

TABLE OF CONTENTS

Preface	iii
Dedication	v
Table of Cases	xvii
CHAPTER 1: The Brand	
1. Introduction	1
2. Brand Components	1
3. Brand Image	5
4. Brand Equity	6
5. Brand Extensions	8
6. Brand Systems	10
7. Co-Branding	12
8. Summary and Checklist	13
CHAPTER 2: Selecting A Brand Name	
1. Introduction	15
2. Choosing a Brand Name	15
a) Desirable Brand Name Characteristics	16
b) Cautions	17
3. Brand Extensions	19
4. Name Changes	19
5. International Considerations	20
a) Brand Names	20
b) Brand Image	21
6. Trade Mark Protection in Canada	21
a) Amendments to the <i>Trademarks Act</i>	24
b) The <i>Combating Counterfeit Products Act</i>	24
c) The <i>Economic Action Plan Act, No. 1</i> (Amending Act)	25
i) Registration Without Use	25
ii) Changes in Nomenclature	25
iii) Certification Marks	26
iv) Distinctiveness	26
v) Distinguishing Guise	27
vi) Broadened Scope for Applications	27
vii) Entitlement	28

TABLE OF CONTENTS

viii) Not to Limit any Art or Industry	29
ix) Utilitarian Function	29
x) The Nice Classification System	30
xi) Applications	31
xii) Claiming Convention Priority	32
xiii) Oppositions	33
xiv) Divisional Applications	34
xv) No More Declarations of Use	35
xvi) Correction of Errors	35
xvii) Associated Trademarks	36
xviii) Section 45	36
xix) The Transfer of Trademarks	36
xx) The Term of Protection	37
xxi) Regulations	37
7. Basic Concepts	39
a) The Trade Mark	39
b) Distinctiveness and Secondary Meaning	40
c) Certification Mark	42
d) Prohibited Marks	44
e) Official Marks	48
8. Availability Searches	51
9. Registrability	54
a) The Concept	54
b) Primarily Merely a Name or a Surname	55
c) Descriptive or Deceptively Misdescriptive Trade Marks	56
i) General Principles	56
ii) Suggestive Words	60
iii) Coined or Invented Words	60
iv) Geographical Words	61
v) Conditions of or the Persons Employed in Production of Wares	61
vi) Disclaimer	62
d) Acquired Distinctiveness — Secondary Meaning	62
e) Names of Wares or Services	65
f) Confusing With a Registered Trade Mark	65
g) Prohibited Trade Marks	66
10. Summary and Checklist	66
CHAPTER 3: Branding on the Internet	
1. Introduction	69
2. Basic Concepts	72

TABLE OF CONTENTS

a) The Internet	72
b) The Domain Name System	72
c) The New gTLDs	75
3. Domain Names	77
a) Availability	77
b) Acquisition and Management	79
i) Registration	79
ii) Management	82
c) Protecting Domain Names as Trade Marks	84
4. Internet Concerns	85
a) Cybersquatting and Related Problems	85
i) Actions in the Courts	86
ii) The UDRP	86
iii) The CDRP	92
iv) Uniform Rapid Suspension System (URS)	95
v) The ACPA	101
b) Phishing and Related Problems	101
c) Sale of Counterfeits on the Internet	102
d) Criticism or Gripe Sites	103
e) Pop-Up Advertisements and Mouse Trapping	105
f) Metatags, Keywords and Search Engine Rankings	105
i) Metatags	105
ii) Keywords	107
iii) Search Engine Rankings	109
g) Linking and Framing	109
h) Jurisdictional Issues	110
i) Privacy Issues	115
j) Anti-Spam Legislation	117
i) What is a Commercial Electronic Message (“CEM”)	117
ii) The Basic Rule	118
iii) Seeking Consent	119
iv) Exceptions	119
A. Full Exceptions	119
B. Partial Exceptions	121
v) Implied Consent	122
vi) Altering Transmission Data	123
vii) Computer Programs	123
viii) Transitional Provisions	124
ix) Penalties for Non-Compliance and Enforcement	125

