



SURVEY EVIDENCE SHOWS THAT THE WORD NORDIQUES BRINGS TO MIND THE *NORDIQUES* HOCKEY TEAM

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***Accessoires d'Autos Nordiques Inc. v. Canadian Tire Corp.*, 2007 FCA 367 (Federal Court of Appeal, Richard C.J.)**

This is an appeal of a decision rendered by Justice Blais of the Federal Court allowing an appeal by the Respondent, Canadian Tire Corporation (hereinafter “Canadian Tire” or the “Respondent”), under section 56 of the *Trade-marks Act* (hereinafter the “Act”).

1. The Registrar’s decision

Canadian Tire filed an application, based on proposed use, to register the trade-mark NORDIC & Snowflake Design (hereinafter the trade-mark “NORDIC”) for use in association with tires. *Accessoires d'Autos Nordiques Inc.* (hereinafter “*Accessoires d'Autos*” or the “Applicant”) opposed Canadian Tire’s application, alleging a likelihood of confusion with, amongst others, its previously registered and used trade-mark NORDIQUES in association with automobile parts and accessories.

Accessoires d'Autos was successful before the Registrar as it was found that: (a) Canadian Tire did not prove, on a balance of probabilities, that there is no likelihood of confusion between the two trade-marks when used in association with automobile parts and accessories; (b) both trade-marks have a commonality of ideas because both suggest that the wares are meant to be used during winter; (c) they are phonetically identical to a monolingual French speaking person; (d) there is overlap between some of the wares covered by the NORDIQUES’ certificate of registration and the wares listed in the NORDIC application; (e) the nature of both parties’ business is similar; and (f) the NORDIC trade-mark is not distinctive within the meaning of section 2 of the Act.

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It is worth noting that the Registrar refused to accept Canadian Tire's argument that the trade-mark NORDIC evoked the name of the defunct NHL hockey team, Quebec *Nordiques*, and not the Applicant's trade-mark NORDIQUES because Canadian Tire failed to file evidence supporting such a conclusion.

2. The Federal Court's decision

Canadian Tire appealed the Registrar's decision to the Federal Court and filed additional evidence establishing that in the Quebec area, where the Applicant's enterprise is located, the trade-mark NORDIQUES evokes images of the hockey team and not the Applicant's trade-mark.

In his review of the likelihood of confusion between the marks at issue, Justice Blais mainly agreed with the conclusions of the Registrar, but not on the criteria of subsection 6(5)(e) of the Act as he determined that the trade-marks were very different in appearance, evoked different ideas and that there had been no instance of confusion. Based on that reasoning, the Registrar's decision, found to be incorrect, was set aside.

3. The Federal Court of Appeal's decision

The Federal Court of Appeal found that Justice Blais conducted the appropriate analysis of the issue in reviewing the Registrar's finding on a standard of correctness. On the issue of the standard of review, the Federal Court of Appeal went by the principles of the decision *Molson Breweries v. John Labatt Ltd.*, [2000] 3 F.C. 145 and wrote that:

"When no additional evidence is introduced before the Federal Court, the standard of review applicable to the Registrar's decisions of fact, law or discretion is reasonableness. When such evidence is introduced, however, the standard of review is different as noted by Justice Rothstein:

However, where additional evidence is adduced in the Trial Division that would have materially affected the Registrar's findings of fact or the exercise of his discretion, the Trial Division must come to his or her own conclusion as to the correctness of the Registrar's decision (*Molson Breweries*, para. 51)."¹

The additional evidence filed by Canadian Tire shed new light on the analysis of the elements of subsection 6(5)(e) of the Act pertaining to the degree of resemblance

¹ *Accessoires d'Autos Nordiques Inc. v. Canadian Tire Corp.*, 2007 FCA 367, at paragraph 29.

between the marks at issue, and led the judge to conclude that the Registrar's application of subsection 6(5)(e) of the Act was incorrect. As the Federal Court did not commit any reviewable error, the appeal was dismissed.

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