



## TWENTY-SEVEN YEARS LATER, FEDERAL COURT ALLOWS CHALLENGE TO OFFICIAL MARK IN *PRINCESS GROUP* CASE

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For those interested in the extensive rights granted by official marks in Canada, a recent decision by Canada's Federal Court has allowed a challenge against an official mark decades after public notice was given of its adoption and use (*Princess Group Inc. et al. v. Canadian Standards Association*, 2009 FC 926 (F.C., Harrington J., September 17, 2009)).

Official marks are a particularity of Canadian Trade-mark Law. Under subparagraph 9(1)(n)(iii) of Canada's *Trade-marks Act*, R.S.C. 1985, c. T-13 (the "Act") 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 the public authority, given public notice of its adoption and use.

Only public authorities can obtain the rights granted under subparagraph 9(1)(n)(iii) for their official marks. In order to be recognized as a "public authority", an entity must be subject to government control and must engage in activities that benefit the public (*United States Postal Service v. Canada Post Corporation*, 2007 FCA 10 (F.C.A.)).

An important effect of the giving of public notice under subparagraph 9(1)(n)(iii) is that, from that date, other persons are prevented from using any mark "as a trade-mark or otherwise" that is likely to be mistaken for the official mark, except in connection with goods and services with which the mark was used before the public notice was given of the official mark (*Ontario Association of Architects v. Association of Architectural Technologists of Ontario*, 2002 FCA 218 (F.C.A.), paragraph 34). Moreover, the Registrar may not refuse to give public notice of the adoption and use of a mark as an official mark for wares or services on any of the grounds that would be raised when examining an application for an ordinary trade-mark. In fact, the Registrar has virtually no discretion to refuse to give notice of the adoption and use of

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a mark as an official mark once the statutory criteria of subparagraph 9(1)(n)(iii) have been met (*Ontario Association of Architects v. Association of Architectural Technologists of Ontario*, 2002 FCA 218 (F.C.A.), paragraph 34).

There has been considerable uncertainty regarding means to challenge the Registrar's decision to give public notice of the adoption and use of a mark as an official mark. In *Princess Group Inc.*, Mr. Justice Harrington underlined the prevalent view in case law that an official mark can be challenged in an application for judicial review. However, according to section 18.1 of the *Federal Courts Act*, R.S.C. 1985, c. F-7, an application for judicial review in respect of a decision such as the one made by the Registrar must be carried out within thirty days after the time the decision is first communicated to the party directly affected by it. One issue raised by a challenge under section 18.1 of the *Federal Courts Act* against an official mark is that there is no decision that is "communicated" by the Registrar to the party who, one day, might be affected by it. Moreover, it has been understood that challenges to official marks should be commenced very shortly after the Registrar gives the notice of subparagraph 9(1)(n)(iii), that is within thirty days of the notice or within any extended deadline granted by the Court once the party affected by the notice becomes aware of it. The case before the Court in *Princess Group* challenged somewhat this assumption because of the time lapsed since the notice was first given.

In 1982, the Registrar of Trade-marks gave public notice under subparagraph 9(1)(n)(iii) of the *Trade-marks Act* of the adoption and use by the Canadian Standards Association of the mark CSA as an official mark for its services. Up until 2009, the public notice given for the CSA official mark stood unchallenged.

In 2007, the Canadian Standards Association gave notice to Princess Group Inc. and Princess Auto Ltd. (hereafter "Princess") of alleged infractions by Princess to its "regular" registered trade-mark CSA but not, however, to its official mark composed of the same letters. In early 2009, the Canadian Standards Association forwarded to Princess a draft statement of claim, again without reference to its official mark. In fact, Princess was put on notice that the Canadian Standards Association was relying on its official mark CSA only upon the issuance and service of its statement of claim, both on April 23, 2009. Thereafter, on June 1, 2009, thirty-eight days after service of the statement of claim, Princess launched its application for judicial review of the Registrar's 1982 decision to give public notice of the CSA official mark.

The Canadian Standards Association challenged Princess' application and took the position that that latter was on sufficient notice as early as 2007 to become, at that time, directly affected by the Registrar's 1982 decision. The Court rejected this argument writing that the Canadian Standards Association never referred to its official mark in 2007 but rather did so only on April 23, 2009. Moreover, the 1982 decision was never communicated by the Registrar to Princess. While Princess took more than thirty days (thirty-eight days, actually) to challenge the official mark, the Court

allowed a short extension “to do justice between the parties”. Moreover, the Court noted that attacking the publication of an official mark by way of judicial review is certainly not an obvious way to proceed since a judicial review aims at challenging, for example, a decision by the Registrar of Trade-marks that is “communicated” to a third party, an event that does not occur when public notice of adoption and use of an official mark is given by the Registrar.

This recent decision by the Federal Court highlights the difficulties and limits in challenging official marks as the *Trade-marks Act* does not mention this type of action. A judicial review now appears to be the vehicle of choice to challenge an official mark, even several years after a public notice of adoption and use has been given by the Registrar. For the time being, official marks appear less invulnerable than they once were.



