

TRADE-MARKS 2012 Year in Review

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Schulich School of Law

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 **STEWART
MCKELVEY**
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Introduction – Trade-marks in 2012

- Well Known Brands
- Beverage Wars
- Luxury Goods
- Dark Market
- Q & A



BBM Canada v. RIM

Same Word Mark *BUT*:

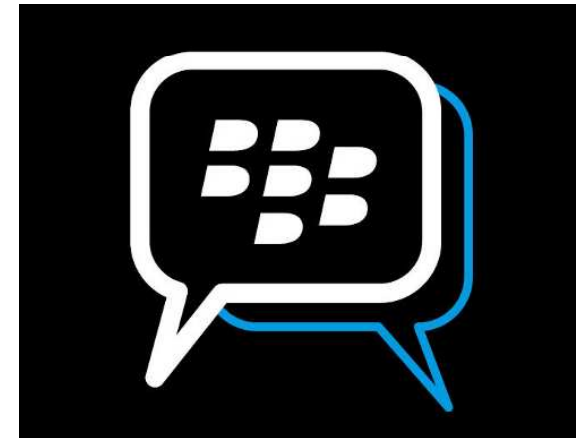
- Different Services
- Different Customers
- Different Protection



BBM Canada v. RIM

Trade-mark Findings for RIM:

- No Confusion
- No Passing Off
- No Depreciation of Goodwill



Bertico v. Dunkin

What Happened to the Franchise?

- Demise of Dunkin's
- Rise of Tim's
- Loss of Brand



Bertico v. Dunkin

Who is Responsible for Losses?

- Franchisor Breach of Contract
- Franchisor Breach of Duty
- Franchisor to Pay \$16 Million



Bodum v. Meyer

FRENCH PRESS for coffee makers:

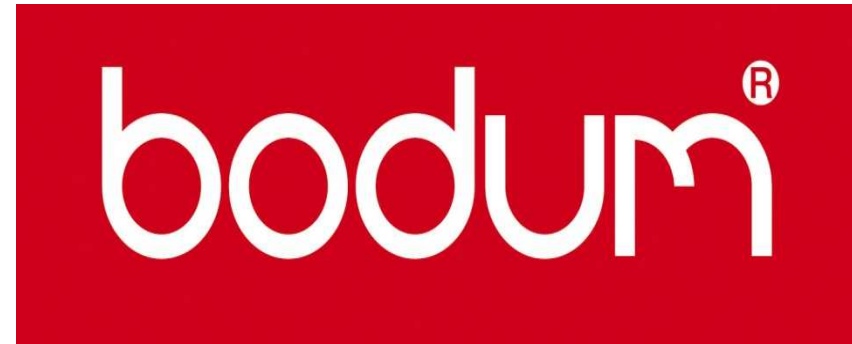
- Generic or Distinctive?
- Valid or Invalid?
- Confusing or Descriptive?



Bodum v. Meyer

Trade-mark Findings for Meyer:

- Not Distinctive
- Not Valid
- Not Confusing



Busch v. Molson (Sub Zero)

REGISTRABILITY

Is SUB ZERO clearly descriptive of method of brewing beer at below 0 temperature?

NO, like KOLD ONE.



Busch v. Molson (Sub Zero)

REGISTRABILITY

Does SUB ZERO clearly describe beer designed to be sold, served, etc. at below 0 temperature?

NO, like KOLD ONE.



Busch v. Molson (Cold Certified)

REGISTRABILITY

Is COLD CERTIFIED clearly descriptive of the conditions of production of beer?

YES, like SUPER COLD.



Busch v. Molson (Cold Certified)

DISTINCTIVENESS

Does COLD CERTIFIED clearly denote type of beer which is certified to be made to be served and drunk at cold temperature?

YES, like SUPER COLD.



Busch v. Molson (Cold Case)

REGISTRABILITY

Does COLD CASE clearly describe a characteristic of beer or a condition of production?

NO, like KOLD ONE.

COLD CASE

Busch v. Molson (Cold Case)

DISTINCTIVENESS

Does COLD CASE clearly describe beer to be sold in cases that are cold?

NO, like KOLD ONE.



BEER MARK TALLY

WORD MARK	REGISTRABLE
KOLD ONE	YES
SUPER COLD	NO
COLD CERTIFIED	NO
SUB ZERO	YES
COLD CASE	YES

Gucci v. Mazzei

Liability for Counterfeit Goods:

- Sale of Goods?
- Advertisement of Goods?
- Display of Goods?

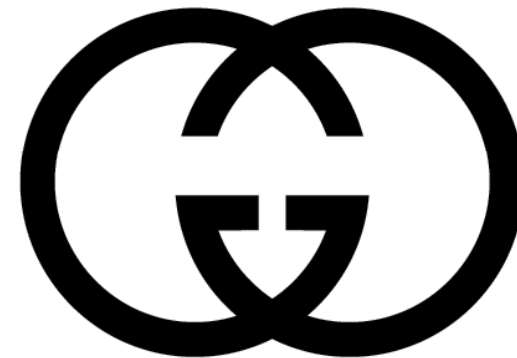


Gucci v. Mazzei

Damages for Counterfeit Goods:

- Value of Originals?
- Nominal Damages Only?
- Minimum Compensation?

GUCCI



Marlboro v. Philip Morris

Can there be trade-mark infringement by PM without using the MARLBORO name on package? YES.



Marlboro v. Philip Morris

Trade-mark Findings for Marlboro:

- Same Wares
- Same Trade
- Resemblance in Ideas
- Surrounding Circumstances



Questions

