



2014 Year In Review

- Social Scientific Evidence -

Courtesy of

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2014 Year in Review: Social Scientific Evidence

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This publication catalogues references to survey and other social scientific evidence in Canadian intellectual property litigation and expert literature. It excludes matters where social scientific evidence was filed but a decision is still outstanding.

Table of Contents:

Expert Literature on Survey Evidence	4
<i>1. Trademark Surveys: An Undulating Path</i> , Texas Law Review – July 2014	4
<i>2. The Hot-Tub Alternative To Adversarial Expert Evidence</i> , The Advocates Journal – Spring 2014	5
Survey Evidence in Canadian Trademark Cases	6
3. Movenpick-Holding AG v Richtree Market Restaurants Inc, 2014 TMOB 138 (CanLII)	6
4. Imperial Tobacco Canada Limited/Marlboro Canada Limited v Philip Morris Brands Sàrl, 2014 TMOB 219 (CanLII)	7
Applications of Other Social Scientific Evidence	8
5. Forest Stewardship Council v GH Imported Merchandise & Sales Limited, 2014 TMOB 99 (CanLII)	8
6. Dm-drogerie markt GmbH v 911979 Alberta Ltd, 2014 TMOB 59 (CanLII)	10
7. Zillow, Inc v HomeZilla Inc, 2014 TMOB 131 (CanLII)	11
8. Imperial Tobacco Canada Limited/Marlboro Canada Limited v Philip Morris Brands Sàrl, 2014 TMOB 219 (CanLII)	11



Noted Absence of Social Scientific Evidence..... 12

9. Yogen Früz Canada Inc v Industries Lassonde Inc, 2014 TMOB 169 (CanLII) 12

10. Sadhu Singh Hamdard Trust v. Navsun Holdings Ltd., 2014 FC 1139 (CanLII) 12

**11. Ottawa Athletic Club Inc. (Ottawa Athletic Club) v. Athletic Club Group Inc., 2014 FC 672
(CanLII) 14**

12. Gary Gurmukh Sales Ltd. v. Quality Goods Imd Inc., 2014 FC 437 15

13. Jack Black L.L.C. v. Canada (Attorney General), 2014 FC 664..... 17



Expert Literature on Survey Evidence

1. *Trademark Surveys: An Undulating Path*¹

Texas Law Review – July, 2014

A recent study, published by Northwestern University Professor Shari Seidman Diamond and University of San Francisco Professor David J. Franklyn, highlights the frequency of, and contributions from, survey evidence in trademark litigation. Their article, *Trademark Surveys: An Undulating Path*, reports on both previously-conducted studies and new research, based on inputs from more than 400 international members of the International Trademark Association. The study attempts to understand why, with survey evidence having grown dramatically in the past 50 years, it is only reported as an evidentiary component in an estimated 25-35% of trademark-related cases.

