



A TALE OF TWO “SALAMS” IN TORONTO

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SUMMARY: The Federal Court of Ontario recently dismissed an action by “Salam Toronto” for trade mark infringement against a company operating under the same trade name. It was held that, despite operating under the same trade name and both parties’ focus on Toronto’s Iranian community, there was no evidence to satisfy the test of confusion: namely that use of the trade name would lead the public to perceive the Iranian weekly newspaper as also an immigration specialist. Thus there was held to be no trademark infringement under sections 7(b), 19, 20, 22 of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

It was the best of times, it was the worst of times for Mr. Taghavi in the matter of *Salam Toronto Publications v. Salam Toronto Inc.*, 2009 FC 24. He is owner of “Salam Toronto Publications”, journalist and publisher of the renowned bilingual English-Farsi newspaper “Salam Toronto”. Mr. Taghavi registered “Salam Toronto Publications” as a business name in 2001, subsequently registering “Salam Toronto” as a trademark in 2004. He went on about his business happily, publishing the weekly newspaper in hardcopy and online, much to the delight of the Iranian community of Toronto.

In 2002, another gentleman, Mr. Naghavi, registered the business name “Salam Toronto”, using it in connection with the provision of immigration and settlement services. Mr. Naghavi is the administrator of “Salam Toronto Inc.”, operating under various other trade names including “Salam Toronto Immigration Services” and “Salam Toronto Immigration and Settlement Services”. He too brought joy to the Iranian residents of Toronto with his immigration advice services.

But this was cause for concern in Mr. Taghavi’s mind. Both men were operating under almost identical trade names (almost identical surnames too); and as they were both prominent members of Toronto’s Iranian community he feared his publication would be confused or otherwise associated with Mr. Naghavi’s immigration and settlement

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services. Thus, as any sensible businessman would do, Mr. Taghavi opted to take legal action against Mr. Naghavi in an attempt to protect his trademark. He alleged the following:

- Infringement of the mark "Salam Toronto" through use of domain names (salamtoronto.net, salamtoronto.ca, salamtoronto.com), email addresses, advertisements and stationary;
- Depreciation of goodwill contrary to sections 19,20 and 22 of the *Trade-marks Act* R.S.C.1985, c. T-13 (the "Act");
- Confusion contrary to section 7(b) of the Act.

The Honourable Madam Justice Simpson passed judgment in January, 2009 which can be surmised as follows:

Use of "Salam Toronto" in domain names, email addresses and adverts clearly fell under the ambit of section 4(2) of the Act, as they give not only substantive information about the services but serve advertising and promotional functions. Display of the mark on stationary on the other hand, did not meet this threshold and was merely considered to contain contact information.

On the question of confusion, Simpson J. followed the principles established in *Mattel Inc. v. 3894207 Canada Inc.*, ([2006] 1 S.C.R 772) and bound herself strictly to the requirement of "whether a probable purchaser of ordinary intelligence, acting with ordinary caution, would be confused". Given that "Salam Toronto" is a weak trademark and not inherently distinctive, Simpson J. deemed some confusion to be unavoidable.

On preponderance of the evidence in light of section 6(4) and 6(5) of the Act, and despite some potential overlap between the current affairs newspaper and immigration and settlement services, she deemed it unlikely for there to be significant confusion: the Plaintiff's mark seemed to have been circulated more widely and his distinctive stature as a publisher and journalist rendered the prospect of being associated with a separate unrelated immigration business too remote. In addition, the newspaper and the immigration services are to be considered completely different products, the former being free or modestly priced and the latter undoubtedly involving relatively significant costs.

On the balance of probabilities, Simpson J. found no evidence to suggest that the Defendant's use of the Mark harmed the Plaintiffs' business or reputation. Further, considering that the Defendant's use of "Salam Toronto" did not lead members of the Iranian community in Toronto to infer that the Plaintiff was both a publisher and an immigration specialist, no breach of section 7(b) of the Act could be found, meaning confusion occurred. Case dismissed!

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