



QUEBEC SUPERIOR COURT RULES AGAINST POLITICAL PARTY IN *L'ARTISAN* PASSING OFF CASE

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Those engaged in the political process should not adopt trade-marks or trade-names that create confusion in order to get their message across to voters on the eve of an election. This was the message delivered recently by the Superior Court of Quebec in a passing off case that did not involve competing commercial interests (*Médias Transcontinental S.E.N.C. v. Carignan and Parti des contribuables de Repentigny*, 2009 QCCS 2848 (Q.S.C., Payette, J., June 23, 2009)). This case comment will identify the trade-mark issues raised by this decision.

Médias Transcontinental S.E.N.C. (hereafter: "Transcontinental") publishes various French weekly newspapers across the Province of Quebec. Two of these weeklies are distributed free of charge to readers in the city of Repentigny, a suburb outside of Montreal. One is called *L'Artisan* and is distributed on Wednesdays while a second, named *L'Hebdo Rive-Nord*, is distributed on weekends. On September 21, 2005, prior to municipal elections that were to be held on November 6, 2005 in Repentigny, the director of information of the *L'Artisan* newspaper, Mr. Sylvain Poisson, advised readers in an editorial that its coverage of the upcoming campaign would be balanced and objective.

As of mid-September 2005, the incumbent administration of Repentigny Mayor Chantal Deschamps appeared to be coasting unopposed to an easy re-election victory. At about the same time, a resident of Repentigny, Mr. Michel Carignan, decided to challenge Mayor Deschamps and founded the *Parti des contribuables de Repentigny* (or the "Repentigny Tax Payers' Party"). As Mr. Carignan and his party were late comers in the electoral process and only received, in their view, minimum media coverage, they decided to convey their message to voters and published, on November 2, 2005, a campaign document which took the form of a newspaper called "*L'Partisan*" similar in presentation to the *L'Artisan* newspaper belonging to Transcontinental.

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The *L'Partisan* newspaper published by Carignan and his party contained partisan criticism of the Deschamps administration. In all, 20,000 copies of the paper were handed out to voters in Repentigny a few days prior to the election. However, many voters appeared to believe that Mr. Carignan's *L'Partisan* newspaper originated from the same source as the *L'Artisan* newspaper published by Transcontinental; these voters were outraged by its apparent partisanship, coming after its promise to strike a balanced tone in its coverage of the campaign.

Transcontinental was quickly made aware that some of the characteristics of the *L'Partisan* document - containing Mr. Carignan's political rhetoric - was apparently similar to the distinctive aspects of the *L'Artisan* newspaper. In Transcontinental's view, the *L'Partisan* newspaper had a similar layout to its own *L'Artisan* newspaper and also used a confusingly similar name. On Saturday, November 5, 2005, on the eve of the vote, Transcontinental published in its *L'Hebdo Rive-Nord* newspaper a front page notice informing its readers that it had nothing to do with the *L'Partisan* paper published a few days earlier.

On December 21, 2005, Transcontinental decided to sue Mr. Carignan and his party for damages because of the confusion created with voters a few days prior to a highly contested election.

In its suit against Mr. Carignan and his party, Transcontinental alleged that the defendants passed off their *L'Partisan* newspaper as *L'Artisan* newspaper in order to benefit from the latter's reputation among voters in Repentigny. In order to succeed in its claim for passing off, Transcontinental had to establish that its *L'Artisan* newspaper had goodwill that deserved protection and that this goodwill resulted from the use of a distinctive characteristic, in this case the name *L'Artisan*. It also had to establish that the public was confused to believe that *L'Partisan* actually originated from Transcontinental and that, because of this, it likely suffered damages.

In considering the Plaintiff's claim, the Court referred to the Supreme Court of Canada decision in *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée*, [2006] 1 S.C.R. 824, at paragraph 20, to describe the relevant test under the circumstances. The test to be applied is one of first impression in the mind of a casual consumer somewhat in a hurry who sees the name *L'Partisan* on the Defendant's newspaper, at a time when he or she has no more than an imperfect recollection of the *L'Artisan* newspaper, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the names.

Having considered the evidence, the Court concluded that the Plaintiff established its case for passing off. The Court concluded that Transcontinental had goodwill in the name *L'Artisan* resulting from its use for more than forty years in Repentigny. By 2005, more than 50,000 copies were distributed weekly. As for confusion, the Court concluded that there was a high degree of resemblance between the layout of the

L'Artisan newspaper and the *L'Partisan* newspaper. Moreover, there was evidence that, in fact, voters had been confused.

As for damages – that were difficult to establish in this case - the Court concluded that the Defendants chose to ride on the coattails of a newspaper that prided itself in its objective political coverage in order to launch its own partisan attack against the incumbent municipal administration. The Court concluded that damages were established but considered that the *L'Partisan* newspaper was only distributed once, and not for profit; under the circumstances, it granted Transcontinental an indemnity of \$15,000.00. Exemplary damages in the amount of \$7,500 were also awarded in order to discourage such behaviour for the future.

Mr. Carignan's unsuccessful attempt to unseat Mayor Deschamps carries a valuable lesson for all aspiring politicians: the use of confusingly similar marks should not be part of the message on the campaign trail.

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