



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 290

Date of Decision: 2021-12-22

IN THE MATTER OF A SECTION 45 PROCEEDING

Passion Mode GmbH

Requesting Party

and

Passion Beauty, Inc.

Registered Owner

TMA681,202 for PASSION

Registration

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA681,202 for the trademark PASSION (the Mark).

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

- (1) Books on the subject of hair fashion, hair education, beauty education and cosmetology.
- (2) Magazines published periodically primarily relating to hairstyling.
- (3) Non-electric hair cutting shears and razors.
- (4) Flat irons.

(5) Hair care products namely hair dryers.

(6) Handbags, clutches, wallets and luggage.

[3] For the reasons that follow, I conclude that the registration ought to be amended to delete “Handbags” and “wallets”.

THE PROCEEDING

[4] On September 14, 2018, at the request of Passion Mode GmbH (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to Image Media International, Inc., the owner of the registration on record at the time. I note here that the owner had amended its name from Image Media International, Inc. to Passion Beauty, Inc. (the Owner) in 2005, by way of an amendment to the Articles of Incorporation, which were filed with the Registrar on December 5, 2018, after the issuance of the notice. The change of name was recorded by the Registrar on January 14, 2019.

[5] The notice required the Owner to show whether the Mark was 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 the Mark 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 14, 2015 and September 14, 2018.

[6] The relevant definition of “use” is set out in section 4 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] In response to the Registrar’s notice, the Owner submitted the affidavit of Daniel Funk, President and CEO of the Owner, sworn on April 4, 2019.

[8] Both parties filed written representations. Only the Owner was represented at an oral hearing.

SUMMARY OF THE OWNER'S EVIDENCE

[9] Mr. Funk attests that the Owner has continuously used the Mark in association with the Goods in Canada before, during and after the relevant period. He explains that the Owner's Goods are sold online or by way of telephone, fax or email, and provides "representative examples of how the [Goods] are displayed on the [Owner's] website located at *www.passionbeauty.com*" (Exhibit C). The two exhibited screenshots display the following categories of products sold by the Owner: brushes, cases, clips, pins, combs, containers, diffusers, mirrors, head fit rulers, neck fitters, razors and shears.

[10] Mr. Funk also attests that, since at least 1983, the Owner "developed and used the Mark in association with books on the subjects of hair fashion, hair education, beauty education and cosmetology" as well as "hairstyling magazines".

[11] With respect to evidence of sales, Mr. Funk states that the Owner has sold "large quantities of its PASSION-branded [Goods] to customers all across Canada in the Relevant Period." In support, he provides representative samples of invoices of such sales (Exhibit D). The exhibited invoices are dated during the relevant period and are issued by the Owner to customers in Canada.

[12] I note here that, without identifying any particular invoiced product, Mr. Funk relates the exhibited invoices to certain Goods. For example, Mr. Funk indicates that the invoice provided under the first tab of Exhibit D relates to "Flat irons and hair dryers". While many of the invoice product descriptions (such as "PASSION IONIC FLAT IRON") plainly correlate with the registered goods, other descriptions are less obvious. In particular, none of the product descriptions include any of the terms from Goods (6), namely "handbags", "clutches", "wallets" and "luggage". Nevertheless, according to Mr. Funk, the following invoices relate to Goods (6):

- Two invoices listing the product PASSION SMALL LEATHER ROLLUP WITH VELCRO with the product code SHLC100, which he relates to the registered goods "Clutches/wallets" (Exhibit D-2 and Exhibit D-11);

- Two invoices listing the product PASSION LEATHER LARGE TRIFOLD CASE WITH 2 BUCKLE with the product code SHLC1003, which he relates to the registered goods “Handbags/clutches” (Exhibit D-4 and Exhibit D-7);
- One invoice listing the product PASSION KYOTO VINYL ZIPPERED CASE WITH ORANGE SPINE with the product code SHLC9014, which he relates to the registered goods “Handbags/clutches” (Exhibit D-5); and
- One invoice listing the product PASSION BLACK ZIPPER CASE FOR 8 SHEAR WITH CREDIT CARD FLAP INSIDE with the product code SHLC1018B, which he relates to the registered goods “Luggage” (Exhibit D-6).

