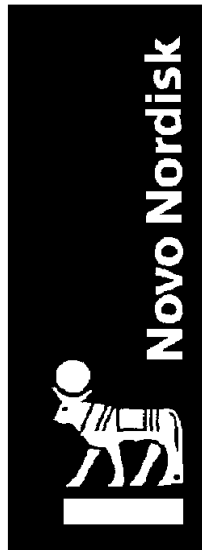


SECTION 45 PROCEEDINGS
TRADE-MARK: NOVO NORDISK & DESIGN
REGISTRATION NO.: 448,987

On March 13, 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 registered trade-mark is reproduced below:



The Apis bull is light blue; the words NOVO NORDISK and the bar beneath the Apis bull are white and the background is dark blue. Colour is claimed as a feature of the mark.

When the notice issued the trade-mark registration covered the following wares:

“Enzymes for use in the detergents, foodstuffs, soft drinks, bakery, brewery, paper mill and tanning industries; pharmaceutical preparations, namely insulin, growth hormone, gynaecological and haematological preparations; pharmaceutical auxiliaries, namely, syringes and medical measuring equipment, namely blood testing instruments and apparatus; instruments and apparatus for measuring insulin; instruments and apparatus for

measuring growth and sex hormone concentrations in blood and urine; pesticides.”

However, on July 16, 2003 the following wares were deleted from the statement of wares pursuant to subsection 41(1)(c) of the Trade-marks Act:

“Enzymes for use in the detergents, foodstuffs, soft drinks, bakery, brewery, paper mill and tanning industries”.

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 13, 2000 and March 13, 2003 and the registrant must show use of the trade-mark in association with the wares that have remained on the register namely “pharmaceutical preparations, namely insulin, growth hormone, gynaecological and haematological preparations; pharmaceutical auxiliaries, namely, syringes and medical measuring equipment, namely blood testing instruments and apparatus; instruments and apparatus for measuring insulin; instruments and apparatus for measuring growth and sex hormone concentrations in blood and urine; pesticides.”

In response to the notice, the affidavit of Alan Davis has been furnished. Each party filed a written argument. The requesting party alone was represented at the oral hearing.

In his affidavit, Mr. Davis states that he is Director of Medical and Scientific Affairs of Novo Nordisk Canada Inc. (a subsidiary of the registrant company), and that he has knowledge of the matters to which he deposes save where stated to be on information and belief. He indicates that the registrant, headquartered in Denmark, has the broadest diabetes product portfolio in the industry, including the most advanced products within the area of Insulin Delivery Devices. He adds that it has a leading position within areas such as coagulation disorders, growth disorders and hormone replacement therapies. He specifies that all anti-diabetic preparations, coagulation disorder products and hormone replacement therapy products sold by his company are either manufactured by the registrant in Denmark or outside Denmark for the registrant.

He explains that the Canadian distributor of the anti-diabetic preparations, coagulation disorder products and hormone replacement therapy products is Avantis Pasteur of North York, Ontario. The distributor takes orders from his company's customers, which include wholesalers, pharmacy chains and hospital across Canada. The distributor ships the products ordered using a regulated cold chain specialist shipping company.

He indicates that many of the products are sold bearing the trade-mark NOVO NORDISK & Design. As Exhibit A he provides sample packaging and a package insert; as Exhibit B he submits sample advertising and promotional literature; as Exhibit C he provides a summary of the sales figures for 2000, 2001 and 2002 associated with the NOVO NORDISK & Design products. As Exhibit D he attaches copies of the distributor's invoices which he states evidence sales of the NOVO NORDISK & Design products; and as Exhibit E he provides a summary of

the advertising and promotional expenditures for 2000 and 2001 associated with the NOVO NORDISK & Design products.

The requesting party's main arguments concerning the evidence furnished are summarized as follows:

There is absolutely no evidence of use concerning the wares "gynaecological preparations; pharmaceutical auxiliaries namely syringes and medical equipment namely blood testing instruments and apparatus; instruments and apparatus for measuring insulin; instruments and apparatus for measuring growth and sex hormone concentrations in blood and urine; and pesticides", accordingly it submits that these wares ought to be deleted from the registration.

Concerning the remaining wares, it submits that the evidence completely fails to show that the trade-mark as registered has been used in association with such wares.

