



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 111

Date of Decision: 2022-06-02

IN THE MATTER OF A SECTION 45 PROCEEDING

Island IP Law

Requesting Party

and

Estée Lauder Cosmetics Ltd.

Registered Owner

TMA656,026 for SPOTLIGHT

Registration

Introduction

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA656,026 for the trademark SPOTLIGHT (the Mark). The Mark is registered for use in association with “Skincare preparations, namely, skin lotions”.

[2] For the reasons that follow, I conclude that the registration ought to be expunged.

The Proceeding

[3] On April 3, 2019, at the request of Island IP Law (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the

Act) to Estée Lauder Cosmetics Ltd. (the Owner). The notice required the Owner to show whether the Mark was 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 (making the relevant period for showing use from April 3, 2016 to April 3, 2019) and, if the Mark had not been so used, the date when the Mark was last in use and the reason for the absence of such use since that date.

[4] The relevant definition of “use” is 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.

[5] In the absence of use, pursuant to section 45(3) of the Act, a trademark is liable to be expunged, unless special circumstances excuse the absence of use.

[6] In response to the Registrar’s notice, the Owner submitted the affidavit of Rita M. Odin, the Vice President and Senior Trademark Counsel for the Owner, sworn on November 1, 2019 (the Odin Affidavit). The Requesting Party filed its written representations on January 6, 2020.

[7] Subsequently, the Owner requested a retroactive extension of time to file a supplemental affidavit, in order to correct a clerical error in the original Odin Affidavit. On March 5, 2020, the Registrar granted this request and the second affidavit of Ms. Odin, sworn on February 24, 2020 (the Supplemental Affidavit), was made of record. The Registrar also granted the Requesting Party additional time, until April 5, 2020, to file and serve further written representations. The Registrar indicated that the Owner would then be given two months to file its written representations, beginning the earlier of April 5, 2020, or the date that the Requesting Party filed and served further written representations or a statement indicating that it did not wish to do so.

[8] On March 6, 2020, the Owner submitted its written representations and requested another retroactive extension of time, this time to file a third affidavit, correcting an “omission in [the Owner’s] evidence” (the Third Affidavit). The Registrar found that, in contrast to the

Supplemental Affidavit, which corrected an obvious clerical error in the original Odin Affidavit, the Third Affidavit consisted of additional evidence beyond what was included in the first and second affidavits. As a result, the Registrar refused to grant the extension of time, and the Third Affidavit was not made of record.

[9] As for the written representations submitted by the Owner, the Registrar found that these were prematurely filed and, therefore, they were not made of record. The Registrar indicated that the timeline set out in the Registrar's correspondence of March 5, 2020, would remain in effect and that the Requesting Party's deadline to file and serve further written representations was April 5, 2020, followed by the Owner's deadline to file and serve same.

[10] The Requesting Party did not file further written representations, nor did the Owner re-file its written representations. No oral hearing was held.

Summary of the Owner's Evidence

The Odin Affidavit

[11] According to Ms. Odin, DJF Enterprises has "used the trademark SPOTLIGHT, under license from the ESTEE LAUDER brand, in Canada since at least as early as 2017, continuously to the present."

[12] Although Ms. Odin does not define "the ESTEE LAUDER brand" as one specific entity, she explains that references to that brand correspond to the "activities of [the Owner]". In addition, Ms. Odin attests that use of the Mark by DJF Enterprises is "under the direct or indirect control of [the Owner] by virtue of the corporate relationship between the parties, and internal reporting structures relating to use of [the Mark] on product, packaging, and related sales and marketing materials."

[13] With respect to the relationships between the companies referenced in her affidavit, Ms. Odin explains that DJF Enterprises and the Owner are related, as they are both wholly-

owned subsidiaries of The Estee Lauder Companies Inc. and part of the Estee Lauder group of companies.

[14] Ms. Odin states that the Mark is “used in association with a skin highlighter palette that enhances the users [*sic*] features such as cheekbones and forehead”. She explains that “the SPOTLIGHT product provides three shades that melts [*sic*] into the skin to add dimension and definition, and is beneficial to skin health” and that this product “can be applied without the use of a separate moisturizer”.

