

SECTION 45 PROCEEDINGS
TRADE-MARK: FOXY ORIGINALS
REGISTRATION NO. TMA609,207

[1] On June 6, 2007, at the request of Kaufman Laramée LLP (the Requesting Party), the Registrar issued the notice prescribed by s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) to Foxy Originals Inc. (the Registrant), the registered owner of registration No. TMA609,207 for the trade-mark FOXY ORIGINALS (the Mark). The Mark is registered in association with the following wares:

- (1) Jewelry, namely necklaces, bracelets, earrings, charms, rings.
- (2) Fashion accessories, namely belts, key chains.
- (3) Hair accessories, namely hair costume jewelry.
- (4) Jewelry, namely pins, clips, broaches, pendants.
- (5) Body jewelry, namely lip rings, tongue rings, belly-button rings, temporary tattoos, eyebrow rings, anklets, toe rings.
- (6) Fashion accessories, namely purses, wallets, jewelry boxes, candles, candle holders, sunglasses, stickers, lamps, cosmetic cases sold empty, gift boxes.
- (7) Hair accessories, namely hair bows, hairpins, ponytail holders, headbands, snap pins, alligator clips.
- (8) Cosmetics, namely lipstick, lip lining pencils, lip balms, lip gloss, eye shadow, eyeliner, nail files, nail lacquer, face blusher, body and hair glitter, mascara, hair mascara.
- (9) Promotional items, namely pens, notepads, mirrors, matches, mousepads.

[2] Section 45 requires the registered owner of a trade-mark to show whether the mark has been used in Canada in association with each of the wares and services listed in the registration at any time during the three years preceding the date of the notice, in this case between June 6, 2004 and June 6, 2007. If the mark has not been used during that time period then the registered owner is required to indicate the date on which it was last used and the reason why it has not been used since that date.

The onus on a registered owner under s. 45 is not a heavy one [*Austin Nichols & Co. v. Cinnabon, Inc.* (1998), 82 C.P.R. (3d) 513 (F.C.A.)].

[3] What qualifies as use of a trade-mark is defined in s. 4 of the Act, which is reproduced below:

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

(2) 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.

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

[4] An affidavit of Jennifer A. Kluger was filed in response to the s. 45 notice. Ms. Kluger attests that she is a co-owner of the Registrant (Foxy Originals). Her affidavit is brief and the most relevant paragraphs, numbers 5-7, are reproduced below:

5. Foxy Originals has used the trade-mark FOXY ORIGINALS in the normal course of trade, during the relevant period, namely from June 6, 2004 to June 6, 2007 (the “relevant period”) and has no intention of abandoning its trade-mark in Canada. Attached as Exhibit “A” are representative labels, catalogues, invoices, and promotional materials used in association with the trade-mark FOXY ORIGINALS in Canada during the relevant period.

6. The approximate dollar value of sales in Canada of wares used in association with the FOXY ORIGINALS trade-mark from the year 2004 to date, including the relevant period are in excess of \$3,000,000,00.

7. The materials attached to this affidavit are evidence of the use by Foxy Originals of the

trade-mark FOXY ORIGINALS in the ordinary course of its business in Canada during the relevant period.

[5] Both parties filed a written argument. I am disregarding those portions of the Registrant's written argument that do not relate to the issues or evidence at hand (e.g. paragraphs 10 and 11).

[6] Both parties participated in an oral hearing.

[7] The Requesting Party's general position is that proper evidence has not been filed, that the evidence is intentionally ambiguous, that the Registrar is not obliged to review the materials provided as a clump as Exhibit "A" to determine what they are, and that the registration should be expunged. On the other hand, the Registrant's position is that the onus on the Registrant is not a heavy one, that the Mark is clearly not deadwood, that evidence with respect to each registered ware need not be provided, and that the registration should be maintained in its entirety. To that end, the Registrant has summarized the contents of Exhibit "A" in its written argument. For the reasons set out below, I have concluded that some, but not all, of the wares should be struck from the registration.

Discussion of Contents of Exhibit "A"

[8] Ms. Kluger has stated that the Mark was used in Canada during the relevant time period, but she has not stated the wares with which the Mark was used. Her exhibit must therefore be analyzed to determine which of the registered wares the Mark was used with during the relevant time period.

i) invoices

[9] Seventeen invoices have been provided dating from the relevant time period. They have been redacted to remove the name of the purchaser but the Canadian addresses of the purchasers are visible. The FOXY ORIGINALS trade-mark does not appear in the body of any of these invoices. However, on five of them, a design version of FOXY ORIGINALS appears in the upper left hand

corner, beside the Registrant's name and/or address. Use of this design version would also qualify as use of the word mark. [*Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (T.M.O.B.); *Compagnie Internationale pour l'Informatique CII Honeywell Bull v. Registrar of Trade Marks* (1985), 4 C.P.R. (3d) 523 (F.C.A.)]

[10] Typically the appearance of a trade-mark on an invoice qualifies as use in association with a ware if the mark appears in the body of the invoice and there is evidence that the invoice accompanied the wares. However here the mark at issue is more in the manner of a house mark, with various styles of the Registrant's wares having individual trade-marks, such as MONSOON and FLORA. As such, it makes sense that the Mark appears outside the body of the invoice. An abbreviation of the Mark, namely FO, is listed in the body of the invoices as the first portion of the style number of each invoiced item.

[11] As to the requirement that the invoices accompany the wares in order to give the association between the Mark and the wares at the time of transfer, it is noted that the shipping date and the issuance date of each invoice coincide. [See *Bereskin & Parr v. Star-Kist Foods Inc.* (2004), 37 C.P.R. (4th) 188 (T.M.O.B.).]

