



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

Citation: 2015 TMOB 64
Date of Decision: 2015-04-02

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Wolfie Furs Inc. against registration No.
TMA716,908 for the trade-mark Fashionista Society
Design in the name of Nygård International Partnership.**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA716,908 for the trade-mark Fashionista Society Design shown below (the Mark), owned by Nygård International Partnership.



[2] The Mark is registered for use with the following services (the Services):

Personalized shopping services, namely an exclusive on-line service whereby customers are provided with clothing and accessories specifically tailored to their personal needs and criteria.

[3] On June 25, 2013, at the request of Wolfie Furs Inc. (the Requesting Party), the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Nygård International Partnership (Nygård). The notice required Nygård to provide evidence showing that it used the Mark in Canada at any time between June 25, 2010 and June 25, 2013 (the relevant period), in association with the Services. If the Mark had not been so used,

Nygård 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.

[4] 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”. Although the criteria for establishing use are not demanding and an overabundance of evidence is not necessary, a bare statement of use of the trade-mark is not sufficient [See *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (4th) 62 (FCA)]. A recipient of a section 45 notice must put forward sufficient evidence showing how it has used the trade-mark in order that the Registrar may assess if the facts qualify as use of the trade-mark pursuant to section 4 of the Act.

[5] The definition of use with respect to services is set out in section 4(2) of the Act, which 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)].

[6] While the word “services” is not defined in the Act, services are generally granted a generous or broad interpretation [*Aird & Berlis v Virgin Enterprises Ltd* (2009), 78 CPR (4th) 306 (TMOB)], and include those services which may be considered “incidental” or “ancillary” [*Kraft Ltd v Registrar of Trade Marks* (1984), 1 CPR (3d) 457 (FCTD)]. As long as some members of the public, consumers or purchasers, receive a benefit from the activity, it is a service [*Renaud Cointreau & Co v Cordon Bleu International Ltd* (2000), 11 CPR (4th) 95 (FCTD), *aff’d*, 18 CPR (4th) 415 (FCA)].

[7] In response to the Registrar’s notice, Nygård provided the affidavit of Heather Roseborough, Nygård’s Director of Retail Marketing, together with Exhibits A through F.

[8] Only Nygård filed written submissions. Neither party requested an oral hearing.

[9] For the reasons that follow, I conclude that the registration ought to be maintained.

The Evidence

[10] In her affidavit, Ms. Roseborough indicates that Nygård is a Canadian manufacturer and distributor of fashion apparel. She states that Nygård operates a traditional bricks and mortar retail store division in Canada as well as an online retail sales division at *www.nygard.com*, the latter whereby customers can purchase clothing and accessories for delivery.

[11] Ms. Roseborough states that, during the relevant period, the Mark was used continuously in Canada in association with the Services. She explains that the Mark was developed as a means to promote online sales of Nygård's clothing and accessories, by allowing customers to actively participate in developing a wardrobe suited to their specific tastes and body type. She states that one of the manners in which the Mark has been displayed is by way of fashion blogs, to assist customers in making appropriate choices from Nygård's vast line of fashions. By way of example, she provides several online blog articles at Exhibits C, D, and E, which she states are "representative of other blog pages posted during the relevant period, showing use of the Trade-mark in a similar fashion, to promote sales of Nygård's clothing and accessories."

[12] The aforementioned blog articles are respectively entitled "*Nygård's Fashionista Society: Warm or Cool...which one are you?*", "*Build the perfect wardrobe with Nygård's Fashionista Society*", and "*Nygård's Fashionista Society: Every woman is a Jewel – which one are you?*". These articles provide customers with fashion advice such as how to build a wardrobe based on colour palette, how to build a wardrobe with a minimal number of clothing items, and how to build a wardrobe based on four differing body types/shapes. I note that in addition to prominently displaying the Mark (aside from the title), each of the articles feature specific selections of Nygård fashions that correspond with the advice being rendered. Furthermore, each of the articles provides multiple links to Nygård's website where customers can purchase the various showcased/selected fashions, or other such items based on the blog's recommendations.

[13] With respect to online sales, Ms. Roseborough attests that during the relevant period, Canadian online retail sales of fashion apparel by Nygård was on average \$2.8 million per year. A sampling of order details from nine online sales transactions to Canadian customers during the relevant period is provided at Exhibit B.

