

TABLE OF CONTENTS

<i>Dedication</i>	iii
<i>Foreword</i>	v
<i>Preface</i>	vii
<i>Table of Cases</i>	xxvii
Chapter 1: INTRODUCTION	1
I. General	1
§ 1.1 Scope of this treatise	1
II. Paris Convention	1
§ 1.2 Article 10 <i>bis</i>	1
III. Canada: Trade Mark Law Revision Committee	2
§ 1.3 Committee report	2
IV. Trademark Treaties	3
§ 1.4 Treaties entered into by Canada are not self-executing	3
V. Constitutional Issues	3
§ 1.5 Section 7(b) and the Constitution	3
§ 1.6 Section 7(e)	5
§ 1.7 Constitutional issues relating to trade names	6
§ 1.8 Section 21(1)	7
VI. Code Civil du Québec	7
§ 1.9 The Québec Civil Code	7
VII. U.K. Jurisprudence	8
§ 1.10 Influence of U.K. jurisprudence on Canadian case law	8
VIII. Trademark Enforcement v. Freedom of Competition	9
§ 1.11 Enforcement of trademark rights and the public interest in freedom of competition	9
§ 1.12 Tension between trademark dilution enforcement and freedom of competition	9
IX. Unfair Competition in General	10
§ 1.13 Misrepresentation: the foundation of passing off	10
§ 1.14 Types of confusion	10
§ 1.15 Similarity between protected trademark and accused trademark or trade name	10
§ 1.16 Product types	11
§ 1.17 Business association, sponsorship or approbation	11
§ 1.18 Misleading representations concerning the quality or nature of a trader's own goods or services	11
§ 1.19 Puffing	12
§ 1.20 False allegations tending to discredit a competitor	12

§ 1.21	Breach of confidence and theft of trade secrets and know-how	12
§ 1.22	Free riding	13
§ 1.23	Trademark dilution	14
§ 1.24	Slavish imitation	15
§ 1.25	False or misleading advertising.....	15
§ 1.26	Comparative advertising.....	15

Chapter 2: HISTORICAL DEVELOPMENT OF UNFAIR COMPETITION
LAW 17

I.	Introduction	17
§ 2.1	General	17
§ 2.2	Unfair competition cases generally turn on the facts.....	18
II.	Pre-19th Century History	19
A.	Early Use of Signs	19
§ 2.3	Trademarks as source indicia	19
B.	Merchant's Marks and Craftsman's Marks.....	19
§ 2.4	Merchant's Marks	19
§ 2.5	Craftsman's Marks.....	19
§ 2.6	Relationship between consumers and makers.....	20
III.	Industrial Revolution	20
§ 2.7	Effect of industrial revolution on trademark evolution	20
IV.	19th Century UK Jurisprudence	21
§ 2.8	Common law	21
§ 2.9	Equity suits	22
§ 2.10	<i>Millington v. Fox</i>	24
§ 2.11	Requisites of proof.....	25
V.	U.K. Trademark Legislation	26
§ 2.12	19th century legislation.....	26
VI.	U.S. Historical Beginnings.....	28
§ 2.13	19th century U.S. jurisprudence.....	28
VII.	Canadian Jurisprudence	30
§ 2.14	19th century	30
§ 2.15	Québec	33

Chapter 3: OVERVIEW OF UNFAIR TRADING CONDUCT 35

I.	Types of Unfair Competition Involving Trademarks or Trade Names.....	35
§ 3.1	Typical kinds of trading wrongs	35
§ 3.2	Passing off	35
§ 3.3	Injurious falsehood.....	35
§ 3.4	Wrongful interference with economic relations	36
II.	Passing Off.....	36
§ 3.5	Section 7(b) of the <i>Trademarks Act</i>	36

