

Federal Court



Cour fédérale

**Date: 20110209**

**Docket: T-478-10**

**Citation: 2011 FC 150**

**Ottawa, Ontario, February 9, 2011**

**PRESENT: The Honourable Madam Justice Simpson**

**BETWEEN:**

**KISS MY FACE CORPORATION**

**Applicant**

**and**

**LAPOINTE ROSENSTEIN LLP**

**Respondent**

**REASONS FOR JUDGMENT AND JUDGMENT**

[1] Pursuant to section 56 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), KISS MY FACE Corporation (the Applicant) appeals a decision of the Registrar of Trade-marks (the Registrar) dated February 2, 2010 (the Decision) expunging Canadian Trade-mark Registration No. TMA298,898 (the Registration) for the trademark “KISS MY FACE” (the Mark) for non-use pursuant to subsection 45(4) of the Act.

[2] The Applicant seeks an order directing the Registrar to reinstate the Registration with the following modifications: the reference to “baseball caps” is to be deleted and all the services are to be deleted.

[3] This application is unopposed and the Applicant does not seek costs.

[4] Although no material was filed before the Registrar, evidence showing use of the Mark has now been filed and will be discussed below.

## **BACKGROUND**

[5] Subsection 45(1) of the Act provides that use in Canada must be shown at any time during the three year period immediately preceding the date of the notice requiring the owner of the trademark to furnish proof of use (the Notice). In this case, since the Notice was dated September 25, 2007, the relevant period runs from September 25, 2004 to the date of the Notice (the Relevant Period).

[6] Use for wares (not services) is described in section 4 of the Act. It provides as follows:

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

4. (1) Une marque de commerce est réputée employée en liaison avec des marchandises si, lors du transfert de la propriété ou de la possession de ces marchandises, dans la pratique normale du commerce, elle est apposée sur les marchandises mêmes ou sur les colis dans lesquels ces marchandises sont distribuées, ou si elle est, de toute autre manière, liée aux marchandises à tel point qu’avis de liaison est alors donné à la personne

à qui la propriété ou possession est transférée.

Idem

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

Use by export

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

Idem

(2) Une marque de commerce est réputée employée en liaison avec des services si elle est employée ou montrée dans l'exécution ou l'annonce de ces services.

Emploi pour exportation

(3) Une marque de commerce mise au Canada sur des marchandises ou sur les colis qui les contiennent est réputée, quand ces marchandises sont exportées du Canada, être employée dans ce pays en liaison avec ces marchandises.

[7] In *Osler v Canada (Registrar of Trade-marks)* (1997), 77 CPR (3d) 475, 139 FTR 64 (FCTD) at paragraphs 22 and 25, the Court said:

22. The nature of the proceeding before this Court under section 56 of the *Act* is similar to a trial *de novo* in that the appellant has the right to adduce evidence which was not presented to the Registrar. The Court is not restricted to deciding whether the Registrar was right or wrong. However, the Court should be circumspect about interfering with a Registrar's decision.

[...]

25. Evidence of a single sale, whether wholesale or retail, in the normal course of trade, can suffice so long as it follows the pattern of a genuine commercial transaction and is not seen as being deliberately manufactured or contrived to protect the registration of the mark.

[8] The wares in this case are a variety of face, body, bath, deodorant and hair care products and t-shirts.

[9] The Applicant submits that it has provided evidence of substantial sales in Canada in the affidavit of Robert McLeod, sworn in New York City on May 7, 2010 (the McLeod Affidavit). Mr. McLeod has been President of the Applicant since its incorporation in 1978. His affidavit provides that the wares (other than t-shirts) were manufactured to the Applicant's specifications and that the t-shirts were finished to the Applicant's specifications. It also provides photographs of the wares with invoices showing their sales in Canada and it identifies the distributors and retailers who purchased and sold the wares.

## CONCLUSIONS

[10] I have heard the submissions of counsel and have reviewed the McLeod Affidavit and its exhibits and am satisfied that, in the Relevant Period, the Applicant sold the wares listed below in Canada (the Sales) and that all the products, except the t-shirts, were sold in packaging affixed with labels displaying the Mark. In the case of the t-shirts, the Mark was displayed on the front of the shirts. In my view, the transactions were genuine and the Sales constituted use of the Mark.

[11] The volumes sold in the Relevant Period were at least the following:

<b>Wares</b>	<b>Sales (USD)</b>
Soap, bar soap, foaming soap, liquid soap	33,200
Shaving cream: moisture shave, shave-French	16,000
Deodorant: deodorant-French, stick deodorant	7,800
Exfoliating cream: scrub, body scrub, hand scrub, foot scrub	1,750
Skin lotion: hand crème, moisturizer, foot crème, body balm	14,350
Skin toner	1,200

AHA cream	3,900
Bath and shower gel	4,750
Crème rinses, hair conditioner	12,150
Cleansing masks: scrubs, masque	1,050
Shampoos	11,200
T-shirts	800

[12] For all these reasons, the appeal will be allowed.

**JUDGMENT**

**THIS COURT'S JUDGMENT is that**

1. The application is granted.
2. The Registrar of Trade-marks shall reinstate the KISS MY FACE Registration with the following modifications: the reference to “baseball caps” is deleted and the services are also deleted.
3. There shall be no costs awarded on this application.

“Sandra J. Simpson”

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Judge

**FEDERAL COURT**  
**SOLICITORS OF RECORD**

**DOCKET:** T-478-10

**STYLE OF CAUSE:** KISS MY FACE v LAPOINTE ROSENSTEIN LLP

**PLACE OF HEARING:** Toronto, Ontario

**DATE OF HEARING:** October 25, 2010

**REASONS FOR JUDGMENT:** SIMPSON J.

**DATED:** February 9, 2011

**APPEARANCES:**

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