Index

 \mathbf{C}

Civil Code of Québec

- conditions for an action, 476
- remedies
 - compensatory damages, 482
 - injunctions, 483
 - punitive damages, 483-484
- types of faults
 - confusion, 477
 - disorganization, 479
 - disparagement, 478
 - parasitism, 479-482
- unfair competition, 6, 7-8, 33, 475-476

Competition Act

- criminal vs. civil regime under, 441
- deceptive marketing, see Deceptive Marketing
- false or misleading advertising, 446-449
- trading offences, 1

Confidential Information and Trade Secrets

- basis for protection
 - contract, 492-493
 - equity, 493-494
 - legal basis, 490-492
 - property, 495-497
- confidential relationship
 - confidence, obligations of, 503
 - directors and officers, 506
 - fiduciary obligations, 504-505
 - implied contract, 504
 - written contract, 504
- confidentiality
 - communicated in confidence, 489-499
 - misuse by recipient, 490
 - must be confidential, 487-489
- disclosees, types of
 - competitors, 513-514
 - consultants, 511-513
 - employees, 507-508
 - governments, 515-516
 - joint venturists, 514-515

Confidential Information and Trade Secrets — continued

- thieves, 517-521
- generally, 485
- litigation
 - confidentiality orders, 537
 - courts, 537-538
 - protective orders, 538-539
- protectable information, 498
- remedies
 - accounting for profits, 533-534
 - Anton Piller order, 531
 - constructive trust, 534-536
 - damages, 531-533
 - generally, 524-525
 - injunctive relief, 525-527
 - interim and interlocutory injunctions, 527-529
 - permanent injunctions, 529-530
 - springboarding injunction, 530-531
- trade secrets
 - defined, 486
 - enforceability requirements, 487

CUSMA, TRIPS and the Trademarks Act

- conclusions, 64
- enforcement
 - border provisions, 63-64
 - criminal procedures and penalties, 62-63
 - provisional measures
 - interlocutory or interim measures, 62
 - specific procedures
 - enforcement provisions, 61-62
 - under CUSMA and TRIPS, 61
- general, 49
- geographical indications
 - definition of (CUSMA), 59
 - definition of (Trademarks Act), 59
 - TRIPS and CUSMA provisions relating to, 60-61
- legislative ambiguities, court resolves by referring to CUSMA or TRIPS,
 50
- minimum standards, 51
- obligations, nature and scope of, 51-53
 - exhaustion, principle of, 52-53
 - dispute settlement, 53
 - intellectual property conventions, 51-52
 - national treatment, 52

CUSMA, TRIPS and the Trademarks Act — continued

- standards concerning trademarks, 53-55
 - enforceability of registrations
 - effect of, 55-56
 - licensing and assignment, 58
 - refusals to register (appeals), 56
 - term and termination
 - registration duration and renewals, 57-58
 - "Trademark" is not defined, 53-54
 - Article 20.17, 53-54
 - non-distinctiveness, preliminary view of, 54-55
 - Trademarks Act, section 32(1), 54
 - TRIPS, Article 15.26, 54
 - well-known marks, 56-57

D

Damage

- categories of
 - defendant's counterfeit or inferior goods, 235
 - expansion of defendant's business, 240
 - generally, 234
 - injurious association, 236
 - licensing opportunities, loss of, 239
 - loss of sales/predicted loss of sales, 234-235
 - reputation damage among other traders, 236-237
 - reputation, risk of damage to plaintiff's, 239-240
- distinctiveness, loss of
 - generally, 240-241
- irrelevant unless proven that misrepresentation affected goodwill, 229
- kinds of
 - cases where wrongly presumed, 219-220
 - protected by unfair competition law, 219
- proof
 - directors and officers, liability of, 227-228
 - interlocutory injunction applications, 222-223
 - loss of control, 225-227
 - proving damage or likely damage, 221-222
- real or substantial, 224-225
- sine qua non, 217-218, 228-229
- U.S. case law, 223-224

Deceptive Marketing

- ambush marketing, 467-469
- anti-spam legislation (CASL), 457-462

Deceptive Marketing — *continued*

- administrative monetary penalties (AMPs)
- commercial electronic messages (CEM), 458
- bait and switch, 451-452
- comparative advertising, 462
- Competition Act, criminal vs civil regime under, 441
- consumer complaints process, 473
- contests, 455-457
- enforcement, Competition Bureau's approach, 442-443
- false or misleading advertising
 - Competition Act legislation, 446-449
- price claims, 451-452
- · product claims
 - proper testing, adequacy and requirements, 449-451
- reviewable conduct, 446
- self-regulation of advertising, 469-470
- testimonials and endorsements, 453-455

