



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

Citation: 2011 TMOB 36
Date of Decision: 2011-03-10

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Shapiro Cohen against registration
No. TMA652,795 for the trade-mark NOMI in the name
of JMAX Global Distributors Inc.**

[1] On December 8, 2008, at the request of Shapiro Cohen (the Requesting Party), the Registrar forwarded a notice under s.45 of the *Trade-marks Act*, R.C.S. 1985, c. T-13 (the Act) to JMAX Global Distributors Inc., the registered owner of the trade-mark NOMI, registration No. TMA652,795 (the mark).

[2] The trade-mark NOMI is registered for use in association with the following wares:

(1) Clothing namely, knitwear, t-shirts, blouses, sweaters, pants, active wear.

[3] Section 45 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/or services listed on 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 use since that date. Thus, the relevant period in which use must be shown is between December 8, 2005 and December 8, 2008.

[4] What qualifies as use of a trade-mark in association with wares is defined in s. 4(1) of the Act, which is reproduced below:

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] In response to the notice, the affidavit of Michael Fugman, vice-president of JMAX Global Distributors Inc. (JMAX) was furnished. Written representations were not filed by the requesting party or the registered owner; an oral hearing was not requested.

[6] Mr. Fugman provides that the original registrant of the mark was Gault Distributors (2004) Inc. and Jana Distributors (2004) Inc., a Partnership trading as Jana Group Partnership (“Jana Group Partnership”). On February 21, 2008, a change in title was registered in favour of JMAX.

[7] Section 45 clearly indicates that use is to be shown “with respect to each of the wares or services specified in the registration”. However, proceedings under s. 45 of the *Trade-marks Act* are summary and administrative in nature and concerns over evidentiary overkill weigh against requiring the use of every registered ware and service be shown to prevent the removal of each from the register [see *Saks & Co. v. Canada (Registrar of Trade Marks)* (1989), 24 C.P.R. (3d) 49 (F.C.T.D.), *Ridout & Maybee LLP v. Omega SA*, 2005 FCA 306, 39 C.P.R. (4th) 261 and *Gowling Lafleur Henderson LLP v. Neutrogena Corporation* (2009), 74 C.P.R. (4th) 153 (TMOB)]. This concept is appropriately applied to cases where there is a long list of wares and where the statement of wares is organized such that demonstration of use for a number of goods within a category can be sufficient to show use for the entire category. In *Performance Apparel Corp. v. Uvex Toko Canada Ltd.*, 2004 FC 448, 31 C.P.R. (4th) 270, Justice Russell speaks of the balance between evidentiary overkill and the obligation to show use such that the Registrar is able to form an opinion on the “use” within the context of s. 45. In these circumstances, an affidavit must contain a clear and comprehensive statement of use in association with each of the wares for the relevant period as well as sufficient facts to permit the Registrar to conclude that the trade mark is in use in association with each ware.

[8] Evidence accompanying Mr. Fugman’s affidavit in the form of purchase orders and invoices are in the name of “Jana & Company, A Division of JMAX Global Distributors Inc.” (Jana & Company); Mr. Fugman asserts that Jana & Company is an unincorporated division of

JMAX. I note that some of these sales documents pre-date the change in title referred to above in paragraph 6, but that the name of Jana & Company or JMAX appears on those documents rather than the name of the predecessor-in-title. While I expect there is a reasonable explanation for this, it has not been provided. Nevertheless, as discussed below, there are sales documents that post-date the change in title and that refer to the same wares; as a result, excluding the older documents will have no effect on the outcome of this decision.

[9] Mr. Fugman states:

JMAX, though its division Jana, in the normal course of business, sells wares in the category of clothing, namely knitwear, t-shirts, blouses, sweaters, pants and active wear, labelled with the trade-mark “NOMI”, and has sold clothing bearing labels with the trade-mark NOMI in Canada in the three years prior to December 8, 2008, the date of notice for these section 45 proceedings.

[10] According to Mr. Fugman the normal course of trade for JMAX is the importation of clothing into Canada from foreign manufacturers and the wholesale distribution of clothing to retail outlets in Canada. Mr. Fugman states that this clothing bears labels and hangtags which display the mark; samples of these labels and hangtags accompany the affidavit, and the mark can be seen clearly on these samples.

[11] A purchase order sent from Jana & Company to a foreign manufacturer and dated March 12, 2008 includes instructions to affix labels and hangtags bearing the mark to the ordered clothing. This purchase order relates to long-sleeved turtleneck pullovers made from 100% cotton. A corresponding invoice dated August 6, 2008 relates to the shipment of these garments to a retail outlet in Canada.

[12] A similar pairing of a purchase order and invoice is provided where the documents are dated August 14, 2008 and January 28, 2009, respectively, and relate to the purchase and sale of lace up shirts made from 95% cotton and 5% spandex. Again, the purchase order includes instructions to affix labels and hangtags bearing the mark to the wares. I note that the purchase order is dated within the relevant period, but that the invoice is not. I am nonetheless prepared to consider these two documents together as evidence of use since it is apparent that the overall transaction was commenced during the relevant period (e.g. the wares were purchased for resale within the relevant period) and subsequently completed [see *Ogilvy Renault LLP v. Trade-Link*

Group (2009), 83 C.P.R. (4th) 475 (T.M.O.B.) and *ConAgra Foods, Inc. v. Fetherstonhaugh & Co.* (2002), 23 C.P.R. (4th) 49 (F.C.T.D.)). In making this determination, I have taken into consideration the fact that this transaction clearly conforms to the evidence provided of the normal course of trade and that there is nothing that indicates that this is a token transaction and/or one initiated by the issuance of the s.45 notice.

[13] Mr. Fugman states that JMAX considers the turtleneck pullover as part of its “knitwear, sweaters and active wear lines” and that the lace-up shirt forms part of its “knitwear, t-shirts and active wear lines.” As such, I am prepared to accept that the use demonstrated may stand for use in association with “Clothing namely, knitwear, t-shirts, sweaters, active wear.”

[14] Although Mr. Fugman’s assertion of use (reproduced above) in which he repeats the statement of wares as registered, includes “blouses” and “pants, I am not prepared to conclude that use of the mark in association with these wares has been shown or could be inferred from the evidence provided; there is no further mention of “blouses” or “pants” in the affidavit, nor any indication that the evidence provided was intended to be representative of these wares. Special circumstances have not been advanced to excuse this non-use.

DISPOSITION

[15] Having regard to the evidence as a whole, I am satisfied that there was use of the mark pursuant to s. 45 and 4(1) of the Act to maintain the registration in association with the wares: “*clothing namely, knitwear, t-shirts, sweaters, active wear.*” Pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be amended to delete the following wares: “*blouses*” and “*pants*” in compliance with the provisions of s. 45 of the Act.

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