

Section 45 Proceedings
Trade Mark: PROTEC'N TAN & DESIGN
Registration No.: TMA 397,548

On October 3, 1996, at the request of the firm Gowling, Strathy & Henderson, the Registrar forwarded a Section 45 Notice to 200219 AB. Ltd., the registered owner of the above-referenced trade-mark registration. The trade-mark PROTEC'N TAN & Design (shown below) is registered for use in association with the following wares:

- (1) Cosmetics namely; skin moisturizing lotion and sun screen.

In response to the Section 45 Notice, the registrant furnished the affidavits of Ursula Zinkowitz, Ana Martinez and Josef P. Zinkowitz. Both the requesting party and the registrant made written submissions in regard to the present proceedings. Neither party requested an oral hearing.

With regard to the affidavits of Ursula Zinkowitz and Ana Martinez, both affiants state their respective positions within companies that are in the business of operating a beauty salon. The affiants also assert that their companies have made purchases from De Loop Hair & Skin Care Products of items which prominently displayed the trade-mark PROTEC'N TAN & Design, and each affiant attaches a copy of one invoice to her respective affidavit as Exhibit 1.

With regard to the affidavit of Josef P. Zinkowitz, Mr. Zinkowitz states that he is a director, shareholder and employee of the registrant company, which carries on business using the trade style "De Loop Hair and Skin Care" (hereinafter "De Loop"). According to the affiant, in the normal course of trade De Loop is in the business of selling skin moisturizing lotions and sun screens. Mr. Zinkowitz claims this is a seasonal business, and at paragraph 3 he provides information regarding typical and average sales.

At paragraphs 4 and 5, the affiant provides the annual sales figure for De Loop for the fiscal year ending December 1995, as well as the projected sales figure for the year ending December 1996. He states that De Loop retains the services of inside and outside sales staff, domestic and foreign distributors, and export agents, and he allegedly attaches as Exhibit 1 copies of recent commission slips for sales by De Loop's staff and distributors.

At paragraph 6, Mr. Zinkowitz states that "our trade mark is used by printing our trade mark on the packages in which our wares are marketed". As Exhibit 2, he attaches "samples of labels currently being used in the sale and distribution in Canada of our wares." According to the affiant, as of the date of the Section 45 Notice, De Loop was selling and continues to sell wares described as skin moisturizing lotions and sun screens in 120 ml plastic squeeze containers wherein the trade-mark is printed directly on the container, and he refers to Exhibit 2.

The affiant also asserts that "routinely and regularly De Loop records the sales of its wares by the issue to our customers invoices and packing slips which prominently references [*sic*] our Trade Mark." To corroborate this assertion, he states that he is attaching as Exhibit 3, true copies of such invoices and packing slips used on or about October 3, 1996, which he claims are typical of those used prior to and since October 3, 1996.

At paragraphs 11, 12 and 13, Mr. Zinkowitz states that De Loop advertises its wares and services by means of the distribution of literature, purchasing radio and television advertising, and Yellow Page type advertising. As Exhibits 4, 5 and 6, respectively, he allegedly attaches true copies of such advertising.

Paragraph 14 of the affidavit has been crossed out and initialled. At paragraph 15, the affiant deposes that De Loop participates in trade shows, and he claims that he is attaching as Exhibit 8 true copies of photos that detail typical booths used by De Loop. However, I note that there is no Exhibit 8 attached to the affidavit.

The main arguments of the requesting party may be summarized as follows: (1) the affidavits of Ursula Zinkowitz and Ana Martinez are virtually identical and should be given no separate weight or credit; further, neither of these affidavits refers to the registered wares nor provides evidence of use of the registered mark; (2) the credibility of the affidavits of Ursula Zinkowitz and Josef P. Zinkowitz is questionable, as the relationship between the affiants has not been explained; (3) there is no documentary evidence showing that “De Loop Hair and Skin Care” is a registered trade name of the registrant; (4) the Exhibits bear the names of various entities which are not the names of the registrant or its trading style; (5) the documents attached as Exhibits do not correspond with the affiant’s description of the Exhibits.

The registrant, in its written submissions, reviews the requirements for showing use of a trade-mark, as set out in the jurisprudence. The registrant then submits that the evidence furnished by it clearly shows the normal course of trade and use by the registered owner of the trade-mark during same.

