



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

**Citation: 2011 TMOB 173**  
**Date of Decision: 2011-09-14**

**IN THE MATTER OF AN OPPOSITION  
by Sun Life Company of Canada to  
application No. 1,265,002 for the trade-  
mark ÉTABLISSEMENT STANDARD  
GARANTI in the name of Royal Bank of  
Canada – Banque Royale du Canada.**

[1] On July 14, 2005 Royal Bank of Canada (the Applicant) filed an application to register the trade-mark ÉTABLISSEMENT STANDARD GARANTI (the Mark) for use in association with “insurance services” (the Services) since May 2004.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 1, 2006. On December 5, the Opponent filed a statement of opposition. The Opponent pleaded grounds of opposition under s. 38(2)(a), (b), and (d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act).

[3] The Applicant filed and served a counter statement in which it denied the Opponent’s allegations.

[4] The Opponent filed the affidavit of Mr. Norm Leblond on August 27, 2007 together with Exhibits A1 through A19. The Applicant filed a certified copy of its registration No. TMA567,636 for the trade-mark GUARANTEE STANDARD ISSUE. No reply evidence was filed and Mr. Leblond was not cross-examined on his affidavit. Both parties filed written arguments; only the Opponent was represented at the oral hearing.

## Grounds of Opposition

[5] The grounds of opposition are summarized as follows:

### *Section 38(2)(a)*

- The Application does not conform to the requirements of s. 30 because the proposed alleged trade-mark does not fall within the definition of a trade-mark in s.2 of the Act as it is a clearly descriptive term that has become recognized by ordinary and *bona fide* commercial usage in Canada as designating the kind of services for which registration is sought.
- The Application does not conform to the requirements of s. 30(b) since the Applicant has not used the alleged Mark in Canada since the date of first use claimed (May 2004), or at all.
- The Application does not conform to the requirements of s. 30(i) since at the date of filing of the application, at the alleged date of first use and at all relevant times, contrary to the statement contained in the application, the Applicant could not, and cannot be satisfied that it was, and is, entitled to use the proposed Mark in Canada in association with “insurance services” having regard to its descriptiveness and the fact that it is a term that has by ordinary and bona fide commercial usage become recognized in Canada as designating the kind of services for which registration is sought, namely “insurance services”.

### *Section 38(2)(b)*

- The Application is not registrable in view of s. 12(1)(b) of the Act because it is clearly descriptive in the French language of the character or quality of the services in association with which it is proposed to be used, namely “insurance services” , since it clearly describes that such services are “établissement garanti”; a term commonly known

in the insurance industry for insurance policies that can be issued with limited underwriting.

*Section 38(2)(d)*

- The Mark is not distinctive of the Applicant because it does not actually distinguish, nor is it adapted to distinguish the services of the Applicant from those of others who deal in the same class of services, namely “insurance services”, as it has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind of services for which registration is sought, namely “insurance services”.

Onus

[6] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts, alleged to support each ground of opposition, exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Material Dates

[7] The material dates relating to the grounds of opposition at issue are generally recognized as:

- non-compliance with s. 30 of the Act: filing date of the application (July 14, 2005), [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 at 475 (T.M.O.B.)].
- non-registrability of the Mark under s. 12(1)(b) of the Act: filing date of the application, [see *Zorti Investments Inc v. Party City Corp.* (2004), 36 C.P.R. (4<sup>th</sup>) 90 (T.M.O.B.); *Havana Club Holdings S.A. v. Bacardi & Co.* (2004), 35 C.P.R. (4<sup>th</sup>) 541 (T.M.O.B.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4<sup>th</sup>) 60 (F.C.T.D.)].

- non-distinctiveness of the Mark under s. 2 of the Act: the filing date of the statement of opposition (December 5, 2006) [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)]

[8] I will discuss below what I consider to be the most relevant portions of the Opponent's evidence.

*The Affidavit of Mr. Norm Leblond*

[9] Mr. Leblond is a Director, Technical Underwriting, employed by Sun Life Assurance Company of Canada. He has held this position since June 2006, prior to which he was a Senior Underwriting Consultant. He further provides that he is a member of the Canadian Institute of Underwriters (CIU) and is currently the Vice-Chair of the Executive Council of the CIU. He has over 12 years of experience in underwriting, and has an AALU (Associate-Academy of Life Underwriting) designation.

[10] His affidavit is directed towards establishing that the Mark is descriptive and has become recognized in Canada as designating the kind of services for which registration is sought, namely "insurance services".

