



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

Citation: 2015 TMOB 55
Date of Decision: 2015-03-26

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Riches, McKenzie & Herbert LLP against
registration No. TMA737,952 for the trade-mark
HARVEST in the name of Farm Business Consultants
Inc.**

[1] On April 15, 2013, at the request of Riches McKenzie & Herbert LLP (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Farm Business Consultants Inc.

[2] The notice required Farm Business Consultants Inc. (FBC) to furnish evidence showing that it had used its trade-mark HARVEST (the Mark) in Canada, at any time between April 15, 2010 and April 15, 2013, in association with each of the services specified in the registration. If the Mark had not been so used, FBC 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.

[3] The Mark is registered for use in association with the following services:

- (i) Planning services namely estate planning, estate equalization and general business succession planning, retirement planning, tax planning services,
- (ii) Insurance services namely advising, arranging and acquiring on behalf of others for life, health, disability, critical illness and long term care insurance,
- (iii) Investment and financial services namely arranging for an investing on behalf of others in relation to segregated funds, mutual funds, guaranteed investment

certificates and alternative investments available through a life and/or mutual fund portfolio investment.

[4] At the time the notice was issued, the Mark was already the subject of a section 45 proceeding pending before the Registrar, wherein the section 45 notice was issued just two months prior on February 19, 2013. A decision in that proceeding was rendered maintaining the registration on November 19, 2014. When a trade-mark registration is already the subject of a section 45 proceeding pending before the Registrar, generally the Registrar sees good reason to the contrary to issue another notice concurrently [as per the practice notice, *Practice in Section 45 Proceedings*, Section II.1.3]. However, in the present case, the second notice was issued inadvertently, and the parties have not withdrawn from the proceedings. Thus, the parties remain entitled to a decision in the present proceedings.

[5] 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; however, sufficient evidence must be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the registered services during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)]. Furthermore, mere statements of use are insufficient to prove use, and ambiguities in the evidence are to be interpreted against the interests of the registered owner [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[6] The definition of use with respect to services is set out in section 4(2) of the Act, which provides that a trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services. It has been held that section 4(2) contemplates that the services advertised in Canada be performed in Canada [*Porter v Don the Beachcomber* (1966), 48 CPR 280 (Ex Ct)]. However, it has also been held that section 4(2) of the Act may be complied with if it is shown that the trade-mark owner is offering and is prepared to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (RTM)].

[7] In response to the notice regarding the present proceedings, FBC provided the affidavit of Steven Ibbotson, the General Manager of FBC, sworn on April 30, 2013. Only FBC filed written submissions; an oral hearing was not held.

[8] I note that the facts of the present case are essentially identical to the facts in the earlier proceeding. The difference in the relevant period between the proceedings does not affect my conclusion in the present case. For the reasons that follow, I conclude that the registration ought to be maintained.

Evidence

[9] In his affidavit, Mr. Ibbotson explains that FBC has offices throughout Canada and provides a wide range of business services to farmers and small businesses in Canada, primarily through a membership program. That is, for an annual fee, those who are FBC members have unlimited access to all the services FBC provides. He explains, however, that there are certain services provided by FBC to its members through which FBC earns a commission from third parties, such as on the sale of insurance policies and investment products.

[10] Mr. Ibbotson then attests that the Mark has been in continuous use in Canada by FBC since April 2000 in association with all of the registered services. In support, he provides the following:

- A photograph of business signage displaying the Mark outside of one of FBC's office locations in Ontario (Exhibit 1);
- Brochures displaying the Mark distributed to FBC members regarding financial planning services including, among other services, estate planning, retirement planning, tax planning, and will planning services (Exhibits 2-4);
- A guide provided by FBC to every member outlining the services available to FBC members (Exhibit 5);
- Internal FBC training documents which Mr. Ibbotson states have been provided to show the services that FBC's HARVEST related personnel are trained to provide (Exhibits 6 and 7);
- An assortment of FBC representative and client/member communications, all dated within the relevant period. The documents include meeting follow-up correspondence regarding discussion of the services as well as outlines of plans regarding the provision of services, forms related to applying for/acquiring the services, and a letter from an FBC

HARVEST representative to an insurance company regarding an FBC member's spousal RSP. The Mark is clearly displayed on the vast majority of these documents (Exhibits 8 through 14);

- Meeting and telephone note reports documenting discussions held during the relevant period between FBC HARVEST representatives and FBC members concerning the provision of the services. The reports, all of which display the Mark, are signed by both the FBC representative and the FBC member and indicate that a variety of the services were discussed including insurance, health, retirement and estate planning, investment and financial planning (Exhibits 15 through 26);

[11] With respect to the performance of the services during the relevant period, Mr. Ibbotson provides statistics concerning revenues generated as well as the number of members who obtained each general category of the services. He explains that no specific revenue is listed under "planning services"; as was previously indicated, these services are provided as part of the member's annual membership fee. The revenues range from \$119,300 in 2010 for "investment and financial services", to \$2,214,464 in 2011 for "insurance services", with the number of members who obtained each general category of services from 2010 to 2010 ranging from 842 to 2,616 members.

Analysis and Reasons for Decision

[12] FBC submits, and I agree, that ample evidence has been provided to show that FBC offered and performed the registered services in Canada during the relevant period. While some of the exhibits are undated, the vast majority of the exhibits are clearly dated during the relevant period and detail the Services offered by FBC to its members (in particular, Exhibits 8-26). I am satisfied upon review of this evidence that each of the services were offered and available to be performed during the relevant period. Furthermore, the revenue statistics provided by Mr. Ibbotson show that in addition to offering the services, FBC performed the registered services during the relevant time period.

[13] With respect to the display of the Mark in the performance or advertising of FBC's services, the Mark appears in most instances throughout the exhibited evidence as follows :



[14] FBC submits, and I agree, that the use of the word HARVEST in the above noted design constitutes use of the word HARVEST as a trade-mark, in that the public as a matter of first impression would perceive the Mark as being used as a trademark. In this respect, the words “estate planning” would not be perceived as forming part of the Mark *per se*, as these words are descriptive, being related to the type of services being provided [see *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)]. This impression is further reinforced as the word HARVEST stands out, being isolated on its own line and printed in a larger and more striking font for emphasis. Lastly, the embellishment to the letter H in the word HARVEST is at most a minor deviation [regarding embellishment of letters, see *FAAM SpA v Fabbrica Italiana Accumulatori Motocarri Montecchio* (2011), 95 CPR (4th) 184 (TMOB)]. Indeed, in the case of a word mark, use of the trade-mark word or words in any stylized form and in any colour can be considered as use of the registered mark [see *Stikeman, Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB)]. In any event, the Mark is being used in such a way that it has not lost its identity and remains recognizable, the dominant feature of the Mark, being the word HARVEST, having been preserved [per *Canada (Registrar of Trade-marks) v Cie International pour l’informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

Disposition

[15] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, registration No. TMA737,952 will be maintained in compliance with the provisions of section 45 of the Act.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office