



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2024 TMOB 018

**Date of Decision:** 2024-01-31

## **IN THE MATTER OF A SECTION 45 PROCEEDING**

**Requesting Party:** Borden Ladner Gervais LLP

**Registered Owner:** G.E.O. Products Ltd.

**Registration:** TMA790,845 for Green Earth Organics

### **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. TMA790,845 for the trademark Green Earth Organics (the Mark), owned by G.E.O. Products Ltd. (the Owner).

[2] For the reasons that follow, I conclude that the registration ought to be amended to delete the registered goods.

### **THE RECORD**

[3] At the request of Borden Ladner Gervais LLP (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on February 15, 2023. The notice required the Owner to show whether the Mark had been

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 February 15, 2020, to February 15, 2023.

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

GOODS

Organically grown fresh fruit and fresh vegetables.

SERVICES

Retail sale, distribution and delivery of organic groceries.

[5] 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.

(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.

[6] It is well accepted 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.

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Daniel Henry, the sole officer and director of the Owner, sworn on May 15, 2023. Both parties submitted written representations; no oral hearing was held.

### **EVIDENCE**

[8] Mr. Henry explains that the Owner has been engaged in selling organically grown fruit and vegetables, and in selling, distributing, and delivering organic groceries, in association with the Mark since 1998. Such goods are sold in baskets displaying the Mark on the side and delivered to customers. Such customers also receive an invoice displaying "GREEN EARTH ORGANICS" on the upper left side; as Exhibit B, Mr. Henry attaches one such invoice for a basket which he delivered to a customer in early 2021. The words "Green Earth Organics" appear in the top left corner of the invoice along with a Vancouver address; however, the customer information and address is redacted on the invoice. I note that Mr. Henry does not specifically state that this sale, or any of the Owner's sales or deliveries during the relevant period, took place in Canada.

[9] As Exhibit C, Mr. Henry attaches screenshots from the webpage *organiclifestyle.com/toronto/organic-home-delivery-toronto*, which he states was "accessible to people around the world within the last three years". Entitled "About Green Earth Organics", Mr. Henry explains that the page describes the Owner's products and delivery service and allows customers to order organic fruits and vegetables through the website. I note that the website provides a Toronto and a Vancouver phone number to contact for information about the products.

### **ANALYSIS**

[10] The Requesting Party submits that the Owner's evidence does not show use of the Mark in association with the registered goods and services in Canada in the normal course of trade. In addition, the Requesting Party submits that the evidence does not establish that the Mark appeared on the basket referenced in the Exhibit B invoice, and that the Exhibit C website does not establish use of the Mark in association with the registered services because its contents are hearsay and because Mr. Henry does not

demonstrate that the website was accessed by Canadians during the relevant period. Each submission will be discussed in turn.

[11] With respect to the registered goods, I agree with the Owner that Mr. Henry has provided sufficient context to establish that the sale reflected in the invoice was in the Owner's normal course of trade, and I note that Mr. Henry explicitly confirms at paragraph 15 of his affidavit that the basket sold would have displayed the Mark. However, as noted by the Requesting Party, Mr. Henry does not confirm that the sale took place in Canada. The only references to Canada in evidence are the Owner's Vancouver address in the Exhibit B invoice, the references to Toronto in the URL for the screenshots shown in Exhibit C, and the Toronto and Vancouver phone numbers shown in those screenshots. While these materials suggest that the Owner is based in Canada and was offering its goods for sale in Canada, it is well established that "offering for sale" is not the same as "selling" [see *Michaels & Associates v WL Smith & Associates Ltd* (2006), 51 CPR (4th) 303 (TMOB)], and that advertising alone is insufficient to establish use of a trademark in accordance with section 4(1) of the Act [see *Riches, McKenzie & Herbert LLP v Cleaner's Supply Inc*, 2012 TMOB 211].

