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Can Novel Findings from Emerging Neuroscientific Technologies be Incorporated into Trademark Law in Canada?

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A thesis submitted in partial fulfillment of the requirements for the Master of Studies in Law degree in Law

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Abstract

American scholar, Mark Bartholomew, predicted in 2018 that a new kind of neuroscientific evidence would help businesses involved in lawsuits connect their trademarks with the public's perception of their trademarks. Bartholomew coined the term "neuromarks" for this evidence. Bartholomew focused on U.S. trademark law. This research demonstrates, looking at both Canada's domestic law and Canada's relevant international treaties and trade agreements, that such evidence has not yet been used (in 2022) in trademark litigation in Canadian courts or tribunals but that there appears to be no legal barrier to its use in future in Canada. This research notes that neuroscience literature indicates that, while Bartholomew discussed "neuromarks" as a future concept, from the neuroscientific perspective, it is already scientifically possible to obtain evidence of individuals' connections between marks and specific goods and services: it only awaits litigators in Canadian cases introducing such evidence and Bartholomew's "neuromarks" can become a reality.

Keywords

Trademarks, Neuroscience, Neuromarks, Emerging Technologies, Cognitive Science, fMRI, Intellectual Property, Paris Convention, TRIPS, CPTPP, CUSMA, Canada-UK Trade Continuity Agreement, CETA.

Lay Summary

Trademarks connect the public with particular goods and services in the Canadian marketplace just as trademarks connect the public with particular goods and services in other nations' marketplaces. The businesses that own the trademarks connected with goods and services in the Canadian marketplace rely upon the Canadian *Trademarks Act* and Canadian courts and tribunals to protect their rights in their trademarks. This can involve businesses in seeking to protect their trademarks in litigation either in litigation that involves the Canadian *Trademarks Act* or in litigation that relies upon the common cause of action known as 'passing off'. In either case, it is often incumbent upon the businesses involved to prove the extent to which the public is aware of their trademarks in connection with their goods or services. This thesis focussed upon what kinds of evidence businesses can bring to bear to prove the connection the Canadian public has (or doesn't have) with a particular trademark.

In 2018, American scholar, Mark Bartholomew, predicted that a new kind of evidence, based in neuroscience, could help businesses involved in lawsuits connect their trademarks with the public's perception of their trademarks: evidence acquired through the use of neuroscientific technologies. Bartholomew coined the term 'neuromarks' for this evidence. Bartholomew focused only on trademark law in the U.S. In this thesis, looking at both Canada's domestic law and relevant international treaties and trade agreements, this research demonstrates that such evidence has not yet been used (in 2022) in connection with trademark litigation in Canadian courts or tribunals but that there appears to be no legal barrier to its use in the future. This research also notes that neuroscience literature indicates that, while Bartholomew discussed "neuromarks" as a

future concept, from the neuroscientific perspective, it is already scientifically possible to obtain evidence of individuals' connections between marks and specific goods and services: it only awaits litigators in Canadian cases introducing such evidence into their legal actions and Canadian courts and tribunals can turn the concepts behind Bartholomew's "neuromarks" into reality.

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- L: *Mattel, Inc. v 3894207 Canada Inc.*, 2006 SCC 22.
- M: *Toys “R” Us (Canada) Ltd. v Herbs “R” Us Wellness Society* 2020 FC 682.

List of Abbreviations

BOLD – Blood-Oxygen-Level-Dependent
CETA – Comprehensive Economic and Trade Agreement
CIPO – Canadian Intellectual Property Office
CPTPP – Comprehensive and Progressive Agreement for Trans-Pacific Partnership
CUSMA – Canada-United States–Mexico Agreement
DNA – Deoxyribonucleic Acid
EEG – Electroencephalography
FC – Federal Court
FCA – Federal Court of Appeal
fMRI – Functional Magnetic Resonance Imaging
fNIRS – Functional near-infrared spectroscopy
FSL – Functional Magnetic Resonance Imaging of the Brain (FMRIB) Software Library
GATT – General Agreement on Tariffs and Trade
GDP – Gross Domestic Product
MATLAB – MATrix LABoratory
MRI – Magnetic Resonance Imaging
PCTIA – Private Career Training Institutions Agency
PIPEDA – Personal Information Protection and Electronic Documents Act
SAS – Statistical Analysis System
SCC – Supreme Court of Canada
sLORETA – Standardized Low Resolution Brain Electromagnetic Tomography
SPSS – Statistical Package for the Social Sciences
TMOB – Trademarks Opposition Board
TPP – Trans-Pacific Partnership
TRIPS – The Agreement on Trade-Related Aspects of Intellectual Property
U.S. – United States
USD – United States Dollar
VCC – Vancouver community College
WIPO – World Intellectual Property Office
WTO – World Trade Organization

Chapter 1: Introduction

1. Introduction

Trademarks are one form of stimulus that businesses and marketing entities rely upon for communicating about the source, quality and other characteristics of their goods or services and the personality and reputation of their brands.¹ Trademarks connect the public with particular goods and services in the Canadian marketplace just as trademarks connect the public with particular goods and services in other nations' marketplaces. The businesses that own the trademarks connected with goods and services in the Canadian marketplace rely upon the Canadian *Trademarks Act* and Canadian courts and tribunals to protect their rights in their trademarks. This can involve businesses in seeking to protect their trademarks in litigation either in litigation that involves the *Canadian Trademarks Act* or in litigation that relies upon the common cause of action known as 'passing off'.

Trademarks have existed since antiquity yet their contemporary legal protection has more modern roots than either copyright or patent: in Canada's *Constitution Act*, 1867, for instance, trademarks are not mentioned though both copyright and patent are.² The even earlier expression of constitutional protection for intellectual property in the American Constitution alludes to copyrights and patents, but not trademark.³

¹ Terrance S Carter & U Shen Goh, *Branding and Trade-marks: Handbook for Charitable and Not for Profit Organizations* (Markham: LexisNexis Canada, 2006) at 61-62; Teresa Scassa, "Trademarks Worth a Thousand Words: Freedom of Expression and the Use of the Trademarks of Others" (2012) 53:4 *Les Cahiers de droit* 877 at 880-881.

² *Constitution Act*, 1867 (U.K.), 30 & 31 Vict., c. 3, reprinted in R.S.C. 1985, App. II, No. 5., ss 91(22) patent and (23) copyright.

³ *US Constitution Act*, 1 §8 c18 (1787): "The Congress shall have the power ... To promote the progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries".

It has been noted that “[u]p until the mid-nineteenth century, when the modern legal separate of a corporation from its owners occurred, inventors, authors and creators were exclusively individuals who, in turn, could only engage in business with other individuals – and a business’s goodwill was only the goodwill of the individual or individuals operating it.”⁴ The earliest expression of protection of trademarks in English common law (through the tort of passing off) occurred in 1842 in *Perry v Truefit*.⁵ This common law recognition was roughly simultaneous with civil law recognition of trademark in France’s *Manufacture and Goods Mark Act, 1857*.⁶ When trademarks entered the realm of international law, through the *Paris Convention*, they were included in two ways:⁷ under the term “trademark” and through the concept of “unfair competition.”

The Canadian *Trademarks Act*⁸ prohibits infringement of trademarks, a concept which is defined in s 20(1). It also created, in s 7, a cause of action that incorporate concepts from the common law tort of passing off but is a statutory cause of action able

⁴ Margaret Ann Wilkinson, “What is the role of new technologies in tensions in Intellectual Property?,” Tana Pistorius (ed) *Intellectual Property Perspectives on the Regulation of Technologies* [ATRIP Intellectual Property Law Series] (Cheltenham, UK: Edward Elgar, 2018), pp 1-34 at 9.

⁵ 49 ER 749 at 752.

⁶ French law no. 4,720 of 23 June 1857.

⁷ See original mentions of “trademark” in “Original Text of 20th March, 1883” and mention of “unfair competition” in Article VI of “Additional Act of Brussels of 14th December, 1900”, both appearing in *The Paris Convention for the Protection of Industrial Property from 1883 to 1983*, at p 216, available at https://www.wipo.int/edocs/pubdocs/en/intproperty/875/wipo_pub_875.pdf

⁸ RSC 1985, c T-13.

to be litigated in Canada's Federal Court system (a system which has no common law jurisdiction⁹). The tort of passing off itself, in Canada, remains entirely non-statutory.¹⁰

To be successful in a passing off action in Canada, the plaintiff must demonstrate three things: the existence of goodwill, deception of the public due to a misrepresentation, and actual or potential damage to the plaintiff.¹¹

In the case of either statutory infringement or the tort of passing off, it is incumbent upon the businesses involved to prove the extent to which the public is aware of their trademarks in connection with their goods or services. For example, when consumers purchase Kellogg's cornflakes cereal, they expect the same quality, taste, smell, texture, and shelf life, irrespective of which processing facility manufactured and packaged the product or from which store the product was purchased.

This thesis focuses upon the kinds of evidence businesses can bring to bear to prove the connection the Canadian public has (or doesn't have) with a particular trademark.

In 2018, American scholar, Mark Bartholomew, predicted that a new kind of evidence, based in neuroscience, could help businesses involved in lawsuits connect their trademarks with the public's perception of their trademarks: evidence acquired through

⁹ See Department of Justice, *Canada's Court System*, 2015, available at <https://www.justice.gc.ca/eng/csjsjc/ccs-ajc/pdf/courten.pdf>

¹⁰ *Lanham (Trademark) Act*, 15 U.S.C. §1125. In the United States, the *Lanham Act*, s 43(a) statutorily enacts the passing off concept federally while American states are able to continue to recognize common law unfair competition or passing off tort actions. See <https://www.nextrendlegal.com/trademark-infringement/unfair-competition/common-law-unfair-competition/>

¹¹ See *Ciba-Geigy Canada Ltd v Apotex Inc* [1992] 3 SCR 120 at 132.

the use of neuroscientific technologies. Bartholomew coined the term ‘neuromarks’ for this evidence. Bartholomew focused only on trademark law in the U.S. This thesis will be looking at both Canada’s domestic law and Canada’s relevant international treaties and trade agreements. This thesis is seeking to examine whether “neuromarks” evidence has yet been used in connection with trademark litigation in Canadian courts or tribunals. This thesis will also examine whether there appear to be any legal barriers to its use in the future in Canada.

Trademarks, like all intellectual property, are non-corporeal – that is to say, “trademarks” themselves do not have a physical presence.¹² To function as a trademark, some symbol must represent, in the minds of the consuming public, an association between that symbol and commerce involving goods or services.¹³ For example, when consumers in Canada and all around the world encounter a “swoosh” trademark on sporting goods and athletic wear, they are more likely to recognize that the wares come from Nike Corporation. However, when consumers in Canada encounter the trademark “asiya”, written in lowercase letters in light blue ink, on athletic wear such as sports and swim hijabs, they are much less likely to recognize that the wares come from Asiya Modest Activewear, an U.S.-based start-up, because the “asiya” mark has less worldwide recognition than the Nike “swoosh” trademark. Moreover, trademark law, like all law, exists within the nation state in which it has been created. Hence, to “own” a trademark is to have a legally protectable exclusive monopoly right to use a given symbol in

¹² Teresa Scassa, *Canadian Trademark Law*, 2nd edition (Markham: LexisNexis Canada, 2015) at 63-65.

¹³ *Ibid.*

association with commercial activities for certain goods or services within the country which has created the law governing that trademark.^{14,15}

If Asiya Modest Activewear were to register its trademark in Canada, the mark would gain for Asiya Modest Activewear an exclusive monopoly right under the statute for use of the mark in association with sports and activewear across Canada. However, without effective marketing practices whereby the brand uses its trademark while communicating about its goods or services with potential consumers, the mark may still fail to create an association between a symbol and commercial activities for the goods or services in the minds of the consuming public.

It is the question of the symbolic representation of a trademark in association with goods or services in the minds of the consuming public that this research explores in terms of neuroscientific technologies. The question has been raised by American author, Mark Bartholomew, where he claimed that “neuromarks” can show how consumers interpret stimuli and this would add value to trademark cases.¹⁶ His ideas will be further explored in the Canadian context in this thesis.

¹⁴ *Ibid.*

¹⁵ There is some overlap between trademark law and copyright law. For instance, Rob Batty has stated:

[w]hen a pictorial mark is first created and recorded in some form, it is likely that the image will be protected as an artistic work by copyright law. Copyright law will prohibit another trader *copying*, the whole or a substantial part, of the pictorial mark. Some traders will additionally seek to register the pictorial mark as a trade mark for the additional protection registered trade mark law offers.

See Rob Batty, “Conceptual confusing similarity and pictorial trade marks” (2021) 11:4 Queen Mary J Int Prop 409 at 412.

¹⁶ Mark Bartholomew, “Neuromarks” (2018) 103:2 Minn L Rev 521.

2. Use of Neuroscientific Advances in Marketing

Marketing often involves the promotion and differentiation of goods or services through use of identifiable branding. Most often businesses choose to work to protect identifiable branding elements as trademarks. In order to create branding that will succeed within their target markets, marketers, over the past few decades, have increasingly used evidence from emerging neuroscientific technologies to gain a better understanding of their consumers.

During these same decades, there has been a shift from traditional marketing practices that use only one type of stimulus or messaging for all consumers to new marketing practices that cater the stimulus or messaging to specific subsets of the consumer groups using enhanced knowledge of the target market.¹⁷ **Figure 1: Changes in Marketing Practices Over Time** illustrates the difference in the flow of messaging from a business or marketing entity to its target consumers using traditional marketing practices and using new marketing practices. The resulting effects of new marketing practices, particularly on recognizing the effect of individual consumer identity on consumer choices and, hence, on collective consumer culture can be seen.¹⁸

¹⁷ Vlasceanu Sebastian, “Neuromarketing and evaluation of cognitive and emotional responses of consumers to marketing stimuli” (2013) 127 *Procedia Soc Behav Sci* 753 at 753-755.

¹⁸ Moran Cerf “Methods” in Cerf Moran and Manuel Garcia-Garcia, eds, *Consumer Neuroscience*, (Cambridge: MIT Press, 2017) at 9-15, 69-72; Scassa, *supra* note 1 at 880-881, 885.

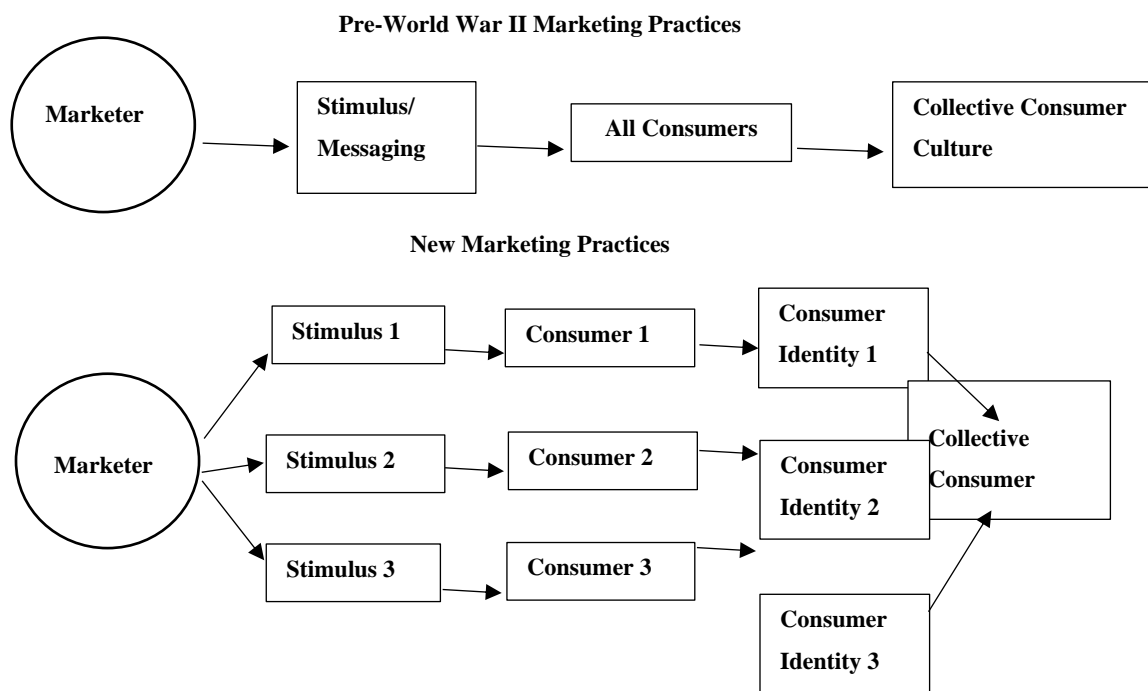


Figure 1: Changes in Marketing Practices Over Time.

There was a shift after world war II from marketing practices that used limited types of stimulus or messaging for all consumers and often relied on facts and logic to new marketing practices that are visual and emotion-based and focus on specific subsets of consumers.¹⁹ Over the past two decades, neuroimaging techniques such as functional magnetic resonance imaging (fMRI)²⁰ have increasingly been employed to obtain

¹⁹ Kat Metaxopoulou. “How WW II shaped modern-day advertising”, (2020) The Startup. Online: <<https://medium.com/swlh/how-wwii-shaped-modern-day-advertising-614fc9f9c8a2>> (accessed April 29, 2022).

²⁰ fMRI is a non-invasive, and relatively safe technique that has gained popularity in academic sciences and commercial contexts over the past 20 years. fMRI detects changes in haemodynamics (i.e., blood oxygenation and flow) to specific brain regions in response to brain activity, known as BOLD (Blood-oxygenation-level-dependent) signals. This is based on the notion that more active brain areas demand a higher blood flow. As such, fMRI scanners along with powerful computational software can be used to produce activation maps involved in various mental processes including perception, attention, emotion, and memory. fMRI has excellent spatial resolution (i.e., ability to distinguish different locations in the image) and temporal resolution (i.e., ability to distinguish changes in the image over time). It also has improved signal to noise ratio, capability for continuous collection of data (i.e., great for tracking ongoing processes) and is relatively easy to use. In contrast, MRI scans are anatomical images of the brain’s structures that are often used in medical settings. See Cerf, *supra* note 18 at 63-75; Owen J Arthurs & Simon Boniface, “How well do we understand the neural origins of the fMRI BOLD signal?” (2002) *Trends Neurosci* 27 at 27-29;

objective information about consumers' emotional engagement, memory retention, purchase intention, perception of newness,²¹ brand awareness, and attention. Only neuroimaging techniques can be used to allow businesses to increase their chances of success by obtaining valuable objective data before launching a new product, making changes to existing product lines, or developing marketing strategies.²² Evidence of such characteristics in real-time cannot be retrieved through use of traditional social science methodologies, such as focus groups, preference questionnaires, simulated choice methods, and market tests.²³ **Figure 2: Consumer Behaviour Research Tools in Social Science and Natural Science** depicts both social science and natural science research tools that have been used, in contexts other than law, to study consumer behaviour.

and Tatjana Aue, Leah A Lavelle, & John T Cacioppo, "Great expectations: What can fMRI research tell us about psychological phenomena?" (2009) 73 *Int J Psychophysiol* 10 at 10-16.

²¹ Brands sometimes introduce a new logo or symbology to play upon the notion of perception of newness and help better capture consumers' attention, especially after their previous logo has saturated the market. For example, Heart and Stroke Foundation and the Canadian Bank of Commerce (CIBC), both have recently changed their longstanding brand logo. When consumers perceive this new logo, it will require greater degree of mental processing, time, and attention to make a connection between the new logo and the commercial source. See Brigitte Muller, Bruno Kocher & Antoine Crettaz, "The effects of visual rejuvenation through brand logos" (2011) 66 *J Bus Res* at 82-84.

²² Sebastian, *supra* note 17 at 754; Dan Ariely & Gregory S Berns, "Neuromarketing: the hope and hype of neuroimaging in business" (2010) 11:4 *Nat. Rev. Neurosci.* 284 at 284-285.

²³ Traditional social science methodologies that are commonly used by marketers tend to ask questions from members of the consuming public about their past behaviours. On the other hand, neuromarketing techniques offer an advantage as they allow researchers to gather information in real-time while members of the consuming public are viewing and interacting with the brand (goods and services and associated logos). See Batty, *supra* note 15 at 441.

