



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2015 TMOB 191
Date of Decision: 2015-10-28

IN THE MATTER OF A SECTION 45 PROCEEDING

Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l. **Requesting Party**

and

**Vifor (International) AG, (Vifor
(International) Ltd.), (Vifor,
(International) Inc.)** **Registered Owner**

TMA722,470 for ferinject & Design **Registration**

[1] At the request of Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l. (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on November 15, 2013 to Vifor (International) AG, (Vifor (International) Ltd.), (Vifor, (International) Inc.) (the Owner), the registered owner of registration No. TMA722,470 for the trade-mark ferinject & Design (the Mark), shown below:



[2] The Mark is registered for use in association with the goods, “Pharmaceutical preparations for the treatment of iron deficiency and iron deficiency anaemia”.

[3] Section 45 of the 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 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 it 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 November 15, 2010 to November 15, 2013.

[4] The definition of “use” in association with goods is set out in section 4 of the Act as follows:

4(1) A trade-mark 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.

...

4(3) A trade-mark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in 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 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 trade-mark in association with each of the goods specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Owner filed a single affidavit sworn by two individuals, Dr. Cyrill Blatter and Jean-Marc Ligibel, on June 10, 2014 in St. Gall, Switzerland. Both parties filed written representations and were represented at an oral hearing.

The Owner’s Evidence

[7] In their affidavit, Dr. Blatter identifies himself as Marketing Effectiveness & Services Director of the Owner and Mr. Ligibel identifies himself as Head of Intellectual Property of the Owner. They attest that the Owner is a Swiss corporation that manufactures pharmaceutical products for the treatment of various ailments. They state that the Owner entered into a licensing agreement with Luitpold Pharmaceuticals, Inc. on April 11, 2004 for distribution of the registered goods in the U.S.A. and Canada. The affiants confirm that, through the licensing agreement, the Owner asserts control over the quality of the goods sold in association with the Mark.

[8] In this respect, the affiants state that, in association with the Mark, the registered goods have been sold in Europe and the U.S.A. However, with respect to Canada, the Owner concedes that it has not demonstrated use of the Mark during the relevant period within the meaning of sections 4 and 45 of the Act.

[9] Instead, the affiants attest that the registered “pharmaceutical preparation” is currently in the process of being approved by Health Canada. Accordingly, they state that this process qualifies as special circumstances excusing non-use during the relevant period.

[10] In this respect, the affiants provide a timeline of Luitpold’s interaction with Health Canada from 2009 to 2014. Attached to the affidavit are copies of letters from Luitpold to Health Canada during that time period. Much of the content of the exhibited letters has been redacted; however, based on these letters and the affiants’ statements, the relevant timeline was as follows:

- July 21, 2009: Luitpold filed a New Drug Submission (NDS) for the registered pharmaceutical preparation with Health Canada.
- April 28, 2010: Luitpold withdrew the NDS. The affiants do not give reasons as to why Luitpold withdrew this NDS.
- December 14, 2012: Luitpold filed a second NDS for the registered pharmaceutical preparation with Health Canada. A partially redacted copy of this NDS application is attached as Exhibit B to their affidavit. The affiants do not give reasons for the delay between the first NDS and the second NDS. I note that the second NDS refers to the

preparation as “Injectafer®”, rather than “Ferinject” or the like; the affiants give no explanation for this.

- May 8, 2013: Luitpold sent correspondence to Health Canada regarding a “Response to Screening and Review Requests”. A partially redacted copy of the correspondence is attached at Exhibit C to the affidavit.
- June 26, 2013: Luitpold sent correspondence to Health Canada regarding a “Response to Review Request”. A copy of the correspondence is attached at Exhibit D to the affidavit. The correspondence is heavily redacted, but again refers to “Injectafer®” in the subject line.
- November 15, 2013: the Registrar issued the section 45 notice to the Owner.
- November 21, 2013: Luitpold sent correspondence to Health Canada regarding a “Response to Clinical Request”. A partially redacted copy of the correspondence is attached at Exhibit E to the affidavit. From this point onwards, Luitpold’s correspondence with Health Canada refers to the drug product as “Ferinject®” rather than “Injectafer®”.
- December 11, 2013: Health Canada issued a Notice of Non-compliance (NON) against Luitpold’s second NDS.
- December 19, 2013: Luitpold sent correspondence to Health Canada requesting a meeting on January 27, 2014 to discuss the NON. The letter states that the purpose of the meeting was to discuss the “scientific/clinical” reasons for Health Canada’s decision not to approve the NDS. A partially redacted copy of the correspondence is attached at Exhibit F to the affidavit.
- February 5, 2014: Luitpold met with Health Canada to discuss the NON.
- February 14, 2014: Luitpold sent correspondence to Health Canada requesting an extension of time to respond to the NON. The letter states that the reason for the requested extension was because it was “necessary to prepare a rationale supporting the broad IDA indication that was not listed in the Notice of Non-Compliance” and to ensure

that the Owner provides “a comprehensive response to include the requested information discussed” at the February 5th meeting. A partially redacted copy of the correspondence is attached at Exhibit G to the affidavit.

