



ADDITIONAL WORDING TO REGISTERED TRADE-MARK NOT A SUBSTANTIAL DEVIATION, FEDERAL COURT RULES

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The Federal Court of Canada recently allowed an appeal from a decision rendered by a Hearing Officer of the Trade-marks Opposition Board under section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (hereafter: the "Act"), maintaining the registration for the trade-mark ING.LORO PIANA & C. & Design solely for the wares "fabrics", after concluding that added wording on the labels would not be perceived as forming part of the trade-mark at issue (*Loro Piana S.P.A. v. Canadian Council of Professional Engineers (CCPE)*, 2009 FC 1095 (Near, J., October 27th, 2009)).

Background Information

Section 45 of Canada's *Trade-marks Act* is the "use it or lose it" provision allowing the Registrar, via administrative proceedings, to expunge trade-mark registrations for marks not in use in Canada. Following a request made by any third party and upon payment of the prescribed fee, the Registrar gives Notice to the registered Owner of a trade-mark to prove use of its registered trade-mark in Canada with respect to each of the wares or services specified in the registration, at any time during the three year period immediately preceding the date of the Notice. Failing to establish use (or justify its non-use due to special circumstances) may lead to expungement of the mark.

The administrative cancellation proceedings

On January 2, 2007, at the request of the Canadian Council of Professional Engineers (CCPE), the Registrar of Trade-marks forwarded a Notice to Ing. Loro Piana & C. S.P.A., the then registered Owner of the ING. LORO PIANA & C. & DESIGN trade-mark, to furnish evidence its mark was used in Canada between January 2, 2004 and January 2, 2007, in association with "yarns and treads; fabrics;

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clothing, namely jackets, coats, skirts, trousers, cloaks, mantles, overcoats and knitted vests, scarves, mufflers, shawls and gloves” (the Registered Wares).

A change of name from Ing. Loro Piana &C. S.P.A. to Loro Piana S.P.A. was recorded by the Trade-marks Office on July 13th, 2007. In response to the section 45 Notice, Loro Piana S.P.A. filed the affidavit of its CFO along with accompanying exhibits. In its evidence, Loro Piana S.P.A. stated that it specialised in the manufacture and sale of high quality fabrics and also designed and produced a line of ready-to-wear and tailor made clothing for men, women and children.

As part of its evidence, Loro Piana S.P.A. filed a representative sample showing the trade-mark as sewn into the company’s wares and a hang tag showing the trade-mark affixed thereon, said tag being also attached to the wares. Neither party submitted written arguments nor requested an Oral Hearing. A decision was rendered on December 11th, 2008.

The Hearing Officer ruled that the use of the disputed mark had been shown only for “fabrics” and not the remaining wares listed in the registration. There was no evidence of special circumstances excusing the absence of use with these remaining wares.

Varied forms of a registered trade-mark

The registered trade-mark under attack is reproduced as follows:



Aside from the question of use with wares, another matter arose in the course of the Registrar’s decision, one which dealt with the theme of varied use of a registered mark since additional wording appeared on the labels and exhibits filed as evidence. Among such elements were the words “FABRIC MADE IN ITALY”¹. The Registrar held that these elements would not be perceived as forming part of the attacked mark *per se* and determined that the Registered Wares should be amended to delete all wares other than “fabrics”.

It is worth mentioning that under Canadian trade-mark law, the golden rule is that a trade-mark must be used **as** registered, otherwise it remains vulnerable such as in

¹ The reported decision does not contain a reproduction of the mark as it was used, making only a verbal passing reference to the appearance of additional material such as “FABRIC MADE IN ITALY” on labels and hang tags. We therefore have no indication as to what other additional material appeared nor its positioning in the labels and hang tags produced as evidence by the owner of the registered trade-mark.

the case of administrative cancellation proceedings initiated by third parties. However, despite this golden rule, commercial realities often dictate that owners inevitably use their registered trade-marks in a varied form and as a result, a body of case law has been created which establishes guiding principles.

A test has been elaborated by Canadian case law in order to determine whether use of a trade-mark in a manner different from its registered form constitutes proper use of the registered trade-mark. In essence, the differences between the two trade-marks in question must be minimal and so unimportant that an unaware purchaser would infer, despite these differences, the goods share a common origin. Jurisprudence therefore allows a certain flexibility with regards to varied uses of marks.

The Federal Court ruling

In maintaining the ING. LORO PIANA & C. & DESIGN trade-mark on the register and on the particular issue of deviations from the registered form of a mark, the Court agreed with the Hearing Officer's decision regarding the impact of the presence of additional material. The Court ruled the deviations were not substantial and therefore acceptable based on the following factors:

1. the trade-mark stood out from the additional material
2. the additional words would not be perceived as forming part of the trade-mark *per se*
3. the additional words were in proportionately smaller fonts
4. the additional words were in different styles of letters.

Based on additional evidence before the Federal Court regarding use for wares other than "fabrics" and in granting the appeal, the Court also held that the registration should be maintained for all of the wares listed therein except for "threads", for which no use or reasons for absence of use were established.

Conclusion

This case serves as another reminder that cautious variations can be made without adverse consequences so long as the same dominant features of the mark are maintained and the differences are not so unimportant as not to mislead an unaware purchaser. However, while the established principles in cases of varied use are essentially clear, their application, as routinely demonstrated in jurisprudence, confirms there is nevertheless a risk of losing the benefits of a registration. To avoid playing with fire, trade-marks owners are best advised to steer clear from having to douse the flames by filing fresh applications for deviations to their registered marks.

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