THE STATUTORY PROTECTION OF NON-TRADITIONAL TRADE-MARKS IN CANADA A FEW REFLECTIONS ON THEIR REGISTRABILITY AND DISTINCTIVENESS

Bob H. Sotiriadis and Laurent Carrière*
LEGER ROBIC RICHARD, Lawyers
ROBIC, Patent & Trademark Agents
55 St-Jacques, Montreal (Quebec), Canada H2Y 3X2
Tel.: (514) 987 6242 - Fax: (514) 845 7874
E-mail: marion@robic.com - Web Site: www.robic.ca

* Lawyer, Bob H. Sotiriadis is one of the senior partners of the law firm LEGER ROBIC RICHARD, g.p. and of the patent and trademark firm ROBIC, g.p. This paper is an adaptation, translation and update of the paper of Laurent Carrière, lawyer and trade-mark agent and one of the senior partners of the same firms entitled "La protection statutaire des marques non traditionnelles au Canada – Quelques réflexions sur leur enregistrabilité et distinctivité".

1. INTRODUCTION

What is a trade-mark? The *Trade-marks Act*[1] provides us with a circular definition from which we can deduce that it is a sign[2] distinguishing[3] wares or services of a person from those of others.

We generally conceive a trade-mark as constituted of one or many letters[4], one or many words[5] -invented or not- a sentence[6], armorial bearings[7], seal, hallmark, label[8], numbers[9], drawing[10], or even a combination of these. So much for traditional trade-marks.

---

[1] *Trade-marks Act* (R.S.C. 1985, c. T-13); hereinafter the Act or TMA.

[2] Section 2 TMA : "trade-mark" means :a) a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others; b) a cerification mark; c) a distinguishing guise; d) a proposed trade-mark. The 1998 Oxford Dictionary describes a trade-mark as a "device or name secured by law or custom as representing a company, product, etc.".

[3] Section 2 TMA : "distinctive" In relation to a trade-mark, means a trade-mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is adapted so to distinguish them.

[4] The perfume Ô of " Lancôme parfums et beauté & cie" [registration TMA 341813] or the abbrevation RCMP for the Royal Canadian Mounted Police (file TMO 907125).

[5] Word : the KODAK cameras of Kodak Canada Inc. [registration TMDA 007446] or the GEO automobiles of General Motors Corporation [registration TMA 428036]; words : the baking soda COW BRAND or ARM & HAMMER of Church & Dwright Ltd. [registration TMA 204654 et TMA 205758]; sentence : **NE PARTEZ PAS SANS ELLE** for the financial services of American Express Company [registration TMA 353254]; name : PIERRE CARDIN clothings of Pierre Cardin [registration TMA 168669] or the food items HEINZ of J.J. Heinz Company [registration TMDA 056296].

[6] TU ME DONNES LE GOÛT! (registration TMA 331397) or IT'S WHERE YOU GO WHEN YOU KNOW ABOUT CHICKEN! (registration TMA 316515) for food services of Groupe alimentaire St-Hubert Inc. or DO IT RIGHT. DO IT PINK for insulation materials of Owens-Corning Canada Inc. (application TMO 806568).

[7] For the RCMP : **MAINTIENS LE DROIT** and the representation of a buffalo (file TMO 907128).

[8] The GRAND MARNIER liqueur of the Société des produits Marnier-Lapostolle [registration TMA 203249].

[9] The 222 analgesic of Merck Frost Canada Inc. (registration UCA 045131) or the 222 helicopter of Bell Helicopter Textron Inc. (registration TMA 389054).

[10] The label of H.J. Heinz Company of Canada Ltd. (registration TMA 163484) or the rooster head of the Groupe alimentaire St-Hubert Inc. (registration TMA 506689).

We also conceive a trade-mark as refering to the positioning of a visible element on the product itself[11] or related to the product[12], or as a distinguishing guise[13], a shaping of the wares[14] or of their containers[15].

But what about sounds, odours and tastes, holograms or kinetic marks? And what about telephone numbers, in their numeric form or as acronyms? Trade-marks that we put on all kinds of promotional materials? Colors? Shapes or product configurations?

Trade-marks are nothing more than two-dimensional statistical signs, like those introduced by the first factory marks of craftsmen and guild members, which became international with the advent of the industrial revolution[16]. The new techniques of

---

[11] For instance, the tie on the neck of the bottle of Champagne Moet & Chandon (registration TMA 399889), the colours on the Thorneburg socks (Registration TMA 319504), the strip on the running Puma AG Rudolf Dassler Sport (registration TMA 264673)

[12] The keyhole shape on the brushes of Newell Operating Company (registration TMA 460749), the clip in the shape of an arrow on the pen of The Parker Pen Company (registration TMA 315448), the piece of material on clothing of Levi Strauss & Co (registration TMA 194716) or the central nylon strip on the notebooks of The Mead Corporation (registration TMA 473317).

[13] As defined by section 13 of TMA.

[14] The pen of Bic Inc. (registration TMA 362414), the bugle shaped munchies BUGLES of General Mills Inc. (registration TMA 497479), the OREO cookies of Nabisco Ltd. (application TMO 840917), the TOBLERONE chocolate of Kraft Jacobs Suchard (Switzerland) (registration TMA 164635).

[15] The HEINZ ketchup bottle (registration TMDA 001177), the YOPLAIT liquid yogurt bottle of Sodima (registration TMA 379043), the PERRIER bottle of water of Perrier Vittel (registration TMA 488661), the silhouette bottle of Coca-Cola Ltd. (registration UCA 044193), the wrapping of the TOBLERONE chocolate of Kraft Jacobs Suchard (Switzerland) (application TMO 832993).

[16] "Trademarks traditionally are characterized as outgrowths of the ancient use of hallmarks by silversmiths and other craftsmen. What historically was the proper subject of trademark protection, however, is a mere sliver of the expansive scope of modern trademark protection" : Russell H. FALCONER, "Big Future for Nontraditional Marks" (1998-05-18) *The National Law Journal* C-28 and URL http://test01.ljextra.com/na.archive.html/98/05/1998_0511_153.html; also available at URL http://www.bakerbotts.com/practice/iptech/library/articles/bigfuture.html (website consulted on 19990401). Heinz DAWID, "Preserving History – Trademark Timeline" (1992), 82 *Trademark Reporter* 1021; Sidney A. DIAMOND, "The Historical Development of Trademarks" (1975), 65 *Trademark Reporter* 265, republished at (1983), 73 *Trademark Reporter* 222; Thomas D. DRESCHER, "The Transformation and Evolution of Trademarks – From Signals to Symbols to Myth" (1992), 82 *Trademark Reporter* 301; Abraham S. GREENBERG, "The Ancient Lineage of Trade-Marks" (1951), 33 *Journal of the Patent Office Society* 876; Benjaminn J. PASTER, "Trademarks – Their Early History" (1969), 59 *Trademark Reporter* 551;

sale[17] related to the explosion of electronic commerce see to it that traditional trade-marks are not always sufficient to catch a more sophisticated consumer[18].

Does the *Trade-marks Act* (and relevant jurisprudence) permit the registration of those non-traditional trade-marks in Canada? It is this topic that will be discussed in this short text.

2 REMINDERS

2.1 DISTINCTIVENESS

The essential characteristic of a trade-mark is not so much that it is visually or phonetically pleasing or that it is original, but rather that it really distinguishes[19] wares or services related to its use or is adapted for such a purpose[20]. A common

---

Edward S. ROGERS, “Some Historical Matter Concerning Trade-Marks” (1910), 9 *Michigan Law Review* 29, republished (1972) 62 *Trademark Reporter* 239; Gerald RUSTON, “On the Origin of Trademarks” (1955), 45 *Trademark Reporter* 127.

[17] Especially through electronic commerce business to consumer.

[18] Danield I. SCHLOSS, “Special Problems in Registration of Nontraditional Trademarks” (1999), 5-4 *Intellectual Property Strategist* 1.

[19] Here it is useful to remind that, according to section 2 TMA, a trade-mark is a mark that is used to distinguish (*for the purpose of distinguishing*) or that is adapted or apt to distinguish (*or so as to distinguish*). “Thus, both intention and result apply equally in determining whether or not a mark is a trade mark”; editor's note in *W.J. Hughes & Sons "Corn Flower" Ltd. v. Morawiec* [TWELVE PETALS FLOWER] (1970), 62 C.P.R. 21, 44 Fox Pat.C. 88 (Ex. Ct.), at p. 89. Consequently, if the trade-mark distinguishes a person’s wares from those of another, it is not relevant that it can also be used for another purposes. : *Chanel, S.A. (Re),* (1988), [1988] T.M.O.B. 215 (Registrar), D. Savard at p. 2-3 [COCO].

[20] On this topic : Harold G. FOX, *The Canadian Law of Trade Marks and Unfair Competition*, 3d ed. (Toronto, Carswell, 1972), at p. 18, 21 and 22 (footnote omitted) : “General Definition: It may, therefore, be shortly put that a trade mark today means a mark that is publicly used by a person to identify as his the goods that he makes or offers for sale in the market, or the services that are performed by him. The words "to identify" in the above definition must be read, at least so far as the statutory definition is concerned, in either one of two senses, namely, that the owner of the mark uses the trade mark for the purpose of, or with the intention of, distinguishing his wares or services in the market from those of others, or alternatively, that whatever may be the purpose for, or the intention with which he uses the mark, it does actually and in fact distinguish his wares or services in the market from those of others”. [p. 18]
"For the Purpose of Distinguishing": The words "for the purpose" in s. 2(t) are not to be read as necessarily synonymous under all conditions with the expression "with the intention". This was pointed out by Romer L.J. in *Nicholson's Application* [(1931), 48 R.P.C. 227, at 260)] where he observed that if a manufacturer uses a mark in association with his goods for merely aesthetic or decorative motives, or for

appellation to an industry or to a degree of quality[21], a descriptive term of a product or an element with only a functional or ornemental purpose rarely include this fundamental characteristic[22].

With respect to the functionality of a trade-mark, the jurisprudence is relatively scarce and for this reason, must be scrutinized carefully in order to extract the applicable principles**.** The invalidity of a trade-mark with respect to its functionality does not have any statutory basis and arises from the case law[23]. Consider the following comments in:

Imperial Tobacco Company of Canada, Limited (The) v. Registrar of Trade marks [COLOURED BAND CELLOPHANE] [1939] 2 D.L.R. 141, [1939] EX. C.R. (Ex. Ct.), J. Maclean at pages 143 and 144-145 :

> The Registrar refused registration of the mark on the grounds that the coloured band performed the function of indicating where the tear strip was located and thus facilitating the opening of the outer wrapper. [p. 143]
>
> One may safely say that the band was primarily designed and adopted for the purpose of opening the outer wrapper, and it is unlikely that if the outer wrapper were not moisture proof and the band did not function as a tearing strip, they, in combination would ever be

---

warehouse purposes, and the mark comes to be recognized by the public as indicating origin, then the mark has been used in such a way as to have served the purpose of indicating origin and comes within the definition. It must, however, be used for the purpose of distinguishing the owner's goods or services and not for the purpose of embarrassing or unfairly competing with other traders. [p. 21]

"So as to Distinguish": The nature of the use sufficient to fulfil the definition of the function of a trade mark is not to be considered in any restrictive sense. Both the intention of the user and recognition by the public are relevant facts and either may be sufficient to show that there has been trade mark use: it is not necessary that there should be both. This is inherent in the use of the disjunctive in the definition of a trade mark, that it is used "for the purpose of distinguishing or so as to distinguish." Nor does the use of the words "for the purpose" imply that any deliberate resolution to that effect on the part of the user of the mark is contemplated. It is enough if in practice the mark has been so used as to denote the origin of the goods. It is not essential to prove in addition that the market has accepted it as a distinguishing mark. The intention of the user, that is, the purpose of use, is, under the Trade Marks Act, sufficient to cause a word or other mark to become a trade mark. This is inherent in the first part of the definition contained in s. 2(t)(i). [p. 22]

[21] See for instance *Decatur v. Flexible Shaft Co.* [No. 360] (1930), [1930] EX. C.R. 97 (Ex. Ct.), J. Maclean at pages 99 and 101.

[22] *IVG Rubber Canada Ltd. v. Goodall Rubber Company* [HELICAL STRIPE] (1980), 48 C.P.R. (2d) 268, [1981] 1 F.C. 143 (F.C.T.D.), J. Dubé at page 146.

[23] *Remington Rand Corp. v. Philips Electronics N.V* [SHAVER HEAD] (1993), 51 C.P.R. (3d) 392, 69 F.T.R. 136, 44 A.C.W.S. (3d) 579 (F.C.T.D.); rev. (1995), 191 N.R. 204, [1995] A.C.F. 1660, 64 C.P.R. (3d) 467 (F.C.A.), J. MacGuigan at page 471; leave to appeal to the Supreme Court of Canada refused (1996), [1996] 2 S.C.R. ix (S.C.C.).

> suggested as a trade mark. It seems to me that the trade mark applied for *was intended to replace the patents referred to*, if they should be found to be invalid, as they were. *In my opinion any combination of elements which are primarily designed to perform a function*, here, a transparent wrapper, which is moisture proof and a band to open the wrapper, *is not fit subject-matter for a trade mark*, and if permitted would lead to grave abuse. [Our italics] [pp. 144-145]

Parke, Davis & Co. Ltd. v. Empire Laboratories Limited [SEALED BANDED CAPSULES] (1963), 24 Fox Pat. C. 88, 38 D.L.R. (2d) 694, 41 C.P.R. 121, [1964] É. 399 (Ex. Ct.), J. Noël at pages 416, 418-419 and 419 :

> […] in this case the coloured gelatin band is used to close the gelatin capsule. […] We have seen [*i.e*., the testimony and a reference to the corresponding U.S. patents] *that the colour banded capsules of the plaintiff have many utilitarian functions* and that even the presence of colour on the bands is useful in enabling the easy detection of a break on the band. […] However, this extensive coverage of the various colours and shades together with the utilitarian use of the coloured bands around the middle of the capsules (particularly the sealing and the use of coloured bands or strips to detect the breakage of the bands) which, as we have seen, happens to be the best place the bands can be placed in order to seal both halves, brings me to the conclusion that the plaintiff by using its trade marks as it does, because it could have merely painted a strip or a band around the capsule, undoubtedly monopolizes, with the exception however of their utility as simple containers, all the forms of the functional parts of the colour banded sealed capsules and because of this I cannot but find that the plaintiff's trade marks are invalid. [Our italics.]

Parke, Davis & Co. Ltd. v. Empire Laboratories Limited [SEALED BANDED CAPSULES]. (1964), 27 Fox Pat. C. 67, 45 D.L.R. (2d) 97, 43 C.P.R. 1, [1964] S.C.R. 351 (S.C.C.), J. Hall at page 354 :

> The validity of the trade marks may, in my view, be disposed of on the ground that the coloured bands have a functional use or characteristic and cannot, therefore, be the subject of a trade mark. The law appears to be well settled that *if what is sought to be registered as a trade mark has a functional use or characteristic, it cannot be the subject of a trade mark.* [Our italics.]

Elgin Handles Ltd. v. Welland Vale Mfg. Co. Limited [DARKER TOOL HANDLE] (1964), 43 C.P.R. 20, [1965] EX. C.R. 3, 27 Fox Pat.C. 168 (Ex. Ct.), J. Jackett at pages 171 et 172 :

> In my view, this may be paraphrased accurately as follows : Darker colouring of the grain of the wood of tool handles accomplished by fire hardening. […] In any event, fire hardening, whatever else it does, actually hardens the surface of the wood to a substantial extent. I have therefore come to the conclusion on the evidence that the fire hardening process is primarily designed to improve wooden handles as objects of commerce and *has therefore a functional use or characteristic* [Our italics.]

W.J. Hughes & Sons "Corn Flower" Ltd. v. Morawiec [TWELVE PETALS FLOWER] (1970), 62 C.P.R. 21, 44 Fox Pat.C. 88 (Ex. Ct.), J. Gibson at pages 98-99 and 100 :

> Apparently a body of the public find glassware with this kind of ornamentation cut on it more attractive than plain glassware of the same quality. This ornamentation cut on glassware was not adapted by the plaintiff, the defendant or these others for the purpose of identification and individuality. Instead, such ornamentation by cutting was related solely to the consuming public's demands in connection with such glassware.[…] The plaintiff in cutting on glassware blanks this design or pattern […] did so, in my view, for a

> utility purpose only, namely, for the purpose of increasing, and such cutting was solely designed to increase, the attractiveness of such wares as objects of commerce and, *therefore, this design or pattern as so employed had a functional use or characteristic only*. [Our italics.]

Adidas (Canada) Ltd. v. Colins [THREE PARALLEL STRIPES] (1978), 38 C.P.R. (2d) 145 (F.C.T.D.), J. Walsh at page 169 :

> Moreover, aside from the question of distinctiveness there is a very serious question as to whether the three stripes do not constitute *a functional design, serving the function of decoration and are not properly registrable as a trade mark*.
>
> There is some evidence to the effect that striping on the sleeves or legs of garments, and athletic garments in particular, adds to their attractiveness for a potential buyer. Longitudinally placed stripes have a slenderizing effect and may perhaps give an illusion of speed or motion. Certainly I believe that it is fair to say that a garment bearing some such decorative stripes is more attractive and has more eye appeal than a plain garment. […] For one particular manufaturer to seize upon one particular type of striping, and by consistent use of it in certain widths and spacing claim that this particular type of stripe has acquired a significance so as to indicate to the public garments of its manufacture appears to be an attempt to convert what is merely ornemental design into a trade mark, which is not permissible. [Our italics.]

IVG Rubber Canada Ltd. v. Goodall Rubber Company [HELICAL STRIPE] (1980), 48 C.P.R. (2d) 268, [1981] 1 F.C. 143 (F.C.T.D.), J. Dubé at page 146:

> In my view, however, the helical stripe on the Goodhall hose does not play the same type of functional use as the band on the Parke, Davis capsule. In the latter case the gelatine band fulfils an essential physical function as well as a distinguishing feature. The band physically holds the capsule together. Without the band the capsule would fall apart. On the other hand, the spiral stripe running along the *Goodhall hose is not physically essential to the hose. It merely distinguishes it from other wares.* [Our italics.]

Samann v. Canada's Royal Gold Pinetree Mfg. Co. Ltd. [TREE CAR FRESHNER] (1984), 4 C.I.P.R. 17, 3 C.P.R. (3d) 313 (F.C.T.D.); rev. (1986), 8 C.I.P.R. 307, 65 N.R. 385, 9 C.P.R. (3d) 223 (F.C.A.), J Heald at page 231 :

> On this record, it is not possible to conclude that the marks in issue were *merely* or *solely* ornemental. *I agree with the appellant's counsel that it is likely that any design mark will have some ornamental features. However, that circumstance will not, per se, render a mark unregistrable so long as it possesses the essential requirements for registrability.* […] When determining the registrability of a trade mark, the only relevant consideration is the trade mark entry as it appears on the registry. Accordingly the manner in which a trade mark has in fact been used is irrelevant to that determination. [Our italics.]

Pizza Pizza Ltd. v. Canada (Registrar of Trade Marks)[24] [967-1111] (1985), 7 C.P.R. (3d) 428, 6 C.I.P.R. 229 (F.C.T.D.); (1989), 26 C.P.R. (3d) 355, 24 C.I.P.R. 152, 101 N.R. 378, 16 A.C.W.S. (3d) 24, [1989] 3 F.C. 379 (F.C.A.), J. Pratte at page 381 and J. Urie at pages 386-387 :

---

[24] Also commented : Marie PINSONNEAULT, « Votre numéro de téléphone est-il enregistré à titre de marque de commerce? L'affaire Pizza Pizza Limited » (1990), 2 *Les cahiers de propriété intellectuelle* 263.

> Counsel for the respondent tried to support the decision of the Trial Division [...] on only one ground, namely, that a telephone number is not registrable as a trade mark because, according to the jurisprudence [*Parke, Davis* et *Elgin Handles*], a mark that is primarily designed to perform a function cannot be the subject of a trade mark. This position, in my view, reveals a complete misunderstanding of that jurisprudence. *In those cases, the marks that were held to be functional were, in effect, part of the wares in respect of which registration was sought so that the registration of those marks would have granted the applicants a monopoly on functional elements or characteristics of their wares; the applicants would, in effect, have obtained patents under the guise of trade marks*. The situation here is entirely different. The trade mark applied for by the appellant is not functional in that sense; for that reason, its functional character does not make it "not registrable". [pp. 356-357]
>
> As I see it, *while undoubtly there is a functional element in its use* by the appellant, in that to place a telephone order for any of the appellant's products the numerical combination that is the telephone number allotted by the telephone company to the appellant must be utilized, *that is not its sole function*. Rather, it is totally unrelated to the wares themselves in the sense that, for example, a numbered part of some product would be so related which is purely a functional use. It is true that the selection by the appellant, of the numerical combination that is its telephone number cannot be said to have been fortuitous. It was a deliberate choice […] "because it was inherently suited to use by Pizza Pizza Limited to identify to its customers and potential customers the source of Pizza Pizza Limited's products and the quality standards which have been and are now associated with those products", and the mark is now "highly indicative of Pizza Pizza Limited and its products and distinguishes Pizza Pizza Limited's products and services from those of others".
>
> None of the foregoing evidence was contradicted nor even disputed. That being so, it is a trade mark and I fail to understand why simply because it also functions as the appellant's telephone number can deprive it of registrability as such a trade mark. It fulfils the requirements of the definition of "trade mark" in s. 2 of the Act in that it is
>
> a) a mark that is used by a person (a corporation),
> b) that it is used for the purpose of distinguishing wares manufactured or sold by it, and
> c) it distinguishes such wares from those sold by others. [pp. 361-362] [Our italics.]

Santana Jeans Ltd. v. Manager Clothing Inc. [CROSS STICH] (1993), 72 F.T.R. 241, 52 C.P.R. (3d) 472 (F.C.T.D.), J. Joyal at pages 476-477 and 478 :

> I took judicial notice during the hearing, for the current case before me, that a cross stitch used as a stitching method or as a decoration is in the public domain. The affidavit and testimony of Mme Annick Vaudelle proved that. The stitch has been used for sewing garments, embroidery, folk costumes, etc. But as the cross stitch is part of the public domain, so is a circle, a square, a line, etc. The distinctiveness in this case is measured by the capacity of the trade mark to distinguish the wares of the respondent from any other manufacturer's similar wares. Does a series of 10 cross stitches distinguish the denim clothing manufactured by Manager from denim clothing manufactured by others?
>
> The use of the stitch, not as a stitching method nor as a simple decoration, but as a distinguishing trade mark is novel and distinct of any previous use of the said stitch. The respondent claimed that its use of the stitch is such as to distinguish its denim clothing from the other manufacturers' similar wares. I agree that such use of the stich makes it registrable under the Act.