Defences

- acquiescence
 - generally, 404
 - public policy considerations, 406
- clean hands
 - equitable conduct, importance of, 401-403
- concurrent use
 - Charter defences, 413-414
 - freedom of expression, 416-418
 - generally, 406-408
 - parallel importation, 408-410
 - parody, 414-416
 - quality differences, 410-413
- descriptive uses, 403-404

Dilution

- free riding
- freedom of expression
 - offence under *Trademarks Act*, section 22(1)?, 247-250
- goodwill, proof of depreciation, 244-245
 - dilution
 - criteria for proving, 245-246
 - proof of, 244-245
- parody
 - parodic uses and the *Charter*, 254-255
- similarity of goods or services, not essential, 250-251
- Trademark Law Revision Committee, 246-247

Dilution — *continued*

- trademark rights vs., 255-258
- Trademarks Act, section 22(1), 243-244
- uniqueness, 250

Distinctiveness

- acquisition
 - bad faith, influence of, 335-336
 - descriptive names, 336
 - generally, 333
 - Polaroid test, 333-334
 - prior use, sufficiency, 334-335
- functionality
 - aesthetics, 329-330
 - generally, 325-328
 - industrial design registration, relevance, 330
 - packaging shapes, 330-331
 - question of degree, 328
- injunctions
 - specificity, 332-333
- introduction
 - confusion, tolerated, 316
 - deception, effect of, 316
 - indicia, importance of, 312-313
 - indicia incapable of protection, 315-316
 - passing off, basis for relief for, 311
 - passing off vs. registrability, 315
 - question of degree, 316-317
 - question of fact, 315
 - sign, definition of, 313-315
- loss of distinctiveness
 - gradual, 346-347
- proving
 - average consumer, 354-357
 - determining confusion, additional issues, 352
 - disclaimers, 360-361
 - "fancy" words, 369-373
 - generic vs descriptive, 363-368
 - initials, 377-379
 - keywords, 395-399
 - market research, 350-352
 - packaging designs, imitation, 390-393
 - plaintiff's trademark, notoriety of, 359-360
 - slogans, 379-382
 - sounds, 399-400

Distinctiveness — *continued*

- surveys, 350-352
- use as trademark essential, 373-377
- virtual monopoly, effect of, 361-362
- secondary meaning
 - bad faith, effect of, 325
 - effect of, 323
 - plaintiff's mark, little distinctiveness, 324
- single trade source requirement, 318-319
- statutory definitions
 - "distinctive", "sign" and "trademark", 317-318

G

Goodwill and Reputation

- bankruptcy, 306-308
- cessation and startup of business
 - advertising prior to trading, 92-93
 - effect of cessation, 90-92
 - goodwill ownership, 93-94
- creation of goodwill without Canadian trading activity, 74-78
 - bad faith, significance of, 78
 - passing off, in absence of bad faith, 79
- enforcement and freedom of competition, balancing of, 104-107
- functionality
 - negation of trademark protection, 73-74
- get-up
 - goodwill in get-up, 71-72
- goodwill attributes
 - assignability, 66
 - bad faith, relevant factor, 67
 - creation of, 66-67, 74-79
 - generally, 65
 - meaning of, 67-68
 - property rights, 65-66
 - value, 66
- legal vs. beneficial ownership, 94-96
- non-trading entities
 - general, 99-101
 - proof of damage to goodwill, 102-103
 - religious institutions, 101-102
- ownership and proof of goodwill
 - assignments without goodwill, 81-82
 - distributor's separate goodwill, 86
 - entitlement to sue for damage to, 83-84

Goodwill and Reputation — continued

- ownership of, question of fact, 82-83
- reputation abroad may not avail a defendant, 79-80
- shared goodwill, 86-90
- surveys as proof, 81
- parody
 - spoofs, 70-71
- reputation
 - goodwill vs. reputation, 68
 - proof of goodwill, 69
 - relevant universe of goodwill, 68-69
- trademark licensing and goodwill, 96-99
- transfer and licensing of goodwill, see Transfer and Licensing of Goodwill

