



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

Citation: 2016 TMOB 191
Date of Decision: 2016-12-20

IN THE MATTER OF A SECTION 45 PROCEEDING

Prolenium Medical Technologies, Inc.

Requesting Party

and

Teoxane, S.A.

Registered Owner

TMA732,828 KISS

Registration

[1] At the request of Prolenium Medical Technologies, 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 December 19, 2014 to Teoxane, S.A., the registered owner of registration No. TMA732,828 for the trade-mark KISS (the Mark).

[2] The Mark is registered for use in association with “produits stériles implantables destinés au comblement des rides, ridules, dépressions cutanées et à l’augmentation du volume des lèvres”. The registered goods were translated in the *Trade-marks Journal* as “implantable sterile products to fill wrinkles, fine lines, and skin dimples and to increase lip volume”.

[3] The notice required the registered owner to furnish evidence showing that the Mark was in use in Canada, in association with the goods specified in the registration, at any time between December 19, 2011 and December 19, 2014.

[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] In response to the Registrar's notice, Teoxane, S.A. furnished the affidavit of Claire Boichot. Both parties filed written representations and were represented at the hearing.

[6] In her affidavit, Ms. Boichot states that she is the legal officer of Teoxane, S.A. and that by virtue of her position, she has knowledge of the facts set out in her affidavit. In its written representations, the Requesting Party submits that this is a "bald and vague assertion" as the affiant did not attest "to anything in the way of oversight in product development, access to and familiarity with [Teoxane, S.A.]'s sales, marketing and promotional history of the [registered goods], or overseeing the trade channels through which the [registered goods] have been provided in Canada". The Requesting Party further submits that given that Ms. Boichot resides in France, "her specific knowledge of the marketing, sales and shipment of the [registered goods] into Canada cannot be assumed".

[7] I disagree. 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 and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)]. As noted above, Ms. Boichot clearly states that she has knowledge of the facts described in her affidavit. When I take into account the fact that she is an officer of Teoxane, S.A., the nature of the evidence discussed below, and keeping in mind the purpose and the summary nature of a section 45 proceeding, I accept that Ms. Boichot would generally have knowledge of the activities of Teoxane, S.A. and that she would be knowledgeable of the facts set out in her affidavit.

[8] According to Ms. Boichot, since its inception more than 10 years ago, Teoxane, S.A., doing business as Laboratoires Texoana Geneva (the Owner), develops, manufactures and markets cosmetic care products and products in injectable form used to fill wrinkles based on hyaluronic acid. In particular, Ms. Boichot states that the Mark has been used in Canada since

2006 in association with two injectable gels to fill wrinkles, fine lines, skin dimples, to increase lip volume and to correct labial commissures; one with lidocaine, one without (KISS Products).

[9] With respect to the manner in which the Mark was used in association with the registered goods during the relevant period, Ms. Boichot states that the Mark appeared on the packaging of KISS Products sold in Canada. In support, attached as Exhibit CB-1 is a photo of two representative packaging of KISS Products as they appeared during the relevant period in Canada.

[10] In terms of the Owner's normal course of trade, Ms. Boichot explains that KISS Products are manufactured in Switzerland, which are then distributed worldwide, including Canada, in packs of two syringes of 1 millimeter each. In Canada, the Owner sells KISS Products to Clarion Medical Technologies Inc. (Clarion), a Canadian medical distributor who in turn sells them to hospitals, cosmetic clinics and private medical clinics.

[11] In its written representations and at the hearing, the Requesting Party submits that the Exhibit CB-1 photo does not show use of the Mark as the dates and the facts presented in Ms. Boichot's affidavit "are neither precise nor reliable, and sorely lack in detail". Specifically, the Requesting Party contends that Ms. Boichot fails to indicate when the photo was taken, where it was taken, the dates when this representative packaging was used, and whether this packaging was used with the goods sold to the Canadian distributor Clarion pursuant to the invoices attached as Exhibit 9, discussed below. In support, the Requesting Party relies on *Smart & Biggar v Jarawan* 2006 FC 1254.

[12] When Ms. Boichot's affidavit is viewed in its entirety, I disagree that Exhibit CB-1 is unreliable or ambiguous. The facts of this case can be distinguished from those of the *Jarawan* case in that Ms. Boichot's affidavit clearly sets out sworn statements pertaining to the manner of use of the Mark with the registered goods *during the relevant period* in Canada. When those statements are read in conjunction with the photo attached as Exhibit CB-1, I accept that the packaging shown are representative of those used with KISS Products sold in Canada during the relevant period.

[13] In its written representations and at the hearing, the Requesting Party also submits that the display of “TEOSYAL KISS” and “TEOSYAL PURSENSE KISS”, as shown in the Exhibits CB-1, 2, 4 and 5, is not use of the Mark *per se*. In this regard, the Requesting Party argues that in those instances, the Mark is unrecognizable considering that the addition of “TEOSYAL” or of “TEOSYAL PURESENSE” is an important feature that is more prominent than “KISS”. As such, the Requesting Party takes the position that “an unaware purchaser would be likely to infer that the goods marked with TEOSYAL KISS or TEOSYAL PURSENSE KISS have a different origin than goods marked only with KISS”. In support, the Requesting Party cites the Registrar’s decision in *88766 Canada Inc v Coca-Cola Ltd* (2006), 52 CPR (4th) 50 (TMOB).

