



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 217

Date of Decision: 2022-11-09

IN THE MATTER OF SECTION 45 PROCEEDINGS

Requesting Party: Fasken Martineau DuMoulin LLP

Registered Owner: getemed Medizin- und Informationstechnik AG

Registrations: TMA678,389 for VitaGuard, and
TMA779,915 for VitaGuard

INTRODUCTION

[1] This is a decision involving summary expungement proceedings under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration Nos. TMA678,389 and TMA779,915, both for the trademark VitaGuard (the Mark), registered for use in association with the following goods:

Medical devices, namely monitors for monitoring heart rate, respiration, pulse rate, arterial oxygen saturation and other physiological parameters.

[2] For the reasons that follow, I conclude that the registrations ought to be maintained.

THE PROCEEDINGS

[3] At the request of Fasken Martineau DuMoulin LLP (the Requesting Party), the Registrar of Trademarks issued two notices under section 45 of the Act on May 19, 2020 to getemed Medizin- und Informationstechnik AG (the Owner), the registered owner of the subject registrations.

[4] The notices required the Owner to show whether the Mark was used in Canada in association with the goods specified in the registrations at any time within the three-year period immediately preceding the date of the notices and, if not, the date when the Mark was last in use and the reason for the absence of such use since that date. In the case of both notices, the relevant period for showing use is May 19, 2017 to May 19, 2020.

[5] The relevant definition of “use” with respect to both proceedings is 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.

[6] 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 removing “deadwood” from the register. The evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at para 9].

[7] In response to both of the Registrar’s notices, the Owner furnished the essentially identical affidavits of Robert Downes, member of the Executive Board of the Owner, sworn November 18, 2020 in Germany. I will make no distinction between both affidavits of Mr. Downes in my review of the evidence and will use the singular form to refer to them.

[8] Both parties submitted written representations. Only the Owner was represented at a hearing.

EVIDENCE SUMMARY

[9] In his affidavit, Mr. Downes states that the Owner is a medical device and health information company based in Germany which has “developed, manufactured and sold medical devices and medical monitoring products in the fields of cardiological diagnostics and vital signs monitoring” since 1984.

[10] Mr. Downes explains that the Owner “exports and sells its medical devices and medical monitoring products through a series of national distributors to customers worldwide, including in Canada”. He further explains that the Owner’s Canadian distributor is Roxon Medi-Tech Ltd. (Roxon), a company in the business of the distribution and sale of medical equipment to medical facilities across Canada.

[11] At paragraph 13 of his affidavit, Mr. Downes attests that the Owner exported and sold the “VITAGUARD VG 3100 model of the [registered goods] bearing the Mark to Roxon in Canada” during the relevant period. As Exhibit C to his affidavit, he provides two invoices dated within the relevant period and issued by the Owner to Roxon with an address in Quebec. Mr. Downes describes these invoices as “representative invoices showing the sale of the VITAGUARD VG 3100 model of the [registered goods] by the Owner to Roxon during the Relevant Period”.

[12] At paragraph 14 of his affidavit, Mr. Downes states that:

During the Relevant Period the VITAGUARD VG 3100 model of the [registered goods] was sold by [the Owner] to Roxon in Canada as a kit, including, among other items:

- a. the VITAGUARD VG 3100 Monitor, identified on the invoice attached as Exhibit “C” as “1 pcs Monitor VG 3100 with Masino-SET”; and
- b. A user manual for the VITAGUARD VG 3100; and
- c. A user manual (short version) for the VITAGUARD VG 3100, identified on the invoice attached as Exhibit “C” as “User manual (short version) for VG 3100 - English”.

[13] Indeed, I note that both Exhibit C invoices show the sale of a product identified as “VG 3100 with Masino-SET”, which includes the items identified by Mr. Downes, namely a VITAGUARD VG 3100 Monitor, a user manual and a user manual (short version).

[14] As Exhibit B to his affidavit, Mr. Downes provides an image of a device bearing the Mark, as shown in the excerpt reproduced below:



[15] Mr. Downes attests that this image “is representative of the VITAGUARD VG 3100 model of the [registered goods] sold in Canada in association with [the Mark] during the Relevant Period”.

[16] As Exhibits D and E to his affidavit, Mr. Downes attaches copies of user manuals which he describes as representative examples of the complete user manual and the user manual (short version) for the VITAGUARD VG 3100. I note that the complete user manual attached as Exhibit D is titled “VITAGUARD VG 3100 - Apnea, heart, and SpO2 monitor - Operating Instructions” and includes several pages depicting the device reproduced above. I further note that the following descriptions appear under a chapter of same manual titled “Intended Use and Indications”:

VitaGuard® VG 3100 is intended to be used for continuous, non-invasive monitoring of, and to generate alarms for, respiratory effort (to detect central apnea when the patient is at rest on a stable underground), heart rate or pulse rate, and functional oxygen saturation of arterial hemoglobin (SpO2) of pediatric and adult patients.

[17] Finally, as Exhibit F to his affidavit, Mr. Downes attaches an essentially identical image to the one reproduced above, which he describes as “a representative image of the [Owner’s VITAGUARD VG 3100], advertised on the Roxon website”.

ANALYSIS AND REASONS FOR DECISION

[18] In its written representations, the Requesting Party first questions whether the evidence is admissible. Otherwise, it questions whether the evidence is sufficient to demonstrate use of the Mark in association with the registered goods.