> Although the respondent is entitled to the trade mark, the use of the said stitch as a distinguishing feature will give no right to the respondent to prevent others from using the stitch's utilitarian features such as for decoration and stitching. [pp. 476-477]
>
> In this case, *the respondent's cross stitch did not serve a function as it was not used as a method of stitching nor was it merely decorative. Obviously, a cross stitch made of yellow, orange or light blue thread has the effect of decorating the ware but its main purpose was to be used as a means to distinguish the respondent's ware*. Contrary to the case in W.J. Hughes & Sons "Corn Flowers" Ltd. v. Morawiec (1970), 62 C.P.R. 21 at p. 34, 44 Fox Pat. C. 88 (Ex. Ct.), the stitch is not used for functional nor ornamentation purposes only. I come to the conclusion that the cross stitch, in this case, is not used as a stitch nor as a decoration although such purposes have been its common use for many years. Rather, the respondent has used the cross stitch as a distinguishing mark on the pockets, or along the outer seam of the legs of its denim ware. The trade mark will therefore not be expunged from the register of trade marks. [p. 478] [Our italics.]

Sun Ice Ltd. v. Kelsey Sportswear Ltd. [V-STRIPE] (1993), 61 F.T.R. 136, 47 C.P.R. (3d) 443 (F.C.T.D.), J. Joyal at page 447 :

> The other test is whether the mark is *purely ornemental or serves a functional purpose*. From the evidence before me, I see no grounds which would substantiate such a conclusion. An examination of the photographs attached to the affidavit evidence of the expert witnesses indicates to me that the mark is neither ornamental nor functional. [Our italics.]

Remington Rand Corp. v. Philips Electronics N.V [SHAVER HEAD][25] (1993), 51 C.P.R. (3d) 392, 69 F.T.R. 136, 44 A.C.W.S. (3d) 579 (F.C.T.D.); rev. (1995), 64 C.P.R. (3d) 467, 191 N.R. 204, [1995] F.C. 1660 (F.C.A.) [request for leave to appeal to the Supreme Court of Canada refused (1996), 67 C.P.R. (3d) vi (S.C.C.).], J. MacGuigan at paragraphs 18-21 :

> [18] […] If functionality goes either to the trade mark itself (*Imperial Tobacco*, and *Parke, Davis*) or to the wares (*Elgin Handles*), then it is essentially or primarily inconsistent with registration. However, if it is merely secondary or peripheral, like a telephone number with no essential connection with the wares, then it does not act as a bar to registration.
>
> [19] […] *If a mark is primarily functional as "part of the ware", the effect would be to grant applicants for registration "a monopoly on functional elements or characteristics of their wares". This would be effectively to create a patent or industrial design rather than a trade mark* : "the applicants would, in effect, have obtained patents under the guise of trade marks". In my view, that would be precisely the consequence of registration of the design trade mark in the case at bar. I cannot therefore agree with the trial judge that the design marks "contain no functional elements or components". Rather, they have an

[25] See: Diane LEDUC-CAMPBELL “Validity of 'Distinguishing Guise' Does Not Turn On Functionality” (1994), 8 *World Intellectual Property Report* 30, also available at URL www.robic.ca, under publication 142.45 (website consulted on 19990401); Diane LEDUC CAMPBELL “Federal Court of Appeal Invalidates Philips' Trademarks” (1996), 10 *World Intellectual Property Report* 69, also available at URL www.robic.ca, under publication 142.64 (website consulted on 19990401); Justine WIEBE et al. “Philips' Triple Head Shaver : When a Shave Can Be Too Close For Comfort” (1996), 3 *Intellectual Property* 120.

> intrinsinc reference to the principal functional feature of the Philips shaver, its cutting heads, which they depict. If this were a *mere* representation, it could not have the effect of preventing the appellants from producing a similar shaver with a different design mark. But the respondent agrees - indeed insists - that this is the effect of its registration of the design mark.
>
> [20] Moreover, I am not persuaded by the trial judge's alternative conclusion that there was no evidence that "utilitarian functionality dictated the design of the triple headed shaver". Shaver heads in general are utilitarian in nature, and the trial judge found that the "equilateral triangular configuration is one of the better designs for a triple headed shaver". Here, the shaver heads are functional and the three-headed equilateral triangular configuration is functional. The design mark, by depicting those functional elements, is primarily functional.
>
> [21] […] Whatever the portion of the sales market in question, registration of a primarily functional mark is a restraint on manufacturing and trade, since it effectively amounts to a patent or industrial design in the guise of a trade mark. [Our italics.]

Thus, utilitarian functionality must be distinguished from aesthetic functionality[26].

We can conclude from this case law:

- That what is used solely for decoration purposes cannot constitute a registrable[27] trade-mark. [which does not necessarily preclude registration of an aesthetically pleasing mark];
- That what is solely functional cannot constitute a registrable trade-mark[28] [which does not preclude a mark, whose utility is secondary, from being registered];

---

[26] A widely commented topic in the United States; on *utilitarian functionality* and *aesthetic functionality*, see for instance Diana Elzey PINOVER, "Aesthetic Functionality : The Need for a Foreclosure of Competition" (1993), 83 *Trademark Reporter* 571; Erin M. HARRIMAN, "Aesthetic Functionality : The Disarray Among Modern Courts" (1996), 96 *Trademark Reporter* 276; John E. McKIE, "Functionality Survives Incontestability As a Type of Constructive Abandonment Despite Shakespeare" (1996), 86 *Trademark Reporter* 304. J. Thomas McCARTHY, *McCarthy on Trademarks and Unfair Competition*, 4th ed. (St. Paul, West Group, 1996), at §7:63 to 7:93 (updated on 98/12/8) and to the excerpt of *Qualitex Co. v. Jacobson Products Co*. [GREEN-GOLD DRY CLEANING PRESS PADS] (1995), 514 U.S. 15, 115 S. Ct. 1300, 34 U.S.P.Q. (2d) 1161 (S.C.), J. Breyer at page 1163 : "The functionality doctrine prevents trademark law, which seeks to promote competition in protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature".

[27] *W.J. Hughes & Sons "Corn Flower" Ltd. v. Morawiec* [TWELVE PETALS FLOWER] (1970), 62 C.P.R. 21, 44 Fox Pat.C. 88 (Ex. Ct.), J. Gibson at pages 98-99 et 100; *Adidas (Canada) Ltd. v. Colins* [THREE PARALLEL STRIPES] (1978), 38 C.P.R. (2d) 145 (F.C.T.D.), J. Walsh at page 169. See also *Modern Houseware Imports v. Verrerie cristallerie d'Arques J.G. Durand & cie* [FLOWERS DESIGN] (1998), [1998] T.M.O.B. 74 (Opp. Board) M. Herzig, at ¶10-11.

- That if the characteristic is the result of a manufacturing process, the trade-mark cannot be registered[29];
- That if the characteristic is not merely decorative or utilitarian, then the trade-mark can be registered[30];
- That this functional nature -aesthetic or utilitarian- has to be linked to the trade-mark itself[31];
- That the functionality of the trade-mark, being aesthetic or utilitarian, must be analyzed according to the application for registration as filed or the obtained registration but not according to the means by which the trade-mark is used[32];

---

[28] See also *Carling O'Keefe Breweries of Canada Ltd. v. Goyarzu* [MOLDED INDENTATION] (1991), 36 C.P.R. (3d) 377, [1991] T.M.O.B. 166 (Opp. Board] M. Herzig at ¶8-9.

[29] *Elgin Handles Ltd. v. Welland Vale Mfg. Co. Limited* [DARKER TOOL HANDLE] (1964), 43 C.P.R. 20, [1965] Ex. C.R. 3, 27 Fox Pat.C. 168 (Ex. Ct.), J. Jackett at pages 171 and 172; See also *Dot Plastics Ltd. v. Gravenhurst Plastics Ltd.* [UPPER EDGE STRIPE] (1988), [1988] T.M.O.B. 279, 22 C.P.R. (3d) 228 (Opp. Board) G. Partington at page 231.

[30] *IVG Rubber Canada Ltd. v. Goodall Rubber Company* [HELICAL STRIPE] (1980), 48 C.P.R. (2d) 268, [1981] 1 F.C. 143 (F.C.T.D.), J. Dubé at page 146; *Samann v. Canada's Royal Gold Pinetree Mfg. Co. Ltd*. [TREE CAR FRESHNER] (1986), 8 C.I.P.R. 307, 65 N.R. 385, 9 C.P.R. (3d) 223 (F.C.A.), J. Heald at page 231, leave to appeal to the Supreme Court of Canada refused (1986), [1986] 2 S.C.R. v (S.C.C.); *Pizza Pizza Ltd. v. Canada (Registrar of Trade Marks)* [967-1111] (1989), 26 C.P.R. (3d) 355, 24 C.I.P.R. 152, 101 N.R. 378, 16 A.C.W.S. (3d) 24, [1989] 3 F.C. 379 (F.C.A.), J. Urie at page 361; *Santana Jeans Ltd. v. Manager Clothing Inc*. [CROSS STICH] (1993), 72 F.T.R. 241, 52 C.P.R. (3d) 472 (F.C.T.D.), J. Joyal at page 478.

[31] *Imperial Tobacco Company of Canada, Limted (The) v. Registrar of Trade marks* [COLOURED BAND CELLOPHANE] (1939), [1939] 2 D.L.R. 141, [1939] Ex. C.R. (Ex. Ct.), J. Maclean at pages 144-145; *Parke, Davis & Co. Ltd. v. Empire Laboratories Limited* [SEALED BANDED CAPSULES] (1963), 24 Fox Pat. C. 88, 38 D.L.R. (2d) 694, 41 C.P.R. 121, [1964] Ex. C.R. 399 (Ex. Ct.), J. Noël at page 416; *IVG Rubber Canada Ltd. v. Goodall Rubber Company* [HELICAL STRIPE] (1980), 48 C.P.R. (2d) 268, [1981] 1 F.C. 143 (F.C.T.D.), J. Dubé at page 146; *Pizza Pizza Ltd. v. Canada (Registrar of Trade Marks)* [967-1111] (1989), 26 C.P.R. (3d) 355, 24 C.I.P.R. 152, 101 N.R. 378, 16 A.C.W.S. (3d) 24, [1989] 3 F.C. 379 (F.C.A.), J. Pratte at page 356; *Remington Rand Corp. v.Philips Electronics N.V* [SHAVER HEAD] (1995), 64 C.P.R. (3d) 467, 191 N.R. 204, [1995] A.C.F. 1660 (F.C.A.), J. MacGuigan at paragraph 21.

[32] *Samann v. Canada's Royal Gold Pinetree Mfg. Co. Ltd*. [TREE CAR FRESHNER] (1986), 8 C.I.P.R. 307, 65 N.R. 385, 9 C.P.R. (3d) 223 (F.C.A.), J. Heald at page 231; *Pizza Pizza Ltd. v. Canada (Registrar of Trade Marks)* [967-1111] (1989), 26 C.P.R. (3d) 355, 24 C.I.P.R. 152, 101 N.R. 378, 16 A.C.W.S. (3d) 24, [1989] 3 F.C. 379 (F.C.A.), J. Pratte at pages 356-357 and J. Urie at pages 361-362. See also *American Fork & Hoe Co. v. Lansing Engineering Ltd*. [TRIPLE TAPER] (1947),

- That this evidence of functionality must be made and cannot be inferred[33];
- That in principle a trade-mark cannot be used as a pretext to extend the effective life of a patent or of an industrial design which has expired, however actions on such trade-marks should not automatically be dismissed without a consideration of standard trade-mark principles relating to distinctiveness and functionality[34].

2.2 USE

[1948] 2 D.L.R. 298, 7 Fox Pat.C. 75, 7 C.P.R. 51 (Ex. Ct.), J. Cameron at pages 56 and 57; conf. (1948), [1948] 3 D.L.R. 865, 9 Fox Pat.C. 1, 8 C.P.R. 1 (S.C.C.); "Where the trade-mark itself is per se not functional, it does not become functional simply because, when applied to the wares, in combination with other elements, it becomes functional" : Roger T. HUGHES et al., *Hughes on Trade Marks* (Toronto, Butterworths, 1984), §12, note 14 (updated 36 in 3/98).

[33] *Santana Jeans Ltd. v. Manager Clothing Inc*. [CROOS STICH] (1993), 72 F.T.R. 241, 52 C.P.R. (3d) 472 (F.C.T.D.), J. Joyal at page 476; *Sun Ice Ltd. v. Kelsey Sportswear Ltd.* [V-STRIPE] (1993), 61 F.T.R. 136, 47 C.P.R. (3d) 443 (F.C.T.D.), J. Joyal at page 447. See also *Dot Plastics Ltd. v. Gravenhurst Plastics Ltd*. [UPPER EDGE STRIPE] (1988), [1998] T.M.O.B. 279, 22 C.P.R. (3d) 228 (Opp. Board), G. Partington at page 231.

[34] *Imperial Tobacco Company of Canada, Limted (The) v. Registrar of Trade marks* [COLOURED BAND CELLOPHANE] (1939), [1939] 2 D.L.R. 141, [1939] Ex. C.R. (Ex. Ct.), J. Maclean at pages 144-145; *Parke, Davis & Co. Ltd. v. Empire Laboratories Limited* [SEALED BANDED CAPSULES]. (1964), 27 Fox Pat. C. 67, 45 D.L.R. (2d) 97, 43 C.P.R. 1, [1964] S.C.R. 351 (S.C.C.), J. Hall at page 356; *Pizza Pizza Ltd. v. Canada (Registrar of Trade Marks)* [967-1111] (1989), 26 C.P.R. (3d) 355, 24 C.I.P.R. 152, 101 N.R. 378, 16 A.C.W.S. (3d) 24, [1989] 3 F.C. 379 (F.C.A.), J. Pratte at pages 356-357; *Remington Rand Corp. v. Philips Electronics N.V* [SHAVER HEAD] (1995), 191 N.R. 204, [1995] A.C.F. 1660, 64 C.P.R. (3d) 467 (F.C.A.), J. MacGuigan at pages 476-477. See also *Thomas & Betts, Ltd. v. Panduits Corp*.[OVAL SHAPE HEAD] (1997), 129 F.T.R. 185, 74 C.P.R. (3d) 185 (F.C.T.D.), J. Richard at page 198; rev. (2000) 4 C.P.R. (4th) 498 (F.C.A.); application for leave to appeal to the Supreme Court of Canada filed on March 8, 2000 (Court File No. 27789). See also Gregory C. LUDLOW, "Survey of Intellectual Property : Part II – Trade-marks Suitability of Application and Validity of Registrations" (1995), 27 *Ottawa Law Review* 339, at page 342 : "The Court also concluded that the two-dimensional trade-mark registrations possessed by Philips would prevent Remington from marketing a shaver with three rotary blades arranged in equilateral triangular configuration".

We saw that a trade-mark must distinguish the wares or services of a person from those of others. The trade-mark must also be *used*, at least in the technical sense given by the *Trade-marks Act*[35].

Thus, with respect to *wares*, a trade-mark is deemed used[36] if, at the moment of the transfer of ownership or possession of the wares, it is marked on or somehow associated with the wares in a manner that gives notice of the connection between the wares and the trade-mark[37].

With respect to *services*, a trade-mark is deemed used if it is shown during the performance of the services or through advertising. However, in order to constitute use of the trade-mark, its advertisement must be associated to the performance of services in Canada[38].

---

[35] Section 2 TMA: "use", in relation to a trade-mark, means any use that by by section 4 is deemed to be a use in association with wares or services. Paragraphs 4(1) and 4(2) TMA : 4(1) " A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is *marked* on the wares themselves or on the packages in which they are distributed or *it is in any other manner so associated* with the wares that notice of the association is then given to the person to whom the property or possession is transferred". 4(2) "A trade-mark is deemed to be used in association with services if it is *used* or *displayed* in the performance or advertising of those services".

[36] For a critique of the jurisprudential interpretation of the notion of 'use' see Daniel R. BERESKIN "Trade-Mark Use" in *Trade-Marks Law of Canada*, collection Henderson (Toronto, Carswell, 1993), ch. 4, pp. 109-112, republished under the title "Trade-Mark 'Use' in Canada" (1997), 87 *Trademark Reporter* 301, at pages 305-309; Hugues G. RICHARD "The definition of 'Use' May Alter Section 20 Infringements of the Trade-marks Act" (1995), 2 *Intellectual Property* 60 and François GUAY "Pour en finir avec l'affaire Clairol: l'article 22 de la *Loi sur les marques de commerce* prévient-il la publicité comparative?" (1999), 11 *Les cahiers de propriété intellectuelle* 441.

[37] "Thus, the placing of the mark on a bottle cap, a label, packages and invoices, shrink-wrapped with an article displaying the trade-mark, on a computer program […] or on tare slips wherein bulk products are weighed or on sealing tape placed across the carton containing the wares is sufficient use of the mark" : Roger T. HUGHES et al., *Hughes on Trade Marks* (Toronto, Butterworths, 1984), at §18, omissions of the notes (updating 37 in 7/98).

[38] See for example *Cornerstone Securities Canada Inc. v. Smart & Biggar* [CORNERSTONE] (1994), 58 C.P.R. (3d) 417, 87 F.T.R. 300 (F.C.T.D.), J. Weston at ¶8; *Porter v. Don the Beachcomber* [DON THE BEACHCOMBER] (1966), 33 Fox Pat. C. 79, 48 C.P.R. 280, [1966] Ex. C.R. 982 (Ex. Ct.), J. Thurlow at page 988, *Marineland Inc. v. Marine Wonderland & Animal Park Ltd.* [MARINELAND] (1974), 16 C.P.R. (2d) 77, [1974] 2 F.C. 558 (F.C.T.D.), J. Cattanach at pages 569-572.

Thus, advertising alone does not constitute use of a trade-mark in association with wares. The trade-mark must be used in a manner to distinguish the wares or services at the moment of the transfer of ownership[39].

The question arises as to marks that are reproduced on merchandising products such as T-shirts, pens, caps, taking into consideration that such products are often given away for free. Is it a matter of a creative use of the rights provided by the *Trade-marks Act*, distinguishing the source of a product, or of something else, like an ornemental use[40]?

This determination will depend, most of the time, on the circumstances of the reproduction, on the transfer of ownership and of the nature of the proceedings (application for registration, opposition, expungement, infringement action). The case law in Canada on this point emanates principally from the Oppositions Board and it suggests that what must be determined is whether the marking of a trade-mark in a prominent manner on such merchandise (generally linked to a sales program), constitutes "use" to "distinguish" (as apposed to simply ornamental use which is particularly true for graphic marks[41]) notwithstanding its primarily ornamental function[42].

---

[39] See *Farodo Ld.'s Application* (1945), 62 R.P.C. 111 (Chan. Div. England), lord Evershed at page 123; "It is not uncommon to-day for manufacturers of or traders in goods of a specific class to advertise their wares by the distribution as gifts of goods, e.g., pencils or matches, bearing their name or their trade mark though such last mentioned goods are wholly different in character from their own goods. […] A member of the public seing goods of the characater of those comprised in classes 5 or 34 bearing the name "Ferodo" might suppose that such goods were being distributed as part of an advertising campaign [for the FERODO brake linings]".

[40] "Rather, I believe there is at least an arguable case to the effect that this is a mere decoration of the articles in question and does not constitute trade mark use in the sense of making the articles to which such decoration is applied distinctive of the Montreal Expos or whatever other club be involved" : Paul V. GADBAN "Thoughts on Trade Mark Use Following Pharmaco" (1982), 8-13 *Patent and Trademark Institute of Canada Bulletin* 630, at pages 637-638.

[41] But does not exclude nominal trade-marks, especially when they are unfortunately included in a slogan. : *Part I Knitting Ltd. v. Tetra Music Ltd.* [CAUTION] (1992), 43 C.P.R. (3d) 154 (Opp. Board) D. Martin at page 158 and *Everything for a Dollar Store (Canada) Inc. v. Dollar Plus Bargain Centre Ltd.* [MORE THAN A DOLLAR STORE] (1998), [1998] T.M.O.B. 73 (Opp. Board), G. Partington at ¶10. See also C. Lloyd SARGINSON, "Color, Slogans & Shapes As Trademarks – The Transition from Non-traditional to Traditional", in *1997 INTA Mid-Year Meeting – Course Materials* (Rio Grande, INTA, 1997), pp.15-25, at pages 19-21.

[42] *Miller Brewing Co. Ltd. v. Labatt Brewing Co.* [ALL YOU WANT IN BEER] (1991), 36 C.P.R. (3d) 400, [1991] T.M.O.B. 116 (Opp. Board), D. Savard at ¶7; *Part I Knitting Ltd. v. Tetra Music Ltd.* [CAUTION] (1992), 43 C.P.R. (3d) 154 (Opp. Board), D. Martin at page 158; *Body Shop International PLC v. K Mart Canada Ltd.* [BODY COMPANY] (1993), 46 C.P.R. (3d) 556 (Opp. Board), G. Partington at page 559;

Consequently, if the presence of a trade-mark on merchandising products is not considered "use" in the sense of paragraph 4(1) of the *Trade-marks Act*[43], the registration of a trade-mark for such merchandising products is going to be vulnerable to administrative[44] or judicial[45] expungement procedures for non-use[46]. On the other hand, such a use could be acceptable in the case of trade-marks for services[47].

Lapointe, Rosenstein v. Bum Wrap Clothing Store [THE BUM WRAP] (1995), 63 C.P.R. (3d) 564 (Opp. Board), D. Savard at pages 568-569; *Philips, Friedman and Kotler v. Blackcomb Skiing Enterprises* [SOLAR COASTER] (1995), [1995] T.M.O.B. 141 (Opp. Board), D. Savard at ¶9; *Philips, Friedman and Kotler v. Blackcomb Skiing Enterprises* [SOLAR COASTER] (1995), [1995] T.M.O.B. 140 (Opp. Board), D. Savard at ¶9; *Thomas J. Lipton v. The HVR Co.* [TAKE HEART] (1995), 64 C.P.R. (3d) 552, [1995] T.M.O.B. 169 (Opp. Board), D. Martin at ¶8 and 9; *Molson Breweries v. Moosehead Breweries Ltd*. [WHAT BEER IS NOW] (1995), 64 C.P.R. (3d) 560, [1995] T.M.O.B. 173 (Opp. Board) M. Herzig at ¶6; *Skydome Corporation v. Toronto Heart Industries Ltd.* [TORONTO COME TO PLAY] (1998), [1998] T.M.O.B. 203 (Opp. Board), D. Savard at ¶16; *Canadian Tire Corp. Ltd. v. Max Rittenbaum Inc.* [THE RIGHT CHOICE] (1998), [1998] T.M.O.B. 201 (Opp. Board), D. Martin at ¶17.

[43] Daniel R. BERESKIN “Trade-mark Use”, in *Trade-mark Law of Canada,* collection Henderson (Toronto, Carswell, 1993), pp. 97-112, republished under the title “Trade-Mark ‘Use’ in Canada” (1997), 87 *Trademark Reporter* 301; Sheldon BURSHTEIN, “Trade-Mark Use in Canada : The Who, What, Where, When, Why and How – Part I” (1998), 11 *Intellectual Property Journal* 229, at pages 236-237; Paul V. GADBAN “Thoughts on Trade Mark Use Following Pharmaco” (1982), 8-13 *Patent and Trademark Institute of Canada Bulletin* 630, at pages 637-639; Barry GAMACHE, “La protection des marques de commerce sur les articles de promotion : un débat à faire” (1994), 3-2 *Update/Résumé de la Section nationale de propriété intellectuelle de l’Association du Barreau canadien*, pp. 4-6, also available at URL www.robic.ca, under publication 171.1 (website consulted on 19990401); John R. MORRISSEY “Double Trademarking” (1982), 9-15 Patent and Trademark Institute of Canada Bulletin 957, also published under the title “Double Trademarking in Canada” à (1983), 73 *Trademark Reporter* 28; Donna G. WHITE, “Potential Pitfalls in the Protection of Merchandising Marks in Canada” (March 1994), *Trademarks America* 8, also published at (1994), 65 *Trademark World* 22.

