



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 255

Date of Decision: 2022-12-16

IN THE MATTER OF AN OPPOSITION

Opponent: Pure Devotion Inc.

Applicant: Ask Cosmetics Inc.

Application: 1,781,468 for PURE DEVOTION

INTRODUCTION

[1] Pure Devotion Inc. (the Opponent) opposes registration of the trademark PURE DEVOTION (the Mark), which is the subject of application No. 1,781,468 (the Application) by Ask Cosmetics Inc (the Applicant).

[2] The Application is based on use of the Mark in Canada since February 14, 2016. The statement of goods (the Goods) is reproduced below, together with the associated Nice class:

CI 3 (1) Face care cosmetics, namely cleansers, lotions, washes, creams, moisturizers, protection lotions and skin milks. (2) Skin care cosmetics, namely cleansers, lotions, washes, creams, moisturizers, protection lotions and skin milks.

[3] For the reasons that follow, the opposition is rejected.

THE RECORD

[4] The Application was filed on May 9, 2016, and was advertised for opposition purposes in the *Trademarks Journal* of March 21, 2018. A statement of opposition was filed on August 21, 2018. In accordance with section 70 of the *Trademarks Act*, RSC 1985, c T-13 (the Act), the grounds of opposition will be dealt with in accordance with the provisions of the Act as they read immediately before June 17, 2019. The Opponent raises grounds of opposition based on non-compliance with sections 30(b) and 30(i), entitlement under section 16(1)(c), and distinctiveness under section 2 of the Act.

[5] The Applicant filed and served a counter statement denying the grounds of opposition.

[6] Both parties filed evidence, which is discussed below. Both parties filed written representations, and only the Applicant attended a hearing.

OVERVIEW OF THE EVIDENCE

[7] The Opponent filed the affidavits of Teresa Van Fleet, the founder of the Opponent, and Chris Steffler, a graphic designer. The Opponent's evidence seeks to establish that Ms. Van Fleet and Mr. Steffler came up with the name PURE DEVOTION. According to Ms. Van Fleet, after having a trademark availability search conducted for PURE DEVOTION, she also started carrying on business as Pure Devotion and later incorporated the name. Ms. Van Fleet takes the position that the Applicant's involvement was limited to acting as a contract manufacturer for the Goods, and that the Opponent and its predecessor in title are the owner and user of the Mark under which the Goods were sold to The Shopping Channel in February 2016.

[8] The Applicant filed the affidavit of Sherry Lane, the Vice President of the Applicant. The Lane affidavit seeks to establish that it was the Applicant that came up with the name PURE DEVOTION, arranged for a trademark availability search for the

Mark, finalized product labelling/artwork displaying the Mark for the Goods, and sold these Goods to The Shopping Channel in February 2016.

[9] As both parties have a different version of events leading up to the creation and use of the Mark, the determination of which party originated, used and owns the Mark ultimately turns on the credibility of the parties' evidence.

LEGAL ONUS AND EVIDENTIAL BURDEN

[10] The legal onus is on the Applicant to show that the Application complies with the provisions of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial burden is met, the Applicant must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition pleaded should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 30(b) ground of opposition

[11] The material date for considering a ground of opposition under section 30(b) of the Act is the date of filing of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

[12] The Opponent has pleaded that contrary to section 30(b) of the Act, the Applicant had not used the PURE DEVOTION trademark on the Goods as of February 14, 2016 as alleged in the Application or at all as required by section 30(b). As I understand it, the Opponent is not disputing that the Mark was used in February 2016, but rather, takes the position that it was the Opponent and its predecessor in title who used the Mark instead of the Applicant.

[13] With this in mind, I will now summarize each party's version of events leading up to the use of the Mark in February 2016.

Opponent's evidence – the Van Fleet and Steffler affidavits

The Van Fleet affidavit

[14] The affidavit of Teresa Van Fleet was sworn on January 9, 2019. Ms. Van Fleet was cross-examined on her affidavit, and the transcript and answers to undertakings form part of the record. Ms. Van Fleet identifies herself as the founder of the Opponent, having held this position since the Opponent's incorporation on February 23, 2016. Ms. Van Fleet describes the Opponent as the successor to a business she started "proposing to manufacture and sell face and skin care cosmetic products through the Shopping Channel, and that began to carry on business as PURE DEVOTION at least as early as January 2016" (para 2).

