



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

**Citation: 2013 TMOB 75**  
**Date of Decision: 2013-04-26**

**IN THE MATTER OF A SECTION 45  
PROCEEDING requested by the Good Earth  
Corporation against registration No. TMA484,678  
for the trade-mark GOOD EARTH CAFES LTD.  
in the name of Good Earth Cafes Ltd.**

[1] On March 22, 2010, the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Good Earth Cafes Ltd. (the Registrant). The notice required the Registrant to show that its trade-mark, GOOD EARTH CAFES LTD. (registration No. TMA484,678) had been used in Canada in association with each of the registered wares and services within the previous three years.

[2] Section 4 of the Act sets out the meaning of “use”. In the present case, the Registrant has conceded non-use of the trade-mark with respect to all of the registered wares, as well as with respect to the services “operation of retail book stores”. Furthermore, the Registrant has not brought forth any special circumstances to excuse such non-use. Thus, the only applicable definition of “use” in the present case is with respect to the remaining registered services. Specifically, it is section 4(2) of the Act that applies:

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.

[3] The remaining registered services are: restaurant and food services (the Services).

[4] In response to the Registrar's notice, the Registrant filed an affidavit of Mr. Michael Going. Both parties filed written submissions and attended an oral hearing.

[5] The sole argument of the requesting party is that the Registrant has not filed any evidence of use of GOOD EARTH CAFÉS LTD. *as a trade-mark* during the relevant period. Rather, the requesting party submits that the evidence shows that the Registrant has been using GOOD EARTH CAFÉS LTD. solely as a corporate name; in other words, GOOD EARTH CAFÉS LTD. has been used simply as an identifier of the Registrant itself.

[6] Further to this, the requesting party submits that it is necessary to rebut the presumption that the corporate name is a trade-name rather than a trade-mark and that the presumption in this case has not been rebutted [citing *Road Runner Trailer Manufacturing Ltd v Road Runner Trailer Co* (1984), 1 CPR (3d) 443 (FCTD)]. The problem, the requesting party argues, is that "Ltd." is invariably going to be an indication of a corporate name, and in the present case, the evidence shows that this is corporate name use by the Registrant.

[7] As further support that trade-name use does not in itself qualify as trade-mark use, the requesting party cites the cases of *Bereskin & Parr v 1082205 Ontario Ltd* (2001), 19 CPR (4th) 103 (TMOB) (for the trade-mark: R.E.M.), *Sunny Fresh Foods Inc v Sunfresh Ltd* (2003), 30 CPR (4th) 118 (TMOB) (for the trade-mark: SUNFRESH), and *Registrar of Trade Marks v Datel Communications Ltd.* (1991), 35 CPR (3d) 443 (TMOB) (for the trade-mark: DATEL COMMUNICATIONS LTD.).

[8] Thus, it is the requesting party's position that the registration ought to be expunged on the basis that the Registrant has not shown use of GOOD EARTH CAFÉS LTD. as a trade-mark, but merely use of its corporate or trade-name.

[9] The evidence filed in response to the section 45 notice consists of the following:

Exhibit A: printouts from the Registrant’s web site, which display a listing of and photographs of various coffeehouse locations as well as a photograph of the corporate office of the Registrant. None of the coffeehouse locations appear to display the registered trade-mark on store signage; instead, they display the words GOOD EARTH Coffeehouse and Bakery, which in some cases includes a design element (a steaming cup of coffee) and the words “A world of good.” However, GOOD EARTH CAFÉS LTD. is displayed on the exterior of the corporate office building. While the evidence indicates that the corporate office of the Registrant also contains a commissary/bakery, the Registrant’s web site clearly indicates that the bakery is not open to the public.

Exhibits B-H: web page captures, brochures, menus, invoices, product packaging, and a customer comment card. The web pages include a photograph of the Registrant’s corporate office (as in Exhibit A) which displays GOOD EARTH CAFÉS LTD. on the exterior of the office building. The remaining materials show GOOD EARTH CAFÉS LTD., but with an address following immediately beneath. There is one exception where GOOD EARTH CAFÉS LTD. did not appear with the Registrant’s corporate address on a take away and delivery menu order form; however, it appears in a diminutive font on the bottom left corner of the second page of the form. Where GOOD EARTH CAFÉS LTD. immediately precedes an address, it is at the top of invoices, the bottom of invoices (after “Remit To:”), the back covers of brochures and menus, and with respect to contact/ mailing information for the Registrant on its web site and customer comment cards. GOOD EARTH CAFÉS LTD. always appears in the same size and style of font as the corporate contact/ mailing information. Furthermore, in all cases, the same logo (GOOD EARTH Coffeehouse and Bakery & Design) that appears on the coffeehouse store signage appears prominently on the brochures, menus, invoices, etc.

