

[62] Mr. Flint filed the Applicant's annual statement of 1936 in which there is a reference to Canada and under the column 'Direct Writings' where there is an amount of \$1704.76 written. During his cross-examination Mr. Flint was unable to explain the meaning of 'direct writings' as used in this annual statement drafted in the United States. In any event if I was to consider such information as evidence of business activities in Canada in 1936, there is no evidence that those activities would relate to Services performed in Canada in association with the Mark.

[63] The Opponent has provided in its written argument a detailed list of the documents filed by the Applicant on which the Mark appears. I asked the Applicant if that list was exhaustive. In view of the volume of the evidence in the record, not always presented in a manageable fashion as discussed hereinafter, I offered the Applicant the opportunity to verify the record and provided me with references to any other material on which the Mark would appear which has not been referenced to in the Opponent's written argument. I did receive that list from the Applicant.

[64] It is clear from the information provided by the parties that the earliest documents filed on which the Mark appears are blank forms in the French language used in 1980-1981. There is no documentary evidence of use of the Mark in Canada between December 31, 1936 and 1980.

[65] This fact scenario illustrates the danger of claiming a date of first use of a trade-mark that goes far back in time. When alleging a date of first use of 1936 in its application, the Applicant had to assure itself that, in case of contestation of that date of first use, it would be in a position to prove use of the Mark as of that date of first use.

[66] Mr. Flint, in an answer to an undertaking, confirmed that all the documents in the possession of the Applicant on which we see the Mark have been filed in the record. Leaving aside some of the arguments raised by the Opponent on the validity of these documents to substantiate the use of the Mark by the Applicant, at best all that the Applicant could prove with them is a date of first use of the Mark in Canada going back to 1980.

[67] This is sufficient to maintain this ground of opposition.

[68] As stated above a second argument was raised by the Opponent to support this ground of opposition. It relates to the identity of the entity (ies) that may have used the Mark over the years. If the Mark has been used by an entity other than the Applicant, could it be deemed use by the Applicant in accordance with the provisions of section 50 of the Act? I will discuss this issue under the ground of opposition based on lack of distinctiveness of the Mark.

X Ground of Opposition Based on Lack of Distinctiveness of the Mark

[69] The Opponent argues that the Mark lacks distinctiveness because:

- i. Absence of a license agreement and/or appropriate control under Section 50 of the Act;
- ii. It does not distinguish nor is it adapted to distinguish the Services from the Opponent's insurance services.

[70] As under any grounds of opposition the Opponent has an initial burden. The Opponent argues that the evidence in the record shows that different entities were using the Mark and there is no evidence of a proper license agreement put in place between the Applicant and those entities using the Mark.

[71] I wish to reiterate that the trade-mark in issue is LIBERTÉ MUTUELLE and not LIBERTY MUTUAL or any of the Applicant's trade-marks having as a component the word LIBERTÉ or LIBERTY. I shall therefore focus my analysis of the evidence only on the material bearing the Mark or what could be interpreted as use of the Mark.

[72] To support an allegation of use of the Mark by entities other than the Applicant the following seem to be the most relevant documents:

- 'Police d'assurance des entreprises', exhibit G to Clint#1 affidavit used in 1980 and 1981 (and also part of exhibit F to Ms. Jackson's affidavit), which is a blank form on which appears at the bottom the mention 'Police émise par' which translates to 'Policy issued by' with two names on two separate lines beside which a box needs to be ticked off: Liberty Mutual Insurance Company and Liberty Mutual Fire Insurance Company;
- 'Police d'assurance automobile du Québec' F.P.Q. No. 1A, exhibit F to Clint#1 affidavit, which has under the Mark the reference to Liberty Mutual Insurance Company and Liberty Mutual Fire Insurance Company;
- Motor Truck Cargo Policy (English and French versions) declaration blank form, exhibit B to Ms. Jackson's affidavit, which has under the Mark the reference to Liberty Mutual Insurance Company and Liberty Mutual Fire Insurance Company as well as those two names on two separate lines beside which a box needs to be ticked off;
- Text of the Motor Truck Cargo Policy (English and French versions), exhibit C to Ms. Jackson's affidavit, which has under the Mark the reference to Liberty Mutual Insurance Company and Liberty Mutual Fire Insurance Company;
- Business Insurance Policy, blank form, part of exhibit F to Ms. Jackson's affidavit, which has Liberty Mutual Insurance Company and Liberty Mutual Fire Insurance Company on two separate lines beside which a box needs to be ticked off under the heading 'Policy issued by';

