



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

TRANSLATION

Citation: 2012 TMOB 169
Date of Decision: 2012-10-05

**IN THE MATTER OF SECTION 45 PROCEEDINGS
requested by Marks & Clerk against registration Nos.
TMA462,354 and TMA247,324 for the trade-marks
KISSKISS Dessin and KISS-KISS in the name of
Guerlain S.A.**

[1] At the request of Marks & Clerk (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on May 31, 2010 to Guerlain SA (the Registrant), the registered owner of registration Nos. TMA462,354 and TMA247,324 for the trade-marks KISSKISS Dessin and KISS-KISS.

[2] With respect to registration No. TMA462,354, the mark KISSKISS Dessin (shown below) is registered for use in association with the following wares: (1) Savons, parfumerie, huiles essentielles, lotion pour les cheveux et dentifrices; cosmétiques, nommément rouge à lèvres, vernis a ongles, démaquillant pour lèvres, dissolvant pour les ongles et baume pour les lèvres.

KISSKISS

[3] With respect to registration No. TMA247,324, the mark KISS-KISS is registered for use in association with the following wares: (1) Lip-gloss.

[4] Section 45 of the 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 or services specified in 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 such use since that date. In this case, the relevant period for showing use is between May 31, 2007 and May 31, 2010 (the Relevant Period).

[5] The relevant definition of “use” in association with wares is set out in section 4(1) of the *Trade-marks Act*:

4. (1) A trade-mark is deemed to be 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.

[6] In response to the Registrar’s notices, the Registrant filed identical affidavits of Sandrine Briatte, Director of Marketing for Guerlain Canada Ltée, the Canadian distributor and subsidiary of Guerlain Société Anonyme. The Requesting Party and the Registrant filed written representations and both parties attended a hearing.

Deficiencies with the Evidence

[7] At the oral hearing of this case, the Requesting Party objected to the form of the documents filed by the Registrant as evidence in each of these cases. More specifically, the Requesting Party submitted that the evidence filed by the Registrant entitled an “Affidavit” was not sworn or affirmed. Alternatively, the Requesting Party submitted that if the evidence filed was a statutory declaration, it did not comply with section 41 of the *Canada Evidence Act*, RSC 1985 c C-5, which provides:

Solemn declaration

41. Any judge, notary public, justice of the peace, provincial court judge, recorder, mayor or commissioner authorized to take affidavits to be used either in the provincial or federal courts, or any other functionary authorized by law to administer an oath in any matter, may receive the solemn declaration of any person voluntarily making the declaration

before him, in the following form, in attestation of the execution of any writing, deed or instrument, or of the truth of any fact, or of any account rendered in writing:

I,, solemnly declare that (*state the fact or facts declared to*), and I make this solemn declaration conscientiously believing it to be true, and knowing that it is of the same force and effect as if made under oath.

Declared before me at this day of 19.....

[8] Indeed, although the evidence filed in these cases bears the title “Affidavit”, Ms. Briatte indicates in the first paragraph that she is solemnly declaring to the information that follows. I note that the document does not contain the knowledge statement required in a statutory declaration by virtue of s 41 of the *Canada Evidence Act*.

[9] At the oral hearing, the Registrant argued that the affidavits of Ms. Briatte filed in these two cases were each properly commissioned in the Province of Quebec. The Registrant also submitted that any alleged deficiencies with respect to the Registrant’s evidence ought to have been raised by the Requesting Party prior to the hearing in this case. Article 91 of the *Code of Civil Procedure* of the Province of Quebec (“CCP”) sets out the elements of an affidavit as follows:

91. Every affidavit must be divided into paragraphs numbered consecutively, and be in the first person.

The names, occupation and exact address of the deponent must be inserted therein.

The date when and the place where it was sworn must be inserted in the jurat.

[10] I note that the evidence filed in these cases contains Ms. Briatte’s full name, title and address, as well as a statement that she has personal knowledge of the marketing of lipstick and lip gloss by the Registrant in Canada by virtue of her duties and position. In addition, the evidence bears Ms. Briatte’s signature, as well as a jurat completed by a commissioner for oaths in the Province of Quebec pursuant to section 218 of the *Quebec Courts of Justice Act*. Based on the foregoing, and bearing in mind the summary nature and purpose of Section 45 proceedings, I accept the Affidavits of Ms. Briatte as being admissible. In reaching this conclusion, I have also considered the timing of the objection and the prejudice to the Registrant. Specifically, no objection was raised when these affidavits were originally filed, or at anytime prior to the

hearing of these cases. Where no objection is raised when the evidence is originally filed, the Registrar will not allow the opposite party to subsequently take advantage of such a technical objection, and most certainly not so at the oral hearing stage where the party has no opportunity to correct the situation [*Maximilian Fur Co, Inc v Maximilian for Men's Apparel Ltd* (1983), 82 CPR (2d) 146 (TMOB)].

