



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 104

Date of Decision: 2025-05-08

[UNREVISED ENGLISH CERTIFIED TRANSLATION]

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Smith & Nephew, Inc.

Registered Owner: Laboratoire Victhom Inc.

Registration: TMA1,068,675 for TANDEM

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. TMA1,068,675 for the trademark TANDEM (the Mark), registered for use in association with the following products:

(1) Orthopedic braces; orthoses and artificial limbs.

[2] For the reasons set out below, the products “orthopedic braces” and “artificial limbs” will be expunged from the statement of goods.

THE RECORD

[3] On November 17, 2023, at the request of Smith & Nephew, Inc. (the Requesting Party), the Registrar of Trademarks issued a notice under

section 45 of the Act to the registered owner of the Mark, namely Laboratoire Victhom Inc. (the Owner or VICTHOM).

[4] The notice required the Owner to provide evidence showing that the Mark was used in Canada in association with each of the goods specified in the registration at any time within the three years immediately preceding the date of the notice and, if not used, the date when the Mark 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 between November 17, 2020 and November 17, 2023.

[5] The relevant definition of “use” 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.

[6] In the absence of use, a trademark registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[7] In response to the Registrar’s notice, the Owner provided the affidavit of Sylvain Boucher, sworn February 16, 2024, to which were attached exhibits SB-1 to SB-9.

[8] Only the Requesting Party filed written representations. An oral hearing was held and only the Requesting Party was present.

OVERVIEW OF THE EVIDENCE

[9] Mr. Boucher has been the President and Chief Executive Officer of the Owner since 2005. In his affidavit, he defines the term “the Goods” as being the products described in the registration, collectively, and the term “the Reference Period” as being a period of approximately six years, from December 4, 2017, to December 15, 2023.

[10] Mr. Boucher attests to the annual revenues generated in Canada from the sale of “Goods” under the Mark in the normal course of VICTHOM’s trade during said Reference Period. The revenues in 2020 were approximately \$460,000, and those for 2021, 2022, and 2023 exceeded \$650,000.

[11] Mr. Boucher attached Exhibit SB-4 to his affidavit, which he describes as [TRANSLATION] “copies of invoices showing the purchase of Goods by patients, as well as quality control forms issued by the Victhom manufacturing plant in association with the goods” [para 8]. I will revisit these invoices in my analysis of the evidence.

[12] Mr. Boucher also provides information and documents regarding the promotional program of the Mark during the Reference Period, including a copy of presentations made to prescribing physicians [Exhibit SB-5], a price list [Exhibit SB-7], and a [TRANSLATION] “Device Guide” [Exhibit SB-6]. I note that the Mark is presented in association with a knee orthosis in several places in these promotional documents.

[13] Lastly, Mr. Boucher indicates that the Mark appeared on the Owner’s websites during the Reference Period; the contents of these websites were not submitted as evidence.

[14] Mr. Boucher concludes his affidavit by stating that [TRANSLATION] “the Mark was used during the Reference Period in connection with all of the Goods” [para 18].

ANALYSIS

“Orthopedic braces” and “artificial limbs”

[15] First of all, it is important to note that—aside from Mr. Boucher’s definition of “Goods”—the evidence makes no mention of the goods “orthopedic braces” and “artificial limbs” as mentioned in the registration.

[16] In a section 45 proceeding, the burden of proof is on the registered owner of the trademark to demonstrate “use” in order to maintain a trademark on the register. It is clear from the case law that this burden is not a stringent one [*Brouillette Kosie Prince v Orange Cove - Sanger Citrus Association*, 2007 FC 1229, at para 7].

[17] Although it is not necessary to provide evidentiary overkill and representative evidence may be submitted as part of a section 45 proceeding, the registered owner must nonetheless establish *prima facie* evidence of use of the trademark in association with each of the goods listed in the registration [*John Labatt Ltd v Rainer Brewing Co* (1984), 80 CPR (2d) 228 (FCA); see also *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[18] In light of the above, and since mere allegations of use of a trademark 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)], without considering that Mr. Boucher’s allegation cover all the goods indistinctly and refer to a period of time that exceeds the relevant period, I find that the Owner has not discharged his burden of showing use of the Mark within the meaning of section 4(1) of the Act in association with the goods “orthopedic braces” and “artificial limbs”.

