

Pharma in brief - Canada

TMOB dismisses section 45 proceedings for the trade-mark REMODULIN

Case:	<i>Blake, Cassels & Graydon LLP v United Therapeutics Corporation</i> , 2017 TMOB 9
Trade-Mark:	REMODULIN
Nature of case:	Summary expungement proceeding pursuant to section 45 of <i>Trade-marks Act</i>
Successful party:	United Therapeutics Corporation
Date of decision:	January 26, 2017

Summary

The Trademarks Opposition Board (TMOB) accepted United Therapeutics Corporation's evidence of use of the trade-mark REMODULIN in association with pharmaceutical preparations in the treatment of cardiovascular, pulmonary and vascular diseases, and maintained both registrations.

The TMOB accepted United's evidence of use based on sample invoices and photographs of individual packaging and shipping boxes. The TMOB further accepted the affiants' evidence of a licensing arrangement between United, the owner and licensor, and Unither, the licensee. Neither party filed written representations and an oral hearing was not held.

Background

The registrar sent a notice to United under section 45 of the *Trade-marks Act* to United at the request of Blake, Cassels & Graydon LLP with respect to its trade-mark, REMODULIN (Registration Nos. TMA637,562 and TMA637,813). United was required to furnish evidence of use of the REMODULIN trade-mark at any time between September 25, 2011, and September 25, 2014.

REMODULIN® (treprostinil) is a pharmaceutical preparation marketed in Canada by United for the treatment of pulmonary arterial hypertension.

The REMODULIN trade-mark is registered for use in association with pharmaceutical preparations used in the treatment of cardiovascular, pulmonary and vascular diseases. The board referred to the goods for each registration collectively as "the Goods" based on the evidence of both affiants, which treated the goods for each registration as one and the same.

Section 45 of the *Trade-marks Act*

The TMOB reiterated that section 45 of the *Trade-marks Act* provides a "simple, summary and expeditious procedure" to expunge a trade-mark from the register for lack of use. Accordingly, section 45 of the *Act* provides the registrar with the ability to require the registered owner to provide evidence of use of the trade-mark in Canada at any time during the

three-year period immediately preceding the date of the notice, and if not, the date when it was last so in use and the reason for the absence of such use since that date.

The proceeding

United filed two affidavits demonstrating use of the REMODULIN trade-mark in association with the goods in Canada at any time between September 25, 2011, and September 25, 2014.

The board accepted the affiants' evidence of the licensing arrangement between Unither and United, in which Unither sells the goods in Canada as the wholly owned Canadian subsidiary and authorized licensee of United, the registered owner of the mark. The affiants further provided evidence of monthly invoices and photographs of the goods' individual packaging and shipping boxes as representative examples of how the REMODULIN trade-mark was used in association with the goods during the relevant time and in the normal course of trade in Canada.

The board found that although there is a difference in phrasing of the statement of goods for each registration, this should not affect the outcome of the proceedings. The board ultimately found that the evidence established use of the mark in association with the goods as registered for each registration.

Norton Rose Fulbright Canada LLP successfully represented United in this matter.

Link:

Blake, Cassels & Graydon LLP v United Therapeutics Corporation, [2017 TMOB 9](#)

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