



# Canadian Intellectual Property Office

## THE REGISTRAR OF TRADEMARKS

**Citation:** 2025 TMOB 127

**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:** TMA921,401 for CHICO'S

[1] At the request of Fasken Martineau DuMoulin LLP (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on November 24, 2023, to Chico's Brands Investments, Inc. (the Owner). The notice required the Owner to show whether registration No. TMA921,401 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) Leather accessories, namely, handbags, traveling bags, brief cases, totes, but expressly excluding baby carriers worn on the body, bags for carrying babies, knap sacks for carrying babies, school bags and knap sacks for children, diaper bags, and bags specially adapted for strollers, prams, baby strollers and baby carriages.

## **Services**

(1) On-line retail store services featuring clothing, footwear, jewelry and accessories, but expressly excluding, infants', children's and pregnant women's underwear, infants', children's and pregnant women's clothing, infants' and children's footwear, and footwear specifically made for pregnant women, also excluding, baby carriers worn on the body, bags for carrying babies, knap sacks for carrying babies, school bags and knap sacks for children, diaper bags, and bags specially adapted for strollers, prams, baby strollers, and baby carriages; Retail store services featuring clothing, footwear, jewelry and accessories, but expressly excluding, infants', children's and pregnant women's underwear, infants', children's and pregnant women's clothing, infants' and children's footwear, and footwear specifically made for pregnant women, also excluding, baby carriers worn on the body, bags for carrying babies, knap sacks for carrying babies, school bags and knap sacks for children, diaper bags, and bags specially adapted for strollers, prams, baby strollers, and baby carriages.

[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 non-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, and provided retail store services featuring clothing, footwear, jewelry, and accessories, to Canadians through its website located at *chicos.com/store* [paras 7 and 18, and Exhibits A and E], and through catalogues mailed to Canadian consumers [para 11 and Exhibits B and C];
- the Owner's website prominently displayed the Mark in the banner at the top of all pages of the site [para 9, and Exhibit A], including on pages where the Goods and other clothing, footwear, jewelry and accessories are selected for purchase [paras 14-15 and 18-19, and Exhibits D and E]; and
- the Owner's catalogues 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 in excess of \$205,000 worth of leather accessories in Canada, including handbags, traveling bags, brief cases, and totes [Munnelly Affidavit, para 16]. As well, the Owner's website, featuring the Goods as well as other clothing, footwear, jewelry, and accessories, was visited by well over 1 million Canadians during the Relevant Period [para 20].

[7] 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.

[8] The evidence is also sufficient to show use of the Mark during the Relevant Period, in association with the Services. The evidence establishes a *prima facie* case that, at a minimum, the Owner advertised its retail store and 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. While the evidence does not explicitly confirm that retail sales of clothing, footwear, jewellery and accessories were made (aside from the sales of the Goods evidenced in the Munnelly Affidavit), I accept that the Services were at least available to be provided in Canada, in view of the fact that orders for the Goods were in fact accepted and delivered to Canada [see *Dollar General Corporation v 2900319 Canada Inc*, 2018 FC 778 at para 21]. The availability of the Services to be performed 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].

[9] 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**

[10] 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