



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 32

Date of Decision: 2025-02-25

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Eikon Therapeutics, Inc.

Registered Owner: Hybritech Incorporated

Registration: TMA317424 for ICON

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. TMA317424 for the trademark ICON (the Mark), owned by Hybritech Incorporated (the Owner).

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

(1) Immunoassay diagnostic kits for human chorionic gonadotropin (HCG) consisting primarily of in vitro diagnostic reagents.

(2) Immunoassay diagnostic kits consisting primarily of in vitro diagnostic reagents for detecting human physiological conditions.

[3] For the reasons below, I conclude that the registration should be maintained.

PROCEEDING

[4] At the request of Eikon Therapeutics, Inc. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on December 15, 2023.

[5] The notice required the Owner to show whether the Mark was 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 Mark was last in use and the reason for the absence of such use since that date. The relevant period for showing use is from December 15, 2020, to December 15, 2023.

[6] The relevant definition of “use” in the present case is set out in section 4 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.

[7] 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. The threshold for establishing “use” in section 45 proceedings is quite low and evidentiary overkill is not required [*Miller Thomson LLP v Hilton Worldwide Holding LLP*, 2020 FCA 134].

[8] In response to the notice, the Owner furnished the affidavit of Jason Piche, Chief IP Counsel of its licensee, Beckman Coulter Inc (Beckman).

[9] Only the Owner submitted written representations; no oral hearing was held.

REASONS FOR DECISION

Overview of the Owner's evidence

[10] Mr. Piche explains that Beckman manufactures products under license from the Owner, which products are then sold by Beckman Coulter Canada LP (Beckman Canada), a sub-licensee, to medical supply distributors in Canada [para 5-7]. He states that the Owner exercises direct or indirect control over the character or quality of all the products sold in association with the Mark in Canada, and he provides examples of how such control has been exercised [para 6].

[11] Mr. Piche explains that the products manufactured and sold under license are immunoassay diagnostic kits for detecting: (i) human chorionic gonadotropin (HCG), which he correlates with goods (1); and (ii) mononucleosis, Group A streptococcal bacteria causing strep throat and *Helicobacter pylori* bacteria causing stomach infections, which he correlates with goods (2) (collectively the Products) [para 8].

[12] With respect to how the Mark was displayed in association with the Products, Mr. Piche states that it appeared prominently on their packaging and shipping boxes during the relevant period [paras 9-11]. Representative photographs of such packaging and shipping boxes show them clearly displaying the Mark [Exhibits A and B].

[13] As evidence of transfers, Mr. Piche states that, during the relevant period, sales revenue for the Products was in excess of CAD \$2 million, representing over 450,000 diagnostic kits [para 13]. Representative invoices show sales to customers in Canada during the relevant period of products described as "Icon 20 HCG", "Icon DS Strep A" and "Icon Mono" [para 14, Exhibit D].

Analysis

[14] Use of a trademark by a licensee or sub-licensee enures to the benefit of its owner when the latter controls, directly or indirectly, the character or quality of the goods sold under that trademark [section 50(1) of the Act]. A clear statement attesting to the requisite control is sufficient in section 45 proceedings [see *Empresa Cubana Del Tabaco v Shapiro Cohen*, 2011 FC 102 at para 84, aff'd 2011 FCA 340]. In view of the

evidence, I am satisfied that any use of the Mark by Beckman and Beckman Canada enured to the Owner.

[15] Considering all the Owner's evidence, I find it shows that the Products correspond to the registered goods, that the Mark was displayed on their packaging and shipping boxes, and that they were sold in Canada, during the relevant period, in the Owner's normal course of trade. I am therefore satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4(1) and 45 of the Act in association with all the goods listed in the registration.

DISPOSITION

[16] 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 maintained.

Emilie Dubreuil
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Requesting Party: Fasken Martineau Dumoulin LLP

For the Registered Owner: Smart & Biggar LP