



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

**Citation: 2014 TMOB 168**  
**Date of Decision: 2014-08-18**

**IN THE MATTER OF A SECTION 45  
PROCEEDING requested by  
Laboratoires Contapharm against  
registration No. TMA617,049 for the  
trade-mark ORIGINS in the name of  
Origins Natural Resources Inc.**

[1] This decision pertains to a summary expungement proceeding with respect to registration No. TMA617,049 for the trade-mark ORIGINS owned by Origins Natural Resources Inc.

[2] The services listed in the registration are essentially retail store services featuring a variety of products, including cosmetics, skin and body care products, hair care products and perfumery, catalogue sales by mail, fax and telephone of these products, consultation services in the selection and use of cosmetics, toiletries, perfumery and beauty treatment, and providing services relating to body, nail and skin care. The statement of services of the registration is entirely reproduced in annex.

[3] For the reasons that follow, I conclude that the registration ought to be amended to delete part of the services listed at (1) and all the services listed at (2) in the registration.

The Proceeding

[4] On May 30, 2012, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Origins Natural Resources Inc. (the Registrant). This notice was sent at the request of Laboratoires Contapharm (the Requesting Party).

[5] The notice required the Registrant to furnish evidence showing that it had used the trade-mark ORIGINS (the Mark) in Canada, at any time between May 30, 2009 and May 30, 2012, in association with each of the services specified in registration No. TMA617,049. If the Mark had not been so used, the Registrant 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] Section 4(2) of the Act provides that a trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services. It has been held that section 4(2) contemplates that the services advertised in Canada be performed in Canada [*Porter v Don the Beachcomber* (1966), 48 CPR 280 (Ex Ct)]. However, it has also been held that section 4(2) of the Act may be complied with if it is shown that the trade-mark owner is offering and is prepared to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (RTM)].

[7] It is 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”. Mere claims of use are insufficient to show the use of the trade-mark [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the criteria for establishing use are not very demanding and an overabundance of evidence is not necessary, sufficient facts must be presented to enable the Registrar to conclude that the trade-mark has been used in association with each ware or service mentioned in the registration during the relevant period [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[8] In response to the Registrar’s notice, the Registrant furnished an affidavit of Lesley A. Moradian, sworn December 18, 2012. At the date of her affidavit, Ms. Moradian was Vice President and Senior Trademark Counsel of the Registrant.

[9] Only the Registrant filed written representations.

[10] Both parties were represented at a hearing held jointly with hearings for summary expungement proceedings with respect to four other registrations owned by the Registrant for the trade-mark ORIGINS. Separate decisions will be issued for these other proceedings, which pertain to registration Nos. TMA466,901, TMA470,749, TMA554,982 and TMA671,380.

## The Evidence

[11] Ms. Moradian states that the Registrant's products include cosmetic products, skin and body care products, hair care products and perfumery [para 3 of the affidavit].

[12] At paragraph 4 of her affidavit, Ms. Moradian references the services provided in Canada by the Registrant in association with the Mark. Although lengthy, I find it useful to reproduce this paragraph in its entirety:

The [Mark] has been used in Canada since at least as early as 1999 in association with the retail store sale of cosmetics (such as eyeshadow, bronzer, concealer, foundation, blush, mascara, eye, lip and brow pencils, skin care preparations), toiletries (such as deodorants) and perfumery, bath products (such as bubble bath), and hair products (shampoo and conditioner), candles, chewing gum and massage tools (the "Products") and consultation services in the selection and use of cosmetics, toiletries, perfumery and beauty treatment and skin care facials. These services are provided on-line at the ORIGINS e-commerce website and at ORIGINS branded cosmetic counters. [The Registrant] also provides catalog sales of the Products by telephone via the ORIGINS e-commerce website. The [Mark] was in use in Canada by [the Registrant] at the date of the Section 45 notice, namely May 30, 2012, and during the period May 30, 2009 to May 30, 2012 (the "relevant period") in association with retail store services featuring cosmetics, toiletries and perfumery, candles, bath products, consultation services in the selection and use of cosmetics, toiletries, perfumery and beauty treatment, and skin care facials and catalog sales by telephone of cosmetics, toiletries, perfumery, candles and hair products (the Services) and such use continues to date.

