



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 46

Date of Decision: 2020-05-27

IN THE MATTER OF A SECTION 45 PROCEEDING

DS Avocats Canada

Requesting Party

and

CHS Inc.

Registered Owner

TMA626,060 for CHS

Registration

[1] At the request of DS Avocats Canada (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on November 6, 2017 to CHS Inc. (the Owner), the registered owner of registration No. TMA626,060 for the trademark CHS (the Mark).

[2] The Mark is registered in association with the following goods and services:

Goods

(1) Clothing, namely, caps, gloves, sweaters, shirts and jackets.

Services

(1) Personnel management consultation services in the field of employee training and benefits, pension benefits and manager's compensation and reviews, personnel recruitment and placement services for local cooperative managers; cooperative business

management, cooperative advertising services, namely, consultation services in the development of advertisements and sales promotions; distributorship services featuring agricultural products and supplies; association services, namely promoting the interests of agricultural cooperatives, farmers and agricultural cooperative oriented parties.

(2) Grain and commodity brokerage services.

(3) Warehouse storage of grain; transportation of grain by truck, train and ship.

(4) Grain processing and milling services.

(5) Evaluation and testing of real estate for the presence of hazardous material.

(6) Restaurant services.

(7) Agricultural fertilizing, namely, application of fertilizers or chemicals.

(8) Cooperative consultation services in the field of financial planning.

[3] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between November 6, 2014 and November 6, 2017, in association with the goods and services specified in the registration. If the Mark had not been so used, the Owner 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 definitions of use are set out in section 4 of the Act as follows:

4(1) A trademark 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.

4(2) A trademark 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 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 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 trademark in association with each of the goods and services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[6] With respect to services, the display of a trademark on advertising is sufficient to meet the requirements of section 4(2) when the trademark owner is offering and prepared to perform those services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Lisa L. Graham-Peterson, sworn June 4, 2018 in Inver Grover Heights, Minnesota (the Affidavit).

[8] Only the Owner submitted written representations; an oral hearing was not requested.

[9] I note that, subsequent to the submission of the Owner's written representations, the statement of services was reorganized pursuant to a request to group the goods and services of the registration by Nice class. The statement above and disposition below reflect the goods and services as they currently appear on the register.

OVERVIEW OF THE OWNER'S EVIDENCE

[10] The Affidavit can be summarized as follows:

- Ms. Graham-Peterson is a director with the Owner [para 1].
- The Owner is a U.S.-based "global agribusiness" serving agricultural cooperatives and farmers [para 5].
- During the relevant period, the Owner operated in Canada through CHS global sales and marketing offices and CHS retail locations in Alberta, Manitoba and Saskatchewan. These locations were operated by licensees and the Owner exercised control over the nature of the goods and services offered by such licensees. Exterior signage at these Canadian locations displayed the Mark [paras 6 and 7].
- Ms. Graham-Peterson asserts use of the Mark in Canada during the relevant period in association with most of the registered goods and services, omitting "gloves" and the following services: "[Personnel management consultation services in the field of] ... benefits, pension benefits and manager's compensation and reviews" and "restaurant services" [para 9].

- During the relevant period, the Owner operated a global website (*www.chsinc.com*) and a Canadian website (*www.chs-canada.ca*), which displayed the Mark and advertised the Owner's services and locations in Canada [paras 10 to 14, Exhibits A to C].
- Since September 2015, the Owner has operated a Twitter account through which it advertised many of the services offered in Canada [para 15, Exhibit D].
- Ms. Graham-Peterson specifically lists the services that were advertised through the aforementioned websites and Twitter feed and she confirms that, during the relevant period, such services were performed or available to be performed in Canada through the CHS offices and retail locations in Canada [paras 14 to 16]. She also specifically lists the services that were available to farmers either directly from the Owner or through its licensed CHS offices and retail locations in Canada during the relevant period [para 17]. I note that these lists correspond to her assertion of use covering most of the registered services in paragraph 9 of the Affidavit.
- With respect to the registered goods, the Owner sells merchandise bearing the Mark, including "clothing such as caps, sweaters, shirts and jackets". During the relevant period, Canadians could purchase these items at the aforementioned CHS retail locations and online. The Affidavit includes representative images of the clothing goods sold in Canada [para 18, Exhibit E], as well as representative invoices [para 21, Exhibit F]. Consistent with its omission from the assertion of use in paragraph 9 of the Affidavit, I am unable to identify any relevant reference to the goods "gloves".

ANALYSIS

[11] In its written representations, the Owner submits that the evidence shows that the Mark was used during the relevant period in association with all of the goods and services, with the exception of "restaurant services".

[12] For the most part, I agree with the Owner. With respect to the services, the evidence shows that the Mark was displayed throughout the Owner's online resources and on signs outside of its CHS offices and retail locations in Canada. In view of Ms. Graham-Peterson's clear

statements regarding the availability and performance of the Owner's services, I am satisfied that the Owner has demonstrated use of the Mark in association with those services for which Ms. Graham-Peterson asserts use.

[13] With respect to "personnel management consultation services in the field of ... employee benefits, pension benefits and manager's compensation and reviews", as noted above, there is no assertion of use. Nevertheless, at paragraph 38 of its written representations, the Owner submits that such services should be maintained as they are ancillary to "personnel management consultation services in the field of employee training; personnel recruitment and placement services for local cooperative managers", for which use has been demonstrated.

