

COULD DONALD TRUMP MAKE AMERICA GREAT AGAIN IN CANADA?

Posted on June 5, 2017

Categories: [Insights](#), [Publications](#)

The “Make America Great Again” slogan is ubiquitous across the United States of America. There’s no denying, regardless of your political affiliation, that President Donald Trump has built goodwill in the slogan. But what rights does he have to sell hats bearing the slogan in Canada? This article explores the status of United States trade-marks and steps that American trade-mark registrants can take to register their marks in Canada, all through the lens of President Trump’s popular refrain.

The Background Of Make America Great Again In The United States

President Trump registered the word mark “MAKE AMERICA GREAT AGAIN” in the United States for a variety of goods and services, ranging from bumper stickers to caps to one piece baby garments to campaign buttons.^[1] The date of first use relied upon was April 12, 2015.

The Status Of The Trade-Marks Register In Canada

Just as the United States Patent and Trademark Office can be searched through the Trademark Electronic Search System, the Canadian Intellectual Property Office (CIPO) permits searches of the Canadian trade-marks database online

A CIPO search discloses one listing for *Make America Great Again* in Canada. Holger Michiels filed an application for the word mark of “Make America Great Again” for, among other things, hats and baby clothing. The application, filed November 9, 2016, is based on proposed use in Canada.

As the date of publication of this article, Mr. Michiels’ application^[2] for *Make America Great Again* has not been examined.

There are six general “steps” in registering a trade-mark:

1. Formalities immediately upon filing;
2. Examination;
3. Advertising;

4. Opposition;
5. Allowance; and
6. Registration

Mr. Michiels application has been formalized but has not been examined. Should a CIPO examiner approve the trade-mark, it will be advertised in the *Trade-Marks Journal*, which is published weekly. President Trump would have two months from the date of advertisement to oppose the trade-mark.

If President Trump intends to use the *Make America Great Again* trade-mark in Canada (or if he wishes to at least prevent others from being granted a monopoly on the phrase in Canada) he should oppose the trade-mark. At that point, the Trademarks Opposition Board would become involved. Opposition proceedings are tribunal proceedings which involve written filings and the opportunity for an oral hearing. There is an entire body of case law concerning proceedings before the Trademarks Opposition Board.

If President Trump were successful in opposing the trade-mark application, the application would be denied. Unless Mr. Michiels could establish some pre-existing common law rights in the mark through prior use in Canada, Mr. Michiels would have no way to prevent President Trump from using *Make America Great Again*, regardless of whether the President has obtained his own registration.

There are also Canadian trade-mark applications related to *Make Canada Great Again*. The Rebel News Network Ltd. is seeking to register it in relation to broadcasting. An individual is also seeking to register it for services and goods such as hats, baby clothing and campaign buttons.

President Trump's Rights To Make America Great Again In Canada

If President Trump wants exclusive use throughout Canada, registration of *Make America Great Again* would be the most prudent step. In Canada, registration provides the owner of a trade-mark the exclusive right to its use throughout Canada with respect to the goods or services in the registration. In contrast, unregistered (or "common law" trade-mark) rights can exist in a trade-mark, but those rights are limited to the geographic area within Canada where the owner can prove the mark has established a reputation and goodwill. In addition to the benefit of rights which extend across the country, a registration would also prevent instances of other people registering other confusingly similar trade-marks.

Canada's *Trade-marks Act* ("**Act**") has multiple grounds on which President Trump could seek to register *Make America Great Again*:

- Marks used or made known in Canada. Section 16(1) of the Act permits an applicant to seek to register a trade-mark based on the mark being used or made known in Canada. This is possible unless on the date of first use or on which it was made known, the trade-mark was confusing with:

- a trade-mark that had previously been used in Canada or made known in Canada by any other person;
- a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or
- a trade-name that had been previously used in Canada by any other person.
- Marks registered and used abroad. Section 16(2) of the Act permits an applicant to seek to register a trade-mark based on registration in the country of origin. This is possible unless on the date of first use or on which it was made known, the trade-mark was confusing with:
 - a trade-mark that had previously been used in Canada or made known in Canada by any other person;
 - a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or
 - a trade-name that had been previously used in Canada by any other person.