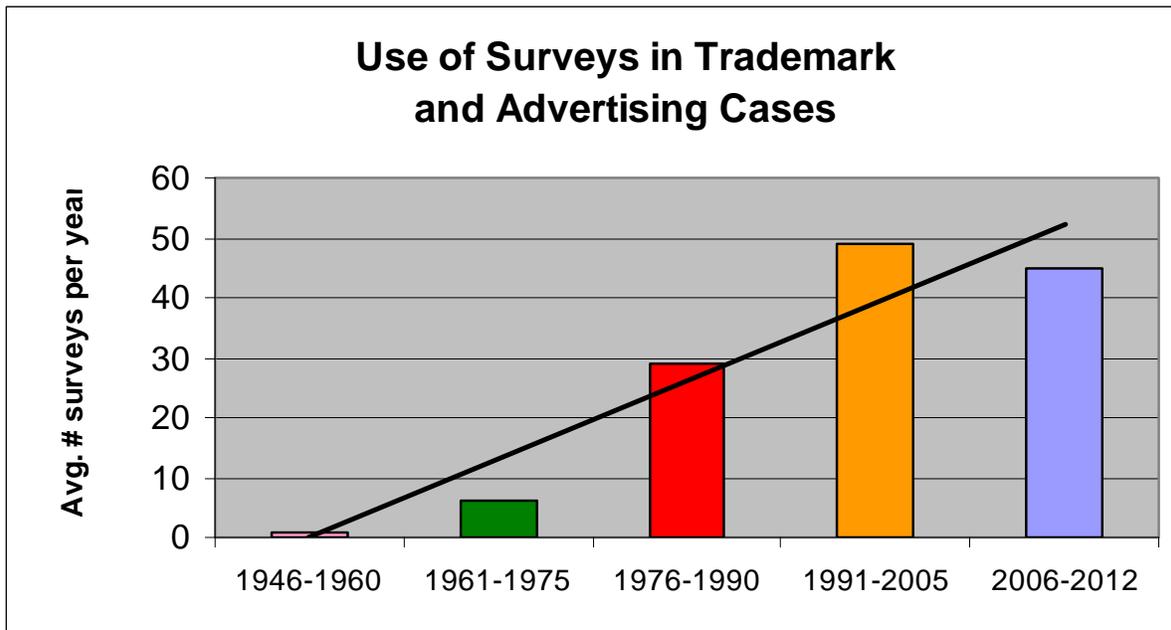


Chart based on Gerald L. Ford, Survey Percentages in Lanham Act Matters, in *Trademark and Deceptive Advertising Surveys: Law, Science, and Design*, supra note 24, at 311, 312 n.3. This data was updated through 2012 by Gerald L. Ford for a presentation at the McCarthy Law Symposium.

¹ Texas Law Review, Vol. 92, 2014 - Northwestern Law & Econ Research Paper No. 14-12
Shari Seidman Diamond - Northwestern University, School of Law & American Bar Foundation
David J. Franklyn - University of San Francisco School of Law
July 8, 2014



Diamond and Franklyn’s article advances the notion that surveys remain the most direct form of evidence in trademark and advertising matters. Just over half of the practicing lawyers interviewed had commissioned at least one survey, and those with longer tenure in practice had commissioned closer to 10 surveys, on average. In approximately half of the closed cases reported, survey results had helped to convince one of the parties to settle or abandon the case.

Among its conclusions, the article notes that "survey use at trial is just the tip of the iceberg". The research found "ample evidence to suggest that surveys enjoy a substantial life before trial as critical evaluative and leveraging tools".

To access the full Diamond and Franklyn article, click [here](#).

2. *The Hot-Tub Alternative To Adversarial Expert Evidence* **The Advocate’s Journal – Spring 2014**

The Spring 2014 issue of The Advocates’ Journal featured Dr. Ruth Corbin’s article “*The hot-tub alternative to adversarial expert evidence*”. The article details the evolution of the use of concurrent expert evidence, whereby expert witnesses testify together as a panel, rather than individually. It also explores which countries have institutionalized hot-tubbing, alternatives to the practice, advantages and disadvantages, and the Canadian progression.



To access the full article, click [here](#).

Survey Evidence in Canadian Trademark Cases

3. Movenpick-Holding AG v Richtree Market Restaurants Inc, 2014 TMOB 138 (CanLII), June 30, 2014

Richtree Markets Inc. filed an application in December 2004 to register the trade mark RICHTREE MARKET RESTAURANTS & Tree Design in association with restaurant, catering and take-out services; franchising and training services and seminars. The “franchising” and related services were later deleted from the application. The application was opposed by Movenpick Holding in January 2006. The opponent pleaded that it was the owner of the registered word marks and trade-names MARCHÉ and MARCHÉLINO (collectively known as MARCHÉ trademarks), as well as registered logo marks associated with these names—all of which were expunged from 2012 to 2013 because of non-use.

The Opponent submitted an online survey “alleging confusion between the applied-for mark and the opponent’s MARCHÉ marks”. The study was conducted by an Assistant Marketing Professor at a major Canadian University, and surveyed 6,400 restaurant-goers from the Greater Toronto Area and the National Capital Region. The results concluded that in the minds of the “relevant public” the MARCHÉ trademark was ...

[31] “...distinctive, [...] acquired distinctiveness and achieved secondary meaning...The consuming public continues to have accurate lingering impressions of the MARCHÉ trademark. These results testify to the strength of the MARCHÉ trademark and are particularly impressive in light of the fact that the Canadian franchises of MARCHÉ restaurants were closed in 2005. The large sample of category- and brand-users, along with the convergent results of the two-study approach adds support and confidence to this conclusion.”

