



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

Citation: 2011 TMOB 103
Date of Decision: 2011-06-07

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Stevenson Hood & Thornton Beaubier LLP
against registration No. TMA539,164 for the trade-mark
TASTE OF THE PRAIRIES in the name of Robert
Harcourt Desautels**

[1] At the request of Stevenson Hood & Thornton Beaubier LLP (the Requesting Party), the Registrar of Trade-marks issued a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on March 24, 2009 to Robert Harcourt Desautels (the Registrant), the registered owner of registration No. TMA539,164 for the trade-mark TASTE OF THE PRAIRIES (the Mark).

[2] The Mark is registered for use in association with the following wares:

Food and substances used as ingredients in food, namely, coffee, tea, cocoa, sugar, sugar confectionary, biscuits, cakes, pastries, candies, chocolates, ice cream, sherbet, honey, treacle, yeast, baking powder, salt, mustard, pepper, vinegar, sauces namely pasta, meat and dessert sauces to be used as an accompaniment, seasonings namely natural salts, spices and herbs; natural sweetening substances, namely sugar, food flavourings namely concentrated fruit, vegetable and meat sauces, maple syrup concentrate, powdered and dried fruit, vegetable and meat essences; fresh, frozen, canned and preserved fruits and vegetables, jellies, preserves, pickles, edible nuts, edible seeds, hot dogs, hamburgers, french fries, cereals, syrups namely reductions of sweet and fruit liquids used as an accompaniment for desserts; maple syrups, fresh meats, cheese and butters and egg products namely cakes and breads made from recipes with eggs, salad dressings and mayonnaise made with eggs; pastas, edible oils, vegetable and olive oils, sausages, fish, smoked fish, seafood, Native foods namely prepared foods namely bannock, wild rices and foraged herbs and corn based foods from authentic native recipes, namely cornbreads and corn and meat combinations; flour, legumes, grains namely oats, brans, nuts, raisins and other dried fruits like apples and peaches all mixed together in dried form to be used as breakfast cereal; edible berries, smoked and cured meats; brewed beverages namely

beer and iced tea; wines, minerals namely natural spring water with CO2 added and natural fruit flavours; aerated waters, beverages with chocolate, cocoa or coffee bases namely non-alcoholic milk based drinks with these natural flavours added; non-alcoholic beverages namely carbonated beverages, fruit flavoured drinks and fruit juices; chewing gum, muffins, breads, granola namely oats, brans, nuts, raisins and other dried fruits like apples and peaches all mixed together in dried form to be used as breakfast cereal; clothing namely shirts, sweatshirts, sweatpants, shorts, pants, hats, dresses, skirts, sweaters, vests, socks, jackets; crafts, namely woodwork, jewelry, metal namely small items made by local artists namely jewelry and decorative art like statuettes; carvings namely small items made by local artists namely jewelry and decorative art like statuettes; prints, artwork namely small items made by local artists namely jewelry and decorative art like statuettes; ceramics, candles, dried flowers, potpourri, books, pottery, beads; cleaning products, namely soaps, all purpose cleaners, household cleaning concentrates; health and beauty aids, namely hair care preparations, namely shampoos, conditioner, styling and holding aids namely natural and edible mousse and hair gels; essential oils, skin care products namely soaps, creams, lotions, emulsions, cleansing milk, face and body scrubs, moisturizers, ointments; scented oils, room deodorizers, plants, namely potted plants, herbs and plant seeds (the Wares).

[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 March 24, 2006 and March 24, 2009 (the Relevant Period).

[4] The relevant definition of “Use” with respect to wares is set out in s. 4(1) 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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of a s. 45 proceeding [*Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1979), 45 C.P.R. (2d) 194, aff'd (1980), 53 C.P.R. (2d) 63 (F.C.A.)]. Although the threshold for establishing use in these proceedings is quite low [*Lang, Michener, Lawrence & Shaw v. Woods Canada Ltd.* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.)], and evidentiary overkill is not required [*Union Electric Supply Co. v. Canada (Registrar of Trade Marks)* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)],

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 or services specified in the registration during the relevant period.

[6] In response to the Registrar's notice, the Registrant, Robert Harcourt Desautels, filed an affidavit sworn on June 15, 2009. Only the Requesting Party filed written arguments; an oral hearing was not held.

[7] Mr. Desautels' affidavit is brief and consists of only five paragraphs, as follows:

1. I am providing this Affidavit in accordance with the *Trade-marks Act* (s.45) as amended by the *World Trade Organization Agreement Implementation Act*.
2. I am the registered owner of "Taste of the Prairies", having a Registration Number of TMA539,164 and a Registration Date of January 5, 2001.
3. I have used the trademark in Canada within the last three years.
4. In particular, I have used this trade-mark within the Province of Ontario to describe and refer to specific beverages and food items offered on menus utilized by the numerous restaurants with which I have partial ownership of and, in some cases, to refer to specific ingredients used in the various food items. In some cases, these beverage and/or food items come from and/or are associated with the Prairies and this trade-mark is used by the restaurants as a marketing phrase.
5. I make this Affidavit for no improper purposes.

[8] No exhibits are attached to Mr. Desautels' affidavit, and no further evidence is of record. The Requesting Party submits that the evidence provided by the Registrant is overly vague and devoid of factual content, noting that the Registrant has provided insufficient evidence of use of the Mark in association with each of the Wares specified in the registration and has provided no documentary evidence in support of the use that is claimed. In particular, the Requesting Party notes that while Mr. Desautels' affidavit refers to "beverages and food items", it is unclear to which of the registered Wares, if any, the above statement applies.

[9] I agree with the Requesting Party that Mr. Desautels' affidavit is vague and ambiguous. Generally for wares, use is demonstrated by showing a transfer of wares, in the normal course of trade, with display of the Mark on the wares or notice of association otherwise made at the time of transfer. Although Mr. Desautels does not explicitly state his normal course of trade, it would

appear from his short statement that he operates or partially owns restaurants in the Province of Ontario, and that these restaurants have menus from which customers can order specific food and beverage items. However, it is not clear from the affidavit which of the food and beverage items appear on such menus, nor is it clear the manner in which notice of association of the Mark with the Wares is given to customers. Although there have been cases where the Registrar has found use even though no supporting exhibits were submitted [see, for example, *Frumkin, Feldman and Glazman v. Frank Mazza* (2004) 38 C.P.R. (4th) 560 (T.M.O.B.)], corroborating exhibits in this case would have been helpful in resolving the ambiguities of Mr. Desautels' statements.

[10] In particular, I am not prepared to infer display of the Mark as registered or notice of association of the Mark with the Wares based solely on Mr. Desautels' vague statement in his affidavit. Similarly, it is unclear what Mr. Desautels means when he states that the Mark "is used by the restaurants as a marketing phrase". I further note that the assertion of use in paragraph 3 of the affidavit makes no reference to the Relevant Period.

[11] Finally, I note that Mr. Desautels' affidavit is entirely silent with respect to the various non-food and beverage wares listed in the registration, and no evidence regarding specific circumstances excusing non-use of the Mark were provided with respect to any of the Wares.

[12] Consequently, I am not satisfied that there was use of the Mark with respect to the Wares within the meaning of s. 45 and s. 4 of the Act during the Relevant Period, there being no special circumstances to justify such non-use.

[13] Accordingly, pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be expunged in compliance with the provisions of s. 45 of the Act.

P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office