

A “Sense-ible” Approach to Non-Traditional Trade Marks

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May 2005**

First published in the May 13, 2005 issue of Lawyers Weekly.

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The Canadian Intellectual Property Office (“CIPO”) has published proposals to “modernize” the *Trade-marks Act and Regulations*, and in this context has invited comment on issues surrounding the protectibility of sound, moving-images, holograms, scent, taste and colour *per se* as trade-marks.

To date, CIPO has been reluctant to extend protection to many types of non-traditional trade-marks. However, the recent proposal signals a recognition that sound and other non-traditional indicia comprise a critical component of modern branding strategies, and a willingness on the part of CIPO to consider extending statutory protection to additional forms of “non-traditional” trade-marks in Canada.

I would argue that the statutory definition of “trade-mark” in Canadian legislation is broad enough to encompass non-traditional trade-marks and that existing statutory and regulatory provisions and common law principles relating to inherent and acquired distinctiveness would suffice to ensure that only those non-traditional trade-marks that meet the essential requirements of trade-marks are monopolized through registration.

For example, one of the current hurdles to the registration of non-traditional trade-marks is presented by CIPO’s position that a trade-mark must be capable of being seen. However, this position is largely based on the 1987 “Playboy” decision of the Federal Court (*Playboy Enterprises Inc. v. Germain* [1987] F.C.J. No. 616), which adopted an antiquated definition of the word “mark” dating back to 1931.

Another difficulty faced by owners of non-traditional trade-marks in Canada is to show that the marks are capable of meeting the use requirements found in section 4. With some non-traditional trade-marks (e.g., sound, scent or moving-image marks), the consumer may only be exposed to the mark after the time of purchase. However, relying on jurisprudence dealing with the use of computer software marks, it is arguable that even if a non-traditional trade-mark is experienced by a consumer post-purchase (e.g. that a sound mark is heard, a scent mark is smelled, or an animated mark is seen), this still qualifies as use if consumers have come to associate the mark with the wares through in-store demonstrations or displays, and/or the identification of the marks on packaging or in advertising via written descriptions or pictorial representations.

Similarly, the application of existing rules relating to distinctiveness would ensure that only those non-traditional trade-marks truly capable of distinguishing wares or services could be registered. For example, if a non-traditional mark were considered to describe a characteristic of a ware or service, an objection under section 12(1)(b) could be raised. In order to overcome such an objection, the applicant would be required to show acquired distinctiveness under section 12(2) (or section 14 for foreign applicants). Alternatively, if a non-traditional trade-mark were considered to be primarily utilitarian or ornamental, an objection based on functionality could be raised. In order to overcome such an objection, the applicant could show that at the time of application, a significant portion of the relevant Canadian consuming public recognized the non-traditional trade-mark as a signifier of source and therefore that it could not be said to be “primarily” functional.

CIPO has recognized that it can be a challenge to accurately describe and depict non-traditional trade-marks in a way that allows them to be suitably indexed for searching. I believe that a flexible interpretation of existing statutory and regulatory provisions would suffice, but I acknowledge that some minor statutory and regulatory changes could be made to expressly address technical filing requirements for non-traditional trade-marks. For example, section 30(h) could be amended to expressly require a drawing only for trade-marks that can be depicted visually, and to expressly allow for written descriptions. Also, the regulations could be amended to expressly allow specimens to form part of the application.

In considering the issues raised by CIPO, it is helpful to consider the treatment of non-traditional trade-marks in other jurisdictions. For example, in the United States, there is little in the legislation that expressly bears on the registration of sounds, smells and other non-traditional trade-marks. However, the United States Patent & Trademark (“USPTO”) Rules of Procedure allow marks that are “not used or printed in written form” to be registered, and permit the submission of a “non-drawing” page if a mark cannot be represented visually. Significantly, more than 30 years ago, the United States recognized that the concept of a trade-mark is one that is constantly evolving, and that it should not be confined to marks having a graphic form. Due to this flexible approach, owners of unique sound and scent marks have been able to register their marks in the United States on the federal Principal Register. Examples include the MGM lion roar (U.S. Reg. No. 1395550), and the Twentieth Century Fox animated “spotlight” registration (U.S. Reg. No. 1928424). These and other U.S. registrations of non-traditional trade-marks offer guidance as to how sound and moving-images and other non-traditional trade-marks can be adequately described and depicted for indexing and searching purposes in Canada.

CIPO’s current trade-mark law modernization initiative signals Canada’s willingness to extend statutory protection to additional forms of “non-traditional” trade-marks. Canadian trade-mark practitioners and rights holders should take this opportunity to actively participate in the development of a “sense-ible” statutory and regulatory framework to govern the registration of such marks in Canada.