Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 132

Date of Decision: 2025-06-23

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: 88766 Canada Inc.

Registered Owner: Luxo Laboratories Limited

Registration: TMDA26,408 for BOOSTER

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. TMDA26,408 for the trademark BOOSTER (the Mark).

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

> Dandruff remedies, namely dandruff tonics and dandruff shampoos; hair tonic, hair cream; hair dressings, namely hair creams and hair gels; head rubs, namely hair lotions and hair oils; aftershave, cologne, facial creams, shampoo, hair spray, cream rinse, styling lotions, atomizer dispensers.

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

PROCEEDING

[4] At the request of 88766 Canada Inc. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on April 17, 2024, to Luxo Laboratories Limited (the Owner), the registered owner of the Mark.

[5] The notice required the Owner to show whether the Mark was used in Canada in association with each of the 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 from April 17, 2021 to April 17, 2024.

[6] The relevant definition of "use" in the present case 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.

[7] Where the Owner does not show "use", the registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[8] In response to the Registrar's notice, the Owner furnished the affidavit of David Kaufman, sworn on September 17, 2024, together with Exhibits A to L.

[9] Both parties filed written representations. Although both parties requested to be heard, the Owner's request was subsequently withdrawn such that only the Requesting Party was represented at a hearing.

EVIDENCE AND REASONS FOR DECISION

[10] In his affidavit, Mr. Kaufman identifies himself as the President of Owner, a Toronto-based company "well known for its aftershaves, facial creams, and hair lotions which are used for hair care, scalp care and personal care". Mr. Kaufman is also the President of Toronto Barber & Beauty Supply Limited (TBBS), a North York-based company that "sells products bearing a variety of different trademarks at retail and wholesale including online and on Amazon" [paras 2, 5, and 11].

[11] Mr. Kaufman describes the Goods as being all "the same kind of products" and as having all "a common purpose" and use. He categorizes them as "hair care, scalp care and personal care" products for men and women [para 28].

[12] Mr. Kaufman states that the Owner has continually sold its Goods in association with the Mark to TBBS, which sold them through its retail store to barber shops and beauty salons for further sales to end customers [paras 6, 11-13 and 15]. In particular, at paragraph 8 of his affidavit, he asserts:

> [The Owner] made available its products, including aftershave, bath products, facial cream, setting lotions, hair dressing, hair tonics, and other products, to be distributed and sold by TBBS. In addition to such sales, sales of professional beauty products were made to beauty/hair salons and barber shops located in almost every major city in Canada, along with many smaller cities. This includes throughout the relevant period.

[13] With respect to display of the Mark, Mr. Kaufman provides four photographs of products displayed on shelves at the TBBS retail store [Exhibits D-1 to D-4]. I note that the last two photographs, namely Exhibits D-3 and D-4, are included in two emails dated July 18, 2024. Mr. Kaufman concedes that these two photographs postdate the relevant period and asserts that all four photographs are representative of the way

the Mark was displayed on the Goods during the relevant period [para 16]. Exhibits D-1 and D-3 show, respectively, a hair cream and a aftershave bottles bearing the Mark. A clearer image of these two products appears on a representative screenshot of the Owner's website *thebeautyfactory.com* (the Screenshot) [Exhibit J]. This image is reproduced below.

[14] With respect to transfers, Mr. Kaufman asserts that the revenue generated by wholesale sales of Goods bearing the Mark in Canada during the relevant period were in excess of $25,000.00 per year [para 14]. As Exhibits I-1 to I-24, he provides 24 invoices which he states are issued by TBBS and dated during the relevant period. I note, however, that the invoice shown under Exhibit I-21 is issued by Angel Cosmoceuticals Inc (Angel) to the Owner. The remaining invoices are issued by TBBS to addresses in Canada. I also note that the last three invoices, namely Exhibits I-22 to I-24, are dated after the relevant period. A review of the invoices issued by TBBS and dated during the relevant period reveals that only two products are identified with the Mark, the first is "BOOSTER LANOLIN CREAM" [Exhibits I-1 to I-20], the second is "BOOSTER

AQUARIOUS" [Exhibits I-5 and I-11]. The aftershave is in turn identified as "POLAR AFTERSHAVE" [Exhibits I-3, I-6, I-7, I-11, I-16 and I-19].

