

TRADUCTION/TRANSLATION

IN THE MATTER OF A PROCEEDING under section 45 concerning registration No. TMA386,185 for the trade-mark PROFIL

On January 6, 2004, at the request of Bereskin & Parr, the Registrar forwarded a notice under section 45 of the *Trade-marks Act* R.S.C. 1985, ch. T-13 (the Act) to the Coopérative Fédérée de Québec (the Coopérative), the registered owner of registration No. TMA386,185 for the trade-mark PROFIL (the Mark), registered in association with [TRANSLATION] "animal feed or ingredients used in the manufacture of animal feed". According to the listing on the trade-mark registration page, La Coop Fédérée was registered on December 21, 2005, as the owner of the registration following a change of name on June 1, 2005. This change of name has no bearing on the present case.

According to section 45 of the Act, the registered owner of a trade-mark must establish that the mark has been in use in Canada in association with each of the wares and services specified in the registration at any time during the three-year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of such use since that date. The relevant period in this case extends from January 6, 2001, to January 6, 2004. What qualifies as use of a trade-mark in Canada is defined in section 4 of the Act.

The affidavit of Jean-Luc Laroche, dated April 8, 2004, was furnished in response to the notice under section 45. Each party filed a written argument. No oral hearing was held.

Mr. Laroche, who states that he has held several positions in the Coopérative since 1976, has been a nutritionist in the Livestock Production Sector of the Farm Supply Division for the Coopérative since 1983. Reproduced below are paragraphs 4 and 5 of his affidavit, which refer to most of the items of evidence submitted by the Coopérative:

[TRANSLATION]

4. *The trade-mark **PROFIL** has been used by the Coopérative fédérée de Québec in association with "animal feed" and also in association with "ingredients used in the manufacture of animal feed" since 1989. For more than 10 years and every year since as early as 1992 to the present, millions of kilograms of **PROFIL** have been sold by the Coopérative fédérée de Québec for use by Canadian producers. **PROFIL** is (1) a supplement for dairy cows used by producers, specifically farmers who own dairy cows or (2) an ingredient in that type of animal feed. The product is sold to producers in bulk and in 40-kilogram bags. Normally, producers purchase **PROFIL** from the Coopérative and have it delivered to their farms by an affiliated cooperative, or they procure the product directly from the affiliated cooperative with the option of having it delivered. Every 40-kilogram bag of **PROFIL** has a label that includes the word "**PROFIL**" and that identifies the product as a product of the Coopérative fédérée de Québec. For bulk deliveries, a **PROFIL** label also accompanies the invoice upon delivery. The 40-kilogram bag format accounts for at least 20% of **PROFIL** sales.*
5. *I submit as Exhibit No. 2 in support of my affidavit an envelope containing five representative invoices for sale of the 40-kilogram bags of **PROFIL** to the affiliated cooperatives, dated October 18, 2003, November 27, 2003, January 8, 2004, and February 6, 2004. For the sake of confidentiality, I have removed the sales prices and totals.*

I note that the name of the affiliated cooperative, billing and shipping addresses and dates, as well as information (code, description, quantity ordered, quantity shipped, weight) about the products sold, including the products described under S PROFIL C 40KG, appear on the invoices.

Mr. Laroche also attaches to his affidavit "information documents or brochures" about the wares associated with the Mark. He states that more than 50,000 brochures have been distributed to producers by the Coopérative since 1992 and that the brochure dated 09/2001 "distributed throughout 2003" continued to be distributed at the date of his affidavit. The brochure, entitled *Supplément Profil*TM, which appears to be a fact sheet of some kind, is the only one from the relevant period. It includes instructions for use, a general product description and information on its characteristics and advantages.

The requesting party submits that the registration ought to be expunged on the basis that the evidence consists of bare assertions of use of the Mark, which do not satisfy the requirements of

section 45 of the Act. The requesting party submits that it should be inferred from the absence of labels that the Mark does not appear on the labels, or, at the very least, that the absence of labels creates an ambiguity that must be resolved against the Coopérative. The requesting party also submits that the invoices and brochures do not establish use of the Mark within the meaning of subsection 4(1) of the Act because there is no evidence that they accompanied the merchandise at the time they were sold in Canada.

The Coopérative submits that Mr. Laroche's statements (i) prove that a label bearing the Mark is affixed to the wares sold in bulk and is printed on the bag for sales of 40-kilogram bags, and (ii) prove that an invoice bearing the Mark accompanies the wares when they are delivered to producers, giving notice of association between the wares and the Mark. The Coopérative further submits that the brochures also give notice of association between the Mark and the wares.

It is true that bare assertions of use are insufficient to satisfy the requirements of section 45 [see *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62 (F.C.A.)]. However, a distinction must be drawn between assertions of use (a matter of law) and assertions of fact showing use [see *Central Transport, Inc. v. Mantha & Associés/Associates* (1995), 64 C.P.R. (3d) 354 (F.C.A.)]. We must bear in mind that the test to be met by a registered owner with respect to evidence under section 45 is not a heavy one [see *Cinnabon, Inc. v. Yoo-Hoo of Florida Corp.* (1998), 82 C.P.R. (3d) 513 (F.C.A.)].