§ 3.6	Trading misconduct vs. freedom of competition	37
§ 3.7	Essential elements of passing off.....	39
§ 3.8	Definition of goodwill	40
§ 3.9	Existence of confusion may demonstrate existence of goodwill	42
§ 3.10	Injurious falsehood.....	42
§ 3.11	Unlawful interference with economic relations.....	46
Chapter 4: CUSMA, TRIPS AND THE <i>TRADEMARKS ACT</i>		49
I.	General	49
§ 4.1	CUSMA, NAFTA and TRIPS	49
§ 4.2	CUSMA is not self-executing	49
§ 4.3	Court may refer to CUSMA or TRIPS to resolve legislative ambiguities	50
§ 4.4	CUSMA and TRIPS	50
II.	Nature and scope of CUSMA and TRIPS obligations.....	51
§ 4.5	Both treaties provide maximum standards	51
A.	Intellectual Property Conventions.....	51
§ 4.6	Compliance with other treaties	51
B.	National Treatment.....	52
§ 4.7	National treatment an essential condition of CUSMA and TRIPS.....	52
C.	Exhaustion	52
§ 4.8	Principle of exhaustion does not apply	52
D.	Dispute Settlement	53
§ 4.9	Adjudication of disputes.....	53
III.	Standards concerning trademarks	53
§ 4.10	CUSMA, Article 20, Section C.....	53
A.	“Trademark” is not Defined.....	53
§ 4.11	Article 20.17.....	53
§ 4.12	TRIPS, Article 15.26	54
§ 4.13	Section 32(1) of the <i>Trademarks Act</i>	54
§ 4.14	Preliminary view of non-distinctiveness.....	54
B.	Enforceability of Registrations	55
§ 4.15	Effect of registration	55
C.	Responses to Refusals to Register; Appeals.....	56
§ 4.16	Requirements of registration system	56
D.	Well-Known Marks.....	56
§ 4.17	Article 6bis of the Paris Convention	56
E.	Term and Termination	57
§ 4.18	Registration duration, renewal	57
F.	Licensing and Assignment	58
§ 4.19	Licensing and assignment permitted; compulsory licensing forbidden	58

	G. General.....	58
	§ 4.20 Marking associated with licensed use.....	58
IV.	Geographical Indications.....	59
	§ 4.21 Definition of “geographical indication”.....	59
	§ 4.22 Definition of geographical indications in the <i>Trademarks Act</i>	59
	§ 4.23 TRIPS and CUSMA provisions relating to geographical indications.....	60
V.	Enforcement.....	61
	A. General.....	61
	§ 4.24 IP enforcement under CUSMA and TRIPS.....	61
	B. Specific Enforcement Procedures.....	61
	§ 4.25 Enforcement provisions.....	61
	C. Provisional Measures.....	62
	§ 4.26 Interlocutory or interim measures.....	62
	D. Criminal Procedures and Penalties.....	62
	§ 4.27 Criminal enforcement provisions.....	62
	E. Enforcement of Intellectual Property Rights at the Border.....	63
	§ 4.28 Border provisions.....	63
VI.	Conclusion.....	64
	§ 4.29 No significant conflicts with current Canadian law.....	64
V.	Functionality.....	73
	Chapter 5: GOODWILL AND REPUTATION.....	65
I.	Goodwill Attributes.....	65
	§ 5.1 Goodwill and reputation.....	65
	§ 5.2 Goodwill is a property right.....	65
	§ 5.3 Value of a trademark is in the goodwill it represents.....	66
	§ 5.4 Property in goodwill is assignable.....	66
	§ 5.5 Creation of goodwill.....	66
	§ 5.6 Bad faith is a relevant factor.....	67
	§ 5.7 Meaning of goodwill.....	67
II.	Reputation.....	68
	§ 5.8 Goodwill vs. reputation.....	68
	§ 5.9 The relevant universe of goodwill.....	68
	§ 5.10 Proof of goodwill.....	69
III.	Parody.....	70
	§ 5.11 Spoofs.....	70
IV.	Get-Up.....	71
	§ 5.12 Goodwill in get-up.....	71
V.	Functionality.....	73
	§ 5.13 Functionality may negate trademark protection.....	73
VI.	Creation of goodwill without trading activity in Canada.....	74