TABLE OF CONTENTS

x) Compliance Programs 126

k) Social Media 126

 i) User Names 127

 ii) Hash Tags 127

 iii) Unauthorized or Negative Publicity 127

 iv) Trademark Claims 128

 v) Summary 129

5. Summary and Checklist 129

CHAPTER 4: Protecting Brand Names — Registration

1. Introduction 131

2. Acquisition of Rights 133

 a) Adoption 133

 b) Making Known 134

 c) Proposed Use 135

 d) Trade Marks Registered Abroad 136

3. Trade Mark Use 138

 a) The Concept 138

 b) Wares 140

 c) Services 142

 d) Exported Wares 143

 e) Deviating Use 143

4. Entitlement 144

 a) Marks Which Have Been Used or Made Known in Canada 145

 b) Marks Registered and Used Abroad 145

 c) Proposed Use Marks 147

5. Applications for Registration 147

 a) The Application 147

 b) Examination 150

 c) Disclaimer 152

 d) Advertisement 152

6. Registration 153

 a) Allowance 153

 b) Effect of Registration 153

 c) Marking 154

 d) Invalidity 154

 e) Registration of Concurrent Rights 156

 f) Term of Protection and Renewal 156

7. Assignment and Licences 156

 a) Assignments 156

TABLE OF CONTENTS

b) Licence	159
8. Expungement for Non-Use	161
a) Section 45	161
b) Evidence	162
c) Absence of Use	165
d) The Decision	167
e) Appeal	168
9. Expungement by the Federal Court	169
a) Jurisdiction	169
b) Person Interested	170
c) Limitations	171
d) Grounds for Expungement	172
i) Section 18	172
ii) Not Registerable	173
iii) Not Distinctive	174
iv) Abandonment	175
v) Entitlement	176
10. Summary and Checklist	176
CHAPTER 5: Protecting Brand Names — Enforcement	
1. Introduction	179
2. Confusing Trade Marks	179
a) The Statutory Criteria	180
b) Inherent Distinctiveness	184
c) Duration of Use	186
d) The Nature of the Wares, Service or Business	187
e) Nature of the Trade	190
f) Degree of Resemblance	191
i) Appearance	191
ii) Sound	193
iii) Idea	194
3. Opposition Proceedings	195
a) Instituting an Opposition	195
b) Evidence	202
c) The Hearing	206
d) Appeal	208
4. Infringement	210
a) The Concept	210
b) Depreciating the Value of the Goodwill Attached to a Trade Mark	215
5. The New Border Enforcement Regime	217

TABLE OF CONTENTS

a) The Prohibition on Importation or Exportation	218
b) Request for Assistance	218
c) Measures Relating to Detained Goods	219
d) Detaining the Goods at the Rights Owner’s Expense	220
6. Criminal Offence	222
7. Common Law Rights — Passing Off	224
a) Basis of the Action	224
b) Subsection 7(b) and (c) of the <i>Trade-marks Act</i>	227
c) Reputation or Goodwill	229
d) Misrepresentation	230
e) Damage	231
f) Defences	231
i) Plaintiff’s Own Wares	231
ii) Descriptive Trade Marks	232
iii) Geographical Words	233
iv) Loss of Distinctiveness	233
v) Functionality	233
vi) Use of a Registered Trade Mark	234
vii) Use of Defendant’s Own Name	234
viii) Consent	234
8. Summary and Checklist	235
CHAPTER 6: Protecting Product Shape and Appearance	
1. Introduction	237
2. Distinguishing Guise	238
3. Industrial Designs	241
a) The Basic Elements of a Design	241
b) Appeal to and be Judged Solely by the Eye	243
c) Features Applied to a Useful Article Dictated Solely by Utilitarian Function	244
d) Sets and Kits	245
4. Industrial Designs and Other Intellectual Property Rights	246
a) Trade Marks	246
b) Copyright	246
c) Patents	249
5. Originality	249
6. Publication	251
7. Applications and Registration	252
a) Applications	252
b) Protection of Separate Features	253

