



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

Citation: 2014 TMOB 182
Date of Decision: 2014-06-13

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Riches, McKenzie & Herbert LLP against
registration No. TMA127,343 for the trade-mark
HARMONIE in the name of TMC Distributing Ltd.**

[1] At the request of Riches, McKenzie & Herbert LLP (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on April 25, 2012 to TMC Distributing Ltd (the Owner), the registered owner of registration No. TMA127,343 for the trade-mark HARMONIE.

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

- (1) Canned, dried, evaporated or frozen fruits; canned or frozen vegetables; canned, fresh or frozen fish; jam, jelly and marmalade; pickles.
- (2) Fruit juices.
- (3) Flour and cereals for human consumption.
- (4) Ice cream.
- (5) Meats, fresh, canned and processed.
- (6) Household detergent.
- (7) Margarine.
- (8) Household baking ingredients namely baking chips and vanilla extract.
- (9) Household plastic and paper products namely garbage bags, paper towels, tissues.
- (10) Pet foods.
- (11) Non alcoholic beverages namely teas, coffees, cocoas, food drinks and juices and ingredients thereof, bottled, packaged, canned, frozen, evaporated and concentrated.
- (12) Condiments.
- (13) Bakery products, namely breads, buns, rolls, sweet goods.
- (14) Spaghetti - canned, dried; macaroni; peanut butter; coffeewhitener.
- (15) Cheese.
- (16) Fruits glazed.
- (17) Household foil products, namely aluminium foil wrap.

- (18) Cat box filler; condiments or sauces, namely tomato ketchup; coffee filters; brooms and mops.
- (19) Pancake syrup, baking powder, salad dressing.
- (20) Rice cakes, popping corn, mayonnaise, spaghetti sauce.
- (21) Canola oil, potato chips, creamed honey, canned soups, tomato sauce.
- (22) Snack crackers, candy.
- (23) Facial tissue, bar soap.
- (24) Sour cream and yogurt.
- (25) Pasta.
- (26) Eggs.
- (27) Toothbrushes.

[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 April 25, 2009 and April 25, 2012.

[4] The relevant definition of “use” in association with wares is set out in section 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 section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], 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 specified in the registration during the relevant period.

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Mr. Kevin Krug sworn on July 23, 2012 in Saskatoon, Saskatchewan. Both parties filed written representations; only the Requesting Party was represented at an oral hearing.

Evidence of Use during the Relevant Period

[7] In his affidavit, Mr. Krug identifies himself as the Trade-marks Manager of the Owner. He states that he is also the Marketing Services Director of Federated Co-operatives Limited (FCL) and the Marketing Services Manager of Interprovincial Cooperative Limited (IPCO), both of which are "closely related" to the Owner. He attests that, by virtue of his positions in these companies, he has access to the documents relevant to this proceeding and personal knowledge of the matters described in his affidavit.

[8] Mr. Krug attests that IPCO was the registered owner of the Mark from 1962 to 1995, when the registration was assigned to the Owner. He explains that since the Mark's assignment, IPCO has been a distributor and licensed user of the Mark, selling the Owner's wares via distributors such as FCL to retail grocery stores in Canada, including "cooperative retail grocery stores." He attests that these agreements provide that IPCO's and FCL's rights as licensees are subject to the Owner's direct or indirect control over the character or quality of the brand wares associated with the Mark.

[9] Attached to his affidavit, Mr. Krug includes invoices (Exhibit A), pictures (Exhibits B and C), and flyers (Exhibit D), all purporting to evidence use of the Mark in association with various products. For each exhibit, Mr. Krug provides lengthy lists of the products which are evidenced in each exhibit. Unfortunately, the products listed do not clearly and explicitly correspond in all cases to the statement of wares as registered. There is also considerable overlap in the evidence, with some wares naturally being referenced multiple times in the affidavit and attached exhibits. I will briefly summarize each exhibit below.

