



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

Citation: 2017 TMOB 151

Date of Decision: 2017-11-09

IN THE MATTER OF A SECTION 45 PROCEEDING

Currier & Kao LLP

Requesting Party

and

Lawtons Drug Stores Limited

Registered Owner

TMA471,310 for PROFILE

Registration

[1] This is a decision involving summary expungement proceedings with respect to registration No. TMA471,310 for the trade-mark PROFILE (the Mark), owned by Lawtons Drug Stores Limited.

[2] The Mark is currently registered in association with the following services:

Operation of a pharmacy; sale and delivery of prescription drugs including counselling regarding the choice of medication, drug usage and related information, and pharmaceutical services required; development and administration of prescription drug programs designed to process claims for medical services and products used by consumers; operation of retail stores for the sale or rental of health and home care products and the delivery of health and home care services inclusive of education, training and teaching (not including conducting training programs and developing skills in hiring, training, evaluating and promoting employees), caregiving, fitting and assembly directly or indirectly related to health and home care products or the general care and improvement to comfort and the quality of life for consumers; telephone sale, rental and delivery of health and home care products; operation of retail stores and telephone services for the sale of homeopathic medications, nutritional products, sports medicine products, video movies, cassette tapes, non-prescription drugs and medicated products, personal grooming, clothing and cosmetic products, baby products, food, confectionery goods, household and daily living products, books, magazines, stationery, office supplies, gifts, and jewellery and the delivery of homeopathy services and sports medicine services.

[3] For the reasons that follow, I conclude that the registration ought to be maintained in part.

THE PROCEEDINGS

[4] On September 16, 2015, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Lawtons Drug Stores Limited. (the Owner). The notice was sent at the request of Currier & Kao LLP.

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between September 16, 2012 and September 16, 2015, in association with each of the services specified in the registration. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[6] The relevant definition of use is set out in section 4(2) of the Act as follows:

4(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[7] 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 FC 448, 31 CPR (4th) 270].

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Janane Chater, sworn April 12, 2016, together with Exhibits A to K.

[9] Only the Owner filed written submissions. An oral hearing was not requested.

THE EVIDENCE

[10] Since July 2015, Ms. Chater has been the Manager of Multi-Format Marketing for the Sobeys National Pharmacy Group, of which the Owner forms part. For the period from 2011 to July 2015, she was the Director of Marketing and Corporate Communications for the Owner.

[11] Ms. Chater discloses that the Owner does not intend to provide evidence that the Mark had been used in Canada during the relevant period in respect of the following services:

Development and administration of prescription drug programs designed to process claims for medical services and products used by consumers; and

Operation of retail stores and telephone services for the sale of homeopathic medications, nutritional products, sports medicine products, video movies, cassette tapes, non-prescription drugs and medicated products, personal grooming, clothing and cosmetic products, baby products, food, confectionary goods, household and daily living products, books, magazines, stationery, office supplies, gifts, and jewellery and that delivery of homeopathy services and sports medicine services.

[12] The registration will be amended to delete the aforementioned services accordingly, in view of Ms. Chater's statement and the absence of any evidence of use or of special circumstances which would excuse the absence of use of the Mark in association with these services.

[13] With respect to the remaining registered services, Ms. Chater attests that the Owner has continuously used the Mark in association with such services throughout the relevant period. For ease of reference, these remaining services are as follows:

Operation of a pharmacy; sale and delivery of prescription drugs including counselling regarding the choice of medication, drug usage and related information, and pharmaceutical services required; operation of retail stores for the sale or rental of health and home care products and the delivery of health and home care services inclusive of education, training and teaching (not including conducting training programs and developing skills in hiring, training, evaluating and promoting employees), caregiving, fitting and assembly directly or indirectly related to health and home care products or the general care and improvement to comfort and the quality of life for consumers; and telephone sale, rental and delivery of health and home care products.

[14] Ms. Chater states that the Mark has been continuously used and promoted at all of the Owner's pharmacy locations across Atlantic Canada since 1997, and that, during the relevant period, there were approximately 78 such locations.

[15] As evidence of use of the Mark, Ms. Chater provides, as Exhibit B, five photographs of the Mark as displayed at the Owner's pharmacy location on Main Street in Dartmouth, Nova Scotia. She states that the photographs were taken on April 11, 2011, and that as of the date of her affidavit, the Mark remains in place as shown in the photographs. The photographs show the Mark on in-store signage and on posters which she states are used in stores having Home Health Care sections.

