

PUBLIC DISPLAY OF ENGLISH-LANGUAGE TRADE-MARKS: QUEBEC COURT OF APPEAL CONFIRMS THE DECISION IN MAGASINS BEST BUY LTÉE V. QUÉBEC (PROCUREUR GÉNÉRAL)

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The Quebec Court of Appeal, in a unanimous decision rendered on May 1, 2015,^[1] confirmed the first instance ruling (see [our analysis in April 2014](#)) with respect to the public display of trade-marks registered only in English, without being required to add thereto a generic term in French.^[2] The facts in this case are spread out over the course of many years. A number of retailers owning trade-marks registered in English only (Costco, Best Buy, Guess, Old Navy, Toys 'R' Us, etc., the "Retailers") have a long-standing practice of publicly displaying these trade-marks in Quebec for business signage purposes, pursuant to an exception to the requirement under the *Charter of the French Language* ^[3] (the "Charter") that public signs, posters and commercial advertising be made in French. Subsection 25(4) of the *Regulation respecting the language of commerce and business* ^[4] (the "Regulation") provides that "On public signs and posters and in commercial advertising, the following may appear exclusively in a language other than French: a recognized trade-mark within the meaning of the *Trade Marks Act*, unless a French version has been registered".

Following the steps taken by the *Office québécois de la langue française* (Quebec's Language Bureau, hereinafter the "OQLF") in order to compel businesses using English-language trade-marks to 'francize' their business signage and advertizing, the Retailers filed a motion for declaratory judgment in order to clarify the authorized derogations from the Charter, including subsection 25(4) of the Regulation. The OQLF argued, both in first instance and in appeal, that the public display of a trade-mark could be equated with the display of a business name, which, pursuant to the legislation applicable to business names, required it to be used with a generic term in the French language, in accordance with section 63 of the Charter.

The Court of Appeal dismissed this interpretation, confirmed the trial judge's reasoning, and held that none of the trade-marks in question were the "name of an enterprise" within the meaning of sections 63 and 67 of the Charter, of articles 305 and 306 of the Civil Code of Quebec or of *An Act Respecting the Legal Publicity of Enterprises*. ^[5] The Court of Appeal therefore determined that the Retailers' practices were in compliance with the Charter and the Regulation, which allow the public display of a trade-mark registered only in English, without being required to add thereto a generic term or any other descriptive element in French. The Court

also added that subsection 25(4) does not require the owner of multiple trade-marks, one of which is registered in French, to use one trade-mark rather than the other. Furthermore, this provision does not place any limitation on the nature of the display, and therefore includes all types of signage, including signs affixed on storefronts.

by Elisa Henry and Christian Abouchaker, Student-at-Law

¹ *Magasins Best Buy Itée v. Québec (Procureur général)*, 2015 QCCA 747.[ps2id id='1' target='']

² *Magasins Best Buy Itée v. Québec (Procureur général)*, 2014 QCCS 1427.[ps2id id='2' target='']

³ CQLR, c. C-11.[ps2id id='3' target='']

⁴ CQLR, c. C-11, r. 9.[ps2id id='4' target='']

⁵ CQLR, c. P-44.1.[ps2id id='5' target='']

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.

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