



October 06, 2022

Via email: iyana.goyette@ised-isde.gc.ca

Trademarks and Industrial Designs Branch
Canadian Intellectual Property Office
Innovation, Science and Economic Development Canada
Place du Portage, Phase 1
50 Victoria Street
Gatineau, QC K1A 0C9

Dear Ms. Goyette:

Re: *An Act Respecting French, the Official and Common Language of Quebec and Trademarks*

I write on behalf of the Intellectual Property Section of the Canadian Bar Association (the CBA Section), to comment on Quebec's new language law, *An Act Respecting French, the Official and Common Language of Quebec*,¹ and its effect on Canadian trademarks. We hope the Canadian Intellectual Property Office (CIPO) can amend its current policy concerning "Requests for expedited examination"² to include applications for marks to be used in the province of Quebec given new time constraints imposed by the new law.

The Canadian Bar Association is a national association representing over 37,000 jurists, including lawyers, notaries, law teachers and students across Canada. We promote the rule of law, access to justice and effective law reform, and offer expertise on how the law touches the lives of Canadians every day. The CBA Section deals with law and practice relating to all forms of ownership, licensing, transfer and protection of intellectual property and related property rights, including patents, trademarks, copyright, industrial designs, plant breeders' rights, as well as trade secrets. Given the provincial scope of the legislation under review, we also sought input from the Quebec Branch.

Bill 96, *An Act Respecting French, the Official and Common Language of Quebec* was adopted by Quebec's National Assembly on May 24, 2022. It received Royal Assent on June 1, 2022. The Act promotes the French language in numerous ways and seeks to reinforce certain provisions of the *Charter of the French language*³, (*Charter*). Non-French trademarks that appear on products (including their label or packaging) sold in Quebec, or on public signs and commercial advertising in Quebec are targeted by this reform.

¹ S.Q. 2022, c.14

² CIPO Requests for expedited examination: [online](#).

³ R.L.R.Q., c. C-11

Currently, in Quebec, a trademark registered in Canada or used without registration such that it has become known in Canada (i.e., a common law trademark) may appear on products, commercial publications (including catalogs and brochures), or public signs and commercial advertising exclusively in a language other than French (if the French equivalent of the trademark is not registered in Canada), with some additional requirements in respect of public signage displayed outside buildings in Quebec. The foregoing is referred to as the “recognized trademark” exception.

The “recognized trademark” exception flows from paragraphs 7(4), 13(4) and 25(4) of the Regulation⁴ respecting the language of commerce and business, which allow the use of a “recognized trademark” within the meaning of the *Trademarks Act* on products, commercial publications, public signs and commercial advertising in Quebec. Since the *Trademarks Act* does not use the expression “recognized trademark”, Quebec Courts have had to construe the meaning of this term. While a non-French trademark that is registered in Canada is a “recognized trademark”, several decisions have held that common law trademarks are also “recognized trademarks” (if the French equivalent of the registered or common law trademark is not registered in Canada).

The Act states that, on June 1, 2025, the “recognized trademark” exception for non-French trademarks displayed on products will only apply for registered trademarks (if the French equivalent of the trademark is not registered in Canada). This results from section 43 of the Act which introduces new section 51.1 to the *Charter*:

51.1. Despite section 51, on a product, a registered trademark within the meaning of the Trademarks Act (Revised Statutes of Canada, 1985, chapter T-13) may be drawn up, even partially, only in a language other than French where no corresponding French version appears in the register kept according to that Act. However, if a generic term or a description of the product is included in the trademark, it must appear in French on the product or on a medium permanently attached to the product.

On June 1, 2025, the “recognized trademark” exception for non-French trademarks displayed on public signage and commercial advertising will also only apply for registered trademarks (if the French equivalent of the trademark is not registered in Canada). This results from section 48 of the Act which introduces new section 58.1 to the *Charter*:

58.1. Despite section 58, on public signs and posters and in commercial advertising, a trademark may be drawn up, even partially, only in a language other than French, provided the trademark is registered within the meaning of the Trademarks Act (Revised Statutes of Canada, chapter T-13) and no corresponding French version appears in the register kept according to that Act.

However, on public signs and posters visible from outside premises, French must be markedly predominant where such a trademark appears in a language other than French.

The above provisions impose a significant burden on marketing in Canada – certainly entry into Quebec – of existing and future products and services whose identifying new English language mark, which is otherwise capable of registration elsewhere, can no longer be used in Quebec without translation and given the application processing delay at CIPO. While the delay may be rectified in the next three years, it is an unknown factor.

From a practical perspective, many trademark owners have global marketing strategies that operate on short runways of only months or weeks, either because their businesses operate on a seasonal basis (e.g. in the fashion industry) or because their marketing strategy is premised on a surprise product announcement where new product names remain confidential even within the

⁴ R.R.Q. c. C-11, r. 9

business itself. Even if trademark owners wished to file and register their non-French trademarks in Canada to comply with the *Charter's* new sections 51.1 and 58.1, they could not register their new trademarks in time to do so. Since their marketing strategy requires that trademarks be consistent worldwide, translating a new trademark or a component within a new trademark into French to comply with the *Charter* (as amended by the Act) is not an acceptable approach. Certain trademark owners are therefore now forced to consider whether they can continue doing business in Quebec once sections 51.1 and 58.1 come into force, certainly for goods and services offered under new trademarks if these provisions remain unchanged.

Considering the above, the CBA Section requests that CIPO amend its current policy concerning "Requests for expedited examination" to include applications for marks for which there are concrete plans for use in the province of Quebec.

We would be pleased to discuss our feedback with you.

Yours truly,

(original letter signed by Julie Terrien for Faylene Lunn)

Faylene Lunn
Chair, Intellectual Property Section