



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2012 TMOB 248
Date of Decision: 2012-12-17

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Pandora Jewelry, LLC against registration
No. TMA610,307 for the trade-mark PANDORA'S in the
name of Pandora's Makeup Box Inc.**

[1] On February 23, 2011, at the request of Pandora Jewelry, LLC, the Registrar forwarded a notice under section 45 of the *Trade-marks Act*, RSC 1985, c T -13 (the Act) to Pandora's Makeup Box Inc. (the Registrant), the registered owner of the trade-mark PANDORA'S (the Mark). The Mark is registered for use in association with:

Cosmetics; namely, lipsticks, eye pencils, lip pencils, eye shadow, mascara, lip gloss, blush, pressed and loose powder, cosmetic foundations, cover sticks and nail polish.
Plastic boxes used to hold cosmetics.
Cosmetic implements; namely cosmetic brushes (the Wares).

[2] Such notice requires the Registrant to show whether the Mark has been used in Canada in association with the Wares 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. The relevant period in this case is any time from February 23, 2008 to February 23, 2011.

[3] In response to the notice, the affidavit of Ms. Susan Kirsch has been furnished together with schedules A to H. Only the Registrant filed written submissions and there was no hearing.

[4] Section 45 proceedings are simple, expeditious and serve the purpose of clearing the register of “deadwood”; as such, the threshold test to establish use is quite low [see *Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)].

[5] A simple allegation of use of the Mark is not sufficient to evidence its use in association with the Wares within the meaning of section 4(1) of the Act. There is no need for evidentiary overkill. However any ambiguity in the evidence filed shall be interpreted against the owner of the Mark [See *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980) 53 CPR (4th) 62 (FCA)].

[6] I therefore have to determine if I am satisfied that the evidence to be described hereinafter enables me to conclude that the Mark has been used by the Registrant in Canada in association with the Wares during the relevant period.

[7] Ms. Kirsch has been the Registrant’s President since its incorporation in 2008. She is also the Registrant’s predecessor in title. She asserts that the Mark has been used during the relevant period in association with the Wares in the normal course of trade. This is a conclusion in law that must be derived from the facts contained in her affidavit.

[8] She filed as Exhibit A representative samples of eye shadow, eyelid primer, face powder, lip gloss, lipstick and mascara packaging bearing the Mark that has been sold in Canada during the relevant period.

[9] She filed as Exhibit B1 a cosmetic brush on which appears the Mark. She states that such brushes have been sold in Canada continuously since 2002, including during the relevant period. She filed as part of Exhibit D an illustration of other brushes sold in association with the Mark during the relevant period. Exhibit B2 is a photograph of a pouch within which a set of travel brushes bearing the Mark were sold during the relevant period.

[10] Ms. Kirsch filed as Exhibit C a photograph of a cosmetics box that is representative of the cosmetics boxes sold by the Registrant during the relevant period. It does show the Mark on the front of the box.

[11] Ms. Kirsch affirms that the Wares were sold in association with the Mark in Canada through different channels of trade, including online sales at the Registrant's website, and through retailers, including Shoppers Drug Mart. She filed as Exhibit D printouts from the Registrant's website showing the PANDORA'S Online Shop through which consumers can purchase the Wares in association with the Mark. Exhibit F are representative confirmation of transactions conclude through the Registrant's website for the sale of Wares bearing the Mark during the relevant period.

[12] Ms. Kirsch filed as Exhibit E a record of 50 sales of Wares bearing the Mark made in Canada through the PANDORA'S Online Shop between October 7, 2009 and November 24, 2009. Exhibit F to her affidavit is a printout from Shoppers Drug Mart vendor order system. It is a representative record relating to the sale of Wares in association with the Mark by Shoppers Drug Mart in Canada during the relevant period.

[13] Finally Ms. Kirsch filed as Exhibit H copies of selected articles and blog posting featuring the Wares in association with the Mark that were published during the relevant period.

[14] The evidence described above shows that Wares bearing the Mark were sold by the Registrant in Canada in the normal course of trade during the relevant period. Consequently the Mark was in use within the meaning of section 4(1) of the Act in association with the Wares during the relevant period.

Disposition

[15] In view of all of the foregoing, pursuant to the authority delegated to me under s. 63(3) of the Act, registration TMA610,307 will be maintained on the register in compliance with the provisions of section 45(5) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office