



# Notable Trademark Decisions in 2018 and What They Said – **Top TM Cases**

by John McKeown



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There are many decided cases each year relating to trademarks. Many cases involve a determination of the potential for confusion between competing marks and turn on their own facts. However, there are decisions that provide help to lawyers and agents and their clients in assessing their rights.

2018 generated a significant number of trademark decisions which provide insights relating to the following: the protection available to weak trademarks or marks that lack inherent distinctiveness; the importance of acquired distinctiveness; and the impact of the online commerce and changes in the way services are delivered.

In more a litigious context, decisions considered the potential admissibility of survey evidence, the scope of protection available under section 22 of the Act, claims for passing based on a false claim of approval or endorsement, and claims based on goodwill when the plaintiff did not carry on business in Canada.

- In *Assurant, Inc. v. Assurancia, Inc.*, the Federal Court reiterated that for trademarks made up of highly suggestive and non-distinctive components, small differences between the trademarks, such as different suffixes, can distinguish the marks and avoid confusion. [Link to our comment and the decision.](#)
- In *The Clorox Company of Canada, Ltd. v. Chloretec s.e.c.*, the Federal Court took an approach similar to that adopted in the *Assurant* decision but the key factor was the lack of inherent distinctiveness of the parties' marks. The judge said that the starting point of the analysis was that the two sets of trademarks were derived from the French expression "eau de Javel" a common noun translated as "bleach" and that designated the product in issue. [Link to our comment and the decision.](#)
- In *Imperial Tobacco Canada Limited v. Philip Morris Brand Sàrl*, survey evidence was found to be admissible by the Federal Court in an appeal from the Trademark Opposition Board. The court went back to basic principles and confirmed that consumer surveys can be admitted as evidence, if relevant and properly designed.
- The decision in *Swatch AG v. Hudson Watch Inc.* emphasizes the importance of the acquired or inherent distinctiveness of a trademark and the importance from a brand owner's viewpoint of taking steps to maintain and increase acquired distinctiveness. [Link to our comment and the decision.](#)
- The decision in *Hilton Worldwide Holding LLP v. Miller Thompson* relates to the problems concerning maintaining a trademark registration that occurs when goods or services are delivered by different means arising from an updated means, method, or format. The Court found in favour of the trademark owner. The scope of a registration must be considered in light of the ordinary meaning of the words influenced by the developments in online commerce as it related to the ordinary commercial understanding of both the business and the customer. [Link to the comment and the decision.](#)
- In *Quality Program Services Inc. v. Ontario*, the Ministry of Energy responded to a claim of infringement of a registered trademark by giving public notice under the Act of the adoption and use of the mark in issue as an official mark. The Ministry then claimed in the later action that the existence of the official mark was a complete defence to a claim of infringement. The judge refused to adopt an interpretation of section 9 of the Act that conferred a statutory immunity on public authorities without clear legislative language supporting such an interpretation. Nothing in the language of the section eliminates rights already conferred upon the owner of a registered trademark.
- The decision in *Energizer Brands, LLC v. The Gillette Company* provides a detailed review of the requirements of subsection 22(1) and the matters relevant to determining when a distinguishing feature of a mark has been used by a defendant is infringing under the section. [Link to our comment and the decision.](#)

- The decision in *Royal Pacific Real Estate Group Ltd. v. Dong*, 2018 BCSC 1272 confirms that an action for passing off is not confined to any particular means of misrepresentation. Doing anything that would lead customers to think there is a connection between the plaintiff's wares, services or business, and the wares, services or business of the defendant, where such a connection does not exist, may be actionable. Here, the defendant promoted its own products in such a way to create the false impression that its product or services were approved or endorsed by the plaintiff.
- In *Sadhu Singh Hamdard Trust v. Navsun Holdings Ltd.* 2018 FC 1039, the Federal Court 2018 applied the direction of the Federal Court of Appeal where the plaintiff relied on goodwill when it did not carry on business in Canada. However, there was no direct or circumstantial evidence that the defendant's activities had any real impact on the plaintiff's business. Damages were at the lower end of the scale for nominal damages. This decision is under appeal. [Link to our comment and the decision.](#)

It has been an interesting year, but perhaps less interesting than it will be in 2019 with the implementation of the various amendments to the Trademarks Act – perhaps the curse of living in interesting times.

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John McKeown is a counsel at Goldman Sloan Nash & Haber LLP. With more than 25 years of experience providing advocacy and advice concerning intellectual property and related marketing matters, he is certified by the Law Society of Upper Canada as a specialist in Intellectual Property Law (Trade Marks/Copyright).

John is the author of [Brand Management in Canadian Law, 4th Edition](#). This book is the only publication in Canada that brings together the legal and business issues that you need to understand when helping clients reach their business objectives through branding. He's also the author of [Fox on Canadian Law of Copyright and Industrial Design, 4th Edition](#), a work which has been extensively referred to by both the Supreme Court of Canada and the Federal Court of Appeal as an authoritative source.

**John McKeown**  
 Goldman Sloan Nash & Haber LLP  
 480 University Avenue, Suite 1600  
 Toronto, Ontario M5G 1V2  
**Direct Line:** (416) 597-3371  
**Fax:** (416) 597-3370  
**Email:** [mckeown@gsnh.com](mailto:mckeown@gsnh.com)

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