The Applicant submitted that conclusions based on this survey were not relevant, reliable or valid and the Judge, in this case, agreed based on an expert opinion submitted by the Applicants.

In reviewing the survey submitted by the Opponent’s expert witness, the Applicant’s expert witness noted several flaws including:

[33] (i) the sampling in the [...]survey was non-random, (ii) questions posed to respondents were ambiguous, and (iii) questions posed to respondents were either leading or misleading, in both cases tending to increase the likelihood of a reply favourable to the opponent.

Finally, the Applicant’s expert witness noted that the survey did not, in fact, measure what it was meant to – specifically the perceived characteristics of the Mark - and the expert who conducted the survey



“drew inferences that people were talking about his client” creating a bias in the survey’s data. The Court agreed that the survey’s data was flawed and, as a result, the evidence became less relevant.

**4. Imperial Tobacco Canada Limited/Marlboro Canada Limited v Philip Morris Brands Sàrl, 2014 TMOB 219 (CanLII), October 6, 2014;
(Including and with reference to: 2014 TMOB 217; 2014 TMOB 218; 2014 TMOB 220;
2014 TMOB 221; 2014 TMOB 222; 2014 TMOB 223)**

In multiple TMOB cases, Imperial Tobacco Canada Limited and Marlboro Canada (collectively referred to as the Opponent) opposed the registration of several trademark applications, including the “Roof Design”, filed by Philip Morris Products S.A. to be used in Canada in relation to cigarette and tobacco related wares. The determinative issue in each of these cases was whether or not the marks Philip Morris aimed to register were “confusing with Marlboro Canada’s trademark MARLBORO” which had been previously used and registered in Canada in association with cigarettes.

The trademarks in question were design elements related to product packaging and can be viewed in the respective procedure details found in the footnotes to the document.²

The Opponent sought to block the registration of these trademarks because they alleged there was confusion with the MARLBORO mark, registered by Marlboro Canada. The Opponent relied on survey evidence (previously filed in the Federal Court of Appeal) of two expert witnesses.

The first survey, which took place in several cities across Canada, assessed the “possible misidentification by consumers and retailers in Canada between the no-name brand ...cigarettes and the international Philip Morris brand ‘Marlboro’ marketed outside of Canada.” During the survey, respondents were shown a package with the Rooftop design and “asked questions regarding their recognition of its source. The purpose of that study was to assess consumer views, if any, on the product origin or source of the Rooftop cigarette package.”

The second survey, which utilized a mystery-shopping approach by having interviewers identify themselves as consumers, assessed retailers in the same cities—retailers were approached on two separate occasions and asked to identify by name the brand of cigarettes indicated by interviewers.

² Complete TMOB decisions in relation to Imperial Tobacco Canada Limited/Marlboro Canada Limited v Philip Morris Brands Sàrl, 2014 TMOB 217 through 223 are available through CanLII – www.canlii.org



The Board's ruling emphasized the importance of consumers' recognition of the cigarette package as a "whole" (including the Marks in question) and the designs themselves. The designs "taken in isolation" might not have yielded the same survey results as one that assesses the package as a whole, and as a result, it is emphasized in the Board's decision that "solely the combination of the elements" on the cigarette package could cause confusion.

Applications of Other Social Scientific Evidence

CorbinPartners' *Year in Review* is traditionally a summary of decisions in which survey evidence played a significant role, or where its absence was noted by the Court. This year, the *Year in Review* includes examples of other social scientific evidence submitted in Canadian intellectual property disputes, including mystery-shopping and the use of Internet reconnaissance. Internet reconnaissance may include social media monitoring, deep internet searches, and/or accessing the "Wayback Machine" Internet Archive.

5. Forest Stewardship Council v GH Imported Merchandise & Sales Limited, 2014 TMOB 99 (CanLII); May 13, 2014

In April 2010, G.H. Imported Merchandise & Sales Ltd. (the Applicant) filed for the registration of a trademark "Tree Design", in association with clothing (dress, casual and athletic) and catalogue shopping services. The application was opposed by the Forest Stewardship Council on the basis that there would be a "reasonable likelihood of confusion between this trademark and its [own] mark", registered in association with "furniture and products made from wood, printed materials relating to forest management and conservation and several different services relating to forests, wood and products made from wood, and as also purportedly been used in association with clothing."