	§ 5.14 Creation of goodwill without prior trading activity in Canada	74
VII.	Bad Faith.....	78
	§ 5.15 Significance of bad faith.....	78
	§ 5.16 Passing off can be found in the absence of bad faith	79
VIII.	Ownership and Proof of Goodwill.....	79
	§ 5.17 Reputation abroad may not avail a defendant	79
	§ 5.18 Surveys as proof of goodwill	81
	§ 5.19 Assignments without goodwill	81
	§ 5.20 Ownership of goodwill is a question of fact	82
	§ 5.21 Usually distributors are not considered the “source”	83
	§ 5.22 Entities entitled to sue for damage to goodwill	83
	§ 5.23 Use of foreign manufacturer’s mark by distributor	85
	§ 5.24 Distributor’s separate goodwill	86
	§ 5.25 Shared goodwill	86
IX.	Cessation and Start-up of Business.....	90
	§ 5.26 Effect of cessation of business on goodwill	90
	§ 5.27 Advertising prior to trading.....	92
	§ 5.28 Goodwill ownership	93
X.	Legal vs. Beneficial Ownership	94
	§ 5.29 Legal vs. beneficial ownership of a trademark and concomitant goodwill	94
XI.	Trademark Licensing and Goodwill.....	96
	§ 5.30 Licensing and goodwill.....	96
XII.	Non-Trading Entities	99
	§ 5.31 Non-trading entities	99
	§ 5.32 Religious institutions	101
	§ 5.33 Proof of damage to goodwill.....	102
XIII.	Balancing Enforcement and Freedom of Competition	104
	§ 5.34 Trademark rights should be balanced with the right of freedom of competition.....	104
Chapter 6: WRONGFUL INTERFERENCE WITH ECONOMIC RELATIONS.....		109
I.	General	109
	§ 6.1 Common law elements of the tort	109
	§ 6.2 Section 7(a) of the <i>Trademarks Act</i>	109
	§ 6.3 <i>Competition Act</i> , section 52(1).....	109
	§ 6.4 Common law: intent to injure and unlawful means.....	110
	§ 6.5 Federal Court of Canada lacks jurisdiction	111
	§ 6.6 Scope of tort of unlawful interference with contractual relations	111
II.	Defence of Preserving Trademark Rights.....	114
	§ 6.7 Justification based on preservation of trademark rights	114

III.	Unlawful Means.....	115
	§ 6.8 Independently actionable “unlawful means”	115
IV.	Scope of Tort.....	116
	§ 6.9 Scope of tort is broader than tort of interference with economic relations	116
	§ 6.10 Intention targeting must be deliberate	117
	§ 6.11 Inducing breach of contract.....	117
V.	Section 7(a) of <i>Trademarks Act</i>	119
	§ 6.12 Section 7(a) of <i>Trademarks Act</i>	119
Chapter 7: INJURIOUS FALSEHOOD		121
I.	Definition.....	121
	§ 7.1 Definition of “injurious falsehood”	121
II.	Section 7(a) of <i>Trademarks Act</i>	121
	§ 7.2 Contrast with section 7(a) of the <i>Trademarks Act</i>	121
III.	Pleadings.....	123
	§ 7.3 Pleadings must particularize the alleged offence.....	123
IV.	Defamation	123
	§ 7.4 Defamation vs. injurious falsehood.....	123
V.	Wrongful Threats of Litigation	124
	§ 7.5 <i>S. & S. Industries Inc. v. Rowell</i>	124
	§ 7.6 Statements must be factual.....	125
	§ 7.7 Proof of damage	125
VI.	Passing Off vs. Injurious Falsehood	126
	§ 7.8 Distinction between passing off and injurious falsehood	126
Chapter 8: MISREPRESENTATIONS IN PASSING OFF		127
I.	Essential Elements of Passing Off.....	127
	§ 8.1 General	127
	§ 8.2 Importance of proof of damage.....	127
	§ 8.3 Common field of activity is not essential	128
	§ 8.4 Puffing	128
	§ 8.5 Passing off cases are fact-driven	129
II.	False Representations.....	129
	§ 8.6 Misrepresentation is an essential basis for passing off.....	129
	§ 8.7 Principles of likelihood of confusion.....	129
	§ 8.8 Misrepresentation as to provenance of the goods	130
	§ 8.9 Goodwill and likelihood of confusion.....	131
	§ 8.10 Significance of descriptiveness, functionality	132
	§ 8.11 Effect of defendant’s conduct	132
III.	Relevance of Representation	133
	§ 8.12 Confusion does not necessarily imply misrepresentation	133
	§ 8.13 Importance of context	134
	§ 8.14 Expiration of monopoly in sale of goods.....	134