Admissibility of the Evidence

[19] The Requesting Party alleges that there is no indication whether the person before whom the affidavit was sworn is a notary public or commissioner for taking oaths having authority to take affidavits or statutory declarations in Germany, and that the exhibits attached to the affidavit are neither individually identified, dated, signed or sworn. It asserts that such deficiencies are fatal to the affidavit’s admissibility.

[20] In response, the Owner notes that the Requesting Party has not identified any German rules that have been broken, and that it is reasonable to infer that the affidavit was made in accordance with German rules in the present cases. Moreover, the Owner submits that the Registrar has accepted an affidavit sworn in Germany as *prima facie* admissible as long as it was made in accordance with the rules of the jurisdiction where it was sworn [citing *San Tomo Partners v Companhia Industrial de Conservas Alimeticias/Cica* (1994), 53 CPR (3d) 560 at para 5 (TMOB)].

[21] In any event, the Owner submits that the affidavit is admissible as: (i) it is apparent from its preamble that the affiant affirmed it before the notary, and that the notary’s certification on the last page applies to the entire affidavit; (ii) Mr. Downes’

signature appears above his printed name at the end of his written statement and at the bottom of each exhibit page attached to the affidavit; and (iii) each exhibit is individually described in the body of the affidavit and assigned a unique letter for identification, as well as effectively dated and affirmed.

[22] In the present cases, I agree with the Owner that the affidavit contains indications of how, where and when it was sworn. Indeed, the preamble of the affidavit includes a statement that Mr. Downes “solemnly affirmed” his affidavit before a Notary Public in the City of Berlin, Germany. Furthermore, the last page of the affidavit is dated November 18, 2020 and the notary public’s stamp appears on such page, including a statement that “Mr. Downes is known” to the notary as well as a statement that the notary certifies that “the preceding signatures which are acknowledged in [his] presence on the 18th of November 2020 are the true signatures, of Mr. Robert Michael Downes...”.

[23] As such, I see no reason to revisit the Registrar’s decision to make the subject affidavit of record in each of these proceedings [for a similar conclusion, see *Portage World-Wide, Inc. v Croton Watch Co., Inc.*, 2017 TMOB 96 at paras 10-15].

Use of the Mark in association with the Registered Goods

[24] The Requesting Party argues that the evidence is insufficient to show sales in the normal course of trade as required by the Act. In particular, it argues that the Owner filed a single invoice, and that Mr. Downes does not explain whether there were additional sales during the relevant period or whether sales were made by Roxon to end consumers, nor does he provide any factual particulars regarding sales such as sales figures or quantities of units sold. In addition, the Requesting Party characterizes Mr. Downes’ statements at paragraph 14 of his affidavit as “bald assertions” and submits that there is no evidence from which to conclude that the invoiced goods referenced at that paragraph actually correspond to the registered goods. Lastly, the Requesting Party submits that the trademark displayed in the evidence is not the Mark as registered, but rather the “composite mark” VITAGUARD VG 3100.

[25] I note that, even evidence of a single sale can be sufficient to establish use for the purpose of section 45, so long as it follows the pattern of a genuine commercial transaction and is not seen as being deliberately manufactured or contrived to protect the registration [see *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD) at 293]. Moreover, there is no requirement that a trademark owner show sales to end consumers, as sales anywhere along the chain of distribution can be considered in the normal course of trade and, if any part of the chain takes place in Canada, such sales are considered to be use in Canada [*LIN Trading Co v CBM Kabushiki Kaisha*, 1988 CanLII 9341, 21 CPR (3d) 417 (FCA)].

[26] As noted above, the evidence before me includes two representative invoices issued by the Owner to Roxon, the Owner's distributor in Canada. The invoices show sales of the VITAGUARD VG 3100 Monitor accompanied by user manuals. Having regard to the evidence as a whole, including Mr. Downes' statement that the invoiced monitor is part of a particular model of the registered goods, I am satisfied that the exhibited invoices show sales of the registered goods by the Owner in its normal course of trade.

[27] I am also satisfied that the Mark was displayed on the registered goods at the time of transfer, despite the additional term "VG 3100" displayed in smaller font, below the Mark.

[28] In this regard, use of a trademark in combination with additional words or features will be considered use of the mark as registered when the public, as a matter of first impression, would perceive the mark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); see also *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)]. This is a question of fact which is dependent on whether the mark stands out from the additional material, for example, by the use of different lettering or sizing, or whether the additional material would be perceived as clearly descriptive or as a separate trademark or tradename. Although not necessarily determinative, the placement of trademark or registration symbols may also

be a relevant factor to consider [see *Rogers, Bereskin & Parr v Canada (Registrar of Trade Marks)* (1986), 9 CPR (3d) 260 (FCTD)].

[29] Considering that the Mark is displayed above the term “VG 3100” and in larger font, and also considering that the registration symbol is placed immediately following the Mark, I find that the Mark is preserved in its entirety and stands out from the additional material such as the VITAGUARD VG 3100 Monitor displays the Mark *per se*.

[30] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods “Medical devices, namely monitors for monitoring heart rate, respiration, pulse rate, arterial oxygen saturation and other physiological parameters” within the meaning of sections 4(1) and 45 of the Act.

DISPOSITION

[31] Pursuant to the authority delegated to me under section 63(3) of the Act, and in compliance with the provisions of section 45 of the Act, both registrations will be maintained.

Yves Cozien Papa Tchoufou
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2022-07-14

APPEARANCES

For the Requesting Party: No one appearing

For the Registered Owner: Reagan Seidler

AGENTS OF RECORD

For the Requesting Party: Fasken Martineau DuMoulin LLP

For the Registered Owner: Smart & Biggar LLP