

## THE TRADE MARK LAW REVISION COMMITTEE\*

By the direction of the Honourable the Secretary of State, a committee has been constituted, which may be referred to as The Trade Mark Law Revision Committee, charged with the duty of examining into proposals for the amendment of the Unfair Competition Act, 1932, and of reporting generally on all matters connected with the law of trade marks.

The Committee will welcome representations from all parties having an interest in the subject. Representations should be submitted in writing and it is requested that, if possible, ten copies of each submission should be forwarded to the Committee. The Committee does not wish to limit the scope of the representations made, which should embrace every matter and point of interest within the scope of the subject, but particular attention is directed to the following list of questions, which is not, however, to be considered as by any means exhaustive.

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(1) Should the "get up" of wares be registrable as a trade mark and, if so, should "get up" extend to a distinctive form of container, *e.g.* Haig's Dimple Whiskey bottle? (See sections 2(c), 2(d))

(2) Should the distinction between a word mark and a design mark be abolished, or should the filing in a proper case of a single application be sufficient to obtain the registration of a mark in each class? In either case, how should the Registrar's powers to refuse an application for registration be defined? (See sections 2(c), 2(d), 26, 27, 30, 31)

(3) Should the right of the owner of a registered trade mark be extended to enable him to prevent its use on wares not similar to those upon which it is registered? (See sections 2(1), 3, 4, 5) If so, should this extended right apply in the case of (a) any trade mark, or (b) only particularly famous marks such as KODAK, ROLLS ROYCE? How should such marks be defined?

(4) Should the definition of a trade mark (section 2(m)) be amended to include service marks, *e.g.* transportation, laundry? If so, what should be the distinction or relation between such a mark and any trade mark originally applied to the serviced wares?

(5) (a) Should the Act be framed to confer the rights to a trade mark on

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\*The Review has been asked to draw this announcement to the attention of the profession and is glad to accede to the request.

- (i) the first to use the mark anywhere, or
- (ii) the first to use the mark or make it known in Canada, irrespective of its reputation abroad,

or to give effect to some other principle, and, if so, what should that principle be? (See sections 3, 4, 10)

(b) What advantages, if any, should registration give beyond the advantage of constituting *prima facie* proof of the owner's rights? (See sections 3, 4, 18)

(6) Should registration of a trade mark be permitted before it has been used anywhere and, if so, subject to what limitations as to the nature of the required subsequent use and the period within which it must be made? (See sections 4 (1-3), 18 (2), 30)

(7) Should section 5 of the Act be amended to confer an exclusive right extending to similar *marks* as well as similar *wares*?

(8) Should section 11 of the Act be made more specific, *e.g.* by dealing expressly with repackaging or the unauthorized substitution of a distributor's for a manufacturer's label? If so, what particular practices should be mentioned?

(9) Should the registered owner of any trade mark be permitted to license the use of his mark

- (a) to anyone, on condition that the licensee is registered as a user?
- (b) only to a parent, subsidiary or otherwise related company, on the same condition or without condition? (See section 12)

(10) Should section 21 be extended to include all cases of honest concurrent user in advance of any registration (*e.g.*, a brickmaker in the Maritime Provinces and another in British Columbia)? (See No. 15 below)

(11) Do sections 26 and 27 require amendment and, if so, on what specific points?

(12) Should section 28 (1) (d) be amended (a) so as to extend to subsidiary registers such as those under Schedule B of the British Act, the United States Act of 1920, or the supplemental register under the United States Lanham Act, and (b) so as to permit registration of marks under it notwithstanding disclaimer in the country of origin?

(13) Should the Registrar be authorized to exercise all or any part of the jurisdiction conferred by section 29 on the court and, if so, subject to what procedural restrictions?

(14) Should the grant of registration to a foreign applicant be conditional on his previously obtaining a registration in his own country? (See section 30)

(15) Should an applicant for registration be allowed to confine his application to a defined territorial area? If so, should a registrant having exclusive rights throughout Canada be entitled to divide these by provinces or otherwise? (See section 35)

(16) Should the allowance of an application for registration be preceded by publication with an opportunity for opposition and, if so, should oppositions be dealt with in the first instance by the Registrar or by the Exchequer Court? (See section 39)

(17) Should a trade mark be assignable apart from the good will of the business in connection with which it is used? (See section 44)

(18) If the answer to the last question is in the negative, what kind of severance of a business (apart from a national territorial severance) should be accepted as sufficient to support an assignment of part of the good will and any trade marks associated with it?

(19) Should the Registrar be given power to amend or cancel the registration of a trade mark which is not in real commercial use in Canada? If so, how should real commercial use be defined and after what period from registration, or from the last proof of such use, should amendment or cancellation be authorized? (See section 49)

(20) Should renewal of a registration be conditional upon the filing of evidence that the mark continues to be in real commercial use? (See section 50)

(21) Should the validity of a trade mark registration be tested as of the date of registration or as of the date of an attack on its validity? (See sections 19, 52)

(22) Should sections 52-54 be amended to alter the character of the procedure laid down?

(23) Should a registration become incontestable after a fixed period of real commercial use (suitably defined) either

- (i) on the ground of descriptiveness or lack of distinctiveness only, or
- (ii) on any ground whatever, and

if a registration is ever to become incontestable, what safeguards should be imposed?

(24) Should registration be permitted for use abroad only of a mark which is not registrable for domestic use, such a provision being designed to overcome rules in other countries corresponding to that referred to above under No. 14?

(25) Should provision be made for registration of and exclusive rights to slogans such as the Packard slogan, "Ask the Man Who Owns One".

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Submissions should be addressed to Harold G. Fox, K.C., Chairman, Trade Mark Law Revision Committee, St. Catharines, Ontario, and should be received by February 1st, 1948. If, for any reason, any person desiring to make representations to the Committee cannot do so within the time limit above mentioned, it will be appreciated if the Committee is advised, by letter, of the approximate date at which such representations will be forwarded.

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#### INTERNATIONAL MONETARY FUND

The purposes of the International Monetary Fund are:

- (i) To promote international monetary cooperation through a permanent institution which provides the machinery for consultation and collaboration on international monetary problems.
- (ii) To facilitate the expansion and balanced growth of international trade, and to contribute thereby to the promotion and maintenance of high levels of employment and real income and to the development of the productive resources of all members as primary objectives of economic policy.
- (iii) To promote exchange stability, to maintain orderly exchange arrangements among members, and to avoid competitive exchange depreciation.
- (iv) To assist in the establishment of a multilateral system of payments in respect of current transactions between members and in the elimination of foreign exchange restrictions which hamper the growth of world trade.
- (v) To give confidence to members by making the Fund's resources available to them under adequate safeguards, thus providing them with opportunity to correct maladjustments in their balance of payments without resorting to measures destructive of national or international prosperity.
- (vi) In accordance with the above, to shorten the duration and lessen the degree of disequilibrium in the international balances of payments of members.

The Fund shall be guided in all its decisions by the purposes set forth in this Article.

(Article I of the Articles of Agreement of the International Monetary Fund)