

“Fashion Santa”: An Intellectual Property Yuletide Carol

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Last year, Paul Mason became a social media phenomenon while working the holiday season as a pseudo Santa Claus, dubbed Fashion Santa, at the Yorkdale Shopping Centre. Fashion Santa, a stylish Saint Nick, portrayed by Paul Mason, caused a festive sensation with shoppers and celebrities alike. However, a dispute between Mason and Yorkdale over the ownership of the rights to Fashion Santa prevented Mason from donning the role of Fashion Santa at Yorkdale this holiday season. In short, the case of Fashion Santa has now become a yuletide intellectual property dispute.

The Canadian Intellectual Property Office records indicate that on December 8, 2015, Oxford Properties Group Inc., which manages Yorkdale Shopping Centre, filed a trademark application for “Fashion Santa” and “Yorkdale Fashion Santa”. Subsequently, Mason filed a trademark application for “Fashion Santa” on December 21, 2015, and on December 22, 2015, registered a copyright in a literary work first published in September 2014 entitled “Fashion Santa”. With respect to the trademark, both parties claim November 2014 as the date of first use in their applications, and are presumably referring to the same event and/or use.

If “Fashion Santa” is in fact a trademark, it is important to identify who was using it first to distinguish themselves as the source of goods or services that is “Fashion Santa” and thus assert exclusive rights in it. Both parties’ claim to ownership of the “Fashion Santa” trademark appear to stem from the same events and/or use, and as such, in order to determine ultimate ownership, a determination of the rights and ownership of the trademark will likely need to consider the nature of the contract, be it employment or otherwise, between Mason and Yorkdale in combination with the trademark applications and use of the trademarks. Like most litigation, this matter is likely to turn on the facts.

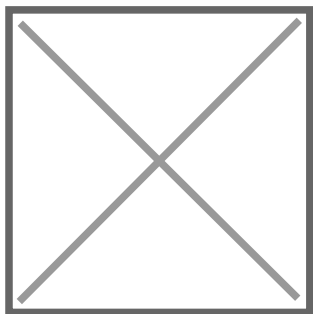
Ultimately, and unfortunately, it appears this dispute has arisen as a result of the parties’ collective failure to sort out ownership of Fashion Santa at the commencement of the business arrangement between Mason and Yorkdale in 2014. Had the parties memorialized their understanding of the terms of ownership of Fashion Santa in writing at that time, they may not be at the present juncture. Of course, Fashion Santa did not have the status and success it presently experiences and it is unlikely that either party turned their mind to this issue. With that said, any good agreement will govern between the parties at present, but also anticipate the issues which may arise in the future.

The snowball fight between Mason and Yorkdale appears to have come to a frost in recent weeks. With that said, unless the parties are able to giftwrap a settlement before the 2017 holiday season, Fashion Santa is likely to take a sleigh ride to the courts.

Happy Holidays!

(This blog is provided for educational purposes only, and does not necessarily reflect the views of Gardiner Roberts LLP).

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