



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

**Citation: 2014 TMOB 164**  
**Date of Decision: 2014-08-18**

**IN THE MATTER OF A SECTION 45  
PROCEEDING requested by  
Laboratoires Contapharm against  
registration No. TMA466,901 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. TMA466,901 for the trade-mark ORIGINS owned by Origins Natural Resources Inc.

[2] The wares listed in the registration are essentially cosmetic products, skin care products and body care products. The statement of wares of the registration is entirely reproduced in annex.

[3] For the reasons that follow, I conclude that the registration ought to be amended to delete the wares “essential oils”.

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. TMA466,901. 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 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. TMA470,749, TMA554,982, TMA617,049 and TMA671,380.

### The Evidence

[11] At paragraph 4 of her affidavit, Ms. Moradian states that the Mark has been used in Canada since at least as early as 1999 in association with a full line of personal care products

including cosmetic products, skin and body care products, perfumery and candles. Ms. Moradian goes on to state that these products include the following wares (subsequently referred to collectively by the term “Wares” throughout her affidavit) in association with which the Mark was used in Canada by the Registrant during the relevant period:

soaps, body lotions and body powders, cosmetics and make-up for lips, namely lipstick, lip gloss and lip pencil, cosmetics and make-up for the face namely, face make-up, pressed powder, loose powder, and blushers, and make-up for the eyes namely, eye shadow, mascara and brow pencil, face and body moisturizers and nourishing and repairing treatments namely face and body gels, facial cleansers, toners and exfoliants, toilet soap, bath oils, bath powder, bath additives, tanning products, namely, creams and lotions to promote natural and artificial tanning; skin creams and lotions, sun care products, namely, sunscreens and creams and lotions to relieve the burning effects of the sun.

[12] As per paragraph 4 of the Moradian affidavit, I note that my use of the term “Wares” throughout is a collective reference to the above-identified wares.

[13] According to Ms. Moradian’s statements [paras 5-6 and 9-11 of the affidavit]:

- the Registrant uses the Mark in association with the Wares by applying the Mark to the product and to product packaging;
- the Wares bearing the Mark are sold in Canada:
  - by the Registrant via an e-commerce website at *www.origins.com*;
  - at ORIGINS branded cosmetic counters at The Bay stores;
  - at Sephora stores; and
  - by The Bay via its e-commerce website at *www.thebay.com*; and
- from 2009 to 2012, sales “in Canada of Wares” bearing the Mark were in excess of US\$10 million. During the same period, e-commerce sales from the *origins.com* website “with delivery to customers in Canada of Wares bearing the [Mark]” were in excess of CAD\$900,000. I note that in both cases, Ms. Moradian furnished a breakdown of the sales figures by fiscal year, i.e. July 1 to June 30.

[14] I now turn to the review of Exhibits A to E 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 coloured images of a variety of products and product packaging for products associated with the Mark, namely, moisturizer, skin cream, face serum, skin treatment gel, eye cream, eye treatment cream, self-tanner, eye shadow, lip gloss and concealer. Ms. Moradian states that these are representative of the manner in which the Mark has been used in Canada for the Wares during the relevant period [para 5 of the affidavit].
- Exhibit B consists of printouts from the Registrant's e-commerce website, *www.origins.com*. 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 sold in Canada during the relevant period in association with the Mark [para 7 of the affidavit].
- Exhibit C is a copy of the Spring 2012 Order Form listing the ORIGINS products available for sale in Canada at the date of the affidavit. The suggested retail prices, in Canadian and US dollars, have been redacted as confidential information. Ms. Moradian states that all the listed products were sold or available for sale in Canada during the relevant period [para 8 of the affidavit].
- Exhibit D consists of printouts from the e-commerce website of The Bay showing products bearing the Mark sold on the website at the date of the affidavit. Ms. Moradian states that these are representative of the Wares sold in Canada by The Bay during the relevant period [para 9 of the affidavit].
- Exhibit E consists of copies of co-operative advertising conducted with The Bay, namely mailers sent during the fiscal year 2012 (July 1, 2011 to June 30, 2012), and representative of mailers distributed in Canada during the relevant period [para 13 of the affidavit].

[15] I note that the Registrant in its written representations provides a table establishing a nexus between the Wares and the products/product packaging depicted in Exhibits A and B and/or the products listed on the order form filed as Exhibit C.

### Analysis of the Issues

[16] 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 evidence show use of the Mark in association with *each* of the registered wares?
3. Is there adequate evidence of use of the Mark in the normal course of trade with respect to the Wares during the relevant period?