[44] Section 45 TMA.

[45] Section 57 TMA, on the basis of paragraph 18(1) TMA.

[46] This would also constitute a good ground of opposition to the registration of such a trade-mark, that the applicant would not have used the trade-mark since the date of the alleged first use. : paragraphs 38(2)a) and 30b) TMA.

[47] Paul V. GADBAN “Thoughts on Trade Mark Use Following Pharmaco” (1982), 8-13 *Patent and Trademark Institute of Canada Bulletin* 630, at page 637.

3 COLOURS

Traditionally, a trade-mark can be composed of a few colour elements, either for the whole or a part of the word portion[48], or the graphic portion[49]. But what about the trade-mark that, without any other distinguishing feature, would consist only of a simple colour?

Except if it is limited to a particular colour, the registration of a trade-mark generally provides its owner with an exclusive right to use the trade-mark in all colours[50].

Moreover, the registration of a particular colour will give to its owner an exclusive right to use this colour in all its variations of shades[51].

When, in an application for registration, the applicant claims a colour as the trade-mark's characteristic, this colour must be described[52]. If the description is unclear, the

---

[48] See for instance, the yellow GOLDEN ARCHES for McDonald's Corporation's clothing (registration TMA 387318 and 299634).

[49] [TRANSLATION] "The cone is yellow, St-Hubert and the hair are red, the hand and the upper face are white, the beak is gold, the eyes and the bow tie are black" : Registration TMA 316852 of the ST-HUBERT trade-mark (& graphics) of the Restaurant Groupe St-Hubert Inc. Also, consider the RED DOT of the umbrellas of Knirps International GmBH (Registration 158783) as well as the red dot of the steel products of the Group Canam-Manac Inc. (application 889216).

[50] *Smith v. Fair* [RED SEAL] (1887), 14 O.R. 729 (Ont. Chan. Div.), J. Proudfoot at page 733; *Tavener Rutledge Ld. v. Specters Ld.* [TAVENER DROPS] (1959), [1959] R.P.C. 385 (C.A. England), J. Evershed at pages 358-359; confirming (1959), [1959] R.P.C. 83 (Chan. Div. England); *IVG Rubber Canada Ltd. v. Goodall Rubber Company* [HELICAL STRIPE] (1980), 48 C.P.R. (2d) 268, [1981] 1 F.C. 143 (F.C.T.D.), J. Dubé at page 146; Harold G. FOX, *The Canadian Law of Trade Marks and Unfair Competition*, 2nd ed. (Toronto, Carswell, 1967), at page 230.

[51] *Parke, Davis & Co. Ltd. v. Empire Laboratories Limited* [SEALED BANDED CAPSULES] (1963), 24 Fox Pat. C. 88, 38 D.L.R. (2d) 694, 41 C.P.R. 121, [1964] Ex. C.R. 399 (Ex. Ct.), J. Noël at page 419; confirmed on a different point (1964), 27 Fox Pat. C. 67, 45 D.L.R. (2d) 97, 43 C.P.R. 1, [1964] S.C.R. 351 (S.C.C.).

[52] Paragraph 28(1) of the *Trade-Marks Regulations (1996)*; hereinafter the "Regulations". For instance, the registration TMA 494137 of Canon K.K. for laser printers addressing a trade-mark described as : "The trademark is comprised of 9 overlapping lenticular shaped figures, 3 oblong bars, and a central triangular shaped figure" claims the following colours : "From the top of the trade-mark moving in a clockwise direction, the three topmost lenticular shaped figures are gold, blue and violet. From the top of the trade-mark moving in a clockwise direction, the three next underlying lenticular shaped figures are green, purple and orange. From the top of the trade-mark moving in a clockwise direction, the three bottom-most lenticular shaped figures are red, mustard and turquoise. The three oblong bars separating the gold and blue, blue and purple, and violet and orange lenticular shaped figures are black. The central triangular shaped figure is white". In short, a drawing is required…

registrar can require the production of a dotted drawing representing the colour according to a concordance chart[53].

A trade-mark consisting of one or more colours in a particular presentation[54] is thus possible. In the same manner, the positioning of the colours on a product[55] can also be registered.

However, as important as the colour can be for its "user", a colour alone will not be, as such, the object of a trade-mark[56], a trade-mark has to be distinct[57] from the

---

[53] Paragraph 28(2) of the Regulations.

[54] Consider for instance, the blue and red rectangle of Tommy Hilfiger Licensing, Inc (registrations TMA 432095 and TMA 482283), the blue and gold strips of Visa International Service Association (registration TMA 160565) or to the black and copper batteries of Duracell International Inc. (registration TMA 246861).

[55] "(…) distinguish between colour as the whole subject of a trade-mark - such as a coloured label - and colour applied to one particular feature or element in a manufactured article" : *Wrights' Ropes Limited v. Broderick & Bascom Rope Co* [YELLOW STRAND IN A ROPE] (1931), [1931] Ex. C.R. (Ex. Ct.) J. MacLean at page 145 and the registration TMDA 048989 ; "Description of the trade-mark : A yellow coloured strand running through a length of wire rope, no claim being made to the representation of a wire rope as shown in the accomapnying drawing apart from the presence of the yellow strand". See the registration TMDA 050742 of Uniontools, Inc. for handles of gardening tools : «A green coloured band which is applied about the knob end of a tool handle and a green coloured band which is applied to the ferrule of the tool handle with a natural wood finish separating the said green coloured bands". See also *IVG Rubber Canada Ltd. v. Goodall Rubber Company* [HELICAL STRIPE] (1980), [1981] F.C. 143 (F.C.T.D.), J. Dubé at page 146 and registration TMA 245066. See also *Reddaway (F.) & Co. Limited's Application* [BLUE RED BLUE LINES] (1914), 31 R.P.C. 147, [1914] 1 Ch. 859 (Chan. Div. England), J. Warrington at page 862.

[56] "[…] the adoption by the plaintiff on such a package of colour alone is not sufficient to constitute a trade mark […]". : *Parke Davis & Co. Ltd. v. Empire Laboratories Ltd.* [SEALED BAND CAPSULES] (1963), [1964] Ex. C.R. 399 (Ex. Ct.), J. Noël at page 413. See also : Hanson's Trade Mark [RED, WHITE, and BLUE] (1887), [1888] R.P.C. 130 (Chan. Div. England), J. Jay at page 132; Harold G. FOX, *The Canadian Law of Trade Marks and Unfair Competition*, 2nd ed. (Toronto, Carswell, 1967), at page 231. For an American perspective before the case *Qualitex*, see Thomas A. SCHMIDT, "Creating Protectible Color Trademarks" (1991), 81 *Trademark Reporter* 285, at page 301 : "Traditionally, the mere color rule operated to bar the registration of color marks. The mere color rule is based upon the color depletion theory, the functionality doctrine and shade confusion concerns".

[57] See Iver P. COOPER, "Trademark Aspects of Pharmaceutical Product Design" (1980), 70 *Trademark Reporter* 1, at page 9 : "When a medicinal component of a drug is inherently colored, that color cannot acquire trademark significance. Thus, the yellow of sulfur, the blue of cupric sulfate, and the vivid red of mercuric iodide cannot

product that is meant to be protected[58]. We must not confuse the colour as a trade-mark and the colour of the trade-mark[59].

Therefore, a trade-mark consisting of a particular colour applied to a particular shape[60] could be registered. It is not because the colour covers the entire product that the trade-mark cannot be registered[61].

---

be appropriated as trademarks for the corresponding medicinals [H.C. Ansel, *Introduction to Pharmaceutical Dosage* Forms (1959), at 68]".

[58] "Although a color applied to the visible surface of a tablet having a particular shape can function as a trade mark, it is not the type of trade mark which is readily identifiable as a mark because it is coextensive with the product itself" : *Novopharm Ltd. v. Burroughs Wellcome Inc*. [BLUE SHIELD-SHAPE TABLET] (1993), 52 C.P.R. (3d) 263 (Comm opp.), D. Martin at pages 271-272; conf. (1994), 58 C.P.R. (3d) 513 (F.C.T.D.), J. McKeown at pages 520 and 521; withdrawal of the appeal A-717-94 produced on December 11, 1997. See also *Smith, Kline and French Laboratories Ltd. v. Sterling-Winthrop Group Ltd.* [MAROON AND TRANSPARENT CAPSULE WITH YELLOW PELLETS] (1971), [1972] R.P.C. 247 (Registrar); conf. (1973), [1973] 1 W.L.R. 1534, [1974] R.P.C. 91 (Chan. Div. England); rev. (1975), [1975] 1 W.L.R. 801, [1975] F.S.R. 298, [1976] R.P.C. 511-513 (C.A. England); rev. (1975), [1975] 1 W.L.R. 914; [1975] 2 All E.R. 578, 119 S.J. 422, [1976] R.P.C. 511-533 (H.L.), Lord Diplock at page 537.

[59] "As submitted by plaintiff's counsel, one must indeed distinguish between colour as a trade mark and colour of a trade mark" : *Parke, Davis & Co. Ltd. v. Empire Laboratories Limited* [SEALED BAND CAPSULES] (1963), 24 Fox Pat. C. 88, 38 D.L.R. (2d) 694, 41 C.P.R. 121, [1964] Ex. C.R. 399 (Ex. Ct.), J. Noël at page 415. On the subject of colours, shapes and flavours of pharmaceutical preparations see : *Apotex Inc.* v. *Ciba-Geigy Canada Ltd. and Registrar of Trade-maks* (2000/04/14) T-2483-97 (F.C.T.D.); *Fournier Pharma Inc. et al.* v. *Apotex Inc.* (1999) 1 C.P.R. (4th) 344 (F.C.T.D.); *Novopharm Ltd.* v. *Astra Aktiebolag* (1999) 1 C.P.R. (4th) 403 (T.M.O.B.); *Novopharm Ltd.* v. *Astra Aktiebolag* (1999) 1 C.P.R. (4th) 397 (T.M.O.B.); *Fournier Pharma Inc. et al.* v. *Apotex Inc.* (1999) 2 C.P.R. (4th) 351 (F.C.T.D.); *Novopharm Ltd.* v. *Bayer Inc.*(1999) 3 C.P.R. (4th) 305 (F.C.T.D.). See also Bob H. SOTIRIADIS and Julie LAROUCHE, "Colours, Shapes and Flavour as Trademarks for Pharmaceutical Preparations" in *World Markets Series Business Briefing PharmaTech* (2000).

[60] Consider this "The trade mark consists of the colour blue applied to the whole of the visible surface of the tablet" for the Naproxen Sodium tablets of Hoffmann- La Roche Limitée, object of the registration TMA 346 453; "The block shown in dotted outline does not form part of the trade-mark; the drawing is lined for the colour pink" for the fibreglass insulate of Owens-Corning Canada inc, object of registration TMA 433100; "The trade-mark shown in the drawing consists of the colour canary yellow applied to the whole of the visible surface of the stationery notes. The representation of the stationary notes shown in the dotted outline does not form part of the trade mark" for the adhesive notes POST-IT of Minnesota Mining and Manufacturing Company, object of the registration TMA 477683. See also J. Thomas McCARTHY, *McCarthy on Trademarks and Unfair Competition*, 4th ed. (St. Paul, West Group,

Moreover, such trade-marks can attract secondary meaning[62].

An important *corpus* of jurisprudence has been developped, principally if not exclusively in the pharmaceutical domain, on some "technicalities" relative to the description of such trade-marks[63]. Thus, a drawing of the trade-mark (accurate

---

1996), at §7:40 (updating 4 in 12/97 : "To the author's knowledge, no [American] court has granted a company the exclusive right to use a color per se, apart from being defined as the coloration of a specific product, shape or design".

[61] "I have concluded that the application in question here is not for a trade mark which would "reside in in colour alone". As qoted above, the trade mark whose registration as sought is a particular colour of green applied to a particular size and shape of tablet. I would not preclude registration simply on the basis that the colour is applied to the whole of the exterior of the tablet and not to some part of it alone". : *Smith Kline & French Canada Ltd. v. Canada (Trade-marks Registrar) [N° 2]* [GREEN TABLET] (1987), 12 C.I.P.R. 204, 9 F.T.R. 129, [1987] 2 F.C.633 (F.C.T.D.), J. Dubé at page 636 invalidate (1984), 10 C.P.R. (3d) 246 (Registrar). See also *Smith, Kline and French Laboratories Ltd. v. Sterling-Winthrop Group Ltd.* [MAROON AND TRANSPARENT CAPSULE WITH YELLOW PELLETS] (1975), [1975] 1 W.L.R. 914; [1975] 2 All E.R. 578, [1976] R.P.C. 511-533 (H.L.), Lord Diplock at page 534.

[62] See *Ciba-Geigy Canada Ltd. v. Apotex Inc.* [BLUE METROPOL TABLET] (1992), 44 C.P.R. (3d) 289, J.E. 92-1624, 143 N.R. 241, 95 D.L.R. (4th) 385, 58 O.A.C. 321, 36 A.C.W.S. (3d) 508, [1992] 3 S.C.R. 120 (S.C.C.), J. Gonthier at pages 141-143; *CIBA-Geigy Canada Ltd. v. Novopharm Ltd.* [PINK ROUND BICONVEX DICLOFENAC TABLETS] (1993), 52 C.P.R. (3d) 497 (F.C.T.D. – temporary injunction); (1994), 83 F.T.R. 161, 56 C.P.R. (3d) 289 (F.C.T.D. – interlocutory injunction), J. Rothstein at pages 315 and 320 : "While with more than one colour, a tablet might be more striking or unusual and therefore more easily associated with trade source, nothing in the authorities precludes appearance of a single-coloured tablet from attracting a secondary meaning." ; (1994), 83 F.T.R. 233, 56 C.P.R. (3d) 344 (F.C.T.D.); (1997), 77 C.P.R. (3d) 428 (F.C.T.D.). See also *Smith Kline & French Inter-American Corporation v. Chiefetz* [ORANGE AND WHITE PELLETS IN BROWN AND TRANSPARENT CAPSULE] (1964), 46 C.P.R. 86 (Sup. Ct.), J. St-Germain at page 90.

[63] See for instance : *Novopharm Ltd. v. Burroughs Wellcome Inc*. [BLUE SHIELD-SHAPE TABLET] (1993), [1993] T.M.O.B. 400, 52 C.P.R. (3d) 263 (Opp. Board), D. Martin at pages 267-268; conf. (1994), 58 C.P.R. (3d) 513 (F.C.T.D.), J. McKeown at pages 520 et 521; withdrawal of appeal A-717-94 produced on December 11, 1997 (application TMO 593889). See also *Novopharm Ltd. v. Searle Canada Inc.* [YELLOW TABLET] (1995), 60 C.P.R. (3d) 400,[1995] T.M.O.B. 15 (Opp. Board), M. Herzig at pages 2-3 (application TMO 637454); *Apotex Inc. v. Burroughs Wellcome Inc.* [BLUE SHIELD TABLET] (1996), 68 C.P.R. (3d) 521, [1996] T.M.O.B. 86 (Opp. Board), M. Martin at page 3 (application TMO 688591); *Novopharm Ltd. v. Bayer Inc* [DUSTY ROSE TABLET] (1996), [1996] T.M.O.B. 256 (Opp. Board), M. Herzig at page 3 (application TMO 657397); *Novopharm Ltd. v. Hoechst Aktiengesellschaft* [PINK TABLET] (1997), [1997] T.M.O.B. 57 (Opp. Board), D. Martin at page 3

representations of the trade-mark as well) is required from the applicant[64] in order to describe precisely the trade-mark that he wants to register[65]. In practice[66], a drawing

---

(application TMO 671135); *Apotex Inc. v. Searle Canada Inc.* [WHITE HEXAGONAL TABLET] (1997), [1997] T.M.O.B. 306 (Opp. Board), D. Martin at page 3 (application TMO 722 545); *Novopharm Ltd. v. Ciba-Geigy Canada Ltd*. (1997), 81 C.P.R. (3d) 558, [1997] T.M.O.B. 221 (Opp. Board), M. Herzig at pages 2-3, appeals T-2483-97 and T-4282-97 (applications TMO 630536 [PINK TABLET] and TMO 630537 [PINK TRIANGULAR TABLET]); *Novopahrm Ltd. v. Astra Aktiebolag* [BROWN-PINK CAPSULE] (1997), [1997] T.M.O.B. 303 (Opp. Board), M. Herzig at pages 2 and 3, appeal T-224-98 (application TMO 692410).

[64] Paragraph 30h) of the *Trade-marks Act* (R.S.C. 1985, c. T-13); hereinafter the Act or TMA. In practice, the examiner will also require a dotted drawing showing a three-dimensional perspective of the trade-mark as well as a declaration according to which the representation by the dotted lines is not part of the trade-mark. : see *Trademark Examination Manual*, 2nd ed. (Hull, Approvisionnement et Service Canada, 1996), at §IV.2.4. If the case arises, if the trade-mark is already used, the examiner can require the production of specimen showing how the trade-mark is used. : paragraph 29c) of the Regulations.

[65] "In the present case, the drawing is too imprecise to make the applicant's description of its trade mark meaningful. The applicant should have provided a drawing showing the trade mark in three dimensional perspective. Alternatively, the applicant could have provided several two dimensional representations of the mark from different perspectives. A less satisfactory alternative might have been to provide a detailed written description of the shape of the mark and rely on the single drawing already filed. A further alternative along those lines woud be to have delineated the shape of the trade mark in the written description by reference to the specimens filed […] In any event, s. 30 (h) requires that the present applicant provide a drawing of the trade mark which, either by itself or in conjunction with the description of the trade mark in the application, delinates the shape of the trade mark claimed" : *Novopharm Ltd. v. Burroughs Wellcome Inc*. [BLUE SHIELD-SHAPE TABLET] (1993), 52 C.P.R. (3d) 263 (Opp. Board), D. Martin at page 268; conf. (1994), 58 C.P.R. (3d) 513 (F.C.T.D.), J. McKeown at pages 520 and 521; withdrawal of appeal A-717-94 produced on December 11, 1997 (application TMO 593889).

[66] In a draft of practice notice of the 1999-01-27, the Trade-marks Office proposes, under the title *La couleur appliquée à l'objet en son entier*, que : «Lorsqu'une marque de commerce consiste seulement en une couleur particulière appliquée à la surface visible d'un objet particulier, celle-ci n'est pas considérée être un signe distinctif. Afin qu'une telle marque soit enregistrable, la demande doit contenir i) un ou des dessins démontrant les aspects visibles de l'objet, et ii) une description indiquant que la marque de commerce consiste en la couleur appliquée à l'objet montré dans le dessin. La description et le dessin doivent par eux-mêmes complètement définir en quoi consiste la marque de commerce, et alors que le Bureau pourrait exiger des spécimens, la description de la marque ne doit pas faire référence à des spécimens. Voici un exemple d'une description acceptable : «La marque de commerce consiste en la couleur pourpre appliquée à la surface visible de la pilule montrée dans le dessin {see *Smith, Kline & French v. Registrar*, [1987] 2 F.C. 633.**}».**

precisely representing one of the product's perspectives on which the colour is marked[67] will be considered sufficient so long as a specimen of the product, as used[68], is produced and the application for registration includes a description of the trade-mark referring to the specimen of the product[69].

The colour that we want to register, of course, will have to be distinctive of the product associated with it. Some colours are, in fact, recognized in some industries to have a particular signification and cannot for that reason distinguish a person's products or services from those of another[70].

Having said this, a colour which is only functional[71] cannot be the object of a trade-mark because, by its functionality, it cannot be used to distinguish the wares or services of a person from those of others[72]. However, the functionality of the trade-

---

[67] In this respect, the Trade-marks Office does not require a precise description of the shade of colour; however, if an applicant wants to refer to the colours PANTONE, he/she will have to indicate that it is a matter of a trade name ; for the indication of different variations of colours, see *Pantone, the Power of Color* URL http://www.pantone.com/aquapage.asp (website consulted on 19990401).

[68] Which seems to be very difficult for a proposed trade-mark in the sense of paragraph 16(3) TMA…

[69] *Novopharm Ltd. v. Bayer Inc* (1996), [1996] T.M.O.B. 256 (Opp. Board), M. Herzig at page 3 [DUSTY ROSE TABLET] (application TMO 65739).

[70] "It is increasingly recognized that certain colours are more appropriate than others for the packaging of particular goods. Yellow is obviously appropriate for a lemon-flavoured drink, brown for potato products, and green for vegetable such as beans and peas" : Christopher WADLOW, *The Law of Passing-Off*, 2nd ed. (Londres, Sweet & Maxwell, 1995), at §6.66. In the Australian case *Aktiebolaget Astra v. Glaxo Group Ltd.* (1995), [1995] A.T.M.O 40 (Trade-marks Office); conf. (1996), 33 I.P.R. 123, the registration of the shades of blue and brown for asthma inhalers has been refused on the ground that, in this branch of the industry, the colour blue signified a relief aspect and the colour brown preventive aspect of the therapy.

[71] For instance, an amber bottle for beer would be functional since it would be used to protect the beer from the light (avoiding the 'skunky flavour' that is disgusting for the real beer consumers) ; the blue dot on the flash of a camera indicates leaks ; the red strip on the cellophane that wraps the pack of cigarettes and shows where exactly we must tear the cellophane ; the colour black for speedboat motors because this colour has the effect to diminish the visible size of the motor and to blend with other boats.

[72] *Parke, Davis & Co. Ltd. v. Empire Laboratories Limited* [SEALED BANDED CAPSULES]. (1964), 27 Fox Pat. C. 67, 45 D.L.R. (2d) 97, 43 C.P.R. 1, [1964] S.C.R. 351 (S.C.C.), J. Hall at page 354 "The validity of the trade marks may, in my view, be disposed of on the ground that the coloured bands have a functional use or characteristics and cannot, therefore, be the subject matter of a trade mark. The law appears to be well settled that if what is sought to be registred as a trade mark has a functional use or characteristic, it cannot be the subject of a trade mark"; confirms (1963), 24 Fox Pat. C. 88, 38 D.L.R. (2d) 694, 41 C.P.R. 121, [1964] Ex. C.R. 399

mark (aesthetic or utilitarian) will preclude its registration only if it is related to the trade-mark itself[73] and not to an incidental or a secondary aspect of the trade-mark[74]. Furthermore, the functional aspects of a colour extend to the indication of the quality of the product rather than the source of the product[75].

The lack of Canadian case law[76] justifies our looking to U.S. law for help and in particular to two recent cases[77] and recent doctrine[78]. However we should be very

---

(Ex. Ct.), J. Noël at pages 416 "[…] in this case the coloured gelatin band is used to close the gelatin capsule" and 418-419 "We have seen that the colour banded capsules of the plaintiff have many utilitarian functions and that even the presence of colour on the bands is useful in enabling the easy detection of a break on the band".