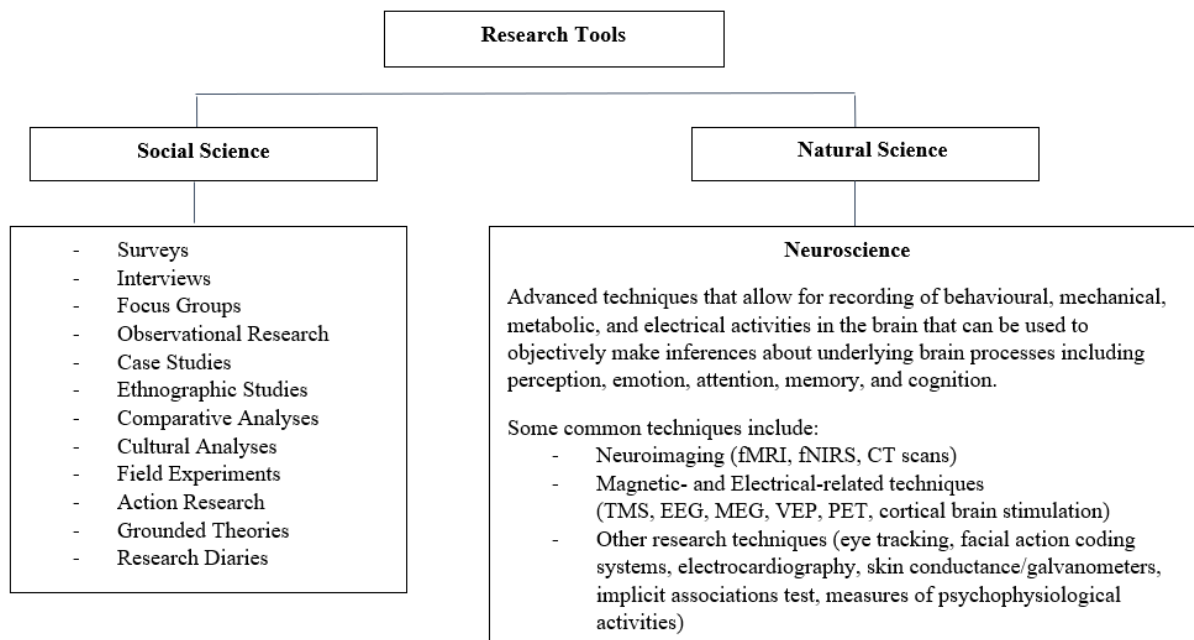


Figure 2: Consumer Behaviour Research Tools in Social Science and Natural Science.

One neuroimaging technique, fMRI scans, can be used to obtain direct measurements of the patterns and levels of activation in individuals' brains. Bartholomew has suggested that such neuroscientific evidence can be introduced in trademark disputes.²⁴ Bartholomew coined the term “*neuromarks*”, which he defined as objectively discoverable patterns of brain activity, recorded in brain scans of responses to external stimuli, that affect consumers' purchasing decisions.²⁵ Although acknowledging that such evidence is not yet actually available,²⁶ Bartholomew predicted that this scanning will

²⁴ Bartholomew, *supra* note 12 at 524-525.

²⁵ *Ibid.*

²⁶ *Ibid.* at 526 (in 1st full para):

[r]esearchers have yet to refine their techniques such that every brand's neural signature will be unique from all others or to show that the biological blueprint uncovered during an fMRI scan would look the same during exposure to a brand in the real-world marketplace.

eventually allow researchers to make direct conclusions about consumers' responses to external cues.²⁷ He went on to assert that,

...[f]or two reasons, the implications of brain science for trademark law deserve serious scholarly consideration.

First, scientific understanding of the brain has increased dramatically in the last decade [footnote omitted]...As a result, even neuromarketing skeptics acknowledge that “[n]euroscience has much to say about such major phenomena as attention, emotion, and memory that are essential to motivating consumers” [footnote omitted]

Second, even flawed science can sometimes find its way into the courtroom... even if the hype of consumer neuroscience does not currently match the reality, critical analysis is needed to prepare courts for attempts to introduce neuroscience evidence into evidence in trademark cases.²⁸

In the context in which Bartholomew used his new term “neuromarks”, it would be natural for a reader to assume that he was using “neuromarks” to refer to a “mark” -- but he is not: his term “neuromarks” refers to evidence of the effect of marks on consumers, not marks themselves. As explained in this thesis, Bartholomew’s idea of “neuromarks” essentially refers to brain scans showing consumers’ reactions to “marks”. These scans, as Bartholomew has argued, can provide evidence to support or refute claims about the power of an actual trademark (at statutory or common law) in a population of potential or actual consumers.

²⁷ *Ibid.* at 524, citing to *Cerf*, *supra* note 18 at 69.

²⁸ *Ibid.* at 526-527.

3. Mark Bartholomew's Conception of "Neuromarks"

Writing in the context of trademark law in the U.S., Bartholomew was, indeed, the first to argue in 2018 that "neuromarks" (i.e., direct evidence of cognitive internal mental processes) can be material to trademark law.²⁹ He argued that the new type of evidence from emerging neuroscientific technologies could be relevant and even compelling in respect of issues of consumer understanding.³⁰ According to Bartholomew, "neuromarks" are objectively discoverable patterns of neural activity in consumers' brains that can provide better insights into consumers' subjective perceptions, behaviours, actions, and decisions.³¹ For example, if researchers can discern specific patterns of neural activation in consumers' brains in response to a given brand, those researchers can then compare this specific neural activity in response to one mark-holder's mark with the specific neural activity in response to another mark owned by a different mark-holder.³² Bartholomew stated: "If a unique neuromark can be defined for a well-known brand, then an interloper whose mark triggers the same neural associations in consumers' heads may be accused of infringement."³³ In sum, he argued that information from these emerging

²⁹ *Ibid.* at 539. It was established that Bartholomew was first to raise these ideas in the context of trademark through literature searches conducted using Google Scholar and HeinOnline for keywords *trademark* and *neuroscience*. Search results revealed articles on the topics of neuroscience and law in general or criminal law, however no articles were found on the specific topic of trademark law. In addition, searches were conducted using the most common Canadian legal databases including LexisNexis and WestLawNext for cases in which neuroscientific evidence related to consumer perceptions and consumer behaviour was considered in trademark law cases. Here, the following keywords were used – *neuroscience* and *trademark law*; *neuroscience* and *consumers* and *trademark*; and *fMRI* and *trademark law*. These searches were conducted on March 1, 2020.

³⁰ *Ibid.* at 523.

³¹ *Ibid.* at 524-525.

³² *Ibid.* at 525 and 539.

neuroscientific technologies can be incorporated into the trademark legal environment in the U.S. in order to support lawsuits based upon current causes of action and relevant legal concepts. Bartholomew acknowledged that current trademark litigation in the U.S. relies heavily on information from traditional social science, rather than neuroscience, methodologies. He acknowledged that the evidence commonly cited in reports of trademark litigation in the U.S. is social science evidence, including evidence from surveys³⁴, interviews³⁵ and focus groups.³⁶ Bartholomew also noted, however, that trademark case law in the U.S. specifically acknowledges judges' intuition³⁷ as a valid reference point from which to draw inferences about how consumers' minds function.

4. Mark Bartholomew's Three Hypothetical Scenarios

Bartholomew begins by describing “the current state of the art in consumer neuroscience and its relationship to the legal [trademark] questions of distinctiveness, likelihood of confusion, and dilution that dominate trademark law [in the U.S.].”³⁸

Bartholomew then presents three hypothetical scenarios, based in trademark law in the

³³ *Ibid.* at 537. At p. 551 Bartholomew also acknowledges that the notion of “neuromarks” is an aspirational goal, and not a present day reality; that incorporation of neuroscientific technologies into trademark law is not a present day practice.

³⁴ Robert C Bird & Joel H Steckel, “The Role of Consumer Surveys in Trademark Infringement: Empirical Evidence from the Federal Courts” (2012) 14:4 U Pa J Bus L 1013 at 1015.

³⁵ Hal Poret, “A Comparative Empirical Analysis of Online versus Mall and Phone Methodologies for Trademark Surveys” (2010) 100:3 Trademark Rep 756 at 768. The authors discuss surveys as well as interviews via the web, telephone, or in-person.

³⁶ Bartholomew, *supra* note 16 at 533.

³⁷ *Ibid.* at 523.

³⁸ *Ibid.* at 527. Note that while distinctiveness and likelihood of confusion are substantive issues in trademark law, the concept of dilution relates to a cause of action available under trademark law in the U.S. (a cause of action which, as will be further explained below, does not exist in Canadian trademark law).

U.S., suggesting when neuroscientific information could help establish answers to key trademark questions.³⁹

(a) First hypothetical scenario -- a restaurant chain named “Burgatory”⁴⁰:

According to Bartholomew, if “the proprietors ... seek trademark protection, they will need to demonstrate that their BURGATORY mark is [either] ‘distinctive’ ... [or] the mark proponent must provide evidence of ‘acquired distinctiveness’ in the minds of consumers”.⁴¹ Bartholomew noted that, to establish acquired distinctiveness, it is key to demonstrate that consumers have come to associate a given mark with a particular source of goods or services: if the mark “does not indicate source to consumers, it is considered ‘merely descriptive’ and forfeits trademark protection.”⁴²

(b) Second hypothetical scenario (extending the first hypothetical scenario) -- Bartholomew posits a second restaurant chain styling itself as “Burger Story”⁴³:

Bartholomew posits that the holder of his original hypothetical mark “Burgatory” might sue a restaurant using “Burger Story” for trademark infringement, claiming that

³⁹ *Ibid.* at 525-528.

⁴⁰ *Ibid.* at 528-529.

⁴¹ *Ibid.* at 529.

⁴² *Ibid.*

⁴³ *Ibid.* at 530.

consumers are likely to confuse the new “Burger Story” restaurant with their own “Burgatory” mark.⁴⁴ Bartholomew notes that, in such cases, “court [in the U.S. must estimate consumer perception ... asking whether customers will mistake the defendant’s trademark for the plaintiff’s”.⁴⁵ Bartholomew indicated that the courts in the U.S.:

rely on a multi-factor test to answer this question... [and] the following factors must be part of the consumer confusion analysis:

- similarity of the plaintiff’s and defendant’s marks,
- ‘strength’ of the plaintiff’s mark,
- intent of the defendant,
- purchaser sophistication,
- presence of actual confusion, and
- relatedness of the goods or services at issue.⁴⁶

According to Bartholomew, in order to make a determination regarding the likelihood of confusion in the consumers’ minds, “judges assess likelihood of confusion through intuition and proxies for consumer sentiment rather than actual testing of that sentiment.”⁴⁷ He further states that “[o]nly the actual confusion factor permits direct evidence of consumer thought to enter the analysis – the rest of the infringement analysis is left largely to judicial guesswork.”⁴⁸

⁴⁴ *Ibid.*

⁴⁵ *Ibid.*

⁴⁶ *Ibid.*

⁴⁷ *Ibid.*

⁴⁸ *Ibid.*

(c) Third hypothetical scenario (a second extension of the first hypothetical scenario) -- Bartholomew posits a pet food supplier that begins to use the same “Burgatory” trademark to market its goods that the restaurant “Burgatory” uses⁴⁹

Bartholomew points out that, in the United States, “[e]ven if pet owners are not confused into thinking the two companies are related, the restaurant chain may attempt to sue for trademark dilution.”⁵⁰ Furthermore, he points out that, from a cognitive science perspective, the use of the “Burgatory” mark by the pet food supplier may interfere with the existing memories established through the marketing efforts of the original mark-holder: “[a] court would need to decide whether exposure to the pet food mark will dim the signaling power of the BURGATORY mark for hamburger restaurants in consumers’ heads”.⁵¹ He goes on to state that “[a] court evaluating such a claim would need to assess whether consumers are likely to make a mental association between the plaintiff’s and defendant’s marks and whether that association somehow negatively impacts their estimation of the BURGATORY mark.”⁵²

5. The Research Question

This thesis will seek to determine whether “neuromarks” can play the same part in substantive Canadian trademark law as Bartholomew has suggested they can play under

⁴⁹ *Ibid.* at 530-531.

⁵⁰ *Ibid.* at 531.

⁵¹ *Ibid.*

⁵² *Ibid.*

U.S. law. The thesis will focus on the substantive legal concepts of distinctiveness and confusion.⁵³

6. The Role of International Law in the Thesis

A factor that would mitigate in favour of the two nations both being able to embrace “neuromarks” to the same extent could be a finding that the two have made

⁵³ Bartholomew stated the thesis of his “Neuromarks” article, at p. 563, as being “that trademark law’s distinctiveness, confusion and dilution analyses will change under the influence of consumer neuroscience.” (p. 563). As noted above, the concept of dilution in trademark law in the U.S. has no direct parallel in Canadian trademark law. The concept of dilution under trademark law in the U.S. is linked to a cause of action available to protect “famous” trademarks in the U.S.: there is no doctrine in Canadian law that gives “famous” marks particular priority.

In the text surrounding paragraph 75 of her article “Trademarks worth a thousand words: freedom of expression and the use of the trademarks of others” Dec 2021, 53(4) *Les Cahiers de Droit*, Teresa Scassa appears to equate “‘dilution’ and ‘tarnishment’ in the United States [with]... ‘depreciation of goodwill’ in Canada” –

The Canadian *Trademarks Act* provides, in s 22, that

22 (1) No person shall use a trademark registered by another person in a manner that is likely to have the effect of depreciating the value of the goodwill attaching thereto.

(2) In any action in respect of a use of a trademark contrary to subsection (1), the court may decline to order the recovery of damages or profits and may permit the defendant to continue to sell goods bearing the trademark that were in the defendant’s possession or under their control at the time notice was given to them that the owner of the registered trademark complained of the use of the trademark.

In “Un Monde Ensemble”: Learning from the U.S. Dilution Experience in Developing Depreciation of Goodwill Law” (Dec 2008) 24(2) *Canadian Intellectual Property Review* 189, Simon Parham analyzed the decision of the Supreme Court of Canada in *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 2, focussing on the possibility of that decision bringing Canadian courts closer to entertaining dilution suits (see p 206). This decision will be analyzed as part of this thesis, but it appears that subsequent Canadian courts and commentators have not interpreted it as ushering dilution into Canadian law. The International Trademark Association (at <https://www.inta.org/fact-sheets/trademark-dilution-intended-for-a-non-legal-audience/>) clearly points to “the United States, the European Union, South Africa, India and Japan, as well as several Central and South American countries” as the jurisdictions that recognize the concept of dilution. The Association notes that “[o]thers, such as **Canada and Australia, have no explicit dilution law** but provide similar protection under other trademark laws. Canada prohibits unauthorized use that depreciates the goodwill of a mark.” (emphasis added). No author has been identified as taking the position that dilution, *per se*, can be pled in Canadian courts (other than Teresa Scassa in the one article noted above, assuming that her sentence, as quoted, can be interpreted as going that far). This author accepts the position of the International Trademark Association and therefore will not be further discussing Bartholomew’s idea of “neuromarks” in connection with the specific concept of dilution.

international commitments that lead to the two countries, each legislating provisions that support implementation of Bartholomew's concept of "neuromarks."

Both Canada and the United States have become party to international instruments that include provisions that deal with trademark law. One aspect of the inquiry into whether "neuromarks" can play an identical role under the laws of both the United States and Canada will be to examine whether Canada's international obligations with respect to trademark are identical to those the United States has: if the obligations that Canada has in this respect differ from those of the United States, it will be more likely that those differing obligations might lead to different roles for "neuromarks" under the laws of the two countries. Chapter 3 will deal with this topic.

As will be discussed further in the following chapters, international law, whether expressed in public international law or in the form of international trade obligations, is not binding on nation states. States are sovereign.⁵⁴ Changes that Canada's domestic governments choose to make in their respective areas of federal or provincial legislative competence can be limited by Canada's obligations as a signatory to international trade agreements and treaties, but because nations are sovereign within their own territory, there can be instances where domestic law cannot be reconciled with a state's international obligations. This may be especially true in countries, like Canada and the United States, where treaties are not self-executing.⁵⁵ Of the two aspects of international

⁵⁴ Richard H. Steinberg, "Who is Sovereign?" (2004) *Stan J Int'l L* 329 at 329-330.

⁵⁵ It is important to note that in sovereign countries such as Canada and the United States, the judiciary are independent of the government in the sense that judges play a key role in judicial decision-making as independent entities separate from the nation's governments and any international obligations into which the governments may have entered: governments cannot necessarily bind domestic law to fit a treaty it has chosen to sign. See Government of Canada, "The Judiciary" online: <<https://www.justice.gc.ca/eng/csjsjc/ccs-ajc/05.html>> (accessed 30 October 2021).

law, namely international public law and international trade law, international public law is a lesser barrier to making changes to domestic law in order to adapt to new situations than are trade agreements. As will be discussed further in Chapter 3, there are few functional enforcement mechanisms in the realm of public international law, and therefore few penalties are available for one nation to force another nation to comply with public international law.

The Agreement on Trade-Related Aspects of Intellectual Property Rights, hereinafter TRIPS Agreement,⁵⁶ is administered by the World Trade Organization, hereinafter WTO and sets minimum standards for intellectual property protection.⁵⁷ WTO member countries may face the possibility of countermeasures for failure to fulfill these obligations. However, since December 2019, the work of the WTO adjudicative body determining the permissibility of countermeasures, the WTO Appellate Body, has been suspended due to broader concerns about its judicial activism. Hence, the enforcement of TRIPS obligations as well as those in the rest of the WTO Agreement, are currently impaired.⁵⁸

While in some quarters it may be thought that the *Paris Convention for the Protection of Industrial Property*, hereinafter Paris Convention⁵⁹ (which falls into the category of public international law) is an exception to the rule that public international

⁵⁶ *Marrakesh Agreement Establishing the World Trade Organization*, Apr. 15, 1994, 1867 U.N.T.S. 154, 33 I.L.M. 1144 (1994).

⁵⁷ Scassa, *supra* note 12 at 47-49.

⁵⁸ Giorgio Sacerdoti, "Solving the WTO Dispute Settlement System Crisis" (2019) *Journal of World Investment & Trade* 20:6 at 785-791.

⁵⁹ *Paris Convention for the Protection of Industrial Property*, 20 March 1883, 828 UNTS 305 (amended 28 September 1979, entered into force 3 June 1984).

law lacks enforceability, it is not.⁶⁰ It is only certain key elements of its text that, incorporated by reference into the TRIPS Agreement (and then referred to in subsequent trade agreements), has become enforceable (in the context of various trade agreements): this is not enforcement of the Paris Convention itself – it is that the trade agreements, have “incorporated” the language of the Paris Convention (by reference) and the trade agreements are, themselves, enforceable.⁶¹

Therefore, while the treaties and agreements regarding trademark that Canada and the United States have entered into may or may not contain provisions that indicate that the two nations have identical obligations, such that the likelihood that “neuromarks” can play the role projected for them by Bartholomew under U.S. trademark law would appear to make that same role possible in the same way in Canadian trademark law, the actual respective laws of the two countries might still differ. Chapter 4, therefore, will turn to an analysis of the relevant Canadian trademark law.

7. Statute and Common Law in the Thesis

In Canadian trademark law, common law and statutory rights co-exist and thus Canada provides protection for both registered and unregistered trademarks.⁶² The

⁶⁰ Scassa, *supra* note 12 at 50-52.

⁶¹ *Ibid.*

⁶² Hagen et al., *Canadian Intellectual Property Law: Cases and Materials*, 2nd ed (Toronto: Emond Montgomery, 2018) at 317-320, 439-441.

current *Trademarks Act*⁶³ is descended from pre-confederation trademark enactments.⁶⁴ Pre-confederation legislation included a system of trademark registration which “effect[ed] in very concise and clear language what, in essence, remains the standard procedure and effect of registration today.”⁶⁵ At the time of Confederation in 1867, legislative authority was divided between federal and provincial levels of government.

The Constitution Act of 1867⁶⁶ accorded power to Canada’s federal government with respect to legislating copyrights⁶⁷ and patents.⁶⁸ However, there was no allocation of authority over matters involving trademark.⁶⁹

Pre-Confederation, the Province of Canada had already enacted a trademark registration system in an early statute, *An Act to Amend the Act respecting Trade Marks and to provide for Registrations of Designs*.⁷⁰ The federal government of Canada after

⁶³ *An Act relating to trade-marks and unfair competition* [Trademarks Act], R.S.C. 1985, c. T-13.

⁶⁴ Legislation enacted after Canada’s 1867 Confederation includes *the Act Respecting Trade Mark and Industrial Design* of 1879,⁶⁴ the *Trade-marks and Design Act* of 1890,⁶⁴ *Trade-marks and Design Act* of 1927,⁶⁴ the *Unfair Competition Act* of 1932,⁶⁴ and the *Trade-marks Act* of 1953 (which was the basis for Canada’s present legislation).

