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**LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS**

Citation: 2022 TMOB 103

Date of Decision: 2022-05-25

IN THE MATTER OF A SECTION 45 PROCEEDING

Ever Young Dermatology

Requesting Party

and

Faces Cosmetics Inc.

Registered Owner

**TMA784,449 for FACES EVER
YOUNG (& DESIGN)**

Registration

INTRODUCTION

[1] At the request of Ever Young Dermatology (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on September 18, 2019 to Faces Cosmetics Inc. (the Owner), the current owner of registration No. TMA784,449 for the trademark FACES EVER YOUNG (& DESIGN) (the Mark), shown below:



[2] The Mark is registered for use in association with the following goods: “Skin moisturizers of face and body, facial cleansers, facial toners, facial anti-aging”.

[3] The notice required the Owner to show it had used the Mark in Canada in association with each of the registered 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 September 18, 2016 to September 18, 2019.

[4] 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.

[5] It is well established that bare statements that a trademark is in 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 Canada (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 registered goods during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[6] In the absence of use, 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.

[7] In response to the Registrar’s notice, the Owner furnished the affidavit of Rhonic Pinto, sworn December 11, 2019, to which were attached Exhibits A to D.

[8] Only the Requesting Party submitted written representations and was represented at an oral hearing.

THE EVIDENCE

[9] In his affidavit, Mr. Pinto states that he is the Financial Controller of the Owner, and has held this position since approximately 2004. He attests that, as a result of his position, he has access to business records maintained by the Owner and its predecessor in title, Faces Cosmetics Group Inc. (the Predecessor). Mr. Pinto collectively refers to both of these entities as “Faces Cosmetics” [para 1].

[10] Mr. Pinto attests that, on or around June 15, 2018, the Mark was assigned from the Predecessor to the Owner [para 6]. I note that this assignment was recorded by the Registrar on August 6, 2018.

[11] Mr. Pinto explains that “As of September 18, 2019, Faces Cosmetics offered an exclusive line of makeup, skincare products and personal care accessories” through its licensed franchisees in Canada, or directly to consumers located in Canada with the operation of its website located at *www.faces-cosmetics.com* [paras 2, 10 and 11].

[12] With respect to use of the Mark, Mr. Pinto states that, during the relevant period, “the [Mark] was in continuous use by [the Owner] or [the Predecessor] in Canada in the normal course of trade” in association with the registered goods, which he collectively refers to as “FACES EVER YOUNG Products” [para 7]. He adds that “During the Relevant Period, at least 500 FACES EVER YOUNG Products bearing the [Mark] were sold in Canada, which amount to a wholesale value of at least \$7000. The retail value of such products were estimated in excess of \$21,000” [para 15].

[13] In support, Mr. Pinto attaches the following exhibits:

- Exhibits A and C consist of printouts from Faces Cosmetics’ website. According to Mr. Pinto’s statements, the Exhibit A printout provides a list of retail stores offering and selling Faces Cosmetics’ products, and the Exhibit C printouts depict the products available for sale on Faces Cosmetics’ website [paras 4 and 12]. I note that the exhibited printouts were taken outside the relevant period, namely on December 3, 2019.

- Exhibit B is described as “photographs of FACES EVER YOUNG Products”, which Mr. Pinto confirms “are representative of the manner in which the [Mark] was displayed on the FACES EVER YOUNG Products and/or their packaging in Canada throughout the Relevant Period” [para 9]. In fact, Exhibit B contains three photographs. The first photograph shows what appears to be a cream container. The second photograph shows another cream container on a packaging. The third photograph shows two versions of what appears to be the packaging from the second photograph. Nothing else other than the Mark is visible on the depicted products. The words “24hr Dual Action Moisturizer” and a version of the Mark, as illustrated below, are visible on the exhibited packaging:



- Exhibit D consists of three invoices, which Mr. Pinto confirms “are representative of those issued by Faces Cosmetics to its franchisees and direct consumers in Canada during the Relevant Period” [para 14]. Two invoices are in the name of the Predecessor and dated outside the relevant period. The third invoice is in the name of the Owner and dated August 16, 2017. Mr. Pinto further confirms that “the product code ‘NSC00040’ displayed in Exhibit D is the product code used to designate the FACES EVER YOUNG Products, including those sold in Canada during the Relevant Period” [para 14].