[73] Consider this summary of the question in American law: "A color that performs some utilitarian function in connection with a product cannot be appropriated as a trademark under the general rule that no functional feature can be a valid trademark. […] while the majority of courts have defined "functionality" to cover only features that directly contribute to the utilitarian functionality of the product. […] When color is used only to indicate a characteristic of the product, such as size, capacity or strenght, it is functional" : J. Thomas McCARTHY, *McCarthy on Trademarks and Unfair Competition* (St. Paul, West Group, 1996), at §7:49 (updating 8 in 12/98).

[74] *Remington Rand Corp v. Philips Electronics N.V*. [SHAVER HEAD] (1995), 64 C.P.R. (3d) 567, at page 475; *Samann v. Canada's Royal Gold Pinetree Mfg. Co. Ltd* (1985), 4 C.I.P.R. 17, 3 C.P.R. 313 (F.C.T.D.); rev. (1986), 65 N.R. 385, 8 C.I.P.R. 307, 9 C.P.R. (3d) 223 (F.C.A.), J. Heald at page 231; leave to appeal refused 72 NR 159n (S.C.C.) [CAR FRESHNER]; Angela FURLANETTO "Prescription Pharmaceuticals and the Passing Off Action" (1996), 11 *Intellectual Property Journal* 70, at page 105.

[75] See Harold G. FOX, *The Canadian Law of Trade Marks and Unfair Competition*, 3d ed. (Toronto, Carswell, 1972), at page 39 and Roger T. HUGHES et al, *Hughes on Trade Marks* (Toronto, Butterworths, 1984), §12, note 13 (updating 36 in 3/98). See also Stephen MOHR et al., *U.S. Trade Dress Law : Exploring the Boundaries* (New York, INTA, 1997), at pages 148-150 et J. Thomas McCARTHY, *McCarthy on Trademarks and Unfair Competition* (St. Paul, West Group, 1996), at §7:49 (updating 8 in 12/98)

[76] If we except the pharmaceutical contentious, which up to now, seems to be a matter of procedure.

[77] *Owens-Corning Fiberglass Corp. (Re)* (1984). 221 U.S.P.Q. 417 (T.T.A.B.); rev. (1985), 774 F.2d 1116, 227 U.S.P.Q. 417 (C.A.F.C.); *Qualitex Co. v. Jacobson Products Co.* [GREEN-GOLD DRY CLEANING PRESS PADS] (1995), 514 U.S. 15, 115 S. Ct. 1300, 34 U.S.P.Q. (2d) 1161 (S.C.) and the subsequent jurisprudence cited in Stephen MOHR et al., *U.S. Trade Dress Law : Exploring the Boundaries* (New York, INTA, 1997), pp. 137-165.

[78] For instance : Jonathan D. BAKER, "Correcting a Chromatic Aberration : Qualitex Co. v. Jacobson Products Co." (1996), 9 *Harvard Journal of Law and Technology* 547; Michael F. CLAYTON et al., "Does the Lanham Act Apply to Color Per Se?" (1995-02-20), *The National Law Journal* C-17; URL http://test01.ljextra.com/archive.html/95/02/cb1995_0211_1754_.html (website

careful in so doing given some of the differences in the underlying legislation of each country.

To sum up: a trade-mark, whether it be a word or design mark, can include a colour claim, can consist of a shape composed of one or more colours or a colour element positioned on the product; and it can also be composed of a particular colour incorporated into a particular shape. In any case, this colour must distinguish - or be

---

consulted on 19990401); Iver P. COOPER, “Trademark Aspects of Pharmaceutical Product Design” (1980), 70 *Trademark Reporter* 1; James DAVEY, “The Lanham Act Permits the Registration of Color Alone As a Trademark” “Qualitex Co. v. Jacobson Prods Co.” (1995), 63 *Tennessee Law Review* 261; Kristi L. DAVIDSON “Supreme Court Says Yes To Color, Pure and Simple : Qualitex Co. v. Jacobson Prods. Co.” (1995), 21 *University of Dayton Law Review* 855; Lawrence B. EBERT “Trademark Protection in Color : Do It by Numbers!” (1994), 84 *Trademark Reporter* 379; David C. GRYCE, “’Qualitex’ Ruling Erases Shades of Gray on Color – The U.S. Supreme Court’s ruling is evolutionary, not revolutionary” (1995-05-08), The National Law Journal C-7; URL http://test01.ljextra.com/na.archive.html/95/04/cb1995_0429_1523_8.html (site consulted on 19990401); Brian Richard HENRY, “Right Hat, Wrong Peg : In re Ownens-Corning Fiberglass Corporation and the Demise of the Mere Colour Rule” (1986), 76 *Trademark Reporter* 389; Donald M. HILL “Protection for Trademarks Consisting of Color Alone” (1995), 63 *University of Cincinnati Law Review* 989; Daniel C. HUDOCK, “Color Receives Trademark Protection and the Courts Receive Confusion” (1996), 16 *Journal of Commerce and* Law 139; Kevin M. JORDAN et al., “Qualitex v. Jacobson Products Co., The Unanswered Question – Can Color Ever Be Inherently Distinctive?” (1995), 85 *The Trademark Reporter* 371; Jean Hayes KEARNES, “Qualitex Co. v. Jacobson Products Co. : Orange You Sorry the Supreme Court Protected Color?” (1996), 70 *St. John’s Law Review* 337; Peter KOEBLER, “Qualitex Co. v. Jacobson Products Co. : It Is Possible to Trademark Color Alone” (1996), 12 *Santa Clara Computer & High Technology Law Journal* 509; Elizabeth A. OVERCAMP, “The Qualitex Monster : The Color Trademark Disaster” (1995), 2 *Journal of Intellectual Property Law* 595; Jeffrey M. SAMUELS et al., Color Trademarks : Shades of Confusion» (1993), 83 *Trademark Reporter* 554; Thomas A. SCHMIDT, “Creating Protectible Color Trademarks” (1991), 81 *Trademark Reporter* 285; Laura R. VISINTINE, “The Registrability of Color Per Se After ‘Qualitex Co. v. Jacobson Products Co.’” (1996), 40 *St. Louis University Law Journal* 611; Juanita J. WEBBER, “The Green-eyed Monster Sore or Can Color Be Trademarked under the Lanham Act?” (1996), 21 *Thurgood Marshall Law Review* 425. See also Stephen MOHR et al., *U.S. Trade Dress Law : Exploring the Boundaries* (New York, INTA, 1997), pp. 137-165, Jerome GILSON et al., *Trademark Protection and Practice* (New York, Matthew Bender, 1974), at §2.11 (updating 33 in 6/95) and J. Thomas McCARTHY, *McCarthy on Trademarks and Unfair Competition* (St. Paul, West Group, 1996), at §7:39 to 7:52 (updating 8 in 12/98). See also Audrey A. HORTON, “Designs, Shapes and Colours : A Comparison of Trade Mark Law in the United Kingdom and the United States” [1989] 9 *European Intellectual Property Report* 311, at pages 314-315 and 316-317.

able to distinguish - a person's products from those of another**.** Whether or not the colour can be registered as a trade-mark entirely depends on its being distinctive[79].

4 SOUNDS

Almost ten years ago the first sound trade-mark registration in Canada caused quite a stir[80]. This registration was for a rapid burst of 11 musical notes[81]. While the technical problems associated with the description of trade-marks is a secondary[82] concern for those who have a general knowledge of musical theory or of acoustic engineering, a problem remains as concerns the appropriateness of the registration and description of such trade-marks under the *Trade-marks Act*.

Indeed, there is no doubt that a series of sounds can be used to distinguish a person's wares and services from those of another[83]. But, according to the *Trade-marks Act*, can a sound constitute a registrable trade-mark[84]?

---

[79] See : Christopher WADLOW, *The Law of Passing-Off*, 2nd ed. (London, Sweet & Maxwell, 1995), at §6.66-6.68 and the jurisprudence cited.

[80] Richard S. GAREAU, « Une grande première au Canada: la marque «sonore»« (1991), 3 *Les cahiers de propriété intellectuelle* 103 ; Susan KING, « Are sounds and scents trade-marks in Canada? » (1992), 9 *Business & The L*aw 6; Georges T. ROBIC, « L'enregistrabilité des marques sonores, signes distinctifs et couleurs», URL www.robic.ca, under publication 53.1 (website consulted on 19990401). See also George GOTTLIEB "In Case You Missed It…" (1972), 62 *Trademark Reporter* 605 et Debrett LYONS, «Sounds, Smells and Signs» [1994] *European Intellectual Property Report* 540.

[81] 11 MUSICAL NOTES for audio tapes and quality services and sound duplication of Capitol Records, registration TMA 359318, trade-mark described as : "the mark consist of 11 musical notes comprising the notes C_2 (62.5Hz), C_3 (125Hz), C_4 (250Hz), C_5 (500Hz), C_6 (1K), C_7 (2K), C_8 (4k), C_9 (8K), E_9 (10K), $G^{\#}_9$ (12.5K), C_{10} (16K)".

[82] If necessary, a reference could be made to the American *Trademark Rules of Procedure* (1998), §2.58(b) and to the *Trademark Manual of Examining Procedure*, 2nd ed. (rev. 1.1 of 1997), §1301.02(d), URL http://www.uspto.gov/web/offices/tac/tmep/1300.htm (website consulted on 19990401).

[83] "In view of this flexible approach toward the concept of what constitutes a service mark or a trademark, a flexibility that is required in order to keep up with the ever-changing ramifications brought about by the changing technology that accompanies the growth of a nation and creates goods, services, and concepts unheard of in the past, the Patent and Trademark Office has recognized that a mark need not be confined to a graphic form. That is, sounds may […] likewise function as source indicators in those situations where they assume a definitive shape or arrrangement and are used in such a manner so as to create in the hearer's mind an association of

The definition of a "trade-mark" given by the Act does not exclude a sound trade-mark. In fact, this statutory definition is "circular" in the sense that a trade-mark is defined as a mark capable of distinguishing[85]. The Act does not enact, by enumeration or exclusion, what constitutes a trade-mark[86]. At first glance, a sound trade-mark should be included in the definition of a trade-mark inasmuch as it distinguishes, or is adapted to distinguish, a person's wares or services from those of another[87]. Nothing in the Act appears to restrict a trade-mark to only what is visible[88].

---

the sound with a service" : *General Electric Broadcasting Company (Re)* [SHIP'S BELL CLOCK] (1978), 199 U.S.P.Q. 560 (T.T.A.B.) Lefkowitz, member, at page 563.

[84] Consider Part VIII of the *Copyright* Act (R.S.C. 1985, c. C-42; hereinafter CA, on private copying with respect to blank audio recording mediums: some imaginative types may see such recordings on magnetic tape as the prelude to a scheme to avoid royalty payments!

[85] Section 2 TMA.

[86] As a matter of interest, we note that, as stated in Harold G. FOX, *The Canadian Law of Trade Marks and Unfair Competition*, 3d ed. (Toronto, Carswell, 1972), at page 20, in the legislation previous to the *Trade-marks Act* of 1954, the term « trade-mark » was defined by the *Trade-marks and Factory Designs Act* (S.R.C. 1927, c. 201, section 5) as "all marks, names, labels, brands, packages or other business devices" and by the *Competition Act* (S.C. 1932, c. 38, paragraph 2m)) as "a symbol which has become adaptated (to distinguish…)".

[87] In response to the ojections of the Examiner who formulated some reserves with respect to the registrability of such a sound mark, the agent of Capitol Records, Inc. produced an answer (1987-12-03). An excerpt of paragraph 15 is reproduced : « The mark is used in relation both to the recording services and to the resulting audio tape. The appearance of the SOUND MARK on each tape is an indication of the quality of the services being rendered to recording artists under contract with Capitol and other companies using the services of Capitol Records"; a similar reference could be made to another answer (1988-12-01), whose paragraph 2 reads as follow; "In short, applicant displays the trade mark both on its own tapes and on the tapes which it prepares as a service to the specification of others"..

[88] The fact that the sound mark can also be the object of protection just like a musical work in the sense of the *Copyright Act* should not create any obstacle since the duality of protection trade-mark/copyright has already been recognized, notably with respect to artistic works : see Hugues G. RICHARD (dir.) et al., *Leger Canadian Copyright Act Annotated* (Toronto, Carswell, 1993) at §5.9.2 and the Canadian jurisprudence cited under §7.1.5. In absence of authorization from the copyright owner, the question whether the use of a few bars - probably the most representative - of a musical work for use as a trade-mark will constitute the reproduction of a substantial part of the work in the sense of section 3 TMA is a very interesting one. This would result in an infringement of the economic rights of the copyright owner, if not to an infringement of moral rights of the author. But, this is another debate! See also *Fun-Damental Too, Ltd. v. Universal Music Group., Inc*. [JAWS] (1997), 43 U.S.P.Q. (2d) 1595 (E.D. Pa.).

That being the case, why have we not registered more sound trade-marks in Canada[89]?

In the firts place, it is said that the registration of the first sound trade-mark was not a big success and the Trade-marks Office now seems to systematically refuse[90] such applications. The *Playboy*[91] case, in which it has been decided that a trade-mark, according to the *Trade-marks Act*, must be visible[92], has been the standard adopted by the Trade-marks Office[93] to deal with any case of a similar nature. So, under this doctrine, the sound trade-mark would not be a mark.

---

[89] Within the applications still pending, we note a lion roaring for the movies of Metro-Goldwyn-Mayer Lion Corp (application TMO 714314) and a progression of five sounds for telecommunication devices of Intel Corporation (application TMO 858570).

[90] Informal interview over the phone on 1999-03-31 with Suzanne Charette, policy director of the Canadian Trade-mars Office.

[91] *Playboy Enterprises Inc. v. Germain (no. 1)* [PLAYBOY] (1986), [1986] T.M.O.B. 176 (Opp. Board); rev. (1987), 16 C.P.R. (3d) 517 (F.C.T.D.). Nonetheless, we note that this case was already decided at the moment of the application for registration of Capitol Records;

[92] "I am of the opinion that, use of a verbal description is not use of a trade mark within the meaning of the Trade Marks Act. A "mark" must be something that can be represented visually" : *Playboy Enterprises Inc. v. Germain (n^{o} 1)* [PLAYBOY] (1987), 16 C.P.R. (3d) 517 (F.C.T.D.), J. Pinard at page 522. This statement of the judge is based on a commentary of J. MacLean in the case *Wrights' Ropes Limited v. Broderick & Bascom Rope Co* [YELLOW STRAND IN A ROPE] (1931), [1931] Ex. C.R. 143 (Ex. Ct.), at pages 144-145 with respect to the definition of the term "mark" as given then by the dictionnary. This appears shallow as a justification. One can agree with the conclusion that, on the particular facts of the case, the owner had never used his trade-mark and that his pathetic explanation was made to maintain his registration at all costs. But, in practice, a sound can be graphically represented.. The position of the Trade-marks Office does not seem to take into consideration this aspect of the decision…Would one have to put on the product a graphic representation of the mark [reminiscent of the definition of a musical work prior to the Act modifying the Copyright Act S.C. 1993, ch.23, section 1(1)] and then contend that the acoustic representation of the graphic representation constitutes infringement? For a critique of this obsolete definition of a "mark", see also Sheldon BURSHTEIN, «Trade-mark "Use" in Canada : The Who, What, Where, When, Why and How – Part I» (1997), 11 *Intellectual Property Journal* 229, at page 234.

[93] *Playboy Enterprises Inc. v. Germain (n^{o} 1)* [PLAYBOY] (1986), [1986] T.M.O.B. 176 (Opp. Board); rev. (1987), 16 C.P.R. (3d) 517 (F.C.T.D.), J. Pinard at pages 522 and 523; *Burns (Re)* [HOT LINE] (1988), [1988] T.M.O.B. 238 (Opp. Board), J. D'Aoust at pages 1-2; *Phillips (Re)* [TECHNIQUE AVANT GARDE] (1997), [1997] T.M.O.B. 19 (Opp. Board), D. Savard at ¶11; *Little Caesar Enterprises, Inc. v.. Flying Wedge Pizza Co. Ltd.* [VEGGIE WEDGIE] (1998), [1998] T.M.O.B. 16 (Opp. Board), D. Martin at ¶14.

Furthermore, this view negates the possibility of showing use:

> Therefore, in order to be deemed to be used in association with wares, at the time of the transfer of the property in or possession of such wares, the trade mark must be something that can be seen, whether it is marked on the wares themselves or on the packages in which they are distributed or whether it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred[94].

However, we have seen that for there to be "use" of a trade-mark with wares, a notice of the association must be given at the moment of the transfer of possession[95]. According to this view of sound marks, the person will be able to listen to the trade-mark once he\she will have bought and used the product, but this will only take place after the transfer of possession[96].

Thus, at the moment when such an audiotape is bought, the sound trade-mark is invisible and inaudible. It is invisible because the merchant has certainly not affixed to the product a graphic representation of the acoustic rendering of the sound trade-mark; it is also inaudible because, generally speaking, the purchaser will not listen to the audiotape on which this sound trade-mark is affixed before the purchase. We can thus infer that, normally and in the absence of explanations on particular practices of a store or an industry, there will rarely be a notice of the association in the case of sound trade-marks for wares. It could however be easily different in the case of sound trade-marks for services.

---

[94] *Playboy Enterprises Inc. v.. Germain (n^{o} 1)* [PLAYBOY] (1987), 16 C.P.R. (3d) 517 (F.C.T.D.), J. Pinard at page 523.

[95] Paragraph 4(1) TMA.

[96] *Compare* : *BMB Compuscience Canada Ltd. v. Bramalea Ltd.* [NETMAIL] (1988), [1989] 1 F.C. 362, 23 F.T.R. 149. 20 C.I.P.R. 310, 22 C.P.R. (3d) 561 (F.C.T.D.), J. Teitelbaum at page 570 and *Quo Vadis International Ltée (Re*) [LE PLANNING HORIZONTAL DE VOTRE ANNÉE D'UN SEL COUP D'ŒIL] (1997), [1997] T.M.O.B. 87 (Opp. Board) D. Savard at ¶15-18; *Cullmann Ventures Inc. v .Quo Vadis International Ltée* [YOUR YEAR'S HORIZONTAL PLANNING AT A SINGLE GLANCE] (1997), [1997] T.M.O.B. 268, 78 C.P.R. (3d) 268 (Opp. Board), D. Savard at pages 272-273. See also *Bostick Ltd. v. Sellotape G.B. Limited* (1993), [1994] R.P.C. 556 (Chan. Div. England), J. Blackburne at pages 563-564 where he has held that the colour blue of the adhesive tape of one or the other party could not be a private distinctive packaging (get up) for the reason that this colour is invisible at the moment of the purchase and could only be seen at the moment of the use; on the same point, see also *Aristoc Ltd. v.. Rysta Ltd*. [RYSTA] (1945), [1949] 1 All E.R. 32, 114 L.J.Ch 52, 172 L.T. 69, 62 R.P.C. 65, [1945] A.C. 68 (H.L. England) and *Uniliver's Ltd's (Striped Toothpaste) Application* (1980), [1980] F.S.R. 280 (Chan. Div. England).

A brief overview of the following chart[97] will allow us to better evaluate examples of use of sound trade-marks related to services[98].

Music			
Registration	Services	Owner	Description
2155923	Entertainment services	Golden Books Publishing company, Inc.	The mark consists of theme music for the LONE RANGER radio, film, and television series, resembling portions of the overture to the 1829 opera "William Tell", composed by Gioacchino Rossini.
2149329	Cellular telephone	Airtouch Communicatio ns Inc	The musical mark consists of a distinctive synthesized musical sound that has a flute-like timbre or sound quality. This musical representation may be described as follows - this musical mark is written in the treble of G clef using the symbol (8va) which signifies that all the notes are played one octave higher than written. this musical mark has a metronimic quarter note beat/tempo of approximately 96 beats per minute =96 this musical mark begins with two sixteenth notes on the pitch B (expressed as b 2 or the B an octave and minor seventh above middle C). Rhythmically, these two notes act as anacrusic or pick-up notes moving upward in an eighth note E (which occurs on the downbeat). This E proceeds upward into two sixteenth notes on the pitch A before returning downward into two sixteeenth notes on the pitch F (a minor third below).
2028472	Movie production		Notes D, E, A, C#, E, F, B :, F, B
2000732	Entertainment services	Twentieth Century Fox	Nine bars of primarily musical chords in the key of B flat; the chords consisting of

[97] Via a basic computer survey of trade-marks registered in the data base of United States Patent Office : URL http://www.uspto.gov/tmdb/index.html (website consulted on 19990401), which excludes, for instance, “The sound "Clop, clop, clop, mooo"” (registration 1590267), **“**The musical notes E flat, B flat, G, C, F electrically reproduced” (registration 928479) “Three short pulses followed by a longer pulse” (registration 922585), “Audio and visual representation of a coin spinning on a hard surface” (registration 641872), “Creaking door” (registration 556780), or “Liberty Bell ringing” (registration 549458).

[98] The classification is borrowed from James E. HAWES, “Non-Traditional Trademarks”, in *1997 INTA Mid-Year Meeting – Course Materials* (Rio Grande, INTA, 1997), pp. 7-10. Some of the sounds corresponding to the registrations are available at Suzie LARSEN et al., “The Sounds File” http://newsport.sfsu.edu/archive/f96/sounds/index.html (website consulted on 19990401);

			four, eight and sixteenth notes
1959642	Radiation detection probe for medical use (product)	Neoprobe Corporation	Six octaves of sound tone starting with 20HZ and descending to 1288HZ, then returning to 20HZ to produce a unique sound
1872866	Entertainment services	LucasArts Entertainment Company	30 voices over seven measures, starting in a narrow range, 200 to 400HZ, and slowly diverting to preselected pitches encompassing three octaves. The 30 voices begin at pitches between 200Hz and 400 HZ and arrive at preselected pitches spanning three octave by the fourth measure. The highest pitch is slightly detuned while there are double the number of voices of the lower two pitches
1829616	Telecommunications voice messaging	U.S. West Communications, Inc.	Three harmonically related tones played together to produce a chime sound
1741879	Retail convenience stores	Wawa, Inc	The jingle having the following sequence of notes : C, D, C, D, C, D, C and G. Each of the notes if the sequence are eighth notes with the exception of the last D note which is quarter note
1700895	Entertainment	International Broadcasting Corporation (Harlem Globetrotters)	The melody "Sweet Georgia Brown"
1680160	Computerized telephone sytems	Applied Voice Technology, Inc.	The chime-like notes A, G, F, C
1620415	Long distance telephone	MCI Communications Corporation	Four harmonically related tones which are summed together in a successive manner to produce a unique chime sound that is used as a prompt to the telephone user
1413137	Sound engineering	Capitol Records	C2, C3, C4, C5, C6, C7, C8, C9, E9, G#, C10
1307448	Telephone message	Octel Communication Corporation (VMX, Inc.)	Four audible tones of varying frequences and durations and contains the following tone frequencies : 770HZ, 770HZ, 853HZ and 697HZ
1280214	Food carry-out services	Del's Lemonade and Refreshments Inc.	A sequence of horn like musical notes, F, sounded at least twice in sequence, the notes F+0 and A+O being just above the middle C
916522	TV programs	National Broadcasting Company, Inc.	Musical notes G, E, C, played on chimes
Lyrics			
2033447	Restaurant services	Apple South, Inc.	"Are you ready to rumba"
20000963	Entertainment Services	Ginsburg Enterprises,	"Ooh It's So Good"

		Inc.	
1838887	Restaurant	Rally's, Inc.	Spoken terms "Ching"
1795371	Restaurant	Rally's, Inc	Spoken term "Cha Ching"
17617241	Telephone	American Telephone and Telegraph Company (AT&T)	The spoken letters "AT&T"
Music and lyrics			
17663541	Retail pizza restaurant store	Pinocchio's Pizza, Inc.	The words « Nobody Nose Pizza Like Pinocchios", set to music
1754344	Retail bedding store	T.J.B., Inc	The words "Have a Good Night's Sleep on Us, Mattress Discounters" superimposed over a musical jingle comprised of 12 notes, in the key of F, in the sequence of A, A, G, A, B Flat, D, C, E , E, G, F, F
1573864	Long distance telephone	American Telephone and Telegraph Company (AT&T)	The spoken words "A T & T" superimposed over the musical sounds in the key of B Flat Major, namely the melody notes F, B Flat, C and two accompanying chord, one of the four notes F, B Flat, C and F and one of the two notes F and F
1471674	Radio broadcast service	Spanish Coast to Coast, Ltd. (Grupo Radio Centro)	The words "radio variedades" superimposed over the notes C, D, E, C, D and G
1326350	Radio entertainment	Al Ham Productions, Inc.	The words "The Dreams We Share We' ll Always Remember, Remember The Music Of Your Life", set to music
1299056	Credit	Beneficial Management corporation of America	The words "At Beneficial You're Good For More" and the sound "Toot, Toot", all set to music
Sounds			
1746090	Radio broadcasting services	Beacon Broadcasting corporation	The sound of a thunderclap
1395550	Entertainment services	Metro-Goldwyn Mayer Corporation	Lion roaring

Finally, in the particular case of the Capitol Records sound trade-mark, some people, by the reading of the prosecution file, would have some serious reserves with respect to the functional character of the sounds for which registration[99] has been obtained.

