



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 110

Date of Decision: 2021-05-31

IN THE MATTER OF A SECTION 45 PROCEEDING

ExeGi Pharma LLC

Requesting Party

and

VSL Pharmaceuticals, Inc.

Registered Owner

TMA640,887for VSL#3

Registration

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA640,887 for the trademark VSL#3 (the Mark), currently owned by VSL Pharmaceuticals, Inc. (the Owner).

[2] All references are to the Act as amended June 17, 2019 (the Act), unless otherwise noted.

[3] The Mark is registered for use in association with “Lactic acid bacteria compositions for use as a drug or dietary/food supplement” (the Goods).

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

THE PROCEEDINGS

[5] At the request of ExeGi Pharma LLC (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on January 3, 2019 to the Owner of the Mark.

[6] The notice required the Owner to show whether the trademark 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 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 January 3, 2016 to January 3, 2019 (the Relevant Period).

[7] The relevant definition of use in the present case is set out in section 4(1) of the Act as follows:

4(1) A trademark 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 to whom the property or possession is transferred.

[8] 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. As such, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448 at para 68] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at para 3]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the mark was used in association with the goods.

[9] In the absence of use as defined above, pursuant to section 45(3) of the Act, a trademark is liable to be expunged, unless the absence of use is due to special circumstances.

[10] In response to the Registrar’s notice, the Owner furnished the affidavit of Luca Aurelio Guarna sworn on July 29, 2019 to which were attached Exhibits A to D inclusive.

[11] Only the Owner filed written representations and no hearing was held.

THE EVIDENCE

[12] Mr. Guarna describes himself as the Owner's President and has held that position for almost five years. As such, he affirms that he has personal knowledge of the matters sworn, save and except where stipulated otherwise.

[13] Mr. Guarna affirms that the Owner is a pharmaceutical company based in Herndon, Virginia, USA that sells medical food for dietary management, dietary supplements and over the counter pharmaceutical preparations to consumers around the world, including Canada.

[14] Mr. Guarna explains that the Owner sells a line of probiotics used as food and dietary supplements that are sold under the Mark (VSL#3 Supplements). He adds that the VSL#3 Supplements are a mixture of different strains of lactic acid bacteria at a very high bacterial concentration.

[15] Mr. Guarna affirms that, in the normal course of business, at the Owner's request, the VSL#3 Supplements are manufactured and packaged in Italy and then shipped directly to the Owner's distributors in various countries. The distributors then resell them to the end consumers. He identifies Ferring, Inc (Ferring), located in Toronto, Ontario as the entity having the exclusive rights to distribute the Goods in Canada.

[16] Mr. Guarna affirms that Ferring places orders to the Owner. The goods ordered are shipped to Ferring from the place of manufacture in Italy. Ferring then distributes the VSL#3 Supplements to Canadian retailers. Moreover, Canadian consumers may purchase VSL#3 Supplements directly via Ferring's website located at *www.vsl3.ca*.

[17] Mr. Guarna explains how the promotion and advertising is done by Ferring but for the purpose of this decision these facts have little impact on this decision, given that the registration covers only goods.

[18] Mr. Guarna affirms that the Mark appears on the packaging of VSL#3 Supplements sold in Canada during the Relevant Period. Attached as Exhibit A to his affidavit, are pictures of representative packaging of VSL#3 Supplements sold and shipped to Ferring in Canada and resold to Canadian consumers during the Relevant Period.

[19] Attached as Exhibit B to Mr. Guarna's affidavit, are representative invoices issued by the Owner to Ferring during the Relevant Period for the sale of VSL#3 Supplements in association with the Mark. I note that a couple of invoices were issued outside the Relevant Period, but this will have no effect on my decision, as there are invoices issued during the Relevant Period.

[20] Finally, Mr. Guarna attached as Exhibit C and D promotional material distributed and used in Canada.

ANALYSIS AND REASONS FOR DECISION

[21] From the evidence described above and given that the Requesting Party has filed no written representations and did not request a hearing, I conclude that the Owner has established use of the Mark in Canada in association with the Goods during the Relevant Period, within the meaning of section 4(1) of the Act.

DISPOSITION

[22] Pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

Jean Carrière
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE No Hearing Held

AGENTS OF RECORD

Jensen IP

For the Registered Owner

Moffatt & Co

For the Requesting Party