



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 259

Date of Decision: 2021-11-29

IN THE MATTER OF A SECTION 45 PROCEEDING

Miss Jen Inc. and Beauty Distribution Requesting Party
MD Inc., A joint venture

and

Too Faced Cosmetics, LLC Registered Owner
TMA692,307 for TOO FACED 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. TMA692,307 for the trademark TOO FACED (the Mark), currently owned by Too Faced Cosmetics, LLC (the Owner).

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

Cosmetics, namely, eye shadows, eyeliners, eyebrow pencils, mascara, lipstick, lip gloss and lip liner (the Goods).

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

THE PROCEEDING

[4] At the request of Miss Jen Inc. and Beauty Distribution MD Inc., A joint venture (the Requesting Party), the Registrar of Trademarks issued on May 19, 2020 a notice under section 45 of the Act to the Owner.

[5] The notice required the Owner to show whether the trademark has been used in Canada in association with 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 May 19, 2017 to May 19, 2020 (the Relevant Period).

[6] The relevant definition of use in the present case 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.

[7] 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*].

[8] Indeed, while there is no need for evidentiary overkill in a section 45 proceeding, a registered owner is nevertheless obligated to provide evidence to the extent that the Registrar is

able to form an opinion on the “use” within the meaning of the Act [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448].

[9] In response to the Registrar’s notice, the Owner furnished the statutory declaration of Juli Jones, the Regulatory and International Compliance Director of the Owner, sworn on December 17, 2020, together with Exhibits A to T.

[10] Only the Owner submitted written representations and no oral hearing was held.

THE EVIDENCE

[11] Ms. Jones explains that the Owner is a manufacturer of cosmetic products that is a fully owned subsidiary of the Estée Lauder Companies. She explains that the Goods are sold by the Owner directly to customers in Canada through the Owner’s online store located at www.toofaced.com/ca/fr and www.toofaced.com/ca/en as well as through third party retailers located in Canada (retail stores and online) such as Sephora Canada and Shoppers Drug Mart Inc. [paras 3 and 4].

[12] Ms. Jones states that the Owner continuously used the Mark in Canada during the Relevant Period with each of the goods listed in the registration [para 6].

[13] In support, Ms. Jones attaches the following relevant exhibits to her declaration:

- Exhibits “B to H”: Photographs of products, packaging and labelling which Ms. Jones attests are representative of how the Mark was used in Canada by the Owner in association with each of the goods listed in the registration [paras 8 to 14]. The Mark is displayed on the products themselves and their packaging.
- Exhibit “I”: Three invoices from the Relevant Period displaying the Mark for eye shadows, eyeliners, eyebrow pencils, mascara, lipstick, lip gloss and a wide variety of other cosmetic products, such as lip insurance, sold by the Owner to Sephora Canada and Shoppers Drug Mart Inc. and shipped to Canada [para 16].

- Exhibit “K”: A copy of a report titled “Summary Sales by State” (the Sales Report) for the “Brand: Too Faced / Region: Canada” for purchases of cosmetic products made by Canadian consumers directly from the Owner’s online store during the Relevant Period. The exhibited report shows 2435 units of products sold from January 1 to May 19, 2020. In paragraph 18 of her affidavit, Ms. Jones specifically provides a correlation between some of the products listed in the report and the following goods in the registration: eye shadows, eyeliners, eyebrow pencils, mascara, lipstick, and lip gloss. I note that the report also lists other cosmetic products sold such as “lip products” and “lip colour”.

[14] Ms. Jones declares that the Owner sold in Canada in excess of \$350,000 a year of products bearing the Mark in the calendar years 2018, 2019 and 2020 [para 15]. She also provides a detailed statement as to how the Mark was displayed on the product themselves, their packaging, shipments to retailers, bills of lading and online store [para 7].

ANALYSIS

[15] The Owner argues that the evidence demonstrates use of the Mark in association with all of the Goods. Considering the evidence as a whole, I agree.

[16] To begin, I am satisfied that the invoices and the Sales Report [Exhibit “I” and “K”], coupled with the product photographs [Exhibit “B” to “G”] demonstrate the sale by the Owner of eye shadows, eyeliners, eyebrow pencils, mascara, lipstick and lip gloss, in association with the Mark to Canadian consumers during the Relevant Period.

[17] As for the remaining good, namely lip liner, I note that there is no such product listed on invoices or the sale report. However, I accept that the items identified as lip insurance, lip products and lip colour on invoices and sale report correspond to the goods registered as “lip liners”. Furthermore, Ms. Jones attaches photographs of the good identified as “lip liner” bearing the Mark in Exhibit “H”. Based on the aforementioned, I am satisfied that the Owner has

established a *prima facie* case of use of the Mark in Canada in association with lip liner during the Relevant Period.

[18] Given that the Owner has sold the Goods in Canada during the Relevant Period [paras 15, 16 and 18], and has shown that the Mark appeared on the Goods themselves, their packaging and invoices [Exhibits “B to I”], I am satisfied that the Owner has shown use of the Mark in Canada within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[19] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

Martin Béliveau
Chairperson
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

Blaney McMurtry LLP

For the Registered Owner

Bayo Odutola (OLLIP P.C.)

For the Requesting Party