[99] To support one of his answers at the exam, the applicant's agent had produced a press dossier. Among those articles, this excerpt of *Forbes* (1986-10-06) is worth mentioning : "Trademarks for the ear. […] Capitol Records has trademarked a burst of 11 rapidly played musical notes it has used for five years on audiocassettes to

In the United States, the debate on the functionality or the non-distinctiveness of sound trade-marks is worth following with respect to the application of registration for a HARLEY-DAVIDSON[100] muffler sound[101].

Suppose that the registration of sound trade-marks would be permitted, the question of infringement on such marks might be very delicate[102], the social and commercial communications being rather focused on the eyesight than on the sense of smell or of hearing[103]. However, we will note that a non-visible use of a registered trade-mark can constitute an infringement of this registered mark[104].

---

check sound and quality". The secondary character of this utilitarian functionality is not so obvious.

[100] Jill YOUNG-MILLER, "Harley Tries to Keep Engine Roar for Itself" (Spring 1996), *University of Kansas School of Law – Intellectual Property in the News* (1996-08-18); URL http://lark.cc.ukans.edu/~akdclass/pct/pct_news.html (website consulted on 19990401); see also *Kawasaki Motors Corp. U.S.A. v. H-D Michigan Inc* (1997), 43 U.S.P.Q. (2d) 1521, 1526 et 1528 (U.S.P.T.O.) in which nine competitors raise objections to the registration of a sound trade-mark described like "the exhaust sound of applicant's motorcycles, produced by V-twin, common crankpin motorcycle engines when the goods are in use" (application 74/485223 of H-D Michigan, Inc.)

[101] Known to *aficionados* as "potato, potato, potato".

[102] This debate about procedure is shown in *Kawasaki Motors Corp. U.S.A. v. H-D Michigan Inc* (1997), 43 U.S.P.Q. (2d) 1521 (U.S.P.T.O.) the Commission, at page 1525 : "Certainly if applicant is correct in its assertions, supported by experts in acoustics, that the essence of the sound in each presentation is the same but for volume, then the application does not present two marks. For us, though, the issue is far simpler. When we compare each of the discrete recordings of the sound to the description of the mark, each recording can fairly be characterized as an aural presentation of the literal description, just as varying presentation of a word in different typefaces and typesizes all may be said to illustrate that word as set forth in plain typed form of the drawing of the mark".

[103] However, paragraph 6(1)e) TMA already foresees that, in deciding on the confusion between two trade-marks, we have to take into consideration all the circumstances of the case, as well as the resemblance degree between the trade-marks in the representation or the sound, or in the suggested ideas.

[104] Even in the logic of the Playboy case, the infringement of a registered trade-mark should not be limited to the sole activities that are a matter of the visual field and a non graphic use could be qualified as an infringement. For an illustration of this blurred approach, *compare* Sheldon BURSHTEIN, «Trade-mark "Use" in Canada : The Who, What, Where, When, Why and How – Part I» (1997), 11 *Intellectual Property Journal* Sheldon 229, at pages 234-235 and Sheldon BURSHTEIN, «Trade-mark "Use" in Canada : The Who, What, Where, When, Why and How – Part II» (1997), 12 *Intellectual Property Journal* 75, at pages 106-108.

Likewise, it does not seem that the sound trade-mark has to be new or characteristic : as long as it distinguishes or is able to distinguish, the use of sounds or of well known ritornellos would then be susceptible to registration[105].

5 ODOURS

We should not confuse the registration of the name of a perfume[106] and the registration of its smell[107] or of its own description[108] with the registration of an olfactory element which, in association with a given product or service, would allow a person to distinguish his/her product or service from those of others.

Also, we should not confuse the olfactory form and the perfume formula[109].

---

[105] *Contra*. «Thus, a distinction must be made between unique, different or distinctive sounds and those that resemble or imitate commonplace » sounds or those to which listeners have been exposed under different circumstances. This does not mean that sounds that fall within the latter group, when applied outside the common environment, cannot function as marks for the services in connection with which they are used, but, whereas the arbitrary, unique or distinctive marks are registrable as such on the Principal Register without supportive evidence, those who fall within the second category must be supported by evidence to show that purchasers, prospective purchasers and listeners do recognize and associate the sound with services offered and/or rendered exclusively with a single source» : Nancy RUBNER FRANDSEN, «Ambience, Subliminal Confusion, color, Smell, and Sound : The Protection of Non-Verbal Rights Under the Trademark and Unfair Competition Law» (1991), C874 *ALI-ABA* 155, at page 187, excerpt inspired of *General Electric Broadcasting Company (Re)* [SHIP'S BELL CLOCK] (1978), 1999 U.S.P.Q. 560 (T.T.A.B.), Lefkowitz member at page 563.

[106] For instance the NO. 5 of Chanel (registration UCA 018879).

[107] Hypothetically, CUIR DE RUSSIE CHANEL of Chanel (registration UCA 018472). In the United States, the trade-mark APPLE PIE for a spices 'pot pourri' with an apple pie smell has been refused as descriptive in *Gyulay (Re)* [APPLE PIE], (1987), 3 U.S.P.Q. (2d) 1009 (C.A.F.C.), J. Newman at page 1010. In Canada, a similar result should arise in accordance with the description prohibition at paragraph 12(1)b) TMA.

[108] For instance the perfume NO. 5 of Chanel has already been described in the United Kingdom as «The scent of aldhehydic-floral fragrance product, with an aldehydic top note, from jasmine, rose, bergamot, lemon and neroli; and elegant floral middle note, from jasmine, rose, lily of the valley, orris and ylang-ylang; and a sensual feminebase note, from sandal, cedar, vanilla, amber, civet and musk. The scent is also known by the written brand name No. 5», application 00724881 withdrawn.

[109] Jean-Pierre PAMOUKDJIAN, *Le droit du parfum*, collection Bibliothèque de droit privé (Paris, LGDJ, 1982), at pages 212-216. For an approach on the protection of a perfume by copyright, see André BRASSARD, «La composition d'une formule de parfum est-elle une 'œuvre de l'esprit' au sens de la Loi du 11 mars 1957?» (1979),

In the United States, the registration, with respect to sewing thread and tapestry thread, of a trade-mark described as "a high impact, fresh, floral fragrance reminescent of Plumeria[110] blossoms"[111] gave rise to an interesting doctrinal discussion on the validity of the registration of a trade-mark for odours[112]. In Canada, no such trade-mark has yet been registered[113]. However, subject to the narrow definition of a trade-mark given by the *Playboy*[114] case, why should[115] an odour be

---

118 *Revue internationale de propriété intellectuelle et artistique* 461; Jean-Louis CROCHET, «Parfumerie et Droit d'Auteur. Quelques réflexions autour de l'arrêt de Laire c. Parfums Rochas» (1979), 118 *Revue internationale de propriété intellectuelle et artistique* 468. As a matter of interest, see also US Patent 4671959 of 1987-01-09 for a *Method of causing the reduction of physiological and/or subjective reactivity to stress in humans being subjected to stress conditions* for «a scent blend selected from the group consisting of: (i) Nutmeg Oil; (ii) Mace Extract; (iii) Neroli Oil; (iv) Valerian Oil; (v) Myristicin; (vi) Isoelemicin; and (vii) Elemicin».

[110] Or the frangipani, this exotic shrub from the tropical or the sub-tropical climates of the apocynaceae family whose flowers have a perfume which reminds the perfume of the frangipane of the Italian perfumer Frangipani. It has been used to perfume skins (gloves) and lemonades. The odour is generally described as *sweet floral,* which appears descriptive…

[111]Registration 1639128 of Celia Clarke, struck off in 1997 for default of production of evidence of proof. A quick computer survey has nonetheless revealed 6 applications for registration (75-360102 à 75-360106) of a Mike Mantel for trade-marks respectively consisting of a strawberry smell, a buble gum smell, a grape smell, a citrus smell and a tutii-frutti smell for … car lubricants and fuel! An application 75/120036 for a lemon smell in association with toner cartridges and an application 75-301972 for an apple smell for a bit have been abandoned. In the United Kingdom, we note the registration 2001416 of Sumitomo Rubber Industries, Ltd. for a trade-mark described as «a floral fragrance/smell reminescent of roses as applied to tyres».

[112] Lee B. BURGUNDER, «Trademark Protection of Smells : Sense or Nonsense», (1991), 29 *American Business Law Journal* 459; Jane M. HAMMERSLEY, «The Smell of Success : Trade Dress Protection for Scent Marks» (1998), 2 *Marquette Intellectual Property Law Review* 105; Malcom GLADWELL, «Trademark Picks Up the Scent; Thread's Smell Gets Legal Registration» (1990-12-04), The Washington Post A-15; Jane M. HAMMERSLEY, «The Smell of Success : Trade Dress Protection for Scent Marks» (1998), 2 *Marquette Intellectual Property Law Review* 105; James E. HAWES, «Fragrances as Trademarks» (1989), 79 *Trademark Reporter* 134; Moon-Ki CHAI, «Protection of Fragrances Under the Post Sale Confusion Doctrine» (1990), 80 *Trademark Reporter* 368. *Compare* Helen BURTON, «The UK Trade Marks Act 1994 : An Invitation to an Olfactory Occasion?» [1995] *European Intellectual Property Report* 378;.

[113] Susan KING, «Are sounds and scents trade-marks in Canada?» (1992), 9 *Business & The L*aw 6.

[114] *Playboy Enterprises Inc. v. Germain (n^{o} 1)* [PLAYBOY] (1986), [1986] T.M.O.B. 176 (Opp. Board); rev. (1987), 16 C.P.R. (3d) 517 (F.C.T.D.).

excluded from the *Trade-marks Act*[116]? In fact, we can imagine that at the moment of the transfer of possession of a product, a trade-mark can be linked to this product in a manner to give notice of the association between this odour-mark and the product in which possession is thus transferred[117].

In order to be protected, the odour must operate as a trade-mark to distinguish. The odour does not have to be new or complex: it should simply distinguish or be capable of distinguishing a person's products or services from those of another[118].

But there are differences between some odours[119]. At first glance, odours which are common to an industry or a product[120] or which are the natural odours of the

---

[115] The Collins English Dictionnary (1986) describes "odour" as "the property of a substance that gives it a characteristic scent or smell."

[116] "While such non-visual identifiers become connected in the minds of the public with a particular source, and thereby acquire the ability to symbolize goodwill and distinguish the goods or services of one person from those of others, they may not satisfy the criteria of the Act. The validity of the restriction to visual marks is based on a historical and outdated interpretation of the word "mark"" : Sheldon BURSHTEIN, "Trade-mark "Use" in Canada : The Who, What, Where, When, Why and How – Part I" (1997), 11 *Intellctual Property Journal* 229, at page 234.

[117] The ethic of the use of odours to attract customers and to provoke a purchase is still a subject to be explored. See Lee B. BURGUNDER, "Trademark Protection of Smells : Sense or Nonsense", (1991), 29 *American Business Law Journal* 459, at page 480.

[118] And not as a gadget like Didier CONRAD et al. *Poupée de bronze*, Les innommables series (Bruxelles, Dargaud, 1998), we could read on the promotional sticker « Cet album pue! 9 cases en odorama », the movie *Polyester* (1981) of John Waters [*filmed in Odorama – Smelling Is Believing;* a scratching card was distributed to the members of the audience with the instruction to scratch one of the 10 spots on the card to give off, at the appropriate moment, an odour corresponding to a sequence of the movie] or *scratch-n-sniff* samples distributed in fashion magazines.

[119] Some people distinguish between the *primary scent marks* when the odours constitute the principal motivation of the purchase (perfume and deodorant), the *secondary scent marks* when the odours do not constitute the primary function of the product but are nonetheless part of the product (soap) and the *unique scent marks* when the odour does not have any relation with the product (lily of the valley for pencils or mineral water). See Jane M. HAMMERSLEY, «The Smell of Success : Trade Dress Protection for Scent Marks» (1998), 2 *Marquette Intellectual Property Law Review* 105, at pages 124-126 and Bettina ELIAS, «Do Scents Really Signify Source – An Argument Against Trademark Protection for Fragrances» (1992), 82 *Trademark Reporter* 475, at pages 495-505.

[120] As an illustration of the generic character of a few uses of odours : lemon for house cleaners or pine for disinfectants, all the more so since such odours are used to mask the unpleasant chemical odours of the active ingredient of the product. See on this subject Lee B. BURGUNDER, "Trademark Protection of Smells : Sense or Nonsense", (1991), 29 *American Business Law Journal* 459, at pages 468-469; Iver

product[121], would be excluded for lack of distinctive[122] character. In the same manner, if the odour is only functional, it should not be registered[123] : it would be the case for the odour of a perfume[124]. If the odour only has a secondary aspect, it could be registered[125]. Finally, if the odour does not have any link with the product[126]- and presumably has not been used yet - it should be protected[127].

P. COOPER, "Trademark Aspects of Pharmaceutical Product Design" (1980), 70 *Trademark Reporter* 1, at page 9; "Fragrance Trademarks in Italy" (September 1998), 2 *Horizon – Italian and EU law* (Turin, Jacobacci e Parini, 1998) 4, at page 5.

[121] For instance, a leather smell for shoes or for a brief case, or a strawberry smell for strawberry drink.

[122] Section 10 TMA states that : "Where any mark has by ordinary and *bona fide* commercila usage become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any wares or services, no person shall adopt it as a trade-mark in association with such wares or services or others of the same general class or use it in a way likely to mislead, nor shall any person so adopt or so use any mark as to be likely to be mistaken therefor."

[123] This would be the case for a perfume or a deodorant who's smell consists of an essential or functional element: *Remington Rand Corp. v. Philips Electronics N.V* [SHAVER HEAD] (1995), 64 C.P.R. (3d) 467, 191 N.R. 204, [1995] A.C.F. 1660 (F.C.A.) J. MacGuigan at paragraphs 18-21. But, what of tissue paper impregnated with menthol or eucalyptus odour for those who have a cold?

[124] "It should be noted that we are not talking here about the registrability of scents or fragrances of products which are noted for these features, such as perfumes, colognes or scented household products. Nor it is a case involving the descriptiveness of a term involving the question of descriptiveness of a term which identifies a particular fragrance of a product. In such cases, it has been held that a term is unregistrable […] if it merely describes an odor or other significant feature of the product" *Clarke (Re),* (1990), 17 U.S.P.Q. (2d) 1238 (T.T.A.B.), Simms member, at page 1239, note 4. See also Lee B. BURGUNDER, "Trademark Protection of Smells : Sense or Nonsense", (1991), 29 *American Business Law Journal* 459, at page 479 : "In this way, no perfume smell should be capable of trademark protection even with a significant showing of secondary meaning. By analogy, perfume smells should be treated no differently than generic marks".

[125] Subject to the practice in the industry, it could be the case for a soap with a smell of burning : this smell is part of the product but is not necessary. Be means of advertising, we can conceive that such a smell could distinguish the product. However, in that event, we must be careful about a possible "reverse genericide [if] the consumers may identify the smell by the product" instead of the reverse : Lee B. BURGUNDER, "Trademark Protection of Smells : Sense or Nonsense", (1991), 29 *American Business Law Journal* 459, at page 470. It is probable that the characteristic odour of the IVORY soap would have such a mark value.

[126] *Clarke (Re)* [SCENTED YARN] (1990), 17 U.S.P.Q. (2d) 1238 (T.T.A.B.), Simms member at pages 1239-1240 : "Upon careful review of this record, we believe that the applicant has demonstrated that the scented fragrance does function as a trademark for her thread and embroidery. Under the circumstances of this case, we see no reason why a fragrance is not capable of serving as a trademark to identity and

How does one proceed on the application for registration? Since the trade-mark of odour is different from a nominal mark, a drawing and a description of the trade-mark must accompany the application[128].

Science has evolved since the days of the Jean Baptiste Grenouille character created by Suskind[129] and the perfumers of the XVIIIth century[130], an odour can now be precisely[131] described and represented graphically.

---

distinguish certain type of product […] the fragrance is not an inherent attribute or natural characteristic of applicant's goods but it is rather a feature supplied by applicant".

[127] The characteristic odour of the BAZOOKA gum or the chocolate flavor tools could illustrate this point. On the other hand, this English registration for tires with a rose smell and American applications for bubble gum smell for motor oil are kind of disturbing…

[128] Remind that the paragraph 30h) TMA on applications for registration of trade-marks states that : "unless the application is for the registration only of a word or words not depicted in a special form, a drawing of the trade-mark and such number of accurate representations of the trade-marks as may be prescribed", drawing which realization must fit with the criteria set out at section 25 of the *Trade-marks Regulations.* In this case, the registrar can, according to paragraph 29c) of the regulations, require the production of a specimen showing how the trade-mark is used.

[129] Patrick SÜSKIND, *Le parfum – Histoire d'un meurtrier* (Paris, Fayard, 1986), translated by Bernard Lortholary.

[130] Ghislaine PILLIVUYT, *The Art of Perfume in the 18th Century* (Paris, La bibliothèque des arts, 1986).

[131] It would certainely be more precise to say that an odour can now be more precisely described. Indeed, there will always be room for subjectivity in a sensorial analysis, especially when it is a matter of "chemical senses" like the sense of smell or of taste compared to the "mechanical senses" like the sight, the sense of touch and of hearing : Pierre BRESSE, «Propriété intellectuelle des créations sensorielles : l'apport de la métrologie et de l'analyse sensorielle pour défendre les droits du créateur» (février 1997), 30 *Bulletin de l'Association des amis du Centre d'études internationales de la propriété industrielle* 13, at pages 13-14. We will not forget that the perception of odours can vary a lot from one environment to another and from one individual to another. : see Michelle DUBUC, *L'odorat* (Montréal, Société pour la promotion de la science et de la technologie, ministère de l'Enseignement supérieur et de la Science du Québec, 1992), at pages 4-13; Terry ENGEN, "Remembering Odors and Their Names" (Septembre-octobre 1987), *American Scientist* 497; Boyd GIBBONS "The Intimate Sense of Smell" (september 1986), 180 National Geographic 360, "The Smell Survey – Sniffing Out the Sense of Smell" (March 1996), 190 *National Geographic* 134.

How do we describe the trade-mark? Most likely by the combination of a description of the trade-mark following one sensorial analysis method or the other, and sensorial metrology.

Sensorial analysis (the examination of the organoleptic characteristics of the odour on the sense organs) is used with the help of a standardized and descriptive[132] vocabulary. When one attempts to recall an odour, it is the image of the odour that comes to mind[133]. The subjective evaluation[134] made by any expert, would have to be completed by a more objective analysis of all the components of the odour, if only to provide a "drawing" of the representation of the trade-mark.

In this respect, different means of analysis, such as gas or liquid chromotography**,** are available to realize visually, by chromatogram or aromogram, the profile of a particular odour; to identify chemically the active components of the odour, one can use mass spectrometry, nuclear resonance or infrared or ultraviolet spectroscopy[135]**.** As we suspect, in the case of complex odours created artificially, the owners would hesitate to disclose too precisely their precious formula[136].

---

[132] Debrett LYONS, « Sounds, Smells and Signs» [1994] *European Intellectual Property Report* 540 and Mariette JULIEN, *L'image publicitaire des parfums – Communication olfactive* (Montréal, L'Harmattan, 1997), third part – La lecture olfactive, pp. 195-219; See also Pierre BRESSE, « Propriété intellectuelle des créations sensorielles : l'apport de la métrologie et de l'analyse sensorielle pour défendre les droits du créateur» (February 1997), 30 *Bulletin de l'Association des amis du Centre d'études internationales de la propriété industrielle* 13, at page 18; Pierre BRESSE, *Propriété intellectuelle des créations sensorielles*, at ¶12, URL http://www.breese.fr/guide/htm/bibliographie/parfum1.htm (website consulted on 19990401); James E. HAWES, « Fragrances as Trademarks» (1989), 79 *Trademark Reporter* 134, at pages 145-146.

[133] Michelle DUBUC, *L'odorat* (Montréal, Société pour la promotion de la science et de la technologie, ministère de l'Enseignement supérieur et de la Science du Québec, 1992), at page 8. « De nouveau, il ferma les yeux. Les senteurs du jardin l'assaillirent, nettes et bien dessinées comme les bandes colorée d'un arc-en-ciel» : Patrick SÜSKIND, *Le parfum* (Paris, Fayard, 1986), at page 208.

[134] James E. HAWES, « Fragrances as Trademarks» (1989), 79 *Trademark Reporter* 134, at page 138.

[135] Eran PICHERSKY, « L'ingénierie du parfum des fleurs» (1999), 187 *Biofutur* pp. 32-36; Nicolas GODINOT, *Perception et catégorisation des odeurs par l'homme* (1994) URL http://olfac.univ-lyon1.fr/~godinot/dea.htm (website consulted on 19990401); Mariette JULIEN, *L'image publicitaire des parfums – Communication olfactive* (Montréal, L'Harmattan, 1997), third part – La lecture olfactive, pp. 131-219; Gilles SICARD et al., « Des représentations de l'espace olfactif : des récepteurs à la perception» (1997), 24 *Intellectica* 85 also available at URL http://olfac.univ-lyon1.fr/~godinot/intellec.htm (website consulted on 19990401).

[136] James E. HAWES, "Fragrances as Trademarks" (1989), 79 *Trademark Reporter* 134, at pages 135-137.

With respect to the proof of the infringement of such a trade-mark[137], there might be, we suspect, interesting "expert battles[138]", if only for rapid evolution of techniques or for the subjective character of the perception of an odour.