[13] With respect to display of the Mark, Mr. Funk states that the Mark appeared on the Goods and their packaging since at least as early as 1983. Mr. Funk provides photographs depicting most of the Goods which he attests are “representative samples of the [Goods] and how the [Mark] is displayed on them” (Exhibit B). He also attests that the photographs are “accurate representations of how the [Mark] has been displayed on [Goods] since they were first introduced in Canada, and how they are [*sic*] displayed on the [Goods], all of which are currently being sold in Canada”.

[14] Exhibit B includes photographs of products – all bearing the Mark – which Mr. Funk describes as a “book”, a “magazine”, a “non-electric shear”, a “non-electric razor”, a “flat iron” and a “hair dryer”. There are also photographs of four items (also bearing the Mark) which Mr. Funk describes only collectively as “Handbags, clutches, wallets and luggage”. These photographs depict what appear to be three small folded cases which are similar in appearance, and one larger zippered leather carrying bag with handles.

[15] Mr. Funk also states that Goods are delivered to customers in “PASSION-branded packaging”, together with an invoice such as the ones shown in Exhibit D. Mr. Funk provides photographs of representative product packaging (Exhibit E). I note that the Mark is displayed on that packaging, as well as in the upper left-hand corner of the exhibited invoices.

[16] Finally, Mr. Funk discusses the advertising of Goods sold in association with the Mark in Canada and in this context, he provides the exhibits described below.

- Exhibit F, which consists of copies of e-mails blasts.
- Exhibit G, which consists of “screenshots from the [Owner’s website] showing the variety of PASSION-branded [Goods] available for purchase in Canada, and are representative of how the Mark was displayed on the [Goods] when purchased by Canadian consumers during the Relevant Period”. The screenshots depict various products including magazines, shears, razors and cases. Mr. Funk does not confirm whether these screenshots are representative of the Owner’s website during the relevant period – his statement seemingly only concerns the representative nature of the display of the Mark during the relevant period. I also note the existence of a copyright notice at the bottom of the webpages which reads: “Passion Beauty © Copyright 1980-2019”.
- Exhibit H, which consists of one screenshot of the Owner’s website printed from the internet archive WayBack Machine and dated January 11, 2016. I note that the appearance of the website is significantly different from that shown in Exhibit G, and importantly, that neither cases nor bags are depicted or referenced on that screenshot.
- Exhibit I, which consists of screenshots of the Owner’s Facebook page.

[17] I note that while many of the Goods listed in the registration such as “razors” and “shears” are shown and identified in the above-listed exhibits, the terms “handbags”, “clutches”, “wallets” and “luggage” are nowhere referenced.

ANALYSIS AND REASONS FOR DECISION

[18] At the outset, I note that the Requesting Party submitted only brief written representations, which make no mention of registered goods (1) through (5). The Requesting Party’s argument relates only to Goods (6), which will be addressed further below.

Goods (1) to (5)

[19] As noted above, many of the registered goods are clearly described in the invoices themselves. For instance, I accept that the invoiced products “KYOTO, GJ SHEAR 6.0”, “PASSION ERGO RAZOR, BLACK”, “PASSION IONIC FLAT IRON - BLACK” and “PASSION PRO IONIC DRYER” correspond to the registered goods “non-electric hair cutting shears”, “non-electric razors”, “flat irons” and “hair dryers”, respectively.

[20] Similarly, I accept that the products identified as “Passion Family Book Volume 13” and “Passion Magazine Volume 118” in the invoices correspond to the registered goods “Books on the subject of hair fashion, hair education, beauty education and cosmetology” and “Magazines published periodically primarily relating to hairstyling”.

[21] Consequently, having regard to the representative photographs showing how the Mark is displayed on the goods themselves and on their packaging, I am satisfied that the Owner has shown use of the Mark within the meaning of sections 4 and 45 of the Act in association with:

- Goods (1), namely “Books on the subject of hair fashion, hair education, beauty education and cosmetology”;
- Goods (2), namely “Magazines published periodically primarily relating to hairstyling”;
- Goods (3), namely “Non-electric hair cutting shears and razors”;
- Goods (4), namely “Flat irons”; and
- Goods (5), namely “Hair care products namely hair dryers”.