[10] With respect to the requesting party’s comments regarding use of “Ltd.,” the Registrant submits that there is nothing in the Act to suggest that “Ltd.” cannot form part of a trade-mark. Furthermore, the Registrant submits the mere fact that a trade-mark has “Ltd.” does not mean it is not a trade-mark.

[11] It is true that there is no bar to registration of a corporate or trade-name as a trade-mark and that a trade-name, depending upon the circumstances of use, can be used concurrently as a trade-mark. However, the question in the present case is not whether a trade-name is registrable as a trade-mark, but rather, whether the Registrant has shown use of the trade-mark in such a way that it is identifiable as a trade-mark and is not merely being used as a corporate name/corporate identifier. In deciding such a matter, the context of use has been considered, including amongst others, factors such as whether the trade-mark stands apart from the corporate or trade-name and other corporate identifier information to the extent that the public would perceive such use as a trade-mark and not merely identification of a legal entity [see for example *Road Runner, supra*; *Bereskin & Parr v Kleen-Flo Tumbler Industries Limited* (2010), CarswellNat 3505 (TMOB); *Norton Rose OR SENCLR, srl v Illico Communication Inc* (2013), CarswellNat 816 (TMOB); *Laboratoire Théramex v E-Z-EM Canada Inc* (2003), CarswellNat 6264 (TMOB); *Stikeman Elliot LLP v Haydock* (2008), CarswellNat 1168 (TMOB); and *Bereskin & Parr v Red Carpet Food Systems Inc* (2007), 64 CPR (4th) 234 (TMOB)].

[12] In the present case - with the exception of use shown at the Registrant's corporate office (which will be discussed below) and at the bottom of the second page of a take away and delivery menu order form - GOOD EARTH CAFÉS LTD. always appears in association with an address, corporate contact information, or within the context of a copyright notice. However, in all cases, GOOD EARTH CAFÉS LTD. is not presented in a manner which sets it apart from other corporate information or in such manner that it would be perceived as anything other than identification of a legal entity; thus, I find it is merely being used as a corporate or trade-name. Indeed, in the context of the copyright notice, reference to Good Earth Cafes Ltd. simply indicates the legal entity that owns the copyright.

[13] The Registrant argues that not all of the examples of use in the evidence are the same; there are some instances where an address accompanies the trade-mark and some instances where it does not. For example, the Registrant submits that the signage on the corporate office building prominently displays the trade-mark without an address.

[14] While this is true, I note that the bakery at the corporate office of the Registrant is not open to the public. Furthermore, the evidence is ambiguous as to whether the “commissary” is open to the public, or merely providing services to the Registrant’s employees; an ambiguity that I must interpret against the interests of the Registrant [*Aerosol Fillers Inc v Plough (Canada) Ltd* (1980), 45 CPR (2d) 194 at 198; aff’d 53 CPR (3d) 62 (FCA)]. Accordingly, as there is no indication that the performance of this service was of benefit to the public, this is not use within the meaning of section 4(2) of the Act [see *Ralston Purina Co v Effem Foods Ltd* (1997), 81 CPR (3d) 528 (TMOB)].

[15] Even if I were to conclude that the commissary is open to the public, or that the provision of these services to employees of the Registrant constitutes service to members of the public, it would appear that such use is trade-name rather than trade-mark use. This is so, given the context in which GOOD EARTH CAFÉS LTD. is used – *i.e.* on the exterior of the building which houses the administrative offices of the Registrant. Furthermore, it is unclear from the evidence what the proximity of GOOD EARTH CAFÉS LTD. would be in relation to the commissary, such that any connection between the trade-mark and the services would be made. Given these factors, I agree with the requesting party that the perception would be that GOOD EARTH CAFÉS LTD. is being used as a corporate identifier. That is, GOOD EARTH CAFÉS LTD. would be perceived as merely the name of the business operating its administrative functions out of that office building.

[16] With respect to the R.E.M. and SUNFRESH cases cited by the requesting party, the Registrant distinguishes on the basis that the trade-marks in those cases only comprised a portion of the corporate or trade-name. The Registrant also pointed out that the use of GOOD EARTH CAFÉS LTD. in the present case was not in the context of a corporate directory, such as in the DATEL COMMUNICATIONS INC. case cited by the requesting party. However, while the facts of each case are different, the decisions in each case still turned on whether a consumer would perceive, given the context of use, that the trade-mark was identifiable as a trade-mark.

[17] Accordingly, as I find that the Registrant has failed to rebut the presumption that the use of the corporate name is a trade-name rather than a trade-mark, I cannot conclude that the Registrant has demonstrated use of the trade-mark in association with the Services within the meaning of sections 4 and 45 of the Act [see *Road Runner, supra*].

Disposition

[18] In view of the forgoing, pursuant to the authority delegated to me under section 63(3) of the Act, registration No. TMA484,678 will be expunged in compliance with the provisions of section 45 of the Act.

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Kathryn Barnett  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office