



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

Citation: 2014 TMOB 166
Date of Decision: 2014-08-18

**IN THE MATTER OF A SECTION 45
PROCEEDING requested by
Laboratoires Contapharm against
registration No. TMA554,982 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. TMA554,982 for the trade-mark ORIGINS owned by Origins Natural Resources Inc.
- [2] The services listed in the registration are “beauty and consultation services”.
- [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 services specified in registration No. TMA554,982. 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, TMA617,049 and TMA 671,380.

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] Ms. Moradian states that the Mark appears on the product and product packaging of “all ORIGINS products sold in Canada”. She files coloured images for a variety of ORIGIN products and product packaging. These are representative of the manner in which the Mark has been used in Canada in association with the Registrant’s products during the relevant period [para 6 and Exhibit B of the affidavit].

[13] According to Ms. Moradian’s statements, the Mark has been used in Canada since at least as early as 1999 in association with beauty and consultation services (the Services). Ms. Moradian states that the Mark was used in Canada by the Registrant during the relevant period in association the Services [para 4 of the affidavit].

[14] Ms. Moradian explains that the Services are rendered in conjunction with the sale of the Registrant’s products in Canada via the Registrant’s e-commerce website and at ORIGINS branded cosmetic counters at The Bay stores and Sephora stores [paras 4 and 7 of the affidavit]. The Registrant does not charge customers separately for the Services. The cost associated with providing the Services is considered overhead and incorporated into the retail pricing of the ORIGINS products [para 11 of the affidavit].

[15] Ms. Moradian provides a yearly breakdown of the Canadian retail and online sales figures for the fiscal years 2009 to 2012 (July 1 to June 30). During that period, retail sales in Canada of products bearing the Mark were in excess of US\$10 million and online sales to customers in Canada were in excess of CAD\$900,000 [paras 11-12 of the affidavit].

[16] I shall now review, in turn, the remainder of the evidence pertaining to the use of the Mark in association with the Services via the Registrant’s website and at ORIGINS branded cosmetic counters.

a) Evidence of use of the Mark via the Registrant’s website

[17] According to Ms. Moradian’s statements [para 8 of the affidavit]:

- the Registrant has operated its website, at *www.origins.com*, since at least as early as 1999. The Mark appears on every page of the website;

- products, such as cosmetics, toiletries, perfumery, bath products and candles may be ordered online from the Registrant's website and shipped to Canada;
- in the Customer Service section of the website, consumers may request beauty and consultation services in the form of information on the selection and use of the Registrant's products, colour suggestions, beauty treatment and product use suggestions; and
- 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.

[18] The following documentary evidence is filed by Ms. Moradian in support of her statements regarding the use of the Mark in association with the Services via the Registrant's website:

- printouts from the Registrant's e-commerce website that depict the products available for sale in Canada at the date of the Moradian affidavit. These are representative of the products bearing the Mark and sold in Canada during the relevant period [para 5 and Exhibit A of the affidavit]; and
- printouts from the Registrant's website displaying the Mark. These are representative of how the Mark has been used in Canada in association with the Services during the relevant period in the Customer Service section of the website [para 8 and Exhibit C of the affidavit].

b) Evidence of use of the Mark at ORIGINS branded cosmetic counters

[19] According to Ms. Moradian's statements [paras 9-10 of the affidavit]:

- the Registrant provides retail store services for the sale of cosmetics, toiletries, perfumery, bath products and candles at ORIGINS branded cosmetic counters at The Bay stores. The Registrant has operated ORIGINS branded counters in Canada since 2003;

- the Services, including information on product use and selection, mini facials, colour consultation and skin care consultation, are provided by dedicated sales clerks at the cosmetic counters; and
- signage bearing the Mark is displayed at the cosmetic counters and the sales clerks wear apparel bearing the Mark. Counter cards and brochures regarding the Services provided in association with the Mark are also available at the counters.

[20] Ms. Moradian files the following specimens of use of the Mark at the cosmetic counter at The Bay on Queen Street, in Toronto, at the date of her affidavit:

- 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, which according to Ms. Moradian’s statement displays products bearing the Mark and offers customers mini facials [Exhibit F]. 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 at the ORIGINS branded counters in Canada during the relevant period [paras 9-10 of the affidavit].

Analysis of the Issues

[21] 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 performance of the Services in conjunction with the sale of the Registrant’s products amount to the performance of services in Canada?
3. Is there adequate evidence of use of the Mark by the Registrant during the relevant period in association with the Services?

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

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

[23] 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.

[24] 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].

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

[26] 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.

[27] 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)].

[28] 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*.

