



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 258**

**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**

**TMA692,308 for LIP INJECTION                              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. TMA692,308 for the trademark LIP INJECTION (the Mark), currently owned by Too Faced Cosmetics, LLC (the Owner).

[2] The Mark is registered for use in association with “Cosmetics, namely lip gloss”.

[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 a notice under section 45 of the Act on May 19, 2020, 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] 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 I.

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

#### THE EVIDENCE

[10] 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 lip gloss is 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].

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

- Exhibit "B": Several photographs of lip gloss bearing the Mark on the product itself and its packaging. Ms. Jones states that Exhibit "B" is representative of the product packaging and labelling used by the Owner in Canada for lip gloss [para 8].
- Exhibit "C": Invoices from the Relevant Period pertaining to several cosmetic products, including lip gloss, sold by the Owner to Sephora Canada and shipped to Canada [para 10]. The lip gloss is listed on the invoices as: "Lip Injection Lip Gloss 2013", "Lip Injection Extreme Lip Gloss 2013" and "Deluxe Lip Injection Extreme in UC".
- Exhibit "G": A copy of a report titled "Summary Sales by State" for Canada for purchases of a wide variety of cosmetic products, including lip gloss, made by Canadian consumers directly from the Owner's online store from January 1, 2020 to May 18, 2020. [para 14]. The lip gloss is listed in the report as: "Lip Injection Lip Gloss 2013", "Lip Injection Extreme Lip Gloss 2013", "Lip Injection Extreme Lip Plumper" and "Deluxe Lip Injection Extreme in UC".

ANALYSIS

[12] Given that the Requesting Party has submitted no written representations and based on the evidence described above, the only question left to determine is whether or not the evidence described above establishes that there has been use of the Mark in Canada during the Relevant Period in association with the good listed in the registration within the meaning of section 4(1) of the Act.

[13] Given that the Owner has sold lip gloss in Canada during the Relevant Period [para 10] and has shown that the Mark appeared on the goods themselves, their packaging and invoices [Exhibits “B” and “C”], 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

[14] 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.

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Martin Béliveau  
Chairperson  
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:** No Hearing Held

**AGENTS OF RECORD**

Blaney McMurtry LLP

For the Registered Owner

Bayo Odutola (OLLIP P.C.)

For the Requesting Party