

**AMENDMENT MADE TO THE NAME OF AN APPLICANT CONSIDERED BY THE
TRADE-MARKS OPPOSITION BOARD**

By
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LendingTree, LLC v. The Attorney General of Canada 2006 FC 373 (Federal Court, J. Eleanor R. Dawson)

1. Factual Background

On January 31, 2001, the Respondent Lending Tree Corp. filed an application requesting registration of the trade-mark LENDING TREE. Said trade-mark application was based on an alleged use of the mark by Lending Tree Corp. in Canada on or before January 5, 2001. However, Lending Tree Corp. did not exist as of that day; it was not incorporated until February 2, 2001.

The Applicant LendingTree, LLC filed an opposition against Lending Tree Corp.'s application and alleged, amongst the grounds of opposition, that, contrary to subsection 30(b) of the *Trade-marks Act*, Lending Tree Corp. had not, and could not have, used the trade-mark in association with the services stated in the application as of the alleged date of first use. Lending Tree Corp. subsequently filed a request with the Registrar, supported by an affidavit, that the subject application be amended to correct the identification of applicant by replacing "Lending Tree Corp." with "Alex Haditaghi doing business as Lending Tree Corp."

The Trade-marks Opposition Board ("the Board") issued a notice, on behalf of the Registrar, to Lending Tree Corp. stating that the requested amendment had been accepted and that if the opponent considered that an amendment to the Statement of opposition was required, leave should be requested pursuant to Rule 40 of the *Trade-marks Regulations*. Instead,

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LendingTree, LLC brought before the Federal Court an application for judicial review seeking an order quashing the decision of the Registrar.

2. Decision of the Federal Court

The main issue at the heart of the dispute was whether the Registrar erred by amending the application in a manner that changed the identity of the applicant as prohibited by subsection 31(a) and sections 30, 31 and 32 of the *Trade-marks Regulations*. The application thus turned on whether the issue of the propriety of amendment of the application is a matter that can be raised and considered in the opposition proceedings.

The Court reviewed jurisprudence establishing that the Board has in the course of opposition proceedings considered the propriety of amendments made to the name of an applicant (*Matsushita Electric v. Libra Importing* (1986), 8 C.P.R. (3d) 512; *Beauty Creations Ltd. v. Eugene-Gallia* (1992), 45 C.P.R. (3d) 278; *Mirabel Fisheries Ltd. v. HydroSerre Inc.* (1994), 55 C.P.R. (3d) 567.)

Therefore, the Court concluded as follows (at paragraphs 19 and 20):

My conclusion that the Board may consider the propriety of amendments made to the name of an applicant, and whether such an amendment changed the identity of the applicant, is consistent with the fact that, after the amendment was allowed, LendingTree U.S. was invited to seek leave to amend its statement of opposition. This would appear to contemplate that LendingTree U.S. would have an opportunity at the hearing of the opposition to argue that the decision to allow the amendment should not have been made and should not be permitted. (...) (S)eeing no special circumstance that would justify granting relief on this application, I am satisfied that this application for judicial review should be dismissed.