[12] The invoices that display the Mark at the top cover the following registered wares:

- necklaces, earrings (invoices 1659, 4385, 6676, 7408)
- hair accessories (barrettes) (invoice 4918)
- bracelets (invoices 1659, 7408)
- rings, brooches, pendants (invoice 1659)

ii) catalogues

[13] Exhibit "A" includes two "catalogues", namely 8 1/2 x 11 booklets of about 30 pages in length that describe the Registrant's business and contain photos of various pieces of jewelry, each with a description, price and style number. The catalogues also contain information on how to order the

offered wares by email, fax or phone.

[14] The two above-mentioned catalogues make the following references to FOXY ORIGINALS:

- Page 3, entitled “Welcome to the Foxy Originals Catalogue”, mentions how two individuals (one of whom is Ms. Kluger) “founded Foxy Originals”, states “visit www.foxyoriginals.com for care instructions”, and provides the email address sales@foxyoriginals.com for placing orders.
- Page 25, entitled “Terms & Conditions” refers a number of times to Foxy Originals but clearly as a trade-name e.g. “Upon receipt by Foxy Originals, we will promptly credit your account or replace the merchandise.”
- Page 26 advertises merchandising products for sale, including a necklace stand that displays the Mark and gift bags that display the Mark. The ad copy with respect to the gift bag reads, “Make your customers smile by completing their jewelry purchases with an adorable Foxy gift bag!” (Exhibit “A” also includes one of the advertised gift bags.)

[15] Exhibit “A” also includes three smaller “catalogues”, namely 9 x 7 booklets of four to six pages in length that promote specific lines of jewelry and contain photographs of various pieces of jewelry, with a description and style number. These catalogues also contain information on how to order the offered wares by email, fax or phone. The back page of each of these catalogues displays a design version of the Mark, essentially the same design as that which appears on the invoices.

[16] The Mark is not displayed directly on any of the jewellery offered for sale in the catalogues.

[17] The Registrant submits at paragraph 37 of its written argument, “Sales made in Canada through catalogues can demonstrate use where the Trade-mark appears on or in the catalogues used for ordering.” However, catalogues cannot on their own serve to maintain wares under s. 45; there must be evidence of sales of the individual wares during the relevant time period.

iii) labels

[18] The labels provided do not display the Mark (they display FOXY and www.foxyoriginals.com).

iv) promotional materials

[19] The “promotional materials” provided include four 3½ x 5 cards that display some jewelry. Three of these cards display the Mark, but they cannot serve to maintain any wares in the registration as they do not show use of the Mark in accordance with s. 4, given that they appear to be merely advertisements that would not satisfy the association requirement set out in s. 4.

[20] A further “promotional material” provided in Exhibit “A” is a paper gift bag. The bag displays the Mark in design form on one side (on the other side, there is a paragraph that begins, “Foxy Originals jewelry is designed with fun and flair...”). Invoice 1659 indicates that 40 bags were sold to a third party on November 24, 2004, but I am not prepared to assume that they were used to package the simultaneously-purchased jewelry in the normal course of trade, in the absence of any specific evidence to that effect. [See *Riches, McKenzie & Herbert v. Pepper King Ltd.* (2000), 8 C.P.R. (4th) 471 (F.C.T.D.).]

Closing Remarks

[21] The Requesting Party submits that it is inappropriate for the Registrar to have to review the various items in Exhibit “A”, without greater assistance from the affiant. While there may be cases where a registrant’s presentation of its evidence makes it too difficult for the Registrar to readily assess the evidence, this is not such a case. The materials provided as Exhibit “A” are not as cumbersome as the Requesting Party would have one believe and the Registrant’s written argument provides an effective summary of the various items included in the single exhibit.

[22] From Exhibit “A”, it is clear that the Registrant designs jewelry, which it sells to third parties for resale to consumers in stores and the like. Sales have not been nominal and overall I have no

difficulty concluding that the sales evidenced were in the Registrant's normal course of trade.

[23] The Registrant submits that, because there are nine categories of wares and more than fifty individual items, it need not show use in association with each of the registered wares in order to maintain the registration in its entirety. However, the fact situation before me is clearly distinguishable from that in *Saks & Co. v. Registrar of Trade Marks et al.* (1989), 24 C.P.R. (3d) 49 (F.C.T.D.). Most significantly, the affiant has not provided a general statement of use of the Mark within the relevant period in relation to each item of wares listed in the registration [see *Mendelson, Rosentzveig & Schacter v. Giorgio Beverly Hills, Inc.* (1994), 56 C.P.R. (3d) 399 (T.M.O.B.)].

[24] The evidence provided makes no reference to any of the wares listed earlier as (5), (6), (8) and (9) and so those wares will be struck from the registration. Regarding the remaining wares, any wares not covered by an invoice that displays the Mark will be struck.

Disposition

[25] Pursuant to my delegation under s. 63(3) of the Act, I find that the requirements of s. 45 have been met with respect to only some of the registered wares. The registration will therefore be restricted to the following wares, in accordance with the provisions of s. 45(5) of the Act: “jewelry, namely necklaces, bracelets, earrings, rings”, “hair accessories, namely hair costume jewelry”, and “jewelry, namely broaches, pendants”.

DATED AT TORONTO, ONTARIO THIS 26th DAY OF NOVEMBER 2009.

Jill W. Bradbury
Member
Trade-marks Opposition Board