⁶⁵ Kelly A. Gill & R. Scott Jolliffe *Fox on Canadian Law of Trade-marks and Unfair Competition*, 4th Ed. (Toronto: Thompson Carswell, 2001) at 1-3.

⁶⁶ *Constitution Act*, *supra* note 2.

⁶⁷ *Ibid.* at s. 91(22).

⁶⁸ *Ibid.* at s. 91(23).

⁶⁹ Teresa Scassa, “The challenge of trademark law in Canada’s federal and bijural system” in “The challenge of trademark law in Canada’s federal and bijural system”, in Ysolde Gendreau, ed., *An Emerging Intellectual Property Paradigm: Perspectives from Canada*, Queen Mary Studies in Intellectual Property Law, Cheltenham, UK: Edward Elgar, 2008 at 3-4.

⁷⁰ *An Act to Amend the Act respecting Trade Marks and to provide for registrations of Designs*, S. Prov. C. 1861 (24 Vict.), c. 21.

1867 continued to legislate in the area of trademarks. It has been assumed that the basis for the federal government's jurisdiction over trademarks relates to its power to regulate "trade and commerce".⁷¹

The modern Canadian *Trade Marks Act* remained relatively unchanged from its inception in 1953⁷² until recently. Then, in 2017⁷³ and 2019,⁷⁴ many amendments were introduced. The most recent amendments,⁷⁵ in particular, are the result of the federal government in Canada responding to international commitments made by Canada in joining the Madrid Protocol in July 2019,⁷⁶ by passing recent amendments to the Act. It now offers protection to non-traditional marks and can protect a three-dimensional configuration, a hologram, sound, smell, touch, colour, slogan, shaping of the wares or their containers, motion, and so forth.⁷⁷ A number of these amendments will be described

⁷¹ *Constitution Act*, *supra* note 2 at s. 91(23).

⁷² The Canadian *Trade Marks Act*, 1953, 1-2 Eliz. II, c. 49.

⁷³ The *Canada – European Comprehensive Economic and Trade Implementation Act*, SC 2017, c.6. See especially ss 60-79 respecting the *Trademarks Act* – particularly affecting provisions of the statute that govern geographic indications.

⁷⁴ *Budget Implementation Act, 2018, No.2*, S.C. 2018, c. 27, Division 7 Intellectual Property Strategy, Subdivision B *Trade-marks Act*, ss 214-242.

⁷⁵ Canadian Intellectual Property Office, "Non-Traditional Trademarks" (17 June 2019), online: < <https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr04453.html>>.

⁷⁶ Stephane Abitbol, "The Canadian Trademark Regime: Amendments to the Trade-Marks Act and the Threat to Canada and the United States" (2015) 24:1 *Cardozo J Intl & Comp L* 229 at 230 and 236; *Madrid Agreement Concerning the International Registration of Marks*, Apr. 14, 1891, as amended on September 28, 1978.

⁷⁷ *Trademarks Act*, *supra* note 8 at s. 2.

in Chapters 3 and 4 because they are important to the discussions presented in this thesis.⁷⁸

Nonetheless, as noted above, Canada's federal government cannot exclusively enact laws in the area of trademark and must leave room for provincial participation.⁷⁹ Thus, despite the introduction of a federal system for trademark registration, the common law tradition (in nine of the ten provinces and the three territories) and the civil law tradition in Quebec both recognize unregistered marks.⁸⁰ Historically and into the present, unregistered marks have been protected through actions in torts (under common law) or delict (under civil law) on the basis of use of a distinctive mark in association with commercial activities that have enabled a trader to establish goodwill or reputation.⁸¹ As such, trademark law falls under both federal law and provincial legal systems in Canada: the federal government has authority over registered trademarks under statutory law; provincial governments can participate in matters related to unregistered marks (through

⁷⁸ These amendments are so recent that there has been little opportunity for peer-reviewed secondary legal literature to be developed. Nonetheless, it is inevitable that a sharp evolution in secondary legal literature and case law will follow over the next few years. (The process of peer-review means that such publications take longer to appear than is the case with publications not peer-reviewed; Since the amendments to the *Trademarks Act* were announced and implemented, there has been lots of un-peer-reviewed commentary from leading law firms and intellectual property law practitioners, see, for instance, Susan J Keri & Jonathan Burkinshaw, "Non-traditional marks in Canada" *Intellectual Property Magazine* (March 2011), online: <https://www.bereskinparr.com/files/file/docs/IPM_Mar_2011-SK_JB.pdf> (accessed September 25, 2021) and Christopher Heer et al., "Amendments to the Trademarks Act will come into force on June 2017 – Are you and your business ready?", online: < <https://www.heerlaw.com/changes-trademarks-act>> (accessed September 25, 2021).

⁷⁹ Scassa, *supra* note 69 at 3-4.

⁸⁰ *Ibid.* at 317-320.

⁸¹ *Ibid.*

the tort of passing off in the common law provinces and territories and as provided for in civil law in Quebec).⁸²

8. Organization of the Thesis

The second chapter will present a literature review of the key works related to this thesis topic, including information about the reception of Bartholomew’s concept of “neuromarks”.⁸³

The third chapter will discuss the public international law substantive trademark obligations that Canada shares with the United States: both countries are members of the Paris Convention.⁸⁴ There are no other substantive trademark commitments in public international law, although both Canada and the United States are signatories to other public international law treaties involving trademark – but these are treaties that focus on procedural aspects of trademark law and practice⁸⁵ and therefore are not relevant to the concepts dealt with by Bartholomew in his article on “neuromarks”. These other public international law instruments, therefore, will not be further discussed in this thesis.⁸⁶

⁸² Hagen et al., *supra* note 62 at 317-325. Note that those who rely on unregistered marks are protected by common law although they may also take action under section 7 of the Trademarks Act, which offers statutory causes of action (not unlike the common law passing-off action) to owners of unregistered marks in some situations. See *Trademarks Act*, RSC 1985, c. T-13 at s. 7.

⁸³ Rebecca Tushnet, “Gone in Sixty Milliseconds: Trademark Law and Cognitive Science” (2008) 86 *Tex L Rev* 507. Rebecca Tushnet is a Professor at Georgetown University Law Center. She holds a B.A. from Harvard University and a J.D. from Yale Law School. Her research work focuses on copyright, trademark, and false advertising law.

⁸⁴ *Paris Convention for the Protection of Industrial Property*, 20 March 1883, 828 UNTS 305 (amended 28 September 1979, entered into force 3 June 1984).

⁸⁵ The federal government in Canada has responded to international commitments made by Canada by joining the Madrid Protocol in July 2019

⁸⁶ Canada, in July 2019, joined the Madrid Protocol in July 2019. United States is also a member of the Madrid Protocol, it joined in November 2003. See United States Patent and Trademark Office, “Madrid Protocol” (26 February 2021), online” < <https://www.uspto.gov/trademarks/laws/madrid-protocol>>.

Both Canada and the United States are also signatories to the key multilateral international trade agreement, the *Marrakesh Treaty*,⁸⁷ that established the WTO, and, through signing of the *Marrakesh Treaty*, to its appendix, the TRIPS Agreement, which contains provisions relating to trademark law.⁸⁸

There are also other international trade agreements involving intellectual property commitments in place involving Canada, all of them created subsequent to the signing of the *Marrakesh Treaty* – and based upon the TRIPS Agreement. The *Comprehensive and Progressive Agreement for Trans-Pacific Partnership*, hereinafter CPTPP,⁸⁹ came into effect in 2018 and includes provisions related to the protection of trademarks – but the United States is not signatory to this agreement.⁹⁰ On the other hand, the *Canada-United States-Mexico Agreement*, hereinafter CUSMA,⁹¹ signed in 2019, also contains provisions relating to trademark and does involve both Canada and the United States.

The key focus of the discussion about the CPTPP will be to identify which provisions, if any, in the CPTPP appear to create obligations in respect of trademarks (which the United States, not being signatory to it, will not have) that might alter the extent to which Canadian law will be able to embrace the concept of “neuromarks” as set out by Bartholomew for U.S. law.

⁸⁷ *Marrakesh Agreement*, *supra* note 56.

⁸⁸ *Ibid.*

⁸⁹ *Comprehensive and Progressive Agreement for Trans-Pacific Partnership*. (2018). (“CPTPP (2018)”).

⁹⁰ *Ibid.*

⁹¹ Government of Canada, “*Canada-United States-Mexico Agreement (CUSMA) - Intellectual property chapter summary*” online: <<https://www.international.gc.ca/trade-commerce/trade-agreements-accords-commerciaux/agr-acc/cusma-aceum/ip-pi.aspx?lang=eng>> (accessed 15 October 2021).

The fourth chapter will analyze the concepts inherent in Bartholomew's notion of "neuromarks" under the Canadian law governing both unregistered marks (i.e., under the common law tort of passing off) and registered trademarks (i.e., under statutory law).⁹² Bartholomew has discussed protection for trademarks offered under both common law for unregistered marks (i.e., as indicated in the *Lanham Act*)⁹³ and statutory law for registered marks. This chapter will conclude with a section analyzing Bartholomew's three hypothetical scenarios (which reflect U.S. trademark law) under Canadian law in order to determine whether the outcomes will be the same as those presented by Bartholomew in the context of trademark law in the U.S.

The fifth chapter will conclude.

⁹² One point of difference between the two countries, that will be discussed further in the conclusion to this thesis, is that in the United States, the Trademark Dilution Act (See *Federal Trademark Dilution Act* (FTDA), 15 U.S.C. § 1125(c)) outlines *dilution* as a cause of action, however Canadian trademark law does not have a similar cause of action. Bartholomew's discussion with respect to dilution and "neuromarks" (See Mark Bartholomew, "Neuromarks" (2018) *Minn L Rev* 521 at 525-535), therefore, cannot have a parallel in the Canadian context.

⁹³ *Lanham (Trademark) Act*, *supra* note 10.

Chapter 2: Scholarly Introduction of Neuroscience into the Domain of Trademark Law

1. Introduction

As noted in Chapter 1, this thesis explores, in the context of Canadian law, the concept of “neuromarks” advanced by Bartholomew in U.S. trademark law. As noted in Chapter 1, when Bartholomew’s paper was published in 2018, “neuromarks” did not actually exist yet in U.S. trademark law, and this remains true today. As such, Bartholomew wrote his paper from a hypothetical standpoint, considering the possibility of incorporating “neuromarks” in U.S. trademark disputes in the future.

This chapter explores the scholarly literature related to neuromarks. Part I describes literature spanning neuroscience and law that preceded Bartholomew’s 2018 article introducing the concept of neuromarks. Part II, focuses on neuroscientific technologies in the context of trademarks. Part III asks whether Bartholomew’s understanding of neuromarks-related technology matches current advances. Part IV considers the impact of Bartholomew’s 2018 article in the legal literature.

2. Literature Involving Neuroscience and Law Prior to Bartholomew’s 2018 Article

a) Neuroscience Literature

Bartholomew based his ideas about “neuromarks” on the results of a marketing research study where Chen Yu-Ping et al. used fMRI scans to measure participants’ brain activation patterns while they were presented with images of several well-known

trademarks.⁹⁴ In the study, first, researchers conducted a behavioural survey to obtain participant ratings on a set of traits outlined in prior literature in the field of marketing,⁹⁵ designed to assess brand personality traits and to successfully predict neural signatures reflecting distinct perceptions including excitement, ruggedness, sophistication, and more in a subsequent stage of the study.⁹⁶ Second, various trademarks of top global brands such as Louis Vuitton, IBM, Google, Coca-Cola, Pepsi, Nestle, and other brands from a variety of market categories were displayed on a computer screen in a consecutive manner while participants were lying flat in an fMRI scanner.⁹⁷ Each trademark was repeated four times in a pseudo-random sequence for brief periods of 4-8 seconds each. Participants were asked to passively view the trademarks and think about the characteristics or traits associated with each brand. Participants' brain activation levels and patterns were recorded in the form of 'BOLD' (blood-oxygen-level-dependent) signals and computer software generated visual representations that were colour-coded to show patterns and levels of activation in the various brain regions.⁹⁸ Third, the data were mapped using a radar chart technique on a two-dimensional representational space. This mapping spatially demonstrated patterns of neural representations of brand associations and brand personalities in the consumers' brains.⁹⁹ These investigations enabled Yu-Ping

⁹⁴ Bartholomew, *supra* note 16 at 523-525, citing to Chen Yu-Ping et al, "From "Where" to "What": Distributed Representations of Brand Associations in the Human Brain", (2015) J Mark Res 453 at 457.

⁹⁵ Jennifer L Aaker, "Dimensions of Brand Personality" (1997) 34:3 J Mark Res 347.

⁹⁶ Chen Yu-Ping et al., *supra* note 94 at 456-458; Bartholomew, *supra* note 16 at 523-525.

⁹⁷ *Ibid.* at 457. See Figure 1b.

⁹⁸ *Ibid.* at 458.

⁹⁹ *Ibid.* at 457. See Figure 1d.

et al. to derive a neural map unique to each well-known brand,¹⁰⁰ neural maps subsequently referred to as “neuromarks” by Bartholomew.¹⁰¹

b) In Areas of Law other than Trademark

In the opening sentences of his 2018 “Neuromarks” article, Bartholomew wrote:

[n]euroscience is changing the law. Between 2007 and 2012, the number of judicial opinions [in the United States] mentioning neuroscientific evidence more than doubled. Brain imaging is now part of the evidentiary record... This evidence can decide the weightiest of legal matters. Scans have been used to reveal brain abnormalities that could explain past behavior and, hence, be used to determine whether a defendant deserves the death penalty.¹⁰²

As Bartholomew noted, and as found by this author’s preliminary search of U.S. legal literature,¹⁰³ there is evidence that neuroscience has been used in criminal¹⁰⁴ and civil

¹⁰⁰ *Ibid.* at 457-458.

¹⁰¹ Bartholomew, *supra* note 16 at 525.

¹⁰² Bartholomew, *supra* note 16 at 521.

¹⁰³ A literature search was conducted in HeinOnline for keywords – “neuroscience and law” with results confined to the United States after 2018. In HeinOnline, a filter was used to select literature relevant to the United States, published after 2018 (after Bartholomew’s article). This database was chosen because of its comprehensive coverage of legal literature. The results revealed 20 peer-reviewed articles and 4 reviews in HeinOnline. Most articles were on the topic of criminal law and some articles were on the topic of civil law such as personal injury, employment, and family law. Another keyword search was conducted for the term “neurolaw” using a filter to restrict the results to those relevant to the United States. The results revealed 78 articles and 6 reviews. Search conducted 8 January 2020.

[NOTE that similar search was conducted in Google Scholar, on 8 January 2020, using the Advanced Search function where an additional keyword was added to the search for this restriction – “neuroscience and law and United States”. The results of this search, for the reasons indicated here, were not considered in the discussions in this thesis and Google Scholar was not used for other keyword searches in this chapter. This search engine was initially chosen because of its comprehensive coverage of legal and non-legal literature. The results revealed 515,000 peer-reviewed and non-peer-reviewed articles in Google Scholar. Upon further inspection of the results, it was clear that there was noise in the obtained data where the results also captured literature when the keywords were mentioned in the journal’s name, references. The limited functionality of the Google Scholar advanced search function only allows for a search to be restricted to keywords in the title or anywhere in the article.

¹⁰⁴ Teneille Brown & Emily Murphy, “Through a Scanner Darkly: Functional Neuroimaging as Evidence of a Criminal Defendant’s Past Mental States” (2010) 62 *Stan L Rev* 1119 at 1132; Nita A. Farahany,

(i.e., personal injury,¹⁰⁵ employment¹⁰⁶ and family¹⁰⁷) law cases in the United States.¹⁰⁸

For example, neuroscience evidence has been used for assessing brain damage as part of seeking mitigation in death penalty-eligible cases in the United States.¹⁰⁹ Similar neuroscience evidence (from fMRI and electroencephalography (EEG)¹¹⁰ technologies) has also been used in litigating brain-injury cases in the United States,¹¹¹ a trend in civil litigation that emerged in the 1980's and 1990's. It was in connection with that trend that

“Neuroscience and Behavioral Genetics in U.S. Criminal Law: An Empirical Analysis” (2015) 2 J L & Biosci 485 at 486.

¹⁰⁵ Francis X Shen, “The overlooked history of neurolaw” (2016) 85 Fordham L Rev 668. In this article, Shen discusses the development of neurolaw in personal injury litigation in the late 1980's and 1990's. Refer to Parts I-IV at 670-693 for a detailed review of this topic. This topic is not discussed in further details in this thesis as it is out of the scope of the overall research questions addressed by this research.

¹⁰⁶ Harvey L Fiser & Patrick D Hopkins, "Getting inside the Employee's Head: Neuroscience, Negligent Employment Liability, and the Push and Pull for the New Technology" (2017) 23:1 BU J Sci & Tech L 44 at 45-46, 65.

¹⁰⁷ Allan Schore & Jennifer McIntosh, “Family Law and the Neuroscience of Attachment, Part I” (2011) 49:3 Fam Court Rev 501.

¹⁰⁸ There is also some literature on the use of fMRI as lie detection evidence in the United Kingdom. See Alex J. Smethurst et al., “The Influence of fMRI Lie Detection Evidence on Jury Decision Making Following Post-Trial Deliberations” (2015) 11:3 Appl Psychol Crim Justice 147.

¹⁰⁹ Deborah W. Denno, “The Myth of the Double-Edged Sword: An Empirical Study of Neuroscience Evidence in Criminal Cases” (2015) 56 B.C. L Rev 493 at 494–499.

¹¹⁰ Electroencephalogram (EEG) is an inexpensive, non-invasive method that involves the use of electrodes placed on the participant's scalp with the help of a helmet, cap, or band. These electrodes are used to measure electrical activity of brain cells called *neurons* in response to stimuli. Moran Cerf “Methods” in Cerf Moran and Manuel Garcia-Garcia, eds, *Consumer Neuroscience*, (Cambridge: MIT Press, 2017) at 65-75.

¹¹¹ Shen, *supra* note 105 at 686.

the term *neurolaw* was coined by J Sherrod Taylor in 1991,¹¹² a term that has been repeatedly recognized in the literature.¹¹³

There is now a growing debate in the legal literature in the U.S. about the role of neuroscientific evidence in law,¹¹⁴ primarily, in the context of criminal law, on the topics of responsibility, extensivity, determinism, and guilt,¹¹⁵ and, in the context of employment law,¹¹⁶ on the topics of power, liberties, obligations, and liability.

Discussions of the role of neuroscientific evidence are also present in the Canadian legal literature on topics such as moral responsibility in criminal law,¹¹⁷ and the admissibility of neuroscientific findings in lie detection for cases involving witness testimonies.¹¹⁸

¹¹² J Sherrod Taylor et al., “Neuropsychologists and Neurolawyers” (1991) 5 *Neuropsychol* 293 at 293. J. Sherrod Taylor is an American lawyer, specializing in the field of Plaintiff’s Personal Injury Law, Federal Employers Liability Law, Wrongful Death, Neurolaw, International Tort Law. He is a graduate of the University of Georgia School of Law.

¹¹³ Shen, *supra* note 105 at 685-687. A literature search was conducted in HeinOnline and Google Scholar for keywords – “neurolaw”. These databases were chosen because of their comprehensive coverage of legal and non-legal literature, respectively. The results revealed 363 results in HeinOnline, including 205 articles, 46 comments, 33 notes, 21 reviews, and 2,230 peer-reviewed and non-peer-reviewed articles on Google Scholar. Search was conducted on 21 December 2021.

¹¹⁴ Francis X. Shen, “The Law and Neuroscience Bibliography: Navigating the Emerging Field of Neurolaw”, (2010) 38 *Intl J Legal Info* 352 at 352.

¹¹⁵ Shen, *supra* note 105 at 673-675, 690.

¹¹⁶ Fiser & Hopkins, *supra* note 106 at 45-47, 52, 64-65.

¹¹⁷ Elizabeth Bennett, “Neuroscience and Criminal Law: Have we been getting it wrong for centuries and where do we go from here?” (2016) 85:2 *Ford L Rev* 437.

¹¹⁸ Jennifer Chandler, “Reading the Judicial Mind: Predicting the Courts’ Reaction to the Use of Neuroscientific Evidence for Lie Detection” (2010) 33:1 *Dal L J* 85.

c) In the Trademark Law Literature

Before Bartholomew's 2018 article describing "neuromarks", only a few earlier articles, such as those by Rebecca Tushnet¹¹⁹ and Thomas Lee et al.,¹²⁰ aimed to bring any psychological research techniques, including neuroscience techniques to bear on trademark law.

