

SECTION 45 PROCEEDINGS
TRADE-MARK: NOVOLIN-PEN
REGISTRATION NO.: 341,997

On March 3, 2003, at the request of Novopharm Limited, the Registrar forwarded a Section 45 notice to Novo Nordisk A/S, the registered owner of the above-referenced trade-mark registration.

The trade-mark NOVOLIN-PEN is registered for use in association with the following wares:
“Medical and surgical syringes for injection including syringes designed as pencils.”

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 March 3, 2000 and March 3, 2003.

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

In his affidavit, Mr. Davis states that he is with Novo Nordisk Canada Inc., (a subsidiary of the registrant company) and that he has knowledge of the matters deposed to in his affidavit unless

stated to be on information and belief. He states that the registrant has the broadest diabetes product portfolio in the industry, including the most advanced products within the area of Insulin Delivery Devices. He indicates that all anti-diabetic preparations and delivery devices sold by his company in Canada are either manufactured by the registrant or for the registrant. He explains that the Canadian distributor of the anti-diabetic preparations and delivery devices is Aventis Pasteur of North York, Ontario which distributor takes orders from his company's customers which include wholesalers, pharmacy chains and hospitals across Canada.

He then specifies that one line of the registrant's anti-diabetic preparations delivery devices is marketed in association with the trade-mark NOVOLIN-PEN. He explains that the delivery devices are "syringes designed as pencils" and he adds that the cost of the delivery devices are included in the cost of the anti-diabetic preparations. He states that this is the normal course of trade in this industry. He provides sample packaging, sample advertising, a summary of the distribution figures for 2000, 2001 and 2002 associated with the NOVOLIN-PEN products, copies of the distributor's invoices which he states evidence sales of the anti-diabetic preparations which the NOVOLIN-PEN products accompany at the point of sale, and a summary of advertising and promotional expenditures.

The requesting party has raised several arguments concerning the evidence furnished, however I find none to be successful.

In my view, having regard to the evidence as a whole, I find it is sufficient to permit me to

conclude that the trade-mark was in use in Canada in association with the registered wares during the relevant period and in a manner complying with the requirements of subsection 4(1) of the Trade-marks Act.

In this regard, I accept that the sample packaging provided (Exhibits A and B) clearly show the manner the trade-mark appears in association with the wares at the time of transfer of the wares in the normal course of trade. It is true that the trade-mark thereon appears as NOVOLIN-PEN® 3 or NOVOLIN-PEN® JUNIOR however because of the presence and location of the ® indicia I am of the view that the message provided to the public is that NOVOLIN-PEN “per se” is being used as a trade-mark (see *Nightingale Interloc Ltd. v. Prodesign Ltd.*, 2 C.P.R. (3d) 535 particularly Principle 1 therein). Accordingly, this permits me to conclude that the use shown constitutes use of the trade-mark NOVOLIN-PEN “per se”.

Concerning sales during the relevant period, Mr. Davis has provided the number of units that were distributed during the relevant period and he has provided copies of invoices which he has explained show sales of the anti-diabetic preparations which the NOVOLIN-PEN products accompany at the point of sale. As it seems the NOVOLIN-PEN syringes packaged in one of the packaging shown in Exhibit A or B accompanied some anti-diabetic preparations sold during the relevant period I conclude that the sale of anti-diabetic preparations accompanied by the NOVOLIN-PEN syringes resulted in transfers not only of the anti-diabetic preparations but of the registered wares associated with the trade-mark in the registrant’s normal course of trade. As for the fact that the NOVOLIN-PEN syringes may not be wares that are sold separately from the

registrant's anti-diabetic preparations, I conclude that as long as at the time of transfer of the wares the public can associate the trade-mark NOVOLIN-PEN with the syringes that accompany the anti-diabetic preparations this is sufficient to permit me to conclude that the use shown complies with the requirements of subsection 4(1) of the Act.

As Mr. Davis has indicated in paragraph 1 of his affidavit that he has knowledge of the matters referred to in his affidavit unless stated to be on information and belief, I accept that he would have had personal knowledge of the manner the wares were being distributed in Canada by the Canadian distributor Aventis Pasteur. Consequently, I have accepted that the wares were offered for sale and shipped to customers in the manner described in the affidavit.

As I am satisfied that the evidence shows use of the trade-mark in Canada during the relevant period in association with the registered wares, I conclude that the trade-mark registration ought to be maintained.

Registration No. 341,997 will be maintained in compliance with the provisions of Section 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 10TH DAY OF MARCH 2005.

D. Savard
Senior Hearing Officer
Section 45 Division

