



Non-Traditional Trademarks - Canada

October 2017
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PERRY + CURRIER | PATENT & TRADEMARK AGENTS
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Canadian Trade-marks Act

Canadian Trademarks Act Revised~ mid-2019

Major changes:

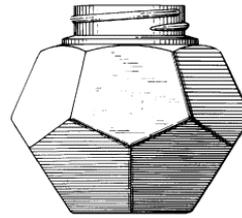
- Madrid Protocol (no use claims, Nice)
- overhaul non-traditional marks

Current Examination:

- Rebuttable presumption is if a 3-D mark then the mark is examined as a distinguishing guise (DG)
 - DG is defined as type of mark and relates to shaping of goods, containers or to modes of wrapping/packaging
 - Akin to trade dress in the US, getup



Distinguishing Guise - NOW



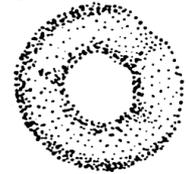
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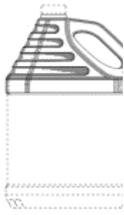
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Current DG Requirements

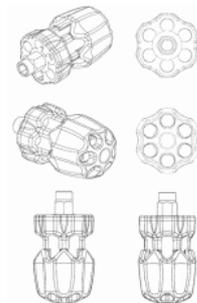
- Distinctive at filing date (secondary meaning)
- Not unreasonably limit development of any art or industry
- Not purely or primarily functional (? aesthetically functional?) e.g. LEGO bricks
- High threshold set – 612 (inactive) : 476 (active)



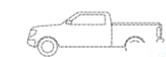
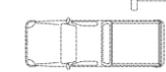
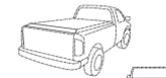
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Distinguishing Guise Existing Registrations



Example Fields of Frequently Sought DG Protection

- Bottles/containers
- Candy/food
- Electronic devices
- Hardware-type items

Scope of Protection and Enforcement value not always clear



Distinguishing Guise Pending Applications



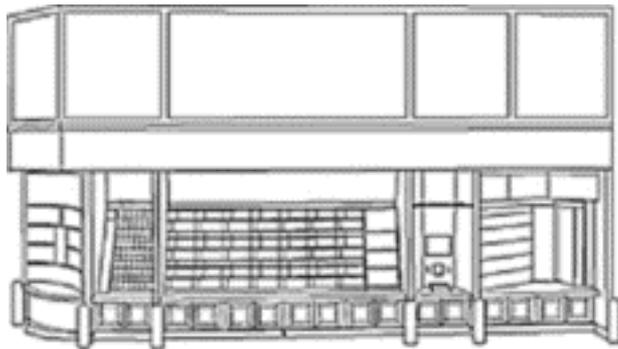
CROC SHOES



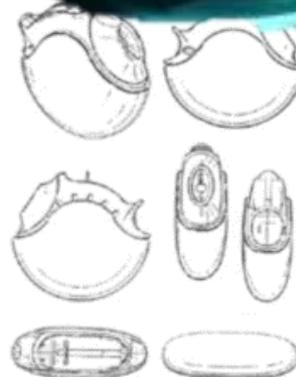
Samsung's EDGE



WOBBLEBONG



Home Depot Paint Center



SERETIDE Inhaler



RINGPOP



True 3-D marks (NOW)



- Cannot be the goods themselves or a portion of the goods



CanadaYes

US NO

Colour Applied to Surface (NOW)

Smith Kline & French Canada Ltd. v. Registrar of Trade-Marks (1987) 2 F.C. 633

Mr. Justice Strayer, as he then was, stated:

It appears to me as a general principle manufacturers and traders ought to have the greatest freedom possible in choosing trade marks, provided that they are distinctive in identifying the product with the supplier and do not infringe on the trade marks of others. The Trade Marks Act nowhere excludes colour as a trade mark and subsection 32(3) of the Trade Marks Regulations [C.R.C., c. 1559] contemplates colour being claimed as a “feature” of a trade mark. While distinctiveness, an issue which is not before me here, will always be an important hurdle for an applicant to overcome in obtaining registration of a trade mark which relies heavily on colour, I would find it difficult to hold that such a trade mark could never be registrable.

