



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

**Citation: 2015 TMOB 18**  
**Date of Decision: 2015-01-29**

**IN THE MATTER OF SECTION 45 PROCEEDINGS  
requested by Gowling Lafleur Henderson LLP against  
registration Nos. TMA346,856 and TMA660,178, both for  
the trade-mark FERRING in the name of Ferring B.V.**

[1] This is a decision involving summary expungement proceedings with respect to registration Nos. TMA346,856 and TMA660,178, both for the trade-mark FERRING (the Mark) owned by Ferring B.V.

[2] The Mark is currently registered in association with a variety of pharmaceutical preparations, and in the case of registration No. TMA346,856, in association with medical devices as well. A complete list of the registered goods associated with the Mark can be found in the attached Schedules A (with respect to registration No. TMA346,856) and B (with respect to registration No. TMA660,178).

[3] For the reasons that follow, I conclude that registration No. TMA346,856 ought to be maintained in its entirety, and that registration No. TMA660,178 be maintained in part.

The Proceedings

[4] On October 31, 2012 (with respect to registration No. TMA346,856) and November 8, 2012 (with respect to registration TMA660,178), the Registrar of Trade-marks sent notices under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Ferring Inc. (Ferring), the

entity recorded as the owner of the registration on the trade-mark register at that time. The notices were sent at the request of Gowling Lafleur Henderson LLP (the Requesting Party).

[5] The notices required Ferring to provide evidence showing that it had used the Mark in Canada, at any time during the respective three year periods immediately preceding the dates of the notices (the relevant periods), in association with the goods specified in each registration. If the Mark had not been so used, Ferring was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[6] Subsequent to the issuance of the section 45 notices, an assignment of the subject registrations to Ferring B.V. was filed with the Registrar on February 12, 2014. The assignment documents indicate that Ferring B.V. acquired the registrations on that date. The assignment, recorded on the register on February 18, 2014, is not at issue in the present proceedings.

[7] In this case, the use of the Mark in association with the registered goods is governed by section 4(1) of the Act, which reads:

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.

[8] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for clearing the register of “deadwood”. Mere claims of use are insufficient to show the use of the trade-mark, and ambiguities in evidence are to be interpreted against the interests of the registered owner [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[9] In response to the Registrar’s notices, Ferring provided the affidavit of Clayton Soon, the Corporate Affairs Director of Ferring, sworn April 29, 2013, together with Exhibits A through F. The evidence filed in response to each notice is identical.

[10] Both parties filed written representations and attended an oral hearing.

## The Evidence

[11] In his affidavit, Mr. Soon states that Ferring is a Canadian pharmaceutical company that also carries on business as Ferring Pharmaceuticals, and is wholly owned by Ferring B.V.

[12] Mr. Soon attests that since 1976, Ferring and its predecessors, and their related companies and licensees, have used and continue to use the Mark in association with the development, marketing and sale of a variety of pharmaceutical and natural health products. More specifically, he states that the Mark has been used in Canada with the registered goods during the relevant periods.

[13] With respect to such use, Mr. Soon explains that the Mark is the house brand for every registered good marketed and sold by Ferring in Canada. He further explains that while specific goods may have a sub-brand, the Mark is also prominently displayed on each package of these goods (with the exception of two products, which will be discussed below), as per the following example (which I note corresponds to the packaging shown in Exhibit D7):



[14] In addition, Mr. Soon provides a table which identifies a variety of additional sub-branded products (for example, OCTOSTIM, ACTHREL, and DDAVP) including columns which list the products' indicated conditions/treatments, the registered good(s) to which the product corresponds, the date the product was first sold, and an associated attached exhibit which contains images of representative packaging for the respective good (Exhibits D1 to D21). I note that the word FERRING on each package appears either by itself, or as in the above

example (as per Exhibit D7), in larger blue lettering in contrast to the word PHARMACEUTICALS and the surrounding boxes or frames. Mr. Soon states that the sample packaging provided in the attached associated exhibits is representative of the registered goods sold in Canada during the relevant periods.

[15] Mr. Soon attests that each of the products identified on the aforementioned table has been manufactured by Ferring or on its behalf through third-party manufacturing agreements. He further attests that each of these products have been marketed and sold in Canada by Ferring in association with the Mark right through the relevant periods.

