



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

Citation: 2016 TMOB 80
Date of Decision: 2016-05-27

IN THE MATTER OF A SECTION 45 PROCEEDING

Gowling Lafleur Henderson LLP **Requesting Party**

and

Cordula May **Registered Owner**

TMA702,290 for Regulat **Registration**

[1] At the request of Gowling Lafleur Henderson LLP (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 January 3, 2014 to Cordula May (the Owner), the registered owner of registration No. TMA702,290 for the trade-mark Regulat (the Mark).

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

Chemical products for use in industry namely chemicals for use in the manufacture of fermentation extracts for preparing cosmetics, and pharmaceutical compositions for humans and animals, food products and animal food products; ferments for chemical purposes; cosmetics for the face, body, lips and nails, except hair care preparations; bleaching preparations and other substances for laundry use; cleaning preparations for skin applications; polishing compositions for skin applications; scouring compositions for skin applications; and abrasive compositions for skin applications; soaps namely skin soaps; perfumery, essential oils for the treatment of acne and scars as a topical application; essential oils for use in the manufacture of skin care products; dentifrices; ferments for pharmaceutical liquids, pharmaceutical creams, and pharmaceutical ointments; pharmaceutical and veterinary preparations namely pharmaceutical preparations for pets and farm animals, for the treatment of inflammatory diseases, for the treatment of vitamin deficiency, for immune defense enhancement, and for the treatment of diseases of the skin and coats of animals; sanitary preparations for medical purposes namely paper and sanitary napkins; pads for covering contacted body parts;

cloth, paper, and sanitary towels; food for babies; dietetic substances adapted for medical use; mineral food-supplements; food supplements with a base of amino acids; food supplements with a base of minerals; food supplements with a base of trace elements; food supplements for medical purposes; vitamin preparations; food supplements for other non-medical purposes with a base of vitamins; preserved, dried and cooked fruits and vegetables; dietetic foodstuffs or food supplements not adapted for medical use, with a base of proteins, fats, fatty acids, with added vitamins, minerals, trace elements, either singly or in combination; meat, fish, poultry and game; meat extracts; jellies; jams, compotes; eggs, milk and milk products; edible oils and fats; dietetic foodstuffs or food supplements not adapted for medical use, with a base of carbohydrates, roughage, with added vitamins, minerals, trace elements, either singly or in combination; coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread, pastry and confectionery; edible ices; chocolate and chocolate products; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

[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 January 3, 2011 to January 3, 2014.

[4] The relevant definition of “use” in association with goods is set out in section 4(1) 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.

[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) at 480], 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 her own affidavit and the affidavit of Alexander May, both sworn on July 8, 2014 in Munich, Germany. Only the Requesting Party submitted written representations; a hearing was not requested.

The Owner's Evidence – Affidavit of Cordula May

[7] In her affidavit, Ms. May attests that she is the owner, Chief Executive Officer and General Manager of SanumTec GmbH, a German company that specializes in the manufacture, distribution and sale of a variety of pharmaceutical and chemical products and preparations and various types of supplements, vitamins and minerals.

[8] Ms. May explains that, in 2008, she granted a license to SanumTec to manufacture the products covered by the subject registration. She attests that SanumTec sells its goods to authorized dealers such as EnzymPro AG, a Swiss company. She confirms that she maintained control over the character and quality of the products produced in association with the Mark.

[9] With respect to the nature of the products sold in association with the Mark, Ms. May explains that Regulat products "have an enzymatic effect which has a wide variety of influences on the entire human body". According to Ms. May, these products "support the body's own regulatory systems and enzyme balance, promote a healthy blood environment, revitalize and improve energy supply to the cells, neutralize free radicals and support a healthy immune system". Further, she states that Regulat products can be taken internally or applied externally to the skin, giving benefits to "skin joints, blood, metabolism, digestion, as well as energy and sluggishness problems."

[10] Ms. May attests that "practitioners regularly prescribe products under the Regulat Mark for over 12 different ailments". In support, attached as Exhibit A to her affidavit are "representative" promotional materials and "research papers" that she attests "are distributed on a regular basis in Canada". As attested by Ms. May, these materials feature Regulat products and describe "some of the numerous end uses" of the Owner's Regulat products. Some of the materials depict a bottle of the Regulat product. For example, on the flyer with a date of "25.05.09", the depicted bottle shows the Mark on the bottle's label along with the terms "cascade fermented", "immune modulating", "antioxidative" and "enzyme regulating".

