



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

Citation: 2011 TMOB 164
Date of Decision: 2011-09-02

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Bereskin & Parr against registration
No. TMA245,881 for the trade-mark TARGET in the
name of Worldwide Management LLC (now AFN Broker
LLC.)**

and

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Bereskin & Parr against registration
No. TMA487,533 for the trade-mark TARGET in the
name of Worldwide Management LLC (now AFN Broker
LLC.)**

[1] At the request of Bereskin & Parr (the Requesting Party), the Registrar of Trade-marks issued notices under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on December 19, 2008 to Worldwide Management LLC, the registered owner at that time of registration Nos. TMA245,881 and TMA487,533 for the trade-mark TARGET (the Mark).

[2] With respect to TMA245,881, the Mark is registered for use in association with “canned meat”. With respect to TMA487,533, the Mark is registered for use in association with “1) grains, grain flours, peas, beans and vinegar; 2) frozen meat and frozen prepared meals”.

[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 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 December 19, 2005 and December 19, 2008 (the Relevant Period).

[4] The relevant definition of “use” in association with wares is set out in s. 4(1) 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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of a s. 45 proceeding [*Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1979), 45 C.P.R. (2d) 194, aff'd (1980), 53 C.P.R. (2d) 63 (F.C.A.)]. Although the threshold for establishing use in these proceedings is quite low [*Lang, Michener, Lawrence & Shaw v. Woods Canada Ltd.* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.)], and evidentiary overkill is not required [*Union Electric Supply Co. v. Canada (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 each of the wares or services specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the current owner of the registrations, AFN Broker LLC (AFN), filed affidavits of Robert Latchman, manager of AFN, in respect to each of the s. 45 proceedings, both sworn on June 2, 2009 (the Affidavits). With respect to TMA487,533, both parties filed written arguments; only AFN filed written arguments with respect to TMA245,881. An oral hearing was held on July 6, 2009, at which both parties appeared.

[7] In the Affidavits, Mr. Latchman states that Worldwide Management LLC assigned its rights to the subject registrations on January 23, 2005 to AFN. The assignment was made of record on April 2, 2009, and attached as Exhibit A to the Affidavits is a copy of the assignment document, dated January 23, 2005. Accordingly, I find that AFN has demonstrated that it was the owner of the Marks during the Relevant Period [see *MacLeod Dixon LLP v. Kayden Instruments Inc.* (2009), 78 C.P.R. (4th) 297 (T.M.O.B.)]

TMA245,881 - Evidence

[8] With respect to registration No. TMA245,881, Mr. Latchman asserts that AFN has used the Mark in Canada in association with canned meat continuously since it acquired the trade-mark in January 2005 and in particular continuously during the Relevant Period. In support, attached as Exhibit C to Mr. Latchman's affidavit is a copy of a label for canned Vienna sausage. I note that the Mark prominently appears on the label. Attached as Exhibit D are four invoices from AFN. The invoices are all from the Relevant Period, each to a different Canadian customer, with several items invoiced, including "Target Vienna sausages 24 x 142 g" in various quantities. I note that the invoices indicate that AFN is located in Linden, NJ, and that the full Canadian address of each customer does not appear on the invoice. Rather, the "Ship To" line on each invoice indicates "Pickup" and the "Terms" line indicates "COD". Handwritten or stamped on each invoice are the words "Paid Cash".

TMA487,553 - Evidence

[9] With respect to registration No. TMA487,553, Mr. Latchman asserts that AFN has used the Mark in Canada in association with the registered wares continuously since it acquired the trade-mark in January 2005 and in particular continuously during the Relevant Period. In support, attached as Exhibit C to Mr. Latchman's affidavit are copies of 5 labels, which Mr. Latchman describes as "representative" of the labels used by AFN during the Relevant Period. I note that the labels are for barley, mashed potatoes, quick oats, creamy wheatlets and barley flour. The Mark is prominently displayed at the top of each label in white lettering on a red background. Attached as Exhibit D to the affidavit are 5 invoices, which Mr. Latchman again describes as "representative". I note that many goods appear on each invoice, including "Target sardines", "Target Vienna sausages", "Target minced mutton (frozen)", "Target luncheon meat", "Target plantain flour", "Target barley flour", "Target chicken bouillon cubes", "Target whole pearled (double milled) barley" and "Target brand creamy wheatlets".

[10] As with the invoices submitted with respect to TMA245,881, I note that the invoices display AFN's address in Linden, New Jersey, and that the full Canadian address of each customer does not appear on the invoice. Again, the "Ship To" line on each invoice indicates

“Pickup”, the “Terms” line indicates “COD”, and the words “Paid Cash” are either handwritten or stamped on each of the invoices.