	§ 8.15 Proof of misrepresentation	136
IV.	Fair Use.....	136
	§ 8.16 Truth of representation	136
	§ 8.17 Descriptive words.....	138
V.	<i>Trademarks Act</i>	138
	§ 8.18 <i>Trademarks Act</i> provisions	138
	§ 8.19 Trade names	141
	§ 8.20 Passing off does not create a monopoly.....	141
VI.	Direct Competition of Parties Not Essential	142
	§ 8.21 Parties need not be in direct competition in the same area.....	142
	§ 8.22 Geographical restriction to injunction	142
	§ 8.23 Hypothetical use in relation to registrations	143
VII.	Proof of Confusion	143
	§ 8.24 Level of proof of likelihood of confusion	143
	§ 8.25 Survey evidence to prove confusion.....	144
	§ 8.26 Burden of proof of misrepresentation.....	146
VIII.	Kinds of Actionable Misrepresentations	148
	§ 8.27 Misrepresentation as to business relationship.....	148
	§ 8.28 Permissible coexistence of similar marks/names	150
	§ 8.29 False implication of continuation of business	151
	§ 8.30 Descriptive names	152
	§ 8.31 Descriptive names constituting misrepresentation	153
	§ 8.32 Geographical names.....	153
	§ 8.33 Personal names	156
	§ 8.34 Distinction between “mere confusion” and deception	158
	§ 8.35 Metatags	159
	§ 8.36 Confusion vs. misrepresentation	160
IX.	Constitutionality of Section 7(b).....	160
	§ 8.37 Constitutionality of section 7(b)	160
	§ 8.38 Section 7(b) and likelihood of confusion.....	161
	§ 8.39 Many unauthorized uses of plaintiff’s trademarks or trade names are not illegal	161
	§ 8.40 Parody, criticism	163
X.	Proof of Intention to Deceive Relevant but not Essential	164
	§ 8.41 Misrepresentation does not require proof of fraud or intention to deceive	164
	§ 8.42 Evidence of intention to deceive is material even if not conclusive.....	164
	§ 8.43 Dishonesty may be material	165
	§ 8.44 Imitation of non-protectable features.....	165
	§ 8.45 Parties need not be competitors for passing off to apply....	166
	§ 8.46 Section 7(a).....	168
XI.	Common Field of Activity	168
	§ 8.47 Common field of activity.....	168

	§ 8.48 Targets of misrepresentations	170
	§ 8.49 Goods given away without charge	171
XII.	Joint Tortfeasors	173
	§ 8.50 Joint tortfeasors	173
	§ 8.51 Proof of fraud	175
XIII.	Fame.....	176
	§ 8.52 Relevance of fame in proving likelihood of confusion.....	176
XIV.	Non-Trading Entities	178
	§ 8.53 Non-profit “traders”	178
XV.	Likely to Deceive	180
	§ 8.54 Calculated to deceive vs. “likely to deceive”	180
	§ 8.55 Section 13(1)(a) of the Ontario <i>Corporations Act</i>	181
	§ 8.56 Common field of activity	182
	§ 8.57 Disparate fields, plaintiff unsuccessful	184
	§ 8.58 Disparate fields, plaintiff successful	186
	§ 8.59 How can the court determine likelihood of confusion without survey or expert evidence?	187
	§ 8.60 Targets of misrepresentation.....	190
XVI.	Internet Issues.....	192
	§ 8.61 Internet misrepresentation	192
XVII.	Extended Passing Off	194
	§ 8.62 Extended scope of passing off	194
	§ 8.63 Trap orders	198
XVIII.	Confusion, Deception and Damage	199
	§ 8.64 Confusion and misrepresentation.....	199
	§ 8.65 The similarity of the respective trademarks, or trademark and trade name	203
	§ 8.66 Similarities in goods or services, and channels of trade.....	206
	§ 8.67 Nature of the trade and marketing methods	208
	§ 8.68 The level of sophistication of the prospective purchasers for the respective parties’ goods or services	209
	§ 8.69 The strength of the plaintiff’s trademark	211
	§ 8.70 Likelihood of expansion of trade: effect on goodwill	212
	§ 8.71 Differences in geographic markets	213
	§ 8.72 Intention to deceive as a factor	215
	§ 8.73 Proof of actual confusion	215
	Chapter 9: DAMAGE.....	217
I.	Damage is the <i>Sine Qua Non</i>	217
	§ 9.1 Damage is the <i>sine qua non</i> for proving passing off	217
II.	Kinds of Damage	219
	§ 9.2 Kinds of damage protected by unfair competition law.....	219
	§ 9.3 Cases where damage has wrongly been presumed	219
III.	Proof.....	221