[11] Ms. May also attaches, as Exhibit C to her affidavit, a page from the website of one of the Owner's authorized Canadian distributors, Avicenna Natural Products Inc. The page provides links to various resources, such as videos and articles, relating to Regulat products.

[12] In particular, Ms. May attests that one of the Regulat products serves to provide support for the immune system. Attached as Exhibit B to her affidavit is a picture of the packaging of this particular Regulat product. The Mark appears on the box. On the side of the box, import indicia are provided, showing information for Advantage Health Matters Inc. of Markham, Ontario. The product is described on the box as follows:

Provides support for healthy innate immune regulation.
Provides antioxidant protection for the protection of good health.
Reduces soluble vascular cell adhesion molecule-1 and soluble intercellular adhesion molecule-1 which are indicators of reduced inflammation.

[13] Ms. May explains that this Regulat product is a liquid and notes that ingredients listed on the packaging includes "concentrated fruits, nuts, vegetables and spices". Stating that she is "fully familiar with the precise ingredients necessary to produce the desired immune regulation and oxidant protection and the other benefits as described above including the required fermentation process", she goes on to list many of the registered goods, asserting that "the use of the Regulat Mark in Canada would correspond" to such goods.

[14] Ms. May's listing encompasses most of the registered goods in the nature of "pharmaceuticals" and "food supplements". By way of example only, her assertion includes such registered goods as "Pharmaceutical compositions for humans and animals, food products and animal feed products", "pharmaceutical and veterinary preparations namely pharmaceutical preparations for pets and farm animals, for the treatment of inflammatory diseases, for the treatment of vitamin deficiency, for immune defense enhancement, and for the treatment of diseases of the skin and coats of animals" and "dietetic foodstuffs or food supplements not adapted for medical use, with carbohydrates, roughage, with added vitamins, minerals, trace elements, either singly or in combination".

Affidavit of Alexander May

[15] In his affidavit, Mr. May attests that he is President of EnzymPro AG of Switzerland. He attests that EnzymPro is “an international health care company specializing in the manufacture, distribution and sale of nature enzymes for medical and veterinary care”.

[16] Mr. May’s affidavit repeats much of Ms. May’s affidavit regarding the uses of Regulat products. Attached as Exhibit A to his affidavit is the same webpage as Exhibit C from Ms. May’s affidavit, providing links to various resources describing the “end uses” of the Regulat products.

[17] Mr. May confirms that his company purchases Regulat products from the Owner’s licensee, SanumTec, and then distributes and sells such products worldwide, including to Canada.

[18] In particular, he identifies three of EnzymPro’s customers in Canada and provides tables showing delivery totals to each customer for dates ranging from August 2009 to March 2014. Although some of the figures are from before the relevant period, he does indicate that 180 boxes of “Regulat (350 ml)” were delivered to Avicenna Natural Products Inc. in North Vancouver, British Columbia in March 2011. As well, with respect to May 2012 to March 2014, he indicates that over 5000 boxes of Regulat were delivered to Advantage Health Matters Inc. in Markham, Ontario. Mr. May attests that each box delivered contained 12 bottles.

[19] In support, attached as Exhibits B, C and D are representative invoices and purchase orders evidencing such deliveries to Canadian customers during the relevant period. Although many of the products listed on the invoices and purchase orders are identified as “samples”, I do note that some of the Regulat products shown on the invoices appear to have been purchased in large quantities. For example, at Exhibit D, the November 30, 2012 invoice to Advantage Health Matters Inc. shows a sale of 2016 bottles of “Regulat Bio-Quality Label Canada 350 ml”, for a total of CAN\$36,288.

[20] Mr. May attests that Regulat products are also distributed via Avicenna’s website. Although he attaches representative screen shots from the website at Exhibit E to his affidavit, Mr. May does not provide any further evidence of such distribution in Canada via the website.