6 FLAVOURS

The registration of flavours[139] as trade-marks[140] has always been discussed in theory but is still always subject to the basic definition of what a trade-mark is.

The first difficulty would certainly be a practical one : the description of the trade-mark itself on an objective basis[141]. In fact, for each flavor, we experience different and individual perceptions[142]. Moreover, besides the subjective factors of individual

---

[137] Like the contentious *scent alike*, those cheap imitations of famous perfumes.

[138] *Saxony Products, Inc. v. Guerlain, Inc*. [FRAGRANCE S/SHALIMAR] (1973), 176 U.S.P.Q. 97 (C.D. Ca.); mod. (1975), 185 U.S.P.Q. 477 (C.A. 9th cir.), J. Jameson at pages 477-478 et 479 : “Based on an analysis of odor components, lasting quality and actual character of the odor, the reports concluded that the Fragrance S was not only unlike SHALIMAR from the standpoint of chemical composition but also in terms of fragrance and lasting quality”. See also *Sherrel Perfumers, Inc. v. Revlon, Inc*. [EQUIVALENT TO CHANEL] (1980), 483 F. Supp. 188, 205 U.S.P.Q. 250 (S.D.N.Y), J. Sweet at pages 254-255.

[139] One can always wonder about the true taste of the super-sandwiches of Dagwood Bumstead, Blondie's husband from the Chic Young comic strip.

[140] And not the protection of the recipes : see POLLACK (Malla), «Intellectual Property for the Creative Chef, or How to Copyright a Cake: A Modest Proposal» (1991), 12 *Cardozo Law Review* 1477 or Nora MOUT-BOUWMAN, “Protection of Culinary Recipes by Copyright, Trade Mark and Design Copyright Law” [1988] *European Intellectual Property Report* 234.

[141] Pierre MICLETTE, « Particuliers ces arômes» (1998), 7-4 *Action Canada France*, pp. 16-17, at page 16 : «Le premier problème auquel nous sommes confrontés en vendant des arômes c’est de décrire ce que nous goûtons et de pouvoir échanger les perceptions autant entre nous qu’avec nos clients. Ça semble absurde, mais vous êtes-vous déjà attardés à la façon dont vous décrivez ce que vous dégustez? Personne n’utilise les mêmes termes puisqu’il n’existe pas vraiment de convention pour aider la description des goûts».

[142] In French : «En fait, pour chacune des saveurs, nous manifestons des perceptions différentes, individuelles. Chacun d’entre nous est en somme, gustativement «daltonien» pour un certain nombre de saveurs particulières» Fabien GRUHIER, «Mille millions de papilles» (1997), 36 *Québec Science* 15, at page 17. Moreover, at p.15, this same author evokes the difficult dissociation of gustative and olfactory sensations in those terms : [TRANSLATION] "Since the mouth is - more than the nose - sensitive to odours, we easily mix up olfactory and gustatory perceptions. Moreover, if it is always possible to perceive odours individually (with the nose, mouth closed), the reverse is impossible : we cannot, normally, eliminate the odours

assessment, exterior factors can be taken into consideration with respect to gustative assessment[143].

Moreover, the question of functionality still remains. Is the flavour part of the product[144]? Is it so widespread in the industry that it cannot be distinctive[145]? Or, also, is its use necessary to the product? For instance, in the case of pharmaceutical products, flavours[146] are used to mask offensive flavours, have a placebo effect or act as an excipient[147].

---

of the food that we eat" . [original French version] "Comme la bouche est – plus que le nez – sensible aux odeurs, nous mélangeons facilement perceptions olfactives et perceptions gustatives. D'ailleurs, s'il est toujours possible de percevoir isolément les odeurs (par le nez, en fermant la bouche), l'inverse est impossible : on ne peut pas, normalement, éliminer les odeurs de ce que l'on mange". We can take as example the pepper, a product perfectly insipid which culinary interest rather resides in the odour! See also Hervé THIS, "Savante cuisine" (1997), 36 *Québec Science*, pp. 18-21.

[143] "A flavor's subjectivity derives principally from its complexity. Flavors consist of three elements : aroma, taste (sweet, acid, bitter, or saline), and feeling. Numerous factors influence taste acuity, among them age, disease, and, for certain tastes, temperature. In addition, one's taste perception varies with practice, increasing the subjectivity of this sense" : Nancy L. CLARKE, "Issues in the Federal Registration of Flavors as Trademarks for Pharmaceuticals" (1993), 1 *University of Illinois Law Review* 105, at page 131. For a description of the gustative process in the context of a sensorial evaluation, see Nancy L. DeVORE, "Sensory Physiology", dans *Readings and Conference* (Corvallis, Oregon State University, 1996), URL (updated on 1997-08-29) http://osu.orst.edu/foo-resource/sensory/nancy.html.

[144] For instance, mint for mint candies (peppermint) or one of the great 31 FLAVORS of Baskin-Robbins International Company for its ice cream!

[145] For instance, mint for toothpaste.

[146] Nancy L. CLARKE, "Issues in the Federal Registration of Flavors as Trademarks for Pharmaceuticals" (1993), 1 *University of Illinois Law Review* 105, at page 127.

[147] "Respondent has no exclusive right to the use of its formula. Chocolate is used as an ingredient, not alone for the purpose of imparting a distinctive color, but for the purpose of also making the preparation peculiary agreable to the palate, to say nothing of its effect as a suspending medium. While it is not a medicinal element in the preparation, it serves a substantial and desirable use, which prevents it from being a mere matter of dress. It does not merely serve the incidental use of identifying the respondent's preparation […] and it is doubtful whether it shall be called nonessential" : s *William R Warner & Co. v. Eli Lilly & Co*. [COCO-QUININE/QUIN-COCO] (1924), 265 U.S. 526 (S.C.) , J. Sutherland at page 531. See also Smith Kline & French Laboratories c. Broder [DEXEDRINE] (1959), 125 U.S.P.Q. 299 (S.D. Texas), J. Connally (cherry flavour and smell medications).

This subjectivity complicates the question of how the trade-mark is to be described according to some[148]. an appropriate/objective description of the trade-mark. This view is not entirely well-founded since if it is not necessary to describe with precision the shade of the colour that we want to protect, there should not be any reason to ask for more in the case of an odour or a flavour. Moreover, advances in science (bio-engineering, neuroscience, sensory neurobiology, etc.) have made describing flavours more accurate/objective[149].

Finally, we can ask ourselves if a flavour can really be the object of *use*[150] to distinguish a product inasmuch as, normally, it is after the transfer of ownership that the product could be tasted[151].

7 HOLOGRAMS

«You should know I'm a hologram and can't be bent, spindled, or mutilated, so don't bother trying.»
-Robert PICARDO (The Doctor), *Star Trek Voyager*
http://www.dalywav.com/s.html

A hologram is a photograph[152] in three-dimensions obtained by laser light, giving the impression of *relief*[153].

---

[148] "Unfortunately, while taste can be described objectively, flavor cannot. For flavor is a product of both taste and odor, and odor cannot, as yet, be described objectively in some universally accepted manner […] For practical reasons, savors and odors are still described mainly by analogy (a "cherry" flavor, a "honey-suckle" odor), and it is debatable whether these highly subjective comparisons offer an "adequate description" of the distinctive flavor or fragrance in question" : Iver P. COOPER, "Trademark Aspects of Pharmaceutical Product Design" (1980), 70 *Trademark Reporter* 1, at page 6. See also Nancy L. CLARKE, "Issues in the Federal Registration of Flavors as Trademarks for Pharmaceuticals" (1993), 1 *University of Illinois Law Review* 105, at page 131.

[149] See Gail Vance CIVILLE et al., *Aroma and Flavor Lexicon for Sensory Evaluation : Terms, Definitions, References, and Examples*, ASTM Data Series No 66 (West Conshocken, ASTM, 1996); R.C. HOOTMAN (dir.), Manual on Descriptive Analysis Testing for Sensory Evaluation (West Conshocken, ASTM, 1992). See also the inescapable Maynard A. AMERINE et al., *Principles of Sensory Evaluation of Food* (New York, New York Academic Press, 1965) as well as the voluminous bibliography of the *Sensory Evaluation* (1998) of the Science of Foods faculty of Oregon University URL http://osu.orst.edu/food-resource/sensory/sensory_ref.html (site visited on 19990401).

[150] In the sense of paragraph 4(1) TMA.

[151] "It is unlikely, for example, that taste would ever operate as a trade mark because it would only be experienced after the goods had ceased to be in the course of trade. In other words, there would be no point-of-sale exposure of the mark" : Debrett LYONS, "Sounds, Smells and Signs" [1994] *European Intellectual Property Report* 540, at page 540.

Few applications concerning the registration of trade-marks composed of holograms have been filed with the Canadian trade-marks registrar[154] : none of them has been admitted for publication.

The position adopted by the Trade-marks Office seems to be to the effect that a hologram would constitute many trade-marks instead of a single one[155]. But, although certain techniques make reference to the registration of many images[156], it is generally a matter of a single image[157].

---

[152] A definition that would probably not fit, *stricto sensu*, with the one given by section 2 of the *Copyright Act*, for "'photograph'. The definition includes photo-lithographs and any work expressed by any process *analogous to photography"*. However, nothing would preclude holograms from the definition of artistic works.

[153] Or « Type de photographie renfermant des données sur l'intensité et la phase de la lumière réfléchie par un objet. Lorsque illuminé au même angle que pour l'exposition de l'objet avec de la lumière suffisamment cohérente, un hologramme produit un train d'ondes diffractées d'amplitude et de répartition de phases identiques à celles de la lumière réfléchie par l'objet lui-même, d'où création d'une image tridimensionnelle que l'on peut observer et photographier» : Éric BOSCO (dir), *Holostar – Atelier d'holographie du collège De Maisonneuve* URL http://holostar.cmaisonneuve.qc.ca/ (site consulted on 19990401). See also Paul D. BAREFOOT, *Holophile, Inc.* URL http://www.holophile.com/about.htm (site consulted on 19990401); Rudie BERKHOUT, "Using HOES in the Holographic Image Making Process" (1996), 2652 *Spie Proceeding Series - Practical Holography X*, pp. 204-212; URL http://rudieberkhout.home.mindspring.com/(SPIE)UsingHOE'stomakeholograms.htm (site consulted on 19990401); Groupe de recherches en arts médiatiques – Université du Québec à Montréal, *Dictionnaire des arts médiatiques* (1996) URL http://www.comm.uqam.ca/~GRAM/frames/termA.html (site consulted on 19990401); Christopher OUTWATER et al., «Practical Holography» (1998-02-23); URL http://www.shadow.net/~holodi/holobook.htm (site consulted on 19990401); Sybil PARKER (dir.), *McGraw Hill Encyclopedia of Physics*, 2nd ed. (New York, McGraw-Hill, 1991), at pages 546-553.

[154] TRIANGLES, object of the application TMO 835927 of SmithKline Beecham Inc. for oral hygiene products; BUTTERFLIES ROSES and FISH/CORAL, object of applications TMO 1002075 and 1002079 of Jeanne Lottie's Fashion Incorporated for hand bags.

[155] Sections 24 of the Regulations.

[156] It is the case of the hologram Multiplex : Christopher OUTWATER et al., "Practical Holography" (1998-02-23), URL http://www.shadow.net/~holodi/chap5.htm#Multipex Holograms (site visited on 19990401). It would also be the case for holograms with multiple chanels. Obviously, acoustic holograms are excluded here.

[157] This could however create a practical difficulty concerning the supply of the graphic reproduction (or drawing) of the mark, required by section 30h) of the TMA and section 27 of the Regulations. If the applicant provides different views of the

We should add that, particularly in the case of holograms, we should make sure that they serve the purpose of a trade-mark (to distinguish a person's wares or services from those of others) and not otherwise, as decoration or anti-infringement security measure[158].

«He's a hologram. We've got to help him.»
-Robert PICARDO (The Doctor), *Star Trek Voyager*
http://www.stinsv.com/voy/holodoca.htm

8 KINETIC MARKS

Kinetic (or animated) trade-marks have also developed as products and services identifiers[159] : they are seen at the cinema[160], in cartoons[161] and documentaries[162], while surfing on the web[163] and even when we look for our cars[164].

---

holograms, he might contravene to section 26 of the Regulations whch limits a application for registration to a single mark; however, if the applicant provides a single view (front), his trade-mark is going to be either "unreadable" (because of the absence of angle of light refraction), or not corresponding to the mark as commercialized. We can be inspired by the description of certain American hologram trade-marks. : “The mark consists in the shape of a soccer ball panel applied to the goods” for the cards of The Upper Deck Company (registration 2177761) : “the mark consists of an oblong shaped metallic foil hologram positioned within the binder margin of the goods” for the books for cards of Rembrandt Photo Services (registration 2143827).

[158] Sharon CARR, “Technology’s Anti-Counterfeiting Offensive” (août 1996), *Trademark World* 19; “Chinese Labels to get a new look in 1998 – Dated holographic labels alert authorities, user to conterfeit UL marks” (Winter 1998), 3-4 On the Mark URL http://www.ul.com/about/otm/otmv3n4/dated.htm (site consulted on 19990401); Erik HOFFER, *CGM Security Solutions* URL http://www.teamlogisticscorp.com/cgm10a.htm (site consulted on 19990401); “VEGETA with Hologram – The Original and the Best”; (not dated) URL http://www.podravka.com/en/vegeta/hologram/hologram.html (site consulted on 19990401); Mario XERRI, “Holographic Labels Deter Chinese Counterfeiters” (Summer 1996), 2-2 *On the Mark* URL http://www.ul.com/about/otm/otmv2n2/holo.htm (site consulted on 19990401).

[159] Erik W. KAHN et al., “Starting to Register : Moving Image Marks” (1996-05-26), *The National Law Journal* C-25 and URL http://test01.ljxextra.com/na.archive.html/96/05/121996_0513_1737_3.html (site consulted on 19990401); Erik W. KAHN, “On the ‘Net, Unusual Marks Gain in Importance” (1998-10-19) *The National Reporter* C-13, URL http://test01.ljextra.com/na.archive.html/98/10/1998_1012_69.html (site consulted on 19990401).

They are at the cross-roads of cinematographic works and trade-marks. Copyright protection does not exclude the protection of the trade-mark, since the two protections are different.

Thus, they could be considered under the artistic work[165] angle or the trade-mark[166] angle, or both[167]. The description of such marks can be effectuated with words or with words and a reference to the main image. Here are some examples from the American federal register.

> NETSCAPE (registration US 2077148)
> The mark consists of an animated sequence of images depicting the silhouette of a portion of a planet with an upper case letter "N" straddling the planet and a series of meteorites passing through the scene, all encompassed within a square frame. The animated sequence is displayed during operation of the software. [Five drawings]
>
> TRISTAR (registration US 1981980)
> A moving image beginning with a view of sky and clouds followed by a flash of light from which a winged horse emerged galloping forward. The the word 'TRISTAR' appears over the horse which is shown with outstretched wings. [One drawing]
>
> JIM HENSON (registration US 1919310)

---

[160] Introductive sequence of 20th Century Fox Film Corporation (registrations US 1928424 and 1928423, of Broadway Video, Inc. (registration US 2092415), of Columbia Pictures Industries, Inc. (registration US 1975999) and of Tristar Pictures, Inc.

[161] Animated sequence of KERMIT THE FROG presenting o production of Jim Henson Productions, Inc. (registration US 1919310) or the moving star of Hanna-Barbera Productions, Inc. (registration US 1339596)

[162] The animated soldier helmet of ABC Cable and International Broadcast, Inc. for its production services for televisual documentaries (registration US 2126551)

[163] The N behind which meteorites fly in the top right corner of the navigator of Netscape Communications Corporation (registration 2077148)

[164] The turning globe of the GPS systems of Garmin corporation (registration US 2106424)

[165] With a term of protection limited to 50 years following the end of the calendar year of the creation of the work or of the death of the author, following the photographic, cinema, dramatic or artistic description of the work, (sections 6-10 CA), possible reversion to the legal representatives 25 years after the death of the author (section 14 CA) and respect of the moral rights - may not be assigned - of the author (sections 14.1, 28.1 and 28.2 CA).

[166] Where the rights are created and are maintained through use.

[167] William L. HAYHURST, "What Is a Trade-mark? The Development of Trade-mark Law", in *Trade-marks Law of Canada*, collection Henderson (Toronto, Carswell, 1993), pp. 27-73, at page 66; see also Hugues G. RICHARD (dir.) et al., *Robic Leger Canadian Copyright Act Annotated* (Toronto, Carswell, 1993) at §5.9.2 (updating 1997-4).

> The mark consists of an animated sequence commencing with a laser-like light dropping from a dark background and moving to etching out the head of the character Kermit the Frog (as shown in the drawing) which rotates from a flat position to a full front vertical view with light sparkling around the perimeter, which dissolves to the laser light crossing the background and etching out the mark "JIM HENSON PRODUCTIONS", all accompanied by sound and music; The stippling is a feature of the mark. [One drawing]
>
> COLUMBIA (registration US 1975999)
> The mark consists of a moving image of a flash of light from which rays of light are emitted against a background of sky and clouds. The scene then pans downward to a torch being held by a lady on a pedestal. The word "COLUMBIA" appears across the top running through the torch and then a circular rainbow appears in the sky encircling the lady. [One drawing]
>
> 20TH CENTURY FOX (registration US 1928423)
> The trademark is a computer generated sequence showing the central element from several angles as though a camera is moving around the structure. The drawing represents four "stills" from the sequence. [Four drawings]

In Canada, it is probable that the Trade-marks Office[168] would oppose the registration of such marks because there is not one but many marks involved at a time[169]. With respect to the actual state of the regulations and of administrative policy, the registration of a kinetic trade-mark should be envisaged by means of the principal sequence (in all likelihood, the final) of the animation.

9 TELEPHONE NUMBERS

The appeal section decision of the Federal Court of Canada in the case *Pizza Pizza*[170] has recognized the right to register, in connection with pizza and restaurants, a numerical sequence as a trade-mark although, in fact, this sequence also constituted the phone number of the enterprise.

Of course a phone number has a communications function, but this function is not related to the products and the services themselves.

---

[168] Informal interview over the phone with Suzanne Charrette on 1999-03-31, Policy Director of the Canadian Trade-marks Office.

[169] Section 24 of the Regulations : "A separate application shall be filed for the registration of each trade-mark".

[170] *Pizza Pizza Ltd. v. Canada (Registrar of Trade Marks)* [967-1111] (1985), 6 C.I.P.R. 229, 7 C.P.R. (3d) 428 (F.C.T.D.); rev. (1989), 26 C.P.R. (3d) 355, 24 C.I.P.R. 152, [1989] 3 F.C. 379, 101 N.R. 378, 16 A.C.W.S. (3d) 24 (F.C.A.), now registration TMA 428709 and also commented by Marie PINSONNEAULT, « Votre numéro de téléphone est-il enregistré à titre de marque de commerce? L'affaire Pizza Pizza Limited» (1990), 2 *Les cahiers de propriété intellectuelle* 263. See also *Bell Canada v. Pizza Pizza Ltd.* (1993), [1993] 2 F.C. D-842, [1993] A.C.F. 379, 48 C.P.R. (3d) 129 (F.C.T.D.).

> As I see it, *while undoubtly there is a functional element in its use* by the appellant, in that to place a telephone order for any of the appellant's products the numerical combination that is the telephone number allotted by the telephone company to the appellant must be utilized, *that is not its sole function*. Rather, it is totally unrelated to the wares themselves in the sense that, for example, a numbered part of some product would be so related which is purely a functional use.[171]

Even if a numerical sequence that is also a phone number can be subject to registration[172], in order to maintain this registration, the telephone number must be used according to the *Trade-marks Act*, that is to say, to distinguish an owner's wares and services from those of others[173]. Distinctiveness will remain a question of fact and will depend considerably on how the owner will have shown or marked his trade-mark[174].

Finally, we note that the monopoly[175] confered by such a registration is not absolute and is restricted to the wares or services object of the registration[176].

It would be the same situation for "*Vanity*" telephone numbers, those telephone numbers that spell a name or an interest word[177] for the owner of a telephone number[178] that can be described as follows:

---

[171] *Pizza Pizza Ltd. v. Canada (Registrar of Trade Marks)* [967-1111] (1985), 6 C.I.P.R. 229, 7 C.P.R. (3d) 428 (F.C.T.D.); rev. (1989), 26 C.P.R. (3d) 355, 24 C.I.P.R. 152, [1989] 3 F.C. 379, 101 N.R. 378, 16 A.C.W.S. (3d) 24 (F.C.A.), J. Urie at page 386.

[172] *Phonenames Limited v. 1-800-Flowers Inc* [1-800-FLOWERS], a decision delivered on 19981217 by the english registrar of trade-marks, application 1525943.

[173] It is useful to remind here that, in *Pizza Pizza,* the respondent registrar had admitted that "in the manner in which the numerical combination 967-111 is utilized by appellant, such combination appears as a separate and distinct element, which stands on its own, and creates an actual and substantial distinction between appellant and other traders and between its products and those of others" [C.P.R., at page 358].

[174] *Unitel Communications Inc. v. Bell Canada* [800-SERVICE] (1995), [1995] T.M.O.B. 76, G. Partington at ¶11 and 25.

[175] On 1999-04-01, Pizza Pizza Limited was listed on the register as owner of 33 registrations of trade-marks which end by the sequence 1111, of 4 registrations of trade-marks which end by the sequence 3333 and of 2 registrations of trade-marks which end by the sequence 444. Consider also the sequence 3030 of MIKES pizzerias of M-Corp inc.

[176] Also subject to the conditions of service between the owner of the trade-mark and the telephone company which assigned such telephone number.

[177] The brokerage of "800" numbers gives rise to publicity even here : see (March-April 1999), *National* 7 “Increase Your Case Load! Advertise These Numbers 1-800-INJURED, 1-800-BANKRUPT, 1-800-CRIMINAL, 1-800-DISABILITY, 1-800-DIVORCE – For further information on how to obtain exclusive use of these numbers in your area, please call…”; see also *Your toll free 800 Vanity Telephone number specialist*, URL http://www.4800use.com/numlist.htm (site consulted on 19990401);

> Vanity telephone numbers can include several types of mnemonics : (1) number that correspond to the spelling of a product, such as "1-800-FLOWERS"; (2) numbers that correspond to letters that spell a business name, such as "1-800-HOLIDAY"; (3) numbers that begin with "4" or "2" and end with a product, service, or business name, such as "1-800-4-TRAVEL," and "1-800-2-GO-WEST"; (4) numbers that only partially spell a product or company name, such as "486-HAIR," "239-ALARM," or "222-CASH"; (5) numbers that are easily remembered, such as "1-800-8000"; and (6) numbers that are heavely marketed, but otherwise lack distinctiveness, such as"1-800-325-3535," which Sheraton Inns made into a jingle[179].

Thus, these numerical or alphanumeric sequences can be protected as trade-marks[180], just like the codes[181]related to radio or television stations[182].

We can also presume that, in order to obtain the registration of such numbers - alphabetical or alphanumeric-, an applicant should disclaim[183], if the case arises, the

---

Toll Free Numbers.com, URL www.tollfreenumbers.com (site consulted on 19990401); *Eighthundred*, URL http://www.eighthundred.com/index4.htm (site consulted on 19990401); *WhoSells800.com*, URL http://whosells800.com (site consulted on 19990401).

