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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 133

Date of Decision: 2021-06-29

IN THE MATTER OF A SECTION 45 PROCEEDING

Riches, McKenzie & Herbert LLP

Requesting Party

and

The Mosaic Company

Registered Owner

TMA772,704 for MES

Registration

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13, (the Act) with respect to registration No. TMA772,704 for the trademark MES (the Mark).

[2] For the reasons that follow, I conclude that the registration ought to be maintained.

THE PROCEEDINGS

[3] At the request of Riches, McKenzie & Herbert LLP, the Registrar of Trademarks issued a notice under section 45 of the Act on December 27, 2018, to The Mosaic Company (the Owner), the registered owner of the Mark.

[4] The Mark is registered for use in association with “Fertilizer”.

[5] The notice required the Owner to show whether the trademark has been used in Canada, in association with the registered good, 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 December 27, 2015, to December 27, 2018.

[6] The relevant definition of use in the present case is set out in section 4(1) 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.

[7] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register. The evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. This burden of proof is light; evidence need only supply facts from which a conclusion of use may follow as a logical inference [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[8] In the absence of use as defined above, pursuant to section 45(3) of the Act, a trademark is liable to be expunged, unless the absence of use is due to special circumstances that excuse the absence of use.

[9] In response to the Registrar’s notice, the Owner furnished the affidavit of its Vice President, Gordon McKenzie, sworn on July 25, 2019.

[10] Only the Owner submitted written representations. No oral hearing was held.

THE EVIDENCE

[11] In his affidavit, Mr. McKenzie states that the Owner produces and retails a variety of premium agricultural fertilizer and crop nutrient products. The fertilizers sold by the Owner are intended primarily for large-scale farming operations, thus, it is sold in bulk format to the targeted clients, such as agricultural producers and retailers. Then, the goods are shipped to purchasers via rail, truck or boat and are distributed throughout Canada.

[12] Mr. McKenzie states that the “goods are typically purchased from the Registrant by retailers and distributors in Canada by way of direct contact with their sales representative”. Then, a purchase order is made by the Owner. Once the product is ready to be shipped, a bill of lading will be generated for provision at the time of delivery of the goods and the customer will receive an electronic invoice. Mr. McKenzie states that this is representative of the agriculture industry with respect to purchasing these types of goods.

[13] With respect to display of the Mark during the relevant period, Mr. McKenzie explains that the Mark does not appear on the goods themselves. However, he states that every customer receives a safety data sheet with the delivery of the goods and that the Mark appears on that sheet.

[14] Mr. McKenzie states that the Owner sold \$635,386,496 of such fertilizer in association with the Mark during the relevant period in Canada.

[15] In support, the following relevant exhibits are attached to Mr. McKenzie’s affidavit:

- Exhibit F consists of emails dated within the relevant period between the Owner’s account managers and purchasers at Cargill and McCain Fertilizer, Canadian clients, displaying orders made for the registered goods; the registered goods sold are referred as “MES-10”, “MAP”, “MESZ”, “MicroEssentials S10”, “MES15” and “MES”.
- Exhibit G consists of a purchase order, an invoice and a bill of lading, all of them within the relevant period, from the Owner to a Canadian client purchasing the registered good. I note that the product sold is listed as “MES Z” on the purchase order and as “MICRO ESSENTIALS SZ” on the invoice and on the bill of lading.

- Exhibit I is a copy of the safety data sheet given to customers when they received shipments. The sheet contains technical information relating to the Owner’s fertilizer and the Mark appears on this sheet, as well as other trademarks.

ANALYSIS AND REASONS FOR DECISION

[16] While I note that the formulation “MES Z” is used on the purchase orders, I am satisfied that the public, as a matter of first impression, would perceive the Mark as being used *per se* given that it is set apart from the additional letter “Z” [see *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)]. Further, while the Mark appears alongside other trademarks throughout the evidence filed, there is nothing in the Act that precludes a the use of more than one trademark at the same time in association with the same goods or services [*AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)].

[17] In previous cases, different documents displaying the trademark were deemed sufficient to give a notice of association between the trademark and the goods sold, such as an instruction sheet [see *Borden Ladner Gervais v Mueller International, Inc*, 2009 CanLII 82132 (TMOB) at para 11], a user manual [see *BCF LLP v THAT Corporation*, 2016 TMOB 190 at paras 31 to 33] and sales brochure, warranty form, and product manual [see *Billi R & D Pty Ltd v Culligan International Company*, 2020 TMOB 20 at para 14].

[18] In the present case, because the Mark appears on safety data sheets that are given to purchasers when they receive the goods, I accept that notice of association between the Mark and the registered good was given to the purchasers at the time of transfer of the registered goods, in accordance with the provisions of section 4(1) of the Act. Further, based on the Exhibit F and G evidence showing transfers of fertilizer in the normal course of trade in Canada during the relevant period, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods during the relevant period within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[19] Accordingly, 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 maintained.

Ann-Laure Brouillette
Hearing Officer
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

MLT Aikins LLP

For the Registered Owner

Riches, McKenzie & Herbert LLP

For the Requesting Party