



**RICHARDS  
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*Established in 1871*

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## **INTELLECTUAL PROPERTY LAW, TRADEMARKS CHAPTER, CLE ANNUAL REVIEW, [2004]**

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By RBS

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## A. Legislation

There were no significant amendments in 2004 to either the *Trade-marks Act*, R.S.C. 1985, T-13 (the "Act"), or the Trade-marks Regulations.

## B. Administrative Practice

### 1. Fee Increases

The Canadian Intellectual Property Office ("CIPO") which is responsible for trade-mark registration in Canada increased and altered the fees for 2004. Some of the increased and altered fees are as follows:

- Application for Registration - increased to \$250 (formerly \$150)
- Statement of Opposition - increased to \$750 (formerly \$250)
- Application to Amend - extending wares or services - increased to \$450 (formerly \$300)
- Application to Amend - address of owner or representative - repealed
- Application for Extension of Time - increased to \$125 (formerly \$50)

Also, it should be noted that there is an increased charge of \$50.00 on top of some of the fees if they are not filed on-line.

For further information and details, please visit the web pages for trade-marks at <http://cipo.gc.ca>.

### 2. Practice Notes

Two Practice Notes were issued by CIPO in 2004.

- (a) On June 2, 2004 CIPO published a practice note concerning time limits under the Act.

Pursuant to Section 26 of the *Interpretation Act*, R.S. 1985, C.I-21 any person choosing to deliver a document to CIPO's office, an Industry Canada regional office or a registered mail establishment where a federal, provincial or territorial holiday exists, it is entitled to an extension of any time limit for the filing of the document that expires on the holiday, until the next day that is not a holiday. The entitlement to the extension is dependent on the establishment to which the document is delivered and not the place of residence of the person for whom the document is filed or of their agent. In this regard, documents transmitted to CIPO by electronic means, including facsimile, would be considered to be delivered to CIPO's offices in Gatineau, Quebec.

It should be remembered that the first Monday in August is a holiday in British Columbia.





Further, in accordance with section 66(1) of the Act a trade-mark time limit that expires on a day when the Trade-marks Offices (CIPO) are closed for business is deemed to be extended to the next day when the offices are open for business.

The Trade-mark Offices are closed for business on the following days:

- All Saturdays and Sundays
- New Years Day\* (January 1<sup>st</sup>)
- Good Friday
- Easter Monday
- Victoria Day (First Monday immediately preceding May 25<sup>th</sup>)
- St. John the Baptist Day\* (June 24<sup>th</sup>)
- Canada Day\* (July 1<sup>st</sup>)
- Labour Day (First Monday in September)
- Thanksgiving Day (Second Monday in October)
- Remembrance Day\* (November 11<sup>th</sup>)
- Christmas Day\* (December 25<sup>th</sup>)
- Boxing Day\* (December 26<sup>th</sup>)

\* If any of these holidays fall on a Saturday or Sunday, the Trade-mark Office will be closed the following Monday with the exception of Boxing Day. If Boxing Day falls on a Saturday, the Trade-mark Offices will be closed on the following Monday. If Boxing Day falls on a Sunday or Monday, the Trade-mark offices are closed the following Tuesday.

(b) On November 6, 2004 CIPO published a practice note concerning updated correspondence procedures:

Delivery to CIPO

For the purposes of Section 3 of the Trade-marks Regulations the address of the Office of the Registrar of Trade-marks is:

Canadian Intellectual Property Office  
Place du Portage 1  
50 Victoria Street, Room C-114





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Correspondence delivered to the above address will be considered to be received on the date of delivery.

