



THE BATTLE FOR THE RIGHT TO USE THE TRADE-MARK “FUCK CANCER” IN CANADA

STELLA SYRIANOS^{*}
ROBIC, LLP
LAWYERS, PATENT & TRADEMARK AGENTS

In a recent case involving a dispute between cancer fundraising organisations, the Federal Court of Canada dismissed an application for judicial review of a TMOB decision (Trade-marks Opposition Board) after declining to consider an argument raised for the first time by the applicant on judicial review. In an interesting twist of events, the applicant did not take issue with the Opposition Board’s finding of confusion between her trade-mark F CANCER & design and the opponent’s unregistered marks “F CANCER”, F*CANCER and F---CANCER. Instead, the applicant invited the Court to consider her argument that the Opposition Board erred in recognising the opponent’s common law rights to marks using the word “FUCK” which is obscene and therefore prohibited by the Canadian *Trade-marks Act* (*Yael Cohen v. Susan Fiedler Incorporated*, 2014 FC 967, Mactavish, J. October 14, 2014).

Facts

Following her battle with non-Hodgkins lymphoma, the respondent Ms. Fiedler began making bracelets in May 2008 inscribed with the slogan FUCK CANCER and variants thereof. She used a portion of the profits to fundraise for charitable cancer organisations. Her cancer awareness and fundraising efforts had garnered media attention and with the support of celebrity ambassadors such as Sarah McLaughlin and the Barenaked Ladies, she had raised over \$100,000 for cancer related charities.

On March 8, 2010 the applicant, Ms. Yael Cohen, filed an application for the following trade mark:



The trade-mark F CANCER & design was filed on the basis of use since September 28, 2009 in association with t-shirts and the operation of a charitable foundation concerned with the detection and prevention of cancer. Ms. Yael’s inspiration was her

© CIPS, 2014.

^{*}Lawyer, Stella Syrianos is a member of ROBIC, LLP, a multidisciplinary firm of lawyers, patent and trademark agents. Published at (2014) 28:12 World Intellectual Property Report. Publication 142.286.

ROBIC, LLP
www.robic.ca
info@robic.com

MONTREAL
1001 Square-Victoria - Bloc E - 8th Floor
Montreal, Quebec, Canada H2Z 2B7
Tel.: +1 514 987-6242 Fax: +1 514 845-7874

QUEBEC
2828 Laurier Boulevard, Tower 1, Suite 925
Quebec, Quebec, Canada G1V 0B9
Tel.: +1 418 653-1888 Fax.: +1 418 653-0006

mother who was battling breast cancer. Profits from the sale of t-shirts which bear the mark F CANCER & design were donated to the applicant's charitable foundations.

TMOB decision

The applicant argued that Ms. Fiedler's use of the F CANCER expression did not amount to trade-mark use but merely a slogan that was not a source identifier. The TMOB rejected the applicant's submissions. While the F CANCER marks communicate a message of standing up to cancer with a sort of rally cry, this did not preclude the marks from also serving as source identifiers. Having decided the opponent used its marks as trade-marks, the TMOB proceeded to assess the criteria for confusion.

The TMOB stated that the opponent had established prior rights in Canada, the parties' marks shared a significant degree of similarity in sound, appearance and ideas suggested, the parties' services were identical and their goods were both personal items relating to fashion. Therefore, the TMOB refused the F CANCER & design application on grounds of confusion.

Judicial review of the TMOB decision before the Federal Court

In its application for judicial review, the applicant's grounds for raised a new issue: that the opponent had no enforceable common law rights to marks using the word "FUCK" which are prohibited by the Canadian *Trade-marks Act*. In that regard, paragraph 9(1)(j) of Canada's *Trade-marks Act* bars the registration of trademarks that are considered "scandalous, obscene or immoral".

There is scarcely any case law in Canada that touches on the interpretation of the "scandalous, obscene or immoral" bar to registration. However, this issue was not debated because the Court refused to consider the applicant's section 9 argument on the ground that it raised a new question that should have been raised before the TMOB, the expert tribunal charged by Parliament with the authority to decide on such issues. In so doing, the Court acted well within its discretion since a party does not have the right to require the Court to consider an argument raised for the first time on judicial review.

As for the applicant's position before the Federal Court, it appears to be somewhat counter-intuitive: had the Court sided with the section 9 argument, it would have been fatal to her own application for registration of the mark F CANCER & design. However, by seeking an order from the Court that recognized the phrase "FUCK CANCER" and variations thereof are prohibited marks to which no one may claim enforceable rights, whether registered or unregistered, the applicant sought to secure her right to freely continue to use her F CANCER & design trade-mark. The collateral purpose of her application had not flown under the Court's radar.

