



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

Citation: 2014 TMOB 181
Date of Decision: 2014-06-13

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Fogler, Rubinoff LLP against registration
No. TMA619,621 for the trade-mark LIPS (DESIGN) in
the name of Blistex Inc.**

[1] At the request of Fogler, Rubinoff 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 (the Act) on May 4, 2011 to Blistex Inc. (the Owner), the registered owner of registration No. TMA619,621 for the trade-mark LIPS (DESIGN), shown below:



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

Medicated and non-medicated topical preparations for human use for dryness, cold sores, burns, itching, for lip and skin care, for cleansing the skin, to prevent or alleviate the symptoms of acne and other skin affections, topical analgesic preparations, topical antibiotic preparations, medicated and non-medicated topical sun screen preparations for use on the lips and skin, and applicators or pads sold as a component with the foregoing items.

[3] 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 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 4, 2008 and May 4, 2011.

[4] The relevant definition of “use” in association with wares is set out in section 4(1) of the 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.

[5] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[6] In response to the Registrar’s notice, the Owner furnished the statutory declaration of Valerie Ryan, sworn on December 2, 2011. Both parties filed written representations; only the Requesting Party was represented at an oral hearing.

[7] In her declaration, Ms. Ryan identifies herself as the Marketing Manager for Blistex Corporation. She explains that the Owner is an American corporation that manufactures lip products bearing the Mark and that Blistex Corporation is the distributor of such products in Canada. She asserts use of the Mark during the relevant period only in association with the following two registered wares: “Medicated topical preparations for human use for dryness, cold sores, burns, itching, for lip” and “medicated topical sun screen preparations for use on the lips”. Attached as Exhibit VR-2 to the declaration are representative photos of the lip care products that Ms. Ryan attests were sold in association with the Mark during the relevant period.

[8] With respect to the remaining wares, including “non-medicated” versions of the foregoing, the Owner submitted no evidence of use and no evidence of special circumstances excusing non-use. Further, the Owner made no representations in support of these remaining wares. The registration will be amended accordingly.

[9] With respect to the two wares for which use was asserted, Ms. Ryan attests that these products were displayed and sold in association with the Mark during the relevant period through drug stores, grocery stores and other large retailers. Although the Mark did not appear directly on the products themselves, Ms. Ryan attests that the products were sold in point-of-sale displays bearing the Mark. Attached as Exhibit VR-3 to the declaration are two pictures of display stands that Ms. Ryan attests are representative of those “disseminated in Canada” during the relevant period.

[10] I agree with the Owner that the displays bear the Mark as registered. Further, I accept that display of the Mark on such in-store displays would bring the Mark to the attention of consumers at the time of transfer of the lip care products and, as such, would satisfy the requisite notice of association within the meaning of section 4(1) of the Act [see *Loblaws Ltd v Richmond Breweries Ltd* (1982), 73 CPR (2d) 258 (TMOB); *Riches McKenzie & Herbert LLP v Parissa Laboratories Inc* (2006), 59 CPR (4th) 219 (TMOB)].

Evidence of Sales

[11] The Requesting Party submitted that the Owner failed to provide any evidence of actual sales during the relevant period that originated from the use of the point-of-sale display stands.

[12] However, Ms. Ryan provides a table in her declaration, showing “the approximate sales figures for the sale of Products associated with [the Mark] in Canada during the last three years”. The table includes five products, including “Loblaws Lip Care Display”, with columns for “net sales”, “retail sales”, “retail sales from displays” and “retail sales remainder of display (to shelf)”. Although the Requesting Party took issue with the clarity and lack of explanation for some of the columns in the table, I accept that Ms. Ryan attests to sales of the Owner’s lip care products at the retail level.

[13] Further, while the table shows sales for a period that does not entirely coincide with the relevant period, the evidence as a whole must be considered, and I am satisfied that the volume of sales shown in the table support Ms. Ryan’s assertion that the Owner’s lip products were sold via the point-of-sale stands displaying the Mark during the relevant period.

[14] As such, and in view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 45 and 4(1) of the Act in association with the following wares only: “Medicated ... topical preparations for human use for dryness, cold sores, burns, itching, for lip ..., medicated ... topical sun screen preparations for use on the lips ...”.

Disposition

[15] 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, the registration will be amended to delete the following from the statement of wares: “... non-medicated ... and skin care, for cleansing the skin, to prevent or alleviate the symptoms of acne and other skin affections, topical analgesic preparations, topical antibiotic preparations, ... and non-medicated ... and skin, and applicators or pads sold as a component with the foregoing items”.

[16] The amended statement of wares will be as follows: “Medicated topical preparations for human use for dryness, cold sores, burns, itching, for lip, medicated topical sun screen preparations for use on the lips”.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office