



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2015 TMOB 171
Date of Decision: 2015-09-29

IN THE MATTER OF SECTION 45 PROCEEDINGS

Gowling Lafleur Henderson LLP

Requesting Party

and

**Carollyne Yardley, coba Carollyne
Yardley Omnimedia**

Registered Owner

TMA746,515 for CAROLLYNE

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA746,515 for the trade-mark CAROLLYNE (the Mark).

[2] The Mark is registered for use in association with the following goods:

Finished paintings, illustrations, reproductions and caricatures; printed matter, namely, books, greeting cards, bookmarks and post cards; Christmas decorations; clothing, namely, children's clothing; toys namely, dolls, plush toys; coffee cups; bed pillows; puzzles.

The Mark is also registered in association with “the retail sale of artwork”.

[3] On February 1, 2013, at the request of Gowling Lafleur Henderson LLP (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 to Carollyne Yardley, coba Carollyne Yardley Omnimedia (the Owner). The notice required the Owner to provide evidence showing that it had used the Mark in Canada at any time in the three years preceding the date of the notice, in association with each of the

registered goods and services. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[4] The relevant definitions of use are set out in sections 4(1) and (2) of the Act as follows:

4(1) A trade-mark 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 trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[5] It has been well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for clearing the register of “deadwood”. The criteria for establishing use are not demanding and an overabundance of evidence is not necessary. However, sufficient evidence must nevertheless be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the registered goods and services during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270]. Furthermore, mere statements of use are insufficient to prove use [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[6] In response to the Registrar’s notice, the Owner furnished her own affidavit, sworn December 20, 2013, together with Exhibits A through J. Only the Requesting Party filed written representations and attended an oral hearing.

[7] The Requesting Party submits that the registration ought to be maintained with respect to “greeting cards” only. In brief, the Requesting Party submits there is no evidence of use, no evidence of commercial transactions, and/or the evidence of use during the relevant period is ambiguous and unreliable with respect to the remaining various goods as well as the services.

[8] For the reasons that follow, I conclude that the registration ought to be maintained in its entirety.

[9] Before discussing the reasons for my decision, I will begin with a summary of the evidence.

The Evidence

[10] Ms. Yardley attests that, during the relevant period, she used the Mark with and without the design features shown in Exhibit A to her affidavit. Exhibit A consists of a rendering of the Mark incorporating a design feature or embellishment of the letter O as follows:



She refers to the Mark and the above embellished mark as the “CAROLLYNE Marks”.

[11] She then describes the nature of her art business, attesting that she established the sole proprietorship CAROLLYNE YARDLEY OMNIMEDIA in 2008 to focus on commercializing her finished paintings, illustrations, caricatures, and reproductions. She refers to the aforementioned as her “Artistic Works”, which she defines as follows:

- “Illustrations” are paintings done for decorating a story;
- A “caricature” is a portrait depicting a person using exaggeration, and the person refers to a real-life person and not to fictional characters; and
- “Reproductions” are high quality reproductions of her finished paintings, illustrations, and caricatures, and reproductions include giclees, posters, and prints.

[12] Ms. Yardley attaches, as Exhibits B1, B2, B3, and B4, photographs of “some of the finished paintings, an illustration, caricatures, and a reproduction, respectively, sold by the Registrant under at least one of the CAROLLYNE Marks in Canada during the Material Period.”

[13] With respect to the Mark appearing on the goods shown in the above-noted photographs, she attests that the Artistic Works are marked on the front with the Mark and have labels at the back that bear at least one of the CAROLLYNE Marks, and were so marked and labelled at the time they were sold in Canada during the relevant period. She further attests that she also sold

some of the Artistic Works with certificates of authenticity bearing at least one of the CAROLLYNE Marks during the relevant period. In support, she provides as Exhibit C to her affidavit, photographs of a label, a certificate of authenticity, and the packaging of a finished painting, all of which she states bear at least one of the CAROLLYNE Marks, and being representative of those used in association with the Artistic Works that she sold in Canada during the relevant period.

