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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 9

Date of Decision: 2020-01-29

IN THE MATTER OF A SECTION 45 PROCEEDING

Sim & McBurney

Requesting Party

and

en Vogue Sculptured Nail Systems Inc.

Registered Owner

TMA789,288 for EN VOGUE DESIGN

Registration

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA789,288 for the trademark EN VOGUE DESIGN (the Mark), shown below, owned by en Vogue Sculptured Nail Systems Inc.

The trademark 'en Vogue' is displayed in a black and white format. The word 'en' is written in a simple, lowercase, sans-serif font. The word 'Vogue' is written in a stylized, cursive script font, with a large, prominent 'V' and a decorative flourish at the end of the word.

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

Chemicals used in industry and photography, in particular light hardening gel; adhesives used in industry; adhesives used for a applying artificial finger nails; nail care products, namely, false nails, artificial fingernails and glue in kit form, emery boards, all for nail grooming; nail care preparations, namely, brush-on gels and resins for nail, curable nail

gels; nail coating removers, artificial nails, nail adhesives; nail brush cleaners, nail forms; dust brushes; apparatus for lighting, namely, UV lamps (not for medical purposes).

[3] For the reasons that follow, I conclude that the registration ought to be maintained in part.

INTRODUCTION

[4] At the request of Sim & McBurney (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on June 12, 2017, to en Vogue Sculptured Nail Systems Inc. (the Owner), the registered owner of the Mark.

[5] The notice required the Owner to show whether the trademark 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 June 12, 2014 to June 12, 2017.

[6] The relevant definition of use for goods in the present case is set out in section 4(1) of the Act, as follows:

4(1) A trademark 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] It is well established that bare statements that a trademark is in 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 trademark in association with *each* of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA) [*John Labatt*]].

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Arlene Janis Rushworth, the President of the Owner, sworn on September 7, 2017. Only the Owner filed written representations. Both parties were represented at an oral hearing.

THE OWNER'S EVIDENCE

[9] Ms. Rushworth explains that the Owner is a manufacturer and distributor of polymer resin nail enhancements and related products for use by professional nail technicians. She states that the Owner typically sells its products to esthetics schools, training centers, and to distributors who distribute the goods to nail and esthetics salons and spas for use by licenced nail technicians. She adds that the Owner also sells products directly to nail technicians, salons, spas, and the like.

[10] Ms. Rushworth affirms that during the relevant period, the Mark was displayed prominently on the Owner's products or on the packaging or containers for these products. As Exhibits A and B, respectively, she attaches photographs of a number of products displaying the Mark, and a catalogue showing a number of products bearing the Mark. She states that these images are representative of how the Mark appeared on the Owner's products and their packaging during the relevant period. She does not correlate the products shown in these exhibits with the registered goods, and in the case of Exhibit A, the products are not identified or described at all; however, the following is a summary of the products depicted in the Exhibit B catalogue:

- on a page entitled "UV HARD GELS", the following items are shown in containers bearing the Mark, listed as being sold in various size formats:
 - an item identified as "CONNECTOR" and described as a "UV cured bonding agent";
 - an item described as a "modeling resin"; and
 - an item identified as "ONE COMPONENT (3 in 1)", described as a self-leveling gel.
- items identified as "Simply" and described as gels, shown in containers bearing the word "Simply" and a stylized letter "V" and, in the case of the 30ml containers, also displaying the Mark (I note that a set of instructions shown in the catalog refers to "curing" the "Simply" gels with UV or LED lights);

