



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

Citation: 2016 TMOB 197
Date of Decision: 2016-12-28

IN THE MATTER OF A SECTION 45 PROCEEDING

MediPurpose Ptc. Ltd

Requesting Party

and

Bemis Company, Inc.

Registered Owner

TMA378,242 for MEDI-PLUS

Registration

[1] At the request of MediPurpose Ptc. Ltd (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 July 16, 2014 to Curwood, Inc. (the Owner), the registered owner at that time of registration No. TMA378,242 for the trade-mark MEDI-PLUS (the Mark).

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

- (1) Disposable medical sterilization pouches and tubing.
- (2) Disposable test packs.

[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 goods 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 the trade-mark was last used, and the reason for the absence of such use since that date. In this case, the relevant period for showing use is between July 16, 2011, and July 16, 2014.

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

4(1) A trade-mark 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 whom the property or possession is transferred.

[5] It is well established that mere assertions of 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 section 45 proceedings is quite 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 trade-mark in association with each of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainer Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)].

[6] In response to the notice, the Owner furnished the affidavit of Thomas R. Pech, Jr., sworn on February 12, 2015 in Oshkosh, Wisconsin. Only the Requesting Party filed written representations; a hearing was not requested.

[7] On May 6, 2015, the Registrar recorded Bemis Company, Inc. as the registered owner of the Mark. That change is not at issue in this proceeding.

The Owner’s Evidence

[8] In his brief affidavit, Mr. Pech identifies himself as an employee of Bemis Healthcare Packaging, Inc. (BHPI). According to Mr. Pech, the Owner and BHPI are both wholly-owned subsidiaries of Bemis Company, Inc.

[9] In support of his assertion that he “verily believe[s] that the mark has been in continuous use in Canada in the normal course of trade in association with the goods during the relevant period”, Mr. Pech attaches two exhibits to his affidavit.

[10] Exhibit A consists of 11 invoices, which Mr. Pech attests are “exemplary invoices for the goods sold in Canada during the relevant period”. The invoices include a reference to a “MediPlus House Account” in the “Sales Representative” field of a table near the top of the invoices, alongside the invoice number, payment terms, and billing and shipping dates. The invoices are all dated within the relevant period and appear to be for customers located in various Canadian cities. However, as the customers’ names and addresses are mostly redacted, the invoices do not show whether the billing and shipping destinations for each customer are the same. I note that the invoices contain the statements “Sold By Bemis Healthcare Packaging, Inc.” and “Payments to: BEMIS HEALTHCARE PACKAGING, INC.” In addition, “BEMIS®” appears in large print in the upper left corner of each invoice. There is no reference to the Owner on the exhibited invoices.

[11] Exhibit B consists of six documents, which Mr. Pech attests are “sample sell sheets distributed in Canada during the relevant period”. The Mark appears at the top of each sheet, above “BEMIS” and the name and address for “Bemis Healthcare Packaging”. The bottom of each sheet indicates “Revised 14 June 2014”. Each sheet includes a general description of “Medi-Plus® brand sterilization packaging”, said to be “manufactured by Bemis Healthcare Packaging the largest manufacturer of medical grade pouches in the world”. Again, there is no reference to the Owner on the exhibited sell sheets.

[12] Each sell sheet also contains a description of the specific product advertised in the sheet, along with a list of product numbers, some of which are reflected in the invoices attached as Exhibit A. Some of the sell sheets also incorporate an image of the product, although only two of those images show the Mark on the product. Of the sell sheets incorporating product images, I note the following in particular:

- The sheet titled “Medi-Plus® Pre-Folded Self Seal Pouches” depicts a pair of pouches. The Mark is visible on one of them. I note that one of the product numbers on this sheet also appears in connection with the product description “Medi-Plus SS” on exhibited invoice 90280668.

- The sheet titled “Medi-Plus® Heat Seal Pouches” depicts boxes of various sizes. The Mark is visible on each box. However, the product numbers on this sheet do not appear in any of the exhibited invoices.
- The sheet titled “Medi-Plus® Tubing” depicts two rolls of tubing. Unfortunately, the picture is of low quality and it is not clear whether the Mark appears on either depicted roll. In any event, I note that the product numbers on this sheet do not appear in any of the exhibited invoices.