[14] Ms. Yardley then attests that once an Artistic Work has been completed, other “derivative products” are created based on such work, including ‘printed matter, such as books, greeting cards, bookmarks and post cards; Christmas decorations; clothing, such as children’s clothing; toys such as dolls and plush toys; coffee cups; bed pillows; and puzzles.’” She attaches as Exhibits D1 to D10 photographs of what she attests are the following goods bearing at least one of the CAROLLYNE Marks that she sold in Canada during the relevant period: a book, greeting cards, bookmarks, postcards, a bed pillow, a puzzle, Christmas decorations, children’s clothing, a doll, and a coffee cup. She attests that she sold older versions of the book shown in Exhibit D1 during the relevant period. She further attests that while Exhibit D5 shows a pillowcase, rather than a bed pillow, the Owner has sold bed pillows in Canada during the relevant period using similar packaging that bore at least one of the CAROLLYNE marks.

[15] In addition to the packaging bearing at least one of the CAROLLYNE marks visible at the time of transfer for the goods shown in Exhibits D1 to D10, Ms. Yardley provides as Exhibit E to her affidavit, copies of representative labels and a shipping box bearing at least one of the CAROLLYNE marks, used by the Owner in Canada during the relevant period on the packaging for the goods.

[16] Ms. Yardley attests that the Owner marketed, advertised, and sold the registered goods under at least one of the CAROLLYNE marks through the Owner’s websites accessible to Internet users in Canada; at art shows, art sale events, and business events in Victoria, British Columbia and nearby areas; and at art galleries and retailers. She attests that the Owner also sent electronic newsletters and used social media to market and advertise the registered goods and services in association with at least one of the CAROLLYNE marks. In support, she attaches as Exhibits F1 to F3, screenshots from the Owner’s website (dated February 2013 and December

2013, “representative of the look and feel and the functionalities of the Websites during the Material Period”), and screenshots of newsletters sent by the Owner in 2010 and 2011 to market and advertise the registered goods and services. She provides website traffic statistics, including the number of unique visitors from Canada to the Owner’s website during the relevant period. She further attests that the Owner shipped goods purchased from its website in the packaging shown in Exhibit C and in the shipping box shown in Exhibit E to her affidavit.

[17] With respect to other channels of trade the Owner engaged in during the relevant period, such as art sale events, art shows, and business events, Ms. Yardley specifically identifies the following: the Annual Moss Street Paint-In in Victoria, British Columbia; the Sooke Fine Art Show in Sooke, British Columbia, and; business meetings of the Victoria Meridian chapter of Business Network International. To further detail one of these events, she attests that the Owner attended the Moss Street Paint-In in July of 2012 and 2013, which showcases artworks and related commercial merchandise from different artists to over 30,000 attendees each year. She states that the Owner sold the registered goods, and marketed, advertised and provided the services under at least one of the CAROLLYNE Marks at this event. In support, she provides a business card that she states was distributed to attendees at the event (Exhibit G), and photographs of the Owner’s tent at the 2012 event showing the goods available for sale (Exhibit H). She states that the packaging of the goods shown in Exhibit H had labels at the back bearing at least one of the CAROLLYNE Marks, and that the labels were visible to attendees when they purchased such goods.

[18] Ms. Yardley attests that, in addition, the Owner also sold the registered goods in Canada during the relevant period through stores, galleries, shows, and retailers (the Resellers). She identifies 16 such Resellers, and attests that customers would use labels to select which of the Artistic Works they wished to purchase at the Resellers. She attaches as Exhibit I1, photographs of labels showing the specific Artistic Works available for purchase at the Resellers, bearing at least one of the CAROLLYNE Marks, stated to be representative of those used at the Resellers during the relevant period. The labels identify the art medium as “oil on canvas”, “oil on board”, “signed ltd edition giclee on canvas”, and indicate that “to purchase item, please take this card to the cashier”. She further attaches as Exhibit I2, photographs taken at two of the Resellers, showing store displays stocking some of the registered goods bearing at least one of the

CAROLLYNE Marks, which she states are representative of the store displays at these two Resellers during the relevant period.

[19] With respect to sales of the registered goods, Ms. Yardley explains that some of the registered goods, such as finished paintings, are sold on consignment at the Resellers that are art galleries, wherein the galleries retain a portion of the purchase price for these goods when sold to purchasers.