- an item described as a “starter kit” showing a box displaying the Mark containing items which are described as resins, gels, a brush, a file, and a UV/LED light unit, as well as “all necessary accessories and an in-depth instructional video on DVD” for creating gel nails;
- an item described as a “drop kit” showing a bag containing items which are described as modeling resins, sealer, Connector, and Prep & Clean, sold in containers displaying the Mark;
- items appearing to be emery boards, described as “Zebra Files” and “Spongeboard”, as well as items appearing to be brushes and dust brushes, all shown as displaying the Mark;
- an item identified as “3g Tip Adhesive”, items described as nail cleaner fluid, and items appearing to be nail tips, described as “50pk Refill Bags Sizes 0-9 Curved Half-Well or Flat Full-Well”, all of which are shown in packs or containers displaying the Mark;
- items appearing to be disposable forms, described as “300pc Disposable Forms w/perforated ends” showing a stylized letter “V” and the Mark;
- an item described as “en Vogue UV/LED Light Unit”, which does not appear to display the Mark.

[11] I note that there are a number of items in the catalogue that display other trademarks, including “Simply”, “Lac It”, and a stylized letter “V”. I further note that the items depicted in the Exhibit A photographs do not appear to include any items that are not also shown in the Exhibit B catalogue.

[12] Ms. Rushworth states that sales for the Owner’s products bearing the Mark during the relevant period were at least \$2.4 million. As Exhibit C, she attaches a sampling of invoices from the Owner for orders placed by its Canadian distributors and customers during the relevant period. Each invoice is dated during the relevant period, and displays the Mark in the top left corner along with the words “Sculptured Nail Systems Inc.” On each invoice, the billing address is the same as the shipping address. Some of the listed items are described in similar terms as the items in the Exhibit B catalogue; these include the following:

- “30ml SIMPLY Clear”;
- “15ml Connector”;
- “Drop Kit”;
- “en Vogue Grey Spongeboard”;
- “en Vogue Zebra Files”;

- “50ml Modeling Resin”;
- “500ml Prep & Clean”;
- “50pk en Vogue FLAT Tips Size #3”;
- “Disposable Forms – 300pk”;
- “en Vogue Sculpting Brush BLACK”;
- “en Vogue Fine Liner Art Brush”;
- “en Vogue INFUSION UV/LED Light Unit”.

[13] I note that there is nothing in the invoices that appears to correspond to some of the items shown in the catalogue as displaying the Mark, including the “ONE COMPONENT (3 in 1)”, the “starter kit”, and the “3g Tip Adhesive”. Further, I note that some of the items in the invoices appear alongside other trademarks, such as “SIMPLY” and “Lac It”. Further, the invoices appear to include certain goods originating from different manufacturers, such the item “TRAPP Industries 9watt UVA Replacement Bulbs For Broken Ones”.

[14] Finally, as Exhibits D and E, Ms. Rushworth attaches sample print advertisements and a screenshot from the Owner’s website. She states that the Exhibit E screenshot is representative of how the website appeared during the relevant period. The Exhibit D advertisements do not show any items bearing the Mark that are not also shown in the Exhibit B catalogue. The Exhibit E screenshot displays the Mark in the top left corner; however, the screenshot consists only of a number of headings and a message from Ms. Rushworth. No products are depicted on the website.

ANALYSIS

[15] At the oral hearing, the Requesting Party submitted that the Owner’s evidence does not show use of the Mark in association with any of the goods during the relevant period for a variety of reasons. These reasons can be generally categorized as follows:

- the Exhibit A photographs and Exhibit B catalogue are undated and do not establish use of the Mark at the time of transfer;
- the appearance of the Mark on the Exhibit C invoices does not establish use of the Mark in association with the registered goods;

- there is no correlation between the registered goods and the items shown in the Exhibit B catalogue and the Exhibit C invoices; and
- the Exhibit D advertisements and Exhibit E screenshot do not establish use of the Mark in association with the registered goods.

I concur with the Requesting Party on the latter point. Exhibits D and E are of no assistance to the Owner; Exhibit D consists merely of advertising, which on its own is insufficient to establish use in association with goods [see *Gowling, Strathy & Henderson v 200219 AB Ltd* (1997), 80 CPR (3d) 292 at para 23; *2077333 Ontario Inc v Logic Alliance Inc*, 2012 TMOB 221 at para 18], while Exhibit E provides only general information about the Owner and does not depict any products at all. The remaining issues will be addressed in turn.