[15] Mr. Kaufman ends his affidavit by adding:

> If [the Goods] in the Registration are to be amended in respect of any part of [the Goods], the value and fundamental purpose of the [Mark] would be significantly depreciated. Use of the [Mark] on any of [the Goods] by a third party would likely cause confusion to the general Canadian public and to salon owners. (…) Accordingly, it is vital to the integrity of [the Owner] and the purpose of [the Mark] that all [Goods] currently registered under the Registration be maintained in this Registration [paras 28-29].

Use by the Owner

[16] The Requesting Party devoted a significant portion of its written and oral submissions to arguing that any transfers by TBBS cannot enure to the Owner pursuant to section 50 of the Act. In particular, it submitted that while Mr. Kaufman states he is the President of both the Owner and TBBS, he does not explain the relationship between them [Requesting Party's written representations, paras 8, and 15-24].

[17] In response, the Owner contends in its written representations that TBBS is clearly a distributor authorized by the Owner to sell Goods bearing the Mark in Canada [Owner's written representations, para 39].

[18] At the hearing, the Requesting Party pointed the invoice issued by Angel to the Owner and submitted that this invoice creates ambiguity as to whether the Owner is "the source of the Goods" [relying on *Gowling WLG (Canada) LLP v Saucony UK, Inc*., 2022 TMOB 44 at paras 12-13].

[19] To the extent that the Requesting Party submits that Angel, rather than the Owner, is the source of the Goods, it questions whether the Owner is entitled to the registration. However, it is well established that section 45 proceedings are not intended to determine substantive rights such as

ownership, distinctiveness, descriptiveness or abandonment of a registered trademark [see *United Grain Growers Ltd v Lang Michener*, 2001 FCA 66; *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD) at 294]. As noted by the Federal Court of Appeal in *Ridout & Maybee srl v Omega SA*, 2005 FCA 306, the validity of the registration is not in dispute in section 45 proceedings. Issues of ownership are more properly dealt with by way of application to the Federal Court pursuant to section 57 of the Act.

[20] Mr. Kaufman does not indicate what entity is the actual manufacturer of the Goods. Nevertheless, the Act does not require the owner of a trademark itself be the manufacturer. A registered owner may outsource that function or have one or more manufacturer suppliers. In other words, contrary to the Requesting Party's suggestion, the Owner needs not be established as the actual manufacturer of Goods for it to be considered the source of such Goods for purposes of the section 2 of the Act [see *Smart & Biggar v Canadian Tire Corporation, Limited*, 2017 TMOB 153 at paras 16-17].

[21] Further, contrary to the case relied upon by the Requesting Party, Mr. Kaufman clearly states that the Owner directly sells its products to TBBS and that such products display the Mark. As such, evidence of the Owner's Goods bearing the Mark distributed within its normal course of trade through TBBS, is sufficient to satisfy the requirements of section 4 of the Act [per *Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD)]. It follows that evidence of a license between the Owner and TBBS is neither necessary nor applicable in this case.

Use of the Mark is shown in association with "hair cream" and "aftershave"

[22] Mr. Kaufman provides representative photographs of a product that he correlates with "hair cream" and bears the Mark [Exhibits D-1 and J]. He also provides 20 invoices dated during the relevant period and issued

by TBBS to barber shops and beauty salons located in Canada that include this product [Exhibits I-1 to I-20]. These pieces of evidence sufficiently show how the Mark was associated with "hair cream" and transfers of this Good in Canada during the relevant period.

[23] I note at this point that "hair cream" appears twice in the registration, alone and as a specific good within the "hair dressing" category.

[24] In my view, a reasonable interpretation of the statement of goods would be that "hair cream" alone correspond to a hair cream product other than a hair dressing product, such as a developing cream to be used for coloring or dyeing hair [*ConAgra Foods, Inc v Fetherstonhaugh & Co* (2002), 23 CPR (4th) 49 (FCTD)].

[25] It has been held that use of a trademark in association with a single item will not generally support use in association with multiple goods in a registration [see *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA); and *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[26] Applied to the present case, I note that Mr. Kaufman does not describe the "hair cream" in evidence in any way, and the evidence does not allow me to conclude that the hair cream in evidence can be characterized as a hair dressing. I therefore accept to maintain the registration only with respect to "hair cream" alone.