Having considered the evidence, I conclude that it is completely silent concerning the wares "gynaecological preparations; medical measuring equipment namely blood testing instruments and apparatus; instruments and apparatus for measuring growth and sex hormone concentrations in blood and urine; and pesticides". Consequently, I conclude that use of the trade-mark has not been shown in association with these wares and that they ought to be deleted from the trade-mark registration.

As for the registered wares "insulin, growth hormone, haematological preparations; pharmaceutical auxiliaries namely syringes; and instruments and apparatus for measuring insulin", I find the evidence unclear as to whether each of these wares were sold in association with the trade-mark in the manner required by subsection 4(1) of the Trade-marks Act during the

relevant period. I note that nowhere in the affidavit has Mr. Davis clearly specified that each of these wares were sold in Canada in association with the trade-mark during the relevant period.

Rather, he makes reference to “anti-diabetic preparations, coagulation disorder products and hormone replacement therapy products” and concerning the trade-mark he indicates that many of the registrant’s products were sold bearing the trade-mark. As it seems not all of the registrant’s products bear the trade-mark and as Mr. Davis has not specified which particular products bore the trade-mark, I will rely on the packaging and the package insert furnished in evidence and I will have regard to the advertising material depicting some of the wares and their packaging in order to conclude which particular products are associated with the trade-mark in a manner complying with subsection 4(1) of the Act and then I will have regard to the invoices to determine if these particular products were sold during the relevant period.

I am satisfied that sample packaging have been furnished for the wares “insulin” which product is identified as the “NOVORAPID®” product”, and for “insulin, syringes and/or instruments and apparatus for measuring insulin, and needles” which product is identified as the “NOVOLIN-PEN ® 3 SYSTEM™” product. A package insert has been submitted for the wares “haematological preparations” which product is identified as the “NIASTASE®” product.

Photographs of packaging for “insulin and syringes” and depictions of some of the wares namely “syringes and instruments and apparatus for measuring insulin” appear in the promotional and advertising material.

The requesting party has submitted that none of the wares and none of the packaging bears the

trade-mark as registered. At paragraphs 16, 17, 18 and 19 of its written argument it argues as follows:

16. The first sample in Exhibit A is a copy of what appears to be the packaging for a NOVOLIN-PEN ® 3 Dial-a-dose insulin delivery device. This packaging does not identify the contents as being for anti-diabetic preparations, coagulation disorder products and hormone replacement therapy products, or any other of the Wares. In any event, the packaging depicts a logo containing the representation of an apis bull and the words NOVO NORDISK in dark font on a white or light coloured background. It is impossible to tell from the photocopies contained in Exhibit A the colours in which the trademark is depicted on the original packaging. Nevertheless, it is obvious the elements of the design mark are not depicted in light blue (bull) and white (text) on a dark blue background as claimed in the Registration.

17. The second sample in Exhibit A is packaging for a product bearing the trade-mark NIASTASE. This packaging depicts a logo containing the representation of an apis bull and the words NOVO NORDISK; however, these trademark elements appear in dark font on a white or light coloured background. Again, it is impossible to tell from the photocopies contained in Exhibit A the colours in which the trade-mark is depicted on the original packaging. But it is obvious the elements of the design mark are not depicted in light blue (bull) and white (text) on a dark blue background as claimed in the Registration.

18. The third sample in Exhibit A is packaging for NOVORAPID insulin aspart. The logo on this packaging is a representation of an apis bull standing above the words NOVO NORDISK. This logo differs from the registered trade-mark in that the words NOVO NORDISK are rotated 90 degrees and are positioned below the bull instead of above the bull. The white bar depicted below the bull in the registered trade-mark is absent from the logo shown on the packaging.

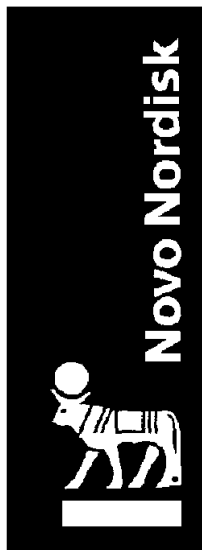
19. Exhibit B is introduced as sample advertising and promotional literature displaying the trade-mark. First, use in advertising of wares is not use within the meaning of s.4 of the Act. Second, there is nothing to indicate when or how this material was distributed in Canada, if at all. The specimen of advertising material, while not demonstrating use of the trade-mark for the Wares, may be an indication of how the trade-mark is depicted in the ordinary course of trade. In the samples in Exhibit "B" only the words NOVO NORDISK appear on the advertising materials. The image of the apis bull is not depicted. The absence of the representation of the bull from the trade-mark is a major alteration which significantly alters the appearance of the trade-mark from that which was the subject of the registration.