[13] I note that my subsequent use of the term "Services" in my review of the evidence reflects the use of this term by Ms. Moradian in her affidavit.

[14] While seemingly unimportant, I note that Ms. Moradian only uses the collective term "Products" at paragraph 4 of her affidavit. Ms. Moradian uses the term "products" throughout the remainder of her affidavit, although in some instances she refers to specific products. In any event, given the totality of the evidence, I accept to infer that the Services are related to the Products.

[15] According to Ms. Moradian's statements [paras 6-13<sup>1</sup> of the affidavit]:

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<sup>1</sup> This is a reference to the first of two paragraphs numbered « 13 » in the affidavit.

- the Mark appears on the product and product packaging of “all ORIGINS products sold in Canada”;
- the Registrant advertises and performs the Services in Canada via its e-commerce retail website, at *www.origins.com*, and at ORIGINS branded cosmetic counters at The Bay stores and Sephora stores;
- the Registrant has operated its e-commerce retail website since at least as early as 1999 where products, such as cosmetics, toiletries, perfumery, bath products and candles, may be ordered online and shipped to Canada. In conjunction with the sale of the products, in the Customer Service section of the website, the Registrant provides consultation services in the selection and use of cosmetics, toiletries, perfumery and beauty treatment in relation to ORIGINS products;
- in 2009, the Registrant began keeping statistics for Canadian specific visitors to its website. Over 58,000 unique visits were recorded in 2009. Since 2010, Canadian visitors have totaled over 100,000 each year;
- the Registrant has operated ORIGINS branded counters in Canada since 2003. The Registrant also provides retail store services for the sale of cosmetics, toiletries, perfumery, bath products and candles and consultation services in the selection and use of cosmetics, toiletries, perfumery and beauty treatment and skin care facials at ORIGINS branded cosmetic counters at The Bay stores. Signage bearing the Mark is displayed at the counters and the sales clerks wear apparel bearing the Mark. Counter cards and brochures regarding the consultation services and skin care facials are also available at the counters; and
- for the fiscal years 2009 to 2012 (July 1 to June 30) retail sales in Canada for the Services performed in association with the Mark] were in excess of US\$10 million. During the same period, online retail sales to customers in Canada for the Services performed in association with the Mark were in excess of CAD\$900,000. I note that in both cases, Ms. Moradian furnished a breakdown of the sales figures by fiscal year.

[16] I now turn to the review of Exhibits A to I of Ms. Moradian's affidavit, attached in support of her statements regarding the use of the Mark in Canada by the Registrant during the relevant period.

- Exhibit A consists of printouts from the Registrant's retail website, at *www.origins.com*, that depict the wares available for sale in Canada at the date of the affidavit. The depicted wares are representative of cosmetics, toiletries, perfumery, candles and bath products bearing the Mark that were sold in Canada during the relevant period [para 5 of the affidavit].
- Exhibit B consists of coloured images for a variety of products and product packaging and are representative of the manner in which the Mark has been used in Canada in association with cosmetics, toiletries, candles and bath products sold in Canada during the relevant period [para 6 of the affidavit].
- Exhibit C consists of printouts from the Registrant's website displaying the Mark. According to Ms. Moradian's statements, the Mark appears on every page of the website and the printouts are representative of the manner in which the Mark has been used in Canada in association with the Services during the relevant period [para 8 of the affidavit].
- Exhibits D to F consist of specimens of use of the Mark at the cosmetic counter at The Bay on Queen Street, in Toronto, at the date of the affidavit, namely:
  - a photograph of the counter sign displaying the Mark [Exhibit D];
  - a photograph of two sales clerks wearing aprons bearing the Mark [Exhibit E]; and
  - a photograph of a counter card [Exhibit F]. According to Ms. Moradian's statements, this counter card displays products bearing the Mark and offers customers mini facials. It also advertises for sale, the "jack nobber" massage tool, which is representative of massage tools sold in Canada by the Registrant during the relevant period. Despite the poor quality of the

photograph, I can see that the counter card displays products bearing the Mark and references “Mini Facial”.

These are representative of signage, apparel worn by sales clerks and counter cards used at the ORIGINS branded counters in Canada during the relevant period [paras 9-10 of the affidavit].

