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Attention: Steven H. Leach

RE: Trademark: CANADIAN SAFE BOATING
COUNCIL
Applicant: Canadian Safe Boating Council

This examiner's report concerns the above identified application. To avoid abandonment proceedings, a proper response must be received by this office by February 10, 2024. All correspondence respecting this application must indicate the file number.

Thank you for your correspondence of January 4, 2021 and March 3, 2023. The objection raised pursuant to paragraph 12(1)(b) of the *Trademarks Act* is hereby withdrawn. The revised services are considered to be in compliance with paragraph 30(2)(a) of the *Trademarks Act* and are classified correctly according to the Nice classification system.

The applicant's comments have been carefully considered however, the Examiner maintains that pursuant to paragraphs 32(1)(b) and 37(1)(d) of the *Trademarks Act*, the trademark is considered to be not inherently distinctive for the services as applied.

The term "distinctive" is defined in section 2 as:

in relation to a trademark, describes a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or that is adapted so to distinguish them.

As stated in H.G. Fox, *Canadian Law of Trade Mark*, 3rd ed. (Toronto: Carswell, 1972), at 25:

the essence of a protectable trade mark and the foundation of trade mark law...is and always has been distinctiveness. 'Distinctiveness means some quality in the trade mark which earmarks the goods so marked as distinct from those of other producers of such goods'.

The *Trademark Act* provides for two different situations in which a trademark can be said to possess distinctiveness, the first being a trademark that "actually distinguishes" and the second being a trademark "adapted so to distinguish," the goods or services of the trademark owner from the goods or services of others.

On the one hand, a trademark "actually distinguishes" by acquiring distinctiveness through use, resulting in distinctiveness in fact. On the other hand, a trademark that is "adapted so to distinguish" is one that does not depend upon use for its distinctiveness because it is inherently distinctive [see *Astrazeneca AB v. Novopharm Ltd.*, 2003 FCA 57 (CanLII) at para 16].

In the present case, the examiner respectfully submits that the subject mark is not adapted to distinguish the applicant's services from the services of others. The CANADIAN SAFE BOATING COUNCIL as a whole is considered to be not inherently distinctive since it indicates to the consumer that the applicant is operating a council that provides information through seminars, training videos and lobbies government

on safe boating practices in Canada. In this regard the applicant's attention is directed the following definition as found in the Merriam-Webster Dictionary. The word "COUNCIL" refers to "an assembly or meeting for consultation, advice, or discussion; a group elected or appointed as an advisory or legislative body." As a result, consumers will not perceive this wording as applied to applicant's services as a source indicator pointing uniquely to applicant. As such, as a whole, the trademark appears to be not inherently distinctive of all the applicant's services, since other traders should be able, in the ordinary course of their business, to use the same trademark in association with the same services.

The examiner respectfully submits that the fact that other traders are not currently using a trademark in association with their goods and/or services is not determinative when considering if a mark is not inherently distinctive. The ultimate question is whether other traders should be free to use that trademark in association with their goods and services. Please note that trademarks that serve only to provide general information about or on any services are not considered inherently distinctive. It is further submitted that the subject trademark has the potential to limit trade since all traders in the field should be able to use this phrase to describe a feature of their services.

With respect to the state of the register evidence provided by the applicant, the examiner respectfully submits that all of the examples provided were approved for registration prior to the amended *Trademarks Act* coming into force on June 17, 2019. It is respectfully submitted that prior to this date, the examination department did not examine to determine if pending marks were inherently distinctive. This may explain the different approach being taken on the subject application.

To be distinctive, the trademark must have come to mean to purchasers that the goods or services sold in association with the trademark come from one source, i.e., the trademark must function in the marketplace to distinguish the goods or services of one person from those of others. To satisfy the test of distinctiveness it is not sufficient that a trademark be merely distinctive in channels of trade as, for example, to the manufacturer or wholesaler, but it must be distinctive to all who are probable purchasers including the ultimate consumer (see *Parke Davis v. Empire Laboratories* (1963), 41 C.P.R. 121 at 145. (Aff'd. 43 C.P.R. 1)).

Having regard to the foregoing, it is respectfully submitted that consumers will not perceive the subject mark as applied to the applicant's services as a source indicator pointing uniquely to the applicant.

The objection raised pursuant to paragraph 32(1)(b) of the *Trademarks Act* is hereby maintained. You are further advised that this application may be refused under subsection 37(1)(d) of the *Trademarks Act*, if your next response does not overcome the aforesaid objection.

If the applicant has any specific questions in respect of this Office action, please contact the assigned examiner. Please note that for general inquiries, including assistance with filing of the revised application, queries about the status of an application or receipt of correspondence, you may contact our Client Service Centre toll free at 1-866-997-1936.

Yours truly,



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