§ 9.4	Proving damage or likely damage.....	221
§ 9.5	Proof of likely damage in interlocutory injunction applications	222
§ 9.6	Damage in U.S. case law.....	223
§ 9.7	Canada: proof of damage or likely damage must be real and substantial.....	224
§ 9.8	Damage resulting from loss of control.....	225
§ 9.9	Liability of directors, officers for damages.....	227
§ 9.10	Damage is now the <i>sina qua non</i> for passing off	228
§ 9.11	Damage irrelevant unless misrepresentation affecting goodwill has been proved	229
§ 9.12	Proof is easier when parties directly compete	230
§ 9.13	Proof of damage	230
§ 9.14	Effect of licensed use	232
§ 9.15	Categories of damage	234
§ 9.16	Loss of sales, or predicted loss of sales.....	234
§ 9.17	Defendant's goods are counterfeit or markedly inferior in quality.....	235
§ 9.18	Injurious association	236
§ 9.19	Reputation damage among other traders	236
§ 9.20	Confusion alone is usually not enough to prove damage ...	237
§ 9.21	Loss of potential licensing opportunities.....	239
§ 9.22	Risk of damage to plaintiff's reputation	239
§ 9.23	Natural expansion of defendant's business.....	240
IV.	Loss of Distinctiveness	240
§ 9.24	Loss of distinctiveness	240
§ 9.25	Reverse passing off.....	241
	Chapter 10: DILUTION	243
I.	Section 22 of the <i>Trademarks Act</i>	243
§ 10.1	Dilution is a statutory tort applicable to registered trademarks	243
§ 10.2	Proof of confusion is not necessary	243
§ 10.3	Scope of section 22 not well-defined	243
II.	Proof of depreciation of goodwill	244
§ 10.4	Proof of dilution	244
§ 10.5	Criteria for proving dilution	245
§ 10.6	Mental association is necessary.....	246
§ 10.7	Dilution protection as recommended by Trade Mark Law Revision Committee	246
III.	Free Riding.....	247
§ 10.8	Is free-riding an offence under section 22(1)?.....	247
§ 10.9	Uniqueness.....	250
§ 10.10	Similarity of goods or services not essential	250

	§ 10.11 Reputation should extend beyond owner's goods or services	251
	§ 10.12 Relevant date of sufficient reputation	252
	§ 10.13 Required level of public awareness	252
IV.	Parody	254
	§ 10.14 Parodic uses and the <i>Charter</i>	254
V.	Freedom of Expression and Section 22	255
	§ 10.15 Freedom of expression vs. trademark rights	255
Chapter 11: MISREPRESENTATIONS: EVIDENCE AND EXAMPLES		259
I.	Introduction	259
	§ 11.1 How to decide if confusion is likely	259
	§ 11.2 Moron in a hurry vs. careful purchaser	259
	§ 11.3 Degree of resemblance is key	260
	§ 11.4 Descriptive components	261
	§ 11.5 Gap between respective goods/services	262
	§ 11.6 Fame	262
II.	Examples of Misrepresentations Leading to Passing Off	262
	§ 11.7 Three basic kinds of misrepresentations	262
	§ 11.8 The defendant's goods or services are those of the plaintiff	263
	A. Parties are Competitors, and Trademarks are Closely Similar	263
	B. Parties are not Competitors	264
	§ 11.9 Effect of guilty motive when parties are not competitors ...	264
	§ 11.10 Use of defendant's own name	265
	§ 11.11 The defendant's goods or services have been approved, authorized or endorsed by the plaintiff	268
	§ 11.12 There is a business connection of some kind between the defendant and the plaintiff	269
	§ 11.13 Concurrent use for years without evidence of confusion	271
Chapter 12: REMEDIES		273
I.	Introduction	273
	§ 12.1 Main remedies	273
II.	Irreparable harm	273
	§ 12.2 Irreparable harm	273
	§ 12.3 Irreparable harm in general requires proof, not inference ..	273
	§ 12.4 <i>American Cyanamid</i> guidelines	274
	§ 12.5 Effect of the <i>Trademarks Act, 2019</i>	275
III.	Interim and Interlocutory Injunctions	276
	§ 12.6 Interim or interlocutory injunctions are extraordinary remedies	276
	§ 12.7 Proof of irreparable harm normally is essential to relief	278