[16] Further to this, Ms. Chater attests that the Mark is prominently displayed on 55 different colour brochures printed by the Owner and distributed to the general public at all of the Owner's locations during the relevant period. She states that approximately 10,000 of those brochures were printed and distributed. She provides two examples of those brochures as follows:

Exhibit C – a brochure entitled “PROfile Services at the Pharmacy”, which describes and/or lists many of the services offered including: “Diabetes Care in Action” (diabetes education, information, and consultation, etc), “Pill Pack Plus” (medication administration scheduling assistance program), “AutoFill Plus” (prescription refill program), “FlavorRx™” (a medication flavour enhancement service), health and wellness education, information and consultation, flu shot administration, public education programs, long term care pharmacy services, assisted living pharmacy services, and drug plan management for small and large businesses. She states that the brochure was distributed to consumers at the Owner's locations from at least September 2012 to the present.

Exhibit D – a brochure entitled “PROfile Kids Club”, which advertises a service that helps children learn about their health and medications using activities, a calendar, and

informational brochures. Ms. Chater attests that the brochure was distributed to the general public visiting the Owner's locations from at least September 2012 to the present.

[17] In addition to the aforementioned, Ms. Chater provides copies of posters and a brochure (Exhibits E to K) which prominently display the Mark and advertise and promote a variety of services offered by the Owner, such as "Pill Pack Plus", "Diabetes Care in Action", "AutoFill Plus", "FlavorRx™", cholesterol and triglycerides testing services, and flu vaccine and other vaccine administration services. She provides specific dates with respect to the display at the Owner's locations for each poster, which range from August 2010 to February 2014, with most posters indicated to still be on display as of the date of her affidavit. With respect to the brochure, she states that it was created on February 4, 2014 and was distributed for approximately one month by attaching a copy to the shopping bag of every customer at the Owner's Portland Street, Dartmouth, Nova Scotia location.

[18] Lastly, Ms. Chater attests that from at least the beginning of September 2012 to the end of December 2014, the Mark appeared on all three sizes of the paper bag used at all the Owner's pharmacy locations. This includes the paper bags used to distribute all in-store purchases and for deliveries of prescription drugs to houses and nursing homes.

ANALYSIS AND REASONS FOR DECISION

[19] The Owner submits that the Chater affidavit and associated exhibits clearly demonstrate that the Mark was used or displayed in the performance or advertising of each of the remaining services claimed. In this regard, the Owner submits that Ms. Chater set out photographs and other evidence of such usage of the Mark on posters and brochures and confirms that these materials relate to such use in respect of the operations of the Owner as a full-service pharmacy and retail store.

[20] The Owner submits that given the burden in section 45 to establish use (citing *Uvex Toko, supra*), the affidavit provides sufficient evidence, such that the registration should be maintained with respect to the remaining registered services.

[21] I agree. Ms. Chater has provided evidence of pharmacy in-store signage and posters and brochures which clearly display the Mark. Further to this, the brochures and posters detail

services which, in my view, are consistent with and cover each of the remaining registered services. Importantly as well, Ms. Chater provides additional factual information in her affidavit with respect to dates, locations, and distribution of such of advertising and promotional materials.

[22] Lastly, I note that while the Mark appears throughout the evidence with a slight embellishment (*i.e.* - a check-mark is positioned through the R resembling an Rx symbol), I consider this embellishment a minor deviation [regarding embellishment of letters, see *FAAM SpA v Fabrica Italiana Accumulatori Motocarri Montecchio* (2011), 95 CPR (4th) 184 (TMOB)]. That is, the Mark is being used in such a way that it has not lost its identity and remains recognizable, the dominant feature of the Mark, being the word PROFILE, having been preserved [per *Canada (Registrar of Trade-marks) v Cie International pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[23] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with the remaining services as registered within the meaning of sections 4(2) and 45 of the Act.

DISPOSITION

[24] Having regard to the aforementioned, 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 the following from the statement of services:

Development and administration of prescription drug programs designed to process claims for medical services and products used by consumers; and

Operation of retail stores and telephone services for the sale of homeopathic medications, nutritional products, sports medicine products, video movies, cassette tapes, non-prescription drugs and medicated products, personal grooming, clothing and cosmetic products, baby products, food, confectionary goods, household and daily living products, books, magazines, stationery, office supplies, gifts, and jewellery and that delivery of homeopathy services and sports medicine services.

[25] The amended statement of services will be as follows:

Operation of a pharmacy; sale and delivery of prescription drugs including counselling regarding the choice of medication, drug usage and related information, and pharmaceutical services required; operation of retail stores for the sale or rental of health and home care products and the delivery of health and home care services inclusive of education, training and teaching (not including conducting training programs and developing skills in hiring, training, evaluating and promoting employees), caregiving, fitting and assembly directly or indirectly related to health and home care products or the general care and improvement to comfort and the quality of life for consumers; and telephone sale, rental and delivery of health and home care products.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE No Hearing Held

AGENTS OF RECORD

Stewart McKelvey

FOR THE REGISTERED OWNER

Currier & Kao LLP

FOR THE REQUESTING PARTY