Delivery to Designated Office

For the purposes of subsection 3(4) of the Trade-mark Regulations the following are designed establishments or offices to which correspondence addressed to the Commissioner of Trade-marks may be delivered relevant to practitioners in British Columbia:

C.D. Howe Building  
235 Queen Street, Room S-117  
Ottawa, Ontario  
K1A 0H5  
Tel: (613) 954-3584

Industry Canada  
Library Square  
300 West Georgia Street, Suite 2000  
Vancouver, British Columbia  
V6B 6K1  
Tel: (604) 666-5000

Correspondence delivered, during normal business hours, to the establishments above, will be considered to be received on the date of delivery to that designated establishment, only if it is a day on which CIPO is open for business. If CIPO is closed on the date of delivery, it will be considered received on the next day CIPO is open for business.

Registered Mail

For the purposes of subsection 3(4) of the Trade-mark Regulations the Registered Mail Service of Canada Post is a designated establishment or office to which correspondence addressed to the Registrar of Trade-marks may be delivered.

Correspondence delivered through the Registered Mail Service of Canada Post will be considered to be received on the date stamped on the envelope by Canada Post. If the date stamp is a day on which CIPO is



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closed, then the Registered Mail will be considered to be received on the next day on which CIPO is open for business.

#### Electronic Correspondence

In accordance with subsection 3(6) of the Trade-mark Regulations correspondence addressed to the Registrar of Trade-marks may be sent by facsimile or on-line via CIPO's web site. However, subsection 3(4) of the Trade-marks regulations specifies certain correspondence which can not be sent by facsimile or on-line.

Correspondence delivered by electronic means will be considered received on the day that it is transmitted if delivered before midnight local time at CIPO. If CIPO is closed for business that day, then the correspondence will be considered to be received on the next day that CIPO is open for business.

The Registrar of Trade-marks can be reached by facsimile at:

(819) 953-2476 or (819) 953-6742

or on-line at CIPO's website: [www.cipo.gc.ca](http://www.cipo.gc.ca).

### **C. Case Law**

Below are summaries of some of the cases relevant to trade-marks that were decided in 2004:

#### **1. Registration Practice**

On July 16, 2004 the Federal Court of Canada delivered a judgment in *Effigi Inc. v. Canada (Attorney General)* 2004 CF 1000, which many practitioners believe will have a significant impact on trade-mark practice in Canada.

##### a. Current Practice

If a Trade-mark Examiner on behalf of the Registrar finds on a search that there are two pending applications for registration which are confusing, the Examiner conducts an analysis of entitlement under Section 16 of the Act to determine which application will proceed and which application will be rejected.

Section 16 states that an applicant may secure registration of its trade-mark unless on the date on which it first used such a trade-mark or made it known in Canada it was confusing with:

- i) a trade-mark had been previously used in Canada or made known in Canada;





- ii) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or
- iii) a trade name that had been previously used in Canada by any other person.

For example, if Acme Inc. filed an application on November 1, 2004 for a trade-mark with a first use date of July 1, 2004 for its trade-mark but Widgets Inc. files an application for a confusing trade-mark on December 1, 2004 but has used its trade-mark since May 1, 2003, Widgets Inc. will be considered to have the superior or senior application. Widgets Inc. is entitled to be immediately approved for advertisement in the absence of any other objections. Acme Inc. will be considered to have an inferior or junior application and the Examiner will deliver an objection to registration citing the superior or senior application of Widgets Inc. Acme Inc. will then have to convince the Examiner that there is no confusion and object to the application of Widgets Inc. in opposition proceedings if it has grounds to do so.

This practice ensures that applications that have the earliest claim to entitlement to registration are first to be advertised and then proceed to the next phase of registration. Applications that show superior or senior use are efficiently moved through the registration process.

Consequently, even if a trade-mark owner is slow to file its application it will still trump an earlier filed application for a confusing trade-mark based on its earlier use of its trade-mark – its superior or senior use. In short, it's not a race to the trade-marks office.

Unfortunately, the Federal Court cast doubt on the ability of Trade-mark Examiners to refer to Section 16 of the Act in the examination process. The result of the *Effigi* decision appears to be that the Examiners may only look at the filing dates of the applications in determining which application can proceed to examination and must ignore the first use dates.

