

## National newspapers engage in Trademark War

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Edward Hore  
Hazzard & Hore  
141 Adelaide Street West, Suite 1002  
Toronto, ON M5H 3L5  
(416) 868-1340  
[edhore@hazzardandhore.com](mailto:edhore@hazzardandhore.com)

Thomson, owner of the *Globe and Mail*, must be really worried about the new competing Conrad Black daily scheduled to appear this October.

My quick search of the Canadian trade-marks database, recently put on the internet, shows that Thomson has been applying to file trade-mark applications in order to tie up every possible name Black might conceivably use for his new newspaper.

At least the following seventeen "proposed use" applications were filed by Thomson, in two batches, one in October 1997 and the other in March of this year, all for newspaper-related wares and services (there may be others):

CANADA TODAY  
THE CANADIAN  
THE TIMES  
THE CANADIAN CITIZEN  
THE NATIONAL OBSERVER  
THE NATIONAL  
THE CANADIAN OBSERVER  
THE CANADIAN TIMES  
THE TIMES OF CANADA  
THE INDEPENDENT  
THE WORLD TODAY  
THE WORLD  
THE DAILY TELEGRAPH  
THE TELEGRAPH  
THE NATION TODAY  
THE NATION  
TIMES COLONIST

The agent for service on the applications is mostly Michael Doody, in-house lawyer at Thomson. I put a call into Mr. Doody, to ask whether these applications might by any

chance have anything to do with the impending arrival of the Conrad Black daily, but he hasn't called me back yet.

In an interview reported in the Globe and Mail on July 23, Black refused to say what he wants to call the new daily, but he mentioned Thomson's spoiler strategy (reading this is what prompted me to search the database). Black told the reporter: "We had adopted a name and the name we had adopted, the copyright had been reserved in a spoiling move, by your employers." The Globe story goes on, "Globe publisher Roger Parkinson confirmed yesterday that the Globe had registered the name Mr. Black had wanted to use. 'It's true. We did it, for competitive reasons,' he said."

Not knowing for sure what name Black wanted, Thomson evidently decided to go for the shotgun approach and apply for every name it could think of. Sure enough, one application seems to have been a direct hit, although we don't know which one (my guess: THE CANADIAN).

It is not clear what exactly Thomson hopes to achieve. Presumably, it hopes to (a) delay the appearance of the new paper, or (b) extract pay-off money from Black, or (c) make Black choose an icky name for the new paper, or (d) generally be obstreperous.

To delve into the technicalities briefly, the applications are what's known in the Trade-mark Act as "proposed use" applications. Such an applications are intended to reserve a mark one intends to use in future. Before one of Thomson's proposed use application can result in a valid trade-mark registration, Thomson would have to file a document saying it's actually begun using the mark.

An argument could be made that even small-scale "use" of the trade-mark by Thomson would enough to get a valid registration. Thomson could maybe come out with a one-page newspaper called THE CANADIAN, and distribute twenty copies to the cleaning ladies and the guys in the mail room. Then it would claim it was entitled to a trade-mark registration for THE CANADIAN. The registration would give it exclusive use of that mark across Canada, meaning you-know-who would be infringing if he used THE CANADIAN for his new newspaper.

But it's unlikely such a scheme would fly in court. A judge would probably think it was too goofy to be legitimate.

Sometimes spoiler strategies work. For example, Imasco owns the mark MARLBORO for cigarettes in Canada, on the basis of minimal use, thus keeping the registration out of the hands of rival Philip Morris, which sells Marlboro cigarettes around the world (but, of course, not in Canada.) However, Imasco has time on its side; the registration is decades old. The passage of time has a way of encrusting trade-mark registrations with legitimacy.

Thomson's proposed use applications will beat out later proposed applications for the same mark by Black's company, Southam (and indeed Southam has now belatedly filed

some such applications). But if Southam establishes actual use of the trade-mark (i.e. that it's actually selling newspapers under a given name) and Thomson doesn't, Southam will get the trade-mark registration, and the right to the name, sooner or later.

The database shows Southam has now filed its own flurry of proposed use applications for various newspaper names in recent weeks, for marks such as CANADA TODAY, THE CANADIAN and CANADIAN TIMES among others.

What it boils down to, I think, is that Conrad Black is going to get the newspaper name he wants in the end, although there may be some legal shenanigans first.

It's odd that Thomson Limited, owner of the venerable Globe and Mail, is indulging an antic like this. Thompson may end up looking bad from a public relations point-of-view, without accomplishing much.