[11] He states firstly that his experience in the insurance industry has made him familiar with terminology used, and that he is familiar with the term ÉTABLISSEMENT STANDARD GARANTI, its English equivalents GUARANTEE STANDARD ISSUE and GUARANTEED STANDARD ISSUE and with similar terms such as GUARANTEED STANDARD-ISSUE, GUARANTEED ISSUE, GURANTEED-ISSUE, and ÉTABLISSEMENT GARANTI. He states that these terms are used to designate or describe insurance services that relate to insurance policies that can be issued with limited underwriting.

[12] He provides the following explanation of these words:

- *Guaranteed*- this term is commonly used in the life and health insurance industry to describe the promise of being offered insurance of a certain amount. It can also mean the promise of being offered insurance of a certain amount at certain rates depending on the health and lifestyle of the person whose life is to be insured.

- *Issue* – this term is commonly used in the life and health insurance industry to describe an insurer’s act of producing, printing and delivering a policy of life or health insurance to a policy owner.
- *Standard* – this term is commonly used in the life and health insurance industry to describe the classification of an applicant for life or health insurance whose health, lifestyle or other risk factors are those for which normal or standard premium rates are based.
- *Guaranteed Issue* - this term is commonly used in the life and health insurance industry to describe an insurer’s promise to offer insurance to an applicant with no or very minimal amounts of evidence of insurability required.
- *Guaranteed Standard Issue* - the life and health insurance industry offers insurance to an applicant based on very limited underwriting requirements similar to what the industry applies when underwriting groups for group insurance.

[13] The affiant provides that he is fluent in both English and French and asserts that a correct French translation of the terms GUARANTEE STANDARD ISSUE and GUARANTEED STANDARD ISSUE is ÉTABLISSEMENT STANDARD GARANTI.

[14] Mr. Leblond further provides that descriptive uses of the above terms, in English and French, can be readily found in insurance underwriting and insurance industry manuals, on the Internet, are in common use by other insurance companies and brokers and can be found in on-line glossaries. In support of these statements he provides as Exhibits, copies of front covers, copyright information page and copies of excerpts of four books, copies of pages from 14 Insurance related websites, and a definition from an on-line insurance glossary.

[15] Exhibit A1 comprises copies of some pages from *Life Company Underwriting* by Charles A Will. The pages explain two types of *guaranteed issue* insurance; (a) *guaranteed standard issue* and (b) *guaranteed no declination*. According to the author, *guaranteed standard issue* provides participants with a plan with minimal underwriting requirements, whereas *guaranteed no declination* guarantees all participants coverage. Underwriting appears to refer to the gathering of information such as age, occupation, medical history, etc, on respective participants

to assess availability of coverage. There is no indication of where or when this book was published.

[16] Exhibit A2 comprises copies of some pages from a book entitled *Disability Income - The Sale The Product The Market* by Jeff Sadler. The excerpted pages appear to relate to information for employers on how to enroll employees in a disability plan and organize payroll deductions. The writer recommends that if an employee declines coverage, the employee should sign a waiver form and provides a copy of one “utilized for solicitation during a *guarantee issue* program”. In the waiver form in the paragraphs above the employees signature, the following sentence appears *inter alia*:

“After seriously considering the benefits, I have decided not to apply for coverage. I understand that this coverage is available to me on a *guaranteed issue* basis provided I am actively at work on the effective date of the plan” (Emphasis mine).

[17] One of the additional resources listed on the page for this topic is an article entitled “*Guaranteed Issue Disability Through Payroll Deduction*” by Robert G. Price. The copyright notice indicates that the book was first published in 1991 and again in 1995; the book appears to have been published in the United States.

[18] Exhibit A3 consists of photocopies of some pages from a book titled *Life Insurance* by Kenneth Black, Jr. and Harold D. Skipper, Jr. The book appears to have been printed in the United States well prior to the date of the subject application. There is a section with the heading *Guaranteed Issue Insurance* under which is an explanation consistent with the explanation the affiant provides and that appears in the pages referred to above.

[19] Exhibit A4 comprises photocopies of some pages of the book *Underwriting in Life and Health Insurance Companies*, edited by Richard Bailey, FLMI. It appears to be a publication of the FLMI Insurance Education Program, Life Management Institute LOMA, Atlanta, Georgia. Further, it appears from a library stamp on the cover page, that it was part of the Mutual Life of Canada Library in 1985. In the pages provided there is a section on Guaranteed-issue Products which explains that with guaranteed-issue insurance, no individual underwriting takes place and all eligible members of a particular group of proposed insureds who apply and meet certain

conditions established by the insurer are automatically issued a policy. Again, this appears consistent with the affiant's explanation above.