[15] Ms. Van Fleet states that after an unsuccessful preliminary attempt in Fall 2015, she decided to try and set up the new business to create, manufacture and sell a natural face and skin care product line. She states that her friend Karen Wheeler, who at the time was the President of the Applicant, indicated that the Applicant would be willing to contract manufacture the product line for Ms. Van Fleet's new business (paras 3-6). I note that Karen Wheeler is also known and referred to as Karen Orlowski in the record (cross-examination of Ms. Van Fleet at Q63). For consistency, I will refer to her throughout this decision as Ms. Wheeler.

[16] Ms. Van Fleet states that in December 2015, she and Chris Steffler were discussing possible names for the new business and Mr. Steffler suggested calling the new product line PURE DEVOTION. They had this name, along with two potential others, searched for availability as a trademark in mid-January 2016. On receipt of the advice that PURE DEVOTION was available, they decided that PURE DEVOTION would be the name of the new product line as well as the company. Ms. Van Fleet states that from that point on she carried on business as PURE DEVOTION (para 7).

[17] The first (and only) PURE DEVOTION product was a face care kit that included a facial cleanser, moisturizer, and a facial chart. Ms. Van Fleet states that to comply with consumer packaging and labelling requirements, they placed a reference to the contract manufacturer's website (*askcosmetics.com*) and customer care telephone number on

the bottle. This was approved by Ms. Wheeler on behalf of the Applicant as manufacturer of the PURE DEVOTION products (para 8). Exhibits 9 and 10 are photographs of the PURE DEVOTION cleanser and moisturizer, respectively. I note that the front of the bottles clearly display the Mark. The back of the bottles also display the Mark along with reference to a partial address (Toronto, Ontario and a postal code), a 1-877 phone number belonging to the Applicant, and the web address *askcosmetics.com*.

[18] Ms. Van Fleet states that in and around the same time that the PURE DEVOTION product was being manufactured, Ms. Wheeler was in discussions with The Shopping Channel (TSC) for a one-hour show for the Applicant's product (not PURE DEVOTION product but other product under a different trademark) in February 2016. Ms. Van Fleet states that since the Applicant didn't have enough inventory to properly do the show, TSC agreed to split the show between the Applicant's product and the PURE DEVOTION product so Ms. Van Fleet could launch the PURE DEVOTION line. Ms. Van Fleet states that during all discussions it was noted and understood by both parties and TSC that the Applicant and Pure Devotion were separate entities even though they would be sharing the one hour timeslot (para 9). Exhibit 5 is described as a copy of an email from TSC to Ms. Fleet together with a New Vendor Agreement referring to the business as Pure Devotion LLC. Exhibits 6, 6A and 7 are described as New Item Specification Forms for the PURE DEVOTION face care kit, cleanser and moisturizer, respectively, submitted by Ms. Van Fleet to TSC on or around February 16, 2016. Exhibit 8 is described as a copy of the Purchase Order (PO) issued by TSC for the PURE DEVOTION products. Ms. Van Fleet states that in order for the PURE DEVOTION products to be included on the February show on TSC, that TSC required a signed PO immediately. To prevent delay, the parties agreed to issue a one-time PO for the PURE DEVOTION order through the Applicant, since it was already set up as a vendor to TSC (para 10).

[19] Ms. Van Fleet states that the Applicant then proceeded, on her instructions to Ms. Wheeler, to bottle the PURE DEVOTION products. Ms. Van Fleet, with the help of friends, then added batch numbers, sealed the products, and packed the facial kits in cartons for shipment to TSC. Approximately 2000 kits were produced (para 12).

[20] Ms. Van Fleet states that during the TSC show, which aired on February 23, 2016, there was a clear division between the part of the show dedicated to the sale of the Applicant's products and the part of the show dedicated to the sale of the PURE DEVOTION products. Ms. Van Fleet notes that to highlight this distinction, the background changed colors and the PURE DEVOTION logo was prominently displayed (para 14).

[21] Ms. Van Fleet states that after the show, TSC remitted payment to the Applicant for all products sold, and shipped back to the Applicant the unsold products of both the Applicant and Pure Devotion. In particular, 1,157 unsold PURE DEVOTION facial care kits were shipped back to the Applicant's facility in Burlington, Ontario. The Opponent moved the product to a temporary warehouse facility on or about April 2016 (para 15, Exhibit 11).