- Exhibit G consists of a photograph of a gumball machine bearing the Mark and displayed at the cosmetic counter at The Bay on Queen Street, in Toronto, at the date of the affidavit. It is representative of how chewing gum was sold in Canada in association with the Mark during the relevant period [para 11 of the affidavit].
- Exhibit H consists of copies of an order form and a shipment confirmation form, both displaying the Mark, for an online order from a Canadian customer, whose name and address have been removed for privacy reasons. These are representative of online order and shipment confirmation forms used by the Registrant during the relevant period in association with the Services [para 13<sup>2</sup> of the affidavit].
- Exhibit I consists of copies of co-operative advertising conducted with The Bay, namely mailers sent during the fiscal year 2012 (July 1, 2011 to June 30, 2012), and are representative of mailers distributed in Canada during the relevant period [para 14 of the affidavit].

### Analysis of the Issues

[17] The issues that arise from the Requesting Party’s oral representations are:

1. Does the evidence show use of the Mark as registered?
2. Does the evidence pertain to the use of the Mark during the relevant period?
3. Is there adequate evidence of use of the Mark with respect to the registered retail store services?

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<sup>2</sup> This is a reference to the second of two paragraphs numbered « 13 » in the affidavit.

4. Is there adequate evidence of use of the Mark with respect to the registered catalogue sale services?
5. Is there adequate evidence of use of the Mark with respect to the registered consultation services and the registered body, nail and skin care services?

[18] Generally speaking, I note that in my view some of the Requesting Party's representations are the result of an overly technical approach in the analysis of the evidence. However, an overly technical approach is inconsistent with the limited purposes of section 45 proceedings. The evidence must be considered as a whole.

[19] The case law is clear that there is no particular kind of evidence that must be provided in response to a section 45 notice. What is required is that the owner of the trade-mark establish a *prima facie* case of use [see *Lewis Thomson & Sons Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)].

[20] I will now analyse each of the issues in turn.

*1. Does the evidence show use of the Mark as registered?*

[21] This issue arises from the Requesting Party's first and foremost contention that the evidence shows use of a composite mark consisting of the word ORIGINS and the design of two trees rather than use of the Mark, i.e. the word ORIGINS.

[22] The Registrant submits that the display of the word ORIGINS in combination with the design of two trees constitutes use of the Mark. In this regard, the Registrant essentially submits that when the word ORIGINS appears in combination with the design of two trees, the word ORIGINS would be seen as a separate trade-mark. Furthermore, the Registrant points out that the counter sign displays the word ORIGINS by itself [Exhibit D] and that the website printouts reference the word ORIGINS in the text [Exhibit C].

[23] For the reasons that follow, I decide the issue in favour of the Registrant.

[24] As a first matter, I note that the Requesting Party mostly relies on the evidence showing the Mark used on products and product packaging to support its contention. Notably, at the

hearing, the Requesting Party did not make any submissions on the display of the word ORIGINS by itself on the counter sign and in the text of the website, which was rightly pointed out by the Registrant.

[25] In any event, the use of a trade-mark in combination with additional words or features constitutes use of the registered mark if the public, as a matter of first impression, would perceive the trade-mark *per se* as being used. As held in *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB) at 538:

This is a question of fact dependent upon such factors as whether the mark stands out from the additional material, for example by the use of different lettering or sizing [...] or whether the additional material would be perceived as purely descriptive matter or as a separate trade mark or trade name [...]

See also *Canada (Registrar of Trade-marks) v Cie International pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 at 525 (FCA). Furthermore, there is nothing in the legislation that prohibits the use of two or more trade-marks simultaneously [*AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)].

[26] Applying these principles to the present case, the Requesting Party's oral representations did not convince me that the evidence showing the word ORIGINS in combination with the design of two trees may not amount to evidence showing use of the Mark. Rather, I agree with the Registrant's representations that the use of the word ORIGINS in combination with the design of two trees would be perceived as use of the Mark *per se*.

[27] Accordingly, I am satisfied that the evidence in the present case shows use of the Mark as registered.

2. *Does the evidence pertain to the use of the Mark during the relevant period?*

[28] This issue arises from the Requesting Party's overall contention that the Registrant's evidence does not pertain to the use of the Mark during the relevant period.