At the outset, I note that the requesting party has attempted to file evidence along with its written submissions. As noted in *Meredith & Finlayson v. Canada (Registrar of Trade Marks)* (1991), 40 C.P.R. (3d) 409 (F.C.A.) at 412, it is clear from s. 45(2) of the *Act* that the Registrar may only receive evidence tendered by or on behalf of the registered owner. Consequently, I have disregarded paragraph 27 of the requesting party’s written submissions as well as the evidence attached thereto. I would add that compliance with other Acts is not a proper consideration in Section 45 proceedings (see *Lewis Thomson & Sons Ltd. v. Rogers, Bereskin & Parr* (1988), 21 C.P.R. (3d) 483 (F.C.T.D.) at 487).

Having reviewed the evidence, I am not satisfied that the registrant in this case has furnished reliable evidence showing use of its trade-mark, for the following reasons.

Regarding the affidavits of Ursula Zinkowitz and Ana Martinez, I agree with the requesting party that these affidavits are form affidavits which are essentially identical in content but for reference to different names and numbers of items purchased. I therefore attribute only minimal weight to the content of these affidavits (see *Manufacturiers de Bas de Nylon Doris Ltée / Doris Hosiery Mills*

Ltd. v. Victoria's Secret, Inc. (1991), 39 C.P.R. (3d) 131 at 135 (T.M.O.B.)). In any event, although these affidavits show purchases the two companies have made from the registrant, they do not show the **type of products** purchased. Furthermore, as the affiants have not attached photographs or copies of products purchased, nor even **described** how the mark appeared on the wares, I find that the affidavits of Ursula Zinkowitz and Ana Martinez are of no use in showing the association between the mark and the wares at the time of transfer.

Concerning the Exhibits attached to the affidavit of Josef P. Zinkowitz, I concur with the requesting party that at least some of the documents do not appear to correspond with the description thereof in the affidavit. With respect to Exhibit 1, the affiant states that he is attaching "copies of recent commission slips for sales by our staff and distributors." However, what has been furnished is a copy of only one invoice, which invoice bears the reference "**administrative services**", and the same amount is invoiced for each of the months of July, August and September 1996. I therefore find the documentary evidence brings into question whether the invoice actually pertained to commissions, and even if it did, the evidence does not show whether any of the registered wares were sold by the person who submitted the invoice.

With respect to Exhibit 3, Mr. Zinkowitz refers to same as "true copies of such invoices and packing slips used on or about October 3, 1996. These invoices and packing slips are typical of the invoices and packing slips used prior to and since the material date of October 3, 1996." However, the only invoices he has provided which refer to sales of Protec'N Tan wares bear dates in **July 1990**. it seems incredible that if sales were in fact made during the relevant period, the registrant would seek to show same by attaching copies of invoices bearing dates six years prior to the date of the Notice. If sales were made during the relevant period, it should have been simple for the affiant to include relevant invoices; however, he chose not to do so. I therefore have serious doubts about whether these invoices were used **on or about October 3, 1996**, as alleged by the affiant; accordingly, I am not prepared to rely on the copies of invoices or the statements pertaining thereto as evidence of transfers of the registered wares during the relevant period.

I would also agree with the requesting party that Exhibit 5 does not consist of true copies of a script for radio and television advertising used by De Loop for advertising its wares and services, as stated by the affiant. Rather, the document attached as Exhibit 5 would appear to be a coupon of some sort.

Exhibit 8 is inexplicably missing from the Josef P. Zinkowitz affidavit. As no copies of photographs have been submitted with the affidavit, any such photographs referred to by Mr. Zinkowitz are not part of the evidence of record in these proceedings.

As noted by Cattnach J. in *Aerosol Fillers Inc. v. Plough (Canada) Ltd.* (1979), 45 C.P.R. (2d) 194 at 198, [1980] 2 F.C. 338 (T.D.); aff'd 53 C.P.R. (2d) 62, [1981] 1 F.C. 679, 34 N.R. 39 (C.A.), affidavits in Section 45 proceedings are not subject to the crucible of cross-examination and contradictory affidavits are prohibited, and the Registrar is under a special duty in such proceedings to ensure that only reliable evidence is received. In my view, the aforementioned discrepancies bring into question the reliability of Mr. Zinkowitz's evidence; I therefore attribute no weight to those portions of Mr. Zinkowitz's evidence discussed, *supra*, and I find that I must exercise extreme caution in considering the remainder of the affidavit.

