



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 055

**Date of Decision:** 2023-03-28

## **IN THE MATTER OF A SECTION 45 PROCEEDING**

**Requesting Party:** Faskin Martineau DuMoulin, LLP

**Registered Owner:** Nelusha McDonald

**Registration:** TMA843,688 for Kitschy Chic Couture

### **INTRODUCTION**

[1] At the request of Faskin Martineau DuMoulin, LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to Nelusha McDonald (the Owner), the owner of registration No. TMA843,688 for the trademark Kitschy Chic Couture (the Mark).

[2] The Mark is registered for the following goods:

Casual clothing and fabric accessories for women and children namely dresses, skirts, pants, shirts blouses, aprons, handbags and totebags.

[3] The notice required the Owner to furnish evidence to show whether she had used the Mark, in association with the Goods, during the three-year period immediately preceding the date of the notice and if not, the date the Mark was last used along with

the reason for non-use since that date. As the notice issued on December 10, 2021, the relevant period is December 10, 2018 to December 10, 2021 (Relevant Period).

[4] The pertinent definitions of use of a trademark, set out in the Act, are as follows:

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

4(3) A trademark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

[5] If the owner is unable to show “use” the registration is liable to be expunged, unless there are special circumstances to excuse non-use.

[6] For the reasons that follow, I conclude that the registration ought to be expunged.

[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 removing “deadwood” from the register. As such, the Owner’s evidentiary threshold is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448 at para 38]. Evidentiary “overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at para 3]. However, mere assertions of use will not suffice, rather the Owner must provide sufficient facts to permit the conclusion that the Mark has been used, during the Relevant Period, in association with each of the goods listed in the registration [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 at 235 (FCA) and *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. The Registrar must be able to rely on an inference from proven facts, rather than on speculation, to satisfy every element required by the Act [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184, at para 11].

[8] In response to the Registrar's notice, the Owner furnished an affidavit in her own name sworn on January 20, 2022. Only the Requesting Party submitted written representations. No hearing was held.

### **Evidence**

[9] In her affidavit, Ms. McDonald states that she has been using the Mark since August 2012 and that she continues to use the Mark "consistently" in association with handmade goods (para 1).

[10] Ms. McDonald describes her business as an on-line shop named KitschyChicCouture, operating through the Etsy e-commerce platform at *www.etsy.com/ca/shop/KitschyChicCouture*. She states that her business has been open and active since 2011 and that every product sold is labelled and includes a Kitschy Chic Couture business card (para 2).

[11] Ms. McDonald explains that she uses the Mark to brand casual clothing and accessories she makes and sells. She explains that the items are handcrafted, therefore all items might not be available at once. However, she says that these have all been "active items" within the past 3 years (para 3). In support, she provides screenshots taken from her e-commerce webpages (Exhibit 3(a, b and c)). She also includes screenshots of her Instagram and Facebook pages (Exhibit 6 (a and b)) as well as a listing of results of Google search results relating to Kitschy Chic Couture (Exhibit 7(a and b)).

[12] Without being specific as to dates, Ms. McDonald states that she uses the Mark to represent her clothing, fabric, leather and vegan leather accessories through business cards, labels and banners when attending arts and craft shows (para 4). Ms. McDonald does not indicate whether these events involved sales of goods, or were merely promotional in nature. While she says, "Evidence of business card, label enclosed", I note these materials are not part of the evidentiary record.

## **ANALYSIS AND REASON FOR DECISION**

[13] As a preliminary matter, I note that at least some of the captured webpages provided by the Owner as evidence appear to post-date the Relevant Period (see, for example, the first page of Exhibit 3(a) indicating a “last update” on December 21, 2021). However, even if I infer that the webpage materials are representative of the websites as they existed during the Relevant Period, for the reasons set out below I find that the evidence does not show use of the Mark in Canada during the Relevant Period.

### ***Dresses, Skirts, Pants and Aprons***

[14] As the Requesting Party notes, nowhere in the affidavit or exhibits does the Owner reference, or does the evidence depict, the goods dresses, skirts, pants and aprons.

[15] While Ms. McDonald references use of the Mark in association with “handmade goods” (para 1) and “casual clothing and accessories” (para 3), I am unable to identify specific evidence relating to sale of “dresses”, “skirts”, “pants”, and “aprons”. At a minimum, I am not satisfied that the evidence shows transfers of these goods at any time. Accordingly, I find that the Owner has not demonstrated use of the Mark in association with “casual clothing and fabric accessories for women and children, namely dresses, skirts, pants and aprons” within the meaning of sections 4 and 45 of the Act.