[16] With respect to the two products which do not display the Mark on associated packaging, Mr. Soon explains that the Mark is displayed instead on invoices for these products. One of these products, he explains is sold by Ferring under a distribution agreement established in 2010 with the Pharmaceutical Partners of Canada, with the first sale occurring in 2011. Attached as Exhibits E1 and E2 to his affidavit are sample invoices for both products from the relevant periods. The Mark appears on the invoices in the same manner as on the packaging; that is, in blue lettering within a black box, with the word PHARMACEUTICALS appearing in smaller black lettering below. "Ferring Inc." appears separately at the bottom of the invoices together with Ferring's address. Mr. Soon states that these invoices accompany the products and are representative of invoices from the relevant periods.

[17] With regard to sales of the registered goods during the relevant periods, Mr. Soon states that Ferring sold its goods in Canada to pharmacies, health food stores, clinics of naturopathic doctors and directly to hospitals. He provides substantial sales figures for the registered goods bearing the Mark for the years 2009 to 2012. He also provides a further breakdown of Ferring's sales in Canada for the relevant periods for each specific product identified by sub-product in the earlier mentioned table.

[18] Lastly, Mr. Soon indicates that some of Ferring's pharmaceutical products include preparations for animal use, and that it is common practice for veterinarians to prescribe drugs, such as those associated with the registered goods, intended for human use to animals. He explains that Ferring Inc. has sold to veterinarian colleges and clinics a number of products bearing the Mark which are associated with preparations for animal use in the registrations. He

attaches as Exhibit F sample invoices which he states feature the Mark from the relevant periods for products sold to veterinarian colleges and clinics in Canada. He states that these invoices are representative of all such sales for the registered goods that include preparations for animal use during the relevant periods.

#### Analysis and Reasons for Decision

[19] The Requesting Party submits that there are ambiguities and deficiencies in the evidence which raise doubts as to whether the use of the Mark (i) has been as a trade-mark rather than as a trade-name or business name, or whether in any event, (ii) it is possible to conclude that there has been use of the Mark in association with each of the registered goods which accrues to Ferring's benefit.

[20] More specifically, with respect to trade name or business name use, the Requesting Party submits that consumers would not perceive the Mark as shown on the product packaging in the evidence as being the "primary" or "house mark". In this regard, the Requesting Party submits that typically, the Mark appears in close association with Ferring's address, and is featured on the back, sides, or lower front portion of the front panel of the packaging in a non-prominent position. Further to this, the Requesting Party submits that the words "FERRING PHARMACEUTICALS" are presented in a smaller font relative to the brand name used on the front panel of the packaging, and that in contrast to the more prominent brand name, no use is made of trade-mark indicia that would convey to the public that the Mark is claimed as a trade-mark. Instead, the Requesting Party submits, the prominent brand name on the product labels is what is intended to be used as a trade-mark.

[21] Similarly, the Requesting Party submits that the invoices are only capable of showing use of the mark "FERRING PHARMACEUTICALS" in association with services related to the manufacture or distribution of pharmaceutical products. In this regard, the Requesting Party submits that the use of a trade-mark at the top of an invoice will not constitute trade-mark use if, among other things, there are other trade-marks associated with the products listed on the invoices [citing *Smith Lyons, Torrance, Stevenson & Mayer v Pharmaglobe Laboratories Ltd* (1996), 75 CPR (3d) 85 (TMOB); *Tint King of California Inc v Canada (Registrar of Trade-marks)* (2006), 56 CPR (4th) 223 (FC); *Burroughs Wellcome Inc v Kirby Shapiro, Eades &*

*Cohen* (1983), 73 CPR (2d) 13 (FCTD); and *Riches, McKenzie & Herbert LLP v Scott-Bathgate Ltd* (2007), 64 CPR (4th) 370 (TMOB)]. In the present case, the Requesting Party submits that there are other trade-marks associated with each of the products listed on the invoices and there is no clear association of the words “FERRING PHARMACEUTICALS” appearing in the upper right hand corner of the invoices with any given product. In any event, the Requesting Party submits, the evidence is unclear as to whether the invoices accompanied the products sold at their time of transfer.

