



AN OVERLY BROAD DECLARATION OF USE RESULTING FROM AN INNOCENT MISSTATEMENT DOES NOT SUFFICE TO STRIKE OUT A TRADE-MARK REGISTRATION

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Parfums de Coeur, Ltd. v. Asta, 2009 FC 21 (CanLII)

In a judgment rendered on 2009-01-08, the Federal Court of Canada found that it should dismiss an application by Parfums De Coeur, Ltd. (the “Applicant”) to strike out the trade-mark BOD registered by Christopher Asta (the “Respondent”) in association with “Hair care, namely, shampoo, conditioner”. The Court refused to grant the application given that (i) the misstatement which led to an overly broad Declaration of Use was wrong and innocent or negligent, but not fraudulent and (ii) the Respondent amended his registration prior to the beginning of the proceedings.

On 2004-02-12, the Respondent filed a Declaration of Use of several wares pertaining not only to hair care but also skin care, cosmetics and body care for its trade-mark BOD. On the other hand, the Applicant started to sell its products with the BOD MAN trade-mark in Canada around October 2002. After issuance of the Respondent’s registration for the BOD trade-mark, the Applicant notified the Respondent of its intent to seek cancellation of the registration.

On 2006-10-13, the Respondent amended the statement of wares for its trade-mark BOD to reflect the actual use in respect of wares associated therewith. The amended registration was cited by the examiner as an obstacle to the registration of the Applicant’s trade-mark BOD MAN in association with “men’s fragrances, namely, cologne, eau de toilette, aftershave, scented body sprays and personal deodorants.”

In its decision, the court reaffirmed that “date of application” in the provision on which the Respondent relied was referring to the filing date of the application to strike out the trade-mark and not the date of the original application to register the trade-mark.

Relying on the prior decision of the Federal Court of Appeal in *General Motors of Canada v. Decarie Motors Inc.* 2000 CanLII 16083 (F.C.A.), the Court stated that

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only (i) fraudulent, intentional misstatements, and (ii) innocent misstatements without which “barriers to registration would have been insurmountable” can be relied-upon to invalidate a trade-mark registration.

Here, the Court found that that the misstatement in the Declaration of Use pertaining to the original application was not fraudulent. The Respondent’s explanations were that he thought that he was entitled to file a Declaration of Use for all the wares specified in the original registration as long as he was using his trade-mark with at least some of the wares listed in the original application. The Court suggests that the outcome would have been different had the Respondent not used the trade-mark at all at the time of filing its Declaration of Use.

Therefore, the burden of the Respondent was to show that the amended registration had been obtained by material misstatement. Ultimately, according to the Court, the amended registration had not been secured by material misstatement, and the Respondent met the requirements for use of the mark as early as in early 2001 in respect of the wares listed in his amended registration, despite some flaws and deficiencies in the evidence of use.

This judgement confirms that there is no provision in the Canadian *Trade-Marks Act* under which misstatements in an application for registration or extension of wares become grounds for invalidating the registration unless the misstatement had the effect of making the trade-mark not registrable or unless there was a fraudulent misrepresentation.

In doing so, the Court made a clear distinction between the Canadian law and the American law and rejected the application of the U.S. doctrine of fraud, according to which real fraud is not required and mere material misstatement may suffice to hold that the registration as a whole is invalid. The Court felt that it was more appropriate not to adopt a principle that, in its view, has no ground in the current Canadian *Trade-Marks Act* and that the Parliament has so far refused to embrace.

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