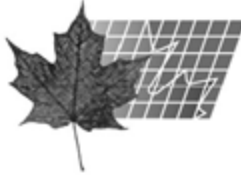


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C I P O

**LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS**

Citation: 2022 TMOB 038

Date of Decision: 2022-03-07

IN THE MATTER OF A SECTION 45 PROCEEDING

Clark Wilson LLP

Requesting Party

and

Greenland Sales Limited

Registered Owner

TMA670,173 for Trailside

Registration

[1] At the request of Clark Wilson LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on October 3, 2018, to Greenland Sales Limited (the Owner), the registered owner of registration No. TMA670,173 for the trademark Trailside (the Mark).

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

(1) Technical digital wrist watches

(2) Sleeping bags, sleeping bag accessories namely camping pillows, sleeping bag accessories namely camping liners, sleeping bag accessories namely compression sacks, sleeping bag accessories namely girth expanders, blankets from aluminized polyethylene.

(3) Rain jackets/coats/pants/suits/vests/caps/ponchos in PVC material, rain jackets/coats/pants/suits/vests/caps/ponchos in nylon material, jackets/coats/pants/suits/vests/caps/ponchos in nylon material, down-filled nylon jackets/pants/vests, synthetic insulated jackets/vests/pants/baby suits, tshirts, shirts, undershirts, shorts, pants, underpants in cotton/nylon/polyester

- (4) Gaiters, shoes, boots, slippers
- (5) Waist packs, fanny packs, money pouches
- (6) Tents, tent accessories namely pegs made of steel, tent accessories namely pegs made of aluminum, tent accessories namely guy line slide adjusters made of aluminum, tent accessories namely aluminum tent poles, tent accessories namely fiberglass tent poles, tent accessories namely adjustable steel poles, tent accessories namely utility nylon cords, tent accessories namely seam sealers, bivy sacks, polyethylene tarpaulins, polyester tarpaulins.
- (7) Daypacks, camping backpacks, mountain backpacks, canoe backpacks, hydration backpacks, carrying bags, briefcases, travel bags, wheeled luggage, trolley luggage, duffel bags
- (8) Toiletry bags, toiletry pouches
- (9) Camping stools, camping chairs, camping cots
- (10) Headlights, flashlights
- (11) Hiking poles in aluminum tubing
- (12) Air mattresses, self-inflatable air mattresses, polyethylene foam pads
- (13) Gas stoves, oil stoves.
- (14) Tealight lanterns in stainless steel/aluminum/brass, candle lanterns in stainless steel/aluminum/brass, lantern glass chimneys, candles
- (15) Stainless steel camping cookware, bottles, mugs, cutlery and tableware, Polycarbonate camping cookware, bottles, mugs, cutlery and tableware, Enameled metal camping cookware and tableware, Melamine metal material camping cookware and tableware

[3] The notice required the Owner to show whether the Mark was 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 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 October 3, 2015 to October 3, 2018.

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

4(1) A trademark 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.

[5] 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 these proceedings 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 trademark in association with each of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[6] In response to the Registrar's notice, the Owner furnished two affidavits of Rex Lu, sworn in Markham, Ontario on April 25, 2019 and May 2, 2019, respectively.

[7] Both parties submitted written representations and were represented at an oral hearing.

THE EVIDENCE

First Lu Affidavit

[8] In his first affidavit, Mr. Lu identifies himself as Controller of the Owner. He states that the Owner "sells products for outdoor activities including mountaineering and camping" and that the Mark "has been used in Canada for many years and continues to be used today" [para 4].

[9] As for the Owner's normal course of trade, Mr. Lu explains that "Products sold in association with [the Mark] are manufactured by third party manufacturers for [the Owner] in accordance with specific standards of character and quality that [the Owner] provides. The products are then delivered to [the Owner] for distribution and sale by [the Owner] to online and bricks-and-mortar retailers of camping and outdoor equipment, apparel and accessories, who in turn sell such goods, which originate from [the Owner], to individual Canadian customers" [para 5].