The Applicant submitted a sworn affidavit that included an Internet search for "active trademarks from the Canadian Trademark Database that consist of or include a tree design". The affidavit included a list of trademarks uncovered, as well as an exhibit of screen captures of the websites which clearly displayed the marks.

The Opponent objected to the submission of this evidence on the belief that "printouts of third-party websites are hearsay, meaning these exhibits are not admissible for the truth of their contents". However, the Board chose to allow the exhibits to remain as evidence of the existence of websites displaying the design, not necessarily as evidence of the truth of the contents of the website.



[22] With respect to the Opponent's second objection, I find that [the] evidence of the display of various marks on third party websites is not being presented to evidence the truth of the contents of the pages but rather simply their existence. I am therefore satisfied that this evidence is sufficient to show that others were displaying tree designs in association with their wares and services on-line on the date that [the Internet search was] conducted...

The Court also referenced a previous TMOB ruling in which the Board gave weight to, and further explained, the importance and admissibility of Internet searches (as well as commentary on the manner in which they are conducted) as evidence:

[23] In considering both of the above objections, I had regard to the following comments of former Member Bradbury in *Canadian Jewellers Association v American Gem Society*, 2010 TMOB 106 (CanLII):

I disagree with the Applicant's position that the Internet search portions of the Cheng evidence are controversial. I understand that a search strategy must be developed in order to conduct a search. The specific strategy used is evident from the exhibits to the Cheng affidavits, but the Applicant's concern is the undisclosed thought that went into creating that strategy. However, I personally do not see that the concerns expressed by the Federal Court of Appeal in *Cross Canada* legitimately apply here. I do not see how any self-interest of an agent employed by a party could be seen to bias these search results. It is quite apparent that the search was directed to see if anyone other than the Applicant has employed the phrase "certified gemologist" on Canadian websites. I do not see how the fact that this evidence was introduced by an employee of the Opponent's agent makes it less proper or open to suspicion than if the Opponent or its agent had hired an outside investigator to do such searches and swear an affidavit. Either way, the Applicant could, if it desired, cross-examine the provider of such evidence to ask why they chose the search terms that they chose. In the present case, the answer seems self-evident. Overall, the evidence does not appear to me to be controversial. I also note that the Applicant could have, if it wished, provided its own Internet searches to rebut the Opponent's Internet searches.

In my view, the impugned exhibits are evidence that as of such a date, the printed pages appeared on the Internet. This does not of course mean that anyone read these pages; it simply means that someone chose to post these pages and that they were at the time of the search accessible from Canada. Such evidence, if sufficient and if prior to the relevant material date, can be good evidence on the issue of whether others employ the phrase "certified gemologist". As such evidence is not being presented to evidence the truth of the contents of the pages, but rather simply their existence, I do not consider there to be a hearsay problem.

The Opponent raised further objections to the submission of another affidavit with additional website printouts on the ground of hearsay. While the Board agreed that the evidence was hearsay, the Board found "the manner in which this type of evidence was submitted to be both necessary and reliable (in that the documents come from a website maintained by an official body)..."

The Board ultimately rejected the opposition of the Applicant's registration.



**6. Dm-drogerie markt GmbH v 911979 Alberta Ltd, 2014 TMOB 59 (CanLII)
March 12, 2014**

The Opponent in this case, dm-drogerie markt GmbH + Co. KG, sought to block the application of a trademark registration for the marks "BALEA" and "Baléa" in relation to various hair and skin care products filed by 911979 Alberta Ltd. The Opponent filed the affidavit of a trademark assistant employed by the firm, who acted in the role of the Opponent's trademark agent.

Research for the affidavit had been conducted under the instructions to "locate websites demonstrating instances of consumer confusion between the goods sold by [the Opponent] and branded by the trademark BALEA, and goods sold by Shoppers Drug Mart and branded by the trademark BALEA or Baléa" online. As the Board decision details, websites were visited and those which were thought to suggest confusion on the part of consumers were printed and submitted as exhibits to the affidavit.

The affiant included email correspondence with an editor and contributor of a beauty product website concerning the relation between the Opponent's goods and the BALEA products sold at Shoppers Drug Mart; she also included website reviews (with no indication as to the source of the product) for BALEA products sold at Shoppers Drug Mart and products sold by the Opponent.