In her 2008 article "Gone in Sixty Milliseconds: Trademark Law and Cognitive Science",¹²¹ Rebecca Tushnet briefly mentioned the potential of neuroscientific technologies to capture information directly from the consumers' brains. She stated:

[n]euromarketing, the investigation of marketing and branding techniques through observation of brain activity rather than consumer self-reports, is the most recent contender in the search for greater understanding of consumer behavior... Neuromarketing also appeals to the idea that there is an objective truth behind intangible brand values.¹²²

However, Tushnet did not thoroughly discuss the implications of neuromarketing for the law. Instead, she focused on a deeper discussion of various psychological concepts underlying the legal notion of trademark dilution, from the perspective of U.S. law, including internal search costs and cognitive models of memory, emotions and decision

¹¹⁹ Tushnet, *supra* note 83.

¹²⁰ Thomas R Lee et al., "An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness" (2009) 41 Ariz St LJ 1033 at 1033-1109. This article is on the topic of trademark distinctiveness and its reliance on consumer psychology (i.e., how consumers perceive a mark, make an association between the mark and the source of the goods or services and establish a schematic perceptual model). The discussion presented in this article is from the perspective of trademark law in the U.S.

¹²¹ Tushnet, *supra* note 83.

¹²² *Ibid.* at 508.

making.¹²³ She primarily cited articles relating to the study of cognitive science using traditional psychological methodologies such as mental constructs,¹²⁴ word associations¹²⁵ and reaction times in recall and recognition tasks.¹²⁶

Tushnet reviewed the functions of trademarks as well as their relationships with cognitive science. She primarily focused on the law of dilution in the United States and discussed how it helps protect original mark-holders as well as consumers.¹²⁷ According to Tushnet, much of branding is about memory and psychological studies can provide researchers with a window into consumers' memories.¹²⁸ She stated:

[m]uch of branding is a matter of memory, corresponding to what lawyers call acquired distinctiveness in trademark, and science offers increasingly sophisticated understandings of memory's relationship to emotion and its effects on purchasing decisions.¹²⁹

For example, psychological studies, conducted either in an in-person laboratory setting or online, can be used not only to study the mental processes of retention, recall and

¹²³ *Ibid.* at 507.

¹²⁴ Michael Hopkin, "Web Users Judge Sites in the Blink of an Eye" (2006) *Nature News*. Online: <https://www.nature.com/news/2006/060109/full/060109-13.html>. Accessed February 10, 2022.

¹²⁵ Joan Meyers-Levy, "The Influence of a Brand Name's Association Set Size and Word Frequency on Brand Memory" (1989) 16 *J Cons Res* 197 at 202-203.

¹²⁶ Maureen Morrin & Jacob Jacoby, "Trademark Dilution: Empirical Measures for an Elusive Concept" (2000) 19 *J Pub Pol & Mark* 265 at 267-270.

¹²⁷ Tushnet, *supra* note 83 at 512-513.

¹²⁸ *Ibid.*; Bartholomew, *supra* note 16. In his reasoning, Bartholomew takes a leap from a) psychological and social science models based on memory to b) a neuroscientific model based on complex mental processes including perception, attention, memory, emotion, and feelings. The key differentiating factor between a) the psychological and social science methodologies that the current state of trademark law heavily relies upon and b) the emerging neuroscientific technologies that Bartholomew discussed is relying on memory which can be subjective versus obtaining objective information about complex mental processes.

¹²⁹ *Ibid.*

recognition, but also to test the influence of external factors such as distractors (i.e., an infringer's mark, as opposed to an original mark-holder's mark) on participants' short-term and long-term memories.¹³⁰ She acknowledged that the networks of neurons in human brains are highly malleable and hence, readily change due to experience.¹³¹ Therefore, she pointed out, it is inevitable that exposure to a similar looking mark can alter consumers' brains and interfere with existing memories of the original mark-holder's mark.¹³²

Tushnet discussed an internal search cost model which can be used to explain the mental efforts that consumers must expend when undertaking a search for goods or services. This model accounts for consumers' mental efforts in sorting incoming information and integrating it with what they already know.¹³³ For instance, when two or more market players use very similar or even identical trademarks to indicate the source of their goods or services to consumers, it can cause consumers to expend additional time and mental effort to decipher whether the marks refer to the same company or to different companies. This is the underlying basis for the legal notions of likelihood of confusion and dilution under trademark law in the U.S.,¹³⁴ and likelihood of confusion (at statutory

¹³⁰ Cerf, *supra* note 18 at 65-69.

¹³¹ Tushnet, *supra* note 83 at 515.

¹³² *Ibid.* at 512-513.

¹³³ *Ibid.* at 509-510.

¹³⁴ *Ibid.* at 512-513, 549-550.

law) or misrepresentation (at common law), depreciation of goodwill, and harm to reputation under Canadian trademark law.¹³⁵

Furthermore, Tushnet acknowledged that even though this concept of internal search cost model applies only to commercial uses under U.S. trademark law, non-commercial uses can also have a dilutive effect. She presented an example of the well-recognized girl's name, Tiffany and the jewelry store Tiffany. When someone mentions "I am going to hang out at Tiffany's", it is possible that this may interfere with recognition of the jeweler's mark Tiffany. However, anti-dilution laws in the United States do not offer protection against such non-commercial uses. Other examples of non-commercial uses may include users in news reporting, non-commercial speech, parody, criticism, and comparative advertising.¹³⁶ Such non-commercial uses are also not prohibited under Canadian trademark law.¹³⁷

Tushnet referred to the findings of various psychological studies where authors discussed some of the leading tests and methodologies up to the writing of her article.¹³⁸ First, she discussed the classic 2004 study¹³⁹ of consumer behaviour with respect to Coca-Cola versus Pepsi, using fMRI technologies. In this landmark study, researchers conducted blinded versus non-blinded taste tests whereby participants were either aware

¹³⁵ Scassa, *supra* note 12, at 319-320, 387-393.

¹³⁶ Tushnet, *supra* note 83 at 549-550, 554.

¹³⁷ *Trademarks Act*, RSC 1985. c. T-13.

¹³⁸ Tushnet, *supra* note 83 at 526-540.

¹³⁹ Samuel M McClure et al., "Neural Correlates of Behavioral Preference for Culturally Familiar Drinks" (2004) 44 *Neuron* 379.

or not aware of the brand of the beverage they were tasting. Participants were asked to provide a self-report of their preferred beverage and their brain activity levels were recorded while they were lying flat inside of an fMRI scanner. This study established that consumers like Coca-Cola better than Pepsi in a non-blinded taste test, but their preferences are reversed in a blinded taste test. These results demonstrated that consumers make strong associations between the product and their memories of past experiences, whereby in this case Coca-Cola and its marketing plays a key role in influencing what the consumers are actually tasting. In other words, consumers are not only tasting the beverage but also making mental associations between the drink and their memories and experiences when they previously consumed the beverage.¹⁴⁰

Second, she cited studies that used psychological models to investigate the effects of confusing marks on the memories and recall of existing marks in the marketplace. For example, she cited a 2000 study by Maureen Morrin and Jacob Jacoby¹⁴¹ where the researchers presented participants with diluting ads for Dogiva dog biscuits, Heineken popcorn and Hyatt legal services and measured their accuracy and response times in associating brands with product categories and attributes. The researchers found that the presence of confusingly similar marks negatively impacted participants' accuracy and slowed their response times.¹⁴² Tushnet argued that such studies distort actual consumer reactions through the act of measurement, raising doubts about surveys and other self-

¹⁴⁰ Tushnet, *supra* note 83 at 508-509, 513-514; Bartholomew, *supra* note 16 at 534-536. Bartholomew also picked up on the discussion of this study in his article.

¹⁴¹ Morrin & Jacoby, *supra* note 126 at 267-270.

¹⁴² *Ibid.*; Tushnet, *supra* note 83 at 521.

report methodologies.¹⁴³ To support her arguments of such weaknesses, she presented an example of a consumer hailing a cab with suitcases in major cities in the U.S. and asking the driver for “American” or “United”. Even though these marks are heavily diluted, given the context of the situation, cab drivers don’t ask consumers “which one?” or mistakenly take consumers to American Apparel, United Van Lines or other branded locations that use these words in their names.¹⁴⁴ As such, in the context of a laboratory or other artificial settings, it is highly likely that consumers’ reactions are distorted given the context and the act of measurement.¹⁴⁵

Third, she cited some traditional psychological studies that were conducted using the paper and pencil method to investigate brand distinctiveness and dilution by studying concepts such as recall, recognition and production of words. Results of such studies supported that dilutive effects of a competitor’s ads had a negative impact on a consumer’s likelihood to purchase the diluted brand from among competing alternatives.¹⁴⁶ These results may be helpful to illustrate dilution by blurring in the legal context in the U.S.¹⁴⁷ Overall, these studies showed how interference from confusingly similar and dilutive marks can make it harder for consumers to retrieve brand information

¹⁴³ *Ibid.* at 528.

¹⁴⁴ *Ibid.* at 529.

¹⁴⁵ *Ibid.* at 530.

¹⁴⁶ Chris Pullig et al, “Brand Dilution: When do New Brands Hurt Existing Brands?” (2006) J Mark 52 at 61.

¹⁴⁷ Tushnet, *supra* note at 521-522.

from memory, thereby increasing their internal search costs (measured by recording participants' reaction times on search tasks).¹⁴⁸

Nonetheless, Tushnet raised some concerns regarding the accuracy of the cognitive models and internal search cost models. Some of the major problems she discussed include insufficient attention to the real-world context in which consumers are exposed to trademarks (i.e., in contrast with the artificial laboratory setting where research studies are conducted), misinterpretation of research into word frequency and associations (i.e., overreliance on research findings that investigate word frequency and associations as a proxy for trademark concepts such as trademark infringement and dilution) and failure of researchers to acknowledge that what may be considered as dilution may sometimes improve consumers' memories for a trademark (i.e., with reference to the *Moseley* dictum,¹⁴⁹ it is possible that associations do not necessitate that the senior mark suffers dilution via blurring of its own association with its source or attributes).¹⁵⁰ She warned legal scholars and practitioners to be wary of over relying on psychological techniques and other cognitive science models:

The use and misuse of cognitive science to explain trademark doctrines offer insight into the broader question of what empirical scientific research can tell us about legal doctrines. Neuroscience, like behavioral economics, is increasingly being offered as a source of wisdom to guide legal doctrine. As happened with economic analysis and antitrust law, cognitive science is being

¹⁴⁸ *Ibid.*, at 518-519.

¹⁴⁹ In the landmark case of *Moseley v V Secret Catalogue, Inc.* in the Supreme Court in the U.S., it was established that even though exposure to a defendant's mark may prompt consumers to make an association with the plaintiff's mark, this does not necessarily constitute dilution by blurring. It may in fact be possible that such associations can strengthen the plaintiff's mark in the consumers' minds by forcing recall from memory. See *Moseley v V Secret Catalogue, Inc.*, 537 US 418 (2003). Also see Barton Beebe et al., "Testing for Trademark Dilution in Court and the Lab" (2019) 86:3 U Chi L Rev 611 at 616-617.

¹⁵⁰ Tushnet, *supra* note 83 at 510.

imported into trademark law in order to convert vague, intuitive concepts into objective rules, generating new law along the way. In antitrust, such scientism led to a rollback of regulation, whereas in trademark it seemingly points to a significant expansion of the law. Here, however, there are significant empirical uncertainties, as well as normative problems with treating consumers' mental images of marks as things that can be owned by other entities. We should therefore hesitate to adopt the cognitive model as legal truth.¹⁵¹

Later Tushnet stated, more specifically:

Given the available evidence, the cognitive model of dilution lacks enough empirical support to justify its adoption as a general theory underlying dilution law. There is still too much we do not know about how consumers process marks in the marketplace. At a minimum, we cannot predict that any particular dilutive use will produce the difficulties posited by the cognitive model.¹⁵²

Tushnet also highlighted a few more limitations of psychological studies including: 1) the inability of their results to hold true in the long-term; 2) the limited predictive value of the results of these studies; and 3) the need for specialized expertise to help lawyers, judges and legal scholars make sense of the research methodologies and findings.¹⁵³

Tushnet acknowledged that cognitive models can be particularly attractive to prove distinctiveness, likelihood of confusion and dilution in trademark law in the U.S., although she warns that courts should be wary of such psychological studies of the human mind.¹⁵⁴ She was skeptical about incorporation of psychological research

¹⁵¹ *Ibid.*, at 511.

¹⁵² *Ibid.* at 546.

¹⁵³ *Ibid.* at 526-540. These limitations are either explicitly stated or implied in the discussion of the various psychological studies in the article. Bartholomew, *supra* note 16 at 526-527. Bartholomew also discusses the history of psychology and law and acknowledged that even faulty science has made its way into the courts in the past.

¹⁵⁴ *Ibid.* at 526-540.

techniques into trademark law. She used psychological studies as an example to show how unreliable they are and what little evidence of actual harm to famous mark owners they can offer. She cautioned that there are no magic bullets or magic MRIs.¹⁵⁵ As will be discussed below, Bartholomew, on the other hand, saw promise in recent scientific advancements and presented an optimistic view about incorporation of neuroscientific techniques into trademark law.¹⁵⁶

Legal scholars, writing before Bartholomew, have presented arguments against overreliance on DNA evidence as an indicator of guilt in criminal law cases and have warned against overreliance on fMRI data as lie detection evidence in criminal law cases in the United Kingdom.¹⁵⁷ In the context of trademark law, legal scholars in the Netherlands and the European Union have more recently raised similar concerns about the potential risk of over reliance on empirical findings (i.e., social science data, neuroscience data, etc.) because, they argue, without normative corrections, empirical findings may enable trademark law to become a self-servicing mechanism for the strongest market players.¹⁵⁸

¹⁵⁵ Bartholomew, *supra* note 16, at 525-526; *Ibid.* at 568.

¹⁵⁶ *Ibid.* at 525-526.

¹⁵⁷ Alex J Smethurst et al., “The Influence of fMRI Lie Detection Evidence on Jury Decision Making Following Post-Trial Deliberations” (2015) 11:3 Appl Psychol Crim Justice 147 at 147-148. The authors state “Researchers argue that the ubiquitous presence of DNA evidence in popular media has led to it gaining a “special aura of certainty” and “mystic infallibility” that has resulted in its very presence becoming a heuristic cue for jurors, who have come to view DNA evidence as a definitive indicator of guilt.”

¹⁵⁸ Lotte Anemaet, “The Fairy Tale of the Average Consumer: Why We Should Not Rely on the Real Consumer When Assessing the Likelihood of Confusion” (2020) GRUR Intl’ 69(10) at 1008. Bartholomew implicitly makes a point on this but does not provide a thorough analysis of the risks of overreliance on this form of evidence. He stated,

[a]lready mistrustful of their own guesses as to which mark resemblances strike too close to home, courts may be even less tempted to rely on these

3. Bartholomew's Contribution

Bartholomew¹⁵⁹ took Tushnet's concerns seriously and agreed with her on some of the limitations of scientific technologies.¹⁶⁰ However, he noted that most of the studies that Tushnet referred to in her article used psychological techniques that allowed researchers to make inferences about participants' cognitive processes from recorded measurements of their behaviours. For example, in one of the studies to which Tushnet referred, researchers recorded participants' retention times in the presence or absence of a competitive mark and made inferences about participants' cognitive processes based on recorded behaviours and reaction times.¹⁶¹ Bartholomew noted that his inspiration for this topic came from his observations of increasing trends in the use of applied research on brain function in market research – research which was guiding advertising and branding strategies.¹⁶² He stated "...[e]stimates of consumer thought form the bulk of trademark doctrine"¹⁶³ and therefore predicted great potential for brain science's applications in the context of trademark law.

guesses when they can place their faith in tangible neural evidence of actual confusion.

See Bartholomew, *supra* note 16 at 559.

¹⁵⁹ Recall that Bartholomew's article has been introduced in Chapter 1 under Section 3 Mark Bartholomew's Conception of "Neuromarks".

¹⁶⁰ Bartholomew, *supra* note 16 at 526.

¹⁶¹ Tushnet, *supra* note 83 at 523-527.

¹⁶² Bartholomew, *supra* note 16 at 522, 527.

¹⁶³ *Ibid.* at 523.

According to Bartholomew, “neuromarks” could potentially help replace judicial guesswork (i.e., judge’s intuitions, interpretations of survey information, etc.) about consumer perception with precise measurements of consumer thought.¹⁶⁴ They might also be more appealing for trademark than other forms of evidence as “neuromarks” would enable researchers to overcome challenges that arise from the use of traditional social science methodologies and their heavy reliance on participants’ self-reports.¹⁶⁵ A central critique of social science methodologies is that participants may not know or may not want to reveal what is going on in their heads or they may present responses to please the researchers.¹⁶⁶ To illustrate this point, Bartholomew cited the high-profile introduction of New Coke in the 1980’s which was preceded by rigorous testing and surveys with sample consumers. Even though data from those social science methodologies was promising, the product flopped after a public launch. The authors of a study on the New Coke launch concluded that the surveyed consumers likely told market researchers what they wanted to hear instead of sharing their true feelings (i.e., social desirability bias).¹⁶⁷

¹⁶⁴ *Ibid.* at 524-525.

¹⁶⁵ *Ibid.* at 527, 532-533. Traditional social science methodologies such as surveys, interviews and focus groups rely on participants to self-report on their feelings, attitudes, and beliefs. Batty, *supra* note 15 at 441. He stated: “The usual evidence put forward in trade mark cases takes the form of expert evidence, evidence from individual consumers and survey evidence.”

¹⁶⁶ Tushnet, *supra* note 83 at 523-527. There are also other sources of noise and limitations in the use of social science methodologies such as the need for an appropriate sample size, attrition rates, participant fatigue, limited abilities to establish causality, issues with analyses and interpretation, and ethical requirements to obtain informed consent. Bartholomew, *supra* note 16 at 539-553. See Some of these concerns of noise and limitations also spill over into the realms of neuroscientific technologies. See Cerf, *supra* note 18 at 63-65. These methodologies can be subject to a variety of biases including sampling bias, non-response bias, response bias, self-report bias, and social desirability bias: this subjectivity can prove to be limiting factors for accurate assessments of trademark evidence.

¹⁶⁷ Robert M. Schindler, “The Real Lesson of New Coke: The Value of Focus Groups for Predicting the Effects of Social Influence” (1992) 4 *Marketing Res* 22 at 22-27. Cerf, *supra* note 18 at 65-69.

Bartholomew stated,

...[t]wo sources of bias are seemingly ameliorated through neurological scans of consumers: that of consumers failing to reveal their “true” impressions of a mark and that of survey administrators, whether accidentally or by design, skewing the results through their interrogation of respondents.¹⁶⁸

Bartholomew forecasted incorporation of neuroscientific information as an inevitable tool to assist with judicial decision making in cases of trademark because these technologies can help avoid some of these traditional problems and biases with consumer self-reporting.¹⁶⁹ He viewed such new technologies as either supplementing information obtained from traditional social science methodologies or being used on its own to develop more capturing and engaging products, trademarks and marketing strategies.¹⁷⁰

In addition to cost barriers, Bartholomew acknowledged that there are a number of other limitations and challenges posed by the use of neuroscientific technologies.¹⁷¹ For example, raw data gathered from participants during fMRI scans needs to be processed using sophisticated neuroscience research software (e.g., FSL, BrainVoyager, BrainSight, FreeSurfer, etc.) and analyzed using specialized quantitative statistical software (e.g., SPSS, SAS, MATLAB, etc.). Neuroscientific technologies and the associated software for data analyses require highly specialized training and skills to operate. Such higher-level skills are also required to understand and articulate the

¹⁶⁸ Bartholomew, *supra* note 16 at 553.

¹⁶⁹ *Ibid.* at 533.

¹⁷⁰ *Ibid.* at 552.

¹⁷¹ *Ibid.* at 539-543.

meaning of the gathered data, which adds a layer of complexity to the challenges and limitations of using neuroscientific technologies in a legal setting.¹⁷²

Another major critique of using neuroimaging techniques such as fMRI and EEG cited by Bartholomew is that they can only be used to gather data in a laboratory setting, which is often artificial in comparison with a real-world setting where consumers typically shop.¹⁷³ There is no doubt that a laboratory setting will always be different from a real-world setting. However, with significant advances in technology, the laboratory can effectively mimic real-world settings to a much greater degree today than in the past. Thus, this critique is becoming less relevant since Bartholomew wrote his article, as technological innovation continues.