- English version of the text of the Business Insurance Policy, part of exhibit F to Ms. Jackson's affidavit, which has Liberty Mutual Fire Insurance Company written underneath the Mark;
- French version of the text of the Business Insurance Policy, part of exhibit F to Ms. Jackson's affidavit, which has Liberty Mutual Fire Insurance Company written underneath the Mark;
- 1994 Montreal Phone Directory, part of exhibit C to Dina Maxwell's affidavit where the Mark appears and reference is made to 'Liberté Mutuelle Assurance Groupe';

[73] The Opponent has also referred to documents where the Mark appears without any indication of the identity of the owner of the Mark. There are no requirements under the Act where the owner of a trade-mark would have to be identified on the documentation bearing the trade-mark. However, there are provisions under section 50 concerning the proper notification to the public when a trade-mark is being used by a licensee and this will be discussed hereinafter.

[74] The Applicant and Liberty Mutual Fire Insurance Company (LMFIC) are two distinct entities. I refer to exhibit C to Ms. Jackson's affidavit where information is provided on the right to vote given to the policy holder. There is reference to the date and time of the annual meeting of the shareholders, held for each company at different times.

[75] Moreover Mr. Clint states in paragraph 19 of his affidavit dated July 27, 2009:

19. I understand that the Opponent is, among other things, alleging that the Marks have been used by other entities, which it assumes, were not licensed to use them. Over the years the Marks have been used by [the Applicant] as well as its affiliated companies, that were licensed to use its marks, such as Liberty Mutual Fire Insurance Company. By virtue of its licenses, [the Applicant] has always controlled the character or quality of the services offered by its licensees.

[76] Mr. Clint during his cross-examination mentioned that he believed that there was a license in place between LMFIC and the Applicant. He did not have a copy of the license agreement. He stated that LMFIC ceased doing business in Canada in 2007 without indicating the month of the year [see Q12 to Mr. Clint's cross-examination], approximately only 2 years

after he signed his affidavit. He was asked to produce a copy of the license agreement. In answer to that request the Applicant's agent stated '...as a result of passage of time, he was unable to locate any licenses'(my underlines) [see answers to undertakings attached to the Applicant's agent letter dated August 15, 2013].

[77] The documents filed by Mr. Clint and Ms. Jackson go back to at least 1980. Mr. Clint was not employed by the Applicant at that time. However he was employed by the Applicant during the year when LMFIC ceased doing business in Canada. There is no indication in the answers to undertakings that Mr. Clint made the proper verifications to locate the license agreement.

[78] The amended statement of opposition was filed on June 15, 2007 and it raises clearly the question of use of the Mark by different entities without a license [see paragraph A.5 (i) and (ii) of the amended statement of opposition]. Consequently the Applicant knew back in 2007 that a licensing problem had been raised and as a result it included the allegation of the existence of a license in paragraph 19 of Mr. Clint's affidavit. In June 2007, either LMFIC was still in business in Canada and was using the Mark under license or had just ceased doing business in Canada. 'Passage of time' was not an issue at that time.

[79] Clearly the documentation filed shows that the Mark was used by at least two separate entities in Canada between 1980 and 2007, namely the Opponent and LMFIC. There is also reference to a possible third entity. However it is not clear from the record as to who is 'Liberté Mutuelle Assurance Groupe'. If it was simply a trade name used by the Applicant, the latter had to prove it. The Opponent has met its initial burden. Therefore the Applicant had to prove the existence of a license agreement between the Applicant and LMFIC.

[80] Mr. Clint does not confirm that he saw a license agreement. He was unable to locate it. He therefore cannot support his allegation that there were quality control mechanisms put in place over the character or quality of the services offered by its licensees.

[81] The present situation is quite different than the case law cited by the Applicant. The latter relies on four decisions wherein inferences were made that there was control over the quality or character of the wares and services licensed. Three of those cases are decisions

rendered in the context of a section 45 proceeding, which is summarily in nature. In those cases the licensor alleged the existence of an oral license. Section 50 of the Act does not require that the license be in writing [see *Lindy v Canada (Registrar of Trade-marks)*, [1999] FCJ No.682 (FCA)]. However the deponents in all of these cases were either officer and/or director of both related companies or owner of the mark and officer and/or director of the licensee.

[82] Mr. Clint has not mentioned that he has been an officer or a director of LMFIC nor that he is presently an officer or director of the Applicant. Moreover Mr. Clint during his cross-examination clearly stated that he was testifying on his behalf alone and not on behalf of the Applicant [see page 4 of the transcription of his cross-examination].

