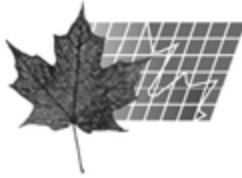


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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2018 TMOB 21

Date of Decision: 2018-02-27

IN THE MATTER OF A SECTION 45 PROCEEDING

Sim & McBurney

Requesting Party

and

Maritime Beauty Supply Co., Ltd.

Registered Owner

**TMA729, 082 for ESSENTIAL
ELEMENTS**

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA729, 082 for the trade-mark ESSENTIAL ELEMENTS (the Mark), owned by Maritime Beauty Supply Co., Ltd.

[2] The Mark is currently registered in association with the following goods and services:

Goods:

Make-up, lipsticks, lip glosses, foundation, blush, eye shadow, hair care preparations, hair gels, hair mousse and hair spray, nail polish, nail care preparations, perfumery, skin care preparations, hand and foot creams; hair bleaching, perming and coloring preparations; nail and foot files; waxing preparations; massage body lotions/oils;

electrical hair tools/ appliances namely curling irons, straightening irons, hair dryers, hot rollers, styling brushes.

Services:

Retail and wholesale supply of hair, beauty and Spa products.

[3] For the reasons that follow, I conclude that the registration ought to be maintained in part with respect to the goods, but amended to delete the services in their entirety.

THE PROCEEDINGS

[4] On February 12, 2016, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Maritime Beauty Supply Co., Ltd. (the Owner). The notice was sent at the request of Sim & McBurney (the Requesting Party).

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between February 12, 2013 and February 12, 2016, in association with each of the goods and services specified in the registration. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[6] The relevant definitions of use in the present case are set out in sections 4(1) and 4(2) of the Act as follows:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[7] Section 45 proceedings are considered to be summary and expeditious for clearing the register of non-active trade-marks. The expression “clearing deadwood” has often been used to

describe such proceedings [*Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD)]. While it is true that the threshold for establishing use in a section 45 proceeding is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD) at 480; *Austin Nichols & Co v Cinnabon, Inc* (1998), 82 CPR (3d) 513 (FCA)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the registered goods and services during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270].

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Peter Alexander, sworn September 6, 2016, together with Exhibits A to D.

[9] Only the Owner filed written submissions. Neither party requested a hearing.

THE EVIDENCE

[10] Mr. Alexander is the General Manager of the Owner.

[11] Mr. Alexander explains that the Owner began business in 1966 as a full service professional beauty supply distributor in the Maritime Provinces. He attests that one of brands the Owner sells is called ESSENTIAL ELEMENTS, which is a brand of hair care preparations and hair bleaching preparations consisting of shampoo, conditioner, peroxide and peroxide substitutes known as stabilized developers.

[12] Mr. Alexander attests that the Owner has been selling the aforementioned ESSENTIAL ELEMENTS branded products consistently since the Mark was registered in Canada. He further attests that the ESSENTIAL ELEMENTS hair care preparations are primarily sold to hair care professionals (salons and stylists) via telephone or online order through the Owner's website *maritimebeauty.com*. The preparations are then shipped out via courier. He attests that during the past three years the Owner has sold on average \$6000 to \$7000 CAD worth of ESSENTIAL ELEMENTS branded hair care and bleaching preparations per month.

[13] In support of the aforementioned, Mr. Alexander provides Exhibits A, B, C, and D. Exhibit A is a sales report, consistent with his above-noted attestation, showing specific dollar and unit amounts of various ESSENTIAL ELEMENTS hair care and bleaching preparations sold

per month from May 2014 to April 2016. Exhibit B consists of copies of invoices for hair care preparations and hair bleaching preparations sold in Canada during the relevant period. Mr. Alexander highlights the ESSENTIAL ELEMENTS hair care and bleaching preparations on the invoices. Exhibit C shows representative photographs of hair care preparations and hair bleaching preparations clearly bearing the ESSENTIAL ELEMENTS Mark. Lastly, Exhibit D consists of representative invoices showing the purchase of hair care preparations and hair bleaching preparations from the Owner's manufacturer, Marianna Industries, during the relevant period.

ANALYSIS AND REASONS FOR DECISION

[14] The Owner provides brief submissions essentially referring to a summary of Mr. Alexander's affidavit and associated exhibits. The Owner concludes that based on its evidence, it has met the onus under section 45 to show that its trademark is being used in Canada in association with goods. Therefore, it requests that the Mark be maintained.

[15] While I note that Mr. Alexander's affidavit speaks to the Mark being used in association with hair care preparations and hair bleaching preparations, the affidavit and evidence are silent with respect to the following registered goods:

Make-up, lipsticks, lip glosses, foundation, blush, eye shadow, [...], hair gels, hair mousse and hair spray, nail polish, nail care preparations, perfumery, skin care preparations, hand and foot creams; hair [...], perming and coloring preparations; nail and foot files; waxing preparations; massage body lotions/oils; electrical hair tools/appliances namely curling irons, straightening irons, hair dryers, hot rollers, styling brushes.

[16] Furthermore, although the Owner sells ESSENTIAL ELEMENTS branded hair care and hair bleaching preparations, there is no evidence that the Mark has been used or displayed in the advertising or the performance of the services.

[17] As no special circumstances have been brought forth which would excuse the absence of use of the Mark with respect to these goods and services, they will be deleted from the registration.

[18] As previously indicated, Mr. Alexander's assertions and evidence of use of the Mark only relate to hair care preparations and hair bleaching preparations. With respect to these specific goods, I accept that the Owner has demonstrated use of the Mark in compliance with sections 4(1) and 45 of the Act. In this regard, Mr. Alexander has provided photographs of hair care and hair bleaching preparations clearly bearing the Mark, which he attests were sold in Canada. In addition, he has provided representative invoices which show the sale of these products during the relevant period in Canada, together with supporting sales figures. Such evidence is sufficient, to establish that sales were made of hair care and hair bleaching preparations bearing the Mark in the normal course of trade during the relevant period in Canada; in other words, the Owner has established a *prima facie* case of use with respect to each of these goods.

DISPOSITION

[19] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the services in their entirety as well as to delete the following goods in compliance with the provisions of section 45 of the Act:

Make-up, lipsticks, lip glosses, foundation, blush, eye shadow, [...], hair gels, hair mousse and hair spray, nail polish, nail care preparations, perfumery, skin care preparations, hand and foot creams; [...], perming and coloring [...]; nail and foot files; waxing preparations; massage body lotions/oils; electrical hair tools/appliances namely curling irons, straightening irons, hair dryers, hot rollers, styling brushes.

[20] The amended statement of goods will be as follows:

Goods:

Hair care preparations; hair bleaching preparations.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE No Hearing Held

AGENTS OF RECORD

MacRae & Co.

FOR THE REGISTERED OWNER

Baker & McKenzie LLP

FOR THE REQUESTING PARTY