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LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 75**

**Date of Decision: 2021-04-22**

**IN THE MATTER OF TWO SECTION 45 PROCEEDINGS**

<b>McMillan LLP</b>	<b>Requesting Party</b>
<b>and</b>	
<b>Conair Corporation</b>	<b>Registered Owner</b>
<b>TMA663,484 and TMA698,437 for</b>	<b>Registrations</b>
<b>SOHO</b>	

INTRODUCTION

[1] At the request of McMillan LLP (the Requesting Party), the Registrar of Trademarks issued notices under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on October 5, 2017 to Conair Corporation (the Owner), the registered owner of registration Nos. TMA663,484 and TMA698,437, both for the trademark SOHO (the Mark).

[2] Registration No. TMA663,484 is registered for use in association with the following goods:

Cosmetics, namely, eyeliner pencils, lipliner pencils, eyebrow pencils, sharpeners for eyeliner pencils, lipliner pencils and eyebrow pencils, automatic eyeliner pencils, automatic lipliner pencils, automatic eyebrow pencils, eye shadows, foundation, powder blush, cream blush, lipstick, concealers, liquid eyeliners, natural and synthetic nail polish, make-up application brushes, make-up brush kits, manicures, make-up sponges, puffs, bath sponges, bath and shower liquid preparations, glycerine soaps, liquid soaps, hard

milled soaps; cosmetic bags, namely cosmetic bags, cosmetic organizers, hang-up bags and cosmetic travel bags.

[3] Registration No. TMA698,437 is registered for use in association with the same goods, albeit set out as follows:

- (1) Cosmetics, namely, eyeliner pencils, lipliner pencils, eyebrow pencils, sharpeners for eyeliner pencils, lipliner pencils and eyebrow pencils, automatic eyeliner pencils, automatic lipliner pencils, automatic eyebrow pencils, eye shadows, foundation, powder blush, cream blush, lipstick, concealers, liquid eyeliners, natural and synthetic nail polish, make-up application brushes, make-up brush kits, manicures, make-up sponges, puffs, bath sponges, bath and shower liquid preparations, glycerine soaps, liquid soaps, hard milled soaps.
- (2) Cosmetic bags, namely cosmetic bags, cosmetic organizers, hang-up bags and cosmetic travel bags.

[4] Each notice required the Owner to show that it had used the Mark in Canada in association with each of the goods specified in the registration 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 such use since that date. In this case, the relevant period for showing use is October 5, 2014 to October 5, 2017.

[5] The relevant definition of use for goods is set out in section 4(1) 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.

[6] It is well established that mere assertions of 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* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v 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 the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[7] In response to the Registrar's notices, the Owner furnished the affidavit of Richard G. Sobel, an officer of the Owner, sworn May 7, 2018. The affidavit refers to both registrations.

[8] Only the Owner submitted written representations and attended an oral hearing. The representations are the same for both registrations.

#### THE EVIDENCE

[9] The Owner is a manufacturer of personal and beauty care products.

[10] In his affidavit, Mr. Sobel appears to assert sales and use of the Mark in association with all of the registered goods, stating that, during the relevant period, the Owner sold "the Goods" in Canada in association with the Mark. In particular, he states that the Owner sold its SOHO-branded products to several stores, including Rexall, London Drugs, Jean Coutu and Walmart.

[11] With respect to display of the Mark, Mr. Sobel attests that, during the relevant period, the Mark appeared directly on the registered goods or their packaging. In support, he provides photographs showing a variety of SOHO-branded products, namely different types of make-up brushes and make-up brush sets, several types of cosmetic bags, cases and organizers, as well as an unidentified pink box [Exhibit A].

[12] With respect to transfers of "cosmetic bags", Mr. Sobel provides evidence in a variety of forms of what appear to be sales of cosmetic bags, cases and organizers to London Drugs.

[13] First, he attests that, during the relevant period, the Owner sold over 2,000 units of various cosmetic bags, cases and organizers to London Drugs, for sales totalling approximately CDN\$20,000. In support, he provides several purchase orders which he confirms are representative of such sales [Exhibit C].

[14] Mr. Sobel also attests that, from January 2017 to October 2017, approximately 1,600 "units of the Goods" bearing the Mark were sold in Canada, with estimated total sales over CDN\$30,000. In support, he provides a chart summarizing such sales [Exhibit D]. As confirmed by the Owner at the hearing, the 20 products identified in the chart all appear to be different types of cosmetic bags, cases and organizers. Although not explicitly stated by Mr. Sobel, I note

that the notation of “LDC” in the chart indicates that these products were all sold to London Drugs Canada.