Exhibit A Photographs and Exhibit B Catalogue

[16] The Requesting Party submits that the photographs and catalogue attached as Exhibits A and B, respectively, are undated and do not show use of all the registered goods. Further, the Requesting Party notes that Ms. Rushworth does not indicate that the catalogue accompanied the goods at the time of transfer.

[17] Ms. Rushworth states in her affidavit that Exhibits A and B reflect the Owner's products as they appeared during the relevant period. Although there is no indication that the catalogue accompanied the goods at the time of transfer, the catalogue and photographs are useful insofar as they show whether the Mark was displayed on the products or their packaging during the relevant period, as discussed further below. The catalogue is of greater utility in this regard as it shows a wider range of products along with descriptions, whereas the Exhibit A photographs merely show close-ups of certain items shown in the catalogue.

Invoices

[18] The Requesting Party submits that there is no evidence that the invoices attached as Exhibit C accompanied any of the registered goods at the time of transfer, and further, that the appearance of the Mark on the invoices does not constitute use within the meaning of section 4(1) of the Act. In support, the Requesting Party cites *Riches, McKenzie & Herbert v Pepper King Ltd* (2000), 8 CPR (4th) 471 at paras 16-24, for the proposition that the Registrar cannot

assume that invoices accompanied goods at the time of transfer where a registered owner has not met its burden of establishing that they did; as well as *Tint King of California Inc v Canada (Registrar of Trade Marks)*, 2006 FC 1440 at para 32, for the proposition that use of a trademark on the top of an invoice, with no use in the body of an invoice, will not generally be use in association with the invoiced goods.

[19] The Owner contends that the Registrar can infer that invoices accompanied goods at the time of transfer where the billing address is the same as the shipping address, citing *LIDL Stiftung & Co KG v Joseph Rutigliano & Sons Inc*, 2005 CanLII 91226 (TMOB) and *Riches, McKenzie & Herbert LLP v KOM Networks Inc* (2005) 51 CPR (4th) 65. In addition, the Owner contends that the Owner would not have been able to display a design mark in the body of the invoices, and cites *Hortilux Schreder BV v Iwasaki Electric Co*, 2012 FCA 321 at paras 14-15 [*Hortilux*] for the proposition that the appearance of a trademark at the top of an invoice can constitute use in certain cases.

[20] Even if the invoices accompanied the goods at the time of transfer, I do not find that use of the Mark at the top of the invoice constitutes use in association with the goods listed therein. *Hortilux* listed a number of relevant factors to consider in assessing whether use of a trademark at the top of the invoice establishes use in association with listed goods, including whether goods of more than one manufacturer are listed and whether other trademarks appear in the invoice. In this case, because the invoices contain a wide range of goods (perhaps even those of other manufacturers), including some accompanied by the words “en Vogue” in their product description and others accompanied by other trademarks, I find that use of the Mark at the top of the invoices would be perceived as being associated with the business of the Owner, rather than the goods listed in the invoice [see *Hortilux* at para 12; *Sim & McBurney v Nikita ehf*, 2015 TMOB 222 at para 22; *McMillan LLP v April Cornell Holdings Ltd*, 2015 TMOB 111 at paras 32-33]. I am assisted in reaching this conclusion by the fact that the Owner’s evidence shows that not all of its goods display the Mark.

[21] Finally, I concur with the Requesting Party that the appearance of the words “en Vogue” next to certain listed items does not in itself establish that the Mark appeared on those items or their packaging, nor does it establish use of the design Mark in association with those items. Use

of the word elements of a design mark does not necessarily constitute use of that design mark; the question to be asked is whether the dominant features of the trademark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. In this case, I find that the dominant elements of the Mark are not only the words “en Vogue” but also the large stylized letter “V”, and that the latter element is not preserved by the appearance of the words “en Vogue” in plain text in the invoices; to conclude otherwise would be to allow the Owner to convert its registration for a design mark to a registration for a word mark [for a similar conclusion, see *Thompson Dorfman Sweatman LLP v CWI, Inc*, 2017 TMOB 152 at paras 27-31]. Accordingly, in my view, the utility of the invoices lies in establishing which of the goods shown in Exhibits A and B were sold during the relevant period.

