

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

**Citation: 2018 TMOB 55**

**Date of Decision: 2018-05-31**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Citadelle, Coopérative de Producteurs  
de Sirop d'Érable / Citadelle, Maple  
Syrup Producers' Cooperative**

**Requesting Party**

**and**

**RAVINTORAISIO OY**

**Registered Owner**

**TMA545,839 for NORDIC & DESIGN**

**Registration**

[1] At the request of Citadelle, Coopérative de Producteurs de Sirop d'Érable / Citadelle, Maple Syrup Producers' Cooperative (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 October 14, 2015 to Raisio Yhtymä Oyj, the registered owner at that time of registration No. TMA545,839 for the trade-mark NORDIC & DESIGN, reproduced below (the Mark):



[2] The Mark consists of the word NORDIC in white capital letters with white clouds behind the N and a yellow, sun-like dot over the I, all above a straight band containing the words “Grown in the pure Finnish arctic environment”. The registration claims, as a feature of the trade-mark, the colours blue, green, yellow and orange running from left to right in the background and the colours black and red running from left to right in the band at the base.

[3] The Mark is registered for use in association with the following goods (the Goods):

(1) Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk, cream, non-alcoholic flavoured milk beverages, condensed milk, milk powder, yoghurts, buttercream, cheese; edible oils and fats.

(2) Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, namely cereal-based snack foods, ready-to-eat cereal derived food bars, breakfast cereals, corn flakes, maize flakes, oat flakes, crispies; pastry, ices; honey, treacle, yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

(3) Agricultural products, namely flower seeds; agricultural grains for planting; live animals; fresh fruits and vegetables; seeds, natural plants and flowers, malt.

(4) Fruit syrups; non-alcoholic drinks made of berries and fruits; mineral waters (beverages) and aerated waters.

[4] On March 8, 2016, the Registrar updated the registration to reflect that the registered owner’s name had changed from Raisio Yhtymä Oyj to Raisio Oyj on April 25, 2005.

[5] On March 29, 2016, the registration was further updated when the Registrar recorded a February 26, 2016 assignment of the Mark from Raisio Oyj to Ravintoraisio Oy (the Owner), the current registered owner.

[6] 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 goods 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 the trade-mark was last used and the reason for the absence of such use since that date. In this case, the relevant period for showing use is October 14, 2012 to October 14, 2015.

[7] The relevant definition of “use” in association with goods 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.

[8] In response to the Registrar’s notice, the Owner furnished a document titled “SECTION 45 JOINT AFFIDAVIT” (the Affidavit Document), which indicates that it was sworn in Raisio, Finland, on September 5, 2016, by Sari Koivulehto-Mäkitalo and Riikka Roman (the Affiants). The issue of whether this document constitutes a properly sworn affidavit is addressed below.

[9] Only the Requesting Party filed written representations, but both parties were represented at an oral hearing.

#### THE OWNER’S EVIDENCE

[10] Sari Koivulehto-Mäkitalo and Riikka Roman identify themselves in the Affidavit Document as the Owner’s Vice-President of Legal Affairs and Senior Legal Counsel, respectively.

[11] They provide, as Exhibits A and B to the Affidavit Document, documentation of Raisio Yhtymä Oy’s 2005 name change (which they refer to as a change in ownership) and the February 2016 assignment of the Mark to the Owner.

[12] The Affiants state that the Mark has been “successful around the world for 20 years in association with the Goods, namely its wide range of grain-based products.” They specify that the Goods consist of a portfolio of nearly 40 products, including porridge flakes and other grain-based products, such as instant porridges, crispbread and snack biscuits. They state that the Mark is prominently displayed on the Goods’ packaging.

[13] In support, attached to the Affidavit Document as Exhibit C is a page depicting eight boxes, described by the Affiants as a sample of the packaging for Goods bearing “the dominant

portion of the [Mark]”. Indeed, the boxes display a variation of the Mark featuring the word NORDIC in slightly different white lettering; a larger, red dot above the I; a plain, navy blue background; and a wave-like yellow band (without wording) at the base. This trade-mark, as it appears on the depicted boxes, is reproduced below:



[14] Most of the text on the depicted boxes is illegible and some appears to be in Cyrillic. However, text that appears to read “PORRIDGE OATS” is visible on one of the boxes and text that appears to read “CEREAL FLAKES” is visible on another. I also note that the images on seven of the boxes display what appears to be a bowl of porridge or breakfast cereal; the eighth box displays what appears to be a type of cereal bar.

