



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

**Citation: 2014 TMOB 165**  
**Date of Decision: 2014-08-18**

**IN THE MATTER OF A SECTION 45  
PROCEEDING requested by  
Laboratoires Contapharm against  
registration No. TMA470,749 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. TMA470,749 for the trade-mark ORIGINS owned by Origins Natural Resources Inc.

[2] The wares listed in the registration are “hair care preparations namely hair conditioners and shampoos”.

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

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 wares specified in registration No. TMA470,749. 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] In this case, the use of the Mark in association with the registered wares is governed by section 4(1) of the Act, which reads:

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.

[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 19, 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, TMA554,982, TMA617,049 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 household products [para 3 of the affidavit].

[12] At paragraph 4 of her affidavit, Ms. Moradian states that the Mark has been used in Canada since at least as early as 1999 and that the Mark was used in Canada by the Registrant

during the relevant period in association with hair conditioners and shampoos (subsequently referred to collectively by the term “Wares” throughout her affidavit).

[13] As per paragraph 4 of the Moradian affidavit, I note that my use of the term “Wares” throughout is a collective reference to hair conditioners and shampoos.

[14] According to Ms. Moradian’s statements [paras 5-6 and 8 of the affidavit]:

- the Registrant uses the Mark by applying it to the Wares;
- the Wares bearing the Mark are sold in Canada via the Registrant’s e-commerce website at *www.origins.com*; and
- at the date of her affidavit, i.e. December 19, 2012, sales in Canada for the Wares bearing the Mark were approximately \$1,000 for the fiscal year July 1, 2012 to June 30, 2013.

[15] Ms. Moradian explains that separate sales figures for the Wares (as opposed to all ORIGINS products) are not available for the relevant period due to limitations in the Registrant’s database. However, based on historical sales figures for the Wares sold in the United States, Ms. Moradian states that sales figures for Canada would have been approximately \$1,000 each year during the relevant period [para 8 of the affidavit].

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

- Exhibit A consists of printouts from the Registrant’s e-commerce website. According to Ms. Moradian’s statements, the printouts depict the Wares available for sale in Canada at the date of her affidavit and are representative of the Wares bearing the Mark that were sold and shipped to Canada during the relevant period [para 5 of the affidavit].

- Exhibit B is a copy of an online shipping confirmation form for the sale and shipment of Wares bearing the Mark to a Canadian customer during the relevant period. Ms. Moradian explains that the customer's name and address have been removed for privacy reasons [para 7 of the affidavit]. I note that despite the poor quality of reproduction, I can read Toronto, ON in the part of the address which has not been removed. However, I cannot read a date.

### 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. Is there adequate evidence of use of the Mark in the normal course of trade with respect to the Wares during the relevant period?

[18] I will address each of these issues in turn.

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

[19] 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.

[20] At the hearing, the Registrant addressed the Requesting Party's contention by submitting 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 Mark appears in combination with the design of two trees, in each case the word ORIGINS is separated from the two trees by a solid bar or a line, which graphically highlights the fact that ORIGINS is a separate trade-mark.

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

[22] As a first matter, I wish to stress that the evidence does not only show the word ORIGINS in combination with the design of two trees on the Wares. Indeed, the evidence also shows the Mark, i.e. ORIGINS, displayed on the Wares with another trade-mark.

[23] 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)].

[24] 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*.

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

2. *Is there adequate evidence of use of the Mark in the normal course of trade with respect to the Wares during the relevant period?*

[26] There are two prongs to the Requesting Party's oral representations from which this issue arises.

[27] The first prong is that there is inadequate evidence of sales of the Wares during the relevant period because:

- there is no evidence that the online shipping confirmation form covers the relevant period;
- the evidence regarding Canadian sales is vague. Only *approximate* sale figures have been provided. Further, the approximate sales figures provided for the relevant period are based on US sales figures; and
- no invoices have been provided.

[28] The second prong is that the evidence does not show use of the Mark in association with the Wares because:

- the Registrant failed to evidence a transfer in or possession of the Wares during the relevant period; without such evidence, the display of the Mark on the Wares is not sufficient to evidence use of the Mark under section 4(1) of the Act; and
- the display of the Wares on the website does not evidence use of the Mark under section 4(1) of the Act.

[29] I decide this issue in favour of the Registrant as I am satisfied that the evidence provides sufficient facts to conclude that the Mark has been in use in Canada in association with the Wares during the relevant period for the reasons that follow.

[30] In my view, the Requesting Party has taken an overly technical approach in its 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.

[31] 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)].

[32] At the hearing, the Registrant replied to the Requesting Party's submissions about the online shipping confirmation form by submitting that Ms. Moradian specifically states that it is for a shipment to Canada during the relevant period. I agree.

[33] The fact that the Registrant did not provide invoices is not fatal to its case. I agree with the Registrant that the totality of the evidence is more than sufficient to permit an inference that sales of the Wares in the normal course of trade occurred during the relevant period.

[34] Indeed, in addition to the online shipping confirmation form as evidence of an actual sale, Ms. Moradian clearly states that the Wares were sold in Canada during the relevant period. The approximate Canadian sales figures provided for the relevant period, despite being "vague" as the Requesting Party submits, comprise factual information which lends support to Ms. Moradian statement. Ms. Moradian provides rationale as to why the sale figures are not precise, and explains how she approximated the Canadian sale figures. Moreover, it has been held that evidence as to use in the normal course of trade is not limited to use prior to the date of the section 45 notice [*John Labatt Ltd v Rainier Brewing Co et al* (1984) 80 CPR (2d) 228 (FCA)]. In my view, the approximate Canadian sales figures provided for July 1, 2012 to the date of the affidavit sworn December 19, 2012 lend further support that sales have occurred in the normal course of trade during the relevant period, and were continuous thereafter.

[35] Finally, Ms. Moradian clearly states that the Wares depicted on the website are representative of the Wares sold during the relevant period. The Mark is displayed on the Wares depicted on the website.

[36] 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(1) and 45 of the Act, in association with the Wares.

Disposition

[37] 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. TMA470,749 will be maintained.

---

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