Colour Applied to Surface (NOW)

- Applied to whole or part
- No requirement to prove distinctiveness at time of examination
- Easy to prosecute through examination
- Unless pharma product usually not opposed



Metalworking fluid



Plumbing pipe



Colour Applied to Surface (NOW)

- Most case law arises from pharma cases
- Inherent distinctiveness frequently lower than in other fields
- Registration almost always refused for tablets and other pharmaceutical products
- Jurisprudence not well developed outside the pharmaceutical field
- Dearth of commentary on the interplay between inherent distinctiveness and acquired distinctiveness
- Is the bar, established in the pharma cases, set too high for more inherently distinctive marks?

Colour/ trade dress/ 3-D Post Legislative Change

- All non-traditional marks will be examined for distinctiveness
 - i.e. as distinguishing guises are now
- Confluence of a generally high threshold established by Examination Section and significant body on jurisprudence in field of pharmaceuticals
- Tough examination expected
- Targeted evidence? Market share? Surveys?

Sound Marks



BMW

- Roaring Lion first true sound mark to be registered
- Epic 20 year battle ended in 2012
- Agreed early in proceedings to narrow the issues to point whether the spectrogram drawing (and later a digital recording) was deemed an insufficient representation of the mark
- Evidence and factum focused on the broad meaning that could be ascribed to “drawing”
- After Memo of Fact and Law was received, CIPO revised policies to accept sound marks

MAC START UP CHIME



MAC start up chime



Intel Corporation

Marks of the Future

- Age old pattern of bricks and mortar retail establishments altered
- 51% of Americans now prefer to shop on-line (67% of millenials)
- 1.4 billion people have purchased goods or services on-line (Ecommerce Foundation)
- In 2014 e-commerce was 8.2% of retail sales in Asia-Pac, 6.7% in Western Europe and 6.3 in North America. Forecasts for 2018 are for 18%, 10% and 9% (Forbes)

Marks of the Future

- Electronic interface allows for more diverse signs to distinguish-
motion, sound
- Online and sometimes in store it's about the “interactive
experience”
 - Cado Crusher – Chipotle Mexican Grill for free chips and quac
 - TOMS Virtual Giving Trip
 - Amazon giving savings codes via SnapChat



Marks of the Future?

- IoT network of connectivity means your devices directly communicate with the world via the Internet
- Sell not just products but solutions
 - Amazon Dash buttons and Dash wand
 - Himirror
 - GeniCan
 - Panasonic's SMART TABLE for heating, cooling, reading, calls, charging
 - Fenotek smart doorbell face recognition
 - Hair Coach brush with mic, accelerometer and gyroscope
 - Mimo wearable baby monitor



Practice “Take-Aways” from this Presentation

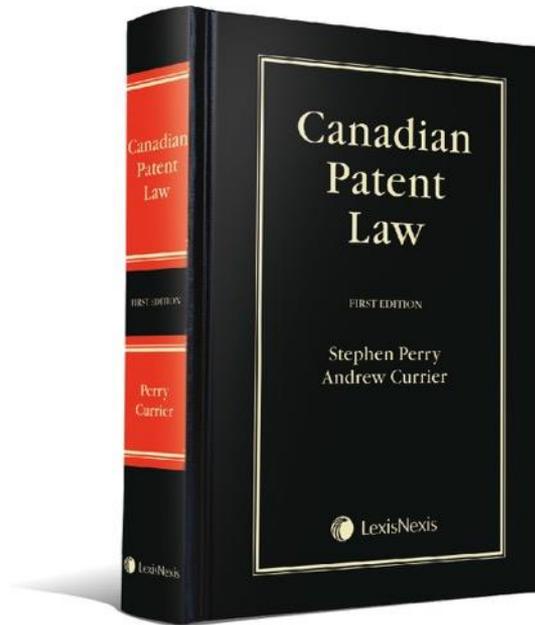
- Colour mark (not pharma) -APPLY NOW
- Sound marks – APPLY NOW distinctiveness might be raised in the future exam
- Precision is your friend - narrower protection is more enforceable
- Monitor, 3-d especially in popular fields (e.g. hardware)
 - Opposition less expensive than litigation to invalidate
- Properly obtained 3-d marks are great enforcement tools against counterfeit
- Think beyond traditional for new products associated with IoT
- Remember fundamental question DOES THE mark distinguish (Mr. Justice Strayer got it RIGHT!)
- If it distinguishes – could well be registrable in Canada

Thank you for listening!



Coleen Morrison

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Patent Law in Canada?

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Cited by the Supreme Court of Canada. See *Teva Canada Ltd. v. Pfizer Canada Inc*
<http://bit.ly/1gUGgsg>

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