

June / July 2000 • Vol. 14 no 3 • \$ 1.00

Practical Information On Corporate And Trade-mark Matters

The Internet Symbols "www", ".com" et ".ca" Are they Registrable as Trade-marks ? ⁽¹⁾

This article deals only with the position of the Trade-marks Office during the examination of an application for registration of a trade-mark.

General Principale

The symbols ".com", "www" and "@" are well known as belonging to the Internet and are consequently inherently weak. This does not however prevent registration of a trade-mark made up of one or more of these symbols. It is essentially a matter of context. If the

examiner concludes that the mark is "descriptive" within the meaning of Section 12(1)b) of the Trade-marks Act, it will be rejected ⁽²⁾. In arriving at such a conclusion, it is important for the examiner to consider the trade-mark in its totality, and with regard to the first impression of an average consumer in association with the related wares or services ⁽³⁾.

This is in essence the explanation given in the Trade-mark Office Practice Notice of

September 1st, 1999. Said Notice deals specifically with the examination process of trade-marks containing the expressions ".com", ".ca", ".fr", ".uk" or "us". It tells us that the addition of one of these terms to a clearly descriptive mark will not make it registrable. Regrettably, no mention is made of the symbols "@" or "www". It seems however, that the Trade-marks Office is trying to apply the same guidelines for these 2 symbols.

The addition of an internet symbol to a trade-mark which is otherwise registrable pursuant to Section 12(1)b) of the T.M.A., will generally not alter the mark's registrability. However, a condition may apply: that of filing a disclaimer.

Producing a Disclaimer

A disclaimer consists in the renunciation to the exclusive use of a portion of the applied for mark by its owner. Disclaimers are mostly used when a portion of the mark is considered descriptive of the associated wares or services.

Example of the principle: the trade-mark PIZZA PIZZA is registered in association with, inter alia, pizzas. A disclaimer for the word PIZZA was produced. However, if the mark had been associated with "operating an

cont'd on page 2

NEW SERVICE



CERTIFICATES OF COMPLIANCE AVAILABLE IN COLOUR!

The federal authorities have decided to issue Certificates of Compliance in black and white. In order to meet the need for visually distinctive certificates, CRAC can now quickly produce them in colour.

However, we have noted that the format used by Industry Canada is cause for some concern, particularly as regards the relative easiness with which one can tamper with the certificate once it is downloaded. To address this issue, CRAC will issue a Certificate of Authenticity™ with every Certificate of Compliance obtained electronically to confirm that it constitutes the original as issued by Industry Canada.

For further information, please contact Mr. Pierre Y. Marchand (extension 355 or e-mail at pmarchand@crac.com).



Turnaround Schedule for Following Services as of June 1st, 2000

SERVICES	PROVINCIAL	FEDERAL
TaxExpress™ (GST / QST / QDAS)	5 to 10 days	—
Name Search Report and Reservation	*5 to 6 days	24 hours
Certificate of Incorporation	*3 to 4 days	2 days
Certificate of Amendment	*3 to 4 days	2 days
Certificate of Continuation, of Continuance or of Amalgamation	*1 to 2 weeks	3 to 6 days
Certificate of Dissolution	2 to 3 weeks	2 to 3 days
Notice of Change (Federal) or Amending Declaration (Quebec)	2 to 3 weeks	2 days
Letters Patent for Non-Profit Corporations	*1 to 2 weeks	20 days
Attestation / Certificate of Good Standing or of Compliance	*24 hours	48 hours
Revival	—	3 to 6 days
Initial Declaration	1 to 2 weeks	—
Registration Declaration	*5 to 6 weeks	—
Annual Declaration	*4 weeks	—
Revocation of Striking-Off (s. 54 Legal Publicity Act)	*1 to 2 weeks	—

The delay may vary slightly according to each file () = Priority service available.*

The Internet Symbols "www", ".com" and ".ca" (cont'd)

art school for adolescents", no disclaimer would have been required, the word PIZZA being in no way descriptive of the services rendered. The practical consequences of the above are as follows: competing traders are not prevented from using the word PIZZA for selling pizzas, but would be prevented from using it to promote or operate an art school.