Correlation of Registered Goods with Exhibited Items

[22] As previously indicated, Ms. Rushworth does not correlate the goods listed in the registration with the items shown in the Exhibit B catalogue or the Exhibit C invoices, nor does she explain which of the products shown in the catalogue are listed in the invoices. The Requesting Party submits that absent such correlation, it is not possible to determine which, if any, of the registered goods correspond to the items shown in the catalogue, or to the items listed in the invoices. At the hearing, the Owner sought to draw such correlations, to which the Requesting Party objected on the grounds that doing so amounted to introducing new facts not in evidence. However, while it is not for the Registrar to speculate as to the nature of the registered goods [*Fraser Milner Casgrain LLP v Fabric Life Ltd*, 2014 TMOB 135 at para 13; *Wrangler Apparel Corp v Pacific Rim Sportswear Co* (2000), 10 CPR (4th) 568 at para 12 (TMOB)], reasonable inferences can be made from the evidence provided [*Eclipse International Fashions Canada Inc v Shapiro Cohen* (2005), 48 CPR (4th) 223 (FCA)]. Thus, in my view, while correlation would have been helpful, sufficient information can be gleaned from the brief product listings and descriptions in the catalogue and invoices to correlate some of the listed items with each other and with the registered goods. In particular, I am prepared to find that many of the registered goods can be correlated with certain products shown in the catalogue and invoices, as shown in the table below. In making such correlations, I am mindful of the principle that when interpreting a statement of goods or services in a section 45 proceeding, one is not to be “astutely

meticulous when dealing with [the] language used” [see *Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654 at para 17]:

Registered good	Catalogue Item	Item in invoice
Chemicals used in industry and photography, in particular light hardening gel	“Simply” gels (30ml container)	“30ml SIMPLY Clear”
adhesives used for a [<i>sic</i>] applying artificial finger nails	“CONNECTOR” UV cured bonding agent (15ml container)	“15ml Connector”
nail care products, namely, false nails, artificial fingernails and glue in kit form [...] all for nail grooming	drop kits (I note that the Mark appears on the component parts of these kits which are sold together as a unit)	“Drop Kit”
emery boards	“Zebra Files” and “Spongeboard”	“en Vogue Zebra Files” and “en Vogue Grey Spongeboard”
nail care preparations, namely, brush on gels and resins for nails, curable nail gels	modeling resins (50ml container)	“50ml Modeling Resin”
nail coating removers	“Prep & Clean” nail cleaner fluid (500ml container)	“500ml Prep & Clean”
artificial nails	“50pk Refill Bags Sizes 0-9 Curved Half-Well or Flat Full-Well”	“50pk en Vogue FLAT Tips Size #3”
nail forms	“300pc Disposable Forms w/perforated ends”	“Disposable Forms – 300pk”
dust brushes	Brushes and dust brushes	“en Vogue Sculpting Brush BLACK” and “en Vogue Fine Liner Art Brush”

[23] Because each of these items is shown in the catalogue as displaying the Mark, and because the invoices list these items as having been sold in Canada during the relevant period, I find that the Owner has established use of the Mark in association with each of the registered goods listed in the above chart within the meaning of sections 4(1) and 45 of the Act.