The Board found that the email submitted as evidence could not be given any weight and would be treated as hearsay. The website content, and the subsequent printouts submitted in the affidavit were also deemed to be inadmissible as evidence because...

[23] [...] At most, [the author of the affidavit] has evidenced that these website pages existed at the time she performed her searches – she has not evidenced the truth of their content. In that regard, I would add that I have difficulty to reconcile the Opponent's contention that it does not rely on the website pages for the truth of their content with its contention that they establish Canadian consumers' awareness of the Opponent's trademark. In other words, how can the Opponent contend that the website pages establish consumers' awareness of its trademark without relying on the truth of their content?

The Board decisions stated the reputation of the Opponents' trademark could have instead been "evidence through an affidavit of an individual with direct knowledge of the Opponent's activities."

The Board rejected the oppositions to the Applicant's registration of the two marks.



**7. Zillow, Inc v HomeZilla Inc, 2014 TMOB 131 (CanLII)
June 25, 2014**

The trademark HOMEZILLA was applied for by Homezilla Inc. for use in association with "real estate related wares and services including computer software and advertising and marketing services" based on its use of the wares and services in Canada since 2007. The Opponent, Zillow Inc., owns the trademarks ZILLOW and ZILLOW.COM in association with real estate-related wares and services. It opposed the registration application on the basis that the HOMEZILLA trademark is "confusing with its registrations for and previous use and/or making known its ZILLOW and ZILLOW.COM marks and the Zillow trade-name". The Opponent also challenged the date of first use as filed in the application.

In order to establish a date of use, evidence was submitted including website pages (dating back as far as 2007) recovered using the Wayback Machine. The Board noted that while pages can be removed from the Wayback Machine, there is no evidence to suggest that the actual content of those pages can be altered. Despite an objection to the submission of evidence taken from the Wayback Machine, the Board concluded that the Wayback Machine "has been found to be generally reliable...More particularly, Wayback Machine evidence" has been found to be admissible in other rulings:

[15]... I appreciate that there be limitations to the accuracy of the Wayback Machine, including but not limited to possible hearsay issues. However, for the purpose of meeting the Opponent's light initial burden under s. 30(b), I find that the search results are sufficient to raise a doubt concerning the correctness of the Applicant's claimed date of first use [...]. The Applicant had the opportunity to file evidence to rebut the results of the Wayback Machine search but chose not to.

The Board decided "based on the evidence of record, the Opponent has met its light evidential burden" and refused the application on the basis of use because the Applicant was unable to prove that it had used the Mark as of the date stated in the application.

**8. Imperial Tobacco Canada Limited/Marlboro Canada Limited v Philip Morris Brands
Sàrl, 2014 TMOB 219 (CanLII), October 6, 2014;**

**(Including and with reference to: 2014 TMOB 217; 2014 TMOB 218; 2014 TMOB 220;
2014 TMOB 221; 2014 TMOB 222; 2014 TMOB 223)**

(See case summary above for use of "mystery-shopping" as social science evidence.)



Noted Absence of Social Scientific Evidence

Cases below specifically highlight the absence of social science evidence where such evidence could have been relevant.

9. Yogen Früz Canada Inc v Industries Lassonde Inc, 2014 TMOB 169 (CanLII), August 19, 2014

Industries Lassonde Inc. applied to register the trademark FLAVÜR in association with and covering the following wares: fruit juices, vegetable juices, non-alcoholic fruit and vegetable beverages. In 2010, the following year, Yogen Früz Canada filed an opposition to the registration. The Opponent claimed the Ü mark was as well known in “the field of frozen yogurt just [as] Nike’s ‘Swoosh’ was in the field of sports items”, and that the Applicant was aware the Ü was a component of the Opponent’s trademarks. At issue was the likelihood of confusion between the Applicant’s potential future use of the mark and the Opponent’s marks. The Judge ultimately found the Opponent did not meet its evidentiary burden with relation to the grounds of opposition it raised.

The Opponent’s lack of evidence, and marketplace evidence in particular, was noted by the Court:

[61] Lastly, it would be remiss of me not to stress the absence of evidence of studies to prove that the average Canadian consumer associates the Opponent’s Ü and/or smiling Ü Drawing mark such that any mark including this element used in association with frozen yogurts, smoothies or any other similar product would be associated with the Opponent. {.....} In fact, if the Opponent claims that its Ü and/or smiling Ü Drawing mark had become recognized to the extent that it constituted a distinctive corporate symbol in the same vein as Nike’s ‘swoosh,’ a market study could have enlightened us on this point.

