
TRADE-MARKS EXAMINATION MANUAL

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I INTRODUCTION

General Information

This manual is designed to serve the needs of the Trade-marks Office, specifically, staff in the Examination Section. The Trade-marks Office — a branch of the Canadian Intellectual Property Office (CIPO) — is the official government body which receives and processes all applications submitted both by individuals and companies who wish to register their trade-marks.

While registration is not essential to use of the mark — many have been used extensively in the marketplace without being registered — the benefits that accrue to the owner of a registered trade-mark make registration highly desirable. For example, a registration may form the basis of an action for trade-mark infringement wherein the plaintiff's (registrant's) rights in the mark are easily shown. Without a registration the plaintiff would be restricted to attempting to prove passing off.

The processing of a trade-mark application involves various stages in the Trade-marks Office and includes: acknowledgement, indexing, examination, prosecution, advertising, opposition and registration or refusal. For the examiners, the initial contact with an application involves verification that certain administrative requirements have been satisfied. Examiners undertake a thorough examination of the trade-mark. In so doing, they are guided by the provisions of the *Trade-marks Act*. But while the Act provides the basic judicial directives concerning the registrability of marks, it is, by its very nature, insufficient for use as a reference text.

This manual incorporates the interpretation of provisions of the *Trade-marks Act* and the *Trade-marks Regulations* by the Courts and should therefore reduce the time needed to process applications by clarifying the statutory guidelines necessary to examine them. In addition, and perhaps more importantly, its use should result in more consistent decision making.

While it is impossible to predict or adequately discuss every problem which may arise during examination, we hope to have dealt with the most important aspects of the examination process and that the manual will meet examiners' immediate needs, and, as a result, will benefit the public.

It should be noted that this manual is a guide only and is not binding on the Trade-marks Office. The manual is in no way intended to replace the *Trade-marks Act* and the *Trade-marks Regulations*. In the case of any inconsistency between the manual and the Act and Regulations, the Act and Regulations must be followed.

II EXAMINATION OF THE APPLICATION AS TO FORM

II.1 Pre-examination

The entire processing of an application from the time of filing to the time of its registration (or, alternately, refusal or abandonment) involves many different operational units of the Trade-marks Office of Industry Canada. Initially, the application arrives in the departmental mail room where it is date stamped. It then goes to the CIPO Financial Branch which is responsible for receiving and coding the appropriate fee. The application cannot be awarded a filing date until the fee is paid. *See Rule 25 of the Trade-marks Regulations.*

The application is transferred to the Formalities Section where it is awarded a file number. Then it is reviewed to ensure that the filing requirements have been met and, if so, awarded a filing date. This is the date of the application's arrival in the Trade-marks Office in Hull/Ottawa, in one of the district or regional offices, or in a Canada Post Office if it is sent by Priority Post. *See Rule 3 of the Trade-marks Regulations.*

The application is then formalized and entered into the database. Next, receipt of the application is acknowledged and the mark applied for is entered in the index of pending applications. The application is then transferred to the Examination Section where it will be searched and assigned to an examiner.

II.2 Request for Early Examination

Applications are usually examined in chronological order of filing date, with some exceptions. An applicant may, in some circumstances, write to the Registrar requesting that the subject application be dealt with expeditiously.

Such advancement of an application out of its routine order creates a favoured position at the expense of all other applicants, who are delayed accordingly. Therefore, any request for expeditious processing must comprise a letter of explanation from the applicant or agent of record detailing the circumstances or reasons which would justify such consideration. Unjustified requests or those made merely in a routine manner by applicants or their agents will not be permitted. Special circumstances which would justify expedition of the examination procedure are as follows:

- a) The mark is in use, and it has come to the applicant's attention that there may be confusion with another mark in the marketplace.

- b) The application is for a proposed trade-mark, and the applicant wants to know if it could be registered before a large amount of money is spent on advertising or production costs.

II.3 Formal Requirements — Section 30

Once the application for registration of a trade-mark has been processed by the other administrative units of the Trade-marks Office, the examiners begin the initial examination. This is to ensure that all the formal requirements of the application form have been satisfied as set out in section 30 of the *Trade-marks Act*. See also the *Trade-marks Regulations*, "General". The following sections in this chapter are provided to aid in the examination of the application as to form.

II.3.1 Physical Format of Applications — Rule 13

Applications for registration shall be on white paper that measures at least 8 inches by 11 inches (21 cm by 28 cm), but not more than 8 1/2 inches by 14 inches (22 cm X 35 cm), on one side only, with left and upper margins of at least 1 inch (2.5 cm).

II.4 Types of Applications - Section 16, Paragraphs 41(1)(c) and 30(b) to (f)

In addition to verifying the application's compliance with paragraph 30(a) of the *Trade-marks Act* and identifying the manner of trade-mark use, the examiners must also review the basis upon which the applicant seeks to register the mark. The applicant will be aided in the completion of his/her application by referring to the *Trade-marks Regulations*, especially to Rule 25 and to paragraphs 30(b) to 30(f) of the *Trade-marks Act*.

The Office does not supply pre-printed forms. An application for the registration of a trade-mark shall be presented in the manner specified by the Registrar in the *Trade-marks Journal* and on the appropriate form published by the Registrar in the *Journal*, or in any other form that allows for the furnishing of the same information. A combination of two or more of the forms outlined below could be used, depending on the circumstances.

Form 1 is for seeking registration of a trade-mark in use in Canada. *See subsection 16(1)*.

NOTE: An application for registration of a trade-mark which is a distinguishing guise (section 13), or for a trade-mark which is alleged to have acquired distinctiveness pursuant to subsection 12(2), must be completed in accordance with Form 1.

Form 2 is for seeking registration of a trade-mark made known in Canada. *See subsection 16(1)*.

Form 3 is for seeking registration of a trade-mark registered and used abroad. *See subsection 16(2)*.

NOTE: This form may also be used by a person seeking registration based on a trade-mark which has been applied for and used abroad.

Form 4 is for seeking registration of a trade-mark which the applicant intends to use in Canada by itself, or through a licensee, or by itself and through a licensee. *See subsection 16(3)*.

Form 5 is for seeking registration of a certification mark used in Canada. To register a certification mark registered and used abroad, a combination of Forms 3 and 5 must be used.

Form 7 is for use by the owner of a registered mark who is applying to amend the registration by extending the statement of wares or services covered by the registration to include additional wares or services. *See paragraph 41(1)(c)*.

NOTE: **Form 6** has not been included above because it is not for use by persons seeking registration of trade-marks. It is a guide for registrants seeking to make certain amendments to the register.

II.5 Contents Common to All Applications

II.5.1 Identification and Description of the Mark — Paragraph 30(h), Rule 24, Paragraph 2, Forms

An application for registration of a trade-mark must cover only one trade-mark. *See Rule 24.*

Paragraph 2 of the model form reads:

"The trade-mark is _____."

If the trade-mark is for a word mark only, it should be presented in capital letters or block letters throughout.

The trade-mark applied for must be shown in a drawing if it consists of:

- a) A word or words in special form.
- b) A word or words in a combination of upper- and lower-case lettering and the combined lettering is a feature of the trade-mark.
- c) A word or words which incorporate foreign accent marks such as the German umlaut or the Spanish tilde. (Trade-marks in ordinary block letters which incorporate words alone featuring French or English accents or punctuation will not be considered design marks.)
- d) A composite mark comprising word and design elements.

- e) A mark comprising foreign characters.
- f) A word or words in colour (when colour is claimed as part of the mark).

See sections II.6.2. and II.7.1.1 of this manual.

If the trade-mark is a design, the phrase "is shown in the accompanying drawing" should be inserted and the drawing annexed to the application form. **The trade-mark should not be described.** Examples such as the following would not be acceptable:

- a) The trade-mark is the word AJAX in fancy lettering.
- b) The trade-mark consists of the word AJAX and a star.
- c) The trade-mark consists of the word AJAX and a star as shown in the attached drawing.

Any of the foregoing are properly described by: "The trade-mark is shown in the attached drawing."

The following are also examples of what the examiners should not accept.

- 1) The applicant indicates willingness to accept registration of any of the following trade-marks:

JIMMY'S PIZZA

JIMMY'S HAMBURGERS

JIMMY'S MUFFINS

2) The applicant lists the marks and indicates a preference:

HEAVEN'S FAVOURITE (first choice)

ECSTATICA (second choice)

FABULICIOUS (third choice)

If an application is filed wherein the trade-mark is composed in whole or part of words in more than one language, the trade-mark must be used exactly in the manner in which it is set out in association with the wares and/or services. Registration No. 224,146 provides such an example, the trade-mark consisting of the following words:

LA FONTAINE DE TREVI THE TREVI FOUNTAIN LA FONTANA DI TREVI

The mark was registered in this fashion with the understanding that it would be used in association with the wares exactly in the manner in which it is set out here; the three versions cannot be used separately but must be used together. However, if the mark is composed of two separate versions in two languages, and where those versions are to be used separately in association with wares/services, the applicant must apply to register two marks.

II.5.2 Identity of Applicant — Paragraph I, Forms

II.5.2.1 General Provisions

Examiners must determine that the applicant and the owner of the trade-mark are one and the same person. They must question ownership when there is indication of use of the trade-mark by anyone other than the applicant, for example, by subsidiaries of a company. Note that, pursuant to subsection 50(1) of the *Trade-marks Act*, use accrues to the applicant if, under certain conditions, use of the trade-mark is by a licensee. Wherever applicable, a predecessor in title must be named, indicating previous ownership. For example, in order to establish that use of the applicant's trade-mark in Canada has been continuous, the applicant must provide a list of all predecessors in

title in descending order to cover the period from the date of first use to the present.

II.5.2.2 Individuals

When the applicant is an individual, he/she should provide a surname and at least one given name. Any trading names used should also be incorporated in the applicant's identification.

EXAMPLE: John Doe trading as Doe's Deli.

The applicant must not be identified by a trading style alone. Whenever it appears that the application has been made in the name of the applicant's trading style rather than applicant's own name, the examiners will require an amended application. It must name the legal owner, that is, the individual, as the applicant, followed by the trading style used.

If the examiners suspect that the applicant is not a legal entity (i.e., if Incorporated, Inc., Limited, Ltd., Corporation or Corp. is not indicated after the name), the examiners will query the point and request clarification. A written statement from the applicant or the applicant's agent to the effect that the applicant is a legal entity will suffice. The onus rests ultimately with the applicant to support this claim. A legal entity is considered one that can sue or be sued in the name given in the application. *See sections II.5.2.4. and II.5.2.8. of this manual.*

II.5.2.3 Partnerships

While the office will not register a trade-mark in the name of more than one individual or entity, applications to register may properly be made in the name of a partnership, which is considered a lawful association. Generally, a group of persons conducting a business as a partnership does so under a trading style. It may occasionally happen that two or more persons apply to register a trade-mark, but do not provide a trading name. The examiners will require

confirmation of an existing partnership and will ask that the trading name be given.

In the past, whenever an application was filed in the name of a partnership, or if an assignment was submitted in favour of a partnership, it was necessary to identify each general partner. However, this is no longer the practice, and the onus of determining whether or not a partnership is a legal entity rests with the applicant or registrant. Accordingly, the office accepts applications, assignments, etc., filed in the partnership name only, without reference to the partners. However, the partnership must be identified as such.

II.5.2.4 Associations

Associations which are legal entities (i.e., lawful associations) may acquire trade-mark rights either in association with services performed for members or for wares or services used in commerce. The full name of the association and full post office address of its place of business must be set out, and the laws under which the association was organized (e.g., the laws of Ontario) should be described. However, the examiners will only require the latter when the applicant has neglected to use "Incorporated" or "Limited" or some other method of identifying the association as a legal entity. *See sections II.5.2.2. and II.5.2.8. of this manual.*

II.5.2.5 Joint Ventures

Applications to register a mark may also be made by two or more applicants who are engaged jointly in commercial activities which result in the production of wares or the provision of a service, e.g., a joint venture, which is yet another form of lawful association. The full names and full business addresses of the applicants must be set out in the application. Only the general partners in a joint venture need be named, not any limited partners.

Furthermore, the office no longer requires information establishing the degree of involvement of each partner as was previously the case.

Such information may be required, however, to disclose the procedure by which the trade-mark may be assigned or ownership resolved if the venture is dissolved. This requirement should be dictated by the facts in each case, and the documentation submitted at the time of assignment should deal with this question.

II.5.2.6 Corporations

The instructions for completion of an application do not require that the jurisdiction under whose laws the applicant was incorporated be named. If a corporate seal is affixed to the application, the examiners should check to ensure that the name on the seal matches that given in the application. Furthermore, if the date of incorporation (e.g., 1994) on the seal is subsequent to a claimed date of first use (e.g., Feb. 16, 1993), the applicant should be questioned as to whether a predecessor used the mark since Feb. 16, 1993. The application must, however, contain the full name of the corporation, which may be a private organization, or a public authority such as a municipal or provincial corporation, or a provincial or federal statutory body.

Corporate applicants must apply in the corporate or company name only. A common error is a person filing an application on behalf of a corporation and identifying him/herself either solely or in addition to the corporation or company which he/she represents. In the following examples, all information preceding XYZ Co. Ltd. is considered superfluous and should not be included when identifying the applicant:

Jack Jones, President of XYZ Co. Ltd.

Jack Jones on behalf of XYZ Co. Ltd.

Jack Jones attorney of XYZ Co. Ltd.

Occasionally, an applicant who intends to form a corporate body will apply for registration of a trade-mark which is in use or which is intended for use, and will request that the registration be made in the name of the intended corporate body. Although an as-yet-uncreated business entity cannot be the applicant, the individual may make application to register the mark and may subsequently assign ownership to the corporate body when it is incorporated.

The designation "Co." or "Company" (e.g., Fizz Company or HappyTraders Co.) does not necessarily denote a corporation in a Canadian jurisdiction, and, consequently, confirmation as to whether the applicant is a legal entity should be requested if the applicant is domiciled in Canada. The designation "Co." or "Company" is indicative of incorporated status in the United States and therefore an American entity so identified (with Co. or Company) should not be questioned.

Where a division or component of a corporation is engaged in commercial activity associated with use of a trade-mark, the examiners will accept, as a proper indication of use by a division, the following:

"General Furniture Ltd., operating through its division Bowes Furniture Manufacturing Co."

or

"General Furniture Ltd., sometimes doing business as Bowes Furniture Manufacturing Co."

or

"Bowes Furniture Manufacturing Co., a division of General Furniture Ltd."

II.5.2.7 Use of French or English Form of Corporate Name

Subsection 10(3) of the *Canada Business Corporations Act* states:

"Subject to subsection 12(1), a corporation may set out its name in its articles in an English form, a French form, an English form and a French form or in a combined English and French form and it may use and may be legally designated by any such form."

Therefore an applicant whose name incorporates both a French and English version, e.g., Tourbières Lambert Inc./Lambert Peat Moss Inc., will be recognized as the same entity whether identified only as Tourbières Lambert Inc. or Lambert Peat Moss Inc.

II.5.2.8 Legal Entities

A legal entity is one with sufficient existence in legal contemplation that it can function legally, sue or be sued and make decisions through agents, as in the case of corporations. The applicant for registration of a trade-mark must be a legal entity. *See sections II.5.2.2 and II.5.2.4 of this manual.*

In some instances, the application will show a trading style which in itself appears to be a legal entity, e.g., ABC Co. Ltd. trading as XYZ Limited. The office considers that the trading style may or may not be a legal entity, the prime consideration being that the owner (ABC Co. Ltd. in the example) is a legal entity.

All confusing marks showing ABC Co. Ltd. in the company name as owner will be associated, whether or not the company trades under another name, e.g., ABC Co. Ltd. doing business as XYZ Limited or ABC Co. Ltd. trading as MNO Co. Limited. *See section III.7.2 of this manual.*

II.5.2.9 Foreign Legal Entities

The following list shows designations accepted as being indicative of a legal entity. The examiners should therefore not query this point if an applicant's name incorporates any of the following denotations:

AB - Sweden

Aktiebolag - Sweden

Aktiengesellschaft - Germany

A/S - Denmark
B.V. - Netherlands
de C.V. - Mexico
G.M.B.H. - Germany
Kabushiki Kaisha - Japan
K.G. - Germany
N.V. - Netherlands
Oy - Finland
P.L.C. - United Kingdom
Public Limited Company - United Kingdom
S.A. - France
S.A.R.L. - France
Societa Per Azione - Italy
Société Anonyme - France
Société à Responsabilité Limitée - France
S.P.A. - Italy

II.5.2.10 Wrong Identification of Applicant

Often an application to register a trade-mark is filed in the wrong name and the agent (or applicant) attempts to remedy the error. There are many variations to the incorrect identification of an applicant, and the following examples typify those most often encountered. Office practice with regard to rectifying these errors is reflected accordingly.

- a) The application shows "Incorporated" instead of "Limited," or vice versa; "Company Limited" instead of "Company Inc.," or vice versa; "Company of Canada Ltd." instead of "Company Ltd.," or vice versa, and so on. This is considered to be a minor variation. An affidavit from the applicant to the effect that the erroneous entity did not exist at the date of filing will be required together with the details of the filing error. If this is in order, the Office will accept the variation, which should be contained in a revised application.

- b) The application is filed in the old name of the applicant when a change of name occurred prior to the date of filing the application. The Office will accept this change with the submission of an affidavit setting out the details of the filing error and a revised application showing the correct name of the applicant. This situation is not contrary to Rule 31(a) as the actual "identity" of the applicant has not changed. (Of course, if the change of name occurs after the filing, a change of name document should be filed in the normal manner.)
- c) The agent (or applicant) advises that an assignment took place prior to the filing of the application; however, the application was filed in the old name. The Office will not accept an affidavit attesting to the circumstances surrounding the error as the applicant was not the owner at the date of filing. This situation is contrary to Rule 31(a). The application must be refiled in the name of the current owner.
- d) The applicant is a United States company and is shown as a state corporation — for example, an Illinois corporation — but the Office is advised that this should have been shown as a Delaware corporation. If there never was an Illinois corporation (i.e., this jurisdiction never existed) then the Office will require an affidavit setting out the details of the error before accepting the amendment to show the applicant as a Delaware corporation.

If both jurisdictions (Illinois and Delaware) existed at the time and the applicant filed the application naming the wrong one, then nothing can be done to correct the error as this would change the identity of the applicant, thereby contravening Rule 31(a). The application must be refiled in the name of the correct owner.

- e) When an application is filed in the name of a non-legal entity, e.g., Farm Foods, no affidavit is required to correct the applicant's name to a legal entity, e.g., Mary Smith trading as Farm Foods. Other corrections to the applicant's name may require an affidavit.

II.5.3 Address Of Applicant — Paragraph 30(g)

The applicant in each case must provide the address of his/her principal office or place of business. A separate mailing address may be provided if the applicant does not wish correspondence sent to the foregoing. *See paragraph 30(g)*. If an individual does not have a business address, the address of the place of residence will suffice. Where an applicant for one registration consists of more than one entity, as in partnerships or joint ventures, and no one single place of business, separate addresses for each entity must be supplied.

Residence addresses are acceptable when it is not possible to supply business addresses. If the applicant has no office or place of business in Canada, the address of the applicant's principal office or place of business abroad as well as the name and address of the person or firm named as the representative for service must be provided.

Since there can be no service of documents in a legal proceeding on an applicant/registrant or a representative for service at a post office box, the examiners must ensure that all trade-mark applications include the full street address (street name and number) and the postal code of the applicant or the representative for service. *See also paragraph 38(3)(b), subsection 42(1) and Rule 6.*

Representative for Service

A representative for service is simply any person in Canada appointed by the trade-mark owner to receive and transmit any notice in respect of the application or registration and upon whom service of any proceedings in respect of the application or registration may be given or served, with the same effect as if they had been given to or served upon the applicant or registrant.

Change in Representative for Service

In order to ensure consistency throughout the Trade-marks Office in the treatment of requests for changes in representatives for service, the policy set out below is followed.

In compliance with paragraph 41(1)(a) of the *Trade-marks Act*, any request for a change in representative for service on a registration should utilize Form 6. It may be signed on behalf of the registrant by the registrant's agent.

In the case of an application to extend the statement of wares/services which reflects a representative for service other than the one shown in the registration, the Office will consider this as a request to change the representative for service on the registration to the new one shown in the extension application.

A change in a representative for service on a pending application may be made in writing on behalf of the applicant by the applicant's agent/representative for service.

New representatives for service may appoint themselves. The document need not be signed by the applicant. Official revocation of the previous representative for service is not required.

The examiners will make the necessary corrections to a file if a new appointment of representative for service is incorporated in a revised application. However, if an actual document of appointment to change the representative for service is filed on a pending application, it should be forwarded to the Assignment and Renewal Section for official recording of the new information.

II.5.4 Signature of Applicant

A signature is no longer required for filing a trade-mark application. However, the applicant or agent may sign the application if he/she wishes to. The Trade-marks Office will also accept trade-mark applications and letters of prosecution which have been stamped with facsimile signatures such as those currently used by a number of firms.

Correspondence and revised applications sent by facsimile transmission are acceptable.

The examiners will question any discrepancy between the name of the applicant as set out in the application or shown in the corporate seal and the signature on the application, and they must be fully satisfied on this account before proceeding.

An application by a partnership may be signed by one of the partners if the partners are named. If the partnership comprises general and limited partners, the application may be executed by a partner who can bind the partnership. An application by a corporation may be signed by an officer authorized to sign on its behalf, and the title of the signing officer should be provided. A trade-mark agent may also sign on behalf of the foregoing entities.

The signature of each of the parties in a joint venture may be affixed to the application, unless it is signed by their trade-mark agent.

II.5.5 Description of Wares or Services — Specific Wares in Ordinary Commercial Terms — Paragraph 30(a)

Paragraph 30(a) of the *Trade-marks Act* clearly states that an application must contain "a statement in ordinary commercial terms of the specific wares or services in association with which the mark has been or is proposed to be used." Where there are no ordinary commercial terms to identify the wares to be associated with the mark, the applicant will use common sense to briefly and accurately describe them as to composition and function. Specific commercial terms may identify several kinds of wares or services which are closely related or which possess similar characteristics, as in the following examples: women's lingerie, drapery hardware, and computer hardware.

Commercial terms which identify items or groups of items only loosely related and/or dissimilar are too broad to be suitable for naming specific wares. For example, "women's clothing" is an unacceptable classification, encompassing a large and not always consistent assortment of clothing items. "Women's lingerie," however, is acceptable because it designates a more or less well-defined collection of female clothing. In every case the examiners must be particularly concerned with the manner in which the wares or services have been described and will request additional information if there is any confusion concerning their description or the manner in which they are to be used.

II.5.5.1 General Classes of Wares & Services — Paragraphs 30(b) and (c)

Wares or services must be grouped into general classes when the application is applied for in relation to wares or services not falling within one general class. Applications based on proposed use do not require breaking down the wares or services into general classes. Pursuant to paragraphs 30(b) and (c), a date of use or making known is required with each of the general classes of wares or services described in the application.

Unlike other countries, Canada does not follow a formal classification system for grouping wares or services or identifying them for registration by a classification number (as, for example, in the U.S.). Instead, the applicant who is seeking to register a mark groups the specific wares or services to be associated with it into general classes. Sources such as the *Canadian Trade Index* and the *International Classification of Goods and Services* can be used as aids in determining classes for grouping wares or services but are by no means definitive guides. The examiners will be guided by the principle that the general classes may include groups of specific wares, as follows:

- a) They have common descriptive properties or can be described by ordinarily used class names.

For example:

PAINTS AND PRESERVATIVES:

paints, primers, wood preservatives, paint strippers

ELECTRONIC HOME ENTERTAINMENT PRODUCTS:

radios, television apparatus, stereo units, tape recorders

or

b) They are closely related in character or function.

For example:

COSMETICS:

face and body powders, nail polishes, lipsticks, rouges,
perfumes, foundation creams

TOILET PREPARATIONS:

personal deodorants, toothpaste, shampoo, foot lotions, hand
creams

or

c) They may be found in the same areas or departments of
retail outlets.

For example:

CLEANING PREPARATIONS:

household cleansers, detergents, laundry preparations,
furniture waxes, toilet bowl cleansers, window
cleaners

EXTERMINATING PRODUCTS:

insect repellents, insecticides, germicides, rodenticides,
mousetraps

If services are involved, the same guidelines must be applied. "Financial Services," for example, might be used and would encompass an unspecified class of services related to mortgages, trust funds, the selling of stocks and bonds and related counselling activities. The specific wares or services falling within the general class must be clearly identified. *See Form I, note (g)*. Registration of a trade-mark does not limit the number of wares or services with which it may be associated, so that one

application could name several groups of specific wares or services falling within a plurality of classes.

Applicants who only propose use of their trade-mark in Canada or who base their right to registration on use and registration abroad, are not required to segregate wares or services according to general class, since no rights based on use in Canada have as yet been acquired. Whatever the circumstances the requirement to name specific wares or services remains.

II.5.6 Naming Date of First Use or Making Known — Paragraphs 30(b) or (c)

Consistency in the classification and grouping of wares and services into classes is extremely important as regards the date of first use of those goods. When an applicant seeks to register a trade-mark that is in use in Canada or which has been made known, it is advantageous to set down the earliest date of use or making known which can be substantiated in association with the wares or services falling within each general class.

This practice enables the applicant to extend the statement of wares or services at any time in accordance with paragraph 41(1)(c), and, as long as the statement is for wares or services of the same general class, the applicant may claim the date of first use as specified for the general class in the initial registration. *See sections II.7.1.2 and II.7.2.2 of this manual for details.*

II.5.6.1 Use of a Trade-mark

The concept of use is important in order to establish a person's right to registration of a trade-mark and to ensure maintenance of that registration once obtained. *See paragraph 18(1)(c) and section 45.*

Section 2 defines "use" in relation to a trade-mark to mean "any use that by section 4 is deemed to be a use in association with wares or services."

Subsection 4(1) states that "a trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred."

As the words "normal course of trade" imply, the use must be by way of a normal commercial transaction.

This provision requires that, at the time of the transfer of the property in or possession of the wares in the normal course of trade, the trade-mark be marked on the wares or on their packaging or be in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

See the following cases:

Gordon A. MacEachern Ltd. v. National Rubber Co. Ltd. (1963), 41 C.P.R. 149.

Union Electric Supply Co. Ltd. v. Registrar of Trade Marks (1982), 63 C.P.R. (2d) 179.

The word "trade" in subsection 4(1) contemplates some payment or exchange for wares supplied. Free distribution of promotional material or advertising gimmicks displaying the mark may not be considered trade use.

See the following cases:

C.I.S. Ltd. v. Sherren (1978), 39 C.P.R. (2d) 251 at pp. 257-258.

Joseph E. Seagram & Sons Ltd. v. Corby Distilleries Ltd. (1978), 42 C.P.R. (2d) 264 at pp. 267-268 following *Hospital World Trade Mark* [1967] R.P.C. 595 at pp. 598-599.

Ports International Ltd. v. Registrar of Trade Marks (1983), 79 C.P.R. (2d) 191 at p. 193.

Subsection 4(2) states that "a trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services."

This implies that services are in fact being provided or offered in Canada. Consequently services that are advertised in Canada must actually be performed in Canada.

See the following cases:

Porter v. Don the Beachcomber (1966), 48 C.P.R. 280 at p. 287

Marineland Inc. v. Marine Wonderland and Animal Park Ltd. (1974), 16 C.P.R. (2d) 97 at p. 109.

There is no definition of "services" in the statute. Consequently, the statute makes no distinction between primary, incidental or ancillary services. From the case law it would seem that as long as some members of the public — some consumers or purchasers — receive a benefit from the activity, it is a service.

See the following cases:

Kraft Ltd. v. Registrar of Trade Marks (1984), 1 C.P.R. (3d) 457.

Carling O'Keefe Breweries of Canada Ltd. - Les Brasseries Carling O'Keefe du Canada Ltée trading as Carling O'Keefe Breweries v. Anheuser-Busch, Inc. (1985), 4 C.P.R. (3d) 216.

Subsection 4(3) states that "a trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares."

This provision requires that the trade-mark be affixed in Canada to the wares or their packaging when the wares are exported from Canada.

It has been stated that in the context of the *Trade-marks Act* as a whole, the words "exported from Canada" must be taken to mean "sent from Canada to another country in the way of commerce," or "transported from Canada to another country in the course of trade."

See the following cases:

Molson Companies Ltd. v. Moosehead Breweries Ltd. (1990), 32 C.P.R. (3d) 363 at pp. 372-373.

National Sea Products Ltd. v. Scott & Ayles (1988), 19 C.P.R. (3d) 481.

Where wares and services are stated to be used in association with a trade-mark, the examiners may, upon examining the application and material filed, be led to the inference that the mark is not actually being used as a trade-mark or is being used as a trade-mark, but not as stated in the application. If, for example, an application is filed for a trade-mark based upon use in association with the wares "rakes" and for the services of promoting the sale of such rakes, the examiners should enquire whether the use of the mark in association with the services complies with subsection 4(2).

In the same manner, an application may be filed for use of a trade-mark in association with restaurant services. If the same application contains a statement of use of the mark applied for in relation to menus and serviettes, the examiners should inquire if the applicant sells menus and serviettes in the normal course of trade in association with the mark applied for. If the applicant is not offering the wares for sale in the normal course of trade, the claim of use of the mark in association with wares should be deleted.

Additionally, an applicant may apply for wares such as a letterhead, business cards or signage, but, although the trade-mark may be displayed on these items, they are not likely to be for sale to the public. Accordingly, the examiners should question whether such use falls within the parameters of "use" as described in section 4 of the *Trade-marks Act*.

II.5.7 Applicant's Statement of Claim of Entitlement — Paragraph 10 of Form 1 — Paragraph 30(i)

A final consideration is whether or not the applicant is satisfied "that he is entitled to use the mark in Canada in association with the wares or services described in the application." This can be looked at as a type of contract between the applicant and the public, establishing that all information and supporting evidence, including revisions or additions of same, have been submitted in good faith, and that the application as it stands is approved by the applicant. The examiners can then proceed with the examination of the mark.

II.6 Content Appearing in Some Applications

II.6.1 Predecessor in Title — Paragraphs 30(b), (c) and (d) — Paragraphs 4 and 5 of Forms

In order to establish use of a trade-mark prior to the actual use by the applicant, a list of all predecessors in title covering the time from the date of first use to the present must be provided.

II.6.2 Drawings — Paragraph 30(h) and Rules 27(1) and 28

Paragraph 30(h) stipulates that a trade-mark application shall contain a drawing of the trade-mark and such number of accurate representations of the trade-mark as may be prescribed unless the application is only for the registration of a word or words not depicted in a special form.

A drawing is required if a trade-mark is presented for registration in other than capital letters or block letters throughout. Drawings will be required in the following instances:

- a) The mark is a word composed of any lower case letters.
- b) The word(s) appears in any special arrangement other than on horizontal lines.

- c) A claim to specific colour or colours is made in respect of the whole or part of the mark.
- d) The word(s) includes foreign language accents other than French accents. (Because Canada recognizes both French and English as its official languages, accents used in the French language are not considered to be design characteristics although accents in other languages are.)
- e) The mark is comprised of foreign characters. (NOTE: Pursuant to Rule 29, both a translation and transliteration must be furnished and will be included in the particulars of the application when advertised.)

See sections II.5.1 and II.7.1.1 of this manual.

Furthermore, the Office no longer considers that an application for the registration of a word or words is in special form merely because it includes any of the following punctuation marks:

period, question mark, exclamation mark, comma, semicolon, colon, ellipsis, parentheses, brackets, quotation marks, single quotation marks, inverted commas, dash, asterisk, diagonal and underscore.

Accordingly, the inclusion of any of the foregoing punctuation marks will not render the trade-mark to be in special or design format as was the previous practice.

All word marks must be typed on the application form in upper-case letters with no space left between the letters of each word, unless, of course, that is a feature of the mark.

II.6.2.1 Form and Size — Rule 27(1)

Where a drawing of a trade-mark is required, it shall be no larger than 2 3/4 inches by 2 3/4 inches (7 cm by 7 cm), and may be smaller as long as it is clear. The size is limited so as to meet the space requirements for reproduction in the *Trade-marks Journal*. The drawing should not include any matter that is

not part of the trade-mark. It may be on paper that satisfies the requirements of section 13. It shall be in black and white to ensure satisfactory reproduction, and of a lasting quality, to withstand usage.

The Trade-marks Office is now electronically capturing all designs submitted with applications and making these available for viewing and searching through electronic means, both in the Trade-marks Public Search Room and through external suppliers. To help ensure that the Office can capture a good quality image of the design, the black and white original should be produced by a high resolution laser printer or good quality photocopier, or professionally printed by a printing house. If the design is hand drawn, a pen and ink drawing in black on white will work well. Lines and edge definitions should be firm and sharp, and filled areas should be in solid black except where lines are used to indicate colour.

The drawing is a representation of the essential constituents of the trade-mark and therefore should not be enclosed in a rectangle or circle or the like, unless these are features of the mark as used or proposed for use. Neither should the following appear on the drawing: the words "Marque de fabrication," "Marque Déposée," "MD," "Trade-mark," "TM," "Trade-mark Pending," or "Trade-mark Registered," in full, or in abbreviated form, or the "R" symbol enclosed in a circle.

Matter which may be associated with trade-marks on the packages or containers in which wares are offered for sale, but which is not a component of the mark, should not appear on the drawing. Examples of such matter includes listings of ingredients, size, weight, volume, alcoholic content, the address of applicant, phone and fax numbers. The examiners may either ask for authorization to delete such matter from the drawing on file or request a revised drawing.

II.6.2.2 Colour — Lining Drawings for — Rule 28

Where colour is an integral part of the trade-mark for which protection is sought, the applicant should so indicate by describing the colour claims and, if such description is not clear, by lining the drawing for colour in accordance

with the colour chart shown in the *Trade-marks Regulations*. See Rule 28(2). Stippling, light and heavy lining, shades of grey, or anything similar which may appear on the drawing will not be regarded as possible colour features of a trade-mark by the examiners.

II.6.2.3 Colour — Word Description

If the application contains a colour description which is readily visualized and clear, the examiners will not require lined drawings.

Example 1

"The upper band is yellow.
The central band is green.
The lower band is red."

Example 2

"The letters are blue on a white background.
The lower panel is red with the leaf in white."

If, however, the application contains a colour description which is not readily visualized, the examiners will request that lined drawings be furnished.

Example

"The leaves and border are green and orange.
The flowers and ribbon are pink, yellow and mauve."

If the drawing furnished with the application is lined and the application contains no reference to a colour claim, the examiners will inquire as to the purpose of the lining on the drawing, i.e., whether colour is a feature of the trade-mark. The applicant's response would be a statement to the effect that:

- 1) "Colour is claimed as a feature of the trade-mark and the drawing is lined for the colour(s)..." (Specify colour.)

(This is understood to be a claim to colour as an integral part of the trade-mark, and therefore will be included in the particulars of the application when advertised, and of the registration.)

or

- 2) "The lining is a feature of the mark but does not indicate colour."

or

- 3) "The lining is used to indicate shading but colour is not a feature of the mark."

The latter statements will also be included in advertisement and registration particulars since they serve to clarify the purpose of the lining.

If an applicant states that the drawing is lined for colour but colour is not claimed as a feature of the mark, the examiners will publish the mark with the following statement: "The drawing is lined for the colour red but the colour red is not claimed as a feature of the trade-mark."

