

Danjaq, LLC



REQUERANT - APPLICANT
MARQUE DE COMMERCE - TRADE-MARK

Sound mark

06717779CA
GOWLING LAFLEUR HENDERSON LLP
SUITE 2600, 160 ELGIN STREET
OTTAWA
ONTARIO K1P 1C3



DATE DE PRODUCTION - FILING DATE 15 juin/Jun 2015	No DOSSIER - FILE NO. 1733564
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RUBRIQUES DE L'INDEX - INDEX HEADINGS

USAGER INSCRIT - REGISTERED USER			DATE DE L'ANNONCE - ADVERTISEMENT DATE		DATE DE L'ADMISSION - ALLOWANCE DATE	
REMIS A REFERRED TO	REMARQUES REMARKS	INITIALES INITIALS	DATE	CLASSER P.A. DATE	INITIALES INITIALS	REPORTER B.F. DATE

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CANADIAN INTELLECTUAL
PROPERTY OFFICE



April 29, 2016



Robert A. MacDonald
Direct Dial (613) 786-0150
Robert.MacDonald@gowlingwlg.com

The Registrar of Trademarks
Place du Portage I
50 Victoria Street, Room C-114
Gatineau, Quebec K1A 0C9

Attention: Examination Section

Industry Canada Industrie Canada A/M/J Y/M/D
2016/04/29
123- 16
E002287893
CIPO OPIC

Dear Sirs:

Re: Canadian Trade-mark Application
Trade-mark : **JAMES BOND THEME SONG - Sound**
Applicant : Danjaq, LLC
Application No. : 1,733,564
Our Reference : 06717779CA

We take this opportunity to respond to the Examiner's Report of March 3, 2016.

First of all, we enclose herewith an amended application in which the following changes have been made:

1. "Downloadable mobile telephone ringtones" has been deleted;
2. "Magnetically encoded computer and video programs" has been changed to "computer video games";
3. "Downloadable computer video game software" has been changed to "downloadable video games"; and
4. "Providing information via an electronic global computer network in the field of entertainment relating to motion pictures" has been changed to "providing information via an electronic global computer network in the field of motion pictures".

We trust that these amendments satisfy the Examiner's concerns and look forward to receiving confirmation that the statement of goods and services is now acceptable.

The Examiner has raised an objection to the registrability of the trade-mark under Section 12(1)(b) of the *Trade-marks Act* (i.e. that the mark is clearly descriptive) with respect to following goods:

1. Pre-recorded audio; and

2. Musical sound recordings contained on compact discs and digital music (downloadable) provided from websites or from any other communication network including wireless and cable. We take this opportunity to request that the objection be reconsidered and withdrawn.

While we are on new ground when it comes to soundmarks in Canada, the principles that underline Section 12(1)(b) of the Act are well established. The Federal Court of Appeal recently noted in *MC Imports Inc. v. Afod Ltd.* (2016 F.C.A. 60) the purpose of the rule against registering clearly descriptive trade-marks:

If, then, the use of every word in the language was to be permitted as a trade-mark, it was surely essential to prevent its use as a trade-mark where such use would deprive the rest of the community of the right which they possess to employ that word for the purpose of describing the character of quality of goods. (*Eastman Photographic Materials Co. Ltd v. Comptroller-General of Patents, Designs and Trade-marks*, [1898] A.C. 571 at 180).

Similarly, the Examination Manual notes at section IV.6.1, that the purpose of Section 12(1)(b) is that no one person should be able to appropriate a word and place legitimate competition at an undue disadvantage in relation to language that is common to all and cites *General Motors Corp. v. Bellows* (1949), 10 C.P.R. 101 at 112-113.

When one keeps the purpose of Section 12(1)(b) in mind, it is apparent that the subject trade-mark is not clearly descriptive. It is not depriving "the rest of the community of the right of which they possessed to employ that word (or sound) for the purpose of describing the character or quality of their goods. Similarly, it does not place "legitimate competition at an undue disadvantage in relation to language (or sound) that is common to all.

Further, the Examiner refers to the Practice Notice of March 28, 2012 and says that "where a soundmark is considered to be functional" an objection will be raised pursuant to provision of Section 12(1)(b). However, the objection must still be founded in the purpose and intent of Section 12(1)(b) as defined by the Courts.

The Act does not address the issue of "functionality". Nor does it specifically raise functionality as a ground upon which an application can be refused under Section 37 of the Act. That said, there is some case law which recognizes that a trade-mark registration which is primarily functional is invalid. The purpose behind denying registration to something that is primarily functional was addressed by the Supreme Court of Canada in *Kirkbi AG v. Ritvik Holdings Inc.*, 2005 S.C.C. 65 at paras 42 and 43:

The doctrine of functionality appears to be a logical principle of trade-marks law. It reflects the purpose of the trade-mark which is the protection of the distinctiveness of the product, not of a monopoly on the product.... The Act clearly recognizes that it does not protect the utilitarian features of distinguishing guise. In this manner, it acknowledges the existence and relevance of the doctrine of longstanding in the law of trade-marks. This doctrine recognizes that trade-marks law is not intended to prevent the competitive use of utilitarian features of products, but that it fulfills a source-distinguishing function. This doctrine of functionality goes to the essence of what is a trade-mark.

