



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

Citation: 2018 TMOB 56

Date of Decision: 2018-05-31

IN THE MATTER OF A SECTION 45 PROCEEDING

COMPO Expert GmbH

Requesting Party

and

The Professional Gardener Co. Ltd.

Registered Owner

UCA20794 for COMPO

Registration

[1] At the request of COMPO Expert GmbH (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 June 3, 2016 to The Professional Gardener Co. Ltd. (the Owner), the registered owner of registration No. UCA20794 for the trade-mark COMPO (the Mark).

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

- (1) Chemical substances used in the production of fertilizer from the refuse of plants and vegetables.
- (2) Chemical substances used in the production of fertilizer from the refuse of plants and vegetables.
- (3) Chemical substances used in the cultivation and fertilization of plants.
- (4) Chemical substances used in the production of fertilizer from the refuse of plants and vegetables.

(5) Chemical substances used in the production of fertilizer from the refuse of plants and vegetables, and chemical substances used in the cultivation and fertilization of plants.

(6) Chemical and organic fertilizers and inorganic and organic plant growing media.

[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 goods 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 the trade-mark was last used and the reason for the absence of such use since that date. In the present case, the relevant period for showing use is between June 3, 2013 and June 3, 2016.

[4] The relevant definition of “use” in association with goods is set out in section 4(1) of the Act as follows:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods 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 section 45 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 goods specified in the registration during the relevant period [*John Labatt Ltd v Rainer Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[6] In response to the Registrar’s notice, the Owner furnished the affidavit of its General Manager Al Nielsen, sworn on August 23, 2016. Both parties filed written representations and were represented at an oral hearing.

THE OWNER'S EVIDENCE

[7] In his affidavit, Mr. Nielsen states that the Owner is a Calgary-based company that has been in business for over 75 years. He explains that the Owner researches, develops, manufactures and distributes “new and innovative products in the field of garden and plant protection, plant disease management, and increased plant and garden productivity”. According to Mr. Nielsen, such products include seeds, soil, soil fertilizers, greenhouse chemicals and equipment, greenhouse structures, and nursery and greenhouse containers. He specifies that the products are sold across Canada, to individuals for use in landscaping, gardening, and greenhouses, and to corporate customers for use in larger scale projects in the golfing, landscaping, greenhouse and soil remediation industries.

[8] With respect to the Mark, Mr. Nielsen admits that it has not been used in Canada during the relevant period in association with the following registered goods:

(1), (2) & (4) Chemical substances used in the production of fertilizer from the refuse of plants and vegetables; and

(5) Chemical substances used in the production of fertilizer from the refuse of plants and vegetables, and chemical substances used in the cultivation and fertilization of plants.

[9] However, he asserts that the Mark *has* been used in Canada during the relevant period in association with the following registered goods:

(3) Chemical substances used in the cultivation and fertilization of plants; and

(6) Chemical and organic fertilizers and inorganic and organic plant growing media.

[10] Mr. Nielsen states that such goods are sold directly to customers at the Owner's warehouse store in Calgary and are also sold and shipped to greenhouses and other private facilities across Canada. He attests that the Owner sold over a hundred thousand dollars' worth of such goods during the relevant period.

[11] To demonstrate how the Mark is used in association with such goods, Mr. Nielsen provides images, promotional materials and sales invoices for a specific product (the Product) that he asserts contains the registered goods and is sold in association with the Mark.

[12] I note that, in several of these documents, the Mark appears within the following logo, where FLORA appears above COMPO'® in the same size and style of lettering (the Product Logo):



[13] In particular, the following documents are attached as exhibits to Mr. Nielsen's affidavit:

- Exhibit B is a photograph of a plastic bag for the Product showing “how the Trademark is used directly on the packaging of the relevant Goods at the time of transfer to a customer during the Relevant Period”. The Product Logo is displayed at the top of the bag and the Owner's name is displayed at the bottom. The contents of the bag are identified on its label as “Soil less ORGANIC BASE POTTING COMPOST”.
- Exhibit C is described by Mr. Nielsen as a “product information sheet” for the goods in question. Titled “Growing Medium” and subtitled “NEW! Flora Compo “Plus” – Soilless Growing Medium”, this two-page sheet depicts the bag from Exhibit B and describes the product, noting its uses and benefits. An earth-like substance—presumably the product itself—is shown next to the image of the bag. I note that the text identifies the product as “Flora Compo “Plus”” and also refers to “the “Plus” factors” as including fungi, silicone, enzymes and hormones.
- Exhibit D consists of four “reprinted sample copies of invoices (partially redacted)” from the Owner to various customers located in Alberta and British Columbia. Each invoice is dated during the relevant period and lists several hundred units of “Flora Compo” or “Flora Compo 65 L” in the description of products sold.