The above-mentioned concerns are analogous to those raised by Tushnet about the incorporation of psychological findings into trademark law as the artificial laboratory settings can pose some challenges in obtaining accurate and relevant data that clearly depicts consumer behaviour in a real-world setting.

Bartholomew claimed that courts can benefit from neuroscientific technologies as researchers improve in their attempts to pinpoint the neural signs of trademark familiarity, comparison and meaning.¹⁷⁴ Bartholomew noted that a central aspect of marketing is branding to create trademark familiarity in the minds of consumers and neuroscience can enable researchers to obtain measurements on how deeply a brand is

¹⁷² The expense amounts depend on the sample size and complexity of the research being conducted.

¹⁷³ Bartholomew, *supra* note 16 at 553-554, 570, 579.

¹⁷⁴ *Ibid.* at 534.

etched in consumers' memories, which may be beneficial for trademark law by providing evidence through which to assess acquired distinctiveness. This would add different evidence to supplement circumstantial evidence such as sales volumes and advertising expenditures presently commonly used in courts in the U.S. in trademark litigation.¹⁷⁵

Bartholomew argued, on the other hand, that neuroscience may not be suitable to provide evidence of inherent distinctiveness (whereby a trademark is inherently thought to be associated with a source of goods or services), a concept which he said relies on more complex brain processes.¹⁷⁶ He acknowledged that consumers have to engage in higher-order mental processes when they make a mental leap from the mark to the goods or services and that such complex mental processes are currently not fully understood by brain science.¹⁷⁷ Bartholomew did not rule out the possibility that, as scientific technologies continue to advance, it may be possible in the future to determine if consumers interpret unfamiliar marks as source indicators or product descriptors.¹⁷⁸

Bartholomew acknowledged that neuroscience can be used to analyze how consumers make choices and how they compare competing options.¹⁷⁹ Consumers routinely make decisions between competing trademarks, and they make such comparisons based on a variety of criteria, such as brand usefulness or brand pleasure.

¹⁷⁵ *Ibid.* at 535-536.

¹⁷⁶ *Ibid.* at 536.

¹⁷⁷ *Ibid.* at 556.

¹⁷⁸ *Ibid.* at 536, 556-557.

¹⁷⁹ *Ibid.* at 536.

According to Bartholomew, these insights could be useful in a legal context for analyzing confusion and the various factors that may contribute to it. He stated,

[i]f a unique neuromark can be defined for a well-known brand, then an interloper whose mark triggers the same neural associations in consumers' heads may be accused of infringement.¹⁸⁰

Bartholomew not only followed up on Tushnet's ideas but, in presenting the argument that elimination of search costs for consumers is the key principle behind modern trademark law, he took a more aggressive stance for accepting neuroscientific evidence in trademark cases:

The elimination of search costs serves as the guiding justification for modern trademark law...Unauthorized trademark usage forces consumers to spend valuable time and effort to scrutinize advertising representations. If I see an advertisement for a tablet computer featuring the "Apple" name yet coming from a different entity than the Cupertino, California-based electronics colossus, I have to waste my limited cognitive and temporal resources evaluating the advertisement more closely than I would otherwise. Even if I do not end up purchasing the product under the mistaken assumption that it comes from the Cupertino company, I will still have to scrutinize this commercial representation more heavily than if such an unauthorized use of the Apple mark was simply prohibited. Saving me from this wasted effort has become trademark law's prime directive.¹⁸¹

[. . .]

If search costs are the primary lens for interpreting consumer neuroscience's entry into trademark law, some changes stemming from trademark law's impending neural turn appear salutary. Additional proof of acquired distinctiveness could help courts make more accurate judgments as to whether a word or symbol

¹⁸⁰ *Ibid.* at 536-537.

¹⁸¹ *Ibid.* at 567.

actually signals source to consumers. In this way, neuroscience might help reduce the danger of trademark false positives: trademark protection for marks that do not actually indicate source, which block competitors from effectively communicating with consumers while doing little to ease shoppers' cognitive burdens.¹⁸²

Bartholomew's example illustrates the negative effects of a confusingly similar mark in the marketplace: not only does it cause harm to consumers and original mark-holders in the short-term (i.e., when a consumer is exposed to a mark and is faced with making a purchase decision), but it does so also in the long-term (i.e., when a consumer's long-term memory is affected due to interference from a confusingly similar mark and when a consumer wrongly begins to associate the infringer's goods or services with those of the original mark-holder in their minds, thus creating a long-term impact on the goodwill and reputation of the original mark-holder).

Bartholomew claimed that, through a search cost lens, "neuromarks" can be beneficial as a form of additional proof of acquired distinctiveness. Use of "neuromarks" could help courts to make more accurate judgments about whether a mark indicates the source of goods or services in the minds of consumers.¹⁸³ Similarly, he claimed that neural data on consumer's perceptions can help courts make a more accurate read of consumer confusion, involving factors including likelihood of confusion, actual confusion and mark strength.¹⁸⁴ He stated, "[c]onfusion is not just an empirical question, but a normative one as well. The search costs justification offers no logical stopping point

¹⁸² *Ibid.* at 568.

¹⁸³ *Ibid.* at 568-569.

¹⁸⁴ *Ibid.* at 568.

for a court trying to assess how much confusion is too much.”¹⁸⁵ On the other hand, he acknowledged that there are implications for trademark and consumer neuroscience because a focus on the search cost model can result in wide disparities in infringement and likelihood of confusion cases.¹⁸⁶

4. Does Bartholomew’s Discussion of the Technology Match Current Advances?

In a 2017 marketing study, Van Kerrebroeck et al. used virtual reality to innovatively present marketing information about brands and their goods or services to consumers and thus investigated the role of “vividness” in marketing communication.¹⁸⁷ They concluded that virtual reality is an effective tool that generates higher perceptions of vividness and presence than a regular two-dimensional video (which is presented to participants on a flat computer screen while data of their brain activation levels is gathered).¹⁸⁸

Neuroscientists have also begun to use approaches similar to those of the marketing researchers Van Kerrebroeck et al., implementing use of virtual reality or augmented reality within an fMRI scanner. In one neuroscience study, Lee Jang-Han et al. used virtual reality technologies in an fMRI scanner to investigate cue-induced

¹⁸⁵ *Ibid.* at 569.

¹⁸⁶ *Ibid.* at 568-569.

¹⁸⁷ Van Kerrebroeck Helena, Malaika Brengman, & Kim Willems “When brands come to life: experimental research on the vividness effect of Virtual Reality in transformational marketing communications” (2017) 21 *Virtual Reality* at 180.

¹⁸⁸ *Ibid.* at 180-182 and 184-186.

smoking cravings¹⁸⁹ and concluded that in three-dimensional conditions created using virtual reality, participants seemed to have more attention, better visual balance and more efficient coordinating movements than in two-dimensional conditions.¹⁹⁰

Neuroscientists Erez et al. have developed innovative ways to present real objects to participants inside fMRI scanners in a safe manner,¹⁹¹ allowing participants to view objects in three-dimensional space and see other characteristics such as depth, height and size. Participants can also interact with objects (i.e., reach, grasp, touch, feel, move, etc.). They used magnetically compatible conveyor belts inside fMRI scanners to present real objects instead of pictures on a computer screen, such that participants could have more real-world-like experiences inside the scanner.¹⁹² There still remain some limitations as real objects that have metallic components cannot be presented to participants inside of an fMRI scanner however three-dimensional prototypes that are safe to enter the fMRI scanner environment can be used as an alternative.

fMRI scanners can be used in conjunction with other methodologies such as eye-trackers to gather deeper insights about specific elements of visual stimuli, including trademarks that capture consumers' attention or trigger memory.¹⁹³ In his book on Consumer Neuroscience, Moran Cerf cited various literature from psychology and

¹⁸⁹ Lee Jang-Han et al. "A Functional Magnetic Resonance Imaging (fMRI) Study of Cue-Induced Smoking Craving in Virtual Environments" (2005) 30:3 Applied Psychophysiology and Biofeedback at 195.

¹⁹⁰ *Ibid.* at 195.

¹⁹¹ Freud Erez et al. "Getting a grip on reality: Grasping movements directed to real objects and images rely on dissociable neural representations" (2018) 98 Cortex at 34-48.

¹⁹² *Ibid.* at 34-48.

¹⁹³ Cerf, *supra* note 18 at 63-70.

neuroscience where researchers investigated internal mental processes such as attention, emotion, memory, and decision making in response to visual stimuli (i.e., abstract visual features, objects, faces, etc.) as well as from marketing where researchers imported learnings from psychology and neuroscience to the study of trademarks using similar research methodologies and technologies.

There are also other recent neuroscientific technologies of which Bartholomew appears unaware. For example, functional near-infrared spectroscopy (fNIRS)¹⁹⁴ that are analogous to fMRI scanners but are portable and can allow researchers to gather direct information about consumers' brain activity levels while consumers not only view trademarks in association with goods or services but also have an opportunity to interact with these goods or services in a real-world setting. For example, researchers can use portable fNIRS devices mounted on consumers' heads while they browse through aisles of products inside a store, enabling researchers to record brain activity levels in real-time (i.e., capture data on consumers' first impressions and exposures to the marks) and in real settings (i.e., inside physical stores or shopping centers). Bartholomew does speculate that as time passes, further scientific advances will enable scientists to probe the main drivers of branding and be of benefit to the law in deciding trademark disputes by attempting to pinpoint the neural signs of trademark familiarity, comparison and meaning.¹⁹⁵

¹⁹⁴ Yoko Hoshi & Shing-Jen Chen, "Introduction" in F.J. Chen, eds, "*Progress in Brain Mapping Research*" (New York: Nova Science Publishers Inc.) at 206.

¹⁹⁵ Bartholomew, *supra* note 16 at 533-534, 554, 564.

Returning to fMRI technology, to mimic the shopping experience that many consumers are familiar with in today's marketplace, researchers can also use e-commerce platforms to present marks in association with goods or services and allow consumers to interact with them on a computer screen while lying inside an fMRI scanner.¹⁹⁶ This can help narrow the gap between laboratory studies and consumers' real-world shopping experiences. Therefore, these types of creative experimental designs add value to the information that can be acquired via traditional consumer surveys that are conducted after the shopping experience, in an artificial setting such as online or laboratory. Consumer surveys also rely on participants' self-report which requires them to engage in a multi-stage reasoning process in order to recall memory of past shopping experiences or consciously think about how they would respond to a present hypothetical shopping experience.¹⁹⁷

These neuroscience methodologies can be used to gather information from an average consumer, an ordinary person who has an average memory with its usual imperfections, which is in line with the definition of an average consumer as discussed by jurors considering Canadian trademark law.¹⁹⁸ Rob Batty stated “[t]he average consumer is not an empirical measure. Rather, the average consumer has been described as a ‘legal

¹⁹⁶ Tun-Min (Catherine) Jai et al. “Seeing It Is Like Touching It: Unraveling the Effective Product Presentations on Online Apparel Purchase Decisions and Brain Activity (An fMRI Study)” (2021) 53 J Interact Mark 66.

¹⁹⁷ Bartholomew, *supra* note 16 at 551-552, 557.

¹⁹⁸ Scassa, *supra* note 12 at 365-366.

construct' (which can be informed, to an extent, by empirical evidence of consumer perception.)”¹⁹⁹

Even though there is potential that neuroscientific information may add value to trademark law and other areas of intellectual property law, there are certain limitations to the technology and barriers to entry that must be taken into consideration. Lotte Anemaet wrote, in 2020, that neuroimaging is a costly technique in which access to the fMRI scanners, participant reimbursement fees, technical staff compensation, software for data analyses, and ongoing maintenance expenses can quickly add up to hundreds of thousands of dollars.²⁰⁰ “Neuromarks” may widen the gap in the level of disparity between litigation outcomes because trademark owners who can afford expensive neuroscientific research will have an advantage in demonstrating the high distinctiveness of their mark or by providing stronger evidence of the degree of consumer confusion, further strengthening their positions in a legal case.²⁰¹ Though Bartholomew noted the problems that the cost of obtaining information on “neuromarks” might engender, he did not propose ways of overcoming them. Anemaet points out that it is important to ensure that trademark law continues to perform its main function of safeguarding market transparency, through which the distinctive signs of a mark-holder can be adequately protected while enabling a competitive marketplace and empowering average consumers

¹⁹⁹ Batty, *supra* note 15 at 442.

²⁰⁰ The expense amounts depend on the sample size and complexity of the research being conducted.

²⁰¹ Anemaet, *supra* note 158 at 1008-1010. Such limitations of using neuroscientific methodologies in trademark law will be discussed in further detail in this thesis.

to rely on trademarks to repeat satisfactory purchases.²⁰² As has been demonstrated in this section of the chapter, Bartholomew’s discussion of the technology does not entirely match the current advances, although he does allude in this article to future advances and improvements to current technology. This section has brought the discussion on neuroscientific technologies up to date. The discussion in Chapter 4 will follow-up on these more modern technologies in the context of Canadian trademark law.

5. Has Attention been paid to Bartholomew’s ‘Neuromarks’ in the Legal Literature?

Peer-reviewed publishing about use of neuroscientific evidence in areas of law other than trademark continues²⁰³ since the publication of Bartholomew’s 2018 “Neuromarks” article, but the focus of this thesis is on the connection between trademarks and the use of this technology.

Literature searches for peer-reviewed materials published on this topic in legal literature were performed using HeinOnline.²⁰⁴ **Table 1: Peer-reviewed Literature Referencing Technology Relevant to “Neuromarks”**,²⁰⁵ below, shows the number of peer-reviewed articles containing relevant search terms retrieved from the universe of legal literature in HeinOnline. As shown in Table 1, three sets of searches were

²⁰² *Ibid.*

²⁰³ See, for instance, Robbie Gonzalez, “How Criminal Courts Are Putting Brains - Not People - On Trial” online <<http://www.wired.com/story/how-criminal-courts-are-putting-brains-not-people-on-trial>> (Accessed 30 November 2020).

²⁰⁴ HeinOnline was chosen for its comprehensive coverage of peer-review legal literature. The literature search indicates that the topic of this research is relatively new and novel and it was hypothesized that there would be limited published secondary literature on this topic. This search was limited to the “Law Journal Library” option and additional filters resulted in retrieval of only peer-reviewed articles. Hence, the counts are reflective of peer-reviewed legal literature. The author is grateful for the assistance of Stephen Spong, Director, John and Dotsa Bitove Law Library and Copyright Officer, Western University.

²⁰⁵ This search was conducted on March 4, 2022.

conducted: the first for trademark with reference to magnetic resonance imaging, the second for trademark with reference to the brain, and the third for trademark with reference to neuroscience (searching more broadly for just “neuro” to capture any related terms).²⁰⁶

The 34 articles shown in Table 1 as retrieved cover a wide range of topics: protection for colour marks, advertising and its influence on the brain, green advertising of environmental goods, etc. Analysis of the search results showed the 33 articles including the term “brain” were not related to the topic of an integration of neuroscientific technologies into cases of trademark. One result was found for the key terms in relation to “neuro”: Daniel R. Bereskin, Miles J. Alexander & Nadine Jacobson, "Bona Fide Intent to Use in the United States and Canada" (2010) 100:3 Trademark Rep 709. This article was on the topic of intent and trafficking in trademark and it was not related to the topic of an integration of neuroscientific technologies into cases of trademark.

None of these searches located any Canadian literature relevant to the topic of incorporating neuroscientific technologies in trademark.

²⁰⁶ As can be seen in Table 1, the searches were designed to accommodate the different spellings of “trademark”, including “trade-mark” and “trade mark”.

Table 1: Peer-reviewed Literature Referencing Technology Relevant to “Neuromarks”.

Search terms	Peer-Reviewed Database: HeinOnline
(“Magnetic Resonance Imaging” OR MRI) AND (Trademark OR Trade-mark OR “Trade Mark”)	0
(Brain) AND Trademark OR Trade-mark OR “Trade Mark”)	33
(Neuro) AND Trademark OR Trade-mark OR “Trade Mark”)	1

A second literature search was conducted in HeinOnline to find articles that have been published since the “Neuromarks” article appeared that referred to Bartholomew’s article.²⁰⁷ Since Bartholomew’s publication of the “Neuromarks” article in 2018, his work has been cited in eight articles, two of which are Bartholomew’s own later articles.²⁰⁸

²⁰⁷ A search for articles that have cited Bartholomew’s 2018 Neuromarks publication was conducted using HeinOnline and Google Scholar. These two databases were chosen because they offer comprehensive coverage of legal and non-legal literature, respectively. HeinOnline offers a comprehensive coverage of peer-reviewed articles and Google Scholar offers a comprehensive coverage of peer-reviewed and non-peer-reviewed articles. Mark Bartholomew also has a Google Scholar profile which provides up-to-date information on the citation count for each of his publications. Search results on HeinOnline revealed that his Neuromarks articles has been cited in 4 publications and search results on Google Scholar revealed that it has been cited in 5 publications. There was some overlap between the results on the two databases, resulting in a total of 6 distinct publications that have cited or indicated Bartholomew’s Neuromarks article. An analysis of these publications revealed that four are peer-reviewed articles (3 published, 1 forthcoming in 2021), one is a bibliography (See “Fiftieth Selected Bibliography on Computers, Technology and the Law, January 2018 through December 2018”, Rutgers Computer and Technology Law Journal 45, no. 2 (2019): 169-342), and one is an index to periodicals (See “Current Index to legal Periodicals” Marian Gould Gallagher Law Library, University of Washington (2019): 1-32). Search was conducted on 2 February 2022.

²⁰⁸ Mark Bartholomew, “Copyright and the Brain” (2020) 98:2 Wash U L Rev 525 at 528-529. In this article that Bartholomew published recently, he cited to his own work on “neuromarks” and drew a parallel with the idea of “neuroaesthetics” (i.e., study of the neural processes that underlie aesthetic behavior) and copyright. Mark Bartholomew, “Copyright and the Creative Process” (2021) 97:1 Notre Dame L Rev 357 at 360. Accessed online: <<https://ssrn.com/abstract=3974615>>. In another article that Bartholomew published recently, he cited to his own work on “neuromarks” and drew a parallel with the idea of incorporating neuroscientific information to the law of copyright and creativity.

Table 2: Authors other than Bartholomew citing his “Neuromarks” article.

Article	Context in which Bartholomew’s Article was cited
Shmuel I. Becher & Tal Z. Zarsky, "Minding the Gap" (2019) 51:1 Conn L Rev 69 at 110.	Passing cite to Bartholomew alluding to possibility of using neuroscientific findings to reveal what consumers actually think in the context of trademarks.
Jake Linford, "Placebo Marks" (2019) 47:1 Pepp L Rev 45 at 49.	Cites Bartholomew in discussion on emotional appeal of trademarks operating independent of signals about price and quality. Referring to Bartholomew, author states that “If consumer loyalty is grounded in emotional appeals or otherwise "unreal" information about the mark-bearing good, the trademark may convey accurate signals about source, but mislead consumers about quality. Many scholars argue this mismatch harms consumers and allows mark owners to expand trademark protection beyond its reasonable bounds.”
Shmuel I Becher, “Key Lessons for the Design on Consumer Protection Legislation” (2020) in <i>The Law and Economics of Regulation</i> , Mathis and Torr eds (Springer, 2021). Accessed online: https://papers.ssrn.com/sol3/Papers.cfm?abstract_id=3565532	Cites Bartholomew positively on how neuroscience may provide policymakers and judges with empirical data, making it easier to determine what average or reasonable consumers think and believe or when they are confused or misled.
Russell Jacobs, "The Anonymity Heuristic: How Surnames Stop Identifying People When They Become Trademarks" (2020) 124:2 Dickinson L Rev 319 at 354-358.	Bartholomew cited in the context of how neuroscience research has found brands with reputation for style or creativity cause consumers to behave impulsively. A quote from Bartholomew on the use of brain imaging data to assess culturally familiar logos included.
Dustin Marlan, "Is the Word "Consumer" Biasing Trademark Law?" (2021) 8:2 Tex A&M L Rev 367 at 388.	Article does not allude to “neuromarks” or neuroscientific technologies. Bartholomew cited in reference to the need for ascertaining consumers’ mental states in order to answer questions of infringement, dilution, distinctiveness, and other trademark doctrine because trademarks tend to be psychological in nature.
Zhihao Zhang et al., “Towards a Neuroscientifically informed “Reasonable Person” Test” (2021) 1 at 2. Accessed online:	Bartholomew cited in passing to support authors’ claim that courts have long sought mechanisms to supplement existing means for

https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3876774 Note: This is an unpublished, non-peer-reviewed article.	determining what constitutes the response of a reasonable person.
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From Table 2, four of the six articles retrieved were relevant to the topic of neuroscience in trademark law but they do not pick up the topic of neuromarks.²⁰⁹ These include:

- 1) a 2019 article by Becher and Zarsky where Bartholomew’s article was mentioned in passing on the topic of using neuroscientific findings that can reveal what consumers actually think when exposed to trademarks;
- 2) a 2019 article by Linford on “placebo marks”, where Bartholomew’s article was cited in the context of the emotional appeal of trademarks which operates independent of the signals about price and quality. Overall, this article is about manipulative effects of trademarks on consumer perception and cited Bartholomew’s arguments against overreliance on the emotional appeal of trademarks as such overreliance allows mark owners to expand trademark protection beyond reasonable bounds;
- 3) a 2020 article by Jacobs where he cited Bartholomew’s “Neuromarks” article in the context of how neuroscience research has found that brands with reputation for style or creativity cause consumers to behave impulsively. The author also included a quote from Bartholomew’s article on the use of brain imaging data to assess culturally familiar logos. The author of this article presented a discussion on protection of homographs that have both a surname and trademark function

²⁰⁹ This count does not include Marlan or Zhang et al. articles because these authors did not mention neuroscience or “neuromarks” or trademark law.

and cited Bartholomew to provide examples to support the author's discussion on the topic of surnames used as trademarks and trademark-related heuristics and how fMRI technologies can help provide additional information on consumers' mental processes; and

4) a 2021 article by Marlan where the author cited to Bartholomew's "Neuromarks" article in reference to the need for ascertaining consumers' mental states in order to answer questions of infringement, dilution, distinctiveness, and other trademark doctrine because trademarks tend to be psychological in nature.

