



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 45

Date of decision: 2021-03-16

[UNREVISED ENGLISH

CERTIFIED TRANSLATION]

IN THE MATTER OF A SECTION 45 PROCEEDING

Cassels Brock & Blackwell LLP

Requesting Party

and

Clinique mon cheveu Inc.

Registered Owner

TMA907,259 for FUR

Registration

INTRODUCTION

[1] At the request of Cassels Brock & Blackwell LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on November 26, 2018, to *Clinique mon cheveu Inc.* (the Owner), the registered owner of registration No. TMA907,259 for the trademark FUR (the Mark).

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

[TRANSLATION]

GOODS

- (1) Shampoos, sunscreens, body moisturizing creams (hereinafter the “Goods”).
- (2) T-shirts, polo shirts, caps.

SERVICES

- (1) Consultation and aesthetics services in the field of hair restoration and hair loss (hereinafter “Consulting Services”).
- (2) Distribution of information in the fields of hair restoration and the treatment of hair loss through printed and electronic documents, videos and websites (hereinafter “Information Distribution Services”).
- (3) Training and technical assistance in the fields of hair restoration and hair loss.
- (4) Third-party licensing for know-how in hair restoration techniques and hair loss treatments.
- (5) Advertising services for third parties through advertising on websites, billboards and print, audiovisual and electronic media.

[3] Section 45 of the Act requires that the registered owner of the trademark indicate, for each of the goods and services described in the registration, whether the trademark has been used in Canada at any time within the three-year period immediately preceding the date of the notice and, if not, that it indicate the date when it was last used and the reason for the absence of such use since that date. In this case, the relevant period during which use is to be established is from November 26, 2015 to November 26, 2018.

[4] In response to the Registrar’s notice, the owner furnished an affidavit of Ronald Plante, President of the Owner, executed on February 18, 2019, to which were attached Appendices A to K.

[5] Only the Owner submitted written representations. No oral hearing was held.

SUMMARY OF EVIDENCE ON FILE

[6] In his affidavit, Mr. Plante explains that the Owner is [TRANSLATION] “a corporation operating in the field of hair products and aesthetics related to hair restoration and hair loss” [para 1].

[7] Mr. Plante states that, during the relevant period, the Mark was displayed on the container of the Goods [para 7] and that the Owner sold the Goods in Canada in the normal course of trade throughout the relevant period [paras 9 and 10]. He attached to his affidavit excerpts from the Owner’s Facebook page showing shampoo, sunscreen and emu oil containers [para 8, Appendix B].

[8] Mr. Plante also states that, during the relevant period, the Owner provided Consulting Services [para 12] and Information Distribution Services [para 14] (collectively, the Services).

[9] In support of his statements concerning the sale of these Goods and Consulting Services, Mr. Plante attached to his affidavit a series of invoices dated during the relevant period [paras 9 and 13, Appendix C].

[10] In support of his statements concerning the Distribution Services, Mr. Plante attached to his affidavit excerpts from the Owner’s website, on which the Owner distributes information about the Services offered in association with the Mark [para 15, Appendix D]. The excerpts are dated during the relevant period, except one, dated April 2015.

[11] Mr. Plante also attached to his affidavit excerpts from the Owner’s Facebook page showing advertisements related to the Services offered by the Owner, including examples of advertisements that appeared in the magazine *Fugues* during the relevant period [paras. 16–18, Appendix E].

[12] Mr. Plante explains that the Owner designed and broadcast radio and television ads for Services offered under the Mark. In support, he attached to his affidavit an example of video [para 19, Appendix F] and radio [para 23, Appendix H] advertising, as well as advertising contracts for the broadcast of such ads during the relevant period [paras 20 to 22, Appendix G (video); para 25, Appendix I (Radio)].

[13] Finally, Mr. Plante explains that, during the relevant period, the Owner promoted its Goods and Services by advertising them on *Société de Transport de Montréal* buses [para 25, Appendix J] and by attending numerous events and trade shows [paras 26 and 27]. In this respect, he attached to his affidavit excerpts from the Owner’s Facebook page announcing its attendance at the “*Salon au masculin*” from November 27 to 29, 2015, and the “*Grand salon marions-nous*” on January 7 and 8, 2017 [Appendix K].

[14] Before I proceed, I note that some of the evidence, including the containers of goods and the invoices, displays a stylized mark, namely the Mark, the letters in which are separated by dots, as shown below:



[15] I find that the addition of these items does not cause the Mark to lose its identity and that the Mark remains identifiable despite the differences between the form in which it was registered and the form in which it was displayed on that evidence [see *Canada (Registrar of Trade-marks) v Cie Internationale pour l’Informatique CII Honeywell Bull*, (1985) 4 CPR (3d) 50 23 (FCA), *Promafil Canada Ltée v Munsingwear Inc.* (1992), 1992 CanLII 12831 (FCA), 44 CPR (3d) 59 (FCA)]. I therefore consider any use of the stylized mark to constitute a use of the Mark.

ANALYSIS AND REASONS FOR DECISION

[16] The relevant definitions of use are set out in section 4 of the Act as follows:

4. (1) A trademark 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.

