

ABOUT BRANDS UNDER ATTACK

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FEUDS OVER THE FAMILY NAME: WHEN YOUR NAME IS NO LONGER YOURS

"A person's name is to him or her the sweetest and most important sound in any language" So said Dale Carnegie. However, when used as a brand name, it can be bittersweet.

Over the next three issues, we will be looking at steps businesses with family names should take or avoid with the family brand. As these businesses mature and involve other family members, there are changes and inevitably disagreements.

The case of *Miranda v. Miranda* before the Federal Court of Appeal illustrates a key principle to bear in mind when establishing a family name as the brand for a business.

Background

Father and son battled over rights to the family name MIRANDA to identify their respective window and door installation businesses.

The son used MIRANDA as a trademark. Use of a trademark can result in rights which may form a basis to prevent competitors, including other family members, from using a similar or identical name to try to benefit from one's reputation. The son also registered the family name as a federal trademark, which gave him Canada-wide rights.

The father applied to the Court to have the son's trademark registration cancelled.

Lessons Learned

The son was able to keep his trademark rights. He succeeded because he showed that his business activities had caused the public to associate the word MIRANDA with products and services emanating from one particular source - his business - a cardinal requirement for claiming trademark rights in Canada. He had also taken the appropriate legal steps to preserve those rights for his company.

This case illustrates a key point which brand owners must keep in mind when selecting a family name as a brand: From the beginning, know how to use the brand as a trademark, so it is defensible in case a dispute should arise.

According to the *Rotman School of Management*, family businesses make up 60% of the Canadian GDP. With such a number and a tendency for founders to use their family name for their business, it is a matter of when and not if there is a brand dispute amongst family members.

For more information on this, please contact a member of our team at:
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This briefing note is not legal or professional advice.

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. Now in its 15th year, it is relied on by the Courts, the Trademarks Office and the trademark profession.

OLLIP P.C. has one of the few lawyers who have been certified by the Law Society of Ontario as dual specialists in trademark and copyright law.

From advice, creation to enforcement - from brands, technology to copyrights - for over 24 years, successful businesses and their counsel have relied on us.

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