

World Trademark Review Daily

Court reinforces high standard for rejecting marks based on living individual's reputation
Canada - Smart & Biggar/Fetherstonhaugh

Examination/opposition
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Canada's Trademarks Act prohibits a person from adopting a trademark consisting of, or so nearly resembling as to be likely to be mistaken for, "any matter that may falsely suggest a connection with any living individual". The recent decision of Canada's Federal Court in *Jack Black LLC v The Attorney General of Canada* (2014 FC 664) confirms that the standard to be met in order to sustain an objection on this basis is extremely high, as it must be established that the living individual in question enjoyed a "significant public reputation" across Canada when the trademark was adopted.

In this case, the applicant, *Jack Black LLC*, a US manufacturer of a prestige line of men's personal care and grooming products, had filed an application to register the trademark JACK BLACK. The Canadian Trademarks Office rejected the application on the ground that its adoption was prohibited because the trademark may falsely suggest a connection with the "renowned actor, comedian and musician", Jack Black. Printouts of articles from the Internet constituted the basis for the registrar's decision, and none of the articles related to Canada.

The applicant appealed the registrar's decision to the Federal Court, which noted that the applicant's uncontroverted evidence established that:

1. the trademark was adopted originally without any knowledge of the actor, Jack Black, and its use has never been challenged, in Canada or elsewhere, by the actor or anyone else;
2. the trademark has been registered in many other countries and no issues have ever been raised; and
3. there is not a single instance of the personal care and grooming products bearing the trademark being purchased on the mistaken belief that they would be in any way connected to the actor.

After observing "how thin the information is in this case" in support of the registrar's rejection of the application, the court found that the new evidence would have had a material impact on the registrar's decision in showing even more clearly that the trademark would not falsely suggest a connection with an individual that the Trademarks Office examiner "suspected on the basis of internet printouts".

The court thus substituted its own opinion for that of the registrar, and allowed the appeal, noting that:

"the evidence presented on appeal... would tend to confirm that there is no false suggestion of a connection with a living individual after more than 10 years of use of this trademark in Canada and elsewhere.

The combination of lack of probative evidence of significant public reputation in Canada, to support the registrar's conclusion with respect to the application of Paragraph 9(1)(k) and new evidence, which tends to show that there is no such connection in Canada, carries that the appeal must succeed."

In finding that the registrar's decision to refuse the application was neither correct nor reasonable, the court held that the internet printouts furnished by the registrar fell short of being commensurate with what was available in previous cases, in which even much stronger and more extensive evidence failed to convince the court of a particular living individual having a "significant public reputation". The court therefore ruled that the registrar had failed to establish that the actor, Jack Black, had a public reputation in Canada sufficiently significant to conclude that use of the trademark would suggest a connection with the actor: "it has not been established that there is a Canadian public's awareness of a person named Jack Black, let alone that that awareness reaches a level of significant public reputation."

This decision serves to remind litigants and, in particular, parties opposing trademark applications, that the standard to be met in order to sustain an objection on this basis is extremely high.

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