



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

Citation: 2010 TMOB 218
Date of Decision: 2010-12-09

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Grafton-Fraser Inc. against registration
No. TMA438,225 for the trade-mark HARVEY
NICHOLS in the name of Harvey Nichols and Company
Limited.**

[1] At the request of Grafton-Fraser Inc. (the Requesting Party), the Registrar of Trade-marks issued a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on December 8, 2008 to Harvey Nichols and Company Limited (the Registrant), the registered owner of registration No. TMA438,225 for the trade-mark HARVEY NICHOLS (the Mark).

[2] The Mark is registered for use in association with “retail department store services” (the Services) and the following wares (the Wares):

(1) Leather and imitations of leather; skins, hides; trunks and travelling bags; bags, namely briefcases, attache cases, vanity cases, ruck sacks, shoulder bags, handbags, clutch bags, beach bags, make-up bags; suitcases, holdalls, purses (not of precious metals or coated therewith) and pocket wallets; clothing, namely raincoats, coats, outer jackets, skirts, trousers, shorts, culottes, shirts, bodysuits, blouses, tops, sweaters, cardigans, waistcoats, T-shirts, sweatshirts, jumpsuits, all-in-one suits, capes, ski pants, jodphurslippers, jeans, jean jackets, skirts suits, trouser suits, bustiers, swimsuits, bikinis, blazers, pareus, pinafores, evening dresses, cocktail dresses, leggings, camisoles, scarves, serapes, gloves, belts, lingerie, men's suits, polo tops, braces, ties, underwear, gloves, hats, caps, cufflinks; footwear, namely socks, hose, stockings, panty hose, tights, boots, shoes, slippers and sandals; belts. (2) Non-medicated toilet preparations, namely deodorants, anti-perspirants, skin creams and lotions, face creams and lotions, bubble baths, shower gels, talcum powder, aftershaves, colognes, toilet waters, sun tan creams and lotions; cosmetics, namely foundation, face powder, blusher, eye shadow, bronzing powder, eyeliner, mascara, lipstick, lip liner, nail colour, lip gloss, make-up brushes,

concealer; preparations for the hair, namely hair shampoos, hair conditioners, hair waving preparations, hair dyes and colorants, hair bleaches; non-medicated preparations for application to the skin, perfumes, eau de cologne and dentifrices. (3) Jewellery; clocks and watches, parts and fittings for all the aforesaid goods. (4) Trunks, travelling bags, briefcases, suitcases, attache cases, holdalls, handbags, shoulder bags, purses (not of precious metals or coated therewith), wallets, umbrellas; parts and fittings for all the aforesaid goods. (5) Clothing, namely raincoats, coats, outer jackets, jackets, skirts, trousers, shorts, culottes, shirts, bodysuits, blouses, tops, sweaters, cardigans, waistcoats, T-shirts, sweatshirts, jumpsuits, all-in-one suits, capes, ski pants, jodphurslippers, jeans, jean jackets, skirt suits, trouser suits, bustiers, swimsuits, bikinis, blazers, pareus, pinafores, evening dresses, cocktail dresses, leggings, camisoles, scarves, serapes, gloves, belts, tights, socks, lingerie, boots, shoes, sandals, men's suits, polo tops, braces, ties, underwear, gloves, hats, caps, cufflinks.

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares and services specified in the registration at any time within the three year period immediately preceding the date of the notice, and if not, the date when it was 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 December 8, 2005 and December 8, 2008 (the Relevant Period).

[4] The definition of “Use” is set out in s. 4 of the Act:

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.

[5] It is well established that the purpose and scope of s. 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register and as such, the evidentiary threshold that the registered owner must meet is quite low. As stated by Mr. Justice

Russell in *Performance Apparel Corp. v. Uvex Toko Canada Ltd.* (2004), 31 C.P.R. (4th) 270 (F.C.) at 282:

[...] We know that the purpose of s. 45 proceedings is to clean up the "dead wood" on the register. We know that the mere assertion by the owner that the trade mark is in use is not sufficient and that the owner must "show" how, when and where it is being used. We need sufficient evidence to be able to form an opinion under s. 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade-mark owners' business and merchandising practices.

[6] In response to the Registrar's notice, the Registrant filed the affidavit of Maninder Gill, Legal Director of Harvey Nichols and Company Limited, sworn on June 5, 2009, together with a list of Canadian suppliers as Exhibit A, screen captures from the Registrant's website, *www.harveynichols.com*, as Exhibit B and a printout from Google Analytics charting visits to that website as Exhibit C. Neither the Registrant nor the Requesting Party filed written arguments; an oral hearing was not requested.

Use with respect to the Wares

[7] In assessing whether there was use of the Wares during the Relevant Period, it is helpful to look at the following comments of Hearing Officer Savard in the case of *Sim & McBurney v. Hugo Boss AG* (1996), 67 C.P.R. (3d) 558 (T.M.O.B.):

In *Saks & Co. v. Registrar of Trade Marks* (1989), 24 C.P.R. (3d) 49 (F.C.T.D.), where the registration contained a long list of wares, the Court was satisfied that where the wares have been logically and properly categorized in the registration, there is no requirement that either direct evidence or documentary proof be furnished regarding every item in each category; however, it seems the affidavit must provide sufficient facts to permit the Registrar to conclude that the trade-mark is in use in association with each ware. Consequently, in my view, this case stands for the proposition that direct or documentary evidence may not be necessary with respect to each item of wares covered by the same category as long as it can be determined from the evidence that the trade-mark is in use with each such item and that the examples of use provided are representative only.