A few examples of how disclaimers are used appear on page 3. What we have observed is that since publication of the Practice Notice, there is greater consistency in the decisions rendered at the examination stage, although there is still room for improvement.

Conclusion

Trade-marks made up of symbols made famous through the Internet are registrable. They must however, comply with the rules governing descriptive marks and for this reason are generally the object of disclaimer requirements. Although consistency in decisions rendered has improved, these rules are still quite new. Future court decisions (Federal Court and Opposition Board) may therefore, impose adjustments to the current Practice. Much like anything related to the Internet, this subject is worth monitoring.

cont'd on page 3

A Word of Thought...

**"Love your enemies.
It will drive them nuts."**

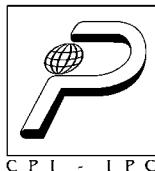
Eleonor Doan

**To find out the current
turnaround times
for corporate
services, consult
our web site's
"what's new"
section**

www.crac.com

The Internet Symbols "www", ".com" and ".ca" (cont'd)

- (1) This article is a follow-up of a previous one concerning corporate names which appeared in our Edition of last April (Vol. 14, No. 2);
- (2) Actually, the rules governing descriptiveness are quite complex, the scope of which is too broad to be covered here. We can however refer to the definition provided for in Section 12(1)b) of the *Trade-marks Act*: 12. (1) Subject to section 13, a trade-mark is registrable if it is not (...) (b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;
- (3) *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978), 40 C.P.R. (2d) 25; et *Mitel Corporation v. Registrar of Trade Marks* (1984), 79 C.P.R. (2d) 202.



CENTRE DE PROPRIÉTÉ
INTELLECTUELLE
INTELLECTUAL
PROPERTY CENTRE

CPI - IPC

A FEW EXAMPLES

The following examples were taken from the Trade-marks Journal. Though they do not set precedent, they do provide some insight as to how the Trade-marks Office is applying current policies.

WWW.GMCANADA.COM – Mark registered in association with, inter alia, the sale of motor vehicles and parts thereof via internet. A disclaimer was filed for "www" and ".com".

WWW.BRANCHÉ.COM – Mark registered in association with children's outerwear. No disclaimer.

BEYOND DOT COM – Mark approved for advertisement. Associated with, inter alia, online retail services for computer software and hardware products. Disclaimer filed for "dot com".

BOYS.COM / GIRLS.COM / BABIES.COM – Marks approved for publication in association with wares of clothing. The words "boys, girls, babies" were disclaimed. Said marks would probably have been refused for services covering the sale of clothing via a web site.

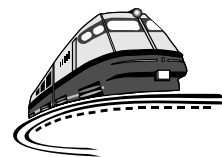
WWW.JONESSODA.COM – Mark registered in association with non-alcoholic beverages and the operation of a web site for the sale of said beverages. The symbols "www" and ".com" were disclaimed. It may have been possible to limit the disclaimer to services.

ESSO.CA – Mark registered in association with internet services (...) in the field of petroleum products and energy. Disclaimer for ".ca".

@MOSPHERE – Mark allowed in association with hair care products and bath soaps. No disclaimer required for "@".

@CANADA – Mark allowed (recently abandoned for other reasons) in association with, inter alia, the service of providing high speed access to internet and other sources. Only a disclaimer for CANADA was required.

Order our TAXEXPRESS™ Service (GST, QST and DAS numbers) with your incorporation!



This service allows you to meet a crucial requirement for your client at the time of incorporating a new company.

The TAXEXPRESS™ service saves you the trouble of getting the GST, QST and the Deductions at Source numbers. All that you have to do is send us, along with your Articles of Incorporation, our questionnaire duly completed and signed. Once the numbers are issued, we promptly fax them to you.

Service fee: \$ 47 (including taxes).

For more information, please contact Ms. Franca Sucapane (ext. 328).