



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

Citation: 2014 TMOB 249
Date of Decision: 2014-11-19

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Borden Ladner Gervais LLP against
registration No. TMA737,952 for the trade-mark
HARVEST in the name of Farm Business Consultants
Inc.**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA737,952 for the trade-mark HARVEST (the Mark), owned by Farm Business Consultants Inc.

[2] The Mark is registered for use in association with the following services:

- (i) Planning services namely estate planning, estate equalization and general business succession planning, retirement planning, tax planning services,
- (ii) insurance services namely advising, arranging and acquiring on behalf of others for life, health, disability, critical illness and long term care insurance,
- (iii) investment and financial services namely arranging for and investing on behalf of others in relation to segregated funds, mutual funds, guaranteed investment certificates and alternative investments available through a life and/or mutual fund portfolio investment.

[3] On February 19, 2013, at the request of Borden Ladner Gervais LLP (the Requesting Party), a notice was issued under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Farm Business Consultants Inc. (FBC). The notice required FBC to provide evidence showing that the Mark was in use in Canada, at any time between February 19, 2010 and February 19, 2013 (the relevant period), in association with each of the services included in the registration. If

the Mark had not been so used, FBC was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[4] The relevant definition of use with respect to services is set out in section 4(2) of the Act as follows:

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.

[5] It has been well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for clearing the register of “deadwood”. The criteria for establishing use are not demanding and an overabundance of evidence is not necessary; however, sufficient evidence must be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the registered services during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)]. Furthermore, mere statements of use are insufficient to prove use, and ambiguities in evidence are to be interpreted against the interests of the registered owner [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[6] In response to the Registrar’s notice, FBC provided the affidavit of Steven Ibbotson, the General Manager of FBC, sworn on April 30, 2013. Both parties filed written submissions and were represented at a hearing.

[7] The Requesting Party’s main submissions can be briefly summarized as follows:

- Use has not been demonstrated of the Mark in Canada during the relevant period in association with *each* of the registered services;
- There is no evidence of use of the trade-mark as registered; and
- The use of “Harvest” and/or “Harvest Estate Planning” is that of the name of a division of FBC and is not use of the Mark as a trade-mark.

[8] I will begin by providing an overview of the evidence, followed by a discussion of the parties’ submissions with respect to each of these issues in turn.

The Evidence

[9] In his affidavit, Mr. Ibbotson explains that FBC provides a wide range of business services to farmers and small businesses in Canada, including business management and recordkeeping services, taxation services, estate and succession planning services, insurance services, and investment and financial services.

[10] Mr. Ibbotson then explains that FBC has 12 offices throughout Canada and that FBC provides its services primarily by offering an “FBC Membership”; that is, for an annual membership fee, those who are FBC members have unlimited access to all the services FBC provides. He specifies however, that there are certain services offered by FBC to its members through which FBC earns a commission; in particular, “the sale of insurance policies to FBC members since insurance companies pay commissions on the sale of insurance policies, and the sale of investment products [...] since the companies that issue certain investment products pay a commission thereon.”

[11] With respect to the Mark, Mr. Ibbotson states that it was introduced in the year 2000, for use in association with FBC’s estate planning, insurance and investment services; services which he collectively defines as including all of the Services. He then attests that FBC has used the Mark continuously in Canada since April 2000 with all of the Services.

[12] In support of his above-mentioned assertions, to begin with, Mr. Ibbotson provides the following as examples of use of the Mark in Canada by FBC:

Exhibit 1: a photograph of business signage outside the HARVEST office in London, Ontario.

Exhibits 2-4: brochures respectively entitled “Your Financial Health Check-Up”, “We Can Put More Money in Your Pocket!”, and “Will Planning Workbook”, stated to show use of the Mark and distributed by FBC to FBC members.

Exhibit 5: a member guide, which Mr. Ibbotson states is given by FBC to every FBC member, outlining the services provided to members. Mr. Ibbotson directs attention to

page 12 of the guide, in which he states the HARVEST services provided to FBC members are listed and the following statement appears:

“Call Harvest at 1-800-265-9237 to arrange a consultation with a Harvest representative. The cost of this service is included in your Membership fee.”

[13] Mr. Ibbotson further attaches as Exhibits 6 and 7 to his affidavit, internal FBC training documents used to train FBC personnel who provide the services associated with the Mark. While FBC does not distribute these documents to its members, Mr. Ibbotson indicates that the purpose of this evidence is to show the services that FBC’s related personnel are trained to provide.

[14] Exhibits 8 through 14 of Mr. Ibbotson’s affidavit consist of an assortment of FBC representative and client/member communications, all of which pertain to the relevant period. These documents include: meeting follow-up correspondence regarding discussion of the Services as well as outlines of plans regarding the provision of Services, forms related to applying for/acquiring the Services, and a letter from an FBC HARVEST representative to an insurance company regarding an FBC member’s spousal RSP.

