

RICKETTS, HARRIS LLP

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Re: Trade Marks

Arguably, a charity's most valuable asset is its goodwill and good name. Second only to that is its mailing list of donor names and addresses.

In recent years, there has been increased emphasis on the need to protect the goodwill of the charity by registering its trademarks. One of the more effective routes of doing this has been to file an application for an "Official Mark". This process has two advantages;

- It does not require publication at the initial application stage in the Trade Marks Journal;
- Once granted the *Trade Marks Act* prohibits all others from adopting a mark that resembles the Official Mark. Thus, an Official Mark is not restricted to specific goods or services.

The Federal Court has recently overruled the decision of the Registrar of Trademarks in granting Chosen People Ministry ("CPM") an Official Mark for its "Menorah design".

Official Marks are only available to "public authorities". CPM claimed that it was qualified as a public authority because it is a charitable organization and, as such, subject to regulation both in Ontario and the United States. To date, the Registrar has accepted the argument that Canadian charities are "public authorities" because of the degree of supervision of charities under the *Income Tax Act* and by the Public Guardian and Trustee in Ontario.

However, Judge Blais ruled that CPM's charitable status was insufficient to establish significant government control. As a result he quashed the decision of the Registrar to grant CPM an Official Mark. An appeal of this decision has been filed.

Charities should continue to vigorously protect their goodwill and Trade Marks, but will now have to do so by the conventional and more drawn out Trade Mark application route.

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