

accident death and dismemberment insurance; voluntary life insurance; voluntary accidental death and dismemberment insurance; dependent life insurance; long term disability insurance; short term disability insurance; vision care; dental care; group home insurance; group auto insurance; discount auto leasing; health club insurance; prepaid legal insurance; daycare coverage; individual disability and life protection; benefit communication services, namely by telephone, e-mail, regular mail or in person; extended health care; health travel plan outside Canada.

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the goods and services specified in the registration at any time within the three-year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is between October 11, 2010 and October 11, 2013.

[4] The relevant definitions of “use” are set out in sections 4(1) and 4(2) of the Act as follows:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[5] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270].

[6] In response to the section 45 notice, the Owner furnished the affidavit of Vic Medland, its Chief Executive Officer, sworn on May 8, 2014. Only the Requesting Party filed written representations; a hearing was not held.

The Owner's Evidence

[7] In his affidavit, Mr. Medland states that the Mark has been in continuous use in Canada during the relevant period by the Owner in conjunction with providing third-party administration services for education employees for the following fringe benefits: group life insurance, group optional life insurance, group accident death and dismemberment insurance, voluntary life insurance, voluntary accidental death and dismemberment insurance, dependent life insurance, long term disability insurance, short term disability insurance, vision care, dental care, group home insurance, group auto insurance, daycare coverage, individual disability and life protection, benefit communication services, namely by telephone, e-mail, regular mail or in person, extended health care and health travel plan outside Canada.

[8] He also states that the Mark has been continuously used in Canada by the Owner in conjunction with the following goods: golf shirts, jackets, pens, bags, key chains, cooler bags, mugs, golf balls, tees, ball markers, and t-shirts.

[9] Mr. Medland attaches to his affidavit various application forms, brochures and booklets (Exhibits B – CC), all of which feature the Mark. Mr. Medland explains that these documents relate to the provision of the services identified above and were used by the Owner during the relevant period. The application forms are for enrollment of members in life, health care, disability and dental care insurance programs and include sections pertaining to applicant information, beneficiary information, privacy and payment. The brochures provide general information about the benefits offered and contact information so that members can obtain more information. The booklets provide further details regarding the different benefits including eligibility, premiums, and exclusions, and, in some cases, referral information.

[10] I note that the exhibits are silent with respect to the following registered services: third-party administration services for educational employees for daycare coverage, discount auto leasing, health club insurance and prepaid legal insurance. Although Mr. Midland asserts that the Mark was used in association with administration services for “day care coverage”, and points to Exhibit W in support, this exhibit rather appears to reference home business protection insurance.

[11] With respect to the registered goods, Mr. Medland attaches to his affidavit photographs of a golf shirt, a jacket, pens, a key chain, a cooler bag, mugs, golf balls, golf tees, a ball marker and a t-shirt, all of which display the Mark (Exhibits DD - NN) . He explains that these photographs show examples of promotional items in use by the Owner during the relevant period. Lastly, Mr. Medland attaches printouts from the website *www.otip.com* (Exhibit OO). The exhibited pages display the Mark and refer to a number of services offered by the Owner.

Use with respect to the Goods

[12] In its written representations, the Requesting Party submits that the Owner has failed to provide evidence of the normal course of trade with respect to the registered goods.

[13] Section 4(1) of the Act requires use with respect to goods be “in the normal course of trade”; the word “trade” in this context contemplates a type of commercial transaction (purchase, sale or rental) involving the goods in question, or contemplates the goods being the subject of transactions carried out to create goodwill for the goods and to make profits thereon [see *Renaud Cointreau & Cie v Cordon Bleu International Ltd* (1993), 52 CPR (3d) 284 (TMOB), *aff’d* (2000), 188 FTR 29]. In this case, Mr. Medland admits that the Goods are “promotional items” and there is no evidence that any free distribution was an object of trade in itself. Accordingly, I am not satisfied that the Owner has demonstrated use of the Mark in association with the Goods during the relevant period within the meaning of sections 4 and 45 of the Act.

Use with respect to the Services

[14] At the outset, I note that the Requesting Party did not make any submissions with respect to use of the Mark in association with any of the Services.

Evidence is Sufficient to Maintain Registration for Most of the Services

[15] In view of the evidence summarized above, I have no difficulty accepting that the Owner has demonstrated use of the Mark in association with the services identified below within the meaning of sections 4(2) and 45 of the Act:

Providing third party administration services for educational employees for the following fringe benefits; group life insurance; group optional life insurance; group accident death and dismemberment insurance; voluntary life insurance; voluntary accidental death and dismemberment insurance; dependent life insurance; long term disability insurance; short term disability insurance; vision care; dental care; group home insurance; group auto insurance; individual disability and life protection; benefit communication services, namely by telephone, e-mail, or regular mail; extended health care; health travel plan outside Canada.

Evidence is Not Sufficient to Maintain the Registration for some of the Services

[16] As noted above, Mr. Midland makes no assertion of use and the supporting exhibits are silent with respect to the provision of administration services for “discount auto leasing”, “health club insurance”, and “prepaid legal insurance”. Furthermore, although Mr. Midland asserts that the Mark was used in association with administration services for “day care coverage”, I note that none of the supporting exhibits refers to day care coverage. In fact, the exhibited information sheet at Exhibit W he refers to as showing use of the Mark in association with day care coverage, appears to be with respect to home business protection insurance.

[17] Similarly, while Mr. Midland asserts use of the Mark in association with “benefit communication services *in person*”, the exhibits are silent with respect to the provision of services in this manner. Having distinguished “in person” communication services from “...communication services namely by telephone, e-mail, [or] regular mail” in the statement of services, the Owner is obligated to produce evidence with respect to “communication services in person” accordingly [see *Sharp Kabushiki v 88766 Canada Inc* (1997), 72 CPR (3d) 195 (FCTD)]. In this respect, while many of the exhibits include contact information for telephone, email, and regular mail channels, none of the exhibits list physical locations where benefit communications services can be obtained in person and the evidence does not otherwise demonstrate that such services were offered in person.

[18] As such, I am not satisfied that the Owner has demonstrated use of the Mark in association with these remaining services within the meaning of sections 4 and 45 of the Act. As the Owner furnished no evidence of special circumstances excusing such non-use, the registration will be amended accordingly.

Disposition

[19] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended in compliance with the provisions of section 45 of the Act to delete the statement of goods in its entirety and the following from the statement of services: “daycare coverage”, “discount auto leasing”, “health club insurance”, “prepaid legal insurance” and “in person”.

[20] The amended statement of services will be as follows:

Providing third party administration services for educational employees for the following fringe benefits: group life insurance; group optional life insurance; group accident death and dismemberment insurance; voluntary life insurance; voluntary accidental death and dismemberment insurance; dependent life insurance; long term disability insurance; short term disability insurance; vision care; dental care; group home insurance; group auto insurance; individual disability and life protection; benefit communication services, namely by telephone, e-mail, or regular mail; extended health care; health travel plan outside Canada.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

Agents of Record

Miller Thomson LLP

For the Registered Owner

Osler, Hoskin & Harcourt LLP

For the Requesting Party