[19] In the absence of evidence of special circumstances excusing non-use of the Mark, these goods will be expunged from the registration.

"Ortheses"

[20] It is well established that the evidence of a single sale may well suffice to establish use for the purposes of a section 45 proceeding so long as it follows the pattern of a genuine commercial transaction and is not seen as being deliberately manufactured or contrived to protect the registration [see *Philip Morris Inc v Imperial Tobacco Ltd*, (1987), 13 CPR (3d) 289 (FCTD) at para 12].

[21] In this case, the evidence includes not only substantial annual revenue generated from the sale of goods during the relevant period, but also three invoices, each stating the sale of a single product identified in the invoices as a [TRANSLATION] "Tandem Knee Orthosis". I note that two invoices report sales during the relevant period, namely those of August 7 and 9, 2023, and that these were issued by "Équilibre Loretteville" and "Équilibre Beloeil", respectively.

[22] Mr. Boucher attests that the sales covered by the invoices were made [TRANSLATION] "in the normal course of trade for EQUILIBRE, a division of VICTHOM laboratory" [at para 9]. Regarding the relationship between Équilibre and the Owner, Mr. Boucher states that [TRANSLATION] "EQUILIBRE is a 'business to patient' division of VICTHOM" and that a [TRANSLATION] "complete range of orthopedic goods and services is offered at *our* EQUILIBRE laboratories" [at para 7, emphasis added].

[23] In my opinion, the invoices as evidence are sufficient to establish the transfer of knee orthoses in the Owner's normal course of trade during the relevant period. The question is therefore to determine whether the Mark

was associated with these goods within the meaning of section 4(1) of the Act.

[24] The Requesting Party submits that the Owner has not proven any association between these products and the Mark, since the Mark was neither affixed to the orthoses or their packaging nor associated with the goods in any other way. In this regard, the Requesting Party submits that in the absence of evidence to that effect, the registrar cannot presume that the invoices accompanied the orthoses at the time of the transfer of property [citing *Riches, Mckenzie & Herbert v Pepper King Ltd*, (2000), 8 CPR (4th) 471, 2000 CanLII 16133 (FC)].

[25] I agree with the Requesting Party that the evidence does not show that the Mark was affixed to the goods or their packaging. However, with respect to the Requesting Party's argument, I believe that this case differs from the situation in *Riches*, since Mr. Boucher's affidavit states the Owner's normal course of trade and provides sufficient facts to conclude that the invoices accompanied the goods sold by the Owner.

[26] Indeed, in his affidavit, Mr. Boucher first attests that [TRANSLATION] "the Mark has been used in association with the goods" and explains that he is attaching to his affidavit copies of invoices showing the purchase of such goods [para 8, Exhibit SB-4]. Mr. Boucher then specifies that the purchases covered by the invoices in question [TRANSLATION] "were made in the normal course of EQUILIBRE's trade, ... by patients who visited one of our laboratories and obtained Goods with which the Mark is clearly associated" [para 9] and he concludes by noting that the Mark is [TRANSLATION] "clearly shown on the invoices" [para 10].

[27] Upon reviewing this sequence of statements as a whole, I believe it is reasonable to conclude that the Owner sells its orthoses directly to the

patients who go to the Owner's facilities and that the invoices are given to the patients during these transactions.

[28] In light of the Mark appearing in the description of the invoiced good, I believe that the Owner has fulfilled the light burden that was incumbent upon it to show use of the Mark within the meaning of section 4(1) of the Act in association with "orthoses".

DISPOSITION

[29] Pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended in compliance with the provisions of section 45 of the Act to delete the goods "Orthopedic braces; ... and artificial limbs".

[30] The amended statement of goods will be worded as follows:
"orthoses".

Eve Heafey
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Certified translation
Tony Santin

Appearances and Agents of Record

HEARING DATE: February 3, 2025

APPEARANCES

For the Requesting Party: Stephanie Karam

For the Registered Owner: No appearance

AGENTS OF RECORD

For the Requesting Party: Robic IP Agency LP / Robic Agence PI S.E.C.

For the Registered Owner: No agent appointed