[15] The Affiants attest to millions of dollars in net sales internationally in each of 2014 and 2015 for brands owned by the Owner’s predecessor-in-title, and confirm that such sales included Goods bearing the Mark. However, no breakdown of the sales figures by brand, product, or country is provided.


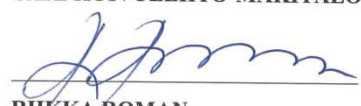
[16] The Affiants also state that, between 2012 and 2015, the Owner’s predecessors-in-title spent “a significant amount” on marketing expenditures in association with the “advertising development” of Goods bearing the Mark. More particularly, they state that, during the relevant period, the NORDIC trade-mark was “advertised and marketed” in investor, marketing and promotional materials, and on the *www.raisio.com/en/nordic* website. They specify that the information on this website is accessible to distributors, wholesale outlets, retail outlets and food service providers in Canada.

[17] Finally, the Affiants state that, “[d]ue to the change of ownership together with the recent Assignment of the Registration to [the Owner]”, the registered goods will be “launched” in 2016 through the Owner’s “affiliated webstore domain” at *www.oatletstore.com*, accessible to

Canadian consumers. The Affiants confirm that the Owner intends to use the Mark itself and/or through a licensee in Canada and has no intention of abandoning the Mark.

[18] On the last page of the Affidavit Document, the Affiants' signatures appear beside the notation "SWORN at Raisio, Finland this 5<sup>th</sup> day of September, 2016". Below that, the signature and stamp of a notary public in Helsinki appears, with a certification that the Affiants are entitled to sign for the Owner, date-stamped "07.09.2016". This portion of the Affidavit Document is reproduced below:

SWORN at Raisio, Finland  
this 5<sup>th</sup> day of September, 2016

)  
)   
) **SARI KOIVULEHTO-MAKITALO**  
)  
)   
) **RIIKKA ROMAN**

NOTARY:  
Seal:

This is to certify that  
Sari Koivulehto-Makitalo and Riiikka Roman  
are according to the trade register entitled  
to sign for Ravintola OX

Helsinki  
Ex officio: 07.09.2016

  
TONI RUOTSALAINEN  
Notary Public

UUDENMAAN MAISTRAATTI  
LOCAL REGISTER OFFICE OF UUSIMAA  
ALBERTINKATU 25  
00180 HELSINKI FINLAND  
TEL. +358 2 955 36222



[19] Although none of the three exhibits attached to the Affidavit Document is endorsed by the notary public, I note that each is clearly identified and explained in the body of the Affidavit Document.

## ADMISSIBILITY OF THE AFFIDAVIT DOCUMENT

[20] In its written representations, the Requesting Party objected to the Affidavit Document on the basis that it is not, on its face, a true affidavit, there being no indication that it was sworn before the notary whose signature and stamp appear on the last page. In this respect, the Requesting Party pointed to (i) the absence of a jurat attesting to the notary's receipt of the Affiants' oath and (ii) the discrepancy between the notary's date stamp and the date that appears by the Affiants' signatures.

[21] At the hearing, the Owner responded by submitting that the notary's signature applies both to the certification of signing authority and to the notation confirming when and where the Affidavit Document was sworn.

[22] I would first note that the Act and the *Trade-marks Regulations* are silent as to the form of affidavits and statutory declarations to be filed before the Registrar. Accordingly, the Registrar generally accepts affidavits sworn in foreign jurisdictions as long as that jurisdiction's requirements are met [see *Dubuc v Montana* (1991), 38 CPR (3d) 88 (TMOB)]. Furthermore, especially in the context of section 45 proceedings—which are intended to be summary and expeditious—the Registrar has frequently considered certain deficiencies in affidavits and statutory declarations to be mere technicalities [see, for example, *Brouillette, Kosie v Luxo Laboratories Ltd* (1997), 80 CPR (3d) 312 (TMOB); *88766 Canada Inc v Tootsie Roll Industries Inc* (2006), 56 CPR (4th) 76 (TMOB); and *Borden & Elliot v Raphaël Inc* (2001), 16 CPR (4th) 96 (TMOB)].

[23] In this case, however, I agree with the Requesting Party and find that the deficiencies in the Affidavit Document are beyond mere technicalities.