In our example, it would be Acme Inc. who would be entitled to proceed to advertisement based on its earlier filing date and Widgets Inc. would be subject to an Examiners rejection.

Practically speaking, a superior or senior trade-mark application such as Widgets Inc. would have to oppose the application of Acme Inc. which has gone to advertisement. However, Widgets Inc. must do so successfully prior to the deadline Widgets Inc. faces from the Trade-marks Office to respond to the Examiners objection to its application. Clearly, Widgets Inc.'s superior or senior application is potentially subject to unnecessary opposition proceedings.

b. The *Effigi* Judgment





The *Effigi* case arose from an appeal from the decision of the Registrar of Trade-marks refusing Effigi Inc.'s application for registration of the trade-mark MAISON UNGAVA. Effigi inc. filed its application on December 19, 2000 on the basis of proposed use and not on the basis of any actual use. The Examiner on behalf of the Registrar of Trade-marks objected to Effigi Inc.'s application under Section 16(3)(a) of the Act because it considered it confusing with the pending trade-mark application of Tricorn Investments Canada Ltd.'s for UNGAVA filed on October 19, 2001 but claiming a first use date for this mark of 1981. Based on conventional practice in the Trade-marks Office, the Examiner refused the Effigi Inc. application citing the Tricorn Investments Canada Ltd.'s superior or senior application.

The Federal Court found that the wording of Section 16 of the Act itself imposes a limitation on its applicability to situations where the trade-mark of the co-pending application is "pending at the date of advertisement of the applicant's application in accordance with Section 37." As a result the Federal Court held:

"[This] indicates that Section 16 does not apply to applications until the date of advertisement of the applicant's application. Since the examination process is conducted prior to the date of advertisement of the application's application, Section 16 does not apply to the examination process."

The Federal Court noted that the application need not provide particulars as to its date of first use and the Examiner is not authorized to request further information such that an Examiner cannot make a complete decision on this point during the examination process. Further, the court drew support for his decision based on dicta of the Federal Court of Appeal in *Unitel International Inc. v. Canada* (1999) 162 F.T.R. 81.

Accordingly, the Trade-mark Examiners have no jurisdiction to refuse to advance a trade-mark application based on an application for a confusing trade-mark that has an earlier first use date.

#### c. Conclusion

As a result of the *Effigi* decision, the first to file a trade-mark application will be the first to proceed to advertisement. Those trade-mark applications that have superior or senior first use dates will be forced to oppose trade-mark applications with confusing marks that have later first use dates or are merely based on proposed use of trade-mark. Opposition proceedings can be expensive and delay registration.

Accordingly, trade-mark owners who have yet to register their trade-mark should do so as quickly as possible in order to avoid potential added expense.

## 2. Contempt Proceedings





Counterfeiting is a continual problem for trade-mark owners. Anton Piller orders are often useful as extraordinary measures to prohibit counterfeiters from selling their products in association with well known trade-marks.

While counterfeiters are known to brazenly ignore these orders, the courts are prepared to provide sanctions for this behaviour. Pursuant to show cause and contempt hearings under Rules 466 and 467 of the Federal Court Rules, the Federal Court in *Louis Vuitton Malletier, S.A. v. Bags O'Fun Inc.* 2003 FC 1335 ordered the defendant to pay \$25,000.00 for each of the two proven contempt charges as well as \$35,000.00 for the cost of the two hearings. However, the court declined to order a term of imprisonment stating that "there is jurisprudence of this Court to the effect that a person cannot be incarcerated for civil contempt in their absence." Further, the court noted that this was a first time offence.

### **3. Expungement Proceedings**

A notice pursuant to Section 45 of the Act to expunge the registration of the trade-mark GLOBALSERVE owned by Primus Telecommunications Canada Inc. ("Primus") for non-use was successful as Primus failed to resolve the ambiguity of its use.

