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<p style="text-align: center;"><b>FOX ON CANADIAN LAW OF TRADEMARKS AND UNFAIR COMPETITION</b> Gill Release No. 4, May 2022</p>
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### Publisher's Special Release Note 2021

The pages in this work were reissued in December 2021 and updated to reflect that date in the release line. Please note that we did not review the content on every page of this work in the December 2021 release. We will continue to review and update the content according to the work's publication schedule. This will ensure that subscribers are reading commentary that incorporates developments in the law as soon as possible after they have happened or as the author deems them significant.

Changes to chapter and heading numbering may have occurred. Please refer to the Correlation Table in the front matter if you wish to confirm references.

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*Fox on the Canadian Law of Trademarks and Unfair Competition*, 4th edition remains the authoritative text for trademark lawyers and agents in Canada. It provides intellectual property law practitioners with the most comprehensive coverage of trademark issues available today.

This release features updates to Appendix PS – Procedural Summaries IV. Trademark Infringement or Passing Off Proceedings Brought in Federal Court of Canada – Summary of Procedure.

## Highlights

- **Trademark Infringement or Passing Off Proceedings Brought in Federal Court of Canada — Summary of Procedure — Commencement of Proceedings by Application — Case Law: Proceedings by Application** — Justice Fothergill observed that the *Trademarks Act* permits proceedings, including claims for passing off, to be brought by action or by application. The Federal Court of Appeal has recognized that access should be given to the more summary application process in appropriate cases, and nothing in the wording of the *Trademarks Act* precludes this interpretation. An applicant’s choice of proceeding should not be interfered with lightly. The Court may decline to determine a matter on summary application where the procedure does not provide sufficient procedural safeguards to ensure fairness to the respondent, or where the applicant has taken steps that militate against the respondent’s right to fully and fairly defend the application. These may include relying on affidavits from persons who are not directly involved with the issues, failing to produce relevant documentation, or refusing to answer proper and relevant questions on cross-examination. The Court may also consider the number of issues and their complexity, the number of parties, the possibility of cross-applications or a multiplicity of proceedings, and whether credibility is in issue. None of those concerns arose in the present case. There was only one central issue, and it was not complex. The test for passing off is well-established. The evidence tendered by Parsons to support the existence and use in Canada of the PARSONS Mark was unassailable, and the fraudulent nature of the respondent’s website was readily apparent. The respondent had been given multiple opportunities to respond to the application. There was nothing to suggest that Parsons had taken any steps that would militate against the respondent’s right to fully and fairly defend the application, if he were inclined to do so. An application was, therefore, the appropriate procedure for Parsons to obtain the redress it sought: *Parsons Inc. v. Khan*, 2021 CarswellNat 71, 2021 CarswellNat 741, 2021 FC 57 (F.C.).

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