



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 031

Date of Decision: 2024-02-26

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: EPO Fashion Co., Ltd.

Registered Owner: Marriott International, Inc.

Registration: TMA1,048,773 for EDITION Logo

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA1,048,773 for the trademark EDITION Logo (the Mark), owned by Marriott International, Inc. (the Owner), and shown below:



[2] For the reasons that follow, I conclude that the registration ought to be amended.

THE RECORD

[3] At the request of EPO Fashion Co., Ltd. (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on November 14, 2022. The notice required the Owner to show whether the Mark had been used in Canada in association with each of the goods 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 November 14, 2019, to November 14, 2022.

[4] The Mark is registered for use in association with the following goods and services:

GOODS

- (1) Personal care products, namely soap, shampoo, conditioner, body lotion and shower gel.
- (2) Scented candles.
- (3) Compact discs featuring music.
- (4) Carry-all bags; umbrellas
- (5) Hats; t-shirts.
- (6) Beer.

SERVICES

- (1) Catalogue retail services and online retail services, namely online sales of jewellery, clothing and gifts, namely body care preparations, hair care preparations, and skin care preparations, publications, furniture, housewares, namely household containers and utensils, textile fabrics, clothing, footwear, headwear, sports equipment, online sales of sporting goods; business centre services, namely, providing access to the Internet and to facsimile machines and telephones, mail sorting, handling and receiving, and photocopying services; rental of fitness equipment; lease-purchase financing.

(2) Business management services, namely management and operation of hotels, restaurants, night clubs, bars, spas, recreational and fitness facilities, retail gift shops, souvenir stores and convenience stores, and meeting facilities for others; retail store services, namely convenience store services; business administration services; planning business meetings for others; providing conference rooms.

(3) Business management services in the field of condominiums and apartment buildings.

(4) Real estate services, namely, listing, brokerage, leasing and management of apartments and condominium residential units.

(5) Health club services, namely providing instruction and consultation in the field of physical exercise; providing gymnasiums and health clubs; hotel services, namely arranging educational and entertainment conferences, and organization of exhibitions for cultural or educational purposes for hotel clients; providing facilities for recreation activities, namely bicycling, golf, swimming, water polo, canoeing, kayaking, paddle boarding, water skiing, snorkelling and scuba diving, horseback riding, skiing, beach access.

(6) Hotel services; restaurant, catering, bar and cocktail lounge services; provision of exhibition facilities in hotels and provision of meeting rooms, conference, convention, banquet hall facilities.

(7) Reservations services for hotel accommodations.

(8) Hotel services, namely gift shops and souvenir stores provided in hotels.

(9) Spa services, namely providing facial, skin, body and hair treatments, manicure and pedicure services, massage services, body waxing services for the human body, and beauty salon services.

[5] The relevant definitions of use in the present case are set out in section 4 of the Act 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.

(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[6] It is well accepted that the threshold for establishing use in these proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)]. However, sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trademark in association with each of the goods and services specified in the registration during the relevant period.

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Kathleen Oberg, the CFO and EVP, Development of the Owner, sworn on June 15, 2023. Both parties filed written representations; no oral hearing was held.

EVIDENCE

[8] Ms. Oberg states that the Owner has been operating EDITION luxury hotels since 2010, and that there were between ten and fifteen such hotels worldwide during the relevant period, including in the United States, Europe, the Middle East, and the Asia-Pacific region; however, no EDITION hotels operated in Canada during the relevant period.

[9] Ms. Oberg states that the Mark is used in Canada in association with a variety of goods and services, including personal care products (including soap, shampoo, conditioner, body lotion, and shower gel), candles, and clothing, as well as online retail services offering clothing and gifts, body, hair, and skin care preparations, publications, furniture, housewares (including containers and utensils), textile fabrics, clothing, and sports equipment, as well as reservation services for hotel accommodations.

[10] As Exhibit B to her affidavit, Ms. Oberg attaches screenshots of the Owner's *shopedition.com* website, including pages dated in 2023 as well as archived pages dated in November and December 2020 by way of the Internet Archive. The Mark is displayed on the home screen of the website and on the footers of the various pages, as well as on certain goods. She confirms that these screenshots are representative of how the pages appeared during the relevant period. The webpages show a number of

goods offered for sale, some of which display the Mark. As Exhibit C, she attaches a spreadsheet showing products which were ordered from the *shopedition.com* website and shipped to Canadian addresses.