NOTE: If the applicant relies on subsection 16(2) as a basis and the application or registration abroad includes a colour claim, that same claim should be incorporated in the Canadian application as the applicant may not obtain broader rights in Canada than those enjoyed in the country of origin.

II.6.3 Specimens — Rule 29(c)

While applicants no longer have to file specimens, Rule 29(c) provides that the Registrar may require an applicant to furnish a specimen of the trade-mark as used. Specimens are required in some cases since the information provided on actual labels, packages, displays and the like may help the examiners to more clearly understand the nature of the wares or services associated with the trade-mark. If there is any discrepancy between the trade-mark as applied for and the specimen submitted, the examiners must question the applicant before proceeding.

Discrepancies between the trade-mark applied for and that shown in the specimen which would not affect the acceptability thereof include differences in script used (as long as all the words are there) or the positioning of design features (as long as all of the elements are there). Specimens showing additional matter in the trade-mark may be acceptable, however, the deletion of matter is not.

EXAMPLE

Trade-mark: AJAX

A specimen showing AJAX*** would be acceptable. However, if the trade-mark is AJAX***, a specimen showing AJAX only would not be acceptable.

See *Saccone & Speed Ltd. v. Registrar of Trade Marks* (1982), 67 C.P.R. (2d) 119. This case discusses issues concerning differences between the trade-mark as registered (ALOHA) and use of the mark.

If colour is claimed as a feature of the trade-mark in the application, the specimen submitted should be in the colours claimed.

When a specimen is required, it must comply with the size requirements of Rule 13 so that it can be placed in the relevant file. When actual labels, containers or displays showing the trade-mark as used cannot be sent because of size or material limitations, photographs of the wares, labels, containers, etc., will suffice. Specimens such as

stampings, dies, invoices, or mailing labels may be acceptable as long as they show the trade-mark as used.

Applicants should not send valuable items or containers such as aerosol spray cans, the former because they risk being damaged or lost, the latter because they are dangerous if punctured or exposed to heat. Business cards or letterheads may be submitted as specimens to show trade-mark use in association with services. An applicant may also submit a flyer or an invoice as long as it shows the mark as used in association with the services. In certain instances either would be acceptable to show use in association with wares.

The name (if any) shown on the specimen should be checked to ensure that it is that of the applicant or a predecessor. Confirmation from the applicant that a name shown on a specimen is that of a licensee is also acceptable.

II.6.4 Disclaimers — Section 35, Forms, Paragraph 3

When a certain portion or portions of a trade-mark are not registrable, disclaimer clauses may often be inserted as amendments on applications for registration if not already entered at the time of filing. They will be entered in paragraph 3 of the form, immediately below the paragraph in which the trade-mark is described. This provision, as set out in section 35 of the *Trade-marks Act*, allows for some flexibility in the choice of material to be used in a trade-mark, but requires the applicant to "disclaim the right to the exclusive use apart from the trade-mark of such portion of the trade-mark as is not independently registrable...." *See section IV.9 of this manual for a more thorough treatment of disclaimers.*

II.7 Contents of Specific Applications

II.7.1 Applications Based on Use in Canada — Subsection 16(1) and Paragraph 30(b), Form 1

Under the provisions of paragraph 30(b) an applicant may submit an application to register his/her trade-mark if it has been used in Canada in association with the wares or services specified and as long as the applicant can provide a date of first use.

NOTE: Pursuant to Rule 32(c), after advertisement, an applicant will not be permitted to change the application from one alleging use or making known to one for a proposed trade-mark.

II.7.1.1 Type of Mark

Trade-marks are used for the purpose of distinguishing the wares or services of one person from the wares or services of others and may comprise words or designs or a combination of words and designs. A word mark describes any trade-mark made up of words, letters, numerals or a combination thereof, presented in ordinary block letters on the application form. Design marks, on the other hand, are not made up of a word or words only and may include representations of objects, or figures or combinations of objects and/or figures or combinations of objects and/or figures and words, numerals or letters in special form, colour or arrangement. *See sections II.5.1 and II.6.2 of this manual.*

II.7.1.2 Naming Date of First Use

It is not acceptable for the applicant to use an expression such as "on or about" a certain date to identify dates of first use, since this is not precise enough. The reason for requesting exact dates is very obvious in situations in which two or more trade-marks which are the subject of applications based on use or making known in Canada are found to be confusing, thus necessitating a determination as to the person entitled to registration. *See subsection 16(1).*

The following prepositions or prepositional phrases are acceptable when used in association with dates: "since," "since before," "since at least," "since as early as," and "since at least as early as."

When naming a date of first use, it is in the applicant's own interest to be as specific as possible, e.g., naming the day of the month, as well as the year. The following sets out the minimum date particulars required according to the time of filing:

Filed in current month

- name the day, month and year

Filed in current year, but not current month

- name the month and year

Filed in any year prior to current year

- name the year only

When only the month and year are named, the last day of the month will be regarded as the effective date for the purpose of determining entitlement in cases of confusion. When only the year is named, December 31st of that year will be the determining date.

NOTE: Drawings and Specimens

See sections II.6.2. and II.6.3. of this manual for guidelines on submitting drawings and specimens.

II.7.2 Applications Based on Making Known in Canada — Subsection 16(1) and Paragraph 30(c), Form 2

A Form 2 application will be submitted when the applicant has not used a trade-mark in Canada but has made a trade-mark well known in Canada (*see section 5*) in relation to wares or services by using the trade-mark in association with the wares or services in a Union Country, and by distributing or advertising the mark in association with the wares or services in Canada.

One cannot base a claim on "made known" if one is also claiming "use" for the same wares/services on identical dates. However, these two claims will be accepted if they are for different wares/services or if the "made known" claim precedes that of the "use" claim for the same wares/services. An application which contains a "made known" claim and a "proposed use" claim for the same wares/services is acceptable.

A change in the basis of an application from "made known" to "use" in Canada is not acceptable notwithstanding that each claim is treated equivalently in determining entitlement under subsection 16(1). Section 5 of the *Trade-marks Act* states that:

"A trade-mark is deemed to be made known in Canada by a person only if it is used by that person in a country of the Union, other than Canada, in association with wares or services...."[underlining ours]

Furthermore, paragraph 30(c) of the same Act reads:

"...in the case of a trade-mark that has not been used in Canada, but is made known in Canada, the name of a country of the Union in which it has been used by the applicant or his named predecessors in title, if any, and..."
[underlining ours]

Section 5 and paragraph 30(c) illustrate the critical differences between the two bases: one alleges use in Canada and the other does not. This distinction would therefore not allow for the interchange of a "made known" claim to a "use" claim unless the date of first use is subsequent to the date of making known.

II.7.2.1 Manner of Making Known in Canada — Section 5

Apart from stating that the mark has been used in a particular Union Country other than Canada in association with the wares or services, the applicant must be specific about the manner of making the mark known in Canada. One or more of the following statements may be made:

- a) The trade-mark has been made known in Canada by reason of the distribution of the wares in association with the trade-mark in Canada.
- b) The trade-mark has been made known in Canada by reason of the advertising of the wares or services in association with the trade-mark in printed publications circulated in Canada in the ordinary course of trade among potential dealers in or users of such wares or services.
- c) The trade-mark has been made known in Canada by reason of the advertising of the wares or services in association with the trade-mark in radio or television broadcasts ordinarily received in Canada by potential dealers in or users of such wares or services.

II.7.2.2 Naming Date of Making Known

The application must also include a statement about the date of making known, and the applicant must be precise in the manner outlined in section II.7.1.2 for applications based on "Use in Canada."

NOTE: Drawings and Specimens

See sections II.6.2 and II.6.3 of this manual for guidelines on submitting drawings and specimens.

II.7.3 Applications Based on Application or Registration in or for a Union Country and Use Abroad - Subsections 16(2) and Paragraph 30(d), Form 3

II.7.3.1 Data Appearing in Canadian Application

Under the provisions of subsection 16(2), an applicant who has applied for or registered a trade-mark in or for another Union country and used it in any country may file to register his/her mark in Canada.

In accordance with paragraph 30(d), the Canadian application must contain particulars of the corresponding foreign application or registration as follows:

- 1) The registration date, and number of the registration or the serial number and the filing date of the application.

- 2) The country of the Union in or for which the mark was registered or applied for. See section 2 of the *Trade-marks Act* for a precise meaning of "country of the Union." See also the appendix at the end of this chapter listing member countries of the Union. This list is periodically updated.

NOTE: A registration in **Benelux** (economic union of **Be**[lgium], **Ne**[therlands], and **Lux**[embourg]) is equivalent to a registration in each of the three countries — Belgium, Netherlands and Luxembourg.

3) The name of a country in which the trade-mark has been used in association with the specific wares/services. If the trade-mark has not been used in a single country in association with all the specific wares/services, but has been used in one country in association with some of them and in another country in association with others, the names of two (or more) countries should be provided.

4) The "country of origin" of the applicant. *See section 2 for a definition of "country of origin."*

If the address for the applicant shows a country (e.g., Japan) which differs from that upon which the 16(2) claim is based (e.g., United States), the examiners will request confirmation that the applicant has a real and effective industrial or commercial establishment in the United States in order that the claim to the provisions of subsection 16(2) of the *Trade-marks Act* may be entertained.

5) In the first part of paragraphs 4, 4a, 5 and 5a of Form 3, the wares and services in association with which the trade-mark application has been filed or the trade-mark registered should be listed as shown on the certified copy. In the second part of these paragraphs, the wares and services in association with which the trade-mark has been used in any country should be listed. The wares/services in the second part should be defined specifically in ordinary commercial terms in accordance with paragraph 30(a).

II.7.3.2 Date of Entitlement

When an application for registration of a mark is based on an application or registration in or for a Union country and on use abroad, the critical date to be used in determining the person entitled, where there is a confusing co-pending application, is the date of filing of the application in Canada. *See subsection 16(2)*. This is so, provided the application does not include a convention priority claim. *See section III.8.1 of this manual*.

NOTE: Drawings and Specimens

See sections II.6.2 and II.6.3 of this manual for guidelines on submitting drawings and specimens.

II.7.3.3 Statement of Use — Paragraph 30(d)

In the event that the application in Canada is based on an application or registration in or for a Union country, and if the trade-mark has neither been used nor made known in Canada, the applicant must specify the name of the country in which he/she used the trade-mark in association with each of the general classes of wares or services described in the application. The country of use need not be confined to a Union country.

If the trade-mark has been used or made known in Canada, no information concerning use is required by paragraph 30(d). However, information concerning the use or making known in Canada would have to be provided to comply with paragraphs 30(b) and (c).

II.7.3.4 Certificate of Corresponding Registration — Subsection 31(1)

When a Canadian application is based on an application or a registration in or for a Union country, the mark may be examined but may not proceed to advertisement until a certified copy of the registration is filed in Canada. The applicant must furnish a copy of such registration certified by the office in which it was made, together with a translation thereof into English or French, if it is in any other language. Registration may be obtained in Canada based on use in the United States and registration on the Principal or the Supplemental Register.

Subsection 31(1) of the *Trade-marks Act* is clear in requiring that the certified copy be issued by the office in which it is made. Consequently, alternatives such as the submission of a notarized copy or the submission of a photocopy of a foreign registration accompanied by an affidavit attesting to its authenticity, are not acceptable.

Owners (other than applicant) Shown on Certified Copy

A certified copy of the corresponding foreign registration which stands in the name of the applicant's predecessor in title is acceptable, as subsection 16(2) states "...that the applicant or the applicant's predecessor in title has duly registered in or for the country of origin of the applicant and has used in association with wares or services is entitled..." The Act and Regulations do not contain a requirement that the foreign registration stand in the applicant's name. However, the applicant must indicate in the application (paragraphs 4, 4A, 5, 5A of Form 3) that he/she is relying on the predecessor in title named in such application/registration.

However, if an application is filed in the name of an applicant both in Canada and the foreign country, and the certified copy when submitted shows that the foreign registration is no longer in the name of the original applicant, the 16(2) claim will no longer be acceptable. This is because the foreign registration stands in the name of a new owner and not that of the applicant or the predecessor.

The Canadian Trade-marks Office does not issue a registration in the name of more than one owner. However, in France, registration can be obtained in the name of two or more owners. See files 381,286; 403,094; and 566,907 where the agents submitted convincing arguments which the Office accepted in support of the claims made under subsection 16(2). Nevertheless, examiners should continue to carefully review applications in which a certified copy showing more than one owner is filed to support a 16(2) claim.

It may be necessary for the examiners to request confirmation of an applicant's incorporating jurisdiction in order to ascertain the acceptability of a foreign registration submitted in support of a 16(2) claim. For example, if a United States registration shows the owner as ABC Limited (a New York Corporation) and the applicant is identified only as ABC Limited and does not have a New York address, confirmation that the applicant is also a New York corporation would be required. This is because ABC Limited incorporated under any jurisdiction other than New York would be considered an entity separate and apart from that identified in the United States registration and, consequently, the 16(2) claim would be unsupported in this case.

Trade-mark Shown on Corresponding Registration

In order to support a 16(2) claim, the trade-mark shown on the corresponding registration must be identical in all respects to that shown in the application. Paragraph 30(d) of the *Trade-marks Act* states: "...in the case of a trade-mark that is the subject in or for another country of the Union of a registration or an application for registration by the applicant or his named predecessor in title on which the applicant bases his right to registration...." [underlining ours]

Therefore any discrepancy between the mark applied for in Canada and that registered abroad would mean the applied for mark is no longer the one in the foreign registration. For example, a design mark applied for in Canada would not be supported by a certified copy which showed the identical features, but in different positions. However, differences in the registration which are due only to another office's different way of showing word marks in standard characters are not relevant. Examples of this are when foreign registrations show a word mark wherein the first letter of the word is capitalized followed by lower case letters (such as shown in a German registration) or when the foreign registration shows a word mark in what appears to be bolder upper case lettering than that shown in the corresponding Canadian application.

NOTE: A certified copy showing a trade-mark which differs in respects that do not affect its identity or alter its distinctive character will be accepted in support of a claim to the benefit of section 14. Therefore, there should be no combination claim (i.e., 16(2) and 14). The section 14 claim must be made exclusive of a 16(2) claim in order to permit reliance on a slightly varied version of the applied for trade-mark.

State Registrations

Occasionally, an applicant will seek to base a 16(2) claim on a registration obtained in one of the individual American states (e.g., North Carolina).

However, such a claim cannot be entertained as section 2, subsection 16(2) and paragraph 30(d) of the *Trade-marks Act* clearly indicate that a registration relied upon for the purposes of subsection 16(2) must be one that has been issued in or for a Union country. Obviously, a state registration would not meet the foregoing criteria as neither would North Carolina be a member of the Union for the Protection of Industrial Property nor could such a registration be considered to have been effected in applicant's country of origin.

Foreign Registrations Covering a Number of Trade-marks

If an application for a single trade-mark is filed based on a subsection 16(2) claim and the corresponding foreign registration comprises a series of design or word trade-marks (one of which is the applicant's trade-mark), the foreign registration will not serve to support the claim, as the trade-mark differs from that which was registered.

II.7.3.5 Priority Filing Date — Section 34

Under the terms of the Convention, an applicant (or his/her successor-in-title) who is a member of a country of the Union may file an application for registration of a mark in Canada, and may claim as the filing date, the date he/she filed an application in or for the Union country for the same or substantially the same mark for use in association with the same kind of wares or services. This applies only to members of Union countries and provided the following conditions are met:

- a) A declaration, setting out the date on which and the country of the Union in or for which the earliest application was filed is included in or accompanies the original application filed in Canada. The applicant will not be allowed to amend the application after the initial filing by claiming a priority filing date, as this would be considered contrary to section 34.

- b) The applicant provides particulars of the application made in or for the Union country which has the earliest filing date. The Canadian

application must be filed within six months of this date. No extension is permitted. However, if the last day within which the applicant could file the application in Canada is a Saturday, Sunday or statutory Canadian holiday, the applicant may file on the first business day to follow and the priority filing date will be recognized. *See subsection 66(1).*

- c) The applicant or predecessor in title who filed the earlier application in or for the Union country must have been a citizen or national of or domiciled in or have had a real and effective industrial or commercial establishment in the Union country at the date of filing of the application.

NOTE: The requirement to file a certified copy of every prior application relied upon within three months of filing the application in Canada was eliminated effective February 28, 1992, the date on which the *Miscellaneous Statute Law Amendment Act* was brought into force repealing paragraph 34(c) of the *Trade-marks Act*. However, a new paragraph 34(c) was subsequently introduced, and while the filing of a priority document is no longer mandatory, evidence may be requested to establish fully the applicant's right to priority.

II.7.4 Applications Based on Proposed Use in Canada — Subsection 16(3) and Paragraph 30(e), Form 4

II.7.4.1 Explanation of Proposed Use Provision

Paragraph 30(e) provides for the submission of an application to the Trade-marks Office based on proposed use of a trade-mark in Canada. Thus, a person may apply for registration of a trade-mark on the basis of intended use in Canada using the following statement:

"The applicant by itself or through a licensee or by itself and through a licensee intends to use the trade-mark in Canada in association with...."

Actual use of the trade-mark in Canada in association with the wares or services applied for must commence before registration. *See subsection 40(2).*

NOTE: An applicant will not be permitted to change the basis of the application from reliance on proposed use in Canada to reliance on use and registration abroad after advertisement, pursuant to Rule 32(d) and also for the following reasons:

- 1) There is no provision in the *Trade-marks Act* for re-advertisement. This would result in the opposition proceedings - an integral procedure - becoming unavailable. A person wishing to file an opposition in view of the change in the basis of an application would be deprived of doing so.
- 2) Subsection 37(1) permits the Registrar to reject an application if it does not comply with the provisions of section 30 or if the applicant is not a person entitled to registration. Section 30 requires a person relying on use and registration abroad to set out the particulars of such registration and use in the application. Thus, a determination in this regard under section 37 can only be made at the point of advertisement. Also, in support of this claim, subsection 31(1) requires that a copy of the corresponding foreign registration be filed before advertisement. See *McDonald's Corp. v. Deputy Attorney-General of Canada* (1977), 31 C.P.R. (2d) 272. Therefore, such an amendment would be contrary to subsection 31(1).
- 3) To permit such an amendment after allowance would be contrary to subsections 40(2) and (3) since the provisions of these sections are mandatory and the Registrar must proceed accordingly. The bases for refusal of such an amendment are Rule 32(d) and subsection 31(1) and, in addition, subsections 40(2) and (3), where the trade-mark has been allowed.

II.7.4.2 Advantage of Proposed Use Application

This provision allows an applicant to determine the registrability of the mark before embarking on costly advertising campaigns or before investing large sums on labelling or packaging materials. The applicant also obtains an entitlement date corresponding to the day the application is filed in Canada. *See subsection 16(3).*

II.7.4.3 Declaration of Use — Subsection 40(2)

After the application is allowed, the applicant must, in accordance with subsection 40(2), file a declaration of use, stating that use of the mark in Canada has commenced in association with all or some of the wares covered by the application. If the trade-mark has only been used in association with some of the wares or services, the mark may only proceed to registration in respect of those wares or services. If the applicant itself does not intend to use the trade-mark, the declaration of use required can be signed by the applicant's licensee.

A licensee is an entity licensed by or with the authority of the owner of a trade-mark to use the trade-mark in a country. The owner has, under the licence, direct or indirect control of the character or quality of the wares or services. Accordingly, the use, advertisement or display of the trade-mark in that country by that entity, has, and is deemed always to have had, the same effect as such a use, advertisement or display of the trade-mark in that country by the owner. *See subsection 50(1).*

The format in which a Declaration of Use should be set out is as follows (use of the identical format is not required provided that the same information is given):

DECLARATION FORM

Application No.: _____

Trade-mark: _____

I, _____ of _____

_____ in the Province of _____

hereby declare:

1. THAT I am the _____ (officer's

title) _____ of _____

_____ (Applicant)

2. THAT since the filing of application serial No. _____ for registration of the trade-mark claimed therein, the applicant, by itself or through a licensee, or by itself and through a licensee, has commenced the use in Canada of the trade-mark claimed in the said application in association with the (enter the wares used and/or the services performed here):

EXECUTED at _____ this _____ day of

_____, 19____.

(Officer's signature)

II.7.4.4 Abandonments under Subsection 40(3)

Pursuant to subsection 40(3), an application for a proposed trade-mark is deemed to have been abandoned if a declaration of use is not received by the later of:

- a) six months after the Notice of Allowance by the Registrar, referred to in subsection 40(2); and
- b) three years after the date of filing of the application in Canada.

The Notice of Allowance forms issued by the Office will specify the date for response based on the foregoing criteria.

In accordance with section 47, the applicant may request a six-month extension upon expiration of the time limit as long as the request is justified. One-year extensions will be granted upon request when an applicant is awaiting approval from Health Canada on a pharmaceutical product.

II.7.4.5 Specimens — Proposed Use

While the filing of specimens is no longer mandatory in all cases, Rule 29(c) provides that the Registrar may require an applicant to furnish a specimen of the trade-mark as used. Therefore, the applicant may be required to submit a specimen when filing a declaration that use in Canada has commenced. *See section II.6.3 of this manual for guidelines on submitting specimens.*

II.7.4.6 Additional Comments Regarding Applications

The forms to be used in making application for registration of a trade-mark set forth the minimum information which must be included. Any additional information must relate directly to the trade-mark for which registration is

sought and must not be published in the *Trade-marks Journal*. The examiners will require the deletion of any information considered extraneous.

II.7.5 Applications for Certification Marks — Sections 23, 24 and 25 and Paragraph 30(f), Form 5

II.7.5.1 Definition of Certification Mark — Section 23

According to paragraph 30(f), an applicant may file an application to register a certification mark as long as he/she is not engaged in the manufacture or sale of wares or the performance of services such as those covered by the mark. (*See section 23.*) Prior to application, the applicant must set the standards relative to those wares or services and license another or others to use the trade-mark in commerce.

A certification mark may be obtained where the mark is used to distinguish: 1) wares or services of a defined standard with respect to the character or quality of the wares; 2) the working conditions under which the wares have been produced or the services performed; 3) the class of persons by whom the wares have been produced or the services performed; or 4) the area within which the wares have been produced or the services performed.

See the *Canadian Patent Reporter*, 1st Series, Vol. 26, p. 115, an article entitled: "Problems and Practice under the Trade Marks Act" by Gordon F. Henderson, Q.C. at pp. 124-125.

The owner of a certification mark may be engaged in activities other than certification, such as the sale of wares or the performance of services other than those covered by the certification mark. The owner may use the same mark as a certification mark on wares and as an ordinary trade-mark on services, or vice versa. However, the applicant cannot use the same trade-mark to both indicate defined standards for wares and use it as an ordinary trade-mark to distinguish those same wares from the wares of others, as the co-existence thereof would directly contradict the claims to use made in each application.

II.7.5.2 Use of Certification Mark

An example of a certification mark is one registered by a trade association to identify wares or services of its members. Thus, the certification mark of the Association of Professional Engineers of Ontario certifies to the purchaser of engineering services that those services have been performed by qualified professional engineers. The Association of Professional Engineers of Ontario is the owner of the certification mark and is responsible for the quality of services performed. The professional engineer who performs the services is not the owner of the certification mark but is authorized by the owner to use the mark in association with the services rendered.

A certification mark can be based on a 16(2) claim. However, it has been a practice in the Trade-marks Office not to accept applications for registration of certification marks based on proposed use pursuant to subsection 16(3) since section 2 defines a "certification mark" as meaning a mark that is used. The wording of the definitions of "proposed trade-mark" and "trade-mark" and of sections 23 and 30 and subsection 40(2) are considered supportive of this decision.

II.7.5.3 Descriptive of Place of Origin — Section 25

An application for registration of a certification mark must satisfy essentially the same registrability requirements under section 12 as an application for an ordinary trade-mark. However, a certification mark which is descriptive of the place of origin of the wares or services is registrable if: a) the applicant is the administrative authority of a country, state, province, or municipality, including or forming part of the area indicated by the mark; or b) is a commercial association having an office or representative in such area. The owner of any certification mark registered under section 25 shall permit the use of the mark in association with any wares or services produced or performed in the area of which the mark is descriptive. *See sections III.7.3 and IV.4.13 of this manual.*

II.7.5.4 Data on Application

Formal examination of an application to register a certification mark requires determining that the following provisions have been met.

- 1) The applicant cannot be engaged in the manufacture, sale, leasing or hiring of wares or the performance of services such as those associated with the certification mark pursuant to subsection 23(1).
- 2) When the mark is identified by a geographical term the applicant must be the administrative authority or a commercial association of the area indicated by the mark. See *WOVEN IN THE BRITISH ISLES & Design* - registration no. 132,993. *See also section 25.*
- 3) The standards may be defined with respect to the character or quality of the wares or services, the working conditions under which the wares have been produced or services performed, the class of persons by whom the wares have been produced or the services performed, or the area within which the wares have been produced or the services performed. The examiners will also accept statements from applicants to the effect that the wares are produced or services performed in accordance with defined standards set by the applicant, or such other general statements of standards.
- 4) The certification mark must be used in Canada by licensees of the applicant in the case of an application based on use in Canada.
- 5) In the case of a foreign applicant relying on registration and use abroad, a certified copy of the foreign registration must be furnished. The corresponding registration need not cover a certification mark. That is, the foreign applicant may have used the trade-mark abroad as an ordinary mark even though he/she now wishes to register it as a certification mark in Canada. (Conversely, a trade-mark registered and used as a certification mark abroad may be offered for registration as an ordinary trade-mark in

Canada.) The certification mark must be used by licensees of the applicant.

NOTE: To register a certification mark registered and used abroad, a combination of Forms 3 and 5 must be used.

- 6) All the standard data in the way of names and addresses, etc., must be furnished.

II.7.5.5 Examples of Registered Certification Marks

Registration No. 174,501

The mark SANITIZED & Design, when affixed to the wares, indicates to the purchaser that the wares (specified articles of clothing and footwear, fabrics, household furnishings and so on) have met the standard set in respect of their character and quality by the registrant, Sanitized Inc. These wares, according to the standard, must resist, retard and inhibit the growth of bacteria and other micro-organisms and must rate at least "good" when subjected to the Anti-Microbial Test and Procedure described in the schedule attached to the application for registration in file No. 316,610.

Registration No. 132,993

The mark WOVEN IN THE BRITISH ISLES on the flag device indicates to the purchaser that the textiles to which this mark is applied have met the standards set by The National Wool Textile Export Corporation of Yorkshire, England. Briefly, these textiles must contain stipulated wool or animal fibre and have been woven in the United Kingdom of Great Britain and Northern Ireland and been dyed or finished in the United Kingdom.

NOTE: Drawings and Specimens

The same requirements are to be met as regards the submission of drawings and specimens for design and composite marks. *See sections II.6.2 and II.6.3 of this manual for guidelines on submitting drawings and specimens.*

II.7.6 Applications for Distinguishing Guises — Sections 13 and 32, Form 1

II.7.6.1 Definition of a Distinguishing Guise

Section 13 of the *Trade-marks Act* provides for the registration of a very particular type of trade-mark known as a distinguishing guise. A distinguishing guise is a shaping of wares or their containers or a mode of wrapping or packaging the wares or their containers. The appearance of the wares, containers or wrapping must serve to distinguish the wares or services of the applicant from the wares or services of others.

A package is defined in section 2 as including any container or holder ordinarily associated with wares at the time of the transfer of the property in or possession of the wares in the course of trade. Applications received for any container or holder must be treated as distinguishing guise applications, subject to the provisions of Section 13. Trade-marks that have been registered as distinguishing guises include: the Haig & Haig pinch bottle and the Coca Cola bottle.

While there are no known distinguishing guise registrations covering services, it would be possible to register a distinguishing guise in association with services: a dry cleaning service could employ a distinctive method of wrapping the articles it has cleaned and could therefore apply to register it as a distinguishing guise. (*See also section IV.2.6 of this manual.*)

II.7.6.2 Paragraph 13(1)(b) and Subsection 13(2)

The examiners assessing an application for registration of a distinguishing guise must give due consideration to the mark's effect on other businesses or

entrepreneurs. According to paragraph 13(1)(b), the use of the trade-mark must not in any way limit the development of any art or industry. Such an objection was raised in the case of *Dominion Lock Co. Ltd. v. Schlage Lock Co.* (1961), 38 C.P.R. 88. The application for the representation of the head of a key as a trade-mark was ruled by the Trade-marks Office to be an application for a distinguishing guise. The evidence disclosed that key blanks were sold in the replacement key industry having the same heads as the original keys. The Registrar found that the distinguishing guise was not registrable because the shape of the key head was a utilitarian feature of replacement keys. Registration would interfere with the right of those in the replacement key industry to manufacture blanks, including the shape of the key head which was the subject of the application.

II.7.6.3 Submitting Proof of Distinctiveness — Section 32

A distinguishing guise, as its name implies, distinguishes by reason of its appearance and, as such, can be registered only when the applicant proves that the mark has acquired distinctiveness in Canada at the date of filing. Since its impact is exclusively visual, as far as the consumer or business person is concerned, this is the basis on which distinctiveness must be established. The emphasis here is on the appropriateness as well as the number and variety of submissions relating to the proof.

Under subsection 32(1), the applicant for a distinguishing guise must furnish the Registrar with evidence, by way of affidavit or statutory declaration, establishing the extent to which and the time during which the trade-mark has been used in Canada and with any other evidence that the Registrar may require. In accordance with Office practice, drawings which may be accompanied by a description of the mark, must show different profiles of the shape of the wares, or the container, package or wrapping which houses them. Trade-marks which are three-dimensional figures must be represented by drawings which show details of both front and back surfaces, or all the surfaces which comprise the mark. Applicants must submit actual specimens of the distinctively shaped or wrapped wares or containers. Of course, all evidence submitted as proof of acquired distinctiveness must be carefully considered. The examiners will look for abundant evidence from dealers in and users of the distinguishing guise to establish that it is in fact the appearance of the shaping of the wares or containers or the mode of wrapping which is distinctive. See *section IV.10 of this manual on submitting evidence to prove "acquired distinctiveness" pursuant to subsection 12(2)*.

Pursuant to paragraph 13(1)(a), a distinguishing guise may not be based on section 14 since a distinguishing guise must have been so used in Canada as to have become distinctive at the date of filing. Therefore, evidence pursuant to subsection 32(1) must be submitted.

II.7.7 Applications to Extend Statement of Wares or Services — Paragraph 41(1)(c), Form 7

Form 7 may be used when an applicant wishes to extend the statement of wares or services associated with a registered trade-mark. The instructions for completing this form begin with a general note which should be read carefully. The form is drafted to cover a basis of use in Canada in association with the additional wares/services, but can be modified where the basis of entitlement is making known in Canada, use and registration abroad, or proposed use in Canada. In such cases the applicable paragraphs from Forms 2, 3 and 4 may be substituted. *See section IV.9 of this manual for disclaimer requirements.*

Conversion to an Ordinary Trade-mark Application

There are occasions when an applicant may wish to convert an application to extend the statement of wares/services to an ordinary trade-mark application. This is an acceptable practice, however a new serial number will have to be awarded and, in the case of design marks, a drawing must be filed. The filing date remains the same.

The examiners must also ensure that the ordinary application replacing the extension of wares application maintains the same trade-mark, wares and/or services statement, basis of filing and name and address of applicant.

Under the same conditions, the Office will also permit the applicant to revert to an ordinary application for registration when the registration on which an extension of wares and/or services application is dependent becomes expunged or cancelled. In addition, the examiners should inform the applicant of the expungement and of the possibility of reverting to an ordinary application. If the applicant requests this change, a revised application must be filed deleting reference to the registration on which the extension application was based.

Affidavit of continuous use for trade-marks previously registered pursuant to subsection 12(2) of the *Trade-marks Act*, section 29 of the *Unfair Competition Act* or Rule X of the *Trade Mark and Design Act*

Where registration of the mark which is the subject of an application to extend the wares is contrary to either paragraphs 12(1)(a) or (b), the Registrar does not require a showing of acquired distinctiveness pursuant to section 32 if the wares in respect of the application to extend are in the same class as the wares covered by the registration. In such a case, the Office accepts an affidavit of continuous use.

The following should be kept in mind:

- 1) The evidence must establish that use of the trade-mark has been continuous in relation to the wares originally registered, from the date of the initial evidence establishing secondary meaning until the date of application for the extended statement. The evidence should also show use of the trade-mark in respect of the extended wares from the date of use in Canada until the date of application for the extension statement.

- 2) The application to extend the wares must be based on use in Canada.

NOTE: The above also applies to applications to extend services.

Trade-marks previously registered pursuant to section 14 of the *Trade-marks Act*

An applicant may not rely on the evidence submitted with the original registration in an extension of wares application unless the evidence in support of the original registration filed pursuant to section 14 also related to the wares for which the application to extend is filed.

For example, if the foreign registration and evidence filed in support of the initial registration showed that the trade-mark was not without distinctive character in Canada in association with "shoes, books, tennis rackets and perfume," yet registration was sought only in relation to "shoes and tennis rackets," the applicant could claim the benefit of section 14 in a subsequent application to extend the statement of wares in relation to "books and perfume" as the evidence already filed supports the claim.

However, if the wares in the application to extend were not included in the certified copy and in the evidence filed in support of the section 14 claim on the initial registration, new evidence pursuant to subsection 12(2) or section 14 must be submitted in relation to the additional wares. It should be noted that it is not sufficient that the additional wares in the application to extend fall within the same class as those for which section 14 evidence was originally filed. Therefore, wares extended to "golf clubs" would not be supported by evidence filed in relation to "tennis rackets."

The mere filing of an affidavit of continuous use is neither appropriate nor acceptable in the foregoing situation.

The preceding practice applies only to trade-marks which, as a whole, contravene either paragraph 12(1)(a) or 12(1)(b) of the *Trade-marks Act*.

NOTE: The above also applies to applications to extend services.

II.7.7.1 Instruction (e) — Form 7

The application to amend a registration to extend its statement of wares or services may include a request for other amendments affecting the statement of wares or services in respect of which the trade-mark is registered. Amendments of the statement of wares or services are authorized by paragraph 41(1)(c) and include deletion of certain wares or services from the statement of registration or re-statement of the wares or services for purposes of clarification.

II.7.7.2 Drawings and Specimens — Extension of Wares/Services

No drawings or specimens are normally required to accompany a Form 7 application covering an extension of wares or services. If, however, the trade-mark was registered under the *Trade Mark and Design Act* (TMDA) or the *Unfair Competition Act* (UCA) and if no drawings are on file, one will be requested. *See sections II.6.2 and II.6.3 of this manual for guidelines on submitting drawings and specimens.*

II.7.8 Claim to the Benefit of Section 14

II.7.8.1 Comparison of Subsection 12(2) and Section 14

Trade-marks which are not registrable because they are names or surnames within the definition set out in paragraph 12(1)(a), or which are clearly descriptive according to paragraph 12(1)(b), may be registered pursuant to section 14. In order to claim the benefit of section 14, the applicant must show that the trade-mark has been registered in or for the country of origin of the applicant or his/her predecessor in association with the same wares or services and must furnish a certified copy of the corresponding registration and any other evidence required by the Registrar. A section 14 claim need not be entered at the time of filing the application. *See subsections 31(1) and 31(2).*

Section 14 of the *Trade-marks Act* differs substantially from paragraph 28(1)(d) of the UCA in that benefits will be accorded:

- 1) only if the trade-mark is not without distinctive character in Canada; and
- 2) only after the Trade-marks Office has taken into account all the circumstances of the case, including the length of time during which such trade-mark has been used in any country.