[11] Having concluded that the evidence is admissible, I now turn to the question of use.

Use

[12] In her affidavit, Ms. Briatte attests that during the Relevant Period and in the normal course of trade, the Registrant used the trade-marks KISSKISS Dessin and KISS-KISS in the form of “KISSKISS or “KissKiss” in Canada in association with lipstick and lip gloss. Ms. Briatte attests that lipstick and lip gloss marked with the trade-marks KISSKISS Dessin and KISS-KISS are distributed in Canada by Guerlain Canada Ltée and sold in the cosmetic sections of department stores and in the cosmetic and beauty sections of certain specialized pharmacies including: The Bay, Sears and Shopper’s Drug Mart. Ms. Briatte does not assert use with respect to the remaining wares in listed in the KISSKISS Dessin registration, and no evidence of special circumstances excusing non-use was submitted.

[13] In support of her assertions of use, Ms. Briatte attaches as Exhibit 1 to her affidavit several photographs of lipstick and lip gloss products and packaging that Ms. Briatte identifies as being representative of the lipstick and lip gloss products sold by the Registrant during the Relevant Period. I note that KISSKISS appears prominently on the packaging in a stylized font. Attached as Exhibit 3 to Ms. Briatte’s affidavit are twelve invoices showing sales of KISSKISS lipstick and lip gloss products from the Registrant to various stores located in Canada during the Relevant Period. Ms. Briatte identifies them as being representative of sales of the Registrant’s lipsticks and lip glosses bearing the marks during the Relevant Period.

[14] In view of the foregoing, I am satisfied that the Registrant has demonstrated use of the trade-mark KISSKISS Dessin in association with lipstick within the meaning of sections 4(1) and 45 of the Act.

[15] I now turn to the Registrant's use of the mark(s) in association with lip gloss. In its written submissions, the Requesting Party notes that the registration for KISSKISS Dessin does not cover lip gloss. And, although the mark KISS-KISS is registered for use in association with lip gloss, I note that when used by the Registrant in association with lip gloss, the mark did not contain a hyphen. The Requesting Party submitted that for this reason, the evidence does not show use of the mark KISS-KISS. However, I do not consider that the absence of a hyphen in the use of the mark KISS-KISS would mislead the public into thinking that it is a different trademark and that wares bearing that mark are from a different source. In my view, the absence of a hyphen does not substantially alter the distinctiveness of the Mark. Applying the principles as set out in *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII HoneywellBull, SA*, (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc*, (1992), 44 CPR (3d) 59 (FCA), I consider the omission of this element to be a minor deviation from the Mark and therefore conclude that there has been use of the mark KISS-KISS in association with lip gloss.

[16] Finally, as noted above, no evidence of use of the mark KISSKISS Dessin in association with wares other than lipstick and lip gloss was provided. Furthermore, no evidence of special circumstances excusing such non-use was submitted and Ms. Briatte makes no statements in her affidavit that the evidence provided should be considered representative of wares in a similar category [as per *Saks & Co v Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD)]. Therefore, although use of the mark KISSKISS Dessin was demonstrated in association with lipstick, I am not prepared to infer that the mark was used in association with the other wares listed in the registration.

[17] In view of the foregoing, I am satisfied that the Registrant has evidenced use of the mark KISSKISS Dessin in association with lipstick within the meaning of section 45 and section 4(1) of the Act during the Relevant Period. As noted above, no evidence of use of the mark KISSKISS Dessin in association with the remaining wares listed in the registration was provided and no evidence of special circumstances excusing such non-use was submitted.

[18] With respect to the mark KISS-KISS, I am satisfied that the Registrant has evidenced use in association with lip gloss within the meaning of section 45 and section 4(1) of the Act during the Relevant Period.

Disposition for registration No. TMA462,354

[19] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, registration No. TMA462,354 will be amended to delete the remaining wares in compliance with the provisions of section 45 of the Act. The amended statement of wares will read as follows: (1) Cosmétiques, nommément: rouge à lèvres.

Disposition for registration No. TMA247,324

[20] Accordingly, 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, registration No. TMA247,324 will be maintained.

Darlene H. Carreau
Chairperson
Trade-marks Opposition Board
Canadian Intellectual Property Office