[14] The Requesting Party further submits that in Exhibits CB-5 and 7, “KISS is used in the brochure and packaging in an identical manner as ULTIMATE, ULTRA DEEP, GLOBAL ACTION”, “words which the [Owner] does not have trade-mark registrations for”. As such, the Requesting Party submits that “an average consumer would perceive KISS merely as a descriptor, not a trade-mark, upon viewing this product line on the Clarion website (Exhibit 7) and promotional material (Exhibit 5)”. The Requesting Party also points to “inconsistent trade-mark ownership notices” in the exhibits where notice in the form of the ® symbol is provided for “TEOSYAL”, but not for “KISS”, “creating a first impression that the only trade-mark being used is TEOSYAL and not the Mark”.

[15] First, I note that whether the Owner has separate trade-mark registrations for ULTIMATE, ULTRA DEEP and GLOBAL ACTION has no bearing on the present proceeding.

[16] Second, 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 trade-mark [see *United Grain Growers Ltd v Lang Michener* (2001) 2001 FCA 66, 12 CPR (4th) 89 and *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD)].

[17] Third, the placement of a trade-mark symbol is not necessarily determinative. The placement of the ® indicia following “Teosyal” merely indicates that TEOSYAL is a trade-mark; it does not determine whether other trade-marks are also being used. I note that in all the instances where the Requesting Party points to the use of the ® indicia following TEOSYAL, they are with respect to the *advertisement* of such goods. However, Ms. Boichot’s affidavit

includes exhibits showing display of the Mark along with TEOSYAL without any ® indicia – on the packaging of KISS Products (Exhibit CB-1) as well as in other advertising materials (Exhibits CB-2, 3, 4, 5, 6 and 8).

[18] Finally, as for the question of whether display of “TEOSYAL KISS” or “TEOSYAL PURSENSE KISS” constitutes use of the Mark *per se*, I partially reproduce below Exhibits CB-1 and CB-5 for ease of reference.



Exhibit CB-1



Exhibit CB-5

[19] Generally, use of a word mark in combination with additional words or design features qualifies as use of the word mark if the public, as a matter of first impression, would perceive the word mark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)]. The issue is a question of fact, dependent upon such factors as whether the word mark stands out from the additional material or whether the additional material would be perceived as purely descriptive matter or as a separate trade mark or trade name [see *Nightingale, supra*; and *Canadian Council of Professional Engineers v Ing Loro Piana & C SPA*, 2009 FC 1096, CarswellNat 3400].

[20] In the present case, I agree with the Owner that the Mark stands out from the other written material on the packaging of KISS Products such that it would create a separate impression in the minds of the public in view of its placement apart from “TEOSYAL” and

“PURESENSE” in the top representative packaging attached as Exhibit CB-1, as well as in view of its different font and size when compared to “TEOSYAL” in both representative packaging [see *Canada (Registrar of Trade-marks) v Compagnie Internationale pour l’informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA); *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[21] In this respect, it is well established that there is nothing to prevent two trade-marks from being used simultaneously in relation to the same goods [see *AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)]. While the Mark might not be the most prominent trade-mark on the representative packaging, I nevertheless consider the Mark to be displayed on the goods in such a way that it remains recognizable and does not lose its identity. As for the aforementioned *Coca-Cola* decision cited by the Requesting Party, I would simply note that the same principles with respect to the issue of deviation were enunciated in that case and that each case must be decided on its own facts and merit.

[22] With respect to transfers of the registered goods in the normal course of trade, Ms. Boichot attests that the Owner sold approximately 8,700 syringes of KISS Products to its Canadian distributor Clarion during the relevant period. In support, attached as Exhibit CB-9 are representative invoices issued by the Owner during the relevant period. I note that the Owner’s trade name, Laboratoires Texoane Geneva, appears on the top left corner of the invoices. All the attached invoices contain Clarion’s invoice address in Canada, which is also its shipping address. The invoices include descriptions for items identified as “Teosyal PureSense Kiss (2X1ml)” and “Teosyal Kiss (2X1ml)”. The Owner is also identified at the bottom of the invoices with its banking information.

[23] In its written representations, the Requesting Party argues that the representative invoices are insufficient as evidence of use as there is no indication that the invoices accompanied the goods at the time of transfer of ownership. Even so, I accept that this evidence is simply to show that the registered goods were distributed, sold and transferred in the normal course of trade in Canada during the relevant period. The exhibited invoices corroborate Ms. Boichot’s statements pertaining to the sales of the registered goods in Canada by the Owner to Clarion during the relevant period, in packages bearing the Mark as discussed above.

[24] When Ms. Boichot's affidavit is viewed in its entirety, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods in the normal course of trade in Canada during the relevant period within the meaning of sections 4 and 45 of the Act.

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

Pik-Ki Fung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: December 6, 2016

APPEARANCES

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For the Requesting Party

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For the Registered Owner

AGENTS OF RECORD

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