[10] Exhibit A consists of 25 invoices, that Mr. Krug attest show sales of HARMONIE brand products by FCL to various retail grocery stores during the relevant period. Mr. Krug attests that the invoices sometimes use the short form "HARM" to indicate the brand associated with the Mark. As noted by the Requesting Party and acknowledged by the Owner in its written

representations, two of the invoices, both from April 2012, were actually issued by “The Grocery People Ltd.”, and not by FCL. Nonetheless, I note that products described as “HARM” or “HARMONIE” do appear in these two invoices. Mr. Krug specifies 62 products shown in the exhibited invoices. Rather than recount all of the listed products, I will simply note at this point that, with some assistance from both parties’ representations, it would appear that this listing corresponds to 26 of the wares appearing in the registration.

[11] Exhibit B consists of pictures showing various packaged products bearing the Mark, which Mr. Krug states are “representative” of those products sold during the relevant period. Mr. Krug lists 55 products appearing in the pictures; again, with some assistance, it would appear that the exhibited pictures correspond to 28 registered wares.

[12] Exhibit C consists of “close-up” pictures of the labels on 25 products bearing the Mark, which Mr. Krug again states are representative of the products sold during the relevant period. Consistent with Mr. Krug’s affidavit, the labels state that the products are prepared for ICOL “under licence”, and identify the Owner as the registered trade-mark owner. Mr. Krug lists 25 products as being pictured, 16 of which appear to correspond with registered wares.

[13] Exhibit D consists of three flyers from CO-OP stores dating from the relevant period, which Mr. Krug attests “show HARMONIE brand products on sale (and which were sold on or about the dates of said flyers respectively)”. Mr. Krug identifies nine products advertised for sale in the flyers, as follows: ice cream, spaghetti, elbow macaroni, kitchen bags, mushrooms pieces and stems, frozen mixed vegetables, all purpose flour, bacon, and cooked sliced ham. These products, all of which bear the Mark on their packaging, appear to correspond with the following six registered wares: ice cream, pasta, garbage bags, frozen vegetables, flour, and processed meat.

Analysis

[14] In its representations, the Owner concedes that it has not provided any documentary evidence in the form of packaging or invoices for some of the registered wares. However, it submits that section 45 proceedings do not require a registered owner to provide direct or documentary proof with respect to each and every ware where the registration contains multiple

categories of several wares that have been “logically and properly categorized” [citing *Saks & Co v Canada (Registrar of Trade-marks)* (1989), 24 CPR (3d) 49 (FCTD)]. The Owner submits that all that is required is that the affidavit must include a clear statement of use of the trade-mark in association with the wares during the relevant period and must provide sufficient facts to permit the Registrar to conclude that the trade-mark was in use in association with each ware.

[15] In this case, however, the wares are not logically and properly categorized, and I do not consider any of Mr. Krug’s statements as clearly asserting use with respect to all of the wares listed in the registration. Mr. Krug has provided exhibits and identified numerous products referenced in those exhibits; however, some of those products do not clearly correspond with the registered wares. Indeed, many of the registered wares are clearly *not* enumerated in any of Mr. Krug’s product lists appearing in his affidavit.

[16] In this case, the statement of wares in the registration is of little assistance in identifying any relevant categories of wares. Wares appear to be grouped based on their date of first use by the Owner, rather than by any criteria useful to this proceeding. For example, the disparate wares “cat box filler”, “condiments” and “brooms” all appear together in group (18) in the registration.

[17] Similarly, there is no grouping of the wares in the evidence so as to identify any relevant categories. If Mr. Krug made an effort to organize the product lists in his affidavit in accordance with the statement of wares in the registration, or in any other relevant manner, it is not readily apparent. By failing to distinguish between the relevant registered wares and all of its other products in evidence, the Owner appears to have furnished evidence of all the products it could identify as having been sold in association with the Mark during the relevant period. Thus, the absence of *any* evidence with respect to some of the registered wares is telling.

