

YOU BE THE JUDGE: CANADIAN TRADE-MARK BATTLES



LISA STATT-FOY

One of the most important steps in the trade-mark registration process is “Opposition”. Anyone who opposes registration of a trade-mark may file a Statement of Opposition based on one of the following grounds:

1. the application does not conform to the requirements of the *Trade-marks Act*
2. the trade-mark is not registrable;
3. the applicant is not the person entitled to registration of the trade-mark; or
4. the trade-mark is not distinctive.

If a trade-mark is opposed, the Trade-mark Opposition Board (TMOB) will either allow the trade-mark to be registered, or refuse registration, based upon submissions and evidence from both the applicant and the opponent. A simple task? You be the judge.

MIND TO MUSCLE VS. MIND TO MUSCLE Trainer’s Choice Inc. v. Vision Tek Inc.

Vision Tek Inc. applied to register the mark MIND TO MUSCLE based on its use since June 1, 1999, in association with athletic clothing and exercise equipment as well as services such as sports injury assessment, massage, acupuncture and fitness instruction. Trainer’s Choice Inc. filed an opposition on the grounds that Vision Tek knew it was not entitled to use the mark, since Trainer’s Choice had offered identical wares and services in association with the mark MIND TO MUSCLE since 2001. Identical mark, identical products, with two different owners.

Years before Vision Tek filed the application for registration, the owners of the competing companies were friends and jointly operated a business using the mark MIND TO MUSCLE. There was no formal agreement as to which party owned the trade-mark, and both had subsequently used the trade-mark in association with separate, competing entities. When Trainer’s Choice saw that Vision Tek had applied for the mark, Trainer’s Choice opposed registration of the mark. The TMOB decided that the interests of Trainer’s Choice prevailed, as the trade-mark was not distinctive of Vision Tek’s products as it had become known for the products of Trainer’s Choice. The

opposition was successful and the application for registration in the name of Vision Tek was refused.

CENTRAL CITY U-LOCK VS. U LOCK JCM Professional Mini-Storage Management Ltd. v. Central City U-Lock Ltd.

This dispute pits two competing self-storage companies against each other. Both marks featured the term U-LOCK, but with different designs, and both companies opposed the application of the other. The TMOB decided that the term U-LOCK (the phonetic equivalent of “you lock”) is simply not a trade-mark that can be given a broad scope of protection given its ordinary meaning in association with self-storage facilities. In this case, the CENTRAL CITY U-LOCK design was permitted, since it contained other distinctive design elements, particularly the dominant positioning of the words CENTRAL CITY. JCM’s U-LOCK design mark was refused, as it was found to be clearly descriptive of self-storage services.

ESURANCE VS. ESURANCE Lofaro v. Esurance Inc.

A well-established U.S. online insurance company (Esurance Inc.) applied to register its U.S. trade-mark ESURANCE in Canada. A Canadian insurance consultant (Ms. Lofaro) opposed the application based on her own use of the mark ESURANCE for similar services, and her ownership of the domain name ESURANCE.CA. Identical mark, similar services, and a well-funded U.S. company against a lone Canadian insurance professional.

Despite Ms. Lofaro’s best attempts to persuade the TMOB that her use of the mark should prevent the U.S. competitor from registering its mark in Canada, the TMOB remained unconvinced that Ms. Lofaro had used the mark ESURANCE as a trade-mark such that it was distinctive of her services. The opposition failed and the application for registration in the name of Esurance Inc. was allowed. ▲

EDMONTON
2000, 10235 - 101 STREET
EDMONTON AB T5J 3G1
PH 780 423 3003
FX 780 428 9329

CALGARY
400, 604 - 1 STREET
CALGARY AB T2P 1M7
PH 403 260 8500
FX 403 264 7084

YELLOWKNIFE
201, 5120 - 49 STREET
YELLOWKNIFE NT X1A 1P8
PH 867 920 4542
FX 867 873 4790

WWW.FIELDLAW.COM

DISCLAIMER

The Medium is a commentary on current legal issues in the intellectual property and technology area and should not be interpreted as providing legal advice. Consult your legal advisor before acting on any of the information contained in it. Questions, comments, suggestions and address updates are most appreciated and should be directed to:
Neil Kathol in Calgary 403-260-8564

REPRINTS:Our policy is that readers may reprint an article or articles on the condition that credit is given to the author and the firm. Please advise us, by telephone or e-mail, of your intention to do so.