[24] Although section 45 proceedings are simple and administrative in nature, the evidence must nevertheless be filed in the form of an affidavit or statutory declaration. In the present case, although the Affidavit Document is titled an affidavit and purports to be sworn, it does not, on its face, appear to have been sworn before an individual authorized to administer oaths.

[25] The fact that a document has been stamped and signed by a notary public does not, in and of itself, demonstrate that the statements contained in the document were sworn before that

notary [see *88766 Canada Inc v 167407 Canada Inc*, 2010 TMOB 167, 89 CPR (4th) 293]. In the present case, there is no indication—either in the notary’s certification or in the notation “SWORN at Raisio, Finland...” —that the Affiants swore the document in the notary’s presence.

[26] Indeed, the fact that the notary’s stamp is dated two days after the date of swearing and indicates a different municipality—Helsinki instead of Raisio—indicates that the document was *not* sworn in front of the notary. This discrepancy is more than a mere irregularity, as it goes to the very basis of the document being an affidavit [for similar conclusions, see *GD Express Worldwide NV v Skyward Aviation Ltd* (2000), 7 CPR (4th) 348 (TMOB); and *Barrette Legal Inc v Dallevigne SPA*, 2015 TMOB 12, 2015 CarswellNat 965].

[27] Moreover, even if it is accepted practice in Finland for a single notarial signature to cover both the administration of an oath and a subsequent verification of signing authority, the absence of an explicit confirmation for administration of the oath makes it unclear whether both steps or only the latter one was performed. If there are any indicators in the notarial certification that resolve this question, the Owner did not reference them.

[28] Although the Requesting Party raised the foregoing deficiencies in its written representations, the Owner chose not to correct the alleged deficiencies, nor did it provide any evidence or authority to confirm that the document meets the standards for sworn statements under Finnish law.

[29] In any event, even if I were to accept the Affidavit Document as a validly sworn document, for the reasons below, I find that it is insufficient to demonstrate use of the Mark within the meaning of sections 4 and 45 of the Act.

#### ANALYSIS WITH RESPECT TO USE

[30] 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 a section 45 proceeding is 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 goods specified in the registration during the relevant period.

[31] In the present case, although the Affiants attest to millions of dollars in net sales internationally during the relevant period, they do not assert that any Goods were sold or otherwise transferred *in Canada*. Nor do they provide any invoices or other documentary evidence, or even any factual particulars, from which such transfers might be inferred.

[32] In this respect, even if I accept the trade-mark displayed on the exhibited packaging as a minor variation of the Mark as registered, there is no indication that such packaging is representative of packaging for Goods sold or distributed in Canada, during the relevant period or otherwise. Moreover, it is not evident which of the Goods, if any, are sold in such packaging. For example, although the Goods include “oat flakes”, “breakfast cereals”, “cereal-based snack foods” and “ready-to-eat cereal derived food bars”, the images at Exhibit C do not clearly indicate which of these specific Goods, if any, are contained in the depicted boxes; nor do the Affiants provide any clarification in this regard.

[33] In any event, absent evidence of transfers of such products in the normal course of trade in Canada during the relevant period, any display of the Mark on the packaging depicted at Exhibit C does not amount to use of the Mark within the meaning of sections 4 and 45 of the Act.

[34] With respect to the Affiants’ statement that the NORDIC trade-mark was “advertised and marketed” during the relevant period on a website accessible in Canada, I note that merely advertising or offering goods for sale is insufficient; some evidence of transfers in the normal course of trade in Canada is necessary [see *Michaels & Associates v WL Smith & Associates Ltd* (2006), 51 CPR (4th) 303 (TMOB); and *Riches, McKenzie & Herbert LLP v Cleaner’s Supply Inc*, 2012 TMOB 211, 2012 CarswellNat 5229].

[35] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered goods within the meaning of sections 4 and 45 of the Act.



## ANALYSIS WITH RESPECT TO SPECIAL CIRCUMSTANCES

[36] In the absence of evidence of use of the Mark, the issue is whether, pursuant to section 45(3) of the Act, special circumstances existed to excuse such non-use.

[37] Special circumstances means circumstances or reasons that are unusual, uncommon, or exceptional [*John Labatt Ltd v Cotton Club Bottling Co* (1976), 25 CPR (2d) 115 (FCTD)]. Generally, a determination of whether such circumstances excuse non-use involves a consideration of three criteria: (1) the length of time during which the trade-mark has not been in use; (2) whether the reasons for non-use were beyond the control of the registered owner; and (3) whether there exists a serious intention to shortly resume use [per *Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA)]. Although all three criteria are relevant, satisfying the second criterion is essential [per *Scott Paper Ltd v Smart & Biggar*, 2008 FCA 129, 65 CPR (4th) 303].