Noteworthy, the Court underlined that its refusal to entertain Ms. Cohen's new argument would not grant the opponent enforceable trade-mark rights to which it was not otherwise lawfully entitled. The Court also mentioned the even if paragraph 9(1)(j) of the *Trade-marks Act* does potentially call into question the enforceability of the opponent's 'FUCK CANCER' mark, it does not necessarily follow that its 'F CANCER', 'F* CANCER', and 'F--- CANCER' marks are also unenforceable.

In its final comments, the Court noted that had it accepted the applicant's section 9 argument, it would have led to the conclusion that her own F CANCER & design mark was not registrable.

The Court therefore agreed with the opponent that for the applicant to argue that the trade-mark she herself applied to register is scandalous, obscene and/or immoral only *after* she had been unsuccessful in the opposition proceedings justified an elevated award of costs of \$5,000.

Conclusion

This case serves as a worthy reminder of the deference accorded by the Courts to administrative tribunals entrusted with the determination of particular issues, especially in cases where new issues are raised for the first time before the Courts in absence of valid reasons. By the same token, it also indirectly raises interesting questions as to the enforceability of marks which may be considered offensive. Clarification on these questions may not be forthcoming as Ms. Fiedler reportedly lacks funds to enforce her trade-mark. To the best of the author's knowledge, the parties have yet to find a way to settle their issues which seems disheartening for two cancer fundraising organisations.



Pour des services de conseils dans le domaine de la propriété intellectuelle et des technologies de l'information et des communications (incluant les services d'agents de brevets et de marques de commerce) de même que des services juridiques.

ROBIC, un groupe d'avocats et d'agents de brevets et de marques de commerce voué depuis 1892 à la protection et à la valorisation de la propriété intellectuelle dans tous les domaines: brevets, dessins industriels et modèles utilitaires; marques de commerce, marques de certification et appellations d'origine; droits d'auteur, propriété littéraire et artistique, droits voisins et de l'artiste interprète; informatique, logiciels et circuits intégrés; biotechnologies, pharmaceutiques et obtentions végétales; secrets de commerce, know-how et concurrence; licences, franchises et transferts de technologies; commerce électronique, distribution et droit des affaires; marquage, publicité et étiquetage; poursuite, litige et arbitrage; vérification diligente et audit. ROBIC, a group of lawyers and of patent and trademark agents dedicated since 1892 to the protection and the valorization of all fields of intellectual property: patents, industrial designs and utility patents; trademarks, certification marks and indications of origin; copyright and entertainment law, artists and performers, neighbouring rights; computer, software and integrated circuits; biotechnologies, pharmaceuticals and plant breeders; trade secrets, know-how, competition and anti-trust; licensing, franchising and technology transfers; e-commerce, distribution and business law; marketing, publicity and labelling; prosecution litigation and arbitration; due diligence. ®/MD

COPYRIGHTER ^{TM/MC}

IDEAS LIVE HERE ^{®/MD}

IL A TOUT DE MÊME FALLU L'INVENTER! ^{®/MD}

LA MAÎTRISE DES INTANGIBLES ^{®/MD}

LEGER ROBIC RICHARD ^{®/MD}

NOS FENÊTRES GRANDES OUVERTES SUR LE MONDE DES AFFAIRES ^{®/MD}

PATENTER ^{®/MD}



ROBIC, LLP
www.robic.ca
info@robic.com

MONTREAL
1001 Square-Victoria - Bloc E - 8th Floor
Montreal, Quebec, Canada H2Z 2B7
Tel.: +1 514 987-6242 Fax: +1 514 845-7874

QUEBEC
2828 Laurier Boulevard, Tower 1, Suite 925
Quebec, Quebec, Canada G1V 0B9
Tel.: +1 418 653-1888 Fax.: +1 418 653-0006