[20] The bulk of the remaining Exhibits are web pages from various third party insurance company websites, all of which list or reference *Guaranteed Issue* products; five of the websites refer to *Guaranteed Standard Issue* products or programs. For example:

- Exhibit A6 includes pages from the French language website of Manulife Financial/Financière Manuvie, in particular, an application form titled “*Demande D’Assurance-Vie Á Établissement Garanti*” [sic].
- Exhibit A7 is a page from the *National Post* published July 21, 2006 containing an advertisement by the Canada Protection Plan insurance company for a *Guaranteed Issue Life Insurance Policy*.
- Exhibit A9 consists of extracts (in both English and French) from the 2003 Annual Report available on Great West Life Insurance Company website. The Annual Report clearly relates to the Canadian insurance industry and there is reference on page 33 of the Report to the launch of Great West Life's pilot *Guaranteed Standard Issue* program in 2002. The equivalent French text refers to this program as “un programme pilote sur les ventes de contrats à *établissement standard garanti* en 2002”.
- Exhibit A10 is a copy of a 2003 newsletter entitled *Group Benefits Update* from an insurance broker in Ontario, which clearly lists as one of the benefits - *GSI – Guaranteed Standard Issue Products*.
- Exhibit A12 comprises copies of pages of a newsletter dated August 2005 issued by PPI Financial Group, an insurance company with offices across Canada. The newsletter provides an explanation of critical illness group coverage, noting the difference between individual coverage which is medically underwritten, and group coverage available on a “*guaranteed issue*” basis. The newsletter further explains that the benefit of this coverage is that it provides access to those who for medical reasons could not get any coverage on an individual basis. The equivalent report in French refers to “*établissement garanti*”.

- Exhibit A17 is a printout of a page entitled Canadian Health Travel Insurance Blog, dated February 24, 2006, that discusses *Guaranteed Issue Health Plans*. In this discussion is a description of a *standard* health plan that excludes pre-existing conditions, and a *guaranteed issue* health insurance plan that will cover a pre-existing condition.
- Exhibit A19 provides a page from what appears to be an online Life Insurance Glossary that is part of a website called *Insurance Options Guide*; there is an entry for *Guaranteed Standard Issue* that defines it as an underwriting term used to describe the fact that a group insurance contract was issued without reference to any medical underwriting. There is no indication of the date of this entry; the page was printed on August 22, 2007.

### *Discussion of the Evidence*

[21] The Applicant argues that the web pages consist of statements of third parties and therefore should be considered inadmissible as hearsay, and further that there is no evidence that Canadians accessed the websites. The Applicant further argues, with respect to the extracts from books, that there is no evidence that the books were available in Canada; rather they appear to have been printed in the United States.

[22] I understand the argument that information from third party websites cannot be considered evidence as to the *truth* of their contents and should therefore be considered inadmissible as hearsay; however, I am of the view that it is reasonable to accept the repeated references to *Guaranteed Issue*, and *Guaranteed Standard Issue* on websites of various companies across Canada as support for the existence of these words as trade terms in the insurance industry.

[23] I do not think that the legislative intent behind opposition proceedings is to burden parties with expensive processes such as engaging independent experts to provide evidence of meaning of words and trade-terms, where other evidence is more readily available. Common sense must prevail, and in the present circumstances there are multiple sources from a variety of insurance companies across Canada all using the same words; this is a logical and reasonable method of introducing evidence and I am therefore willing to give some evidentiary weight to these Exhibits.



[24] I am also of the view that the abundance of the evidence, namely, the fact that the same information appears in the books and on multiple Canadian web pages relating to the Canadian insurance industry and clearly directed to Canadian consumers, adds support to Mr. Leblond's own explanation of the terms as used in the insurance industry.

[25] With respect to the books, while I agree that the books appear to have been published in the United States, common sense would dictate that the insurance industry in the United States and Canada would be somewhat similar and therefore I will afford these excerpts some weight in the determination. Furthermore, the "Library of Mutual Life of Canada 1985" stamp on the cover page of Exhibit A4 supports the inference that at least one of these books was relevant to the Canadian insurance industry well before the date of filing of the subject application.

[26] In any event, I find it persuasive that multiple Canadian websites, from local insurance brokers to large insurance companies, list *Guaranteed Issue* and/or *Guaranteed Standard Issue* products. I note that in none of the instances is the expression identified as a trade-mark or the product of any specific insurance company. Further, while some of the website evidence is dated after both the application date and the date of filing of the opposition, there are Exhibits, as noted above, dated before the application date, as well as some before the date of filing of the statement of opposition. I also note that the extracts from the books indicate that the books were published well prior to the date of application.

[27] In addition, having reviewed the material provided in the French language, I am willing to accept that *Établissement Standard Garanti* is used for the same purpose when providing insurance services in French.

