



LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2017 TMOB 69

Date of Decision: 2017-06-16

IN THE MATTER OF A SECTION 45 PROCEEDING

Cameron IP

Requesting Party

and

**The Canadian Institute of Financial
Planning**

Registered Owner

TMA788,873 for CR

Registration

[1] At the request of Cameron IP (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on February 6, 2015, to The Canadian Institute of Financial Planning, the registered owner of registration No. TMA788,873 for the trade-mark CR (the Mark).

[2] The Mark is registered for use in association with the following goods:

Printed publications, namely, instructional texts relating to the financial services industry, newsletters, and bulletins; online publications, namely, instructional texts relating to the financial services industry, newsletters, web-boards, web-based chat rooms and bulletins.

[3] The Mark is also registered for use in association with the following services:

Educational services in the field of investment and financial planning; financial services, namely financial planning services.

[4] 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 the trade-mark was last used and the reason for the absence of such use since that date. In this case, the relevant period for showing use is between February 6, 2012 and February 6, 2015.

[5] 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.

4(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[6] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainer Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)]

[7] In response to the Registrar’s notice, the Owner furnished the affidavit of Justin Warren, a Director of the Owner, sworn on September 3, 2015 in Mississauga, Ontario. Neither party filed written representations; a hearing was not requested.

The Owner’s Evidence

[8] In his affidavit, Mr. Warren explains that the Owner is a non-profit corporation that provides educational training in the field of investment and financial planning. He states that since 1992, the Owner has trained “thousands of students to become financial planners and

advisors in various industry sectors, including mutual funds, banking, credit unions, securities and insurance.”

[9] With respect to use of the Mark during the relevant period, Mr. Warren attests that one of the Owner’s educational programs is a retirement financial planning program, offered in both French and English. He states that in French, the program is branded “CR®” and that in English, the program is branded “RRC®”.

[10] By way of background, Mr. Warren explains that the CR educational program “provides students a detailed look at how clients plan for retirement, how financial assets are used during retirement and how people make financial decisions during retirement.” He attests that students of the CR program include current or future financial planners, typically employed by Canadian financial institutions, as well as government employees who are involved in providing retirement advice. He states that students of the CR program must pass a final examination administered by the Owner “in order to be entitled to use the CR and RRC marks in Canada under license.”

[11] Mr. Warren attests that the Owner offers its CR program online through its Virtual University portal at *virtualuniversity.cifp.ca*. He states that students can access their online course, print course materials and take in-course assessments through their portal accounts.

[12] Mr. Warren further attests that “students who successfully complete the CR educational program and meet all other requirements” set by the Owner are permitted to use the Mark under license in providing financial planning services. Mr. Warren confirms that the Owner controls the kind and quality of such services provided under the Mark. He states that the Owner “has granted over 1000 students in Canada with a license to use the CR mark in association with financial planning services.”

[13] Finally, Mr. Warren attests that the CR program is promoted by various means, including attendance at industry trade shows as well as the publication and distribution of print advertisements.

[14] In support of his assertion of use, Mr. Warren attaches the following exhibits to his affidavit:

- Exhibit 1 is a course outline for the CR/RRC course, which he states is available on the Owner's website, *www.cifp.ca*.
- Exhibit 2 consists of copies of representative invoices from the relevant period, which he attests shows sales of CR educational programs by the Owner to students in Canada.
- Exhibit 3 is a photograph of a banner advertising the CR program, which Mr. Warren confirms is an example of banners displayed at trade shows in Canada during the relevant period. The Mark appears on the banner, above the following information: "Industry Recognized Designation", "Retirement and Estate Planning", "Technical and Competency Based" and "Start on your Path Towards this Specialized Designation Today!"
- Exhibit 4 consists of two advertisements that Mr. Warren attests are used by the Owner to promote its CR program to prospective students. He explains that the first document, the "2015 Career Education Sourcebook", is a publication circulated among high school students in Canada and was distributed in January 2015. He attests that the second advertisement was emailed to members of the Investors Group in January 2015, offering a special promotional rate for the CR program.
I note that, as both advertisements are in English, they primarily reference the RRC mark. "CR" is only indicated as a registered trade-mark along with various other marks in the fine print at the bottom of the first advertisement, but does appear in the text of the second advertisement.
- Exhibit 5 consists of screenshots from the Owner's Virtual University portal. The partially-redacted screenshots show information regarding students enrolled in the "Registered Retirement Consultant (RRC/CR Program)" during the relevant period. As attested by Mr. Warren, the screenshots display links to the online courses that are offered under the CR program.
- Exhibit 6 consists of representative pages of "a sample print copy of the course material for the CR program provided in 2014." The Mark appears on the first page of the course material. Mr. Warren highlights the fact that the materials contain a statement to the

effect that the printed course material should be used in conjunction with the online material.

