



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 126

Date of Decision: 2025-06-16

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Fasken Martineau DuMoulin LLP

Registered Owner: Chico's Brands Investments, Inc.

Registration: TMA561,683 for CHICO'S

THE PROCEEDING

[1] At the request of Fasken 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) on November 21, 2023, to Chico's Brands Investments, Inc. (the Owner). This notice required the Owner to show whether registration No. TMA561,683 for the trademark CHICO'S (the Mark) was used in Canada in association with each of the registered goods and services set out below (the Goods and Services), at any time within the three-year period ending on the notice's date (the Relevant Period):

Goods

(1) Women's clothing, namely, skirts, pants, sweaters, blouses, dresses, shirts, tops and jackets.

Services

(1) Retail clothing store services.

[2] If the Mark was not used in Canada during the Relevant Period, in association with some or all of the Goods and Services, and if the absence of use was not due to special circumstances that excuse the absence of use, the registration of the Mark is liable to amended or expunged accordingly [section 45(3) of the Act].

[3] For the following reasons, the registration will be maintained.

ANALYSIS

[4] 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 [*Black & Decker Corp v Method Law Professional Corp*, 2016 FC 1109 at para 12]. The evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at para 9].

[5] In response to the section 45 notice, the Owner filed the affidavit of Christine Munnelly, the Senior Vice-President, Group Merchandise Manager & Design, for the Owner. Ms. Munnelly’s evidence includes the following:

- the Owner is a women’s clothing and accessories retailer founded in 1983 on Sanibel Island, Florida [Munnelly Affidavit, para 3];
- throughout the Relevant Period, the Owner marketed, offered, and sold the Goods to Canadians through its website located at

chicos.com/store [para 7], and through catalogues mailed to Canadian consumers [para 12];

- the Owner's website prominently displayed the Mark in the banner at the top of all pages of the site [para 10, and Exhibit A], including the pages where the Goods are selected for purchase [paras 15-16, 19-20, 23-24, 27-28 and 31-32, and Exhibits D-H]; and
- the Owner's catalogs featured the Mark on the front and back cover, and the website *chicos.com* on each page therein [Exhibits B and C].

[6] Ms. Munnelly's evidence is that, during the Relevant Period, the Owner sold the following in Canada, in the manner described above:

- in excess of \$325,000 worth of skirts and dresses [Munnelly Affidavit, para 18];
- in excess of \$430,000 worth of pants [para 22];
- in excess of \$375,000 worth of sweaters [para 26];
- in excess of \$705,000 worth of knit blouses, shirts and tops, and in excess of \$740,000 worth of woven blouses, shirts and tops [para 30]; and
- in excess of \$340,000 worth of jackets [para 34].

[7] In addition, the evidence shows that the Owner's website was visited by well over 1 million Canadians during the Relevant Period [para 8].

[8] Ms. Munnelly's evidence is sufficient to show use of the Mark during the Relevant Period, in association with each of the Goods. It is well established that, where a customer can order goods from a website that displays a trademark, there is use of that trademark in association with the goods [*Fraser Milner Casgrain LLP v LG Electronics Inc*, 2014 TMOB 232 at

para 22 (*LG Electronics*); see also *Kirby Eades Gale Baker v Endress+Hauser Group Services AG*, 2021 TMOB 284 at para 24 (*Endress+Hauser*)].

Similarly, notice of association between a trademark and goods can be established when customers place orders for goods by way of a catalogue that displays the trademark in close proximity to the goods; the notice of association continues when the goods are delivered [*LG Electronics*, at para 21; see also *Endress+Hauser*, at para 24]. The evidence establishes at least a *prima facie* case that the Goods were sold via both the Owner's website and catalogues, and that the Mark was associated with the Goods via both the website and the catalogues, as required by the definition of use in association with goods in section 4(1) of the Act.

[9] The evidence is also sufficient to show use of the Mark during the Relevant Period, in association with the Services. The evidence establishes at least a *prima facie* case that, at a minimum, the Owner advertised its online retail store services to Canadians during the Relevant Period, via its catalogues mailed to Canadians, and via its website which was visited by Canadians. Both the Owner's catalogues and its website prominently displayed the Mark. The evidence also establishes that the Owner's retail store services were available in Canada during the Relevant Period, since such services were actually provided by delivering to Canada the Goods that were ordered [see *Dollar General Corporation v 2900319 Canada Inc*, 2018 FC 778 at para 21]. The availability of the Services in Canada, combined with the advertisement of the Services in Canada, is sufficient to demonstrate use of the Mark in association with the Services [see e.g. *Shift Law v Jefferies Group, Inc*, 2014 TMOB 277 at para 13].

[10] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with each of the Goods and Services.

DISPOSITION

[11] 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 maintained.

Jaimie Bordman
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2025-03-20

APPEARANCES

For the Requesting Party: No one appearing

For the Registered Owner: Nathan Piché

AGENTS OF RECORD

For the Requesting Party: Fasken Martineau DuMoulin LLP

For the Registered Owner: Gowling WLG (Canada) LLP