[22] Ms. Van Fleet states that she instructed the incorporation of the Opponent on February 19, 2016 and as of the incorporation date (of February 23, 2016), transferred all of her rights in the PURE DEVOTION business including the trade name and trademark PURE DEVOTION to the newly formed company (para 16). The Opponent filed an application for the trademark PURE DEVOTION which was inadvertently abandoned; a new application was filed in January 2018 (para 17). Ms. Van Fleet also asked Mr. Steffler to register, on behalf of the Opponent, the domain names *puredevotion.ca* and *pure-devotion.com* (para 18).

[23] On cross-examination, a number of Ms. Van Fleet's assertions were called into question or undermined. In this regard, the following facts and admissions are set out below:

- Before incorporating the Opponent, Ms. Van Fleet ran her new business personally (Q16). She had said that this new business began to carry on business as Pure Devotion at least as early as January 2016 (para 2). This means she was looking into developing the business and was at that point making inquiries about names and possible product packaging for the cosmetic products (Q54). Other than the sales to TSC, Ms. Van Fleet did not

sell any other product under Pure Devotion or by herself prior to February 23, 2016 (the date of incorporation of the Opponent) (Q58-60), nor did she file any income tax returns on behalf of that business or in her personal income taxes any deductions or income on behalf of the Pure Devotion business. (Q260-261)

- Ms. Van Fleet never created written documents using PURE DEVOTION as a business name (Q20).
- Ms. Van Fleet did not have a written agreement for contract manufacturing with the Applicant, but rather an oral agreement with Ms. Wheeler (Q62-65). Ms. Van Fleet advised that: the Applicant was fronting the production costs of the PURE DEVOTION product for her (Q73); the Applicant never sent her a written document setting out those costs for production (Q75); the Applicant sent the PURE DEVOTION product to TSC (Q71); Ms. Van Fleet was never paid for the sales of the PURE DEVOTION product (Q76), and; the Applicant never sent Ms. Van Fleet any invoice, PO or other business document in relation to this contract manufacturing (Q77).
- It was actually Ms. Wheeler who first looked at the trademark issues from selecting the trademark PURE DEVOTION (Q210). Ms. Van Fleet states that Ms. Wheeler ordered the trademark searches on Ms. Van Fleet's behalf, but is not aware of any communication (such as an instructing email) she might have with Ms. Wheeler to suggest this (Q212).
- Exhibit 8 to the Van Fleet affidavit is not a PO but in fact a document entitled "Purchase Order Worksheet, Canadian New" (Q88). Under the heading "Vendor Details", it says "Ask Cosmetics Inc." (Q94). The sheet lists three products which have an Ask Cosmetics trademark (TIPS) on it, and nowhere on the document is PURE DEVOTION referred to as a corporate entity or sole proprietorship or business name (Q108).
- Ms. Van Fleet was presented with an invoice (No. 886743) of the Applicant, dated February 12, 2016, sold and shipped to TSC accounts payable (Q111-113; Exhibit A for identification, Exhibit G to the Lane affidavit). Ms. Van Fleet admitted that the three PURE DEVOTION items listed in the invoice, along

with the corresponding quantity of each item, correspond to the numbers on the Purchase Order Worksheet in Exhibit 8.

- Ms. Van Fleet admitted that she had no reason to believe that invoice No. 886743 of the Applicant was not sent to TSC (Q120).
- The unsold PURE DEVOTION facial care kits leftover from TSC show (which aired in February 2016) were shipped back to the Applicant in March 2016, not to the Opponent (Q272-277). Ms. Van Fleet made arrangements to move the PURE DEVOTION product to a warehouse, but it was later seized from this warehouse by the police and returned to the Applicant (Q294).
- Ms. Van Fleet objected to the seizure of the PURE DEVOTION product by the police, but did not have anything to present to the police to show the product belonged to the Opponent as the agreement between the Applicant and the Opponent was oral (Q297). The Opponent never brought a lawsuit against the Applicant to return the PURE DEVOTION product seized by the police (Q298), nor did the Opponent ever write to the Applicant asking for the return of this product (Q299). The Opponent took no other steps (phone calls, emails or any other communication) with the Applicant to try to get the product back (Q300). Ms. Van Fleet indicated that she did not bring this forward to the Applicant “based on the various disputes that were happening” (Q302).