[8] In the present case, Mr. Gill asserts that there are "usually in the region of a dozen direct orders" for Harvey Nichols Christmas hampers from Canada each year and that Harvey Nichols

vouchers/gift certificates were purchased during the Relevant Period from consumers holding Canadian issued credit cards. However, the list of Wares does not include “Christmas hampers”, “vouchers” or “gift certificates”, nor are they among the items shown in the website screen captures attached as Exhibit B. Furthermore, there is no evidence demonstrating how the Mark was displayed in association with these goods, nor is there any evidence that the hampers were delivered in Canada by the Registrant during the Relevant Period. In view of the evidence furnished, it cannot be concluded that the sale of Christmas hampers or vouchers/gift certificates as described in the affidavit constitutes “use” of the Mark in Canada pursuant to s. 4(1) of the Act, nor can they be considered representative examples of use of the Mark with respect to any of the Wares.

Use with respect to Services

[9] Mr. Gill attests that since about 2001 the Registrant has operated a retail website, *www.harveynichols.com*, which appears to offer a wide variety of goods for sale. I note that the screen captures of this website attached as Exhibit B are all dated after the Relevant Period, namely on May 15, 2009. However, the evidence demonstrates that in 2008 there were in excess of 10,000 visits from computers with Canadian IP addresses to the *harveynichols.com* website and that 25 Canadians held Harvey Nichols credit cards and that consumers holding Canadian issued credit cards purchased Harvey Nichols gift certificates for the years 2006, 2007 and 2008. With respect to marketing materials, Mr. Gill states that during the Relevant Period, 179 people in Canada were registered to receive regular newsletter updates and marketing materials from the Registrant. Lastly, Mr. Gill attested that “... there are usually in the region of a dozen direct orders for HARVEY NICHOLS Christmas Hampers from Canada each year.”

[10] In the present case, the screen captures of the Registrant’s website do not contain any indicia that may suggest that the Services were available to consumers in Canada, such as displaying prices in Canadian dollars, including contact information in Canada or for Canadians, or displaying shipping policy and information for goods to Canada. Furthermore, there is no evidence such as invoices to demonstrate that any of the goods available via the Registrant’s website were in fact purchased or delivered in Canada during the Relevant Period. Indeed, Mr.

Gill's affidavit contains no clear statement that the Registrant offered the Services in Canada during the Relevant Period.

[11] In today's economy, it is not necessary to have a "brick and mortar" presence in Canada in order to find that retail store services were performed in Canada (*Saks, supra*, and *Law Office of Philip B. Kerr v. Face Stockholm, Ltd.* (2001), 16 C.P.R. (4th) 105 (T.M.O.B.)). Offering retail store services online through a website where the registrant delivers the goods in Canada is performance of retail store services in Canada (*Hennan Blaikie LLP v. Sports Authority Michigan, Inc.*; 2010 CarswellNat 581 (T.M.O.B.)). However, in this case, there is no evidence demonstrating that delivery of products was made by the Registrant in Canada during the Relevant Period, and consequently, I cannot conclude that the Registrant's retail store services were performed in Canada during the Relevant Period.

[12] As such, I conclude that the evidence does not demonstrate use of the Services in Canada pursuant to s. 4 and s. 45 of the Act.

Special Circumstances Justifying Non-Use

[13] As there was no evidence of use with respect to the Wares and Services, I will now consider whether there were any special circumstances justifying non-use. Determining whether special circumstances excusing non-use existed requires consideration of three criteria: the length of time during which the mark has not been in use, whether the reasons for non-use were beyond the control of the registered owner, and whether there exists a serious intention to shortly resume use (*Smart & Biggar v. Scott Paper Ltd.* (2008), 65 C.P.R. (4th) 303 (F.C.A.)).

[14] There is no evidence with regards to when the Mark was last used in Canada. Furthermore, there is no evidence pertaining to whether the reasons for non-use of the Mark were beyond the Registrant's control. Though Mr. Gill describes how the company has to be very careful in managing the expansion of their business, noting the complexities of negotiations involving the North American marketplace, the challenges in finding the right infrastructure and retail premises to operate from, and the need to provide appropriate training of staff to ensure the highest levels of customer service, none of these reasons appear to be unusual, uncommon or exceptional. Rather, the decision to refrain from use of the Mark in Canada with respect to the

Wares appears to be the “voluntary act” of the Registrant (*John Labbat Ltd v. Cotton Club Bottling Co.* (1976), 25 C.P.R. (2d) 115 at 125 (F.C.T.D.)).

[15] Finally, the Registrant does not provide any evidence with regards to its intention to resume use of the Mark in the future. Specifically, the Registrant provides no timeline for resumption of use, nor any evidence of concrete next steps that would assist in determining whether the Registrant has a serious intention to shortly resume use. As such, I conclude that the Registrant has not demonstrated special circumstances to justify non-use of the Mark.

[16] Consequently, I am not satisfied that there was use of the Mark with respect to the Wares or Services within the meaning of s. 45 and s. 4 of the Act during the Relevant Period, there being no special circumstances to justify such non-use.

[17] Accordingly, pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be expunged in compliance with the provisions of s. 45 of the Act.

Darlene Carreau
Chairperson
Trade-marks Opposition Board
Canadian Intellectual Property Office