[83] Mr. Flint testified that he believed that a license existed. There has been no reference by Mr. Clint, in his affidavit, during his cross-examination, or in his answers to undertakings, that the license was verbal. Mr. Clint has not provided the provisions of control that were allegedly put in place by the Applicant. Finally during his cross-examination Mr. Flint mentioned that all companies in the 'Liberty Mutual Group', which would include the Applicant and LMFIC are owned and controlled by a separate entity called Liberty Mutual Holding Incorporated or Inc. (LMHI) [see page 18 of the transcript of Mr. Clint's cross-examination]. Consequently If I was to infer any control from one entity over LMFIC it would be from LMHI and not from the Applicant.

[84] For all of these reasons I conclude that the Applicant has not established, on a balance of probabilities, that the use of the Mark by LMFIC was deemed use of the Mark by the Applicant in virtue of the provisions of section 50 of the Act. Consequently as of the relevant date, namely December 27, 2001 (original statement of opposition) or October 9, 2007 (amended statement of opposition) the Mark was not distinctive of the Applicant.

[85] The ground of opposition of lack of distinctiveness of the Mark based on the absence of proper licensing is therefore maintained.

[86] The other prong of the distinctiveness ground of opposition is based on the likelihood of confusion between the Mark and the Opponent's trade-marks. I will discuss the issue of likelihood of confusion under the ground of registrability of the Mark. As it will be discussed

below, the difference between the relevant dates associated with those two grounds of opposition will not have an impact on my analysis of the relevant criteria listed under section 6(5) of the Act. Consequently my conclusion on the likelihood of confusion between the Mark and the Opponent's trade-marks reached under the next ground of opposition will equally apply to this prong of the distinctiveness ground of opposition.

XI Registrability of the Mark under Section 12(1)(d) of the Act

[87] The Opponent's initial burden is met with respect to a section 12(1)(d) ground of opposition if the registrations relied upon are in good standing as of the date of my decision. The Registrar has discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[88] The Opponent relies under this ground of opposition on the following registrations:

- LIBERTÉ 55, certificate of registration TMA308,603 for life insurance, financial planning and investment services and investment savings plans;
- EN LIBERTE certificate of registration TMA403,990 in association life insurance, financial planning and savings and investment services;
- FONDS LIBERTÉ, certificate of registration TMA497,737 in association with life insurance, financial planning, savings and investment services;
- LIBERTE PREMIERE certificate of registration TMA403,991 in association with life insurance, financial planning, savings and investment services;
- LA LIBERTÉ COMMENCE AUJOURD'HUI certificate of registration TMA498,349 in association with insurance services and financial services namely providing, managing and administering employee benefit plans, retirement savings plans, pension plans, investment savings plans, investment services, financial planning services, asset management, financial administration services, lending services, mortgage administration services;

(collectively referred to as the Opponent's Registered trade-marks)

[89] Extracts of the register for these registrations were part of Ms. Witt's affidavit, a trade-mark agent with the Opponent's agent firm. I exercised my discretion and checked the register. These registrations remain extant. As such the Opponent has met its initial burden of proof.

[90] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [See *Clorox Co v Sears Canada Inc* (1992), 41 CPR (3d) 483 (FCTD) and *Gainers Inc v Marchildon* (1996), 66 CPR (3d) 308 (FCTD)].

[91] Section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of goods or services in the same area from one source as being from another source. In the instant case, the question posed by section 6(2) is whether there would be confusion of the Applicant's Services, associated with the Mark, as services emanating from or sponsored by or approved by the Opponent.

[92] Mr. Justice Binnie of the Supreme Court of Canada commented on the assessment of these criteria [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 and *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321].

Inherent distinctiveness of the trade-marks and the extent to which they have become known

[93] I wish to state at the outset that reference has been made by both parties on certain decisions of the Registrar as well as judgments of the Federal Court involving oppositions filed by the Opponent where a conclusion over the strength of the Opponent's trade-marks has been made.

[94] I am obviously bound by the conclusion reached by the Federal Court on the issue of the inherent distinctiveness of each of the Opponent's Registered trade-marks. However a conclusion on the extent to which any of these marks have become known in Canada is not binding on the undersigned. I must draw my own conclusion on the acquired distinctiveness of any of the marks in issue based on the evidence filed in this docket.

[95] The Registrar and the Federal Court have already ruled that the Opponent's trade-mark LIBERTÉ 55 has little inherent distinctiveness when applied to life insurance, financial planning and investment services as it conveys the idea of being free of financial worries at age 55 [see *London Life Insurance Co v Manufacturers Life Insurance Co* (1997), 77 CPR (3d) 249 (TMOB), affm. *London Life Insurance Co v Manufacturers Life Insurance Co* (1999), 87 CPR (3d) 240 (FCTD)].

[96] In *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC) the Supreme Court clearly stated that each trade-mark being cited by the Opponent must be compared with the Mark. None of the Opponent's Registered trade-marks listed above has a fair degree of inherent distinctiveness. The term 'LIBERTÉ' used in association with the Opponent's services is suggestive of obtaining some financial freedom.