[14] However, I am not prepared to accept the Owner's mere assertion that "consultation services" related to benefits and compensation are necessarily ancillary or within the scope of "consultation services" related to training, recruitment or placement. The Owner distinguished these services in the registration and neither Ms. Graham-Peterson's otherwise clear statements nor the evidence as a whole supports this assertion.

[15] In any event, the assertion of use at paragraph 9 in the Affidavit specifically omits reference to such "benefits" and "compensation" consultation services, and I am otherwise unable to identify any reference to such omitted services in the evidence. As such, even if consultation services with respect to benefits and compensation *could* be considered "ancillary" or within the scope of "personnel management consultation services in the field of employee training" and/or "personnel recruitment and placement services", there is no basis to conclude that this was the case for the Owner in Canada during the relevant period or otherwise.

[16] In the absence of such an assertion of use and in the absence of any evidence indicating that the Owner did indeed offer such specific services in Canada during the relevant period, I am unable to conclude that, at a minimum, the Owner offered and was able to perform such further consultation services in the field of "employee benefits, pension benefits and manager's compensation and reviews" in Canada during the relevant period.

[17] Furthermore, as conceded by the Owner, there is no evidence of use of the Mark in association with "restaurant services".

[18] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with all of the registered services with the exception of “[personnel management consultation services in the field of] ... employee benefits, pension benefits and manager’s compensation and reviews” and “restaurant services” within the meaning of sections 4(2) and 45 of the Act.

[19] With respect to the registered goods, in view of Ms. Graham-Peterson’s statements together with the representative evidence of transfers and display of the Mark indicated above, I am satisfied that the Owner has demonstrated use of the Mark in association with caps, sweaters, shirts and jackets.

[20] With respect to “gloves”, the Owner submits that gloves “are closely related to the other clothing items ... for which use has been demonstrated” and should therefore be maintained as well [Owner’s written representations at para 37].

[21] In this respect, the Owner submits that “it is not necessary to provide evidence of use for each and every registered good and/or service in Section 45 proceedings, due to their summary and administrative nature” [Owner’s written representations at para 36, citing *Earth to Table Inc v Restaurants Pacini Inc*, 2019 TMOB 10 at para 7; *Matthew S. George v Dr. ’s Own, Inc*, 2018 TMOB 147 at para 72; *Billy Bob’s Jerky Inc v 676166 Ontario Limited*, 2010 TMOB 76 at para 16; *Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD); and *Saks & Co v Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD)].

[22] However, the Owner’s submission that it is not necessary to provide evidence of use for each good is an over-generalization and such a principle is not actually reflected in its cited decisions. For example, *Earth to Table* simply states that “there is no need to file overabundant evidence” [at para 7]. Both *Matthew S. George* [at para 72] and *Billy Bob’s Jerky* [at para 16] go further and correctly characterize the principle that what is not required is “direct” evidence or documentary proof of use in association with each good.

[23] As noted in *Plough, supra*, a mere assertion of use is not sufficient to establish use in a section 45 proceeding. What is required is that an affidavit “show use by describing facts from which the Registrar or the Court can form an opinion or can logically infer use within the

meaning of section 4 of the Act” [*Guido Belucchi & C Srl v Brouillette Kosie Prince*, 2007 FC 245 at para 18]. In this case, the Affidavit does not even provide an assertion of use with respect to “gloves”. Given the lack of any reference to “gloves” otherwise in the Affidavit, this omission does not appear to be inadvertent.

[24] In the absence of such an assertion or any clear evidence or statements otherwise, whether or not gloves are “related” to the other registered “clothing” goods is irrelevant to the question of whether use of the Mark with respect to “gloves” has been demonstrated in this case.

[25] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with all of the registered “clothing” goods except “gloves” within the meaning of sections 4(1) and 45 of the Act.

[26] As there is no evidence of special circumstances excusing non-use of the Mark before me, the registration will be amended accordingly.

DISPOSITION

[27] Pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete the goods “gloves” as well as services (6) “Restaurant services” and “[...] and benefits, pension benefits and manager's compensation and reviews” from services (1).

[28] The amended statement of goods and services will be as follows:

Goods

(1) Clothing, namely, caps, sweaters, shirts and jackets.

Services

(1) Personnel management consultation services in the field of employee training, personnel recruitment and placement services for local cooperative managers; cooperative business management, cooperative advertising services, namely, consultation services in the development of advertisements and sales promotions; distributorship services featuring agricultural products and supplies; association services, namely promoting the interests of agricultural cooperatives, farmers and agricultural cooperative oriented parties.

(2) Grain and commodity brokerage services.

(3) Warehouse storage of grain; transportation of grain by truck, train and ship.

- (4) Grain processing and milling services.
- (5) Evaluation and testing of real estate for the presence of hazardous material.
- (7) Agricultural fertilizing, namely, application of fertilizers or chemicals.
- (8) Cooperative consultation services in the field of financial planning.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: No Hearing Held

AGENTS OF RECORD

Borden Ladner Gervais LLP

For the Registered Owner

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For the Requesting Party