[11] As Exhibits D and E to her affidavit, Ms. Oberg attaches screenshots from the Owner's *editionhotels.com* website, including pages dated in 2023 as well as archived pages dated in 2020 by way of the Internet Archive. The pages include the Mark displayed prominently above a list of locations and a button marked "RESERVE". She confirms that these pages are representative of how the Mark has been promoted on this website since at least 2011, including during the relevant period. She states that throughout the relevant period, Canadians were able to reserve hotel accommodations online through this website, and that the website generated a considerable amount of Canadian traffic. Finally, as Exhibit F to her affidavit, she attaches a number of screenshots from the Owner's social media pages promoting the Owner's goods and services in association with the Mark.

ANALYSIS

[12] In its written representations, the Owner defines its "Goods" as including registered goods (1), "Personal care products, namely soap, shampoo, conditioner, body lotion and shower gel", and goods (2) "Scented candles", but not (3) through (6). Similarly, it defines its "Hotel Services" as including "hotel services" (from services (6) in the registration) and "Reservations services for hotel accommodations" (listed as services (7) in the registration), and its "Retail services" as "Catalogue retail services and online retail services, namely online sales of clothing and gifts, namely body care preparations, hair care preparations, and skin care preparations, publications, furniture, housewares, namely household containers, textile fabrics, clothing, sports equipment, online sales of sporting goods" (from services (1) in the registration).

[13] The Owner does not claim that it sold any of the following goods or services during the relevant period:

- Goods (3), (4), (5), or (6);

- Services (2), (3), (4), (5), (8), or (9);
- Any of the following services listed in services (1): “[...] jewellery, [...] and utensils, [...] footwear, headwear, [...] business centre services, namely, providing access to the Internet and to facsimile machines and telephones, mail sorting, handling and receiving, and photocopying services; rental of fitness equipment; lease-purchase financing.”
- Any of the following services listed in services (6): “restaurant, catering, bar and cocktail lounge services; provision of exhibition facilities in hotels and provision of meeting rooms, conference, convention, banquet hall facilities.”

[14] As the Owner has not claim that there were any special circumstances which would excuse non-use, the registration will be amended to delete these goods and services.

[15] Because a requesting party’s written representations are filed before those of a registered owner in a section 45 proceeding, many of the Requesting Party’s submissions refer to goods and services which are no longer at issue in this proceeding in view of the foregoing. In general, with respect to the registered goods, the Requesting Party submits that the Exhibit C spreadsheet is not equivalent to an invoice, and that it does not show every step of a commercial transaction in the way an invoice would. However, I find that Ms. Oberg has clearly explained the Owner’s normal course of trade, in which customers order the Owner’s goods through its *shopedition.com* website, and such goods are then shipped to the customer’s address. As such, I accept that the listings in the spreadsheet reflect bona fide commercial transactions in the normal course of trade.

[16] Among the goods listed in the spreadsheet as having been purchased by a customer with a Canadian address during the relevant period are “Soap”, “Shampoo”, “Conditioner”, “Body Lotion”, “Shower Gel”, and “Candle”. As representative images of each of these goods are shown in Exhibit B as displaying the Mark, I am satisfied that the Owner has shown use of the Mark in association with each of goods (1) and (2) within the meaning of sections 4 and 45 of the Act.

[17] As for the registered services at issue, it appears that the Requesting Party largely does not dispute that the Owner used the Mark in association with either the Hotel Services or Retail Services as defined in the Owner's written representations. I note that with respect to the Hotel Services (including "hotel services" and "Reservations services for hotel accommodations"), the Federal Court has held that "hotel services" can include ancillary and incidental services such as reservation services [see *Hilton Worldwide Holding LLP v Miller Thomson*, 2018 FC 895 at para 76, aff'd 2020 FCA 134]. Similarly, I accept that in this case, "hotel services" would include reservation services, bearing in mind that the Registrar has previously held that "in certain cases, statements of services contain overlapping and redundant terms in the sense that the performance of one service would necessarily imply the performance of another" [*Gowling Lafleur Henderson LLP v Key Publishers Co*, 2010 TMOB 7 at para 15; see also *Provent Holdings Ltd v Star Island Entertainment, LLC*, 2014 TMOB 178 at para 22; *GMAX World Realty Inc v RE/MAX, LLC*, 2015 TMOB 148 at para 69].

