

SEXUAL PURSUIT GAME INFRINGED TRIVIAL PURSUIT TRADE-MARK, FEDERAL COURT FINDS

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A recent decision handed down by the Trial Division of the Federal Court of Canada concluded that the manufacturer of a game called SEXUAL PURSUIT infringed the well-known trade-mark TRIVIAL PURSUIT by directing public attention to the SEXUAL PURSUIT game, in a way that would likely create confusion between both sets of games. (*Horn Abbot Ltd. et al -vs- Brian Thurston et al*, T-32-85, September 25, 1997, Reed, J.). This decision is interesting in that it deals with a trader riding on the coattails of another in order to benefit from the latter's reputation.

The original idea for the game TRIVIAL PURSUIT resulted from the ingenuity of four individuals who incorporated Horn Abbot Ltd. in 1980. After a test marketing of the game in 1981, sales started in 1982 and, by 1984 it could be said that the game had become a phenomenal success, millions of copies having been sold in Canada and in the U.S. This noteworthy story in the mid-1980's was covered by such magazines as MacLean's, Time, Readers Digest and the Toronto Star.

In early 1984, Brian Thurston along with Tom Hayes, having played TRIVIAL PURSUIT, thought up a similar game they called SEXUAL PURSUIT, whose content included questions and answers relating to issues of a sexual nature. In order to market the SEXUAL PURSUIT game, original artwork was created for the board game; an hexagonal pattern on the board was used as opposed to the round one in TRIVIAL PURSUIT; in lieu of the "roll-again" spaces found on the TRIVIAL PURSUIT boards, Thurston devised a category of questions he called E-zone or erogenous zone questions (for which there were no correct answers printed on cards that accompanied the game). Similarities however existed: Thurston used an identical number of spaces on each of the six spokes that connected the centre of the board to the corners of the hexagon (like the spokes on the TRIVIAL PURSUIT board). Finally, the trade-mark SEXUAL PURSUIT was used on the box in which the game was packaged, in a place

similar to where the TRIVIAL PURSUIT name was found on the plaintiff's box. Finally, the boxes were both almost identical in shape and size.

Defendant Thurston started distributing his SEXUAL PURSUIT game in late 1984 and Horn Abbot Ltd. initiated its action on January 4, 1985. An interlocutory injunction was granted against Thurston on February 6, 1985, restraining him along with co-defendant Hayes from manufacturing, distributing or selling a game in association with the trade-mark SEXUAL PURSUIT until final resolution of the action at trial. In its action, Horn Abbot Ltd. requested a permanent injunction restraining defendants from manufacturing, distributing or selling games in association with the trade-mark SEXUAL PURSUIT, or in association with any other trade-mark confusing with Horn Abbot's registered TRIVIAL PURSUIT trade-mark, an order allowing for the destruction of all copies of the SEXUAL PURSUIT game, an award of damages and costs of the action.

In her decision, Madam Justice Reed indicated that she did not believe that defendant Thurston intended to infringe plaintiff's IP rights but that he was obviously aware that what he had designed was a board game packaged and presented in a fashion similar to the TRIVIAL PURSUIT game; he just hoped that the two games were sufficiently different so that he would not be the subject of a successful infringement action. However, Madam Justice Reed reminded the parties that the similarities between the games was not the issue in the action but rather the use of the trade-mark SEXUAL PURSUIT. The similarities (or dissimilarities) between the games could only be seen in the context of the use of the trade-mark SEXUAL PURSUIT.

The plaintiff's trade-mark TRIVIAL PURSUIT was registered and used for a board game and equipment therefore. Was there confusion between the trade-marks TRIVIAL PURSUIT and SEXUAL PURSUIT? Madam Justice Reed found that both trade-marks in association with a board game were inherently distinctive. However, the trade-mark TRIVIAL PURSUIT had become well-known when the defendant started selling his SEXUAL PURSUIT game. Due to the interlocutory injunction which was granted in early 1985, the game SEXUAL PURSUIT never achieved any kind of notoriety. As for the degree of resemblance between the trade-marks, Madam Justice Reed observed that the two marks both consisted of two words, the second of which were identical while the first both ended with the letters "AL".

Horn Abbot Ltd. relied on sub-section 7(b) of Canada's *Trade-Marks Act* (R.S.C. 1985, c. T-13) in order to obtain a finding of infringement. Sub-section 7(b) was described in *Asbjorn Horgard A/S v. Gibbs/Nortac Industries Ltd.* (1987), 14 C.P.R. (3d) 314 by the Federal Court of Appeal as "a statutory statement of the common law action of passing-off, which consisted of a misrepresentation to the effect that one's goods or services are someone else's or sponsored by or

associated with that other person. It is effectively a "piggy backing" by misrepresentation."

Madam Justice Reed concluded that the evidence before her supported a finding that the use of the name SEXUAL PURSUIT did raise an association with the plaintiff's TRIVIAL PURSUIT game, an association that would lead a person to think that the two games came from the same source. Consequently, the court found that the defendant had infringed the plaintiff's trade-mark and directed public attention to its game in a way that would likely create confusion between both parties' games; defendant's trade-mark and get-up was used to ride on the goodwill and commercial success enjoyed by TRIVIAL PURSUIT.

In his defence, Thurston argued that plaintiff's game was not all that original as it had borrowed elements; the court dismissed this line of reasoning stating that the originality of the game per say was not an issue in this trade-mark case. Thurston further argued that the trade-mark TRIVIAL PURSUIT was descriptive and therefore not a valid trade-mark; here again, the court rejected this defence stating that because the game is a trivia game does not make the trade-mark TRIVIAL PURSUIT descriptive of a game inasmuch as that expression was never used to describe a game. Finally, defendant argued that there was no confusion between the trade-marks TRIVIAL PURSUIT and SEXUAL PURSUIT; here too, the court dismissed this argument stating that the games, per say, were not confusing but rather confusion was created when consumers thought that both games had the same origin and same source.

Madam Justice Reed consequently granted a permanent injunction in favour of the plaintiff but concluded that there was insufficient evidence to support a finding for damages since the defendant's game was on the market for a very short period of time. An order was also issued permitting the destruction of all the remaining copies of the SEXUAL PURSUIT game.

This recent decision is the latest illustration of the dangers for any trader who wishes to "piggy-back" on someone else's reputation. When such situation occurs, it is not sufficient for a defendant to show that the parties' wares are not confusing but he must rather establish that consumers will not conclude that both originate from a single source because of the trade-marks at issue.

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