



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 229

Date of Decision: 2021-10-13

IN THE MATTER OF A SECTION 45 PROCEEDING

KIRBY EADES GALE BAKER

Requesting Party

and

Cosmedix MD Inc.

Registered Owner

TMA650,719 for COSMEDIX MD

Registration

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA650,719 for the trademark COSMEDIX MD (the Mark), currently owned by Cosmedix MD Inc.

[2] All references are to the Act as amended June 17, 2019 (the Act), unless otherwise noted.

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

GOODS

- (1) Skin lotions and creams.
- (2) Vitamins.

SERVICES

- (1) Skin care treatment and consultation.
- (2) Cosmetic dermatologic treatment, including facial and body chemical peels, microdermabrasion and sclerotherapy.
- (3) Surgical cosmetic treatment, including medical and cosmetic laser treatments, radio frequency skin treatments, injection of botulinum toxin type A and intense pulse light therapy.
- (4) Aesthetic services, namely facials, facial peels, radio frequency induced skin tightening, threading and waxing.

[4] For the reasons that follow, I conclude that the registration ought to be maintained in part.

THE PROCEEDINGS

[5] At the request of KIRBY EADES GALE BAKER (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on December 10, 2019, to Cosmedix MD Inc. (the Owner), the registered owner of the Mark.

[6] The notice required the Owner to show whether the trademark has been used in Canada in association with each of the goods and services 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 December 10, 2016 to December 10, 2019 (the Relevant Period).

[7] 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.

[8] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register. The evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184]. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant* at para 9].

[9] In the absence of use as defined above, pursuant to section 45(3) of the Act, a trademark registration is liable to be expunged, unless the absence of use is due to special circumstances.

[10] In response to the Registrar’s notice, the Owner furnished the affidavit of Dr. John Nathan Henry Goldhar sworn on August 7, 2020 to which were attached Exhibits A and B and the affidavit of Shelley Goldhar sworn on August 5, 2020 to which were attached Exhibits A to NN.

[11] Both parties submitted written representations and no oral hearing was held.

THE EVIDENCE

Affidavit of Dr. Goldhar

[12] Dr. Goldhar states that he holds a medical degree and specializes in the area of dermatology.

[13] Dr. Goldhar further states that he is a shareholder of the Owner which operated a clinic (the clinic) in Toronto during the Relevant Period where he “ran the day to day operations” and performed “dermatology, cosmetic and laser services” under the Mark.

[14] To support this allegation, Dr. Goldhar attached Exhibit B to his affidavit consisting of a photograph taken in September of 2017 showing the front desk of the clinic with a sign bearing the Mark on the wall behind the desk and an individual that Dr. Goldhar affirms is himself. Additional language on the sign is partly readable including “...for Dermatology, Cosmetics...”, the name “John Goldhar” followed by medical doctor credentials, followed by “and Associates”.

[15] In paragraph 22 of his affidavit Dr. Goldhar further states that “...topical vitamins bearing the Trademark were offered for sale at the Clinic during the Relevant Period.”

Affidavit of Shelley Goldhar

[16] Ms. Goldhar describes herself as the “sole director, officer, president and secretary of the Owner.” In paragraph 15 of her affidavit Ms. Goldhar describes software in use by the Owner including during the Relevant Period to track inventory and sales for the clinic which was used to generate reports showing excerpts of invoice summaries referenced in her affidavit and Exhibits.

[17] Ms Goldhar affirms that during the Relevant Period, “skin care and related goods” displaying the Mark on the goods or their packaging were offered for sale and sold at the clinic.

[18] To support these allegations, in paragraph 20 of her affidavit Ms. Goldhar describes Exhibit C as showing “hydrating cleanser, hand and body cream and various skin cleansers”, each bearing the Mark and available for sale at the clinic during the Relevant Period including:

- a 90 ml tube with the phrase “Advanced Hand and Body Care” appearing on the tube;
- a 237 ml container with the phrase “hydrating cleanser” appearing on the container.

[19] Ms. Goldhar describes the following Exhibits attached to her affidavit as being excerpts of invoice summaries showing details of sales during the Relevant Period for the Goods described as “skin lotions”:

| Exhibit | Exhibit Page Number | Invoice Summary Date | Product |
|---------|---------------------|----------------------|-------------------------|
| I | 64 of 2083 | December 22, 2016 | brightening facial wash |
| P | 112 of 2083 | January 10, 2017 | hydrating cleanser |
| S | unnumbered | January 19, 2017 | purifying cleanser |
| V | 157 of 2083 | January 23, 2017 | hydrating cleanser |

[20] Ms. Goldhar describes the following Exhibits attached to her affidavit as being excerpts of invoice summaries showing details of sales during the Relevant Period for the Goods described as “creams”:

| Exhibit | Exhibit Page Number | Invoice Summary Date | Product |
|---------|---------------------|----------------------|-----------------------------|
| G | 20 of 2083 | December 14, 2016 | restorative night cream |
| K | 77 of 2083 | December 28, 2016 | advanced hand and body care |
| Q | 113 of 2083 | January 10, 2017 | advanced hand and body care |
| EE | 218 of 2083 | February 7, 2017 | restorative night cream |

[21] In paragraph 54 of her affidavit Ms. Goldhar states, “During the Relevant Period, the Trademark was displayed in the performance and advertising of services offered at the Clinic. The COSMEDIX MD Services were offered and sold to the end-user consumer.”

