

CANADIAN TRADE-MARK ACT ANNOTATED

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PREFACE¹

The Editors are pleased to introduce this new loose-leaf annotated *Trade-marks Act*.² While practitioners in other areas of Canadian law have for many years had available to them loose-leaf services which keep lawyers up-to-date on the latest judicial, administrative and legislative developments, practitioners in the domain of trade marks law have had to resort to their own means and ingenuity to stay abreast of constant developments in their field. It is hoped that this new annotated *Trade-marks Act* with its semi-annual revisions³ will succeed in filling this gap.

The Editors have taken a practical approach to the topic, intending this loose-leaf service to differ from and supplement the more academic works presently on the market. The *Canadian Trade-marks Act Annotated*, as well as having a comprehensive table of cases and topical index is divided into four major parts:

Trade-marks Act and annotations.
Unfair Competition Act.

* CIPS 1984-2004.

All of the Lawfirm LEGER ROBIC RICHARD, g.p. and of the patent & Trademark Agency firm ROBIC, g.p.. Publication 1.

¹ To the 1983 initial edition as a complete edition was made in 1991.

² Now with over 1650 pages.

³ Since 1992, they were three releases a year.

Trade Marks Regulations.
Convention of the Union of Paris.

The first major division is subdivided into nine headings:

§1.0 Related Sections

§2.0 Related Regulations

These two headings contain, respectively, a list of the related sections in the Act and of the related rules in the regulations.

§3.0 Corresponding Sections in the Unfair Competition Act

Here, the Editors have tried to link the section under study to one or more sections of the *Unfair Competition Act* in order that the reader may refer to the corresponding case law under the *Unfair Competition Act*, and generally so that the reader may be aware of the origins of the section.

§4.0 Purpose

Here, the Editors have attempted to condense the "pith and substance" of the section under analysis.

§5.0 Commentary

Under this heading the Editors have inserted a commentary on the law as it stands, occasionally contributing their own thoughts on the interpretation of a given section - such personal thoughts being found under the subheading "Editorial Comment".

§6.0 Case Law

Under this heading, the reader will find summaries or extracts of leading cases relating to the section under study. The number of summaries or extracts vary depending on the importance of the section and the number of cases reported. The reader will discover that under certain sections, there are no summaries or extracts to be found. This is usually because the reported cases relating to such sections were based on findings of fact, and are therefore of no great interest. Altogether, approximately 400 summaries⁴ or extracts are

⁴Now over 600.

set out in this volume. Under this heading the numbering of the sections of the *Trade-marks Act* has remained the same as provided for in R.S.C. 1970, c. T-10⁵.

§7.0 List of Cases

Under this heading, the Editors have listed additional court cases and some of the Trade Marks Office decisions relating to the section under study. The list of cases provides the practitioner with an unprecedented index of over 2,000 cases⁶ arranged according to the sections of the Act.

§8.0 Administrative Policies

Where Consumer and Corporate Affairs Canada has with respect to given sections of the Act, published "Practice Notices" in the *Trade Marks Journal*, or given "Directives" to its examiners in the *Trade Marks Examination Manual*, the Editors have reproduced them in this volume. It should be noted that not all existing practice notices and directives have been reproduced. The Editors chose to reproduce only those notices or directives which are of direct interest to the practitioner. Please also note that sectional references under this heading are pursuant to R.S.C. 1970, c. T-10⁷.

Extracts from the *Trade Marks Examination Manual* have been reproduced with the permission of the Minister of Consumer and Corporate Affairs Canada. All or part of the following publications have been reproduced with the permission of the Minister of Supply and Services Canada: the *Trade Marks Act*, 1952-53, c. 49, s. 1 as amended, the *Trade Marks Regulations*, the *Unfair Competition Act* of 1932 as amended, the *Trade Marks Journal*, the judgments of the Supreme Court of Canada and the judgments of the Federal Court of Canada.

The Editors wish to thank both Departments for their courtesy in having granted the right to reproduce in whole or in part the above publications of the Government of Canada.

Throughout the work the masculine pronoun and adjective have been used for consistency in style only and should be interpreted to include the feminine.

⁵ Now with a correspondence to the R.S.C. 1985, c. T-13.

⁶ Now over 2500 cases cited.

⁷ Now with a correspondence to the R.S.C. 1985, c. T-13.

Hugues G. Richard
Editor-in-Chief

**A WORD FROM THE PUBLISHER
CARSWELL**

The respected authority in trade-marks research...

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Editor-in-Chief: Hugues G. Richard

"I am confident that any practitioner who reads these pages will owe a debt of gratitude to the authors who have made so comprehensive and practical a compilation of information on the subject of trade-mark law and practice."

The Honourable Mr. Justice Cattanach,
Federal Court of Canada
(from the Foreword)

Look no further than this authoritative reference work for trade-mark practitioners. Each provision of the *Trade-Marks Act* has been annotated with: the purpose of the section ... editorial commentary ... exhaustive case references and excerpts ... administrative policies, including practice notices in the *Trade-Marks Journal* and extracts from the Trade-marks Examination Manual. You'll also find the answers to your questions regarding:

- . The constitutionality of the s. 7 prohibitions against unfair business practices
- . Your options at each step in proceedings under s. 38 (opposition) or s. 45 (evidence of use of mark)
- . What marks have been held to be confusing

- . When a name, surname or the place of origin cannot be registered as a trade-mark
- . What constitutes an "interested person" under the Act
- . The status of foreign marks sold in Canada through distributors with no direct sales made by the owner

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