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FAMOUS TRADE-MARKS IN CANADA: SUMMARY OF THE PRINCIPLES

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I. DEFINITION: TRADE-MARK

- Ref. s. 2 *Trade-Marks Act*, R.S.C. 1985 c. T-13 (hereinafter “TMA”):

“trade-mark” means

(a) a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others,

(b) a certification mark,

(c) a distinguishing guise, or

(d) a proposed trade-mark;

- A trade-mark can be a word, a design, a symbol, a mode of wrapping or packaging, the configuration of an object or any other type of indicia, or combination of indicia, that serves to distinguish the wares and services of one person from those of other persons;
- The definition of a trade-mark applies whether the mark is one that is registered, or if it is a *common law* trade-mark, i.e. an unregistered trade-mark;
- In order to distinguish, a trade-mark must not be confusing with another trade-mark of trade-name;
- Ref. s. 2 TMA:

“distinctive”

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in relation to a trade-mark, means a trade-mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is adapted so to distinguish them;

II. DEFINITION: CONFUSION

- Ref. s. 6(2) and 6(5) TMA:

(2) The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[...]

(5) In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

- (a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;*
- (b) the length of time the trade-marks or trade-names have been in use;*
- (c) the nature of the wares, services or business;*
- (d) the nature of the trade; and*
- (e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.*

III. DEFINITION: USE

- Ref: s. 4 TMA

(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[...]

- In Canada, use of a trade-mark is constitutive of rights. Registration simply confirms the existence of such rights;

IV. DEFINITION: FAMOUS TRADE-MARKS

- There is no definition of a “famous” trade-mark under the Canadian trade-marks scheme;
- Generally, a “famous” trade-mark is one that transcends the goods and services with which it is normally associated; it may even permeate other related or even unrelated areas of trade;

V. PROVING FAME

- Evidence is usually made in the course of opposition proceedings, or judicial proceedings for infringement, depreciation of goodwill, passing-off and for judicial expungement of a registered trade-mark registration;
- Evidence of fame should be made in each case;
- The burden of proof rests on shoulders of party alleging the “fame of its trade-mark”
- Generally, the Courts and the Registrar of Trade-Marks will look for any evidence that tends to show the degree of recognition of the trade-mark in one or more areas of trade, or that tends to show the extent to which the trade-mark permeates areas of trade to which it is not normally associated;

VI. CASE LAW PRIOR TO 2006

- The Pink Panther case was considered as the “reference” for all famous trade-mark cases from 1998 until 2006...

- *Pink Panther Beauty Corp. v. United Artist Corp.*, [1998] 3 F.C. 534 (F.C.A.)
- *Toyota Jidosha Kabushiki Kaisha v. Lexus Foods Inc.*, [2001] 2 F.C. 15 (F.C.A.)

VII. CASE LAW SINCE 2006

- In 2006, the Supreme Court of Canada heard two famous trade-marks cases:
 - *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée*, [2006] 1 S.C.R. 824 (S.C.C.)
 - *Mattel Inc. v. 3894207 Canada Inc.*, [2006] 1 S.C.R. 22 (S.C.C.)
- The principles of *Veuve Clicquot* and *Mattel* have since been followed:
 - *Remo Imports Ltd v. Jaguar Cars Limited*, 2007 FCA 258 (F.C.A.)

VIII. SUMMARY OF PRINCIPLES

- There is no best/ideal way to prove fame: it is a conclusion of fact based on the evidence presented by the party claiming it;
- There is no “one size fits all” test to determine the degree of notoriety/fame of a trade-mark;
- Proof of the degree of notoriety has now become more important than evidence of “fame” itself;
- The level of notoriety will determine the scope of protection afforded to a famous trade-mark;
- Evidence of notoriety must be made in every case that it is asserted: a successful claim of notoriety cannot serve as a precedent for future cases;

IX. CONCLUSION

- Evidence of fame is not a guarantee that opposition or infringement proceedings will be successful: fame is but one criterion amongst others.

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