



MADRID PROTOCOL IN CANADA: WHY UNIFORMITY CAN KILL YOUR BRAND!

by Karen Hansen

Every brand owner wants a uniform approach to describing its goods and services around the world. The [Madrid Protocol](#) helps make that happen. But under Canadian trademark practice, it does not necessarily pay. To the unwary, it can cost a registration.

The case of *Supershuttle International, Inc. v. Fetherstonhaugh & Co.* warns of this risk.

Supershuttle owned the registered trademark SUPERSHUTTLE in Canada for services described as “airport passenger ground transportation services.”

In a summary cancellation proceeding, Supershuttle was required to show use of the trademark for services as registered. It was unable to do so. It lost its registration because the services that matched those of its U.S. registration did not reflect what it was actually doing in Canada – providing reservation services.

This case illustrates a fundamental lesson: the importance, when designating Canada, to describe the brand owner’s activities in Canada, rather than rely on a home registration description. They must be activities that the brand owner can reasonably perform in Canada, even remotely. With [Canada’s accession](#) to the Madrid Protocol scheduled for February 2019, this is an increased concern. An applicant will be able to register its mark in Canada without using the mark in Canada. So an applicant’s description

of goods and services will become even more crucial to the registrability and enforceability of its brand.

In my next article, we will examine the increased challenges that brands as family names may face using the Madrid Protocol in Canada.

If you want further information regarding how to take a strategic approach with the Madrid Protocol and Canadian trademark practice, please contact me.

Author the Author

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