[22] The goods referenced in this section will therefore be maintained in the registration.

Goods (6) – Handbags, clutches, wallets and luggage

[23] As for the remaining registered goods, namely “Handbags, clutches, wallets and luggage”, the Requesting Party argues that the evidence provided by the Owner is insufficient because it relates to “organizational, storage and display *cases* for the [Owner’s] hair care appliances/tools” rather than the registered goods “Handbags, clutches, wallets and luggage”.

[24] Indeed, the evidence references “cases”. For instance, the exhibited invoices reference “zippered cases” (some of them also reference “leather rollups”), and an Exhibit G screenshot depicts the types of “cases” sold by the Owner, which are specifically described as “display”, “holsters”, “rollups” and “zippered” cases. That being said, the fact that the Owner’s evidence refers to “cases” and “rollups” is not necessarily determinative of the actual nature of the products sold and I accept the Owner’s submission that a product identified as a “case” or a “rollup” in an invoice could correspond to one of the Goods. That being said, the Owner did not provide clear correlations between the invoiced products and specific registered goods.

[25] In particular, Mr. Funk indicates that invoices which list the product PASSION SMALLER LEATHER ROLLUP WITH VELCRO evidence sales of “clutches/wallets”; that the invoices which list the product PASSION LEATHER LARGE TRIFOLD CASE WITH 2 BUCKLE evidence sales of “handbags/clutches”; and that the invoice which lists the product PASSION KYOTO VINYL ZIPPERED CASE WITH ORANGE SPINE evidences the sale of “handbags/clutches”.

[26] In short, Mr. Funk correlates single invoiced products to multiple registered goods. However, it is well established that use evidenced with respect to one specific good cannot serve to maintain multiple goods in a registration – having distinguished particular goods in the registration, the Owner was obligated to furnish evidence with respect to each of them [per *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[27] As such, to consider the exhibited invoices as evidence of transfers within the meaning of section 4 of the Act, particular invoiced products must be correlated to specific registered goods. In doing so, sworn statements must be accorded substantial credibility [*Oyen Wiggs Green &*

Mutala LLP v Atari Interactive Inc, 2018 TMOB 79 at para 25] and reasonable inferences may be drawn from the evidence provided [*Eclipse International Fashions Canada Inc v Shapiro Cohen* (2005), 48 CPR (4th) 223 (FCA)]. However, it is not for the Registrar to speculate as to the nature of the owner’s goods [see, for example, *Fraser Milner Casgrain LLP v Fabric Life Ltd*, 2014 TMOB 135 at para 13].

[28] I will therefore turn to the evidence to determine what correlations can be made.

Invoice for “Luggage”

[29] Mr. Funk asserts that the sale of “luggage” is evidenced by the Exhibit D-6 invoice. This invoice lists a product identified as PASSION BLACK ZIPPER CASE FOR 8 SHEAR WITH CREDIT CARD FLAP INSIDE.

[30] Bearing in mind that an affiant’s statements must be accorded substantial credibility, I am satisfied that this invoice evidences the sale of luggage and, therefore, that the Owner has demonstrated use of the Mark in association with “luggage” within the meaning of sections 4 and 45 of the Act.

Invoices for “Handbags/clutches”

[31] Mr. Funk asserts that the sale of “handbags/clutches” is evidenced by the Exhibit D-4, D-5 and D-7 invoices. The invoices include a PASSION LEATHER LARGE TRIFOLD CASE WITH 2 BUCKLE and a PASSION KYOTO VINYL ZIPPERED CASE WITH ORANGE SPINE.

[32] I note that these two products are depicted in the Exhibit G website screenshots and are identified as a *14-Shear Tri-fold Case #1003* and a *2 Shear Kyoto Case #9014*, respectively. The appearances of these products are similar. The first product is a handheld, folded case equipped with two buckles to hold the case closed, and the second product is also a handheld, folded case equipped with what appears to be a zippered closure. Based on their appearance, I find that both depicted products correspond most readily to the registered goods “clutches”.

