

SECTION 45 PROCEEDINGS
TRADE-MARK: MEMBER OWNED TRULY CANADIAN
REGISTRATION NO.: 285,466

On November 4, 1999, at the request of Messrs. Gowling, Strathy & Henderson, the Registrar forwarded a Section 45 notice to Federated Co-operatives Limited, the registered owner of the above-referenced trade-mark registration.

The trade-mark MEMBER OWNED TRULY CANADIAN is registered for use in association with the following services:

Retail consumer services, namely the provision of advise to consumers as to maintenance upkeep of agricultural, horticultural products and implements; the provision of advise on financial planning in various fields; operation of retail outlets, namely: hardware and sporting goods stores; petroleum outlets such as garages, gas bars, and bulk petroleum distribution; food stores; farm and garden supply stores; clothing stores; lumber yards; delivery units for products allied to the foregoing, namely units, containers used for delivery and/or storage of hardware items, sporting goods, foods and petroleum; provision of services to retail co-operatives, namely advertising; design of business forms; packaging; provision of exterior and interior signage.

In response to the notice, the affidavit of Kevin Krug together with exhibits has been furnished.

Each party filed a written argument. An oral hearing has not been requested in this case.

The requesting party argues that the evidence fails to show any use of the trade-mark in association with any of the registered services during the relevant period. Further, it submits that the business of the owner as stated in the affidavit is vastly different from the services described in the registration.

On the other hand, the registrant in its written argument submits that the registration should be maintained in its entirety. It argues that the registrant has shown its use of the trade-mark during the relevant period in association with some of the registered services and use which enures to it with the rest of the registered services.

Having considered the evidence and the arguments of the parties, I conclude that the trade-mark registration ought to be maintained.

I agree that Mr. Krug could have been more precise and could have provided details concerning each of the services. Nevertheless, sufficient facts have been furnished to permit me to conclude that the trade-mark was in use in association with each of the services during the relevant period.

As Mr. Krug has explained, the registrant is a wholesaling, manufacturing, procurement and refining co-operative. It distributes a wide variety of products and services through its members (retail associations). He has indicated that there are currently 334 of said co-operative retail associations providing goods and services through 362 service stations, 137 bulk petroleum operations, 14 propane distribution centres, 143 commercial fuel stops, 325 food stores, 100 home centres, 215 agro outlets, 125 department store outlets and 18 family fashion departments across Canada. He adds that the co-operative retail associations are also end users of services provided by the registrant for example, in relation to facilitating their operations. He has indicated that in the conduct of such activities, the registrant has used the trade-mark since about 1982 and continuously to the present. He has attached several exhibits in order to show the manner the trade-mark is used or displayed in the advertisement or performance of the services.

Concerning the registered services “retail consumer services, namely the provision of advice to consumers as to maintenance upkeep of agricultural, horticultural products and implements”, I am prepared to conclude that such services would be offered by the 215 agro outlets that are currently in operation and were probably in operation during the relevant period. Further the letter dated December 1, 1999, attached as Exhibit 15 and the statements made in paragraph 18 of the affidavit appear to confirm that one service which is being performed by such outlets is provision of advice to customers in that field.

Concerning the registered services, “operation of retail outlets namely, hardware and sporting goods stores, petroleum outlets such as garages, and gas bars, food stores, farm and garden supply stores, clothing stores, lumber yards”, I am prepared to conclude that these services were provided by the 334 co-operative retail associations operating through the 362 service stations, 14 propane distribution centres, 143 commercial fuel stops, 325 food stores, 100 home centres, 125 department stores and 18 family fashion departments. I am satisfied from the affidavit as a

whole, in particular from paragraphs 4, 9, 13, 14, 15, 16, and from the pamphlet submitted as Exhibit 3, that in advertising and performing their activities the co-operative retail outlets used the trade-mark MEMBER OWNED TRULY CANADIAN. All of the forms they use such as invoices (see Exhibit 12) bear the trade-mark. Further, it can be inferred from the number of outlets that were in operation at the date of the affidavit January 31, 2000, that a large number of the stores would have been in operation during the relevant period namely between November 4, 1996 and November 4, 1999.

Concerning the use of the trade-mark by such retail associations, it seems evident from the evidence as a whole that the registrant controls the character and quality of the services offered and performed by the retail co-operative associations. The registrant permits its members to use the trade-mark, namely it identifies the manner the trade-mark is to be used and it provides directives on the manner services are to be performed by the members.

Concerning the remaining registered services namely “the provision of advice on financial planning in various fields, bulk petroleum distribution, services of delivery units namely units, containers used for delivery and/or storage of hardware items, sporting goods, foods and petroleum; the provision of services to retail co-operatives namely advertising, design of business forms, packaging and provision of exterior and interior signage”, the evidence shows that these services were performed by the registrant in association with the trade-mark. Mr. Krug has clearly indicated that the registrant distributes products and services to the said co-operative retail associations as end users for example, in relation to facilitating their operations and paragraphs 4, 5, 6, 7, 8, 9, 11, 14, 15, 16, show this to be the case. The exhibits show that when such services are being provided, the trade-mark is used or displayed with such services in the manner required by Section 4(2) of the Act.

In view of the above, I conclude that the trade-mark registration ought to be maintained on the register.

Registration No. 285,466 will be maintained in compliance with the provisions of Section 45(5)
of the Act.

DATED AT HULL, QUEBEC, THIS 25th DAY OF APRIL 2001.

D Savard
Senior Hearing Officer
Section 45 Division