Н

Historical Development of Unfair Competition Law

- Canadian jurisprudence, 19th century, 30-33
- general, 17-18
- Industrial Revolution, 20-21
- introduction, 17-18
- pre-19th century history, 19-20
 - craftsman's marks, 19-20
 - early use of signs, 19
 - merchant's marks, 19
- "Turn on the Facts", 18
- U.K. jurisprudence, 19th century, 21-26
- U.K. trademark legislation, 19th century, 26-27
- U.S. jurisprudence, 19th century, 28

I

Initial Interest Confusion and Keyword Advertising

- case law
 - Canadian jurisprudence
 - Red Label vacations case, 434-436
 - Vancouver Community College case, 436-437
 - U.S. jurisprudence, 437-439
- generally, 433
- metatags and keywords, 159-160, 433-434

Injurious Falsehood

- defamation vs., 123-124
- definition, 121
- generally, 1, 35
- passing off vs., 126

Injurious Falsehood — *continued*

- pleadings, 123
- Trademarks Act, section 7(a), 121-123
- wrongful threats of litigation, 124-125

K

Keyword Advertising, see Initial Interest Confusion and Keyword Advertising

M

Misrepresentations in Passing Off

- actionable misrepresentations, kinds of
 - business relationships, 148-150
 - confusion vs. misrepresentation, 160
 - descriptive names, 152-153
 - false implication of continuation of business, 151-152
 - geographical names, 153-156
 - mere confusion vs. deception, 158-159
 - metatags, 159-160, 433-434
 - permissible co-existence, 150-151
 - personal names, 156-158
- common field of activity
 - generally, 168-170
 - goods given away without charge, 171-172
 - misrepresentation, targets of, 170-171
- confusion, deception and damage
 - confusion and misrepresentation, 199-203
 - difference in geographic markets, 213-214
 - proof of actual confusion, 215-216
 - similarity of goods or services, 206-208
 - similarity of respective trademarks, 203-206
 - strength of plaintiff's trademark, 211-212
 - trade and marketing methods, nature of, 208-209
- constitutionality of section 7(b) of *Trademarks Act*, 160
- deceive, likely to
 - calculated to deceive vs. "likely to deceive", 180-181
 - common field of activity, 182-184
 - disparate fields, plaintiff successful, 186-187
 - disparate fields, plaintiff unsuccessful, 184-185
 - internet issues
 - internet misrepresentation, 192-194
 - Ontario Corporations Act (section 13)(1)(a)), 181-182
 - targets of misrepresentation, 190-192
- direct competition of parties, not essential
 - injunctions, geographical restrictions, 142

Misrepresentations in Passing Off — continued

- no need for direct competition in the same area, 142
- essential elements of
 - common field of activity, not essential, 128
 - fact-driven, 129
 - general, 127
 - proof of damage, importance of, 127
 - puffing, 128
- extending passing off
 - extending scope of, 194-198
 - trap orders, 198-199
- fair use
 - descriptive words, 138
 - truth of representation, 136-137
- false representations
 - defendant's conduct, effect of, 132
 - goodwill and likelihood of confusion, 131
 - likelihood of confusion, principles, 129-130
 - misrepresentation essential basis, 129
 - significance of descriptiveness/functionality, 132
- fame
 - relevance in proving confusion, 176-178
- intent to deceive, proof of, relevant but not essential, 164
 - dishonestly may be material, 165
 - evidence is material not conclusive, 164-165
 - imitation of non-protectable features, 165-166
 - parties need not be competitors, 166-167
- joint tortfeasors
 - generally, 173-174
 - proof of fraud, 175-176
- non-trading entities
 - non-profit "traders", 178-180
- proof of confusion
 - burden of proof, 146-147
 - level of proof, 143-144
 - survey evidence, 144-146
- relevance of representation
 - confusion does not imply misrepresentation, 133-134
 - contextual importance, 134
 - expiration of monopoly in sale of goods, 134-136
 - proof of misrepresentation, 136
- Trademarks Act
 - provisions, 138

Misrepresentations: Evidence and Examples

- examples leading to passing off
 - overview, 262-263
 - parties are competitors, 263-264
 - parties are not competitors, 264-266
- introduction
 - confusion is likely, how to decide if, 259
 - degree of resemblance, 260-261
 - descriptive components, 261-262
 - fame, 262
 - goods and services, gaps between respective, 262