- June 10, 2014: The affiants swore the affidavit in response to the Registrar’s notice.

[11] As indicated above, the exhibited correspondence is heavily redacted and does not shed much light on the particulars of Health Canada’s pharmaceutical approval processes. Furthermore, I note that the Owner does not provide evidence describing, in general terms, Health Canada’s NDS and NON processes, nor does it provide evidence with respect to timelines typically associated with these processes.

Admissibility of the affidavit

[12] At the oral hearing, the Requesting Party submitted that the affidavit of Dr. Blatter and Mr. Ligibel is inadmissible due to technical deficiencies. In this respect, it submitted that the affidavit was not admissible under “Canadian standards” because it was sworn by two individuals together. Furthermore, the Requesting Party submitted that the affidavit was not properly notarized. Finally, the Requesting Party submitted that the exhibits were not signed by the “legalizing officer”, and therefore the exhibits were not properly “legalized”.

[13] In response, the Owner submitted that the affidavit was properly sworn according to the standards of the jurisdiction in which it was sworn, Switzerland. As such, the Owner submitted that the affidavit was properly notarized and the attached exhibits were sufficiently “legalized”.

[14] The Registrar generally accepts affidavits sworn in foreign jurisdictions as long as they meet the requirements of that jurisdiction [see, for example, *Dubuc v Montana* (1991), 38 CPR (3d) 88 (TMOB) and *Bull, Housser & Tupper LLP v Sacha London, SL*, 2013 TMOB 112, 113 CPR (4th) 371]. Furthermore, in the context of section 45 proceedings – which are intended to be summary and expeditious – the Registrar has frequently considered certain deficiencies in affidavits and statutory declarations to be mere technicalities [per *Brouillette, Kosie v Luxo Laboratories Ltd* (1997), 80 CPR (3d) 312 (TMOB); *88766 Canada Inc v Tootsie Roll Industries Inc* (2006), 56 CPR (4th) 76 (TMOB)].

[15] Therefore, I see no reason, for the purpose of this proceeding, to find the furnished evidence inadmissible. As indicated by the Owner, the affidavit appears to have been properly sworn in a foreign jurisdiction.

[16] Furthermore, neither party submitted jurisprudence with respect to whether a single affidavit sworn by two individuals is admissible before the Registrar. Although unusual in that it was sworn by two individuals, the affidavit in this case contains no statements that make it inherently ambiguous as to content. Essentially, the affidavit simply explains the relationship between the Owner and Luitpold and recounts Luitpold's interactions with Health Canada. Given the affiants' respective positions with the Owner, I accept that they would both be knowledgeable of the facts to which they attest. As such, I see no reason that the affidavit should be inadmissible in this proceeding merely because it was sworn by two individuals together [see also *GD Express Worldwide NV v Skyward Aviation Ltd* (2000), 7 CPR (4th) 348 (TMOB), for a similar finding by the Registrar].

Hearsay

[17] In the alternative, the Requesting Party argues that, because the affiants are not employed by Luitpold, and are not the Presidents of the Owner, it is unclear "how much control over and access to" the activities of Luitpold the affiants had during the relevant period. In this respect, the Requesting Party submits that there is no basis for the affiants to have personal knowledge of Luitpold's activities. Thus, the Requesting Party submits that the evidence relating to Luitpold contained in the affidavit, including the exhibited correspondence, is inadmissible hearsay.

[18] In response, the Owner submits that the affiants' statement alone is sufficient to establish a license between the Owner and Luitpold. Specifically, the Owner submits that "the licensed activities under the ferinject & Design mark by Luitpold" enures "to the benefit" of the Owner.

[19] It appears that the Owner is responding to a licensing issue not raised by the Requesting Party. As the Owner concedes that there has been no use of the Mark in Canada, there is no licensing issue in this case.

[20] In any event, the Federal Court has stated that a stricter approach to hearsay evidence may be appropriate under section 57 of the Act, where adversarial proceedings are intended to determine the rights of parties; however, given the summary nature of cancellation proceedings, concerns regarding the hearsay nature of evidence can go to weight, rather than admissibility [see *Eva Gabor International Ltd v 1459243 Ontario Inc*, 2011 FC 18, 90 CPR (4th) 277]. Again, given the nature of the affiants' respective positions with the Owner, I accept that the affiants would generally have knowledge of the activities of Luitpold on the Owner's behalf in North America.