These four articles are evidence that Bartholomew's ideas in his "Neuromarks" article have had some impact on the legal literature, though entirely in the United States. As discussed in Chapter 1, this study will extend consideration of Bartholomew's article in the Canadian context.

Chapter 3: Canada's Relevant International Obligations with respect to Trademark

1. Introduction

As noted in Chapter 1, if the international obligations Canada and the United States have agreed upon that involve trademark differ, though trademark law in the U.S. may be able to embrace the concepts of “neuromarks” as Bartholomew has demonstrated in his article, Canada’s commitments concerning trademarks made in treaties or agreements to which the United States is not signatory could prove a barrier to Canada in terms of adopting the concept of “neuromarks”. As also noted in Chapter 1, on the other hand, since nation states are sovereign within their own domains, the fact that any two nations have made different international commitments in respect of a particular area of law does not necessarily mean that the two nation states, in fact, have different domestic laws in that particular area.

Here, in Chapter 3, this thesis will explore whether, indeed, the commitments made internationally by the United States and Canada with respect to trademark *might* prove to create barriers to acceptance of Mark Bartholomew’s concept of “neuromarks” in Canadian trademark law. The next chapter of this thesis, Chapter 4, analyzes Bartholomew’s concept of “neuromarks” in the context of Canadian trademark law, examining whether, in fact, there *are* differences in Canadian trademark law relevant to Bartholomew’s discussion of trademark law such that his concept of “neuromarks” currently would not be applicable to Canadian trademark law.

This chapter begins by presenting a discussion of the Paris Convention,²¹⁰ the historic, continuing public international law convention involving the substantive law of trademark.²¹¹ This will be followed by a discussion of the inclusion of trademark in modern global international trade law through the TRIPS Agreement.²¹² This latter will include a discussion of its enforcement mechanisms in the TRIPS Agreement. This will be followed by a discussion of trade agreements concluded since the TRIPS Agreement, involving trademark, to which Canada has become a member (in some cases with the United States and in some case not).

As noted in Chapter 1, trademark-related text from the Paris Convention is referenced in the TRIPS Agreement, which gives these provisions, embedded in the Paris Convention (which lacks enforceability in itself²¹³) enforceability through the WTO Agreement's dispute settlement enforcement mechanism.²¹⁴

²¹⁰ *Paris Convention for the Protection of Industrial Property*, 20 March 1883, 828 UNTS 305 (amended 28 September 1979, entered into force 3 June 1984).

²¹¹ The 1891 *Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods*, Apr. 14, 1891, as last revised at Lisbon on Oct. 31, 1958, 828 U.N.T.S. 163 [Madrid Agreement] and the 1958 *Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration*, Oct. 31, 1958, as last revised Jan. 1, 1994, 923 U.N.T.S. 205. These treaties will not be discussed further in this chapter because they do not pertain to the legal elements.

²¹² *Marrakesh Agreement*, *supra* note 56.

²¹³ It might be thought that nation states or trademark holders or claimants might have access to the United Nation's International Court of Justice in order to settle disputes between them, since the Paris Convention is dealt with by the United Nations' World Intellectual Property Organization. The International Court of Justice, however, has never been involved in intellectual property dispute resolution. Both Canada and the United States are amongst the minority of the world's states that have accepted the jurisdiction of the International Court of Justice in matters involving "1. the interpretation of a treaty; 2. any question of international law; 3. the existence of any fact which, if established, would constitute a breach of an international obligation; and 4. the nature or extent of the reparation to be made for the breach of an international obligation." (Joseph L Daly, "Is the International Court of Justice worth the effort?" (1987) 20:3 *Arkon Law Review* 391 at 395, 409). However, the International Court of Justice has no enforcement capability (Joseph L Daly, "Is the International Court of Justice worth the effort?" (1987) 20:3 *Arkon Law Review* 391 at 404).

²¹⁴ Although, as noted earlier, it is not currently working. See page 16 for details.

Many nation states that are signatory to the TRIPS Agreement have since entered into bi-lateral or multi-lateral trade treaties that create obligations between or among states that are consistent with, but go beyond, the obligations to which they have agreed under TRIPS.²¹⁵ Canada has entered into four such agreements: (1) in 2016, the *Canada-European Union Comprehensive Economic and Trade Agreement* (CETA), which came into force for Canada in 2017²¹⁶; (2) in 2018, the *Comprehensive and Progressive Agreement for Trans-Pacific Partnership* (CPTPP),²¹⁷ which came into force for Canada in that same year (2018)²¹⁸; (3) in 2019, the *Canada-United States-Mexico Agreement* (CUSMA),²¹⁹ which came into force for Canada in 2020;²²⁰ and (4) in 2020, the *Canada-United Kingdom Trade Continuity Agreement*, which came into force for Canada in 2021.²²¹

²¹⁵ These are frequently referred to as “TRIPS-plus” agreements.

²¹⁶ *Canada-EU Comprehensive Economic and Trade Agreement Implementation Act*, Statutes of Canada 2017, c. 6.

²¹⁷ Note that the text of the CPTPP incorporates by reference the text of an earlier document prepared following negotiations for an agreement known as the Trans-Pacific Partnership (TPP) which failed to come to fruition (see <https://www.international.gc.ca/trade-commerce/trade-agreements-accords-commerciaux/agr-acc/cptpp-ptpgp/text-texte/index.aspx?lang=eng>)

²¹⁸ *Comprehensive and Progressive Agreement for Trans-Pacific Partnership Implementation Act*, Statutes of Canada 2018, c.23.

²¹⁹ *Canada-United States-Mexico Free Trade Agreement*, <https://www.international.gc.ca/tradecommerce/trade-agreements-accords-commerciaux/agr-acc/cusma-aceum/text-texte/toc-tdm.aspx?lang=eng>. This treaty has four official names: Tratado entre Mexico, Estados Unidos y Canada [T-MEC] (used primarily in Mexico), United States, Mexico, Canada Agreement [USMCA] (used primarily in the United States), Accord Canada – Etats-Unis—Mexique [ACEUM] (used in Canada, in French), and Canada-United States-Mexico Agreement [CUSMA] (used in Canada, in English). This trade agreement is the successor to the North American Free Trade Agreement [NAFTA] which had been in effect between these three countries since January 1, 1994.

²²⁰ *Canada-United States-Mexico Agreement Implementation Act*, Statutes of Canada 2020, c 1.

²²¹ *United Kingdom-Canada Trade Continuity Agreement Act*, Statutes of Canada 2021, c.1. (https://www.international.gc.ca/trade-commerce/trade-agreements-accords-commerciaux/agr-acc/cuktca-accru/agreement_trade_continuity-accord_continuite_commerciale.aspx?lang=eng)

The United States is only signatory to one of the four trade agreements involving intellectual property, beyond the TRIPS Agreement itself, to which Canada is currently committed: the Canada-United-Mexico Agreement (CUSMA).²²² On November 30, 2018, Canada, the United States and Mexico signed the new CUSMA.²²³ The provisions of CUSMA are geared towards encouraging trading partners to standardize and enhance intellectual property protections across the three nations, consequently advancing the economic well-being of Canadians, Americans and Mexicans.

Because the United States is not party to CETA, CPTPP or the Canada-United Kingdom Trade Continuity Agreement, it is possible that Canada's obligations to any one or more of these three trade treaties might make it challenging for Canada to adopt Bartholomew's concept of "neuromarks" into its trademark law in the same way as Bartholomew has described such an adoption being possible under trademark law in the U.S.

The Canada-United Kingdom Trade Continuity Agreement essentially mirrors CETA – but, to the extent its text differs from the text of CETA, that different text does not appear to include anything pertaining to trademarks.²²⁴ Therefore the only possible

²²² Canada and the United States first began negotiating a free trade agreement in the mid-1980's which resulted in the Canada-US Free Trade Agreement (1989), superseded by the North American Free Trade Agreement (NAFTA, 1994) and the recent Canada-US-Mexico Free Trade Agreement (2020). CUSMA reiterates the harmonizing principles of TRIPS and NAFTA. Dan Ciuriak, "The Trade and Economic Impact of the CUSMA: Making Sense of the Alternative Estimates" (2020) C.D. Howe Institute Trade and International Policy Working Paper 1 at 1.

²²³ *Canada-United States-Mexico Free Trade Agreement*, <https://www.international.gc.ca/tradecommerce/trade-agreements-accords-commerciaux/agr-acc/cusma-aceum/text-texte/toc-tdm.aspx?lang=eng>

²²⁴ *Canada-United Kingdom Trade Continuity Agreement* (Canada-UK Trade Continuity Agreement Annex A and B) <https://www.international.gc.ca/trade-commerce/trade-agreements-accords-commerciaux/agr-acc/cuktea-accru/ab.aspx?lang=eng>

challenges that could arise for “neuromarks” in Canada because of Canada’s international trade commitments would have to be any that might arise in consequence of Canada’s signing of CETA and the CPTPP. As will be demonstrated below in this chapter, neither the trademark-related obligations Canada has agreed to through CETA nor the trade-related obligations Canada has agreed to in the CPTPP appear to give Canada obligations in respect of trademark that would require Canada to adopt law different from that of the United States in terms of the possibility of a role for “neuromarks” in trademark law.

2. Trademarks and the Paris Convention for the Protection of Industrial Property

The Paris Convention, originally signed on March 20, 1883 in Paris, France, was the world’s first intellectual property treaty.²²⁵ The scope of the Paris Convention is not the whole of intellectual property,²²⁶ however, but only *industrial* property: it provides, in Article 1(2) that

[t]he protection of industrial property has as its object patents, utility models, industrial designs, trademarks, service marks, trade names, indications of source or appellations of origin, and the repression of unfair competition.²²⁷

²²⁵ *Paris Convention*, *supra* note 7. It was later revised in Brussels in 1900, Washington in 1911, The Hague in 1925, London in 1934, Lisbon in 1958, and Stockholm in 1967, and was amended in 1979. The provisions and articles mentioned in this section refer to the 1979 document. See WIPO Paris Convention for the Protection of Industrial Property, 20 March 1979, online: WIPO <https://www.wipo.int/edocs/lexdocs/treaties/en/paris/trt_paris_001en.pdf> (accessed 10 May 2021).

²²⁶ The Berne Convention, concluded in 1886, deals with copyright. *Berne Convention for the Protection of Literary and Artistic Works*, 9 September 1886, as revised in Paris, 24 July 1971, 1161 UNTS 30, Can TS 1998, No 1 (Index) (as amended on 28 September 1979, entered into force 19 November 1984).

²²⁷ *Paris Convention*, *supra* note 7.

The overall objective of the Paris Convention was to establish a Union of member nations for protecting industrial property on an international level and to remove barriers for international trade between member nations.²²⁸

The Paris Convention recognized that trademarks communicate the source of goods or services and relevant attributes including quality, cost, function, and reputation to the consuming public. Hence, it is crucial to provide sufficient measures for the protection and benefits of mark-holders and consumers. The Paris Convention also encourages member nations to view industrial property in the broadest sense, such that it not only applies to industry and commerce purposes, but also to agricultural and extractive industries, and to all manufactured and natural products. It states, in Article 1(3):

[i]ndustrial property shall be understood in the broadest sense and shall apply not only to industry and commerce proper, but likewise to agricultural and extractive industries and to all manufactured or natural products, for example, wines, grain, tobacco leaf, fruit, cattle, minerals, mineral waters, beer, flowers, and flour.²²⁹

The Paris Convention formalized the concept of territoriality and adopted the principle of national treatment. Article 6 covers the topic of conditions of registration and independence of protection of the mark in different countries. It states, at Article 6,

- (1) The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation.
- (2) However, an application for the registration of a mark filed by a national of a country of the Union in any country of the Union may not be refused, nor may a registration be invalidated, on the ground that filing, registration, or renewal, has not been effected in the country of origin.

²²⁸ Paul Duguid, “French Connections: The International Propagation of Trademarks in the Nineteenth Century” (2008) *The Internationalization of Trademarks in the Nineteenth Century* at 3-5.

²²⁹ *Paris Convention*, *supra* note 7 at Article 1(3).

(3) A mark duly registered in a country of the Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin.²³⁰

The national treatment provision stipulates that member nations must treat residents of other member nations as it treats its own residents in terms of industrial property rights protection.²³¹ It also states that member nations may not subject foreign nationals to higher industrial property protection standards than those that apply to its own residents.²³² This provision also applies to nationals of non-member nations if they are domiciled or have an industrial or commercial presence in the member nation.²³³ As such, this provision aims to provide an equal level of minimum protection to industrial property owners (including mark-holders in the context of trademark) affiliated with any member nation.

The Paris Convention is concerned with the harmonization of substantive trademark law (i.e., definitions of protected subject matter and minimum protections) and does not discuss specifics related to procedural trademark law (i.e., registration systems, remedies and enforcement). Filing and registration of trademarks are to be determined by the member nations' domestic laws.²³⁴

²³⁰ *Ibid.* at Article 6.

²³¹ *Ibid.* at Article 2.

²³² *Ibid.*

²³³ *Ibid.* at Article 3.

²³⁴ *Ibid.* at Article 6(1).

The Paris Convention also provides for cancellation of a mark's registration if it has created likelihood of confusion with an existing mark and also provides for cancellation of a mark registered or used in bad faith.²³⁵ For example, if another market player either registers or begins to use the same or a similar mark that may cause confusion with regard to the source of goods or services in the minds of consumers, the original mark-holder may seek cancellation of the alleged infringer's registered mark or bring an action for infringement. It is important to note that, based on the doctrine of national treatment set out in Article 2 of the Paris Convention, the nationality of the holder of the mark does not matter as long as the mark-holder belongs to one of the member nations of the Union.²³⁶

Article 2 of the Paris Convention, the national treatment provision is applicable to all industrial property rights, including trademark rights:

²³⁵ *Ibid.* at Article 6^{bis} (2) and (3) – Paris Convention. According to the provisions of paragraph 3 of Article 6^{bis} of the Paris Convention 1883, any registration of a mark which is made in bad faith may be cancelled without any limitation of time.

²³⁶ *Ibid.* at Article 4. The Paris Convention also has a provision for the *right of priority* in the case of patents, utility models, marks, and industrial designs. According to Article 4, industrial property owners may use the first application filed in one of the member nations to file for further protection in any other member nation, within a certain period of time. This second provision of the *right of priority* allows owners of industrial property to take advantage of a certain degree of flexibility when filing for protection through the appropriate channels. It allows applicants desiring protection in several member nations of the Paris Convention with the advantage and convenience of not having to file multiple applications simultaneously in all nations, without risking that a third party may file an application for a same or similar mark, for use in association with the same or similar goods or services. For example, if a national from any one of the member nations of the Paris Convention files a first application for trademark registration in country A, and files a second application for the same mark in country B six months later, but meanwhile a second applicant also files an application for the same or similar mark to be used in association with the same or similar goods or services in country B, the first applicant will have priority over the second applicant in country B because the application in country B by the first applicant will be treated as if filed at the same time as it was filed in country A. Therefore, all applications filed within the priority period will have priority over any other intervening application for the same or similar mark filed in that country by a third party. The suggested timeframes of this provision are designed to consider the conflicting priorities of the applicants and those of the third parties.

[n]ationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.²³⁷

The national treatment provision in the Paris Convention was the first elementary and efficient rule that facilitated international legal rights to, and protection of, industrial property across national boundaries.²³⁸ To fully understand the impacts of this provision on domestic intellectual property laws, it must be noted that a member nation may refuse legal rights and protection for industrial property to nationals of nations that are *not* signatories to the Paris Convention.²³⁹ In fact, a member nation may subject nationals of non-member nations to stricter standards of legal rights and protection for industrial property.²⁴⁰ With regard to Canada's implementation of the Paris Convention in its domestic laws, Thomas McMahon stated,

[u]nder the Trademarks Act of 1953, trademark rights may be acquired and priority established through any one of four means: 1) commencement of use of the mark in Canada, 2) the filing of an application to register the mark in Canada together with "a statement that the applicant intends to use such trademark in Canada", 3) by "making known" in Canada a trademark which has

²³⁷ *Ibid.* at Article 2(1).

²³⁸ Graeme B Dinwoodie & Rochelle C Dreyfuss, "TRIPS and the Dynamics of Intellectual Property Lawmaking" (2004) 36:1 Case Western reserve Journal of International Law at 96-97.

²³⁹ States enter these international agreements primarily to protect the rights of their own residents, including those living abroad. By extension, participation of these states in the international agreements also provides protection to foreign nationals operating within the state's national borders.

²⁴⁰ Harriet R Freeman, "Reshaping trademark protection in today's global village: Looking beyond GATT's Uruguay Round toward global trademark harmonization and centralization" (1995) 1 ILSA Journal of International and Comparative Law at 74.

been used in another country of the Paris Union, and 4) by filing an application to register a trademark which has already been registered or applied for in another country of the Paris Union and which has been used somewhere in the world.²⁴¹

Article 2(2) of the Paris Convention states “no requirement as to domicile or establishment in the country where protection is claimed may be imposed upon nationals of countries of the Union for the enjoyment of any industrial property rights.”²⁴²

Article 3 equates nationals of countries of the Union with non-nationals of countries of the Union who have real and effective industrial establishments in a member nation:

[n]ationals of countries outside the Union who are domiciled or who have real and effective industrial or commercial establishments in the territory of one of the countries of the Union shall be treated in the same manner as nationals of the countries of the Union.²⁴³

It must be noted, however, that this distinction is of minimal importance now that so few countries remain outside the Paris Union.²⁴⁴

The Paris Convention leaves arrangements for the filing and registration of trademarks to the domestic legislations of the member nations.²⁴⁵ According to Article

²⁴¹ Thomas J McMahon, "Canadian Trademark Law - A Bridge between United States and Foreign Law" (1980) 4:2 *Suffolk Transnat'l LJ* 251 at 257. The Canadian *Trademarks Act* was recently amended in 2019 and the requirement for use of a mark no longer holds true.

²⁴² *Paris Convention*, *supra* note 7 at Article 2(2).

²⁴³ *Paris Convention*, *supra* note 7 at Article 3.

²⁴⁴ One hundred and seventy-seven of the one hundred and ninety-five countries of the world are signatory to Paris. WIPO “WIPO-Administered Treaties Contracting Parties > Paris Convention (Total Contracting Parties: 177)”, online WIPO: https://wipolex.wipo.int/en/treaties/ShowResults?start_year=ANY&end_year=ANY&search_what=C&code=ALL&treaty_id=2 (accessed 15 August 2021).

²⁴⁵ *Paris Convention*, *supra* note 7 at Article 6(1).