[29] For the reasons that follow, I am satisfied that the evidence pertains to the use of the Mark during the relevant period and so I decide this issue in favour of the Registrant.



[30] For one thing, Ms. Moradian clearly and specifically states that the Mark has been used in Canada by the Registrant during the relevant period in association with the Services. Moreover, based on a fair reading of the Moradian affidavit, it is clear that Exhibits A, B and I depict products which are representative of those associated with the Mark and sold in Canada by the Registrant during the relevant period. It is also clear that Exhibits C to H are representative of the manner of use of the Mark during the relevant period in association with the Services. Finally, Ms. Moradian provides factual information for the relevant period, including Canadian sale figures and Canadian specific visitors to the Registrant's website.

3. *Is there adequate evidence of use of the Mark with respect to the registered retail store services?*

[31] This issue arises from the Requesting Party's contention that the Moradian affidavit does not establish use of the Mark in Canada in association with the retail store services listed in the registration, namely:

- retail store services featuring cosmetics, toiletries and perfumery, essential oils, aromatherapy oils and gels, candles, body sponges, body brushes, soap dishes, bath products, hair products, hair brushes, massage tools, squeeze balls, essential oil diffusers, books, pillows, chewing gum, dog shampoo, baby skin balm, baby hair and body wash, room fresher, potpourri, fine linen wash, sachets, and stuffed animals, herbal teas (the Retail Store Services (1)); and
- retail store services featuring books, wrapping paper, notecards, notebooks, address books, memo pads, folk art made from paper, mirrors, picture frames, candle holders, wood carvings, wall hangings, baskets, wooden boxes, wall shelves, pencil holders, bowls, vessels, dishes, vases, glasses, bed covers, table covers, textile wall coverings, embroidery, napkins, placemats, floor throws, rugs, belts, gloves, hats, purses, wallets, backpacks, boots, novelty shoes, and dolls (the Retail Store Services (2)).

[32] Based on my understanding of the Requesting Party's oral representations, its submissions with respect to this issue are in three prongs, namely:

- (a) the sale of the Registrant's products via the e-commerce website and at cosmetic counters does not amount to the performance of retail store services in Canada by the Registrant;

- (b) the evidence does not show the sale of any products in Canada during the relevant period because:
  - (i) no invoices have been provided to evidence sales of products via the e-commerce website or at cosmetic counters; and
  - (ii) there is no evidence of delivery of products purchased via the website;
- (c) the evidence does not establish use of the Mark in association with the Retail Store Services (1) and the Retail Stores Services (2). Alternatively, the Registrant did not provide evidence establishing that the Retail Store Services (1) featured all of the listed wares.

[33] I will address each prong of the Requesting Party's submissions in turn.

Sale via the e-commerce website and at ORIGINS cosmetic counters

[34] It has been held that services should be given a generous or broad interpretation [*Venice Simplon-Orient-Express, Inc v Société Nationale des Chemins de Fer Français* (2009), 9 CPR (4th) 443 (FCTD); *TSA Stores Inc v Canada (Registrar of Trade-marks)* (2011), 91 CPR (4th) 324 (FC) *Renaud Cointreau & Co v Cordon Bleu International Ltd* (2000), 11 CPR (4th) 95 (FCTD), *aff'd* 18 CPR (4th) 415 (FCA)].

[35] Given the evidence of record, I am satisfied that the sale of the Registrant's products via its e-commerce website does amount to retail store services in Canada. In *TSA Stores Inc, supra*, the operation of a website accessible to Canadians that provides information and pricing on specific products has been considered "retail store services". In the present case, the Registrant's e-commerce website printouts show prices in Canadian dollars and provide information on the products that can be purchased online [Exhibit A].

[36] Likewise, I am satisfied that the sale of the Registrant's products at ORIGINS branded cosmetic counters in Canada does amount to retail store services. Furthermore, the Requesting Party did not convince me that these retail store services are performed by The Bay stores, not by the Registrant. In my view, The Bay stores merely act as intermediaries providing the services to the ultimate Canadian consumers. Thus, the performance of the retail store services at the

ORIGINS branded cosmetics counters at The Bay stores constitute the performance of retail store services by the Registrant. [See, by way of analogy, *Venice Simplon-Orient-Express, supra*, where it was found that the performance in Canada by travel agencies of booking, reservation and ticketing services constituted the performance in Canada of such services by the registrant since the travel agencies merely acted as intermediaries providing the registrant's services to the ultimate Canadian consumer.]