P

Paris Convention

• article10bis, 1-2

R

Remedies

- acquiescence
 - Anton Piller orders, 289-291
 - delay, vs., 289
 - injunctive relief, relevance to, 288
- damages and profits
 - calculation, accounting of profits, 291-294
- injunctions
 - interim and interlocutory
 - extraordinary remedies, 276-278
 - irreparable harm, clear, not speculative, 280-281
 - irreparable harm, proof of, essential to relief, 278
 - permanent
 - considerations for, 286-287
 - subject to equitable considerations, 287-288
- irreparable harm, 273
 - American Cyanamid guidelines, 274-275, 284
 - balance of convenience, 284-285
 - expert evidence, 282-283
 - loss of sales/goodwill, 281-282
 - requires proof, not interference, 273
 - Trademarks Act, 2019, effect of, 275-276
- main remedies, 273

Reputation, see Goodwill and Reputation

 \mathbf{S}

Survey Evidence

- admissibility, 419-420
 - contrary to judge's common sense, discounted, 420
 - surveys acceptable as evidence, 419
- choice of control, 423-426
- expert evidence, admissibility of, 419-420
- *Mohan* principles
 - assistance to court, 422-423
- generally, 421-422
- social science proof
 - generally, 427-428
 - U.K. surveys, 428-429
 - U.S. surveys, 429-431

Т

Trademark Law Revision Committee

- Committee Report, 2
- dilution protection recommendations, 246-247

Trademarks Act

- constitutionality of section 7(b), 160
- dilution, 243-244
- "distinctive", "sign" and "trademark", 317-318
- free-riding, 247-248
- misrepresentations in passing off, 138
- transfer of goodwill, 298-300
- unfair trading conduct, passing off, 36
- wrongful interference with economic relations, 109, 119-120

Trade Secrets, see Confidential Information and Trade Secrets

Transfer and Licensing of Goodwill

- bankruptcy
 - goodwill, 306-308
- licensing
 - competition by licensor, post-assignment, 305-306
 - control of licensee, 303-304
 - trademark licensing, 301-303
 - unwritten licenses, 304-305
- residual goodwill
 - generally, 308-309
- transfer
 - distinctiveness, 300-301
 - in gross, 297-298

Transfer and Licensing of Goodwill — continued

- proper assignment, effect of, 300
- trade names, 298
- trademark property rights, 300
- Trademarks Act, section 48, 298-300

U

Unfair Competition

- Code Civil du Québec, see Civil Code of Québec
- Competition Act, trading offences, 1
- confusion
 - likely to cause, 1, 129-130
 - types of, 10-16
- constitutional issues, 3-5
 - section 7(b), 3-4
 - section 7(e), 5-6
 - section 21(1), 7
 - tradenames, 6
- false or misleading advertising, 1, 9, 15
- freedom of competition, 9
- free-riding, 1, 13-14
- general, 1
- goodwill, depreciation of, 1
- historical development, see Historical Development of Unfair Competition Law
 - imitation, 15
- injurious falsehood, see Injurious Falsehood
- introduction, 1
- misrepresentation, 10
- provincial consumer protection statutes, offences, 1
- scope of treatise, 1
- trade disparagement, 1
- trade secrets, misappropriation, 1
- trademark dilution, 14-15
- trademark enforcement, 9
- U.K. jurisprudence, 8, 21-22

Unfair Trading Conduct

- passing off, 36-48
 - confusion demonstrates existence of goodwill, 42
 - essential elements of, 39-40
 - goodwill, definition of, 40-42
 - injurious falsehood, 42-46
 - Trademarks Act, section 7(b), 36

Unfair Trading Conduct — *continued*

- trading misconduct vs. freedom of competition, 37-39
- unlawful interference with economic relations, 36, 46-48
- types of unfair competition
 - injurious falsehood, see Injurious Falsehood, 35
 - passing off, 35
 - trading wrongs, 35
 - wrongful interference with economic relations, see Wrongful Interference with Economic Relations

W

Wrongful Interference with Economic Relations

- Competition Act, section 52(1), 109-110
- elements of tort, 109
- Federal Court of Canada lacks jurisdiction, 111
- generally, 36, 46-48
- intent to injure and unlawful means, 110-111
- preserving trademark rights, defence of
 - justification, 114-115
- scope of tort
- scope of tort of unlawful interference with contractual relations, 111-114
 - breach of contract, inducing, 117-119
 - broader than interference with economic relations, 116-117
- Trademarks Act, section 7(a), 109, 119-120
- unlawful means, independently actionable, 115-116