



DISPUTE OVER THE RIGHT TO USE A FAMILY'S SURNAME: NOT ALWAYS "LIKE FATHER, LIKE SON"

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In a judgment rendered on April 16, 2010 by the Federal Court of Appeal of Canada in the case of *Miranda Aluminum Inc. v. Miranda Windows & Doors Inc.* 2010 FCA 104 (CanLII), the bench dismissed an appeal brought by Miranda Aluminum Inc. (the "Appellant"), a company that filed an application to expunge two trade-marks (the word mark "Miranda" and a design mark, Miranda surrounded by the outline of a house) that had been registered by Miranda Windows & Doors Inc. (the "Respondent"), a company owned by the son of the Appellant's owner.

The parties were arguing over the right to use the family's surname, Miranda, in connection with the sale and installation of aluminum home renovation products, such as windows, doors, etc. At the trial level, the judge dismissed the expungement application essentially for the following reasons:

1. Even if Miranda is primarily a surname, the Respondent's trade-marks had acquired distinctiveness in connection its wares and services by the time the applications to register them were filed on February 20, 2006;
2. Previous use of the name Miranda by the Appellant that could have constituted a basis for expungement under the Canadian *Trade-marks Act* had not been established;
3. The trade-marks could not be expunged on the basis that the name Miranda may falsely suggest a connection with a living individual (i.e. the Appellant's owner), given that when the Respondent's owner first used the trade-name "Miranda Aluminum and Vinyl Products" with its first company, T.M. Renovations Inc., in 1990, the public would not falsely have connected "Miranda" with the Appellant's owner in association with the supply and installation of aluminum products;
4. There was no material false statement regarding the date of first use in the Respondent's applications to register the trade-marks; and

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5. Registration of the trade-marks could not be invalidated on the ground that they had lost their distinctiveness due to the Appellant's alleged use of the name Miranda as of July 16, 2007, the date when expungement proceedings were commenced.

At the appeal level, the Court had to decide whether or not the trial judge erred in:

1. finding that, when the respondent applied to register the marks on February 20, 2006, it did not misrepresent the date of the first use of the mark of at least as early as August 31, 1991;
2. finding that the name Miranda had acquired distinctiveness by either February 20, 2006, when the Respondent applied to register the marks, or by July 17, 2007, when the Appellant commenced the present proceedings; and
3. failing to hold that the name falsely suggested a connection with a living person, that is, the Appellant's owner.

In respect of the first issue, the Court, after restating that innocent misstatements will only invalidate a trade-mark if they are "material", held that "there would have been no bar to the registration of the marks, if the respondent had stated in its application that their first use was in March 2005" instead of August 31, 1991. Here, the Court qualified the misstatement as a "technical irregularity" resulting from the fact that T.M. Renovations Inc. was dissolved involuntarily in June 2004, without the knowledge of the Respondent's owner, while he continued to operate the business until the respondent was incorporated in March 2005.

In respect of the second issue, the Court considered to be findings of fact reasonably open to the trial judge to rule that:

- (i) the brother of the appellant's owner, John Miranda and the Respondent were not competing with each other given that the former was in the manufacturing and wholesale business, while the latter was in retail sales and installation;
- (ii) the Appellant's owner had twice abandoned the use of the name in connection with a business and that his use of the name between 2000 and 2004 had been calculated to deceive customers; and
- (iii) the "Miranda" surname had acquired distinctiveness in connection with the Respondent's goods and services.

Therefore, the Court refused to conclude that trial judge made a palpable and overriding error on this point.

In respect of the third issue, the Court refused to interfere with the trial judge's finding that "it was unlikely that, in 1990, the public would have falsely connected the name

Miranda with the father in association with the supply and installation of aluminum and vinyl products”. In support of its position, the Court stated that a living individual challenging the validity of a trade-mark on the basis that the public will falsely associate the mark with him would have to establish the existence of a “significant public reputation”, for which there was no evidence in this case.

In light of the above reasons, the Court dismissed the appeal.

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