

ABOUT BRANDS UNDER ATTACK

MARCH 2021

IN THIS ISSUE

Madrid Protocol in Canada:

DISTINCTIVENESS: BLIND DRUNK, LOSING IT & PROVISIONAL REFUSALS

The Beverage Industry Magazine recently reported 264% growth of online alcohol sales during the pandemic, giving the expression “hitting the bottle” a whole new dimension. In this and the next edition, we look at distinctiveness, how it is the Achilles heel of registrations and obstacle to Protocol Applications.

Background

Several parties battled over rights to the trademark DIAL-A-BOTTLE. However, Mr. Vardy owned the registered trademark DIAL-A-BOTTLE for delivery services, essentially alcohol order and delivery.

Mr. Vardy licensed businesses but did not monitor the character or quality of the services provided under the trademark. He lost his registration.

Lessons Learned

A trademark owner must control how its mark is used. Failure to do so will result in the same fate as the DIAL-A-BOTTLE trademark.

Widespread use by others defeats the principle under Canadian trademark law that a trademark must indicate a single source of goods or services. When a trade

mark does not indicate a single source, it is not distinctive.

Use by a licensee indicates a single source only if the trademark owner controls the character or quality of the goods or services which the licensee provides under the trademark.

This applies even if the licensee is a wholly-owned subsidiary of the trademark owner. A parent company and its related company are not considered to be a single source. And control over the “character or quality of the goods or services” is not presumed by that relationship.

The DIAL-A-BOTTLE decision illustrates the importance of distinctiveness and controlling the character or quality of the goods or services provided by others.

In the next edition, we will deal with non-distinctiveness in provisional refusals.

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

Disclaimer:
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 16th 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



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:
Claudia Pietrulla
Tel.: +49 (0)8221.274.0097