	§ 12.8	Serious question to be tried	278
	§ 12.9	<i>Woods</i> exception	279
	§ 12.10	Irreparable harm must be clear and not speculative	280
IV.		Kinds of Irreparable Harm	281
	§ 12.11	Kinds of irreparable harm: loss of sales, loss of goodwill	281
	§ 12.12	Expert evidence should not contradict common sense	282
	§ 12.13	Balance of convenience	284
V.		Permanent Injunctions	286
	§ 12.14	Permanent injunction considerations	286
	§ 12.15	Injunctions are subject to equitable considerations	287
VI.		Acquiescence	288
	§ 12.16	Acquiescence — relevance to injunctive relief	288
	§ 12.17	Acquiescence vs. delay	289
	§ 12.18	Anton Piller orders	289
VII.		Damages and Profits	291
	§ 12.19	Calculation of damages, accounting of profits	291
	§ 12.20	Delivery up	294
Chapter 13: TRANSFER AND LICENSING OF GOODWILL			297
I.		Transfer of Goodwill in Gross	297
	§ 13.1	Transfer of goodwill “in gross”	297
	§ 13.2	Trade names	298
	§ 13.3	Section 48 of the <i>Trademarks Act</i>	298
	§ 13.4	Effect of proper assignment	300
	§ 13.5	Trademarks and property rights	300
	§ 13.6	Distinctiveness	300
	§ 13.7	Division of trademark rights	301
II.		Licensing	301
	§ 13.8	Trademark licensing	301
	§ 13.9	Control of licensee must be exercised in fact	303
	§ 13.10	Unwritten licences	304
	§ 13.11	Competition by licensor post assignment	305
III.		Bankruptcy	306
	§ 13.12	Bankruptcy and goodwill	306
IV.		Residual Goodwill	308
	§ 13.13	Residual goodwill	308
Chapter 14: DISTINCTIVENESS			311
I.		Introduction	311
	§ 14.1	Basis for passing off relief	311
	§ 14.2	Passing off may take many forms	311
	§ 14.3	Importance of distinctive indicia	312
	§ 14.4	Definition of “sign”	313
	§ 14.5	Distinctiveness is a question of fact	315

	§ 14.6 Distinctiveness in passing off vs. registrability	315
	§ 14.7 Indicia incapable of protection	315
	§ 14.8 When some confusion should be tolerated	316
	§ 14.9 Effect of deception	316
	§ 14.10 Distinctiveness is a question of degree	316
II.	Statutory Definitions	317
	§ 14.11 Statutory definitions of “distinctive”, “sign” and “trademark”	317
III.	Single Trade Source Requirement	318
	§ 14.12 Consumers must rely on indicia as single trade source	318
IV.	Pharma Cases	319
	§ 14.13 Pharma pills and tablets	319
	§ 14.14 Protection of inherently distinctive marks vs. less distinctive marks	322
	§ 14.15 Advertising should avoid descriptiveness	322
V.	Secondary Meaning	323
	§ 14.16 Effect of secondary meaning	323
	§ 14.17 Small differences may avoid confusion if plaintiff’s mark has little distinctiveness	324
	§ 14.18 Effect of bad faith	325
VI.	Functionality	325
	§ 14.19 Functionality is a question of degree	328
	§ 14.20 Aesthetic functionality	329
	§ 14.21 Relevance of prior industrial design registration	330
	§ 14.22 Packaging shapes	330
VII.	Injunctions	332
	§ 14.23 Injunctions should be specific	332
VIII.	Acquisition of Distinctiveness	333
	§ 14.24 Acquisition of distinctiveness	333
	§ 14.25 <i>Polaroid</i> test	333
	§ 14.26 Principle to be applied in assessing distinctiveness	334
	§ 14.27 Sufficiency of prior use	334
	§ 14.28 Influence of bad faith	335
	§ 14.29 Descriptive names	336
IX.	Use as a Trademark is Essential	337
	§ 14.30 Both plaintiff’s mark and accused mark must be used as a trademark	337
	§ 14.31 When descriptors can acquire secondary meaning	338
	§ 14.32 Consumers need not know name of source	339
	§ 14.33 Consumers may refer to trademark otherwise than intended by owner	340
	§ 14.34 Concurrent use of similar marks/names in same territory ..	340
	§ 14.35 Surnames and given names	341
	§ 14.36 Use of same trademark in other fields	342