[24] During cross-examination, it was acknowledged by Ms. Van Fleet that in January and February of 2016, Ms. Wheeler was involved in a dispute involving at least one other shareholder of the Applicant (Q141). Ms. Van Fleet was also aware that Ms. Wheeler was being petitioned into bankruptcy (Q145). The dispute between Ms. Wheeler and the other shareholders of the Applicant could be characterized as relating to the allocation of funds in the Applicant that may have been borrowed by Ms. Wheeler (Q147).

The Steffler affidavit

[25] The affidavit of Chris Steffler was sworn on January 9, 2019. Mr. Steffler was cross-examined on his affidavit, and the transcript and answers to undertakings form

part of the record. Mr. Steffler describes his employment as freelance graphic designer (para 1).

[26] Mr. Steffler states that in December 2015, he was discussing alternative names for Ms. Van Fleet's new venture that was proposing to manufacture and sell face and skin care cosmetic products, and proposed "PURE DEVOTION" as the name of the new product line (para 2).

[27] Mr. Steffler states that he was retained by Ms. Van Fleet to develop the artwork for the bottles for both the PURE DEVOTION facial cleanser and moisturizer. Mr. Steffler was also responsible for designing the facial chart sheet intended to accompany the products. Exhibits 1-3 are copies of the artwork for the bottles and chart. Mr. Steffler further notes that he was instructed by Ms. Van Fleet to direct all invoices for the aforementioned work to PURE DEVOTION (para 5, Exhibit 4). However, on cross-examination Mr. Steffler admitted that he never invoiced anyone for that work (Q34).

[28] During cross-examination, Mr. Steffler acknowledged that he had also done work for the Applicant in January 2016 (Q70). He stopped when the Applicant stopped paying him (Q71), and pursued the matter of non-payment in small claims court (Q73-75). A costs order was made against Mr. Steffler in favour of the defendants (including the Applicant in this case) (Q76).

[29] On cross-examination, Mr. Steffler appeared unsure which of the parties was actually selling the PURE DEVOTION products. When asked whether it made sense to have the contact information for the Applicant on the PURE DEVOTION products because it was the Applicant that was selling the product, Mr. Steffler stated "That is a good question. I would have to leave that up to the girls [Ms. Van Fleet and Ms. Wheeler]. I don't know. Like I said, I am just the logo guy. I am just the marketing guy. I am just the – you know, I am over there. They had manufacturing equipment, and Karen was, you know, part of the whole show there. I don't know. That is what I would say" (Q94).

Applicant's evidence – the Lane affidavit

Preliminary matter – objection to the admissibility of the affidavit

[30] In its written representations, the Opponent argues that the Lane affidavit should be removed from the record or alternatively, given little weight, if any, and that an adverse inference be drawn against the Applicant where the evidence of the Opponent conflicts with that of the Applicant.

[31] An order for the cross-examination of Ms. Lane issued on September 18, 2019, and on January 20, 2020, the Opponent wrote to Registrar stating that the Applicant declined to provide dates for cross-examination with the result that the Lane affidavit should be deemed not to be part of the record, or that alternatively, the Opponent be granted an extension of time to complete cross-examination. On January 21, 2020, the Applicant wrote to the Registrar objecting to the Opponent's characterization of the facts. The Applicant submitted that it did not refuse to provide dates but that there was a conflict of interest issue in that Mr. James Carson, a lawyer for the Opponent (at that time), who had appeared at the cross-examination of the Opponent, had in fact previously represented the Applicant in respect of the Applicant's business directly related to the opposition. Counsel for the Applicant had raised this issue with the Opponent and indicated that it was prepared to provide dates for cross-examination to the extent that the Opponent's firm did not represent the Opponent. Counsel for the Applicant states that it followed up with the Opponent's counsel on December 6, 2019, but received no response.

[32] On February 7, 2020, the Opponent appointed new counsel. While new counsel requested an extension of time to file reply evidence, no request was made in respect of cross-examination, nor were any submissions made indicating any interest in or steps being taken to schedule the cross-examination of Ms. Lane.

[33] Based on the foregoing, it does not appear that the Applicant refused to provide dates for cross-examination. Rather, it appears that the Applicant was amenable to providing dates subject to resolution of a conflict issue which was raised with the

Opponent. I therefore find that there is no basis for the Lane affidavit to be removed from the record.

