

ABOUT BRANDS UNDER ATTACK

OLLIP | Intellectual Property
& Technology Law

ABOUT BRANDS UNDER ATTACK examines how Canada's accession to the *Madrid Protocol* in February 2019 will affect brand owners' ability to obtain or keep their monopoly in the Canadian marketplace.

— IN THIS ISSUE —

Madrid Protocol in Canada: WHY UNIFORMITY CAN KILL YOUR BRAND!

Every brand owner wants a uniform approach to describing its goods and services around the world. The *Madrid Protocol* helps make that happen. But under Canadian trademark practice, uniformity can cost you a registration.

The case of *Supershuttle International, Inc.* warns of this risk.

Supershuttle owned the registered trademark SUPERSHUTTLE in Canada for services described as "airport passenger ground transportation services".

In a summary cancellation proceeding, Supershuttle was required to show use of the trademark for services as registered. It was unable to do so. It lost its registration because the services which matched those of its U.S. registration, did not reflect what it was actually

doing in Canada - providing reservation services.

This case illustrates a fundamental lesson: the importance, when designating Canada, to describe the brand owner's activities in Canada, rather than relying on a home registration description. They must be activities that the brand owner can reasonably perform in Canada, even remotely.

With *Canada's accession* to the Madrid Protocol scheduled for February 2019, this is an increased concern. An applicant will be able to register its mark in Canada without using the mark in Canada. So an applicant's description of goods and services will become even more crucial to the registrability and enforceability of its brand.

In our next article, we will examine the increased challenges that brands who bear family names may face using the Madrid Protocol in Canada.

If you want further information regarding how to take a strategic approach with the Madrid Protocol and Canadian trademark practice, please contact me.

About Us

OLLIP P.C. is an intellectual property agency and law firm with offices in Ottawa and Toronto, Canada.

We are the authors of the leading treatise *Odutola on Canadian Trademark Practice: Vol. I Prosecution and Vol. II Opposition, Summary Cancellation and Appeals*, published by Carswell, a Thomson Reuters Business. This is the only publication, now in its 12th year, which provides strategies and practical advice for managing trademark applications in Canada. Trademark practitioners rely on our publication for solutions to the problems they encounter daily in their practice before the Canadian Trademarks Office.

With *our fixed fee approach*, for six years in a row we have responded to more Office Actions/Provisional Refusals for trademark owners who manage their own applications than any other firm in Canada.

Editors:

Karen Hansen
karen.hansen@ollip.com
Bayo Odutola
bayo.odutola@ollip.com

Foreign Department:

Frau Claudia Pietrulla
claudia.pietrulla@ollip.com

OLLIP P.C.

	OTTAWA	TORONTO
Tel.:	+ 613.238.1140	647.496.0313
Fax:	+ 613.238.5181	647.496.0315
Web:	www.ollip.com	

Disclaimer:

This briefing note is not legal or professional advice.