ANALYSIS AND REASONS FOR DECISION

[14] In its representations, the Requesting Party first questions whether any evidenced use of the Mark is by the Owner or the Predecessor. Otherwise, it submits that there is no evidence of use of the Mark in association with any of the registered goods.

[15] With respect to this first point, the Requesting Party submits that Mr. Pinto's use of the collective term "Faces Cosmetics" in his affidavit is vague to substantiate use of the Mark by any entity, whether the Predecessor or the Owner.

[16] Indeed, reference by Mr. Pinto in his affidavit to the term "Faces Cosmetics" raises some ambiguity relating to the status of such entity during the relevant period. By way of example, it is unclear as to what Mr. Pinto meant by "As of September 18, 2019, Faces Cosmetics offered an exclusive line of makeup, skincare products and personal care accessories" [emphasis added].

[17] Given Mr. Pinto's statements regarding the assignment of the Mark and subsequent recordal of such assignment on the register, and as there is no allegation in the Pinto affidavit of a licence pertaining to the Owner (and/or the Predecessor) to satisfy the requirements of section 50 of the Act, any evidenced use of the Mark must be that of the Owner.

[18] With respect to the Requesting Party's second point above that there is no evidence of use of the Mark in association with any of the registered goods, I note that Mr. Pinto states at paragraph 7 of his affidavit that the Mark was in continuous use by the Owner or the Predecessor in Canada in the normal course of trade in association with the registered goods, and that he attaches three invoices and photographs. The Requesting Party submits that Mr. Pinto's statement regarding use of the Mark is bald, too broad, unspecific and not to be taken as the required evidence of use under section 4 of the Act. I agree.

[19] Indeed, I find that the evidence falls short of establishing use within the meaning of section 4(1) of the Act, and such for the following reasons.

[20] First, as noted above, the two invoices issued by the Predecessor fall outside the relevant period, and are therefore of no assistance in the present case.

[21] Second, although the third invoice is within the relevant period and shows sales by the Owner of various cosmetics, there does appear to be some ambiguities or contradictions between Mr. Pinto's statements and the content of such invoice. In this respect, Mr. Pinto indicates that the Mark was assigned to the Owner on June 15, 2018. However, it appears that the invoice is dated August 16, 2017. It is unclear as to how, in the period prior to the assignment of the Mark, the invoice is in the name of the Owner rather than the one of the Predecessor. Furthermore, Mr. Pinto states that the product code "NSC00040" is the product code used to designate all the registered goods. However, based on the plain meaning of the words "Ever Young 24h Dual Moisturizer" which identify the product correlating to that product code in the invoice, one would reasonably infer that such product code relates, at best, to the registered goods "Skin moisturizers of face and body", and not to all the registered goods as purported by Mr. Pinto. In view of the foregoing ambiguities, I am not prepared to accept that invoice as documentary support of the Owner's transfer of any of registered goods during the relevant period in Canada.

[22] Third, I note that, absent direct or documentary evidence, the evidence of transfer in the normal course of trade in Canada can also be through clear sworn statements regarding volumes of sales, dollar value of sales, or equivalent factual particulars in order to satisfactorily reply to a section 45 notice [see, for example, *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79]. In the present case, other than stating that at least 500 of the registered goods were sold in Canada for a wholesale value of at least \$7000, Mr. Pinto does not provide any sales breakdown to show which of the skin, body or face care items bearing the Mark, if any, were actually sold by the Owner during the relevant period.

[23] Consequently, there is no evidence of a transfer in the normal course of trade of any of the registered goods in Canada during the relevant period. As such, I am not satisfied that the Owner has demonstrated use of the Mark in Canada within the meaning of sections 4(1) and 45 of the Act in association with such goods. As there is no evidence of special circumstances to excuse non-use of the Mark, the goods will be deleted from the registration.

DISPOSITION

[24] 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 expunged.

Yves Cozien Papa Tchoufou
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: 2022-04-14

APPEARANCES

No one appearing	For the Registered Owner
Colleen Spring Zimmerman	For the Requesting Party

AGENTS OF RECORD

Borden Ladner Gervais LLP	For the Registered Owner
Fogler, Rubinoff LLP	For the Requesting Party