



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

Citation: 2011 TMOB 21
Date of Decision: 2011-01-26

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Balmshell Inc. against registration
No. TMA544,190 for the trade-mark FETISH in the name
of Finanz St. Honoré, B.V.**

[1] On February 27, 2009, at the request of Balmshell Inc. (the Requesting Party), the Registrar forwarded a notice under s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) to Finanz St. Honoré B.V. (the Registrant) the registered owner of the trade-mark FETISH registration number TMA544,190 (the Mark) covering the following wares:

Cosmetics and fragrances namely adhesive for attaching artificial nails, adhesive for attaching artificial eyelashes, after-shave lotion, antiperspirant, artificial/false eyelashes, artificial/false nails, artificial/false nail tips, astringent for cosmetic purposes, baby shampoo, bath gel, bath oil, powder, bath salts, beauty masks, blusher, body cream, body lotion, body oil, body powder, body soap, bubble bath, cologne, compacts, cosmetic pencils, cotton for cosmetic purposes, cotton puffs for cosmetic purposes, cotton sticks for cosmetic purposes, cotton swabs for cosmetic purposes, cotton swabs for personal use, cold cream, curl paper, cuticle removing preparations, deodorant soap, emery boards, eye cream, eye makeup, eye makeup remover, eye pencils, eye shadow, eyebrow pencils, eyeliner, face powder, face soap, facial lotion, facial makeup, facial scrub, foot powder, foundation makeup, grooming shampoo, hair bleaching preparations, hair care preparations, hair cleaning preparations, hair color remover, hair conditioner, hair dressing, hair dye, hair gel lightener, hair lotion, hair relaxing preparations, hair removing cream, hair rinse, hair shampoo, hair spray, hair straightening preparations, hair styling preparations, hair waving lotion, hand cream, hand soap, hydrogen peroxide for use on hair, incense, lip balm, lip gel, lip gloss, lipstick, liquid soap, makeup, makeup remover, mascara, massage oil, nail buffing preparations, nail care preparations, nail enamel, nail glitter, nail glue, nail grooming products, namely tips, glue, glitter, lacquer, and

artificial nail removing preparations, nail hardener, nail lacquer, nail polish, nail polish base coat, nail polish remover, nail polish top coat, nail strengthener, nail tips, night cream, essential oils for personal use, essential oils for use in manufacturing cosmetics, perfume, petroleum jelly for cosmetic purposes, powder, pre-moistened cosmetic tissues, pre-moistened cosmetic towelettes, pre-moistened cosmetic wipes, rouge, sachets, shaving balm, shaving cream, shaving gel, shaving lotion, shower gel, skin clarifier, skin cleansing cream, skin cleansing lotion, skin cream, skin emollient, skin lightener, skin lotion, skin moisturizer, skin toner, soap, sun block preparations, sun screen preparations, suntanning preparations, talcum powder, toilet soap, toilet water, vanishing cream, and decorative nail accessories used with finger and/or toe nails, namely, glitter, studs, beads, foil, decals, tattoos, and paper-backed transfers (the Wares).

[2] Such notice requires the Registrant to show whether the Mark has been used in Canada in association with the Wares 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 use since that date. The relevant period in this case is any time between February 27, 2006 and February 27, 2009 (the Relevant Period).

[3] In response to the notice, the Registrant filed the affidavits of Constantin Iliopoulos and Joseph Sienkiewicz. Only the Registrant filed written representations and no oral hearing was requested.

[4] Section 45 proceedings are considered to be summary and expeditious for clearing the register of non-active trade-marks. The expression “clearing deadwood” has been often used to describe such proceeding [see *Philip Morris Inc. v. Imperial Tobacco Ltd.* (1987), 13 C.P.R. (3d) 289].

[5] A simple allegation of use of the Mark is not sufficient to evidence its use in association with the Wares within the meaning of s. 4 of the Act. There is no need for evidentiary overkill establishing such use. However any ambiguity in the evidence filed shall be interpreted against the owner of the Mark [See *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980) 53 C.P.R. (4th) 62 and *Footlocker Group Canada Inc. v. Steinberg* (2005), 38 C.P.R. (4th) 508]. It is with these general principles in mind that I shall now summarize the evidence filed.

[6] Mr. Sienkiewicz has been the Chief Financial Officer of Dana Classic Fragrances Inc. (Dana) and states that he is a duly authorized representative of the Registrant. He states that the

Registrant requests that the registration of the Mark be maintained solely for fragrances, namely cologne (Fragrance Wares) on the basis of the evidence described hereinafter.

[7] He states that the Registrant has used the Mark in Canada through licenses granted to affiliate companies. Dana is a wholly-owned subsidiary of IMG Holdings Inc., the ultimate parent company of the Registrant. Dana Classic Fragrances Canada Inc. (Dana Canada) is a company incorporated in July 1999 and is a wholly-owned subsidiary of the Registrant. The Registrant is the sole shareholder of Dana Canada.

[8] By licensing agreement dated and effective as of December 29, 2003 the Registrant licensed certain trade-marks, including the Mark to Dana as licensee to manufacture, market and distribute fragrance products under the Mark for the world, which include the territory of Canada and with the right to appoint distributors within the permitted territory. A copy of the license agreement has been filed. Dana Canada is the distributor of fragrance products bearing the Mark as supplied by Dana for sale in Canada.

[9] To illustrate the use of the Mark in Canada during the relevant period, Mr. Sienkiewicz has filed specimen packaging of Fragrance Wares bearing the Mark as sold in Canada by the Registrant through Dana and Dana Canada.

[10] Mr. Sienkiewicz alleges that the Fragrance Wares bearing the Mark are sold in Canada by Dana Canada to mass marketers and retail locations such as national drugstore chains and department stores. He filed a specimen invoice dated September 14, 2007 issued by Dana Canada to evidence the sale in Canada of the Fragrance Wares bearing the Mark during the Relevant Period.

[11] Mr. Iliopoulos has been the General Manager of Dana Canada. He states that Dana Canada is a wholly-owned subsidiary of the Registrant. He provides the same information given by Mr. Sienkiewicz on the corporate structure of Dana and Dana Canada and their relationship with the Registrant.

[12] Mr. Iliopoulos has filed copies of specimen packaging for the Fragrance Wares bearing the Mark as sold in Canada during the Relevant Period. He filed a copy of the same invoice attached to Mr Sienkiewicz's affidavit and alleges that such invoice was issued by Dana Canada

to the head office of Uniprix, a Quebec pharmacy chain. He explains that the product code number 66261 mentioned on the said invoice corresponds to the Fragrance Wares bearing the Mark.

[13] From this evidence I conclude that there exists a license agreement between the Registrant and Dana. Moreover Dana Canada, a wholly-owned subsidiary of the Registrant, acts as a distributor and was appointed as such pursuant to the terms and conditions of the license agreement concluded between the Registrant and Dana.

[14] The evidence described above shows that the Mark has been used in Canada during the Relevant Period within the meaning of s. 4(1) of the Act in association with Fragrance Wares, as any sales of those wares by Dana Canada is deemed to be use of the Mark by the Registrant pursuant to s. 50 of the Act.

[15] No facts have been provided that could be considered as special circumstances within the meaning of s. 45(3) of the Act to justify the non-use of the Mark by the Registrant in association with the other wares during the Relevant Period. As such the registration shall be maintained only with respect to Fragrance Wares.

Disposition

[16] In view of all of the foregoing, pursuant to the authority delegated to me under s. 63(3) of the Act, registration TMA544,190 will be amended to delete all wares except for “fragrances, namely cologne” in compliance with the provisions of s. 45(5) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office