[97] In its written argument the Applicant simply states that '...the Applicant's mark is inherently distinctive when considered in its entirety as applied to the Services'. No reasoning has been provided to justify such conclusion. With all due respect for the Applicant's opinion, I disagree. The Mark is composed of two ordinary words in the French vocabulary. The Applicant had to disclaim the exclusive use of the word 'MUTUELLE' apart from the Mark as a whole as it describes in the French language that the Applicant operates a mutual insurance company.

[98] The distinctiveness of a trade-mark may be enhanced through its use or promotion. I have already reviewed the Applicant's documentary evidence relating to the use of the Mark. It is quite scarce in terms of the documentation filed illustrating use of the Mark. As for the sales figures provided by Mr. Clint in his first affidavit, there is no breakdown per Applicant's trade-mark, including the Mark. In his affidavit Mr. Clint does state that the Applicant has used over the years many trade-marks in Canada [see paragraph 11 of Clint#1 affidavit].

[99] Again and I must highlight the fact that the Applicant has filed mainly evidence of use of the English version of the Mark, namely LIBERTY MUTUAL, which is not the trade-mark applied for. I must assess the acquired distinctiveness, if any, of LIBERTÉ MUTUELLE.

[100] This portion of the first relevant factor has been the subject of voluminous documentation filed by the Opponent. The affidavit of Ms. Noye with the exhibits attached has more than 600 pages with no page numbers and tabs to separate and identify the exhibits. Given the volume of the evidence and that it was the Opponent's burden to show use of each of its trade-marks, including LIBERTÉ 55, it had to provide some sort of a list which would identify each registered and unregistered trade-marks with the corresponding exhibit and page number where they can be located. So it might be that some evidence of use of LIBERTÉ 55 or any other registered trade-marks included in exhibit C to Ms. Noye's affidavit (approximately 300 pages) has not been noticed by the undersigned. A similar remark is applicable to the Applicant in so far its evidence of use of the Mark through the affidavit of Ms. Jackson.

[101] Ms. Noye alleges that the first LIBERTÉ mark initially adopted by the Opponent was LIBERTÉ 55 which was introduced with wide use across Canada and advertising primarily in Quebec in 1984 to identify its insurance and financial planning services. As for evidence of use of the LIBERTÉ 55 trade-mark I refer to exhibits B1-to B10 to her affidavit as examples of its use which consist of various marketing communications that the Opponent distributed to current or prospective clients between 1985 and 2003. However during her cross-examination, Ms. Noye was unable to provide the number of each of these brochures that circulated in Canada.

[102] As for the use of the other Opponent's trade-marks, I refer to:

Exhibit B3 to Ms. Noye's affidavit for the trade-mark EN LIBERTÉ (used in 1993);

Exhibits A1, B6, B7, B8 and C to Ms. Noye's affidavit for the trade-mark FONDS LIBERTÉ (used since 1998);

Exhibit B3 to Ms. Noye's for the trade-mark LIBERTÉ PREMIÈRE (used in 1991);

Exhibit B6, B7 and B8 to Ms. Noye's affidavit for the trade-mark LA LIBERTÉ COMMENCE AUJOURD'HUI (used since 1998).

[103] I wish to point out that Ms. Noye filed exhaustive documentation showing use of the trade-mark FINANCIÈRE LIBERTÉ 55 and bird design. I do not consider such evidence as use of the trade-mark LIBERTÉ 55 or any of the other Registered trade-marks[see *Registrar of trade-marks v Compagnie Internationale pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA)].

[104] Ms. Noye has provided the annual individual premium income from 1980 to 2006 which varies from approximately 296 million dollars to over 1.4 billion dollars. She alleges that premium income from Quebec represents approximately 19 per cent of total individual premium income nationally. However there is no breakdown of the figures provided per registered trade-mark. In fact during her cross-examination Ms. Noye admitted that those figures may include other insurance products and not just LIBERTÉ 55 products.

[105] Based on that evidence, but due to the lack of breakdown in the sales figures and specific information as to how and to what extent each of the Opponent's trade-marks has been promoted and used, I can only conclude that that there has been some use of the Opponent's Registered trade-marks in Quebec in association with life insurance, financial planning and investment services and investment savings plans. I concede that the figures provided by the Opponent may look quite impressive but in the absence of some breakdown per trade-mark how can I state that one, some or all of them are well known in the Province of Quebec. However the evidence shows use of a family of LIBERTÉ trade-marks [see *MacDonald's Corporation v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101 (FCTD)].