- Exhibit E is described by Mr. Nielsen as a sample page from a promotional “resource guide” sent to customers during the relevant period. Mr. Nielsen explains that such resource guides are regularly sent to customers by mail and are also available at the Owner’s warehouse. The exhibited page is titled “Greenhouse Growing Media” and displays the Product Logo, next to an image of the Product and its bag. The text identifies the product as “Flora Compo” and describes it with reference to “the “Plus” factors”.

[14] As noted by Mr. Nielsen, certain terms referring to the registered goods have been underlined on the product information sheet at Exhibit C. In particular, a reference to “silicon” is underlined in the passage “silicon has been added which stabilizes the pH of the growing medium while promoting healthier and stronger cell walls”. Mr. Nielsen confirms that “silicon” is a chemical substance used in the cultivation and fertilization of plants.

[15] In addition, the terms “micronutrients”, “enzymes and hormones”, “fungi” and “organic base” are underlined; Mr. Nielsen confirms that these substances are chemical and organic fertilizers and inorganic and organic plant growing media. In this respect, I note that the information sheet refers more particularly to “proper nutrient balance, including micronutrients”; “naturally occurring enzymes and hormones [added] to further support healthier and stronger plant growth”; “living microorganisms naturally found in the soil, called fungi”, which “help to eliminate food for disease causing organisms” and “allow for greater nutrient availability for the plants”; “organic base compost”; and “A Soilless Medium with an Organic Base”.

[16] Additional descriptions in the information sheet include references to “A Trace Element Package”, “humus” and a “granular wetting agent”.

ANALYSIS

[17] In its written representations and at the hearing, the Owner confirmed that the Mark was not used in Canada during the relevant period in association with Goods (1), (2), (4) or (5), and there is nothing in the evidence to suggest otherwise.

[18] With respect to Goods (3) and (6), however, the parties differ in their interpretation of the evidence.

The Requesting Party's Position

[19] The Requesting Party makes two principal submissions: first, that the trade-marks depicted in the evidence are not the Mark as registered, and second, that the Product does not correspond to any of the registered goods.

[20] With respect to its first argument, the Requesting Party contends that the trade-mark depicted in the evidence is FLORA COMPO or FLORA COMPO PLUS, neither of which constitutes the Mark as registered.

[21] In this respect, the Requesting Party interprets the ® subscript following COMPO in the Product Logo as applying to the indivisible phrase FLORA COMPO. In advancing this interpretation, the Requesting Party argues that FLORA and COMPO are of the same size and lettering style, such that the registered trade-mark COMPO does not stand out.

[22] Furthermore, in the Requesting Party's submission, the apostrophe at the end of COMPO suggests an abbreviation for a word such as "compost", "composition" or "compound". Accordingly, the Requesting Party argues that the Product Logo may be perceived as consisting of the dominant feature FLORA followed by COMPO as a merely descriptive term. In the Requesting Party's submission, although this apostrophe is absent from COMPO in the exhibited invoices and informational materials, its presence on the product packaging influences the public's perception of the trade-mark in general.

[23] The Requesting Party also notes that the word PLUS in the expression FLORA COMPO "PLUS" is of the same size and font as FLORA COMPO. Accordingly, the Requesting Party submits that the word PLUS might be perceived as an element of the trade-mark as well.

[24] With respect to the nature of the goods, the Requesting Party submits that a trade-mark owner is required to produce distinct evidence for *each* good listed in the registration. More particularly, the Requesting Party submits that the evidence must identify products whose primary function corresponds to each of the registered goods. In support, the Requesting Party cites the Federal Court's decision in *Sharp Kabushiki Kaisha v 88766 Canada Inc* (1997), 72 CPR (3d) 195 (FCTD), where the Court stated that a microwave oven possessing a clock

function cannot be labelled a “clock”, because the time-keeping function is “clearly incidental to the distinct prime use” of a microwave oven [at paragraphs 10–11].

[25] The Requesting Party contends that, in the present case, the Product does not correspond to any of the registered goods as they are defined in the registration.

