Section 45 Proceedings
Trade Mark: LAWNSCAPE
Registration No.: TMA 297,382

On September 28, 1995, at the request of the firm Cassels, Brock & Blackwell, the Registrar forwarded a Section 45 Notice to The Davey Tree Expert Company, the registered owner of the above-referenced trade-mark registration. The trade-mark LAWNSCAPE is registered for use in association with the following wares:

> Fertilizers and plant foods.

and the following services:

> Lawn care service, including lawn feeding, weeding and treatment for lawn and garden pests.

In response to the Section 45 Notice, two affidavits of Blaire Sayers were furnished, executed on December 21, 1995 and September 3, 1996, respectively. Both the requesting party and the registrant made written submissions in regard to the present proceedings. An oral hearing was not conducted.

Prior to January 1, 1996, Section 45 of the *Trade-Marks Act* R.S.C. 1985, c. T-13 (hereinafter "the *Act*") required the registered owner to demonstrate use of its trade-mark at any time during the two years preceding the date of the Notice. However, Section 45 as amended by the *World Trade Organization Agreement Implementation Act* now requires the registrant to demonstrate use at any time during the **three year period** preceding the date of the Notice for each of the registered wares and/or services. The Trade-Marks Opposition Board applies Section 45 as amended to all Section 45 cases whether they were commenced before or after January 1, 1996. Consequently, the relevant period in this case is between September 28, 1992 and September 28, 1995. If the registrant cannot show use within this period, it is required to show the date of last use of the mark and provide the reason for the absence of use since such date.

The two affidavits of Blaire Sayers are identical, except that the documents attached to the December 21, 1995 affidavit were not notarized or referred to as Exhibits, whereas the documents attached to

the September 3, 1996 affidavit are properly notarized and are identified as Exhibit A in the affidavit. Accordingly, all references below shall be to the September 3, 1996 Sayers affidavit.

In his affidavit, Blaire Sayers states that he currently holds the position of President of the Davey Tree Expert Co. of Canada, Limited (hereinafter "Davey Tree-Canada"), and that such company is a wholly-owned subsidiary of the registrant. He further states that the registrant maintains control of the mark LAWNSCAPE for the services provided under that mark in Canada.

The affiant attaches, as Exhibit A, a copy of a "marketing" and "advertising and information" brochure. In regard to the brochure, the affiant states the following: that Davey Tree-Canada uses the marketing brochure for the purpose of marketing certain services, including those identified in connection with the mark LAWNSCAPE, and to provide related information on specific lawn problems and potential solutions to clients and potential clients (at paragraph 2); that Davey Tree-Canada has maintained the brochure and made it available to customers continuously since the date of registration of the subject mark, namely, November 23, 1984, through and including the 1995 season (at paragraph 3); that the brochure is typically provided to customers and potential customers before and during the growing season, normally in the early spring through the summer months, and is circulated as a marketing piece to educate customers on the effect and control of specific lawn health problems (at paragraph 4); and, that it has been customary since the initial use of LAWNSCAPE, that customers who ask for the services identified in the brochure in connection with LAWNSCAPE are not billed with specific reference to the mark, but are billed generally (at paragraph 5).

The main arguments of the requesting party may be summarized as follows: (1) the documents attached to the December 21, 1995 affidavit do not constitute proper evidence and are inadmissible; (2) even if the documents are admissible, they do not show use of the registered mark *per se*; rather, a composite trade-mark appears on the documents which effects a separate commercial impression from the registered mark; (3) the affiant admits that the subject mark did not appear on invoices; (4) no use of the trade-mark in association with wares is shown, nor are the wares mentioned in the Sayers affidavit.

The main arguments of the registrant may be summarized as follows: (1) even token use is acceptable to show use of a trade-mark; (2) the subject mark is used for wares and services in advertising by the registrant; (3) the letters "TM" are used on the documents attached as Exhibit A to identify the word "Lawnscape" as a trade-mark; (4) it is impossible to apply a label to "fertilizer and plant foods" as such wares are applied in granular form placed onto the grass and hence, no labels, boxes or containers exchange between the registrant and its customer.

