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## Good News for Owners of Certification Marks in Canada

By Marina Stipanac

Trademark is defined in Canada as being:

- a mark used by a person to distinguish his or her goods or services from those of others;
- a certification mark;
- a distinguishing guise or;
- a proposed trade-mark.

Certification marks are used for the purpose of distinguishing the goods and/or services that are of a defined standard with respect to:

- the character or quality of the goods or services;
- the working conditions under which the goods have been produced or the services performed;
- the class of persons by whom the goods have been produced or the services performed, or
- the area within which the goods have been produced or the services performed, from goods and/or services which are not of such a defined standard.

A certification mark may be adopted and registered only by a person who is not engaged in the manufacture, sale, leasing or hiring of goods or the performance of services in association with which the certification mark is used. The owner of a certification mark may license others to use the mark in association with goods and/or services that meet the defined standard, and the use of the mark by licensees shall be deemed to be use by the owner; however, the owner of the certification mark cannot be using the certification mark on the goods and/or services that the certification mark extends to.

There are a few peculiarities of the certification mark regime in Canada. One is that since 1974, all the certification mark applications have had to be filed based on use. On March 1, 2013, the Canadian government introduced Bill C-56, the *Combating Counterfeit Products Act*. This Bill is designed to protect Canadian consumers, manufacturers and retailers from threats and losses posed by counterfeit goods. Bill C-56 has also introduced some other changes to the trademark regime in Canada. One of the proposed changes is to allow owners of the certification marks to apply for certification mark registrations on a proposed use basis. If this Bill, which has undergone a first reading, is passed into law, it will bring a welcome change for Canadian, as well as foreign, owners of certification marks.

Another odd exclusion imposed by the Canadian Intellectual Property Office (CIPO) is that professional designations have not been considered valid certification marks. This practice was a result of a case decided in 1988 ([Life Underwriters Association of Canada v. Provincial Association of Quebec Life Underwriters](#)). A recent appeal to the Federal Court from an Opposition Board decision in [Ontario Dental Assistants Association v. Canadian Dental Association](#), held that a professional designation can function as a



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certification mark, provided the other certification mark criteria are met. These criteria are: the mark cannot be clearly descriptive or deceptively misdescriptive of the goods or services in association with which it is used; it needs to be distinctive; it should not be used by the owner, but only by authorized licensees; it should not be confusing with a previously used, registered, or applied for trademark or trade name; and it needs to be used in accordance with section 4 of the *Trade-marks Act*.

This Federal Court decision will finally make it possible for owners of professional designation certification marks to obtain registrations for their trademarks in Canada.

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