Concerning the advertising and promotional literature furnished as Exhibit B, although I agree

that use of the trade-mark on the advertising and promotional material is not use complying with Section 4(1) of the Act, I also agree that when the wares and/or their packaging are depicted in such material, this may provide an indication of the manner the trade-mark is affixed to the wares or their packaging in the normal course of trade. Here, I agree with the requesting party that only the words NOVO NORDISK without the representation of the bull appears on some wares/packaging displayed. As I am of the view that the apis bull is a dominant and essential component of the registered trade-mark I conclude that the use of NOVO NORDISK without the representation of the bull does not constitute use of the registered trade-mark.

Concerning the sample packaging and insert furnished as Exhibit A, I agree with the requesting party that none bear the trade-mark exactly in the form as registered. The issue is whether the differences are such as to not constitute use of the registered trade-mark.

I reproduce below the trade-mark as registered:



COLOUR CLAIM: "The apis bull is light blue; the words NOVO NORDISK and the bar beneath the apis bull are white

and the background is dark blue”.

I reproduce below the trade-mark as used:

The packaging for the NOVOLIN-PEN® 3 SYSTEM™ product (comprising insulin, a syringe and/or instrument and apparatus for measuring insulin, and needles), and the packaging for the “NIASTASE®” product (i.e. a haematological preparation) bear the trade-mark as follows:

The packaging for the NOVORAPID® product (i.e. insulin) bears the trade-mark as follows:

Relying on the principles enunciated in *Nightingale Interloc Ltd. v. Prodesign Ltd.*, 2 C.P.R.(3d) 535, *Registrar of Trade-Marks v. Compagnie Internationale pour l'Informatique CII Honeywell Bull S.A.* (1985), 4 C.P.R.(3d) 523 (FCA) and *Promafil Canada Ltée v. Munsingwear Inc.*, 44 C.P.R.(3d) 59 (FCA), I consider the different variations of the trade-mark as used to consist of minor variations of the registered trade-mark. I cannot agree with the requesting party that the changes to the trade-mark are substantial. Rather, I am of the view that each trade-mark as used differs from the trade-mark as registered only in petty details. In this regard I find that the dominant and essential elements of the registered trade-mark are the “apis bull” and the words “NOVO NORDISK”. As these elements have been preserved in each trade-mark as used, I conclude that the trade-mark remains recognizable and that it has not lost its identity and that the different variations are not apt to mislead or deceive the public in any way. Further, I consider the fact that the trade-mark is not used in the colour as claimed to be of minor importance in this case. In view of the above, I conclude that each of the trade-marks shown on the sample packaging and insert reproduced above constitutes use of the registered trade-mark.

The next issue is whether the evidence shows sales during the relevant period of the products identified as “NOVOLIN-PEN ® 3 SYSTEM™”, “NIASTASE®” and “NOVORAPID®” referred to above.

I have to agree with the requesting party that none of the invoices refer to a sale of the “NOVOLIN- PEN ® 3 SYSTEM™” product or the “NIASTASE ®” product. However, the invoice dated September 4, 2002 refers to the sale of “NOVORAPID®” which I accept is a

reference to the sale of “insulin” associated with the trade-mark “NOVORAPID®” which product would probably have been sold in the type of packaging provided in exhibit A and which packaging I have concluded bears a trade-mark that constitutes use of the registered trade-mark. As the sale appears to have been made in the registrant’s normal course of trade, I conclude that the evidence is sufficient to permit me to conclude that the wares “ insulin” were sold in Canada in association with the trade-mark during the relevant period.

As the evidence permits me to conclude that only the wares “insulin” were sold in Canada during the relevant period in association with the trade-mark, I conclude that only the wares “pharmaceutical preparations namely insulin” ought to be maintained on the trade-mark registration.

Registration No. 448,987 will be amended accordingly in compliance with the provisions of Section 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 29TH DAY OF APRIL 2005.

D. Savard
Senior Hearing Officer
Section 45 Division