[20] In addition to annual revenue figures, Ms. Yardley provides sales figures for the following registered goods through the above-noted channels of trade: finished paintings, an illustration, reproductions, caricatures, books, greeting cards, bookmarks, postcards, Christmas decorations, children's clothing, dolls, coffee cups, bed pillows and puzzles. She attests that all such goods bore at least one of the CAROLLYNE Marks visible to the purchaser when the purchaser took possession of them. As further evidence of sales of these registered goods, she attaches as Exhibit J, a sampling of invoices, some of which indicate sales to the "Moss Street Paint-In". She provides a table to cross-reference which invoice pertains to which specific registered good. Although one such invoice refers to the sale of "pillowcases", she once again attests that this actually refers to bed pillows.

[21] Lastly, Ms. Yardley provides further context regarding sales of the registered goods and the normal course of trade of the Owner. More specifically, she explains that while the Owner's average yearly revenues during the relevant period may appear low compared to large scale commercial operations, such sales figures are in the normal course of trade in the Owner's business. She explains that certain Artistic Works are very time consuming to complete, labour intensive, and hand-made and not mass produced; thus, for example, she can only produce on average 11 paintings in one calendar year, and only a few of the hand-made items would be available for sale at any given time.

Analysis and Reasons for Decision

[22] As a preliminary matter, although not contested by the Requesting Party, I wish to point out that I am of the view that any use of the Mark which incorporates a design feature or embellishment of the letter O (as shown in paragraph 9 above) constitutes use of the Mark as registered. I consider this embellishment to the lettering of the Mark to be a minor deviation [regarding embellishment of letters, see *FAAM SpA v Fabbrica Italiana Accumulatori Motocarri Montecchio*, 2011 TMOB 132, 95 CPR (4th) 184]. Indeed, in the case of a word mark, use of the trade-mark word or words in any stylized form and in any colour can be considered as use of the registered mark [see *Stikeman, Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB)]. In any event, the Mark is being used in such a way that it has not lost its identity and remains recognizable; the dominant feature of the Mark, namely, CAROLLYNE, having been preserved [per *Canada (Registrar of Trade-marks) v Cie International pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. Thus, for ease of reference for the purposes of the remainder of the decision, I will refer to what has previously been referred to as the CAROLLYNE Marks, simply as the Mark.

[23] Now I will turn to the submissions of the Requesting Party, namely, that aside from “greeting cards”: (i) there is no evidence of commercial transactions; (ii) the evidence of use during the relevant period is ambiguous and unreliable, and/or; (3) there is no evidence of use at all, with respect to the remaining various goods as well as the services. I will deal with each of these submissions in turn.

(i) Is there evidence of commercial transactions with respect to certain goods?

[24] The Requesting Party has identified the following goods to which it submits there is no evidence of a commercial transaction, and therefore, no use of the Mark in the normal course of trade during the relevant period: reproductions; printed matter, namely, bookmarks and post cards, Christmas decorations, toys namely, dolls, plush toys; coffee cups; bed pillows; puzzles.

[25] Specifically, to begin with, the Requesting Party submits that the only evidence of sales of these items was to an entity referred to as the “Moss Street Paint-In” (as per the invoices in

Exhibit J). The Requesting Party submits that there is no evidence that the Moss-Street Paint-In, an unincorporated body, was legally capable of entering into a sales contract. Absent such evidence, the Requesting Party submits, the evidence does not demonstrate that a sale took place in the normal course of trade. I consider, however, given the evidence as a whole, that the Requesting Party has taken an overly technical approach in its analysis of the evidence that is inconsistent with the purpose of section 45 proceedings [see *John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)]. Instead, I accept that these items were sold to attendees of the event, rather than to the event itself; this being so, particularly in view of Ms. Yardley's statements in paragraphs 16 and 17 of her affidavit that sales took place *at* events such as the Moss Street Paint-In, and the photographs showing the goods on sale to attendees at the event in 2012 (Exhibit H). In any event, I note that the sales at or to the "Moss Street Paint-In", are not the only sales shown in the evidence. Given the evidence as a whole, I have no difficulty accepting that sales of these items were made in the normal course of trade by the Owner during the relevant period.

(ii) Is the evidence of use during the relevant period ambiguous and unreliable?