Special Circumstances

[21] As the Owner conceded that there is no evidence of use of the Mark in Canada during the relevant period, the issue is whether, pursuant to section 45(3) of the Act, there were special circumstances which excused such non-use.

[22] The general rule is that absence of use will be penalized by expungement, but there may be an exception where the absence of use is excusable due to special circumstances [*Smart & Biggar v Scott Paper Ltd*, 2008 FCA 129, 65 CPR (4th) 303].

[23] To determine whether special circumstances have been demonstrated, the Registrar must first determine, in light of the evidence, why in fact the trade-mark was not used during the relevant period. Second, the Registrar must determine whether these reasons for non-use constitute special circumstances [per *Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA)]. The Federal Court has held that special circumstances mean circumstances or reasons that are "unusual, uncommon, or exceptional" [*John Labatt Ltd v The Cotton Club Bottling Co* (1976), 25 CPR (2d) 115 (FCTD) at paragraph 29].

[24] If the Registrar determines that the reasons for non-use constitute special circumstances, the Registrar must still decide whether such special circumstances *excuse* the period of non-use. This involves the consideration of three criteria: (i) the length of time during which the trade-mark has not been in use; (ii) whether the reasons for non-use were beyond the control of the registered owner; and (iii) whether there exists a serious intention to shortly resume use [per *Harris Knitting Mills, supra*].

[25] The Federal Court of Appeal offered further clarification with respect to the interpretation of the second criterion, with the determination that this aspect must be satisfied in order for there to be a finding of special circumstances excusing non-use of a trade-mark [*Scott Paper, supra*]. In other words, the other two criteria are relevant, but considered by themselves in isolation, they cannot constitute special circumstances excusing non-use.

[26] Further, the intent to resume use must be substantiated by the evidence [see *Arrowhead Spring Water Ltd v Arrowhead Water Corp* (1993), 47 CPR (3d) 217 (FCTD); *NTD Apparel Inc v Ryan*, 2003 FCT 780, 27 CPR (4th) 73].

Reasons for Non-Use

[27] As stated above, the Owner submits that the “lengthy” NDS approval process was the reason for non-use of the Mark. In this regard, the Owner asserts that there were no unreasonable delays in Luitpold’s pursuit of approval from Health Canada.

[28] In response, the Requesting Party submits that, when facing regulatory obstacles such as the NDS approval process, an owner must provide sufficient reasons as to why the period of non-use was reasonable [citing *Blake, Cassels & Graydon LLP v Canadian Western Bank*, 2011 TMOB 201, 97 CPR (4th) 324 at paragraph 14]. However, the Requesting Party notes that no evidence was furnished to explain the following: the one year delay between registration of the Mark and the first NDS; Luitpold’s cancellation of the first NDS; or the more than three year delay between Luitpold’s first and second NDS submissions.

[29] Although government approval processes *can* warrant special circumstances [see *Montorsi Francesco E Figli-SpA v San Daneile Ham* (2007), 63 CPR (4th) 255 (TMOB)], it is not clear in this case that the NDS approval process itself was the reason for non-use. The Owner simply maintains that the NDS approval process is “lengthy” and that any delays were “reasonable”, leaving it to the Registrar to assume that the NDS approval process was responsible for the non-use.

[30] However, I agree with the Requesting Party that the Owner provides insufficient explanation and evidence with respect to the delays in filing the NDS submissions and with respect to the cancellation of the first NDS.

[31] Furthermore, the Owner provides no description of Health Canada's NDS and NON processes. In the absence of particulars, it is not clear that these processes should be considered unusual, uncommon, or exceptional circumstances that constitute special circumstances [see *Harris Knitting Mills, supra*; and *Lander Co Canada Ltd v Alex E Macrae & Co* (1993), 46 CPR (3d) 417 (FCTD)].

[32] Therefore, in this case, it is at best unclear whether the NDS approval process was the reason for non-use of the Mark during the relevant period.

[33] Indeed, the Owner does not provide any reasons for the first NDS withdrawal or subsequent delays. Furthermore, the Owner does not furnish correspondence related to the first NDS. With respect to the second NDS, the exhibits are heavily redacted and provide no insight as to whether the delays were voluntary.

[34] Accordingly, I agree with the Requesting Party that the Owner's decision to cancel the first NDS and its apparent inaction cannot be considered involuntary. Absent evidence to the contrary, the delays are likely attributable, at least in part, to the voluntary business decisions of the Owner. However, voluntary business decisions are not the sort of unusual, uncommon, or exceptional circumstances that constitute special circumstances [per *Harris Knitting Mills, supra*; *Lander, supra*].

[35] As such, I am not satisfied that the reasons for non-use of the Mark in this case constituted special circumstances.