Sale of products in Canada during the relevant period

[37] The fact that the Registrant did not provide invoices showing the sale of its products in Canada is not fatal to its case. I agree with the Registrant that the totality of its evidence is more than sufficient to establish the sale of its products in Canada during the relevant period.

[38] Suffice it to say that the Canadian retail sales and online sales figures provided for the fiscal years 2009 to 2012 consist of factual information that lends support to Ms. Moradian's statements as to the sale of the Registrant's products via its e-commerce website and at ORIGINS branded cosmetic counters in Canada during the relevant period. The statistics for Canadian specific visitors to the Registrant's website starting in 2009 also consist of factual information that lends support to Ms. Moradian's statements as to the sale of the Registrant's products via its e-commerce website.

[39] I would add that all that was required from the Registrant was to show that it was willing and able to perform the retail store services associated with the Mark in Canada during the relevant period. In this case, the Registrant succeeds with both showing that it was willing and able to perform the retail store services, and did indeed perform these services.

Use of the Mark in association with the Retail Store Services (1) and the Retail Store Services (2)

[40] In considering the last prong of the Requesting Party's submissions, I note from the outset that I am satisfied that the evidence establishes use of the Mark, under section 4(2) of the Act, in association with retail store services for the reasons that follow.

[41] For one thing, I find that the display of the Mark on the order and shipping confirmation forms constitutes use of the Mark in association with the retail store services performed via the operation of the Registrant's website [Exhibit H]. Moreover, I find that the printouts of the Customer Service section of the website also provide evidence of use of the Mark in the performance and advertisement of these retail store services [Exhibit C]. The Mark is clearly displayed at the top of the Customer Service section of the website pages and, among others, there are obvious references and links to "Shop Online" and "Shipping Info" on the website pages.

[42] Finally, I find that the display of the Mark on the counter sign constitutes use of the Mark in the performance of the retail store services at the ORIGINS branded cosmetic counters [Exhibit D].

[43] As I am satisfied that the evidence shows use of the Mark by the Registrant in association with retail store services in Canada, during the relevant period, I shall now address the Requesting Party's submissions that the evidence does not establish that the Retail Store Services (1) featured each ware listed, nor does it establish use of the Mark in association with the Retail Store Services (2).

[44] I will discuss the parties' submissions and the evidence with respect to the Retail Store Services (1) and the Retail Store Services (2) in turn. In doing so, I am mindful of Ms. Moradian's sworn statement at paragraph 4 of her affidavit that the Registrant has used the Mark in Canada since 1999 in association with the retail store sale of *cosmetics* (such as eyeshadow, bronzer, concealer, foundation, blush, mascara, eye, lip and brow pencils, skin care preparations), *toiletries* (such as deodorants) and *perfumery, bath products* (such as bubble bath), and *hair products* (shampoo and conditioner), *candles, chewing gum and massage tools*". [My emphasis]

#### *Retail Store Services (1)*

[45] Based on my understanding of its oral representations, the Registrant does not dispute that it did not provide direct evidence or documentary proof that the Retail Store Services (1) featured all of the listed wares. However, citing *Saks & Co v Canada (Registrar of Trade Marks)*

(1989), 24 CPR (3d) 49 (FCTD), the Registrant argues that it would be an evidentiary overkill to require direct evidence or documentary proof for each of the listed wares.

[46] In this regard, the Registrant essentially argues that there is sufficient evidence to conclude that the Retail Store Services (1) featured all of the listed wares because these wares are within the categories of wares in respect of which evidence has been provided. In other words, the Registrant relies on the concept of accepting evidence of use with a few wares within a category as sufficient to evidence use for the entire category.

[47] This concept is typically applied in the context of the use of a trade-mark registered for wares, as in the *Saks & Co* case. In any event, 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 wares within a category can be sufficient to show use for the entire category. However, in these circumstances, an affidavit must contain a clear statement of use within the relevant period in association with *each* of the wares and must provide sufficient facts to permit the Registrar to conclude that the trade-mark is in use in association with each ware.

