



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 078

Date of Decision: 2022-04-26

IN THE MATTER OF SECTION 45 PROCEEDINGS

Pronature Inc.

Requesting Party

and

The Nomad Company B.V.

Registered Owner

**TMA792,913 for NOMAD, and
TMA792,912 for NOMAD & Design**

Registrations

Introduction

[1] This is a decision involving a summary expungement proceeding with respect to registrations No. TMA792,913 for the word mark NOMAD, and No. TMA792,912 for the design mark NOMAD & Design, reproduced below:



[2] The subject trademarks are both registered for use in association with:

GOODS

Leather and imitations of leather; travelling trunks; valises; bags, namely traveling bags, duffle bags; rucksacks; daypacks; cases on wheels, namely trolley bags; wheeled duffle bags; bicycle bags; toilet bags sold empty; shoulder bags; handbags; hip bags; neck bags, namely necktie wallets; belt bags; bags for documents and/or securities, namely passport wallets, document wallets, document pouches; pocket wallets; purses; umbrellas, parasols and walking sticks; sleeping bags; sleeping mats; mattresses; carry cots; air pillows; air cushions; air mattresses; bedding (except linen); ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags, namely cases for covers for tents, sleeping mats, mattresses, air mattresses, air pillows and air cushions; padding and stuffing materials (except of rubber or plastics); clothing, namely outdoor clothing, namely jackets, pants, skirts, shirts, vests, pullovers, sweaters, shorts, ski clothing namely ski jackets, ski trousers, ski sweaters; mountaineering boots, climbing boots, hiking shoes, caps, hats, gloves, shawls and socks.

SERVICES

Commercial intermediary services in the field of wholesale trading of, as well as retail services, import and export in fields of leather goods, luggage and accessories, furniture and bedding, textile materials and clothing; commercial intermediary services in the field of wholesale trading of, as well as retail services, import and export in fields of leather goods, luggage and accessories, furniture and bedding, textile materials and clothing through electronic and telecommunications means, such as the Internet, television networks, (mobile) telephone networks, cable, satellite and ether networks, and other similar networks.

[3] For the reasons that follow, I conclude that the registrations ought to be expunged.

The Proceedings

[4] On June 22, 2020, at the request of Pronature Inc. (the Requesting Party), the Registrar of Trademarks issued two notices pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to The Nomad Company B.V. (the Owner). The notices required the Owner to show whether the subject trademarks were used in Canada in association with each of the goods and services specified in the registrations at any time within the three-year period immediately preceding the date of the notices and, if not, the date when the trademarks were 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 June 22, 2017 and June 22, 2020.

[5] In response to the Registrar's notices, the Owner submitted a document signed by Kasper Schroeter, together with Exhibits A to C (the Affidavit Document). The issue of whether this document constitutes a properly sworn affidavit is addressed below.

[6] Only the Requesting Party submitted written representations and no oral hearing was requested.

Overview of the Affidavit Document

[7] Mr. Schroeter defines "rucksacks, daypacks and clothing namely shirts, jackets and caps" as "the NOMAD Goods" and "Commercial intermediary services in the field of retail services of clothing and luggage" as "the NOMAD Services".

[8] In addition, Mr. Schroeter asserts that, during the relevant period, the subject trademarks were used by the Owner in association with the NOMAD Goods which were "offered for sale" to customers in Canada, and in association with the NOMAD services which were "advertised, offered and performed" for customers in Canada.

[9] With respect to the NOMAD Goods, he states that the subject trademarks were "displayed on the NOMAD Goods themselves, on the packaging and labelling of the NOMAD Goods, as well as on price lists and packing slips accompanying the shipment of NOMAD Goods to retailers or distributors in Canada". He attaches, as Exhibit A to his affidavit, materials he describes as showing the manner in which the trademarks were so displayed during the relevant period.

[10] While Mr. Schroeter does not specifically identify the documents in Exhibit A, I note the following:

- Four pages of photographs depicting various jackets bearing the subject trademarks.
- An itemized list of products, namely various backpacks, t-shirts and a cap, together with a spreadsheet table showing additional information for each of the products. These

documents contain no indication that those products were transferred, such as a shipment date or a shipping address.

- A list of products such as “Nomad College daypack 18L” and “Nomad Heuptas” with corresponding prices in USD and total quantities for each product. The top of this page indicates a “Ship Date” of “20-dec-2019”. There is no indication as to the shipping address.
- A bundle of e-mail exchanges with references to shipments of samples. Although the e-mails seemingly pertain to establishing business relationships with retailers, there is no clear indication as to the location of those prospective retailers. I note, however, one reference to “putting some units in, for a test, in Canada”.

[11] As for the NOMAD Services, Mr. Schroeter states that, during the relevant period, the subject trademarks were displayed in e-mail correspondence with prospective retailers in Canada in order to find a new selling market in Canada. Although he attaches Exhibit B to his affidavit in support of that statement, it appears that his statement instead refers to the bundle of e-mail exchanges provided in Exhibit A.