[22] Ms. Goldhar describes the following Exhibits attached to her affidavit as being excerpts of invoice summaries showing details of sales during the Relevant Period for the Services “intense pulse light therapy”:

| Exhibit | Exhibit Page Number | Invoice Summary Date |
|---------|---------------------|----------------------|
| I | 64 of 2083 | December 22, 2016 |
| AA | 194 of 2083 | February 1, 2017 |
| FF | 219 of 2083 | February 7 2017 |

[23] Ms. Goldhar describes Exhibit NN attached to her affidavit as being excerpts of invoice summaries showing details of sales during the Relevant Period for the Services:

(a) “skin care treatment and consultation”

| Exhibit Page Number | Invoice Summary Date | Service Provided |
|---------------------|----------------------|----------------------|
| 3 of 2083 | December 12, 2016 | Removal - lesion |
| 60 of 2083 | December 22, 2016 | Hand Treatment |
| 67 of 2083 | December 27, 2016 | Skin Tag Removal |
| 196 of 2083 | February 1, 2017 | Consult Aesthetician |
| 279 or 2083 | February 21, 2017 | Consultation |
| 292 of 2083 | February 23, 2017 | Removal - lesion |

(b) “facial and body chemical peels”

| Exhibit Page Number | Invoice Summary Date |
|---------------------|----------------------|
| 65 of 2083 | December 22, 2016 |
| 153 of 2083 | January 20, 2017 |
| 278 of 2083 | February 21, 2017 |

(c) “microdermabrasion”

| Exhibit Page Number | Invoice Summary Date |
|---------------------|----------------------|
| 6 of 2083 | December 12, 2016 |
| 269 of 2083 | February 16, 2017 |
| 296 of 2083 | February 24, 2017 |

(d) “sclerotherapy”

| Exhibit Page Number | Invoice Summary Date |
|---------------------|----------------------|
| 103 of 2083 | January 6, 2017 |
| 213 of 2083 | February 6, 2017 |
| 289 of 2083 | February 22, 2017 |

(e) “medical and cosmetic laser treatments”

| Exhibit Page Number | Invoice Summary Date | Service Provided |
|---------------------|----------------------|----------------------------|
| 20 of 2083 | December 14, 2016 | laser hair removal |
| 60 of 2083 | December 22, 2016 | laser – vascular trmt face |
| 132 of 2083 | January 17, 2017 | laser -Axillae (underarm) |
| 133 of 2083 | January 17, 2017 | laser vascular trmt |

(f) “radio frequency skin treatments”

| Exhibit Page Number | Invoice Summary Date | Service Provided |
|---------------------|----------------------|--------------------|
| 43 of 2083 | December 20, 2016 | cryotherapy |
| 45 of 2083 | December 20, 2016 | electrodessication |
| 63 of 2083 | December 22, 2016 | cryotherapy |
| 72 of 2083 | December 27, 2016 | electrodessication |
| 107 of 2083 | January 9, 2017 | cryotherapy |

(g) “injection of botulinum toxin type A”

| Exhibit Page Number | Invoice Summary Date |
|---------------------|----------------------|
| 12 of 2083 | December 13, 2016 |
| 54 of 2083 | December 21, 2016 |
| 153 of 2083 | January 20, 2017 |

(h) “facials”

| Exhibit Page Number | Invoice Summary Date |
|---------------------|----------------------|
| 32 of 2083 | December 19, 2016 |
| 78 of 2083 | December 28, 2016 |
| 265 of 2083 | February 16, 2017 |

(i) “facial peels”

| Exhibit Page Number | Invoice Summary Date |
|---------------------|----------------------|
| 124 of 2083 | January 13, 2016 |

(j) “radio frequency induced skin tightening”

| Exhibit Page Number | Invoice Summary Date |
|---------------------|----------------------|
| 141 of 2083 | January 18, 2017 |
| 181 of 2083 | January 30, 2017 |
| 269 of 2083 | February 16, 2017 |

ANALYSIS AND REASONS FOR DECISION

[24] The only argument raised by the Requesting Party is that the Owner’s evidence, “...does not disclose any sales or other salient evidence of COSMEDIX MD trademark use after February 28, 2017.”

[25] The Requesting Party acknowledges that the Relevant Period in this matter is December 10, 2016 to December 10, 2019. However, it argues that the Registrar should issue a new notice under section 45 given that there has been no evidence of use filed that is subsequent to February 28, 2017.

