

ABOUT BRANDS UNDER ATTACK

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FEUDS OVER FAMILY NAME: WHY SHARING IN THE FAMILY IS NOT GOOD (PART II)

The famous Canadian children's author Robert Munsch wrote "This is kindergarten! In kindergarten, we share! We share everything!" Families, like children in kindergarten, proudly share, share their names. However, sharing the family name as a brand with family members is the antithesis of branding.

In last month's issue as part of Brand Family Feuds series, we discussed the importance of ensuring that a family name adopted as a business brand be used in a way which makes it a brand. This month we look the case of CIBC v Stenner which illustrates another key issue family businesses must keep in mind when claiming a family name as a brand.

Background

Various family members used their family name STENNER as a brand to identify their respective financial services businesses. The father registered STENNER as a trademark.

The son succeeded in having the father's trademark registration cancelled. With the cancellation, the father lost the accompanying means to prevent others from using a conflicting trademark or trade name in Canada.

Lessons Learned

The father lost because the variation of the mark he was using did not support the registration. In addition, STENNER did not distinguish the father's financial services from STENNER branded financial services provided by other businesses, a cardinal requirement for maintaining trademark rights in Canada.

This case illustrates a key business strategy which family owned businesses must keep in mind when relying on a family name as a brand: To benefit from a family name as a brand, care must be taken to maintain the rights by proper ongoing usage and by defending those rights as necessary under trademark law. Otherwise, the mark can become available to anyone else to use.

For more information on this, please contact a member of our team at:
newsletter@ollip.com

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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.

Editors:
Karen Hansen
Bayo Odutola

 Certified Specialist
(Intellectual Property Law:
Trademark/Copyright)

OTTAWA
Tel.: +1 613.238.1140
Fax: +1 613.238.5181

TORONTO
Tel.: +1 647.496.0313
Fax: +1 647.496.0315
www.ollip.com

Foreign Department:
Frau Claudia Pietrulla
Tel.: +49 (0)8221.274.0097