



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 089

Date of Decision: 2022-04-27

IN THE MATTER OF A SECTION 45 PROCEEDING

**Norton Rose Fulbright Canada
LLP/S.E.N.C.R.L., S.R.L.**

Requesting Party

and

Hem Corporation Private Limited

Registered Owner

TMA591,993 for PRECIOUS

Registration

INTRODUCTION

[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. TMA591,993 for the trademark PRECIOUS (the Mark).

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

Incense and incense sticks, perfumes and perfumery compounds, essential oils, air and room fresheners, cosmetics, hair lotions, hair oil, shampoos, soaps, detergents, tooth paste, tooth powder, dentifrices, cleaning preparations (the Goods)

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

THE PROCEEDING

[4] On February 10, 2021, at the request of Norton Rose Fulbright Canada LLP (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the Act to Hem Corporation Private Limited (the Owner). 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 February 10, 2018 and February 10, 2021 (the Relevant Period).

[5] The relevant definition of “use” 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.

[6] In response to the Registrar’s notice, the Owner submitted the affidavit of Uday L. Shah, the Director of Hem Corporation, sworn on May 4, 2021.

[7] Both parties submitted written representations and no hearing was held.

THE OWNER’S EVIDENCE

[8] Mr. Shah explains that the Owner is one of India’s leading perfumed incense companies that manufactures and exports to 70 countries [para 7]. He states that the Owner has sold the following products in Canada through Canadian retailers during the Relevant Period: incense, incense sticks, and soaps [paras 8 and 11]. He further explains that perfumes and perfumery

compounds, essential oils, and air and room fresheners were used to manufacture the aforementioned products [para 9].

[9] Mr. Shah states that the Owner has not used the Mark in Canada in association with the following products: cosmetics, hair lotions, hair oil, shampoos, detergents, tooth paste, tooth powder, dentifrices, and cleaning preparations [para 10].

[10] In support, Mr. Shah attaches the following relevant exhibits to his affidavit:

- Exhibits “A1” and “A2”: Photographs of several small boxes of Precious Chandan Incense Cones from the Owner as well as photographs of large shipping boxes with one bearing a white label identifying the content as “Precious Chandan Cone - 30 boxes containing 12 pkts of 10 pcs each”. Mr. Shah states that these photographs are representative of the packaging of the Goods shipped by the Owner to Canada during the Relevant Period [para 12].
- Exhibits “B1” and “B2”: Photographs of several boxes of Precious Chandan Premium Bathing Soap with Sandalwood Aroma Oil from the Owner. Mr. Shah states that these photographs are representative of the packaging of the Goods shipped by the Owner to Canada during the Relevant Period [para 13].
- Exhibits “C1” and “C2”: Photographs of several boxes of Precious Chandan Incense Sticks from the Owner as well as photographs of large shipping boxes with one bearing a white label identifying the content as “Precious Chandan Square - 50 boxes containing 25 pkts of 8 stk each”. Mr. Shah states that these photographs are representative of the packaging of the Goods shipped by the Owner to Canada during the Relevant Period [para 14].
- Exhibits “D1” and “D2”: Photographs of several boxes of Precious Jasmine Premium Bathing Soap with Jasmine Aroma Oil from the Owner. Mr. Shah states that these photographs are representative of the packaging of the Goods shipped by the Owner to Canada during the Relevant Period [para 15].

- Exhibits “E1” and “E2”: Photographs of several boxes of Precious Lavender Incense Cones from the Owner. Mr. Shah states that these photographs are representative of the packaging of the Goods shipped by the Owner to Canada during the Relevant Period [para 16].
- Exhibits “F1” and “F2”: Photographs of several boxes of Precious Lavender Incense Sticks from the Owner as well as photographs of large shipping boxes with one bearing a white label identifying the content as “Precious Lavender Hexa - 50 boxes containing 6 pkts of 20 stk each”. Mr. Shah states that these photographs are representative of the packaging of the Goods shipped by the Owner to Canada during the Relevant Period [para 17].
- Exhibits “G” to “L”: Six invoices issued by the Owner to customers in Canada during the Relevant Period. The products sold in association with the Mark fall under one of the following three categories used by the Owner to divide its invoices: perfumed incense sticks, perfumed incense cone, and soap. Mr. Shah explains that the invoices show sales of incense cones, incense sticks, and soaps [paras 18 to 23].

I also note that the invoice provided in Exhibit H contains a category called essential oil without any product associated with the Mark underneath, contrary to three categories mentioned above.

- Exhibit M: Screenshots from the *www.hemfrances.in* website for the following products: Precious Chandan Incense Sticks, Precious Lavender Incense Sticks, Precious Chandan Incense Cones, Precious Lavender Incense Cones, Precious Lavender Soap, Precious Jasmine Soap, and Precious Chandan Soap. All products are depicted with the Mark on their packaging. In particular, the product description of Chandan Incense Cones states: “For everyday use in your homes, prayer, meditation or yoga room, social gatherings or in your surroundings to spread fragrance, remove unpleasant odors and purify the air around”. Mr. Shah states that this is the Owner’s website [para 24].