[38] At the hearing, the Owner submitted that the scarcity of references to Canada in the Affidavit Document is due to the evidence of use during the relevant period being in the hands of its predecessor-in-title. However, the Owner pointed to its recent acquisition of the Mark, its intention to use and not abandon the Mark, the Mark's international presence, and "resumption" of use in Canada through *www.oatletstore.com* as evidence of special circumstances that excuse non-use of the Mark in Canada during the relevant period.

[39] In this respect, the Owner sought to draw an analogy between the present case and that in *Swabey, Mitchell, Houle, Marcoux & Sher v Dominion Textile Inc* (1988), 21 CPR (3d) 204 (TMOB), where it was held that a distinction should be made between "non-use due to market conditions generally" and "a temporary stoppage of use" during which a product is changed, improved or redeveloped owing to a decline in the market for that product [at paragraph 8]. In maintaining the registration, the Registrar commented that it is not the intention of the Act to "monitor use of trade marks so closely that a stoppage in use for a short period ought to be sanctioned by expungement" [at paragraph 10].

[40] However, in *Dominion Textile*, at the date of the section 45 notice, use of the trade-mark at issue had only been "temporarily stopped" for nine months. In the present case, the Affiants do

not indicate when the Mark was last in use in Canada; indeed, there is no evidence of the Mark ever having been used in Canada. Accordingly, the period of non-use in the present case cannot be considered a “temporary stoppage”.

[41] With respect to the Owner’s actions after acquiring the Mark, I note that special circumstances alleged to excuse non-use must apply to the relevant period [per *Oyen Wiggs Green & Mutala LLP v Rath* , 2010 TMOB 34, 82 CPR (4th) 77; see also *PM-DSC Toronto Inc v PM-International AG*, 2013 TMOB 15, 110 CPR (4th) 378]. In the present case, the Owner acquired the Mark after the section 45 notice had already issued. Thus the Owner’s actions with respect to the Mark following its acquisition do not address the circumstances that existed during the relevant period.

[42] Furthermore, even a realized intention to resume use of a trade-mark shortly after the end of the relevant period is, in and of itself, insufficient to excuse a period of non-use. As stated by the Federal Court of Appeal, “plans for future use do not explain the period of non-use” [*Scott Paper, supra* at paragraph 28]. In the present case, the Affiants merely speak to the Owner’s acquisition of and future plans for the Mark. The Affiants provide no indication that the predecessor’s reasons for not using the Mark in Canada during the relevant period involved circumstances that were unusual, uncommon or exceptional, or beyond its control.

[43] Even if I were to accept that it was difficult for the Owner to obtain information on prior use of the Mark from its predecessor, such difficulties do not constitute special circumstances excusing non-use of a trade-mark per the criteria set out in *Harris Knitting Mills, supra*.

[44] Accordingly, I am not satisfied that the Owner has demonstrated special circumstances excusing non-use of the Mark during the relevant period within the meaning of section 45(3) of the Act.

[45] In closing, I note that, at the hearing, the Owner also questioned the Requesting Party’s motives in initiating the present proceeding. In this regard, it has been established that the purpose of section 45 is to provide a simple and expeditious procedure for removing “deadwood” from the register and that section 45 proceedings are not intended to resolve disputes or to determine rights as between parties with competing commercial interests [see *Meredith &*

*Finlayson v Canada (Registrar of Trade Marks)* (1991), 40 CPR (3d) 409 (FCA)]. However, the only matter to be resolved in a section 45 proceeding is whether the furnished evidence regarding use or the absence of use is sufficient to maintain the registration. Accordingly, the Requesting Party's motivation for requesting the notice is irrelevant to the proceeding.

DISPOSITION

[46] In view of all the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration will be expunged.

---

Oksana Osadchuk  
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** 2018-02-05

**APPEARANCES**

Alpesh Patel

FOR THE REGISTERED OWNER

Gabriel St-Laurent

FOR THE REQUESTING PARTY

**AGENTS OF RECORD**

Keri A.F. Johnston (Johnston Law)

FOR THE REGISTERED OWNER

ROBIC

FOR THE REQUESTING PARTY