

**SECTION 45 PROCEEDING
TRADE-MARK: BEAUTYFIL
REGISTRATION NO.: TMA 346,602**

On February 6, 1997, at the request of Messrs. Ridout & Maybee, the Registrar forwarded a Section 45 notice to Simmons I.P. Inc. the registered owner of the above-referenced trade-mark registration.

The trade-mark BEAUTYFIL is registered for use in association with the following wares: (1) mattresses and upholstered furniture.

In response to the Registrar's notice, the affidavit of R. Edward Jackson was furnished. Each party filed a written argument. An oral hearing has not been requested in the present proceeding.

In his affidavit, Mr. Jackson states that the trade-mark has been used by Simmons Canada Inc. since 1988 in association with select mattresses containing a high quality fibrefil quilting including mattresses marketed in Canada by such company under the following trade-marks: BEAUTYREST QUINTESSENCE PLUS; BEAUTYREST SOVEREIGN PLUS; BEAUTYREST CHERRINGTON; BEAUTYREST WORLD CLASS REGENT ULTRA; AND BEAUTY SLEEP DEBUTANTE. He clearly specifies that the trade-mark BEAUTYFIL was in use in association with such mattresses when sold during the relevant period. He explains that Simmons Canada Inc. has been granted a license to use the trade-mark and that the registrant has control over the character and quality of the wares manufactured by Simmons Canada Inc. and sold under the trade-mark BEAUTYFIL. As exhibit A, he provides what he describes as a label bearing the trade-mark which was used by Simmons Canada Inc. in 1988. He then submits that since 1991, the trade-mark BEAUTYFIL has been used by Simmons Canada Inc. by displaying the trade-mark in the "Features and Benefits" booklets which are distributed to all dealers who sell mattresses in association with the BEAUTYFIL trade-mark in Canada. As exhibit B, he encloses photocopies of pages from a representative "Features and Benefits" booklet. He states that in the booklet, the BEAUTYFIL name is followed by an asterisk which serves to indicate that BEAUTYFIL is a trade-mark. He adds that this

booklet is representative of the booklets which were in use in Canada during the relevant period. He explains that the booklets are presented by dealers to customers when they buy any of the select mattresses sold in association with the BEAUTYFIL trade-mark to point out the mattress features.

At paragraph 6 he states that the trade-mark is currently being used by displaying the trade-mark on product labels sewn onto mattresses sold in association with the trade-mark in Canada. He encloses as exhibit C, a sample label bearing the trade-mark, which he states is representative of the labels which are currently in use. He provides wholesale dollar sales figures concerning mattresses sold in association with the trade-mark, for the period February 6, 1994 to February 6, 1997.

The main objection of the requesting party is that the evidence fails to show use of the trade-mark in association with the wares for which the trade-mark is registered; that rather the use appears to be in association with a “comfort layer” which appears to be a component of a mattress. It adds that in exhibit B the word BEAUTYFIL is used to describe a feature of a SIMMONS BEAUTYREST mattress and that accordingly such usage is not trade-mark usage in association with mattresses but rather is a description of a feature of a particular Simmons mattress.

Concerning the manner the trade-mark was being used during the relevant period, I agree with the requesting party that the photocopy of the label submitted as exhibit A is irrelevant since the affiant has clearly stated that such label was in use in 1988, therefore, well prior to the relevant period.

Further, the label submitted as exhibit C, is also irrelevant in showing the manner of use during the relevant period since Mr. Jackson has clearly indicated that it is the label currently in use, that is, subsequent to the relevant period.

The only evidence that shows the manner the trade-mark was being used during the relevant period is exhibit B, which Mr. Jackson describes as photocopies of pages of a

representative “Features and Benefits” booklet which display the trade-mark and which Mr. Jackson has indicated is representative of the booklets which are distributed to all dealers who sell mattresses in association with the BEAUTYFIL trade-mark and which he states are presented by dealers to customers when they buy any of the select mattresses sold in association with the trade-mark BEAUTYFIL in order to point out the mattress features. Mr. Jackson submits that the trade-mark has been displayed in “Features and Benefits” booklets in such manner since 1991.

According to Section 4(1) of the Act, a trade-mark is deemed to be used in association with wares if at the time of transfer of the property in or possession of such wares in the normal course of trade any one of the following conditions is met:

- the trade-mark is marked on the wares themselves;
- the trade-mark is marked on the package in which the wares are distributed
- the trade-mark 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 being transferred.

It is clear from the evidence that during the relevant period the trade-mark was not marked on the wares themselves or on the package in which the wares were distributed. Consequently the question is whether the use shown by the evidence meets the third criteria of Section 4(1).

In the present case, I am prepared to accept that when the “Features and Benefits” booklet was presented by the dealers to the customers of the mattresses, that this would have provided the required notice between the trade-mark and the mattresses at the time of transfer of the mattresses to the customers.

The requesting party however, argues that the trade-mark BEAUTYFIL is used therein to describe a feature of a SIMMONS BEAUTYREST mattress and is not trade-mark usage with mattresses, but rather is a description of a feature of a particular SIMMONS mattress.

In my view, the term BEAUTYFIL as shown in the “Features and Benefits” booklet appears to be used as a trade-mark to distinguish the quilting used in particular mattresses marketed by Simmons Canada Inc. under the trade-marks BEAUTYREST QUINTESSENCE PLUS; BEAUTYREST SOVEREIGN PLUS, etc.

Although I have some doubts on the matter, I am not convinced that the word BEAUTYFIL used in such manner would not also be perceived as distinguishing the mattresses containing the particular type of quilting. As it arguably may be perceived as such, I conclude that the use shown of the trade-mark BEAUTYFIL is use in association with mattresses, and that such use meets the requirements of Section 4(1) of the Trade-marks Act.

The statements made at paragraph 7 of the affidavit, confirm that sales of such mattresses associated with the trade-mark in the manner discussed above, were made during the relevant period.

Concerning the wares “upholstered furniture” the evidence is completely silent concerning such wares, therefore, I conclude that the evidence fails to show use with such wares and that they ought to be deleted from the statement of wares in the registration.

In view of the evidence furnished, I conclude that the trade-mark registration ought to be amended by deleting therefrom the wares “upholstered furniture”.

Registration No. TMA 346,602 will be amended accordingly in compliance with the provisions of Section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 30th DAY OF November, 1998.

D. Savard
Senior Hearing Officer
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