



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

Citation: 2013 TMOB 187
Date of Decision: 2013-10-30

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by McMillan LLP against registration
No. TMA630,150 for the trade-mark NEOGEN in the
name of Neogen Corporation**

[1] At the request of McMillan 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 March 25, 2011 to Neogen Corporation (the Registrant), the registered owner of registration No. TMA630,150 for the trade-mark NEOGEN (the Mark).

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

- (1) Enzyme-linked immunosorbent assay test kits for the detection of drugs, drug metabolites, antibiotics, hormones and toxins in animal urine, animal serum and animal tissue.
- (2) Diagnostic kits comprising biological or chemical reagents for detecting microorganisms or chemicals in various environments.
- (3) Animal vaccines.
- (4) Instruments in the nature of belt press simulators, monitors, sensors, and meters for detecting chemicals, microorganisms and environmental conditions in various environments.
- (5) Cosmetics, toiletries and skin care products, namely skin and facial creams and lotions, hair and skin conditioners, shampoos, skin and facial cleansing agents.

[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 wares and services 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 use since that date. In this case, the relevant period for showing use is between March 25, 2008 and March 25, 2011.

[4] The relevant definition of “use” is set out in section 4(1) of the Act:

4(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares 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 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 and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[6] In response to the Registrar’s notice, the Registrant furnished the affidavit of Jason Lilly, Director - Corporate Development of the Registrant, sworn on September 26, 2011. Only the Requesting Party filed written representations; an oral hearing was not held.

[7] Based on the furnished evidence, it would appear that the Registrant is a Michigan-based company specializing in the manufacture and sale of food safety and animal safety products such as diagnostic kits and vaccines. Nonetheless, with respect to wares (5) and “instruments in the nature of belt press simulators, monitors, sensors” from wares (4), Mr. Lilly states in his affidavit that “no evidence is being submitted of sales in Canada” and that the Registrant “is agreeable to the deletion of these goods from the registration”. The registration will be amended accordingly.

[8] With respect to the remaining wares, Mr. Lilly attests that the Registrant “enjoyed continuous sales of the subject wares, marked with the trade-mark NEOGEN, in its normal course of trade to Canadian customers throughout the relevant period.” In support, Mr. Lilly provides the exhibits described below.

[9] With respect to the “test kits” set out in wares (1), Mr. Lilly provides Exhibits A and H as evidence of the manner in which the Mark was used in Canada during the relevant period. Exhibit A consists in part of specimen labels applied to “enzyme-linked immunosorbent assay test

kits”, which Mr. Lilly explains are commonly referred to in the trade as “ELISA kits”. Also included in Exhibit A is a related brochure which Mr. Lilly attests was distributed to customers and potential customers in 2010. Mr. Lilly states that the labels are representative of the labelling used on the ELISA kits sold in Canada during the relevant period. I note that the Mark appears on the labels as well as in the depictions of the kits shown in the brochure.

[10] Exhibit H consists of a two-page price list for ELISA kits dated March 1, 2011. Mr. Lilly attests that the price list is representative of the price lists distributed by the Registrant during the relevant period to customers and potential customers. Mr. Lilly notes that the product codes appearing on the price list correspond with the ELISA kits represented in Exhibit A. I note that the Mark appears at the top of the first page and that a phone number for Canadian customers is displayed at the bottom of the second page.

[11] With respect to the “diagnostic kits” set out in wares (2), Mr. Lilly provides Exhibit B, which consists of specimens of labels for “*Listeria* diagnostic kits” and an excerpt from the Registrant’s order catalogue entitled “Food Safety Diagnostic Tests”. As above, Mr. Lilly attests that the labels are representative of labels applied to various diagnostic kits sold by the Registrant in Canada during the relevant period. Mr. Lilly also attests that the catalogue excerpt is representative of catalogues distributed in 2008 and 2009. He explains that the catalogues contain various depictions of the kits as they would have appeared to customers at the time of sale. I note that the Mark is prominently displayed on the kit labels as well as in the depictions of labelling and packaging shown in the Registrant’s catalogue.

[12] With respect to the “animal vaccines” set out in wares (3), Mr. Lilly provides Exhibit C, which consists of a sample label for the Registrant’s “BotVax® B” animal vaccine and a copy of the Registrant’s informational brochure regarding that vaccine. Mr. Lilly explains that the Registrant’s animal vaccines are controlled and restricted products and only ordered by licensed practitioners directly from the Registrant or from the Registrant’s sales representatives. He attests that the exhibited label is representative of labels applied to various animal vaccines sold by the Registrant in Canada during the relevant period. As above, I note that the Mark is prominently displayed on the labels as well as in the depictions of labelled vaccine bottles in the brochure.

[13] With respect to “instruments in the nature of . . . meters for detecting chemicals, microorganisms and environmental conditions in various environments” as set out in wares (4), Mr. Lilly provides Exhibit D as evidence of the manner in which the Mark was used in Canada during the relevant period. Exhibit D includes specimens of the packaging for the Registrant’s “AccuPoint 2” detection meters as well as specimen box labels for test media used in the Registrant’s “Soleris” detection meters. Also included in Exhibit D are copies of User Guides for two of the Registrant’s “Accupoint” detection meters. Mr. Lilly attests that the exhibits are representative of the labeling, packaging and supporting documentation used and distributed by the Registrant in the normal course of trade in Canada during the relevant period. I note that the Mark is prominently displayed on the labels and packaging and throughout the User Guides.

[14] As evidence with respect to one of the means by which the Registrant sells its products in Canada, Mr. Lilly provides Exhibit E, which consists of a printout from the Registrant’s website and a copy of the Registrant’s 16-page online order form. Mr. Lilly explains that the Registrant’s website contains links to their various products and instructions on how to order the products. He attests that the Registrant’s website and the information contained on the website were accessible to Canadians during the relevant period. I note that the Mark is prominently displayed on the website printout and on the sample online order form.

[15] As to actual sales by the Registrant in Canada during the relevant period, Mr. Lilly attaches a chart at Exhibit F to his affidavit, providing annual Canadian sales figures relating to each of the evidenced wares for 2008, 2009 and 2010. I note, for example, that total sales in 2010 by the Registrant with respect to the evidenced wares were just under \$1 million.

[16] In further support, Exhibit G consists of copies of numerous invoices, which Mr. Lilly attests are representative of invoices documenting sales in Canada during the relevant period. I note that the invoices are from the Registrant to various companies in Canada dated within the relevant period and include evidence of sales for each of wares (1), (2) and (3) as well as “meters” from wares (4).

[17] In view of the foregoing, I am satisfied that the Registrant has demonstrated use of the Mark in association with wares (1), (2), (3) and the following from wares (4): “instruments in the

nature of meters for detecting chemicals, microorganisms and environmental conditions in various environments”, within the meaning of sections 4 and 45 of the Act.

Disposition

[18] Accordingly, 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, the registration will be amended to delete wares (5) and “belt press simulators, monitors, sensors” from wares (4).

[19] The amended statement of wares will read as follows:

- (1) Enzyme-linked immunosorbent assay test kits for the detection of drugs, drug metabolites, antibiotics, hormones and toxins in animal urine, animal serum and animal tissue.
- (2) Diagnostic kits comprising biological or chemical reagents for detecting microorganisms or chemicals in various environments.
- (3) Animal vaccines.
- (4) Instruments in the nature of meters for detecting chemicals, microorganisms and environmental conditions in various environments.

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