[106] From all this evidence I conclude that the Opponent's trade-marks are more known than the Mark in Quebec. I specifically refer to the Province of Quebec as both parties have admitted that the use of the Mark or the Opponent's Registered trade-marks outside that province would be limited to French speaking clients who wish to obtain documentation in French. Unless proven otherwise, I do not consider such use outside the province of Quebec to be as impressive as the use within the province.

The length of time the trade-marks have been in use

[107] The Opponent argues that the documents filed by the Applicant to illustrate use of the Mark are blank forms and this would not constitute proper evidence of use of the Mark. The application covers services and not wares. Moreover Ms. Jackson confirmed during her cross-examination that those forms were used by the Applicant. Nonetheless she could not specify the extent of their use.

[108] As it appears from the evidence described above the Mark has been used since at least as early as 1980 while evidence of use of one of the Opponent's Registered trade-marks (LIBERTÉ 55) goes back to 1985. In fact Ms. Noye admitted during her cross-examination that not all of the Opponent's Registered trade-marks were in use in 1984. This factor favours the Applicant no matter which one of the Opponent's Registered trade-marks is compared with the Mark.

The nature of the services

[109] As stated in the Opponent's written argument: 'While it is true that the parties' respective wares and services are not identical, and are in fact mutually exclusive as they are dictated by statute, they remain of the same general class from the perspective of the average consumer. They are both in the insurance services field.'

[110] The Applicant argues that the parties' services differ. The Services cover property and casualty insurance, general liability insurance, and personal lines insurance, while the Opponent's services covered by the registrations listed above are life insurance, financial planning, savings and investment services.

[111] Ultimately both parties offer insurance services. This factor favours the Opponent.

The nature of the business

[112] The Applicant relies on the Opponent's evidence, namely Ms. Noye's affidavit and her cross-examination to argue that the parties' businesses are different. Ms. Noye states in her affidavit that the Opponent's financial security advisors personally consult with clients to assess

and advise on their individual financial security needs and offer clients the full array of the Opponent's and third-party products and services.

[113] During her cross-examination she stated that:

- One of the goals is providing customers with long-term financial planning. (Q47 & 48)
- People are buying life insurance through the financial security advisors and not through the Internet. (Q64)
- So when the consumer is making the decision to buy he knows with whom he is dealing. (Q66)
- The Opponent's security advisors are essentially exclusive to it. (Q72)
- The Opponent offers life and health insurance and not automobile, property and casualty insurance. (Q74-77)
- The Opponent's financial advisors do not offer the Applicant's insurance products. (Q123)

[114] We also have the affidavit of Mr. John Wintoniak, a Broker in Damage Insurance with Wintoniak & Motard Assurances, a Montreal firm that he created with his partner in 2005. He has been a Broker in Damage Insurance in Quebec for over 35 years. He states that because of the complexities involved with this type of insurance the clients will consult him prior to purchasing damage insurance products. He does offer the Applicant's products.

[115] The Applicant argues that the evidence shows the parties' insurance services are provided through advisors or brokers and as a result the clients are informed on the nature of the products they will purchase. Consequently, given also that the products are expensive and complex in nature, the consumer will be aware as to the source of origin of the services being provided.

[116] The Supreme Court of Canada in *Masterpiece* has discussed this issue in the following terms:

71. It is not relevant that, as the trial judge found, consumers are "unlikely to make choices based on first impressions" or that they "will generally take considerable time to inform themselves about the source of expensive goods and services" (para. 43). Both of these — subsequent research or consequent purchase — occur *after* the consumer encounters a mark in the marketplace.

72. This distinction is important because even with this increased attentiveness, it may still be likely that a consumer shopping for expensive goods and services will be confused by the trade-marks they encounter. Careful research and deliberation may dispel any trade-mark confusion that may have arisen. However, that cannot mean that consumers of expensive goods, through their own caution and wariness, should lose the benefit of trade-mark protection. It is confusion when they encounter the trade-marks that is relevant. Careful research which may later remedy confusion does not mean that no confusion ever existed or that it will not continue to exist in the minds of consumers who did not carry out that research.

73. Indeed, *before* source confusion is remedied, it may lead a consumer to seek out, consider or purchase the wares or services from a source they previously had no awareness of or interest in.(...)