The word "distinctive" in the expression "not without distinctive character," should be given the meaning ascribed to it in section 2 of the Act. The person who is entitled to rely on section 14 is given some advantage over a person who must rely on subsection 12(2) of the Act in that while both persons must satisfy the Registrar as to the distinctive character of their trade-marks, the burden of adducing evidence is lighter in the case of the person relying on section 14.

For example, in order to prove acquired distinctiveness of a mark pursuant to subsection 12(2), the applicant must show that it has acquired a secondary meaning throughout Canada, unless the applicant is prepared to accept territorial limitations. The applicant who invokes section 14 however, has only to show that the mark is not without distinctive character in Canada by virtue of the manner and extent to which it has been used or advertised. It need not be shown that such distinctiveness existed as of the date of filing of the application. Territorial limitations are not applicable.

Section 14 evidence will be questioned if it shows that use or making known of the trade-mark has been by a person other than the applicant. The evidence will be acceptable if it shows use or making known by the applicant or, under certain conditions, by a licensee. *See subsection 50(1)*. In those cases of substantial spill-over advertising into Canada, proof of actual use in Canada may not be a prerequisite.

II.7.8.2 Data Required on Affidavits

The affidavit or statutory declaration in support of a claim to registration based on section 14 of the *Trade-marks Act* should contain the following information:

- 1) the status of the declarant, i.e., president, manager, secretary, and so on;
- 2) particulars of the applicant company, i.e., when and how it was founded, and where it carries on business;
- 3) the wares or services in association with which the mark is used — the list should be detailed — and the date of first use anywhere in the world;
- 4) the date as of which the wares have been sold under the trade-mark in Canada (If there has been no use of the trade-mark in Canada, the Office expects proof of substantial spill-over advertising into Canada.);
- 5) a list of the countries in which the trade-mark is used in association with the same wares and/or services;
- 6) a list of the countries in which the trade-mark has been registered;
- 7) the approximate total volume and value of the wares and/or services sold or performed in Canada in association with the trade-mark, and the approximate total value of such wares and/or services sold in other countries;
- 8) the total volume and value of advertising of the trade-mark in Canada and in other countries;
- 9) sample advertisements, labels, etc., as used in Canada and elsewhere, mounted, where possible, on paper which will fit on the application file.

II.7.8.3 Further Notes on Section 14

- a) The trade-mark which the applicant seeks to register in Canada may differ from the trade-mark registered abroad in respects which do not affect its identity or alter its distinctive character. *See subsection 14(2)*. In practice, only minimal differences are permitted.

- b) The wares and/or services associated with the trade-mark in the Canadian application may not extend beyond those covered by the foreign registration. For example, a registration in or for a Union country extending to electric kettles, would not support a registration in Canada extending to small electrical appliances, namely, kettles, toasters, knives, mixers.

- c) A claim to the benefits of section 14 may not be invoked to overcome a disclaimer requirement pertaining to unregistrable portions of a composite mark. For example, a trade-mark which contains an element or elements which contravene the provisions of paragraphs 12(1)(a) or (b), such as LEVESQUE'S HOTSPOT would not be registrable without a disclaimer of LEVESQUE'S, unless this unregistrable portion of the trade-mark had become distinctive in Canada, pursuant to subsection 12(2), or had been shown to be not without distinctive character in Canada, pursuant to section 14, as evidenced by one or more registrations in Canada relating solely to the unregistrable matter. Evidence may not be submitted for elements of marks, only to marks as a whole.

If the registration relied upon does not include all of the same or similar classes of wares and/or services applied for in the Canadian application, a disclaimer statement extending to the unregistrable portion(s) of the trade-mark in association with the wares/services not covered will be required.

- d) If the Registrar is not satisfied that evidence furnished pursuant to subsection 31(2) establishes that the trade-mark is "not without distinctive character in Canada," further evidence may be required. Such evidence may be in the form of affidavits from independent persons in Canada attesting that they recognize the trade-mark as indicating the applicant's wares or services. However, the applicant might succeed in establishing the claim by providing evidence of more advertising of the trade-mark in Canada than was given in the original affidavit.

- e) All affidavits pursuant to subsection 31(2) should be accompanied by specimens of advertisements and exhibits showing the manner of use of the trade-mark.

- f) An applicant who wishes to claim the benefits of section 14 and whose statement of use of the mark in Canada is extended to cover additional wares or services, may, if there has been extensive use of these, rely on the provisions of subsection 12(2) and section 32 to establish acquired distinctiveness in association with those additional wares or services.

Paris Convention for the Protection of Industrial Property

Paris Convention (1883), revised at Brussels (1900), Washington (1911), The Hague (1925), London (1934), Lisbon (1958) and Stockholm (1967), and amended in 1979

(Paris Union)

Status on January 1, 1996

State	Date on which State became party to the Convention	Latest Act ¹ of the Convention to which State is party and date on which State became party to that Act
Albania	October 4, 1995	Stockholm: October 4, 1995
Algeria	March 1, 1966	Stockholm: April 20, 1975 ²
Argentina	February 10, 1967	Lisbon: February 10, 1967 Stockholm, Articles 13 to 30: October 8, 1980
Armenia	December 25, 1991	Stockholm: December 25, 1991 ²
Australia	October 10, 1925	Stockholm, Articles 1 ^{to} 12: September 27, 1975 Stockholm, Articles 13 to 30: August 25, 1972
Austria	January 1, 1909	Stockholm: August 18, 1973
Azerbaijan	December 25, 1995	Stockholm: December 25, 1995
Bahamas	July 10, 1973	Lisbon: July 10, 1973 Stockholm, Articles 13 to 30: March 10, 1977
Bangladesh	March 3, 1991	Stockholm: March 3, 1991 ²
Barbados	March 12, 1985	Stockholm: March 12, 1985
Belarus	December 25, 1991	Stockholm: December 25, 1991 ²
Belgium	July 7, 1884	Stockholm: February 12, 1975
Benin	January 10, 1967	Stockholm: March 12, 1975
Bolivia	November 4, 1993	Stockholm: November 4, 1993
Bosnia and Herzegovina	March 6, 1992	Stockholm: March 6, 1992
Brazil	July 7, 1884	Stockholm, Articles 1 to 12: November 24, 1992 Stockholm, Articles 13 to 30: March 24, 1975 ²
Bulgaria	June 13, 1921	Stockholm, Articles 1 to 12: May 19 or 27, 1970 ³ Stockholm, Articles 13 to 30: May 27, 1970
Burkina Faso	November 19, 1963	Stockholm: September 2, 1975
Burundi	September 3, 1977	Stockholm: September 3, 1977
Cameroon	May 10, 1964	Stockholm: April 20, 1975
Canada	June 12, 1925	London: July 30, 1951 Stockholm, Articles 13 to 30: July 7, 1970
Central African Republic	November 19, 1963	Stockholm: September 5, 1978
Chad	November 19, 1963	Stockholm: September 26, 1970
Chile	June 14, 1991	Stockholm: June 14, 1991
China	March 19, 1985	Stockholm: March 19, 1985 ²
Congo	September 2, 1963	Stockholm: December 5, 1975
Costa Rica	October 31, 1995	Stockholm: October 31, 1995
Côte d'Ivoire	October 23, 1963	Stockholm: May 4, 1974
Croatia	October 8, 1991	Stockholm: October 8, 1991
Cuba	November 17, 1904	Stockholm: April 8, 1975 ²
Cyprus	January 17, 1966	Stockholm: April 3, 1984
Czech Republic	January 1, 1993	Stockholm: January 1, 1993
Democratic People's Republic of Korea	June 10, 1980	Stockholm: June 10, 1980
Denmark ⁴	October 1, 1894	Stockholm, Articles 1 to 12: April 26 or May 19 1970 ³ Stockholm, Articles 13 to 30: April 26 1970
Dominican Republic	July 11, 1980	The Hague: April 6, 1951
Egypt	July 1, 1951	Stockholm: March 6, 1975 ²
El Salvador	February 19, 1994	Stockholm: February 19, 1994
Estonia	August 24, 1994 ⁵	Stockholm: August 24, 1994
Finland	September 20, 1921	Stockholm, Articles 1 to 12: October 21, 1975 Stockholm, Articles 13 to 30: September 15, 1970

State	Date on which State became party to the Convention	Latest Act ¹ of the Convention to which State is party and date on which State became party to that Act
France ⁶	July 7, 1884	Stockholm: August 12, 1975
Gabon	February 29, 1964	Stockholm: June 10, 1975
Gambia	January 21, 1992	Stockholm: January 21, 1992
Georgia	December 25, 1991	Stockholm: December 25, 1991 ²
Germany	May 1, 1903	Stockholm: September 19, 1970
Ghana	September 28, 1976	Stockholm: September 28, 1976
Greece	October 2, 1924	Stockholm: July 15, 1976
Guinea	February 5, 1982	Stockholm: February 5, 1982
Guinea-Bissau	June 28, 1988	Stockholm: June 28, 1988
Guyana	October 25, 1994	Stockholm: October 25, 1994
Haiti	July 1, 1958	Stockholm: November 3, 1983
Holy See	September 29, 1960	Stockholm: April 24, 1975
Honduras	February 4, 1994	Stockholm: February 4, 1994
Hungary	January 1, 1909	Stockholm, Articles 1 to 12: April 26 or May 19, 1970 ³ Stockholm, Articles 13 to 30: April 26, 1970 ²
Iceland	May 5, 1962	Stockholm, Articles 1 to 12: April 9, 1995 Stockholm, Articles 13 to 30: December 28, 1984
Indonesia	December 24, 1950	London: December 24, 1950 Stockholm, Articles 13 to 30: December 20, 1979 ²
Iran (Islamic Republic of)	December 16, 1959	Lisbon: January 4, 1962
Iraq	January 24, 1976	Stockholm: January 24, 1976 ²
Ireland	December 4, 1925	Stockholm, Articles 1 to 12: April 26 or May 19, 1970 ³ Stockholm, Articles 13 to 30: April 26, 1970
Israel	March 24, 1950	Stockholm, Articles 1 to 12: April 26 or May 19, 1970 ³ Stockholm, Articles 13 to 30: April 26, 1970
Italy	July 7, 1884	Stockholm: April 24, 1977
Japan	July 15, 1899	Stockholm, Articles 1 to 12: October 1, 1975 Stockholm, Articles 13 to 30: April 24, 1975
Jordan	July 17, 1972	Stockholm: July 17, 1972
Kazakstan	December 25, 1991	Stockholm: December 25, 1991 ²
Kenya	June 14, 1965	Stockholm: October 26, 1971
Kyrgyzstan	December 25, 1991	Stockholm: December 25, 1991 ²
Latvia	September 7, 1993 ⁷	Stockholm: September 7, 1993
Lebanon	September 1, 1924	London: September 30, 1947 Stockholm, Articles 13 to 30: December 30, 1986 ²
Lesotho	September 28, 1989	Stockholm: September 28, 1989 ²
Liberia	August 27, 1994	Stockholm: August 27, 1994
Libya	September 28, 1976	Stockholm: September 28, 1976 ²
Liechtenstein	July 14, 1933	Stockholm: May 25, 1972
Lithuania	May 22, 1994	Stockholm: May 22, 1994
Luxembourg	June 30, 1922	Stockholm: March 24, 1975
Madagascar	December 21, 1963	Stockholm: April 10, 1972
Malawi	July 6, 1964	Stockholm: June 25, 1970
Malaysia	January 1, 1989	Stockholm: January 1, 1989
Mali	March 1, 1983	Stockholm: March 1, 1983
Malta	October 20, 1967	Lisbon: October 20, 1967 Stockholm, Articles 13 to 30: December 12, 1977 ²
Mauritania	April 11, 1965	Stockholm: September 21, 1976
Mauritius	September 24, 1976	Stockholm: September 24, 1976
Mexico	September 7, 1903	Stockholm: July 26, 1976
Monaco	April 29, 1956	Stockholm: October 4, 1975
Mongolia	April 21, 1985	Stockholm: April 21, 1985 ²
Morocco	July 30, 1917	Stockholm: August 6, 1971
Netherlands ⁸	July 7, 1884	Stockholm: January 10, 1975
New Zealand ⁹	July 29, 1931	London: July 14, 1946 Stockholm, Articles 13 to 30: June 20, 1984
Niger	July 5, 1964	Stockholm: March 6, 1975
Nigeria	September 2, 1963	Lisbon: September 2, 1963

State	Date on which State became party to the Convention	Latest Act ¹ of the Convention to which State is party and date on which State became party to that Act
Norway	July 1, 1885	Stockholm: June 13, 1974
Paraguay	May 28, 1994	Stockholm: May 28, 1994
Peru	April 11, 1995	Stockholm: April 11, 1995
Philippines	September 27, 1965	Lisbon: September 27, 1965 Stockholm, Articles 13 to 30: July 16, 1980
Poland	November 10, 1919	Stockholm: March 24, 1975
Portugal	July 7, 1884	Stockholm: April 20, 1975
Republic of Korea	May 4, 1980	Stockholm: May 4, 1980
Republic of Moldova	December 25, 1991	Stockholm: December 25, 1991 ²
Romania	October 6, 1920	Stockholm, Articles 1 to 12: April 26 or May 19, 1970 ³ Stockholm, Articles 13 to 30: April 26, 1970 ²
Russian Federation	July 1, 1965 ¹⁰	Stockholm: Articles 1 to 12: April 26 or May 19, 1970 ^{3, 10} Stockholm: Articles 13 to 30: April 26, 1970 ^{2, 10}
Rwanda	March 1, 1984	Stockholm: March 1, 1984
Saint Kitts and Nevis	April 9, 1995	Stockholm: April 9, 1995
Saint Lucia	June 9, 1995	Stockholm: June 9, 1995 ²
Saint Vincent and the Grenadines	August 29, 1995	Stockholm: August 29, 1995
San Marino	March 4, 1960	Stockholm: June 26, 1991
Senegal	December 21, 1963	Stockholm, Articles 1 to 12: April 26 or May 19, 1970 ³ Stockholm, Articles 13 to 30: April 26, 1970
Singapore	February 23, 1995	Stockholm: February 23, 1995
Slovakia	January 1, 1993	Stockholm: January 1, 1993
Slovenia	June 25, 1991	Stockholm: June 25, 1991
South Africa	December 1, 1947	Stockholm: March 24, 1975 ²
Spain	July 7, 1884	Stockholm: April 14, 1972
Sri Lanka	December 29, 1952	London: December 29, 1978 Stockholm, Articles 13 to 30: September 23, 1978
Sudan	April 16, 1984	Stockholm: April 16, 1984
Suriname	November 25, 1975	Stockholm: November 25, 1975
Swaziland	May 12, 1991	Stockholm: May 12, 1991
Sweden	July 1, 1885	Stockholm, Articles 1 to 12: October 9, 1970 Stockholm, Articles 13 to 30: April 26, 1970
Switzerland	July 7, 1884	Stockholm, Articles 1 to 12: April 26 or May 19, 1970 ³ Stockholm, Articles 13 to 30: April 26, 1970
Syria	September 1, 1924	London: September 30, 1947
Tajikistan	December 25, 1991	Stockholm: December 25, 1991 ²
The former Yugoslav Republic of Macedonia	September 8, 1991	Stockholm: September 8, 1991
Togo	September 10, 1967	Stockholm: April 30, 1975
Trinidad and Tobago	August 1, 1964	Stockholm: August 16, 1988
Tunisia	July 7, 1884	Stockholm: April 12, 1976 ²
Turkey	October 10, 1925	Stockholm, Articles 1 to 12: February 1, 1995 Stockholm, Articles 13 to 30: May 16, 1976
Turkmenistan	December 25, 1991	Stockholm: December 25, 1991 ²
Uganda	June 14, 1965	Stockholm: October 20, 1973
Ukraine	December 25, 1991	Stockholm: December 25, 1991 ²
United Kingdom ¹¹	July 7, 1884	Stockholm, Articles 1 to 12: April 26 or May 19, 1970 ³ Stockholm, Articles 13 to 30: April 26, 1970
United Republic of Tanzania	June 16, 1963	Lisbon: June 16, 1963 Stockholm, Articles 13 to 30: December 30, 1983
United States of America ¹²	May 30, 1887	Stockholm, Articles 1 to 12: August 25, 1973 Stockholm, Articles 13 to 30: September 5, 1970
Uruguay	March 18, 1967	Stockholm: December 28, 1979
Uzbekistan	December 25, 1991	Stockholm: December 25, 1991 ²
Venezuela	September 12, 1995	Stockholm: September 12, 1995
Viet Nam	March 8, 1949	Stockholm July 2, 1976 ²

State	Date on which State became party to the Convention	Latest Act ¹ of the Convention to which State is party and date on which State became party to that Act
Yugoslavia	February 26, 1921	Stockholm: October 16, 1973
Zaire	January 31, 1975	Stockholm: January 31, 1975
Zambia	April 6, 1965	Lisbon: April 6, 1965
Zimbabwe	April 18, 1980	Stockholm, Articles 13 to 30: May 14, 1977 Stockholm: December 30, 1981
(Total: 136 States)		

¹ “Stockholm” means the Paris Convention for the Protection of Industrial Property as revised at Stockholm on July 14, 1967 (Stockholm Act); “Lisbon” means the Paris Convention as revised at Lisbon on October 31, 1958 (Lisbon Act); “London” means the Paris Convention as revised at London on June 2, 1934 (London Act); “The Hague” means the Paris Convention as revised at The Hague on November 6, 1925 (Hague Act).

² With the declaration provided for in Article 28(2) of the Stockholm Act relating to the International Court of Justice.

³ These are the alternative dates of entry into force which the Director General of WIPO communicated to the States concerned.

⁴ Denmark extended the application of the Stockholm Act to the Farøe Islands with effect from August 6, 1971.

⁵ Estonia acceded to the Paris Convention (Washington Act, 1911) with effect from February 12, 1924. It lost its independence on August 6, 1940, and regained it on August 20, 1991.

⁶ Including all Overseas Departments and Territories.

⁷ Latvia acceded to the Paris Convention (Washington Act, 1911) with effect from August 20, 1925. It lost its independence on July 21, 1940, and regained it on August 21, 1991

⁸ Ratification for the Kingdom of Europe, the Netherlands Antilles and Aruba.

⁹ The accession of New Zealand to the Stockholm Act, with the exception of Articles 1 to 12, extends to the Cook Islands, Niue and Tokelau.

¹⁰ Date of adherence of the Soviet Union, continued by the Russian Federation as from December 25, 1991

¹¹ The United Kingdom extended the application of the Stockholm Act to the territory of Hong Kong with effect from November 16, 1977, and to the Isle of Man with effect from October 29, 1983.

¹² The United States of America extended the application of the Stockholm Act to all territories and possessions of the United States of America, including the Commonwealth of Puerto Rico, as from August 25, 1973.

WTO Members (122)
- as of June 10, 1996 -

Members	Entry Into Force
Antigua and Barbuda	1 January 1995
Argentina	1 January 1995
Australia	1 January 1995
Austria	1 January 1995
Bahrain	1 January 1995
Bangladesh	1 January 1995
Barbados	1 January 1995
Belgium	1 January 1995
Belize	1 January 1995
Benin	22 February 1996
Bolivia	13 September 1995
Botswana	31 May 1995
Brazil	1 January 1995
Brunéi Darussalam	1 January 1995
Burkina Faso	3 June 1995
Burundi	23 July 1995
Cameroon	13 December 1995
Canada	1 January 1995
Central African Republic	31 May 1995
Chile	1 January 1995
Colombia	30 April 1995
Costa Rica	1 January 1995
Côte d'Ivoire	1 January 1995
Cuba	20 April 1995
Cyprus	30 July 1995
Czech Republic	1 January 1995
Denmark	1 January 1995
Djibouti	31 May 1995
Dominica	1 January 1995
Dominican Republic	9 March 1995
Ecuador	21 January 1996
Egypt	30 June 1995
El Salvador	7 May 1995
European Community	1 January 1995
Fiji	14 janvier 1996
Finland	1 January 1995
France	1 January 1995
Gabon	1 January 1995
Germany	1 January 1995
Ghana	1 January 1995

Greece	1 January 1995
Grenada	22 February 1996
Guatemala	21 July 1995
Guinea	25 October 1995
Guinea Bissau	31 May 1995
Guyana	1 January 1995
Haiti	30 January 1996
Honduras	1 January 1995
Hong Kong	1 January 1995
Hungary	1 January 1995
Iceland	1 January 1995
India	1 January 1995
Indonesia	1 January 1995
Ireland	1 January 1995
Israel	21 April 1995
Italy	1 January 1995
Jamaica	9 March 1995
Japan	1 January 1995
Kenya	1 January 1995
Korea	1 January 1995
Kuwait	1 January 1995
Lesotho	31 May 1995
Liechtenstein	1 September 1995
Luxembourg	1 January 1995
Macau	1 January 1995
Madagascar	17 November 1995
Malawi	31 May 1995
Malaysia	1 January 1995
Maldives	31 May 1995
Mali	31 May 1995
Malta	1 January 1995
Mauritania	31 May 1995
Mauritius	1 January 1995
Mexico	1 January 1995
Morocco	1 January 1995
Mozambique	26 August 1995
Myanmar	1 January 1995
Namibia	1 January 1995
Netherlands - For the Kingdom in Europe and for the Netherlands Antilles	1 January 1995
New Zealand	1 January 1995
Nicaragua	3 September 1995
Nigeria	1 January 1995

Norway	1 January 1995
Pakistan	1 January 1995
Papua New Guinea	9 June 1996
Paraguay	1 January 1995
Peru	1 January 1995
Philippines	1 January 1995
Poland	1 July 1995
Portugal	1 January 1995
Qatar	13 January 1996
Romania	1 January 1995
Rwanda	22 May 1996
Saint Lucia	1 January 1995
Saint Vincent & the Grenadines	1 January 1995
Senegal	1 January 1995
Sierra Leone	23 July 1995
Singapore	1 January 1995
Slovak Republic	1 January 1995
Slovenia	30 July 1995
South Africa	1 January 1995
Spain	1 January 1995
Sri Lanka	1 January 1995
St. Kitts et Nevis	21 February 1996
Suriname	1 January 1995
Swaziland	1 January 1995
Sweden	1 January 1995
Switzerland	1 July 1995
Tanzania	1 January 1995
Thailand	1 January 1995
Togo	31 May 1995
Trinidad and Tobago	1 March 1995
Tunisia	29 March 1995
Turkey	26 March 1995
Uganda	1 January 1995
United Arab Emirates	10 April 1996
United Kingdom	1 January 1995
United States	1 January 1995
Uruguay	1 January 1995
Venezuela	1 January 1995
Zambia	1 January 1995
Zimbabwe	3 March 1995

For more information you may contact: Gilles B. Legault
 Department of Foreign Affairs and International Trade
 Multilateral Trade Institutions Divisions (EAI)
 (613) 995-0739

III THE SEARCH / CONFUSION

III.1 Purpose of the search

In addition to being conversant with the *Trade-marks Act* and the *Trade-marks Regulations* and ensuring that an application complies with their provisions, the examiners also play a role in protecting the rights of other registrants and their registered trade-marks. This is done by examining the results of the search, which may be a computerized or a manual search. The purpose of the search is to determine whether the mark applied for:

- a) is confusing with a mark which is the subject of a pending application, pursuant to section 16;
- b) is confusing with a mark which is registered, pursuant to paragraph 12(1)(d);
- c) so nearly resembles as to be likely to be mistaken for a mark which is protected under section 9 (*see also paragraph 12(1)(e)*);
- d) is a denomination the adoption of which is prohibited by section 10.1 (*see also paragraph 12(1)(f)*); or
- e) is in whole or in part a protected geographical indication, and the application covers wines or spirits. (*See paragraphs 12(1)(g) and (h)*).

If the mark applied for is confusing with a mark or marks which are the subject of one or more pending applications, the examiners must decide who is entitled to registration pursuant to section 16 and object to the other application(s).

If the mark applied for is confusing with a registered trade-mark, the application is objected to pursuant to para. 12(1)(d).

If the mark applied for is identical or almost identical to a prohibited mark, the application is objected to pursuant to paragraph 12(1)(e).

If the mark applied for consists of a plant variety denomination or is a mark so nearly resembling a plant variety denomination as to be likely to be mistaken therefor, and the application covers the plant variety or another plant variety of the same species, the application is objected to pursuant to paragraph 12(1)(f).

If the mark applied for is, in whole or in part, a protected geographical indication for wines or spirits and the application covers a wine or spirit not originating in the territory indicated by the geographical indication, the application is objected to pursuant to paragraphs 12(1)(g) or (h) as applicable.

NOTE: The Registrar of Trade-marks keeps a list of protected geographical indications in accordance with section 11.12(1) of the *Trade-marks Act*.

The search is a key operation in the examination of a trade-mark application. Its importance cannot be minimized, nor can the fact that the examiners are the first to consider possible confusion as to source. The searcher therefore is charged with great responsibility and should be aware that a careless or incomplete search might result in an invalid registration or cause considerable embarrassment and expense to the owner or to this Office. Keeping in mind that registration of a trade-mark accords to the owner exclusive right to use of that mark in Canada in respect of the wares or services with which it is associated, the examiners should be consistent in the manner of consulting the search results and must also make use of all pertinent reference sources.

III.2 Definition of Confusion — Subsection 6(2)

Section 6 of the *Trade-marks Act*, particularly subsection 6(2), describes the manner and circumstances in which one trade-mark would cause confusion with another. In deciding the question of confusion, Ritchie J. set forth the following criteria in *Rowntree Co. Ltd. v. Paulin Chambers Co. Ltd.* (1967), 54 C.P.R. 43 at p.47:

"It is enough, in my view, if the words used in the registered and unregistered trade marks are likely to suggest the idea that the wares with which they are associated were produced or marketed by the same person."

In *Benson & Hedges (Canada) Ltd. v. St-Regis Tobacco Corp.* (1968), 57 C.P.R. 1 at p.4, Ritchie J., after reviewing subsection 6(2) stated:

"I have italicized the words 'would be likely to lead to the inference' as it appears to me to be clear that in opposing an application for registration, the holder of a trade mark which is already registered is not required to show that the 'mark' which is the subject of the application is the same or nearly the same as the registered mark, it being enough if it be shown that the use of this mark would be likely to lead to the inference that the wares associated with it and those associated with the registered trade mark were produced by the same company."

In *Haw Par Brothers International Ltd. v. Registrar of Trade Marks* (1979), 48 C.P.R. (2d), Marceau J. stated:

"...[I]n order to determine whether trade marks are confusing within the meaning of the Act, that is, whether their concurrent use is likely to lead a purchaser to believe that the associated products come from the same source, the surrounding circumstances, particularly five major factors, must be taken into account." [At p. 70.]

The word TIGER with a design for medicinal preparations for human consumption was found not to be confusing with the words TIGER'S MILK for vitamin supplements, and food and beverages enriched with proteins.

III.2.1 Surrounding Circumstances

In determining the likelihood of confusion, the examiners must take into account all the surrounding circumstances. In the *Pianotist Case*, reported in (1906) 23 R.P.C. 774, Parker J., after reviewing the surrounding circumstances which had been the subject of judicial consideration on many occasions, stated at p. 777:

"You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks."

In order to consider all the surrounding circumstances, the examiners are directed to subsection 6(5) of the Act. The following case provides guidance on its provisions.

The Federal Court of Canada heard an appeal from a decision of the Opposition Board where DAYPAK for proposed use in association with "pharmaceutical dispensing packages" was found not to be confusing with DIALPAK registered for "a

tablet dispenser." The appeal was dismissed. The following tests were applied in *Ortho Pharmaceutical Corp. v. Mowatt & Moore Ltd.* (1972), 6 C.P.R. (2d) 161 where Heald J. stated:

"Having given this matter my best consideration, I conclude that the two trade marks in question do not closely resemble one another in appearance or sound or in the ideas suggested by them. I have reached this conclusion after considering the subject marks on a first impression basis, and not by way of detailed comparison. In my view, the two marks do not appear similar nor do they sound similar. Finally, the ideas suggested by the two marks are totally different. Appellant's mark clearly suggests a dial package tablet dispenser from which you 'dial your tablet' or pill. On the other hand, respondent's mark has no dial connotation but rather, relates to day or daily which is a deliberate course followed by the respondent to create in the minds of the trade, an association between its trade mark and the daily nature of the product.

Section 6(5) requires the Court, in determining whether the trade marks are confusing, to consider the particular matter listed in paras. (a), (b), (c), (d) and (e) thereof and also 'all the surrounding circumstances'.

An additional 'surrounding circumstance' which, in my view I am entitled to consider, is the fact that both of the subject marks have in them an element common to the trade — that is — they both have in them the terminal letters 'pak'.

The rule is that where elements of a particular trade mark are common to the trade, they cannot be appropriated to the exclusive use of a particular trader because they cannot be said to have in them the vital element of distinctiveness. The evidence is that apart from appellant's mark DIALPAK, there are several hundred other trade marks registered for dispensers or packages in the Canadian Trade Marks Office containing the letters 'pak, pac or pack' and many of them relate to pharmaceutical products. It seems to me that where, in a case like this, the two marks have a common suffix, this serves to make members of the trade more alert for a different prefix and thus minimizes the likelihood of confusion."

III.2.2 Subsection 6(5)

Where the likelihood of confusion pursuant to subsection 6(2) exists, the examiners will, pursuant to subsection 6(5) of the *Trade-marks Act*, consider all the surrounding circumstances including:

- a) the inherent distinctiveness of the trade-marks and the extent to which they have become known;
- b) the length of time the trade-marks have been in use;
- c) the nature of the wares, services or business;
- d) the nature of the trade; and
- e) the degree of resemblance between the trade-marks in appearance or sound or in the idea suggested by them.

III.2.2.1 Paragraph 6(5)(a) — Inherent Distinctiveness

A trade-mark which is created, unique, and non-descriptive is deemed to be inherently distinctive. If an inherently distinctive mark is the subject of a pending application, it would be considered to be a strong candidate for registration. If such a mark is already registered, it is the examiners' responsibility to protect those rights which accrue as a result of its inherent distinctiveness.

For example, it is clear that a mark such as KODAK, which is a purely arbitrary word, possesses more inherent distinctiveness than a mark such as CORTI-VET which may be used in association with a veterinary preparation containing cortisone. In other words, the quality of "inherent distinctiveness" is easily attributed to the mark KODAK because, unlike CORTI-VET, KODAK has no suggestive or descriptive properties, nor does it suggest any other relation to the wares photographic film or photographic equipment. When it comes to actually comparing two word marks, the examiners are directed to the following statements:

"If the words are distinctive, in the sense of being invented words, small differences will not be sufficient to distinguish them, whereas if the words are common or descriptive in meaning, they must be taken with their disadvantages. No person is entitled to fence in the common of the English language and words of a general nature cannot be appropriated over a wide area. In such a case small differences will be sufficient to distinguish between them and this rule applies where a common part of two words is also common to the trade." H.G. Fox, *Canadian Law of Trade Marks*, Third Edition, p. 173.

In *General Motors Corp. v. Bellows*, Rand J. approved the doctrine that a common word, that is, a weak trade-mark, is entitled to a narrower range of protection than an invented or unique word. At the trial level, (1947), 7 C.P.R. at p. 8, Cameron J. expressed the rule in these words:

"In considering whether marks are similar, consideration ought to be given to the nature of the words themselves, and a distinction drawn between a fancy or invented word and an ordinary word in everyday use. In the case of a purely invented word, the scope is very much wider than that of an ordinary word."

On appeal, (1949), 10 C.P.R. 101 at p. 115, Rand J. said:

"Mr. Fox submitted this basic consideration: that where a party has reached inside the common trade vocabulary for a word mark and seeks to prevent competitors from doing the same thing, the range of protection to be given him should be more limited than in the case of an invented or unique or non-descriptive word; and he has strong judicial support for that proposition." H.G. Fox, *Canadian Law of Trade Marks*, Third Edition, p. 173.

III.2.2.2 Paragraph 6(5)(b) — Extent and Length of Time Used

Generally speaking, examiners are limited in their ability to make judgments about confusion based on the length of time and extent of use of a trade-mark. Evidence of actual instances of confusion pursuant to paragraph 12(1)(d) will be unavailable to them.

If the owners of marks considered by the Registrar to be confusing do not agree with the Registrar's decision, they may appeal to the Federal Court of Canada. The Court would then consider the length and extent of use of both a registered trade-mark and the mark deemed to be confusing. In judgments of this nature it is generally accepted that a mark which has seen substantial use for a long time, and is therefore well known, deserves more protection than a lesser known mark. Where both marks have been used for a long time in the same area without evidence of confusion, it follows that confusion would be unlikely to occur in the future, thus allowing for the registration of both marks. Where the unsuccessful applicant attempts to have the registered mark expunged, the consideration of the length and extent of use of the competing marks becomes especially crucial.

III.2.2.3 Paragraph 6(5)(c) — Nature of Wares or Services

When making a decision concerning the issue of confusion, the examiners must not only focus on the inherent distinctiveness of the marks, but also on the nature of the wares or services to be associated with them. Therefore, the examiners must clearly understand the description of wares and/or services as it appears on the application form, as well as the classification of those wares and services.

The examiners must also determine whether the wares covered by the application are of the everyday sort, bought casually, or if they are expensive, thereby calling for a high degree of selection on the part of the purchaser. (*General Motors Corp. v. Bellows* (1949), 10 C.P.R. 101 at pp. 115-116.) If the former case applies, the examiners must be assured that the pending mark is dissimilar enough to the registered mark that consumers will not confuse them in the course of routine and often hasty shopping. If the latter applies, the examiners can allow for more subtle or complex differences between marks, since the purchaser will be taking more time to choose the item and therefore the mark associated with it.

III.2.2.4 Paragraph 6(5)(c) — Nature of Wares or Services — Pharmaceuticals

When assessing confusion between trade-marks used in the pharmaceutical industry, the examiners must exercise special care to avoid confusion in view of the serious consequences which may arise through mistakes or negligence.

In *Mead Johnson & Co. v. G.D. Searle & Co.* (1967), 53 C.P.R. 1, Justice Dumoulin stressed the importance of avoiding confusion with respect to the selling and dispensing of pharmaceutical products even in those instances where the products in question are sold only by means of prescription and are only dispensed by pharmacists from written instructions from a physician.

See also *Schering Canada Inc. v. Thompson Medical Co., Inc.* (1983), 81 C.P.R. (2d) 270.

III.2.2.5 Paragraph 6(5)(d) — Nature of the Trade

In assessing the nature of the trade, a relevant consideration would be to determine if the wares are sold directly by the manufacturer through wholesalers, retailers or catalogues, or by telephone. If the wares are ordered by telephone, the sound of the trade-mark becomes even more important than when consumers can see the mark affixed to the wares. Wholesalers may not be confused since they deal directly with manufacturers, but consumers do not have specialized knowledge of the trade and therefore could be confused.

If the examiners are initially uncertain as to whether the channels of trade are the same for the marks, they should cite the registration in an official Action Report and require the applicant to argue the merits of the citation. If the applicant convincingly argues that the channels of trade are different, the examiners will have to consider this in deciding whether or not to withdraw the objection.