[178] Closer to home, consider 98-ROBIC and 845-RUSH (respectively the telephone and the fax numbers of the Robic patents and trade-marks agents firm), the number 1-888-123MIKE of the telecommunication systems of Clearnet Communications Inc., the EN FORME number for the Nautilus Plus Inc. fitness center, a hypothetical 1-800-PATENTS for a service offered to inventors, a 1-888-8888 number for the classified ads of the Journal de Montréal or even to the venerable "526-9231 les petites annonces du Montréal Matin ne coûtent pas cher et rapportent bien"!

[179] Lisa D. DAME, “Confusingly Dissimilar Applications of Trademark Law to Vanity Telephone Numbers” (1997), 46 *Catholic University Law Review* 1199, at page 1246, note 1.

[180] Just like, for instance, the V-8 vegetable cocktail and A-1 sauce.

[181] Which we must not confuse with frequencies. See J. Thomas McCARTHY, *McCarthy on Trademarks and Unfair Competition*, 4th ed. (St Paul, West Group, 1996), at §7:17 (updating 6 in 6/98).

[182] Dan L. BURK, “Trademarks Along the Infobahn : A First Look at the Emerging Law of Cybermarks” (1995), 1 *Richmond Journal of Law and Technology* 1, at ¶50-51, URL http://www.urich.edu/~jolt/vlil/burk.html (site consulted on 19990401) : this is also related to the radio stations signs (CKOI, CHUM or CIEL), as the frequency (690 AM or 95,1 MF), as long as there is a use as a trade-mark and not as an address. A similar argument can be made with respect to domain names : François PAINCHAUD, «La propriété intellectuelle sur l’Internet», in *Internet et inforoute* (Montréal, Institut canadien, 1995), URL http://www.robic.ca, under publication 179 (site consulted on 19990401) and Marie-Hélène DESCHAMPS-MARQUIS, «Les noms de domaine : au delà du mystère» (1999), 11-3 *Les cahiers de propriété intellectuelle*.

[183] Section 35 TMA.

right to the exclusive use of the non-registrable[184] portion of the trade-mark[185]. The numerical or alphanumeric mark can thus be protected and this protection is to be assured by taking the trade-mark as a whole (*i.e.,* without dissecting it)[186], taking into consideration usual criteria to evaluate confusion[187] and the average consumer who knows the first mark but has a vague recollection of it[188].

Interesting questions relate to the infringement of such trade-marks. With respect to the use of telephone numbers of old partners, employees or franchisees or the use by a competitor of a number in a manner to create confusion, the case law is abundant[189].

---

[184] For instance, last name, description of the product or of its origin, name of the product in another language : paragraph 12(1) TMA. The prohibition of paragraph 12(1)(b) as to the descriptive character is not limited to the graphic aspect of the trade-mark, but it also concerns its phonetic aspect : the U for *You*, 2 for *To* and 4 for *For* would then be considered in the examination concerning the registrability and the necessity of an examination.

[185] Within the context of the evaluation of confusion between two trade-marks, one must take into consideration the whole of the trade-marks concerned, including the part for which there has been a disclaimer.: *Questor Commercial Inc. v. Discover Services Ltd.* (1979), 46 C.P.R. (2d) 58 (F.C.T.D.), J. Cattanach at page 19.

[186] On the general valuation, see, among other cases, *Mr. Submarine Ltd.* v. *Amandista Investments Ltd.* [Mr. SUBMARINE] (1986), 11 C.P.R. (3d) 425, 9 C.I.P.R. 164, 6 F.T.R. 189, [1986] 3 F.C. F-33 (F.C.T.D.); rev. (1987), [1988] 3 F.C. 91, 16 C.I.P.R. 282, 19 C.P.R. (3d) 3, 81 N.R. 257 (F.C.A.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* [POSTURE-BEAUTY] (1987), 18 C.P.R. (3d) 84 (Opp. Board); conf. (1989), 25 C.P.R. (3d) 408, 29 F.T.R. 264; rev. (1991), 37 C.P.R. (3d) 413, 130 N.R. 223, [1991] 3 F.C. F-52 (F.C.A.); *Miss Universe, Inc. v. Bohna* [MISS NUDE UNIVERSE] (1991), 36 C.P.R. (3d) 76 (Comm.opp.); conf. (1992), [1992] 3 F.C. 682, 43 C.P.R. (3d) 462 (F.C.T.D.); rev. (1994), [1995] 1 F.C. 614, 58 C.P.R. (3d) 381, 165 N.R. 35, [1994] F.C.A.D. 3362-01 (F.C.A.).

[187] Section 6 TMA.

[188] "The imperfect recollection of the unwary purchaser" according to Canadian case law since *General Motors Corporation v. Bellows* (1949), 9 Fox Pat. 78, 10 C.P.R. 101, [1950] 1 D.L.R. 569, [1949] S.C.R. 678 (S.C.C.).

[189] See, among others, in Quebec the cases *Piscines et abris Tempo inc. (Les) v. Tempo Fab inc.* (1978), J.E. 78-1023 (C.S.Q.); *Librairie Ste-Thérèse inc. v. Papeterie-librairie Ste-Thérèse inc*. (1995), J.E. 05-1899 (C.S.Q.), J. Julien; *Paquin v. Fournier* (1996), J.E. 96-663 (C.S.Q.), J. Daigle; *Via Route inc. v. Zawahry* (1997), J.E. 97-197 (C.S.Q.), J. Rayle; *Association coopérative des taxis de l'Est de Montréal inc. v. Harfouche* (1997), L.P.J. 97-0546, J.E. 97-192, [1997] A.Q. 2388 (C.A.Q.); *Club Vidéo Éclair inc. v. 9045-9835 Québec inc.* (1998), [1998] A.Q. 1740 (C.S.Q.) J. Walters and, elsewhere in Canada, *Breuvage Lucky One Inc. v. L.B.G. Distributors Ltd.* (1971), 64 C.P.R. 226 (Ex. Ct.), J. Noël; *Carnen Systems Corporation v. British Columbia Telephone Co.* (1983), 74 C.P.R. (2d) 48 (B.C.S.C.), J. Bouck; *Goliger's Travel Ltd. v. Gilway Maritimes Ltd.* (1987), 17 C.P.R. (3d) 380 (N.S.S.C.), J. Hall; *Allbram Taxi Inc. v. Sandhu* (1988), 24 C.P.R. (3d) 334 (O.D.Ct.), J. West; 241 *Pizza*

The most interesting questions are surely to come[190]. For instance, what about the competitor who chooses a telephone number according to the propensity of consumers to confuse certain letters (the letter "o" and the number "0" as well as the letter "l" and the number "1"), to make frequent spelling mistakes (double consonants), or to use a different area code but with the same numbers as those corresponding to the competitor mnemonic number[191]? What about the very often descriptive[192] character of the number/mark : does the addition of a brief numerical

---

Ltd. v. 872515 Ontario Inc. (1992), 43 C.P.R. (3d) 527 (Ont. Ct. Gen Div.); *Tel-E-Connect Systems Ltd. v. Modular telephone Interface Ltd.* (1993), 52 C.P.R. (3d) 138 (Ont. Ct. Gen. Div.), J. MacDOnald. See also Christopher WADLOW, *The Law of Passing-Off*, 2nd ed. (London, Sweet & Maxwell, 1995), at §6.70 to 6.72.

[190] At least in Canada because, in the United States, abundant doctrine already exists: Keith A. BARRIT, ""Use" of Another's Trademark in Vanity Phone Numbers and Internet Domain Names" (1998), 4 *Intellectual Property Today*, article 1; URL http://www.lawworks-iptoday.com/04-98/barritt.htm (site consulted on 19990401); Keith A. BARRIT, "FCC Acts on Trademark Rights in Vanity Numbers in the "888" and "877" Toll-free Exchanges", URL http://www.fr.co./piblis/fcctmvanity, html (site consulted on 19990401); Dan L. BURK, "Trademarks Along the Infobahn : A First Look at the Emerging Law of Cybermarks" (1995), 1 *Richmond Journal of Law and Technology* 1, at ¶52-59, URL http://www.urich.edu/~jolt/vlil/burk.html (site consulted on 19990401) ; Lisa D. DAME, "Confusingly Dissimilar Applications of Trademark Law to Vanity Telephone Numbers" (1997), 46 *Catholic University Law Review* 1199; Anthony L. FLETCHER et al., "The Forty-third Year of Administration of the Lanham Trademark Act of 1946" (1990), 80 *Trademark Reporter* 591, at pages 675-677 ; Elizabeth A. HORKY "1-800-I-AM-VAIN : Should Telephone Mnemonics Be Protected As Trademarks ?" (1995), 3 *Journal of Intellectual Property* 213, URL http://www.lawsch.uga.edu/~jipl/vol3/horky.html (site consulted on 19990401); Terry Ann SMITH, "Telephone Numbers that Spell Generic Terms : A Protectable Trademark or an Invitation to Monopolize a Market?" (1994), 28 *University of San Francisco Law Review* 1079.

[191] We thus note, by numerical equivalence, 1-800-HOLIDAY and 1-800-H0LIDAY, INJURY-1 and INJURY-9, 1-800-GO-U-HAUL and 1-800-GO-U-HALL, YELLOW BOOK and 1-800-YELLOW B[OOK], 1-900-BLU BOOK and 1-800- BLUE BOOK, 772-ROOF and 773-ROOF, CALL-LAW and LAW-CALL, LAWYERS and 1-800-LAWYERS, all these examples are given by Lisa D. DAME, "Confusingly Dissimilar Applications of Trademark Law to Vanity Telephone Numbers" (1997), 46 *Catholic University Law Review* 1199, at page 1200, note 5 and Elizabeth A. HORKY "1-800-I-AM-VAIN : Should Telephone Mnemonics Be Protected As Trademarks ?" (1995), 3 *Journal of Intellectual Property* 213, URL http://www.lawsch.uga.edu/~jipl/vol3/horky.html (site consulted on 19990401) at ¶35-50.

[192] Anthony L. FLETCHER et al., "The Forty-third Year of Administration of the Lanham Trademark Act of 1946" (1990), 80 *Trademark Reporter* 591, at pages 675-676 and Ann SMITH, "Telephone Numbers that Spell Generic Terms : A Protectable

sequence create private rights[193]? Alternatively, one can ask oneself if presumably weak inherent distinctiveness will result in slight variations to numerical correspondence being sufficient to avoid infringement[194]. And, of course, has the alphanumeric or numerical mark been used as a trade-mark or for another purpose?

10 THREE-DIMENSIONAL MARKS

«My view is that, properly practised, design is nothing if not a courageous adventure.»
Arthur ERICKSON, The Architecture of Arthur Erickson (1988)

The external appearance of a product, its distinctive packaging, can, regardless of registration, be protected against copying on the grounds of unfair competition and passing off[195], so long as this appearance is largely recognized by the public as identifying a particular source[196]. However, can such a trade-mark be registered?

Trademark or an Invitation to Monopolize a Market?" (1994), 28 *University of San Francisco Law Review* 1079.

[193] The interest of the question, of course, is a matter of the determination of infringement in accordance with the *Trade-marks Act* rather than constituting unfair competition (as codified at section 7 TMA and in Quebec at section 1457 C.c.Q.)

[194] "Finally, in the context of slight variations, any change in the mnemonic should be enough to distinguish the marks. As noted above, any change in a mnemonic is a functional change in the operation of the telephone that will be noticed by the consumer. Clearly any change in a mnemonic will be a change in the underlying telephone number. In order to prevent a firm from monopolizing a group of numbers through the luck of being the first to get a telephone number, slight variations should distinguish the second mark" : Elizabeth A. HORKY "1-800-I-AM-VAIN : Should Telephone Mnemonics Be Protected As Trademarks ?" (1995), 3 *Journal of Intellectual Property* 213, URL http://www.lawsch.uga.edu/~jipl/vol3/horky.html (site consulted on 19990401), at ¶77-78.

[195] For instance, *Source Perrier v. Canada Dry Ltd.* [BOUTEILLE INDIAN CLUB] (1982), 64 C.P.R. (2d) 116, 36 O.R. (2d) 695 (Ont. H.C.); *Iona Appliances Inc. v. Hoover Canada Inc*. [ASPIRATEUR VROOM BROOM] (1988), 32 C.P.R. (3d) 304 (Ont. H.C.); *Dumont Vins & Spiritueux Inc. v. Celliers du Monde Inc.* [BOUTEILLE DE TYPE HOCK BLACHE OPAQUE] (1990), [1990] R.J.Q. 556 (C.S.Q.), withdrawal of appeal 500-09-000100-909 produced on 1990-08-17; *Reckitt & Colman Products Ltd. v. Borden Inc.* [JIF LEMON CONTAINER] (1990), [1990] 1 W.L.R. 491, 17 I.P.R. 1, [1990] 1 All E.R. 873, [1990] R.P.C. 116 (H.L. Angleterre); *Ray Plastics Ltd. v. Dustbane Products Ltd.* [BALAI À NEIGE SNOW TROOPER] (1990), 33 C.P.R. (3d) 219, 75 O.R. (2d) 37 (Ont. Ct. gen. Div..); additional motives to (1990), 33 C.P.R. (3d) 219-237, 47 C.P.C. (2d) 280; conf. (1994), 57 C.P.R. (3d) 474, 74 O.A.C. 131 (C.A. Ont.); (1995), 62 C.P.R. (3d) 247 (Ont. Ct. Gen. Div. - damages); *Kraft Jacobs Suchard (Schweiz) A.G. v. Hagemeyer Canada Inc*. [TABLETTE DE CHOCOLAT TOBLERONE] (1998), 78 C.P.R. (3d) 464 (Ont. Ct. Gen. Div.).

[196] *Oxford Pendaflex Canada Ltd. v. Korr Marketing Ltd.* [DESK OFFICE TRAY] (1979), 23 O.R. (2d) 545, 46 C.P.R. (2d) 191, 97 D.L.R. (3d) 124 (H.C. Ont.); conf. (1980), 27 O.R. (2d) 760n, 47 C.P.R. (2d) 119n, 107 D.L.R. (3d) 512n (C.A. Ont.);

The right to register three-dimensional trade-marks depends on the statutory definition of "distinguishing guise"[197].

If the trade-mark is a shaping of the merchandise[198] or of its container[199] or is a way to envelop or to pack the merchandise[200], the trade-mark will then be considered as a distinguishing guise[201].

---

conf. (1982), [1982] 1 S.C.R. 494, 64 C.P.R. (2d) 1, 134 D.L.R. (3d) 271, 41 N.R. 553, 20 C.C.L.T. 113 (S.C.C.). Louis CARBONNEAU «La concurrence déloyale au secours de la propriété intellectuelle», in *Développements récents en droit de la propriété intellectuelle (1995)*, Service de la formation permanente du Barreau du Québec (Cowansville, Blais, 1995), at pages 239-292. See also generally R. Scott JOLLIFFE, "The Common Law Doctrine of Passing OFF", in *Trade-marks Law of Canada*, Henderson collection (Toronto, Carswell, 1993), at chapiter 8 and Christopher WADLOW, *The Law of Passing-off*, 2nd ed. (London, Sweet & Maxwell, 1995), at chapiter 6.

[197] Section 2 TMA : "distinguishing guise" Means : a) a shaping of wares or their containers, or b) a mode of wrapping or packaging wares the appearance of which is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or perform by others. We should take note that the qualification "the appearance of which" is linked to the paragraph a) as well as the paragraph b) : *Registrar of Trade Marks v. Brewers Association of Canada* (1978), [1979] 1 F.C. 849, 5 B.L.R. 155, 94 D.L.R. (3d) 198, 42 C.P.R. (2d) 93 (F.C.T.D.), J. Cattanach at page 96; rev. on another point (1982), [1982] 2 F.C. 622, 132 D.L.R. (3d) 577, 41 N.R. 470, 62 C.P.R. (2d) 145 (F.C.A.),

[198] The TOBLERONE chocolate of Kraft Jacobs Suchard (Switzerland) (Registration TMA 164635).

[199] The packaging of TOBLERONE chocolate of Kraft Jacobs Suchard (Switzerland) (application TMO 832993) or the bottle of orange juice ORANGE MAISON of A. Lassonde inc. (registration TMA 407013).

[200] "The mode of wrapping a cylindrical roll having a hollow control core, according to which the roll is so enclosed in a rectangular sheet of paper having red bands at two opposite edges as to dispose the red bands over the whole of the flat annular ends of the roll and provide a substantially cylindrical package and flat ends of which are red" : registration UCA 046595 (today struck off) for the toilet paper FACELLE of The Procter & Gamble Company. Not to confuse with the trade-mark that is only applied to the packaging : "the trade mark consist of a tartan design applied to the packaging for the applicant's wares", in the case in point the cookies of Nabisco Ltd. (registration TMA 492729).

[201] On this topic, see generally Hugues G. RICHARD (dir.), *Leger Canadian Trade-marks Act Annotated* (Toronto, Carswell, 1984), under section 13; see also Mary CARDILLO "Distinguishing Guise Trade Marks and Their Relationship to Copyright and Industrial Design" (1989), 6 *Canadian Intellectual Property Review* 14.

If the distinguishing guise does not cover the merchandise or the container entirely but only a part of these, it is nonetheless by way of distinguishing guise that we must proceed[202].

The way to wrap or to pack wares would include[203] containers or supports and both could benefit from protection as a distinguishing guise[204]. Furthermore, the Trade-marks Office policy is to the effect that everything that is shown on the wrapping will be part of the distinguishing guise, unless it has been excluded specifically.

If a mark falls under the definition of "distinguishing guise", its owner does not have any other choice than to register it as a distinguishing guise rather than an "ordinary" trade-mark[205].

An application for registration of a distinguishing guise is however not limited to one (shaping or container) or the other (wrapping) mentioned in the statutory definition of this term. It is admitted that a distinguishing guise can include one or the other of these elements[206], on the condition however that the applicant proves that every

---

[202] If we had to interpret the definition of distinguishing guise as limited to the shaping of a merchandise or a container as a whole, this would [TRANSLATION]"permit an applicant to easily bypass the restrictions provided at section 13 of the *Act*, because an applicant could then delete an unimportant detail of the shaping of the merchandise as a whole and obtain a protection regarding this guise as a regular trade-mark": Draft of the practice notice of the 1999-01-27 of the Trade-marks Office.

[203] Concerning the definition of "package" given by s. 2 TMA.

[204] *Smith Kline & French Canada Ltd. v. Canada (Registrar of Trade-marks) [No. 1]* [LIGHT GREEN COATING] (1987), 9 F.T.R. 127, 12 C.I.P.R. 199, 14 C.P.R. (3d) 432, [1987] 2 F.C. 628 (F.C.T.D.), J. Strayer at page 632. The application TMO 462697, which was the object of this appeal, described distinguishing guises in these terms : "The distinguishing guise consists of a light green coloured coating applied to the outside of a circular bi-convex tablet as shown in the attached drawing lined for the colour green".

[205] *Registrar of Trade Marks v. Brewers Association of Canada* (1978), [1979] 1 F.C. 849, 5 B.L.R. 155, 42 C.P.R. (2d) 93, 94 D.L.R. (3d) 198 (F.C.T.D.); rev. (1982), [1982] 2 F.C. 622, 132 D.L.R. (3d) 577, 41 N.R. 470, 62 C.P.R. (2d) 145 (F.C.A.), J. Pratte at page 149.

[206] In a draft of the practice notice of the 1999-01-27**,** the Trade-marks Office considers that a distinguishing guise can include a combination of elements described in a) and b) of the definition; based on an *obiter* in *Smith Kline & French Canada Ltd. v. Canada (Registrar of Trade-marks) [No. 1]* [LIGHT GREEN COATING] (1987), 9 F.T.R. 127, 12 C.I.P.R. 199, 14 C.P.R. (3d) 432, [1987] 2 F.C. 628 (F.C.T.D.), J. Strayer at page 631 : "While I am not convinced that an appicant should be precluded from claiming as part of his monopoly elements described in both (a) and (b) of the definition, I need not decide that matter here".

element constitutes an acceptable element of a distinguishing guise[207]. If the trade-mark contains elements covered by the definition of distinguishing guise and others that are not[208], then the provisions concerning the registration of distinguishing guises will apply.

In order to obtain the registration of a distinguishing guise, one must prove[209] to the registrar that the guise has been used in Canada so that it has become distinctive[210] at the date of the application[211] and that this use will not have the effect to unduly limit commerce[212]. In fact, distinguishing guises often have functional aspects[213].

---

[207] *Smith Kline & French Canada Ltd. v. Canada (Registrar of Trade-marks) [No. 1]* [LIGHT GREEN COATING] (1987), 9 F.T.R. 127, 12 C.I.P.R. 199, 14 C.P.R. (3d) 432, [1987] 2 F.C. 628 (F.C.T.D.), J. Strayer at page 631.

[208] For instance a container on which a nominal trade-mark would also be marked.

[209] The nature of the required evidence is provided at the section 32 TMA and is the object of technical indications in the *Trademark Manual of Examining Procedure*, 2nd ed. (Hull, Approvisionnement et Service Canada, 1996), at §II.7.6 and §IV.10; see also the practice notice *Evidence Required Pursuant to Subsections 31(2) and 32(1) of the Trade-Marks Act* of 1975-07-30, *Distinguishing Guise* of 1976-09-01 and *Requirement with respect to section 12(2) evidence* of 1985-01-02. Moreover, as J. MacKay reminds, "In my view, the Act provides for registration of a distinguishing guise, through application, in the same manner as for other trade marks" : *Calumet Manufacturing Ltd. v. Mennen Canada Inc.* (1991), 50 F.T.R. 197, 40 C.P.R. (3d) 76 (F.C.T.D.), at page 87.

[210] And, as for a trade-mark, the evidence of a use of this distinguishing guise by non-licensee third parties will lead to the conclusion of the absence or the loss of the distinctive character. : *Calumet Manufacturing Ltd. v. Mennen Canada Inc.* (1989), [1989] T.M.O.B. 246, 27 C.P.R. (3d) 467 (Opp. Board), M. Martin at pages 473-474; conf. (1991), 50 F.T.R. 197, 40 C.P.R. (3d) 76 (F.C.T.D.), J. MacKay at pages 91-96; *Gillette Canada Inc. v. Mennen Canada Inc*. (1989), 32 C.P.R. (3d) 216, 26 C.I.P.R. 258, [1989] T.M.O.B. 245, M. Martin at page 222; conf. (1991), 50 F.T.R. 197, 40 C.P.R. (3d) 76 (F.C.T.D.)

[211] Paragraph 13(1)a) TMA : "A distinguishing guise is registrable only if : a) it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration […]". See *Sport Maska Inc. v. Canstar inc. v. Canstar Sports Group Inc.* [HOCKEY HELMET]), (1994), J.E. 94-1396, english translation at 57 C.P.R. (3d) 323 (C.S.Q.), J. Denis at pages 345-347 (appeal 500-09-001275-940 abandonned on 1995-08-16).

[212] Paragraph 13(1)b) : "A distinguishing guise is registrable only if : […] b) the exclusive use by the applicant of the distinguishing guise in association with the wares or services with which it has been used is not likely unreasonably to limit the development of any art or industry." And paragraph 13(3) "The registration of a distinguishing guise may be expunged by the Federal Court on the application of any interested person if the Court decides that the registration has become likely unreasonably to limit the development of any art or industry". This rejoins the functionality argument discussed previously. : see Maureen BOYD CLARK, « Passing Off and Unfair Competition : The Regulation of the Marketplace» (1990), 6

However, the question is not to find out whether the configuration of the merchandise contains utilitarian elements, but rather to determine whether the degree of their functionality is such that there is an absence of protection as distinguishing guise[214].