[21] As to the nature of the product sold in Canada, Mr. May echoes Ms. May's description of the particular Regulat product that provides "support for the immune system". Attached as Exhibit F to his affidavit is a picture of the packaging of this product. Although the packaging is in French, it appears to be the same product as shown at Exhibit B of Ms. May's affidavit. The import indicia on the side of the packaging indicates it was imported by Advantage Health Matters Inc. of North York, Ontario.

[22] Similar to Ms. May's affidavit, Mr. May attests that given his familiarity with the ingredients "necessary to produce the desired immune regulation", he asserts that "use of the Regulat Mark in Canada" corresponds to the same wide variety of registered goods.

Analysis

[23] In its written representations, the Requesting Party first notes that, for most of the non-pharmaceutical and food supplement-type registered goods, neither affiant asserts use of the Mark in association with such goods. This includes goods such as "chemical products for use in industry", "soaps", "meat, fish, poultry and game" and "spices".

[24] Further, it notes that both affidavits attach only a single photograph of "representative" packaging. Given the import indicia appearing on the packaging, I accept that it is representative of the packaging for Regulat products listed in the exhibited invoices, in that it displays the Mark as registered. However, I agree with the Requesting Party that neither affiant clearly correlates the packaging or invoiced products to any particular registered good.

[25] Furthermore, many of the Regulat products listed on the exhibited invoices appear to be in the nature of free samples. The Federal Court has held that, generally, the free delivery of samples does not constitute transfers in the normal course of trade [see *JC Penney Co v Gaberdine Clothing Co*, 2001 FCT 1333, 16 CPR (4th) 151], except in particular circumstances. For example, in *ConAgra Foods, Inc v Fetherstonhaugh & Co*, 2002 FCT 1257, 23 CPR (4th) 49 (FCTD), the Court accepted the free distribution of samples as a regular step in the normal course of trade in the industry where the owner of the trade-mark was seeking to develop a market. This was supported by the fact that actual sales closely followed the relevant period in that case.

[26] In this case, it is not clear that such free distribution is a “regular step” in the normal course of trade in the Owner’s industry. Even if I were to make that inference from the evidence, it is not clear which of the registered goods correspond with the invoiced samples. In any event, if the registered owner secured future sales from the distribution of such samples, it provides no clear evidence of such subsequent sales. As such, the free distribution of Regulat products evidenced in Mr. May’s affidavit cannot be considered transfers of such goods in the normal course of trade in Canada during the relevant period.

[27] Nonetheless, in view of the evidence of Regulat products actually sold during the relevant period and the corresponding packaging in both affidavits, I am satisfied that the Owner has demonstrated use of the Mark in association with “pharmaceutical preparations for immune defense enhancement” within the meaning of sections 4(1) and 45 of the Act. In this respect, I note that this registered good most closely corresponds with the product description on the exhibited packaging, which states that the product “Provides support for healthy innate immune regulation”.

[28] In their affidavits, both affiants describe the potential uses and functions of the Owner’s Regulat product as broadly as possible so as to encompass as many of the listed registered goods as possible. However, this approach improperly conflates the potential functions of a product with what a statement of goods sets out as the ordinary commercial term for that product.

[29] The proper approach in a section 45 proceeding is that, generally, where a registered owner provides evidence of use in relation to one of the listed registered goods, it cannot rely on that same evidence to show use with respect to separately listed goods. In this respect, where a registered owner specifies differences between goods in its registration, the implication is that one good is somewhat different from the other and, therefore, use must be shown with respect to each good [see *John Labatt Ltd v Rainer Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA) and *Deeth Williams Wall LLP v Wutzke*, 2010 TMOB 91, CarswellNat 2555].

[30] As such, I am not satisfied that the Owner has demonstrated use of the Mark in association with the remaining registered goods within the meaning of sections 4 and 45 of the Act. As the Owner furnished no evidence of special circumstances excusing non-use of the Mark, the registration will be amended accordingly.

Disposition

[31] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration will be amended to delete all of the registered goods with the exception of "... pharmaceutical ... preparations namely pharmaceutical preparations ... for immune defense enhancement".

[32] The amended statement of goods will read as follows: "pharmaceutical preparations namely pharmaceutical preparations for immune defense enhancement".

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

TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD

No Hearing Held

AGENTS OF RECORD

Lapointe Rosenstein Marchand Melançon, LLP/SENCRL For the Registered Owner

Gowling WLP (Canada) LLP For the Requesting Party