[26] Section 45(1) requires the registered owner of a trademark to furnish evidence showing use of the trademark “at any time” during the Relevant Period.

[27] The Requesting Party’s objection can be disposed of because the Owner has submitted evidence from within the Relevant Period. In any event, in light of the Federal Court of Appeal’s remarks discouraging the practice of maintaining a registration and simultaneously issuing a second notice in *Spirits International N.V. v. Canada (Registrar of Trade-Marks)* (2007), 2007 FCA 162 (CanLII), 60 C.P.R. (4th) 31, a second notice will not be issued.

[28] The Owner alleges that by way of a letter to the Registrar dated October 16, 2020 the Requesting Party initially states that it does not wish to submit representations, but then proceeds to make representations, in contravention of Section 73 of the *Trademark Regulations*, which states that a requesting party may either:

(a) file and serve written representations; **or**

(b) file and serve a statement that it does not wish to make written representations.

[29] Given that the Requesting Party’s objections have been disposed of, there is no need to address this portion of the Owner’s submissions. Still, the Registrar has to determine whether the evidence described above establishes use of the Mark in association with each of the Goods and Services in Canada.

Evidence of Use During the Relevant Period

[30] Section 45 proceedings are summary in nature and the evidentiary threshold to be met is quite low [*Woods Canada Ltd v Lang Michener* (1996), 1996 CanLII 17297 (FC), 71 CPR (3d) 477 (FCTD)]. Nevertheless, it is well established that a mere assertion that a trademark has been used in Canada is insufficient to meet the requirements of section 45 of the Act [*Plough*

(*Canada) Ltd v Aerosol Fillers Inc.* (1980), 1980 CanLII 2739 (FCA), 53 CPR (2d) 62 (FCA)]. A registered owner must not merely state, but actually show use of the trademark in association with each of the goods or services listed in the registration, “by describing facts from which the Registrar or the Court can form an opinion or can logically infer use within the meaning of section 4” [see *Guido Berlucchi & C Srl v Brouillette Kosie Prince*, 2007 FC 245, 56 CPR (4th) 401 at para 18].

[31] In its written representations, the Owner itself acknowledges that the threshold imposed by Section 45 for showing use of a trademark in association with goods or services is low, such that even evidence of a single sale of a good or service may suffice.

[32] From the evidence described above, I am satisfied that the Owner has established use of the Mark in Canada during the Relevant Period in association with each of the Goods and Services, save and except for “vitamins”, “threading” and “waxing” for the reasons detailed hereinafter.

Goods: “vitamins”

[33] As stated by the Registrar of Trademarks in *Tamarack Bay Group Holdings Inc. v. James A Murray*, 2019 TMOB 92,

“To establish use of a trademark in association with goods, an owner must provide sufficient evidence to allow the Registrar to conclude that the goods were transferred in association with the trademark in Canada during the relevant period. Such transfers must be in the normal course of trade. Although there is no specific form that this evidence must take, some evidence of transfers in the normal course of trade in Canada is necessary. Such evidence will often be in the form of documentation like invoices or sales reports, but it can also be through clear sworn statements detailing transfers in the normal course of trade.”

[34] There is no evidence in the affidavits of Dr. Goldhar or Ms. Goldhar nor in the exhibits attached to those affidavits describing or showing transfer of the Goods “vitamins” in association with the Mark in Canada during the Relevant Period. There is also no allegation of facts that could excuse the non-use of the Mark during the Relevant Period in Canada in association with “vitamins”. The registration will be amended accordingly.

Services: “threading” and “waxing”

[35] As defined in section 4(2) of the Act, in order to show use of a trademark in association with a registered service, the evidence must show that the trademark was displayed in the performance or advertising of that service in Canada. In the case of advertising, the evidence must also show that the owner was offering and prepared to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[36] In the present case, there is neither a clear assertion of use of the Mark in association with either of the Services “threading” or “waxing” in Canada during the Relevant Period, nor evidence from which such use might be inferred. There is also no allegation of facts that could excuse the non-use of the Mark during the Relevant Period in Canada in association with those Services. The registration will be amended accordingly.

DISPOSITION

[37] Pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the following goods:

“vitamins”

and the following services

“threading” and “waxing”

in compliance with the provisions of section 45 of the Act.

[38] The amended statement of goods and services shall now read:

Goods:

- (1) skin lotions and creams

Services:

- (1) Skin care treatment and consultation.
- (2) Cosmetic dermatologic treatment, including facial and body chemical peels, microdermabrasion and sclerotherapy.
- (3) Surgical cosmetic treatment, including medical and cosmetic laser treatments, radio frequency skin treatments, injection of botulinum toxin type A and intense pulse light therapy.
- (4) Aesthetic services, namely facials, facial peels and radio frequency induced skin tightening.

Jean Carrière
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE No Hearing Held

AGENTS OF RECORD

MINDEN GROSS LLP

For the Registered Owner

KIRBY EADES GALE BAKER

For the Requesting Party