[26] Specifically, with respect to Goods 3—chemical substances used in the cultivation and fertilization of plants—the Requesting Party submits that, although the Product may contain chemical substances, it is not itself a “chemical substance” and therefore does not fit within the definition of Goods 3.

[27] With respect to Goods 6—chemical and organic fertilizers and inorganic and organic plant growing media—the Requesting Party first submits that the Product’s ingredients have only been shown to include fertilizer that is “chemical” and not “organic” and that, in any event, the Product’s primary function is not that of a “fertilizer”. Secondly, the Requesting Party submits that the Product is, at best, an “organic” growing medium as opposed to an “organic and inorganic” growing medium.

The Owner’s Position

[28] The Owner submits that the trade-mark COMPO as it appears in the evidence has not lost its identity, remains recognizable, and is preserved as the dominant feature of the Mark both as registered and as used. The Owner submits that the trade-mark COMPO stands out from the other written material with which it is displayed and creates a separate impression in the minds of the public.

[29] In particular, the Owner emphasizes that COMPO is presented on its own line in the Product Logo, which serves to separate it from the word FLORA and to signal that FLORA does not form part of the trade-mark. The Owner interprets the ® symbol in the logo’s bottom right corner as being positioned next to COMPO only and away from FLORA. In the Owner’s submission, had the ® symbol been intended to apply to the entire logo, it would have been placed in its *upper* right corner.

[30] The Owner further submits that FLORA, in light of its “plain and well-known meaning”, would be regarded as purely descriptive matter—indicating a product intended to be used with plants—while COMPO stands out as a coined trade-mark. In this respect, the Owner does not concede that the ’ symbol in the Product Logo would be perceived as an apostrophe, particularly when it is absent from the corresponding word mark displayed in the exhibited materials.

[31] With respect to the word PLUS, the Owner emphasizes that it only appears after FLORA COMPO on the product information sheet, where it is set apart by quotation marks. The Owner submits that it would accordingly be perceived as “marketing puffery”, separate from the COMPO trade-mark.

[32] With respect to the nature of the goods, the Owner submits that the present case is one where a single product can serve as evidence of use for an entire category of goods on a plain reading of the registration. More specifically, the Owner submits that the statement of goods may be read as defining a single product having a number of characteristics. In this respect, the Owner draws an analogy with the Registrar’s decision in *Sim & McBurney v Parmalat Food Inc* (2003), 30 CPR (4th) 552 (TMOB), where it was held that cheese spread met all the characteristics of the registered statement of goods “a food product in the nature of a dip, spread, or fondue and a product similar to sour cream to be used as a sauce or condiment on vegetables and other foods or as a base for a dip, spread, fondue, and salad dressing or mayonnaise”.

[33] Applying the same reasoning to the present case, the Owner submits that the Product is a mixture of chemical fertilizers, organic fertilizers, inorganic growing media, organic growing media, and chemical substances used in both cultivation and fertilization of plants, which satisfies all aspects of both Goods 3 and Goods 6.

[34] In particular, the Owner points to Mr. Nielsen’s evidence that the silicon component of the Product is used in both cultivation and fertilization as satisfying all aspects of the definition of Goods 3.

[35] With respect to Goods 6, the Owner characterizes the Product’s micronutrients as chemical fertilizers; its enzymes and hormones as organic fertilizers; its granular wetting agent

as an inorganic growing medium; and its fungi and organic base compost as organic growing media.

Conclusion

[36] As noted by the Owner, when interpreting a statement of goods in a section 45 proceeding, one is not to be “astutely meticulous when dealing with [the] language used” [see *Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654, 51 CPR (4th) 434 at paragraph 17]. With this principle in mind, and given the particular nature of the goods, I am prepared to accept that each registered statement of goods at issue in the present case may be interpreted as referring to a single product that comprises multiple registered goods.

[37] Moreover, given that the Product is identified as “compost” on its label and as a “growing medium” on its information sheet and in the Owner’s resource guide, I am prepared to accept that the Product’s primary function is two-fold, namely, to act both as fertilizer and as a growing medium. Furthermore, notwithstanding the Requesting Party’s submissions, I consider the Product descriptions in the information sheet and resource guide sufficient to demonstrate that the bag includes both chemical and organic fertilizers and both inorganic and organic growing media. Likewise, I find this evidence sufficient to demonstrate that the Product is essentially a mixture of chemical substances that are used both in the cultivation of plants and in their fertilization.

