

TRADE-MARK ASSIGNMENTS AND THEIR EFFECTS ON OPPOSITION PROCEEDINGS

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The matter of *United Artists Corporation v. Pink Panther Beauty Corporation & The Registrar of Trade Marks* (yet unreported) Federal Court of Canada, Trial Division No. T-3487-90, consisted of an appeal brought by United Artists Corporation pursuant to s. 56 of the Trade-Marks Act R.S.C., c. T-13, from a decision rendered by the Registrar of Trade Marks rejecting an opposition to registration by the respondent of the trademark THE PINK PANTHER (Application No. 557,655) for use in association with wares pertaining to hair care and beauty supplies as well as certain services related thereto.

The appellant is the owner of the trademark THE PINK PANTHER (Registration No. 152,831) as well as certain other design marks depicting a panther cartoon, all of which are registered for use in association with wares and services relating to various aspects of the entertainment industry. The trademark THE PINK PANTHER was registered in Canada in 1967 by Mirisch-Geoffrey-D-F and was subsequently transferred on numerous occasions, the appellant having become the most recent assignee of the mark in October 1994.

Although the judgement essentially rejected the respondent's application after having determined that the widespread use of appellant's trade-mark and the high degree of resemblance between the two subject marks would likely lead to confusion amongst ordinary consumers as to the source of the wares and services associated to each, the most noteworthy aspect of the court's decision concerned appellant's standing to appeal the Registrar's decision to reject the opposition.

The appellant's standing to appeal the decision became an issue due to the fact that numerous corporate entities successively took on the roles of owner of the trademark THE PINK PANTHER and party to the opposition proceedings. The opposition to respondent's application to register the trademark THE PINK PANTHER which initiated the proceedings was filed by MGM/UA Communications Co. on April 4, 1988. On September 28, 1988 the mark was

assigned to United Artists Pictures, Inc., effective as of December 1, 1987 which resulted in a change to the identity of the opponent. The Registrar rendered a decision on October 31, 1990 whereby it rejected the appellant's opposition.

On December 31, 1990, following the Registrar's decision, MGM-Pathe Communications Co. who had been assigned the mark in January 1991, effective November 1, 1990, filed a notice of appeal of said decision to the Federal Court of Canada, Trial Division. In October 1994, prior to the hearing of the appeal, the trade-mark was assigned to United Artists Corporation who filed a preliminary motion requesting that it be recognized as the new appellant in the proceedings.

The respondent argued that United Artists Corporation did not have standing to bring the appeal because its two most recent predecessors in title had not expressly assigned their rights in the appeal proceedings to MGM-Pathe Communications Co. and United Artists Corporation, thereby only resulting in the assignment of the trade-marks themselves, not their respective rights in the proceedings. The respondent looked to *Union Carbide Canada Limited v. Trans-Canadian Feeds Limited et al.* (1965), 49 C.P.R. 7 at 26 and *Amstead Industries Inc. v. Wire Rope Industries Ltd.* (1990), 32 C.P.R. (3d) 334 at 339, to support its position.

The court set aside these decisions because they dealt with the right of assignees of patent rights to initiate actions as opposed to the case at bar which concerned a statutory appeal calling for the review of an administrative decision.

The court then turned to *Primax Computer Corporation v. Primax Electronic (U.S.A.) Inc.* (1995), 62 C.P.R. (3d) 75 (F.C.T.D.) in which Mr. Justice Denault, of the same court, had refused a similar substitution based on exactly the same type of reasoning as was being put forward by Pink Panther Beauty Corporation.

The court distinguished the *Primax* decision based on the fact that the notice of appeal had been filed by a bankrupt corporation, not its receiver, and that the language of the assignment was "rather more limited" than that found in the case at bar. This second distinguishing factor was based on the difference between assigning the name "Primax and all trade mark registrations..." as was the case in the *Primax* matter and assigning "all right, title and interest" in the mark **THE PINK PANTHER**. Mr. Justice MacKay found that the latter wording included the transfer of interest in the opposition proceedings while the preceding did not.

The court made it abundantly clear throughout its decision that it felt that an "assignee of all interests in a trade-mark", when possible, should not be precluded from "seeking to protect its primary right, to exclusive use, merely because the assignment of rights was general and did not expressly provide a right to oppose another party's application...". Although the court's reasoning is not an outright contradiction of the *Primax* decision, it clearly adopts a different perspective to the problem. A perspective based on the notion that the general assignment of trade-mark rights should include the transfer of the accessory rights needed to enforce and protect the primary rights conveyed by the assignment.

Unfortunately a clear standard has not yet been established and therefore the courts shall still be called on to determine whether an assignment is general enough to also effectively transfer the rights in proceedings or too limited to do so.

Published at (1996), 10 W.I.P.R. 208 under the title *Trade-Mark Assignments and Their Effects on Opposition Proceedings*.

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