With respect to transfers of the registered wares, I find that the evidence is unclear in this regard. At paragraph 3, the affiant mentions that De Loop is in the business of selling skin moisturizing lotions and sun screens. However, he does not specify the **trade-mark(s)** under which such products are sold. Then, at paragraph 4, the affiant refers to sales during the fiscal year ending December, 1995 in the amount of \$150,000. Again, he does not mention any trade-marks, nor does he state that sales of the registered wares in association with the trade-mark PROTEC'N TAN & Design were included in this sales figure. It is clear from the affidavit and the Exhibits that the business of the registrant is not restricted to sales of the registered wares in association with the subject mark (for example, the affiant states at paragraph 13 that "Routinely and regularly De Loop advertises **its wares and services . . .**"). Accordingly, in the absence of a clear statement, I am not prepared to infer that the sales figure provided at paragraph 5 includes sales of the **registered wares in association with the subject mark.**

Concerning use during the relevant period, at paragraph 6 of the affidavit, the affiant states that Exhibit 2 consists of samples of labels “currently being used in the sale and distribution in Canada of our wares” [emphasis added]. He does not specify that labels of this sort were used **during the relevant period** in association with any of the wares sold. Then at paragraph 7, Mr. Zinkowitz states that as of October 3, 1996, the registrant was selling and continues to sell the registered wares in association with the trade-mark. Thus, he does not inform whether the registrant was selling the registered wares bearing the subject mark **during the three year period preceding the date of the Section 45 Notice, i.e. prior to October 3, 1996**, and none of the Exhibits show sales during such period. Similarly, the references in paragraphs 10, 11, 12, 13 and 15 to use “prior to and since the material date of October 3, 1996” do not constitute unequivocal allegations of use during the three year period preceding October 3, 1996.

In my view, the affidavit of Josef P. Zinkowitz is replete with ambiguities, which I conclude must be resolved against the registrant (see *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62, [1981] 1 F.C. 679, 34 N.R. 39 (C.A.)). As the registrant has failed to furnish reliable evidence showing transfers of the registered wares in association with the trade-mark PROTEC’N TAN & Design during the relevant period, I find that use of the mark in compliance with the provisions of ss. 45(1) and 4(1) of the *Act* has not been shown.

I would add that advertising is not sufficient to show use of a trade-mark with wares (see, for example, *Parker-Knoll Ltd. v. Registrar of Trade Marks* (1977), 32 C.P.R. (2d) 148 (F.C.T.D.)). Accordingly, even if I had found paragraphs 11, 12, 13 and 15 of the Josef P. Zinkowitz affidavit to be reliable, such evidence would not have been sufficient to show use of the trade-mark PROTEC’N TAN & Design in association with the registered wares.

I would also add that I agree with the requesting party that several of the Exhibits refer to entities that are neither the company name nor the trade name of the registrant; for example, the advertisement attached as Exhibit 6 refers to “De Loop Beauty Supplies”. This is yet another deficiency in the evidence, and in the absence of an explanation from the affiant on this point, I would have been inclined to conclude that any use shown by such Exhibits did not accrue to the registrant.

As stated in *Philip Morris Inc. v. Imperial Tobacco Ltd.* (1987), 13 C.P.R. (3d) 289 (F.C.T.D.) at 293, “Evidence in response to a s. 44 [now s. 45] notice should be forthcoming in quality, not quantity, and there is no need nor justification for evidentiary overkill.” The evidence in the present case, in my opinion, is simply **not forthcoming in quality** and does not show use of the mark in association with the registered wares in compliance with the provisions of ss. 4(1) and 45(1) of the *Act*. Further, in its written submissions, the requesting party pointed out a number of valid concerns regarding the reliability of the evidence furnished by the registrant, and the registrant elected not to address these concerns in its written submissions.

In view of the evidence furnished, I have concluded that the registrant has failed to show that the registered trade-mark PROTEC’N TAN & Design was in use in Canada in association with “cosmetics namely; skin moisturizing lotion and sun screen” during the three year period immediately preceding the date of the Section 45 Notice, as required by s. 45(1) of the *Act*. I therefore conclude that Registration No. TMA 397,548 ought to be expunged.

Disposition:

In view of the evidence furnished, and in compliance with the provisions of Section 45(5) of the *Act*, Registration No. TMA 397,548 will be expunged from the register.

DATED AT HULL, QUEBEC, THIS 7th DAY OF August, 1997.

C.J. Campbell
Hearing Officer
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