In *Sarah Coventry, Inc. v. Abrahamian* (1984), 1 C.P.R. (3d) 238, the trade-marks SARAH for costume jewellery and ZAREH for custom-made jewellery were found not to be confusing. The SARAH jewellery was mass produced and inexpensive, while the ZAREH jewellery was individually hand-made and very expensive. Furthermore, the parties marketed their wares through different kinds of outlets. The court concluded on this basis that there was no likelihood of confusion. The court also considered the fact that SARAH was a

weak mark that had not been extensively used, and that phonetic differences between the two marks were sufficient to avoid confusion.

The examiners should not necessarily take into account a submission that the applicant is only selling the wares wholesale when, in fact, the wares could also be sold retail. In *Eminence S.A. v. Registrar of Trade Marks* (1977), 39 C.P.R. (2d) 40 at p. 43, Dubé J. stated:

"Even if Fabergé does not sell its products in the same places as appellant, it is legally entitled to do so. It matters little that at the present time Fabergé's wares are sold in hairdressing salons rather than in drug stores."

III.2.2.6 Paragraph 6(5)(e) — Degree of Resemblance between the Marks

When dealing with the issue of confusion between marks, the examiners must consider the degree of resemblance in the appearance, sound and ideas suggested by the marks. If the mark applied for appears in the same script as the mark on the Register, this factor must be taken into consideration. If two marks are comprised of a similar arrangement of word and design, or if two marks express a common idea, confusion may occur.

The examiners must also be alert to confusion between trade-marks in either or both of Canada's official languages. In *Scott Paper Co. v. Beghin-Say S.A.* (1985), 5 C.P.R. (3d) 225, Strayer J. stated:

"I have no doubt that the Registrar of Trade Marks and the court should be alert to the possibility of confusion between trade marks in either or both of Canada's official languages. This is not only required by the constitutional and legal status of both languages at the federal level, but is also a reflection of the fact that there are several million

bilingual Canadians who may associate words in one official language with their equivalent in the other."

In *Rose v. Fraternité Interprovinciale Des Ouvriers en Electricité* (1977), 32 C.P.R. (2d) 42, Walsh J. found a design mark having the words FRATERNITÉ INTERPROVINCIALE DES OUVRIERS EN ELECTRICITÉ confusing with an earlier registration of a design mark having the words INTERNATIONAL BROTHERHOOD OF ELECTRICAL WORKERS. See also *Johnson & Johnson Ltd. v. Philippe-Charles Ltd.* (1974), 18 C.P.R. (2d) 40, referred to therein.

The examiners must carefully consider two marks that suggest the same idea even though they do not necessarily sound alike or look alike. For example, a consumer might confuse the words MONDAY and LUNDI.

As well, the examiners will have to carefully consider two marks that sound alike, even though they appear dissimilar in written form. For example, a consumer might confuse the words KAUPHUSA and COFFUCA, even though they look different.

When assessing confusion between trade-marks, the first word or first syllable in a trade-mark is more important for the purpose of distinction than those that follow. In *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183, Cattnach J. stated:

"It [respondent] has appropriated the appellant's mark in its entirety and added thereto as a suffix the words `age tendre'. It is axiomatic that the first word or the first syllable in a trade mark is far the more important for the purpose of distinction. Here the first and most important word in the mark which the respondent seeks to register is identical to the mark registered by the appellant."

III.3 Test of Confusion

The test of confusion is one of first impression. Consumers may be aware of the registered trade-mark, but imperfect recollection may cause them to mistake one mark for another. Examiners must put themselves in the position of consumers and ask whether a person with imperfect recollection would be likely to infer that the wares or services associated with the applicant's trade-mark and those associated with the registered trade-mark are manufactured, sold, leased or hired by the same person.

Every application must be examined with respect to confusion, be it an ordinary trade-mark, proposed trade-mark, certification mark or distinguishing guise.

After reviewing a number of cases relating to the determination of confusion in *British Drug Houses Ltd. v. Battle Pharmaceuticals* (1944), 4 C.P.R. 48, President Thorson made the following summation at pp. 57-58:

"In determining whether the registration of a trade-mark should be expunged on the ground of its similarity to a mark already registered for use in connection with similar wares it is not a correct approach to solution of the problem to lay the two marks side by side and make a careful comparison of them with a view to observing the differences between them. They should not be subjected to careful analysis; the Court should rather seek to put itself in the position of a person who has only a general and not a precise recollection of the earlier mark and then sees the later mark by itself; if such a person would be likely to think that the goods on which the later mark appears are put out by the same people as the goods sold under the mark of which he has only such a recollection, the Court may properly conclude that the marks are similar. The reasons for this guiding rule are sound. Similar marks are not identical marks and similarity of marks implies some difference between them, for without any difference they would be identical. A careful analysis of the marks with a view to ascertaining differences fails to observe this important distinction. Moreover, it is the likely effect of the use of the later mark on the minds of ordinary dealers or users generally that must be considered and people as a rule have only a general recollection of a particular thing, rather than a precise memory of it."

In *Canadian Schenley Distilleries Ltd. v. Canada's Manitoba Distillery Ltd.* (1975), 25 C.P.R. (2d) 1, Cattanach J. stated:

"To determine whether two trade marks are confusing one with the other it is the persons who are likely to buy the wares who are to be considered, that is those persons who normally comprise the market, the ultimate consumer. That does not mean a rash, careless or unobservant purchaser on the one hand, nor on the other does it mean a person of higher education, one possessed of expert qualifications. It is the probability of the average person endowed with average intelligence acting with ordinary caution being deceived that is the criterion and to measure that probability of confusion the Registrar of Trade Marks or the Judge must assess the normal attitudes and reactions of such persons.

In considering the similarity of trade marks it has been held repeatedly that it is not the proper approach to set the marks side by side, and to critically analyze them for points of similarities and differences, but rather to determine the matter in a general way as a question of first impression." [At p. 5.]

In this case, the mark TSAREVITCH, for alcoholic beverages, was found to be confusing with the mark TOVARICH for the same wares.

Where the mark or marks being considered are composite marks, it is the totality of the marks which must be considered. In the *British Drug Houses* case, President Thorson said, at p. 60:

"It is the combination of the elements that constitutes the trade mark and gives distinctiveness to it, and it is the effect of the trade mark as a whole, rather than of any particular element in it, that must be considered."

See also *Ultravite Laboratories Ltd. v. Whitehall Laboratories Ltd.* (1965), 44 C.P.R. 189.

In determining confusion, the examiners should take into account only the mark applied for by the applicant and only the trade-mark as registered. The fact that the mark applied for is used in association with a corporate name or logo is of no significance because that is not the mark for which the exclusive right is sought. Commenting on this in *British Drug Houses Ltd. v. Battle Pharmaceuticals* (1944), 4 C.P.R. 48, President Thorson stated at p. 55:

"... the Court must not allow its consideration of the main issue, namely, whether there is a likelihood of confusion in the minds of dealers or users as a result of the use of the mark in dispute, to be deflected by taking irrelevant matters into account. The respondent filed samples of the bottles in which the respective preparations of the parties are sold. These differ somewhat in shape and there are differences in the labels. The Court is not concerned with the bottles in which the preparations are sold or the labels on them but with the trade marks under which they are put out. It is the effect of the trade marks, and not of the bottles or labels, that must be considered. If the use of the marks on the wares is likely to result in confusion as to the wares, differences in the bottles or labels might serve to lessen the confusion but do not eliminate it. Differences in the bottles or labels cannot turn similar trade marks into dissimilar ones. Such differences have nothing to do with the issue before the Court, for there is no reason why either party should continue the use of the present bottles or labels and nothing to prevent either of them from changing the present shape of the bottles or form of labels. Neither the bottle nor the label is part of the trade mark. The protection given by the registration extends to any normal use of the trade mark and is not confined to any particular use of it such as its use with a particular shape of bottle or on a particular form of label."

III.3.1 Doubt as to Confusion

If the examiners have doubts about whether the mark applied for is likely to cause confusion with a registered trade-mark, they shall cause the application to be advertised in the manner prescribed. Pursuant to subsection 37(3), the examiners shall notify the owner of the registered trade-mark which may be confusing with the mark applied for of the advertisement of the application.

III.4 The Search Sheet

This is a document which is electronically generated and contains basic data such as the mark, headings, applicant, serial number, wares/services and filing date. This document is used during the manual search and for recording research done by the examiners. (Sample follows.)

III.5 Search Headings

The first step in a search is a consideration of the trade-mark and its salient features. Next is the noting of the headings under which the search will be made. These include, but are by no means limited to, those headings under which the trade-mark is indexed. The noting of headings can only be done if there is a clear understanding of the nature and purpose of the actual wares or services with which the application is concerned. On occasion, the examiners and searchers may find that they are unable to determine the area in the trade connected with the trade-mark because they are unfamiliar with the wares or services specified in the application. If research sources available fail to provide the necessary information, they should postpone the search until they have obtained clarification or additional information from the applicant. Assumptions can lead to serious mistakes.

To give some idea of the headings under which various types of marks would be searched, a few examples are cited below.

III.5.1 Vowels

When searching words beginning with or including vowels, the search should generally extend to all or most of them. This is particularly applicable to short words.

EXAMPLE

Mark: GIRO

Indexed: GIRO

Headings: Garo
Gero
Giro
Goro
Gyro

III.5.2 Consonants

Words beginning with consonants which have phonetic equivalents in other letters of the alphabet should be searched under the phonetic equivalent.

EXAMPLE

Mark: CHRYMEC

Indexed: CHRYMEC

Headings: Chry

Cry

Kry

Khry

NOTE: The phonetic equivalents of words, letters and/or numbers must be considered, bearing in mind that the "degree of resemblance" in appearance and sound is very important in a determination of confusion. The indexes contain many cross references to various phonetic equivalents of familiar dictionary words, but in the case of an invented word, additional headings may have to be searched.

III.5.3 Letters

A two-letter combination is searched under both letters. A three or more letter combination is searched under the first and second letters. A monogram is searched under all the component letters. Letters should be searched under their phonetic equivalent.

EXAMPLE

Mark: JP

Indexed: JP

Headings: JP

PJ

Jay pee

III.5.4 Names or Surnames

EXAMPLE

Mark: MARY JONES

Indexed: MARY JONES
JONES, MARY

Headings: Mary Jones
Jones, Mary

III.5.5 Words of Praise or Quality

When words of praise or quality are involved, e.g., "favourite," "ideal," "peerless," the search may be restricted to the mark for wares or services in the same class since these words tend to make very weak marks.

III.5.6 Common Prefixes or Suffixes

There are some words or combining forms which appear to be highly favoured by trade-mark owners because of their suggestive connotations.

EXAMPLE

Dura (the quality of durability)

Flex (the quality of flexibility)

Tone (the quality of sound or colour)

In these circumstances the search is restricted to locating those marks which bear a high degree of resemblance in sound or appearance or in the ideas suggested by them and which are associated with identical or very closely related wares or services.

III.5.7 Distinctive Marks

A very distinctive mark requires a very broad search extending to marks that resemble it only slightly and to wares or services which may or may not be related - e.g., KODAK, XEROX.

III.5.8 Pharmaceutical Marks

When conducting a search of a word mark which is applied to the general class of wares known as pharmaceutical preparations, medicines, veterinary preparations and so on, a separate index known as the Pharmaceutical Index must be searched. This is an alphabetical index allowing the searcher to broaden the search for this class of wares. The Pharmaceutical Index is unique in that it breaks up the trade-mark, in some cases letter by letter, and provides a card for each letter or group of letters preceding the severed portion.

EXAMPLE

Mark: RESPBID

Pharmaceutical Index Listings:

RESPBID
ESPBID, R
BID, RESP
ID, RESPB
D, RESPBI

EXAMPLE

Mark: TRIPHASIL

Pharmaceutical Index Listings:

TRIPHASIL

RIPHASIL, T
IPHASIL, TR
PHASIL, TRI
HASIL, TRIP
ASIL, TRIPH
SIL, TRIPHA
IL, TRIPHAS

Thus, when searching a mark such as RESPBID in the Pharmaceutical Index, a potentially confusing mark such as DESPID or RASPBID may be located by checking under the headings ESPID and BID, as indicated. Otherwise, these potentially confusing trade-marks might not be located.

Once any potentially confusing trade-marks have been located in the Pharmaceutical Index, the searchers must also check the regular trade-mark index, including the abandoned and refused indexes, to determine the wares, owner, registration date, etc.

Note that the Pharmaceutical Index was created to supplement the regular index. A pharmaceutical mark must also be searched in the regular index, although not as stringently. A potentially confusing mark may be located there for wares other than pharmaceuticals, but in a related class, and may therefore yield an objection.

Incorporated in the Pharmaceutical Index, but not broken down as with trade-marks, are some Approved Names for Pesticides, International Non-Proprietary Names (I.N.N.) and the British Pharmacopoeia Commission (B.P.C.) approved names. If the mark being searched is listed as an approved name of one of the above, then recourse to paragraph 12(1)(b) of the Act should be considered by the examiner in charge of the case.

NOTE: Since 1988, approved names of pesticides have not been in this index, but have instead been listed in the green binder in the Public Search Room. The most current I.N.N. can also be found in a binder in the Search Room.

III.6 Searching the Indexes

A complete search of the indexes must include a search of pending, registered and abandoned or refused marks under the *Trade Marks and Design Act*, the *Unfair Competition Act*, the *Trade-marks Act* and the Newfoundland Register. A search of the refused and abandoned indexes is made to discover past decisions or research which has been compiled and which might apply to the case at hand.

Indexes of names of applicants and registrants are useful to the examiners, particularly in cases where the applicant is the owner of previously registered trade-marks which would otherwise be found confusing. *See section 15.*

Additional indexes, such as the ones for cancelled and expunged marks, as well as the Pharmaceutical Index and the index to marks filed under the Paris Convention, will also be searched when occasion demands. For example, the Pharmaceutical Index and the list of pesticides, which include common names for drugs or pesticides, should be consulted in searches of marks applied to medicines, drugs, dietetic foods, food supplements, medicated wound dressings, antiseptics, germicides, pesticides, fungicides, veterinary preparations, etc.

The list of geographical indications for wines or spirits should be consulted when the application covers such goods.

The index and registers for subject matter protected pursuant to Article 6*ter* of the Paris Convention should be consulted when searching marks comprising flags, coats of arms, emblems and the like. *See paragraph 9(1)(i).* The reasons for this are discussed in section IV.8 of this manual.

III.7 Discovering a Confusing Mark

III.7.1 Confusion with a Registered Mark — Paragraph 12(1)(d)

If, according to the criteria in section III.2 of this manual, the mark applied for is confusing with a registered trade-mark, the examiners must, pursuant to paragraph 12(1)(d) of the Act, raise an objection. Subsection 37(2) dictates that the applicant must be notified of the reasons for the objection and be given an opportunity to respond. The applicant's response will be evaluated. If the examiners still find that the mark applied for is confusing with the registered mark, the application may be finally refused, with complete reasons given.

NOTE: If the applicant wishes to overcome a citation of confusion with a registered trade-mark on the basis of earlier use in Canada, he/she could proceed with an action in the Federal Court to expunge the cited registration. To allow for the pursuit of such an expungement action, the examiners may grant the applicant an extension of time.

III.7.2 Associated Marks — Section 15

If the applicant is the owner of other marks with which the mark being applied for could be confused, the examiners will not raise a paragraph 12(1)(d) objection. Pursuant to section 15, the mark applied for will be associated with the applicant's other marks.

In cases where a partial assignment has been recorded, the statement of association should specify the wares in respect of which the marks are associated. For example, the mark HABITANT has partial owners and would be associated in the following manner: associated mark TMDA 46783 in respect of the wares marked 2. The Trade-marks Office may correct any error, in accordance with Rule 33, by removing the association between marks which, through clerical error, should not have been associated initially.

III.7.3 Confusion with Certification Mark

Section 24 of the Act provides for the registration of a mark that is confusing with a registered certification mark by a licensee of the certification mark. This can occur only if the owner of the registered certification mark consents and if the marks exhibit an "appropriate difference." The mark must be used by the licensee "to indicate that the wares or services in association with which it is used have been manufactured, sold, leased, hired or performed by him as one of the persons entitled to use the certification mark." The Registrar must, however, expunge the registration should the owner withdraw consent, or upon cancellation of the registration of the certification mark. *See subsections 23(2) and (3) of the Trade-marks Act and sections II.7.5.3 and IV.4.13 of this manual.*

III.7.4 Trade-names

There is no authority in the *Trade-marks Act* which permits examiners to object on the basis of confusion with trade-names. A trade-name is the name of the establishment under which an applicant trades and can also be a trade-mark (e.g., "GE") assuming it is used as a trade-mark. Of course, the test of registrability applicable to all trade-marks applies.

III.8 Confusion — Person Entitled Re: Co-pending Applications — Section 16

If a search of the pending indexes reveals an application for a trade-mark which is considered to be confusing with the mark being examined, the examiners must make a decision as to which applicant is entitled to registration. Historically, decisions about entitlement were made by determining that the person who first used a mark in Canada was the one entitled to register the mark. There are now bases for filing in Canada other than use. Dates of entitlement for applications based on making known, proposed use and foreign registrations are provided for in section 16 of the *Trade-marks Act*. The following chart sets out the bases upon which trade-mark rights may be claimed in Canada and the date of entitlement associated with each basis of filing. *See subsections 16(1), (2) and (3). Also see sections III.8.4, V.10 and V.11 of this manual.*

III.8.1 Entitlement

Basis of filing	Date which establishes entitlement
16(1) Used in Canada	Date of use in Canada named in application
16(1) Made known in Canada	Date of making known in Canada stated in application
16(2) Registered abroad in or for a Union country and used in some country other than Canada (Convention priority claimed)	Filing date of application in or for a Union country on which application in Canada is based
16(2) Registered abroad in or for a Union country and used in some country other than Canada	Filing date in Canada
16(3) Proposed use in Canada	Filing date in Canada

III.8.1.1 Disposition of Application

The application for a mark which is deemed to be unregistrable may meet with several ends.

- 1) The applicant may voluntarily abandon the application.

or

- 2) Default procedures may be instituted pursuant to section 36.

or

- 3) The application may be refused pursuant to paragraph 37(1)(c).

or

- 4) The application may proceed to advertisement if the applicant overcomes the objections.

III.8.2 Abandoned Applications

An abandoned application cannot be cited against a pending application. *See paragraph 37(1)(c).*

III.8.3 Concurrent Use of Confusing Marks

Although examiners are not responsible to take action in the event of concurrent use of confusing marks, they may at least familiarize themselves with the provision on this matter as set down in subsection 21(1) of the *Trade-marks Act* and as provided for in the event a court order is issued.

Concurrent use would occur where the owner of the confusing mark had "in good faith used a confusing trade-mark" and where "continued use in a defined territorial area" would not be considered contrary to the public interest.

III.8.4 Notification of Applicants

When confusion is apparent between pending trade-marks, the examiners will immediately accept for advertisement the application of the entitled person, as long as no other objections or requirements exist. At the same time, the examiners will notify the non-entitled party of the action and give the reason for non-entitlement, namely, the earlier date of entitlement of the other application.

An entitled application encountering a co-pending confusing application which is being opposed will not be withheld in any circumstance, particularly pending the resolution of the opposition proceedings, but will proceed to advertisement in the *Trade-marks Journal*. See *Anheuser-Busch, Inc. v. Carling O'Keefe Breweries of Canada Ltd.* (1982), 69 C.P.R. (2d) 136.

An entitled application encountering a co-pending application which has been allowed will not give rise to a section 16 objection. The examiner will merely draw attention to the allowed application and approve the subject application as long as no other objection or requirements exist.

Where the non-entitled person's application encounters a co-pending confusing application which has been published in the *Trade-marks Journal*, the non-entitled person should receive an action citing the confusing trade-mark and be informed of the publication date.

Where the non-entitled application being examined encounters a co-pending confusing application which is the subject of opposition proceedings, it will not be held in abeyance pending the opposition outcome, but will receive an action citing the confusing trade-mark and a time limit of four months in which to reply. See *Anheuser-Busch, Inc. v. Carling O'Keefe Breweries of Canada Ltd.* (1982), 69 C.P.R. (2d) 136.

NOTE: An entitled application encountering a co-pending confusing application which is scheduled for advertisement but not yet officially published in the *Trade-marks Journal* will be accepted for advertisement, as long as no other objection or requirements exist, notwithstanding that it may be too late to prevent the publication of the non-entitled mark. The deadline for withdrawal of approval in such a case is the actual date of publication. The examiners will issue a report advising the non-entitled party that a subsequent application has been filed with an earlier entitlement date and will withdraw the approval. The examiners will also advise that an erratum will be published stating that the publication of the non-entitled application was in error. However, if the co-pending confusing application is discovered after the publication date, then the process becomes irreversible since the finality is the advertisement. See RAPIDO PLUS case. *Beaver Knitwear Ltd. v. Registrar of Trade Marks* (1986), 11 C.P.R. (3d) 257.

III.8.5 Same Entitlement Date

In cases where both parties have the same entitlement date (i.e., the same date of first use or same date of filing, etc., for similar or identical wares or services), both applications will be approved for publication. This is because it cannot be said that one applicant is entitled to registration over the other, pursuant to section 16.

III.9 Reference Sources

Chapter IV of this manual — The Examination of the Mark — provides a complete list of all reference sources available to the examiners, i.e., dictionaries, encyclopedias, etc.

III.10 Preparation of File for Advertisement

The following is a checklist for preparing the file for advertisement.

- 1) Bring forward the acceptable application, supporting certificates and the proof sheet.
- 2) Affix the drawing of the mark in the lower left-hand corner of the first page of the application.
- 3) Enter in the upper right-hand corner of the application:
 - a. Serial Number
 - b. Filing Date
 - c. Priority Date (if applicable)
- 4) In the case of a subsection 16(2) claim, enter the registration number and date in the margin to the left of the claim (if this information is not contained in the claim).
- 5) Using the pre-printed advertisement sheet (sample follows), indicate all pertinent information to appear in the *Trade-marks Journal*, as well as other information that will subsequently appear on the registration certificate.

ADVERTISEMENT SHEET - FEUILLE DE PUBLICATION

Change of Agent - Changement d'agent _____

Change of representative for service - Changement de représentant pour signification

Change of name or transfer _____

Changement de nom ou transfert

Priority filing date - Date de priorité _____

CERTIFICATION MARK - MARQUE DE CERTIFICATION

DISTINGUISHING GUISE - SIGNE DISTINCTIF

Disclaimer - Désistement

As per application - Comme dans la demande

or - ou _____

Colour claim - Couleur

Lined for colour
Ligné pour couleur

As per application
Comme dans la demande

or - ou _____

Consent, re: Signature/Portrait

Consentement Signature/portrait

As per application

Comme dans la demande

or - ou _____

Amendment of wares (filing date) _____

Modification des marchandises (date de production)

Revised wares - Marchandises révisées

Revised Services - Services révisés

Section 12(2) - Article 12(2)

Restricted to - _____

Section 14 - Article 14

Restreint (à/au)

Section 67(1) Nfld. No. - Article 67(1) Terre-Neuve N° _____

Section 37(3) (Flag File) - Article 37(3) (Étiqueter le dossier) _____

Applicant is the owner of Registration No.

Le requérant est le titulaire de l'enregistrement N° _____

Associated marks - Marques liées: _____

or - ou Identified on Search Report by RED check mark - Cochées en ROUGE sur la feuille de recherche

Other instructions

Autres renseignements

IV THE EXAMINATION OF THE MARK

IV.1 Purpose of Examination

A formal review of the application serves initially to establish its compliance with the requirements of section 30 of the *Trade-marks Act*. However, the study of the application also allows the examiners to assess the character of the trade-mark, to become familiar with the wares or services associated with it, and to understand the nature of the business involved. Using this knowledge, the examiners are then well prepared to undertake an examination of the mark itself and to determine its registrability. For while an applicant can use a mark in association with wares or services for purposes of identification in the marketplace and call it a trade-mark, it is not necessarily registrable.

Upon receiving the application, the examiners will carefully scrutinize its subject matter giving particular consideration to the following:

- a) Is the subject matter a trade-mark pursuant to section 2?
- b) Is the subject matter a distinguishing guise pursuant to section 13?
- c) If the subject matter is a trade-mark, is it registrable pursuant to paragraphs 12(1)(a), (b), (c), (d), (e), (f), (g) or (h) or sections 9 or 10 of the *Trade-marks Act*?

or

- d) If the trade-mark is not registrable pursuant to paragraph 12(1)(a) or (b) of the *Trade-marks Act*, is it registrable on proof of acquired distinctiveness or secondary meaning pursuant to subsection 12(2), or on proof that the mark applied for is not without distinctive character in Canada pursuant to section 14?

IV.2 Definition of Trade-mark

According to section 2 of the *Trade-marks Act*, a trade-mark is:

- a mark which is used for the purpose of distinguishing, or so as to distinguish, the wares or services of one person from those of others (ordinary mark);
- a certification mark;
- a distinguishing guise; or
- a proposed trade-mark.

All trade-marks are defined in terms of subject matter and purpose. The subject matter is "a mark." The purpose is defined in the same manner for an ordinary trade-mark, a distinguishing guise and a proposed mark and in a different manner for certification marks. *See relevant sections in this manual.*

Although the word "mark" has not been specifically defined in the *Trade-marks Act*, it has been interpreted as being co-extensive with the word "symbol" as it appeared in the *Unfair Competition Act* and as co-extensive with the list of subject matter under the *Trade Marks and Design Act*. The exception is that the shaping of wares or their containers or a mode of wrapping or packaging wares has been separately defined as a distinguishing guise.

The subject matter protectable under the *Trade Marks and Design Act* was: "all marks, names, labels, brands, packages, or other business devices," used to distinguish the wares of any person. At present, a mark which is primarily functional or which has a characteristic appearance resulting from the process of manufacture or which consists of ornamentation applied to wares for the purpose of enhancing the appearance of the wares is not necessarily proper subject matter for a registrable trade-mark.

IV.2.1 Colour

An applicant may claim colour as a feature of the trade-mark. Unless restricted to a particular colour, registration confers on the registered owner the exclusive right to use the mark in any colour. See *Smith v. Fair* (1887), 14 O.R. 729 and *Tavener Rutledge Ltd. v. Specters Ltd.* [1959] R.P.C. 355.

If, on application, colour is claimed as a feature of the trade-mark, the colour of the mark or of its elements must be described in the application.

Colour alone will not render a trade-mark registrable. However, the Office now accepts marks which consist of a specific colour as applied to a particular shape and size of a product in view of the Federal Court of Canada decision *Smith, Kline & French Canada Ltd. v. Registrar of Trade Marks* (1987), (Unreported - T - 567 - 84). In that case, Strayer J. concluded that the trade-mark did not "reside in colour alone." The judge noted that, "the trade mark whose registration as sought is a particular colour of green applied to a particular size and shape of tablet."

In cases such as these, the examiners will request a dotted outline drawing showing a three-dimensional perspective of the mark to comply with paragraph 30(h). (The drawing may be lined in accordance with the colour chart in Rule 28(2) of the Regulations.) Also, if a specimen is to form part of the description of the mark, the specimen should be specifically referenced therein. See *Novopharm Ltd. v. Burroughs Wellcome Inc.* (1993), 52 C.P.R. (3d) 263. This opposition decision was subsequently upheld in the Federal Court Trial Division in *Burroughs Wellcome Inc. v. Novopharm Ltd.* (1994), 58 C.P.R. (3d) 513

The applicant should include a paragraph relating to the colour claim, together with a clear description as to what the trade-mark consists of, as well as a statement that the representation of the wares shown in the dotted outline does not form part of the trade-mark.

Colour applied to one strand in a wire rope has been held to be a registrable trade-mark. See *Wrights' Ropes Ltd. v. Broderick & Bascom Rope Co.* [1931] Ex. C.R. 143. Furthermore, colour in the form of lines woven into the edge of cloth is registrable as a trade-mark. See *F. Reddaway & Co. Ltd's Application* (1914), 31 R.P.C. 147.

The representation of a plaid, however, for use in association with cloth is not a mark. Since plaid consists of combinations of coloured threads woven in a precise pattern to create the wares, the coloured pattern is the wares and therefore cannot be a trade-mark applied to the wares.

IV.2.2 Functionality

Where the subject matter of an application is primarily functional, it cannot be protected as a trade-mark.

A combination of a clear cigarette package wrapper and a red coloured band, which were deemed functional, were ruled not fit subject matter of a trade-mark in *Imperial Tobacco Co. of Canada, Ltd. v. Registrar of Trade Marks* [1939] Ex. C.R. 141. At p. 145, Maclean J. stated:

"In my opinion any combination of elements which are primarily designed to perform a function, here, a transparent wrapper which is moisture proof and a band to open the wrapper, is not fit subject matter for a trade mark, and if permitted would lead to grave abuses."

The function, in this case, dictated the design, hence such a design was not registrable as a trade-mark. This is not regarded, however, as the only criterion upon which a mark would be rejected for being primarily functional. For example, public perception is seen as being important regarding the particular design involved.

In *Parke, Davis & Co., Ltd. v. Empire Laboratories Ltd.* (1963), 41 C.P.R. 121, Noel J. found that the registration of 10 different colours applied to pharmaceutical capsules constituted a monopoly and that the band sealing the two portions of the capsule performed a function. By contrast, in *IVG Rubber Canada Ltd. v. Goodall Rubber Co.* (1980), 48 C.P.R. (2d) 268, Dubé J. found that the helical stripe on the Goodall hose does not have the same type of functional use as the band on the Parke, Davis capsule. He found that, unlike the gelatine band which fulfils the essential physical function of holding the capsule together, the spiral stripe running along the Goodall hose is not physically essential to the hose, but that it merely distinguishes it from other wares.

Also, if the subject of the application contains certain markings arising from the process of manufacture, it is not proper subject matter for an application. See *Elgin Handles Ltd. v. Welland Vale Manufacturing Co. Ltd.* (1964), 43 C.P.R. 20.

If the design applied to the wares has a primarily functional or ornamental use, the application should be refused. In *W.J. Hughes & Sons "Corn Flower" Ltd. v. Morawiec* (1970), 62 C.P.R. 21, Gibson J. considered the validity of a trade-mark

consisting of the fanciful representation of a cornflower, the design of which was cut on glass blanks, which then became cut glass. The design was described as follows:

"The conventional representation of a flower having twelve petals and a compound pistil illustrated by intersecting lines, said flower being supported on a stem or stalk having a plurality of narrow pointed leaves."

In finding the registration invalid, Gibson J. stated at pp. 34-35:

"But there could have been no valid registration of this pattern or design to be applied on glassware for ornamentation or functional use only. If the intention to do this latter only had been conveyed to the Registrar at the time of the application in 1951, he probably would have refused the registration.

The attack in this case is that the intention the plaintiff had when applying for registration of this pattern or design in 1951 was for the purpose of enabling it to use the registration of this pattern or design for cut glass tableware for ornamentation purposes only in fact, but the plaintiff did not convey such intention to the Registrar of Trade Marks. Instead the intention the plaintiff conveyed to the Registrar at the time was that this pattern or design was to be used by it for trade mark purposes."

In *Adidas (Canada) Ltd. v. Colins Inc.* (1978), 38 C.P.R. (2d) 145, Walsh J. considered the validity of a mark depicting a person wearing a training suit. The mark was described as follows: "The design consists of three parallel stripes applied to the outside of the sleeves and of the legs of the training suit in a longitudinal direction." The wares were described as training suits. Two other similar marks for sportswear were also considered. At p. 169, Walsh J. stated:

"Moreover aside from the question of distinctiveness there is a very serious question as to whether the three stripes do not constitute a functional design, serving the function of decoration and are not properly registrable as a trade mark.

There is some evidence to the effect that striping on the sleeves or legs of garments, and athletic garments in particular, adds to their attractiveness for a

potential buyer. Longitudinally placed stripes have a slenderizing effect and may perhaps give an illusion of speed or motion. Certainly I believe that it is fair to say that a garment bearing some such decorative stripes is more attractive and has more eye appeal than a plain garment. This has been recognized by manufacturers for many years and no doubt accounts for the great variety of striping which is so used".

At p. 170, Walsh J. approved the statements of the Registrar refusing to register three parallel stripes applied for in relation to various types of sports clothing. At pp. 154-155, Walsh J. stated:

"These were all objected to by the Registrar for the same reasons, namely, that they were intended to be used primarily for ornamentation rather than as trade marks properly speaking, and that ornamentation is protected by the *Industrial Design Act*, R.S.C. 1970, c. I-8, only for five years subject to renewal for a further five years, and that the *Trade Marks Act*, must be strictly interpreted so as to not grant rights for ornamentation of wares for a longer period. It was further stated that it is not the intention of the applicant which is the determining factor but the effect that the particular ornamentation or dress applied to the representations of the wares produces upon the public mind. It was conceded that ornamentation not normally used as a trade mark may by reason of extensive use acquire a distinctiveness and thus in time become a distinguishing guise capable of being registered as a trade mark, but must first as a result of extensive use be perceived or understood by the public to be performing the function of distinguishing the goods of the applicant from those of others."

In *Remington Rand Corp. v. Philips Electronic N.V.* (1993), 51 C.P.R. (3d) 392, McGillis J. was faced with an action for expungement of four trade-marks held by Philips. Two of the marks were two-dimensional representations of a triple-headed rotary shaver head assembly and the other two were distinguishing guises. McGillis was of the opinion that the applicant for the expungement action had failed to establish a factual basis to support the contention that utilitarian functionality dictated the design of the triple-headed shaver. Therefore, the action to expunge the four trade-mark registrations was dismissed.

The Decision of McGillis J. was, however, reversed by the Federal Court of Appeal (1995), 64 C.P.R. (3d) 467, which ordered Phillips' registrations expunged. Only two of the original four registrations were at issue in the appeal decision - one design mark and one distinguishing guise. After a thorough review of the jurisprudence, MacGuigan J. A. concluded at p. 475 of the decision:

“...what is determinative is the kind of functionality in question. If functionality goes either to the trade mark itself (*Imperial Tobacco*, and *Parke Davis*) or to the wares (Elgin Handles), then it is essentially or primarily inconsistent with registration. However, if it is merely secondary or peripheral, like a telephone number with no essential connection to the wares, then it does not act as a bar to registration.”

The Court of Appeal went on to hold that both the design mark and the distinguishing guise in question were primarily functional and therefore not registrable. The Federal Court of Appeal appears to have been influenced by the fact that registration of a primarily functional trade-mark is a restraint on manufacturing and trade, since it effectively amounts to a patent or industrial design in the guise of a trade-mark.

In the event that the mark applied for is not objectionable as being primarily functional or ornamental, then the depiction of the wares showing particular shapes or markings or the shaping of the containers of the wares should be examined as a distinguishing guise, pursuant to section 13. *See also "Distinguishing Guise" in section IV.2.6 of this manual.*

IV.2.3 Representation of the Wares (full-line drawing)

Sometimes, applications are filed for trade-marks which are depictions of the wares in full-line drawing showing particular shapes, decorations or ornamentations applied to the wares or to containers. Such applications have been filed for a wide variety of wares, including athletic shoes, dish cloths, swimsuits, briefcases, cut glass, and so on.

Office practice does not allow for full-line drawings of the wares or containers as trade-marks unless the application is for a distinguishing guise.

If the application clearly states that the representation of the wares or the container does not form part of the mark, then the applicant will be permitted to change the drawing to dotted outline format. Once the amendment is made, the application will be examined as an ordinary trade-mark. An application originally submitted lacking such a statement or any other information to indicate that the applicant did not intend to file for a distinguishing guise, will be treated as an application for registration of a distinguishing guise. This guidance as to form does not preclude the Office from determining that a mark is primarily functional or ornamental in nature.