10. Sadhu Singh Hamdard Trust v. Navsun Holdings Ltd., 2014 FC 1139 (CanLII) November 26, 2014

The name “Ajit” was being used by two Punjabi language newspapers: a subscription daily newspaper in Jalandhar, India, as well as a free weekly newspaper distributed in Toronto and Vancouver, Canada. Neither party registered the trademark. The eventual registration and use of the mark led to litigation in the U.S., England, and Canada.



The Plaintiff, Hamdard Trust, has owned and published the India-based “Ajit Daily” since 1995, with an online version available since 2003. The Ajit Daily is available in Canada only to subscribers. The Defendants own and publish the Canadian “Ajit Weekly”, which has been available to Canadians since 1993, with an online version becoming available in 1998. The Canadian-based publisher, Master Web Inc., is also named by the Plaintiff in this claim. However, the Publisher maintains that any claims against it should be dismissed as it was “only hired” to print the weekly publication. Neither party involved has a registered trademark or copyright in Canada. It should also be noted that both newspapers display the “common” Punjabi word “Ajit” in their names (and are prominently displayed on the front page of their newspapers), written in Punjabi font but “in different colours”.

While both publications are available online, the Ajit Weekly is distributed for free (and in grocery stores) in Toronto and Vancouver and has a subscription base of 13,000 in Toronto and 11,000 in Vancouver. By contrast, in 2010 the Ajit Daily’s subscriber base in Canada numbered only 7, however, the newspaper is known by “Punjabi speaking immigrants as being a daily newspaper that is held in high regard by the Punjabi community”.

No survey evidence was submitted in this case and the lack of such evidence by the Plaintiff was noted in the decision.

The Court was responsible for deciding if the Defendant in this case was liable for “passing off” (pursuant to Sections 7(b,) which addresses Unfair Competition, of the Trademarks Act), whether or not the trademark is registered. A finding of “passing off” requires existence of goodwill. The Court deferred to *Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée (2006)* to define goodwill as “the positive association that attracts customers towards its owner’s wares or services rather than those of competitors.” And furthermore, the

[81]“...existence of commercial goodwill is tested by looking if the party has established that its goods are known in the market by reason of their distinguishing feature. The goodwill must have been created through the exclusive use of the name or mark with its business, wares or services. The relevant market where a plaintiff proves reputation is the defendant’s market [...]. So I must ask myself if the people that subscribe (seven subscribers) to the Ajit Daily in Canada are likely to suffer a misrepresentation because of the Ajit Weekly’s reputation in the same market. The onus is on the Plaintiff to establish their reputation in this market so as to be protected against passing off in that same market [...].”

[82] In *Orkin Exterminating Co Inc v Pestco of Canada Ltd*, 1985 CanLII 157 (ON CA), [1985] OJ No 2526 (QL) at para 37, 19 DLR (4th) 90, the Ontario Court of Appeal wrote that the plaintiff does not need to be in direct competition with the defendant in that market but that:

If the plaintiff’s trade name has a reputation in the defendant’s jurisdiction such that the public associates it with services provided by the plaintiff then the



defendant's use of it means that the plaintiff has lost control over the impact of its trade name in the defendant's jurisdiction.

[83] The Plaintiff alleged that the mark is "famous" amongst the Punjabi speaking public. At the hearing, the Plaintiff argued that there is "no dispute - it is a famous institution". The Plaintiff submitted that the evidence of large circulation in the Punjab and the paper's availability on the internet shows that everyone knows of the paper. The Plaintiff's evidence is that every Punjabi family worldwide knows the Ajit Daily and in fact even the Defendants' family read the Ajit Daily in India.

[84] The Plaintiff's evidence falls short of demonstrating reputation in the Defendants' geographic region. There is no survey or other independent reputable evidence before me to find that the Ajit Daily has commercial goodwill in Canada or is famous in Canada as the only evidence presented to me is of seven subscribers in Canada in 2010. There is one statement made in an affidavit in support of the Plaintiff that the reader "...read it on line" but I give that little weight because it is far from a quantitative analysis such as expert survey evidence may provide.