[33] I find that the products described by Mr. Funk as “handbags/clutches” correspond to the registered goods “clutches” and I am therefore satisfied that the Owner has demonstrated use of the Mark in association with “clutches” within the meaning of sections 4 and 45 of the Act.

[34] As for evidence relating to handbags, as previously noted, no products are identified in the evidence using the term “handbag”. Based on my review of the exhibited materials, I note that one zippered leather carrying bag with handles is depicted in an Exhibit B photograph, and that other leather carrying bags with handles are depicted in the Exhibit G website screenshots.

[35] That being said, I can find no evidence from which to conclude that the depicted carrying bags were sold during the relevant period. First, Mr. Funk states that the Exhibit B photographs depict products “currently being sold in Canada”, but does not confirm whether all were also sold during the relevant period. Second, none of the invoices include product descriptions or product codes matching the carrying bags depicted in Exhibit G. In any event, even if I were to accept that the products depicted in Exhibit G were available for purchase in Canada *during the relevant period*, which is not at all clear from the evidence, this would be insufficient to demonstrate use of the Mark under section 4(1) of the Act [see, for example, *Michaels & Associates v WL Smith & Associates Ltd* (2006), 51 CPR (4th) 303 at 307 (TMOB), where the Board held that “offering for sale” is not the same as “selling”].

[36] As such, having found that the invoices identified by Mr. Funk as relating to “handbags/clutches” evidence sales of “clutches”, and in the absence of further evidence, I am not satisfied that the Owner has demonstrated use of the Mark in association with “handbags” within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances before me, these goods will be deleted.

Invoices for “Clutches/wallets”

[37] Mr. Funk asserts that the sale of “clutches/wallets” is evidenced by the Exhibit D-2 and D-11 invoices, which include the product PASSION SMALL LEATHER ROLLUP WITH

VELCRO. However, per *John Labatt, supra*, use evidenced with respect to that product cannot serve to maintain both clutches and wallets.

[38] Based on my review of the evidence, the PASSION SMALL LEATHER ROLLUP WITH VELCRO product is nowhere depicted or described. In the absence of representations of assistance on this point, I am therefore unable to correlate the invoiced product without improperly speculating as to its nature, namely whether it actually corresponds to a “clutch” or to a “wallet”.

[39] Otherwise, I note that there is no evidenced product which clearly corresponds to a wallet or which is described as such in the exhibited evidence.

[40] Consequently, I am not satisfied that the Owner has demonstrated use of the Mark in association with “wallets” within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances before me, these goods will be deleted.

[41] Before concluding, I note that, in its written submissions and at the hearing, the Owner relies on two invoiced products to show use of the Mark in association with “wallets”. The first is the aforementioned PASSION SMALL LEATHER ROLLUP WITH VELCRO. The second is the PASSION BLACK ZIPPER CASE FOR 8 SHEAR WITH CREDIT CARD FLAP INSIDE referenced in the Exhibit D-6 invoice. The Owner argues that the latter product corresponds to the registered goods “wallets” because the product is meant to contain a credit card. However, I am not prepared to accept the Owner’s argument in this regard as it is not supported by evidence and appears inconsistent with Mr. Funk’s clear statement that this particular invoice evidences the sale of “luggage”.

DISPOSITION

[42] 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 “Handbags” and “wallets”.

[43] The statement of goods will now read as follows:

- (1) Books on the subject of hair fashion, hair education, beauty education and cosmetology.
- (2) Magazines published periodically primarily relating to hairstyling.
- (3) Non-electric hair cutting shears and razors.
- (4) Flat irons.
- (5) Hair care products namely hair dryers.
- (6) clutches and luggage.

Eve Heafey
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: October 20, 2021

APPEARANCES

Kaleigh Zimmerman For the Registered Owner

No one appearing For the Requesting Party

AGENTS OF RECORD

McMillan LLP For the Registered Owner

Bereskin & Parr LLP/S.E.N.C.R.L., S.R.L. For the Requesting Party