TABLE OF CONTENTS

c) Registration	253
8. Marking	255
9. The Proprietor	256
a) The First Proprietor	256
b) Designs Executed for Consideration	257
10. Assignment and Licence	257
a) Requirements	227
b) Registration	258
11. Term	258
12. Amendment of the Register	258
a) Statutory Provisions	258
b) Expungement	259
13. Infringement	259
14. Trade Dress or Get-Up of Goods	262
a) General	262
b) Similarity of Get-up	263
c) Functionality	265
d) Common to the Trade	265
e) Substitution of Goods	266
15. Summary and Checklist	266
 CHAPTER 7: Protecting Product Packaging	
1. Introduction	269
2. Trade Marks	270
3. Copyright	271
a) Acquisition	271
b) Originality	272
c) Fixation	273
d) Compilations	274
e) Derivative Works	274
4. Literary Works	275
a) What is Protected	275
b) The Rights Associated with a Literary Work	275
5. Artistic Works	276
a) What is Protected	276
b) The Rights Associated with an Artistic Work	277
6. Registration and Marking	278
a) The Effect of Registration	278
b) Marking	280
7. Term of Protection	280

TABLE OF CONTENTS

8. Ownership	281
a) The General Principle	281
b) The Author	282
c) Computer Generated Works	282
d) Compilations	283
e) Photographs	283
i) Photographs Made Before November 7, 2012	283
ii) Photographs Made After November 7, 2012	286
f) Engravings	286
i) Engravings Made Before November 7, 2012	286
ii) Engravings Made After November 7, 2012	287
g) Sketches and Drawings	287
h) Contracts of Service	287
i) The Control Test	288
ii) The Organization or Integration Test	289
iii) The Economic Reality Test	289
iv) The Work Must be Made in the Course of Employment	290
v) Absence of Agreement to the Contrary	290
9. Moral Rights	290
10. Assignment	291
a) The Statutory Provisions	291
b) Must Be In Writing	292
c) Subject Matter	293
11. Infringement	294
a) Direct Infringement	294
b) Secondary Infringement	295
c) The 2015 Border Enforcement Measures	296
12. Summary and Checklist	297
CHAPTER 8: Protecting Brand Advertising	
1. Introduction	301
2. Trade Mark Protection	302
a) Slogans and Taglines	302
3. Copyright Protection	303
a) Ownership	303
b) Parodies	303
4. Common Law Rights — Passing Off	304
5. Misleading Advertising	305
a) Introduction	305
b) The Legislative Framework	305

TABLE OF CONTENTS

c) Criminal Offences	307
d) Reviewable Matters	309
e) Responsibility for Representations	310
f) Remedies for Reviewable Matters	311
g) Access to the Competition Tribunal	313
h) Misleading Representations	313
i) Correction Notices	316
j) Product Performance Claims	317
k) Misleading Price Representations	320
6. Comparative Advertising	323
a) The <i>Competition Act</i>	324
b) The <i>Trade-marks Act</i>	325
c) The <i>Copyright Act</i>	327
d) The Torts of Injurious Falsehood and Unlawful Interference with Economic Relations	327
7. Summary and Checklist	329
CHAPTER 9: Developing Effective Brand Management Policies	
1. Introduction	331
2. Selecting a Brand Name	331
3. Online Branding	332
4. Obtaining and Maintaining Trade Mark Registrations	332
5. Controlling Brand Expression	333
6. Licensing Programs	335
7. Records Retention	336
8. Educational Programs	337
9. Policing the Marketplace	337
a) Monitoring the Trade-marks Journal	337
b) Watch Services	338
c) Specific Investigations Carried Out by Brand Owner	339
10. Enforcing Rights	339
11. Protecting Product Shape and Appearance	340
12. Protecting Product Packaging	340
13. Protecting Brand Advertising	341
Index	343