74. For these reasons, it was an error to discount the likelihood of confusion by considering what actions the consumer might take after encountering a mark in the marketplace. The trial judge should have instead limited his consideration to how a consumer, upon encountering the Alavida mark in the marketplace, with an imperfect recollection of the Masterpiece Inc. mark, would have reacted. Because consumers for expensive retirement residence accommodation may be expected to pay somewhat more attention when first encountering a trade-mark than consumers of less expensive wares or services, cost is not irrelevant. However, in circumstances where a strong resemblance suggests a likelihood of confusion, and the other s. 6(5) factors do not point strongly against a likelihood of confusion, then the cost is unlikely to lead to a different conclusion.
(my underlines)

[117] Therefore the distinction in the nature of the parties' business does not appear to be as decisive as the Applicant would like it to be. They are both in the business of offering and selling insurance services. As mentioned above the likelihood of confusion between the parties' trade-marks must be assessed when the consumer is put in contact for the first time with the Applicant's Mark. This could very well happen after seeing an advertisement in a magazine or consulting the Yellow Pages® and being vaguely aware of one the Opponent's Registered trade-marks.

[118] In all I consider this factor to slightly favour the Opponent.

The degree of resemblance

[119] In its judgment in *Masterpiece* the Supreme Court of Canada has clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks. Also it alluded to the fact that, for the purpose of distinguishing two trade-marks, in the past it has been decided that the first word was the most important. However the Supreme Court of Canada has suggested that the preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique, which would then be considered as the dominant portion of a trade-mark [see *Masterpiece, supra*, para. 63].

[120] There is no doubt in my mind that the dominant portion of the Mark as well as in each of the Opponent's Registered trade-marks is the component LIBERTÉ. It creates some visual and phonetic resemblance between the parties' trade-marks. However when the marks are viewed as a whole, the ideas suggested by each trade-mark differs. For example LIBERTÉ 55 suggests the idea of financial freedom at the age of 55, while the Mark either suggests that the parties to a insurance contract would enjoy mutual freedom or that the Services are provided by a mutual insurance company. On this point I may add that I acknowledge the fact that I must also take into consideration the unilingual English and bilingual consumer. However I believe the likelihood of confusion if any, to be greater within the French speaking population as they will be able to understand the meaning of the words comprising each trade-mark in issue.

Additional surrounding circumstances

[121] The weight to be given to each of these factors may be diminished or strengthened by other relevant factors such as: the state of the register and the marketplace, the existence of a family of trade-marks. Also the fact that the common dominant element (LIBERTÉ) is inherently weak will have to be taken into consideration in the equation. Finally the coexistence of the marks in issue over a long period of time may also be considered.

i) state of the register and marketplace

[122] The Applicant filed state of the register and of the marketplace evidence through the affidavit of Christina I. Doria, a student when she executed her affidavit, employed by the Applicant's agent firm. She filed two excerpts of the register, namely:

VILLAGE LIBERTÉ, TMA606899, for management of a residence for persons over 50;

ASSOCIÉS...POUR CRÉER VOTRE PROSPÉRITÉ ET VOTRE LIBERTÉ FINANCIÈRE, TMA707819, for various financial services.

[123] She also consulted and filed extracts of four websites where the expression 'liberté financière' is used as a business name, trade name or slogan.

[124] She was then asked to contact a representative of each of these six businesses but was able to speak with only 3 of them. This evidence falls far short of establishing the widespread use of the word 'LIBERTÉ' as part of third parties' trade-marks or trade names in association with insurance and/or financial services. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where a large number of relevant registrations have been located [see *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)]. Therefore I cannot infer that Canadian consumers are accustomed to see numerous trade-marks or trade names comprising the word 'LIBERTÉ' used in association with insurance and/or financial services such that they can distinguish them.

[125] In view of the weight to be given to this evidence I do not need to address the issue of hearsay evidence raised by the Opponent but not developed in-depth in its written argument [see paragraph 67 of the Opponent's written argument] or at the hearing.

ii) Family of trade-marks

[126] The fact that the Opponent is the registered owner of many trade-marks in Canada incorporating a word is not sufficient to benefit from a wider scope of protection associated with the existence of a family of trade-marks. There must be evidence of actual prior use of those trade-marks [see *MacDonald's Corporation v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101]. I already concluded above that there has been some evidence of use of the Opponent's Registered trade-marks. As such I must consider the fact that there exists a family of trade-marks owned by the Opponent comprising the word 'LIBERTÉ' used in association with life insurance.

iii) Coexistence of the marks in issue

[127] To support its contention that there is no likelihood of confusion between the Mark and the Opponent's Registered trade-marks, the Applicant argues that the parties' marks have co-existed for a period of over 18 years without any evidence of instances of confusion.

[128] In *Mattel, Inc v 3894207 Canada Inc* (2006) 49 CPR (4th) 321 (SCC) the Supreme Court of Canada addressed this issue in the following terms:

55 Evidence of actual confusion would be a relevant "surrounding circumstance" but is not necessary (*Christian Dior S.A.*, at para 19) even where trade-marks are shown to have operated in the same market area for ten years: *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (Fed. C.A.). Nevertheless, as discussed below, an adverse inference *may* be drawn from the lack of such evidence in circumstances where it would readily be available if the allegation of likely confusion was justified.

