

ABOUT BRANDS UNDER ATTACK

IN THIS ISSUE

Madrid Protocol in Canada:

“SPIRITING AWAY” INTERNET EVIDENCE IN DISTINCTIVENESS OBJECTIONS

While much has been said about the “right to be forgotten”, when it comes to branding, it is the contrary. You want to be remembered. But it comes at a price. And for brand owners, the price is that Canadian trademark Examiners can now use even mention of your brand by a third party on the internet to support the distinctiveness refusal of a Protocol Application.

Background

In our last edition, we saw how Mr. Vardy lost his DIAL-A-BOTTLE trademark registration because he didn’t ensure his trademark indicated a single source - his trademark wasn’t distinctive. In this edition, we will deal with non-distinctiveness in Provisional Refusals, that is, obstacles during the application process.

Previously, a distinctiveness challenge could only be raised by third parties, and only in opposition proceedings against the application or in court after the trademark was registered.

Now, trademark applications are being examined for distinctiveness. If the DIAL-A-BOTTLE trademark were being examined, the Examiner would issue a Provisional Refusal based on “internet advertisements” and “Yellow Pages ads and

websites showing several other Dial a Bottle businesses”.

Lessons Learned: How to overcome distinctiveness objections

This is new territory for Canadian trademark Examiners, and responding to non-distinctiveness objections is new territory for applicants.

However, unlike the test in opposition proceedings, to overcome a distinctiveness Provisional Refusal, all the applicant must do is create doubt as to the reliability of the Examiner’s evidence.

This can be done in multiple ways from explaining that the third-party use is licensed use, or illegal use that the applicant is taking steps to stop such as sending out cease and desist letters and/or demanding that internet advertisements be removed. Unlike opposition or court proceedings, the bar to overcome is low. While these steps did not save Mr. Vardy’s DIAL-A-BOTTLE trademark, because he did so selectively, they may be sufficient to overcome a distinctiveness Provisional Refusal before an Examiner.

The DIAL-A-BOTTLE decision illustrates the importance of how evidencing steps taken to protect one’s brand, even if unsuccessful, can help overcome a distinctiveness Provisional Refusal.

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