[10] In support of the foregoing, the following exhibits are attached to his affidavit:

- Exhibit A consists of over 100 invoices sent by the Owner to different companies in Canada for payments related to a variety of camping and outdoor equipment, apparel and accessories, furniture, and other goods. Mr. Lu confirms that these are a “representative sample of invoices issued by the Owner during [the relevant period], pertaining to sales of goods in Canada, including goods bearing the [Mark]” [para 6]. I note that the Mark does not appear on the invoices; however, some of the listed items are highlighted and appear to correlate with Trailside-branded products identified in Exhibits B and C.
- Exhibit B is a table that Mr. Lu identifies as a “summary of sales of Trailside branded products during [the relevant period] generated from sales data” [para 7]. The table lists 35 products, and Mr. Lu states that each item includes “annual quantity and dollar amount sold” during the relevant period. As discussed below, I note that those columns are blank for some of the products listed. For the products containing sales information, I note that the identifying product codes in the Exhibit B table correlate to the ones listed on the Exhibit A invoices and appearing in the Exhibit C Product Guides.
- Exhibit C consists of copies of “Product Guides” for the years 2016, 2017, 2018 and 2019, which Mr. Lu states “were distributed to Canadian customers and prospective customers” [para 8]. The Product Guides advertise different types of camping and outdoor equipment, apparel and accessories in association with various trademarks, including the Mark. I note that the Mark appears throughout the Product Guides, including on some of the depicted products.

Second Lu Affidavit

[11] In his second affidavit, Mr. Lu asserts that all of the Trailside-branded products referred to in his first affidavit and supporting Exhibit B table “had the [Mark] either marked on the products themselves, or marked on the packages in which the products were distributed and sold by the [Owner], during the time period” [para 2].

[12] Mr. Lu adds that “For the sleeping bags, the appearance of the product in the Product Guides may be difficult to see but I confirm that the [Mark] appears on the referenced sleeping

bags” [para 3]. He further adds that “the stools, chairs and foam pads have the [Mark] on the products, which are not clearly shown in the Product Guides” [para 3].

[13] In support, Mr. Lu provides further “representative photographs” of sleeping bags, stools, chairs and foam pads [Exhibit 1]. I note that the Mark is clearly visible on each of the depicted products.

ANALYSIS AND REASONS FOR DECISION

[14] In its representations, the Requesting Party first questions whether any evidenced use of the Mark enures to the benefit of the Owner. Otherwise, it questions whether the evidence is sufficient to demonstrate use of the Mark in association with *each* of the registered goods.

Use by the Owner

[15] The Requesting Party first alleges that the evidence is ambiguous as to who used the Mark, submitting that the Lu Affidavits fail to clearly demonstrate that the Owner exerted control over the third-party manufacturers. Alternatively, the Requesting Party contends that the Owner merely acted as a distributor of the goods and that any evidenced use of the Mark does not enure to its benefit.

[16] In response, the Owner submits that no other entity is or was using the Mark aside from it. In this regard, it notes that the Act does not require the owner of a trademark to itself be a manufacturer [citing *Marks & Clerk v Tritap Food Broker, a division of 676166 Ontario Limited*, 2017 TMOB 35 at para 50]. In the Owner’s view, the present case does not involve any license issue nor is it a situation where the third-party manufacturers acted as licensees.

[17] In view of Mr. Lu’s sworn statement regarding the Owner’s normal course of trade, I agree with the Owner’s submissions and accept that the Owner is the source of the relevant goods for purposes of the Act. Indeed, Mr. Lu clearly states that the goods are manufactured by third-party manufacturers on behalf of the Owner, to which the invoices clearly show the Owner is the source of the goods in question. Accordingly, section 50(1) of the Act is not applicable in this case.

[18] In view of the foregoing, I am satisfied that any evidenced use is that of the Owner.

Use with respect to each of the registered goods

[19] Aside from the alleged licensing issue, at paragraph 57 of its written representations and at the hearing, the Requesting Party essentially conceded that use of the Mark has been demonstrated with respect to some of the registered goods. Otherwise, it submits that the Owner's evidence does not show use of the Mark in association with each of the registered goods during the relevant period.

[20] As confirmed by the Owner at the hearing, the Exhibit A invoices appear to be redundant to the evidence of transfers indicated in the Exhibit B table. As noted above, that table lists 35 products, each purporting to correlate to a registered good. With the exception of the registered goods "carrying bags" and "toiletry pouches" discussed below, the Requesting Party does not take issue and I accept such correlations at face value. Of these listings, ten include sales information from the relevant period and I am also able to identify such products in the exhibited Product Guides or photographs as displaying the Mark.