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

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

[18] 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.

[19] At the hearing, the Registrant addressed the Requesting Party's contention by relying on its written representations 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.

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

[21] As a first matter, I wish to stress that the word ORIGINS in combination with the design of two trees appears on *some* of the Wares or packaging. Indeed, the evidence also shows use of the Mark, i.e. ORIGINS, by itself or with another trade-mark for some of the Wares.

[22] 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 Internationale 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)].

[23] 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*.

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

2. *Does the evidence show use of the Mark in association with each of the registered wares?*

[25] This issue arises from the Requesting Party's submissions that the Moradian affidavit does not provide any evidence with respect to the registered wares "essential oils". I note that "essential oils" are the only registered wares that are not identified at paragraph 4 of the Moradian affidavit [see paragraph 11 of my decision].

[26] The issue can be summarily decided in favour of the Requesting Party. Indeed, the Registrant conceded at the hearing that its evidence does not show use of the Mark in Canada during the relevant period in association with "essential oils". Furthermore, the Registrant has

not evidenced circumstances justifying the absence of use of the Mark in association with these wares.

[27] Accordingly, the wares “essential oils” will be deleted from the registration.

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

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

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

- no invoices have been provided;
- providing sales figures in US dollars results in an ambiguity as to whether these figures relate to sales in Canada;
- the printouts of the e-commerce websites do not evidence that the Wares could be purchased from these websites during the relevant period, nor is there evidence that the printouts of The Bay e-commerce website pertain to the relevant period;
- no evidence of sales via the e-commerce websites of the Registrant and The Bay has been provided, nor has evidence of delivery of products purchased via these websites; and
- the Spring 2012 Order Form does not evidence sales of the Wares. Also, it may not serve as evidence for the relevant period. Since springtime extends beyond the end of the month of May, it could be that sales of any of the listed products would have occurred after May 30, 2012.

[30] 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 products or packaging is not sufficient to evidence use of the Mark under section 4(1) of the Act;
- the display of the Wares on the websites does not evidence use of the Mark under section 4(1) of the Act;
- the mailers are advertising material that may not serve as evidence of use of a trade-mark in association with wares; and
- the Spring 2012 Order Form does not provide the required notice of association between the Mark and the Wares.

[31] 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.

[32] I note that while I have strived to reflect all of the Requesting Party's oral representations, I do not consider it is necessary to address each of them specifically. Indeed, 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.

[33] 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)].

[34] The fact that the Registrant did not provide invoices is not fatal to its case. Also, even though sale figures have been provided in US dollars, it is clearly stated by Ms. Moradian that the amount of US\$10 million pertains to sales in Canada. In addition, the e-commerce sale figures of CAD\$900,000 provided by Ms. Moradian corroborate her statement concerning sales



of the Wares via the Registrant's e-commerce website during the relevant period. I would add that the printouts of the Registrant's e-commerce website show prices in Canadian dollars.

[35] At the hearing, the Registrant replied to the Requesting Party's submissions about the 2012 Spring Order Form by submitting that it may serve as evidence corroborating Ms. Moradian's statements concerning sales of the Wares in Canada during the relevant period. I agree.

[36] I also agree with the Registrant that Ms. Moradian clearly and specifically states that the Mark has been used in Canada during the relevant period in association with all of the Wares. Furthermore, exhibits to the Moradian affidavit show the Mark displayed on products or on their packaging. Ms. Moradian clearly states that the coloured images of products and product packaging filed as Exhibit A to her affidavit are representative of the manner in which the Mark has been used in Canada for the Wares during the relevant period. Ms. Moradian also clearly states that the products depicted on the e-commerce websites are representative of the Wares sold during the relevant period.

[37] 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

[38] 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. TMA466,901 will be amended to delete the wares "essential oils" from the statement of wares.

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

## **Annex**

### Statement of Wares of Registration No. TMA466,901

Soaps, body lotions and body powders; cosmetics and make-up for lips, namely lipstick, lip gloss and lip pencil, cosmetics and make-up for the face namely, face make-up, pressed powder, loose powder, and blushers, and make-up for the eyes namely, eye shadow, mascara and brow pencil, face and body moisturizers and nourishing and repairing treatments namely face and body gels, facial cleansers, toners and exfoliants, toilet soap, bath oils, bath powder, essential oils, bath additives; tanning products, namely, creams and lotions to promote natural and artificial tanning; skin creams and lotions; sun care products, namely, sunscreens and creams and lotions to relieve the burning effects of the sun.