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

Citation: 2017 TMOB 121

Date of Decision: 2017-09-07

IN THE MATTER OF A SECTION 45 PROCEEDING

Trade-mark Factory International Inc.

Requesting Party

and

Greenleaf, Inc.

Registered Owner

TMA664,360 for GREENLEAF

Registration

[1] This is a decision involving summary expungement proceedings with respect to registration No. TMA664,360 for the trade-mark GREENLEAF (the Mark), owned by Greenleaf, Inc.

[2] The Mark is currently registered in association with the following goods:

Goods:

(1) Potpourri, bag potpourri, scented envelope sachets, fireplace potpourri; air fresheners and aromatic sprays; scented pine cones; candle holders; scented refresher oils for potpourri products.

(2) Stationery, namely, paper and envelopes.

- (3) Placemats.
- (4) Fragranced products for bath and body, namely bath crystals.
- (5) Fragranced products for bath and body, namely, soaps; sponges.
- (6) Fragranced products for bath and body, namely, body lotions, bath splash, bath gels.
- (7) Candles.
- (8) Essential oils; gift box potpourri sets; fragranced products for bath and body, namely, hand lotions, skin conditioners and creams, bath beads, bubble baths, bubble beads, bath oils; decorative wood eggs; decorative jewellery bags; decorative tote bags; decorative pillows; fragrant accents and aesthetic accents, namely, scented pine cones, pomegranates, wheat, berries, cinnamon sticks and cedar, scented pillow sachet.
- (9) Potpourri, scented granular matter, bag potpourri, essential oils, scented refresher oils for potpourri products, scented envelope sachets, gift box potpourri sets, fireplace potpourri; scented candles; fragranced products for bath and body, namely soaps, hand and body lotions, skin conditioners and cremes, bath oils and gels, and bubble baths; air fresheners and aromatic sprays; commercial and consumer display stands and easels; decorative wooden eggs; fragranced inspirational cards; stationery, namely, paper and envelopes; greeting cards; decorative pillows; coordinating placemats, napkin rings; decorative jewellery bags; decorative tote bags; scented pine cones; fragrant and/or aesthetic accents, namely, lotus pods, pomegranates, wheat, berries, cinnamon sticks, and preserved cedar.

[3] For the reasons that follow, I conclude that the registration ought to be maintained in part.

THE PROCEEDINGS

[4] On August 26, 2015, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Greenleaf, Inc. (the Owner). The notice was sent at the request of Trade-mark Factory International Inc.

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between August 26, 2012 and August 26, 2015, in association with each of the goods specified in the registration. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[6] The relevant definition of use is set out in section 4(1) of the Act as follows:

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

[7] 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. Nevertheless, sufficient evidence must still be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the registered goods [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270]. Furthermore, mere statements of use are insufficient to prove use [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[8] In response to the Registrar’s notice, the Owner furnished an affidavit of Christopher Burns, sworn November 19, 2015, together with Exhibits A to C, and an affidavit of Laurie Peet, also sworn November 19, 2015, together with Exhibits A to E.

[9] Only the Owner filed written submissions. An oral hearing was not requested.

THE EVIDENCE

The Burns Affidavit

[10] Mr. Burns is the Director of Business Development for the Owner.

[11] Mr. Burns attests that the Owner manufactures and packages the registered goods in packaging labelled with the Mark in the United States. He refers to the registered goods as the GREENLEAF Goods. He provides as Exhibit B to his affidavit, photographs of “the packaged GREENLEAF Goods as they are sold in Canada, and were sold in Canada during the relevant period.” The goods shown in the photographs include a variety of scented products, namely, reed diffusers, scented envelope sachets, candles, home fragrance oil, room spray, hanging scented sachets, and linen spray. The Mark clearly appears on the packaging of the goods shown in the photographs.

[12] Mr. Burns explains that the GREENLEAF Goods are then shipped to the Owner's exclusive Canadian distributor, Candym Enterprises Ltd. (Candym) in Markham, Ontario, who, in turn, sells the GREENLEAF Goods in Canada to its retail customers, including specialty gift shops. He provides as Exhibit C to his affidavit, representative invoices for the sale of GREENLEAF Goods by the Owner to Candym during the relevant period. He states that the products listed in the invoices and sold to Candym were clearly marked with the Mark as shown in the examples of packaged GREENLEAF Goods in Exhibit B. The goods listed are grouped into the following categories on the invoices: candles, sachets, sprays, aroma décor, pine cones and scented reed diffusers, oil & warmers, auto vent clips, and displays. The displays appear to be display materials for showcasing fragrance products for sale.

The Peet Affidavit

[13] Mr. Peet is the Chief Operating Officer of Candym. He states that Candym, as the Owner's exclusive Canadian distributor, has continuously sold the GREENLEAF Goods marked with the Mark in Canada since 1994 to retail customers, including specialty gift stores.

