



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

Citation: 2015 TMOB 139
Date of Decision: 2015-08-24

IN THE MATTER OF A SECTION 45 PROCEEDING

Olen Cosmetics Corporation

Requesting Party

and

Diptyque S.A.S.

Registered Owner

TMA760,436 for OLÈNE

Registration

[1] At the request of Olen Cosmetics Corporation (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 September 24, 2013 to Diptyque S.A.S., the registered owner of registration No. TMA760,436 for the trade-mark OLÈNE (the Mark).

[2] The Mark is registered in association with the following goods: Skin soap, perfumery, essential oils for use in aromatherapy and in the manufacture of scented products, perfume and skin soaps, cosmetics namely, foundation, cream and hair lotions.

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the goods 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 such use since that date. In this case, the relevant period for showing use is between September 24, 2010 and September 24, 2013.

[4] The relevant definition of “use” in association with goods is set out in section 4(1) of the Act:

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 quite 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 specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Owner filed the affidavit of Jonathan Day, sworn on April 24, 2014 in London, England. Only the Requesting Party filed written representations; however, the Owner was represented at an oral hearing held on August 19, 2015.

The Owner’s Evidence

[7] In his affidavit, Mr. Day identifies himself as a partner at Arnold & Porter (UK) LLP and the principal advisor to the Owner on international trade mark matters. He confirms that he has access to the Owner’s records and is aware of the business activities of the Owner and its use of the Mark “in and into Canada”.

[8] He asserts that the Owner used the Mark in association with the registered goods in Canada during the relevant period. He explains that the Owner sells “its product” to various distributors in the United States who in turn resell to retailers in Canada. He attests that the goods are manufactured, labelled and packaged in Europe and shipped to a distribution centre in New York from which the goods are shipped throughout the United States and into Canada.

[9] Mr. Day attests to sales of goods bearing the Mark in Canada “at the wholesale level” for each year from 2010 to 2013, totalling \$10,000. However, he explains that, as exact sales “are highly confidential”, actual sales figures were in excess of the amounts indicated.

[10] In support of his assertion of use of the Mark, Mr. Day attaches three exhibits to his affidavit:

- Exhibit A consists of five “representative” pictures of bottles that Mr. Day attests are typical of the labels and packaging used in Canada “for all of the Wares bearing the Mark in the Relevant Period.” I note that the bottles all appear to be empty glass bottles with black caps. The bottles have slight variations in shape, but all bear essentially the same label. While OLENE appears in the center of the label, the label does not identify any particular product.
- Exhibit B consists of printouts from two webpages that Mr. Day attests shows “the OLENE product as well as its packaging which also bears the Mark.” Again, he attests that the depiction is “typical and representative of the bottles, labelling and packaging for all the Wares sold into and in Canada in the Relevant Period”. I note that the webpages appear to be from third-party retail websites. The first webpage depicts an OLENE bottle with the same labelling as the bottles shown at Exhibit A. The product is identified on the website as “Olene Diptyque for women”, and is described as a “fragrance”. The second page shows a bottle, also with a label similar to the bottles depicted at Exhibit A. The product is identified on the website as “Olene” and described as “Eau de Toilette” and “fragrance”.
- Exhibit C consists of six partially-redacted invoices from the Owner’s distribution center in New York to addresses in Etobicoke and Montreal, all dated within the relevant period. Mr. Day does not identify the particular goods represented by the invoices, stating only that the invoices reflect “sales of the Wares bearing the Mark into Canada for resale during the Relevant Period”. However, amongst many other goods, the invoices include descriptions for “OLENE100 – EAU DE TOILETTE OLENE 3.4 FL.O”, “OLENE EDT SAMPLE 2ML” and “OLENE 100V1 – OLENE 100ML” in various quantities. I note that the prices have all been redacted.

