

Use it or Lose it: Provide Gifts, Inc. V. MJB Marketing Inc. 2014 TMOB 15

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The recent (and brief) decision of the Registrar of Trade-marks in *Provide Gifts, Inc. V. MJB Marketing Inc.* 2014 TMOB 15 should serve as a reminder to businesses of the potential power of expungement proceedings, and why the existence of a registration won't always bar another's use and registration of a similar mark in a similar field.

THE FACTS

In 2009, MJB Marketing Inc. applied to register the mark "MyJewelryBox.com" and its logo. MJB had used these marks since 2006 in connection with online retail jewelry sales, and the application was submitted despite the existence of a prior, similar registration; Provide Gifts Inc. had registered a gift box logo in 2007, having used the logo in Canada since 1999 in relation to online ordering of gifts. The similarities in the marks and associated business might have prevented MJB from attempting the registration, and may have prevented its mark from being selected for use in the first place.

THE DECISION

An opposition from Provide to MJB's application was to be expected, and was duly filed in 2010. Rather than fight the opposition on its merits (for example, arguing, that the marks were not confusingly similar), MJB took another approach. It used section 45 of the Trade-marks Act and succeeded in having Provide's registration expunged. Once the registration was removed, Provide appears to have taken no other steps to contest MJB's registration, and filed no other materials to support its opposition. The registration was allowed.

LESSONS LEARNED

The lesson for those choosing to register their trade-mark, and those deciding on a new mark, is that hits returned from a search of the trade-marks database will not always prevent a new registration. If the extant mark is not being used (or is only being used in association with a subset of the wares and services it purports to relate to), it may be vulnerable to expungement proceedings.

The other lesson is for the holder of a registration, and is the old adage - 'use it, or lose it'.

Contact

Please direct questions
or suggestions to:

Nicholas Mott
nmott@coxandpalmer.com
902.491.4208

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