

SECTION 45 PROCEEDINGS
TRADE-MARK: SKIN
REGISTRATION NO.: TMA461,104

On March 9, 2004, at the request of Riches, McKenzie & Herbert LLP, the Registrar issued the notice prescribed by section 45 to Parfums de Coeur Ltd., the registered owner of the above-mentioned registration.

The trade-mark SKIN is registered in association with cologne.

Section 45 of the *Trade-marks Act* requires the registered owner of a trade-mark to indicate whether the mark has been used in Canada in association with each of the wares and services listed in the registration at any time during the three years preceding the date of the notice and, if not, the date on which it was last used and the reason why it has not been used since that date. The relevant period in this case is any time between March 9, 2001 and March 9, 2004. What qualifies as use of a trade-mark is defined in s. 4 of the Act.

In reply to the notice, the registrant furnished the affidavit of Mark A. Laracy. Both parties submitted a written argument. An oral hearing was not requested.

Mr. Laracy is the registrant's President. His evidence may be summarized as follows:

- Parfums de Coeur, Ltd. acquired the SKIN mark from Bonne Bell, Inc. on January 15, 2003.
- The registrant was not able to commence distribution of SKIN products until later in 2003 – an invoice dated December 18, 2003 to Wal-Mart Canada in Ontario has been provided. It shows the sale of 36 items described as SKNMSK .5OZ SKIN OIL, SKNMSK 1OZ COL, and SKNMSK 2OZ COL. Mr. Laracy attests that these products are bottles of SKIN cologne and that each bottle bore the brand name SKIN. He provides a copy of the packaging in which such wares were distributed in Canada. This exhibit (No. 5) displays the word SKIN in a large,

fanciful font, with the word “musk” appearing below it in much smaller, standard font. Both words are enclosed inside a box, below which appear the words “cologne spray” in smaller, standard font.

- Sales to Canada have been interrupted because of bilingual language requirements which the registrant had to comply with but, as of August 16, 2004, arrangements were in place for anticipated major sales to Wal-Mart Canada (Wal-Mart U.S.A. being a major client in the United States). Such sales were expected to occur late in 2004 and “certainly by the first quarter of 2005”.
- The registrant’s predecessor-in-title, Bonnie Bell, Inc., sold SKIN cologne in Canada in each of the years 2000, 2001 and 2002. Canadian sales figures have been provided for each of these years, together with invoices issued by Bonne Bell, Inc. in 2002 to Canadian retailers for Skin Musk Spray and Skin Musk Oil.

In its written argument, the requesting party’s main argument is that the evidence shows use of SKIN MUSK, not SKIN. In support, it points to the appearance of ® on the packaging to the right of the word “musk” and the fact that the other exhibits always refer to “msk” when they refer to “skn”. The requesting party relies upon *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (T.M.O.B.) and *Registrar of Trade Marks v. CII Honeywell Bull, S.A.*, 4 C.P.R. (3d) 523 (F.C.A.), as well as the s. 45 decision re registration No. TMA279,556 for the trade-mark HERITAGE.

In its written argument, the registrant points out that “musk” is a scent and I can take judicial notice of this meaning, as evidenced by dictionaries. It also submits that it would be clear to purchasers that SKIN is the cologne’s trade-mark and “musk” is its scent. Concerning the appearance of ®, it submits that it is located to the base and to the right of the letter “n” in the SKIN trade-mark. It argues that none of the cases cited by the requesting party supports the requesting party’s position that SKIN is not being used. It says that *Honeywell* does not apply because the mark at issue here has not been absorbed into a broader expression. It submits that because SKIN appears on the packaging in large, unique lettering, it has not lost its identity or become unrecognizable. Moreover, it says that the test in *Nightingale* actually

supports its position because that decision tells us to consider if the mark stands out from other material, by means of the type or size of the lettering. It distinguishes the *Heritage* decision by saying that the words there all appeared in the same font and letter size. Furthermore, it relies on *Little Eagle Corp. v. Aliments Dainty Foods Inc.* (1994), 53 C.P.R. (3d) 573 where the appearance of a descriptive word below a trade-mark, in the same size and type of font, did not prevent the maintenance of the registration pursuant to s. 45.

Having considered the evidence and both sides' submissions, I am satisfied that the trade-mark SKIN was in use in Canada in association with cologne during the material three-year period in the registrant's normal course of trade. I am satisfied that the packaging shows use of SKIN *simpliciter* as a trade-mark. Use of a mark in combination with additional material constitutes use of the mark *per se* as a trade-mark if the public, as a matter of first impression, would perceive the mark *per se* as being used as a trade-mark. This is a question that depends on whether the mark stands out from the additional material (e.g., by means of different lettering or sizing) or whether the additional material would be perceived as purely descriptive. Since the word "musk" both describes a certain scent of cologne and is presented in smaller and different font, the packaging would be perceived as referring to the owner's SKIN brand of musk cologne. I do not consider the placement of ® on the packaging to be a deciding factor because it is somewhat ambiguous and could be interpreted in a number of ways by consumers. Bearing in mind the purpose and summary nature of s. 45 proceedings, I find that the SKIN trade-mark is not deadwood.

Registration No. TMA461,104 will therefore be maintained in accordance with the provisions of s. 45(5) of the Act.

DATED AT TORONTO, ONTARIO THIS 24th DAY OF JANUARY 2006.

Jill W. Bradbury
Member
Trade-marks Opposition Board