The burden to show the distinctiveness lies with the applicant[215]. Finally, one must remember that there is nothing preventing a distinguishing guise from distinguishing services or products other than those with respect to which they are the shaping or the wrapping.

What about two-dimensional trade-marks that are marked on three-dimensional objects? Again, one will have to determine what the mark consists of and the importance of its positioning on the three-dimensional object[216].

Intellectual Property Journal 1, at pages 28 to 31 and Louis CARBONNEAU «La concurrence déloyale au secours de la propriété intellectuelle», in *Développements récents en droit de la propriété intellectuelle (1995)*, Service de la formation permanente du Barreau du Québec (Cowansville, Blais, 1995), at pages 260-272.

[213] Section 13(2) TMA provides that : "No registration of a distinguishing guise interferes with the use of any utilitarian feature embodied in the distinguishing guise".

[214] *Remington Rand Corp. v. Philips Electronics N.V* [SHAVER HEAD] (1993), 51 C.P.R. (3d) 392, 69 F.T.R. 136, 44 A.C.W.S. (3d) 579 (F.C.T.D.); rev. (1995), 64 C.P.R. (3d) 467, 191 N.R. 204, [1995] A.C.F. 1660 (F.C.A.) [motion for a leave to appeal to the Supreme Court of Canada refused (1996), 67 C.P.R. (3d) vi (S.C.C.).], J. MacGuigan at paragraph 18-21. See also Justine WIEBE, “Philips’ Triple-Headed Shaver : When a Shave Can Be Too Close For Comfort” (1996), 3 *Intellectual Property Journal* 120, at page 122 and Carol HITCHMAN, “Trade Marks versus Patents; The Protection of Functional Elements (1999), 5 *Intellectual Property Journal* 298, at page 298. See also Peter HANSEN, “Getting Into Shape – The Trade Mark Issues” (1999), 1 *In Depth* 1., at page 3.

[215] “However, due to the overwhelming functionality of all but one minor aspect of the design, it is, at best, an inherently weak distinguishing guise. Thus, not only is there a heavy onus on the applicant to establish the distinctiveness of its distinguishing guise pursuant to s. 13(1) of the Act, that onus is particularly severe where, such as in the present case, the guise is inherently weak” : *Gillette Canada Inc. v. Mennen Canada Inc*. (1989), 26 C.I.P.R. 258, [1989] T.M.O.B. 245, 32 C.P.R. (3d) 216 (Opp. Board) M. Martin, at page 220; conf. (1991), 50 F.T.R. 197, 40 C.P.R. (3d) 76 (F.C.T.D.) to the same effect, *Novopharm Ltd. v. Burrough Wellcome Inc.* [HEXAGONAL TABLET] (1999), [1999] T.M.O.B. 23 (Opp. Board) M. Martin at ¶30-32 et 36-37. See also *Mr. Frostee Inc. v. Dickie Dee Ice Cream (Canada) Ltd.* [FROZEN CONFECTION ON STICK] (1994), [1994] T.M.O.B. 312, 59 C.P.R. (3d) 393 (Opp. Board) G. Partington at pages 396 and 398; *Celliers du Monde Inc. v. Dumont Vins & Spiritueux Inc*. [BOUTEIILE HOCK BLANCHE OPAQUE] (1997), [1997] T.M.O.B. 244, 82 C.P.R. (3d) 396 (Opp. Board), M. Herzig at ¶4.

[216] Although the Trade-marks Office indicates a policy to the effect that the description of the trade-mark should not contain any kind of indication that can lead someone to think that the mark encompasses a three-dimensional element, like a statement which specifies that the drawing shows the spot where the trade-mark is

Since it is not just a word mark, a drawing must also be provided. The drawing has to represent the trade-mark and not the one marked on the three-dimensional object. If the case arises, in order to describe the trade-mark more efficiently, the application can be accompanied by a drawing showing how the trade-mark is marked. However, this drawing must comply with the requirements of the Trade-marks Office[217], and these requirements are as follows :

- The outline of the three-dimensional object must be represented with a dotted line;
- The application must consist of a statement to the effect that the three-dimensional object, which is shown by the dotted line on the drawing, is not a part of the trade-mark and is solely represented to provide an example of the manner by which the trade-mark can be marked on a three-dimensional object.
- The application must include a description of the mark indicating clearly that the application only foresees the two-dimensional mark[218].

These requirements address only questions of form and do not restrict the Trade-marks Office from verifying the functional or decorative character of the trade-mark applied for.

11 MISCELLANEOUS

11.1 ARCHITECTURAL MARKS

The appearance, the external and internal decoration of a business is also susceptible of protection. Numerous decisions from the Courts relating to

---

marked on a three-dimensional object, the weekly reading of the Trade-marks Journal reveals that before January 1999 this policy was not uniformly enforced. We would have to, for instance, describe such a trade-mark as a trade-mark consisting of a representation of a cross which appears on the bottle; the representation of the bottle by a dotted line is not part of the trade-mark.

[217] See *Trademark Manual of Examining Procedure*, 2nd ed. (Hull, Approvisionnement et Service Canada, 1996), at §IV.2.4 with respect to the representation of wares by a dotted line (drawing). See also the notice of the *Trade-Marks Journal change of format and drawings requirements under Rule 32(1)* of the 1978-11-01 and *Full and dotted outlines* of the 1980-13-30 published in the Trade-marks Journal.

[218] Draft of the practice notice of the 1999-01-27 of the Trade-marks Office.

restaurants[219] prove it. The recourse used is generally an interlocutory recourse based on unfair competition and “passing off” in respect of "get-up" and so on.

However, it is possible to register as a trade-mark[220] the distinctive elements of business premises. In Canada there is the truncated pyramid of the ST-HUBERT rotisserie, as well as the golden arches of MCDONALDS restaurants, the roofs of the DAIRY QUEEN ice cream outlets or the gable of a KENTUCKY restaurant[221].

The subject matter is not the registration of an image consisting of the representation of the building as it could be marked on certain products, but rather the architectural aspect of the products, as seen by the consumer[222].

The elements of the external (or internal) appearance of the building that we want to protect must distinguish the products or services of a person from those of another. These elements will have to indicate a source rather than being presented or perceived as decorative elements[223]. However, it should be sufficient, in this context,

---

[219] Christopher BRETT, “Get-Up of Premises and Action for Passing Off” (1991), 7 *Canadian Intellectual Property Review* 259; George R. STEWART, “Two Pesos for a Taco : Inherent Distinctiveness and a Likelihood of Confusion for Protectable Trade-mark Rights – Hold the Secondary Meaning” (1993*), Intellectual Property Journal* 1; Louis CARBONNEAU “La concurrence déloyale au secours de la propriété intellectuelle”, in *Développements récents en droit de la propriété intellectuelle (1995)*, Service de la formation permanente du Barreau du Québec (Cowansville, Blais, 1995), at pages 257-258.

[220] The distinctive packaging, in this case, is not a part of the strict definition of « distinguishing guise » given by section 2 TMA.

[221] As an illustration, see the architectural archs (registration TMA 148964), the descriptive double archs (registration TMA 152229) and the general external appearance (registration TMA 280 719) of a MCDONALD’S restaurant, characteristic roofs of a DAIRY QUEEN (registrations TMA 197852 and 197921), external appearance of an ARBY’S restaurant (registration TMA 165839), COUNTRY CHICKEN (registration TMA 294507) or POPEYES (registration TMA 319712), awning of a restaurant FIRE PIT (registration TMA 303139), roof a MELODY FARM restaurant (registration TMA 449 587) or gable of a KENTUCKY restaurant (registration TMA 400998).

[222] “And the design of a restaurant does not, except metaphorically, package the wares and services. Rather, the design and get up of the premises serve to advertise, inform, suggest, attract and perhaps describe the goods and services that are offered for sale” : George R. STEWART, “Two Pesos for a Taco : Inherent Distinctiveness and a Likelihood of Confusion for Protectable Trade-mark Rights – Hold the Secondary Meaning” (1993*), Intellectual Property Journal* 1, at page 19.

[223] Considered as architectural or artistic works, these elements can also, in certain circumstances, benefit from the *Copyright Act* protection (R.S.C. 1985, c. C-42). Can also be contemplated the protection in accordance with the *Industrial Design Act* (R.S.C. 1985, c. I-9), a drawing being described as "[…] features or shape,

to justify use as a trade-mark by indicating that the services are rended or the products sold from those establishements[224]. Normally, it boils down to a matter of evidence, especially as to the manner of presentation to the public.[225]

11.2 PORTRAITS

One cannot register a trade-mark that principally constitutes the name or the last name of a family or of an individual[226]. On the other hand, there is nothing stopping us from registering the portrait of an individual[227] as a trade-mark, so long as this individual gives his consent[228].

This portrait can be a photograph, a painting or a drawing[229]. The consent of the person is self-evident, if only for the right to his image[230].

The mentions required by the Trade-marks Office with respect to applications for registration of such trade-marks will vary according to their nature[231]. But, if the

---

configuration, pattern or ornament and any combination of those features that, in a finished article, appeal to and are judged solely by the eye".

[224] J. Thomas McCARTHY, *McCarthy on Trademarks and Unfair Competition*, 4th ed. (St Paul, West Group, 1996), at §7:101 (updating 8 in 12/98).

[225] George R. STEWART, "Two Pesos for a Taco : Inherent Distinctiveness and a Likelihood of Confusion for Protectable Trade-mark Rights – Hold the Secondary Meaning" (1993*), Intellectual Property Journal* 1, at pages 12-15.

[226] Paragraph 12(1)a) TMA. It is still possible to register such a trade-mark by proving, according to the paragraph 14(1), that this trade-mark has become distinctive or, in accordance with paragraph 14(1) that the trade-mark is not without any distinctive character.

[227] Paragraph 12(1)e) TMA reads as follow : "[…] a trade-mark is registrable if it is not […] a mark of which the adoption is prohibited by section 9 or 10" and thus makes reference, among other things, to paragraphs 9(1)(k) and 9(1)(l) TMA : "[…]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 […] k) any matter that may falsely suggest a connection with any living individual; l) the portrait or signature of any individual who is living or has died within the preceding thirty years".

[228] Paragraph 9(2) TMA.

[229] Themselves protectable according to the *Copyright Act* (R.S.C. 1985, c. C-42) : we then have to make sure of the title to these works, taking into consideration sections 10 and 13 CA.

[230] See sections 35 and 35,5^{o} of the *Quebec Civil code* (L.Q., 1991, c. 64)

[231] "The portrait is that of the registrant", HARRIGAN (TMA 211558); "The drawing comprising the trade-mark is the portrait of a fictional character" MEN'S HEAD DESIGN (TMA 440011); "The portrait forming part of the trade mark is not of a living individual or one who has died in the last 30 years" HENRY CHOICE (TMA 437196); "An imaginary portrait of the head and shoulders of the historic Cardinal Wolsey

subject matter is an individual who is still alive[232], the Trade-marks Office will require the production of a written consent.

11.3 SLOGANS

The *Competition Act* used to prohibit the registration of a trade-mark that would be composed of more than 30 characters apportioned in four groups or less[233], this requirement was very similar to an anti-slogan measure[234].

The *Trade-marks Act*[235] did not include this odd restriction and a trade-mark can be registered regardless of the number of characters that it contains[236], which allows for the registration of slogans and other promotional material.

However, as is the case for other trade-marks, such a slogan, in order to be registered, has to distinguish - or be adapted to distinguish- the wares and services of its user from those of others[237]. In order to be registered, slogans do not have to be literary works[238] or new expressions: a well known expression, by its liaison with a product or a service, can easily serve to distinguish wares and services.

---

wearing a Cardinal's cap" PORTRAIT DESIGN (UCA 004635); "The portrait and signature appearing in the trade mark are those of Father Sebastian "Kneipp who died in 1897" PORTRAIT OF MAN (TMA 428532);

[232] Presumably, if this person is dead for at least 30 years, such a consent could be obtained from his/her succession. See the paragraphs 35(2) and 625(3) *C.c.Q*. and *Fondation Le Corbusier v. Société en commandite manoir Le Corbusier Phase I* (1991), [1991] R.J.Q. 2864 (C.S.Q.), J. Lemieux at pages 2871-2873, withdrawal of appeal 500-09-001609-916 produced on 19941122.

[233] S.C. 1932, c. 38, paragraph 26(1)a).

[234] Harold G. Fox, *The Canadian Law of Trade Marks and Unfair Competition,* 2nd ed. (Toronto, Carswell, 1972), at page 78.

[235] S.C. 1953, c. 49, now R.S.C. 1985, c. T-13.

[236] We are still waiting for the person who, willing to publish his/her poem or a short story**,** will simply ask for its registration as a trade-mark, obtaining as such publication and dissemination by means of the Trade-marks Journal…

[237] See the discussion at section 2.2 *supra* on how to use a trade-mark. The slogan trade-mark will also have to comply with the other provisions of the Act, the non-registrability of descriptive or false and deceptive trade-marks for instance.

[238] Section 2 of the *Copyright Act* describes "work" as also including the titles. For a discussion on the protection of titles and slogans by means of the *Copyright Act*, see Hugues G. RICHARD (dir.) et al., *Robic Leger Canadian Copyright Act Annotated* (Toronto, Carswell, 1993), under 2(25) "work" (unpdating 1997-3).

To incorporate in a slogan a trade-mark already registered will not automatically prevent the slogan from being registered as a trade-mark[239]. However, caution is advised[240].

12 CONCLUSION

In Canada[241], the statutory protection of trade-marks is still regulated by obsolete criteria and with outdated definitions, disconnected from contemporary commercial reality[242], at least with respect to the protection that it gives to non-traditional trade-marks.

The *Trade-marks Act* has not been adapted[243] to the protection required by the new products and services identification techniques by means of non-traditional marks, even though those non-traditional marks are adapted to distinguish products and services of a user from those of another.

Nonetheless, there is always a balance to maintain between the legitimate protection of goodwill in trade-marks and the hindrances to free competition and, notwithstanding the lack of statutory protection, the recourse in unfair competition and passing-off is still available before our Courts.

---

[239] It is then going to be simply linked to the mark it includes, in conformity with paragraph 15(1) TMA.

[240] *Cie internationale pour l'informatique CII Honeywell Bull v. Herridge, Tolmie* [BULL] (1983), [1983] 2 F.C. 766, 1 C.I.P.R. 231, 77 C.P.R. (2d) 101 (F.C.T.D.); rev. (1985), [1985] 1 F.C. 406, 4 C.I.P.R. 309, 61 N.R. 286, 4 C.P.R. (3d) 523 (F.C.A.), J. Pratte at page 526.

[241] The territorial character of legislations on trade-marks and distinguishing guises must be recalled : Daniel ZENDEL et al., "Companies Using Color, Sound or Scent Marks May be foiled Overseas" (19960212), The National Law Journal C-25 and URL http://test01.ljextra.com/na.archive.html/96/02/131996_0205_7.html; also published under the title "Making Sense of Trademarks" (août 1996), *Trademark World* 21 and URL http://www.ladas.com/GUIDES/TRADEMARKS/MakingSenseTM.html (site consulted on 19990401).

[242] For instance : electronic commerce, cyberspace, cathodic mode or, more simply, new techniques of marketing.

[243] As interpreted by the tribunals and applied by the Trade-marks Office, we must specify.

ANNEXE A

SECTION 28 OF THE *TRADE-MARKS REGULATIONS (1998)*

ANNEXE B

ILLUSTRATIONS OF A FEW REGISTRATIONS

«ARCHITECTURAL» TRADE-MARKS

Registration TMA 197852 on 1974-03-01 of American Dairy Queen Corporation
Registration TMA 280719 on 1983-06-23 of McDonald's Corporation
Registration TMA 400998 on 1992-08-07 of Pepsi-Cola Canada Ltd. (KFC)

«KINETIC» TRADE-MARKS

American registration 1339596 on 1985-06-04 of Hanna-Barbera Productions, Inc.
American registration 1928424 on 1995-10-17 of Twentieth Century Fox Film Corporation
American registration 2077148 on 1997-07-08 of Netscape Communications Corporation
American registration 2106424 on 1997-10-21 of Garmin Corporation

MARKS AND COLOURS

Registration TMDA 48989 on 1930-03-24 of Amsted Industries Incorporated
Registration UCA 50742 on 1953-08-11 of Union Tools, Inc.
Registration TMA 245066 on 1981-02-06 of Goodall Rubber Company
Registration TMA 246861 on 1980-06-20 of Duracell International Inc.
Registration TMA 346453 on 1988-10-14 of Hoffmann-La Roche Limited
Registration TMA 359172 on 1989-08-04 of DNA, Incorporated
Registration TMA 433100 on 1994-09-09 of Owens-Corning Canada Inc.a
Registration TMA 477683 on 1997-06-12 of Minnesota Mining and Manufacturing Co.
Application TMO 722545 on 1993-02-11 of Monsanto Canada Inc.

«HOLOGRAM» TRADE-MARKS

Application TMO 835927 on 1997-02-10 of Smithkline Beecham Inc.
Application TMO 10002075 on 1999-01-14 of Jeanne Lottie's Fashion Incorporated

TRADE-MARKS « BY POSITIONING »

Registration TMA 194715 on 1973-10-12 of Levi Strauss & Co.
Registration TMA 264673 on 1981-12-10 of Puma-Sportschuhfabriken Rudolf Dassler KG
Registration TMA 315448 on 1986-06-20 of The Parker Pen Company
Registration TMA 319504 on 1986-10-10 of James L. Thorneburg
Registration TMA 353328 on 1989-03-17 of Estwing Manufacturing Company, Inc.
Registration TMA 399889 on 1992-07-23 of Champagne Moët et Chandon
Registration TMA 449353 on 1995-10-27 of Hurteau & associés inc.

Registration TMA 460749 on 1996-08-02 of Newell Operating Company
Registration TMA 473317 on 1997-03-21 of The Mead Corporation
Registration TMA 481586 on 1997-08-26 of Smithkline Beecham Inc.
Registration TMA 495414 on 1998-05-28 of Canderm Pharma Inc.

DISTINGUISHING GUISES
Registration TMDA 46595 on 1953-04-23 of The Procter & Gamble Company
Registration TMA 164635 on 1969-08-15 of Kraft Jacobs Suchard (Suisse)
Registration TMA 337783 on 1988-03-04 of Kwik Lok Ltd.
Registration TMA 362414 on 1989-11-03 of Bic. Inc.
Registration TMA 409284 on 1993-03-12 of Gerber Products Company
Registration TMA 488662 on 1998-01-29 of Perrier Vittel
Registration TMA 497479 on 1998-07-21 of General Mills, Inc.

«SOUND» TRADE-MARKS
Registration TMA 359318 on 1989-08-11 of Capital Records, Inc.
Application TMO 714314 on 1992-10-06 of Metro-Goldwyn Mayer Lion Corp.
Application TMO 824753 on 1996-10-01 of Queisser Pharma GmBH
Application TMO 858570 on 1997-10-14 of Intel Corporation

Registration TMA 197852 on 1974-03-01 of American Dairy Queen Corporation

Registration TMA 280719 on 1983-06-23 of McDonald’s Corporation

Registration TMA 400998 on 1992-08-07 of Pepsi-Cola Canada Ltd. (KFC)

American registration 1339596 on 1985-06-04 of Hanna-Barbera Proonctions, Inc.

American registration 1928424 on 1995-10-17 of Twentieth Century Fox Film Corporation

American registration 2077148 on 1997-07-08 of Netscape Communications Corporation

American registration 2106424 on 1997-10-21 of Garmin Corporation

Registration TMDA 48989 on 1930-03-24 of Amsted Industries Incorporated
.

Registration UCA 50742 on 1953-08-11 of Union Tools, Inc.

Registration TMA 245066 on 1981-02-06 of Goodall Rubber Company
.

Registration TMA 246861 on 1980-06-20 of Duracell International Inc.

Registration TMA 346453 on 1988-10-14 of Hoffmann-La Roche Limited

Registration TMA 359172 on 1989-08-04 of DNA, Incorporated

Registration TMA 433100 on 1994-09-09 of Owens-Corning Canada Inc.a

Registration TMA 477683 on 1997-06-12 of Minnesota Mining and Manufacturing Co.

Application TMO 722545 on 1993-02-11 of Monsanto Canada Inc.

Application TMO 835927 on 1997-02-10 of Smithkline Beecham Inc.

Application TMO 10002075 on 1999-01-14 of Jeanne Lottie's Fashion Incorporated

Registration TMA 194715 on 1973-10-12 of Levi Strauss & Co.

Registration TMA 264673 on 1981-12-10 of Puma-Sportschuhfabriken Rudolf Dassler KG

Registration TMA 315448 on 1986-06-20 of The Parker Pen Company

Registration TMA 319504 on 1986-10-10 of James L. Thorneburg

Registration TMA 353328 on 1989-03-17 of Estwing Manufacturing Company, Inc.

Registration TMA 399889 on 1992-07-23 of Champagne Moët et Chandon

Registration TMA 449353 on 1995-10-27 of Hurteau & associés inc.

Registration TMA 460749 on 1996-08-02 of Newell Operating Company

Registration TMA 473317 on 1997-03-21 of The Mead Corporation

Registration TMA 481586 on 1997-08-26 of Smithkline Beecham Inc.

Registration TMA 495414 on 1998-05-28 of Canderm Pharma Inc.

Registration TMDA 46595 on 1953-04-23 of The Procter & Gamble Company

Registration TMA 164635 on 1969-08-15 of Kraft Jacobs Suchard (Suisse)

Registration TMA 337783 on 1988-03-04 of Kwik Lok Ltd.

Registration TMA 362414 on 1989-11-03 of Bic Inc.

Registration TMA 409284 on 1993-03-12 of Gerber Products Company

Registration TMA 488662 on 1998-01-29 of Perrier Vittel

Registration TMA 497479 on 1998-07-21 of General Mills, Inc.

Registration TMA 359318 on 1989-08-11 of Capital Records, Inc.

Application TMO 714314 on 1992-10-06 of Metro-Goldwyn Mayer Lion Corp.

Application TMO 824753 on 1996-10-01 of Queisser Pharma GmBH

Application TMO 858570 on 1997-10-14 of Intel Corporation

THE STATUTORY PROTECTION OF NON-TRADITIONAL TRADEMARKS IN CANADA A FEW REFLECTIONS ON THEIR REGISTRABILITY AND DISTINCTIVENESS

International Bar Association 2000
Amsterdam

Bob H. Sotiriadis and Laurent Carrière
LEGER ROBIC RICHARD, Lawyers
ROBIC, Patent and Trademark Agents
55 St Jacques
Montreal (Quebec)
Canada H2Y 3X2

Tel. (514) 987-6242
Fax (514) 845-7874
E-mail: marion@robic.com
Website: www.robic.ca

Lawyers and trademark agents, Laurent Carrière and Bob H. Sotiriadis are senior partners in the lawfirm LEGER ROBIC RICHARD, g.p. and in the patent and trademark agency firm ROBIC, g.p..

.