MADRID PROTOCOL

Total Provisional Refusal of Protection

(Rule 17(1) of the Regulations under the Protocol)

I. Name of the Office:

Canadian Intellectual Property Office

II. International registration number:

1637675

III. Name of the holder:

Iron Mountain Incorporated

IV. Information concerning the type of provisional refusal:

Total provisional refusal based on an ex officio examination.

V. Information concerning the scope of the provisional refusal:

The provisional refusal affects all the goods and services.

VI. Grounds for refusal (where applicable, see item VII):

This examiner's report concerns the above identified Protocol application. To avoid abandonment proceedings, a proper response must be received by this office by November 3, 2023. All correspondence respecting this Protocol application must indicate the file number.

This Protocol application has been examined under the provisions of the Trademarks Act and Trademarks Regulations.

The trademark is considered to be primarily merely the surname of an individual who is living or has died within the preceding thirty years, and therefore unregistrable pursuant to paragraph 12(1)(a) of the Trademarks Act.

In Jurak Holdings Ltd v. Matol Biotech Laboratories Ltd (2007), 64 CPR (4th) 195 (T.M.O.B.), affd 69 CPR (4th) 321 (F.C.), Member Carrière summarized the test for paragraph 12(1)(a) as follows:

The leading cases on the issue of non-registrability of a trade-mark consisting of primarily merely the name or surname of an individual who is living or has died in the preceding thirty years are Canada (Registrar of Trade-marks) v. Coles Book Stores Ltd. (1972), 4 C.P.R. (2d) 1 (S.C.C.), Gerhard Horn Investments Ltd. v. Registrar of Trade-marks (1983), 73 C.P.R. (2d) 23 (F.C.T.D.), and Standard Oil Co. v. Canada (Registrar

of Trade Marks) (1968), 55 C.P.R. 49. As set out in those cases the test under s. 12(1)(a) is two-fold:

1. The first and foremost condition is whether the mark is the name or surname of a living individual or an individual who has recently died;
2. If the answer to the first question is affirmative, then the Registrar must determine if in the mind of the average Canadian consumer the mark is "primarily merely" a name or surname rather than something else.

The first part of the test is to determine whether the trademark is the surname of an individual who is living or has died within the preceding thirty years. In the present case, this trademark meets this first arm of the test, as research shows that CROZIER appears over 350 times in the online directory Canada 411 (www.canada411.ca).

The second part of the test is to determine the likely response to the trademark by the average Canadian consumer. If a person in Canada of ordinary intelligence and of ordinary education in English and/or French would be more likely to respond to the trademark by thinking of it as a surname, then it is primarily merely a surname. On the other hand, if a person would be just as likely, if not more likely, to respond to the trademark as something other than a surname, then the trademark cannot be considered primarily merely a surname.

In the present case, the surname significance overwhelms any other meaning that might be attributed to the trademark. Consequently, the average Canadian would be more likely to respond to the trademark as being a surname rather than something else.

In addition, pursuant to paragraph 37(1)(d) of the Trademarks Act, it appears that the trademark is not distinctive, in association with all of the applied-for services.

The Registrar’s preliminary view is that the trademark is not inherently distinctive, as trademarks which do not appear registrable pursuant to paragraph 12(1)(a) of the Trademarks Act are considered not inherently distinctive. In particular, the trademark “CROZIER” does not distinguish the applicant’s services from those of other traders in the marketplace as it is primarily merely the surname of a living individual or an individual who has died within the preceding thirty years, as CROZIER is found more than 350 times in the online directory Canada 411 (www.canada411.ca). Therefore, it is considered that other traders should be able, in the ordinary course of their businesses, to use the same trademark in association with the same or similar services.

Pursuant to paragraph 32(1)(b) of the Act, the applicant may wish to furnish the Registrar with evidence establishing that the trademark was distinctive at the filing date of the application for its registration. Alternatively, the applicant may wish to provide, in writing, information which would persuade the Registrar to withdraw the objection that the trademark is not, on a preliminary view, inherently distinctive.