[21] By way of example, the second product listed in the table, "Thermal Blanket" is correlated to the registered good "Blanket from Aluminized Polyethylene". According to the information in the table, 668 blankets were sold in Canada during the relevant period. Furthermore, the Product Guides show that the Mark appeared on the packaging of such blankets [e.g., page 63 of the 2016 Product Guide].

[22] Similar evidence is provided for the following registered goods identified in the sales summary table, and I note that the Requesting Party appears to concede that use was shown in respect of such goods [Requesting Party written representations at para 57]: "sleeping bag accessories namely camping pillows" and "sleeping bags" from goods (2); "tents" from goods (6); "canoe backpacks" from goods (7); "camping chairs", "camping cots" and "camping stools" from goods (9); and "polyethylene foam pads" and "self-inflatable air mattresses" from goods (12).

[23] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with these registered goods within the meaning of sections 4 and 45 of the Act.

[24] For nine of the products listed in the table, although sales data from the relevant period is provided, the evidence does not clearly demonstrate that the Mark appeared on such products or their packaging, or was otherwise associated in any other manner. In this regard, neither the exhibited photographs nor the Product Guides show that the Mark was displayed on such goods or their packaging. These products are correlated with the following registered goods: “technical digital wrist watches” from goods (1); “sleeping bag accessories namely camping liners” from goods (2); “tent accessories namely adjustable steel poles”, “tent accessories namely fiberglass tent poles”, “tent accessories namely guy line slide adjusters made of aluminum”, “tent accessories namely pegs made of aluminum”, “tent accessories namely pegs made of steel” and “tent accessories namely utility nylon cords” from goods (6); and “flashlights” from goods (10).

[25] Although display of the Mark on all the products or their packaging was asserted by Mr. Lu at paragraph 2 of his second affidavit, the Owner conceded at the hearing that no such photographs for these nine products appear in the evidence. While direct documentary evidence for each registered good is not necessarily required to successfully respond to a section 45 notice, I note that the Second Lu Affidavit specifically provides photographic evidence of display of the Mark for some of the goods not depicted or not clearly depicted in the exhibited Product Guides; it is unclear why Mr. Lu was unable to provide similar evidence for these other nine goods. I further note that some of these products are depicted in the exhibited Product Guides, but in association with different trademarks.

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

[27] With respect to “carrying bags” from goods (7), the exhibited sales table correlates this with a “Folding Washbasin” product and provides sales data accordingly. However, the Requesting Party submits that this correlation should be rejected.

[28] In this respect, the Requesting Party notes that page 59 of the 2016 and 2017 Product Guides and page 57 of the 2018 and 2019 Product Guides advertise the Trailside “folding washbasin” product. It submits that this product is not a “bag”, noting that the depicted washbasin is advertised beside a number of personal hygiene and care products, rather than bags,

luggage and the like, which are advertised elsewhere in the Product Guides, and in association with different trademarks. Thus, the Requesting Party contends that any evidenced use of the Mark in association with such “folding washbasins” cannot serve to maintain the registered goods “carrying bags”.

[29] For its part, the Owner noted that the “folding washbasin” is used for carrying water and that the correlation should be taken at face value.

[30] Per section 30 of the Act, goods must be stated in ordinary commercial terms and whether a trademark has been used in association with the registered goods is to be determined on a case-by-case basis [see *Express File Inc v HRB Royalty Inc*, 2005 FC 542, 39 CPR (4th) 59]. As such, registered goods should be interpreted in accordance with common sense and given their ordinary meaning.

[31] Keeping these principles in mind, I agree with the Requesting Party that the depicted folding washbasin is not a bag *per se*, and that any evidenced use of the Mark in association with such “folding washbasins” cannot serve to maintain the registered goods “carrying bags”.

[32] As there is no evidence with respect to such registered goods otherwise, I am not satisfied that the Owner has demonstrated use of the Mark in association with “carrying bags” within the meaning of sections 4 and 45 of the Act.

[33] With respect to “toiletry pouches” from goods (8), the sales table correlates this with “Drypouch Trio Set” and provides sales data accordingly. However, the Requesting Party again submits that this correlation should be rejected and, in any event, notes that any “Drypouch Trio Set” depicted in the Product Guides do not display the Mark.