IV.2.4 Representation of the Wares (broken-line drawing)

Trade-mark registrations should be as clear as possible as to exactly what is being protected. Applications must include a drawing in dotted outline and statements which help to clarify the actual trade-mark being applied for. Such an application must also state that the representation of the wares or containers does not form part of the mark. If missing from the application, these elements will be requested in a revised application.

This guidance as to form does not preclude the Office from determining that a mark is primarily functional or ornamental in nature.

IV.2.5 Packages (unfolded)

From time to time, registration is sought for a box design with the box being shown in the drawing in its unfolded or knocked-down form and in which all four, or more, side panels and the ends may be viewed at once. This is acceptable provided that the unfolded or knocked-down form is shown in dotted outline and the application contains the statement that the representation of the unfolded container does not form part of the mark, as well as a statement which helps to clarify the actual trade-mark applied for.

IV.2.6 Distinguishing Guise

The definition of a distinguishing guise, as opposed to that of a trade-mark, refers directly to the wares themselves or their containers or packaging as being the mark. Applications which show a representation of the wares, containers or packaging as part of the mark must therefore be examined as a distinguishing guise. *See also section II.7.6 of this manual.*

If the representation of the wares or containers is not part of the mark, it should not be shown or, if shown, it should be in dotted outline only. The application must also include a statement that the representation of the wares or container is not part of the mark and a statement as to what the mark consists of.

All other applications showing a representation of the wares, containers or packages in full outline will be examined as a distinguishing guise. In this assessment, the public perception as to whether the design applied for serves to indicate the source of origin, or whether it is primarily functional or ornamental, is important.

For example, three parallel stripes on a jogging suit have aspects other than identifying a source of origin. The striping makes the garment attractive to potential buyers by giving the illusion of speed and, in the case of longitudinally placed stripes,

by having a slenderizing effect. The public has been conditioned to perceive these stripes as merely decorative, adding eye appeal to the garment.

As pointed out by Walsh J. in *Adidas (Canada) Ltd. v. Colins Inc.* (1978), 38 C.P.R. (2d) 145, at p. 155:

"It was conceded that ornamentation not normally used as a trade mark may by reason of extensive use acquire a distinctiveness and thus in time become a distinguishing guise capable of being registered as a trade mark, but must first as a result of extensive use be perceived or understood by the public to be performing the function of distinguishing the goods of the applicant from those of others".

See also section IV.2.2 of this manual on functionality.

IV.2.7 Slogan

Occasionally, an applicant will seek to register a slogan as a trade-mark. The limitations previously found in the *Unfair Competition Act* which provided that a word mark was not registrable if it contained more than 30 letters and/or numerals divided into more than four groups are not found in the *Trade-marks Act*. Currently, the registrability of a slogan is judged, as with subject matter presented in any form, pursuant to the provisions of section 12 of the Act.

IV.2.8 Letters and Initials

Letters and initials are acceptable as subject matter for a trade-mark or part of a composite mark provided that they are not the name or abbreviation of the name of the wares or that they are not otherwise unregistrable.

For example, NO. 1 is a mark, but is not a registrable trade-mark, being clearly descriptive of the character or quality of the wares. See *John Labatt Ltd. v. Carling Breweries Ltd.* (1974), 18 C.P.R. (2d) 15. Mere letters are building blocks of written communication and, as such, are given a very narrow scope of protection when used as trade-marks. See *GSW Ltd. v. Great West Steel Industries Ltd.* (1975), 22 C.P.R. (2d) 154.

With respect to letters and initials, the ambit of protection accorded to such marks can be enhanced by incorporating the letters in a design, bearing in mind that it is the reaction of the public to the totality of the design which determines the distinctiveness of the trade-mark. See *Cochrane-Dunlop Hardware Ltd. v. Capital Diversified Ltd.* (1976), 30 C.P.R. (2d) 176 at p. 183, where Blair J. stated:

"...the result might have been different had the mark consisted not only of letters of the alphabet but also design features giving it greater distinctiveness. An example of such distinctiveness added to mere letters of the alphabet is provided by *Building Products Ltd. v. B.P. Canada Ltd.* (1961), 36 C.P.R. 121, 21 Fox Pat. C. 130, per Cameron J., at p. 143."

See also section IV.6.3 of this manual.

IV.2.9 Numerals

Applications in which numerals appear as subject matter for protection should be accepted unless it is apparent from material filed by the applicant that the numbers are used merely to number parts of equipment sold in association with a trade-mark. See *Decatur v. Flexible Shaft Company Limited* [1930] Ex. C.R. 97. Nevertheless, numerals, like initials and letters, are marks of low inherent distinctiveness and should be given a narrow scope of protection. *See also section IV.6.3 of this manual.*

Fox, in his *Canadian Law of Trade Marks and Unfair Competition*, Third Edition, argues against the acceptability of numerals as subject matter, pointing out at page 80 that the inherent danger in marks consisting only of numerals lies in their being used, more often than not, merely as grade or quality marks, and not as trade-marks as defined in section 2 of the Act. Such numerals are barred from *prima facie* registrability under paragraph 12(1)(b) as being clearly descriptive of the character or quality of the wares. However, some marks composed of numerals may be properly

registered as trade-marks. See *Pizza Pizza Ltd. v. Registrar of Trade Marks* (1989), 26 C.P.R. (3d) 355, where a Federal Court Trial decision upholding the Registrar's refusal of the mark "967-1111" was overturned.

IV.3 Paragraph 12(1)(a) — Names and Surnames

The Act states that a trade-mark is registrable if it is not:

"a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years."

The statute generally follows the historical principle of common law that all people should be able to identify their goods by their names or surnames, providing the name or surname was used honestly and not with the intent of passing off the goods as those of another person with the same or a similar name.

When confronted with a mark comprised of a word or words which have name or surname connotations, the examiners must determine in each case if the word is primarily merely the name or surname of an individual who is living or has died within the preceding thirty years, since the word may have another or other connotations which would figure significantly in the minds of Canadian consumers. Where the word is the name or surname of an historical character who has been dead for more than 30 years, that word is normally registrable. See also section IV.3.11 of this chapter.

In addition, subsection 12(2) and section 14 of the Act provide for the registration, under certain circumstances, of a word or words which are prohibited under paragraph 12(1)(a). A word which is a name or surname may be registrable under subsection 12(2) provided the applicant can furnish satisfactory evidence to show that the name or surname has acquired a secondary meaning and does in fact distinguish the goods of the applicant from those of others. See section IV.10 of this manual.

Pursuant to section 14, a word which is a name or surname may be registrable, provided the trade-mark is not without distinctive character in Canada. Where an applicant claims the benefit of section 14, circumstances such as the length of time the mark has been used in any country will be carefully considered. See also section II.7.8 of this manual.

IV.3.1 Word

The *Interpretation Act* provides that the singular includes the plural, so that "a word" in paragraph 12(1)(a) includes "words."

In *Standard Oil Co. v. Registrar of Trade Marks* (1968), 55 C.P.R. 49 at p. 58, Jackett J. stated:

"For trade mark purposes, there are at least three classes of `words', viz., dictionary words, names, and invented words. They are all words, in my view, at least for the purposes of the Trade Marks Act."

IV.3.2 Definition of Name or Surname

A surname is the name borne in common by members of a family, while a name is a forename or given name or initials combined with a surname, for the purpose of individualizing members of the same family. A word is registrable when it is only a forename or a given name, unless it is also a common surname. *See section IV.3.10 of this manual for further clarification.*

A trade-mark comprised of a form of address such as Sir, Madam, Miss, Ms., M., Mme., etc., in combination with a word which is a given name, is not normally considered to be primarily a name or surname, and is also seen as registrable material. However, in *Baroness Spencer-Churchill v. Cohen* (1968), 55 C.P.R. 276, the Registrar found the trade-mark SIR WINSTON to constitute a combination of words by which the late Sir Winston Leonard Churchill was regularly known and designated, and was therefore primarily merely the name of an individual who had died within the preceding 30 years. In the case of a trade-mark which consists of a form of address and a word deemed to be primarily merely a surname, the surname portion of the mark must be disclaimed.

IV.3.2.1 Given Name and Surname

A mark which appears to be a combination of a given name and a surname, or the initial(s) of a given name or names and a surname, should not be objected to under paragraph 12(1)(a) unless that exact combination can be located in a directory, book of names or similar reference source.

If such a combination cannot be located, but only its surname portion, then the examiners should request a disclaimer to the right to the exclusive use of the surname portion.

If, however, such a combination can be located, then, and only then, should the test to determine primary meaning be applied. *See section IV.3.10 of this manual.*

EXAMPLE

TRADE-MARK	LISTINGS	ACTION
John Wilson	John Wilson	12(1)(a)
John Wilson	J. Wilson	disclaimer of Wilson
J. Wilson	John Wilson	
	Jack Wilson	12(1)(a)
J. Wilson	J. Wilson	12(1)(a)

In *Gerhard Horn Investments Ltd. v. Registrar of Trade Marks* (1983), 73 C.P.R. (2d) 23, Cattnach J., in allowing registration of the mark MARCO PECCI, said at p. 25:

"What is precluded by para. 12(1)(a) from registration as a trade mark is the `name or surname of an individual who is living or has died within the preceding thirty years' and the name of a fictitious person is

not precluded thereby from registration except when by chance the fictitious name coined by the applicant for registration thereof coincides with the name of a living person or a person who bore such name and has been dead for less than thirty years."

And later at p. 30:

"The first and foremost consideration is whether the word or words sought to be registered in the mark is the name or surname of a living individual or an individual who has recently died. It is when that condition precedent is satisfied, and only then, that consideration need be given to the question whether the trade mark applied for is 'primarily merely' a name or surname rather than something else."

And again at p. 31:

"It is not enough that the fictitious name may resemble the name that could be borne by an actual person or might be thought by the public to be names or surnames. That thought only becomes material when it is established by evidence that there is a living person of the name or surname in question."

IV.3.2.2 Surnames Followed by "& Sons," "Brothers," etc.

Words comprised of a surname followed by "& Sons," "Brothers," etc. are not, as a whole, objectionable under paragraph 12(1)(a) as being primarily merely a surname. The additional matter such as "& Sons" takes away the "primarily merely" element. A disclaimer of the surname portion of the trade-mark would, however, be required in view of paragraph 12(1)(a) and section 35 of the *Trade-marks Act*.

IV.3.3 Compound Surnames

A trade-mark composed of two or more surnames, either separated by a hyphen or not, will not be considered contrary to paragraph 12(1)(a) of the Act unless at least one listing of the exact combination can be found in the telephone directories. In cases involving compound surnames without hyphens and where no listing can be found of the combination, each portion is to be checked for surname significance. If

either or both portions are located as a surname individually, then that portion, or both, as the case may be, should be individually disclaimed.

Such disclaimer requests may not be overcome by the filing of evidence pursuant to subsection 12(2) or section 14 since the mark as a whole has not been objected to and is registrable with the disclaimers. If both portions, however, are located individually as surnames, but the combination is hyphenated, then no disclaimer statement would be required.

A trade-mark comprising two words which are primarily merely surnames separated by any indicia, other than a hyphen, such as the word "and" or by an ampersand, oblique sign, asterisk, comma and so on, is registrable with a disclaimer statement extending to the two surnames. The trade-mark as a whole cannot be said to be primarily merely the surname of an individual, following the thinking of Cattanach J. in *Gerhard Horn Investments Ltd. v. Registrar of Trade Marks* (1983), 73 C.P.R. (2d) 23.

IV.3.4 Pluralized Surnames

A surname in the pluralized form may or may not be registrable. An objection under paragraph 12(1)(a) may be raised if the surname is found in the telephone or city directories. However, the test to determine primary meaning must be applied. The examiners must determine what in their opinion would be the response of the general public in Canada to that word. If they consider that a person in Canada of ordinary intelligence and of ordinary education in English or French would respond to the word by thinking of it as the surname of a living individual, then an objection under paragraph 12(1) (a) will be raised.

IV.3.5 Surnames in the Possessive Form

A surname in the possessive form may or may not be registrable. An objection under paragraph 12(1) (a) may be raised if the surname is found in the telephone or city directories. However, the test to determine primary meaning must be applied. The examiners must determine what in their opinion would be the response of the general public in Canada to that word. If they consider that a person in Canada of ordinary intelligence and of ordinary education in English or French would respond to the word by thinking of it as the surname of a living individual, then an objection under paragraph 12(1) (a) will be raised.

IV.3.6 Portions Objectionable under Paragraphs 12(1)(a) and (b) or 12(1)(a) and (c)

A trade-mark comprised of portions, one portion being objectionable under 12(1)(a) and the other under 12(1)(b) or (c), is registrable providing a disclaimer of both portions is submitted. In these cases, the mark as a whole is not objected to since it cannot be said to be primarily merely the name or surname of a living individual or of an individual who has died within the preceding 30 years, nor can the mark as a whole be said to be clearly descriptive or the name of the wares. See *Molson Companies Ltd. v. John Labatt Ltd.* (1981), 58 C.P.R. (2d) 157.

IV.3.7 Reference Sources — Paragraph 12(1)(a)

Sources of information most commonly referred to regarding name and surname significance include city and area telephone directories, encyclopedias and language dictionaries. It is not possible or reasonable for examiners to conduct exhaustive directory searches. Reference is always made, but not restricted to, telephone directories of larger centres in Canada such as Vancouver, Winnipeg, Toronto, Ottawa, Montreal, Quebec City and Halifax. Examiners may also consult telephone directories of major international cities such as London, England and New York. The departmental library and the Ottawa Public Library are other sources of information. In addition, foreign embassies may be referred to for confirmation of surname significance in countries other than Canada.

The examiners will also consult dictionaries and other relevant source documents to determine if the word or words have other meanings.

In *Standard Oil Co. v. Registrar of Trade Marks* (1968), 55 C.P.R. 49 at p. 57, the learned President of the Exchequer Court considered an objection by the applicant that the appearance of FIOR in directories of certain Canadian cities as a surname is not a proper evidentiary basis for concluding that it is the surname of an individual. President Jockett did not accept this proposition and stated:

"In my view, it was open to the respondent to conclude from the fact that FIOR has appeared in directories in Canada as a surname, that the balance of

probability is that FIOR is the surname of one or more individuals in Canada who are living. If the appellant had had any doubt as to the correctness of this conclusion, he had ample opportunity to cause the facts to be checked and to place evidence with regard thereto before the respondent or the Court. He has not done that and I can only conclude, as the respondent did, that the balance of probability is that there are individuals in Canada whose surname is Fior."

IV.3.8 Merely a Name or a Surname

When confronted with a word which might be prohibited under paragraph 12(1)(a), the examiners must first review the research results to determine whether the word is merely (i.e., only, nothing more than) a surname. If the word is only a name or surname and is not found to have any other significance, an objection to registrability under paragraph 12(1)(a) should be made.

If the review of the research results shows that the word is a name or surname, but that it also has another significance, a second inquiry must be commenced.

The other significance may be that the word is a created word (FIOR); that the word has another meaning (COLES) and (ELDER'S); that the word possesses meaning as the name of a community, city, town, capital, river, stream or castle; that it is a given name; or that it has trade-mark significance.

As enunciated in the FIOR case, *Standard Oil Co. v. Registrar of Trade Marks* (1968), 55 C.P.R. 49 at p. 58:

"As far as the appellant was concerned, therefore, FIOR was a word invented by it for use as its trade mark in this connection. It follows, therefore, that FIOR is not 'merely' the surname of a living person because it also has existence as a word invented by the appellant or persons working for it for trade mark purposes."

And further at pp. 58-59:

"Certainly, from the point of view of the people called 'Fior' and their immediate circle of friends and acquaintances, the answer is that FIOR is principally if not exclusively a surname, and, from the point of view of the

trade mark advisers of the appellant, the answer is that it is principally, if not merely, an invented word. The test, for the purposes of s. 12(1)(a) is not, in my view, the reaction of either of these classes of persons. The test must be what, in the opinion of the respondent or the Court, as the case may be, would be the response of the general public of Canada to the word. My conclusion is that a person in Canada of ordinary intelligence and of ordinary education in English or French would be just as likely, (if the two characters (surname and invented word) are of equal importance, it cannot be said that it is 'primarily merely' a surname), if not more likely, to respond to the word by thinking of it as a brand or mark of some business as to respond to it by thinking of some family of people (that is, by thinking of it as being the surname of one or more individuals). Indeed, I doubt very much whether such a person would respond to the word by thinking of there being an individual having it as a surname at all."

IV.3.9 Meaning of "Primarily"

When the research results indicate that the word has name or surname significance as well as another significance, the examiners must decide what is the primary (chief, principal, first importance) meaning of the word. The primary meaning of the word is determined pursuant to a test to be applied by the examiners.

IV.3.10 Test to Determine Primary Meaning

In order to determine the primary meaning of a word, examiners must determine what in their opinion would be the response of the general public of Canada to that word. The primary meaning is not to be determined subjectively, that is, examiners must not base their findings on what they consider to be the primary meaning of the word. Instead, they must ask themselves what would be the response of a person in Canada of ordinary intelligence and of ordinary education in English or French as to the primary meaning of the word.

The examiners must then balance the name or surname significance of the word and the other significance of the word found in dictionaries or provided by applicants in their responses. If they believe the name or surname significance overwhelms the other significance in the mind of the hypothetical Canadian, an objection pursuant to paragraph 12(1)(a) must be made to the application. If the examiners believe that the other significance of the word predominates in the mind of the hypothetical Canadian, no objection should be made.

In the event that the surname significance and the other significance of the word are equal when the test is applied, or, if the examiners doubt that the surname significance is more substantial to the hypothetical Canadian than the other significance of the word, then no objection should be made pursuant to paragraph 12(1)(a).

In *Elder's Beverages (1975) Ltd. v. Registrar of Trade Marks* (1979), 44 C.P.R. (2d) 59, Mr. Justice Cattanach allowed registration of the mark ELDER'S, stating at p.63:

"In my opinion the two characters of the word `elder', one as a surname and the other as a dictionary word, are each of substantial significance and therefore it cannot be said that the word is `primarily' a surname."

In the FIOR case, *Standard Oil Co. v. Registrar of Trade Marks* (1968), 55 C.P.R. 49, Jackett J. found on the evidence that FIOR is "a word that is...the surname of an individual who is living." It was also established by evidence that FIOR was created by the applicant by combining the first letters of each of the words "fluid iron ore reduction." FIOR was an invented word and not "merely" a surname. The learned Judge, after reviewing the evidence and the law, stated at p. 59:

"My conclusion is that a person in Canada of ordinary intelligence and of ordinary education in English or French would be just as likely, (if the two characters (surname and invented word) are of equal importance, it cannot be said that it is `primarily merely' a surname), if not more likely, to respond to the word by thinking of it as a brand or mark of some business as to respond to it by thinking of some family of people (that is, by thinking of it as being the surname of one or more individuals). Indeed, I doubt very much whether such a person would respond to the word by thinking of there being an individual having it as a surname at all."

In *Registrar of Trade Marks v. Coles Book Stores Ltd.* (1972), 4 C.P.R. (2d) 1, Mr. Justice Judson of the Supreme Court of Canada approved the test of the hypothetical person in the FIOR case. In the COLES case, Judson J. found that COLES is a surname well-known to the general public in Canada. He also found that the dictionary meaning of the word "cole" and its plural form "coles" are largely obsolete. At p. 3, refusing registration, he stated:

"My only possible conclusion in this case is that a person in Canada of ordinary intelligence and of ordinary education in English or French would

immediately respond to the trade mark `Coles' by thinking of it as a surname and would not be likely to know that `Coles' has a dictionary meaning."

In *Galanos v. Registrar of Trade Marks* (1982), 69 C.P.R. (2d) 144, Mr. Justice Cattanach applied the test in allowing registration of the mark GALANOS and said as follows at p. 155:

"I have difficulty in appreciating that the purchasing public would respond to the word `Galanos' prominently displayed on the label of a bottle of toilet water by spontaneously thinking of it as being the surname of an individual.

In my opinion a Canadian of ordinary intelligence and education in English or French would be as likely, if not more likely, to respond to the word by thinking of it as a coined, fanciful or invented word used as a brand or trade mark of a business as by thinking of it as primarily merely the surname of an individual."

Therefore, examiners should give weight to the applicant's argument that the word or words adopted are for trade-mark purposes and should have regard to the public perception of the word or words. Once this has been done, and if it is decided that the word or words are not "merely" a name or surname, i.e., they have trade-mark significance, dictionary meaning, geographical significance, and so on, then the "primary" meaning of the word or words must be decided. Is it primarily a name or a surname, or is it primarily a trade-mark, geographical location, and so on?

In *Juneau v. Chutes Corp.* (1986), 11 C.P.R. (3d) 260 (Opp. Bd.), the mark JUNEAU was held to be primarily merely the surname of a living individual even though "Juneau" is the capital of Alaska and a county or town in the state of Wisconsin. This was because a majority of Canadians, particularly those in the province of Quebec, would immediately respond to the trade-mark JUNEAU as having a surname significance as opposed to having any of the geographic significances put forward by the applicant.

IV.3.11 Historical Characters — Paragraph 9(1)(I)

A trade-mark may have name or surname significance and, at the same time, call to mind an individual bearing the same name in the field of literature, art, music, history, politics, commerce, science or the like. If the examiners believe that the hypothetical Canadian would respond to the word as the name or surname of an individual who has died more than 30 years ago, the word is registrable. The examiners must also keep in mind how the name or surname is displayed or depicted on the mark. For example, for the hypothetical Canadian, the primary significance of the name Sir John A. MacDonald would be historical. The name MacDonald alone, however, would elicit a completely different response unless the mark as a whole clearly suggested an association with the historical character, as in a combination of some pictorial representation and the name of the person.

IV.3.12 Signatures — Paragraph 9(1)(I)

An application for registration of a trade-mark which is wholly or in part the signature of an individual must be accompanied by a letter of consent, unless it is the applicant's own signature. *See paragraph 9(2)(a) regarding the use of a signature as a trade-mark.* If the individual whose signature is used has died within the preceding 30 years, the applicant must submit acceptable authorization (e.g., from the executor of the individual's estate). A signature contravenes the provisions of paragraph 12(1)(a) and a disclaimer statement must therefore be inserted in the application form, unless the name per se has been previously registered by the applicant on the filing of evidence pursuant to subsection 12(2) or section 14 for similar wares or services.

NOTE: If it is an actual signature then it follows that it must also be the name of a living individual or of an individual who died less than 30 years ago.

EXAMPLES

Actual Signature of Robert Moore:

- 1) If Robert Moore is the applicant, a disclaimer of Robert Moore is required.
- 2) If another entity is the applicant, a disclaimer of Robert Moore is required to overcome 12(1)(a), and a consent from Robert Moore (or from an executor of his estate if he died within the preceding 30 years) is needed to overcome 12(1)(e), if research discloses the signature contravenes 9(1)(l).

In the case of a trade-mark application covering a form of signature of a purportedly made-up or fictitious character, the examiners will still require the disclaimer of the name or surname if research discloses that it is the name of a living individual or one who has died within the preceding 30 years. However, in lieu of the consent under paragraph 9(2)(a) of the Act, the examiners will require a statement in the application to the effect that the signature is the created signature of a fictitious individual. For example, an application for the signature of the fictitious character "Ronald McDonald" requires the name to be disclaimed apart from the mark and a statement that the signature is the created signature of a fictitious individual.

Where it is discovered that the "signature" of a living individual is an artistic creation and not the actual signature of that person, a statement to that effect would be required in lieu of a consent under paragraph 9(2)(a). However, a consent under 9(2)(a) would be required to overcome paragraph 9(1)(k) if there are grounds to believe that matter may falsely suggest a connection with a living individual.

EXAMPLES

- 1) Signature is fictitious or an artistic creation. A disclaimer of the name is required to overcome 12(1)(a) if it is located as the name of a living individual or one who has died within the preceding 30 years. A statement that the signature is a created or fictitious signature is also required, to show that the mark does not contravene 9(1)(l) and 12(1)(e).
- 2) Signature is the created signature of a well-known living individual. A disclaimer to overcome 12(1)(a) is required, as well

as a consent, since it would appear to falsely suggest a connection with a living individual, which would contravene 9(1)(k). Also a statement that this is an artistic creation would be required to show that the mark does not contravene 9(1)(l) and 12(1)(e).

IV.4 Paragraph 12(1)(b) — Clearly Descriptive or Deceptively Misdescriptive

IV.4.1 Definition

Trade-marks which are in part or in whole composed of words must also be examined for any clearly descriptive or deceptively misdescriptive meanings, in English or French, as applied to the character or quality, place of origin, conditions of, or persons employed in the production of the associated wares or the performance of the services. The purpose of a paragraph 12(1)(b) objection to registrability of clearly descriptive words is that no one person should be able to appropriate such a word and place legitimate competition at an undue disadvantage in relation to language that is common to all. See *General Motors Corp. v. Bellows* (1949), 10 C.P.R. 101, at pp. 112-113.

The word "clearly" is not used in the sense of "accurately", but of "easy to understand...evident, plain." See *Thorold Concrete Products Ltd. v. Registrar of Trade Marks* (1961), 37 C.P.R. 166.

The purpose of denying registration to deceptively misdescriptive marks is to prevent the public from being misled with respect to the wares or services and to prevent the person making such misrepresentations from obtaining an unfair advantage over competitors. The word "deceptive" is key. A misdescriptive word is registrable, but a deceptively misdescriptive word is not. See sections IV.4.5 and IV.4.6 of this manual on *misdescriptiveness*.

IV.4.2 Examination under Paragraph 12(1)(b)

Trade-marks which, as a matter of first impression, appear to be unregistrable because of a descriptive significance, require very thoughtful analysis. The examiners must establish the case. To do so will require research into the language meanings of words and into the characteristics and properties of the broad spectrum of wares and services available to today's consumer. When faced with a design or composite mark, the examiners must also study the impression created by the non-word portion of the mark as it stands alone and/or the impression created in conjunction with that portion of the mark which is composed of reading matter.

If a paragraph 12(1)(b) objection is made, the examiners should explain the reasons for it fully when reporting to the applicant. It is not enough to quote dictionary meanings of a word and leave it to the applicant to determine how, in the examiners' view, the mark is clearly descriptive or deceptively misdescriptive in association with the wares or services applied for. Similar care must be exercised when requesting a disclaimer in respect of a portion of a trade-mark considered objectionable under paragraph 12(1)(b).

It is important to keep in mind that the context within which a paragraph 12(1)(b) determination is made encompasses the meaning conveyed by the trade-mark and its relationship to the wares or services to which it is applied. See the KOLD ONE decision, *Provenzano v. Registrar of Trade Marks* (1977), 37 C.P.R. (2d) 189, and the Federal Court of Appeal decision (1978), 40 C.P.R. (2d) 288.

The question to be asked is: What, as a matter of first impression, does the trade-mark tell the potential dealer in, or purchaser of, the wares or services? What does the mark lead such people to believe about the quality, character, or conditions of production, etc.? Does the mark tell them what the wares or services are, or describe them or describe a property which is commonly associated with them? If so, the mark should remain at the disposal of any other parties engaged in the production and distribution of similar goods or the performance of like services. Thus, an applicant would not be allowed to monopolize the word "juicy" for use in relation to apples, and a trade-mark affixed to a carton of ice-cream which reads "frozen dessert" would be considered to be unregistrable for the same reasons.

If, on the other hand, the mark deceptively misdescribes a property of the wares or services, then the examiners must also consider raising an objection to registration under paragraph 12(1)(b). The essence of unregistrability in this case is that the dealers in, or purchasers of, the wares would be deceived by the misdescription into

purchasing wares or ordering services which differed in character or quality from those expected.

It is possible to avoid the clearly descriptive prohibition in some instances where the applicant agrees to disclaim that part of the mark which the examiners find objectionable. Thus, the trade-mark PUB SQUASH, when used in association with soft drinks and soft drink syrup or concentrates, would be eligible for registration on the condition that the right to the exclusive use of the word "squash" be disclaimed apart from the trade-mark.

Examiners may be guided by the comments of the judge in *Lake Ontario Cement Ltd. v. Registrar of Trade Marks* (1976), 31 C.P.R. (2d) 103, concerning the use of disclaimers in respect of deceptively misdescriptive matter of composite marks. Although the decision taken did not hinge on this issue, Dubé J., in reference to marks where the deceptively misdescriptive portion of the mark is a dominant feature of the composite mark, stated at p. 109:

"In my view a disclaimer ought not to be used in relation to deceptively misdescriptive matter so as to render the mark as a whole registrable when the unregistrable matter is the dominant feature of the composite mark. After all, the disclaimer does not appear on the mark and the deception stands visually overwhelming."

See section IV.9 of this manual on disclaimers. See also T.G. Bright & Co., Ltd. v Institut National des Appellations d'Origine des Vins et Eaux-de-vie (1986), 9 C.P.R. (3d) 239.

IV.4.3 Test

In deciding whether a mark is clearly descriptive or deceptively misdescriptive in the English or French languages, the word must be considered as to the immediate impression created. The word is not to be assessed according to its etymological meaning. In *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978), 40 C.P.R. (2d) 25, Collier J. stated at p. 27:

"The decision that a mark is clearly descriptive is one of immediate impression; it must not be based on research into the meaning of words."

It follows that the examiners must not rely on any obsolete, archaic or unusual significance of a word or words in relation to the wares or services. The meaning of the word in common parlance, not the etymological meaning, is the determining factor in finding if a word is clearly descriptive or deceptively misdescriptive of the wares or services. Dictionaries, among other means, may be used for this purpose. See *John Labatt Ltd. v. Carling Breweries Ltd.* (1974), 18 C.P.R. (2d) 15.

However, the fact that a particular combination of words does not appear in any dictionary does not prevent a trade-mark from being found to be clearly descriptive or deceptively misdescriptive. If each portion of a mark has a well-known meaning in English or French, it may be that the resultant combination would be contrary to paragraph 12(1)(b) of the Act.

In *Oshawa Group Ltd. v. Registrar of Trade Marks* (1980), 46 C.P.R. (2d) 145, Cattanach J. stated at pp. 148-149:

"With respect to trade marks such as HYPER-VALUE and HYPER-FORMIDABLE which are coined in the sense that the well-known French and English prefix 'hyper' is combined with the well-known English word 'value' and the word 'formidable' which is a well-known word in both the French and English languages, the resultant combinations do not appear in any dictionary but because those combinations do not appear it cannot be said that they are devoid of meaning. The components of the coined marks do have dictionary status and for that reason I do not think that resort might not be had to dictionaries for instruction as to the meaning of the components and, if possible, to ascertain therefrom the meanings of the resultant words. This is particularly so when the initial word is a prefix, as 'hyper' is, used with prepositional force or as an adverb or adjective."

And further at p. 52:

"In ascertaining the impression that the trade marks HYPER-FORMIDABLE and HYPER-VALUE convey to determine if such marks are clearly descriptive it is the impression of the probable user of the appellant's services which is to be ascertained."

Further, in *Mitel Corporation v. Registrar of Trade Marks* (1984), 79 C.P.R. (2d) 202, Dubé J. stated the following when determining if the trade-mark SUPERSET, to be used in association with subscribers' telephone instruments, was contrary to paragraph 12(1)(b):

"Undoubtedly, the decision whether a trade mark is clearly descriptive is one of first impression....The Court must place itself in the shoes of the ordinary consumer who sees the trade mark advertised in store windows, or reads it in newspaper advertisements, or hears it over the radio or the television. The use of a dictionary may be useful, but a coined mark which has not acquired dictionary status still remains within the ambit of para. 12(1)(b)...In such instances the Court may look at the component parts of the trade mark in order to assess what the mark as a whole looks, or sounds like. Words or prefixes having a laudatory connotation are *prima facie* descriptive terms, although in certain associations such epithets may have lost their descriptive impact." [At p. 206.]

At p. 208, Dubé J. also set out the next important principle: "...the mark is not to be considered in isolation; it must be perceived in connection with the wares to which it is associated."

The second element of the test is for the examiners to decide what first impression the word would create upon the ordinary everyday dealer in or purchaser or user of the wares or services. In *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978), 40 C.P.R. (2d) 25, Collier J. applied the test as follows in considering the registrability of the mark SUPERWASH:

"The Court, in considering whether the impugned expression is clearly descriptive, must endeavour to put itself in the position of the everyday user of the wares. It seems to me the ordinary user or dealer in sweaters and men's hosiery, fabricated from wool, would know that wool has, traditionally, been susceptible to shrinkage when the garment is washed. In my opinion, that notional person, as a matter of immediate impression, would conclude that 'superwash,' applied to particular woolen goods, described a garment that washed very, or extremely well, with little or no resultant shrinkage." [At p. 27.]

In the event that the examiners are in doubt as to whether a dealer or consumer would, as a matter of first impression, feel that the trade-mark was clearly descriptive of the

character or quality of the wares or services, then an objection under paragraph 12(1)(b) should not be made.

A different approach was taken with respect to new words or new variations in meanings of older words found in the French or English languages in *Home Juice Co. v. Orange Maison Ltée.* (1970), 1 C.P.R. (2d) 14. Although the word or variation on the word may have developed in some other French or English country and be in use in that country, and although the word may not be known to the ordinary dealer in or user of the wares in Canada, that word must be considered as a part of the common parlance for the purpose of applying paragraph 12(1)(b). As Mr. Justice Pigeon stated in the Home Juice case at p. 16:

"Respondent has contended that the current meaning in France is not to be considered, that regard must be had only to the meaning current in Canada and that, in the absence of any evidence, whether by dictionaries or otherwise, that the meaning in question was current in Canada at the date of registration, no account should be taken of a recent meaning found in France only. This contention would have serious consequences if it was accepted. One result would be that a shrewd trader could monopolize a new French expression by registering it as a trade mark as soon as it started being used in France or in another French-speaking country and before it could be shown to have begun being used in Canada.

In my opinion, the wording of s. 12 does not authorize such a distinction. It refers to a description 'in the English or French languages'. Each of these two languages is international. When they are spoken of in common parlance they are considered in their entirety and not as including only the vocabulary in current use in this country, a vocabulary that is extremely difficult to define especially in these days when communication media are no longer confined within national boundaries."

In *Clarkson Gordon v. Registrar of Trade Marks* (1985), 5 C.P.R. (3d) 252, the marks AUDITCOMPUTER and THE AUDITCOMPUTER were found not to be clearly descriptive since the word AUDITCOMPUTER was an awkward and cumbersome combination of two words.

In *Pizza Pizza Ltd. v. Registrar of Trade Marks* (1982), 67 C.P.R. (2d) 202, the mark PIZZA PIZZA was found not to be clearly descriptive since the expression PIZZA

PIZZA was not a linguistic construction that is a part of normally acceptable spoken or written English.

Therefore, when considering descriptiveness, due regard must be given as to whether the mark is grammatically correct.

IV.4.4 Depicted, Written or Sounded

When applying the test of registrability under paragraph 12(1)(b), the examiners must be prepared to consider the objection to descriptiveness or deceptive misdescriptiveness as it applies to any type of mark, whether a word, design or composite mark, since a depiction or a design may be objectionable, as well as a word when seen or sounded.