[38] Regardless, the bigger question in this case is whether the evidence demonstrates use of the Mark as registered. In this respect, I note that COMPO is not displayed on its own anywhere in the evidence; it is always displayed after the word FLORA, for example, as “Flora Compo”, “Flora Compo “Plus””, or the Product Logo.

[39] In considering whether display of a trade-mark constitutes display of the mark as registered, the question to be asked is whether the trade-mark was used in such a way that it did not lose its identity and remained recognizable, in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA)].

[40] Generally, use of a word mark in combination with additional words or design features qualifies as use of the word mark if the public, as a matter of first impression, would perceive the word mark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)]. The issue is a question of fact, dependent upon such factors as whether the word mark stands out from the additional material, for example, by the use of different lettering or sizing, or whether the additional material would be perceived as purely descriptive matter or as a separate trade-mark or trade name [*Nightingale, supra*; see also *Loro Piana SPA v Canadian Council of Professional Engineers (CCPE)*, 2009 FC 1096, 2009 CarswellNat 3400]. The placement of a trade-mark registration symbol may be a relevant factor to consider in this respect, but is not necessarily determinative.

[41] Applying the foregoing principles to the present case, I am not satisfied that the public, as a matter of first impression, would perceive the Mark *per se* as being used.

[42] In my view, the dominant feature of the Mark as registered is the short, single word COMPO, whereas the dominant feature of the variations in evidence is the combination FLORA COMPO. I find that, although FLORA in this context arguably suggests a product for “plants”, COMPO too is suggestive in this context, calling to mind “compost” or a chemical “composition” for such plants. The element resembling an apostrophe, where it appears, regardless of its intended meaning reinforces this interpretation. In the circumstances, I consider the particularity of the construction FLORA COMPO as creating a unitary expression that would be perceived as one trade-mark.

[43] In the case of the Product Logo, the common lettering size and style further unify the two words FLORA and COMPO into a single design and thus reinforce the impression of a single trade-mark. I do not consider the stacked arrangement of the words or the placement of the ® symbol in the bottom corner to detract from this impression.

[44] In the case of the word marks, I find that the capitalization of the initial letters in the phrase “Flora Compo” separates this combination from the surrounding text, again reinforcing the impression of a single trade-mark. Whether “Plus” would be perceived as a third element of the trade-mark or as a separate reference to the addition of “the “Plus” factors” does not alter the impression that “Flora Compo” is being presented as a unitary expression.

[45] At the hearing, the Owner cited several cases where the trade-mark at issue in a section 45 proceeding was considered to be used as registered, notwithstanding the presence of adjacent word elements that were apparently of the same size and lettering style as the trade-mark. However, as noted above, whether a word mark stands out from surrounding text is a question of fact, to be decided on a case by case basis. In the present case, I find that the decisions cited by the Owner involved distinguishing factors.

[46] For example, in *Riches, McKenzie & Herbert v Pillsbury Co* (1995), 61 CPR (3d) 96 (TMOB) and *LE PEPE' SRL v PJ Hungary Kft*, 2017 TMOB 82, 2017 CarswellNat 4361, the elements added to the registered trade-mark essentially *named* the associated goods, in plain language. In *88766 Canada Inc v OM Scott & Sans Co* (1997), 79 CPR (3d) 160 (TMOB) and *Dimock Stratton LLP v Cadman Manufacturing Co*, 62 CPR (4th) 216 (TMOB), elements such as physical spacing or the prefix “PLUS” created the impression that more than one trade-mark was being displayed. Somewhat similarly, in *Fasken Martineau DuMoulin LLP v AGF Management Ltd* (2003), 29 CPR (4th) 411 (TMOB), the positioning of TM symbols was considered to separate the registered trade-mark from adjacent word elements placed after—but, notably, not before—the registered mark. However, in the present case, I do not find that any such factors act to differentiate the Mark *per se* from the expression FLORA COMPO.

[47] Accordingly, I am of the view that the public, as a matter of first impression, would perceive the trade-mark being used as FLORA COMPO. The registered trade-mark COMPO does not stand out from this combination. Consequently, I am not satisfied that the Mark maintains its identity or remains recognizable as a distinct trade-mark within either the Product Logo or the expressions “Flora Compo” and “Flora Compo “Plus””.

DISPOSITION

[48] In view of all the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered goods within the meaning of sections 4(1) and 45 of the Act. Furthermore, there is no evidence before me of special circumstances excusing the absence of such use.

[49] 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 expunged.

Oksana Osadchuk
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2018-04-17

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