

# ABOUT BRANDS UNDER ATTACK

**OLLIP** | Intellectual Property  
& Technology Law

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

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## Madrid Protocol in Canada: CONFUSION & CONSENT - WILL ANYTHING CHANGE?

Every brand owner wants a uniform approach to protecting its marks around the world. The *Madrid Protocol* helps make that happen. But in Canada, unlike in many other jurisdictions, consent from the owner of a confusing mark will not overcome a confusion objection to registering a mark. That is the lesson from the Federal Court in *Holding Benjamin et Edmond de Rothschild v. Canada (Attorney General)*. In *Edmond de Rothschild*, the Court found the consent to be incomplete and therefore too vague and unspecific.

Under Canadian practice, confusion between trademarks will continue to be assessed by whether consumers perceive the trademarked goods or services to originate from the same legal entity whether or not the goods or services are in the same class.

A consent agreement cannot waive or preclude this assessment. Nor can the fact that the owners of the confusing marks are related by family or share ownership, since the companies are different legal entities.

However, a properly drafted consent or co-existence agreement will likely influence the confusion analysis if the Registrar or the Court is convinced by a detailed factual explanation in the consent of why consumers are unlikely to perceive that the trademarked goods or services originate from the same legal entity. This brings the confusion assessment back to consumer perception of the trading origin of the goods or services.

Alternatively, the confusion objection can be overcome by placing both confusing marks in the name of a special purpose legal entity. Agreements can be made to protect the interests of the parties. Having all confusing marks in the name of one legal entity, rather than in the names of several, strengthens the trademark rights against potential infringers.

By implementing specific strategies that acknowledge Canadian trademark law, a brand owner can obtain solid protection in Canada.

## 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 14th 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.

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