#### Applicant's Evidence

[28] The Applicant filed a certified copy of its English language trade-mark registration No. TMA567,636 for GUARANTEE STANDARD ISSUE. I observe in this regard that ownership of a registration for the Mark in English does not give the Applicant the automatic right to the registration of the same or similar Mark in French no matter how closely the trade-marks may be related, since arguably, the English trade-mark might not have been descriptive at the time it was filed. In any event, during the examination stage, the Registrar does not have the same access to

evidence regarding descriptiveness, and the Applicant does not have the same burden to prove its trade-mark is registrable, since, under s. 37(1)(b), trade-marks can only be refused at the examination stage if the Registrar is *satisfied* that trade-mark is *not* registrable □see *American Cyanamid Co. v. Stanley Pharmaceuticals Ltd.* (1996), 74 C.P.R. (3d) 571 (T.M.O.B.); *Ralston Purina Canada Inc. v. H.J. Heinz Co. of Canada* (2000), 6 C.P.R. (4th) 394 (T.M.O.B.)□. Therefore, this registration is not relevant to this proceeding.

Section 38(2)(b)/ Not Registrable under s.12(1)(b)

[29] I will first consider the ground of opposition under s. 12(1)(b). The Opponent has pleaded that the Mark is not registrable on the basis that it is clearly descriptive or deceptively misdescriptive in the French language of the character or quality of the services in association with which it is proposed to be used, namely “insurance services” since it clearly describes that such services are “*établissement garanti*”, a term commonly known in the insurance industry for insurance policies that can be issued with limited underwriting.

[30] The issue as to whether the Mark is clearly descriptive must be considered from the point of view of the average purchaser of the associated services. Furthermore, the Mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [*Atlantic Promotions Inc. v. Registrar of Trade Marks*, (1984) 2 C.P.R. (3d) 183 at 186 (F.C.T.D.)]. “Character” in s. 12(1)(b) means a feature, trait or characteristic of the wares or services and “clearly” means “easy to understand, self-evident or plain” [*Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 at 34 (Ex. Ct.)].

[31] The Opponent’s initial evidentiary burden has been met in view of the fact that these words are clearly dictionary words that have some significance in the insurance industry. The Applicant now has the legal burden of demonstrating that its trade-mark was registrable at the date of filing of the application.

[32] As I understand the Opponent’s argument, since “standard” is also a known term used to denote a “standard” insurance policy, the phrase in its entirety - ÉTABLISSEMENT STANDARD GARANTI, clearly describes a guaranteed issue standard policy, that is to say, one

guaranteed and without exclusions. I accept Mr. Leblond's explanation of the terms, and that they are accepted trade-terms, both individually and taken together as an expression, on the basis of his experience in the field, and the abundance of evidence from the web pages, the books, and the definition found in the *Life Insurance Glossary* attached as Exhibit A19.

[33] In my view, the evidence demonstrates that at the application date insurance companies in Canada were offering *guaranteed issue* products, and *guaranteed standard issue* products. I note that there is no evidence that either of these terms was, in effect, used as a trade-mark; rather they appear to be used to describe a particular benefit of group insurance plans. The equivalent expression was also being used in French, as evidenced by Exhibits A9 and A12.

[34] I am therefore satisfied that the Mark was clearly descriptive of the specific character of the "insurance services" offered by the Applicant at the date of the subject application, namely, that the said services include providing *guaranteed standard issue* insurance to participants. This ground of opposition is successful.

#### Section 38(2)(d)/s. 2 Non-Distinctiveness

[35] The Opponent has alleged that the term ÉTABLISSEMENT STANDARD GARANTI is a common and well-known term in the insurance underwriting and insurance industry, used to designate or describe insurance services that relate to insurance policies that can be issued at standard rates with limited underwriting.

[36] The material date for assessing distinctiveness is the date the statement of opposition was filed, namely December 5, 2006. I am satisfied that for the reasons set out above with respect to s. 12(1)(b), that the Mark is descriptive of "insurance services"; no evidence has been filed to indicate that the Mark has acquired any secondary meaning. Therefore, I am of the view that the reasoning in *Canadian Council of Professional Engineers v. APA-The Engineered Wood Assn.* (2002), 7 C.P.R. (4th) 239 (F.C.T.D.) applies. In that decision, Mr. Justice O'Keefe stated "a purely descriptive or a deceptively misdescriptive trade-mark is necessarily not distinctive". Based on my earlier finding that the Mark is clearly descriptive, the difference in material dates being of no consequence in these circumstances, I conclude that the Mark is also not inherently

adapted to distinguish the services of the Applicant from similar services of others. This ground of opposition is successful.

[37] Having found the Opponent successful on two grounds of opposition, it is unnecessary to make a determination on any other issues.

Disposition

[38] Pursuant to the authority delegated to me under s. 63(3) of the Act, and pursuant to s. 38(8) of the Act, the subject application is hereby refused.

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P. Heidi Sprung  
Member,  
Trade-marks Opposition Board  
Canadian Intellectual Property Office