In the *Primus Telecommunications Canada Inc.* [2003] T.M.O.B. No. 71 Primus filed affidavit evidence to show use of its trade-mark GLOBALSERVE. However, the Trade-mark Opposition Board held that in the Primus affidavit reference was made to the "GLOBALSERVE logo" and to the "GLOBALSERVE trade-mark" and that any ambiguities in the affidavit caused by reference to the former would be construed against Primus as it had the burden of proving trade-mark usage.

Further, the Trade-mark Opposition Board noted that there were references to usage by Primus Telecommunications Inc. which was not the name of the registered owner of the trade-mark in issue. As well, there was no evidence to indicate that advertisements referring to the trade-mark in issue were ever circulated in Canada. Finally, evidence that every time a customer logged on to the internet it saw the "GLOBALSERVE logo" was irrelevant as this was not the trade-mark in issue.

This case once again demonstrates the need to carefully prepare an affidavit of trade-mark usage when faced with a Section 45 proceeding under the Act. While the general burden is not great on trade-mark owners, it is still important to take care in marshalling evidence.

Similarly, in *Footlocker Group Canada Inc. v. Steinberg* 2004 FC 717 the well known and potentially valuable trade-mark WOOLWORTH was expunged from the register of trade-marks as a consequence of inadequate evidence to support continuous usage pursuant to Section 45 proceedings.







In this case, the affidavit evidence of sales figures and photographs showing store front usage with respect to the trade-mark in issue were successfully challenged. The party seeking expungement successfully pointed out that the affiant failed to identify which entity operated the retail outlets shown in the photographs and made the sales referred in the affidavit. Further, there was no mention as to which entity had made use of the trade-mark in Canada for the relevant period of time.

In another expungement case pursuant to Section 45 of the Act, the Trade-mark Opposition Board held that the use of numbers after a registered mark did not vary the use of the mark such that it should be expunged for lack of use.

In *Re: Oy Lahden Polttimo Ab* [2004] T.M.O.B. No 18 it was found that the use of the marks MALTAX 2001 and MALTAX 1500 constituted use of the registered trade-mark MALTAX “per se”.

#### **4. Confusion**

The case of *9013-0501 Quebec Inc. v. Bluedot Jeanswear Co.* 2004 FC 197 is a reminder of the relevance of the bilingual nature of our country to trade-mark law in Canada.

The Registrar of Trade-marks rejected the application of 9013-051 Quebec Inc. (“9013”) for its mark RAGE JEANS in association with men’s, women’s and children’s clothing athletic wear and souvenir items based on the opposition of Bluedot Jeanswear Co. (“Bluedot”) with respect to its mark ORAGE.

9013 appealed to the Federal Court which upheld the Registrar decision. The court rejected the appeal and found that francophone and bilingual consumers would likely be confused between the trade-marks RAGE JEANS and ORAGE based on the finding that the visual impact, spelling and pronunciation of the distinctive words RAGE and ORAGE are very similar in the French language.

#### **5. Co-existence**

Where two marks that closely resemble each other, the absence of any evidence of confusion during a period of 10 years of co-existence, may be a significant factor in denying a claim for trade-mark infringement and passing-off. In *Alticor Inc. v. Nutravite Pharmaceuticals Inc.* 2004 FC 235 the Federal Court dismissed the claim of Alticor Inc. (“Alticor”) for trade-mark infringement and passing off with respect to its trade-mark NUTRILITE and the trade-mark NUTRAVITE owned by Nutravite Pharmaceuticals Inc. The Court found that the nature of the wares of the parties were the same but that the channels of trade were different. Also, the court held that the usage of NUTR in trade-marks was common such that small differences in the marks serve to distinguish them. Accordingly, despite finding some similarity in visual impact, spelling and sound of the two marks the Court found that there was no confusion between the





marks to support a finding of infringement and passing-off. The court appears to have treated as a significant factor the absence of any evidence from *Altacor* that there was any instance actual confusion between the marks.