Overview of the Lane affidavit

[34] Ms. Lane is the Vice President of the Applicant, and has held this position since September 27, 2016. Ms. Lane takes the position that the Mark always belonged to the Applicant. She alleges that Ms. Wheeler, before being removed from her position with the Applicant (in around January 2016), sought to transfer the Applicant's assets, one being the subject Mark, for her own benefit. Ms. Lane further alleges that since Ms. Wheeler was subject to bankruptcy proceedings, she did not want to personally hold any assets, including the Mark. Rather, she alleges that Ms. Wheeler sought to conspire with or misled Ms. Van Fleet and potentially Mr. Steffler to establish a seemingly separate business to do.

[35] Ms. Lane explains that after Ms. Wheeler left the Applicant, she later became its Vice President and by virtue of this role, has access to the Applicant's business records, including its email servers (para 12). To this end, Ms. Lane attaches a number of emails and invoices to support her assertions that it was the Applicant that created, owned, and used the Mark.

Emails and invoice indicating the Applicant thought of the name PURE DEVOTION and arranged for a trademark availability search

[36] Ms. Lane states that beginning in around August 2015 to January 2016, Mr. Steffler was a contractor for the Applicant. She states that Mr. Steffler had an exclusive contract and was not supposed to be working for others in respect of cosmetics (para 13). Attached as Exhibit A is email thread starting on January 12, 2016 where Mr. Steffler wrote to "Team ASK" regarding "our latest project", namely two face care items in two ounce bottles. Mr. Steffler wrote that "ASK needs a product line name branding" and asked for input on a list of three proposed PURE/PURITY names. He then stated "Thank you in advance for a prompt response as Karen [Wheeler] is hot to get moving on this as a good size order is in for the products".

[37] Various responses to the request for input on name selection are included in the email thread (para 15). Of particular note is the following email which shows that an employee of the Applicant (with the email address *accounting@askcosmetics.com*) thought of the name of the Mark:

On Thu, Jan 14, 2016 at 3:47 PM, Ask Accounting <accounting@askcosmetics.com> wrote:

What about Pure Devotion ? Just a thought. Not sure if it has the right ring to it for a brand, but figured I'd toss it out there. I wont be offended if you guys shoot it down lol

[38] Exhibit B includes a set of emails from January 14, 2016, between Karen Wheeler (from her email address *karen@askcosmetics.com*) and the Applicant's trademark lawyer at the time, Mr. James Carson at Blaney McMurtry LLP, regarding the availability of a number of trademarks including PURE DEVOTION (para 16). Ms. Wheeler asked to know the usability of Pure Devotion for face care in Canada, the US and Europe on an urgent basis.

[39] Exhibit D is a copy of an invoice dated January 31, 2016, from Mr. James Carson to Ms. Diane Iles (identified as Vice President Operations for the Applicant) in respect of various trademark services including "conducting a preliminary registrability search for PURE DEVOTION" (para 18).

Email suggesting Ms. Wheeler initiated the incorporation of the Opponent

[40] Exhibit E is a copy of an email dated March 11, 2016 from Mr. James Carson to Ms. Wheeler, Ms. Van Fleet and Mr. R. Carson (another lawyer) regarding the PURE DEVOTION trademark. This document was also marked as Exhibit 4 in the Van Fleet cross-examination. In this email, Mr. Carson notes that his firm has some accounts for the trademark searches resulting in the selection of the PURE DEVOTION name that will be addressed to the Applicant, "as that was the entity in existence at the time".

[41] The email further states that "When Karen wanted to incorporate Pure Devotion Inc. I directed her to my son who practices in Burlington. He has incorporated Pure

Devotion Inc. but the trademark applications [for PURE DEVOTION] have not been filed”.

Email suggesting Ms. Wheeler had final approval over artwork/labelling for the PURE DEVOTION products

[42] Exhibit F is an email dated January 18, 2016 from Ms. Wheeler to Mr. Steffler, Ms. Van Fleet, and other email addresses including “Ask Accounting”; this exhibit was also marked as Exhibit 3 to the Van Fleet cross-examination. The subject line of the email is “Face Care Cleanser bottle art text”. Ms. Wheeler writes “Hi, sorry for the delay. Here is the text. Open to changes of course. Who has any thoughts? Speak up or forever hold your peace. K.” The email goes on to provide text to appear on the front and back of the PURE DEVOTION cleanser bottle. Notably, Ms. Wheeler writes that the “Ask Cosmetic Logo and the address etc” are to be included on the back of the bottle.

