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Canadian Trademarks: How can I win one case and lose another when similar issues and evidence appear to be involved?

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The Canadian Federal Court recently examined this question in reasons for judgment issued in an appeal from a decision of the Registrar of Trademarks involving oppositions to the registration of several related trademark applications, with some interesting reminders about how evidence is weighed.

An applicant applied to register three proposed trademarks featuring the words “VALENTINE” and “SECRET” for use with goods in the area of women’s clothing. An opponent opposed based on registration of several marks for similar goods featuring the word “SECRET”, alleging that the applied-for marks are not registrable on the basis of reasonable likelihood of confusion with the opponent’s previously-registered marks. The Opponent filed affidavit evidence and was cross-examined by the applicant, but the applicant filed no further evidence on its own behalf. In its decision, the Registrar sided with the opponent and refused to register the applied-for marks.

On appeal to the Federal Court, further evidence was filed by both parties, and one of the issues discussed by the Court dealt with recent divergent decisions previously issued by the Court about the likelihood of confusion between marks containing the word “SECRET” in the market for women’s clothing. In one of those decisions, the applicant’s “VALENTINE SECRET” marks were found not likely to be confusing with a third party’s marks featuring the words “VICTORIA’S SECRET”. In another decision, another third party’s mark “WOMEN’S SECRET” was found likely to create confusion with the opponent’s “SECRET” marks.

The issue of the divergent cases was discussed by the Federal Court since both parties made reference to it in supporting their positions before the Court. Each party claimed that judicial comity should lead the Court to follow the conclusions reached by the Court in a previous decision. Judicial comity is the principle that certainty in the law is encouraged in preventing the creation of conflicting lines of jurisprudence by different judges of the same Court.

The Court indicated that the position of neither party should be followed in this instance since judicial comity only applies to determinations of law (that is, the principle upon which the case is decided) and has no application to findings of facts where there is a “different factual matrix or evidentiary basis between the two cases”. Here, the Court held that the doctrine of judicial comity cannot be invoked to trump a trial judge’s role in assessing evidence as it unveils before him or her.

The applicant noted before the Court that it filed the exact same evidence this time as its “further evidence” on appeal and argued that the Court should find that there is no reasonable likelihood of confusion and set aside the Registrar’s decisions. However, the



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Court noted that the totality of the evidence should be considered and that confusion between a different set of trademarks is before the Court in this case. The judge commented in his reasons that he will be mindful of findings made by colleague judges in the previous cases, but must assess the current case based on the evidence and arguments of the current case.

The case is interesting because it reminds us that each case is different and care should be taken in deciding what evidence should be placed on the record, given the specific legal issues that are important in the case.

The reasons of the Court are set out in full at *Eclectic Edge Inc. v. Gildan Apparel (Canada)* LP 2015 FC 1332 and may be accessed through the Federal Court website at <http://decisions.fct-cf.gc.ca/fc-cf/decisions/en/item/127100/index.do?r=AAAAAQAIZWNsZWN0aWMB>

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