

SECTION 45 PROCEEDINGS
TRADE-MARK: L'OREAL RENOVATIVE
REGISTRATION NO.: 335,060

On March 30, 1994 at the request of Johnson & Johnson, represented by Messrs. Baker McLachlen, the Registrar forwarded a Section 45 notice to L'Oréal Rénovative, Société anonyme, the registered owner of the above-referenced trade-mark registration.

The trade-mark L'OREAL RENOVATIVE is registered for the following wares:

"Coloration pour les cheveux".

In response to the Registrar's notice, the affidavit of Thérèse Haraoui was furnished. Each party filed a written submission and was represented at an oral hearing.

One argument raised by the requesting party is that the evidence was not tendered by or on behalf of the registrant and it relies on the decisions in Registrar of Trade Marks v. Securicor Investigation & Security Ltd., 32 C.P.R.(3d) 512, and Registrar of Trade Marks v. Harris Knitting Mills Ltd., 4 C.P.R.(3d) 488 (F.C.A.).

Ms. Haraoui identifies herself as the Director of Legislative Affairs and Marks of Cosmair Canada Inc. By virtue of her position and functions with such company she states that she has knowledge of the affairs of the company and that she has access to all documents and information pertaining to the present case. She adds that because of her position with "Cosmair", and because of the relationship between "Cosmair" and "L'Oréal", "Cosmair" being the exclusive distributor of "L'Oréal" products in Canada, she has access to certain information concerning the marketing in Canada of products of "L'Oréal" and is equally in a position to obtain from "L'Oréal" all pertinent information. She then adds that she has the authority to represent "L'Oréal" in this case and is authorized to make the affidavit in response to the Registrar's notice.

The above satisfies me that the affidavit has been tendered on behalf of "L'Oréal" and I respectfully disagree with the requesting party that something more was required in order to conclude that the evidence was being tendered on behalf of the registrant.

The requesting party also argues that the evidence merely contains a statement that the trade-mark is in use without showing how it is in use; that the evidence is ambiguous concerning the normal course of trade of the registrant for the wares in association with the mark; and that concerning the

trade-mark being in use, it argues that any evidence of use is of the trade-mark RENOVATIVE and not L'OREAL RENOVATIVE.

I must agree with the requesting party that the evidence is not overwhelming and that it is not as precise as it could have been. I also agree that most of the exhibits (invoices, price lists, purchase order forms) do not refer to the trade-mark L'OREAL RENOVATIVE but to the trade-mark RENOVATIVE which would not be considered use of the trade-mark as registered. However, Exhibit TH-1 shows the words L'OREAL RENOVATIVE as they appear on the container for the registrant's wares. Concerning such exhibit, Ms. Haraoui has stated the following at paragraph 6:

"Depuis l'année 1987, L'Oréal fabrique et vend au Canada une préparation pour la coloration des cheveux en association avec sa marque déposée L'OREAL RENOVATIVE. Cette préparation est pour usage professionnel seulement et de ce fait, Cosmair distribue celle-ci uniquement aux salons de coiffure. Je produis, comme élément TH-1 au soutien de mon affidavit, une fiche technique-produit reproduisant le contenant de la préparation capillaire lequel n'est pas chemisé."

In view of the fact that the container for the wares bears the trade-mark as registered, and the fact that Ms. Haraoui has stated that it represents the container for the wares which have been produced and sold by L'Oréal since 1987, I am prepared to infer that the sales of "RENOVATIVE" products mentioned in the invoices submitted as Exhibit TH-3 would have consisted of sales of the wares in containers similar to those shown in Exhibit TH-1.

I note that on the container, the name Cosmair Canada Inc. appears and that such company was a registered user prior to the change to the Act on June 9, 1993. I therefore accept that any use shown by Cosmair prior to June 9, 1993 would accrue to the registrant.

Concerning the sales of the wares in Canada as shown in evidence, and concerning the registrant's normal course of trade in Canada for the wares, I must agree that the evidence is somewhat ambiguous. Ms. Haraoui has submitted that "Cosmair" is the exclusive distributor of the wares and she has provided copies of invoices which she states show sales by "Cosmair". However, the invoices would appear to show sales by Vincent Ltée/Vincent Ltd., a distributor of L'Oréal Technique Professionnelle Products. I am of the view that Ms. Haraoui should have commented on such company; nevertheless, such company is identified on the invoices as being merely a distributor. Consequently, I am prepared to conclude that Vincent Ltée would be a distributor of the products of "Cosmair" and that any sales by such company of the wares in containers similar to the ones submitted as Exhibit TH-1 still would be use of the trade-mark by "Cosmair" and that any sales prior to June 9, 1993 would accrue to the registrant, since "Cosmair" was at the time registered as

a registered user of the trade-mark (Section 50 of the Act, prior to June 9, 1993). Therefore, the invoice dated December 17, 1992 shows use that accrues to the registrant. Concerning a single sale, I refer to the case Phillip Morris Inc. v. Imperial Tobacco Ltd., 13 C.P.R.(3d) 289.

The requesting party has commented on the fact that "Cosmair" is identified in the affidavit, as the "exclusive distributor", yet the invoices show "Vincent Ltd." also as a distributor. I agree that this is puzzling, however, as stated by counsel for the registrant, this situation does not make the invoices irrelevant.

Concerning the other business names such as "L'Oréal Technique Professionnelle" and "L'Oréal Coiffure-Ecoles", which appear either on the price lists, or "fiche technique" or "purchase order forms", again I agree that their appearance should have been explained. Nevertheless, they appear merely as trade names or trading styles and I am not prepared to infer that they are distinct entities from the registrant.

As a final note, I would state that it is somewhat surprising that a trade-mark owner would be so cavalier in defending its trade-mark rights. In the present case, I was left to draw inferences from the sketchy materials submitted when it would have been quite simple for the registrant to have been more explicit concerning the materials furnished.

However, notwithstanding the shortcomings in Ms. Haraoui's affidavit, I was able to conclude that the trade-mark was being used some time during the relevant three-year period by the registrant (see Section 45(1) as amended January 1, 1996 by the World Trade Organization Agreement Implementation Act).

Registration No. 335,060 will therefore be maintained, in compliance with the provisions of Section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 14th DAY OF June, 1996.

D. Savard
Senior Hearing Officer
Section 45 Division