[15] Lastly, with respect to “cosmetic organizers” specifically, Mr. Sobel attests that the Owner sold 360 units of a SOHO “organizer” to London Drugs in January 2017. Attached as Exhibit F to the affidavit is the purchase order and supporting tracking information regarding this sale.

[16] With respect to transfers of other goods, Mr. Sobel attests to the sale of “one SOHO eye brush set” to Walmart Canada in March 2016. In support, he attaches the purchase order regarding this sale [Exhibit E]. He confirms that the product listed on the purchase order as “SOHO 6PC ULTIMATE EYE BRUS...” is an “eye brush set”.

[17] Mr. Sobel further states that the registered goods “can be acquired” online through several websites. In support, he attaches to his affidavit undated website printouts from *amazon.ca* [Exhibit B-1], and a printout, dated after the relevant period, from *ulta.com* [Exhibit B-2]. I note that the products depicted on the *amazon.ca* website include make-up brushes and collections of make-up brushes described as either a “set” or “kit”. However, I further note that Mr. Sobel does not clearly state whether the SOHO-branded products that “can be acquired” through these websites are sold by the Owner or are otherwise within the Owner’s normal course of trade. In any event, the affidavit provides no indication as to whether these website printouts are from or representative of the relevant period.

#### ANALYSIS AND REASONS FOR DECISION

[18] As a preliminary matter, I note that, at the hearing, the Owner indicated that it had difficulties in obtaining internal records from the relevant period due to “transitions” in its computer records. However, I also note that Mr. Sobel makes no reference to such difficulties in his affidavit and that, notwithstanding that the Owner was obviously able to obtain some documentary evidence relating to its use of the Mark during the relevant period, it was open to the Owner to provide evidence by other means, *e.g.*, via clear statements and representative evidence.

[19] In any event, based on Mr. Sobel's affidavit, there is clear evidence that a variety of SOHO-branded cosmetic bags, cases and organizers were sold in Canada during the relevant period. In view of the different types of SOHO products depicted in the Exhibit A photographs and evidenced as sold (in Exhibits C, D and F), I am satisfied that such bags, cases and organizers correspond to the various "cosmetic bags" goods as registered. Therefore, I am satisfied that the Owner has shown use of the Mark in association with "cosmetic bags, namely cosmetic bags, cosmetic organizers, hang-up bags and cosmetic travel bags" within the meaning of sections 4 and 45 of the Act.

[20] With respect to the registered "cosmetics" goods, I first note that the Exhibit A photographs include display of SOHO-branded make-up brushes, make-up brush kits, and the aforementioned pink box.

[21] However, notwithstanding Mr. Sobel's general assertion, the only evidence of actual sales or transfers of goods other than the aforementioned cosmetic bags is the single March 2016 sale of an "eye brush set" to Walmart Canada.

[22] As expressed by the Federal Court, a registered owner who chooses to provide evidence of a single sale is "playing with fire in the sense that he must provide sufficient information about the context of the sale ..." [*Guido Berlucchi & C Srl v Brouillette Kosie Prince*, 2007 FC 245, 56 CPR (4th) 401 at para 20]. However, evidence of a single sale can be sufficient to establish use for the purposes of section 45 expungement proceedings, so long as it follows the pattern of a genuine commercial transaction and is not seen as deliberately manufactured or contrived to protect the registration [see *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD)]. In the present case, I accept that nothing in the evidence indicates that this "eye brush set" sale was other than a genuine commercial transaction. However, there remains the issue of what, if any, registered goods this sale correlates with.

[23] While the evidence could have been clearer in this respect, I accept that such an "eye brush set" correlates with the registered goods "make-up brush kits" – being a collection of make-up brushes – as appears to be identified and shown in Exhibit A. I consider this correlation to at least be consistent with the SOHO products as they are offered for sale on the third-party website, *amazon.ca*, shown at Exhibit B-1, notwithstanding other issues related to this part of the

evidence. On that website, the words “set” and “kit” appear to be used interchangeably for collections of make-up brushes. I am therefore satisfied that the Owner has shown use of the Mark in association with “cosmetics, namely ... make-up brush kits” within the meaning of sections 4 and 45 of the Act.

[24] However, absent further evidence, I am not satisfied that the Owner has demonstrated use of the Mark with respect to any of the remaining registered “cosmetics” goods, including “make-up application brushes”. In this respect, while I accept that “make-up brush kits” could include different types of brushes, the Owner made a distinction between “make-up brush kits” and, for example, “make-up application brushes” in its statement of goods. To the extent there is a distinction, the Owner is required to provide evidence of use for each of the registered goods [see *John Labatt, supra*; *Sharp Kabushiki Kaisha v 88766 Canada Inc* (1997), 72 CPR (3d) 195 (FCTD); *Fogler, Rubinoff LLP v Canada Safeway Ltd*, 2013 TMOB 227]. As such, for the Owner to maintain its registration for “make-up application brushes”, it had to show transfer of such goods otherwise than by reference to “make-up brush kits”.