[13] Finally, I note that there is another sell sheet for a “tubing” product, titled “Medi-Oxide® Tyvek® Tubing”. However, although this sell sheet lists product numbers that appear in the exhibited invoices, it does not incorporate a product image. Thus, I am unable to determine whether the Mark is visible on the product.

Analysis

[14] At the outset, I note that none of the invoices or sell sheets reference registered good (2), “disposable test packs”. Thus, there is neither any evidence of the Mark being displayed on or otherwise associated with such goods nor any evidence of such goods being sold or otherwise transferred in Canada during the relevant period. Since there is also no evidence before me of special circumstances excusing non-use of the Mark, the registered goods “disposable test packs” will be deleted from the registration.

[15] With respect to the remaining goods, the Requesting Party makes numerous submissions regarding alleged insufficiencies in the evidence furnished. In particular, the Requesting Party submits that the evidence does not show transfers of the registered goods and does not show display of the Mark in association with any goods at the time of transfer. In any event, the Requesting Party submits that the evidence does not demonstrate any use of the Mark that would enure to the Owner’s benefit.

Transfers of the Registered Goods

[16] With respect to transfers of the registered goods, the Requesting Party submits that it is unclear whether the product numbers and short product descriptions in the exhibited invoices refer to the registered goods.

[17] However, when the invoices are read in conjunction with the sell sheets, I note that all but one of the product numbers on the invoices appear in the sell sheets, as explained above. Since those sell sheets advertise pouches and tubing described as “sterilization packaging” that is “medical grade”, I accept that the evidence shows transfers of registered goods (1), “disposable medical sterilization pouches and tubing”, in Canada during the relevant period.

Display of the Mark

[18] With respect to display of the Mark in association with such transferred goods, the Requesting Party notes that Mr. Pech did not state in his affidavit that the Mark was displayed on any of the goods sold or on their packaging.

[19] However, as noted above, one of the sell sheets distributed in Canada, titled “Medi-Plus® Pre-Folded Self Seal Pouches”, depicts the Mark displayed on such a pouch. Furthermore, the product numbers on that sell sheet also appear in three of the exhibited invoices, including invoice 90280668, which lists the product as “Medi-Plus SS”. When the evidence is viewed in its entirety, I accept that the Mark was displayed on “disposable medical sterilization pouches” sold in Canada in the normal course of trade during the relevant period.

[20] Conversely, none of the exhibited sell sheets depict the Mark on any tubing, despite the fact that the Mark appears on top of the sell sheets. The Federal Court of Appeal has held that display of a trade-mark on printed materials can only constitute use in association with goods if those materials accompanied the goods at the time of transfer in the normal course of trade [see *BMW Canada Inc v Nissan Canada Inc*, 2007 FCA 255, 60 CPR (4th) 181].

[21] In this case, there is no indication that the sell sheets were distributed at the time of sale or that they otherwise accompanied the goods at the time of any transfer. I am therefore not

prepared to find that distribution of the sell sheets as referred to by Mr. Pech constituted use of the Mark in Canada within the meaning of section 4(1) of the Act.

[22] Similarly, the display of a trade-mark on an invoice can only constitute use of that trade-mark within the meaning of the Act if the invoice accompanied the goods at the time of transfer [see *Gordon A MacEachern Ltd v National Rubber Co Ltd* (1963), 41 CPR 149 (Ex Ct); and *Riches, McKenzie & Herbert v Pepper King Ltd* (2000), 8 CPR (4th) 471 (FCTD)].

[23] In the present case, there is no indication that the exhibited invoices accompanied the goods when they were delivered. Indeed, in the absence of particulars from Mr. Pech and given the redactions to the billing and shipping destinations on the invoices, I am not prepared to infer that the individuals who received shipments of tubing would have received the corresponding invoice at the same time such that they would associate the Mark's appearance on the invoice with the goods themselves.

[24] In any event, the Mark does not appear in the product descriptions of the invoice entries for "tubing". Furthermore, in applying the principles set out by the Federal Court of Appeal in *Hortilux Schreder BV v Iwasaki Electric Co*, 2012 FCA 321, CarswellNat 4836] and by the Federal Court in *Tint King of California Inc v Canada (Registrar of Trade Marks)*, 2006 FC 1440, 56 CPR (4th) 223, I am not satisfied that the reference to a "MediPlus House Account" on these invoices constitutes display of a trade-mark in association with the invoiced goods.

