

SECTION 45 PROCEEDINGS
TRADE-MARK: ALCOJEL
REGISTRATION NO.: 152,061

On July 17, 2003, at the request of Suyen Corporation, the Registrar forwarded a Section 45 notice to 3053851 Nova Scotia Company, the registered owner of the above-referenced trade-mark registration. I note from the trade-mark registration page that 3053851 Nova Scotia Company purchased the trade-mark on August 31, 2001 and that it changed its name to Wellspring Pharmaceutical Canada Corp. (hereinafter Wellspring) on August 19, 2002.

The trade-mark ALCOJEL was registered on July 14, 1967 for use in association with the following wares: “pharmaceutical preparations”.

I would add here that on February 20, 2004 (that is subsequent to the date of the Section 45 notice) the statement of wares was amended pursuant to s-s. 41(1)(c) of the Trade-marks Act to read: pharmaceutical preparations namely isopropanol in the form of emollient and gel.

Section 45 of the Trade-marks Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares and/or services listed on 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 use since that date. The relevant period in this case is any time between July 17, 2000 and July 17, 2003.

In response to the notice, the affidavit of Bonnie Feeney together with exhibits was furnished. Each party filed a written argument and was represented at the oral hearing.

In her affidavit Ms. Feeney states that she is President and COO of Wellspring Pharmaceutical Canada Corp. (hereinafter "Wellspring"). She attests that in her capacity as President and COO of Wellspring she is fully aware of its commercial activities and is familiar with the facts set forth in her affidavit either from her personal knowledge or from information derived from Wellspring's records.

She specifies that Wellspring is and has been in business in Canada since July 2001 providing contract manufacturing and packaging services to the Pharmaceutical Market, both in Canada and the United States. She states that Wellspring also produces and markets an extensive portfolio of OTC products for the Canadian market.

She states that Wellspring, or its predecessor in title has been selling in all provinces in Canada through wholesalers and retailers in Canada and she provides Wellspring's approximate annual sales figures throughout Canada for the sale of pharmaceutical preparations under the trade-mark ALCOJEL for each of the years 2000 to 2002.

As Exhibit B she provides what she terms a picture of the ALCOJEL trade-mark as used in commerce in Canada. She adds that there are no product labels due to the fact that the product labelling is presented as a silk screened bottle and she indicates that a photocopy of the bottle has

been included.

As Exhibit C she provides copies of various invoices for the goods sold under the trade-mark ALCOJEL.

She then states that each of Exhibits A, B and C is typical of the labelling, advertising and invoicing materials used in association with the sale of the goods sold and offered for sale under the trade-mark.

The main arguments of the requesting party are summarized as follows:

The evidence fails to show use by the registered owner and in a manner complying with the requirements of s-s. 4(1) of the Act.

If use of the trade-mark has been shown it is only with a single product namely isopropanol.

Having considered the evidence, I conclude that it is not overwhelming and not as specific as it could have been. Nevertheless, I accept that it shows use of the trade-mark in association with the wares pharmaceutical preparations. The evidence shows that sales in the normal course of trade of the following pharmaceutical preparation namely “isopropanol in the form of emollient and gel” were made during the relevant period by Wellspring. Further, concerning the manner the trade-mark was associated with the wares at the time of transfer of the wares, Ms. Feeney swears that labelling of the product is presented as a silked screened bottle and she states that Exhibit B is typical of such labelling. Consequently, I am prepared to accept that at the time of

sale the trade-mark appeared on the bottle for the wares in the manner shown by Exhibit B and therefore I conclude that the trade-mark was associated with the wares during the relevant period in a manner complying with the requirements of s-s. 4(1) of the Act.

The requesting party, however, argues that it cannot be determined from the evidence whether the use was by the registered owner and it relies on the documents furnished as Exhibits A and B which bear the names of other entities.

The registrant, on the other hand, submits that the use shown is by the registered owner. It states that the pharmaceutical preparation ALCOJEL is one of the OTC (over the counter) products being produced by Wellspring and the evidence clearly shows sales by Wellspring during the period January and March 2003.

I agree with the registrant that the evidence is sufficient to permit me to conclude that during the relevant period the trade-mark was in use by the registered owner Wellspring. The invoices show sales by Wellspring and they clearly refer to the trade-mark ALCOJEL. Further as the registrant's pharmaceutical preparation appears to be an OTC (over the counter) product, I am prepared to accept that it is one of the OTC products produced and marketed by Wellspring for the Canadian market (as stated in paragraph 4 of the affidavit). Consequently, as I accept that it is a product manufactured by the registered owner (Wellspring) and as the evidence clearly shows that it was sold by the registered owner (Wellspring) during the relevant period, I conclude that the evidence shows use by the registered owner.

It is true that the documents furnished as Exhibits A and B do not refer to Wellspring. In fact the Price List refers to Shire Canada Inc. and the advertisement refers to Roberts Pharmaceutical Canada Inc. From the names given I would think that these may be Canadian subsidiaries or otherwise companies related to the registrant's predecessor-in-title namely Shire US Inc. (previously known as Robert Laboratories Inc.) and owner of the trade-mark from September 1993 to December 5, 2000 but as Ms. Feeney has not explained their relationship with the registered owner I would say that the appearance of these names on the documents in question may affect the distinctiveness of the trade-mark, however distinctiveness is not an issue to be considered in a Section 45 proceeding.

As I have concluded that the evidence shows use during the relevant period of the trade-mark in association with the registered wares in the manner required by the Trade-marks Act and as I have concluded that the use shown is by the registered owner "Wellspring", that is sufficient to maintain the trade-mark registration.

Registration No. 152,061 will be maintained in compliance with the provisions of Section 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 25TH DAY OF MAY 2006.

D. Savard
Senior Hearing Officer
Section 45 Division