



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 115

Date of Decision: 2022-06-08

**[UNREVISED ENGLISH
CERTIFIED TRANSLATION]**

IN THE MATTER OF A SECTION 45 PROCEEDING

Smart & Biggar LLP

Requesting Party

and

Marina Del Rey Foods Inc.

Current Owner

TMA408,815 for ALIBI

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. TMA408,815 for the trademark ALIBI (the Mark), currently owned by Marina Del Rey Foods Inc. (the Owner).

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

[TRANSLATION]

Body and facial care products, namely: cleansing milk, toning lotion, exfoliative, foundation cream, self-tanning milk, protective cream, bo milk, massage oil, hand cream,

talcum powder, bath oil, soaps; hair care products, namely: shampoos, cosmetics and make-up, namely: lipstick, lip pencils, blush, eyeshadow, mascara, foundation.

[3] For the following reasons, I conclude that the registration ought to be amended.

THE PROCEEDING

[4] At the request of Smart & Biggar LLP (the Requesting Party), the Registrar of Trademarks gave notice under section 45 of the Act on May 19, 2020, to 7096933 Canada Inc., then the registered owner of the Mark.

[5] The notice required the registered owner to show that it had used the Mark in Canada in association with each of the goods listed in the registration at any time within the three-year period immediately preceding the date of the notice. In the absence of use, the Registrar's notice directed the registered owner to demonstrate the date on which the Mark was last used 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.

[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 criterion for establishing use is not demanding, and there is no need for an overabundance of evidence [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)]. However, sufficient facts must be presented to enable the Registrar to conclude that the Mark was used in association with each of the goods listed in the registration during the relevant period [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448]. Bare assertions of use are not sufficient to demonstrate use of the Mark [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[8] Although not consequential in this case, I note that the footnotes in the registration show that the following changes were recorded by the Canadian Intellectual Property Office on August 11 and August 18, 2020, respectively:

- change in title from 7096933 Canada Inc. to 8875154 Canada Inc. following a merger on May 20, 2014;
- change in title from 8875154 Canada Inc. to the Owner following a merger on August 26, 2014.

[9] In response to the Registrar's notice, the Owner furnished the affidavit of Franco Cristiano, signed on December 9, 2020, to which Exhibits A to D are attached.

[10] Only the Requesting Party filed written submissions, while only the Owner was represented at the hearing.

THE EVIDENCE

[11] Mr. Cristiano has been president, secretary, and director general of the Owner since its creation in May 2014 [para 1]. He explained that the Owner is a private Canadian company that manufactures, imports, and distributes throughout North America several types of goods, including the range of skin, bath, and body care products sold under the Mark [para 6].

[12] Mr. Cristiano states that during the relevant period, the Owner used the Mark in Canada, in the normal course of trade, in association with "*body and face care products, including exfoliants, body lotion, talc, body oil and soap.*" He states that these goods correspond to those identified in French in the registration under: [TRANSLATION] exfoliative, body milk, talcum powder, bath oil, soaps (collectively "the Goods") [para 7].

[13] Mr. Cristiano attached as Exhibit B to his affidavit pictures of the Goods bearing the Mark. He states that these photographs are representative of the Goods sold in Canada by the Owner during the relevant period [para 8].

[14] Mr. Cristiano explains that Goods bearing the Mark are usually sold in discount stores (dollar stores) and pharmacies. He has provided the names of retailers in Canada to whom the Owner sold the Goods during the relevant period [para 9].

[15] Mr. Cristiano attached as Exhibit C to his affidavit a sample of invoices attesting to the sale of the Goods bearing the Mark, by the Owner, during the relevant period. His affidavit even includes a correlation table between the Goods and the goods identified by the Mark on all invoices contained in Exhibit C [para 10].

[16] Finally, a page on the Owner's website showing some of the Goods bearing the Mark is attached as Exhibit D to the affidavit; this page is representative of the promotion of the Goods on the Owner's website during the relevant period [para 13].

ANALYSIS AND REASONS FOR DECISION

Absence of evidence of use

[17] At the hearing, the Owner acknowledged that it did not present evidence of use of the Mark in association with the following goods listed in the registration:

[TRANSLATION]

... Cleansing milk, toning lotion ... foundation cream, self-tanning milk, protective cream ... massage oil, hand cream, ...; hair products, namely: shampoos, cosmetics, and make-up, namely: lipstick, lip pencils, blush, eyeshadow, mascara, foundation.

