

SMART & BIGGAR

BRANDING IN QUÉBEC.

Strategically navigating French language requirements and leveraging trademarks

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Our speakers



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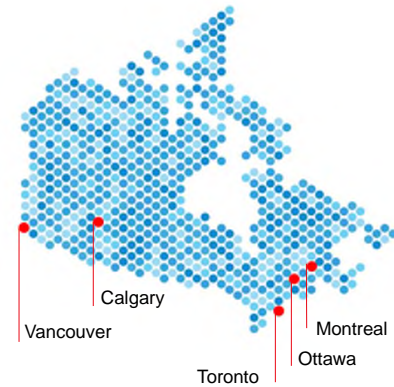
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Who we are

Canada's **leading IP law firm**
with expertise at the interface of
technology and **business** law

- Expertise in all areas of IP
- 130+ years serving clients
- 100+ lawyers, agents and technical consultants
- 8,000+ patents & trademarks filed annually
- Litigation bench strength and record of success



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Overview

1. The *Charter of the French Language* ("French Charter")
2. The recognized trademark exception
3. Risks of breaching the French Charter
4. Changes proposed to the French Charter (Bill 96)
5. Q&A

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1. The French Charter

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The French Charter: What it is

Statute adopted by the government of Québec in 1977 to protect the French language in all spheres of public life



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Territorial application



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Our focus

Language of commerce and business



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General rule: **Inscriptions**

Must be in FRENCH



- Accompanying documentation
 - Certificates of warranty / authenticity
 - User manuals
 - Brochures / promotional materials
 - Registration cards
 - Discount coupons
- Other languages may be used
 - **No greater prominence** requirement

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General rule: **Commercial publications**

Must be in FRENCH



- Commercial publications
 - Websites
 - Brochures
 - Flyers
 - Catalogues
 - Commercial directories
- Other languages may be used
 - **No greater prominence** requirement

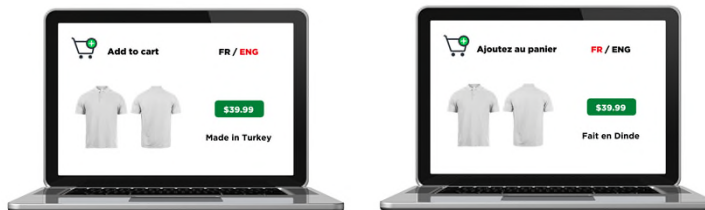
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General rule: **Commercial publications**

2 versions possible

- French version as accessible and of no lesser quality than the version in the other language
- **Beware of online translation tools**



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General rule: **Commercial publications**

All **websites** accessible in Québec do **not** need to be in French

Establishment in Québec



Products / services sold /
offered in Québec

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General rule: **Public signage and advertising**

Must be in FRENCH



- Public signage and commercial advertising
 - Messages displayed in a place accessible to the public
 - On any medium whatsoever such as signs, posters, billboards, storefronts
- When other languages may be used alongside French
 - **Markedly predominant** requirement

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General rule: **Public signage and advertising**

When **no** other languages may be used alongside French...

Billboards, signs or posters having an area of 16 m² or more and visible from a public highway (unless the advertising is displayed on the very premises of the business)



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General rule: **Public signage and advertising**

When **no** other languages may be used alongside French...

Commercial advertising in Québec
on any means of **public transportation**
(including indoors and on bus shelters)



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2. The Recognized Trademark Exception

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Key Point

A recognized TM does **not** need to be translated into French **provided** that no French version of the TM has been (previously) registered in Canada

TAKE AWAY:
Do not register a French version of the TM

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A recognized TM: What it is

Registered or **common law** marks in Canada?

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A recognized TM: What it is

Registered TM

- CIPO has issued a certificate of registration for the TM

Benefits

- Matter is generally resolved before the OQLF

Common law TM

- TM used, promoted and advertised in Canada to the point where it has acquired some level of recognition in the market

Limited and burdensome

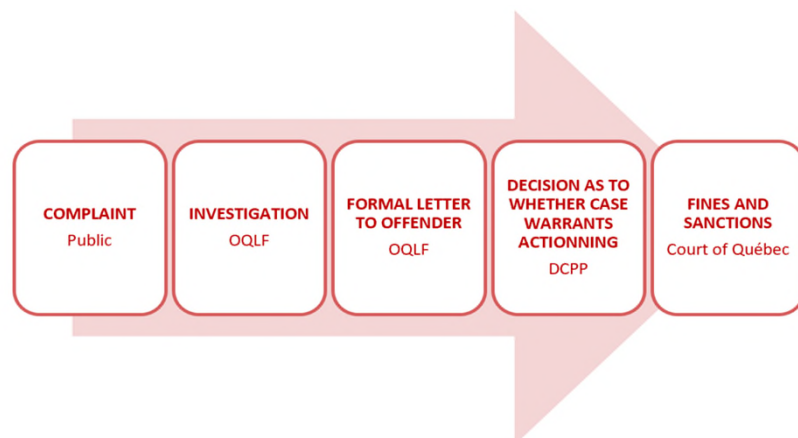
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Complaint process

Relying on a
TM registration or
common law TM



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Case

Public signage and commercial advertising not in French

- Trucks bearing the slogans COAST TO COAST SERVICES and CLASS OF 200_
- Slogans are not registered as a TM

Had to demonstrate for each slogan that:

- Functions as a TM (i.e. indicates source of services)
- Used in Canada with transportation services
- Protectable goodwill

Results?