[48] For the reasons that follow I disagree with the Registrant's contention that I have sufficient evidence to conclude that the Retail Store Services (1) featured all of the listed wares.

[49] For one thing, based on a plain reading of the listed wares in the registration, it is apparent that they are not organized by categories. Moreover, I disagree with the Registrant's overall contention about the categorization of the wares featured by the Retail Store Services (1). For instance, I do not consider that wares such as "books", "pillows", "stuffed animals" and "herbal teas" correspond to cosmetics, toiletries, perfumery, bath products, hair products or massage tools, as suggested by the Registrant.

[50] Despite the Registrant's argument that a plain reading of Ms. Moradian's statement permits the inference that products identified in parenthesis are provided as examples of products within the entire category, I am not prepared to make such an inference in all instances, even when I consider the evidence in its entirety. For example, I have no basis to infer that "hair products" include wares other than shampoo and conditioner, such as dog shampoo.

[51] In any event, Ms. Moradian's statement with respect to the featured wares is at the very least ambiguous; an ambiguity that I must interpret against the interest of the Registrant [*Plough (Canada) Ltd, supra*]. It remains that Ms. Moradian does not clearly reference the retail store sale of essential oils, aromatherapy oils and gels, body sponges, body brushes, soap dishes, hair brushes, squeeze balls, essential oil diffusers, books, pillows, dog shampoo, baby skin balm, baby hair and body wash, room fresher, potpourri, fine linen wash, sachets, stuffed animals, and herbal teas. Moreover, I am not satisfied that the evidence provides sufficient facts for me to infer that the Retail Store Services (1) featured these wares.

[52] In the end, I am satisfied that the evidence is sufficient to conclude to the use of the Mark during the relevant period in Canada by the Registrant, within the meaning of sections 4(2) and 45 of the Act, in association with retail store services featuring cosmetics, toiletries and perfumery, candles, bath products, hair products, massage tools, and chewing gum.

[53] Accordingly the registration will be amended to delete the wares "[...], essential oils, aromatherapy oils and gels, [...], body sponges, body brushes, soap dishes, [...], hair brushes, [...], squeeze balls, essential oil diffusers, books, pillows, [...], dog shampoo, baby skin balm, baby hair and body wash, room fresher, potpourri, fine linen wash, sachets, and stuffed animals, herbal teas" for the Retail Store Services (1).

#### *Retail Store Services (2)*

[54] Based on my understanding of the Registrant's oral representations, its submissions concerning the evidence with respect to the Retail Store Services (2) are essentially the same as its submissions with respect to the Retail Store Services (1).

[55] Thus, for reasons similar to those discussed above, I disagree with the Registrant's overall contention that the Moradian affidavit is sufficient to show use of the Mark in association with retail store services featuring books, wrapping paper, notecards, notebooks, address books, memo pads, folk art made from paper, mirrors, picture frames, candle *holders* (my emphasis), wood carvings, wall hangings, baskets, wooden boxes, wall shelves, pencil holders, bowls, vessels, dishes, vases, glasses, bed covers, table covers, textile wall coverings, embroidery, napkins, placemats, floor throws, rugs, belts, gloves, hats, purses, wallets, backpacks, boots,

novelty shoes, and dolls. Furthermore, the Registrant has not evidenced circumstances justifying the absence of use of the Mark in association with retail store services featuring these wares.

[56] Accordingly, the Retail Store Services (2) will be deleted from the registration.

4. *Is there adequate evidence of use of the Mark with respect to the registered catalogue sales services?*

[57] This issue arises from the Requesting Party's contention that the Moradian affidavit does not establish use of the Mark in Canada in association with the following registered services:

catalog sales by mail, fax and telephone of cosmetics, toiletries, perfumery, essential oils, aromatherapy oils and gels, candles, body sponges, body brushes, soap dishes, bath products, hair products, hair brushes, massage tools, squeeze balls, essential oils diffusers, books, pillows, chewing gum, dog shampoo, baby skin balm, baby hair and body wash, room fresher, fine linen wash, sachets.

[58] I note that Ms. Moradian at paragraph 4 of her affidavit only references catalogue sales *by telephone* of cosmetics, toiletries, perfumery, candles and hair products.

