



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

Citation: 2016 TMOB 61
Date of Decision: 2016-04-13

IN THE MATTER OF A SECTION 45 PROCEEDING

Fogler, Rubinoff LLP

Requesting Party

and

Agrium Inc.

Registered Owner

TMA794,795 for ATACK

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA794,795 for the trade-mark ATACK (the Mark), owned by Agrium Inc.

[2] The Mark is registered for use in association with “pesticide and insecticide”.

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

The Proceeding

[4] On June 16, 2014, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Nu-Gro Ltd. (Nu-Gro), then registered as owner of registration No. TMA794,795. The notice was sent at the request of Fogler, Rubinoff LLP (the Requesting Party).

[5] I note that the registration page shows that Agrium Inc. became the owner of registration No. TMA794,795 by assignment from Nu-Gro on September 1, 2015, which assignment was

recorded on October 2, 2015. Since the change of owner stems from an assignment that occurred after the date of the section 45 notice, the change of owner has no consequence in this case.

[6] The notice required Nu-Gro to furnish evidence showing that it had used the Mark in Canada, at any time between June 16, 2011 and June 16, 2014 (the Relevant Period), in association with each of the registered goods. If the Mark had not been so used, Nu-Gro was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[7] Section 4(1) of the Act sets out the relevant definition of “use” in association with goods:

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.

[8] It has been well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for clearing the register of “deadwood”. The criteria for establishing use are not demanding and an overabundance of evidence is not necessary. Nevertheless, sufficient evidence must still be provided to allow the Registrar to conclude that the Mark was used in association with each of the registered goods specified in the registration [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270]. Any ambiguity in the evidence should be interpreted against the registered owner as it bears the full burden of proof [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184, 90 CPR (4th) 428 at para 16]. Furthermore, mere statements of use are insufficient to prove use [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[9] In response to the Registrar’s notice, Nu-Gro filed the affidavit of Sharon Izzo, sworn on July 24, 2014.

[10] Only the Requesting Party filed written representations; a hearing was not requested.

The Evidence

[11] Ms. Izzo identifies herself as Sales Manager, Professional Pest Control Products for Direct Solutions, a division of Agrium Advanced Technologies (U.S.) Inc. (AAT) [para 1].

[12] In paragraph 5 of her affidavit, Ms. Izzo states that Nu-Gro has licensed the use of the Mark to AAT which is a “business unit” of Agrium Inc., and the Mark has been sublicensed to Direct Solutions which is a “business unit” of AAT.

[13] Ms. Izzo states that the Mark has been used since 1997. Ms. Izzo files, as Exhibit “A” to her affidavit, a copy of the product registration form with Agricultural and Agri-Food Canada, dated November 18, 1996, for the ATACK Hornet and Wasp Killer product [para 6].

[14] Ms. Izzo explains that the ATACK Hornet and Wasp Killer product is sold in aerosol cans, and by case of 12 cans of 350 g. Ms. Izzo files a copy of the label of the cans, as Exhibit “B” to her affidavit. I reproduce below the trade-marks displayed on the label.



[15] I note that the label references the company Agrium Advanced Technologies RP Inc., which is not an entity mentioned by Ms. Izzo in her affidavit.

[16] The following are also provided by Ms. Izzo as exhibits to her affidavit:

- Exhibit “C”: copy of the Material Safety Data Sheet and label for the ATACK Hornet & Wasp Killer product available on the website at *www.directsolutions.com* [para 8¹];
- Exhibit “D”: information on the ATACK Hornet and Wasp Killer product available on the website [para 8²]; and

¹ This is a reference to the first of two paragraphs numbered « 8 » in the affidavit.

² This is a reference to the second of two paragraphs numbered « 8 » in the affidavit.

- Exhibit “E”: “a list comprised of AAT’s customers, the geographical area and sales” for the ATACK Hornet and Wasp Killer product from 2011 to the date of her affidavit [para 9].

[17] Ms. Izzo concludes her affidavit by stating that there has been continuous use of the Mark and that AAT has not abandoned nor has any intent of abandoning the Mark in Canada [para 10].

Analysis of the Issues

[18] In summary, the Requesting Party’s submissions with respect to the evidence are that:

- (a) the use shown is not use that enures to the benefit of Nu-Gro;
- (b) the Mark as used is not the Mark as registered; and
- (c) the affidavit does not evidence use of the Mark, during the Relevant Period, in association with each of the registered goods.

[19] I shall first consider the issue arising from the Requesting Party’s submissions that the use shown is not use that enures to Nu-Gro’s benefit because the evidence does not show that the alleged licensed use of the Mark by AAT satisfies the requirements of section 50 of the Act.

[20] Section 50(1) of the Act requires the owner of a trade-mark to have direct or indirect control of the character or quality of the goods or services in order for the use of a trade-mark by a licensee to be deemed to be use by the owner. Pursuant to section 50(2) of the Act, where public notice is given of the fact that the use of the trade-mark is a licensed use and the owner of the trade-mark is identified, it shall be presumed, unless the contrary is proven, that the use is licensed by the owner of the trade-mark and that the character or quality of the goods or services is under the control of the owner.

[21] It has been held that there are three main methods by which a trade-mark owner can demonstrate the requisite control pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of the license agreement that explicitly provides for the requisite control [see *Empresa Cubana Del Tabaco Trading v Shapiro Cohen*,

2011 FC 102, 91 CPR (4th) 248 at para 84, aff'd 2011 FCA 340]. In the present case, none of these methods has been satisfied.

[22] Thus, I conclude that the affidavit of Ms. Izzo fails to provide evidence establishing that Nu-Gro controlled, either directly or indirectly, the character or quality of the ATAK Hornet and Wasp Killer product that would have been sold by AAT in Canada during the Relevant Period, as required by section 50(1) of the Act.

[23] Furthermore, Ms. Izzo has not explained the relationship between AAT and Advanced Technologies RP Inc., whose name appears on the label filed as Exhibit "B", or the relationship between this entity and Nu-Gro. In addition, there is no public notice on the label that would allow Nu-Gro to benefit from the presumption created by section 50(2) of the Act.

[24] In view of the above, I conclude that the affidavit of Ms. Izzo does not disclose facts enabling me to conclude that the alleged licensed or sublicensed use of the Mark in Canada, during the Relevant Period, would have enured to the benefit of Nu-Gro. Furthermore, Nu-Gro did not provide any evidence establishing its own use of the Mark in Canada, within the meaning of section 4(1) of the Act, in association with "pesticide and insecticide", nor evidence of special circumstances excusing its non-use of the Mark during the Relevant Period.

[25] Accordingly, I find that Nu-Gro has failed to furnish evidence satisfying the requirements of section 45 of the Act. Thus, it is not necessary to consider any other issues arising from the Requesting Party's submissions.

Disposition

[26] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, registration No. TMA794,795 will be expunged.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

No Hearing Held

AGENT(S) OF RECORD

Bennet Jones LLP

FOR THE REGISTERED OWNER

Miller IP Law

FOR THE REQUESTING PARTY