[129] To prove its point the Applicant is relying on the following:

- Allegation contained in paragraph 20 of Clint#1 affidavit where he states that he is unaware of any instance where a Canadian consumer was confused as to the source of the services associated with the Mark or mistook the Services for someone else's services;

- Allegation contained in Mr. Wintoniak's affidavit that he never came across a customer that mistook the Applicant's products or services for those of the Opponent;
- Cross-examination of Ms. Noye where she stated that she was not aware of any incidents where a customer bought a LIBERTÉ 55 product thinking it was buying someone else's product or that a consumer bought someone else's product and mistakenly thought he was buying a LIBERTÉ 55 product. (Q221-222 of her cross-examination).

[130] In order to give this factor a certain weight there has to be evidence of sufficient volume of actual concurrent use of the marks in issue within the same area. Moreover in most instances where the Registrar relied on this factor, it was to support a conclusion of absence of likelihood of confusion. It was not a determining factor by itself.

[131] In this case the paucity of the evidence of use of the Mark as described above could very well explain the absence of actual instances of confusion. The Applicant's volume of sales has not been broken down per trade-mark and per province. Therefore it is impossible to determine if there has been enough commercial activities in the Province of Quebec, in particular, in association with the Mark to conclude in favour of the Applicant on this issue.

Conclusion on the likelihood of confusion

[132] In all I have not been convinced by the Applicant that the Mark is registrable. I reach this conclusion based on the following:

- Despite the fact that none of the Opponent's Registered trade-marks are inherently distinctive strong marks, the Opponent has established that the Mark LIBERTÉ 55 is more known than the Mark;
- There is evidence of the existence of a family of trade-marks;
- There are only two other registered trade-marks owned by third parties that contain the element LIBERTÉ in association with some kind of financial services;

- The word MUTUELLE is at least suggestive of the type of insurance company offering the Services;
- Finally the parties' services fall in the general category namely insurance services.

[133] As the ultimate onus is on the Applicant to prove, on a balance of probabilities, that the Mark is registrable, I have no other alternative but to conclude in favour of the Opponent and maintain this ground of opposition [see *Mattel, supra*].

XII Lack of Distinctiveness of the Mark Based on Likelihood of Confusion with the Opponent's Trade-marks

[134] As discussed earlier the distinctiveness ground of opposition as drafted has two prongs. The second prong is based on the fact that the Mark cannot nor is it adapted to distinguish the Services from the Opponent's services as it is confusing with the Opponent's trade-marks. Under this ground of opposition the Opponent has not referred to specific trade-marks. The Applicant has not requested particulars. Consequently I must assess this ground of opposition in light of the evidence in the record [see *Novopharm v AstraZeneca AB* (2002), 21 CPR (4th) 289 (FCA)]. It becomes obvious from the Opponent's evidence, that it intended to rely not only on the use of the Opponent's Registered trade-marks but also on the use of the trade-marks FINANCIÈRE LIBERTÉ 55 and FINANCIÈRE LIBERTÉ 55 & Bird Design.

[135] The Opponent has the initial evidential burden to prove that its Registered trade-marks had become sufficiently known in Canada on December 27, 2001 in association with life insurance and financial services to negate the distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD) and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FCTD)]. If this initial burden is met then the Applicant has a legal onus to show, on a balance of probabilities, that the Mark was not confusing with the Opponent's trade-marks at the relevant date such that it was adapted to distinguish or actually did distinguish throughout Canada the Services from the Opponent's services [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[136] The Opponent's evidence described above is sufficient to conclude that it has met its initial burden of proof in so far as LIBERTÉ 55, FONDS LIBERTÉ and LA LIBERTÉ COMMENCE AUJOURD'HUI are concerned [see paragraph 101 above]. Consequently the issue becomes whether there was, at the relevant date, a likelihood of confusion between the Mark and any of those Opponent's Registered trade-marks.

[137] I do not need to summarize the evidence of use of the Opponent's trade-marks FINANCIÈRE LIBERTÉ 55 and FINANCIÈRE LIBERTÉ 55 & Bird Design as at best it would add two trade-marks to consider in the assessment of the criteria listed under section 6(5) of the Act and would be included in the Opponent's family of LIBERTÉ trade-marks.

[138] The difference in the material date would not favour the Applicant and thus would not have any impact on my analysis of the criteria already done under the ground of registrability of the Mark.

[139] Consequently I conclude the Applicant failed to prove, on a balance of probabilities, that the Mark was distinguishing, or was adapted to distinguish the Services from the Opponent's services at the material date. Therefore this ground of opposition is also maintained.