[18] Since the Owner also acknowledged that its evidence did not show any special circumstances excusing this non-use, I find that the goods identified above should be expunged from the registration.

Evidence of use with respect to the remaining goods

[19] In its written representations, the Requesting Party acknowledges that the evidence clearly demonstrates that the "exfoliative," "body milk," "talcum powder," and "soap" goods listed in the registration were sold in Canada during the relevant period and that these goods bore the Mark at the time of transfer.

[20] In light of the parties' arguments, discussed below, the sole issue left to be determined in this case is whether the Owner's evidence leads to the conclusion that the Mark was used in Canada, during the relevant period, in association with the "bath oil" good specified in the registration.

[21] In its written submissions, the Requesting Party essentially argues that Mr. Cristiano's statement concerning the use of the Mark in association with "body oil" (as specified in the registration) constitutes a bare allegation of use.

[22] In support of its position, the Requesting Party submits that the goods appearing in the photos of Exhibit B are clearly identified on their labels as "hand and body lotion" (1st photo), "baby oil" (2nd photo), "daily exfoliating body gel" (3rd photo), "ultra fine talc" (4th photo), and "hand soap" (5th to 9th photos). None of the goods illustrated in the photos are identified as "bath oil," and the "baby oil" good is a good entirely different from the "bath oil" good.

[23] Furthermore, the Requesting Party notes that although the table in paragraph 10 of Mr. Cristiano's affidavit states that invoices Nos. 100886, 102596 (sic), 105618, 107341, 107574, 108469, 110678, and 119174 included in Exhibit C show the sale of bath oil, the corresponding good listed on each of these invoices is "#ALIBI HUILE POUR BEBE" or "#ALIBI BABY OIL." None of the invoices included in Exhibit C refers to "bath oil."

[24] At the hearing, the Owner submitted that baby oil qualifies as bath oil because it is an oil that can be poured/diluted in bath water to act on the skin. While acknowledging that its claim is not supported by the evidence, the Owner noted that the label of the baby oil bottle states "FOR BABY AND ADULTS" (emphasis added) [2nd photo of Exhibit C]. Based on my understanding of the Owner's representations, the fact that the good is also intended for adults supports its position.

[25] It is not for the Registrar to speculate as to the nature of the registered goods. It is the responsibility of the registered owner to show the connection between the products described in the registration and those referred to in the evidence [*Fraser Milner Casgrain LLP v Fabric Life Ltd*, 2014 TMOB 135 at para 13; *Wrangler Apparel Corp v Pacific Rim Sportswear Co* (2000), 10 CPR (4th) 568 at para 12 (TMOB)]. However, the Registrar may make reasonable inferences

based on the evidence provided [*Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64].

[26] I agree with the Owner that the evidence supports the finding that adults can use the baby oil associated with the Mark. However, I am not satisfied that this fact leads to the conclusion that baby oil corresponds to bath oil. The goods at issue are certainly a type of oil, but I do not think that baby oil is a good generally considered to be bath oil. In my opinion, it is quite reasonable to conclude that baby oil is an oil intended to be applied directly to the skin, rather than an oil intended to be poured or diluted in bath water. In other words, in the absence of clear evidence from the Owner, I rely on common sense to conclude that baby oil is not bath oil.

[27] Therefore, I find that the Owner did not demonstrate use of the Mark in association with “bath oil” during the relevant period. Since there is no evidence of special circumstances excusing this non-use, I find that this good should be expunged from the registration.

[28] In light of the above, I find that the evidence establishes the use of the Mark in Canada, within the meaning of section 4(1) and section 45 of the Act, only in association with the following goods: [TRANSLATION] “exfoliative,” “body milk,” “talcum powder,” and “soap.”

DISPOSITION

[29] For the reasons set out above, and pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended pursuant to section 45 of the Act to expunge the following goods:

[TRANSLATION]

... Cleansing milk, toning lotion ... foundation cream, self-tanning milk, protective cream ... massage oil, hand cream, ...; bath oil, hair products, namely: shampoos, cosmetics, and make-up, namely: lipstick, lip pencils, blush, eyeshadow, mascara, foundation.

[30] The statement of goods will read as follows:

[TRANSLATION]

Body and facial care products, namely: exfoliative, body milk, talcum powder; soaps.

Céline Tremblay
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Certified translation
Daniel Lepine

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

HEARING DATE 2022-06-02

APPEARANCES

Ms. Catherine Bergeron

For the Owner

No appearance

For the Requesting Party

AGENTS OF RECORD

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For the Owner

Smart & Biggar LLP

For the Requesting Party