



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 191

Date of Decision: 2022-09-28

IN THE MATTER OF A SECTION 45 PROCEEDING

McMillan LLP

Requesting Party

and

**Green Cross Society of British
Columbia**

Registered Owner

**TMA773,749 for GREEN CROSS &
Design**

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. TMA773,749 for the trademark GREEN CROSS & Design (the Mark), owned by Green Cross Society of British Columbia (the Owner), and shown below:



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

THE PROCEEDING

[3] At the request of McMillan LLP (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on December 22, 2020.

[4] The notice required the Owner to show whether the Mark was used in Canada in association with each of the goods and services 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 December 22, 2017, to December 22, 2020.

[5] The Mark is registered for use in association with the following goods and services:

GOODS:

Cannabis namely marijuana.

SERVICES:

Providing research services in the area of cannabis namely marijuana; Product development services in the area of cannabis namely marijuana.

[6] The relevant definitions of use in the present case 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.

[7] It is well established that 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)]. However, 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.

[8] In response to the Registrar's notice, the Owner furnished the statutory declaration of Stephen James Burris, Director of the Owner, sworn on July 18, 2021. Both parties submitted written representations; no hearing was held.

THE EVIDENCE

[9] Mr. Burris states that the Owner is a "compassion club" that distributed cannabis products to its members from its offices in British Columbia during the relevant period. Such distribution is often by way of Canada Post, with payment for such products often being made in cash.

[10] Mr. Burris attaches the following exhibits to his statutory declaration:

- Exhibit A: a "recent" photograph of cannabis alongside packaging displaying the Mark. Mr. Burris states that the strain of cannabis shown in the photograph was sold by the Owner during the relevant period.
- Exhibit B: a photograph of the address label for a "typical" Canada Post Xpresspost package of cannabis product that was "recently" sent by the Owner to a customer. Mr. Burris states that when using this delivery method, the packaging displaying the Mark shown in Exhibit A is included in the Xpresspost envelope, and that many similar packages bearing the Mark were sent by the Owner to its members by Canada Post during the relevant period.
- Exhibit C: a screenshot from the Owner's website dated August 20, 2020, displaying testimonials by members of their experience with the activities of the Owner.
- Exhibit D: a photograph of the exterior signage and interior reception areas of the Owner's Vancouver office as it appeared before the Owner vacated that office in July 2019.

REASONS FOR DECISION

[11] In its written representations, the Owner submits only that its evidence shows use of the Mark in association with its registered goods. As there is no reference to the registered services in Mr. Burris' statutory declaration or evidence of use of the Mark in association with such services, or of special circumstances excusing such non-use, I am not satisfied that the Owner has shown use of the Mark in association with the registered services within the meaning of sections 4 and 45 of the Act. The registration will be amended accordingly.

[12] With respect to the registered goods, the Requesting Party submits that it is ambiguous whether the exhibited photographs attached to Mr. Burris' statutory declaration are dated during the time period, noting that Exhibits A and B, for example, are described as "recent" but not explicitly dated during the relevant period by Mr. Burris. In this respect, I note that the Requesting Party attaches an appendix to its written representations purporting to show that the tracking number on the package shown in Exhibit B is dated outside the relevant period. However, pursuant to sections 45(1) and (2) of the Act, I can only consider evidence submitted in the form of an affidavit or statutory declaration filed by the Owner. Accordingly, these purported facts will be disregarded.

[13] I concur with the Requesting Party that Mr. Burris does not state that the photographs of packaging shown in Exhibits A and B were taken during the relevant period. However, Mr. Burris is clear in his statutory declaration that the packaging shown in Exhibit A is representative of packaging that would have been used by the Owner during the relevant period. Nevertheless, I note that the Owner's only evidence that its goods were actually transferred in the normal course of trade in Canada during the relevant period, as required by the Act, are the following statements by Mr. Burris:

- that the Owner "distributed and still distributes cannabis/marijuana products for medical purposes to its members" [para 3];
- that the Owner "has continuously used the Trademark in connection with such distribution activities during the three-year period preceding December 22, 2020" [para 4];

- that the cannabis product shown in Exhibit A “is of a strain of marijuana that was sold by the [Owner] during the [relevant period]” [para 5];
- that the packaging shown in Exhibit A was used by the Owner “when selling or distributing its cannabis/marijuana products to its members during the [relevant period]” [para 5]; and
- that “many similar packages [to the packaging shown in Exhibit B] bearing the Trademark were sent by the [Owner] to its members by Canada Post throughout the [relevant period]”.

[14] Aside from these statements, the Owner provides no evidence *demonstrating* that transfers in the normal course of trade occurred during the relevant period. I note that Mr. Burris states that the Owner’s customers typically pay for cannabis in cash, which may imply that invoices for such purchases were not available. However, although invoices are not mandatory in order to satisfactorily reply to a section 45 notice [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)], some evidence of transfer in the normal course of trade in Canada is necessary [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)]. Such evidence can be in the form of documentation like sales reports, but can also be through clear sworn statements regarding volumes of sales, dollar value of sales, or equivalent factual particulars [see, for example, *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79].

[15] In this case, no such factual particulars are provided. Indeed, Mr. Burris refers to the Owner “selling or distributing its cannabis/marijuana products” [emphasis added]; it is not clear whether such distribution of cannabis, which he appears to distinguish from selling cannabis, would amount to transfer in the normal course of trade as opposed to, for example, free distribution of samples. Further, Mr. Burris states that in 2018, which I note is shortly after the beginning of the relevant period, the Owner had to reduce its activities while it applied for new licences. In my view, this further calls into question whether the Owner was able to transfer its goods in the normal course of trade during the relevant period.

[16] Ultimately, in the absence of factual particulars clearly demonstrating that the Owner transferred goods in Canada in the normal course of trade during the relevant period, I am not

satisfied that the Owner has shown use of the Mark in association with the registered goods within the meaning of sections 4 and 45 of the Act. The registration will be amended accordingly.

DISPOSITION

[17] In view of all of the foregoing, 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 expunged.

G.M. Melchin
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

Accupro Trademark Services LLP

For the Registered Owner

McMillan LLP

For the Requesting Party