

ABANDONMENT OF A REGISTERED TRADEMARK WITH RESPECT TO A DESIGN VARIANT

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Under Canadian Trade-Mark Law, a registered trademark may be expunged on application by any interested party who demonstrates that the trade-mark has been abandoned by its owner. This principle applies whether the trade-mark consists of a word-mark or a design-mark.

Generally speaking, in examining whether abandonment of a trade-mark has occurred, the court must satisfy itself that the mark is no longer in use in Canada and that the intention of the owner of the mark is to abandon it.

In this essay, we will discuss a recent jurisprudential development with respect to abandonment when it occurs as a result of the employment of a *wariant* of a registered mark as opposed to its abandonment purely and simply.

The Promafil Case. In the case of *Promafil Canada Ltée v. Munsingwear Inc.* (T-328-88, February 7th, 1990),¹ the Federal Court of Canada was again given the opportunity to consider to what extent and to what degree the owner of a registered trade-mark may employ a variant of the said mark and still be said to be using the registered trade-mark.

As we shall see, a variant of a registered trade-mark will constitute use of the mark as long as the variant does not consist of an overly radical departure from the registered mark. One of the interesting aspects of the *Promafil* case

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¹The case is presently on appeal. However, it serves as an excellent example of the manner in which the courts will invariably treat this question. Furthermore, the whole question could have been avoided, and the appeal would have been unnecessary had the Respondent registered its new mark as mentioned in our conclusion.

is the fact that the Court had before it an application for the expungement of a *design* mark, as opposed to a mark containing only words. Also, the designs under scrutiny by the Court did not necessarily differ in an obvious way.

Facts Before the Court. In the *Promafil* case, the Applicant sought the expungement of a registered design mark referred to as the slim penguin. This design had not been used by Munsingwear Inc. or any registered users since 1982.

On the other hand a "corpulent penguin" designmark had been used before and after the date the Respondent stopped using the "slim penguin" design.

Both designs consist of penguins with their heads turned to the right. Evidently the "corpulent penguin" is wider but only slightly taller than the Uslim penguin. The "corpulent penguin's" tuxedo is drawn with a little more detail and its bow tie is more evident. The "corpulent penguin" also has a more oval head, a finer beak, and better designed arms and feet.

The "slim penguin" design was embroidered on the front, or sleeves of men's sport shirts from 1957 to 1982. After 1982, only the "corpulent penguin" was used in connection with men's sport shirts.

The Court was asked to decide whether the use of the "corpulent penguin" on shirts after 1982, constituted a use of the registered "slim penguin" design in accordance with the *Trade-Mark Act*. If this constituted use, then there would be no case of abandonment. The answer to this question, however, will always depend on the extent to which deviation of a mark can occur and still be considered use of the registered mark.

Principles Invoked. In the *Promafil* case, the Honourable Justice Barbara Reed considered the principles enunciated in a well-established line of jurisprudence on the question. A summary of the principles considered by her may be set forth as follows:

- a) a mark will be considered to be in use when the deviation is not substantial, especially when essential features of the mark as registered are retained in the mark as used;
- b) a mark will be considered to be in use when the deviation does not touch on one of the dominant features of the mark as registered;
- c) a mark will be considered to be in use when the Court concludes that the mark in its deviant form would not have deceived any person who would come across it; and

d) a mark will be considered to be in use when only insignificant features are added to it.

Analysis and Distinctions Made by the Court. The Honourable Justice Reed chose, however, to distinguish the foregoing jurisprudence on the basis that the cases in question dealt with marks which contained only words. She stated that in such cases the Court will focus on the meaning of the words conveyed.

On the contrary, in the *Promafil* case, the Honourable Judge found that when a design mark is under scrutiny no commonality of focus exists. In such cases, the Court must determine not only whether the difference is one of several features, but must also look at the visual impact of the designs examined.

According to the Honourable Justice, once this analysis is carried out, the Court must apply the test of the unaware purchaser which was summarized as follows in the case of the *Registrar of Trademarks v. Compagnie internationale pour l'informatique Honeywell Bull société anonyme* (1985), 4 C.P.R. (3d) 523 (F.C.A.):

"The practical test to be applied in order to resolve a case of this nature is to compare the trade-mark as it is registered with the trade-mark as it is used and determine whether the differences between these two (2) marks are so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin."

Conclusion. Evidently, *Promafil* is not the only judgement ever rendered on the question of the variation of a design mark. However, this decision serves as a clear warning to owners of registered trade-marks who wish, for whatever reasons, to use a variant of their registered trademark without seeing to the registration of the new version of the mark.

It should also be noted that the Respondent in the *Promafil* case argued without success that the development of the "corpulent penguin" evolved as a result of an improvement over the years of embroidery techniques. The Honourable Justice further dismissed an argument to the effect that the "corpulent penguin" was merely a development or evolution of the "slim penguin".

The decision in *Promafil* makes it clear then that when in doubt about the variant of a registered trademark, however slight it may appear upon casual

scrutiny, the owner is well advised to see to the registration of the variant in a timely manner.

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