



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

Citation: 2010 TMOB 88
Date of Decision: 2010-06-18

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Riches, McKenzie & Herbert LLP against
registration No. TMA536,312 for the trade-mark ACRI-
LENS & Design in the name of I-Med Pharma Inc.**

[1] At the request of Riches, McKenzie & Herbert LLP (the Requesting Party), the Registrar of Trade-marks forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on September 11, 2007 to I-Med Pharma Inc. (the Registrant), the registered owner of the above-referenced trade-mark.

[2] The trade-mark ACRI-LENS & Design (the Mark), shown below, is registered for use in association with “intraocular lens for eye surgery” (the Registered Wares).

The logo for 'acri-lens' is written in a bold, cursive script. The letters are lowercase and connected. The 'i' in 'acri' has a small dot above it. The 'l' in 'lens' is tall and thin. The overall style is elegant and professional.

[3] Section 45 of the Act requires the registered owner to show whether the trade-mark has been used in Canada in association with each of the wares or 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 such use since that date. In this case, the relevant period for showing use is any time between September 11, 2004 and September 11, 2007 (the relevant period).

[4] “Use” in association with wares is set out in s. 4(1) and 4(3) 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.

[...]

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

[5] In response to the Registrar's notice, the Registrant furnished the affidavit of Ilan Hofmann, sworn on March 11, 2008, together with Exhibits "IH-1" through "IH-3". Mr. Hofmann states that he is the president and secretary of the Registrant. Only the Requesting Party filed written submissions; an oral hearing was not requested.

[6] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of s. 45 proceedings [*Plough (Canada) Ltd v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62 (F.C.A.)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd. v. Lang Michener* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.) at 480], and evidentiary overkill is not required [*Union Electric Supply Co. Ltd. v. Registrar of Trade Marks* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the wares or services specified in the registration during the relevant period.

[7] The Registrant has provided evidence related to export of the Registered Wares and therefore this is a situation to which s. 4(3) of the Act applies. Section 4(3) of the Act requires:

- a) that the trade-mark be marked in Canada
- b) on the wares or the packaging, and
- c) that the wares be exported from Canada.

While there is no requirement to show that the export sale occurred in the normal course of trade, a commercial transaction must be established [*Molson Cos. v. Moosehead Breweries Ltd.* (1990), 32 C.P.R. (3d) 363 (F.C.T.D.)].

[8] Mr. Hofmann explains that the Registrant is in the business of manufacturing and distributing ophthalmic products related to cataract and refractive surgery, including intraocular lenses used for human and veterinary surgery; it distributes and exports the ophthalmic products to Asia, Europe, South America, the Caribbean, the United States and the Middle East. The affiant further provides that “outside Canada, all ophthalmic products are distributed by local distributors”.

[9] With respect to the manner in which the Mark was associated with the wares, Mr. Hofmann states that during the relevant period, each intraocular lens for eye surgery sold and exported from Canada was packaged in Canada and bore the Mark. In support, a photograph of a representative sample card box in which the Registered Wares were packaged before export is attached as Exhibit “IH-1”. The affiant adds that the Mark is clearly visible on the card box and that it “represents the marking usually used during the Relevant Period”. I note that the Mark appears prominently on the card box followed by a TM indicia on the upper right hand corner.

[10] The Requesting Party contends that the photograph of the packaging produced as Exhibit “IH-1” “merely establishes that the packaging was printed in Canada on behalf of I-Med Pharma Inc.” and that it “does not support the affiant’s assertion [...] that each product sold by [the Registrant] and exported from Canada is packaged in Canada.” It is clear that the photograph does not purport to show the Registrant’s step-by-step process of packaging intraocular lenses into card boxes in Canada; it simply supports Mr. Hofmann’s statements that the card boxes in which the Registered Wares were packaged before they were exported bore the Mark.

[11] When the evidence is considered in its entirety, in particular Mr. Hofmann’s unequivocal statements regarding the Registrant’s business processes and the manner in which the Mark was associated with the intraocular lenses before export (corroborated by the photograph of the representative packaging in question), I am satisfied that the Mark was marked on the packages which contained the Registered Wares before they were exported from Canada.

[12] With respect to the nature of these exports, Mr. Hofmann attaches copies of invoices issued during the relevant period by the Registrant as Exhibit “IH-2”, representative of sales of the Registered Wares exported from Canada. I note that the invoices are dated between January 2005 and January 2007; they bear the Registrant’s name and contact information in Canada, as

well as the customer's name, billing and shipping addresses in different parts of the world (i.e. Czech Republic, Jamaica, Mexico and the United States). In addition to the quantity shipped, the notation "ACRI-LENS" can be seen in the detailed descriptions of the items sold in several of the sample invoices provided.

[13] The Requesting Party argues that "while these invoices merely establish that sales made during the relevant time to end consumers, they do not establish that the products, marked with the trade-mark ACRI-LENS & Design, were shipped from Canada in the marked packages to the Registrant's distributors, supporting use of the trade mark by export". As discussed earlier, the affiant's statements supported by the photograph of the representative card box attached as Exhibit "IH-1" have already established that the Registered Wares were shipped from Canada in packages bearing the Mark.

[14] Second, the question of whether the purchasers identified in the sample invoices were "end consumers" or "local distributors" is of no consequence to the fact that the Registrant has provided evidence of numerous commercial transactions which involved the export sales of the Registered Wares from Canada to third parties in other parts of the world. As explained in the *Molson Cos.* case, the words "exported from Canada" must be taken to mean "sent from Canada to another country in the way of commerce", or "transported from Canada to another country in the course of trade". While it might have been of interest to understand the role of these purchasers in the chain of commercial transactions, the invoices are nevertheless illustrative of sales and shipments of the Registered Wares by the Registrant from Canada to a third party in another country in the way of commerce during the relevant period.

[15] Finally, the Requesting Party alleges that the wares identified in two of the sample invoices were shipped from other parts of the world instead of Canada, based on its understanding of information that did not form part of the Registrant's evidence. As the Registrant is the only party allowed to file evidence in this proceeding, I am not taking this information into consideration. In any event, Mr. Hofmann has provided other sample invoices that clearly corroborate his statements regarding the sale and the export of the Registered Wares by the Registrant from Canada during the relevant period. On a fair reading of Mr. Hofmann's statements as well as the information available on the sample invoices provided, I am satisfied

that the Registrant exported the Registered Wares from Canada to other countries in the course of trade during the relevant period.

[16] In view of the foregoing, I am satisfied that there was use of the Mark within the meaning of s. 45 and 4(3) of the Act on “intraocular lens for eye surgery” during the relevant period.

Accordingly, and pursuant to the authority delegated to me under s. 63(3) of the Act, registration TMA536,312 for the trade-mark ACRI-LENS & Design will be maintained in compliance with the provisions of s. 45 of the Act.

P. Fung
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office