Ultimately the Court decided the Ajit Daily was not as famous in Canada as *Veuve Clicquot*, and that the plaintiff did not meet the onus of "providing the existence of goodwill in the Defendant's geographical region".

The Plaintiff's claim was ultimately dismissed by the Court.

11. Ottawa Athletic Club Inc. (Ottawa Athletic Club) v. Athletic Club Group Inc. 2014 FC 672 (CanLII), July 9, 2014

The Ottawa Athletic Club Inc., the Applicant, has operated fitness facilities in the Ottawa and claimed to have continuously used the trade name and trademark "Ottawa Athletic Club" since 1976. The Respondent, The Athletic Club, a London, Ontario based fitness facility with 9 locations in Ontario including 2 in Ottawa, has been operating since 1997. In 2003, the Respondent applied to register the trademark THE ATHLETIC CLUB & DESIGN, however once registered the trademark included the following stipulation "The right to the exclusive use of the words ATHLETIC CLUB is disclaimed apart from the trademark". The Respondent claimed to have used the trademark continuously in association with its services since 1997.

This case involved an application to strike a trademark from the register and the prohibition of any future uses of the "allegedly invalid trademark or its common law equivalent on the grounds that it offends." The Applicant sought to have the trademark expunged based on a number of grounds,



"including that it is confusing with the Applicant's own trade name and trademark, which had been in use for 21 years when the Respondent began using the Athletic Club Trademark".

The Applicant in turn filed its own trademark application (referred to as the "OAC & design" which include the words "Ottawa Athletic Club", which it claimed was used in relation to the operation of a fitness club and fitness activities, including personal training, indoor golf facilities, and the operation of summer sports camps beginning in 1983). The Respondent opposed this application.

The Applicant sought to have the trademark expunged based on the claim that the Athletic Club Trademark was invalid as it was not distinctive on the date of the registration, amongst several other claims. The Court defined "distinctive" in this case as "a trademark 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".

In attempting to assess distinctiveness, the Court noted the absence of any social scientific evidence submitted in the case, stating that evidence of the Athletic Club Trademark in use or advertised prior to the registration date was "extremely scarce", and the Respondent "did not file any survey evidence or consumer affidavits to support a finding that the Trademark had acquired any secondary meaning or distinctiveness". [47]

The Court considered many factors in this proceeding, and decided the Athletic Club & Design trademark was invalid and the registration of the trademark in the Canadian Trademark Register should be struck-out on the "ground it does not accurately express or define the existing rights of the person appearing to be the registered owner of the Mark."

12. Gary Gurmukh Sales Ltd. v. Quality Goods IMD Inc., 2014 FC 437 May 7, 2014

This case involved three parties. Gary Gurmukh Sales Ltd. (GGS) manufactures, distributes and sells products for the Canadian souvenir market. Mr. Gurmukh is also the President of Per-Design Inc. ("Per"), a company which "designs logos and designs that are used on various products", including merchandise from GGS. Per is the owner of the two registered marks, "CANADIAN FAST FOOD" and "CANADIAN POLAR BEAR IN SNOW STORM", both registered for use "in association with t-shirts, sweatshirts, tank tops, mugs, fridge magnets, aprons, hats, and shopping bags".

Quality Goods IMD Inc. ("Quality") is a competitor of GGS, which has imported, manufactured and distributed merchandise sold in the "tourist market" in Canada for the past 45 years. This includes merchandise which bears the applicable trademarks as noted in the decision...



[24] Quality has used the trade-marked phrases on merchandise, often accompanied by images similar to those used by GGS, since 2005. It claims that its art and design department developed the designs independently in 2004, and they were well known in the tourist/souvenir industry in Canada.

GGS and Per commenced an infringement proceeding seeking “injunctive relief restraining Quality from using the relevant trademarks, the delivery up of Quality’s infringing merchandise, damages for trademark infringement, pre-and-post judgement interest” and costs. In response to the filing, Quality commenced an expungement proceeding challenging the validity of the applicable trademarks and sought an order striking these trademarks. It claimed the marks were well-known in the industry before the GGS registration.