4. (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.

[17] It is well established that bare statements that a trademark is in use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc.* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is low [*Woods Canada Ltd v Lang Michener et al* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trademark in association with each of goods and services described in the registration during the relevant period.

Preliminary remarks

[18] First, I note that Mr. Plante does not allege use of the Mark in association with goods (2) or with services (3), (4) and (5) as defined in paragraph 2 above, and none of the aforementioned evidence demonstrates use of the Mark in association with those goods and services. I am therefore not satisfied that the Owner has demonstrated use of the Mark in association with those goods and services within the meaning of sections 4 and 45 of the Act. As there is no evidence before me of special circumstances excusing non-use of the Mark in association with them, the registration will be amended accordingly.

Use of the Mark in association with the Goods and Consulting Services

[19] The invoices presented in Appendix C show sales of a treatment entitled “*Traitement F.U.R.*” during the relevant period. All the invoices display the Mark in the header except the first one, dated April 27, 2016. On each invoice, a handwritten note indicates that the invoice amount also includes the sale of [TRANSLATION] “shampoo + sunscreen.”

[20] The Mark is also displayed on the containers of the goods listed in Appendix B, namely shampoo, sunscreen and emu oil.

[21] In light of this evidence, I am satisfied that the Owner has demonstrated use of the Mark in association with “shampoo” and “sunscreen” and the Consulting Services within the meaning of sections 4 and 45 of the Act.

[22] The same is not true for “body moisturizing creams.” Despite the Owner’s claims that Mr. Plante’s affidavit demonstrates that all the “Goods” were sold, there is no evidence before me to support that claim with respect to moisturizing creams. The invoices submitted do not show any sales of moisturizing cream. I also note that no body moisturizing creams are shown in the photographs of containers.

[23] In this respect, in the absence of evidence to the contrary, I must consider each good listed in the statement of goods as being somehow distinct from the others (see *Oyen Wiggs Green & Mutala LLP v MC Imports Ltd*, 2014 TMOB 116, at para 19, citing *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d 115 (FCTD)). The sale of sunscreens as shown on the invoices therefore cannot support the registration of two separate registered goods, namely “sunscreens” and “body moisturizing creams”.

[24] The evidence on record does not demonstrate and does not allow me to conclude that the Owner sold or otherwise transferred “body moisturizing creams”. I am therefore not satisfied that the Owner has demonstrated use of the Mark in association with that product within the meaning of sections 4 and 45 of the Act. As there are no special circumstances excusing non-use of the Mark in association with such a product, the registration will be amended accordingly.

Use of the Mark in association with Information Distribution Services

[25] In support of use of the Mark in association with Information Distribution Services, the Owner cites advertising of its Services on the Facebook social network, as well as video and radio advertisements. The Owner also submits that it publishes information on its website concerning the Services offered in association with the Mark.

[26] However, the jurisprudence teaches that advertising itself cannot be a service if it only benefits the registered owner, such as when advertising its goods or services [see *Ralston Purina Co v Effem Foods Ltd.* (1997), 81 CPR (3d) 528 (TMOB) at para 14].

[27] The radio and video advertising identified above only benefit the Owner. It provides purely promotional content and contains no information or explanations. This is also the case for the advertising on *Société de Transport de Montréal* buses and the publications in the magazine *Fugues* and on the Owner's Facebook page. Although that advertising may be evidence of use of the Mark in association with the Consulting Services, it is not evidence of use of the Mark in association with Information Distribution Services.

[28] Similarly, while the Owner's website outlines the Owner's hair replacement technique, namely scalp micropigmentation, it offers little more information than the advertising discussed above. The website simply promotes the technique and invites consumers to contact the Owner for more details.

[29] In summary, it is clear from the evidence as a whole that the information distributed offered no benefit to consumers or the public. It only served the interests of the Owner by promoting the method it offers to its clients.

[30] I am therefore not satisfied that the Owner used the Mark in association with the Information Distribution Services within the meaning of sections 4(2) and 45 of the Act. As there are no special circumstances excusing non-use of the Mark in association with such services, the registration will be amended accordingly.

DISPOSITION

[31] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the following descriptions from the statement of goods and services, in compliance with the provisions of section 45 of the Act.

GOODS

- (1) ... body moisturizing creams.
- (2) T-shirts, polo shirts, caps.

SERVICES

- (2) Distribution of information in the fields of hair restoration and the treatment of hair loss through printed and electronic documents, videos and websites.
- (3) Training and technical assistance in the fields of hair restoration and hair loss.
- (4) Third-party licensing for know-how in hair restoration techniques and hair loss treatments.
- (5) Advertising services for third parties through advertising on websites, billboards and print, audiovisual and electronic media.

[32] The amended statement of goods will read as follows:

GOODS

- (1) Shampoos, sunscreens.

SERVICES

- (1) Consultation and aesthetics services in the field of hair restoration and hair loss.

Eve Heafey
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Certified translation
Gerald Woodard

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE No Hearing Held

AGENTS OF RECORD

Fasken Martineau DuMoulin LLP

For the Registered Owner

Cassels Brock & Blackwell LLP

For the Requesting Party