In *Frost Steel and Wire Co. Ltd. v. Lundy* (1925), 57 O.L.R. 494, the Court was considering the validity of a trade-mark which consisted of the picture of a knot used in a wire fence. In holding the registration invalid, Rose J. stated at p. 498:

"There are, however, very few reported cases in which the Courts have had to consider the question whether a design mark that is merely descriptive is capable of registration. But it is difficult to see why there should be any difference between the rules to be applied in the case of a design and those applied in the case of a word...."

The hearing officer in *Ralston Purina Co. v. Effem Foods Ltd.* (1990), 31 C.P.R. (3d) 52, (a cat's head design for pet food, namely food for cats) stated at p. 55:

"The test to be applied respecting s. 12(1)(b) of the Act is the immediate impression the mark used in association with the wares creates on an everyday user of those wares. In the present case, I consider that the use of the applicant's mark on a can or package of cat food would clearly indicate that the character of the wares are such that they are intended for cats."

The mark THOR-O-MIX, for use in association with ready-made concrete, was refused by the Registrar as being clearly descriptive of the character of the wares. In *Thorold Concrete Products Ltd. v. Registrar of Trade Marks* (1961), 37 C.P.R. 166, Kearney, J. stated at p. 172:

"When I first sounded the instant trade name, it plainly had the same significance for me as if it were written `thorough-mix', and I think that in like circumstances the general public would be similarly impressed."

The mark was refused as being clearly descriptive of the character of the wares.

IV.4.5 Misdescriptiveness

While paragraph 12(1)(b) prohibits the registration of marks which are deceptively misdescriptive, there is no bar to registration of misdescriptive marks if they are not likely to lead the average purchaser to believe erroneously that the products or services with which they are associated possess some characteristic or quality. Interestingly enough, H.G. Fox argues for the registrability of clearly misdescriptive words, saying:

"Many words may be clearly misdescriptive of the wares or services in association with which they are used but are by no means deceptively misdescriptive. In a sense a clearly misdescriptive word may be quite distinctive. Its very misdescriptiveness attracts the senses and thus makes for distinctiveness. In such a case a word of that type ought to constitute a good trade mark and ought to be registrable. If, on the other hand, a mark is deceptively misdescriptive, the reverse is the case. Thus, the mark `North Pole' might well be descriptive of the character or quality of the wares if used in association with ice cream or frozen foods, just as the word `Frigidaire' has been held to be descriptive of refrigerators and refrigerating systems. But while the use of the words `North Pole' would be misdescriptive of bananas or oranges it would not be deceptively misdescriptive. It would be the use of a geographical name dislocated or disconnected from the origin of the goods." (H.G. Fox, *The Canadian Law of Trade Marks and Unfair Competition*, Third Edition, pp. 93-94.)

IV.4.6 Deceptively Misdescriptive

The principle which underlies a paragraph 12(1)(b) objection as it concerns deceptive misdescriptiveness is that a mark which is the subject matter of an application must not mislead the public by ascribing a quality to wares that they do not possess. For example, in *Deputy Attorney-General of Canada v. Biggs Laboratories (Canada) Limited* (1964), 42 C.P.R. 129, the trade-mark SHAMMI, as applied for in relation to a transparent polyethylene glove, was denied registration. The glove did not contain one scintilla of chamois or shammy. In finding the mark SHAMMI deceptively misdescriptive of the character or quality of the wares, Dumoulin J. stated at p. 130:

"An article advertised for sale as containing certain components which, in truth, it does not have, surely must be considered as deceptively misleading to the purchasing public."

However, in *Lake Ontario Cement Ltd. v. Registrar of Trade Marks* (1976), 31 C.P.R. (2d) 103, Dubé J. held that the word PREMIER was not deceptively misdescriptive as applied to the wares "sand and gravel and ready-mixed concrete" and "concrete blocks and bricks ordinarily used in the construction of buildings and homes." Dubé J. found that the word PREMIER denotes a degree of quality that might be attained by the wares and, insofar as the wares did not meet that quality, the word PREMIER would be misdescriptive of the quality of the wares. However, ordinary dealers in or purchasers of the wares would perceive PREMIER, as applied for, as an indirect reference to the quality of the wares and would not be led to believe that the wares being purchased were of the best quality. The word PREMIER was held not to be deceptively misdescriptive, but it was found to be clearly descriptive and therefore had to be disclaimed. *See reference to this case in section IV.4.2 of this chapter.*

IV.4.7 In the English or French Languages

A word in a language other than English or French which is clearly descriptive of the character or quality of the wares or services is not prohibited by paragraph 12(1)(b), the prohibition being limited to words in the English or French languages. In *Gula v. Manischewitz Co.* (1947), 8 C.P.R. 103, it was held that even though the word "tam" meant "taste" or "tasty" to a Hebrew- or Yiddish-speaking person, the mark TAM TAM was a good subject of a trade-mark being neither in the English nor the French languages.

Paragraph 12(1)(b) also does not preclude the registration of a trade-mark comprised of a combination of French and English words individually descriptive of the wares. In *Coca-Cola Co. v. Cliffstar Corp.* (1993), 49 C.P.R. (3d) 358, the applicant applied to register the trade-mark LE JUICE for juices. The word "juice" was disclaimed. The opponents alleged the mark was the name of the wares and unregistrable pursuant to paragraph 12(1)(c) of the *Trade-marks Act* and that the mark was clearly descriptive or deceptively misdescriptive of the character or quality of the wares, contrary to paragraph 12(1)(b). The opposition was rejected and the following was stated at p. 360:

"The opponents' own evidence establishes that the word 'le' is a French language definite article and 'juice' is an English language word referring to fluid naturally contained in plant or animal tissue. Thus, the trade mark as a whole cannot be said to be the name of anything in the English language nor can it be said to be the name of anything in the French language."

And further at p. 361:

"The applicant's proposed mark is comprised of the French word 'le' and the ordinary English word 'juice'. The former word is a definite article in the French language. The latter word is clearly descriptive in the English language of the character of the wares 'fruit juices' and the applicant has conceded this by including a disclaimer in its application. The combination of the two words, however, does not offend the provisions of s. 12(1)(b) of the Act which precludes registration of a trade mark that is

(b) ...whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language...

Section 12(1)(b) of the Act does not preclude the registration of a trade mark comprised of a combination of French and English words individually descriptive of the wares."

IV.4.8 Character or Quality

A trade-mark is not registrable if it is clearly descriptive or deceptively misdescriptive in the English or French languages of the character or quality of the wares or services in association with which it is used or proposed to be used. As to what constitutes the character of the wares or services, the examiners may be guided by the words of Cattnach J. in *Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 at p. 34, where he states that "...the word 'character' as used in s. 12(1)(b) must mean a feature, trait or characteristic of the product."

Words descriptive of the function or result of using wares have also been refused. The marks STA-ZON, a distortion of "stays on," and SHUR-ON, a distortion of "sure on," as applied to eyeglass frames, were held not to be proper trade-marks. In *Kirstein Sons & Co. v. Cohen Bros., Limited* (1907), 39 S.C.R. 286 at p. 288, Mr. Justice Davies stated: "He could not pre-empt nor claim the exclusive use of the idea descriptive of some merit in the article."

In the ULTRA FRESH decision, *Thomson Research Associates Ltd. v. Registrar of Trade Marks* (1982), 67 C.P.R. (2d) 205, the function of the wares was held to be clearly descriptive of their character. Mahoney J. stated at p. 208:

"I agree with the respondent that 'ultra fresh' is clearly descriptive. It is not descriptive of the bacteriostats and fungistats themselves but it does clearly describe, or deceptively misdescribe, the condition of the products, e.g., the underwear, after treatment with those bacteriostats and fungistats."

And further:

"'Ultra fresh' does not merely suggest a characteristic of the bacteriostats and fungistats at all; it clearly suggests the principal, if not only, effect of their application to other wares, in other words, their function."

Words which are common to a particular trade, such as "Fashions" or "Pack" (Pak), and which express a special or distinguishing attribute of wares or services, are seen as clearly descriptive of the character of the wares and are not registrable. However, a composite mark containing these clearly descriptive words may be registrable if a disclaimer clause is inserted in the application, and providing the composite mark, when considered as a whole, contains registrable subject matter.

Concerning the meaning of the word "quality" as it applies in paragraph 12(1)(b), the examiners will find objectionable those words which describe a degree of excellence reputed to be achieved by the wares. (For example, SUPERWASH as applied to the yarn or fabric in sweaters or hosiery, or NO. 1 in association with brewed alcoholic beverages.)

Marks such as SUPERIOR, EXCELLENT, QUALITY, BEST, ULTRA, SUPER, SUPREME or PERFECT, which laud the merits or superiority of the wares, are clearly descriptive of their quality and are not registrable except upon receipt of evidence of acquired distinctiveness or secondary meaning pursuant to subsection 12(2) or proof that the mark applied for is not without distinctive character in Canada pursuant to section 14 of the Act. *See sections IV.10 and II.7.8 of this manual.* However, such words may be made the subject matter of a disclaimer, providing the word is part of a composite mark, and "...there remained a distinctive feature, or a pictorial representation, which would make the mark as a whole distinctive from other marks...." *Lake Ontario Cement Ltd. v. Registrar of Trade Marks* (1976), 31 C.P.R. (2d) 103 at p. 109

The SUPERSET decision, *Mitel Corporation v. Registrar of Trade Marks* (1984), 79 C.P.R.(2d) 202, reflects the same line of thinking on laudatory words, since the mark involved was found to be clearly descriptive.

IV.4.8.1 Embellishment of Descriptive Words

Some marks are applied for in fanciful lettering. These marks are not registrable since they do not have any design features exclusive of the words which form the mark. In *John Labatt Ltd. v. Registrar of Trade Marks* (1984), 79 C.P.R.(2d) 110, Cattanach J. had the following to say on this matter when considering the registrability of SUPER BOCK:

"In this case, as in the CANADIAN JEWISH REVIEW case, the words `super bock' form the material part of the trade mark and in spite of the added embellishments to some of the letters of the word `bock' and the sequence of the letters of the word `super' positioned above the word `bock' where the meaning of the combination dictates it must be positioned on a gentle curve still spell out 'super bock'.

As Cameron J. has said, `without the words there would be no special features or design'.

Since the two words `super bock' form a most material part of the trade mark, despite the disclaimer of those two words, and there is no design feature exclusive of the letters and their positioning it follows from the reasoning of Cameron J. which I adopt and apply, the trade mark as a whole cannot be other than clearly descriptive of the character or quality of the wares with which they are associated and so not registrable." [At p. 120.]

NOTE: This would also apply where the mark is unregistrable pursuant to paragraph 12(1)(a) or (c).

IV.4.9 Suggestive Trade-marks

A trade-mark that does not clearly describe the character or quality of the wares is sometimes referred to as a suggestive trade-mark. The trade-mark WATERWOOL was held registrable in relation to a list of wearing apparel for men and ladies in *Deputy Attorney-General of Canada v. Jantzen of Canada Limited* (1964), 46 C.P.R. 66 at p. 72. President Jackett reviewed the evidence and concluded as follows:

"My first impression, and my present impression, is that WATERWOOL may mystify the person who is confronted with it in association with a garment; it may even vaguely suggest some association with wool; but it does not describe the garment as being made of the wool of any animal."

The GRO-PUP case is often cited with respect to a mark found to be suggestive rather than descriptive. This case is reported as *Kellogg Co. of Canada Ltd. v. Registrar of Trade Marks* [1940] Ex. C.R. 163. After reviewing the evidence, Angers J. stated at p. 170:

"...I do not think that the word 'Gro-Pup' is descriptive of the article to which it is to be applied, namely, dog food; it is at the utmost suggestive of the result which it is liable to produce."

However, in *Quaker Oats Co. of Canada Ltd. v. Ralston Purina Canada Inc.* (1987), 18 C.P.R.(3d) 114, the trade-mark HELPING DOGS LIVE LONGER LIVES was refused for being clearly descriptive and not registrable. The Chairman of the Opposition Board, G.W. Partington, had the following to say in finding the mark clearly descriptive of the result.

"...I am of the view that the average purchaser of dog food would immediately conclude that the trade mark HELPING DOGS LIVE LONGER LIVES as applied to such wares would clearly describe to the purchaser that the use of the applicant's wares would result in their pet living a longer and healthier life. As such, the present situation is clearly distinguishable from that considered by Mr. Justice Angers in *Kellogg Co. of Canada Ltd. v. Registrar of Trade Marks*, [1939] 3 D.L.R. 65, [1940] Ex. C.R. 163, where the learned trial judge concluded that the trade mark GRO-PUP as applied to dog food was 'at the utmost suggestive of the result which it is liable to produce'. Further, I do not consider that the GRO-PUP decision can any longer be considered as authority for the proposition that the result that an article of commerce is liable to produce is not such as to render a description of that result unregistrable as a trade mark for that article: see *Sharp Kabushiki Kaisha v. Dahlberg Electronics, Inc.* (1983), 80 C.P.R. (2d) 47 at pp. 51-5."

IV.4.10 Conditions of Production — Clearly Descriptive or Deceptively Misdescriptive in the English or French Languages

If the mark applied for is clearly descriptive or deceptively misdescriptive of the conditions of production, an action objecting to registration should be issued to the

applicant. In *Staffordshire Potteries Ltd. v. Registrar of Trade Marks* (1976), 26 C.P.R. (2d) 134, the Court refused the application for registration of the mark KILNCRAFT on the grounds that the first impression of a person seeing the mark would be that the wares (tableware) were produced by a kiln process. It followed that if the wares were not produced in this way, the mark would be deceptively misdescriptive.

IV.4.11 Persons Employed in the Production of — Clearly Descriptive or Deceptively Misdescriptive in the English or French Languages

A word clearly descriptive or deceptively misdescriptive of the persons employed in the production of the wares or performance of the services is not registrable. The word "potter" would not be registrable for pottery, nor would the word "baker" be registrable for bread.

IV.4.12 Place of Origin — Clearly Descriptive or Deceptively Misdescriptive Of

A word which is found in an atlas or gazetteer as the name of a place may or may not be registrable. The issue is whether the word is clearly descriptive or deceptively misdescriptive in the English or French languages of the place of origin of the wares or services.

The examiners must determine if, as a matter of first impression, a dealer in or purchaser of the wares or a user of the services would perceive the word as the place of origin of the wares or services.

In *Atlantic Promotions Inc. v. Registrar of Trade Marks* (1984), 2 C.P.R. (3d) 183, the Court upheld the Registrar's decision that MILAN SHOWERGEL as a proposed trade-mark for lathering soaps, detergent rinses and like showering material was deceptively misdescriptive of the place of origin of the wares.

Similarly, in *T.G. Bright & Co., Ltd. v. Registrar of Trade Marks* (1985), 4 C.P.R. (3d) 64, the Court upheld the Registrar's refusal of the application for the trade-mark

CASABLANCA as a proposed mark for wines. The mark was deemed deceptively misdescriptive of the place of origin of the wares.

See also the decision in respect of the mark BRIGHTS FRENCH HOUSE (1986), 9 C.P.R.(3d) 239.

In *Dower Bros. Ltd. v. Registrar of Trade Marks* [1940] Ex. C.R. 73, the words FRENCH ROOM, applied for in association with certain types of shoes, were held as being descriptive or misdescriptive of their place of origin and therefore unregistrable. It is commonly accepted that France was then, and is now, noted for its fashions and accessories.

In examining the application, the examiners will find the mark to be clearly descriptive of the place of origin if the mark applied for is the geographical name of:

- 1) the place from which the associated wares or services originate (applicant's place of business);
- 2) an area, region or country which has an established reputation as a source of production of the wares or services with which it is associated; or
- 3) a place widely recognized as a manufacturing, trading or industrial centre and a likely source of a wide variety of products.

With respect to Nos. 2 & 3, if the wares do not emanate from that geographical area, the mark will be found to be deceptively misdescriptive of the place of origin. The examiners must keep in mind that a design mark also may be clearly descriptive or deceptively misdescriptive of the place of origin. An application for a shamrock for linen, for example, may be either clearly descriptive or deceptively misdescriptive of the place of origin of the wares, depending on whether or not the linen came from Ireland.

Certain cities, states, areas and countries have, as a result of natural resources combined with expertise, developed world-wide reputations as producers or manufacturers of certain products. Britain and areas therein are famous for bone china and finished steel. Spain is noted for certain types of wines; France and

Germany for other types. Switzerland is noted for watches, chocolate and cheese; California for wines.

If the examiners believe that a dealer in or purchaser of the wares or services would, upon seeing the design or word associated with the wares, conclude that the wares or services emanated from the place named, the mark should be objected to pursuant to paragraph 12(1)(b). If the place named is not in fact the place of origin of the wares or services, then the mark is deceptively misdescriptive of the place of origin and should be objected to on this basis.

Some geographical names, however, are acceptable in that they are not regarded as the place of origin of certain wares or services. Hollywood, the Strand, the Riviera, Fifth Avenue and Pall Mall are all place names which, one might argue, a person primarily associates with a mood, an atmosphere or a sense of well being. Nevertheless, a prohibition may be attached to their use, depending on the nature of the associated wares or services.

IV.4.13 Certification Mark — Place of Origin

A certification mark which is descriptive of the place of origin of wares or services is registrable if the applicant is the administrative authority of a country, state, province or municipality which includes or forms part of the area indicated by the mark, or is a commercial association having an office or representative in that area. *See also sections II.7.5.3 and III.7.3 of this manual.*

IV.5 Reference Sources

To fully satisfy themselves on the question of descriptiveness or misdescriptiveness, examiners must be prepared to make liberal use of the reference sources available to them. These sources can also be used to help settle various questions which arise concerning a mark's registrability. They include various trade-mark text books, *The Canadian Patent Reporter*, *The Supreme Court Reports*, and *The Federal Court Reports*, all of which are useful as "precedent" sources. In addition, a fairly extensive collection of language and trade-term reference works is listed below:

Trade Names Dictionary

International Classification of Goods and Services for the Purposes of the Registration of Marks

Canadian Intellectual Property Review

Plant Varieties Denominations

Canada Phone

Various Telephone Directories

Vancouver City Directory

Halifax City Directory

Toronto City Directory

Ottawa City Directory

Grolier Encyclopedia

International Encyclopedia Information Finder

Nouvelle encyclopédie Larousse

Encyclopedia International

What's What: A Visual Glossary of the Physical World

Random House Webster's

Heritage Dictionary

Oxford Dictionary

Oxford Dictionary of the English Language

Webster's Third New International Dictionary

American Slang

Le Robert

Le Petit Robert II

Le Robert Dictionnaire Québécois d'Aujourd'hui

Dictionnaire de la langue Québécoise

Dictionnaire général de la langue française au Canada

Harrap's Shorter French and English Dictionary

Harrap's New Standard French and English Dictionary

Dictionnaire Oxford français-anglais, anglais-français

Cassell's Italian-English Dictionary, Cassell's German-English Dictionary, Cassell's Spanish-English Dictionary

German-French Dictionary, Italian-French Dictionary (Garnier)

Howarth & Smith's Primer for Typography

1500 prénoms et leur signification

20,001 Names for Baby

The Condensed Chemical Dictionary (Van Nostrand Reinhold Company)

Chemical Synonyms and Trade Names (Gardner)

Hackh's Chemical Dictionary

Grant & Hackh's Chemical Dictionary

The Merck Index and Encyclopedia of Chemicals and Drugs

Common Names for Pest Control Chemicals

Pharmacopeia of the United States

Dorland's Medical Dictionary

Encyclopédie Médicale (Quillet)

Glossary of Insurance Terms

Modern Laboratory Appliances

Pratt & Whitney Gages

Schott Guide to Glass

Kimble Products Glass and Plastic Laboratory Ware

Dictionary of Plastics (Wordingham and Reboul)

The Dictionary of Paper

Dictionary of Paper (American Pulp & Paper Association)

Pulp & Paper Dictionary of Canada

Canadian Gypsum - manuel de construction en planches de gypse

Vocabulaire de tournage du bois (French-English)

Vocabulaire de ponçage du bois (French-English)

Vocabulaire des panneaux dérivés du bois (English-French)

Fairchild's Dictionary of Textiles

The Modern Textile Dictionary (Linton)

The Modern Textile and Apparel Dictionary

International Glossary of Leather Terms (International Council of Tanners)

Vocabulaire de l'habillement (English-French)

Vocabulaire du tricot chaîne (English-French)

Lexique de l'industrie de la boulangerie (English-French)

Lexique de l'industrie laitière (English-French)

Dictionnaire des fromages (Larousse)

La Cuisine: The Complete Book of French Cooking

Encyclopedia of Food & Cookery

New Cheese Diet

Cheese Varieties

German Wine Atlas and Vineyard Register

The Doubleday 1983 Wine Companion

Grober Deutscher Weinatlas

Alexis Lichine's New Encyclopedia of Wines & Spirits

Alexis Lichine encyclopédie des vins et des alcools

Grossman's Guide to Wines, Beers, and Spirits

Layman's Dictionary of Computer Terminology (Sondak)

Electronic Computer Glossary (Freedman)

Illustrated Dictionary of Microcomputers

Microsoft Press Computer Dictionary

Fritz Spiegl's Encyclopedia of Computer Science

Illustrated Dictionary of Microcomputer Terminology

Terminologie de l'informatique

Dictionnaire de l'informatique (Larousse)

Dictionnaire de l'informatique anglais-français

IEEE Standard Dictionary of Electronics and Electrical Terms

Collins Gem Flags

Inn List

Webster's New World Collegiate Dictionary

Prentice Hall's Illustrated Dictionary of Computing (second edition)

The Internet Dictionary (The essential guide to Netspeak)

Vocabulaire d'Internet

Microsoft Bookshelf

IV.6 Paragraph 12(1)(c) — Name of Wares or Services

IV.6.1 Reasons for Paragraph 12(1)(c)

The name of the wares or services in any language is not a registrable trade-mark for the obvious reason that it could not function to distinguish wares or services of one person from identical wares or services produced by other persons.

IV.6.2 Interpreting and Applying Provisions

When examiners are faced with text in a language other than English or French and the language dictionaries are not adequate, they must request a translation to satisfy themselves that the material does not contravene paragraph 12(1)(c). Translation enquiries are generally directed to the applicant, although it may be necessary to consult with the Translation Bureau of Canadian Heritage.

Should the translation indicate that the entire mark is the name of the wares or services, then a paragraph 12(1)(c) objection must be raised. If only a portion of the mark is the name of the wares or services, then that portion must be disclaimed. The disclaimer statement must indicate that the matter in question constitutes the name of the wares or services and must stipulate the language used, if other than French or English. If the offending portion is not essential to the performance of the mark, it may be removed entirely by submitting a revised application or revised drawings, providing this change is not contrary to Rule 31(b).

The combination of a registrable word and the name of the wares or services to form a compound word is acceptable. A disclaimer of the portion of the compound word which is the name of the wares or services in any language will not be required if the compound word is hyphenated.

A trade-mark which is the name of the wares or services cannot become registrable on a showing of acquired distinctiveness.

IV.6.3 Information from Government Departments — Paragraphs 12(1)(b) and (c) and 30(i)

It is important to note that the registration of a mark under the *Trade-marks Act* does not imply that its use will necessarily comply with the requirements of other federal statutes. The use of a registered trade-mark or a coined trade or brand name may, depending on what is implied or expressed, violate federal law.

Examples of provisions that could be contravened are as follows:

- a) The *Textile Labelling Act* prohibits any false or misleading representations relating to a textile fibre product, whether by label, advertising or otherwise.
- b) The *Consumer Packaging and Labelling Act* prohibits false or misleading representations on the label of prepackaged products.
- c) The *Competition Act* prohibits false or misleading representations to promote a business interest.
- d) The *Food and Drugs Act* prohibits the advertising, labelling or selling of any food in a manner that is false or misleading or likely to create an erroneous impression.
- e) The *Precious Metals Marking Act* prohibits the use of false, misleading or incorrect marks in relation to precious metal articles.

Examiners can use a variety of reference sources to determine whether the names of certain substances or compounds, etc., appear in trade-marks. They can avail themselves of the sources already mentioned as well as information provided by various government departments and agencies.

Examining trade-marks used in association with pharmaceutical preparations is sometimes difficult. The word mark may involve a combination of different syllables, only some of which refer to chemical substances or organic compounds. If the mark is not wholly descriptive, the examiners must decide on the "degree" of descriptiveness permissible, or the point at which descriptiveness becomes unacceptable. Health Canada might also alert the examiners to the addition of additives or substances which are alluded to in the trade-mark, but which do not appear in the product with which it is associated.

The Trade-marks Office cooperates with the Precious Metals Marking Section of the Consumer Products Branch of Industry Canada in attempting to reduce the chances of marks being registered which might be misconstrued by the trade as representing quality marks. Examiners must decipher abbreviations and the like and determine their relation to the wares or services in order to make a decision on descriptiveness.

The Precious Metals Marking Section has provided the following list of quality marks which, if applied for as trade-marks for precious metals and/or articles made from precious metals, would be considered contrary to paragraph 12(1)(b) of the Act:

HGE	abbrev. for	"heavy gold electroplating"
GF		"gold filled"
RGP		"rolled gold plate"
GEP		"gold electroplate"
R.P.		"rolled plate"
S.F.		"silver filled"
S.P.		"silver plated"

E.P.		"silver plated"
ST		"sterling silver"
STER		"sterling or sterling silver"
800		"below min. quality imported for silver"
835		"below min. quality imported for silver"
925	num. equiv. for	"silver or sterling silver min. quality"
333	below min. for	"8 karat import for gold"
375		"9 karat gold"
416		"10 karat gold"
4167		"10 karat gold"
583		"14 karat gold"
5833		"14 karat gold"
585		"14 karat gold"
750		"18 karat gold"
800		"19.2 karat gold imported from Portugal"

916	"22 karat gold imported"
9167	"22 karat gold imported"
9K to 24K incl.	"karat designations acceptable for gold"

ARTICLES OTHER THAN PLATED ARTICLES

Gold

"karat", "carat", "Karat", "Carat", "Kt.", "Ct.", "K", "C" or a decimal designation may be used to express the quality of gold of an article having a minimum quality of 9K or higher.

Gold articles having a quality of 10K, 14K, 18K may alternatively be marked as .416, .583, .750 respectively.

Silver

"silver", "sterling silver", "sterling", "argent", "argent sterling" or any abbreviations thereof (e.g., "ster." or "STG") are quality marks provided for any article which contains at least 925 parts pure silver in 1,000 parts by weight.

The use of ".925" for "silver" of 925 parts pure silver per 1,000 parts by weight is also provided for.

Platinum

"platinum", "plat.", or "platine" are quality marks provided for any article which contains at least 95 percent platinum or at least 95 percent an alloy of platinum and iridium or ruthenium.

Palladium

"palladium" or "pall." are quality marks provided for any article which contains 95% palladium. This quality mark may also be used for an alloy of at least 90% palladium only when accompanied with an additional 5% of any combination of the following prescribed metals, namely: platinum, iridium, ruthenium, rhodium, osmium or gold.

PLATED ARTICLES

This section does not cover the requirement for plated watch cases, spectacle frames, flatware and hollow ware which are discussed later in this section.

"gold filled"

"G.F."

or **"doublé d'or"**

"rolled gold plate"

"R.G.P."

or **"plaqué d'or laminé"**

"gold electroplate"

"gold plated"

"G.E.P."

"electro-plaqué d'or"

or **"or plaqué"**

"silver filled"

"S.F."

or **"doublé d'argent"**

"silver electroplate"
"silver plate"
"silver plated"
"electro-plaqué d'argent"
or **"plaqué d'argent"**

NOTE: The abbreviation **"S.P."** is taken to mean silver electro-plated and is an acceptable quality mark due to long-standing trade use.

"vermeil"
or **"vermil"**

PLATED POCKET WATCH CASES AND PLATED BRACELET WATCH CASES

"gold filled"
"G.F."
"doublé d'or"

"rolled gold plate"
"R.G.P."
or **"plaqué d'or laminé"**

"silver filled"
"S.F."
or **"doublé d'argent"**

"gold electroplate"
"gold plated"
"G.E.P."
"electro-plaqué d'or"
or **"or plaqué"**

"silver electroplate"
"silver plated"
"electro-plaqué d'argent"
or any abbreviation for any of the foregoing

SPECTACLE FRAMES

"gold filled"
"G.F."
or **"doublé d'or"**

"rolled plate"
"R.P."
"rolled gold plate"
"R.G.P."
"placage laminé"
or **"placage d'or laminé"**

"gilt"
"gold plated"
"G.E.P."
"or plaqué"
or **"doré"**

PLATED FLATWARE

"silverplate"

"placage d'argent"

"silverplated"

"plaqué d'argent"

"silverware"

"argenterie"

"S.P."

or **"E.P."**

"A.I."

"A.I.X."

"A.I.+"

"A.I. EXTRA"

"A.A.+"

"A.A.I.+"

"A.A.I. EXTRA"

"TRIPLE PLATE"

"TRIPLE PLACAGE"

"QUADRUPLE"

or **"XXXX"**

"gold electroplate"

"gold plated"

"G.E.P."

"electroplaqué d'or"

or **"or plaqué"**

"nickel-silver"

"nickel-argent"

or **"N.S."**

PLATED HOLLOW WARE

"gold electroplate"

"electro-plaqué d'or"

"gold plated"

"or plaqué"

or **"G.E.P."**

"silverplate"

"placage d'argent"

"silverplated"

"plaqué d'argent"

"argenterie"

"S.P." or "E.P."

"Sheffield Reproduction"

or **"reproduction of Sheffield plate"**

"nickel-silver"

"nickel-argent"

or **"N.S."**

"Britannia Metal"

"Métal Anglais"

"White Metal"

"Métal Blanc"

"W.M." or "B.M."

NOTE: When examiners request a disclaimer for terms, abbreviations and numerals for precious metals from the list provided by the Precious Metals Marking Section, they must seek confirmation that the wares contain or are made with the particular component.

If this is not the case, the mark is deceptively misdescriptive of the character of the wares since it is not appropriate to disclaim a portion which is deceptively misdescriptive. *See sections IV.4.2 and IV.4.6 of this manual.* If the whole mark is deceptively misdescriptive, then the mark must be objected to pursuant to paragraph 12(1)(b).

Where the trade-mark is used in association with an article made of a precious metal, that article must be stamped with a trade-mark and an application for registration received in the Trade-marks Office before it will be accepted for distribution in Canada. For example, a consignment of jewellery arriving in Canada would not be released from Customs until these two requirements have been satisfied. As well, the Precious Metals Marking Section keeps track of marks which are registered by the Trade-marks Office for use with articles made of precious stones and metals.

The examiners must also consider compliance with paragraph 30(i) — the requirement of "a statement that the applicant is satisfied that he is entitled to use the trade-mark in Canada in association with the wares or services described in the application" — in view of:

- a) the *Bank Act* which prohibits the use of the words "bank," "banker" or "banking" unless the applicant is authorized to so describe itself or to so describe the services under authority of the *Bank Act* or any other act of Parliament;
- b) the *Canada Agricultural Products Act* and the *Meat Inspection Act* which prohibit the use of grade names and the agricultural product legends unless the applicant is authorized to so use the aforementioned, under the authority of the *Canada Agricultural Products Act* and/or the *Meat Inspection Act*.

The operation of certain sections of the *Bank Act*, the *Canada Agricultural Products Act* and the *Meat Inspection Act*, together with paragraph 30(i) of the *Trade-marks Act*, proscribe the Registrar from accepting trade-mark applications which contain prohibited matter. Therefore an objection under paragraph 30(i) must be raised.

The following lists have been provided by Agriculture and Agri-Food Canada:

LIST OF GRADE NAMES AND AGRICULTURAL PRODUCT LEGENDS

(National Trade-marks Under the *Canada Agricultural Products Act*
and the *Meat Inspection Act*)

PROCESSED POULTRY PRODUCTS

Canada A
Canada Utility
Canada C
(see Attachment A)

PROCESSED EGG REGULATIONS

Canada & Maple Leaf Design and Establishment Number
(see Attachment B)

EGG REGULATIONS

Canada A
Canada B
Canada C
Canada Nest Run
(See Attachment C)

PROCESSED PRODUCTS REGULATIONS

Canada Fancy
Canada Choice
Canada Standard
Canada A
Canada B
Canada C
Fancy Grade
Choice Grade
Standard Grade
Grade A
Grade B
Grade C
(see Attachment D)

DAIRY PRODUCTS REGULATIONS

Canada 1
Canada 2
Canada 3
(see Attachment E)

HONEY REGULATIONS

Canada No. 1
Canada No. 2
Canada No. 3

MAPLE PRODUCTS REGULATIONS

Canada No. 1
Canada No. 2
Canada No. 3

FRESH FRUIT AND VEGETABLE REGULATIONS

Canada Extra Fancy
Canada Fancy
Canada Commercial
Canada Commercial Cookers
Canada Hailed
Canada No. 1 (Peelers)
Canada No. 2 (Peelers)
Canada No. 1
Canada Domestic
Canada Domestic Hailed
Canada Orchard Run
Canada No. 2
Canada No. 1 - Cut Crowns
Canada No. 1 Pickling
Canada No. 1 Large
Canada No. 1 Small
Canada No. 1 Picklers
Canada No. 2 Picklers
Canada No. 1 Slender
Canada No. 1 Heart
Canada No. 1 Extra Large

Canada Produce Legend - See Attachment F

**LIVESTOCK & POULTRY CARCASS GRADING REGULATIONS APPEARING IN
MAPLE LEAF**

Beef Grades

- Canada A
- Canada AA
- Canada AAA
- Canada B1
- Canada B2
- Canada B3
- Canada B4
- Canada D1
- Canada D2
- Canada D3
- Canada D4
- Canada E

Beef Grade Stamp



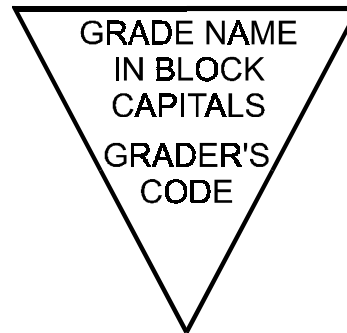
Beef Yield Stamp



Veal Grades

- Canada A1
- Canada A2
- Canada A3
- Canada A4
- Canada B1
- Canada B2
- Canada B3
- Canada B4
- Canada C1
- Canada C2

Veal Grade Stamp



Hog Grades (Yield Class — No. 1-7)

- Canada Emaciated
- Canada Ridgling
- Canada Sow 1
- Canada Sow 2
- Canada Sow 3
- Canada Sow 4
- Canada Sow 5
- Canada Sow 6
- Canada Sow 7
- Canada Stag
- Canada Boar

Bison Grades

Canada A1
Canada A2
Canada A3
Canada B1
Canada B2
Canada C1
Canada C2
Canada D1
Canada D2

Bison Grade Stamp

GRADE NAME IN BLOCK CAPITALS
GRADER'S CODE

MEAT INSPECTION REGULATIONS

Meat Inspection Legend - (See Attachment G) Only the meat inspection legend is declared as a national trade-mark under the *Meat Inspection Act*.

