

Federal Court



Cour fédérale

Date: 20110209

Docket: T-480-10

Citation: 2011 FC 151

Ottawa, Ontario, February 9, 2011

PRESENT: The Honourable Madam Justice Simpson

BETWEEN:

KISS MY FACE CORPORATION

Applicant

and

**LAPOINTE ROSENSTEIN MARCHAND
MELANÇON, 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. TMA574,850 (the Registration) for the trademark “KISS KIDS” (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 modification: the deletion of clothing namely, knitted tops, knitted shirts and t-shirts.

[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 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.

Idem

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.

(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.

Use by export

Emploi pour exportation

(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.

(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 body soaps and hair care products.

[9] The Applicant submits that the affidavit of Robert McLeod, sworn in New York City on May 7, 2010 (the McLeod Affidavit) provides evidence of substantial sales of the wares in Canada. Mr. McLeod has been President of the Applicant since its incorporation in 1978. His Affidavit

shows that the wares were manufactured to the Applicant's specifications. The McLeod Affidavit exhibits photographs showing that the wares were packaged in containers which bore labels which prominently displayed the Mark. The McLeod Affidavit also lists the distributors and retailers of the wares and exhibits invoices proving that the sales were made in Canada. I have no doubt that these transactions were genuine.

CONCLUSIONS

[10] I am satisfied that the Mark was used in Canada in the Relevant Period.

[11] 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 KIDS Registration with the following modifications: delete clothing namely, knitted tops, knitted shirts and t-shirts.
3. There shall be no costs awarded on this application.

“Sandra J. Simpson”

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-480-10

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

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