[22] The Requesting Party submits, for the aforementioned reasons, that the average consumer would not perceive the Mark as a trade-mark identifying the associated goods; thus, not qualifying as use in accordance with the Act. To this end the Requesting Party additionally relies on *Montana Silversmiths v Montana* (1999), 1 CPR (4th) 570 (TMOB), *Road Runner Trailer Manufacturing Ltd v Road Runner Trailer Co* (1984), 1 CPR (3d) 443 (FCTD), and *AW Allen v Warner Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD), in that there is a rebuttable presumption that a company name appearing on goods or sales invoices is being used as a trade-name rather than a trade-mark. Indeed, the Requesting Party submits, Mr. Soon admits at paragraph 3 of his affidavit, that “Ferring Pharmaceuticals” is Ferring’s business or trade name.

[23] Ferring submits, on the other hand, that it is clear from the evidence that such use of the Mark is as a trade-mark, particularly as it appears in logo form. It is in this regard, Ferring submits, that the present case is clearly distinguishable from the cases relied upon by the Requesting Party. In the present case, Ferring submits, the Mark as it appears in the logo (as per the example from Exhibit D7) is given prominence due to its blue lettering and larger relative font size in comparison to the generic word “pharmaceuticals”; a situation it stresses is even less egregious than that in *Road Runner, supra*, wherein the trade-mark at issue appeared in conjunction with “Co. Ltd.”.

[24] Ferring further submits that Mr. Soon’s statement at paragraph 3 of his affidavit is not an admission that the use shown is merely that of a trade or business name; rather, his statement is factual and consistent that Ferring Pharmaceuticals is a name under which Ferring conducts business. In addition, Ferring points out that there is nothing that prevents the use of two trade-

marks simultaneously [citing *AW Allen, supra*], and Mr. Soon has clearly explained in his affidavit, as the evidence also demonstrates, that the Mark is used as a house mark together with a sub-brand. As by example, Ferring submits, the commercial impression with respect to the product in Exhibit D1, is that OCTOSTIM (a sub-brand) is a FERRING product.

[25] As for the Requesting Party's submission that the Mark ought to be marked with trade-mark indicia to clearly convey to the public that the Mark is claimed as a trade-mark, Ferring submits that trade-mark indicia is not required [see *AW Allen, supra*]. I agree and find the cases relied upon by the Requesting Party in this regard to be distinguishable. In particular, in *Montana Silversmiths, supra*, the hearing officer commented that the inclusion of the designation <sup>TM</sup> or ® would have helped in identifying and perceiving the mark as a trade-mark in that case, as there was "absolutely nothing that would permit the average consumer to perceive [the mark] as other than the name of the owner." In the present case, as already discussed, the Mark is set apart visually from the surrounding matter, to the extent that it would be perceived as a trade-mark *per se* [see *Road Runner, supra*, and *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 322 at 538 (TMOB)].

[26] With respect to the appearance of the Mark on the invoices, Mr. Soon clearly swears that the invoices accompanied such products. Furthermore, he explained that invoices were submitted with respect to these two specific products, as the Mark does not appear on the respective product packaging. While other marks also appear on the invoices, they are among the sub-brands identified in Mr. Soon's affidavit and shown in the exhibits to be marked on their respective packages together with the house mark FERRING. I note again, that it is permissible to use more than one mark together in association with goods [as for another example, see *Mantha & Associates v Old Time Stove Co* (1990), 30 CPR (3d) 574 (TMOB)].

[27] In the present case, the Mark appears prominently at the top of the invoices, and is not used in proximity to a corporate address or telephone number; indeed, "Ferring Inc." appears separately at the bottom of the invoices in conjunction with such contact information. Furthermore, the invoices only reflect sales of products stated by Mr. Soon to be manufactured by Ferring, or on its behalf through third-party manufacturing agreements. Lastly, I note that the purchaser in this case, is not the end consumer, but rather is an entity such as a pharmacy,

medical facility/clinic, or veterinary college. I find it reasonable to accept that such purchasers would have some familiarity with the pharmaceutical industry, and would understand that the Mark is being used as a house mark in association with a variety of sub-brands or trade-marks used to distinguish specific pharmaceutical products. Having regard to the all of these factors, I accept that the invoices demonstrate use of the Mark in association with these products [see *Iwasaki Electric Co Ltd v Hortilux Schreder BV*, 2012 FCA 321].