[15] The remainder of the exhibit evidence (Exhibits 15 through 26) consist of what Mr. Ibbotson describes are “Meeting and Telephone Note Documentation” file reports of meetings between an FBC HARVEST representative and an FBC member which document discussions concerning the provision of the Services. The reports are signed by both the FBC representative and the FBC member and indicate that a variety of the Services were discussed including health, retirement and estate planning, investment and financial planning (e.g. RSP’s, GIC’s, etc.), and insurance (e.g. life, disability, etc.).

[16] Lastly, Mr. Ibbotson provides statistics concerning revenues generated as well as the number of members that obtained each general category of the Services (i.e. – planning services namely [...], insurance services namely [...], and investment and financial services namely [...]) for the years 2010, 2011, and 2012. He explains that no specific revenue is listed under “planning services”; (as was previously indicated) these services are provided as part of the member’s annual membership fee. The revenues range from \$119,300 in 2010 for “investment

and financial services”, to \$2,214,464 in 2011 for “insurance services”, with the number of members who obtained each general category of services from 2010 to 2012 ranging from 842 to 2,616 members.

The Issues

Has “use” of the Mark been shown in association with each of the registered services?

[17] With respect to services, where the trade-mark owner is offering and prepared to perform its services in Canada, use of the trade-mark on advertising of those services meets the requirements of section 4(2) of the Act [see *Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (RTM)]. In other words, advertising in Canada alone is insufficient to demonstrate use; at the very least, the services have to be available to be performed in Canada without the Canadian customer having to leave Canada [*Porter v Don the Beachcomber* (1966), 48 CPR 280 (Ex Ct); *Bedwell v Mayflower* (1999), 2 CPR (4th) 543 (TMOB); and *Société Nationale des Chemins de Fer Français SNCF v Venice Simplon-Orient-Express, Inc* (2000), 9 CPR (4th) 443 (FCTD) aff’g 64 CPR (3d) 87 (TMOB)].

[18] The Requesting Party submits that the fact that certain product offerings were discussed with members as evidenced in the meeting and telephone reports (Exhibits 15-26), and/or that reporting letters and other correspondence refers to certain services/topics (Exhibits 9-14), does not establish that FBC performed or was prepared to perform all of the services/topics discussed in those letters/meetings/conference calls, or that the performance of any or some of those services occurred in association with the Mark. Rather, the Requesting Party submits, it appears that these meetings and/or conference calls discussed estate planning services and that other topics or services or product offerings discussed would likely be performed by third parties or by FBC in association with FBC’s other commonly used trade-marks, which also appear in most of the materials attached to Mr. Ibbotson’s affidavit.

[19] Further to this, the Requesting Party submits that evidence of discussion of services, is not performance of the services. In particular, the Requesting Party submits that the exhibits detailing telephone conversations do not constitute use; the customer would not have seen the Mark at the time of the conversation. Furthermore, the FBC representative may have discussed

the Services and possibly given advice, but there is no indication that the Services were actually provided.

[20] The Requesting Party additionally submits that insurance is regulated and insurance providers and brokers require a license. While one or two of the exhibits make reference to employees who are CPA's, there is no evidence of licensing or certification; thus, it cannot be presumed that FBC is qualified to perform the services. Instead, the Requesting Party submits, the evidence shows that FBC refers customers to third parties who perform the services.

[21] Moreover, the Requesting Party submits that the evidence shows that FBC uses the trademark HARVEST ESTATE PLANNING & Design, and not the Mark *per se*, which suggests that the Mark is not used with insurance and other services. Lastly, many of the exhibits are undated, thus it is impossible to know whether use occurred during the relevant period.

[22] In conclusion, the Requesting Party submits, the Mark should be expunged or alternatively amended to: estate planning and insurance advisory services only.

[23] In response, FBC submits that the statement of services in the registration indicates that FBC advises, arranges, and acquires insurance on behalf of others, and that it advises and invests on behalf of others; the registration does not state that FBC places investments themselves or administers insurance policies. I agree, and note that the evidence is consistent with the language employed in the description of services in the registration.

[24] Furthermore, there is no requirement that FBC provide evidence of professional certifications or licenses in order to prove that FBC was qualified to perform the services. Indeed, the threshold for establishing use in section 45 proceedings is quite low [*Austin Nichols & Co v Cinnabon, Inc* (1998), 82 CPR (3d) 513 (FCA)], and there is no need for evidentiary overkill when use can be shown in a simple, straightforward fashion [see *Union Electric Supply Co v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)].

[25] FBC has provided ample evidence to support that each of the services were offered during the relevant period, as well as evidence that the services were actually performed. While some of the exhibits are undated, the vast majority of the exhibits are clearly dated during the relevant period and detail the services offered by FBC to its clients/members (Exhibits 9-26).