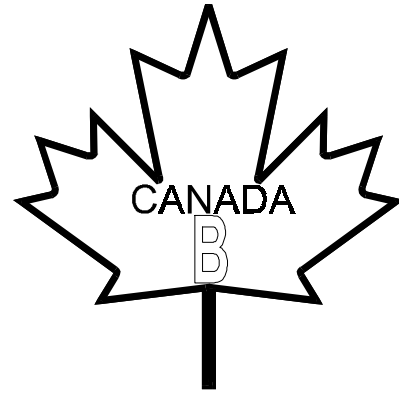
Poultry Stamps



Inspection Legend



Stamps



**CANADA
C**

CANADA NEST RUN / CANADA OEUFS TOUT VENANT

REJECTS / REJETÉS

Stamps

CANADA FANCY

CANADA CHOICE

CANADA STANDARD

CANADA A

CANADA B

CANADA C

FANCY GRADE

OR

GRADE A

CHOICE GRADE

OR

GRADE B

STANDARD GRADE

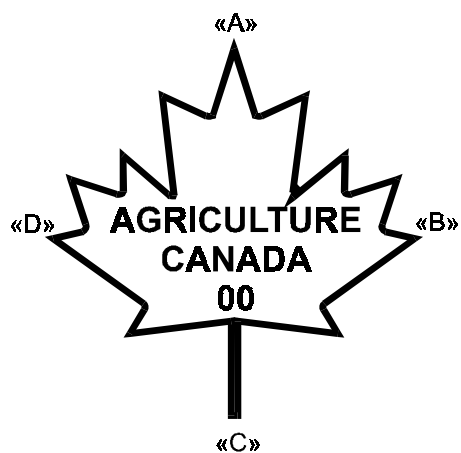
OR

GRADE C

Stamps



Canada Produce Legend



Meat Inspection Legend



Examiners must also be aware of generic names for different varieties of seeds. These may be found in the TMA indexes. Any trade-mark which consists of a seed name applied for use in association with seeds would be contrary to paragraph 12(1)(b).

IV.7 Paragraph 12(1)(d) — Confusion

See Chapter III, "The Search/Confusion," for a discussion of the issue of confusion in light of the provisions of paragraph 12(1)(d) and section 16 of the Act.

IV.8 Paragraph 12(1)(e) — Prohibited Marks

Marks which may not be used or registered as trade-marks are set down in subsection 9(1) and section 10 of the Act. The examiners must remember that the prohibition against registration applies both to exact reproductions of the marks, crests, emblems, etc. and to marks so nearly resembling them as to be likely to be mistaken for them.

The following commentaries deal with the various subsections of sections 9 and 10.

IV.8.1 Paragraphs 9(1)(a), (b) and (c)

A mark is not registrable if it consists of, or so nearly resembles as to be likely to be mistaken for, any of the subject matter named in paragraphs 9(1)(a), (b) or (c). But, although the Act prohibits marks that reproduce or resemble the Royal Arms, Crest or Standard, etc., no objection will normally be raised in respect of the words "royal" or "vice regal," etc., or to the use of titles such as "Royal Prince" or "Her Majesty," etc. See, for example, *B. Houde Company Limited v. Commissioner of Patents* [1934] Ex. C.R. 149, in which the word "Royal," as part of a composite mark, was held not to contravene section 14 of the *Unfair Competition Act*, corresponding to paragraphs 9(1)(a) and (b) of the *Trade-marks Act*. See also the following commentary on paragraph 9(1)(d).

IV.8.2 Paragraph 9(1)(d)

An objection to registration will be raised in respect of any mark which suggests an association with a royal, vice-regal or governmental authority as set out in paragraph 9(1)(d). Note that a word which alludes in a general way to royalty or a crown, etc. is registrable material — see *Nehi Inc. v. Registrar of Trade Marks* [1939] Ex C.R. 217, in which the words ROYAL CROWN were held not to be prohibited by section 14 of the *Unfair Competition Act*. However, a mark in which such a word is used in a manner to indicate royal patronage must be objected to pursuant to paragraph 9(1)(d).

In *T.S. Simms & Co. Ltd. v. Commissioner of Patents* [1938] Ex. C.R. 326, in which a representation of a crown closely resembling the royal crown included in the Royal Crest was refused registration, the learned trial judge, Angers J. stated:

"I do not believe that section 14 forbids the use of a crown in general; in my opinion, however, it does forbid the use of the crown forming part of the Royal Arms or crest or of the arms or crest of a member of the Royal Family or of a crown so nearly resembling them that it may lead to mistake."

See also *A.B. Statens Skogsindustrier v. Registrar of Trade Marks* (1964), 46 C.P.R. 96, in which the mark ROYAL BOARD THREE CROWNS with a design was held not to offend paragraph 9(1)(d) of the *Trade-marks Act*.

In *Canada Post Corp. v. MacLean Hunter Ltd.* (1994), 55 C.P.R. (3d) 559, the applicant applied to register the trade-mark LASER POST based on use for personalized direct-mail services and personalized direct-mail wares. The words LASER and POST were disclaimed.

The opponent alleged that the trade-mark was not registrable pursuant to paragraphs 9(1)(d) and 12(1)(e) of the *Trade-marks Act* because it was likely to lead to the belief that the wares and services in association with which it was used had received or were produced, sold or performed under governmental patronage, approval or authority.

The application was refused because it was concluded that there was a significant association in the public mind between the word "post" and the opponent when it is used for mail-related wares and services. Further, LASER POST customers would assume that Canada Post had approved, authorized, sponsored or licensed the applicant's use of the trade-mark LASER POST.

IV.8.3 Paragraph 9(1)(e)

Examples of arms, crests or flags for which public notice has been given of their adoption and use by a municipal or government authority and which are unacceptable matter for trade-marks are as follows:

- a) The **Coat-of-Arms of Canada**, which was subject of a notice under paragraph 9(1)(e) in the *Trade Marks Journal* of April 13, 1955.
- b) The **Canadian Red Ensign** with the shield of the Coat-of-Arms of Canada in the flag, which was also subject of a notice under paragraph 9(1)(e) in the *Trade Marks Journal* of April 13, 1955.
- c) The **Canadian Flag**

On April 14, 1965, and pursuant to the provisions of paragraph 9(1)(e), public notice was given in the *Trade Marks Journal* of the adoption and use of the Canadian Flag. Such flag consists of an 11-point maple leaf in a white square with red bars on either side, of the proportion two by length and one by width. The national flag of Canada is therefore a prohibited mark; any application for a trade-mark consisting of or containing the Canadian flag must be objected to.

Notwithstanding the above, on September 2, 1965, Order-in-Council PC 1965, 1623, was passed entitled *Purposes and Conditions of Use By the Public of Certain Canadian Symbols and Emblems*, in which consent was given in section 4 to use the maple leaf on a trade-mark or in a design. Such consent was granted on the condition that:

- a) the use of the design or trade-mark conforms to good taste;
- b) an applicant for the registration of such design or trade-mark disclaims, in the application, the right to the exclusive use of the maple leaf; and
- c) the owner of such design or trade-mark will not attempt to prevent anyone else from using the maple leaf.

The consent pertains to the use of the 11-point maple leaf as part of a composite mark; there must be some registrable portion of the composite mark other than the 11-point maple leaf. The composite mark applied for will be examined in the usual manner pursuant to section 12.

In cases where a trade-mark includes a representation of the Canadian flag, both a consent and a disclaimer are required. Consent may be requested at the following address:

Department of Canadian Heritage
Ceremonial and Protocol
Canadian Identity Directorate
Ottawa, Ontario
K1A 0M5
Tel: (819) 994-1616
Fax: (819) 997-8550

IV.8.3.1 Form of Request for Public Notice — Paragraph 9(1)(e)

The Government of Canada or the government of a province or a municipal corporation may, after adoption and use of a coat of arms, crest or flag, request the Registrar to give public notice of such adoption and use. The written request for public notice should specify that it is made pursuant to the provisions of paragraph 9(1)(e) of the Act, and should be signed by a person having authority to sign for the Government of Canada, the province or the municipal corporation. A black-and-white drawing no larger than 2 3/4 inches by 2 3/4 inches (7 cm X 7 cm) should be submitted. If colour is claimed, it

may be described or the drawing may be lined for colour in accordance with the colour chart provided in the *Trade-Mark Regulations*. See section II.6.2 of this manual on the submission of drawings.

Public notice is considered to be given by the Registrar when the particulars relative to the protected matter are advertised in the *Trade-marks Journal*. Such notices appear in a special section of the *Journal* under the heading "Notices under section 9 of the *Trade-marks Act*."

NOTE: These "requests" are not open for public inspection until they are indexed. See subsection 29(1).

The Registrar must give public notice when requested to do so under paragraph 9(1)(e) of the Act, provided that the form of request conforms to the criteria set out below. As Cattanaich J. said in *Insurance Corporation of British Columbia v. Registrar of Trade Marks* (1979), 44 C.P.R. (2d) 1, at p. 12:

"So, too, the requests contemplated in s. 9(1)(e) and the remaining sources of request in s. 9(1)(n) are made by the Government of Canada, of a Province or by a municipality and by a university or public authority, originate from like, but lesser, high authority and, despite polite usage of the word 'request', are likewise mandatory in nature."

And further:

"...I conclude that there is no discretion in the Registrar to refuse to give public notice when requested to do so under s. 9(1)(e) and s. 9(1)(n) regardless of the body mentioned in either paragraph which makes the request."

IV.8.4 Paragraphs 9(1)(f), (g) and (h)

The prohibitions against adoption for use as a trade-mark of any of the emblems or signs as set down in paragraphs 9(1)(f), (g) and (h) are very specific and therefore do not require additional commentary, except for a practice established in regard to the

heraldic emblem of the Red Cross. An objection based on paragraphs 12(1)(e) and 9(1)(f) of the Act is to be raised against any trade-mark consisting of, or so nearly resembling as to be likely to be mistaken for, the representation of the Red Cross whether applied for in black and white or the colour red. If the applicant claims another colour, other than red, then the mark may be registrable. A composite mark including the Red Cross may be registrable with a consent under paragraph 9(2)(a) and a disclaimer statement extending to the cross design. If the applicant claims a colour other than red, then the cross need not be disclaimed nor is a consent required. A similar approach should be taken on the basis of paragraphs 9(1)(g) and (h).

IV.8.4.1 Paragraph 9(1)(h.1)

This section is self-explanatory.

IV.8.5 Paragraphs 9(1)(i) and 9(1)(i.1)

Under Article 6*ter* of the Paris Convention, the Registrar may receive a communication from the International Bureau of the World Intellectual Property Organization advising of a request for protection in respect of a territorial or civic flag; a national, territorial or civic arm, crest or emblem; or an official sign or hallmark indicating control or warranty.

Public notice of the communication from the International Bureau is given by way of advertisement in the *Trade-Marks Journal*. Matter to be protected under this section is not indexed in the subject indexes in the usual manner. The specimens, which are true representations of the territorial or civic flag; national, territorial or civic arm, crest or emblem; official sign or hallmark indicating control or warranty, are placed in numbered folders. These prohibited marks were previously filed alphabetically in a subject index of the elements comprising the matter to be protected. In 1981, this subject index was discontinued and replaced with black binders. Therefore, this information now appears in the indexes (up to 1981), and subsequently in black binders.

IV.8.5.1 Paragraph 9(1)(i.2)

The prohibition against adoption for use as a trade-mark of any national flag of a country of the Union does not, as in the case of paragraphs 9(1)(i) and

9(1)(i.1) require a communication from the International Bureau and public notice by the Registrar. However, if a communication is received from the International Bureau in respect of a national flag, it will be treated in the same way as communications referred to above under the heading "Paragraphs 9(1)(i) and 9(1)(i.1)"

IV.8.5.2 Paragraph 9(1)(i.3)

Under Article 6^{ter} of the Paris Convention, the Registrar may receive a communication from the International Bureau of the World Intellectual Property Organization advising of a request for protection in respect of an armorial bearing, flag or other emblem, or an abbreviation of the name of an international inter-governmental organization.

Public notice is given by way of advertisement in the *Trade-marks Journal*. The requests are then placed in numbered folders and the information is recorded in the black binders.

IV.8.6 Paragraph 9(1)(j)

Although the Trade-marks Office is not aware of any interpretation of this section by the courts in Canada, similar provisions in the trade-marks acts of the United States and Great Britain have been the subject of consideration. In examining a mark in respect of paragraph 9(1)(j) the examiners may be guided by the following:

- A scandalous word or design is one which is offensive to the public or individual sense of propriety or morality, or is a slur on nationality and is generally regarded as offensive.

- A word is obscene if marked by violations of accepted language inhibitions or regarded as taboo in polite usage.

- A word or design is immoral when it is in conflict with generally or traditionally held moral principles.

A mark consisting of the representation of a topless dancer combined with a second representation of the torso of a topless dancer was found contrary to paragraph 9(1)(j) and was refused by the Registrar pursuant to paragraph 12(1)(e). (*See application No. 409,882.*)

In an American case, the mark BUBBY TRAP as applied to brassieres was refused. Shyrook of the Patent Office Trademark Trial and Appeal Board in *Re: Runsdorf*, 171, U.S.P.Q. 443, stated:

"...`BUBBY TRAP' as applied to brassieres would be offensive to a segment of the public sense of propriety or morality and is therefore prohibited by Section 2(a) of the Act. `Vulgar,' as defined means, inter alia, lacking in taste, indelicate, morally crude, and can, in our opinion, be encompassed by the term scandalous matter."

In order to determine if a word or design is scandalous, obscene or immoral, the examiners must determine whether the word or design would offend the feelings or sensibilities of a significant segment of the public.

In *Oomphies Trade Mark* (1946), 64 R.P.C. 27, Mr. Justice Evershed overruled the Registrar's decision to refuse to register the non-invented word OOMPHIES for shoes on the admitted ground that "oomph" was American slang for sex appeal. Evershed J., while overruling the Registrar, made it quite clear that he had no disagreement with the principles upon which the Registrar acted, stating at p.30:

"I must wholeheartedly accept the proposition that it is the duty of the Registrar (and it is my hope that he will always fearlessly exercise it) to consider not merely the general taste of the time, but also the susceptibilities of persons, by no means few in number, who still may be regarded as old fashioned and, if he is of the opinion that the feelings or susceptibilities of such people will be offended, he will properly consider refusal of the registration."

In another instance, the refusal to register a mark was based on the argument that the mark would offend people's religious sensibilities. In *Hallelujah Trade Mark* (1976), R.P.C. 605, the word HALLELUJAH was refused registration in respect of articles of

clothing for women on the grounds that the word had an overwhelming religious significance and, as applied to the wares, would offend accepted mores of the time.

IV.8.7 Paragraph 9(1)(k)

Since the wording of this paragraph lends itself to a broad interpretation, the examiners must pay particular attention to any way in which a mark might suggest a "false connection" with a living individual. The examiners must be aware of any details such as a nickname, caricature, original element of clothing or some other characteristic which the public associates with the living individual and which cannot be registered as a trade-mark if it falsely suggests a connection with that individual. See *Carson v. Reynolds* (1980), 49 C.P.R. (2d) 57.

IV.8.8 Paragraph 9(1)(l)

The wording of this paragraph is self-explanatory. However, examiners should also see sections IV.3.11 (Historical Characters) and IV.3.12 (Signatures) of this manual for a fuller commentary on the extent to which such material is seen as unregistrable.

IV.8.9 Paragraph 9(1)(m)

This paragraph is self-explanatory

IV.8.10 Paragraph 9(1)(n)

The following pages discuss the salient points of this paragraph.

IV.8.10.1 Subparagraphs 9(1)(n)(i) and (ii)

These subparagraphs provide for the protection of any badges, crests, emblems or marks of her Majesty's Forces or those of any university and which become

prohibited marks per se once public notice of their adoption and use under subparagraphs 9(1)(n)(i) or (ii) is given in the *Trade-marks Journal*. Public notice has been given of the emblems of McGill, Concordia and other universities. The request to give public notice is carried out in the same way as a request under paragraph 9(1)(e) and as outlined in section IV.8.3.1 of this manual.

IV.8.10.2 Subparagraph 9(1)(n)(iii)

This subparagraph differs from 9(1)(n)(i) and (ii) in two respects. First, the request concerning the adoption and use of the badge, crest, emblem or mark must come from a public authority. Secondly, in order that public notice be given, the badge, crest, emblem or mark must have been adopted and used by the public authority as an official mark for wares or services.

Although the specifying of wares and/or services is not a requirement for official marks, many public notices incorporate such information.

Once published, these become prohibited marks and may not be adopted as trade-marks. Therefore, when faced with one of these prohibited marks while examining an ordinary trade-mark, the only consideration is the similarity of the marks, even though there may be wares/services associated with the official mark.

In *Canadian Olympic Assn. v. Holmont Industries Ltd.* (1986), 13 C.P.R. (3d) 308, the Hearing Officer stated at p. 310:

"Having regard to the above and in accordance with the *Kruger* decision, I am of the view that the test under ss. 9(1)(n)(iii) and 12(1)(e) is restricted to resemblance between the prohibited mark and the adopted mark ."

IV.8.10.2.1 Public Authority

The question of whether a body is a public authority has been decided in a number of cases. In *Littlewood v. George Wimpey & Co., Ltd.* [1953] 1 All E.R. 583, British Overseas Airways Corporation was held to be a public authority. In deciding the case, Parker J. considered whether the duties and responsibilities which were entrusted to the body were in the public interest. The Court also considered what degree of public control existed and whether the duties were to be performed in the public interest.

These same tests were applied by Laskin, J.A., in *Cloudfoam Ltd. v. Toronto Harbour Commissioners*, reported in [1969] 2 O.R. 194, at pp. 196-197, where he found that the Toronto Harbour Commissioners was a public authority.

Generally then, a public authority is a body which: 1) has public duties to perform, and 2) performs those duties and carries out the transactions for the benefit of the public and not for private profit.

In another case, namely, *Registrar of Trade Marks v. Canadian Olympic Assn.* (1982), 67 C.P.R. (2d) 59, Urie J. stated at p. 69:

"The only remaining issue, then, is whether there must be a significant degree of governmental control for a body to be found a 'public authority' and, if so, does a significant degree of control exist in the case of the COA. From the authorities earlier referred to it seems that one of the elements the courts have examined in determining the public character of a body is the degree of control exercised by the appropriate government.

Firstly, it should be noted, that there is imposed on the COA by the statute authorizing its incorporation, at least the same degree of control as that imposed on any

other corporation incorporated as a non-profit association the objects of which are, inter alia, of a national, patriotic or sporting character.

Secondly, it is provided that in the event that the COA surrenders its charter, its assets are to be disposed of by the Government of Canada in co-operation with the IOC.

Thirdly, the material on the record shows that a substantial portion of the financing of the COA's activities is derived from the federal government with the control of the disposition thereof undoubtedly being monitored by those representing the government.

Fourthly, the example furnished during the 1980 Olympic Games when the federal government was able to prevail upon the COA not to participate in those games is indicative of a rather substantial degree of influence on the COA's decision making.

Fifthly, the close relationship between the COA, the Directorate of Fitness and Amateur Sport and Sport Canada in the development of athletes, in the provision of training opportunities and facilities and in coaching is indicative of an element of control.

For these reasons, I am of the opinion that there is a sufficient degree of control exercised by government in the COA's activities to reinforce its public character as a 'public authority' within the meaning of subpara. 9(1)(n)(iii) of the Act."

Therefore, a public authority must also be subject to some degree of governmental control.

IV.8.10.2.2 Official Marks

An official mark is an authorized mark derived from, or having the sanction of, persons in office and adopted and used by any public authority in Canada for wares or services.

In *Insurance Corporation of British Columbia v. Registrar of Trade Marks* (1979), 44 C.P.R. (2d) 1, Cattanach J. addressed the question of what constitutes an official mark. At p. 9, he stated:

"What then is an 'official' mark within the meaning of s. 9(1)(n)(iii). An official mark is not defined in the statute.

The Registrar in his reasons dated April 14, 1978, resorted to a dictionary meaning of the word 'official'. One such definition was 'derived from the proper office or officer or authority'.

The definition in the Shorter Oxford English Dictionary is to like effect reading '4. Derived from, or having the sanction of persons in office; hence authorized, authoritative.'"

And further, at p. 10:

"The mark so adopted falls within the dictionary meaning of the word 'official' and therefore is an 'official mark' within the meaning of these words."

Under subparagraph 9(1)(n)(iii), public authorities may request the Registrar to give public notice of the adoption and use of badges, crests, emblems or marks as official marks for wares or services. When such notice is given in the *Trade-marks*

Journal, the information is entered in the index of registered trade-marks maintained in the public search room and also in the database. This enables both the public and the examiners to find any prohibited marks during an availability search.

An official mark is not registrable by another party, and an objection under paragraph 12(1)(e) must be made in any instance where such a mark or a similar mark is the subject matter of an application to register by another party.

IV.8.10.2.3 Form of Request for Public Notice — Subparagraph 9(1)(n)(iii)

The form of the request to advertise must include all the information contained in the request to advertise under paragraph 9(1)(e). *See section IV.8.3.1 of this manual — Form of Request for Public Notice.* In addition, the public authority should enclose a copy of the enabling legislation incorporating the public authority.

The Registrar must give public notice when requested to do so under paragraph 9(1)(n) provided that the form of the request conforms to the criteria set out in section IV.8.3.1 of this manual.

In *Canadian Olympic Assn. v. Olympus Optical Co.* (1991), 38 C.P.R. (3d) 1, it was stated at p. 3:

"Counsel for the appellant strongly urges that the June 11, 1986 public notice is not to be considered because the date on which registrability is to be determined is the date the application for registration was advertised or, at the latest, the date on which the opposition was filed. We are unable to agree. In our view, the appellant acquired no rights to registration on either of those dates and the question of registrability remained

at large until the matter was finally disposed of. Indeed, this view is supported by Canadian Olympic Assn., supra, in which MacGuigan J.A. stated at p. 166, that the 'right to register the mark is... prohibited from the time of the giving of the public notice': see also *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.*, Court File No. A-263-89, judgment rendered June 24, 1991, per Desjardins J.A., at pp. 9-12 [since reported 37 C.P.R. (3d) 413 at pp. 422-4, 28 A.C.W.S. (3d) 103].

In our view, it is of no moment that the appellant submitted an application for registration or that the application was advertised or that the application was opposed before the June 11, 1986 public notice was given. What is critical is that at the time the application was disposed of that notice had been given. The office of the Registrar in disposing of the application was obliged by the statute to give full effect to the prohibition thus created."

Accordingly, the normal commercial trade-mark must defer to the official mark where public notice of an official mark has been given and an identical trade-mark, or one so nearly resembling it as to be likely to be mistaken for it, is the subject of a pending application that has not been advertised in the *Trade-marks Journal*.

IV.8.10.2.4 Paragraph 9(1)(n.1)

This paragraph provides for the protection of any armorial bearings granted, recorded or approved for use, pursuant to the prerogative powers of Her Majesty as exercised by the Governor General in respect of the granting of armorial bearings, if the Registrar has at the request of the Governor General given public notice of the grant, recording or approval.

Once public notice is given in the *Trade-marks Journal*, these become prohibited marks. The information is then entered in the index of registered trade-marks maintained in the public search room and also recorded in the database, thereby enabling a member of the public as well as the examiners to find any prohibited marks during an availability search.

IV.8.11 Paragraph 9(1)(o)

This paragraph of the Act is self-explanatory.

IV.8.12 Section 10

In order to refuse a mark under section 10, the examiners must first establish that, in ordinary commercial usage, the mark applied for is recognized by dealers or purchasers in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any wares or services.

Use of the mark applied for by the applicant and others in printed matter such as catalogues, in a non-trade-mark sense as designating the kind, quality, quantity, destination, value, place of origin or date of production of any wares or services, may be a basis for a first office action. Examiners should be careful, however, to ensure that the date of the printed matter referred to (in order to substantiate a section 10 objection) is prior to the applicant's date of adoption (*see section 3*) of the mark as shown in the trade-mark application.

In opposition decision *Simmonds Aeroaccessories Ltd. v. Elastic Stop Nut Corp.* (1960), 34 C.P.R. 245, the Registrar considered the registrability of the red fibre locking sleeve for a lock nut. After reviewing the evidence, which disclosed the use of like fibre locking sleeves in Canada by other manufacturers for several years, the application was refused pursuant to section 10.

The examiners may also refuse words which, through frequent and prolonged use in the marketplace (e.g., "moped" for motor powered vehicles), are recognized by dealers in or purchasers of the wares as designating the kind of wares.

If the mark applied for is a composite mark and, as a whole, is registrable, a disclaimer clause pertaining to the portion which is unregistrable pursuant to paragraph 12(1)(e) can be inserted in the application.

IV.8.12.1 Section 10.1

Where a denomination must, under the *Plant Breeders' Rights Act*, be used to designate a plant variety, no person shall adopt it as a trade-mark in association with the plant variety or another plant variety of the same species or use it in a way likely to mislead. Nor shall any person so adopt or so use any mark so nearly resembling that denomination as to be likely to be mistaken for it.

Agriculture and Agri-Food Canada has the mandate to grant rights for denominations of plant varieties under the *Plant Breeders' Rights Act*. These rights give owners control over the multiplication and sale of reproductive material. Protection is for up to 18 years. For more information, call the Plant Breeders' Rights Office at (613) 995-7900.

The grants are published in the *Plant Varieties Journal*, a copy of which is sent to the Trade-marks Office regularly. The Office then incorporates this information in the index of registered trade-marks maintained in the public search room, which enables both members of the public and examiners to find these prohibited marks during an availability search.

In cases where a trade-mark applied for is the same as or similar to one of these prohibited marks and the application covers the plant variety or another plant variety of the same species, the examiners must raise an objection under paragraph 12(1)(f).

IV.8.13 Sections 9 and 10 — Informing the Applicant

When examiners find a mark or portion of it that consists of or is almost identical to the prohibited mark, they must, in communicating with the applicant, identify which part of subsection 9(1) or section 10 is being applied. They must state that the mark is not registrable under the provisions of paragraph 12(1)(e) or (f).

IV.8.14 Paragraph 9(2)(a) — Consent for Use of Prohibited Marks

This paragraph provides a means whereby, with the consent of Her Majesty or such other person, society, authority or organization considered protected by subsection 9(1), prohibited matter may be used or registered as a trade-mark in connection with a business.

Consents to overcome the prohibition in paragraph 9(1)(l) against the portrait or signature of an individual who is living or has died within the preceding 30 years are quite common. *See also section IV.3.12 of this manual.*

The examiners must also secure a disclaimer statement extending to the prohibited matter since no one person is entitled to exclusive use of that matter.

IV.8.14.1 Paragraph 9(2)(b)

Subparagraph 9(2)(b)(i) stipulates that if the trade-mark applied for consists of, or so nearly resembles as to be likely to be mistaken for, an official sign or hallmark mentioned in paragraph (1)(i.1), an objection will be raised if the wares are the same or similar to the wares in respect of which the official sign or hallmark has been adopted.

On the other hand, if the wares in question are totally dissimilar, then no objection will be raised.

Subparagraph 9(2)(b)(ii) stipulates that if the trade-mark applied for consists of, or so nearly resembles as to be likely to be mistaken for, an armorial bearing, flag, emblem or abbreviation mentioned in paragraph (1)(i.3), an objection will be raised if use of the mark is likely to mislead the public as to a connection between the user and the organization.

On the other hand, if it is unlikely that the public would be misled, then no objection will be raised.

IV.8.15 Paragraph 12(1)(f) and Section 10.1 — Plant Variety Denominations

This paragraph deals with denominations which are prohibited for use as trade-marks under section 10.1. These denominations are granted by Agriculture and Agri-Food Canada. *See section IV.8.12.1 of this manual for more details.*

IV.8.16 Paragraphs 12(1)(g) and (h) — Protected Geographical Indications for Wines or Spirits

These paragraphs relate to protected geographical indications for wines or spirits. The Registrar of Trade-marks is required to keep a list of protected geographical indications for wines or spirits in accordance with section 11.12(1). *See sections III.1, III.6, IV.1, IV.9.4.4, IV.10.1 and V.9.2 of this manual for more details.*

IV.9 Disclaimers — Section 35

This section enables an applicant to disclaim certain portions of a trade-mark which would otherwise be unregistrable, subject to the conditions set out in this section of the manual. *See also section II.6.4 of this manual.*

In *Lake Ontario Cement Ltd. v. Registrar of Trade Marks* (1976), 31 C.P.R. (2d) 103 at 107, Dubé J., after reviewing a number of cases relating to disclaimers, stated:

"The role and effect of disclaimers is discussed in Fox, *Canadian Law of Trade Marks and Unfair Competition*, 3rd ed., p. 238. It is pointed out that, even when parts of a mark taken separately may not be capable of registration, the mark when taken as a whole may be distinctive and so registrable, but 'nevertheless, the practice of combining registrable and unregistrable material in a registration is one that should be avoided and means for its avoidance provided'. It is stated that the practice of disclaimers is a valuable one in that it allows a registration to contain matter which standing alone 'is non-distinctive'. The practice was given statutory authority by s.34."

In their original applications, many applicants include disclaimers of portions of the trade-mark which are not independently registrable. The form of the disclaimer is found in Form 1 and reads as follows:

"The applicant disclaims the right to the exclusive of _____ apart from the trade-mark."

The inclusion of the disclaimer in the original application saves both the applicant and the Office time and, in many cases, avoids an unnecessary first action requesting a disclaimer. When an application has no disclaimer, the examiners must determine if any portion of the mark contravenes the pertinent provisions of section 12 and, if so, must request that the application be amended to include a disclaimer.

On applications to extend the statement of wares/services, a disclaimer must be requested, if warranted, even if matter was disclaimed in the original registration. *See section II.7.7 of this manual on extension of wares/services applications.*

NOTE: A requirement for a disclaimer cannot be overcome by invoking subsection 12(2) or section 14 and submitting evidence relating to the trade-mark as a whole. It can only be overcome by satisfying the Registrar that the subject matter of the proposed disclaimer is independently registrable.

In other words: Does the applicant have a per se registration or an allowed application under subsection 12(2) or section 14 or a per se registration under the UCA or TMDA (with or without evidence) pertaining to the unregistrable subject matter? If so, the subject matter is considered independently registrable and therefore the mark will be published with the notation: "The applicant is the owner of....etc."

NOTE: An applicant can, in some instances, establish that a portion is independently registrable through argument.

IV.9.1 Portion of the Trade-mark

IV.9.1.1 Compound Word

If a trade-mark is a compound word written as one word (e.g., HAPPYSOX as applied to men's hosiery), no disclaimer will be required for the word SOX.

If, however, a portion of the mark stands out as separate, having, for example, different print, a different colour claim, or a portion beginning with a capital letter, a disclaimer will be requested if such portion contravenes the pertinent provisions under section 12.

IV.9.1.2 Hyphenated Word

If the compound word is in hyphenated form, the same rules with respect to a disclaimer of single compound words apply. Thus, for a mark shown as HAPPY-SOX, no disclaimer statement extending to the word SOX would be requested.

IV.9.1.3 Composite Mark

If, however, the mark is a composite mark, consisting of the words HAPPY SOX or the word HAPPY and a representation of socks, a disclaimer will be required of the word SOX or the representation of socks.

In the case of a mark composed of both English and French words, and if both portions are objectionable under the pertinent provisions of section 12, a disclaimer of both portions will be required. If a mark is composed of portions which are objectionable under different paragraphs, i.e., 12 (1)(a) and (b) or (a) and (c), a disclaimer of both portions is required. (For example, LABATT EXTRA or LABATT BEER.)

IV.9.1.4 Partial Disclaimers

Where a portion of a trade-mark is found to be unregistrable for only some of the wares or services named in an application, the examiners will request a disclaimer restricted to those wares/services for which the mark is objectionable.

For example, if the mark EMBASSY SPORTING GOODS is applied for in relation to "sporting goods of all kinds, namely, tents, knapsacks and hunting knives; and baby clothes, canned vegetables and waxed paper," the examiners will accept a disclaimer statement as follows:

"The applicant disclaims the right to the exclusive use of the words SPORTING GOODS apart from the mark, in respect of the wares sporting goods of all kinds, namely, tents, knapsacks and hunting knives."

Since these are the only goods applied for in association with which the words SPORTING GOODS are objectionable under paragraph 12(1)(c), it is not necessary to disclaim rights in those words in respect of the other wares.

IV.9.2 Portion Not Independently Registrable — Disclaimer Requested

Any portion of a trade-mark which is not independently registrable pursuant to paragraphs 12(1)(a), (b), (c) and (e) must be disclaimed.

Disclaimers of unregistrable portions of trade-marks will be requested where a portion of the trade-mark:

- 1) consists of reading matter which is primarily merely the name or surname of an individual who is living or who has died within the preceding 30 years;

- 2) consists of any matter, whether depicted, written or sounded, which is clearly descriptive, in the English or French language, of the character or quality of any of the wares or services, or of the conditions or persons employed in their production, or in the performance of the services or of their place of origin;
- 3) is the name in any language of any of the wares or services;
- 4) consists of a word or symbol common to the trade or business with which the applicant is concerned (e.g., fashions);
- 5) consists of a slogan, phrase, sentence or word combination which, as a whole, is clearly descriptive of any of the wares or services (the disclaimer statement may extend to the phrase, sentence or word combination as a whole);
- 6) consists of a map, representative of the place of origin of any of the wares or services;
- 7) consists of a depiction of any of the wares or services associated with the trade-mark;
- 8) consists of a representation of the 11-point maple leaf.

IV.9.3 Portions Independently Registrable — No Disclaimer Request

Disclaimers should not be requested for portions of marks which have been registered upon proof of distinctiveness in respect of the wares/services applied for. That is, disclaimers should not be requested in the following circumstances:

- 1) The portion of the mark has been previously registered for similar wares or services under the TMDA or UCA.

- 2) The portion of the mark has been previously registered for similar wares or services on the basis of acquired distinctiveness pursuant to subsection 12(2), or registered on the basis of being "not" without distinctive character pursuant to section 14.

In the cases mentioned above (1 and 2), the examiners will have the application published with the statement: "The applicant is the owner of registration no...." This is in lieu of a disclaimer.

- 3) The portion is in a language other than English or French and is clearly descriptive or deceptively misdescriptive of the wares or services associated with the trade-mark.
- 4) The mark as a whole is not descriptive and the portion comprises the following words or abbreviations: LIMITED, LTD., CORPORATION, CORP., INCORPORATED, INC., COMPANY, CO., PRODUCT(S), AND BRAND(S).

IV.9.4 Marks Non-Registrable, Even with Disclaimer

In a number of circumstances, a mark, when considered as a whole, is not registrable, even though a part or each part of the mark applied for has been disclaimed. See the following paragraphs under this section.

IV.9.4.1 Disclaimer - Deceptively Misdescriptive or Misleading Prohibited Matter

If the disclaimed portion of the mark applied for is deceptively misdescriptive and non-registrable pursuant to paragraph 12(1)(b), or if the disclaimed portion of the mark applied for is a prohibited mark pursuant to section 10, and the wares/services are not of the kind, quality, etc. covered by the

prohibited mark, the mark as a whole is not registrable if the non-registrable or prohibited disclaimed portion forms a significant part of the mark.

In *Lake Ontario Cement Ltd. v. Registrar of Trade Marks* (1976), 31 C.P.R. (2d) 103 at p. 109, Dubé J., after finding it would not be difficult to visualize the appellant's trade mark without the word PREMIER, stated:

"In my view a disclaimer ought not be used in relation to a deceptively misdescriptive matter so as to render the mark as a whole registrable when the unregistrable matter is a dominant feature of the composite mark. After all, the disclaimer does not appear on the mark and the deception stands visually overwhelming."

IV.9.4.2 Disclaimer - Confusing Marks

A disclaimer does not overcome an objection of confusion with a registered trade-mark pursuant to the provisions of paragraph 12(1)(d) or a pending trade-mark pursuant to subsections 16(1), (2) and (3).