[28] Consequently, having regard to the aforementioned, I accept that the evidence shows use of the Mark as a trade-mark *per se* in association with the registered goods.

[29] As previously indicated however, the Requesting Party submitted that, in any event, the evidence is not sufficient to conclude that there has been use of the Mark in association with *each* of the registered goods which accrues to Ferring's benefit. The Requesting Party provided numerous submissions in this regard.

[30] To begin with, the Requesting Party submitted that the evidence of sales is ambiguous, as it does not clearly establish that sales of all of Ferring's products occurred during the relevant periods. More specifically, the Requesting Party submitted that invoices were not provided for each of the registered goods and that Mr. Soon's statements regarding sales are not only ambiguous, but do not constitute proof of sales. The ambiguity in Mr. Soon's statements regarding sales, the Requesting Party submitted, lies in the fact that the sales figures provided for each of the sub-branded products are cumulative sales for a four year period from January 1, 2009 to December 31, 2012; this period is not coterminous with the relevant periods. As a result, the Requesting Party submitted, it is impossible to know whether such sales occurred during the relevant periods or whether they occurred in the months either before or after the relevant periods.

[31] Ferring submitted however, and I agree, that there is no requirement to file invoices in order to maintain goods in a registration under section 45 [see *Lewis Thomson & Sons Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 at 486 (FCTD)]. Furthermore, I also agree that Mr. Soon's sworn statements, including the sales summary charts provided, constitute sufficient evidence of sales for those goods identified in the table [see *Lapointe Rosenstein v Big Apple Ltd* (2004), 34 CPR (4th) 561 (TMOB)]. With respect to the Requesting Party's



submission concerning ambiguity as to when such sales took place, again I agree with Ferring that this evidence must be read in conjunction with Mr. Soon's sworn statement that the figures in the chart he provided refer to sales made during the relevant periods.

[32] The Requesting Party additionally submitted that certain uses of the Mark ought not to accrue to Ferring's benefit, as some product packaging provides confusing or conflicting impressions to the consumer as to the source of the goods. In particular, the Requesting Party submitted that a number of the products shown in the evidence show that the primary marks (that is, what Ferring refers to as "sub-brands"), are trade-marks of Ferring B.V., not Ferring. Furthermore, the Requesting Party submitted, Mr. Soon does not provide any statements to the effect that these trade-marks are used under license by Ferring or to suggest that Ferring is nonetheless the source of these products. The Requesting Party submitted that given that "FERRING PHARMACEUTICALS" and related corporate indicia also appear on the packaging, an unclear impression is therefore provided to the consumer. Furthermore, the Requesting Party submitted that Mr. Soon's affidavit does not clarify the situation; he only states that the products are "marketed and sold" by Ferring. While Ferring B.V. is described as wholly-owning Ferring, corporate control alone is insufficient to establish that use by the related company of a trade-mark is properly licensed use [citing *Spirits International BV v BCF sencl*, 2011 FC 805 at paras 19-24, var'd on other grounds 2012 FCA 131; *Marcus v Quaker Oats Co of Canada* (1988), 20 CPR (3d) 46 (FCA); and *House of Kwong Sang Hong International Ltd v Borden Ladner Gervais*, 2004 FC 554 at para 22]. As such, the Requesting Party submitted, it would be unclear to the consumer whether Ferring or Ferring BV is the manufacturer, distributor or otherwise of these products and in these circumstances, such use cannot accrue to Ferring's benefit.

[33] Ferring submitted that they are not relying on licensed use; therefore, the cases cited by the Requesting Party are irrelevant. I agree. Moreover, whether the use of the sub-brands by Ferring was proper licensed use, is irrelevant – these are not the marks at issue in the present proceedings. Mr. Soon has clearly sworn that all sub-branded products shown in the evidence were manufactured by Ferring, or on its behalf through third-party manufacturing agreements, and there is no reason not to take his sworn statements at face value. In any event, as correctly pointed out by Ferring, all of the packaging or invoices attached to the affidavit clearly feature

the Mark, as well as the Ferring Inc. trade-name and address; accordingly, I find it reasonable to accept that consumers would identify Ferring as the source of the goods. That other entities' names appear on the product packaging, as submitted by Ferring, does not contradict Mr. Soon's assertion that the Mark was used by Ferring during the relevant periods in the manner described in his affidavit. In any event, Ferring submitted that this is not a licensing issue, but rather is an attack based on distinctiveness, and issues such as distinctiveness are beyond the scope of section 45 proceedings [see *United Grain Growers Ltd v Lang Michener* (2001), 12 CPR (4th) 89 (FCA)].

