



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

**Citation: 2015 TMOB 219**  
**Date of Decision: 2015-12-03**

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

<b>Protool Belts &amp; Accessories Inc.</b>	<b>Requesting Party</b>
<b>and</b>	
<b>Lancôme Parfums et Beauté &amp; Cie</b>	<b>Registered Owner</b>
<b>TMA282,940 for LIP LOVER</b>	<b>Registration</b>

[1] At the request of Protool Belts and Accessories Inc. (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on March 6, 2014 to Lancôme Parfums et Beauté & Cie (the Owner), the registered owner of registration No. TMA282,940 for the trade-mark LIP LOVER (the Mark).

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

Toiletries and cosmetics, namely, facial scrub, facial masks, skin toner, skin astringent, moisture cream, tanning lotion, bath oil, hair shampoo, hair conditioner and lip gloss, lip balm, lipsticks.

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with the registered goods, at any time between March 6, 2011 and March 6, 2014 (the Relevant Period). If the Mark had not been so used, the Owner was required to

furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[4] The relevant definition of use with respect to goods is set out in section 4(1) of the Act as follows:

4(1) A trade-mark 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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc*, (1980) 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the goods and services specified in the registration during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp* 2004 FC 448, 31 CPR (4th) 270].

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Mr. José Monteiro. Only the Owner filed written representations; a hearing was held and attended only by the Owner.

#### The Owner's Evidence

[7] Mr. Monteiro is the director of the International Department of Trade-marks with L'Oréal, a French company, doing business in the field of beauty products, cosmetics and perfumery. He alleges that the Owner is a subsidiary of L'Oréal and thus because of his functions, he has access to the Owner's files.

[8] Mr. Monteiro states that the Owner has been in the business of perfumery and beauty products for the past 39 years. It distributes and sells its products around the world, including Canada.

[9] Mr. Monteiro alleges that, initially, the Mark was registered in the name of Rachel Perry Inc. (Rachel Perry). However, on January 8, 2014 the Owner acquired the Mark, in the circumstances described later, from Rachel Perry and such transfer was recorded on February 11, 2014 by the Registrar. Attached to his affidavit as exhibit JM-2 are copies of the documents filed with the Registrar to register the transfer.

[10] Mr. Monteiro asserts that Rachel Perry did make use of the Mark in association with the registered goods during the Relevant Period, before the transfer of the Mark to the Owner. In support, attached to his affidavit as exhibit JM-3, are pictures of lip gloss and lip balm bearing the Mark, as well as an invoice issued during the Relevant Period by Rachel Perry for the sale of these goods in Canada.

[11] With respect to the use by the Owner, Mr. Monteiro attests that, during the Relevant Period and before the aforementioned transfer, the Owner made efforts and important investments to develop and use the Mark in Canada and elsewhere in the world. To support such allegation, he states that, on July 9, 2013, the Owner filed an application, with the Registrar, to register LIP LOVER in association with cosmetics and make-up on the basis of proposed use, which was still pending (exhibit JM-4).

[12] Mr. Monteiro alleges that publicity material for Canada was developed by the Owner during the Relevant Period and he filed a copy of such material as exhibit JM-5.

[13] Mr. Monteiro explains that it was only after the filing of the aforementioned application the Owner learned that the Mark was the subject of a registration in the name of Rachel Perry. Therefore, the Owner began, in 2014, negotiations for the acquisition of the Mark. He asserts that, as of the date of execution of his affidavit, the Owner had already used the Mark in association with lip gloss, lip balm and lipstick (collectively referred hereinafter as the Lip products) in the form of a 'lip perfecter' which cumulates those functions.

[14] Mr. Monteiro affirms that orders have been placed for the purchase of products bearing the Mark as early as March 3, 2014 and he filed copies of invoices as exhibit JM-6. These invoices are dated after the Relevant Period but show that the orders were placed prior to the issuance of the Registrar's notice. He also filed pictures of the Owner's packaging for products bearing the Mark, as exhibit JM-7.

[15] Mr. Monteiro attests that the products bearing the Mark are offered for sale in more than 780 points of purchase located in all the provinces and territories of Canada. He also provides the Owner's sales figures of such products in Canada since the beginning of 2014. However, there is no breakdown of the sales figures per product. Furthermore, he states that the Owner spent more than \$280,000 from January to July 2013 in promotion and marketing; however, he does not state for which product(s) and for which trade-mark(s) those expenses related to.

#### Use of the Mark in association with some of the registered goods

[16] In the absence of any representations from the Requesting Party, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods 'lip gloss' and 'lip balm'. In this respect, the photographs and invoice exhibit JM-3 are sufficient to show that the Owner's predecessor-in-title sold LIP LOVER lip balm and lip gloss in Canada during the Relevant Period.

[17] For the remaining goods (i.e. all the registered goods, except for lip gloss and lip balm), the Owner relies on *Saks & Co v Canada (Registrar of Trade-marks)* (1989), 24 CPR (3d) 49 (FCTD) to support its contention that the Owner does not need to prove use of the Mark in association with each of the registered goods. In *Saks*, however, there were 28 categories of goods and services logically and properly categorized and each category contained a list of multiple goods and services. More significantly, there were also statements and documents indicating that there were sales of those goods and services.