[25] In this respect, I note that "MediPlus House Account" appears in a table containing shipping and payment particulars, whereas an unrelated trade-mark, "BEMIS®", appears far more prominently at the top of each invoice. In addition, in applying the principles set out by the Federal Court of Appeal in *Canada (Registrar of Trade Marks) v Cie International pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), I am not satisfied that the dominant features of the trade-mark as registered have been retained. Although a variation of the Mark appears within "MediPlus House Account", it is without trade-mark indicia and without otherwise being set aside from the surrounding text. As such, I am not satisfied that the exhibited invoices constitute display of the Mark as registered in association with "tubing".

[26] Thus, although I am satisfied that the Mark was displayed on “disposable medical sterilization pouches” sold in Canada during the relevant period, there is no evidence that the Mark appeared on or that notice was otherwise given of an association between the Mark and “disposable medical sterilization tubing”.

Use by the Owner

[27] The remaining question, however, is whether any such use of the Mark in association with “disposable medical sterilization pouches” enures to the benefit of the Owner. As noted by the Requesting Party, there is no reference to the Owner in any of the furnished exhibits. Indeed, issues of possible hearsay aside, Mr. Pech’s statement that he “verily believe[s] that the mark has been in continuous use in Canada in the normal course of trade” itself omits any identification of the entity that used the Mark.

[28] Based on the information contained in the exhibited invoices and sell sheets, any use of the Mark would appear to be by BHPI, with no reference to the Owner. In this respect, the exhibited invoices all indicate that the products are “Sold By Bemis Healthcare Packaging, Inc.” and the sell sheets refer to the products as being “manufactured by Bemis Healthcare Packaging”.

[29] Pursuant to section 50(1) of the Act, for BHPI’s use of the Mark to enure to the benefit of the Owner, the Owner must maintain “direct or indirect control of the character or quality of the goods” sold in association with the Mark under licence.

[30] As stated by the Federal Court, there are three main methods by which a trade-mark owner can demonstrate the requisite control pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of a licence agreement that provides for the requisite control [per *Empresa Cubana del Tabaco v Shapiro Cohen*, 2011 FC 102, 91 CPR (4th) 248]. Evidence of control by the owner of a registered trade-mark can in turn support the finding of a licence agreement [*Wells’ Dairy Inc v UL Canada Inc* (2000), 7 CPR (4th) 77 (FCTD)].

[31] In the present case, Mr. Pech neither alleges the existence of a licence nor asserts that any form of control was exerted by the Owner. Mr. Pech does state that BHPI and the Owner are both wholly-owned subsidiaries of the same parent, Bemis Company, Inc. However, even if I were to accept that this corporate relationship existed during the relevant period, the evidence does not indicate that, by virtue of this relationship, the Owner exercised – directly or indirectly – control over the character or quality of the goods sold in association with the Mark.

[32] In this regard, as submitted by the Requesting Party, I note that some jurisprudence has suggested that corporate structure alone is insufficient to establish the existence of a licensing arrangement within the meaning of section 50 of the Act, in the absence of evidence from which the requisite control may otherwise be inferred [see *MCI Communications Corp v MCI Multinet Communications Inc* (1995), 61 CPR (3d) 245 (TMOB); *Loblaws Inc v Tritap Food Broker* (1999), 3 CPR (4th) 108 (TMOB)]. In the present case, there is simply no information regarding any licensing agreement or control between these entities. Furthermore, there is also no evidence that BHPI was merely acting as the Owner's agent.

[33] The limited evidence furnished by the Owner is consistent with use of the Mark by BHPI absent the requisite control over the quality or character of the goods by the Owner. The Owner furnished an affidavit from an employee of BHPI, with evidence of promotion and sales by that company. The exhibited invoices and sell sheets all identify BHPI without any reference to the Owner. Furthermore, the evidence provides no context regarding the Owner's corporate relationship with BHPI and contains no other reference to the Owner whatsoever. Under the circumstances, I am not prepared to infer that any demonstrated use of the Mark by BHPI enures to the Owner's benefit.

[34] In view of foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered goods within the meaning of sections 4 and 45 of the Act.

[35] Furthermore, there is no evidence before me of special circumstances excusing non-use of the Mark.

Disposition

[36] 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 expunged.

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

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

MacRae & Co.

For the Registered Owner

Sander R. Gelsing

For the Requesting Party