[43] Ms. Lane states that with a minor change, the artwork/labelling proposed by Ms. Wheeler was used on the final products sold by the Applicant on TSC (para 24). Ms. Lane points out that a reference to the Applicant’s website (www.askcosmetics.com) is listed at the bottom of the product (para 25).

Invoice from the Applicant to TSC for PURE DEVOTION branded products

[44] Exhibit G is an invoice (No. 886743) dated February 12, 2016 from the Applicant to TSC, and marked as “PAID”. This document was also marked as Exhibit A in the Van Fleet cross-examination). Ms. Lane explains that on the invoice, the Applicant’s primary brand, TIPS, is being used to describe the products being sold (e.g. 2000 TIPS – Pure Devotion Essential Face Care, 12 TIPS – Pure Devotion Daily Facial Cleanser, and 12 TIPS – Pure Devotion Protection Moisturizer). Ms. Lane asserts that this further supports that the trademark PURE DEVOTION was a sub-brand of TIPS, and was always a trademark of the Applicant (para 26). Packing list documents from the Applicant for shipping to TSC and corresponding to the order, as well as orders for other products of the Applicant under its TIPS brand are attached as Exhibit I.

[45] Exhibit H is comprised of copies of pages from the web version of TSC showing how the PURE DEVOTION products are advertised. The bottle of cleanser displaying

the Mark is shown, along with a product overview, usage suggestions, ingredients, and a section called “About the Brand”. In this section, the Applicant’s primary brand TIPS is discussed (para 27).

[46] Ms. Lane states that much of the PURE DEVOTION product was sold on TSC; the remaining product was returned by TSC to the Applicant’s warehouse. Some of this product was later stolen from the Applicant’s warehouse and delivered on Ms. Van Fleet’s direction to another warehouse. Ms. Lane submits that at no time did TSC deliver PURE DEVOTION products to Ms. Van Fleet or to the Opponent (para 28).

[47] Ms. Lane states that shortly after Ms. Wheeler was declared bankrupt, unknown individuals filled at least one truck up with product and equipment, including product bearing the PURE DEVOTION mark, from the Applicant’s warehouse. The police were called and the stolen product was tracked down to another warehouse where it was seized by police and eventually returned to the Applicant (para 9).

Analysis

[48] Based on my review of the evidence, I am not satisfied that the Opponent has provided sufficient facts to put into question the Applicant’s claim of use of the Mark. On the contrary, the Opponent’s evidence regarding its predecessor in title’s purported use of the Mark raises significant doubts as to whether it was the party that actually used the Mark.

[49] For instance, while the Van Fleet affidavit makes a number of allegations relating to Ms. Van Fleet’s selection and clearance of the trademark PURE DEVOTION, these allegations are not substantiated in the evidence. The Applicant’s evidence, which is substantiated by emails and invoices, directly contradicts the claims made by Ms. Van Fleet.

[50] Further, the Opponent’s allegation that the Applicant’s involvement with PURE DEVOTION products was limited to the role of contract manufacturer is not supported in the evidence. Indeed, Ms. Van Fleet’s admissions on cross-examination suggest otherwise, in particular, her admissions that: the Applicant never sent her any written

documentation setting out production costs, that the Applicant sent the PURE DEVOTION product to TSC, that Ms. Van Fleet was never paid for the sales of the PURE DEVOTION product, and that the Applicant never invoiced Ms. Van Fleet for any work done in respect of the purported contract manufacturing.

[51] In addition, Ms. Van Fleet did not have any invoices reflecting the sale of the PURE DEVOTION products to TSC. When presented with the Applicant's invoice for the sale of PURE DEVOTION products to TSC on cross-examination (Exhibit G, Lane affidavit) she admitted that she had no reason to believe that invoice was not sent to TSC. Notably, in the invoice, the Applicant's primary brand TIPS is used to describe the products being sold (e.g. TIPS – Pure Devotion Essential Face Care etc). Information on the Applicant's TIPS brand is also provided alongside the display of the PURE DEVOTION products on TSC website (Exhibit H, Lane affidavit).

[52] Moreover, Ms. Van Fleet does not dispute that the unsold PURE DEVOTION product that was removed by the Opponent to a temporary warehouse facility was seized by the police and returned to the Applicant and that no steps were taken to try to get the product back.