ou «R» ^{®/MD} stylisé

ROBIC^{®/MD}

ROBIC +
+
+
+

Ou stylisé ROBIC ++++ ^{®/MD} stylisé

ROBIC + DROIT
+ AFFAIRES
+ SCIENCES
+ ARTS

ou ROBIC + DROIT +AFFAIRES +SCIENCES +ARTS^{®/MD} stylisé

ROBIC + LAW
+ BUSINESS
+ SCIENCE
+ ART

ou ROBIC +LAW +BUSINESS +SCIENCE +ART^{®/MD} stylisé

THE TRADEMARKER GROUP ^{TM/MC}

TRADEMARKER ^{TM/MC}

VOS IDÉES À LA PORTÉE DU MONDE , DES AFFAIRES À LA GRANDEUR DE LA PLANÈTE^{®/MD}

YOUR BUSINESS IS THE WORLD OF IDEAS; OUR BUSINESS BRINGS YOUR IDEAS TO THE WORLD ^{®/MD}

Marques de commerce de ROBIC, S.E.N.C.R.L. pour ses services de conseils dans le domaine de la propriété intellectuelle et des technologies de l'information et des communications (incluant les services d'agents de brevets et de marques de commerce) de même que ses services juridiques

*

For services pertaining to intellectual property, technology and communication law and related matters (including patent and trade-mark agency services) as well as legal services.

ROBIC, LLP
www.robic.ca
info@robic.com

MONTREAL
1001 Square-Victoria - Bloc E - 8th Floor
Montreal, Quebec, Canada H2Z 2B7
Tel.: +1 514 987-6242 Fax: +1 514 845-7874

QUEBEC
2828 Laurier Boulevard, Tower 1, Suite 925
Quebec, Quebec, Canada G1V 0B9
Tel.: +1 418 653-1888 Fax.: +1 418 653-0006

ROBIC, un groupe d'avocats et d'agents de brevets et de marques de commerce voué depuis 1892 à la protection et à la valorisation de la propriété intellectuelle dans tous les domaines: brevets, dessins industriels et modèles utilitaires; marques de commerce, marques de certification et appellations d'origine; droits d'auteur, propriété littéraire et artistique, droits voisins et de l'artiste interprète; informatique, logiciels et circuits intégrés; biotechnologies, pharmaceutiques et obtentions végétales; secrets de commerce, know-how et concurrence; licences, franchises et transferts de technologies; commerce électronique, distribution et droit des affaires; marquage, publicité et étiquetage; poursuite, litige et arbitrage; vérification diligente et audit. ROBIC, a group of lawyers and of patent and trademark agents dedicated since 1892 to the protection and the valorization of all fields of intellectual property: patents, industrial designs and utility patents; trademarks, certification marks and indications of origin; copyright and entertainment law, artists and performers, neighbouring rights; computer, software and integrated circuits; biotechnologies, pharmaceuticals and plant breeders; trade secrets, know-how, competition and anti-trust; licensing, franchising and technology transfers; e-commerce, distribution and business law; marketing, publicity and labelling; prosecution litigation and arbitration; due diligence. ®/MD

COPYRIGHTER™/MC

IDEAS LIVE HERE®/MD

IL A TOUT DE MÊME FALLU L'INVENTER!®/MD

LA MAÎTRISE DES INTANGIBLES®/MD

LEGER ROBIC RICHARD®/MD

NOS FENÊTRES GRANDES OUVERTES SUR LE MONDE DES AFFAIRES®/MD

PATENTER®/MD



or stylizedR®/MD

ROBIC®/MD

ROBIC +
+
+
+

ROBIC, LLP
www.robic.ca
info@robic.com

MONTREAL
1001 Square-Victoria - Bloc E - 8th Floor
Montreal, Quebec, Canada H2Z 2B7
Tel.: +1 514 987-6242 Fax: +1 514 845-7874

QUEBEC
2828 Laurier Boulevard, Tower 1, Suite 925
Quebec, Quebec, Canada G1V 0B9
Tel.: +1 418 653-1888 Fax.: +1 418 653-0006

or stylized ROBIC ++++®/MD

ROBIC + DROIT
+ AFFAIRES
+ SCIENCES
+ ARTS

or stylized ROBIC + DROIT +AFFAIRES +SCIENCES +ARTS®/MD

ROBIC + LAW
+ BUSINESS
+ SCIENCE
+ ART

or stylized ROBIC +LAW +BUSINESS +SCIENCE +ART®/MD

THE TRADEMARKER GROUP™/MC

TRADEMARKER™/MC

VOS IDÉES À LA PORTÉE DU MONDE , DES AFFAIRES À LA GRANDEUR DE LA PLANÈTE®/MD

YOUR BUSINESS IS THE WORLD OF IDEAS; OUR BUSINESS BRINGS YOUR IDEAS TO THE WORLD®/MD

Trade-marks of ROBIC, LLP for its services pertaining to intellectual property, technology and communication law and related matters (including patent and trade-mark agency services) as well as legal services