



TRANSLATION  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2016 TMOB 189**  
**Date of Decision: 2016-12-13**  
**[UNREVISED ENGLISH**  
**CERTIFIED TRANSLATION]**

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

**Amir Inc.**

**Requesting Party**

**and**

**Eugene Perma France**

**Registered Owner**

**TMA208,362 for KERACOLOR**

**Registration**

The record

[1] On February 5, 2015 at the request of Amir Inc., the Registrar sent the notice stipulated in section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Eugène Perma France (the Registered Owner), holder of registration No. TMA208,362 for the KERACOLOR trade-mark (the Mark).

[2] This notice enjoined the Registered Owner to prove that its Mark was used in Canada at any time between February 5, 2012 and February 5, 2015 (the relevant period), in association with the goods specified in the registration, namely [TRANSLATION] "hair care and beauty preparations" and, in the negative, the date when the Mark was used for the last time and the reason for its failure to use it since that date.

[3] In response to the Registrar's notice, the Registered Owner filed an affidavit submitted by its President and Chief Executive Officer, Didier Martin, on June 16, 2015.

[4] Neither party filed written representations, and no hearing was held.

### Analysis

[5] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing "deadwood" from the register; this is why the applicable test is not very stringent. As stated by Judge Russell in *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC), at p. 282:

We know that the purpose of s. 45 proceedings is to clean up the "deadwood" on the register. We know that the mere assertion by the owner that his trade-mark is in use is not sufficient and that the owner must "show" how, when and where it is being used. We need sufficient evidence to be able to form an opinion under s. 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade-mark owner's business and merchandising practices.

[6] In the present case, section 4(1) of the Act defines use in association with goods as follows:

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.

[7] This leads me to review the evidence filed by the Registered Owner.

[8] Mr. Martin affirms that since 1918, the Registered Owner, whose head office is located in France, has designed and marketed hair hygiene and care products. Mr. Martin affirms that the Registered Owner specializes, in particular, in the design, manufacturing, packaging and merchandising of shampoos, hair care, hair styling goods and colour products intended for professional hair stylists.

[9] Mr. Martin affirms that the sale in Canada of the goods covered by the registration in the case at bar (to which he refers as the "Goods") is done via sales by the Registered Owner to its distributor Procap Ltée ("Procap") of Montreal, which resells in Canada the Goods bearing the Mark to hairdressing professionals.

[10] In support of his assertions of use of the Mark in Canada during the relevant period, Mr. Martin files the following supporting exhibits:

- Exhibit DM-1, which consists of an excerpt from the Registered Owner's website. Mr. Martin affirms this excerpt illustrates the Goods bearing the Mark, as available and sold in Canada, in the normal course of trade, during the relevant period. In the review of this excerpt, I note that it shows a list of KERACOLOR goods in the form of numbered tubes, four of which were indicated with an arrow by hand. Considered in isolation, this exhibit is of little use, because it does not allow the nature of the goods in question to be determined. However, it emerges from Mr. Martin's affidavit that this exhibit must be examined in light of Exhibits DM-2 and 3.
- Exhibit DM-2, which consists of [TRANSLATON] "some photographs of the Goods bearing the Mark". Mr. Martin confirms that even though these photographs were taken in March 2015, the goods illustrated under this exhibit are the same as those sold by the Registered Owner during the relevant period. He adds in this regard that in Exhibit DM-1, the goods identified as 4, 9\*1, 4\*22, and 6\*53, represented in DM-2, were indicated with arrows. In reviewing this exhibit, I note that it pertains to tubes of permanent colour bearing the Mark, as represented in Appendix "A" of my decision.
- Exhibit DM-3, which consists of two tubes of permanent colour, one of the packages of which is reproduced in Appendix "A".
- Exhibits DM-4 and 5, which respectively consist of a sample of invoices concerning the sale in Canada of the Registered Owner's Goods to Procap during the relevant period; and a sample of invoices issued by Procap to some of its Canadian customers. In reviewing these exhibits, I note that the KERACOLOR goods referenced therein concern the tubes illustrated in Exhibits DM-1, 2 and 3.

- Exhibit DM-6, which consists of an order sheet used in Canada during the relevant period to order the Goods bearing the Mark from Procap. Mr. Martin specifies they were indicated with arrows to facilitate the concordance with Exhibits DM-1, 2 and 3.
- Exhibit DM-7, which consists of a few excerpts from the Procap website for the Goods bearing the Mark. Mr. Martin adds that:

[TRANSLATION] These excerpts illustrate some of the Goods bearing the Mark, in the colours Red, Cashew, Ash [...] and for a lightener. [...] In all cases, these are hair care and beauty preparations of [the Registered Owner] bearing the Mark.

- Exhibit DM-8, which consists of an excerpt from the Canadian Trade-mark Registry regarding registration TMA577,660 of the semi-figurative mark EUGNÈNEPERMA found on the packaging reproduced in Appendix "A", the Registered Owner of which is the owner.

[11] From my review of Mr. Martin's affidavit, I am satisfied that the Registered Owner has proved the use of the Mark in association with the goods described in the registration as [TRANSLATION] "hair care and beauty preparations" during the relevant period.

[12] Indeed, I find that the Mark as used and illustrated in Appendix "A" is valid for the use of the Mark as registered. Although the "KERA" and "COLOR" elements appear on two separate lines, the Mark as used has not lost its identity and remains recognizable.

[13] The practical test that must be applied to resolve a case of this nature consists of comparing the trade-mark as registered with the trade-mark as used and determining whether the differences between these two marks are so insignificant that an unformed shopper be likely to infer that both, despite their differences, identify goods of the same origin [see *Canada (Registrar of Trade-Marks) v Compagnie Internationale pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA) at page 525]. In the case at bar, minor differences are involved, which have no impact on the way the Mark is pronounced.

[14] I also find that the use proved in association with hair colours falls under the statement [TRANSLATION] "hair care and beauty preparations".

Disposal

[15] In exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

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Annie Robitaille  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Certified true translation  
Arnold Bennett

Appendix A

EUGENEPERMA  
PARIS

KERA  
COLOR



**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
AGENTS IN THE CASE**

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No hearing held

**AGENT(S) OF RECORD**

Robic, S.E.N.C.R.L.

FOR THE REGISTERED  
OWNER

Mason Professional Corporation (Cynthia D. Mason)

FOR THE APPLICANT