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### **Use It or Lose It!** **Marina Stipanac**

Even I, a not-very-gracefully-ageing woman who prefers letting nature take its course, know that with a little help from BOTOX, you can fool the rest of the world and shave off a few years from everywhere but your Birth Certificate. Although use of the products and procedures under this mark would be utterly justified in my case, this is not what excites me about BOTOX. What does excite me is the fact that our long standing cautionary advice to clients has been validated; foreign use and registration basis in a Canadian trademark application should only be claimed if the mark was in use in the foreign country as of the Canadian filing date.

The Canadian Trade-marks Opposition Board recently published a decision that supports the practice of those Canadian firms who have been advising their clients not to include foreign use and application/registration basis at the time of filing a Canadian application unless both conditions were met as of the filing date.

Allergan Inc. (“Allergan”), is the owner of the trademark BOTOX, used for different therapeutic treatments, and BOTOX COSMETIC, used for aesthetic applications. Lancôme Parfums and Beauté & Cie (“Lancôme”) filed a Canadian trademark application to register the mark MYOTOX in association with a variety of cosmetic products. They based their application upon use and application of the mark in France.

Allergan opposed the registration of the trademark MYOTOX on a number of grounds, one being that the mark MYOTOX was either not in use in France, or was abandoned, at the time of filing the Canadian application. Lancôme filed no evidence of use in France, or in any other country, of their MYOTOX mark. As a result, the Opposition Board refused the application for MYOTOX on the grounds that the Applicant did not fulfill the requirements of Section 30 of the Trade-marks Act.

The present case confirms that the material date for determining whether requirements of Section 30 of the Canadian Trade-marks Act are fulfilled is the date of filing the application or the filing date of the priority application, if applicable.

This does not mean that the basis of foreign use and application/registration cannot be added to the application after the filing date, provided a mark was in use in a foreign country prior to the filing of the Canadian application, and that information was not available to the Canadian agent at the time of filing.

This decision is welcomed by our firm, confirming our long standing cautionary advice to clients that the mark should be in use in the foreign jurisdictions before claiming foreign use and application/registration basis at the time of filing in Canada.

*Allergan Inc. v. Lancôme Parfums and Beauté & Cie, General Partnership, 64 C.P.R. (4th) 147 (T.M.O.B.).*