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| RIDOUT & MAYBEE LLP  5500 North Service Road  Suite 101  Burlington  ONTARIO L7L 6W6 | | |
| Attention: Steven H. Leach | | |
| RE: | Trade-mark: | 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 April 11, 2019. All correspondence respecting this application must indicate the file number.

Your correspondence of December 20, 2017 is acknowledged and your comments have been noted.

To summarize the requirements of subsection 12(2) of the *Trade-marks Act*, a trade-mark becomes distinctive throughout Canada when it has come to be recognized by the Canadian public as a mark which serves to distinguish the goods of the applicant from those of others. If a trade-mark is considered to offend paragraphs 12(1)(a) or (b) of the *Act*, it may be registrable if it has acquired a secondary meaning in the minds of the consumer. A trade-mark is said to have acquired a secondary meaning in that when the mark is presented to the public, whatever primary meaning it may have is submerged and the trade-mark significance takes precedence.

The evidence provided by an applicant proving that its mark has acquired a secondary meaning must be strong and convincing. As Fox stated in *Canadian Law of Trade Marks and Unfair Competition*, 3rd edition at p. 131:

There will, of course, always be considerable difficulty in convincing the Registrar, or the court, that a *prima facie* unregistrable word has acquired a secondary meaning sufficient to permit its registration, for the legislature and the courts have always shown a natural disinclination to allow any person to obtain by registration a monopoly in what others may legitimately desire to use.

In *Philip Morris Incorporated v. Imperial Tobacco Ltd. et al.*, (1985) 7 C.P.R. (3d) 254, Rouleau J. outlines the three-part test for determining distinctiveness:

One can also see that distinctiveness requires that three conditions be met: (1) that a mark and a product be associated; (2) that the "owner" uses this association between the mark and his product and is manufacturing and selling his [good]; and, (3) that this association enables the owner of the mark to distinguish his product from that of others.

Whether a trade-mark satisfies these requirements is a question of fact and depends on all of the circumstances of a particular case, the most critical factor being the message that the trade-mark actually conveys to the public. As stated by Strayer J. in *Royal Doulton Tablegood Ltd. v. Cassidy’s Ltd.*, (1986) 1 C.P.R. (3d) 214, the message which a distinctive trade-mark sends to the purchaser is one that assures him that the goods have come from one particular source in which he has confidence.

When submitting an application based on a subsection 12(2) claim of distinctiveness, the applicant must file a master affidavit. The Examiner notes that the applicant makes reference to a master affidavit submitted on a previous file; however, as every application is evaluated on it’s own merit, a new master affidavit is required for every application. The affidavit should be accompanied by specimens of the mark as used in relation to the goods or services and the following information supplied:

1. A statement of the nature of use of the mark in association with the goods or services.
2. An explanation concerning the manner of association of the mark at the time of any transfer of property or transfer in the possession of goods.
3. A statement on the manner of use of the mark in the advertisement of goods or services pursuant to sections 4 and 5 of the *Trade-marks Act*, accompanied by specimens of advertising material.
4. Statements which clearly indicate the extent of use of the mark for each territory (province) in which the mark is stated to have become distinctive. For example, in claiming that the mark has achieved distinctiveness in Canada at the date of filing, the applicant must show that the mark has achieved secondary meaning in each of the provinces.
5. Statements which attest to the length of time of use of the mark in association with the goods or services.

With regards to the Supplementary Evidence filed, none of the evidence appears to be used in connection with the actual services listed. In order to use this evidence, a clear connection must be made to the applicant’s services.

With regards to Exhibit A, it is unclear what is being tabulated in some of the headings, specifically, CLIPPING – COMMUNITY PAPERS and ONLINE & MISC. For example, under the heading CLIPPINGS – COMMUNITY PAPERS it lists the number 45,819 beside the Burlington Post. Does this mean that in the time period specified, there were 45,819 separate adds run in the newspaper, or was there one add run and the newspaper circulation is about 45,000? Obviously, the first would be much more significant than the second.

In addition, there appears to be only website printouts submitted supporting the applicant’s claim. Specifically, there does not appear to be any clippings from newspapers, or examples of the radio advertising. It is required that actual evidence is submitted that supports the applicant’s claims.

Lastly, a substantial portion of the website printouts don’t seem to have the mark even in them and the remainder that do don’t seem to make any real connection with the services being applied for.

The undersigned has reviewed the evidence filed in support of applicant’s claim to the benefit of subsection 12(2) of the *Act* and is of the opinion that the evidence is insufficient to show that the subject mark had become distinctive across Canada at the time of filing.

In order to support the applicant’s claim that the subject mark has become distinctive across Canada, the applicant may wish to supply the following information:

* the applicant’s market share in Canada and for each territorial area (i.e. province) for the applied for services; and
* survey evidence and/or secondary affidavits from both distributors and end consumers attesting to the fact that they are familiar with and can readily and easily recognize the mark, as being that of the applicant. Alternatively, the applicant may wish to adduce survey evidence.  Note, if a market survey is to be used as evidence, and in order to be worthwhile, it must be carried out by a person who can file an affidavit which attests to the fact that this person is an expert in designing, organizing, implementing and interpreting survey results. A qualified surveyor will set out the strategy and statistical basis of the survey and will explain the form of the questions asked and the manner in which the survey is conducted. All the results of the survey must be reported — both negative and positive — and the interpretation of the results fully explained.

Moreover, it is respectfully submitted that one of the most important purposes of paragraph 12(1)(b) of the *Trade-marks Act* is to protect the right of all traders to use apt descriptive language. The Courts have recognized and held that descriptive words are the property of all and cannot be appropriated by one person for their exclusive use.

The applicant is required to file a supplemental affidavit which responds to the above-mentioned deficiencies in the evidence filed in support of its claim to subsection 12(2) of the *Act.*

Any comments you may wish to submit will receive consideration.

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,



Christopher Lewis

Examination Section

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