Interestingly, the Court found that the Trade-mark Opposition Board's earlier finding at the time of the trade-mark application for registration that there was no likelihood of confusion between the marks was not relevant as a surrounding circumstance for evaluating confusion in the infringement and passing-off action.

## 6. Famous Marks

The case of *Mattel, Inc. v 3894207 Canada Inc.* 2004 FC 361 is a reminder that the law in Canada with respect to famous marks is different from that of the United States.

In this case *Mattel, Inc.* ("Mattel") sought to appeal the decision of the Registrar of Trade-marks which allowed the registration of the mark BARBIE'S and design by 3894207 Canada Inc. ("3894") with respect to restaurant services.

Mattel tendered new evidence on the appeal to the Federal Court in the form of a survey showing that a majority of people thought of Barbie dolls when they saw the BARBIE and design logo of 3894. The Court found that this evidence was not persuasive as it did not survey people who were familiar with 3894's business and restaurant.

Further, the Court was dismissive of the notoriety of Mattel's trade-mark for Barbie dolls as having an effect on determining whether other use of the mark should be allowed. The court cited with approval Mr. Justice Linden in the Federal Court of Appeal decision of *Toyota Jidosha Kabushiki Kaisha v Lexus Foods Inc.* [2001] 2 F.C. 15:

"Famousness alone does not protect a trade-mark absolutely. It is merely a factor that must be weighed in connection with all the other factors. If the fame of the name could prevent any use of it, the fundamental concept of a trade-mark being granted in relation to certain wares would be rendered meaningless..."

In the United States the treatment of famous marks is different as the United States has specific legislation, the *Federal Trade-mark Anti-Dilution Act* 15 U.S.C. §1125(c) (1998) which deals with the protection of famous marks. Canada has no comparable legislation although it has been argued that Section 22 of the Act was originally intended and should be used in this manner.

## 7. Deceptively Misdescriptive





In 2004, the Canadian Council of Professional Engineers (“Professional Engineers”) was once again active in protecting against the commercial use of the word “engineering” in trade-marks.

In the *Canadian Council of Professional Engineers v. John Brooks Co.* 2004 FC 586 the Federal Court allowed an appeal by the Professional Engineers from a decision of the Trade-mark Opposition Board allowing the registration of BROOKS BROOKS SPRAY ENGINEERING by John Brooks Co. (“Brooks”).

The Court found the admission of Brooks that it was not registered or licensed to provide engineering services to be significant and accordingly held that the Brooks’ mark was deceptively misdescriptive and not registrable.

#### **8. Use**

The Federal Court of Appeal in *Tommy Hilfiger Licensing Inc. v. International Clothiers Inc.* 2004 FCA 252 overturned the Trial Division decision in a trade-mark infringement and passing-off case in which the meaning of “use” of a mark under the Act was examined.

In a surprising decision at trial, the court found that the Crest Designs of *Tommy Hilfiger Licensing, Inc.* (“Hilfiger”) placed on its clothing products were not infringed and no passing-off took place with respect to a similar Crest Design on products of International Clothiers Inc. (“International”). The trial judge determined that while the Crest Designs of Hilfiger and International were confusingly similar, International did not infringe or pass-off its clothing products as those of Hilfiger as International did not intend to use the Crest Design as trade-marks. In doing so, the trial judge held that International did not use its Crest Design as a trade-mark “for the purpose of distinguishing or so as to distinguish” its wares from those of others pursuant to the definition of “use” set out in Section 2 of the Act.

It appears that the trial judge erred in treating the words “for the purpose of distinguishing” synonymously with the expression “with the intention”.

The Court of Appeal had no difficulty in concluding that intention of International was not relevant to the determination that International had used a confusingly similar Crest Design to that of Hilfigers as a trade-mark and that International had infringed Hilfigers trade-mark rights under the Act and committed passing-off.