I am prepared to accept that the brochure, which falls within the relevant period, gives notice of association between the Mark and the wares. However, I find no evidence that the brochure accompanied the wares upon the transfer of ownership in such a way as to establish use of the Mark within the meaning of subsection 4(1) of the Act. Let me add that while it seems reasonable to conclude that, at the moment of transfer of ownership, the wares were accompanied by a document providing instructions for their use, I cannot conclude that such a document necessarily resembled the brochure.

It seems to me that it would have been relatively simple for the Coopérative to produce a sample of the label affixed to each 40-kilogram bag or of the label used for the wares sold in bulk. Yet

Mr. Laroche provided no justification for his failure to submit labels with his affidavit. The Coopérative seems to have voluntarily decided not to produce even a single label demonstrating use. It also seems to me that Mr. Laroche's statement that each label "includes" ["*comprend*" in the original] the word PROFIL is not unambiguous. Why did he use "includes"? Is it possible that the labels show the word "profil" in combination with other elements, resulting in the use of a trade-mark different from the Mark in question? Is the label affixed to each 40-kilogram bag the same as the label for the bulk wares? It is well established that ambiguities in evidence produced in response to a notice under section 45 must be resolved against the owner [see *Plough (Canada) Ltd., supra*]. In this case, the absence of labels combined with the ambiguity of Mr. Laroche's statements lead me to conclude that the latter's statements are insufficient evidence that the Mark per se appears on the labels in such a way as to establish use within the meaning of subsection 4(1) of the Act.

When I consider the evidence as a whole, I am prepared to infer that the marking S PROFIL C 40KG on the invoices refers to the feed supplement associated with the Mark. Accordingly, I accept that the invoices give notice of association between the wares sold in 40-kilogram bags and the Mark. However, to establish use within the meaning of subsection 4(1) of the Act, the evidence must show that the invoices accompanied the wares at the time of transfer of ownership, since this accompaniment cannot be presumed [see *Riches, McKenzie & Herbert v. Pepper King Ltd.*, 8 C.P.R. (4th) 471 (F.C.T.D.)]. With respect for the opinion of the Coopérative, I find that none of Mr. Laroche's statements allow me to conclude that an invoice accompanied the wares sold in 40-kilogram bags at the time of transfer of ownership, whether we are talking about the transfer of ownership from the Coopérative to an affiliated cooperative or the transfer of ownership from an affiliated cooperative to a producer. I will therefore consider the invoices submitted as evidence.

Only the invoices dated October 18, 2003, and November 27, 2003, fall within the relevant period. In addition to showing a billing date subsequent to the shipping date, each of the relevant invoices shows that the address of the affiliated cooperative facility where the wares were shipped is different from the address of the affiliated cooperative facility where the invoice was sent. Accordingly, I cannot conclude that the wares and invoices were received at the same time

and at the same affiliated cooperative facility, which for the purposes of section 45 would constitute a sufficient association to satisfy the requirements of subsection 4(1) of the Act [see *McCarthy Tétrault v. Acer America Corp.* (2003), 30 C.P.R. (4th) 562 (T.M.O.B.)]. I note that the invoice dated January 8, 2004, demonstrates that the wares were shipped to the same address as the invoice. However, in addition to the fact that the date the invoice was issued is subsequent to the relevant period, the shipping date of December 22, 2003, prevents me from concluding that the wares and the invoice were received at the same time. I also note that the invoice dated February 6, 2004, demonstrates that the wares were sent on the same date and to the same address as the invoice, but the invoice in question does not fall within the relevant period.

As for the wares sold in bulk, I recognize that Mr. Laroche states that a [TRANSLATION] "PROFIL label also accompanies the invoice upon delivery". I have already mentioned the reasons that, in this case, I cannot accept that the assertions regarding the labels constitute proof of the use of the Mark. I do not interpret Mr. Laroche's statement as an assertion that the Mark appears on the invoices of the wares sold in bulk. Moreover, there is no invoice for sale of wares in bulk for me to analyse to determine whether it establishes use of the Mark within the meaning of subsection 4(1). Let me add that I find it somewhat surprising that no invoice for sales in bulk during the relevant time was produced, since the percentage of bulk sales does not strike me as insignificant. Although I realize that it is not always necessary to furnish invoices, in this case, the absence of invoices for the sale of wares in bulk during the relevant period combined with the absence of labels prevents me from finding that there was an association between the Mark and the wares sold in bulk at the time of the transfer of ownership.

Finally, although it remains possible that the Mark was associated with the wares at the time they were sold to producers by the affiliated cooperatives, no evidence was furnished to that effect.

In view of the evidence furnished, I conclude that the Coopérative has failed to establish use of the Mark within the meaning of subsection 4(1) of the Act at any time during the relevant period and, accordingly, that the registration of the Mark ought to be expunged.

Registration No. TMA386,185 will be expunged in accordance with subsection 45(5) of the Act.

DATED AT BOUCHERVILLE, QUEBEC, JUNE 9, 2006.

Céline Tremblay
Member
Trade-marks Opposition Board