[34] At the hearing, the Owner acknowledged that the pouch products shown in the Product Guides do not clearly display the Mark. Otherwise, however, it submits that the correlation should be taken at face value, noting that the dry pouch product can have many uses, including for toiletries. Here, I am inclined to agree with the Owner and accept the correlation.

[35] However, I agree with the Requesting Party that the Mark is not clearly visible on any of the pouches depicted in the Product Guides, and that the evidence does not otherwise show that the Mark was associated with any such dry pouch products sold by the Owner.

[36] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with “toiletry pouches” within the meaning of sections 4 and 45 of the Act.

[37] With respect to the registered goods “air mattresses” from goods (12), the Owner did not concede non-use; however, it furnished no evidence of sales of such goods *per se*. Indeed, the evidence of use was limited to “self-inflatable air mattresses”, addressed above. Accordingly, I am not satisfied that the Owner has demonstrated use of the Mark in association with the more general “air mattresses” within the meaning of sections 4 and 45 of the Act.

[38] With respect to the remaining goods, the Owner made concessions in its written representations or at the hearing that the evidence does not show use of the Mark in association with such goods during the relevant period. Indeed, I am not satisfied that the evidence demonstrates use of the Mark in association with any of the remaining goods within the meaning of sections 4 and 45 of the Act. In particular, as indicated above, I note that 11 of the products listed in the exhibited sales table do not include any sales data for the relevant period, despite being correlated to a particular registered good. For example, four types of “rain jacket” are listed in the table, but no quantities or dollar amounts of sales are indicated for such goods.

[39] In summary, I am satisfied that the Owner has demonstrated use of the Mark in association with the following registered goods only: “blankets from aluminized polyethylene”, “sleeping bag accessories namely camping pillows” and “sleeping bags” from goods (2); “tents” from goods (6); “canoe backpacks” from goods (7); “camping chairs”, “camping cots” and “camping stools” from goods (9); and “polyethylene foam pads” and “self-inflatable air mattresses” from goods (12). As there is no evidence before me of special circumstances excusing the absence of use, the registration will be amended accordingly.

DISPOSITION

[40] In view of all the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete the following from the statement of goods:

- (1) Technical digital wrist watches
- (2) ... sleeping bag accessories namely camping liners, sleeping bag accessories namely compression sacks, sleeping bag accessories namely girth expanders, ...
- (3) Rain jackets/coats/pants/suits/vests/caps/ponchos in PVC material, rain jackets/coats/pants/suits/vests/caps/ponchos in nylon material, jackets/coats/pants/suits/vests/caps/ponchos in nylon material, down-filled nylon jackets/pants/vests, synthetic insulated jackets/vests/pants/baby suits, tshirts, shirts, undershirts, shorts, pants, underpants in cotton/nylon/polyester
- (4) Gaiters, shoes, boots, slippers
- (5) Waist packs, fanny packs, money pouches
- (6) ... tent accessories namely pegs made of steel, tent accessories namely pegs made of aluminum, tent accessories namely guy line slide adjusters made of aluminum, tent accessories namely aluminum tent poles, tent accessories namely fiberglass tent poles, tent accessories namely adjustable steel poles, tent accessories namely utility nylon cords, tent accessories namely seam sealers, bivy sacks, polyethylene tarpaulins, polyester tarpaulins.
- (7) Daypacks, camping backpacks, mountain backpacks, ... hydration backpacks, carrying bags, briefcases, travel bags, wheeled luggage, trolley luggage, duffel bags
- (8) Toiletry bags, toiletry pouches
- (10) Headlights, flashlights
- (11) Hiking poles in aluminum tubing
- (12) Air mattresses, ...
- (13) Gas stoves, oil stoves.
- (14) Tealight lanterns in stainless steel/aluminum/brass, candle lanterns in stainless steel/aluminum/brass, lantern glass chimneys, candles
- (15) Stainless steel camping cookware, bottles, mugs, cutlery and tableware, Polycarbonate camping cookware, bottles, mugs, cutlery and tableware, Enameled metal camping cookware and tableware, Melamine metal material camping cookware and tableware

[41] The amended statement of goods shall now read as follows:

- (2) Sleeping bags, sleeping bag accessories namely camping pillows, blankets from aluminized polyethylene
- (6) Tents
- (7) Canoe backpacks
- (9) Camping stools, camping chairs, camping cots
- (12) Self-inflatable air mattresses, polyethylene foam pads.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: 2022-01-20

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