In *American Cyanamid Co. v. Record Chemical Co. Inc.* (1972), 7 C.P.R. (2d) 1, Noel J. found the mark PINE-L, as applied for in relation to disinfectants, confusing with the registered mark PINE-SOL for use in association with detergents, deodorants, and disinfecting and bleaching fluids, even though the registrant had disclaimed the right to the exclusive use of the word "pine" apart from the trade-mark. At p. 5 Noel J. stated:

"The appellant, (registrant), as already mentioned, disclaimed the word 'pine' but the marks must still be considered in their totalities in determining whether there is a likelihood of confusion between them."

See also *Lake Ontario Cement Ltd. v. Registrar of Trade Marks* (1976), 31 C.P.R. (2d) 103.

IV.9.4.3 Disclaimer — All Elements of Trade-mark

A disclaimer of all the elements of a trade-mark is not acceptable if the trade-mark considered as a whole is unregistrable and does not contain any distinguishing feature. In *Ingle v. Registrar of Trade Marks* (1973), 12 C.P.R. (2d) 75, at p. 77, Addy J., after noting that the applicant had disclaimed the words STUDENT LIFE, and after considering the applicant's submission that it had the right to have the mark itself registered, stated:

"This might very well be true if there were a mark or anything sufficiently peculiar in the form or layout of either of the words or of any of the letters to which the registration might attach...."

And further:

"To constitute a mark, there must be a pictorial representation or design, or something which marks or distinguishes it in some way and allows it to be recognized."

See *Canadian Jewish Review Ltd. v. Registrar of Trade Marks* (1961), 37 C.P.R. 89, where despite the disclaimer to the words THE CANADIAN JEWISH REVIEW the mark was found to be unregistrable. In this case, at p. 93, Cameron J. stated:

"In my opinion, the trade mark in spite of the design features is still clearly descriptive in the English language of the character of the wares or services with which it is used. Notwithstanding the disclaimer, the four words (admittedly not registrable *per se*) still form the material part of the trade mark and in spite of the added design features still spell out 'The Canadian Jewish Review.' Both the words themselves and the Hebraic letterpress are *publici juris* and their combination without at least any design features exclusive of the letters does not in

my view on the evidence before me make the mark, when considered as a whole, other than descriptive of the wares or services of the appellant."

In *John Labatt Ltd. v. Registrar of Trade Marks* (1984), 79 C.P.R. (2d) 110, Cattanach J. after noting that the applicant had disclaimed the words SUPER and BOCK, said:

"Since the two words `super bock' form a most material part of the trade mark, despite the disclaimer of those two words, and there is no design feature exclusive of the letters and their positioning it follows from the reasoning of Cameron J. which I adopt and apply, the trade mark as a whole cannot be other than clearly descriptive of the character or quality of the wares with which they are associated and so not registrable."

In each case the examiners must decide whether or not the mark as a whole is registrable when the individual elements are disclaimed.

Where a disclaimer is applied separately and independently to the different parts comprising a trade-mark there must be some distinctiveness in the combination of the words such that the mark, even with the disclaimers, is still registrable.

For example: COFFEE CRISP for chocolate-coated biscuits; COMMERCE CAPITAL for real estate services and financial services; TERRY CREPE for textile goods; and BURGER DOG for sandwiches.

IV.9.4.4 Disclaimer — Protected Geographical Indications for Wines or Spirits

A disclaimer does not overcome a paragraph 12(1)(g) or (h) objection to a portion of a mark.

IV.9.5 Form of Disclaimers

When the examiners have thoroughly assessed all the facts, and have determined that a disclaimer clause is necessary, the applicant will be required to enter a disclaimer of the unregistrable portion of the mark as shown in Form 1, paragraph 3. Each portion of the mark applied for which is not independently registrable must be disclaimed pursuant to section 35.

The examiners may request that an applicant amend the application: a) by requesting that a disclaimer clause be inserted in the application of each independently unregistrable portion of the trade mark; or b) by requesting an amendment of the disclaimer clause to include a disclaimer of independently unregistrable material not already disclaimed; or c) by requesting a revision of the original disclaimer statement so as to require a disclaimer statement in the proper form.

Failure to comply with a disclaimer request within the time allowed for its entry means that the applicant will be found to be in default of the prosecution of the application, thus giving the examiners the authority to institute abandonment procedures pursuant to section 36.

IV.10 Subsection 12(2) — Distinctiveness

IV.10.1 General

A trade-mark which is not *prima facie* registrable under the provisions of paragraph 12(1)(a) or (b) may be registered if it has been used in Canada so as to have become distinctive at the date of filing of the application in Canada, pursuant to subsection 12(2).

An applicant may not claim the benefits of subsection 12(2) if the mark is objectionable under paragraph 12(1)(c), (d), (e), (f), (g) or (h).

A trade-mark becomes distinctive throughout Canada or in some provinces when it has come to be recognized by the Canadian public, not as the unregistrable word, but as a word which, when used in association with the wares or services applied for, serves to distinguish the wares or services of the applicant from those of others. The

word is said to have acquired a secondary meaning with respect to the wares or services in that when the word is presented to the public, whatever primary meaning it may have is submerged, and only the trade-mark designation remains.

Proof of distinctiveness or secondary meaning must be filed by way of affidavit or statutory declaration meeting the requirements of subsection 32(1), and distinctiveness must be established at the date of filing of the application. Even words disclaimed pursuant to section 35 as unregistrable under 12(1)(a) and (b) may be the subject of a subsequent application if the disclaimed matter has become distinctive. Proof of distinctiveness must be offered as described in the following paragraphs.

IV.10.2 Evidence

It is possible to appeal to the Federal Court of Canada any refusal of an application made under subsection 12(2) or any opposition decision which such an application may be subject to. Therefore, the material filed before the Trade-marks Office should be in a form which is admissible in the Federal Court of Canada and should follow its rules of evidence.

Further, section 40 of the *Canada Evidence Act*, provides:

"In all proceedings over which Parliament has legislative authority, the laws of evidence in force in the province in which those proceedings are taken, including the laws of proof of service of any warrant, summons, subpoena or other document, subject to this Act and other Acts of Parliament, apply to those proceedings." R.S., c.E-10, s.37.

Evidence shall be furnished by way of affidavit or statutory declaration pursuant to subsection 32(1) and should be submitted by an affiant having first-hand knowledge of the situation. It is incumbent upon the applicant to produce the best evidence available.

Affidavits should be sworn and statutory declarations should comply with the requirements for Statutory Declarations in section 41 of the *Canada Evidence Act*. Exhibits should be identified and the usual identification made of each exhibit

together with the signature of the notary or commissioner taking the affidavit or receiving the statutory declaration.

IV.10.2.1 Master Affidavits

When submitting an application based on a subsection 12(2) claim of distinctiveness, the applicant must file a master affidavit. If filed on behalf of a company, the master affidavit should be submitted by a knowledgeable officer of the company. In all cases the affiant must be identified and the basis and source of the person's knowledge explained. The affidavit should be accompanied by specimens of the mark as used in relation to the wares or services and the following information supplied:

- a) A statement of the nature of use of the mark in association with the wares or services.
- b) An explanation concerning the manner of association of the mark at the time of any transfer of property or transfer in the possession of wares.
- c) A statement on the manner of use of the mark in the advertisement of wares or services pursuant to sections 4 and 5 of the *Trade-marks Act*, accompanied by specimens of advertising material.
- d) Statements which clearly indicate the extent of use of the mark for each territory (province) in which the mark is stated to have become distinctive. For example, in claiming that the mark has achieved distinctiveness in Canada at the date of filing, the applicant must show that the mark has achieved secondary meaning in each of the provinces.
- e) Statements which attest to the length of time of use of the mark in association with the wares or services.

The extent of use may be stated in terms of units, dollar volume of sales, or percentage of the market for the wares or services performed, sold, leased or hired in association with the mark. The evidence may refer to the mode of

distribution, the number of distributors, and the number of outlets in which the product or services associated with the mark is offered for sale.

As for the manner and extent of advertising, the affidavits should indicate the number of ads and dollar volume for each type of media. Information attesting to the geographical area covered by the advertisements is essential.

IV.10.2.2 Additional Affidavits

Additional affidavits, i.e., from dealers in or users of the wares, will not be required in all cases to support a claim under the provisions of subsection 12(2) of the *Trade-marks Act*.

The master affidavit may be sufficient as long as the criteria set out in section IV.10.2.1 of this manual are met, particularly where territorial sales and advertising are concerned.

Only when there is some doubt whether the trade-mark had acquired distinctiveness as of the date of filing, and depending on the particular mark and circumstances involved, will the office require additional evidence, possibly by means of supplementary affidavits.

These additional affidavits may be from advertising agencies, distributors, wholesalers, retailers and users who can attest as to the secondary meaning of the word or words in association with the wares or services at or preceding the date of filing in Canada. These affidavits should also relate to the form of use, extent of use, length of use, and territory of use of the mark applied for in relation to the wares or services set out in the application.

IV.10.2.3 Survey Evidence

Surveys are now used extensively in commerce and many business decisions are based on their results. If a market survey is to be used as evidence, in

order to be worthwhile, it must be carried out by a person who can file an affidavit which attests to the fact that this person is an expert in designing, organizing, implementing and interpreting survey results. A qualified surveyor will set out the strategy and statistical basis of the survey and will explain the form of the questions asked and the manner in which the survey is conducted. All the results of the survey must be reported — both negative and positive — and the interpretation of the results fully explained.

A properly conducted survey was accepted as evidence of secondary meaning by Cameron J. in *Aluminum Goods Ltd. v. Registrar of Trade Marks* (1954), 19 C.P.R. 93. In completing his review of the evidence, Cameron J. stated at p. 97:

"It is sufficient to state that as a result of the questioning, 91% of 3,007 housewives and 96.5% of 505 dealers identified 'Wear-Ever' as a brand. It is a significant fact that while 44% of the dealers questioned did not deal in 'Wear-Ever' utensils, 96.5% of all identified 'Wear-Ever' as a brand, thus indicating the widespread knowledge among dealers of the manner in which the word was used.

On the whole of the evidence I have no hesitation whatever in reaching the conclusion that the petitioner has satisfied the onus cast upon it by s. 29...."

And further:

"It is true, as pointed out by counsel for the Registrar of Trade Marks, that the recognition by dealers and users is not perhaps universal, a small percentage of those questioned stating that they thought the word referred to a quality of the wares and was not used as a brand. The section, however, requires only that the trade mark be *generally* recognized in the manner stated. To borrow a phrase used by the Master of the Rolls in the *Sheen case — Re J. & P. Coats Ltd's Application* (1936), 53 R.P.C. 355 at p. 381 — the distinctiveness in fact in this case is as wide and as long continued as one could expect to find in any case."

In *Canadian Schenley Distilleries Ltd. v. Canada's Manitoba Distillery Ltd.* (1975), 25 C.P.R. (2d) 1, Judge Cattnach, after reviewing the law relating to survey evidence and reviewing the form and content of the survey submitted, admitted the survey evidence. At p. 9 Cattnach J. stated:

"In my view the admissibility of survey evidence and the probative value of that evidence when admitted is dependent on how the poll was conducted, the questions asked, how they were asked and how they were framed and what purpose the evidence is to be used for. There would be no objection to evidence being admissible when the poll is put forward not to prove the truth of the statements it contains but merely to show the basis of an expert's opinion, or as in the present instance, an assessment of the results of the survey."

In *Boyle-Midway (Canada) Ltd. v. Farkas Arpad Homonnay* (1976), 27 C.P.R. (2d) 178, a public opinion survey was refused by the Acting Registrar on the grounds that it was substantially in breach of all the rules governing admissibility of public survey evidence. See also the decision of Mr. Justice Mahon in *Customglass Boats Ltd. v. Salthouse Brothers Ltd.* (1975), R.P.C. 589, for a review of Canadian, U.S. and British law on admissibility of public opinion evidence.

The survey results should be in addition to the master affidavit filed by the applicant or a knowledgeable officer of the applicant company.

IV.10.2.4 Restriction as to Territory

While it may be difficult to establish that a mark has acquired secondary meaning, the examiners should, if satisfied from a review of the evidence that this has occurred, permit the mark to proceed to advertisement with a restriction as to territory if necessary. In *Standard Coil Products (Canada) Ltd. v. Standard Radio Corp.* (1971), 1 C.P.R. (2d) 155, Cattnach J., after reviewing the evidence, concluded at p. 173:

"Under the circumstances of the case I have come to the conclusion that the appellant has been successful in discharging the onus of establishing that the trade mark STANDARD actually distinguishes its product."

See also *Home Juice Co. v. Orange Maison Ltée.* (1967), 53 C.P.R. 71 at pp. 77-78, where ORANGE MAISON was held to have acquired a distinctive meaning in relation to the orange juice of the respondent and its predecessors in title among dealers and purchasers of orange juice in the Province of Quebec.

IV.10.3 Determination of Distinctiveness — Subsection 12(2)

The evidence filed by the applicant must be sufficient to enable the examiners to conclude that the public in Canada, or in a territory or province, perceives the descriptive word or surname (as used by the applicant in association with the wares or services applied for), as a word which distinguishes the wares or services of the applicant from those of others. The primary descriptive connotation or surname significance will have been subordinated in the mind of the public in relation to the particular wares or services applied for, and its secondary meaning will dominate.

A word having a primarily descriptive or surname significance cannot reasonably be expected to have acquired a secondary meaning as a trade-mark to every last individual in the territory. The proof of distinctiveness pursuant to subsection 12(2) requires only that there be a substantial recognition of the secondary meaning of the mark by dealers and/or the public. *See also sections IV.10.2.3 and IV.10.2.4 of this manual.*

Nevertheless, the evidence of acquired distinctiveness or secondary meaning must be strong and convincing. As Fox stated in *Canadian Law of Trade Marks and Unfair Competition*, 3rd edition at p. 131:

"There will, of course, always be considerable difficulty in convincing the Registrar, or the court, that a *prima facie* unregistrable word has acquired a secondary meaning sufficient to permit its registration, for the legislature and the courts have always shown a natural disinclination to allow any person to obtain by registration a monopoly in what others may legitimately desire to use."

IV.10.3.1 Prior Decision

The examiners must read with caution the decisions under the *Unfair Competition Act*, as the words "adapted to distinguish," which appeared in paragraph 2(m) of the *Unfair Competition Act, 1932*, do not appear in the *Trade-marks Act*. The words "adapted to distinguish" required that a word not only be distinctive in fact, but secondly, that the word must be inherently adapted to distinguish. In applying the provisions of the *Unfair Competition Act* certain laudatory words such as SUPER-WEAVE were found not inherently adapted to distinguish and therefore could never be registrable based on acquired secondary meaning. See *Registrar of Trade Marks v. G.A. Hardy & Co. Ltd.* (1949), 10 C.P.R. 55.

IV.10.3.2 Onus

An applicant who contends that a surname or descriptive word has acquired a secondary meaning is under heavy onus to prove it. As Cattnach J. stated in *Standard Coil Products (Canada) Ltd. v. Standard Radio Corp.* (1971), 1 C.P.R. (2d) 155 at p. 172, when considering whether the mark STANDARD had acquired a secondary meaning in Canada in association with the wares television tuners:

"It remains for me to assess the probative value of such evidence. In so doing I am conscious that the onus on a person contending that a trade mark which is descriptive or laudatory of his wares has come to actually distinguish those wares is a heavy one and that onus is increased by the adoption of a word which lacks inherent distinctiveness."

Also in *Carling Breweries Ltd. v. Molson Companies Ltd.* (1984), 1 C.P.R.(3d) 191, Strayer J. stated:

"I am not only of the view that the onus lay instead on the applicant to prove distinctiveness within s-s. 12(2), but I also think that it was a very heavy onus given the nature of the mark CANADIAN. There are various authorities to the effect that where one must prove that a normally descriptive word has acquired a secondary meaning so as to make it descriptive of a particular product, the onus is indeed heavy: see, for example, *Canadian Shredded Wheat Co. v. Kellogg Co. et al*

[1938] 2 D.L.R. 145 at pp. 151-2, 55 R.P.C. 125 at p. 142 (J.C.P.C.); *J.H. Munro Ltd. v. Neaman Fur Co. Ltd.* (1946), 6 C.P.R. 97 at p. 113, [1947] 1 D.L.R. 868, 5 Fox Pat C. 194 at p. 208 (Ex.Ct.). In my view, this is particularly true where the word is one such as 'Canadian' which is first and foremost, legally and factually, an adjective describing any citizen of this country, and more particularly for present purposes any product of any sort having its point of origin in this country. As used in conjunction with the word 'beer' it is capable of describing any such malt beverage produced in Canada by any brewer. The onus, as I have noted above, is on the applicant for registration of such a mark to demonstrate clearly that it has become so distinctive of his product that it has acquired a secondary meaning which would not, vis a vis the relevant public, normally be confused with the primary meaning of the word."

This decision was upheld at the Federal Court of Appeal (1988), 19 C.P.R.(3d) 129.

IV.11 Section 14 — Not Without Distinctive Character

Subsection 31(2) of the Act provides for the submission of an application to register a trade-mark which the applicant has registered in his/her country of origin, as long as the applicant furnishes evidence which shows that the mark is "not without distinctive character" in Canada pursuant to paragraph 14(1)(b).

The applicant must submit an affidavit, specimens and details about the value and volume of sales, although the extent to which he/she must offer proof of distinctiveness is clearly reduced when compared with an applicant claiming the benefit of subsection 12(2).

See section II.7.8 of this manual for more extensive treatment of a section 14 claim.

V THE EXAMINERS' REPORTS

V.1 Objection to Registration — Subsection 37(2)

According to the provisions of subsection 37(2), the Registrar shall not refuse any application without first notifying the applicant of the objection to registration and the reasons for it. Also, the applicant must be given adequate opportunity to answer such objections.

The Registrar's objections to registration are communicated to the applicant by way of the examiners' reports and deal with: 1) the conformity of the application to the requirements of section 30; 2) whether the subject matter sought to be registered comes within the meaning of a trade-mark as defined in section 2 of the Act; 3) the registrability of the trade-mark in light of the provisions of sections 9, 10 and 12; and 4) the applicant's entitlement to registration in light of rival applicants in accordance with the provisions of section 16.

V.2 First Actions

The examiners' reports are prepared after the initial examination of the application and the trade-mark for which registration is requested, and is referred to as the "first action."

The examiners' first action must deal with all requirements which need to be remedied before the application can proceed to advertisement. The examiners must not engage in piecemeal reporting because this leads to undue protraction of the examination process and a high incidence of oversight and error. It is also disconcerting for the applicant (or the agent) who has complied with the requirements of an examiner's report to be told in a subsequent report that there is a sound statutory bar to registration.

V.3 Standard Paragraphs

First actions are, for the most part, written in standardized form. The examiners may use either the pre-printed form covering a number of common objections and formal requirements or a series of "standard paragraphs" that are retained on the computer systems in the Word Processing Section.

The standard paragraphs have been coded according to subject matter. When composing the report, the examiners designate, by code number, the paragraphs which most accurately describe the requirements or objections which apply to the trade-mark application in question. However, to comply with the provisions of subsection 37(2), the examiners must give reasons for statutory objections and so will incorporate the information necessary for a fuller explanation of the objection. Reports are prepared in duplicate, with one copy kept on file. Circumstances which require issuing of examiners' reports are described below.

V.4 Wares or Services

The statement of wares or services will be deemed unacceptable and an amended application required in the following cases:

- 1) If the applicant does not name the specific wares or services in ordinary commercial terms. This also applies when wares are described according to function or in any similar fashion. The examiners must, for example, comprehend the general class designation used by the applicant. Terms such as "accessories" or "equipment" or "products" in, for example, "ladies dresses and accessories" or "artist's equipment" or "agricultural products" will be questioned.
- 2) When further information is required as to how wares or services are used in commerce — for example, if the examiners are unable to identify the area of use of the wares or services. In this case the examiners may ask for illustrative or advertising materials.

V.5 Paragraph 12(1)(a)

An objection or disclaimer request pursuant to paragraph 12(1)(a) must be supported by giving the number, or an approximate number, of the names or surnames found in the directories.

V.6 Paragraph 12(1)(b)

An objection or a disclaimer request based on "descriptiveness" or "deceptive misdescriptiveness" must be supported by identification of the sources of information on which the examiner based the objection and/or an explanation as to how that information applies to the description of the particular wares or services. An exception is made when the descriptive objection is based on the fact that the trade-mark is an obvious laudatory epithet.

An objection under paragraph 12(1)(b) should not be made on the basis of information obtained as a result of oral enquiry only. Information received from telephone conversations and the like is only used to confirm that an objection should or should not be raised.

V.7 Paragraph 12(1)(c)

An objection or a disclaimer request, based on the fact that the trade-mark is the name of the wares or services in any language, should be supported by factual evidence, usually dictionary definitions establishing that the word or words identify wares or services in whatever language.

V.8 Paragraph 12(1)(d)

An objection based on paragraph 12(1)(d) is always supported by a copy of the registration of the trade-mark with which the applicant's trade-mark is considered to be confusing within the terms of subsection 6(2) of the Act. The examiners should always verify that the copy relates to the appropriate registration, identified by registration number and that the registered trade-mark is in good standing.

V.9 Paragraph 12(1)(e)

When raising a paragraph 12(1)(e) objection, the examiners must be careful to distinguish between the basis for the objection and the reasons for it. The reasons for objection are set out in subsection 9(1) and section 10 of the Act, while its basis is in the provisions of paragraph 12(1)(e).

When an objection to registration is made for a mark which is prohibited by reason of public notice having been given pursuant to paragraphs 9(1)(e), (i) or (n), it must always be supported by a copy of the public notice.

When an objection to registration is made for a mark which is prohibited, as defined in section 10 of the Act, the examiners must provide evidence which shows ordinary and *bona fide* commercial usage of the mark.

V.9.1 Paragraph 12(1)(f)

When raising a paragraph 12(1)(f) objection, the examiners must provide a copy of the plant variety denomination published in the *Plant Varieties Journal*.

V.9.2 Paragraphs 12(1)(g) and (h)

When raising an objection based on paragraphs 12(1)(g) or (h), the examiners must provide information pertaining to the protected geographical indication.

V.10 Section 16

The following is an example of how to evaluate entitlement between co-pending confusing applications:

- 1) Applicant: ABC Company
Mark: AJAX
Wares: motor trucks — registered and used abroad basis
Filed: December 1, 1993
Priority Date: August 3, 1993

- 2) Applicant: XYZ Company
Mark: AJAX
Wares: Motor-driven vans — used in Canada basis
Filed: January 2, 1994
Used in Canada: September 11, 1992

In the above case, XYZ Company, which has used the mark in Canada since September 11, 1992 is entitled to registration because the date of use in Canada is earlier than the priority date of ABC Company.

Had both companies filed on the basis of registration and use abroad, or proposed use in Canada, ABC Company would have been entitled over XYZ Company by reason of its earlier priority filing date.

V.11 Multiple Claims

It may happen that an application contains an allegation to use or making known in Canada, and use and registration abroad, and/or proposed use in Canada, for a trade-mark which is found to be confusing with a trade-mark in an application subsequently filed. If the application bearing the later filing date discloses earlier use of the trade-mark in Canada in association with the same or similar wares or services, then it will be considered to be the entitled one by virtue of the provisions of paragraph 16(1)(a).

Examiners should exercise care when making a determination as to the person entitled between rival applicants where applications for registration are based on two or more of the provisions of section 16. The applicant's entitlement to registration must be assessed in respect of and in accordance with the provisions of each of the claims under subsections 16(1), (2) or (3) made in the application. (See example below).

1) Applicant: ABC Company

Mark: AJAX

Wares:

- Plant growth regulators - used in Canada since June 1993 — *16(1)*

- Insecticides - registered and used abroad — *16(2)*

- Hair colouring preparations - proposed use — *16(3)*

Filed: September 11, 1994

2) Applicant: XYZ Company

Mark: AJAX

Wares: Shampoo and hair bleaching preparations - used in Canada since May 11, 1993 — *16(1)*

Filed: December 2, 1994.

NOTE: XYZ Company is the entitled applicant because the date of use of the trade-mark in Canada, in association with shampoo and hair bleaching preparations, is earlier than the date of filing of the ABC Company's application for intended use of a trade-mark in association with hair colouring preparations.

The non-entitled applicant may withdraw the claim based on proposed use of the trade-mark in Canada, and request registration of the trade-mark in respect of insecticides and plant growth regulators, thereby removing the objection to registration based on the non-entitlement.

V.12 Second and Third Actions

An examiner's report contains a notice to the effect that a complete response should be filed within four months from the date of the report, failing which, the Registrar will institute abandonment procedures. This is considered to provide adequate time to answer objections, as provided for in subsection 37(2).

The applicant must deal with all issues raised in the examiner's report in order to have the application approved for advertisement in the *Trade-marks Journal*. The Trade-marks Office endeavours to follow a system whereby the status of the application will, in most cases, be determined after two action reports.

While the examiner's first action identifies the problems evident in the application, the second action considers the applicant's response and identifies the areas in which the applicant has failed to overcome the objections raised in the initial report. It must also deal with all questions relating to the form of the application and the registrability of the trade-mark which have not been satisfactorily answered in the applicant's response.

Furthermore, when dealing with submissions in which an applicant points to a number of advertised and registered marks similar to the subject mark, the examiner must explain the perceived inconsistencies to some extent in the second action. See *Canadian Parking Equipment Ltd. v. Canada (Registrar of Trade Marks)* (1990), 34 C.P.R. (3d) 154.

Second actions will usually include a paragraph warning the applicant that only one further opportunity remains in which to overcome the Registrar's statutory objections. The applicant is again allowed four months to reply. An example of the "warning paragraph" appears below.

"You are further advised that this application may be refused under subsection 37(1) of the Act, if your next response does not overcome the aforesaid objection(s)."

If the applicant's second response succeeds in answering all objections to registration, the application will be accepted for advertisement. Acceptance for advertisement is considered to be the "disposal" of the application on the part of examiners.

The *Trade-marks Act* does not provide for intervention by third parties prior to advertisement. After advertisement, any interested person may intervene pursuant to the opposition procedure set out in the *Trade-marks Act* and the *Trade-marks Regulations*. The Office does not maintain a notice service. The responsibility for maintaining a watching brief on the application rests with the potential opponent. Therefore, any letter of intervention received by the Office prior to the advertisement will be returned to the sender.

V.12.1 Telephone Amendments

In certain cases it is more efficient to handle some issues by telephone. Issues which are controversial, such as changes to the statement of wares and services, the trade-mark itself, the date of first use, the basis of filing or the identity of the applicant, must be handled only with written authorization from the applicant/agent.

GUIDELINES:

- 1) Amendments which may be made by examiners without contacting the applicant/agent:
 - Changing the word "wares" to "services" or vice versa in the entitlement paragraph where it is obvious that an error was made.
 - Adding the phrase "and the applicant requests registration in respect of such wares or services."
 - Amending the identification of the trade-mark when there is no doubt that it is a word or a design (paragraph No. 2).
 - Crossing out the name of the former representative for service if a new one has been appointed.

2) Amendments which may be made following a telephone conversation without written confirmation:

- Inserting the date of first use or of making known when it has been forgotten in the revised application.

- Inserting the country of use when it has been forgotten in the revised application.

- Inserting the disclaimer when it has been forgotten in the revised application, but is mentioned in the covering letter.

- Deleting TM or ^R symbols from the drawing. Must not affect the quality of the drawing.

- Correcting spelling errors in statements of wares/services.

- Confirming that the applicant is a legal entity.

- Entering the serial number in priority claims.

3) Amendments which should always be authorized in writing in view of their controversial nature:

- Amending, adding or deleting the statement of wares/services.

- Amending, adding or deleting a disclaimer statement.

- Correcting a typographical error in the applicant's name.

- Changing the trade-mark.

- Adding the statement that the applicant "is satisfied that he is entitled to use the trade-mark in Canada" pursuant to paragraph 30(i).

V.12.2 Approval and Publication

Once a trade-mark application complies with all the formal requirements and any statutory objections have been overcome, the examiner will approve the mark for publication in the *Trade-marks Journal*. A pre-publication search will be conducted and if no co-pending confusing marks are located, the file will be transferred to the Publication Section. The particulars of the application will then be published in the *Trade-marks Journal*.

Pursuant to Rule 32(a), no changes to the trade-mark are permissible after the application appears in the *Journal*, as long as the particulars are published correctly. However, a trade-mark will be re-published if it is discovered, prior to allowance, that the Trade-marks Office made a clerical error in the original advertisement related to:

- a) the identity of the trade-mark,
- b) the statement of wares or services,
- c) the basis of filing.

Other types of clerical errors will continue to appear under the erratum heading in the *Journal*. Note that the Office no longer re-advertises a mark when an omission or inaccuracy occurs regarding a disclaimer statement. In such cases, the Office publishes an erratum instead. This decision was the result of a discussion held during the Joint Liaison Committee meeting of September 28, 1994.

A re-advertised trade-mark will be subject to the normal opposition period.

V.13 Letter of Refusal

If the examiners are not satisfied with the response to a warning in an action report and are not convinced the objection should be withdrawn, they will recommend to the Registrar that the application be refused. If the Registrar agrees, the applicant will be notified by letter to that effect.

The letter must be as explicit as possible so that the applicant is clearly aware of the reasoning behind the refusal decision. The letter must also draw attention to the provisions of section 56 of the Act, whereby the applicant may appeal the Registrar's decision to the Federal Court.

V.14 Third and Subsequent Actions

Circumstances sometimes arise during the prosecution of an application which interfere with its early disposal and necessitate further action reports. See the following examples.

V.14.1 Evidence Requirements

The point at issue may be a statutory bar to registration of the trade-mark, such as a 12(1)(a) or 12(1)(b) objection. The applicant may claim the benefits of section 14 or subsection 12(2). In either of these situations, actions outlining evidence requirements, and/or an evaluation of the evidence submitted may be issued.

V.14.2 Deletion of Wares or Services

The applicant's second response may be accompanied by a revised application in which specific wares or services have been deleted to overcome the likelihood of confusion with a registered or pending trade-mark cited by the examiner. Re-examination of the application for purposes of reaching a decision about confusion as defined in subsection 6(2) will be necessary, with the result that further actions may be issued.

V.14.3 Additional Information

The examiners may request further information on points raised in an applicant's argument, if they feel that circumstances warrant it. Such requests are issued in report form and are considered to be "further actions" by the examiners.

V.14.4 Clarification by Examiners

"Further actions" may also be necessary where it appears to the examiners that the applicant has not understood the nature of a requirement or the reasons for an objection to registration.

V.14.4.1 Further Objections under Section 16

"Further actions" may also be necessary when a newly filed application is confusing with a mark which has already been examined and which has not yet been published. In these cases the examiners must determine the entitled party and either raise an objection under section 16, or inform the applicant of the existence of the later-filed application. *See section III.8.4 of this manual.*

V.14.5 Notice Pursuant to Section 44 and/or Section 45

The applicant may request that a notice pursuant to the provisions of section 44 and/or section 45 be sent to the registered owner of a trade-mark with which the subject trade-mark is considered to be confusing. This may result in an extended processing period and will require re-examination and further action by the examiners.

V.14.6 Consent — Confusing Marks

In some instances the applicant may submit a "consent" from the registrant of the mark with which the applicant's mark is considered to be confusing. This document outlines the registrant's acceptance of the registrability of the mark which is the subject of the pending application. However, a simple statement of consent is, in itself, insufficient; the registrant must indicate that confusion has not or is not likely to occur. The Registrar will not normally give favourable consideration where the trade-marks involved are identical and/or where the wares or services covered by the trade-marks are overlapping. Where the statement of consent can satisfy some or all of the requirements as set out below, the applicant may be successful in overcoming the paragraph 12(1)(d) objection.

- 1) The wares or services should be sufficiently dissimilar so that they are not likely to travel through the same channels of trade in the marketplace. Therefore, if the wares or services are dissimilar, the fact should be emphasized in the consent form.
- 2) The consent should set forth that there would be no likelihood of confusion in the public mind as a result of the contemporaneous use of the trade-marks in the marketplace.
- 3) The consent should state that the parties will do everything in their power to avoid the possibility of confusion in the marketplace.
- 4) If the two trade-marks have co-existed over a period of time in the marketplace without any known instances of confusion, the consent should state this in order to support the conclusion that there would be no future likelihood of confusion.

V.15 Applicant's Failure to Reply

The applicant may fail to respond to an examiner's action at any time during the course of prosecution. If, at the end of the four-month period, no response has been received, the examiners' clerk will initiate abandonment proceedings as provided by section 36 of the Act. The application will be deemed abandoned if the applicant fails to remedy the default in prosecution within the time allowed in the section 36 notice.

V.16 Section 36 — Abandonment of Applications

Applications may be abandoned voluntarily, or as a result of failure to respond to the Registrar's notice under section 36. A section 36 notice will be issued in any case where an applicant fails to respond to an examiner's action, thereby interrupting continued prosecution of the application. The notice states that, in the opinion of the Registrar, the applicant is in default in the prosecution of the application by reason of his/her failure to respond to the examiner's communication and that unless the default is remedied within two months from the date of the notice, the application will be deemed abandoned.

V.17 Abandoned Files

When an application is deemed abandoned, the relevant file is stamped "Abandoned" on the file jacket cover and on the file copy of the final notice to the applicant, and is forwarded to the Trade-mark Search Room Section for transfer of the relevant index cards.

V.18 Transfer of Index Cards

The subject cards are removed from the pending trade-mark indexes and filed in the index of "abandoned trade-marks," and the applicant's name cards are transferred to the index of "abandoned applicants." The date on which the cards are transferred is stamped on the file jacket cover. This information is then entered in the database.

V.19 Officially Abandoned

The date the file cover is stamped "abandoned" is the official date of abandonment. A file will not be given any further consideration after it has been so stamped.

V.20 Time Extensions — Subsections 47(1) and (2)

Section 47 of the Act provides for time extensions under certain circumstances and at the discretion of the Registrar. A request for an extension under the provisions of subsection 47(1) may be made to the Registrar at any time before the deadline specified on the action.

The file will be reviewed and, if it is judged that the applicant's request is justified, the extension will be granted. If the deadline for responding to the action has passed, the applicant may similarly request an extension under the provisions of subsection 47(2) as long as such request is made before the file is stamped "abandoned" and if the applicant satisfies the Registrar that the failure to respond was not reasonably avoidable.

V.20.1 Time Extensions — Office Action and Section 36

A notice is added to each examiner's report stating that a full response is due within four months in order to avoid abandonment proceedings.

The Act does not fix time limits to reply to Office actions and to section 36 default notices and they do not fall under section 47. Therefore, no penalty fee is payable when an application is made after the expiry of one of these time limits. However, it is expected that requests for extensions will be made prior to expiry of the time limit involved unless there are strong extenuating circumstances.

The applicant's success in being granted the extension will depend on the applicant being able to clearly show that certain circumstances made it impossible to respond within the time set by the Registrar in the section 36 notice.

V.21 Effect of Abandoned Trade-mark Applications

While searching the index of abandoned trade-marks, examiners may come across some which could be confusing with pending applications. The examiners may consult the index for information of various sorts, but must remember that the abandoned applications are without status in the Trade-marks Office. They are therefore irrelevant with respect to entitlement to registration between rival applicants.

VI LIST OF CASES

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