TRADUCTION/TRANSLATION

SECTION 45 PROCEEDINGS
TRADE-MARK: MIRACLE MIX & Design
REGISTRATION NO.: TMA477834

[1] On July 12, 2007, at the request of Stikeman Elliott LLP, the Registrar forwarded a notice pursuant to section 45 of the *Trade-Marks Act*, R.S.C. 1985, c. T-13 (the "Act") to Les Sols R. Isabelle Inc. (the "Company"), owner of the trade-mark MIRACLE MIX and design (the "Mark") covered by the above-referenced registration.

[2] The certificate of registration was amended on April 26, 2004, so that certain wares could be added. It was already subject to another notice under section 45 of the Act dated January 2, 2007, for the wares originally listed in the certificate of registration. Therefore only the wares added to the original certificate of registration on April 26, 2004, are subject to this notice, namely:

> Soil, mixed soil, professional soil, peat moss, cedar mulch, decorative stones, pine bark, manure, compost, granular fertilizers, liquid fertilizers, soluble fertilizers, grass seed, vegetable seeds, annuals, flowers, perennial seeds. (The "Wares")

[3] Section 45 of the Act requires the registered owner of a trade-mark to show whether the trade-mark was in use in Canada in association with each of the wares and/or services listed on the registration at any time during the three-year period immediately preceding the date of the notice, and if not, to furnish the date when it was last so in use and the reason for the absence of

such use since that date. The relevant period in this case is between July 12, 2004, and July 12, 2007.

[4] In response to the notice, the Company provided the statutory declaration of Roger Isabelle dated September 18, 2007. No evidence was included with the statutory declaration. Only the requesting party filed a written argument. An oral hearing was not requested.

[5] In his statement, Mr. Isabelle describes himself as the Company's authorized representative. He states that during the relevant period the Company used the Mark in Canada on the bags used for the wares indicated in the certificate of registration.

[6] He adds, however, that the Company has, to date, used the Mark for the following products:

> [TRANSLATION]
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> Ph-balanced lawn soil, organic bedding and potting soil, ph-balanced garden soil, natural and dyed cedar mulch, organic soil for indoor and outdoor use, organic soil for cacti, organic potting for indoor plants and flowers, organic soil for indoor tropical plants, light potting soil and seed starting mix, soil mix for perennials/roses and flowering shrubs, fertilizer and shade lawn seed.

[7] He indicates that the Company does not intend to use the Mark in association with the following wares:

> [TRANSLATION]
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> Perlite, black earth, decorative stones, pine bark, vegetable seeds, annuals, perennial seeds.

[8] In conclusion, he states that the Company still intends to use the Mark in association with the following wares: manure and compost.

[9] Case law tells us that there is no need to show use of the mark by evidentiary overkill and that the purpose of section 45 proceedings is to remove the "deadwood" from the register [see *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62].

[10] In *Plough*, *supra*, Justice Thurlow of the Federal Court of Appeal wrote as follows:

> I do not think that the use in this context of the expression "a mere declaration of user" [*sic*] is anything but a way of putting a name on what is required. It is by no means a definition of what is required to show user [*sic*]. In my opinion, the expression used by Jackett P. is not fairly open to an interpretation that what is required to establish use for the purposes of section 44 is a mere bald statement that the trade mark is used or has been used . . .
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> What section 44(1) requires is an affidavit or statutory declaration not merely stating but "showing", that is to say, describing the use being made of the trade mark within the meaning of the definition of "trade mark" in section 2 and of use in section 4 of the Act. (Emphasis added)

[11] In view of these teachings, it is clear that Mr. Isabelle's statutory declaration does not comply with the requirements of section 45 of the Act. In fact, no evidence has been produced to support his allegation that the Company used the Mark in association with each of the Wares during the relevant period. His statement is a conclusion of law that must be based on facts. However, no material facts have been alleged and no evidence has been produced to support such a conclusion of law. A mere allegation that the Mark has been displayed on the packaging of the Wares is not sufficient *per se* to prove use of the Mark in association with the Wares. This

type of affidavit has previously been found insufficient for the purpose of a proceeding under section 45 of the Act. [See *Plough op. cit.*]

[12] It remains to be determined whether the owner furnished explanations that could constitute special circumstances within the meaning of section 45(3) of the Act to excuse the non-use of the Mark during the relevant period. Mr. Isabelle indicates that the Company [TRANSLATION] "still intends" to use the Mark in association with manure and compost without, however, describing the circumstances that could excuse non-use of the Mark during the relevant period. Non-use of the Mark in association with these wares can only be presumed, since the Wares are not included in the list of wares for which the Mark has allegedly been "used". No fact that in any way relates to the concept of "special circumstances" within the meaning of section 45(3) has been alleged. The intention to want to use the Mark in the future is not in itself sufficient to constitute special circumstances.

[13] Since the owner of the Mark has not discharged its burden of proof, I conclude that the registration of the Mark should be amended so that the following wares can be expunged:

> [TRANSLATION]
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> Soil, mixed soil, professional soil, peat moss, cedar mulch, decorative stones, pine bark, manure, compost, granular fertilizers, liquid fertilizers, soluble fertilizers, grass seed, vegetable seeds, annuals, flowers, perennial seeds.

[14] Pursuant to the authority delegated to me by the Registrar of Trade-marks under section 63(3) of the Act, registration no. TMA477834 will therefore be amended accordingly, in accordance with section 45(5) of the *Trade-marks Act*.

[15] In conclusion, I would like to point out that by the decision of the same date concerning a first notice dated January 2, 2007, I also expunged the following wares: sod, perlite and black earth. The combination of this decision with the one concerning the notice dated January 2, 2007, has the effect of expunging registration no. TMA477834 in its entirety.

DATED AT BOUCHERVILLE, QUEBEC, THIS 6TH DAY OF JULY 2009.

Jean Carrière,
Member, Trade-marks Opposition Board

Certified true translation
Johanna Kratz