[53] Accordingly, this ground of opposition is rejected on the basis that the Opponent has failed to meet its initial evidential burden under section 30(b) of the Act.

Section 30(i) ground of opposition

[54] The material date for considering a ground of opposition under section 30(i) of the Act is the date of filing of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

[55] The Opponent has pleaded that the Applicant could not state in good faith, as required by section 30(i) of the Act, that it was satisfied it was entitled to use the Mark in association with the applied for Goods in view of the PURE DEVOTION trade name that had been previously used in Canada by the Opponent's predecessors in title, Ms. Van Fleet and Mr. Steffler.

[56] Where an applicant has provided the statement required by section 30(i) in its application (as in this case), a ground of opposition based on this section should only succeed in exceptional cases such as where there is evidence of bad faith on the part of an applicant [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155].

[57] Based on my review of the evidence above, I find that the Opponent has failed to meet its initial evidential burden of proving any bad faith on the part of the Applicant. Nothing in the record leads me to conclude that, on the filing date of the Application, the Applicant acted in bad faith in declaring that it was satisfied that it was entitled to use the Mark. On the contrary, the evidence indicates that there was no previous use of PURE DEVOTION as a trade name (or trademark) by Ms. Van Fleet or by Mr. Steffler, who was in fact erroneously identified as a predecessor in title of the Opponent in the statement of opposition (Van Fleet cross-examination Q26-31).

[58] Accordingly, this ground of opposition is rejected.

Section 16(1)(c) ground of opposition

[59] For the entitlement ground pleaded, the Opponent has an initial evidential burden to prove that that the Opponent's predecessor in title had used the trade name PURE DEVOTION in Canada prior to the Applicant's claimed date of first use, namely February 14, 2016.

[60] As discussed above, I find that the Opponent's evidence fails to show prior use of the trade name PURE DEVOTION by the Opponent's predecessor in title. On cross-examination, Ms. Van Fleet indicated that to the extent that she carried on business as PURE DEVOTION, she was simply looking into developing the business and was making inquiries about names and possible cosmetic product packaging. Notwithstanding that it is questionable whether she was even the person that made inquiries about PURE DEVOTION as a possible name (as discussed above), I do not consider that these activities would establish use of the trade name in the normal

course of trade and in relation to the class/classes of persons with whom such trade is to be conducted.

[61] Moreover, Ms. Van Fleet acknowledged that other than the sales made to TSC in February 2016, Ms. Van Fleet did not sell any other product under the trade name Pure Devotion or by herself prior to February 23, 2016, the date of incorporation of the Opponent.

[62] Accordingly, this ground of opposition is rejected.

Section 2 ground of opposition

[63] The Opponent has pleaded that the Mark is not distinctive in that it does not and is not adapted to distinguish the Goods associated with the Mark from the goods associated with the PURE DEVOTION trademark and trade name of the Opponent.

[64] To meet its initial evidential burden under this ground of opposition, the Opponent must show that as of the filing date of the statement of opposition, August 21, 2018, its PURE DEVOTION trademark or trade name was known to some extent at least and the reputation of the trademark or trade name in Canada was substantial, significant or sufficient [*Motel 6, Inc v No 6 Motel Ltd* (1981), 1981 CanLII 2834 (FC), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd* (2006), 2006 FC 657 (CanLII), 48 CPR (4th) 427 (FCTD)].

[65] As discussed above, I find that the evidence does not support the Opponent's allegation that it is the owner and user of the Mark. On the contrary, the record shows that it was the Applicant that created the Mark, manufactured the PURE DEVOTION branded product, and sold it to TSC – the only sales of the product – with the result that any reputation attributable to the Mark would be associated with the Applicant.

[66] As for the PURE DEVOTION trade name, the Opponent has shown no evidence of the use of this trade name in Canada, as the mere registration of the company under a particular name does not, by itself, constitute use as a trade name [*Pharmx Rexall Drug Stores Inc v Vitabrin Investments Inc*, (1995) 62 CPR (3d) 108].

[67] Accordingly, the Opponent has not met its initial evidential burden and this ground of opposition is rejected.

DISPOSITION

[68] In view of all the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Jennifer Galeano
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2022-09-20

APPEARANCES

For the Opponent: No one appearing

For the Applicant: Kenneth R. Clark

AGENTS OF RECORD

For the Opponent: No agent appointed

For the Applicant: Aird & Berlis LLP