



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 204

**Date of Decision:** 2023-12-07

## **IN THE MATTER OF A SECTION 45 PROCEEDING**

**Requesting Party:** Luxie, Inc.

**Registered Owner:** Big IP OPCO, LLC

**Registration:** TMA831358 for LUXY

### **INTRODUCTION**

[1] At the request of Luxie, Inc. (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 June 27, 2022, to Big IP OPCO, LLC (the Owner), the registered owner of registration No. TMA831358 for LUXY (the Mark).

[2] The Mark is registered in association with the following goods and services:

#### *Goods*

- (1) Hair extensions, namely, clip in human hair extensions, remy quality human hair extensions; hairpieces; hair wefts, hair swatches; hair weaves; human hair.
- (2) Cosmetics; skin care preparations; hair care preparations; hair colouring preparations; hair bands; hair clips, hair fasteners; hair ornaments; hair accessories.

*Services*

(1) Online retail sales of hair extensions, clip in human hair extensions, remy quality human hair extensions, hairpieces, hair wefts, hair swatches, hair weaves, human hair.

(2) Online retail sales of cosmetics, skin care preparations, hair care preparations, hair colouring preparations, hair bands, hair clips, hair fasteners, hair ornaments, hair accessories.

[3] The notice required the Owner to show whether the Mark was used in Canada in association with the goods and services specified in the registration 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 use since that date. In this case, the relevant period for showing use is June 27, 2019 to June 27, 2022.

[4] The relevant definitions of use are 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.

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[5] In the absence of use, pursuant to section 45(3) of the Act, the registration is liable to be expunged or amended accordingly, unless the absence of use is due to special circumstances.

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Amy Sveda, sworn January 16, 2023 (the Sveda Affidavit).

[7] Neither party submitted written representations; a hearing was not requested.

**THE OWNER'S EVIDENCE**

[8] In her affidavit, Ms. Sveda attests that she is the President of Luxy Hair Co. (Luxy), which is engaged in direct-to-consumer sales in the luxury hair market in

Canada [paras 4, 5 and 18]. She attests that, prior to November 20, 2020, Luxy owned and continuously used the Mark in association with all of the registered goods and services [para 10], at which time the Mark was acquired by the Owner. Ms. Sveda explains that Luxy and the Owner are both wholly-owned subsidiaries of Big Pledgeco, LLC [paras 2 to 7]. She confirms that any evidenced use of the Mark by Luxy after November 20, 2020 was under license, with the Owner exerting the requisite control over the quality of the goods and services offered in association with the Mark [paras 11 and 12].

[9] As such, Ms. Sveda asserts that, throughout the relevant period, the Mark was used in Canada by Luxy (directly or under license from the Owner) in association with all of the registered goods and services [para 16], primarily via Luxy's website, *luxyhair.com*.

[10] In particular, regarding the registered goods, Ms. Sveda evidences 14 representative "specimens" of LUXY-branded products, including various "hair extensions", "hair weaves", "conditioner for hair", "shampoos for hair", "hair ties", "hair bands", "hair brushes", and various "hair ornaments" [para 19, Exhibits E to R]. The exhibits all show that the Mark was displayed on the packaging of the products.

[11] Ms. Sveda explains that invoices accompanied such products sold in Canada during the relevant period through Luxy's website, and provides example copies of invoices [para 20, Exhibits S to U]. The Mark appears prominently at the top of each invoice. For the invoice at Exhibit S, Ms. Sveda also includes screenshots of relevant pages from the Luxy website to show the correlation between the item number of the product on the website and the invoiced products. I note that the invoices are for various hair-related products, including the following: "Hair Extensions", "Classic Clip-In", "Ponytail", "brush", "Lace Wefts", "CurlerKitBundle", "Shampoo", and "Conditioner".

[12] With respect to the registered services, Ms. Sveda details the various services, including the registered "Online sales" services, that were available in Canada during the relevant period through the Luxy website [paras 23 to 27]. Exhibits V to CC are screenshots from the Luxy website, showing various features, products, and ancillary

services available throughout the relevant period. Exhibit BB, in particular, consists of screenshots showing the various product collections offered by Luxy [para 29].

[13] At the end of her affidavit, Ms. Sveda attests that, during the relevant period, Luxy sold “more than \$56 million CAD worth of hair extensions, \$1.2 million CAD worth of hair accessories; and \$27,000 CAD worth of hair care products to customers throughout Canada” [para 33].