	§ 14.37 Protection of descriptors or highly suggestive marks is problematic	342
	§ 14.38 Importance of good faith adoption.....	343
	§ 14.39 Geographical extent of renown.....	343
	§ 14.40 Trademarks having dual significance	344
	§ 14.41 Effect of prior monopoly.....	344
X.	Loss of Distinctiveness	346
	§ 14.42 Gradual loss of distinctiveness.....	346
	§ 14.43 Assessing likelihood of confusion	347
XI.	Proving Distinctiveness.....	350
	§ 14.44 Surveys and market research experts	350
	§ 14.45 Additional issues for determining confusion	352
	§ 14.46 Mythical “average” consumer	354
	§ 14.47 Weight is discounted for non-distinctive or suggestive elements	357
	§ 14.48 Respective suggestive ideas	358
	§ 14.49 Ordering devices.....	358
	§ 14.50 Notoriety of plaintiff’s trademark.....	359
	§ 14.51 Disclaimers	360
	§ 14.52 Effect of virtual monopoly	361
	§ 14.53 Trademark is understood to be the name of the goods	362
	§ 14.54 Generic vs. descriptive.....	363
	§ 14.55 “Fancy” words.....	369
	§ 14.56 Use as trademark is essential.....	373
	§ 14.57 Initials.....	377
	§ 14.58 Slogans	379
	§ 14.59 Product get-up	382
	§ 14.60 Imitation of packaging designs	390
	§ 14.61 Single colours.....	393
	§ 14.62 Keywords.....	395
	§ 14.63 Sounds	399
	Chapter 15: DEFENCES	401
I.	Clean Hands	401
	§ 15.1 Importance of equitable conduct	401
II.	Descriptive Uses.....	403
	§ 15.2 Descriptive uses and uses other than as a trademark	403
III.	Acquiescence	404
	§ 15.3 Acquiescence	404
	§ 15.4 Public policy considerations	406
IV.	Concurrent Use.....	406
	§ 15.5 Concurrent use.....	406
	§ 15.6 Parallel importation	408
	§ 15.7 Quality differences, compliance with Canadian regulations	410

§ 15.8	Charter defence	413
§ 15.9	Parody	414
§ 15.10	Freedom of expression is not absolute	416
Chapter 16: SURVEY EVIDENCE		419
I.	Admissibility of Survey and Expert Evidence.....	419
§ 16.1	Surveys are now accepted as evidence in trademark cases..	419
§ 16.2	Surveys and expert evidence may be discounted if contrary to judge's application of common sense	420
II.	<i>Mohan</i> principles.....	421
§ 16.3	<i>R. v. Mohan</i>	421
§ 16.4	When surveys are of assistance to the court.....	422
III.	Control	423
§ 16.5	Choice of control	423
IV.	Social Science Proof	427
§ 16.6	Social science evidence	427
§ 16.7	U.K. surveys	428
§ 16.8	United States surveys	429
Chapter 17: INITIAL INTEREST CONFUSION AND KEYWORD ADVERTISING		433
I.	Canadian Jurisprudence	433
§ 17.1	Initial interest confusion.....	433
§ 17.2	Metatags and keywords.....	433
§ 17.3	<i>Red Label Vacations</i> case.....	434
§ 17.4	<i>Vancouver Community College</i> case.....	436
II.	U.S. Jurisprudence	437
§ 17.5	U.S. jurisprudence.....	437
Chapter 18: DECEPTIVE MARKETING PRACTICES.....		441
I.	Overview of the Federal and Regulatory Regime.....	441
§ 18.1	Criminal vs. civil regime under the <i>Competition Act</i>	441
§ 18.2	Criminal vs. civil sanctions	442
§ 18.3	The Bureau's approach to enforcement	442
§ 18.4	False or misleading advertising may constitute a criminal offence under the <i>Competition Act</i>	443
§ 18.5	Deceptive marketing practices as "reviewable conduct"	446
II.	False or Misleading Advertising	446
§ 18.6	<i>Competition Act</i> legislation	446
III.	Product Claims	449
§ 18.7	Adequate and proper testing is mandatory	449
IV.	Price Claims, Bait & Switch and Selling Above Advertised Price	451
§ 18.8	Sales claims.....	451
V.	Testimonials and Endorsements.....	453