The applicant’s written comments with respect to this matter are invited.

Pursuant to paragraph 30(2)(a) of the Trademarks Act, an application for the registration of a trademark must contain a statement in ordinary commercial terms of the associated goods and services. Furthermore, section 29 of the Trademarks Regulations requires that the statement must describe each of those goods or services in a manner that identifies a specific good or service. It is considered that the following are not in specific and ordinary commercial terms:

1) Transportation, [...]; (Class 39)

For further guidance on redefining the statements of goods or services, please refer to the Goods and Services Manual available on our website. This searchable tool is not an exhaustive list of acceptable terms, but it may be used as a guide to the specificity and ordinary commercial term requirements of the Trademarks Act and its Regulations.

The applicant is required to file an amended Protocol application, using the e-service on the CIPO website at www.cipo.ic.gc.ca, by fax at 819-953-2476 or by mail at the following address:

Registrar of Trademarks
Place du Portage I
50 Victoria Street, room C-114
Gatineau, QC K1A 0C9

If the applicant has any specific questions in respect of this Office action, please contact the assigned examiner. Please note that for general inquiries, including assistance with filing of the revised Protocol application, queries about the status of an application or receipt of correspondence, you may contact our Client Service Centre toll free at 1-866-997-1936.

Yours truly,

Mazen Al Homsi
Examination Section
819-665-4072
fax: 819-953-2476

VII. Information relating to an earlier mark:

(i) Filing date and number, and, if any, priority date:

Not applicable

(ii) Registration date and number (if available):

Not applicable

(iii) Name and address of the owner:

Not applicable

(iv) Reproduction of the mark:

Not applicable

(v) List of the relevant goods and services (this list may be in the language of the earlier application or registration):

Not applicable

VIII. Provisions of the applicable law:

Paragraph 12(1)(a) of the *Trademarks Act*

Paragraph 30(2)(a) of the *Trademarks Act*

Paragraph 32(1)(b) of the *Trademarks Act*

Paragraph 37(1)(d) of the *Trademarks Act*

Section 29 of the *Trademarks Regulations*

IX. Information relating to the possibility to request a review or file an appeal or otherwise respond to the opposition:

(i) Time limit to request a review or file an appeal or otherwise respond to the opposition:

2023-11-03

(ii) Calculation of time limit (the time limit runs from):

2023-05-03

(iii) Authority to which such request for review, appeal or response should be made:

Registrar of Trademarks

(iv) Whether the request for review, appeal or response has to be filed in a specific language or through a local representative:

Correspondence must be in French or English

(v) Other requirements, if any:

Not applicable

X. Date and signature of the Office:

Registrar of Trademarks

3 mai/May 2023
Votre référence Your File

Notre référence Our File
2158190
Numéro EI IR Number
1637675

MOFFAT & CO.
P.O. Box 2088, Station D
Ottawa
ONTARIO K1P 5W3
Attention: James R. Palmer

RE: Trademark: CROZIER
Applicant: Iron Mountain Incorporated

This examiner's report concerns the above identified Protocol application. To avoid abandonment proceedings, a proper response must be received by this office by November 3, 2023. All correspondence respecting this Protocol application must indicate the file number.

This Protocol application has been examined under the provisions of the *Trademarks Act* and *Trademarks Regulations*.

The trademark is considered to be primarily merely the surname of an individual who is living or has died within the preceding thirty years, and therefore unregistrable pursuant to paragraph 12(1)(a) of the *Trademarks Act*.