## **USE OF THE MARK IN ASSOCIATION WITH THE GOODS**

### ***Hair-related Goods***

[14] It is clear from the evidence that, during the relevant period, Luxy used the Mark in association with various hair-related products, primarily hair extensions. This is reflected in the exhibited specimens and the assertion of sales. However, this statement regarding sales is only broken down by “hair extensions”, “hair accessories” and “hair care products” generally, and the exhibited invoices also do not account for all of the specified goods set out in goods (1) and (2) of the registration. Furthermore, although the evidence shows the 14 specimens mentioned above, Ms. Sveda does not explicitly correlate such specimens with the registered goods.

[15] Nevertheless, most of these correlations are obvious (e.g., “hair extensions”) and I accept the evidence as representative, at least as far as hair-related products are concerned. In this respect, I am able to identify numerous types of LUXY-branded hair extensions, hair accessories, and hair care products throughout the exhibits.

[16] As such, I am satisfied that the Owner has demonstrated use of the Mark in association with all of goods (1) and the following from goods (2): “...hair care preparations; hair colouring preparations; hair bands; hair clips, hair fasteners; hair ornaments; hair accessories” within the meaning of sections 4(1) and 45 of the Act.

### ***Cosmetics and Skin Care Preparations***

[17] With respect to the remaining goods, “cosmetics” and “skin care preparations” from goods (2), Ms. Sveda only references such goods when making general assertions regarding the “Luxy Products” (e.g., when defining the “Luxy Products” at paragraph 12

of her affidavit to encompass all of the registered goods). In particular, I note that the aforementioned specimens and invoices do not reference such goods. Although Ms. Sveda asserts that such evidence is representative, the Sveda Affidavit is nearly 200 pages (including exhibits), and yet there is no specific reference to any “cosmetics” or “skin care preparations”. Having reviewed the numerous exhibited website screenshots, the evidence regarding Luxy’s products appears to be limited to hair extensions, accessories and some hair care preparations. While I accept that the invoices are representative to some extent, Ms. Sveda provides no evidence of display of the Mark or transfers specific to the registered goods “cosmetics” or “skin care preparations”. If the Owner considered any of the products appearing in the evidence to constitute such registered goods, it was incumbent on the Owner to make any such correlation clear. In any event, as noted above, even the aggregate sales figures provided at the end of Ms. Sveda’s affidavit are limited to “hair extensions”, “hair accessories” and “hair care products”.

[18] As such, even when considering the evidence as a whole, I am not satisfied that the Owner has demonstrated use of the Mark in association with “Cosmetics; skin care preparations” within the meaning of sections 4 and 45 of the Act. In the absence of evidence of special circumstances, the registration will be amended accordingly.

#### **USE OF THE MARK IN ASSOCIATION WITH THE SERVICES**

[19] As described above, it is clear that, through its website available to Canadian customers during the relevant period, Luxy offered various hair-related products for sale in association with the Mark.

[20] Again, however, I note the absence of any specific statements regarding the transfer or sale of “cosmetics” or “skin care preparations”, and the absence of any clear reference to such despite the numerous exhibited screenshots from the Luxy website. If Luxy and/or the Owner offered “Online retail sales of cosmetics, skin care preparations” at any time, this is at best not clear from the evidence.

[21] As such, with respect to the registered services, while I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4(2) and 45 of

the Act in association with online retail sales of the specified hair-related products, I am not satisfied that the Owner has demonstrated use of the Mark in association with online retail sales of “cosmetics” and “skin care preparations”. In the absence of evidence of special circumstances, the registration will be amended accordingly.

**DISPOSITION**

[22] In view of all of the foregoing, 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 amended to delete “Cosmetics; skin care preparations” from goods (2) and “...cosmetics, skin care preparations...” from services (2). The amended statement of goods and services will be as follows:

*Goods*

- (1) Hair extensions, namely, clip in human hair extensions, remy quality human hair extensions; hairpieces; hair wefts, hair swatches; hair weaves; human hair.
- (2) Hair care preparations; hair colouring preparations; hair bands; hair clips, hair fasteners; hair ornaments; hair accessories.

*Services*

- (1) Online retail sales of hair extensions, clip in human hair extensions, remy quality human hair extensions, hairpieces, hair wefts, hair swatches, hair weaves, human hair.
- (2) Online retail sales of hair care preparations, hair colouring preparations, hair bands, hair clips, hair fasteners, hair ornaments, hair accessories.

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Andrew Bene  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** No hearing held

## **AGENTS OF RECORD**

**For the Requesting Party:** Richard Uditsky

**For the Registered Owner:** Gilbert's LLP