Requesting Party Submissions

[11] At the hearing, the Requesting Party submitted that, with respect to both registrations, there is no evidence of use of the Mark in Canada with respect to the wares. In particular, the Requesting Party asserts that the invoices unambiguously show that the sale and transfer of the wares in question did not occur in Canada. Rather, given AFN’s address in New Jersey, the indication of “Pickup” and the handwritten note “Paid Cash” on each invoice, the invoices demonstrate that the transfer in property and possession of the wares occurred in New Jersey. The Requesting Party notes the language in Mr. Latchman’s affidavit is ambiguous as to whether sales actually took place in Canada, and further that Mr. Latchman fails to provide details as to the normal course of AFN’s trade. Furthermore, the Requesting Party notes that there are no indicia in the invoices such as references to Canadian dollars or GST/PST calculations from which it could be inferred that the invoices represent sales in Canada. Finally, the Requesting Party notes that the product labels provided do not have any indication of compliance with Canadian packaging and labelling regulations or that these labels were otherwise used on wares targeted for the Canadian market.

[12] In the alternative, with respect to registration No. TMA487,533, the Requesting Party submits that insufficient or no evidence is provided with respect to each of the wares as registered. In particular, the Requesting Party asserts that with respect to “grains, grain flours; frozen meat”, the evidence is limited in that only a small number of invoices were provided, with no overall sales figures; with respect to “frozen meat”, no product label bearing the Mark was produced; and, finally, no evidence was provided whatsoever with respect to the wares “peas, beans, vinegar and frozen prepared meals”. Accordingly, the Requesting Party submits in the alternative that the registration should be cancelled at least with respect to the latter wares.

AFN’s Submissions

[13] At the hearing, the agent for AFN submitted it was reasonable to infer that AFN shipped its wares from the U.S. into Canada with the wares being picked up at the broker’s warehouse in

Canada. In support, AFN's agent emphasized the significance of the word "Broker" appearing in AFN's name and noted that AFN's Canadian customers appear to be of a "local nature". In this respect, it was submitted that given the nature of the wares, I should conclude that they were shipped to Canada since it was unlikely that buyers in Canada, including Vancouver, would travel to AFN's New Jersey address to pick up canned goods.

[14] With respect to registration No. TMA487,533, AFN submitted that a registered owner of a mark is not required to furnish direct evidence for every registered ware, asserting that the invoices demonstrate that AFN has a line of TARGET food products, and that the general assertion of use of the Mark in the affidavit was accordingly supported by sufficient representative evidence.

Analysis

[15] With respect to TMA487,533, I note that the requisite assertion of use for each of the registered wares is found in paragraph 4 of the affidavit. Additionally, Mr. Latchman identifies both the labels and invoices as "representative" of the labels and invoices used by AFN during the Relevant Period. Given the nature of the wares, I would not have considered this a case where it is necessary to burden AFN with providing direct evidence of use of each of the wares listed in the registration. Of the labels provided, the Mark appears on the wares at the top of the label in a similar fashion, and given the supporting statements in the affidavit, I am prepared to conclude that the Mark appeared on the other wares in a similar manner. Viewing the evidence as a whole, I am prepared to accept that the Mark was displayed in association with each of the wares and that the invoices provided were representative of AFN's wares as registered.

[16] However, I find that the invoices are ambiguous with respect to whether sales and/or the transfer of property or possession of the wares occurred in Canada. Although Mr. Latchman states at paragraph 6 of the Affidavits that "sales of [the wares] by AFN Broker in association with the trade-mark TARGET have been significant...", he does not state anywhere in the Affidavits that such sales occurred in Canada or that the wares were subsequently sold in Canada. No information is displayed on the product labels themselves to indicate they were used or sold in Canada and the Affidavits are silent regarding AFN's normal course of trade and in particular regarding how AFN operates its business in Canada. Certain facts alleged by the agent

for AFN at the hearing, such as the presence of the aforementioned warehouses in Canada, are not in evidence in these proceedings and I have disregarded all such references [see *Ridout & Maybee LLP v. Encore Marketing International Inc.* (2009), 72 C.P.R. (4th) 204 (T.M.O.B.) at 206]. Furthermore, I do not consider a reference to “broker” in “AFN Broker LLC” sufficient to infer details regarding AFN’s normal course of trade [see *S.C. Johnson Inc. v. Canada (Registrar of Trade-marks)* (1981), 55 C.P.R. (2d) 34 (F.C.T.D.)].

[17] From the evidence before me, it does not appear that the wares are shipped to Canada; rather, as submitted by the Requesting Party, it would appear that transfer of the wares occurred in the United States. At best, I consider the invoices ambiguous in this respect and, therefore, I am not satisfied that the invoices provided demonstrate sales of the wares in Canada [see *Plough, supra*]. The evidence should not raise more questions than providing answers to the key issues to be determined [*Axia NetMedia Corporation v. NetManage Inc.* (2010), 87 C.P.R. (4th) 254 (T.M.O.B.) at para. 27].

[18] Accordingly, with respect to both registrations, I am not satisfied that AFN has evidenced use of the Mark in Canada in association with the wares within the meaning of s. 45 and s. 4(1) of the Act during the Relevant Period.

[19] Pursuant to the authority delegated to me under s. 63(3) of the Act, registration Nos. TMA245,881 and TMA 487,533 will be expunged in compliance with the provisions of s. 45 of the Act.

Darlene Carreau
Chairperson
Trade-marks Opposition Board
Canadian Intellectual Property Office