These exhibits, which include client communications, clearly indicate that each of the services were offered by FBC. Indeed, it becomes evident through a review of the evidence that the services are intertwined; that is, FBC's insurance and financial and investment services are related to, or part and parcel of FBC's estate planning services. Given the interconnectedness of the services, it is understandable why the descriptive words "estate planning" appear with the word HARVEST throughout the evidence. Lastly, Mr. Ibbotson provides revenue figures associated with the services, as well as the number of members who accessed each of the services during the relevant period.

[26] Having regard to the foregoing, I am satisfied that FBC offered and performed the services during the relevant period.

Has use been shown of the trade-mark as registered?

[27] The Requesting Party submits that the evidence does not show use of the Mark, but instead shows the trade-mark HARVEST ESTATE PLANNING & Design, as shown below:



[28] The Requesting Party submits that this trade-mark bears a significant design feature and includes additional reading matter which render the mark as a whole significantly different from the trade-mark as registered. It is the Requesting Party's view that it would be difficult to characterize the differences between the trade-mark as used and the trade-mark as registered as "unimportant" [citing *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. Further to this, the Requesting Party submits that while the word HARVEST may be a dominant feature of both marks, the trade-mark as used includes other very dominant features as well, namely the curved line design element and the additional words ESTATE PLANNING [citing *887766 Canada Inc v Coca-cola Ltd* (2006), 52 CPR (4th) 50 (TMOB)]. These features, the Requesting Party submits, are essential features that create an overall visual impact which is different from the impact created by the word HARVEST alone; thus, an unaware customer may

not infer that the services performed in association with the design mark have the same origin as those associated with the trade-mark as registered, resulting in a loss in identity through these modifications [citing *Ridout & Maybee v 420123 Ontario Ltd* (2002), 25 CPR (4th) 281 (TMOB)].

[29] FBC on the other hand, points out that the word HARVEST does on occasion appear on its own. As will be discussed below however, the Requesting Party submits that such use is as a trade-name and not as a trade-mark.

[30] In any event, FBC submits that even when the word HARVEST appears as part of the above-noted overall design, such use constitutes use of the Mark. To explain, FBC submits that the reading matter “estate planning” is purely descriptive of the type of services provided, and appears in a smaller and different font below the word HARVEST [see *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)]. Additionally, the word HARVEST stands out because it is isolated on its own line and is printed in a different and more striking font for emphasis [citing *Standard Coil Products (Canada) Ltd v Standard Radio Corp et al* (1971), 1 CPR (2d) 155 at 163]. As for the design element, FBC submits, similar to *Unilever Canada Inc v Red Rose Canada Inc* (2005), 47 CPR (4th) 421 (TMOB), this design element is only minor and does not detract from the word HARVEST itself. For all the aforementioned reasons, FBC submits, the public as a matter of first impression would perceive that the word HARVEST is being used as a Mark.

[31] The Requesting Party submits that all of the aforementioned cases noted by FBC are distinguishable on their facts. While the facts of each case may be different, I note that the principles surrounding what qualifies as use of a registered mark *per se* remain the same. In this regard, I find it difficult to accept that a simple embellishment to the letter H in the word HARVEST renders the Mark unrecognizable. The word HARVEST clearly stands out apart from the smaller, descriptive words “estate planning” below. In my view, the Mark is being used in such a way that it has not lost its identity and remains recognizable [*Registrar of Trade Marks v Compagnie Internationale Pour L’Informatique CII Honeywell Bull, Societe Anonyme et al* (1985), 4 CPR (3d) 523 (FCA) at 525]. Furthermore, the dominant features of the Mark have been preserved [*Promafil Canada Ltée, supra*].

Has the Mark been used as a trade-mark or merely as the name of a division of FBC?

[32] The Requesting Party submits that any use of “Harvest” and/or “Harvest Estate Planning” shown in the evidence, in a manner other than as HARVEST ESTATE PLANNING & DESIGN (as depicted above), is use as the name of a division of FBC, rather than use of the Mark *per se*.

[33] However, I have already accepted that use of HARVEST ESTATE PLANNING & DESIGN (as depicted above) constitutes use of the Mark *per se*, and therefore, need not address the Requesting Party’s submissions on this issue. The word HARVEST in the aforementioned design is clearly set apart from the remaining matter to such an extent, that even when followed by a telephone number or by the phrase “a division of FBC”, it would be construed as use of the Mark *per se*, rather than merely identifying HARVEST ESTATE PLANNING as a division of FBC [see *Road Runner Trailer Manufacturing Ltd v Road Runner Trailer Co* (1984), 1 CPR (3d) 443 (FCTD)].

Disposition

[34] Having regard to the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

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