[36] Nonetheless, I will discuss whether the NDS approval process in this case could constitute special circumstances excusing non-use of the Mark in view of the three criteria set out by the Federal Court of Appeal [per *Harris Knitting, supra*].

Length of Time

[37] In cases such as this, where the registered owner has not alleged use at any time, the registration date is considered the relevant date for purposes of the first criterion [per *Oyen Wiggs Green & Mutala LLP v Rath*, 2010 TMOB 34, 82 CPR (4th) 77]. Therefore, as the Mark was registered on August 27, 2008, the period of non-use is more than six years.

Whether Reasons for Non-use Were Beyond the Control of the Owner

[38] Similar to my finding above that the reasons for non-use were more likely attributable to the voluntary business decisions and/or inaction of the Owner, I do not consider that the NDS approval process itself was beyond the control of the Owner. From the date of registration, the Owner has had over six years to complete the NDS approval process. Although the Owner submits that the NDS approval process was “pursued with diligence” and that “this is not an unreasonable delay in the circumstances”, the Owner provides no particulars as to why more than six years is a reasonable period in the circumstances.

[39] In *Montorsi, supra*, negotiations between the Canadian and Italian governments impacted the registered owner’s approval process and were considered circumstances beyond the registered owner’s control. Here, the Owner only provides heavily redacted correspondence with respect to the NDS process. These letters do not evidence circumstances similar to those in *Montorsi*.

[40] Indeed, I agree with the Requesting Party that, as the Owner provides little in the way of explanation, a negative inference should be drawn that, at a minimum, the Owner was not prepared to meet Health Canada’s criteria for NDS approval.

[41] Furthermore, the exhibited correspondence indicates that Luitpold’s pursuit of NDS approval only proceeded with urgency subsequent to the issuance of the section 45 notice. Following the notice, Luitpold’s correspondence with Health Canada increased in frequency and began to refer to the pharmaceutical preparation as “Ferinject®” rather than “Injectafer®”. This raises the question of why such effort was not being made prior to the notice.

[42] In this respect, I note the following observation by the Federal Court of Appeal in *Plough, supra*:

There is no room for a dog in the manger attitude on the part of registered owners who may wish to hold on to a registration notwithstanding that the trade mark is no longer in use at all or not in use with respect to some of the wares in respect of which the mark is registered. [at paragraph 66]

[43] In view of the foregoing, I am not satisfied that the NDS approval process in this case was beyond the Owner's control.

Serious Intention to Commence Use

[44] With respect to whether the Owner has demonstrated a serious intention to commence use, the affiants attest that the Owner intends to use the Mark in Canada as soon as the NDS is approved by Health Canada. As noted above, this intent appears to be reflected in the increased frequency of Luitpold's correspondence with Health Canada after the section 45 notice date.

[45] Nevertheless, the Requesting Party notes that, while that correspondence references "Ferinject®", the correspondence does not refer to the Mark as registered, which includes additional words and design elements. Furthermore, the Requesting Party notes that while the affiants assert that the Mark as registered is used outside of Canada, no evidence of that use was furnished. As such, the Requesting Party submits that it is unclear whether the Owner intends to use the design Mark as registered, or whether it intends to use INJECTAFER or some variation of FERINJECT that may not constitute use of the Mark as registered.

[46] In any event, the Requesting Party notes that the Owner does not identify the length of time it would take for Luitpold to bring the pharmaceutical preparation in question to market. Absent evidence of when the Owner will sell the registered goods in Canada, the Requesting Party submits that there is insufficient evidence of a serious intention to commence use of the Mark shortly.

[47] Indeed, one is left in the dark with respect to how long the duration of non-use will persist in this case. The Owner furnished no evidence as to what is the typical duration of an NDS approval process, nor did it furnish a likely timeline for this particular NDS.

[48] As such, I am not satisfied that the Owner has sufficiently substantiated its intention to commence use of the Mark [per *Arrowhead, supra*, and *NTD Apparel, supra*].

[49] In any event, due to the lengthy period of non-use without sufficient explanation, I am not satisfied that the Owner has demonstrated that the reasons for non-use of the Mark were beyond its control. Therefore, even if I were to conclude that the NDS approval process constituted special circumstances, I would not be satisfied that the circumstances in this case excuse non-use of the Mark.

Disposition

[50] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be expunged in compliance with the provisions of section 45 of the Act.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

Hearing Date: 2015-09-21

Appearances

Gowling Lafleur Henderson LLP	For the Registered Owner
Bereskin & Parr LLP/S.E.N.C.R.L., S.R.L.	For the Requesting Party

Agents of Record

Simon Hitchens	For the Registered Owner
Jonathan Colombo	For the Requesting Party