



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 48

Date of Decision: 2024-03-18

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Canadian Premature Babies Foundation-Fondation pour
Bébés Prématurés Canadiens

Registered Owner: Original Appalachian Artworks, Inc.

Registration: TMA454,480 for PREEMIE

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. TMA454,480 for the trademark PREEMIE (the Mark), owned by Original Appalachian Artworks, Inc. (the Owner).

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

THE RECORD

[3] At the request of Canadian Premature Babies Foundation-Fondation pour Bébés Prématurés Canadiens (the Requesting Party), the Registrar of Trademarks issued a

notice to the Owner under section 45 of the Act on November 30, 2022. The notice required the Owner to show whether the Mark had been used in Canada in association with each of the goods 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 30, 2019, to November 30, 2022.

[4] The Mark is registered for use in association with the goods “Toys and games, namely: dolls, dolls sold with birth certificates and adoption papers, doll clothing outfits.”

[5] The relevant definition of use in the present case is 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.

[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 specified in the registration during the relevant period.

[7] In response to the Registrar’s notice, the Owner furnished the affidavit of Joyce Henderson, the Secretary and Treasurer of the Owner, sworn on June 14, 2023. Only the Requesting Party filed written representations; no oral hearing was held.

EVIDENCE

[8] Ms. Henderson states that the Owner has been selling its “PREEMIE” dolls and doll accessories in Canada since 1995, including through the relevant period. She states that such goods are “routinely available for purchase in Canada” on the Owner’s

website at *cabbagepatchkids.com* and on the “BabyLand General Hospital” website. As Exhibit A, Ms. Henderson attaches a screenshot from the former website, which she states is representative of website pages that would have offered “PREEMIE dolls” for sale during the relevant period. She states that the Owner’s dolls are advertised on that website and “are often sold within minutes of being offered for sale”. The page shown in the screenshot shows images of dolls but does not display the Mark. Ms. Henderson explains that the SKU numbers for the Owner’s “PREEMIE” dolls starts with “LPP”, which stands for “Little People Preemie”.

[9] As Exhibits B through E, she attaches four copies of purchase orders dated during the relevant period and showing Canadian shipping addresses. Each such purchase order is accompanied by a photograph of the doll in question and of certificates showing information about the dolls. The Mark is not displayed on the purchase orders or in the photographs of the dolls and certificates.

[10] As Exhibits F through I, Ms. Henderson attaches traffic data for the *cabbagepatchkids.com* website, the BabyLand General Hospital website, and the Owner’s YouTube and Facebook pages, showing that Canadians visited each during the relevant period. As Exhibit K, she attaches screenshots from the Owner’s Facebook page, including posts dated during the relevant period showing dolls for “adoption” (which I understand to mean sale). The dolls are identified as “preemies” in these posts, and some posts include prices and/or links or email addresses for purchase. Finally, as Exhibit L, she attaches a copy of a full-page advertisement for the Owner’s doll products which ran in an adult colouring book during the relevant period. The advertisement includes the Mark.

ANALYSIS

[11] As noted by the Requesting Party, to establish use of a trademark within the meaning of section 4(1) of the Act, an owner must show that at the time of transfer, the trademark in question appeared on the goods themselves, on their packaging, or was otherwise associated with the goods such that notice of association is given. In this case, the Requesting Party submits that the Owner has not met these requirements as

the Mark does not appear in evidence at all other than in the Exhibit K Facebook post screenshots and the Exhibit L advertisement, which do not establish that the Mark was associated with the goods at the time of transfer.

[12] I concur with the Requesting Party that the Owner has not established that the Mark was used in association with the Owner's goods within the meaning of the Act. While I accept that the Owner sold dolls to Canadian customers in the normal course of trade during the relevant period, as evidenced in the purchase orders shown in Exhibits B through E, there is no evidence demonstrating that the Mark was associated with these goods in any way at the time of transfer. The Mark does not appear on the dolls themselves, on the materials shown in the photographs of the dolls, or on the purchase orders. Moreover, there is no evidence showing any packaging for these dolls, such that it cannot be determined if their packaging would have displayed the Mark.

[13] While the display of a trademark on a webpage from which goods are purchased can be sufficient to establish the necessary notice of association between the trademark and those goods [see *Kirby Eades Gale Baker v Endress+Hauser Group Services AG*, 2021 TMOB 284 at para 24; *FeraDyne Outdoors, LLC v Bass Pro Intellectual Property, LLC*, 2023 TMOB 104 at para 19], there is no evidence that the Mark is so displayed in this case. Indeed, the evidenced screenshots from *cabbagepatchkids.com* website do not appear to display the Mark, and the BabyLand General Hospital website is not shown in evidence. Although Ms. Henderson states that the SKU numbers for the Owner's "PREEMIE" dolls on the former website starts with "LPP", with the "P" standing for "PREEMIE", this does not amount to display of the Mark as registered.

[14] Although the Mark appears in the Exhibit L advertisement, it is well established that display of a trademark in advertising generally does not constitute use of that trademark in association with goods, unless such advertising materials are provided or visible at the time of transfer of property or possession [*BMW Canada Inc v Nissan Canada Inc*, 2007 FCA 255 at para 25]. There is nothing in evidence to suggest that this was the case with respect to the Exhibit L advertisement.

[15] As for the Exhibit K Facebook screenshots, I am not satisfied that the display of the Mark in these posts would provide the requisite notice of association at the time of transfer, since it appears that the dolls are not sold directly through the Facebook page, as evidenced by the fact that the posts include links to separate websites or to email addresses through which the purchase appears to be actually conducted. In other words, the Facebook posts appear to be more in the nature of advertising material than a website from which goods can be directly ordered; there is no evidence that the Mark would have been visible at the time the dolls would have been purchased.

[16] I further note that in her affidavit, Ms. Henderson states that the Owner's Facebook followers in Canada "can use the OAA Facebook page to post photos of their PREEMIE dolls available for adoption". In view of this statement, it is unclear whether the dolls shown on the page are being sold by the owner, as opposed to being resold by customers as part of a secondary market. Although some of the posts have links to the Owner's website or have email addresses ending with "*@cabbagepatchkids.com*", I find that at minimum, it is not clear that dolls sold in this manner would be part of the Owner's normal course of trade.

[17] In any event, there is nothing to suggest that any of the dolls advertised on the Facebook page were actually sold in Canada during the relevant period, whether as part of the transfers evidenced in Exhibits B through E or otherwise. In this respect, it is well established that "offering for sale" is not the same as "selling" [see *Michaels & Associates v WL Smith & Associates Ltd* (2006), 51 CPR (4th) 303 (TMOB)].

[18] As such, the display of the Mark in posts on the Owner's Facebook page is not sufficient, in and of itself, to establish that the Mark was displayed in association with the Owner's goods in a transfer in Canada in the normal course of trade during the relevant period.

[19] I am therefore not satisfied that the Owner has shown use of the Mark within the meaning of sections 4(1) and 45 of the Act. Further, the Owner has not put forward any special circumstances which would excuse non-use of the Mark.

DISPOSITION

[20] 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.

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: Osler, Hoskin & Harcourt LLP

For the Registered Owner: Norton Rose Fulbright Canada

LLP/S.E.N.C.R.L., s.r.l.