#### **9. International Enforcement of Orders**

As is well reported, perpetrators of trade-mark counterfeiting often carry out their activities in more than one country. Further, the operations and assets of the perpetrators may be in countries other than where





the counterfeiting takes place making it difficult to enforce orders. This problem is illustrated by the case of *Pro Swing Inc. v. Elta Golf Inc.* [2004] O.J. No. 2801 (Ont. C.A.)

*Pro Swing Inc.* (“Pro Swing”) was a manufacturer and retailer of customized golf clubs sold in association with the trade-mark TRIDENT. Pro Swing commenced an action in Ohio for, among other things, infringement of its trade-mark TRIDENT and use of a counterfeit mark against *Elta Golf Inc.* (“Elta”), an Ontario retailer of golf clubs. A settlement agreement was reached between Pro Swing and Elta and formed the basis of an Ohio court order. However, the extra-territorial application of the Ohio court order was unclear.

When Elta commenced selling TRIDENT golf clubs in Ontario, Pro Swing obtained a contempt order in the Ohio court and sought a summary judgement to enforce the Ohio court orders in Ontario. Pro Swing was successful at the first instance. The effect was to make the consent decree and part of a contempt order issued by the Ohio court valid and enforceable in Ontario. However, this order of the Ontario Superior Court of Justice was overturned by the Ontario Court of Appeal.

Historically Canadian courts have not enforced non-monetary awards of foreign courts such as the orders of the Ohio court. However, since the decision in *Morguard Investments Ltd. v. De Savoye* [1990] 3 S.C.R. 1077 this position has come under attack. (see *Uniforêt and Pâte Port-Cartier Inc. v. Zerotech Technologies Inc.* (1998) 9 W.W.R. 688 (B.C.S.C.)).

While the Court of Appeal stated that the time was ripe for a re-examination of the rules governing the recognition and enforcement of non-monetary foreign judgments, on the facts of this case it was not prepared to do so as the foreign orders were not sufficiently clear as to whether they were intended to apply outside of Ohio. The Court of Appeal held that a non-monetary foreign judgment “would have to be sufficiently certain in its terms that the Ontario Court could enforce the judgment without having to interpret its terms or vary it.”

The Court of Appeal noted that Pro-Swing was not without remedies as it could sue on the settlement agreement in Ontario and commence an infringement action in Ontario.

## 10. Damages

It is often a vexing question as to what are appropriate damages in trade-mark cases as general damages are awarded for the injury to the goodwill or reputation associated with the trade-marks as well as any special damages that may have been caused. In some respects, the issue of damages is not unlike those that concern defamation cases where once the cause of action has been proven damages are presumed.





In *Natural Process Equipment Inc. v. Sigurdson et al* 2004 ABQB 566, National Process Equipment Inc. (“National”) obtained an injunction and damages for passing-off with respect to its pump and compressor products. The Alberta Court of Queens Bench found that National had significant goodwill and reputation in the use of the name and associated logos in issue as it had been in business for 30 years and had carried on business across Canada.

The trial judge awarded damages of \$100,000.00 against the defendants stating that he had to assess the damages “by the best means I can, [as to] what is a fair and temperate sum.” The trial judge seems to have been impressed by the evidence that the value of the goodwill of the prior owners of the marks in issue was at one time identified as \$450,000.00 and that the revenues of defendant companies was collectively approximately \$1 million per year.

#### **11. Domain Names**

Of general interest to lawyers in British Columbia is the case of the *Law Society of British Columbia v. Canada Domain Name Exchange Corp.* 2004 B.C.S.C. 1102.