[15] Ms. Odin further states that, in Canada, the SPOTLIGHT product is sold through Sephora stores and is also available for sale on the SMASHBOX website. She identifies Exhibit A as a printout from the Sephora Canada website, and Exhibit B as a webpage printout from the SMASHBOX website. However, both exhibits contain the same printout (this clerical error was later corrected by the Supplemental Affidavit).

[16] The exhibited printout is a webpage from the Sephora website depicting a three-color palette identified as “SMASHBOX Spotlight Palette”. As shown in the excerpt reproduced below, the Spotlight palette appears to be categorized under the “Makeup > Face > Highlighter” website tabs.

Makeup > Face > Highlighter



SMASHBOX
Spotlight Palette

SIZE 0.30 oz / 8.61 g • ITEM 1934645

★★★★☆ 242 reviews | ❤️ 10K loves

COLOR: Pearl - Soft Highlight

Standard size: Radiant finish



[17] Finally, Ms. Odin attests that annual sales revenue figures for the SPOTLIGHT product have exceeded \$400,000 during the fiscal years 2017 and 2018.

The Supplemental Affidavit

[18] In her Supplemental Affidavit, Ms. Odin provides a webpage printout from the SMASHBOX website which she explains is “the one that was supposed to be attached as Exhibit B to [her] prior affidavit”.

[19] The exhibited printout depicts a three-color palette identified as “SPOTLIGHT PALETTE” which resembles the palette depicted on the Sephora website (provided by the first Odin Affidavit). The product is described on the exhibited webpage as an “easy to use highlighting palette” and appears to be categorized under the “Palette > Spotlight Palette” website tabs.

Analysis

[20] 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. As such, the evidentiary threshold that the registered owner must meet is quite low; the registered owner must simply establish a *prima facie* case of use within the meaning of section 4 of the Act [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[21] That being said, the evidence must contain sufficient facts to support a conclusion that the trademark has been used in Canada, as opposed to containing bare assertions of use, which 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 reasonable inferences can be made from the evidence provided [*Eclipse International Fashions Canada Inc v Shapiro Cohen* (2005), 48 CPR (4th) 223 (FCA)], the Registrar must be able to “rely on an inference from proven facts rather than on speculation” to satisfy every element required by the Act [*Diamant Elinor* at para 11; see also *Smart & Biggar v Curb*, 2009 FC 47 at para 20].

[22] In my view, the evidence in this case is insufficient to establish that the Mark was used in association with the registered goods. In particular, the Owner has failed to show that the evidenced SPOTLIGHT product corresponds to skin lotion.

[23] In coming to that conclusion, I am cognizant that one is not to be “astutely meticulous when dealing with [the] language used” when interpreting the statement of goods [*Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654 at para 17]. However, as pointed out by the Requesting Party, the product in evidence is a “skin highlighter palette” – it is described as such on the exhibited webpages as well as by Ms. Odin in her affidavit, and is nowhere characterized as lotion. In fact, aside from Ms. Odin’s recitation of the registered goods, the evidence makes no reference to “lotions”. On this point, it is unclear why Ms. Odin would not describe the evidenced SPOTLIGHT product as a “skin lotion” if it in fact corresponds to the registered goods.

[24] Furthermore, the characterizations and depictions of the SPOTLIGHT product in the evidence are not sufficient for me to reasonably infer that the product corresponds to lotion. For example, while Ms. Odin states that the evidenced highlighter palette “can be applied without the use of a separate moisturizer”, it would be merely speculative to infer from that statement that the SPOTLIGHT product is itself a moisturizer or lotion [see *Fraser Milner Casgrain LLP v Fabric Life Limited*, 2014 TMOB 135 at para 13, for the principle that it is the responsibility of the registered owner to show the connection between the goods registered and those included in the evidence]. The same reasoning applies to Ms. Odin’s statement that the product “melts” into skin.

[25] In view of the foregoing, I am not satisfied that the Owner has met its *prima facie* burden to demonstrate use of the Mark in association with the registered goods within the meaning of sections 4 and 45 of the Act.

Disposition

[26] As there is no evidence of special circumstances excusing non-use of the Mark before me, 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.

Eve Heafey
Hearing Officer
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

Bereskin & Parr LLP

For the Registered Owner

Stephen R. Burri

For the Requesting Party