ANALYSIS AND REASONS FOR DECISION

[11] Although the threshold for establishing use in the context of section 45 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 Canada (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)]. In this case, the Owner states that it has not used the Mark with some of the Goods and the evidence further establishes that the Mark has been used during the Relevant Period with some, but not all, of the remaining Goods.

[12] As mentioned above, Mr. Shah attests in his affidavit that the Owner has not used the Mark in Canada in association with the following Goods: cosmetics, hair lotions, hair oil, shampoos, detergents, tooth paste, tooth powder, dentifrices, and cleaning preparations [para 10]. Given Mr. Shah's statement and as there is no evidence before me of special circumstances excusing non-use of the trademarks, the aforementioned goods will be deleted from the registration.

[13] As for the Goods incense and incense sticks, and soaps, Mr. Shah provides invoices showing the sale of these Goods in association with the Mark in Canada by the Owner during the Relevant Period [Exhibits G to L] and photographs showing how the Mark appeared on the packaging of the Goods [Exhibits A1 to F2]. Given this evidence, I am satisfied that the Owner has shown use of the Mark within the meaning of sections 4 and 45 of the Act for these goods.

[14] The Requesting Party submits in its written submission that perfumes and perfumery compounds, essential oils, and air and room fresheners were solely used in manufacturing other products and were not sold or offered in Canada in association with the Mark. The Requesting Party argues, and I agree, that it does not show use of the Mark within the meaning of sections 4 and 45 of the Act for these goods.

[15] For essential oils, the Owner submits in its representation that it has shown the use of the Mark as the products listed on the second page of the invoice in Exhibit H shows the sale of such good. I respectfully disagree. While the invoice in Exhibit H uses a category of products called essential oils, none of the products identified as such on the invoices are used in association with the Mark contrary to the goods under other categories. Furthermore, the affidavit of Mr. Shan is silent as to any sale of essential oils associated with the Mark in the normal course trade in Canada during the relevant period. He only goes as far to say that essential oils were used in the manufacturing of incense, incense sticks and soaps [para 9].

[16] The Owner further argues that it has also shown use of “air and room fresheners” as the incense cone product description available on the Owner’s website states that it can be used to “spread fragrance, remove unpleasant odors and purify the air around” [Exhibit M]. Registered goods should be understood in accordance with common sense and given their ordinary meaning. In this case, all the products are identified as either incense cones, soap and incense sticks on their packaging and by Mr. Shah in his affidavit. Moreover, the fact that incense products may be used as an air and room fresheners is insufficient to characterize the exhibited various fragrance of incense cones or incense sticks as such [as an example, see *MAPA GmbH Gummi-und Plastikwerke v 2956-2691 Québec Inc*, 2012 TMOB 192 at para 11, where the Registrar found that assertions of children wearing men’s slippers or women’s slippers were insufficient to characterize the slippers as “children’s slippers”.]

[17] The Owner also argues that it has shown use of the Mark with “perfume and perfumery compounds” with the sale of “Precious Chandan Hexa - *Perfumed* Incense Sticks” as listed on some invoices and photograph of packaging displaying the Mark for “*Lavender* Hexa Incense Sticks” shown in Exhibit F2. In the absence of any explanation from Mr. Shah in his affidavit, it would appear that the term “perfumed” in this context simply indicates that the incense sticks are scented. The evidence does not establish that the Owner’s incense sticks or cones can be considered a specific type of perfume. Furthermore, considering all the product photographs provided in Exhibits A1 to F2, none are showing a “perfume or perfumery compounds” product. Rather, it appears the Owner is seeking to rely on use of the Mark with incense products to

maintain the registration for a related good. However, having distinguished particular goods in the registration, the Owner must provide some evidence of use with respect to each of the listed goods [see *John Labatt Ltd v Rainier Brewing Co, supra*; and *Sharp Kabushiki Kaisha v. 88766 Canada Inc.* (1997), 72 CPR (3d) 195 (FCTD)].

[18] Lastly, regarding the use of perfumes and perfumery compounds, essential oils, and air and room fresheners in the manufacturing of registered goods, even if I accept that these become part of the incense, incense sticks, and soaps, I am not convinced that a product that ultimately becomes part of another registered goods establishes use of that trademark in association with both products when it has not been sold as such. Sufficient facts must 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)]. In this case, the goods described by Mr. Shah's in his affidavit, the photographs provided in Exhibit A1 to F2, as well as the screenshots of the Owner's website clearly identify the goods as incense cones, soap and incense sticks.

[19] In the absence of evidence showing use of the Mark for perfumes and perfumery compounds, essential oils, and air and room fresheners within the meaning of sections 4 and 45 of the Act, or special circumstances to justify the absence of use, these goods will be deleted from the registration.

DISPOSITION

[20] Pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the following goods in compliance with the provisions of section 45 of the Act:

Perfumes and perfumery compounds, essential oils, air and room fresheners, cosmetics, hair lotions, hair oil, shampoos, detergents, tooth paste, tooth powder, dentifrices, cleaning preparations.

[21] The statement of goods will now read as follow:

Incense and incense sticks, and soaps.

Martin Béliveau
Chairperson
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE No Hearing Held

AGENTS OF RECORD

Riches, McKenzie & Herbert LLP

For the Registered Owner

Norton Rose Fulbright Canada LLP/S.E.N.C.R.L.,
S.R.L.

For the Requesting Party