



BRANDS UNDER ATTACK

Canadian Briefing Note for Brand Managers

ABOUT BRANDS UNDER ATTACK

Trade-mark opposition and cancellation proceedings in Canada can determine the fate of a brand. Businesses use these proceedings to attack each other and to gain entrance into or maintain a market position.

Brands Under Attack examines some common reasons why businesses and their brands fail or succeed in keeping their monopoly in the Canadian marketplace.

IN THIS ISSUE: A BRAND CAN BE CHEAP BUT NOT CLEARLY DESCRIPTIVE

Cheap Tickets and Travel Inc. had registered its trade-marks CHEAP TICKETS and CHEAP TICKETS AND TRAVEL for use in connection with its travel agency services.

Relying on its registered trade-marks, the company tried to force *Emall.ca* to hand over and stop using the domain name "cheaptickets.ca".

Emall.ca counter-attacked in the Federal Court with a cancellation proceeding. In *Emall.ca v Cheap Tickets & Travel Inc.*, *Emall.ca* succeeded in having the CHEAP TICKETS trade-marks struck from the trade-marks register.

Emall.ca succeeded because the words "cheap tickets" clearly describe the business of selling, of all things, cheap tickets.

This case illustrates a key business strategy brand owners and their marketing departments must keep in mind when selecting a brand name or thinking of engaging in brand warfare: The trade-mark cannot describe an inherent feature of the goods or services. If it does, the owner can end up losing it.

ABOUT OLLIP

Ollip is an intellectual property agency and technology law boutique. Our clients, successful companies and their counsel, turn to us for our expertise. As authors of the leading treatise: *Odutola on Canadian Trade-mark Practice: Vol. I Prosecution and Vol. II Opposition, Summary Cancellation and Appeals*, published by Carswell, a Thomson Reuters Business, our reputation is built on our clients, the Courts, the Trade-marks Office and peers alike relying on our work.

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