In *Jurak Holdings Ltd* v. *Matol Biotech Laboratories Ltd* (2007), 64 CPR (4th) 195 (T.M.O.B.), affd 69 CPR (4th) 321 (F.C.), Member Carrière summarized the test for paragraph 12(1)(a) as follows:

The leading cases on the issue of non-registrability of a trade-mark consisting of primarily merely the name or surname of an individual who is living or has died in the preceding thirty years are *Canada (Registrar of Trade-marks)* v. *Coles Book Stores Ltd.* (1972), 4 C.P.R. (2d) 1 (S.C.C.), *Gerhard Horn Investments Ltd.* v. *Registrar of Trade-marks* (1983), 73 C.P.R. (2d) 23 (F.C.T.D.), and *Standard Oil Co.* v. *Canada (Registrar of Trade Marks)* (1968), 55 C.P.R. 49. As set out in those cases the test under s. 12(1)(a) is two-fold:

1. The first and foremost condition is whether the mark is the name or surname of a living individual or an individual who has recently died;

2. If the answer to the first question is affirmative, then the Registrar must determine if in the mind of the average Canadian consumer the mark is "primarily merely" a name or surname rather than something else.

The first part of the test is to determine whether the trademark is the surname of an individual who is living or has died within the preceding thirty years. In the present case, this trademark meets this first arm of the test, as research shows that CROZIER appears over 350 times in the online directory Canada 411 (www.canada411.ca).

The second part of the test is to determine the likely response to the trademark by the average Canadian consumer. If a person in Canada of ordinary intelligence and of ordinary education in English and/or French would be more likely to respond to the trademark by thinking of it as a surname, then it is primarily merely a surname. On the other hand, if a person would be just as likely, if not more likely, to respond to the trademark as something other than a surname, then the trademark cannot be considered primarily merely a surname.

In the present case, the surname significance overwhelms any other meaning that might be attributed to the trademark. Consequently, the average Canadian would be more likely to respond to the trademark as being a surname rather than something else.

In addition, pursuant to paragraph 37(1)(d) of the *Trademarks Act*, it appears that the trademark is not distinctive, in association with all of the applied-for services.

The Registrar's preliminary view is that the trademark is not inherently distinctive, as trademarks which do not appear registrable pursuant to paragraph 12(1)(a) of the *Trademarks Act* are considered not inherently distinctive. In particular, the trademark "CROZIER" does not distinguish the applicant's services from those of other traders in the marketplace as it is primarily merely the surname of a living individual or an individual who has died within the preceding thirty years, as CROZIER is found more than 350 times in the online directory Canada 411 (www.canada411.ca). Therefore, it is considered that other traders should be able, in the ordinary course of their businesses, to use the same trademark in association with the same or similar services.

Pursuant to paragraph 32(1)(b) of the *Act*, the applicant may wish to furnish the Registrar with evidence establishing that the trademark was distinctive at the filing date of the application for its registration. Alternatively, the applicant may wish to provide, in writing, information which would persuade the Registrar to withdraw the objection that the trademark is not, on a preliminary view, inherently distinctive.

The applicant's written comments with respect to this matter are invited.

Pursuant to paragraph 30(2)(a) of the *Trademarks Act*, an application for the registration of a trademark must contain a statement in ordinary commercial terms of the associated goods and services. Furthermore, section 29 of the *Trademarks Regulations* requires that the statement must describe each of those goods or services in a manner that identifies a specific good or service. It is considered that the following are not in specific and ordinary commercial terms:

1) Transportation, [...]; (Class 39)

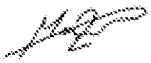
For further guidance on redefining the statements of goods or services, please refer to the *Goods and Services Manual* available on our website. This searchable tool is not an exhaustive list of acceptable terms, but it may be used as a guide to the specificity and ordinary commercial term requirements of the *Trademarks Act* and its *Regulations*.

The applicant is required to file an amended Protocol application, using the e-service on the CIPO website at www.cipo.ic.gc.ca, by fax at 819-953-2476 or by mail at the following address:

Registrar of Trademarks
Place du Portage I
50 Victoria Street, room C-114
Gatineau, QC K1A 0C9

If the applicant has any specific questions in respect of this Office action, please contact the assigned examiner. Please note that for general inquiries, including assistance with filing of the revised Protocol application, queries about the status of an application or receipt of correspondence, you may contact our Client Service Centre toll free at 1-866-997-1936.

Yours truly,



Mazen Al Homsi
Examination Section
819-665-4072
fax: 819-953-2476