[18] In this case, Ms. Oberg has attested that Canadians could book hotel reservations online through the Owner's *editionhotels.com* website during the relevant period, and has provided representative screenshots showing how the Mark was displayed on that website in the course of making such a booking. While she has provided no evidence that any Canadians actually did book hotel reservations in this manner during the relevant period, the display of a trademark in the advertisement of services is sufficient to satisfy the requirements of section 4(2) of the Act, from the time the owner of the trademark is willing and able to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)]. I accept that the exhibited website constitutes advertising of the Owner's Hotel Services, that it was visited by Canadians during the relevant period (based on Ms. Oberg's attestation that the website generated a considerable amount of Canadian traffic), and that the Owner was offering and prepared to perform its Hotel Services during the relevant period (given that the Owner was operating between ten and fifteen EDITION hotels during the relevant period at which a Canadian customer could make a reservation). Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with "hotel

services” and “Reservations services for hotel accommodations” within the meaning of sections 4(2) and 45 of the Act.

[19] Similarly, I accept that the exhibited screenshots from the Owner’s *shopedition.com* website would constitute advertising of the Owner’s Retail Services, and that the Exhibit C spreadsheet shows that the Owner was offering and prepared to perform, and did perform, these services in Canada during the relevant period. In particular, I note that in its written representations, the Owner correlates the services in the registration with the following products:

- “clothing”: robes and a thong shown on the website; the robe is also listed in the spreadsheet.
- “body care preparations, hair care preparations, and skin care preparations”: the soap, shampoo, conditioner, body lotion, and shower gel goods shown on the website and listed in the spreadsheet.
- “publications”: items listed as “IAN SCHRAGER STUDIO 54” and “SCHRAGER WORKS” shown on the website, which appear to be art books or brochures. Listings for “Book – Ian Schrager Studio 54” and “Book – Ian Schrager Works” also appear in the spreadsheet.
- “furniture”: a marble pouf and a bed shown on the website. A listing for “Pouf – Marble” also appears in the spreadsheet.
- “housewares, namely household containers”: an item that appears to be a cup on a dish. A listing for “Drinkware” also appears in the spreadsheet.
- “textile fabrics”: towels and throws; listings for “Towel”, “Pillow Protector”, “Pillowcase”, and various sheets also appear in the spreadsheets.
- “sports equipment, online sales of sporting goods”: a bowling ball shown on the website.

[20] Although the Mark is not marked on all of the products, I concur with the Owner that it is displayed in association with the Retail Services as it appears on the *shopedition.com* home page and on the footers of the pages that offer the retail goods for sale, and thus, that it is displayed in association with these retail services. As such, I

am satisfied that the Owner has demonstrated use of the Mark in association with “Catalogue retail services and online retail services, namely online sales of clothing and gifts, namely body care preparations, hair care preparations, and skin care preparations, publications, furniture, housewares, namely household containers, textile fabrics, clothing, sports equipment, online sales of sporting goods” within the meaning of sections 4(2) and 45 of the Act.

DISPOSITION

[21] 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 amended to delete Goods (3), (4), (5), and (6); Services (2), (3), (4), (5), (8), and (9); the following services listed in services (1): “[...] jewellery, [...] and utensils, [...] footwear, headwear, [...] business centre services, namely, providing access to the Internet and to facsimile machines and telephones, mail sorting, handling and receiving, and photocopying services; rental of fitness equipment; lease-purchase financing”; and the following services listed in services (6): “restaurant, catering, bar and cocktail lounge services; provision of exhibition facilities in hotels and provision of meeting rooms, conference, convention, banquet hall facilities.”

[22] The amended registration will be as follows:

GOODS

(1) Personal care products, namely soap, shampoo, conditioner, body lotion and shower gel.

(2) Scented candles.

SERVICES

(1) Catalogue retail services and online retail services, namely online sales of clothing and gifts, namely body care preparations, hair care preparations, and skin care preparations, publications, furniture, housewares, namely household containers, textile fabrics, clothing, sports equipment, online sales of sporting goods.

(2) Hotel services.

(3) Reservations services for hotel accommodations.

G.M. Melchin
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: Xin Xu (Fang An Law PC)

For the Registered Owner: Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l.