[18] It was in that context that the Court concluded in *Saks* that there was no obligation to file direct evidence or documentary proof regarding every item in each category. In the present case, there is no document or statement concerning the sale of any registered goods other than lip gloss

and lip balm by Rachel Perry. If the latter sold other toiletries or cosmetics in association with the Mark, it is not clear from the evidence and the Owner should have furnished clear statements, further representative photographs and/or invoices in support.

[19] In the alternative, the Owner argues that, if the evidence filed does not establish use of the Mark in association with each of the registered goods, it has shown that there were special circumstances justifying non-use. Therefore, it submits that the registration should be maintained for all of the registered goods.

[20] I shall now determine if the Owner has shown special circumstances justifying non-use of the Mark within the meaning of section 45(3) of the Act?

#### Special circumstances explaining non-use of the Mark

[21] The concept of ‘special circumstances’ has been defined in the jurisprudence. Recently, the Federal Court, in *Gouverneur Inc v The One Group LLC* 2015 FC 128, did an analysis of the relevant jurisprudence on the matter from which it derived the procedure to follow.

[22] Firstly, the Registrar must identify the reason for non-use of the Mark. Secondly, the Registrar must decide whether the circumstances explaining the non-use of the Mark are ‘special circumstances’, i.e. unusual, out of ordinary, or exceptional. Finally, the Registrar must decide whether the non-use is excused by the special circumstances, by considering the three criteria laid out in *Canada (Registrar of Trade Marks) v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA), namely:

- 1) The length of time during which the trade-mark has not been used;
- 2) Whether the registered owner’s reasons for not using its trade-mark were due to circumstances beyond its control; and
- 3) Whether there exists a serious intention to shortly resume use.

[23] It is clear from the evidence described above that there is no proof of use of the Mark in association with the remaining goods during the Relevant Period. There is also no evidence of the last time the Mark was used in association with such goods.

[24] The reason for non-use of the Mark presented by the Owner is the short period of time elapsed since its acquisition of the Mark. There were unusual circumstances surrounding the transfer of the Mark. The Owner filed its own application to register the Mark during the Relevant Period, only to find out that Rachel Perry owned the Mark. Negotiations led to its transfer shortly before the Registrar issued the notice under section 45.

[25] The period of non-use by the Owner has only been for a couple of months. As for the period of non-use of the Mark by its predecessor-in-title, it was certainly beyond the Owner's control.

[26] Finally, as for the Owner's serious intention to shortly resume use of the Mark, the Owner is relying on the following facts:

- Prior to its acquisition of the Mark, the Owner filed its own application to register the same trade-mark in association with cosmetics and make-up;
- Publicity material was created in 2013-2014, samples of which are furnished as exhibit JM-5;
- Products bearing the Mark are now available for sale throughout Canada; samples of packaging and bottles are furnished as exhibit JM-7.

[27] I note that Mr. Monteiro states that the 'lip perfecter', sold by the Owner in association with the Mark, cumulates the functions of a lipstick, of a lip balm, and of a lip gloss (collectively referred to as the Lip products). In fact, on the publicity material, exhibit JM-5, it is advertised as 'all-in-one'; 'care- colour- shine'. Moreover, one illustration of the 'lip perfecter', part of exhibit JM-5, shows a packaging that is open so that we see the product in the form of a lipstick.

[28] There is no doubt in my mind that the Owner has shown a serious intention to resume use of the Mark. However, is such intention with respect to each of the registered goods or only in association with the Lip products? For the reasons that follow, I conclude that the Owner has demonstrated a serious intention to resume use of the Mark only in association with the Lip products.

[29] As mentioned earlier, the Owner filed a copy of an application to register the same trademark as the Mark to prove that it had a serious intention to use the Mark. Such application ultimately lead to the transfer of the Mark to the Owner. However, the application it filed in 2013 was for cosmetics and make-up. There is no specific reference to the remaining goods in the application filed by the Owner. Therefore, I cannot infer from the filing of that application that the Owner had the intention to use the Mark in association with the remaining goods.

[30] The publicity material, the orders received by the Owner, the packaging and the bottles bearing the Mark and presently used by the Owner are all for Lip products. There are no orders, packaging, bottles or publicity for any products other than the Lip products.

[31] Indeed in his affidavit, Mr. Monteiro does not make specific reference to any of the remaining goods at all. His only reference to the registered goods is in paragraph 14, where he makes a bald statement that the Owner has the intention to use the Mark in association with the registered goods in Canada. However, to support such allegation, he refers to the use of the Mark in association with the Lip products only, as evidenced by the material described previously all relating to the 'lip perfecter'.

[32] Consequently, I conclude that the Owner has established special circumstances justifying the non-use of the Mark in Canada during the Relevant Period in association with only the Lip products. The registration will be amended accordingly.

Disposition

[33] Pursuant to the authority delegated to me under section 63(3) of the Act and in accordance with the provisions of section 45 of the Act, registration TMA282,940 will be amended to delete the following goods:

Toiletries and cosmetics, namely, facial scrub, facial masks, skin toner, skin astringent, moisture cream, tanning lotion, bath oil, hair shampoo, hair conditioner.

The amended statement of goods will be:

Lip gloss, lip balm, lipsticks.

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



Hearing Date: 2015-11-18

Appearances

Chloé Latulippe  
Amélie Béliveau

For the Registered Owner

No one appearing

For the Requesting Party

Agents of Record

Fasken Martineau DuMoulin

For the Registered Owner

Fogler, Rubinoff LLP

For the Requesting Party