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

2. *Does the performance of the Services in conjunction with the sale of the Registrant's products amount to the performance of services in Canada?*

[30] This issue arises from the Requesting Party's submissions revolving around the facts that the Services are provided free of charge and in conjunction with the sale of the Registrant's ORIGINS products.

[31] 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.

[32] 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 are provided. 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 [*Venice Simplon-Orient-Express, Inc v Société Nationale des Chemins de Fer Français SNCF* (2000), 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)].

[33] 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.]

[34] This leads me to turn to the Requesting Party's contention that the evidence does not show the sale of the Registrant's products in Canada during the relevant period, and thus the evidence does not establish use of the Mark in association with the Services *provided in conjunction with the sale of the products*.

[35] The Requesting Party essentially contends that the evidence does not show the sale of the Registrant's products in Canada during the relevant period because:

- (i) no invoices have been provided to evidence sales of the Registrant's products via its e-commerce website or at cosmetic counters; and
- (ii) there is no evidence of delivery of products purchased via the website.

[36] I disagree with the Requesting Party's contention for the reasons that follow.

[37] Ms. Moradian clearly states that the products depicted on the e-commerce website printouts are representative of the Registrant's products sold in Canada during the relevant period [Exhibit A]. Likewise, she clearly states that the photograph of the counter sign at the cosmetic counter at The Bay Store in Toronto is representative of signage at the ORIGINS branded counters in Canada during the relevant period [Exhibit D].

[38] The fact that the Registrant did not provide invoices showing sales in Canada is not fatal. The Canadian retail sales and online sales figures provided for the fiscal years 2009 to 2012 consist of factual information which lends support to M. Moradian's statements as to the sale of the Registrant's products in Canada during the relevant period. I would add that the e-commerce website printouts show prices in Canadian dollars. Likewise, they clearly show that the Registrant's products can be purchased online. In addition to the mention of "checkout" displayed at the bottom right corner of the pages, the mention of "FREE shipping with any purchase" is displayed at the bottom left corner.

[39] In the end, I find that the totality of the evidence is more than sufficient to show the sale of the Registrant's products in Canada via its e-commerce website and at ORIGINS branded cosmetic counters during the relevant period. In any event, I would add that all that was required from the Registrant was to show that it was willing and able to sell its products in Canada during the relevant period. In this case, the Registrant succeeds with both showing that it was willing and able to sell its products in Canada, and did indeed sell its products.

[40] Thus, I shall now address the Requesting Party's alternate contention that the evidence does not show use of the Mark by the Registrant in association with the Services during the relevant period under section 4(2) of the Act.

3. Is there adequate evidence of use of the Mark by the Registrant during the relevant period in association with the Services?

[41] Based on my understanding of the Requesting Party's oral representations, it essentially submits 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 [Exhibits D to F] do not establish use of the Mark in association with the Services during the relevant period.

[42] 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)].

[43] In my view, the Requesting Party has taken 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.

[44] For the reasons that follow, considering the evidence as a whole, I am satisfied that the exhibits challenged by the Requesting Party are more than sufficient to support Ms. Moradian's statements that the Mark has been used in Canada by the Registrant in association with the Services during the relevant period.

a) Exhibit C - Customer Service section of the website

[45] At the hearing, the Registrant pointed to the first three links under the “Product Questions” part of the Customer Service section of the website as evidence of use of the Mark in the performance and advertisement of the Services. These three links read as follows:

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

[46] The Registrant submitted that these links show that consumers may request beauty and consultation services in the form of information on product use and selection, colour consultation and skin care consultation. I agree. 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.

[47] Furthermore, the Mark is clearly displayed at the top of the Customer Service section of the website pages. Ms. Moradian clearly states that the printouts of the website are representative of the manner in which the Mark has been used in Canada in association with the Services during the relevant period. Since 2010, Canadian visitors to the website have totaled over 100,000 each year.

b) Exhibits D to F - ORIGINS cosmetic counters

[48] I disagree with the Requesting Party’s submissions that it cannot be concluded that the specimens of use of the Mark at the cosmetic counter at The Bay store, in Toronto, pertain to the relevant period. Ms. Moradian clearly states that these are representative of signage, apparel worn by sales clerks, and counter cards used at ORIGINS branded counters in Canada during the relevant period.

[49] 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. I would add that I have previously indicated that the counter card references “Mini Facials”.

[50] This leads me to turn to the Requesting Party's alternate submission that the Services performed at the ORIGINS cosmetic counters were performed by The Bay stores, not by the Registrant.

[51] In my view, The Bay stores merely acted as intermediaries providing the Services to the ultimate Canadian consumers. Thus, the performance of the Services by dedicated sales clerks at the ORIGINS branded cosmetics counters at The Bay stores constituted the performance of the 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.]

[52] 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 the Services.

Disposition

[53] 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. TMA554,982 will be maintained.

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