

SECTION 45 PROCEEDINGS
CERTIFICATION MARK: AHBAI & DESIGN
REGISTRATION NO: TMA 343,633

At the request of Laboratoires UMA, S.L., the Registrar forwarded a notice under section 45 of the *Trade-marks Act* on August 31, 2004 to American Health and Beauty Aids Institute, the registered owner of the above referenced certification Mark.

Registration No: TMA 343, 633 AHBAI & Design shown below is registered as a certification mark in association with:

“Health and beauty aids, and cosmetics namely: soaps, perfumes, essential oils, creams, lotions, anti-perspirants, deodorants, non-medicated preparations in the form of creams and lotions, all for the care of the skin; toilet articles namely: combs, brushes, head bands, clips, hair nets, hair lotions, hair dyes, hair coloring agents, hair relaxing compounds, shampoos and conditioners.”



The defined standard (section 2 of the *Trade-marks Act*, R.S.C. 1985, c. T-13) is set out in the registration.

Section 45 of the *Trade-marks Act*, requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares and/or services listed on 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 use since that date. In this case the relevant period for showing use is any time between August 31, 2001 and August 31, 2004.

Use in association with wares is set out in subsection 4(1) of the *Trade-marks Act*:

A trade-mark is deemed to have been used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

In response to the Registrar's notice, the registrant furnished two affidavits of Geri Jones. The requesting party and the registrant filed written submissions; neither party requested an oral hearing.

The first affidavit of Geri Jones (Affidavit 1), states that she is the Executive Director of the American Health and Beauty Aids Institute (the "Institute"), the registrant. Ms. Jones states that the Institute grants licences to use the above referenced certification mark, and that one such licensee is Luster Products, Inc., which has been manufacturing and selling the wares identified above in association with the subject certification mark, in Canada during the relevant period.

Attached to Affidavit 1 as Exhibits A and B, are invoices of sales by Luster Products, to three different customers in Canada - on July 28, 2003, February 12, and June 10, 2004, respectively. These dates are within the relevant period. Each invoice lists numerous products, most of which appear to be hair care products which are in the statement of wares.

Exhibit C to Affidavit 1 attaches samples of labels. The affiant states in paragraph 7 that these were used with the marketing and sale of the wares in the registration, in the ordinary course of trade in Canada. The Requesting Party argues that the affiant fails to explicitly state that said labels were the ones used during the relevant period. However, on balance, taking the statement of Ms. Jones that said labels were used on sales in Canada, together with the evidence of sales in Canada during the relevant period

(Exhibits A and B), I am prepared to accept that the labels used during the relevant period, were those referred to by the affiant in paragraph 7.

The second affidavit of Geri Jones (Affidavit 2) attaches a copy of a Licence Agreement between the registrant and Luster Products. The requesting party argues that the licence agreement is in respect to US registrations only, and further that copies of the US registrations are not attached. Further, I note the ambiguity in that Ms. Jones states in her affidavit that the licence agreement includes reference to the defined standard, yet this defined standard is not referred to in the attached licence agreement. In any event, for reasons that will become obvious below, it is unnecessary to discuss the sufficiency of the licence agreement any further.

Deviation

There is an issue with respect to the differences between the marks as registered and as shown on the two labels in Exhibit C. The quality of the images on the labels is very poor; however, there is no doubt that there are differences between the marks as used and as registered.

As set out in *Canada (Registrar of Trade-marks) v. Cie International pour l'informatique CII Honeywell Bull* (1985), 4 C.P.R. (3d) 523 at 525 (F.C.A.), where the mark as used deviates from the mark as registered, the question to be asked is whether the mark was used in such a way that the mark did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used. In deciding this issue, one must look to see if the “dominant features” have been preserved, *Promafil Canada Ltée v. Munsingwear Inc.*, 44 C.P.R. (3d) at 59 (FCA).



TMA No. 343, 633

LABEL

Firstly with respect to the design portion of the mark - the profile of the woman's head and long flowing hair - I consider that the 2 white stripes running through her hair are prominent in the registered mark and are a dominant feature of the mark. These lines are absent, however, in the mark as used. In my view, without the white stripes, the mark as used presents a sphinx-like image rather than a profile of a woman's head. Accordingly, I consider that a dominant feature of the mark has not been preserved in the mark as used.

Secondly, there is additional written and graphic material in the mark as used – namely, a rectangular border containing the words, “THE PROUD LADY” with the words AHBAI MEMBER appearing above as part of the border line. Although use of a trade-mark in combination with additional material can be considered use of the mark *per se*, if the public, as a matter of first impression, would perceive the mark used as being the trade-mark *per se* (*Nightingale Interloc Ltd.v. Prodesign Ltd.* 2 C.P.R. (3d) 535), in this case the rectangular border visually and conceptually fuses the additional wording with the design portion of the mark and the word AHBAI, to the extent that the mark as used cannot be considered use of the registered mark *per se*.

I find therefore that the mark as used is substantially different from the mark as registered; firstly, one of the “dominant” features is missing (white stripes), and the other dominant feature - AHBAI, is subsumed into additional material in such a way that the certification mark *per se*, no longer exists. In view of the fact that I consider that the differences between the registered certification mark and the mark as depicted on the

labels are too substantial to be considered minor deviations, it is my conclusion that certification mark TMA No.343, 633 for AHBAI & Design ought to be expunged from the Register, for failure to show use pursuant to Section 45 of the Trade-marks Act.

DATED AT GATINEAU, QUEBEC, THIS 11th DAY OF JANUARY 2007.

P. Heidi Sprung

Member, Trade-marks Opposition Board