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LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 80

Date of Decision: 2020-06-30

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Torys LLP**

**Requesting Party**

**and**

**Innovatek Medical Inc.**

**Registered Owner**

**TMA483,828 for ACCU-MAB DESIGN**

**Registration**

INTRODUCTION

[1] At the request of Torys LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on July 31, 2018, to Innovatek Medical Inc. (the Owner), the registered owner of Registration No. 483,828 for the trademark ACCU-MAB DESIGN (the Mark), shown below:

***Accu-MAb***

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

In vitro diagnostic kits namely: reagents employing conjugated monoclonal antibodies.

[3] For the reasons that follow, I conclude that the registration ought to be maintained.

[4] The notice required the Owner to show whether the Mark has been used in Canada in association with the goods 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 July 31, 2015, to July 31, 2018.

[5] The relevant definitions of use for goods are set out in section 4 of the Act as follows:

4(1) A trademark 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 trademark 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.

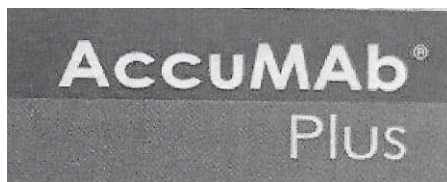
[6] It is well established that bare statements that a trademark is in use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is low [*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 trademark in association with each of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[7] In response to the Registrar's notice, the Owner furnished the affidavit of King Fei Hui, President and Secretary of the Owner, sworn October 25, 2018. Both parties filed written representations. No oral hearing was held.

## THE OWNER'S EVIDENCE

[8] Mr. Hui states that the Mark was owned by Delta Biotech Inc., a solely-owned subsidiary of the Owner, until September 20, 2016, when Delta Biotech was dissolved and its assets (including the Mark) were assumed by the Owner, a British Columbia-based company. He explains that the in vitro diagnostic kit described in the registration (the “kit”) was sold directly to medical laboratories in Canada. As Exhibit B, he attaches an invoice dated during the relevant period, showing sales to a Quebec-based laboratory of “Accu-MAb Plus DFA” items which Mr. Hui identifies as the kit. As Exhibit F, he attaches a second invoice dated during the relevant period, showing sales to a Colombia-based company of “AccuMAb” items which Mr. Hui identifies as the kit.

[9] As Exhibits C and D, Mr. Hui attaches a brochure and a photograph of packaging, respectively. He states that the brochure was used to advertise the kit in 2016; I note that the packaging shown in Exhibit D also appears on the brochure. In both cases, the Mark appears on the kit’s packaging in the following configuration:



## ANALYSIS

[10] The Requesting Party submits that the Mark as shown in evidence deviates from the Mark as registered and that the Owner’s evidence does not show use during the relevant period. Each submission will be considered in turn.

### Deviation

[11] The Requesting Party submits that the Owner’s evidence does not show the Mark as registered. In particular, the Requesting Party submits that the Exhibit B and F invoices feature “AccuMAb Plus DFA” or “AccuMAb”, which do not contain a hyphen, are not italicized, and are in a different font than the Mark as registered. Similarly, the Requesting Party submits that

the packaging displays the words “AccuMAb Plus”, which also do not contain a hyphen, are not italicized, and are in a different font than the Mark as registered. The Requesting Party contends that because of the simplicity of the Mark as registered, the hyphen and font are dominant and essential features of the Mark, such that their omission would mislead an unaware purchaser as to the origin of the goods.

[12] In response, the Owner submits that minor variations to a registered trademark are permissible so long as the dominant features of the trademark are maintained and the variations are so unimportant as to not mislead an unaware purchaser. In this case, the Owner submits that the dominant features of the Mark are the unique word “Accu-MAb”, and that the changes shown in evidence are not significant enough to cause confusion for an unaware purchaser.

[13] In considering whether the display of a trademark constitutes display of the trademark as registered, the question to be asked is whether the trademark was displayed in such a way that it did not lose its identity and remained recognizable, in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see whether the “dominant features” of the registered trademark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. The assessment as to which elements are the dominant features and whether the deviation is minor enough to permit a finding of use of the trademark as registered is a question of fact to be determined on a case-by-case basis.

[14] Further, the use of a trademark in combination with additional words or features constitutes use of the registered mark if the public, as a matter of first impression, would perceive the trademark *per se* as being used. This is a question of fact which is dependent on such factors as whether the trademark stands out from the additional material, such as by the use of different lettering or sizing, or whether the additional material would be perceived as purely descriptive matter or as a separate trademark or trade name [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)].

[15] Comparing the Mark to the trademark used by the Owner on the kit’s packaging during the relevant period, in my view, the Mark did not lose its identity and remains recognizable. The

dominant feature of the Mark, namely, the word “Accu-MAb”, remains present in the trademark used by the Owner. I do not consider the hyphen, the font, or the italicization of the word to constitute dominant features of the Mark or that their absence would tend to mislead unaware consumers. Further, I consider “Plus” to be a descriptive or laudatory word, and I note that it appears below the Mark in different lettering on the kit’s packaging. Thus, the Mark stands out from this additional word. Since the dominant features have been preserved and the Mark remains recognizable, I conclude that display of the Mark in the manner that it appears on the kit’s packaging constitutes display of the Mark as registered.

Use during the Relevant Period

[16] The Requesting Party submits that the Owner’s evidence does not show use of the Mark during the relevant period. In particular, it contends that certain exhibits, including the Exhibit D photograph, are not dated during the relevant period, and are therefore not relevant to the current proceeding. With respect to the Exhibit C brochure showing the packaging for the kit, the Requesting Party submits that Mr. Hui’s explanation that this brochure was used in 2016 amounts to a bald statement and does not support a claim of use of the Mark within the meaning of the Act.

[17] However, I note that Mr. Hui’s statement that the brochure was used in 2016 is not a bald statement, but a sworn statement of fact. Such statements are to be taken at face value in section 45 proceedings, absent evidence to the contrary [*Oyen Wiggs Green & Mutala LLP v Atari Interactive, Inc*, 2018 TMOB 79 at para 25]. Here, there is nothing in evidence that would cause me to doubt the affiant’s credibility. As such, I conclude that the brochure shows the packaging of the kit as it appeared during the relevant period. Given that the Mark was displayed on the packaging of the kit, and that the Exhibit B and F invoices show sales and export of the kit during the relevant period, I conclude that the Owner has established use of the Mark in association with the registered goods during the relevant period within the meaning of sections 4(1), 4(3), and 45 of the Act.

DISPOSITION

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

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G.M. Melchin  
Hearing Officer  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE** No Hearing Held

**AGENTS OF RECORD**

Nicola D. Collins (Hammerberg Lawyers LLP)

For the Registered Owner

Torys LLP

For the Requesting Party