

TRADEMARKS AND LANGUAGE BARRIERS

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Between 20 and 25 percent of Canada's 33.6 million people are francophone and reside in the province of Quebec. The impact of such a large population of French-Canadians is reflected in certain pieces of legislation that have legal implications for brand owners' global branding and marketing strategies—particularly where harmonisation of marketing and branding initiatives throughout North America is the goal.

While federal legislation such as the Trade-marks Act and the Consumer Packaging and Labelling Act dictate that descriptiveness and confusion, as well as labelling requirements, be assessed through the prism of bilingualism, on a provincial level, the Charter of the French Language also has ramifications of its own when selling products/services in Quebec.

The charter and its regulations prescribe French as the language of commerce and business in Quebec. This includes all inscriptions on products, their containers or packaging, catalogues, etc. Among the exceptions are the inscriptions on a product of a recognised trademark within the meaning of the Trade-marks Act, which may be exclusively in a language other than French, unless a French version has been registered.

Prior to 1993, the exception explicitly referred to 'a registered trademark'. Since then, the courts have interpreted the term 'recognised trademark' to include trademarks used in common law. This is consistent with the Trade-marks Act, which recognises common law rights.

The significance of these provisions is twofold. First, brand owners with both a French and an English version of a registered mark must use either the French version only or both versions, but not the English version only.

Secondly, until recently, the internal guidelines of the Office of the French Language, the organisation that enforces the charter, interpreted recognised trademark to mean registered and unregistered marks. In late 2008, the Office narrowed its internal interpretation of recognised trademark to include registered marks only, although its website (www.oqlf.gouv.qc.ca) still refers to trademarks recognised within the meaning of the Trade-marks Act. This would also include trademarks used in common law.

The Office, in practice, acts primarily on complaints that are filed regarding the alleged improper use of English wording on product packaging, advertising or signage. If a complaint is deemed legitimate, the Office will contact the offender to request rectification of the situation.

The offender may seek to justify its use of English wording, and factors such as the existence of a pending application for an English trademark, while not determinative, could and likely would be taken into account by the Office, even under the revised guidelines. Only a small proportion of

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cases cannot be resolved at this stage, at which point, the Office will decide whether to prosecute the matter in court, where the offender will again have an opportunity to make its case.

Determining unregistered trademark rights is clearly more difficult, and the Office's policy change may reflect its desire to simplify its role in the enforcement process. However, the implication of this policy change for brand owners is not yet clear since the charter, the regulations and the courts' interpretation of a recognised trademark have not changed.

From a practical standpoint, brand owners should realise that registered English trademarks appearing on packaging or advertising in the Province of Quebec (where no French equivalent is registered) are not problematic. Similarly, English trademarks that are pending before the Trademarks Office but are not yet in use in the Province of Quebec are also not problematic, since charter complaints relate to the improper use of English wording only.

The only trademarks that could technically face a charter complaint are unregistered English trademarks used in Quebec. While the existence of a pending trademark application could be of assistance in dealing with a complaint, in all other cases, the Office may force and/or bring court action against a brand owner to stop its use of the English version only.

However, as noted above, the charter, the regulations and the case law used to interpret these (which recognise common law rights) have not changed.

In conclusion, brand owners are encouraged to consider the above-mentioned ramifications early on in the branding process in order to prevent surprises.

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