[18] As such, I do not accept the Owner’s general submission that the evidence can be considered as representative of use of the Mark in association with *all* of the registered wares.

[19] Clearly, this is not the case with respect to, for example, “brooms and mops” from the registration. Brooms and mops are not specifically referenced anywhere in Mr. Krug’s affidavit, nor is their reference to them in any of the exhibits. Further, it is not self-evident that any of the

products Mr. Krug does identify in his evidence should be considered “representative” of a category of products under which brooms and mops would be logically placed.

[20] Likewise, “Meats, fresh, canned and processed” are listed under wares (5) in the registration. However, there is no evidence with respect to “fresh” or “canned” meats. Further, it is not clear how “fresh” meats would have been packaged and sold in association with the Mark during the relevant period.

[21] Accordingly, I agree with the Requesting Party that the Owner has not furnished evidence in association with the following registered wares, none of which Mr. Krug clearly lists as having been sold in association with the Mark during the relevant period: dried, evaporated, or frozen fruits; canned, fresh, or frozen fish; jelly and marmalade; pickles; fresh and canned meats; cocoas; buns, rolls; fruits glazed; cat box filler; coffee filters; brooms and mops; pancake syrup, baking powder, salad dressing; rice cakes, popping corn, mayonnaise, spaghetti sauce; potato chips, creamed honey, canned soups; tomato sauce; snack crackers; facial tissue, bar soap; sour cream and yogurt; and toothbrushes.

[22] With respect to the registered wares “pickles”, in its written representations, the Owner appears to equate this with the product “pickled sliced beets”, for which invoices and pictures of packaging were furnished. However, absent clear statements in Mr. Krug’s affidavit or further submissions from the Owner, I am not prepared to give such a broader interpretation to the ordinary commercial term “pickles”.

[23] Furthermore, with respect to wares (11), “Non-alcoholic beverages...”, I agree with the Requesting Party that “bottled ... frozen, evaporated...” should be deleted from the registration. In this respect, with the exception of “cocoas”, I can identify in the evidence the various relevant non-alcoholic beverages, in crystal/concentrated form or packaged in cartons or cans. However, none of the various beverage products in the evidence appear to be in “bottled”, “frozen” or “evaporated” form. Again, in light of the volume of evidence, in particular for beverages packaged in other forms, the omission in this respect is telling. Absent clear evidence or submissions on point, I am not prepared to conclude that the various drink crystals shown in evidence should be considered “evaporated” forms of the beverages in question.

[24] Nonetheless, with respect to the remaining wares, Mr. Krug states that such products were sold in association with the Mark during the relevant period. In view of the evidence as a whole, I am satisfied that the Owner has demonstrated use of the Mark in association with such wares, identified below, within the meaning of sections 4 and 45 of the Act.

[25] Indeed, generally, the Requesting Party does not take issue with the wares identified in one or more of the product lists in Mr. Krug's affidavit. However, in its written representations, the Requesting Party also identifies "candy" and "ice cream" as wares that should be deleted from the registration. For the reasons below, I disagree.

[26] With respect to "ice cream", the Requesting Party generally submitted that the flyers contained in Exhibit D should be given no weight as they cannot establish use of the Mark in association with the wares. "Ice cream" is the only relevant product appearing in Exhibit D that does not appear otherwise in the exhibits. However, as noted by the Owner, a picture of a vanilla ice cream product bearing the Mark is depicted in one of the flyers dated from the relevant period. In view of Mr. Krug's statement that the flyers show the products, including ice cream, "sold on or about the date of said flyers", I accept that the evidence as a whole demonstrates use of the Mark in association with "ice cream" during the relevant period.

[27] With respect to "candy", the Requesting Party also generally submits that any assertions of use by the Owner relating to the two Exhibit B invoices issued by The Grocery People Ltd. from April 2012 must be disregarded, as Mr. Krug does not attest to the relationship between the Owner and this entity. Appearing in one of these invoices, but not in the exhibits otherwise, is "ribbon slices", which Mr. Krug identifies as corresponding with the registered ware "candy".