The Act also permits applications on the base of “proposed use” (which is similar to the “intent to use” basis in the United States). However, like the two types of applications mentioned above, an application based on proposed use can be refused by an Examiner (or successfully opposed by a third party) if it is confusing with a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person or for which there is prior use of a confusing mark in Canada. As noted above, Holger Michiels filed an application on November 9, 2016 and, as such, a subsequent application by President Trump based solely on proposed use would lack priority.

Canada plans to implement the *The Madrid Protocol* in 2019 through amendment of the *Trade-marks Act*. The filing system utilized in relation to *The Madrid Protocol* differs from that currently in place in Canada. It involves filing an application with the World Intellectual Property Office which then permits an applicant to make international designations, covering up to 114 countries. For now, President Trump is left with the domestic Canadian filing system.

What About The “Make Canada Great Again” Trade-mark?

As noted above, there are two pending applications in Canada for *Make Canada Great Again*. The first application, brought by an individual, has been advertised and is currently being opposed by The Rebel News Network Ltd. The other application, brought by The Rebel News Network Ltd. has just been formalized.

If either of these registrations are granted, they would give the applicant the exclusive right to the use of *Make Canada Great Again* throughout Canada with respect to the goods or services in the registration. If President Trump wants to prevent the registration of these trade-marks because they are confusingly similar to his, he

should begin monitoring Canadian trade-mark proceedings more closely. At present, it is already too late for President Trump to oppose the individual's application for *Make Canada Great Again*.

President Trump's Rights Against Canadians Who Are Making America Great

To simply use *Make America Great Again*,^[3] President Trump does not have to register the trade-mark. Right now there is no registered trade-mark for *Make America Great Again*. So if President Trump wanted to sell some hats in Canada with that mark and he was not concerned about possible infringers, he could open his kiosk and get started.^[4] However, in light of the application by Mr. Michiels, he is doing so with the risk that he would be investing in the creation of infringing goods depending on who actually uses the trade-mark first.

Until President Trump obtains a registered trade-mark, the only recourse that President Trump has regarding use of *Make America Great Again* is under the statutory and common law guise of passing off. An action in passing off protects the goodwill enjoyed by registered and unregistered trade-marks.^[5] Entities outside of Canada are entitled to seek relief via passing off if they have built sufficient reputation and intend to expand their business here.^[6]

President Trump Could Seek to Cancel A Registered Trade-mark

The preferred procedure for an interested party in the position of President Trump is to monitor the progress of the application, and oppose its registration at the appropriate time. However, if President Trump were to miss the deadline for opposing the application, he could still bring proceedings in Federal Court to expunge the mark.^[7] Summary cancellation proceedings can also be initiated against a registration, though no sooner than three years following the date of registration.

Conclusion

While our discussion here has been about the *Make America Great Again* slogan, the circumstances surrounding the United States and Canadian trade-mark filings serve as a useful reminder, even for those of us not running for the Office of the President. Monitoring trade-mark applications, and proactively filing applications, in jurisdictions where your business or clients have a possible interest in operating (or preventing others from operating), can greatly reduce the risk of future headaches and costs arising from third parties who are first to file. We note that President Trump also filed a United States of America application in January 2017 for the trade-mark "KEEP AMERICA GREAT" – an anticipated slogan of his re-election run? Time will tell as to who will be first to file in Canada.

by Adam D.H. Chisholm, Sarah Kilpatrick and Peter Wells

[1] Application Nos. 5020556, 4773272. The validity and status of the United States trade-mark is beyond the

scope of this article.

[2] Application No. 1808563.

[3] At the time of publication of this article.

[4] Subject of course, to Canadian and United States laws about financial relationships with foreign officials or monetary contributions.

[5] *Kirkbi AG v. Ritvik Holdings Inc.*, 2005 SCC 65.

[6] *Orkin Exterminating v. Pestco*, 50 O.R. (2d) 726 (C.A.).

[7] One example of a party failing to oppose an application, but later successfully expunging the trade-mark is *Masterpiece Inc. v. Alavida Lifestyles Inc.*, [2011] 2 S.C.R. 387

A Cautionary Note

The foregoing provides only an overview and does not constitute legal advice. Readers are cautioned against making any decisions based on this material alone. Rather, specific legal advice should be obtained.

© McMillan LLP 2017