- Exhibit 7 is a partially-redacted sample CR certificate, which Mr. Warren attests was awarded to a student in Canada in May 2014. The Mark appears on the certificate.
- Exhibit 8 consists of a seven-page spreadsheet listing of students in Canada who were granted a license by the Owner to use the CR mark in 2012, 2013, 2014 and 2015.
- Exhibit 9 consists of sample copies of license agreements signed by students located in Quebec in 2014. As attested by Mr. Warren, the agreement states that the Owner can monitor the licensees' provision of financial planning services to ensure that they meet the standards of the Owner.
- Exhibit 10 consists of Appendices A and B of the aforementioned license agreements, which set out the requirements and standards set by the Owner regarding proper usage of the Mark by licensees.
- Exhibit 11 consists of an email dated August 4, 2014 "from a qualified licensee in Saskatchewan" to Mr. Warren, which Mr. Warren attests is an example of use of the CR designation by a licensee. The Mark is displayed in the licensee's signature panel.
- Exhibit 12 consists of a business card of one of the Owner's licensees located in Alberta. Again, as an example of use of the Mark by a licensee, the Mark is displayed after the licensee's name.

Analysis - Services

[15] With respect to the registered "educational services", I am satisfied that the exhibited materials, as described above, demonstrate use of the Mark in the performance and advertisement of such services within the meaning of sections 4(2) and 45 of the Act.

[16] In contrast, the evidence with respect to "financial planning" services is not strong. If the CR program itself constitutes such services in addition to the registered "educational services",

this is not clear from the evidence itself and, as noted above, the Owner filed no representations. Similarly, the evidenced license agreement envisions licensed use of the Mark in association with financial planning services by the licensee, but does not itself demonstrate it.

[17] As such, the evidence of display of the Mark in this respect is essentially limited to the sample e-mail at Exhibit 11 and the representative business card at Exhibit 12. Neither exhibit is an example of display of the Mark in the *provision* of financial planning services.

[18] Nevertheless, although the *prima facie* evidence of use of the Mark with respect to the registered “financial planning” services is not overwhelming, it is sufficient in this case. In this respect, the business card and email both display the Mark and reference financial planning services. Mr. Warren confirms that this is an example of the manner of use of the Mark in association with such services. In the limited context of a section 45 proceeding and in the absence of representations from the Requesting Party, I accept that, at a minimum, such evidence constitutes display of the Mark in the advertising of the registered financial planning services, available to be performed by authorized licensees in Canada during the relevant period.

[19] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with all of the registered services within the meaning of sections 4(2) and 45 of the Act.

Analysis - Goods

[20] With respect to the registered goods, “instructional texts relating to the financial services industry”, I accept that Exhibit 6 is an example of such printed texts, with Exhibit 5 showing reference to online texts. Mr. Warren confirms that such texts are distributed in print form and online as part of the CR course materials. Accordingly, I am satisfied that such distribution constitutes transfers of those goods “in the normal course of trade” within the meaning of section 4(1) of the Act.

[21] On the other hand, with respect to “printed publications, namely ... newsletters, and bulletins” and “online publications, namely ... newsletters, web-boards, web-based chat rooms and bulletins”, Mr. Warren does not specify how such publications are reflected in the evidence. In the absence of representations from the Owner, I am not prepared to make any inferences

from the evidence before me that such goods were transferred in the normal course of trade in Canada during the relevant period or otherwise.

[22] As such, with respect to the registered goods, I am only satisfied that the Owner has demonstrated use of the Mark in association with “printed publications, namely instructional texts relating to the financial services industry” and “online publications, namely, instructional texts relating to the financial industry” within the meaning of sections 4 and 45 of the Act.

[23] As the Owner furnished no evidence of special circumstances excusing non-use of the Mark with respect to the remaining goods, the registration will be amended accordingly.

Disposition

[24] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete the following from the statement of goods: “... newsletters, and bulletins; ... newsletters, web-boards, web-based chat rooms and bulletins.”

[25] The amended statement of goods and services will be as follows:

GOODS

Printed publications, namely, instructional texts relating to the financial services industry; online publications, namely, instructional texts relating to the financial services industry.

SERVICES

Educational services in the field of investment and financial planning; financial services, namely financial planning services.

Andrew Bene
Hearing Officer
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

Deeth Williams Wall LLP

For the Registered Owner

Cameron IP

For the Requesting Party