



Madrid Protocol in Canada: Confusion and Consent – Will Anything Change?

by Bayo Odutola

Every brand owner wants a uniform approach to protecting its marks around the world. The *Madrid Protocol* helps make that happen. But in Canada, unlike in many other jurisdictions, consent from the owner of a confusing mark will not overcome a confusion objection to registering a mark.

That is the lesson from the Federal Court in *Holding Benjamin et Edmond de Rothschild v. Canada (Attorney General)*. In *Edmond de Rothschild*, the Court found the consent to be incomplete and therefore too vague and unspecific.

Under Canadian practice, confusion between trademarks will continue to be assessed by whether consumers perceive the trademarked goods or services to originate from the same legal entity, whether or not the goods or services are in the same class.

A consent agreement cannot waive or preclude this assessment. Nor can the fact that the owners of the confusing marks are related by family or share ownership, since the companies are different legal entities.

However, a properly drafted consent or co-existence agreement will likely influence the confusion analysis if the Registrar or the Court is convinced by a detailed factual explanation in the consent of why consumers are unlikely to perceive that the trademarked goods or services originate from the same legal entity. This brings the confusion assessment back to consumer perception of the trading origin of the goods or services.

Alternatively, the confusion objection can be overcome by placing both confusing marks in the name of a special purpose legal entity. Agreements can be made to protect the interests of the parties. Having all confusing marks in the name of one legal entity, rather than in the names of several, strengthens the trademark rights against potential infringers.

By implementing specific strategies that acknowledge Canadian trademark law, a brand owner can obtain solid protection in Canada.

About the Author

Bayo Odutola is the author of the leading practitioners' manual, now in its 13th year, *Odutola on Canadian Trademark Practice*. This book provides insightful analysis of trade-mark law practice and procedure before the Canadian Trade-marks Office and Trade-marks Opposition Board.

He is a partner at Ollip P.C. (ollip.com). Bayo has built a strong copyright (technology licensing), trademark prosecution (acquisition, clearance, and advice), and intellectual property litigation (Trademarks Opposition Board, Federal Court, and Federal Court of Appeal) practice. He represents or has represented individuals and business of all sizes, from Canada and elsewhere. His clients range from Juno and Academy Award winners and fashion designers to chemical companies, alcohol producers, and restaurants. He is certified as a specialist in IP (Trade-mark/Copyright) Law by the Law Society of Ontario and has served on the Law Society of Ontario's Committee for the Certification of Specialists in Intellectual Property Law.

He is active in various intellectual property organizations, including the Intellectual Property Institute of Canada (IPIC), International Trademark Association, MARQUES, Pharmaceutical Trademarks Group, and the European Communities Trade-mark Association (ECTA). He is currently a member of ECTA's Committee on Geographical Indications.

Previously, he served as an adjunct professor of law at the University of Ottawa. His IP practice has been recognized by the Canadian Bar Association's *The National* magazine (cover feature). Also, Export Development Canada's *Exportwise* magazine has recognized his IP practice twice for its strength and focus on intellectual property export risk and insurance management.