[28] While the relationship is not explicitly stated by Mr. Krug, I note that he attests that IPCO has sold HARMONIE products to retail grocery stores "via distributors *such as* FCL" (emphasis added). Accordingly, it is reasonable to conclude that The Grocery People Ltd. was another distributor of IPCO or at least in the chain of distribution between the Owner and its retail grocery store customers. As such, and in any event, although the invoice is not perfectly representative, I accept Mr. Krug's specific listing of "ribbon slices (candy)" in his affidavit and the evidence as a whole as demonstrating use of the Mark with respect to "candy".

[29] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act in association with the following registered wares only:

- (1) Canned ... fruits; canned or frozen vegetables; ...jam ...
- (2) Fruit juices.
- (3) Flour and cereals for human consumption.
- (4) Ice cream.
- (5) Meats, ... processed.
- (6) Household detergent.
- (7) Margarine.
- (8) Household baking ingredients namely baking chips and vanilla extract.
- (9) Household plastic and paper products namely garbage bags, paper towels, tissues.
- (10) Pet foods.
- (11) Non alcoholic beverages namely teas, coffees, ... food drinks and juices and ingredients thereof, ... packaged, canned, ... and concentrated.
- (12) Condiments.
- (13) Bakery products, namely breads, ... sweet goods.
- (14) Spaghetti - canned, dried; macaroni; peanut butter; coffeewhitener.
- (15) Cheese. ...
- (17) Household foil products, namely aluminium foil wrap.
- (18) ... condiments or sauces, namely tomato ketchup; ...
- (21) Canola oil, ...
- (22) ... candy...
- (25) Pasta.
- (26) Eggs...

[30] For the reasons set out above, I am not satisfied that the Owner has demonstrated use of the Mark in association with the remaining wares, there being no evidence of special circumstances excusing non-use of the Mark before me.

Disposition

[31] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration will be amended to delete the following from the statement of wares:

- (1) ...dried, evaporated, or frozen [fruits;] ... canned, fresh, or frozen fish; jelly and marmalade; pickles.
- (5) [Meats,] fresh, canned and ...
- (11) [Non-alcoholic beverages, namely,]... cocoas ... bottled, frozen, evaporated...
- (13) ...buns, rolls...

- (16) Fruits glazed.
- (18) Cat box filler; ...coffee filters; brooms and mops.
- (19) Pancake syrup, baking powder, salad dressing.
- (20) Rice cakes, popping corn, mayonnaise, spaghetti sauce.
- (21) ... potato chips, creamed honey, canned soups, tomato sauce...
- (22) Snack crackers...
- (23) Facial tissue, bar soap.
- (24) Sour cream and yogurt.
- (27) Toothbrushes.

[32] The amended statement of wares will be as follows:

- (1) Canned fruits; canned or frozen vegetables; jam.
- (2) Fruit juices.
- (3) Flour and cereals for human consumption.
- (4) Ice cream.
- (5) Meats, processed.
- (6) Household detergent.
- (7) Margarine.
- (8) Household baking ingredients namely baking chips and vanilla extract.
- (9) Household plastic and paper products namely garbage bags, paper towels, tissues.
- (10) Pet foods.
- (11) Non alcoholic beverages namely teas, coffees, food drinks and juices and ingredients thereof, packaged, canned and concentrated.
- (12) Condiments.
- (13) Bakery products, namely breads, sweet goods.
- (14) Spaghetti – canned, dried; macaroni; peanut butter; coffeewhitener.
- (15) Cheese.
- (17) Household foil products, namely aluminium foil wrap.
- (18) Condiments or sauces, namely tomato ketchup.
- (21) Canola oil.
- (22) Candy.
- (25) Pasta.
- (26) Eggs.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
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