[24] The Owner submits that because most of the registered goods are related to nail enhancement products, the evidence should be sufficient to enable me to conclude that the Mark is not “deadwood” with respect to all of the registered goods. The Owner cites *Saks & Co v Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD) [*Saks*], and *Westinghouse Air Brake Co v Moffat & Co* (2001), 14 CPR (4th) 257 (FCTD), for the proposition that it would be evidentiary overkill to require the Owner to provide specific documentary evidence with respect to each and every product. In response, the Requesting Party cites *Matthew S George v Dr’s Own, Inc*, 2018 TMOB 147 at paras 71-77, for the proposition that the *Saks* principle is only applicable where a registered owner has provided sufficiently detailed evidence, and explained such evidence with sufficient clarity, that the Registrar can logically conclude that a trademark was used in association with each of the goods in the registration.

[25] I concur with the Requesting Party on this point. The Owner’s evidence depicts a wide range of products, some displaying the Mark and others displaying other trademarks. There is no factual basis upon which I could conclude that any of the registered goods not listed in the chart would display the Mark as opposed to other trademarks.

[26] In particular, I note that there are no products in the catalogue that can be readily characterized as “nail brush cleaners”. Accordingly, I find that the Owner has not established use of the Mark in association with the registered good “nail brush cleaners”.

[27] Similarly, it appears to me that in the context of the items shown in the Owner’s evidence, the registered goods “adhesives used in industry” and “nail adhesives” are simply more generalized formulations of the registered goods “adhesives used for [...] applying artificial finger nails”. Generally, use evidenced in association with one specific good cannot serve to maintain multiple goods in a registration [see *John Labatt* at para 14]; further, where use in association with a specific good could potentially support two goods in a registration, the more specific registration will be maintained over the more generalized [*Sharp Kabushiki Kaisha v*

88766 *Canada Inc* (1997), 72 CPR (3d) 195 (FCTD) at paras 14-16; *DLA Piper (Canada) LLP v Huer Foods Inc*, 2019 TMOB 62 at para 19]. As there is nothing in evidence that would fall within the category of some of the adhesive goods but not others, I find that the Owner has not established use of the Mark in association with the registered goods “adhesives used in industry” and “nail adhesives”.

[28] Finally, I cannot conclude that the Owner has shown use of the Mark in association with the registered good “apparatus for lighting, namely, UV lamps (not for medical purposes)”. While a UV/LED lamp is shown in the catalogue, the Mark does not appear to be displayed on the lamp itself, and although the invoices list “en Vogue INFUSION UV/LED Light Unit” as having been sold during the relevant period, the appearance of the words “en Vogue” in the invoices does not constitute use of the design Mark, as discussed above. I note that a UV/LED lamp is also shown in the catalogue as part of the “starter kit” product whose packaging does display the Mark; however, the starter kit is not listed anywhere in the invoices as having been sold during the relevant period. As a result, I find that the Owner has not established use of the Mark in association the registered good “apparatus for lighting, namely, UV lamps (not for medical purposes)”.

[29] As there is no evidence before me of special circumstances excusing non-use of the Mark with respect to “nail brush cleaners”, “adhesives used in industry”, “nail adhesives”, and “apparatus for lighting, namely, UV lamps (not for medical purposes)”, the registration will be amended accordingly.

DISPOSITION

[30] In view of all of the foregoing, 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 “adhesives used in industry”, “nail adhesives”, “nail brush cleaners”, and “apparatus for lighting, namely, UV lamps (not for medical purposes)” from the list of registered goods.

[31] The amended statement of goods will be as follows:

Chemicals used in industry and photography, in particular light hardening gel; adhesives used for a applying artificial finger nails; nail care products, namely, false nails, artificial fingernails and glue in kit form, emery boards, all for nail grooming; nail care preparations, namely, brush-on gels and resins for nail, curable nail gels; nail coating removers, artificial nails; nail forms; dust brushes.

G.M. Melchin
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2019-12-05

APPEARANCES

Jacky Wong For the Registered Owner

Kenneth McKay For the Requesting Party

AGENTS OF RECORD

Borden Ladner Gervais LLP For the Registered Owner

Marks & Clerk For the Requesting Party