[59] The Registrant conceded at the hearing that its evidence does not show use of the Mark in Canada in association with catalogue sales *by fax*. However, the Registrant submitted that its evidence establishes use of the Mark in association with catalogue sales *by mail* and *telephone*. The Registrant essentially contends that the display of the products on the website is akin to a catalogue and thus the evidence establishing use of the Mark in association with online retail sales establishes use of the Mark in association catalogue sales by mail and telephone.

[60] I agree with the Registrant that the printouts of its e-commerce website show the mention "Order by Phone 1-800-ORIGINS" [Exhibit B]. This is the end of my agreement with the Registrant.

[61] Indeed, I am not prepared to conclude that the online sale of products automatically amounts to catalogue sales, especially in a case such as this one where there is no evidence of sales by catalogue in the first place. Furthermore, there is no evidence that an electronic version of a paper catalogue was available for consultation on the website or could be downloaded from the website during the relevant period.

[62] Finally, the Registrant has not evidenced circumstances justifying the absence of use of the Mark in association with catalogue sales by fax, mail and telephone.

[63] Accordingly, the catalogue sales services listed at (1) in the registration will be deleted.

5. *Is there adequate evidence of use of the Mark with respect to the registered consultation services and the registered body, nail and skin care services?*

[64] This issue arises from the Requesting Party's contention that the Moradian affidavit does not establish use of the Mark in Canada in association with the following registered services:

- consultation services in the selection and use of cosmetics, toiletries, perfumery and beauty treatment; and
- providing services relating to body massages, manicures, pedicures, skin care facials and reflexology.

[65] Insofar as these registered services are concerned, it is of note that Ms. Moradian states at paragraph 4 of her affidavit that the Mark has been used by the Registrant in association with "consultation services in the selection and use of cosmetics, toiletries, perfumery and beauty treatment, and skin care facials". She does not reference the use of the Mark in association with the provision of services relating to body massages, manicures, pedicures and reflexology, which was acknowledged by the Registrant at the hearing.

[66] Ultimately, the Registrant conceded at the hearing that its evidence is not sufficient to establish use of the Mark in Canada in association with "providing services relating to body massages, manicures, pedicures [...] and reflexology". Furthermore, as the Registrant has not evidenced circumstances justifying the absence of use of the Mark in association with these services, they will be deleted from the registration.

[67] Hence, the question becomes whether the evidence establishes use of the Mark in association with "consultation services in the selection and use of cosmetics, toiletries, perfumery and beauty treatment" and "providing services relating to [...] skin care facials [...]".

[68] I disagree with the Requesting Party's contention that the fact that the services are provided free of charge is fatal to the Registrant's case.



[69] Indeed, I agree with the Registrant that the fact that the services are incidental to the sale of its products and performed free of charge does not negate the fact that the services have been provided. As I have previously indicated, services should be given a generous or broad interpretation. The law is clear that there is no distinction in the Act between primary, incidental or ancillary services. As long as some members of the public, consumers or purchasers, receive a benefit from the activity, it is a service. In the present case, the services go beyond making the public aware of the products. Furthermore, it is quite possible that consumers buying the Registrant's products look for and expect information on how to use the products or select the products according to different factors such as colour or skin type. [See, by way of analogy, *Renaud Cointreau & Co, supra*, where it was found that offering recipes, suggestions and other instructive matter printed on food product labels constituted services distinct from the product itself.]

[70] Thus, I will now turn to the Requesting Party's last contention that the printouts of the Customer Service section of the website [Exhibit C] as well as the specimens of use of the Mark at the cosmetic counter at The Bay store in Toronto [Exhibits D to F] do not establish use of the Mark in association with the services during the relevant period.

[71] At this juncture, the Requesting Party's concern as to whether Exhibits C to F pertain to the relevant period is no longer an issue, nor is its concern as to whether the evidence shows the sale of any products in Canada during the relevant period. The only issue is whether these exhibits establish use of the Mark *in association with* the services. For the reasons that follow, I find that they do.

[72] At the hearing, the Registrant pointed to the first three links under the "Product Questions" part of the Customer Service section of the website, which are reproduced below, as establishing that consumers may request consultation services in the selection and use of cosmetics, toiletries, perfumery and beauty treatment.