Having reviewed the evidence, I am not satisfied that the registrant has shown use of the trade-mark LAWNSCAPE in association with the registered wares or the registered services.

Regarding the requesting party's concern about the admissibility of the documents attached to the December 21, 1995 affidavit, as noted above the documents were properly identified and notarized in the affidavit sworn on September 3, 1996. Consequently, even if I were to disregard the documents attached to the first affidavit, copies of the same documents appear in an admissible form attached to the second affidavit.

I do, however, have some concerns regarding the admissibility of both of the documents submitted as affidavits. The word "AFFIDAVIT" appears at the top of both documents, followed by the words "I, Blaire Sayers, the undersigned affiant, being under oath or affirmation, say: ..." [emphasis added]. It is therefore not entirely clear whether Mr. Sayers swore or affirmed the documents. However, the jurats on the documents would appear to indicate that Mr. Sayers swore the documents as affidavits, as the jurats state "Subscribed and Sworn to before me this 3rd day of September, 1996." Accordingly, although I have some concerns, in the absence of arguments on this matter by the requesting party, I am not prepared to conclude that such evidence is inadmissible for the purposes of Section 45 proceedings.

Concerning the registered services, s. 4(2) of the *Act* 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. In the present case, the registrant has not provided sufficient facts which would enable me to conclude that the registered services were performed in Canada during the relevant period. The

only evidence in this regard is Mr. Sayers' statement at paragraph 5 of the affidavit that "it has been customary since the initial use of LAWNSCAPE, that customers who ask for the services identified in the brochure in connection with LAWNSCAPE are not billed with specific reference to the mark, but are billed generally." Unfortunately, the affiant does not state whether any of the registered services were in fact requested by customers or performed by the registrant in Canada during the three year period immediately preceding September 28, 1995. Further, the registrant has not provided any invoices or sales figures showing that the services were performed.

I also have doubts about whether the brochure attached as Exhibit A would constitute **advertising of the registered services**. Although the affiant has stated that customers ask for the services identified in the brochure, I am unable to find any references in the brochure to the registered services "lawn care service, including lawn feeding, weeding and treatment for lawn and garden pests"; rather, the brochure would appear to simply provide information on "Dollar Spot" and "Crabgrass". The third paragraph on the second page of the brochure contains the statement "[t]hese practices should be done prior to the first Lawnscape application", but there are no details concerning the Lawnscape application or the offering of any services. Subsection 4(2) of the *Act* requires a registered owner to show advertising of the registered services in association with the trade-mark, and not simply advertising of its trade-mark (see *Registrar of Trade Marks* v. *Colwell et al. carrying on business in partnership as Canadian Masters* (1993), 48 C.P.R. (3d) 105). Accordingly, if the brochure was in fact used by the registrant to advertise the registered services, it was incumbent upon the registrant to provide sufficient facts showing how it was so used.

Concerning wares, there is no evidence of any transfers of the registered wares having occurred during the relevant period, as required pursuant to s. 4(1) of the *Act*. Consequently, I am unable to conclude that any use has been shown of the mark in association with the registered wares.

In view of the fact that the requesting party cannot cross-examine the registrant's affiant and cannot file evidence of its own, it is incumbent on the registrant to clearly evidence use of its mark. This does not require evidentiary overkill. In the present case, if the registrant was using the trade-mark LAWNSCAPE in Canada for the registered wares and/or registered services during the relevant time,

it could have easily evidenced that fact. Since it chose not to, I am unable to conclude that the mark was used in Canada in association with the registered wares and services during the three year period immediately preceding the date of the Section 45 Notice. The registrant has not relied on any special circumstances excusing the absence of use.

Disposition:

In view of the evidence furnished, and in compliance with the provisions of Section 45(5) of the *Act*, Registration No. 297,382 will be expunged from the register.

DATED AT HULL, QUEBEC, THIS 12th DAY OF June, 1997.

C.J. Campbell
Hearing Officer
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