6^{quinquies}, a mark that is registered and protected in its country of origin shall be accepted for filing and protection in all other countries of the Union as long as it is the same mark and is for use with the same product or service category.²⁴⁶ However, an application for registration may not be refused and a registration may not be invalidated in any country of the Union on the ground that filing, registration or renewal has not been processed in the country of origin.²⁴⁷

The Paris Convention also recognizes that in certain circumstances, legal tools such as registered user agreements and licensing agreements can be used to duly grant permission to others to use the mark.²⁴⁸ For example, the Paris Convention allows for the assignment of marks, where at the same time as the transfer of the business or goodwill, the mark can be transferred to another entity.²⁴⁹ In addition, the Paris Convention outlines stipulations for the protections of collective marks, whereby member nations of the Union must accept the filing of collective marks from associations and grant appropriate protections for trade names, even if such associations are not industrial or commercial establishments.²⁵⁰

²⁴⁶ *Ibid.* at Article 6^{quinquies}.

²⁴⁷ *Ibid.* at Article 6(2).

²⁴⁸ Deepa Singh, "Article 6bis of the Paris Convention: How the United States Court of Appeals for the Second Circuit is Violating International Law," (2020) 35:3 American University International Law Review 577 at 578. These conditions are also part of Canadian trademark law, which allows the owner of a registered mark to sell or license the trademark to third parties independent of sale of the associated business or its assets. The mark owner must ensure that the licensing or sale does not impact the distinctiveness of the mark such that the mark continues to identify goods and services from a single source in the minds of the consuming public. See Hagen et al, *Canadian Intellectual Property Law: Cases and Materials*, 2nd ed (Toronto: Emond Montgomery, 2018) at 440. Also see *Trademarks Act*, *supra* note 8 at s. 48 and 50.

²⁴⁹ *Paris Convention*, *supra* note 7 at Article 6^{quater}.

²⁵⁰ *Ibid.* at Article 7^{bis}.

It is important to take note that the above-mentioned articles of the Paris Convention relate to registered marks. Such marks are protected under statutory law. However, the Paris Convention since its inception in 1883 has acknowledged the existence of other protections for marks. This has been particularly important to countries whose law descends from British common law. Canada and the United States are both such countries. It is in these countries that the tort of passing off developed to protect “common law marks.”²⁵¹

One key provision, in terms of Canada’s system of protection for both common law marks (protectable through the tort of passing off) and registered marks (protected under the *Trademarks Act*), is Article 6^{bis}:

Marks: Well-Known Marks

- (1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use of a trademark which constitutes a reproduction, and imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as already being the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.
- (2) A period of at least five years from the date of registration shall be allowed for requesting cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

²⁵¹ See Gary L. Lilienthal, “The Development of the Tort of Passing Off,” PhD thesis, Curtin University, 2019. See <https://core.ac.uk/download/pdf/195631551.pdf>. The author traces the origins of the present tort back to the heyday of the guild system.

- (3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.²⁵²

The specific provision of the Paris Agreement that acknowledges protection of trademarks though the tort of passing off is Article 6^{quinquies}: Marks: Protection of Marks Registered in One Country of the Union in Other Countries of the Union:

- A. (1) Every trademark duly registered in the country of origin shall be accepted for filing and protected as is in other countries of the Union, subject to the reservations indicated in this Article. ...
- B. Trademarks covered by this Article may be neither denied registration nor invalidated except in the following cases:
1. when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed;
...²⁵³

Therefore, the Paris Convention's provisions of most relevance to passing off are the national treatment provision which is defined to include "the repression of unfair competition",²⁵⁴ outlined under Article 2 and a non-exhaustive list of contraventions of "honest practices in industrial and commercial matters,"²⁵⁵ against which all member states are required to provide "effective protection", outlined under Article 10^{bis}.²⁵⁶

Protections under statutory law, even in common countries, now provide that a trader may register a trademark and acquire monopoly rights for the use of the mark in relation to the goods or services for which it is registered.²⁵⁷ During the period of

²⁵² *Paris Convention*, *supra* note 7 at Article 6^{bis}.

²⁵³ *Ibid.* at Article 6^{quinquies}.

²⁵⁴ *Ibid.* at Article 2.

²⁵⁵ *Ibid.* at Article 10^{bis}.

²⁵⁶ *Ibid.* at Article 1.

²⁵⁷ John Drysdale & Michael Silverleaf "Passing Off: Law and Practice" 2nd ed (London: Butterworths Law, 1995) at 3.

registration,²⁵⁸ the registered trademark entitles the owner of the registered mark to prevent others from registering or using the same or confusingly similar mark with a good or service.²⁵⁹ However, the existence of a previous reputation in a mark, though unregistered, will, in Canada, either block the registration of a mark altogether, or limit the territory for which the mark will be registered,²⁶⁰ depending upon the circumstances.

Provisions relevant to unfair competition in the Paris Convention include Article 6^{bis} related to *well-known marks*, Article 8 related to *trade names*, and Articles 9 and 10 related to *customs seizures of counterfeit and imitation marks*. In addition, Articles 10 and 10^{ter} relating to *geographical indications* which serve as indications of source and appellations of origin are also associated with *unfair competition* but are not further

²⁵⁸ When the registration status is maintained by ensuring that the registration status is renewed periodically (i.e., after every 10 years in Canada) and the registration fees are paid.

²⁵⁹ Drysdale & Silverleaf, *supra* note 257 at 3.

²⁶⁰ The *Trademarks Act*, *supra* note 8 at Section 21 provides as follows:

Concurrent use of confusing marks

21 (1) If, in any proceedings respecting a registered trademark the registration of which is entitled to the protection of [subsection 17\(2\)](#), it is made to appear to the Federal Court that one of the parties to the proceedings, other than the registered owner of the trademark, had in good faith used a confusing trademark or trade name in Canada before the filing date of the application for that registration, and the Court considers that it is not contrary to the public interest that the continued use of the confusing trademark or trade name should be permitted in a defined territorial area concurrently with the use of the registered trademark, the Court may, subject to any terms that it considers just, order that the other party may continue to use the confusing trademark or trade name within that area with an adequate specified distinction from the registered trademark.

Registration of order

(2) The rights conferred by an order made under subsection (1) take effect only if, within three months from its date, the other party makes application to the Registrar to enter it on the register in connection with the registration of the registered trademark.

discussed here.²⁶¹ The legal effect of Articles 1 and 2 in the context of *unfair competition* is this: whatever rights and remedies a country confers on its own nationals in the field of unfair competition must equally be made available, without discrimination or any requirement of reciprocity, to nationals of the other countries of the Union, subject to the reservation of Article 1(3) in respect of matters of jurisdiction and judicial procedure.²⁶² This obligation of national treatment is quite independent from that of Article 10^{bis} which provides for certain minimum standards of protection to nationals of all member nations. In addition, there is nothing to prevent a particular member of the Union from legislating more generously than required by Article 10^{bis}, whether in terms of substantive law or in terms of the rights and remedies made available.

Overall, the Paris Convention is a multilateral treaty which mandates that all member nations must adhere to the minimum requirements as outlined in the negotiated document. Over the last nearly 140 years, it has enabled the standardization of industrial property laws, including trademark laws, in many countries throughout the world and has prohibited discrimination between nationals of different nations.²⁶³ However, it must be noted that this treaty is not truly global in scale and applies only to the countries (i.e., 191

²⁶¹ Due to their significant economic impact and differing national attitudes toward their protection in law, geographical indicators (GIs) are a hotly debated topic in treatises and in negotiations related to international agreements. They are not discussed in this paper as they do not relate to the topic of this thesis.

²⁶² *Paris Convention for the Protection of Industrial Property*, 20 March 1883, 828 UNTS 305 (amended 28 September 1979, entered into force 3 June 1984) at Article 1(3).

²⁶³ Guy Tritton (editor), *Intellectual Property in Europe*, (Thomson – Sweet & Maxwell Publisher, 2002), at 196.

parties including 190 member countries and the European Union) that have signed on to the Paris Convention: there still remain a few countries who are not part of the Union.²⁶⁴

One key limitation of the Paris Convention in Canada and the United States is that under trademark law in both countries, international treaties and agreements are not self-executing. Thus, neither public international law treaties nor international trade agreements have the force of law in Canada or the United States until they are enacted into domestic law in both countries.²⁶⁵ In the case of public international law like the Paris Convention, there is no realistic way for any member state to compel any other member state to either comply with a treaty by implementing necessary changes in its own domestic laws or enforce the provisions of the treaty through its own domestic law. Thus, even though Canada and the United States have signed onto the Paris Convention, this does not automatically mean that all its requirements have been made part of the domestic laws in each country.

Article 10^{bis} of the Paris Convention urges members of the Union to assure to their own nationals, as well as to nationals of other member nations, that they comply with effective protection mechanisms against unfair competition.²⁶⁶ Article 10^{ter} outlines remedies and right to sue in cases of infringement and prohibited acts, as stated in

²⁶⁴ WIPO “WIPO-Administered Treaties Contracting Parties > Paris Convention (Total Contracting Parties: 177)”, online WIPO: <https://www.wipo.int/treaties/en/ShowResults.jsp?lang=es&treaty_id=2> (accessed 15 August 2021).

²⁶⁵ Tara D Rose, "The High Price of Fame Deserves a Discount: A Call for Uniform Dilution Law in North America for the Protection of Well-Known Trademarks" (2007) 14:1 Sw J L & Trade Am 195 at 198.

²⁶⁶ *Paris Convention*, *supra* note 7 at Article 10^{bis}(1).

Articles 9, 10 and 10^{bis}.²⁶⁷ It permits federations and associations representing interested industrialists, producers or merchants to take action in the courts or in front of administrative authorities.²⁶⁸

As can be seen from the above, nothing in the Paris Convention directly affects questions of evidence in proceedings, which is essentially what “neuromarks” are.

3. Trademarks and the Agreement on Trade-Related Aspects of Intellectual Property Rights (1994)

The TRIPS Agreement, is an appendix to the WTO Agreement that was signed in 1994²⁶⁹ and came into effect on January 1, 1995.²⁷⁰ Thus, the TRIPS Agreement is mandatory for all members of the WTO (currently 164 customs territories),²⁷¹ though it should be mentioned that, under TRIPS Article 66.1, there are lengthy transition periods concerning TRIPS obligations for least-developed countries (countries constituting approximately one third of the WTO membership) which have been extended on several occasions. The most recently to the end of 2021, and in the case of least-developed countries pharmaceutical protection, until 1 July 2034 (or the date on which a country ceases to be a least-developed country member, whichever date is earlier).²⁷²

²⁶⁷ *Ibid.* at Article 10^{ter}(1).

²⁶⁸ *Ibid.* at Article 10^{ter}(2).

²⁶⁹ *Marrakesh Agreement*, *supra* note 56.

²⁷⁰ WTO “Overview: the TRIPS Agreement”, online
<https://www.wto.org/english/tratop_e/trips_e/intel2_e.htm> (accessed 15 July 2019).

²⁷¹ *Ibid.*

²⁷² The World Trade Organization “WTO members agree to extend TRIPS transition period for LDCs until 1 July 2034” (2021) online

The TRIPS Agreement was the product of negotiations that took place between 1984 - 1994 within the context of the General Agreement on Tariffs and Trade (GATT) Uruguay Round.²⁷³ It resulted from a compromise among countries with strongly opposing views regarding the value of intellectual property for economic growth and development.²⁷⁴ It is a comprehensive multilateral agreement that links intellectual property with international trade.²⁷⁵ It states that intellectual property rights are private rights and as such, it requires member nations to have substantive domestic laws and procedures to enforce these private rights.²⁷⁶

According to Article 15(1), *protectable subject matter* for trademarks is defined as,

Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.²⁷⁷

[https://www.wto.org/english/news_e/news21_e/trip_30jun21_e.htm#:~:text=TRIPS-,WTO%20members%20agree%20to%20extend%20TRIPS%20transition%20.%20for%20LDCs,Intellectual%20Property%20rights%20\(TRIPS\).](https://www.wto.org/english/news_e/news21_e/trip_30jun21_e.htm#:~:text=TRIPS-,WTO%20members%20agree%20to%20extend%20TRIPS%20transition%20.%20for%20LDCs,Intellectual%20Property%20rights%20(TRIPS).) (accessed 29 April 2022).

²⁷³ Dinwoodie & Dreyfuss, *supra* note 238 at 96-97.

²⁷⁴ *Ibid.*

²⁷⁵ WTO “Overview: the TRIPS Agreement”, online <https://www.wto.org/english/tratop_e/trips_e/intel2_e.htm> (accessed 15 July 2019).

²⁷⁶ Dinwoodie & Dreyfuss, *supra* note 238 at 114.

²⁷⁷ *Marrakesh Agreement*, *supra* note 56 at Article 15(1).

Unlike the definitions in the Paris Convention, this article is important as it is the first international instrument to legally define the expression “*trademark*” on a multilateral level.²⁷⁸ It is important to note this definition is very broad and does not limit the types of signs that may be considered a trademark. Under TRIPS, member nations may exclude non-visually perceptible marks from registration, such as olfactory and sound marks.²⁷⁹

Another important point in relation to Article 15(1) is that it clearly does not limit the definition of trademark only to *registered marks*: the TRIPS Agreement also contemplates rights to *unregistered marks*, without necessarily mandating their protection by all member nations.²⁸⁰ This clearly recognizes, for common law countries, a role for the law of *passing off*.

By virtue of the incorporation by reference of the provisions of the Paris Convention, including, for instance, ones dealing with official marks,²⁸¹ protections must also be extended under the TRIPS Agreement beyond commercial marks to marks that may be non-commercial. Since the TRIPS Agreement stipulates minimum standards, member nations are also free to grant additional protections to mark holders.²⁸²

²⁷⁸ Daniel Gervais “The TRIPS Agreement: Drafting History and Analysis” 3rd ed (London: Tomson Reuters, 2008) at 266.

²⁷⁹ Canada has made recent amendments, effective June 17, 2019 to include such non-traditional marks within the definition of trademark and extent protection to such marks.

²⁸⁰ Gervais, *supra* note 278 at 266.

²⁸¹ *Marrakesh Agreement*, *supra* note 56. *Paris Convention*, *supra* note 7.

²⁸² Gervais, *supra* note 278 at 266. There are no user right sections that are indicated in the TRIPS Agreement.

The primary focus in TRIPS is placed on *distinctiveness*, which can be inherent in the mark or acquired through use (also known as *secondary meaning*).²⁸³ Overall, *distinctiveness* is based on the notion that consumers expect consistency in the products or services from the same source, even though the provider may have various manufacturing plants and distribution outlets.²⁸⁴

The provisions of the Paris Convention relating to trademarks (Articles 4, 5C, 6, 6^{bis}, 6^{ter}, 6^{quater}, 6^{quinquies}, 6^{sexies}, 6^{septies}, 7, 7^{bis}, 8, 9, 10^{ter}, 11, and 12) have been incorporated in the TRIPS Agreement by reference.²⁸⁵ In addition, Part 2 Section 2 of TRIPS (Articles 15 - 21) has created further provisions with respect to trademarks. Some of these provisions are mandatory (for example, those in Article 16)²⁸⁶ -- others are optional (for example, Article 17).²⁸⁷

The TRIPS Agreement covers trademarks and, as it does in all its aspects related to intellectual property, TRIPS plays three key roles with respect to trademarks: 1) setting minimum standards that member nations of the WTO must adhere to within their own domestic intellectual property laws;²⁸⁸ 2) mandating member nations to enforce specific

²⁸³ *Ibid.*

²⁸⁴ *Ibid.*

²⁸⁵ *Ibid.* at 265.

²⁸⁶ See other mandatory elements at Articles 15.1 (in part), 15.2, 15.3 (in part), 15.4, 15.5 (in part), Article 18, Article 19, Article 20.

²⁸⁷ See other optional elements at Articles 15.1 (latter parts), 15.3 (latter part), 15.5 (latter part), Article 21.

²⁸⁸ Dinwoodie & Dreyfuss, *supra* note 238 at 96.

remedies against infringement of trademarks;²⁸⁹ and 3) providing dispute resolution methods under the administrative oversight of the WTO.²⁹⁰

Even though the TRIPS Agreement aims to set standards that must be followed by member nations, it allows individual member nations to determine appropriate methods for implementing these provisions.²⁹¹ More specifically, Article 1(1) of the TRIPS Agreement recognizes the autonomy of member nations,²⁹² and allows them to comply with the stated international obligations in ways that are best suited to their political, institutional, economic, and social needs.²⁹³ Such a degree of flexibility and autonomy is crucial for the processes of domestic law-making as national governments must retain their abilities to structure domestic intellectual property laws to deal with changing internal conditions.²⁹⁴ Nonetheless, the rules and potential sanctions of the TRIPS Agreement bind member nations to fulfill their obligations in good faith. TRIPS does not allow member nations to use provisions of their domestic law as justification for failure to abide by TRIPS.²⁹⁵ The prospect of enhanced investment and the threat of trade sanctions bring WTO members to comply with the implementation and enforcement of TRIPS.²⁹⁶

²⁸⁹ *Ibid.* at 108-110.

²⁹⁰ *Ibid.* at 114.

²⁹¹ *Marrakesh Agreement*, *supra* note 56 at Article 1(1).

²⁹² *Ibid.*

²⁹³ Dinwoodie & Dreyfuss, *supra* note 238 at 95-96.

²⁹⁴ *Ibid.* at 97.

²⁹⁵ *Ibid.*

As noted earlier,²⁹⁷ the TRIPS Agreement incorporates, by reference to the Paris Convention, the principle of *national treatment* requiring member nations to provide at least as favourable protection for intellectual property to foreign nationals operating within their domestic borders as they do to their own nationals.²⁹⁸ The TRIPS Agreement goes beyond the Paris Convention in two key ways. First, the TRIPS Agreement introduces the concept of “*most favored nation*”: according to Article 4 “any advantage, favor, privilege, or immunity granted by a Member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other Members”.²⁹⁹

The TRIPS Agreement Part III: Enforcement of Intellectual Property Rights (Articles 41 – 61) specifically requires domestic enforcement of intellectual property rights by member states: for instance, member nations are required to introduce procedures into their national legislation that will allow for efficient action against infringement of intellectual property rights,³⁰⁰ and such procedures are not to be unduly complicated, costly, unreasonably time-limited, or involve unwarranted delays.³⁰¹ Part III of the TRIPS Agreement creates obligations for states that contrast completely with the

²⁹⁶ *Ibid.*

²⁹⁷ As indicated earlier on page 62.

²⁹⁸ *Marrakesh Agreement*, *supra* note 56 at Article 3. “Article 3 also includes details on the exceptions that are originally highlighted in the Paris Convention.” – this was in the main text of your draft, but, as written, does not seem to make sense: clarify and leave it in this footnote, if that seems right once it is understandable – or, if, once clarified, it seems a more important point, move it back up into the text.

²⁹⁹ This provision is subject to four exemptions but none of them appear to be relevant to the trademark context. (see Article 4, (a)-(d))

³⁰⁰ *Marrakesh Agreement*, *supra* note 56 at Article 41.1.

³⁰¹ *Ibid.* at Article 41.2.

lack of enforcement that is characteristic of the public international law system involving trademarks.³⁰²

Trademarks are dealt with specifically in Part II, Section 2 of the TRIPS Agreement covers the topic of *trademarks*.

Article 16(1) of the TRIPS Agreement defines the *rights conferred* to the owners of trademarks.³⁰³ It states,

The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.³⁰⁴

This Article, applicable to registered trademarks, says countries must enact domestic law such that third parties using signs identical to a mark for goods or services shall be presumed to have created a *likelihood of confusion*.³⁰⁵ This would mean that the third

³⁰² Gustavo Bravo, "From Paris Convention to TRIPS: A Brief History" (2001) 12:1 Journal of Contemporary Legal Issues at 448-449.

³⁰³ *Marrakesh Agreement*, *supra* note 56 at Article 16. It must be noted that neither the Paris Convention nor the TRIPS Agreement explicitly or implicitly determine the ownership of the trademark or how ownership is acquired. Article 6(1) of the Paris Convention allows members of the Union and Articles 3 and 4 of the TRIPS Agreement allows members of the WTO to determine the definitions and conditions of ownership within their national legislation. See Daniel Gervais, Page 278-279.

³⁰⁴ *Ibid.* at Article 16(1).