Analysis

[11] As a preliminary matter, I note that the evidence actually shows display of the trade-mark OLENE throughout, without the accent over the first E as it appears in the Mark. Nonetheless, in applying the principles set out by the Federal Court of Appeal [per *Canada (Registrar of Trade Marks) v Cie International pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)], I am satisfied that the dominant feature of the Mark, being the word OLENE, is retained in the trade-mark displayed. The omission of the accent over the letter E is a minor deviation [see also, for example, *Borden Ladner Gervais LLP v Elmira Pet Products Ltd*, 2014 TMOB 273, CarswellNat 6225].

[12] In its written representations, the Requesting Party submits that it is not clear from the evidence whether the Owner did, in fact, sell each of the registered goods in association with the Mark during the relevant period. In this respect, it submits that, given the similarity between the bottles depicted in Exhibit A and the bottles depicted on the webpages at Exhibit B, the evidence only shows the labelling and packaging for “perfumery”. It further submits that the OLENE products identified in the Exhibit C invoices also appear to be perfumery only.

[13] Accordingly, the Requesting Party submits that none of the invoices support sales of the other registered goods, being skin soap, essential oils and cosmetics.

[14] At the oral hearing, the Owner submitted that Mr. Day provided a clear statement of use of the Mark with respect to all of the registered goods along with “representative” invoices and “representative” packaging and labelling showing how the Mark was displayed.

[15] As for whether the exhibits are sufficiently representative, at best the exhibited bottles appear to be for end consumer use. Even if I were to accept that the bottles could also be used for certain types of “cosmetics” or “soaps”, the registration includes goods that appear to be for manufacturing purposes, such as “essential oils for use in the manufacture of scented products”. Absent further particulars, it is not clear that such goods would have the same packaging as end-consumer products.

[16] With respect to transfers of the goods, although invoices are not mandatory in order to satisfactorily reply to a section 45 notice [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)], use must be shown in association with all of the goods as registered [*John Labatt Ltd v Rainier Brewing Co et al* (1984) 80 CPR (2d) 228 (FCA)]. As such, some evidence of transfers in the normal course of trade in Canada is necessary. Such evidence can be in the form of documentation like invoices or sales reports, but can also be through clear sworn statements.

[17] However, in this case, Mr. Day does not provide sales figures for each of the registered goods. He only provides “total sales of the Wares ... at the wholesale level”. Accordingly, it is not clear if all of the registered goods were in fact sold in Canada during the relevant period. As such, it is necessary to rely on the invoices actually exhibited.

[18] Again, however, aside from “eau du toilette”, the goods are not clearly identified in the invoices or by Mr. Day. As submitted by the Requesting Party, all of the OLENE descriptions in the invoices appear to be for perfumery products; the Owner made no representations to the contrary on this point.

[19] Accordingly, although the Owner submits that the evidence is “representative”, I consider Mr. Day’s affidavit effectively silent with respect to the remaining goods. Indeed, despite Mr. Day’s assertions with respect to all of the registered goods, he curiously refers to “the product” in the singular in paragraphs 1 and 6 of his affidavit. Although not in itself determinative, such references to a singular “product” are consistent with an interpretation of the evidence that, at best, the Owner only manufactured and sold the one product, perfumery, in association with the Mark in Canada.

[20] In any event, in view of all of the foregoing, I consider the evidence ambiguous as to whether the Owner in fact transferred skin soaps, essential oils and cosmetics bearing the Mark in Canada during the relevant period. Per *Plough, supra*, such ambiguity must be resolved against the interests of the Owner.

[21] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark only in association with “perfumery” within the meaning of sections 4 and 45 of the Act.

Disposition

[22] Accordingly, 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 “skin soap, ... essential oils for use in aromatherapy and in the manufacture of scented products, perfume and skin soaps, cosmetics namely, foundation, cream and hair lotions”.

[23] The amended statement of goods will be as follows: “Perfumery”.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

Hearing Date: 2015-08-19

Appearances

Kenneth McKay	For the Registered Owner
No one appearing	For the Requesting Party

Agents of Record

Sim & McBurney	For the Registered Owner
Theo Yates (Yates IP)	For the Requesting Party