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What's New for Trade-mark Owners Doing Business in Quebec?

By Marina Stipanac, Registered Trade-mark Agent

French language became the official language in the province of Quebec in 1974. Companies doing business in Quebec must ensure that they follow the strict language rules of *La charte de la langue française* (The Charter of the French Language, "the Charter"). The Charter guarantees French language rights and governs the use of French in Quebec, but also offers certain exceptions for language use in different areas of business, such as use in brochures and catalogues, product labeling, public signs, posters, commercial advertising, company names and trademarks.

The Charter also provides that French need not be used for a recognized trade mark within the meaning of the *Trade-Marks Act*. This is where the confusion begins. The *Trade-Marks Act* recognizes both registered and unregistered trade-marks in Canada. However, the *Office québécois de la langue française* (the "OQLF"), the commission responsible for enforcing the Charter, takes the position that unregistered trade-marks and trade-marks that are subjects of pending applications do not benefit from the exception provided for in the Charter. So, it is left for the Courts to determine if an unregistered trade-mark has gained sufficient recognition to benefit from the recognized trade-mark exception. As the relevant case law is inconsistent and the burden and expense of proving recognized trade-mark status falls on trade-mark owner, registering a trade-mark with the Canadian Intellectual Property Office remains the safest course of action for trade-mark owners.

OQLF's Trade Name Campaign

General rule for trade name use in Quebec is that the names of enterprises must be in French. In the past, companies with establishments in Quebec were permitted to use their registered trade-marks, regardless of the language, on signs outside of their premises. In November 2011, OQLF adopted a new policy and started treating the storefront signs as trade names rather than trademarks. OQLF takes the position that a trademark appearing on a storefront sign is perceived by consumers in Quebec as being a trade name.

With this campaign, OQLF started targeting several major retailers in Quebec, demanding that they add French to the exterior signage on their premises. Complying with OQLF's demands would be a considerable financial undertaking, especially given the number of establishments that some large retailers operate in Quebec and it is not surprising that Walmart, Costco, Best Buy, Gap, Old Navy and Guess took this matter to the Quebec Superior Court at the end of 2012. The decision of the Court is expected in Spring 2013.



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What Else is New? - Bill 14

In December 2012, the Quebec minority government tabled [Bill 14, An Act to amend the Charter of the French language](#). Bill 14 proposes granting wider investigative powers to OQLF by allowing the Minister responsible for the application of the Charter to authorize a competent person to conduct an inspection of any business with respect to their use of trademarks and trade names. It would fall within the inspector's investigative power to seize materials that he/she believes offends the Charter. Bill 14 also proposes the removal of present requirement of giving a formal notice to the alleged offender and it proposes that no grace period is allowed within which to rectify the infraction.

The Committee on Culture and Education will hold public hearings in March for anyone wishing to express their opinion of the changes proposed by the Bill. It is expected that representations will be made by multiple groups and associations, including businesses and cultural communities.

Both the Quebec Superior Court's decision regarding trade-mark use on storefronts and Bill 14 will likely have an impact on businesses that operate their establishments or offer their goods and services in the province of Quebec. What the exact impact of those two would be remains to be seen. We will provide you with further updates as the issues progress.

The above article is for general information purposes only and does not constitute legal advice.

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