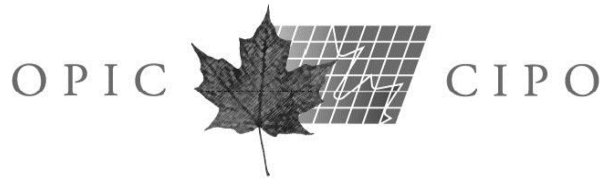

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2012 TMOB 165
Date of Decision: 2012-09-12

IN THE MATTER OF A SECTION 45 PROCEEDING requested by Atlantica Law Group against registration No. TMA442,984 for the trade-mark NATURALLY NUTS in the name of Brent Clutterbuck

[1] At the request of Atlantica Law Group (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) on February 3, 2010 to Brent Clutterbuck (the Registrant), the registered owner of registration No. TMA442,984 for the trade-mark NATURALLY NUTS (the Mark).

[2] The Mark is registered for use in association with “edible nuts, nuts packaged as snack food, nuts packaged or in bulk quantities as ingredients for cooking and baking” (the Wares) and “tree planting, and consulting service pertaining to husbandry of nut bearing trees” (the Services).

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares 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 between February 3, 2007 and February 3, 2010.

[4] The definition of “use” is set out in section 4 of the Act:

> 4(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.
>
> (2) 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.
>
> (3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite 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)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the wares and services specified in the registration during the relevant period.

[6] In response to the Registrar's notice, the Registrant filed his own affidavit, sworn on April 29, 2010. Only the Registrant filed written representations; an oral hearing was not held.

[7] In his affidavit, the Registrant identifies himself as the President of Naturally Nuts Ltd. and he attests that the Mark was used in Canada during the Relevant Period. In support, the Registrant submits the following:

- Exhibit A consists of copies of four photographs, which he identifies as "photographs of chestnut, heartnut and filbert trees just coming into production". He states that "the nut crop to be harvested from these trees and marketing under the name Naturally Nuts follows planting of the trees in 1990 by Naturally Nuts Ltd." However, nothing in this exhibit demonstrates that the Mark was used or displayed in association with these activities.

- Exhibit B consists of an invoice dated November 22, 2009 for services of consultation and moving trees for an individual in St. Thomas, Ontario. I note that the Mark does not appear on the invoice, although the business name, "Naturally Nuts Ltd", and the Registrant's own name, address and GST registration number are handwritten at the top of the invoice.

- Exhibit C consists of a photocopy of an Ontario corporation "Certificate of Status" for "Naturally Nuts Ltd.", issued on April 29, 2010 by the Ministry of Government Services. The Registrant states that Naturally Nuts Ltd. uses its name under license from him.

- Finally, he states that "the production of nuts is carried on in association with the trademark referred to in Exhibit B and the Corporation described in Exhibit C bear[s] the trademark as registered".

[8] I would note that the mere registration of a corporate name does not constitute use of a trade-mark within the meaning of section 4 of the Act [see *Schwalb v Godbout* (1987), 15 CPR (3d) 532 TMOB]. Furthermore, with respect to the Wares, I note that the Registrant provides no evidence of use of the Mark in accordance with section 4 of the Act and provides no evidence of sales of the Wares during the Relevant Period.

[9] With respect to the Services, notwithstanding the registration of the business name shown in Exhibit C, the issue is whether the Mark was used or displayed in the performance or advertisement of the Registrant's Services. In this respect, I note that the Registrant provides no evidence of display of the Mark at all via, for example, signage, business cards, letterhead, advertisements or invoices. Nor does he provide any summary of total sales of his Services in association with the Mark during the Relevant Period.

[10] With respect to the single invoice that the Registrant does provide, the Registrant states that the invoice is in regards to "services of consultation and moving of trees" and, although somewhat illegible, the handwritten description on the invoice itself appears to be "Consult on and Move Trees". Notwithstanding whether such services would constitute the Services as registered, I consider the appearance of "Naturally Nuts Ltd" at the top of the invoice as use of the corporate name only, and not use of the Mark. In contrast to other cases involving the

appearance of a trade-mark on invoices [see, for example, *Road Runner Trailer Mfg Ltd v Road Runner Trailer Co Ltd* (1984), 1 CPR (3d) 443 (FCTD); *Bereskin & Parr v Red Carpet Food Systems Inc* (2007), 64 CPR (4th) 234 (TMOB)], the words "Naturally Nuts" appear in the same size and handwritten lettering as the word "Ltd" and the Registrant's name, address and GST registration number at the top of the invoice. Consequently, the words "Naturally Nuts" used in such a manner do not stand out and do not constitute use of the Mark.

[11] Accordingly, in the absence of further evidence, I cannot conclude that the Registrant has demonstrated use of the Mark in association with the Wares and Services within the meaning of sections 4 and 45 of the Act.

Special Circumstances

[12] As such, I will now consider whether there were any special circumstances justifying non-use. Generally, a determination of whether there are special circumstances that excuse non-use involves consideration of three criteria, as set out in *Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA); the first is the length of time during which the trademark has not been in use, the second is whether the reasons for non-use were beyond the control of the registered owner and the third is whether there exists a serious intention to shortly resume use. The decision in *Scott Paper Ltd v Smart & Biggar* (2008), 65 CPR (4th) 303 (FCA) offered further clarification with respect to the interpretation of the second criterion, with the determination that this aspect of the test *must* be satisfied in order for there to be a finding of special circumstances excusing non-use of a mark. In other words, the other two factors are relevant but, considered by themselves, in isolation, cannot constitute special circumstances. Further, the intent to resume use must be substantiated by the evidence [*Arrowhead Spring Water Ltd v Arrowhead Water Corp* (1993), 47 CPR (3d) 217 (FCTD); *NTD Apparel Inc v Ryan* (2003), 27 CPR (4th) 73 (FCTD)].

[13] In the present case, the Registrant makes no explicit submissions in his affidavit regarding special circumstances. Despite the Mark having been registered in 1995, there is no evidence of use of the Mark in association with the Wares or Services, nor is there any evidence of sales of the Wares by the Registrant at all. Furthermore, although he states in his affidavit that the trees depicted in Exhibit A are "just coming into production", the Registrant provides no

explanation as to the nature of his business to assist me in concluding that such constitutes a reason for non-use. In any event, I do not consider his statement sufficient to conclude that the Registrant has a serious intention to resume use of the Mark.

[14] In this respect, I note the following observation by Thurlow J of the Federal Court of Appeal in *Plough*, *supra,* at 66:

> There is no room for a dog in the manger attitude on the part of registered owners who may wish to hold on to a registration notwithstanding that the trade mark is no longer in use at all or not in use with respect to some of the wares in respect of which the mark is registered.

[15] Accordingly, I cannot conclude that the Registrant has demonstrated special circumstances to excuse non-use of the Mark during the Relevant Period within the meaning of section 45(3) of the Act.

Disposition

[16] In view 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.

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Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office