

IMPACT OF BILL 96 ON PRODUCT TRADEMARKS.

Insights from new regulation, OQLF's guidelines and discussions with the OQLF

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Our speakers



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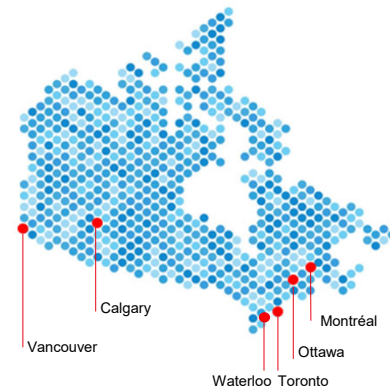
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Who we are

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Canada's **leading IP law firm**
with expertise at the interface of
technology and **business law**

- Expertise in all areas of IP
- 130+ years serving clients
- 180+ lawyers, agents and technical consultants
- 10,000+ patents & trademarks filed annually
- Litigation bench strength and record of success



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Overview

1. Legal Framework
2. General Rules
3. Current Key Exceptions
4. Case Studies
5. Complaint & Investigation process
6. Q&A

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1. Legal Framework

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The French Charter: What it is

- Statute adopted by the government of Québec in 1977 to protect the French language in all spheres of public life



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Territorial application



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Our focus

- Inscriptions on products (their packaging/container/label) and accompanying documentation



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2. General Rules

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General rule: Product markings and accompanying documentation

Must be in FRENCH



Other languages may be used

- **No greater prominence**
- **Available on terms as favourable**

Accompanying documentation

- Certificates of warranty / authenticity
- User manuals
- Brochures / promotional materials
- Registration cards
- Discount coupons

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3. Current Key Exceptions

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May be in another language than French



Inscriptions that are
engraved/inlaid/embossed in the
product itself

Provided

- Do not concern safety
- Product from outside Québec

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May be in another language than French



Name (appellation) of origin, exotic products or foreign specialties

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May be in another language than French

Software

- For which no French version exists



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May be in another language than French

International certification marks

- pursuant to international usage exception



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May be in another language than French

A “Recognized TM”

- **provided** that no French version of the TM has been registered in Canada



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A recognized TM: What it is

Registered TM

- CIPO has issued a certificate of registration for the TM

Benefits

- Matter is generally resolved before the OQLF

Common law TM

- TM used, promoted and advertised in Canada to the point where it has acquired some level of recognition in the market

Burdensome

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“Recognized trademark” exception

Currently

- Registered or common law
- No French version “has been registered”

As of June 1, 2025

- No French version “appears in the Register”
- **Generic term/description** in a recognized trademark must be translated to French and appear on the product or on a medium permanently attached to the product while respecting the “equal prominence” and “as favorable terms” requirements

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Clarification of the terms “Generic” and “Descriptive”

- a description refers to one or more words describing the characteristics of a product, **excluding** the **name of the enterprise** and the **name of the product as sold**
- a generic term refers to one or more words describing the nature of a product, **excluding** the **name of the enterprise** and the **name of the product as sold**

name of the enterprise: brand name that matches the trade name

name of the product as sold: product brand name

What about secondary and tertiary brand names, brand names of components, ingredients, flavours, technology, etc.

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Transition period of 2 years

Until June 1, 2027

For **products manufactured before June 1, 2025**

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4. Case studies

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Case studies for 51.1 after June 1, 2025: general background

- A company called ECO Body Care commercializes hand soaps under the trademark BESTSOAP
- BESTSOAP branded products are offered in a wide range of fragrances
 - Fragrance names → descriptive, suggestive, registered as TM
- BESTSOAP branded products sometimes include branded ingredients that are sourced from 3rd parties.

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Position of French translations **after June 1, 2025**



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Position of French translations **after June 1, 2025** (cont.)



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BESTSOAP SPRING BREEZE Design



TM registration for

→ entire label

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BESTSOAP SPRING BREEZE Design

TM as registered



TM as used



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BESTSOAP and SPRING BREEZE



→ BESTSOAP
→ SPRING BREEZE

Both registered

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ECO BODY CARE and BESTSOAP



→ E · C · O · BODY CARE
→ BESTSOAP

Both registered

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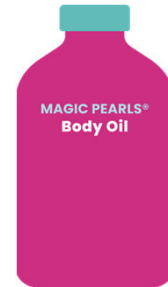
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BESTSOAP and MAGIC PEARLS branded oil



→ BESTSOAP
→ MAGIC PEARLS

Both registered



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5. Complaint & investigation Process

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Office Québécois de la Langue Française (OQLF)

Administrative body in charge of enforcing the French Charter and its regulations

Has the power to issue orders and seek injunctions

Does not have the power to grant fines – only the Court of Québec does

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OQLF : Approach



Usually reasonable when willingness to cooperate and remedy the situation



Tries to resolve most complaints amicably (in 85% of the cases according to the OQLF 2022-2023 Annual Report)

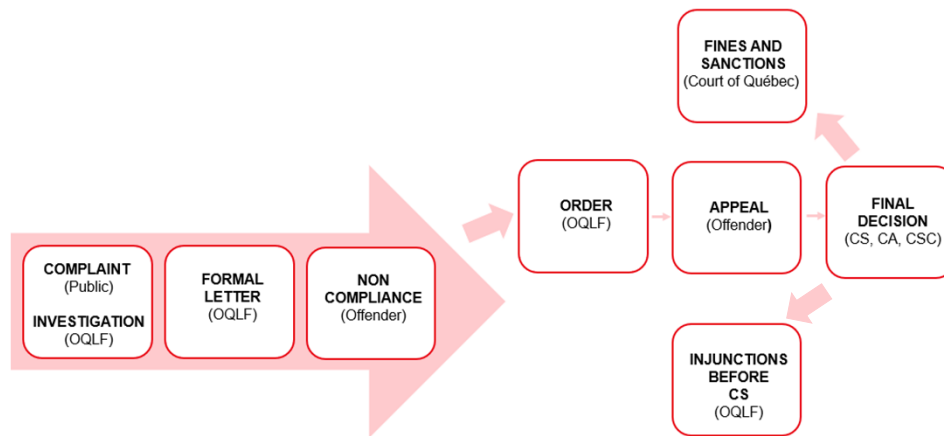


May be incline to allow phase-out periods

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Complaint & Investigation Process



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Risks

Fines

- \$3,000CAD to \$30,000CAD per violation
- Fines are doubled for a second offence, tripled for subsequent offences
- If the violation continues for more than one day, each day is considered a distinct violation

Sanctions

- Injunctions
- Suspension or revocation of permits granted by the Québec government

Reputational risk

- Court decisions are public
- List of non compliant businesses

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Right to live in French and be informed and served in French

- Important amendments introduced by Bill 96
 - could give rise to a class action by consumers

Charter of human rights and freedoms

3.1. Every person has a right to live in French to the extent provided for in the Charter of the French language (chapter C-11).

French Charter

50.2. An enterprise that offers goods or services to consumers must respect their right to be informed and served in French. An enterprise that offers goods or services to a public other than consumers must inform and serve it in French.

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6. Q&A

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Thank you!

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