This case concerned the domain names [www.lawsociety.bc.ca](http://www.lawsociety.bc.ca) and [www.lsbc.org](http://www.lsbc.org) and the websites operated by the Law Society of British Columbia (“Law Society”) and the defendant’s domain names [www.lawsocietyofbc.ca](http://www.lawsocietyofbc.ca) and [www.lsbc.ca](http://www.lsbc.ca) for adult websites. The Law Society brought an action and obtained damages and a permanent injunction enjoining the defendant from using their domain names. The Law Society successfully argued that there was a misrepresentation. The defendants assertion that there was no goodwill in the name “Law Society” given the different uses of those words by different organizations in Canada was rejected by the Court. The goodwill in the name is not diminished by the fact there are other Law Societies in different provinces with somewhat similar names, such as The Law Society of Alberta.

#### **12. Licensing and Official Marks**

The *Canadian Rehabilitation Council for Disabled v. Rehabilitation for the Disabled* 2004 FC 1357 is a case of interest as it concerns an instance of judicial review of the publication of an official mark and issues of licensing.

The Canadian Rehabilitation Council for the disabled carrying on business as the Easter Seals/March of Dimes National Council (“National Council”) sought judicial review of the decision of the Registrar of Trade-marks to issue public notices to register official marks pursuant to Section 9(1)(n)(iii) of the Act for MARCH OF DIMES and ONTARIO MARCH OF DIMES by the Rehabilitation for the Disabled carrying on business as the Ontario March of Dimes (the “Ontario Council”).





In 1953, THE MARCH OF DIMES was registered as a trade-mark and it was assigned to the National Council four years later. In 1965, the National Council entered into an agreement with the Ontario Council for a license to use THE MARCH OF DIMES trade-mark. In 1971, the parties entered into a new and similar agreement which was renewable annually (the “1971 Agreement”). While the conduct of the parties suggested they believed they were bound by the 1971 Agreement, renewal documents only existed for two years. However, the Ontario Council never terminated the 1971 Agreement and continued to pay fees to the National Council under it.

In 1997, the National Council obtained public notices for official marks pursuant to Section 9(1)(n)(iii) of the Act for THE MARCH OF DIMES and MARCH OF DIMES. However, the Ontario Council became disenchanted with the National Council and obtained its own public notices under Section 9(1)(n)(iii) of the Act for official marks for MARCH OF DIMES and ONTARIO MARCH OF DIMES. The Ontario Council thereafter ceased paying fees under the 1971 Agreement to the National Council.

The National Council sought judicial review of the public notices of the Ontario Council to the Federal Court. The Federal Court found in favour of the National Council and quashed the decision of the Registrar of Trade-marks to issue public notices in favour of the Ontario Council for the official marks MARCH OF DIMES and ONTARIO MARCH OF DIMES.

The Federal Court reasoned that the Ontario Council should not be free to obtain its own public notices and benefit from the remedies of the Act based solely on the rights it obtained in the 1971 Agreement. The court concluded that it could not recognize use of an official mark under license from another public authority as constituting “adoption and use” for the purposes of Section 9(1)(n)(iii) of the Act.

Interestingly, the Court refused to be drawn into clarifying the conflicting case law on whether a licensor can obtain a public notice for an official mark based on use by licensees (see *Canada Post Corp. v. Post Office* [2001] 2 F.C. 63 (T.D.); *Magnolta Winery Corp v. Vintors Quality Alliance* 2001 FCT 1421 and the comments of the court at paras 75 - 84 in *Sullivan Entertainment Inc. v. Anne of Green Gables Licensing Authority Inc.* 2002 FCT 1321).

#### **D. Miscellaneous**

Vancouver was fortunately awarded the Winter Olympic Games for 2010. As a part of the process of awarding the Winter Olympic Games to Vancouver, the International Olympic Committee required that Vancouver agree to protect the Olympic symbols.

##### a. Registrations





In this regard, the Canadian Olympic Association (“COA”) has registered as trade-marks and official marks many Olympic related marks in Canada including the word mark OLYMPICS and CIRCLES design. The Vancouver Organizing Committee for the 2010 Olympic and Paralympic Winter Games (“VANOC”) has been authorized to use those marks in connection with the 2010 Winter Games.