In Fox on Trade-marks and Unfair Competition (4th Edition), the author states:

Any combinations of elements that are primarily designed to perform a function, or have a functional use or characteristic, are not fit subject-matter for a trade-mark. If functionality goes either to the trade-mark itself or to the wares, then it is essentially or primarily inconsistent with registration. However, if it is merely secondary or peripheral with no essential connection to the wares, then functionality does not act as a bar to registration... it has been noted in the case law that allowing a trade-mark, which is primarily functional or ornamental, to be registered or to remain on the Registry would be in effect, to grant a monopoly by granting a patent or an industrial design under the guise of a trade-mark amounting to restraint of trade.

Obviously, the purpose behind denying registration to a functional mark is much the same as the purpose of denying registration to clearly descriptive mark. In both cases, the intent is to prevent a restraint of trade and to ensure that legitimate competition is not put at undue disadvantage.

When one keeps in mind the purpose and intent of these restrictions, it is apparent that the soundmark in question does not offend the provisions of the Act. Registration of the soundmark in question will not in any way place a restraint on trade or unduly disadvantage legitimate competition.

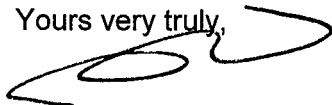
Further, we are unsure how the Examiner has come to determine of functionality in any event.

With respect to the first objection ("pre-recorded audio"), the Examiner must look at the entire phrasing of the goods which is: "pre-recorded audio and video compact discs, DVD's, and motion picture films featuring entertainment, namely, action adventure, drama, comedy, and romance". When the entirety of the statement is read, as it must be, we fail to see how functionality could be an issue. Accordingly, the objection must be withdrawn.

With respect to the second set of goods namely "musical sound recordings contained on compact discs and digital music (downloadable) provided from websites or from any other communication networks including wireless and cable", we again fail to see how functionality has been determined. Just as a word or a phrase can serve as a mark for printed material, a sound can service a mark for a musical sound recording. In any event, the question the Examiner must ask is whether or not the registration of this soundmark would place a restraint on trade or put legitimate competition at an undue disadvantage and the answer is clearly that it does not.

In the circumstances, we submit that the application should be approved for advertisement in association with the amended goods and services.

Yours very truly,



Robert A. MacDonald

RAM:jdm

Encl.

OTT_LAW\ 6269092\1

To: The Registrar of Trade-marks
Ottawa-Gatineau, Canada

1. The undersigned hereby applies for the registration, in accordance with the provisions of the Trade-marks Act, of the sound trade-mark identified below.

2. The sound trade-mark has been used in Canada by the applicant in association with all the specific wares listed hereafter, and the applicant requests registration in respect of such wares. The sound trade-mark has been so used in Canada in association with the general class of wares comprising the following specific wares:

Pre-recorded audio and video compact discs, DVDS, and motion picture films featuring entertainment, namely, action adventure, drama, comedy, and romance; musical sound recordings, contained on compact discs and digital music (downloadable) provided from web sites or from any other communications network including wireless and cable; Computer video games; video and computer game compact discs adapted for use with television receivers; Downloadable video games supplied on-line from databases or provided through a global computer network or from any other communications network including wireless and cable; images and animations via the internet and wireless devices; downloadable videos and films featuring entertainment, namely, action adventure, drama, comedy, and romance via a wireless network for use with mobile devices; downloadable mobile telephone games and graphics via a global computer network and wireless devices

since at least as early as 2002.

3. The sound trade-mark has been used in Canada by the applicant in association with all the specific services listed hereafter, and the applicant requests registration in respect of such services. The sound trade-mark has been so used in Canada in association with the general class of services comprising the following specific services:

Entertainment services, namely, production and distribution of motion pictures

since at least as early as 1962.

internet services, namely, providing information via an electronic global computer

network in the field of motion pictures, and providing electronic games, not downloadable, via the internet

since at least as early as 2002.

4. The mark is a sound recording consisting of an instrumental musical theme played mainly by brass instruments and string instruments consisting of the following:

INTRO: Brass F5-C#5-G4-E4 chord eighth note; E5-C#5-G4-E4 chord eighth note; eighth rest; bass B2 held over a quarter note; brass F5-C#5-G4-E4 chord eighth note; E5-C#5-G4-E4 chord eighth note; eighth rest; bass B2 held over a quarter note; brass F5-C#5-G4-E4 chord sixteenth note; E5-C#5-G4-E4 chord eighth note; F5-C#5-G4-E4 chord sixteenth note; F5-C#5-G4-E4 chord eighth note; F5-C#5-G4-E4 chord eighth note. Bass then plays a sequence of B2 half note, C3 half note, C#3 half note, C3 half note, B2 half note, C3 half note, C#3 half note, C3 half note, while simultaneously a bass E2 note is played at the second and fourth beat of every measure (this sequence continuously repeats under the following melody.)