### ***Shirts and Blouses***

[16] The Requesting Party notes in its written representations, the evidence comprises general, rather than specific, statements of use in respect of articles of clothing and images from the Owner’s e-commerce website (see McDonald affidavit, para 3 and Requesting Party’s Written Representations, paras 29 and 30). I agree it is not clear whether the casual clothing and accessories Ms. McDonald claims to sell includes shirts and blouses specifically.

[17] While Ms. McDonald states that every “product” sold is labeled (McDonald affidavit, para 2), there is no evidence showing the manner of use of the Mark as it was applied directly to shirts and blouses, or their packaging.

[18] The appearance of a trademark on business cards accompanying a purchase, has been held to provide the requisite notice of association between trademark and goods [see, for example, *Robinson Sheppard Shapiro SENCRL/LLP v Ineat Canada Inc*, 2019 TMOB 64]. However, while the Owner's states that the Mark appears on business cards (McDonald affidavit, paras 1 and 2), she has not provided an example of such a card that would permit an assessment of whether the Mark was used in association with the shirts and blouses the cards accompanied. Knowing the precise manner of use is particularly important since, as argued by the Requesting Party, the evidence suggests that at times the Mark was also used as a trade name (para 46), or in a form that did not include a portion of the Mark, namely "Couture" (para 34).

[19] Affixing the trademark to goods or packaging or having it appear on business cards that accompany the goods are, of course, not the only means of satisfying the requirements of section 4 of the Act. Display of a trademark on a website through which a purchaser can order goods has also been found to be use of that trademark [see *Fraser Milner Casgrain LLP v LG Electronics Inc* 2014 TMOB 232 at paras 21 to 22 and *Law Office of Philip B Kerr v Face Stockholm Ltd* (2002), 16 CPR (4th) 105 (TMOB)]. The question is whether sufficient facts can be drawn from evidence to allow the Registrar to form an opinion of, or logically infer, use of the Mark within the meaning of section 4 of the Act [*Guido Berlucchi & C SRL v Brouillette Kosie Prince*, 2007 FC 245 at para 18].

[20] Assuming the materials in evidence are representative of the Owner's e-commerce website during the Relevant Period, a number of shirts and blouses appear to be listed for sale (McDonald affidavit, Exhibit 3(b)). I note the Mark appears at the top of the first page of the website and also in conjunction with some, but not all, product listings. I further note Ms. McDonald identifies the e-commerce site as the means through which sales are made (paras 2 and 3). As mentioned above, the evidence includes "sold listings" (handwritten notation on Exhibit 3(c)) and the "shop listing" information shows "203 sales" (Exhibit 3(b) first page). However in the absence of evidence of one or more transfers of "shirts", or of "blouses", in Canada, during the Relevant Period, I am not satisfied that the Owner has demonstrated use of the Mark in

association with casual “clothing and fabric accessories for women and children namely shirts and blouses” within the meaning of sections 4 and 45 of the Act.

[21] I also note that while copies of the Owner’s Instagram and Facebook pages have been included in evidence, there is no indication that any goods were transferred via these sites (paras 5 and 6 and Exhibits 5(a) and (b) and 6(a) and (b)). As pointed out by the Requesting Party (para 63), appearance of a trademark on advertising and promotional material is not use in association with goods unless those materials are provided to purchasers at the time of transfer of the property in or possession of the goods [See *BMW Canada Inc v Nissan Canada Inc*, 2007 FCA 255].

### ***Handbags and Tote Bags***

[22] With respect to the goods “casual clothing and fabric accessories for women and children, namely handbags and totebags”, the Owner’s “sold listings” (Exhibit 3(c)) include a few sales of these goods in Canada. However, as noted by the Requesting party, there is nothing in evidence to show how the handbags and tote bags were labelled or marked (para 42). Also absent are representations showing the manner in which the Mark might have appeared in conjunction with handbags and tote bags offered for sale at the Owner’s e-commerce platform. The Owner has not provided sufficient factual evidence to enable me to conclude that the Mark has been used in association with “casual clothing and fabric accessories for women and children namely handbags and tote bags”.

### ***Trademark Use Through Export***

[23] Several of the Owner’s sales of tote bags and handbags were to purchasers outside Canada. In the absence of representations from the Owner regarding use of the Mark through export, I agree with the Requesting Party that the Owner has not evidenced use of the Mark on the goods or any packaging of the handbags and totebags as would be required by section 4(3) of the Act (para 57).

**DISPOSITION**

[24] 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 the provisions of section 45 of the Act, the registration will be expunged in its entirety.

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Coleen Morrison  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** No hearing held

## **AGENTS OF RECORD**

**For the Requesting Party:** Fasken Martineau Dumoulin, LLP

**For the Registered Owner:** No agent appointed