Also, VANOC and the 2010 Bid Corporation have filed official mark registrations for a number of marks specific to the Vancouver Games in 2010.

The following are a list of marks which have been registered as trade-marks or official marks by VANOC, the COA or the 2010 Bid Corporation:

- OLYMPICS
- 2010 design
- THE VANCOUVER 2010 LGOG
- OLYMPIAD
- VANCOUVER 2010
- TEAM CANADA 2010
- OLYMPIAN
- CANADA 2010
- WINTER GAMES
- CIRCLES designs
- WHISTLER 2010
- COUNTDOWN TO 2010
- TORCH design
- VANCOUVER WHISTLERS 2010
- SEA TO SKY GAMES
- THE OLYMPIC FLAME
- 2010 GAMES
- SPIRIT OF 2010
- CITIUS ALTIUS FORTIUS (the Olympic motto)
- VANCOUVER '10

b. Disputes

VANOC has taken action in the past year to protect marks related to the 2010 Winter Games and other Olympic marks on behalf of the COA, including initiating litigation and obtaining injunctions. A number of





disputes have been reported in the British Columbia press involving the following word marks, design marks and domain names:

- OLYMPIC WILDLIFE REFUGE

This mark was used by a non-profit group, Association of Whistler Area Residents for the Environment (AWARE), which believed proponents of the Vancouver Whistler Games were failing to create an environmental legacy for an area in the Upper Soo Valley. VANOC requested AWARE to remove the word OLYMPIC from its name.

- WHISTLER OLYMPIC REAL ESTATE, OLYMPIC, 2010 VANCOUVER and OLYMPIC GAMES

An action was commenced against Algino Holdings Ltd. and its principals by VANOC and the COA with respect to these marks which were used in a business name, as meta-tags on a website and as part of a domain name registration by Algino Holdings Ltd. VANOC and the COA obtained an interlocutory injunction restraining transfer of the whistler-olympic.com domain name.

- OLYMPIC VALLEY REGISTERED TRADE SERVICES and OLYMPIC TORCH design

These word and design marks were used by a recently formed construction company in Squamish. VANOC requested the company cease using the marks.

- OLYMPIA PIZZA AND PASTA, OLYMPIC RINGS design and OLYMPIC TORCH design

A pizza restaurateur in Vancouver has been requested by VANOC to cease using the OLYMPIC RINGS design and the OLYMPIC TORCH design, but is apparently refusing to do so.

- VANCOUVER 2010, WHISTLER 2010 and CANADA 2010

A souvenir company used these marks on coasters, cups, glasses and fridge magnets. VANOC requested the company cease using the marks. The company agreed to comply.

- <http://www.olympic.org/vancouver-2010-winter-olympics> and <http://www.whistler2010.com/>

A West Vancouver individual registered these domain names and used the vancouver2010.ca domain name for a website advertising promoting a bed and breakfast business in Victoria. VANOC and the COA have initiated an action concerning these domain names and their use.

As indicated above, it is anticipated that the 2010 Winter Games will generate disputes and litigation over trade-marks. It will be important to watch in the coming years for any significant court decisions resulting







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from these disputes and litigation particularly as it relates to the law concerning official marks in Canada.

With respect to the protection of official marks and potential litigation involving official marks by VANOC and the COA it is worth noting previous cases arising out of Vancouver's Expo '86 and the 1988 Calgary Winter Olympic Games.

In the *Mihaljevic v. British Columbia* (1988) 22 F.T.R. 59 (F.C.T.D.) use of the number "86" as an official mark was held as being against public order because too many corporations and models of cars and other machines need to be able to use "86".

Similarly, in the *Canadian Olympic Association v. Hipson* (1987), 18 C.P.R. (3d) 444 (Alta Q.B.) the court stated that the word "winter" and year "1988" each standing alone should not be protected as official marks. However, the court in this instance stated that if the name of a city such as Calgary is placed in front of "1988" or "'88" then such marks merit protection.

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