



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 084

Date of Decision: 2022-04-26

IN THE MATTER OF A SECTION 45 PROCEEDING

Sun Taiyang Co., Ltd.

Requesting Party

and

Isabella Julee Shen

Registered Owner

TMA931,077 for X-expression

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. TMA931,077 for the trademark X-expression (the Mark) as shown below:



[2] The Mark is registered for use in association with the following (the Goods): hair pieces; braids and wigs; and add-on hair accessories constructed primarily of synthetic and/or human hair.

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

THE PROCEEDING

[4] At the request of Sun Taiyang Co., Ltd. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on December 24, 2020 to the registered owner of the Mark, Isabella Julee Shen (the Owner).

[5] The notice required the Owner to show whether the Mark was used in Canada in association with each of the Goods 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 24, 2017 to December 24, 2020 (the Relevant Period).

[6] The relevant definition of use in the present case is set out in section 4(1) of the Act:

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] 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. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[8] In response to the Registrar’s notice, the Owner furnished her Affidavit sworn on July 24, 2021, to which were attached Exhibits A to F.

[9] Neither party submitted written representations. No oral hearing was held.

THE EVIDENCE

[10] The Owner states that the Mark was displayed on the Goods sold in Canada during the Relevant Period and that sales in the period 2019 to December 20, 2020 exceeded \$545,000.

[11] The Owner states that sales of the Goods during the Relevant Period were either by the Owner personally or by J&L Beauty Supplies Inc., a company which she owns (J&L). The Owner states that she has licensed J&L to use the Mark and that she has full and direct control of the character and quality of the Goods sold by J&L.

[12] To show the manner in which the Mark was displayed on the Goods, the Owner attaches to her Affidavit the following exhibits which she states are representative of the way in which the Mark was displayed on the Goods sold to consumers in Canada during the Relevant Period:

- (a) Exhibit A consists of photographs showing the Mark on packaging for braids;
- (b) Exhibit B consists of photographs showing the Mark on packaging for hair extensions which the Owner states are also known as hair pieces in the industry;
- (c) Exhibit C consist of photographs showing the Mark on packaging for wigs; and,
- (d) Exhibit D consist of photographs showing the Mark on packaging for add-on hair accessories namely drawstrings which the Owner describes as ponytails which are attached to a person's own hair by elastic bands.

[13] In addition to the Mark, the packaging in Exhibits A to D also displays the word mark X-PRESSION and references J&L.

[14] To evidence sales of the Goods, the Owner provides the following invoices from J&L to House of Braids in Saskatchewan as Exhibit F:

- (a) Invoice dated August 24, 2020 for the sale of braids;
- (b) Invoice dated November 30, 2020 for the sale of braids;
- (c) Invoice dated January 29, 2020 for the sale of braids, wigs and drawstrings; and,
- (d) Invoice dated September 1, 2019 for the sale of braids and clip-on weave extensions.

[15] The Owner states that the Goods listed in the invoices were sold and shipped in the same kind of packaging as the packaging shown in Exhibits A to D.

ANALYSIS AND REASONS FOR DECISION

[16] I am satisfied that the evidence described above shows use of the Mark in Canada within the meaning of sections 4 and 45 of the Act in association with the Goods during the Relevant Period. In particular, I am satisfied that:

- (a) The Owner, either by herself or through her licensee J&L sold the Goods in Canada during the Relevant Period;
- (b) The Owner had control over the character or quality of the Goods sold by J&L such that the use of the Mark accrued to the Owner's benefit;
- (c) The Mark was displayed on the packaging for the Goods as shown in Exhibits A to D; and,
- (d) There were sales of the Goods in the normal course of trade in Canada during the Relevant Period as shown in the invoices attached as Exhibit F.

DISPOSITION

[17] 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, the registration will be maintained.

Robert A. MacDonald
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

Aventum IP Law LLP

For the Registered Owner

Bereskin & Parr LLP/S.E.N.C.R.L., S.R.L.

For the Requesting Party