- How to use or apply product
- What products are best for my skin type or skin concerns?
- What color products are best for me

[73] I agree with the Registrant. Also, I have no reason to believe that these links on the Customer Service section of the website were not active during the relevant period.

[74] Furthermore, I find it is overly technical for the Requesting Party to contend that there is no association between the services and the Mark displayed on the counter sign or the aprons because there is no mention of the services either on the counter sign or the aprons. It is of note that I have previously indicated that the counter card references “Mini Facials”.

[75] Finally, for the same reasons than those discussed under the third issue arising in this proceeding, I consider that the performance of the services by dedicated sales clerks at the ORIGINS branded cosmetics counters at The Bay stores constitutes the performance of the services by the Registrant.

[76] In the end, I am satisfied that the evidence shows use of the Mark during the relevant period in Canada, within the meaning of sections 4(2) and 45 of the Act, in association with “consultation services in the selection and use of cosmetics, toiletries, perfumery and beauty treatment; providing services relating to [...] skin care facials [...]”.

### Disposition

[77] In view of all of 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, registration No. TMA617,049 will be amended to delete the following from the statement of services:

(1) [...] essential oils, aromatherapy oils and gels [...], body sponges, body brushes, soap dishes, [...] hair brushes, [...], squeeze balls, essential oil diffusers, books, pillows, [...], dog shampoo, baby skin balm, baby hair and body wash, room fresher, potpourri, fine linen wash, sachets, and stuffed animals, herbal teas; catalog sales by mail, fax and telephone of cosmetics, toiletries, perfumery, essential oils, aromatherapy oils and gels, candles, body sponges, body brushes, soap dishes, bath products, hair products, hair brushes, massage tools, squeeze balls, essential oils diffusers, books, pillows, chewing gum, dog shampoo, baby skin balm, baby hair and body wash, room fresher, fine linen wash, sachets; [...] body massages, manicures, pedicures, [...] and reflexology. (2) Retail store services featuring books, wrapping paper, notecards, notebooks, address books, memo pads, folk art made from paper, mirrors, picture frames, candle holders, wood carvings, wall hangings, baskets, wooden boxes, wall shelves, pencil holders, bowls, vessels, dishes, vases, glasses, bed covers, table covers, textile wall coverings, embroidery, napkins, placemats,

floor throws, rugs, belts, gloves, hats, purses, wallets, backpacks, boots, novelty shoes, and dolls.

[78] Accordingly, the amended statement of services will be as follow:

(1) Retail store services featuring cosmetics, toiletries and perfumery, candles, bath products, hair products, massage tools, chewing gum; consultation services in the selection and use of cosmetics, toiletries, perfumery and beauty treatment; providing services relating to skin care facials.

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Céline Tremblay  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

## **Annex**

### Statement of Services of Registration No. TMA617,049

- (1) Retail store services featuring cosmetics, toiletries and perfumery, essential oils, aromatherapy oils and gels, candles, body sponges, body brushes, soap dishes, bath products, hair products, hair brushes, massage tools, squeeze balls, essential oil diffusers, books, pillows, chewing gum, dog shampoo, baby skin balm, baby hair and body wash, room fresher, potpourri, fine linen wash, sachets, and stuffed animals, herbal teas; catalog sales by mail, fax and telephone of cosmetics, toiletries, perfumery, essential oils, aromatherapy oils and gels, candles, body sponges, body brushes, soap dishes, bath products, hair products, hair brushes, massage tools, squeeze balls, essential oils diffusers, books, pillows, chewing gum, dog shampoo, baby skin balm, baby hair and body wash, room fresher, fine linen wash, sachets; consultation services in the selection and use of cosmetics, toiletries, perfumery and beauty treatment; providing services relating to body massages, manicures, pedicures, skin care facials and reflexology.
- (2) Retail store services featuring books, wrapping paper, notecards, notebooks, address books, memo pads, folk art made from paper, mirrors, picture frames, candle holders, wood carvings, wall hangings, baskets, wooden boxes, wall shelves, pencil holders, bowls, vessels, dishes, vases, glasses, bed covers, table covers, textile wall coverings, embroidery, napkins, placemats, floor throws, rugs, belts, gloves, hats, purses, wallets, backpacks, boots, novelty shoes, and dolls.