- COAST TO COAST SERVICES: Complaint dismissed // Use as a TM since **1970** was demonstrated
- CLASS OF 200_: Fine of 500\$ // Unable to show use of the slogan as a TM

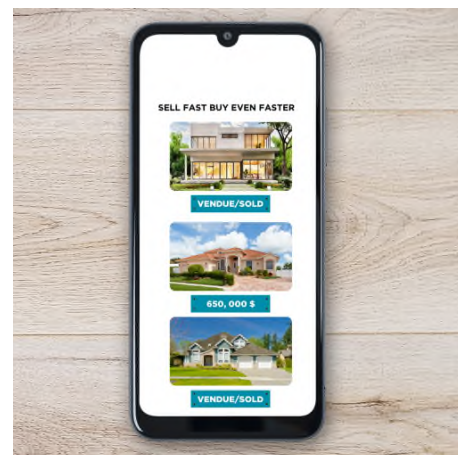
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A recognized TM: **How to leverage**

Register slogans and expressions

SELL FAST BUY EVEN FASTER

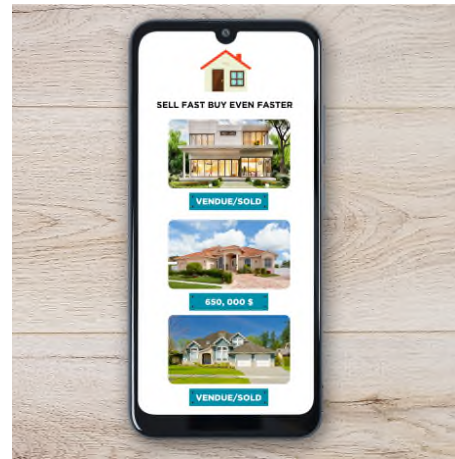


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A recognized TM: **How to leverage**

Register logos



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A recognized TM: **How to leverage**

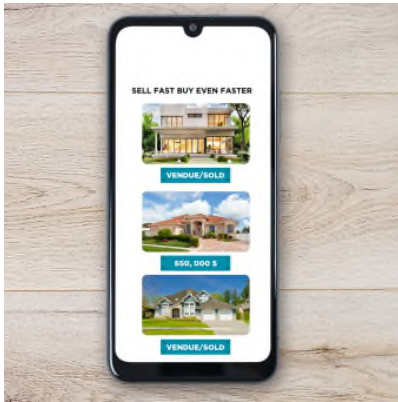
Register labels or parts thereof



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Challenge: **Time to registration**

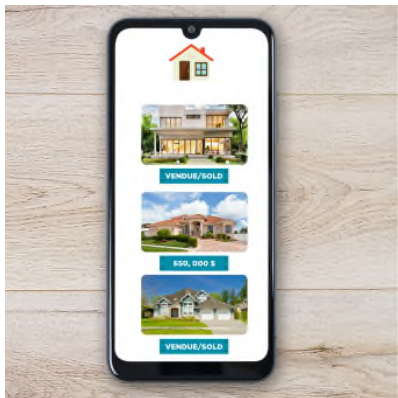


- Current timeline to registration = over 3 years
- Solution: Good planning or manage risks

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Challenge: **Criteria for registration**



- TM must be registrable
- TM must be distinctive
- Solution: Add a distinctive element

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Challenge: TM may change over time



- Solution: Minor / subtle changes

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Challenge: TM outside a building

- Recognized TM displayed outside a building must be accompanied by French inscriptions as per the “sufficient presence of French” requirement
- **Solution:** Add descriptive language, a slogan or an indication as to the nature of the business.



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3. Risks of Breaching the French Charter

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Consequences of a negative decision

Fines and sanctions

- Individuals: \$600 CAD to \$6,000 CAD
- Businesses: \$1,500 CAD to \$20,000 CAD
- Financial gain derived from violation
- Destruction or removal of non-compliant public signage and commercial advertising

Reputational risk

- Decisions rendered by the Court of Québec are public
- May be reported in the media
- French language is a sensitive topic in the province of Québec
- Bad publicity

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4. Changes proposed to the French Charter (Bill 96)

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Bill 96: Overview

Bill proposed by the government of Québec to strengthen the provisions of the French Charter

Coming into force? Unknown

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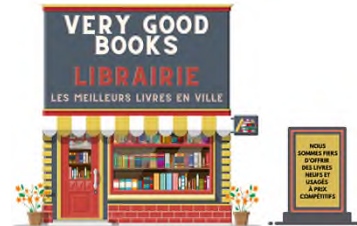
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Proposed changes include...

Recognized TM exception is not impacted except for **public signage** and **commercial advertising**



Sufficient presence of French
no longer accepted



French must be
markedly predominant

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Proposed changes include...(cont.)

Powers of the OQLF are extended, e.g.

- May order removal of non-compliant products or ask the court to issue an injunction
- May ask the court to order the removal or destruction of non-compliant public signs, posters, billboards, and the like

Fines are increased, e.g.

- Individuals: \$700 CAD to \$7,000 CAD
- Businesses: \$3,000 CAD to \$30,000 CAD
- Amount doubles for second violation and triples for any subsequent violations
- If violation continues for more than one day, each day = distinct violation

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5. Q&A

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Useful resources

- French Charter
www.legisquebec.gouv.qc.ca/en/showdoc/cs/c-11
- Regulation respecting the language of commerce and business
www.legisquebec.gouv.qc.ca/en/showdoc/cr/C-11,%20r.%209
- Regulation defining the scope of the expression "markedly predominant" for the purposes of the Charter of the French language
www.legisquebec.gouv.qc.ca/en/ShowDoc/cr/C-11,%20r.%2011%20/
- Bill 96
m.assnat.qc.ca/fr/travaux-parlementaires/projets-loi/projet-loi-96-42-1.html
- OQLF website
www.oqlf.gouv.qc.ca/accueil.aspx

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Thank you!

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