A GGS affidavit contained information on the history of GGS, sales figures for merchandise related to merchandise bearing the trademarks, and “how they became aware of Quality’s use of the trade-marks and the action taken in response”. The GGS submission did not include social survey evidence to support their case as noted in the decision:

[52] There is no survey evidence to indicate that the public can distinguish the wares of GGS or the trade-marked wares from the wares of others, nor is there evidence of an advertising budget for the trade-marks. There is no evidence that links the trade-marks to GGS as the source of trade-marked wares in the mind of consumers; see the decision in *Consorzio del Prosciutto di Parma v. Maple Leaf Meats Inc.* (2001), 2001 CanLII 22030 (FC), 205 F.T.R. 176 at paragraph 19. Quality submits that GGS was not entitled to register the trade-marks pursuant to paragraph 18(1)(b) of the Act as the marks do not distinguish their wares from others and are not distinctive.

However, the Court found that onus was on Quality to demonstrate that the “trade-marks are no longer capable of distinguishing the wares of GGS from the wares of others in the marketplace” in order to establish that the marks were not distinctive. The Court did not believe Quality “produced sufficient evidence to demonstrate that the trade-marks are no longer distinctive”.

Further in its decision, the Court noted:

[98] With respect to the degree to which the trade-marks have become known, there is no direct evidence on this point. However, GGS has provided extensive evidence of the sales of products bearing these trade-marks. It is reasonable that the trade-marks are known or at least recognizable to consumers in the marketplace. An ordinary casual consumer, somewhat in a hurry, with an imperfect recollection of GGS’ trade-marks, would be likely to think products marked with Quality’s similar trade-marks originated from the same producer. This factor weighs in favour of finding a reasonable likelihood of confusion between the trade-marks.

The Court maintained the validity of GGS’ trade-marks, and found Quality did commit trade-mark infringement.



13. Jack Black L.L.C. v. Canada (Attorney General), 2014 FC 664 July 8, 2014

This case was an appeal of a Registrar of Trade-marks 2012 decision to reject an application to trademark “JACK BLACK”. The applicant, Jack Black L.L.C., sought to have the Registrar’s decision reversed and the trademark approved by the Federal Court. The trademark concerned various personal care and hygiene wares, including: skin lotions, hand creams, after-shave lotions, shaving balms, shower gels, antiperspirants, shower gels, shampoo, hair conditioner, eye creams, and many others. The applicant had registered the trade-mark JACK BLACK AUTHENTIC AND ORIGINAL DESIGN in 2004, permitted it to become abandoned, but as the Court details, there is evidence that the trade-mark was in use as of 2002 in Canada. In evidence before the Federal Court, the Applicant claimed the name was created without any knowledge of anyone having the name “Jack Black”.

[8] The Trade-mark has been registered in a number of countries around the world. The applicant claims in that new evidence that there has not been any complaint or challenge in connection with its registration of the Trade-mark, including from anyone whose name would be “Jack Black”, and including the actor by that name. It would appear that the only resistance to the registration came from the Registrar of Trade-marks and that the objection was raised *proprio motu*.

The Federal Court cited the TMOB’s original decision which noted a lack of evidence, comparable in value to survey evidence in a previous case, to help establish the Canadian public’s awareness of the name:

[27] [...] The TMOB said: In one of the cases on point cited by the opponent, *Carson v. Reynolds* (1980), 49 C.P.R. (2d) 57 (F.C.T.D.), Mahoney J. had extensive survey evidence before him to the extent of the Canadian public’s awareness of the Tonight Show and Johnny Carson’s personal notoriety in Canada. By contrast, I do not have sufficient evidence to conclude that Daniel E. Aykroyd is famous and that he is associated in the public’s mind with the trade-mark BLUES BROTHERS. As a result, I have dismissed this second ground of opposition. [My emphasis]

The Court recognized that no such evidence existed in the current proceedings, namely the Appeal, and that there was no evidence to support that a connection with the actor Jack Black was ever intended and no complaints were filed since use of the Trademark began.

[28] [...] Internet printouts constitute the basis for the decision in this case, without any evidence commensurate with what was available in Waltrip, Aykroyd, or Carson. To put it simply, it has not been established that there is a Canadian public’s awareness of a person named Jack Black, let alone that that awareness reaches a level of significant public reputation.

The Court decided to set aside the Registrar’s decision and approved the registration of the Trademark.

