

**NON PROFIT RELIGIOUS ORGANIZATION NOT A “PUBLIC AUTHORITY” UNDER
SECTION 9 OF CANADA’S TRADE-MARKS ACT,
FEDERAL COURT RULES**

By
Barry Gamache*
LEGER ROBIC RICHARD, Lawyers
ROBIC, Patent & Trademark Agents
Centre CDP Capital
1001 Square-Victoria - Bloc E – 8th Floor
Montreal, Quebec, Canada H2Z 2B7
Tel.: (514) 987 6242 - Fax: (514) 845 7874
www.robic.ca - info@robic.com

A recent judgment of the Trial Division of the Federal Court of Canada quashed a decision of the Registrar of Trade-marks giving public notice of an official mark described as a “Menorah Design” by a religious organization under Section 9 of Canada’s *Trade-marks Act*, R.S.C. 1985, c. T-13 (*Canadian Jewish Congress v. Chosen People Ministries, Inc.*, 2002 F.C.T. 613 (May 28, 2002, Blais, J.)).

The applicant, the Canadian Jewish Congress, applied for judicial review pursuant to subsection 18.1(1) of the *Federal Court Act*, R.S.C. 1985, c. F-7, of a decision by the Registrar of Trade-marks dated November 3, 1999 giving public notice pursuant to subparagraph 9(1)(n)(iii) of the *Trade-marks Act* of the adoption and use by the respondent Chosen People Ministries, Inc. of the mark identified as a “Menorah Design”, a representation of a stylized menorah i.e. a seven-branched candelabrum.

This decision by the Registrar followed a request made on December 31, 1997 by Chosen People Ministries, Inc. to the Registrar that it give public notice under subparagraph 9(1)(n)(iii) of the *Trade-marks Act* of its adoption and use of the “Menorah Design” as its official mark. Chosen People Ministries, Inc. can be described as a non profit Christian organization originating from the United States. The mission of this “Messianic Jewish” religious organization is to spread the “Gospel of the Lord Jesus Christ among the Jews in the United States of America and in all parts of the world”.

Subparagraph 9(1)(n)(iii) of the *Trade-marks Act* is a far-reaching provision which prohibits persons from adopting trade-marks that resemble those

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* Of the Lawfirm LEGER ROBIC RICHARD, g.p. and the Patent and Trademark Agency Firm ROBIC, g.p. Publication 142.142.

previously adopted by public authorities. It specifically states that no person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of or so nearly resembling as to be likely to be mistaken for (...) any badge, crest, emblem or mark (...) adopted and used by any public authority, in Canada as an official mark for wares or services, in respect of which the Registrar has, at the request of (...) (a) public authority, (...) given public notice of its adoption and use (...).

The Registrar initially refused Chosen People Ministries, Inc.'s application for its official mark; however, on November 3, 1999, it reversed its position and gave public notice in the *Canadian Trade-marks Journal* that the "Menorah Design" was an official mark of Chosen People Ministries, Inc. As of November 3, 1999, Chosen People Ministries, Inc. could therefore claim all the rights and enforce all the prohibitions available to it under Section 9.

As the *Trade-marks Act* does not provide a mechanism to challenge any Registrar's decision to give public notice of an official mark, the Canadian Jewish Congress applied for relief to the Federal Court against the November 3, 1999 decision. The Canadian Jewish Congress aims "to develop the highest standards of participation" in the democratic process by the Canadian Jewish Community by encouraging, carrying on and participating in activities of a national, cultural and humanitarian nature, among other things. As such, the Canadian Jewish Congress considered it would be directly affected by the Registrar's decision and prejudiced by it in that it would be unfair to prohibit any other Jewish organization from using a mark incorporating a menorah.

According to Section 9, an official mark can only be adopted and used by a "public authority". Under the circumstances, the Canadian Jewish Congress argued that Chosen People Ministries, Inc. was not a public authority and could therefore not claim the benefit of the provisions of Section 9 of the Act. The Court noted that the *Trade-marks Act* does not provide any definition as to the meaning of "public authority" and so it adopted a plain and ordinary interpretation of such words. The Court also considered case law which defined a "public authority" as one which is subject to government control and has a duty to the public: "... to be regarded as a public authority, a body must be under a duty to the public, must be subject to a significant degree of government control and must be required to dedicate any profit earned for the benefit of the public and not for private benefit" (*Big Sisters Association of Ontario v. Big Brothers of Canada* (1997) 75 C.P.R. (3d) 177).

The Court noted that the fact that chosen People Ministries, Inc. was incorporated as a non profit corporation with charitable objects and tax exempt status was not sufficient in itself to grant it public authority status. The

fact that all charitable organizations must comply with government regulations was not seen by the Court as subjecting these organizations to “significant” government control.

The Canadian Jewish Congress argued that Chosen People Ministries, Inc. had an overtly religious mission and that, as such, it could not be considered subject to government control as the government of Canada cannot intervene in any way with the internal affairs of Churches, religious bodies, or charitable organizations nor can it dictate how they should conduct their affairs.

The Court therefore concluded that Chosen People Ministries, Inc. did not qualify as a public authority and ruled that the Registrar of Trade-marks erred in granting the “Menorah Design” as an official mark.

On a practical level, the Court also noted that it would be counterproductive to prohibit Jewish organizations and associations from using and adopting a mark such as the Menorah, since it has always been historically associated with the Jewish culture. Historical and religious evidence was put before the Court: The Menorah was described, for example, as one of the commonest Jewish symbols in late antiquity, both in Israel and in the Diaspora. The Court took the view that such a symbol should not be the object of monopolistic rights and sided with the Canadian Jewish Congress which had expressed the view that, like the Crucifix in the Christian religion, the Menorah is not the exclusive property of any one organization, but is rather the shared symbol of Jewish persons and organizations around the world.

The Court’s decision can be seen as attempting to bring some order as to who can claim “public authority” status under Section 9 of Canada’s *Trade-marks Act*. With this decision, it may be much more difficult for religious organizations to qualify as public authorities. Religious bodies, by their own nature, cannot be the object of governmental control as the Canadian State treats all religions equally, without interfering in their internal affairs, a situation of fact Canada’s Supreme Court recognized nearly half a century ago in *Chaput v. Romain* (1955) S.C.R. 834.

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