XIII Closing Remarks

[140] I am well aware of the fact that I may not have discussed the content of some affidavits filed or other portion of affidavits already referred thereto. This has been done on purpose as such evidence would not alter my findings; or was irrelevant to the issues that had to be addressed in this decision; or finally was of little probative value.

[141] Finally some other legal issues could have been argued by the Opponent in view of its evidence filed. For example the fact that the Applicant ceased using the Mark in Canada by virtue of the sale of some parts of its business. No arguments were presented on this issue. The conclusions reached in this decision are sufficient to dispose of this opposition.

XIV Disposition

[142] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application to register the Mark in association with the Services pursuant to section 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule A

The grounds of opposition now presently pleaded can be summarized as follow:

1. The application does not comply with the requirements of section 30(i) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) in that the Applicant cannot be satisfied that it is entitled to register the Mark in Canada in view of its knowledge of the Opponent using trade-marks containing the element LIBERTÉ for similar services;
2. The application does not comply with the requirements of section 30(b) of the Act in that the Applicant has not used the Mark in Canada in association with the Services since at least as early as December 1936 as alleged in the application or to the extent that there has been any use, which is not admitted but denied (i) such use was not within the meaning of section 4 of the Act or (ii) there is no further use of the Mark as a result of a sale by the Applicant of its health business in June 2003 and its personal lines property and casualty operations including automobile and homeowners insurance in 2004;
3. In the alternative, or cumulatively, the Opponent further bases its opposition on the fact that the application does not comply with the requirements of section 30(b) of the Act, in that at the alleged date of first use claimed by the Applicant, the Mark was used by other entities, which were not licensed to use the Mark in accordance with the provisions of section 50 of the Act or if they were, such license did not provide for the Applicant to have direct or indirect control of the character or quality of the services and/or the Applicant did not exercise such direct or indirect control as required by section 50 of the Act;
4. The Mark is not registrable in view of section 12(1)(d) of the Act since the Mark is confusing with the Opponent's registered trade-marks LIBERTÉ 55, certificate of registration TMA308,603 for life insurance, financial planning and investment services and investment savings plans; EN LIBERTE certificate of registration TMA403,990 in association life insurance, financial planning and savings and investment services; FONDS LIBERTÉ, certificate of registration TMA497,737 in association with life insurance, financial planning, savings and investment services; LIBERTE PREMIERE certificate of registration TMA403,991 in association with life insurance, financial planning, savings and investment services; and LA LIBERTÉ COMMENCE AUJOURD'HUI certificate of registration TMA498,349 in association with insurance services and

financial services namely providing, managing and administering employee benefit plans, retirement savings plans, pension plans, investment savings plans, investment services, financial planning services, asset management, financial administration services, lending services, mortgage administration services;

5. The Mark is not distinctive of the Services of the Applicant since it does not actually distinguish nor is it adapted to distinguish the Services from the services of the Opponent which has used trade-marks containing the element LIBERTÉ in Canada, or others.
 - a) Without limiting the generality of the foregoing the Mark is not distinctive of the Services since any purported use of the Mark which is not admitted but denied, would have been made by one or more other entities that used the present trade-mark or one or more LIBERTÉ- or LIBERTY- formative trade-marks without being subject to a license that meets the requirements of section 50 of the act;
 - b) Alternatively or cumulatively, to the extent that the Applicant authorized other entities to use the Mark or one or more of its LIBERTÉ-or LIBERTY- formative trade-marks such use was outside the scope of the provisions provided for by section 50 of the Act, since the license did not provide for the Applicant to have direct or indirect control of the character or quality of the Services and/or the Applicant did not exercise such direct or indirect control.

Schedule B

Oppositions filed by London Life Insurance Company
796174(LIBERTÉ INTERNATIOANLE CANADA)
796175 (LIBBERTÉ MUTUELLE)
796178 (LIBERTÉ INTERNATIONALE)
Oppositions filed by Liberty Mutual Insurance Company
835160 (LIBERTÉ ET POUVOIR)
835161 (LA LIBERTÉ DE CHOISIR. LE POUVOIR DE RÉALISER)
835164 (LA LIBERTÉ DE CHOISIR)
1065522 (FINANCIÈRE LIBERTÉ 55)
1065524 (FINANCIÈRE LIBERTÉ 55 & Design)
1079488 (FINANCIÈRE LIBERTÉ 55 & Chinese Characters & Design)
1079490 (FINANCIÈRE LIBERTÉ 55 & Chinese Characters & Design)
1118020 (FINANCIÈRE LIBERTÉ 55 & Design)