[25] Further to this issue, at the hearing, the Owner claimed that the evidenced purchase orders demonstrate transfer of goods in both categories, “cosmetics” and “cosmetic bags”. In particular, referring to *Saks & Co v Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD), the Owner submits that the representative sale of brushes should cover the entire category of “cosmetics”, and that make-up brushes are very closely related with other goods listed in the category, such as “powder blush” or “eye shadows”.

[26] However, while evidentiary overkill is not required and representative evidence can be furnished in section 45 proceedings, the Owner must still establish a *prima facie* case of use of the Mark in association with each of the registered goods [*John Labatt, supra*]. In other words, the Registrar must be able to form an opinion regarding “use” within the meaning of the Act, and must be able to “rely on an inference from proven facts rather than on speculation” to satisfy every element required by the Act [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448; *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184]. Evidence regarding transfers can be in the form of documentation like invoices and sales reports, but can also be through clear sworn statements regarding volumes of sales, dollar value of sales, or equivalent factual

particulars [see *John Labatt, supra*; also *Lewis Thomas & Sons Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD); and *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79].

[27] In the present case, Mr. Sobel makes a general assertion regarding the sale of all of the registered goods. However, Mr. Sobel's affidavit contains neither clear sworn statements nor invoices, sales reports or other exhibits demonstrating facts which would allow me to conclude that there were any transfers of any of the registered "cosmetics" goods aside from make-up brush kits, during the relevant period or otherwise. In this respect, at the hearing, the Owner identified the aforementioned pink box depicted in the Exhibit A photographs as likely being a box of SOHO eye shadow or blush. However, in his affidavit, Mr. Sobel neither identifies the nature of the product, nor does he provide any particular evidence that this product was the subject of transfers in Canada at any time.

[28] Again, while I note the Owner's submission that it had difficulties in obtaining internal records, no single form of evidence is required in a section 45 proceeding. If the Owner was not able to present evidence of transfers based on its computer records, it could have submitted such evidence in different form, including by clear sworn statements. In the present case, however, I do not consider Mr. Sobel's general assertion with respect to "the Goods" to be sufficient to permit me to conclude that the Owner has demonstrated use of the Mark in association with each of the goods as registered. In this respect, I further note that Mr. Sobel's assertion may in part rely on sales or potential sales through third-party websites, such as those shown at Exhibits B-1 and B-2. However, it is not clear whether any such sales occurred or were otherwise within the Owner's normal course of trade.

[29] In view of the foregoing, I am only satisfied that the Owner has demonstrated use of the Mark in association with "cosmetics, namely ... make-up brush kits" and "cosmetic bags, namely cosmetic bags, cosmetic organizers, hang-up bags and cosmetic travel bags" within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances excusing non-use of the Mark in association with the remaining registered goods, the registrations will be amended accordingly.

DISPOSITION

[30] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, and in compliance with the provisions of section 45 of the Act, both registrations will be amended to delete the following goods:

... eyeliner pencils, lipliner pencils, eyebrow pencils, sharpeners for eyeliner pencils, lipliner pencils and eyebrow pencils, automatic eyeliner pencils, automatic lipliner pencils, automatic eyebrow pencils, eye shadows, foundation, powder blush, cream blush, lipstick, concealers, liquid eyeliners, natural and synthetic nail polish, make-up application brushes, ..., manicures, make-up sponges, puffs, bath sponges, bath and shower liquid preparations, glycerine soaps, liquid soaps, hard milled soaps

[31] The amended statement of goods for registration No. TMA663,484 will be as follows:

Cosmetics, namely, make-up brush kits; cosmetic bags, namely cosmetic bags, cosmetic organizers, hang-up bags and cosmetic travel bags.

[32] The amended statement of goods for registration No. TMA698,437 will be as follows:

- (1) Cosmetics, namely, make-up brush kits.
- (2) Cosmetic bags, namely cosmetic bags, cosmetic organizers, hang-up bags and cosmetic travel bags.

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Andrew Bene  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office



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

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**HEARING DATE:** 2021-03-01

**APPEARANCES**

Marie Lussier	For the Registered Owner
No one appearing	For the Requesting Party

**AGENTS OF RECORD**

Chitiz Pathak LLP	For the Registered Owner
McMillan LLP	For the Requesting Party