[12] Mr. Schroeter also explains that Exhibit B contains a letter “regarding Nomad’s activities and the international expansion of the brand, amongst others in Canada.” The exhibited letter, dated January 18, 2021 (that is, outside the relevant period), briefly presents “NOMAD®” and its products, namely products which “stand for high quality and are known for their durability. From a core expertise in sleeping bags and mats, we have created a complete range of travel gear including, outdoor clothing, day packs, tour packs, backpacks and tents.” While no recipient is indicated on the letter, a section titled “Canada” indicates “For Canada we have chosen to work with a strong partner to set up a long term partnership. The Canadian Tire Corporation is one of the largest retailers of the country.”

[13] Finally, Mr. Schroeter states that “the full product line” of goods covered by the subject registrations can be ordered, and during the relevant period were “available to order” from the

website *www.nomad.nl*, for shipment to customers around the world including in Canada. In support, he attaches Exhibit C to his affidavit, consisting of website screenshots which he states are “representative of the product line offered and available for sale and shipment to customers in Canada during the Relevant Period”.

Admissibility of the Affidavit Document

[14] The introductory paragraphs of the Affidavit Document are reproduced below:

I, Kasper Schroeter, of the City of [illegible], make oath and say as follows:

1. I make this affidavit in response to a notice issued by the Registrar of Trademarks on June 22, 2020...

[15] Although the Affidavit Document is signed by Mr. Schroeter, there is no indication as to the location where it was signed or that the document was sworn (or affirmed) in front of a notary public, commissioner of oaths, or similar authority authorized to administer oaths.

[16] In its written representations, the Requesting Party argues that because there is no indication that it was sworn before a person authorized to administer oaths, the Affidavit Document is not a true affidavit or statutory declaration as required by section 45(1) of the Act, and is therefore not admissible.

[17] I would first note that the Act and the *Trademarks Regulations*, SOR/2018-227, 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)].

[18] The Registrar has also frequently considered certain deficiencies in affidavits and statutory declarations to be mere technicalities, especially in the context of section 45 proceedings which are intended to be summary and expeditious [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)]. In this regard, it is well established that mere technical deficiencies in an owner's evidence should not be a bar to a successful response to a section 45 notice [*Baume & Mercier SA v Brown* (1985), 4 CPR (3d) 96 (FCTD)].

[19] In this case, however, I agree with the Requesting Party that the deficiencies in the Affidavit Document are beyond mere technicalities. In particular, while the document purports to be an affidavit, it does not, on its face, appear to have been sworn or affirmed.

[20] Indeed, while Mr. Schroeter provides a statement that he “make[s] oath and say[s]” at the beginning of the Affidavit Document, there is no jurat or other indication that the document was in fact sworn before a notary public, commissioner of oaths or other individual authorized to administer oaths. All that appears at the bottom of the Affidavit Document is the signature of Mr. Schroeter and a date.

[21] Moreover, the Owner chose not to correct the deficiencies raised by the Requesting Party in its written representations, nor did the Owner provide any submissions or evidence to confirm that the Affidavit Document meets the standards for sworn statements under the law in the jurisdiction where it was signed.

[22] Consequently, I find that the Affidavit Document cannot be considered in these proceedings, and that the Owner has failed to furnish the evidence of use required by section 45 of the Act.

[23] In any event, even if I were to accept the Affidavit Document as a validly sworn document, for the reasons below, I would conclude that the evidence is insufficient to demonstrate use of the subject trademarks within the meaning of sections 4 and 45 of the Act.

Analysis with Respect to Use

[24] 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), 1996 CanLII 17297 (FC), 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 and services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[25] The relevant definitions of “use” in this case are set out in section 4 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.

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[26] In the present case, Mr. Schroeter states that the NOMAD Goods were “offered for sale” and that the “full product line” was available to order from the Owner’s website. However, it is not sufficient that the goods were merely offered during the relevant period; some evidence of transfers in the normal course of trade in Canada is necessary [see, for example, *Molson Cos v Halter* (1976), 28 CPR (2d) 158 (FCTD); and *Gowling, Strathy & Henderson v Royal Bank* (1995), 63 CPR (3d) 322 (FCTD)].

[27] The Owner has provided no clear evidence of such transfers. For instance, even if I were to accept an Exhibit A e-mail exchange dated in November 2019 confirming that products samples were “all received”, there is no information regarding the nature of the samples, and no indication that those samples were received in Canada.

[28] As for services, I first note that while Mr. Schroeter defines the NOMAD Services as “Commercial intermediary services in the field of retail services of clothing and luggage”, the complete registered term is “*Commercial intermediary services in the field of wholesale trading*”

of, as well as *retail services*, import and export in fields of leather goods, *luggage and accessories*, furniture and bedding, textile materials and *clothing*".

[29] Even if I were to accept that the asserted NOMAD Services fall within the ambit of the registered services, or a portion thereof, the evidence falls short of establishing that the services offered by the Owner correspond to "commercial intermediary services".

Disposition

[30] 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 registrations will be expunged.

Eve Heafey
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: No Hearing Held

AGENTS OF RECORD

Osler, Hoskin & Harcourt LLP

For the Registered Owner

Gowling WLG (Canada) LLP

For the Requesting Party