[26] The Requesting Party further submits that the basis for deleting the goods "finished paintings, illustrations, caricatures; toys, namely, dolls, plush toys, clothing, namely children's clothing" from the registration is because the evidence is ambiguous and unreliable (in addition to the submissions made above). The Requesting Party groups these goods as follows, providing separate submissions for each grouping: a) finished paintings, illustrations, caricatures; b) toys, namely, dolls, plush toys; and c) clothing, namely, children's clothing.

[27] With respect to the goods grouped under a) above, the Requesting Party submits that the evidence is unreliable and contradictory, as for example, despite that Ms. Yardley defines each of these goods in her affidavit, none of the associated exhibits are clearly labelled or identified by such generic identifications or descriptions. Thus, the Requesting Party submits, the Owner has not established a link between the goods shown in the evidence and the goods specified in the registration. Further to this, the Requesting Party submits that the Owner's evidence in respect of "finished paintings" is contradictory and unreliable since Ms. Yardley states that the

minimum cost of a “finished painting” is \$500, yet the invoices in respect of “finished paintings” show that unit prices were \$400 and \$475.

[28] Ms. Yardley, however, does link the registered goods with those shown in the evidence, as she attests that attached to her affidavit “as Exhibits B1, B2, B3 and B4 are photographs of some of the finished paintings, an illustration, caricatures, and a reproduction, *respectively* [...]” (my emphasis). Furthermore, the goods featured in these exhibits are consistent with the definitions Ms. Yardley provided of these goods (paragraph 6 of her affidavit). Additionally, Ms. Yardley has cross-referenced each of the registered goods with specifically identified invoices (paragraph 22 of the affidavit, Exhibit J). With respect to the price discrepancy of the “finished paintings” noted by the Requesting Party, I consider this to be a minor inconsistency by the affiant; indeed, the prices reflected on two of the three relevant invoices are well above the \$500 benchmark, while the third invoice reflects unit prices that are relatively close to this benchmark. I do not consider that such a minor discrepancy should call into question the reliability of the evidence and negate that such sales took place.

[29] With respect to the goods grouped under b) above, namely, “toys, namely, dolls, plush toys”, the Requesting Party submits that the Owner’s evidence regarding these goods is ambiguous, unclear and contradictory. For example, the invoice provided in support of these goods (at Exhibit J) ambiguously refers to the sale of “Merchandise – toy or doll”. The Requesting Party submits that, as it is unclear whether the sale pertains to “dolls” or “plush toys”, this ambiguity must be interpreted against the interests of the Owner. In addition, the Requesting Party submits that the same product cannot satisfy use with respect to two distinctly listed goods in the registration, absent evidence to the contrary [see *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)]. In the alternative, the Requesting Party submits, the evidence at best supports use with respect to “plush toys”. In this regard, the Requesting Party submits that while Ms. Yardley identifies the good shown in the photograph in Exhibit D9 as being a “doll”, the item in the photograph appears instead to be a “plush toy”. However, I am of the view that the good shown in the Exhibit D9 photograph is a “plush doll” and actually falls within the definitions submitted by the Requesting Party for the terms “doll” and “plush toy”. In this respect, Exhibit D9 appears to depict a “small model of a human” that is “sewn from a textile, and stuffed with a soft material”. While I acknowledge that “stuffed toys” are broader

than “dolls”, I note that Ms. Yardley has also broadly used the term “doll” in the evidence to describe a stuffed animal toy (see webpages in Exhibit F). Consequently, I am of the view that the use demonstrated, particularly in view of Ms. Yardley’s attestations regarding derivative products, is representative of both “dolls” and “stuffed toys”.

[30] Lastly, with respect to the goods grouped under c) above, namely, children’s clothing, the Requesting Party submits that while the evidence appears to show use of the Mark in association with clothing, there is insufficient or ambiguous evidence in respect of *children’s* clothing. I note, however, that Ms. Yardley has provided numerous sworn statements throughout her affidavit in reference to the various exhibits that relate to clothing (and in particular, t-shirts), indicating that such goods are for children. For example, Ms. Yardley attests in paragraph 8 of her affidavit that the t-shirts shown in Exhibit D8 in packaging clearly bearing the Mark are “children’s clothing”. In paragraph 20 of her affidavit, Ms. Yardley attests that 21 pieces of “children’s clothing” were sold. Further to this, she provides representative invoices (at Exhibit J), to which she attests at paragraph 22 of her affidavit that three such invoices reflect sales of “children’s clothing”. I see nothing inconsistent in the evidence, or any reason to doubt Ms. Yardley’s sworn statements that these goods are items of “children’s clothing”; as such, I accept these sworn statements at face value [per *Rubicon Corp v Comalog Inc* (1990), 33 CPR (3d) 58 (TMOB)].