[27] With respect to "aftershave", the Requesting Party submitted at the hearing that the evidence does not support transfers of "aftershave" in Canada during the relevant period. In this regard, it noted that the invoices include third-party trademarks.

[28] However, the lack of association with the Mark in the invoices is inconsequential as the requisite notice of association is given through display

of the Mark on the aftershave bottles. In addition, there is nothing in the Act that precludes a trademark owner from using more than one trademark at the same time in association with the same goods [*AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)]. As such, the aftershave bottles [Exhibits D-3 and J] show how the Mark was associated with "aftershave" and the invoices [Exhibit I-3, I-5 to I-7, I-11, I-17 and I-19] show transfers of this Good in Canada during the relevant period.

[29] In view of the above, I am satisfied that the Owner has shown use of the Mark in association with "hair cream" and "aftershave" pursuant to sections 4 and 45 of the Act.

Use of the Mark is not shown in association with the remaining Goods

[30] The Requesting Party submits that the evidence does not show display of the Mark in association with any of the remaining Goods (the Remaining Goods) [Requesting Party's written representations, para 15].

[31] In response, the Owner submits that the evidence shows display of the Mark "on several of the [Owner's Goods]" and that any doubt must be resolved in its favour. Referring to Mr. Kaufman's statement that the Owner's products have all the same use and purpose, it submits that there is no need to incur in the expense of evidentiary overkill and that invoices are not mandatory [Owner's written representations, paras 45-50 and following, wrongly numerated as paras 38-39].

[32] While I agree that evidentiary overkill is not required and that invoices are not mandatory in section 45 proceedings, the registered owner must still establish a *prima facie* case of use of the trademark in association with *each* of the goods specified in the registration [per *John Labatt* and *Diamant Elinor, supra*].

[33] Even accepting that the display of the Mark shown in the photographs and the Screenshot is representative of the way the Mark was displayed on *each* of the Remaining Goods, I am not satisfied that any of them were sold in Canada during the relevant period. As noted above, aside from "hear cream" the only product identified with the Mark in the invoices is "BOOSTER AQUARIOUS". Mr. Kaufman's affidavit is silent with respect to this product. Without further evidence, it would be a matter of speculation, not inference, to determine to which Remaining Good, if any, this "BOOSTER AQUARIOUS" correlates with [*Diamant Elinor*, supra, at para 11].

[34] Regardless of whether the Owner's Goods are all of the same kind and have the same use or that they can be categorized as "hair care, scalp care and personal care", the fact remains that there is no evidence of use of the Mark in association with Goods other than "hear cream" and "aftershave".

[35] Contrary to the Owner's submission, furnishing evidence of *each* of the Remaining Goods would not have placed an onerous or unreasonable burden on the Owner. In this regard, I note that Mr. Kaufman provides 51-page exhibits including 20 invoices to support use of the Mark in association with "hear cream" and "aftershave".

[36] In view of the above, I am not satisfied that the Owner has shown use of the Mark in association with the Remaining Goods in Canada during the relevant period. As the Owner has not provided any evidence of special circumstances excusing non-use of the Mark in association with the Remaining Goods, the registration will be amended accordingly.

[37] Before closing, I note that in its written representations, the Owner relied on Mr. Kaufman's statement concerning the potential depreciation of the Mark and risk of confusion. However, whether the deletion of the

Remaining Goods can lead to depreciation or confusion is not relevant to consider and out of the scope of section 45 proceedings.

DISPOSITION

[38] In view 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 the following goods:

> Dandruff remedies, namely dandruff tonics and dandruff shampoos; hair tonic, […]; hair dressings, namely hair creams and hair gels; head rubs, namely hair lotions and hair oils;[…], cologne, facial creams, shampoo, hair spray, cream rinse, styling lotions, atomizer dispensers.

[39] The amended statement of goods will read as follows:

> Hair cream, aftershave.

Maria Ledezma
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: May 8, 2025

APPEARANCES

For the Requesting Party: Stephanie Karam

For the Registered Owner: No one appearing

AGENTS OF RECORD

For the Requesting Party: ROBIC AGENCE PI S.E.C./ ROBIC IP AGENCY LP

For the Registered Owner: FOGLER, RUBINOFF LLP