[14] Lastly, Ms. Roseborough provides at Exhibit F, a Google Analytics Graph which she attests shows that 22,505 unique visitors located in Canada visited the Nygård's online blog during the relevant period.

Analysis and Reasons for Decision

[15] Nygård submits that it clearly advertised and offered its Services under the Mark in Canada during the relevant period, as evidenced in the representative blog articles at Exhibits C through E, and the Google Analytics graph at Exhibit F. More specifically, Nygård submits that Canadian consumers, upon seeing the Mark on its blog, clicked through to Nygård's online store in order to browse and order clothing and accessories specifically tailored to their personal needs and based on the blog's recommendations.

[16] Nygård further submits that the fact that its Services appear to be provided as an integral part of its online retail sales services or as a service incidental to its principal activity does not negate the fact that the Services are being provided. Further to this, Nygård correctly submits that there is no definition of "services" in the Act, nor is the definition of a "trade-mark" so narrowly construed to suggest that services are limited to those which are not incidental or ancillary to the sale of goods; "as long as some members of the public, some consumers or purchasers, receive a benefit from the activity, it is a service" [citing *Riches, McKenzie & Herbert v Gulliver's, The Travel Accessory Store Ltd*, 2006 CanLII 80508 at 11 (TMOB); *Renaud Cointreau, supra*; and *Société Nationale des Chemins de Fer Français SNCF v Venice Simplon-Orient-Express Inc et al* (2000), 9 CPR (4th) 443 (FC)].

[17] I am satisfied that Nygård has shown use of the Mark in association with the Services in the manner required by sections 4(2) and 45 of the Act. Exhibits C through E demonstrate that a visitor to Nygård's online fashion blog is provided with a selection of clothing and accessories based on clearly defined criteria and attributes. For example, in Exhibit C, customers are given a list of criteria upon which they can classify themselves as possessing either a warm or cool colour palette. Customers are provided specific selections of clothing and accessories for each colour palette. The article then directs customers to the Nygård's retail website where customers can then purchase the recommended clothing and accessories.

[18] Similarly, in Exhibits D and E, customers are provided with criteria and attributes based upon the number of clothing items desired and body type respectively, and are provided with examples of clothing and accessories that correspond to those criteria and attributes. Ms. Roseborough attests that clicking on any link in the blog articles takes the customer to a page on Nygård's website where the customer can purchase the recommended items. Even though the customer makes the ultimate selection, the customer is provided with information, recommendations, and specifically identified selections to enable that choice. In my view, the examples in Exhibits C through E, of clothing and accessories based on personal attributes and criteria and the links to the website where customers could purchase the clothing and accessories, demonstrate that customers were "provided with clothing and accessories specifically tailored to their personal needs and criteria".

[19] The webpage traffic statistics at Exhibit F, showing the number of unique Canadian visitors to the Nygård's online blog does not demonstrate whether any of the visitors actually accessed the Services in the more narrow sense of ultimately making purchases based upon the blog's recommendations. Neither do the order details from the online sales transactions at Exhibit B.

[20] Nevertheless, Exhibits C through E demonstrate, that at the very least, the Services were available to be performed in Canada. Furthermore, given that there is some evidence that Canadians accessed Nygård's blog and could and did purchase Nygård's clothing and accessories within the relevant period, I find it reasonable to infer that at least some of Nygård's online sales were resultant of the information, advice and fashion selections on the blog which clearly featured the Mark.

[21] Lastly, although Nygård's blogs are used to promote online sales of Nygård fashions, I am satisfied that the information provided through these blogs goes beyond what would normally be considered within the expectations of a customer of an online retail store. In my view, the services actually advertised or performed by Nygård, as reflected in the statement of services, amount to more than mere advertising of Nygård's goods; there is a service employed in Nygård's fashion blogs featuring the Mark that is of benefit to the public. Accordingly, this case

is distinguishable from *Ralston Purina Canada Inc v Effem Foods Ltd* (2000), 5 CPR (4th) 398 (TMOB).

Disposition

[22] 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 the provisions of section 45 of the Act, registration No. TMA716,908 will be maintained on the register.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office