[12] The Federal Court has held that the Registrar must be able to "rely on an inference from proven facts rather than on speculation" to satisfy every element required by the Act [*Diamant Elinor Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at para 11; see also *Smart & Biggar v Curb*, 2009 FC 47]. In this case, while I accept that the Exhibit B invoice reflects a sale of the registered goods in the normal course of trade during the relevant period, there are no facts in evidence on which I could conclude that this sale occurred in Canada. Indeed, in *Trademark Factory International Inc v Steven Scott Hanft*, 2018 TMOB 48, cited by the Owner in support of its contention that the evidenced sales were in the normal course of trade, the Board noted that "the evidence should be clear that transfers occurred *in Canada*, as in the present case, it could be that the Canadian consumer purchased the Owner's goods in the United States" [para 18, emphasis in original]. In this case, if the Owner, being based in British Columbia, is able to offer its goods for sale in Toronto, there is nothing to suggest that it would not also be able to do business in the United States, even considering Mr. Henry's

statement that he personally delivered the basket. In the absence of facts confirming that the sole transfer of goods in evidence took place in Canada, I am not prepared to conclude that the Owner has shown that the Mark was used within the meaning of section 4(1) of the Act. Similarly, there is insufficient information for me to conclude that the Mark was marked in Canada on the goods or their packaging at the time of export pursuant to section 4(3). As the Owner does not set forth any special circumstances which would excuse non-use, the registration will be amended accordingly.

[13] As for the registered services, unlike the requirements of section 4(1), the display of a trademark in the advertisement of services is sufficient to satisfy the requirements of section 4(2) of the Act, from the time the owner of the trademark is willing and able to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)]. While the Exhibit B invoice does not show that the Owner performed its services in Canada during the relevant period, I accept that this transfer, when read in conjunction with the Exhibit C webpage URL referencing home delivery in Toronto and the Canadian phone numbers shown on that page, shows that the Owner was willing and able to perform its services in Canada.

[14] Although the Requesting Party contends that Mr. Henry's reference to the website being accessible "within the last three years" may refer to three years from the date of the affidavit being sworn (that is, May 15, 2023, three months after the end of the relevant period), as opposed to the three-year relevant period, I nevertheless accept that the screenshots reflect how the website would have appeared for at least the majority of the relevant period. With respect to the Requesting Party's submissions regarding the contents of that page being hearsay, it is well established that, given the summary nature of section 45 proceedings, "concerns with respect to the hearsay nature of evidence can go to weight, rather than admissibility" [*Eva Gabor International Ltd v 1459243 Ontario Inc*, 2011 FC 18 at para 18].

[15] While I agree with the Requesting Party that Mr. Henry has not clearly explained the relationship between the website shown in Exhibit C and the Owner, I nevertheless accept that the webpages would amount to advertising of the Owner's retail services in

association with the Mark, bearing in mind Mr. Henry's sworn statement that the page is "all about the Registered Owner and its products". With respect to advertising, I note that materials displaying the trademark must be "distributed to" or accessed by prospective customers in order to constitute advertising [*Cornerstone Securities Canada Inc v Canada (Registrar of Trade Marks)* (1994), 58 CPR (3d) 417 (FCTD)]. As such, for the exhibited webpages to constitute advertisement of registered services, there must be some basis upon which to infer that those webpages were accessed by Canadians during the relevant period [see, for example, *Ridout & Maybee v Residential Income Fund LP*, 2015 TMOB 185 at paras 47 and 48].

[16] In this case, Mr. Henry has confirmed that the websites were accessible for much of the relevant period. I note that the Registrar has been prepared to infer that a publicly accessible website was directed to and visited by Canadians on the basis of a ".ca" URL [see *Andrews Robichaud v Entechnevision Inc*, 2017 TMOB 109 at para 31; *Drake Marks Associates v Services Optométriques (Opt) Inc*, 2023 TMOB 137 at para 42]. While the website in evidence in this case is not a ".ca" website, I am prepared to infer, based on the webpage URL (which incorporates "*organic-home-delivery-toronto*") and the phone numbers listed on the website, that the website is directed towards prospective customers in Toronto and possibly Vancouver. Based on these factors, I consider it reasonable to infer that at least some Canadians would have accessed the website during the relevant period.

[17] Accordingly, I am satisfied that the Owner advertised its services in Canada in association with the Mark, and was offering and prepared to perform those services during the relevant period. I am therefore satisfied that the Owner has shown use of the registered services within the meaning of sections 4(2) and 45 of the Act.

### **DISPOSITION**

[18] 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 amended to delete the goods from the registration.

[19] The amended registration will be as follows:

Retail sale, distribution and delivery of organic groceries.

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G.M. Melchin  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** No hearing held

## **AGENTS OF RECORD**

**For the Requesting Party:** Borden Ladner Gervais LLP

**For the Registered Owner:** Jonathan Mesiano-Crookston