



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

Citation: 2010 TMOB 114
Date of Decision: 2010-07-21

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by M. Capewell & Associates Inc. against
registration No. TMA133,849 for the trade-mark
PRAIRIE GOLD in the name of Corn Products
International, Inc.**

[1] At the request of M. Capewell & Associates Inc. (the “requesting party”), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the “Act”) on June 18, 2008 to Corn Products International, Inc. (“Corn Products” or the “registrant”), the registered owner of the above referenced trade-mark.

[2] The trade-mark PRAIRIE GOLD (the “Mark”) is registered for use in association with “animal feeds”.

[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 wares 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 June 18, 2005 and June 18, 2008 (the “Relevant Period”).

[4] The registrant is required to show use of the trade-mark with each of the wares and services set out in the statement of wares and services; 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 C.P.R. (2d) 62 (F.C.A.)]. Although the

threshold for establishing use in section 45 proceedings is quite low [*Woods Canada Ltd. v. Lang Michener* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.) at 480], and evidentiary overkill is not required [*Union Electric Supply Co. Ltd. v. Registrar of Trade Marks* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with the wares and services specified in the registration, during the relevant period.

[5] Use in association with wares is set out in s. 4(1) and 4(3) of the Act:

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

[...]

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

In this case, s. 4(1) applies.

[6] In response to the Registrar's notice, the registrant furnished the affidavit of Nathan Yates sworn on September 16, 2008, with accompanying exhibits. Only the registrant filed written submissions; an oral hearing was not requested.

[7] Mr. Yates states that he has been employed by Corn Products since June 2003, and is the Manager, Agribusiness US/Canadian Region, responsible for the sales and marketing of the products associated with the Mark. He states that he has access to Corn Products' marketing and sales records and, where appropriate, has reviewed them prior to swearing his affidavit. He also states that he has personal knowledge of his evidence, and where it is based on information that he received from others, he has identified the source of the information and, in each such case, verily believes it to be true.

[8] Mr. Yates explains that in approximately 1998, CPC International Inc., the original owner of the Mark, spun off into two divisions: Corn Products and Bestfoods, and that the Mark was assigned to Corn Products. He describes Corn Products as one of the world's largest corn refiners, and explains that it services more than 60 industries worldwide, including the animal feed sector, and states that Corn Products and/or its licensees have continuously and extensively used the Mark in Canada since at least February 1999, to the present day (i.e. the date of the signing of the affidavit).

[9] Mr. Yates asserts that the Mark has been used in Canada in association with corn gluten based animal feed since 1963, and that from 2005 to 2008, approximately 299,902 metric tons of PRAIRIE GOLD animal feed were sold and distributed in Canada. He explains that the animal feed is produced, sold, and distributed in Canada by Corn Products' wholly owned subsidiary, Casco, under license from Corn Products, and that by virtue of this licence, Corn Products controls the character or quality of the products. Therefore, I conclude that any use shown by Casco is deemed to be use by the registrant pursuant to s. 50 of the Act.

[10] Given the nature of the business, Mr. Yates states that PRAIRIE GOLD animal feed is sold in bulk and, accordingly, there is minimal packaging that depicts the Mark. Despite this, he states that the Mark is depicted on every bill of lading, certificate of analysis, invoice, technical specification and material safety data sheet, and that it is also found on promotional materials.

[11] In Exhibit A, he provides copies of eleven invoices issued by Casco between July 2005 and November 2007 (i.e. during the Relevant Period), demonstrating sales to customers in Canada of significant amounts of "PRAIRIE GOLD 60% CORN GLUTEN MEAL". The Mark appears in the body of the invoices in the product description. The invoices confirm that sales of Prairie Gold Corn Gluten Meal were made to Canadian customers during the Relevant Period. Furthermore, based on Mr. Yates statement in the affidavit that "[i]n Canada, the PRAIRIE GOLD Mark is used in association with corn gluten based animal feed", I find that the "Corn Gluten Meal" sold in these invoices was used for animal feed.

[12] Copies of eight bills of lading have been provided in Exhibit B, evidencing shipments in Canada of "PRAIRIE GOLD 60% CORN GLUTEN MEAL" during the Relevant Period. I note that the documents provided correspond to eight of the sales invoices in Exhibit A, confirming

that these orders were in fact shipped to the customers. Exhibit B also includes a Delivery Note for a Canadian delivery that Mr. Yates states took place on March 31, 2008, referencing “PRAIRIE GOLD 60% CORN GLUTEN MEAL” in the product description.

[13] As for the manner in which the trade-mark was associated with the wares at the time of their transfer, the evidence clearly shows that the Mark appeared in the body of the invoices and bills of lading, and that the wares were shipped in bulk to the same physical place that the invoices and bills of lading were delivered. As the invoices depicting the Mark show the same “bill to” and “ship to” entity, and the bills of lading depicting the Mark show the same entity in the fields for “sold to” and “consignee”, I conclude that these invoices and bills of lading, would have been seen by the party who received the wares. For the purposes of s. 45, this would have provided sufficient notification to satisfy s. 4(1) [see *Riches, McKenzie & Herbert LLP v. KOM Networks Inc.* (2005), 51 C.P.R. (4th) 65 (T.M.O.B.), at 69].

[14] Having considered the evidence, I conclude that the registrant’s evidence clearly demonstrates that there was use of the Mark within the meaning of s. 45 and 4(1) in association with “animal feeds”. Accordingly, and pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be maintained in compliance with the provisions of s. 45 of the Act.

R. Shore
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office