[14] The remainder and thus the bulk of Mr. Peet's affidavit deals with Candym's marketing and advertising in Canada of the GREENLEAF Goods. In this regard, Mr. Peet explains that Candym advertises and markets the GREENLEAF Goods at trade-shows such as the Toronto Gift Fair every year since 1994. He provides as Exhibit A to his affidavit, a brochure showing photographs of Candym's booth at the 2015 Toronto Gift Fair. He further provides as Exhibit B to his affidavit, representative examples of pamphlets distributed by Candym showing the GREENLEAF Goods.

[15] Mr. Peet attests that Candym has also distributed about 750 catalogues featuring GREENLEAF Goods to its retail customers. He provides as Exhibit C to his affidavit, representative examples of such catalogues, which includes a spring and a fall 2015 catalogue. He attests that Candym began distributing the fall 2015 catalogue on June 5, 2015.

[16] Lastly, Mr. Peet attests that Candym advertises and markets the GREENLEAF Goods to its retail customers, through its website and its Facebook page. He provides as Exhibits D and E respectively, printouts from Candym's website showing GREENLEAF Goods and printouts

from Candym's Facebook page showing an advertisement for the GREENLEAF Goods published on August 10, 2015.

ANALYSIS AND REASONS FOR DECISION

[17] The Owner submits that taken together, the Burns and Peet affidavits establish that the Mark has been used in Canada by the Owner during the relevant period in association with "potpourri, scented envelope sachets, air fresheners and aromatic sprays, scented pine cones, scented refresher oils for potpourri products, candles and commercial and consumer display stands."

[18] I accept that use of the Mark in Canada during the relevant period has been shown by the Owner with respect to the above goods which the Owner contends, with the exception of "potpourri" and "scented refresher oils for potpourri products".

[19] In this regard, the evidence shows packaging of the following goods which clearly display the Mark (Exhibit B to the Burns affidavit): scented envelope sachets, candles, home fragrance oil, room spray, hanging scented sachets, and linen spray. Furthermore, the evidence shows that such goods, as well as "pine cones and displays" were sold by the Owner to Candym during the relevant period, as per the invoices in Exhibit C to the Burns affidavit. Mr. Burns also clearly attests that all of the products listed in the invoices and sold to Candym were clearly marked with the Mark as per the manner shown in the Exhibit B product packaging. The advertising and marketing materials in the Peet affidavit, while not evidence of use of the Mark in and of themselves, show the above-noted goods in a consistent manner to the Burns affidavit, with the Mark clearly marked on the goods. Although no sales to end consumers are ultimately shown, I note that a sale includes a sale to a distributor and it is not necessary to show transactions along the entire chain to the ultimate consumer in order to satisfy the requirements of section 4 of the Act [*LIN Trading Co v CBM Kabushiki Kaisha* (1988), 21 CPR (3d) 417 (FCA)].

[20] With respect to the remaining registered goods however, the Owner has not made any submissions and the Burns and Peet affidavits are silent regarding these goods as well as "potpourri" and "scented refresher oils for potpourri products". Consequently, the Owner has

failed to demonstrate use of the Mark in association with these remaining goods and no special circumstances have been brought forth to excuse the absence of such use. Accordingly, the remaining goods will be deleted from the registration.

DISPOSITION

[21] Having regard to the aforementioned, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the following goods in compliance with the provisions of section 45 of the Act:

- (1) Potpourri, bag potpourri, [...], fireplace potpourri; [...]; candle holders; scented refresher oils for potpourri products.
- (2) Stationery, namely, paper and envelopes.
- (3) Placemats.
- (4) Fragranced products for bath and body, namely bath crystals.
- (5) Fragranced products for bath and body, namely, soaps; sponges.
- (6) Fragranced products for bath and body, namely, body lotions, bath splash, bath gels.
- (7) [...].
- (8) Essential oils; gift box potpourri sets; fragranced products for bath and body, namely, hand lotions, skin conditioners and creams, bath beads, bubble baths, bubble beads, bath oils; decorative wood eggs; decorative jewellery bags; decorative tote bags; decorative pillows; fragrant accents and aesthetic accents, namely, scented pine cones, pomegranates, wheat, berries, cinnamon sticks and cedar, scented pillow sachet.
- (9) Potpourri, scented granular matter, bag potpourri, essential oils, scented refresher oils for potpourri products, [...], gift box potpourri sets, fireplace potpourri; [...]; fragranced products for bath and body, namely soaps, hand and body lotions, skin conditioners and cremes, bath oils and gels, and bubble baths; [...] and easels; decorative wooden eggs; fragranced inspirational cards; stationery, namely, paper and envelopes; greeting cards; decorative pillows; coordinating placemats, napkin rings; decorative jewellery bags; decorative tote bags; [...]; fragrant and/or aesthetic accents, namely, lotus pods, pomegranates, wheat, berries, cinnamon sticks, and preserved cedar.

The amended statement of goods will be as follows:

(1) Scented envelope sachets; air fresheners and aromatic sprays; scented pine cones.

(7) Candles.

(9) Scented envelope sachets; scented candles; air fresheners and aromatic sprays; commercial and consumer display stands; scented pine cones.

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

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE No Hearing Held

AGENTS OF RECORD

SMART & BIGGAR

FOR THE REGISTERED OWNER

TRADE-MARK FACTORY INTERNATIONAL INC.

FOR THE REQUESTING PARTY