

# 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: **IMPROPER BRAND USE AND ITS CONSEQUENCES**

A recent *Nissan v BMW* Federal Court case illustrates key strategies businesses must keep in mind when engaging in brand warfare.

BMW sought to protect and enforce the mark M. However, in

Canada BMW had always used M3 and M5.

BMW lost because it failed to show any commercial activities which gave it rights to the letter M alone as a trade-mark.

BMW did not show use of M separately as a trade-mark from M3 or M5. Its activities did not fulfill the necessary requirements of “use” under Canadian law, namely that M unaccompanied by the numbers be associated with automobiles or automobile parts at the moment the goods were sold.

Although there was some evidence that the mark M had appeared in advertisements, promotional materials and owner’s manuals, this did not qualify as a trade-mark “use” because these materials had not been available to purchasers at the time of their purchases.

## 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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