MELODY: E4 eighth note; F#4 sixteenth note; F#4 sixteenth note; F#4 eighth note; F#4 eighth note held over an eighth note; E4 eighth note; E4 eighth note; E4 eighth note; E4 eighth note; G4 sixteenth note; G4 sixteenth note; G4 eighth note; G4 eighth note held over an eighth note; F#4 eighth note; F#4 eighth note; F#4 eighth note; E4 eighth note; F#4 sixteenth note; F#4 sixteenth note; F#4 eighth note; F#4 eighth note held over an eighth note; E4 eighth note ; E4 eighth note; E4 eighth note; E4 eighth note; G4 sixteenth note; G4 sixteenth note; G4 eighth note; G4 eighth note held over an eighth note; F#4 eighth note; F#4 eighth note; F#4 eighth note; E4 eighth note; F#4 sixteenth note; F#4 sixteenth note; F#4 eighth note; F#4 eighth note held over an eighth note; E4 eighth note ; E4 eighth note; E4 eighth note; E4 eighth note; G4 sixteenth note; G4 sixteenth note; G4 eighth note; G4 eighth note held over an eighth note; F#4 eighth note; F4 eighth note; E4 eighth note; D#5 eighth note; D5 eighth note held over a half note; B4 eighth note; A4 eighth note; B4 whole note.



5. The applicant appoints Gowling Lafleur Henderson LLP whose full post office address in Canada is 160 Elgin Street, Box 466, Station D, Ottawa, Ontario, K1P 1C3, as the firm to whom any notice in respect of the application or registration may be sent, and upon whom service of any proceedings in respect of the application or registration may be given or served with the same effect as if they had been given to or served upon the applicant or registrant.

6. The applicant is satisfied that it is entitled to use the trade-mark in Canada in association with the wares and services described above.

EXECUTED at OTTAWA, ONTARIO, CANADA, this 15th day of June, 2015.

AMENDED at OTTAWA, ONTARIO, CANADA, this 29th day of April, 2016.

Danjaq, LLC

11400 Olympic Blvd.,
Suite 1700, Los Angeles, CA, 90064,
UNITED STATES OF AMERICA

Gowling WLG (Canada) LLP

BY:

Its Trade-mark Agents

Danjaq, LLC

1733564

MARQUE DÉPOSÉE - TRADE-MARK

Sound mark

DATE DE PRODUCTION - FILING DATE

15 juin/Jun 2015

RUBRIQUES DE L'INDEX - INDEX HEADINGS

PRODUITS/SERVICES - GOODS/SERVICES

Pre-recorded audio and video compact discs, DVDS, and motion picture films featuring entertainment, namely, action adventure, drama, comedy, and romance; musical sound *** See file for remainder ***
Entertainment services, namely, production and distribution of motion pictures Internet services, namely, providing information via an electronic global computer network *** See file for remainder ***



EXIGENCES FORMELLES - FORMAL REQUIREMENTS

☒ GOODS/PRODUITS

☒ SERVICES

☒ DISCLAIMER

☐ GC + FEE

☒ OTHER/AUTRE

30 (w)

30 (u)

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OBJECTIONS

☒ 12 (1)(a)

☒ 12 (1)(c)

☐ 12 (1)(b)

(i) of goods, namely the mark is functional, namely the mark
is in essence the goods

☒ 12 (1)(d)

No Confusion

☐ 16

16.1

☒ OTHER

MARQUES ASSOCIEES - ASSOCIATED MARKS

17 Feb 18/18



montréal • ottawa • toronto • hamilton • waterloo region • calgary • vancouver • moscow • london

1733564

June 15, 2015

The Registrar of Trade-marks
Ottawa/Gatineau K1A 0C9

Robert A. MacDonald
Direct 613-786-0150
Direct Fax 613-788-3443
robert.macdonald@gowlings.com

Attention: INDEXING SECTION

Dear Sir:

Re: Application for Sound Trade-mark
Applicant: Danjaq, LLC
Our File: 06717779CA



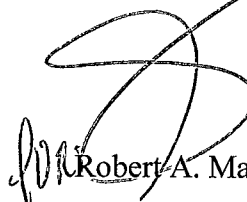
Enclosed is an application for a sound trade-mark.

The application fee of \$300.00 is included in our firm payment of today's date.

Should the fees submitted with this letter be insufficient to cover all of the fees for which payment is explicitly or implicitly requested by this letter, the Office is authorized to charge the amount of the insufficiency to account number 600000107 already on file.

We look forward to receiving the filing receipt in due course.

Yours very truly,


Robert A. MacDonald

RAM/ph

Enc.

OTT_LAW\5344179\1

To: The Registrar of Trade-marks
Ottawa-Gatineau, Canada

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6. The applicant is satisfied that it is entitled to use the trade-mark in Canada in association with the wares and services described above.

EXECUTED at OTTAWA, ONTARIO, CANADA, this 15th day of June, 2015.

Danjaq, LLC

11400 Olympic Blvd.,
Suite 1700, Los Angeles, CA, 90064,
UNITED STATES OF AMERICA

Gowling Lafleur Henderson LLP
BY:

Its Trade-mark Agents