[34] In addition to the above submissions, the Requesting Party submitted that, in any event, no use has been shown whatsoever with respect to certain additional goods. Specifically, the Requesting Party submitted, no use has been shown with goods (2) under TMA346,856, or with goods (2), (12), and (13) under TMA660,178. The Requesting Party submitted that Mr. Soon did not identify any of the products listed in the table in his affidavit as corresponding to any of these registered goods. Furthermore, the Requesting Party submitted that it is not claimed elsewhere in Mr. Soon's affidavit that the Mark has otherwise been in use during the relevant periods in association with these specific goods.

[35] At the oral hearing, Ferring conceded that no use had been shown with respect to good (13) under registration TMA660,178, being "antiprotozoal and antibacterial agent in modified release tablet form. Consequently, this good will be deleted from this registration. However, Ferring maintained that while the remaining goods may not have been specifically identified in the table in Mr. Soon's affidavit, Mr. Soon did not specifically state in his affidavit that the table describes *all* of Ferring's products, and that these goods are nonetheless shown in the attached exhibits. Ferring provided several submissions directing attention to various exhibits in order to provide the relationship between the disputed registered goods and several of the products shown in the evidence, all of which I find reasonable. For example, Ferring submitted that the packaging in Exhibit D5 for the sub-branded product DURATOCIN® indicates that it is a uterotonic agent in injectable form, for the prevention of uterine atony and post-partum hemorrhage; such a description I find reasonably consistent with good (12) under registration TMA660,178, being "Pharmaceutical preparations for human use which regulate uterine contractions in injectable form. I come to this conclusion, bearing in mind the purpose of section

45 of the Act, and the principle that “one is not to be astutely meticulous when dealing with language used in a statement of wares” [*Levi Strauss & Co. v. Canada (Registrar of Trade-marks)* (2006), 51 CPR (4th) 434 (FCTD)].

Disposition

[36] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, registration No. TMA346,856 will be maintained in its entirety, and registration No. TMA660,178 will be amended in compliance with the provisions of section 45 of the Act to delete the following goods:

- (13) Antiprotozoal and antibacterial agent in modified release tablet form.

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Kathryn Barnett  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

## **Schedule A**

*Registered goods under TMA346,856:*

- (1) Pharmaceuticals, namely hormones for treating reproductive and excretory function disorders, X-ray contrast media and gastrointestinal medicaments.
- (2) Medical devices for administering hormones containing pumps, timers, ampules and structural parts thereof.

## Schedule B

*Registered goods under TMA660,178:*

- (1) Pharmaceutical preparation that modulates fertility and for use in the induction and stimulation of ovulation in humans in injectable form; pharmaceutical preparations for use as a laxative, bowel cleanser and diagnostic aid in powder form.
- (2) Pharmaceutical preparations and substances in intravenous form for the prevention of premature labour and premature birth.
- (3) Pharmaceutical preparations for human and animal use in tablet, nasal spray and injectable form which regulate the flow of urine and controls the body's water balance and in injectable form for blood clotting.
- (4) Pharmaceutical preparation for the treatment of intestinal bowel diseases and certain auto-immune diseases in tablet, enema and suppository form.
- (5) Brain peptide in injectable form which modulates the pituitary function.
- (6) Human and animal pharmaceutical preparation used as a vasoconstrictor and in the control of water metabolism in injectable form.
- (7) Hypothalamic releasing substance for use in human and veterinary medicine as a diagnostic and therapeutic agent.
- (8) Pharmaceutical preparation consisting of gonadotropin releasing hormones for human and animal use.
- (9) Pharmaceutical preparations in liquid form for the treatment of hypercalcemia.
- (10) Pharmaceutical preparation for human and animal use in liquid and nasal spray form which regulates the body's coagulation system.
- (11) Pharmaceutical preparations, namely a pessary for cervical ripening and induction of labour at term.
- (12) Pharmaceutical preparations for human use which regulate uterine contractions in injectable form.
- (13) Antiprotozoal and antibacterial agent in modified release tablet form.