	§ 18.9 Protocols must be followed	453
VI.	Contests	455
	§ 18.10 Contest rules	455
VII.	Anti-Spam Law.....	457
	§ 18.11 2014 Amendments to the <i>Competition Act</i> to address false or misleading representation sender or subject matter information — criminal and civil.....	457
VIII.	Comparative Advertising.....	462
	§ 18.12 Comparative advertising must be truthful, and supported by evidence	462
	§ 18.13 Unsubstantiated comparative claims.....	462
	§ 18.14 Civil remedies for wrongful comparative advertising.....	462
	A. Section 36 and sections 52(1) or 52.01 of the <i>Competition Act</i>	462
	B. Section 7(a) of the <i>Trademarks Act</i>	465
	C. Section 7(b) passing off	466
	§ 18.15 Keyword advertising	466
	§ 18.16 Ambush marketing.....	467
IX.	Self-Regulation of Advertising.....	469
	§ 18.17 The self-regulatory regime for comparative advertising	470
	§ 18.18 <i>Code</i> enforcement.....	471
	§ 18.19 Consumer Complaints Process.....	473
	§ 18.20 Provincial legislation	473
	Chapter 19: CIVIL CODE OF QUÉBEC.....	475
I.	Introduction	475
	§ 19.1 Legal basis of unfair competition under the <i>Civil Code of Québec</i>	475
II.	Conditions for Action under C.C.Q.....	476
	§ 19.2 Conditions for an action in unfair competition.....	476
III.	Types of Faults	477
	§ 19.3 Classification of faults of unfair competition in Québec.....	477
	A. Delict of confusion.....	477
	B. Delict of disparagement.....	478
	C. Delict of disorganization	479
	D. Parasitism	479
IV.	REMEDIES.....	482
	§ 19.4 Available remedies for an action in unfair competition in Québec.....	482
	A. Damages	482
	B. Injunction	483
	C. Punitive damages	483
	D. Restitution of profits.....	484

Chapter 20: CONFIDENTIAL INFORMATION AND TRADE SECRETS

85

I.	Introduction	485
	§ 20.1 General	485
II.	What is a Trade Secret?	486
	§ 20.2 What is a trade secret?	486
	§ 20.3 Three requirements for enforcing confidentiality/trade secrets obligations	487
III.	Confidentiality	487
	§ 20.4 The information must be confidential	487
	§ 20.5 The information was communicated under circumstances of confidence	489
	§ 20.6 The information was or is about to be misused by recipient	490
IV.	Basis for Protection	490
	§ 20.7 Legal basis for the protection of confidential information	490
	§ 20.8 Contract	492
	§ 20.9 Equity	493
	§ 20.10 Property	495
V.	Protectable Information	498
	§ 20.11 The requirement of confidentiality	498
VI.	Inaccessibility/Extent to which Information is Known	498
	§ 20.12 Measures taken to protect secrecy	498
	§ 20.13 Voluntary disclosure	500
	§ 20.14 Reverse engineering	501
VII.	Confidential Relationship	503
	§ 20.15 Obligations of confidence	503
	§ 20.16 Written contract	504
	§ 20.17 Implied contract	504
	§ 20.18 Fiduciary obligations	504
	§ 20.19 Directors and officers	506
	§ 20.20 Obligations imposed by the nature of the trade	506
	§ 20.21 Recoverable disclosure to a third party	507
VIII.	Types of Disclosees	507
	§ 20.22 Employees	507
	§ 20.23 Consultants	511
	§ 20.24 Competitors	513
	§ 20.25 Joint venturists	514
	§ 20.26 Governments	515
	§ 20.27 Thieves	517
IX.	Limitations, Delay and Laches	521
	§ 20.28 Statute of limitations	521
	§ 20.29 Laches, acquiescence and delay	522
X.	Remedies	524

§ 20.30 Remedies for breach of confidence — general	524
§ 20.31 Injunctive relief	525
§ 20.32 Interim and interlocutory injunctions	527
§ 20.33 Permanent injunction	529
§ 20.34 Injunction against springboarding	530
§ 20.35 Anton Piller order	531
§ 20.36 Damages	531
§ 20.37 Accounting of profits	533
§ 20.38 Constructive trust.....	534
XI. Protecting Confidential Information in Litigation.....	537
§ 20.39 Confidentiality orders.....	537
§ 20.40 Courts.....	537
§ 20.41 Protective orders	538
<i>Appendix A — Model Non-Disclosure Agreement</i>	<i>541</i>
<i>Appendix B — Model Confidentiality Order</i>	<i>543</i>
<i>Appendix C — Model Protective Order</i>	<i>545</i>
<i>Index</i>	<i>555</i>