(iii) With respect to the remaining various goods as well as the services, is there any evidence of use?

[31] The Requesting Party has identified “books”, “coffee cups”, “bed pillows” and “the retail sale of artwork”, as the goods and services to which it submits there is no evidence use of the Mark at all during the relevant period.

[32] In particular, with respect to “books”, the Requesting Party submits that the Owner’s evidence in support of the alleged sales of books is in the form of a single handwritten sales order or “pre-order” for seven books in January 2013, only days before the end of the relevant period. The Requesting Party submits that an order for goods which is not supported by proof that the goods were actually delivered or later invoiced is not sufficient to establish use of a trade-mark in association with such goods [citing *Shapiro Cohen v JMAX Global Distributors*

Inc, 2011 CarswellNat 2743, 2011 TMOB 36 at para 12]. However, I note that Ms. Yardley has provided a sworn statement that the Owner also sold older versions of the book during the relevant period. The Requesting Party submits that this statement is contradicted later in the Yardley affidavit, as she states that only seven books were sold during the relevant period. The Requesting Party submits that this later statement means that the only sales of books made were the seven “pre-ordered” books. While Ms. Yardley could have been more precise and indicated the quantity of older versions of the book that were sold during the relevant period, I do not consider that her statement that seven books were sold ought to dismiss her previous statement that older versions of the book were also sold during the relevant period. Given the evidence as a whole, I ultimately see no inconsistency with Ms. Yardley’s statements in this regard.

[33] Now turning to the goods “coffee cups” and “bed pillows”, the Requesting Party submits that the goods shown in the evidence do not correspond with these registered goods. However, contrary to the Requesting Party’s submissions, I consider that reference to “mugs” in the evidence (per the Exhibit J invoices), is a reference to “coffee cups” (as shown in the Exhibit D10 photograph, and referred to in paragraphs 8 and 22 of the Yardley affidavit). Additionally, I am satisfied with Ms. Yardley’s sworn statement that despite reference to “pillowcases” in the evidence, the Owner “has sold bed pillows (pillowcase surrounding pillow filler)” and that the supporting invoice (at Exhibit J) reflects such a sale (as per the sworn statement in paragraph 23 of the Yardley affidavit).

[34] Lastly, with respect to the “retail sale of artwork”, the Requesting Party submits that services incidental to the sale of goods (*i.e.* the retail sale of one’s own goods) do not constitute “services” [citing *Carling O’Keefe Breweries of Canada Ltd v Anheuser-Busch Inc* (1985), 4 CPR (3d) 216 (TMOB)]. In the present case, however, the Owner is not merely engaged in incidental services, such as advertising and promoting one’s own goods; the Owner is actually providing retail sale services of artwork through its websites *www.carollyne.com* and *www.etsy.com/ca/shop/carollyneyardley*, both of which clearly feature the Mark with respect to an online art gallery and store. I note that both websites include online shopping cart functions, and Ms. Yardley clearly attests that sales were made through the websites during the relevant period. Furthermore, there is nothing that limits retail sales to sales through traditional brick and mortar operations. In any event, the Federal Court of Appeal has held that there is nothing in

section 4(2) of the Act that restricts services to those that are independently offered to the public or that are not ancillary or connected with goods [*Gesco Industries Inc v Sim & McBurney* (2000), 9 CPR (4th) 480 at 484].

[35] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with each of the registered goods and services.

Disposition

[36] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

Kathryn Barnett
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Hearing date: May 11, 2015

Appearances

No one appearing

For the Registered Owner

Michael O'Neil

For the Requesting Party

Agents of Record

Oyen Wiggs Green & Mutala LLP

For the Registered Owner

Gowling Lafleur Henderson LLP

For the Requesting Party