³⁰⁵ Gervais, *supra* note 278 at 274.

parties would not be able to prevail in a legal action in any member state over the owner of the registered trademark.³⁰⁶

The TRIPS Agreement allows for enhanced applicability through enforcement where the burden of proof imposed on the mark holder is to show that the average relevant consumer or buyer of the goods or services may be misled.³⁰⁷

Article 16(2) of the TRIPS Agreement refers back to Article 6^{bis} of the Paris Convention (quoted above on page 68), which deals with “well-known marks” in the context of refusing or cancelling marks proposed in connection with “identical or similar goods” [emphasis added]. TRIPS Article 16(2) makes it clear that, for both the Paris Convention and the TRIPS Agreement, Paris Convention Article 6^{bis} “shall apply, *mutatis mutandis*, to services.”³⁰⁸ It is interesting to note that, in Article 6^{bis}, the Paris Convention is referring to not allowing trademarks to create confusion in a country with marks considered “to be well known in that country”. Article 16(2) of the TRIPS Agreement adds to the concept of well-known by saying that “members shall take account of the

³⁰⁶ *Ibid.* at 275.

³⁰⁷ Information from neuroscientific methodologies about how the brain of an average consumer responds to the mark-holder’s mark in comparison with potentially confusing marks or signs can be valuable for the legal assessment of trademarks. For example, a neuroimaging study may be conducted with a representative sample of the relevant consumer pool where brain activation levels that are indicative of the consumer’s perception, memory, emotions, attention and other similar cognitive factors are recorded in the presence or absence of a potentially confusing mark.

³⁰⁸ Information from neuroscientific methodologies is also relevant for the evaluation of *well-known marks*, whereby emerging scientific research tools and technologies can be used to evaluate knowledge of the average consumers regarding the well-known mark as a result of promotion. The concept of well-known marks will be discussed as part of an illustrative case, *Mattel, Inc. v 3894207 Canada Inc.*, 2006 SCC 22, in Chapter 4.

knowledge of the trademark in the relevant sector of the public, including knowledge...obtained as a result of the promotion of the trademark”.

At the same time, through reference to Article 6^{bis} of the Paris Convention, Article 16(3) of the TRIPS Agreement also provides protection for the public against the confusing effects that may arise from the use of identical or similar marks.³⁰⁹ For example, in the case of *well-known marks*, when confusingly similar marks are used in association with similar goods or services, misrepresentation is considered to have taken place if a link is made to the owner of the well-known mark and there are likely damages to the interests of the mark owner as well as the general public.³¹⁰ In fact, in the case of some very well-known marks, damage to the interests of the mark owner may almost be presumed.³¹¹ For example, if another commodity such as cars were to be traded using the trademark Coca-Cola, it can be presumed that misrepresentation, damage to reputation or depreciation of goodwill has occurred, even without the presence of likelihood of confusion.³¹² As such, contrary to Article 6^{bis} of the Paris Convention which is limited to similar goods or services and requires likelihood of confusion, Article 16(2) of the TRIPS Agreement extends further without such requirements.³¹³

³⁰⁹ Daniel Gervais “The TRIPS Agreement: Drafting History and Analysis” 3rd ed (London: Tomson Reuters, 2008) at 278.

³¹⁰ *Ibid.* at 277.

³¹¹ *Ibid.*

³¹² *Ibid.* at 278.

³¹³ *Ibid.*

4. Trademarks and the Comprehensive and Progressive Agreement for Trans-Pacific Partnership (2018)

Canada was involved for some time in trade agreement negotiations with the following Pacific-Rim countries: Australia, Brunei Darussalam, Chile, Malaysia, Mexico, New Zealand, Peru, Singapore, the United States, and Vietnam. In February of 2016, these countries signed the *Trans-Pacific Partnership Agreement* (TPP) – but the agreement was never ratified because the United States pulled out of the Agreement in January of 2017. Negotiations amongst the remaining Pacific-Rim countries (other than the United States) resumed and, in January 2018, these eleven countries signed the *Comprehensive and Progressive Agreement for Trans-Pacific Partnership* (CPTPP). On December 30, 2018, the CPTPP was ratified by six countries (Australia, Canada, Japan, Mexico, New Zealand, and Singapore) and came into force.³¹⁴ The overall goal of this trade agreement is to create new market-oriented rules in the context of a changing international environment, foster investments and economic growth, and reduce trade barriers among member nations.³¹⁵

This agreement is of key importance because it represents an opportunity for Canada to increase its access to the fast-growing Asia-Pacific markets and benefit from eliminating trade barriers between member nations.³¹⁶ The countries that have signed on

³¹⁴ Since then both the United Kingdom (February 2021) and China (September 2021) have applied for membership and several other nations have shown interest.

³¹⁵ Petri, P.A. & Plummer, M.G. (2016). *The economic effects of the Trans-Pacific Partnership: New estimates*. Washington, DC: Peterson Institute for International Economics.

³¹⁶ World Bank. (2016). *Trade (% of GDP)*, World Bank national accounts data, and OECD National Accounts data files. Washington, DC: World Bank. Retrieved January 18, 2018 from <https://data.worldbank.org/indicator/NE.TRD.GNFS.ZS?end=2016&start=2003>.

to the CPTPP together represent a combined GDP of 13.5 trillion USD, over 13% of the world's GDP.³¹⁷

One of the CPTPP's key objectives is to address tariff and non-tariff barriers, including those in the area of intellectual property rights.³¹⁸

The CPTPP contains a comprehensive chapter (Chapter 18) on intellectual property which covers the topics of protection and enforcement of rights. Like the Paris Convention, the CPTPP also promotes the principle of national treatment.³¹⁹ On the topic of trademark, this agreement covers topics such as types of signs that can be registered as trademarks, collective and certification marks, use of identical or similar marks, well-known marks, procedural aspects of examination, opposition, and cancellation. The CPTPP outlines rules on protection against infringing uses of traditional marks such as brand names and symbols as well as non-traditional marks such as sound marks and scent marks.³²⁰ It must be noted that this is different than the language seen in the above-mentioned Paris Convention and the TRIPS Agreement which focus on the traditional definitions of industrial property and intellectual property (i.e., trademark), respectively. Chapter 18 of the CPTPP also includes details about obligations for member nations to

³¹⁷ *Ibid.*

³¹⁸ *Ibid.*

³¹⁹ *Comprehensive and Progressive Agreement for Trans-Pacific Partnership*. (2018) at Chapter 2. <<https://www.iilj.org/wp-content/uploads/2018/03/CPTPP-consolidated.pdf>>

³²⁰ *Comprehensive and Progressive Agreement for Trans-Pacific Partnership*. (2018). ("CPTPP (2018)") at Chapter 18.

ensure transparent and efficient rules and procedures and ensuring that they are in line with the existing regimes within their domestic laws.³²¹

Returning to the question about whether there is anything in those of Canada's international commitments not shared with the United States that would lead to Canada being less able than the United States to adopt Bartholomew's notion of "neuromarks" in Canadian law, this chapter has established that, though Canada does indeed have international obligations which the United States does not share (i.e., CETA, CPTPP and the Canada-United Kingdom Trade Continuity Agreement), these commitments do not appear to create a barrier to Canada's reception of the "neuromarks" concept.

³²¹ *Ibid.*

Chapter 4: Canadian Trademark Law and Mark Bartholomew's Hypothetical Scenarios

1. Introduction

This chapter considers whether or not the concept of “neuromarks” may be relevant to Canadian trademark law.³²²

As Chapter 3 has established, Canada's memberships in CETA, CPTPP and the Canada-United Kingdom Trade Continuity Agreement (to none of which the United States belongs) do not create differences between Canada and the United States that can affect Canada's ability to adopt Bartholomew's concept of “neuromarks”. The only question remaining for this thesis is whether there are aspects of Canada's own trademark law that would preclude introduction of “neuromarks” in the Canadian context. This question will be answered in this chapter.

This chapter also explores whether there is any mention of neuroscience (i.e., neuroimaging or other relevant information obtained from neuroscientific technologies as it relates to Bartholomew's definition of “neuromarks”) found in Canadian trademark law and, if not, whether there is any mention of language that requires or implies exclusion of such information or technologies from Canadian law, either in the *Trademarks Act* or in

³²² The areas of distinctiveness and confusion are the substantive areas of trademark being focused on in this chapter because these are two areas of Canadian trademark law which parallel areas of Bartholomew's own focus in his article focussed on trademark law in the U.S. Recall the discussion in Chapter 1, above, where it was established that the third concept in trademark law in the U.S. discussed by Bartholomew, dilution, is not a feature of Canadian trademark law (and therefore is not analyzed in this thesis). However, this chapter will discuss a hypothetical case described by Bartholomew, involving his imaginary “Burgatory” mark, which, according to Bartholomew, under trademark law in the U.S., would come within the statutory provisions for dilution. As will be seen, there are other areas of Canadian trademark law that come into play in such a situation in Canada.

the case law that relates to the above-mentioned key legal elements in Canadian trademark law that Bartholomew focused on in his article.

In the United States both registered trademarks and “common law” marks are dealt with under the *Lanham Act*³²³ -- where the statute speaks of bringing claims involving unregistered marks “in a civil action”.³²⁴

In Canada, the *Trademarks Act* focuses on registered marks, although it does have a section which enables litigation involving unregistered marks to be brought before Canada’s Federal Court³²⁵: the law of passing off in Canada has been developed outside the statutory framework of the *Trademarks Act*³²⁶ and the jurisdiction of Canadian provincial courts to hear passing off actions is part of their inherent jurisdiction,³²⁷ unrelated to the *Trademarks Act*.

³²³ See *Lanham (Trademark) Act*, 15 U.S.C. §1051, s 43, which provides, in s43(a):

- (1) Any person who, on or in connection with any [goods](#) or [services](#), or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any [false designation of origin](#), false or misleading description of fact, or false or misleading representation of fact, which — (A) is [likely to cause confusion](#), or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her [goods](#), [services](#), or commercial activities by another person, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's [goods services](#), or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

³²⁴ “The *Lanham Act* generally does not preempt state common law trademark and unfair competition principle or state trademark statutes.” *Lanham (Trademark) Act* Glossary, [https://ca.practicallaw.thomsonreuters.com/8-501-4903?transitionType=Default&contextData=\(sc.Default\)&firstPage=true](https://ca.practicallaw.thomsonreuters.com/8-501-4903?transitionType=Default&contextData=(sc.Default)&firstPage=true)

³²⁵ *Trademarks Act*, *supra* note 8 at s. 7.

³²⁶ *Ibid.*

³²⁷ *Ibid.* at s. 7; Scassa, *supra* note 12 at 367-372.

2. Bartholomew’s Three Hypothetical Scenarios examined under Canadian Law

In his article, Bartholomew presented three hypothetical scenarios to illustrate the possible role of “neuromarks” which can be mapped as five illustrative scenarios under Canadian law (see **Table 3: Bartholomew’s Trademark Scenarios expanded for the Canadian Trademark context**).

Table 3: Bartholomew’s Trademark Scenarios expanded for the Canadian Trademark.

Bartholomew’s American Scenarios	Canadian Scenarios Examined in Chapter 4
<i>Scenario 1:</i> the “Burgatory” restaurant chain seeks registered trademark protection in the United States	<i>Scenario 1:</i> the “Burgatory” restaurant chain seeks registered trademark protection in Canada
<i>Scenario 2:</i> the “Burgatory” restaurant chain objects to a new “Burger Story” restaurant – set in the context of an infringement action	<i>Scenario 2(a):</i> the “Burgatory” restaurant chain objects to a new “Burger Story” restaurant using the infringement provisions of the Trademarks Act
	<i>Scenario 2(b):</i> the “Burgatory” restaurant chain objects to a new “Burger Story” restaurant through a suit brought for passing off
<i>Scenario 3:</i> a pet food supplier begins selling a dog food mix under the “Burgatory” name – set in the context of an action involving dilution	<i>Scenario 3(a):</i> the “Burgatory” restaurant chain objects to a new “Burger Story” restaurant using the infringement provisions of the <i>Trademarks Act</i>
	<i>Scenario 3(b):</i> the “Burgatory” restaurant chain objects to a new “Burger Story” restaurant through a suit brought for passing off

(a) **Canadian Scenario 1: the “Burgatory” restaurant chain seeks registered trademark protection in Canada**³²⁸

Bartholomew postulates a scenario where the ‘Burgatory’ restaurant is seeking trademark protection -- which, in Canada, would be done pursuant to the *Trademarks Act* Section 30 “Applications for Registration of Trademarks”.³²⁹

In *Masterpiece Inc.*, disputes about trademark registration lay at the heart of the litigation,³³⁰ though the actual cause of action under which the *Masterpiece Inc v Alavida Lifestyles Inc.* lawsuit was litigated was for expungement of pending registration of “Masterpiece Living” as a trademark by Alavida. The Canadian expungement provision appears at Section 45(3) of the *Trademarks Act*:

[w]here, by reason of the evidence furnished to the Registrar or the failure to furnish any evidence [under s.45(1)], it appears to the Registrar that a trademark, either in respect to all of the goods or services specified in the registration or with respect to any of those goods or services, was not used in Canada at any time during the three year period immediately preceding the date of notice and that the absence of use has not been due to special circumstances that excuse the absence of use, the registration of the trademark is liable to be expunged or amended accordingly.³³¹

Masterpiece Inc. had operated a retirement business in Alberta, using several unregistered trademarks, such as “Masterpiece the Art of Living” since 2001.³³²

³²⁸ Bartholomew, *supra* note 16 at 528.

³²⁹ *Trademarks Act*, *supra* note 8 at s. 30.

³³⁰ This action was complex and is summarized in a table presented in Appendix G.

³³¹ *Trademarks Act*, *supra* note 8 at s. 45.

³³² *Masterpiece Inc. v Alavida Lifestyles Inc.*, 2011 SCC 27, [2011] 2 SCR 387 at paras. 8-9.

Alavida Lifestyles Inc. began operating in Ontario and submitted an application to register the mark “Masterpiece Living” on December 1, 2005.³³³

Soon after Alavida filed its application for registration of “Masterpiece Living” on December 1, 2005, Masterpiece Inc., in Alberta, began to use “Masterpiece Living” as a mark and applied to register the mark “Masterpiece” in January 2006 (and the mark “Masterpiece Living” in June 2006).

Both registration applications by Masterpiece Inc. (i.e., for “Masterpiece Living” and “Masterpiece”) were denied by the Canadian Intellectual Property Office (CIPO) because of possible likelihood of confusion with Alavida’s mark “Masterpiece Living”, actually registered on March 23, 2007.³³⁴

In the court of first instance, the Federal Court, Justice O’Reilly accepted some social science evidence and expert testimonies from Dr. Michael Mulvey testifying for Alavida and Dr. Ruth Corbin testifying for Masterpiece Inc. (see Appendix H which sets out paras. 20-39 of the trial court decision by Justice O’Reilly). Having considered this evidence, Justice O’Reilly found as follows.³³⁵

[41] I agree with Dr. Corbin that there is some distinctiveness in the use of the word “Masterpiece” in association with retirement residences or services. While “Masterpiece” is a common word with wide use in naming or describing goods and services available to the public, its use in relation to the particular services at issue here is somewhat distinctive.

³³³ *Ibid.* at paras. 8-10.

³³⁴ *Masterpiece, Inc.*, SCR 387, paras. 10-12.

³³⁵ *Masterpiece Inc. v Alavida Lifestyles Inc.*, 2008 FC 1412 at paras. 41-42. [*Masterpiece Inc. v Alavida Lifestyles Inc.*, 2008]

[42] As for the extent to which the trade-marks have become known, I have no evidence. Dr. Corbin's survey does not suggest that respondents were aware of a company called "Masterpiece" or had seen the trade-mark "Masterpiece Living" before. I agree with Dr. Mulvey that Masterpiece Inc.'s marks did not acquire distinctiveness, given the time-frame and the inconsistent manner in which they were used, before Alavida registered its mark.

This form of evidence is subject to criticism as surveys were conducted with participants who relied on their memories of past experiences and reported them to the researcher (Dr. Corbin). This may introduce various biases and problems as indicated by the testimony of Dr. Mulvey.³³⁶ In addition, expert witnesses also have their own biases based on their own subjective experiences and world views (see again Appendix H for commentary on the opinions of Drs. Corbin, Mulvey and Chakrapani).

At the trial court, Justice O'Reilly found that the term "Masterpiece" is a common word but its use in relation to the particular services at issue here [retirement residences or services] was somewhat distinctive.³³⁷ Justice O'Reilly also found that, at the time of Masterpiece's application, neither Masterpiece Inc. nor any of its trademarks were particularly well known and none had acquired distinctiveness before Alavida applied for its registration, even though Masterpiece Inc. had been using the marks for some time.³³⁸ He dismissed Masterpiece Inc.'s action for expungement of Alavida's registered mark.

³³⁶ As discussed in Chapter 1, neuroscientific information is less susceptible to such types of biases and problems.

³³⁷ [*Masterpiece Inc. v Alavida Lifestyle Inc.*, 2008] at para 41.

³³⁸ *Ibid.* at para 42.

On appeal by Masterpiece Inc., Federal Court of Appeal Justices Sexton and Trudel (Justice Layden-Stevenson concurring) considered the evidence presented by expert witnesses, Drs. Mulvey, Corbin and Chakrapani, that was previously accepted by Justice O'Reilly at the Federal Court,³³⁹ and found that the mark "Masterpiece" in association with retirement residences or services, while somewhat inherently distinctive, had not acquired distinctiveness through use over time.³⁴⁰ They noted that the first word of a trademark is important for the purposes of distinctiveness.³⁴¹ They ruled that Masterpiece Inc. could only rely on trademarks that it had already used and had not been abandoned before Alavida's registration and that the use of the newly proposed marks was not permitted.³⁴²

On appeal to the Supreme Court of Canada, the seven-person Supreme Court considered the expert evidence presented at the lower courts and applying their own intuitions unanimously overruled the courts below,³⁴³ holding that Masterpiece Inc.'s appeal should be allowed and Alavida's registration should be expunged.³⁴⁴ Justice

³³⁹ *Masterpiece Inc. v Alavida Lifestyle Inc.*, 2009 FCA 290 at para. 36.

³⁴⁰ *Masterpiece, Inc.*, SCR 387, paras. 41-42. In trademark litigation cases in Canada, one can present evidence at the Trademark Opposition Board and also present additional evidence at the trial courts. However, additional evidence cannot be introduced at the Courts of Appeal or the Supreme Court of Canada. At these later two stages (Courts of Appeal and the Supreme Court of Canada), judges can only rely on judicial notice (also referred to as judicial intuition) to add to the evidence that was previously presented to the Trademark Opposition Board or the trial courts.

³⁴¹ *Masterpiece, Inc.*, SCR 387, paras. 2. See *Conde Nast Publications Inc. v. Union des éditions modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.), at p. 188, *per* Cattanach J.).

³⁴² *Masterpiece, Inc.*, SCR 387, para. 39.

³⁴³ *Ibid.* at paras. 78-101.

³⁴⁴ *Ibid.* at paras. 3-7.

Rothstein, for the Court, concluded that there was nothing striking or unique about the word “Living” or “the Art of Living”, whereas the first word “Masterpiece” distinguished both Alavida Lifestyles Inc. and Masterpiece Inc. from other sources for consumers³⁴⁵

Justice Rothstein further stated:

While the first word may, for purposes of distinctiveness, be the most important in some cases, I think a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique. Here there is nothing striking or unique about the word “Living” or the words “the Art of Living”. “Masterpiece” is the word that distinguishes Alavida and Masterpiece Inc. from other sources of retirement residence services. It is a reasonable conclusion that “Masterpiece” is the dominant word in these trade-marks, and it is obviously identical as between Alavida and Masterpiece Inc. By the same token, in the context of the retirement residence industry, the idea evoked by the word “Masterpiece”, high quality retirement lifestyle, is the same for both Alavida and Masterpiece Inc. Finally, the word “Living” is identical as between the Alavida and Masterpiece Inc. trade-marks.³⁴⁶

Upon establishing that Masterpiece Inc.’s unregistered mark “Masterpiece the Art of Living” was somewhat inherently distinctive³⁴⁷ and that it was protectable at common law³⁴⁸ as well as under the statute,³⁴⁹ the Supreme Court applied the test for likelihood of confusion based on Section 6 of the *Trademarks Act*.³⁵⁰

³⁴⁵ *Ibid.* at para. 64.

³⁴⁶ *Ibid.*

³⁴⁷ *Ibid.* at paras. 39, 41-42.

³⁴⁸ *Ibid.*; *Trademarks Act*, *supra* note 8 at s. 6(5) and 7.

³⁴⁹ *Ibid.*; *Ibid.* at s. 2, 12(3).

³⁵⁰ *Ibid.* at s. 6. See Appendix E for excerpt.

Canada's test for confusion is based upon assessing the marks in question from the perspective of first impressions of a "casual consumer somewhat in a hurry" with an imperfect recollection to see whether such a consumer would be likely to think that, in this case, Masterpiece Inc. and Alavida are the same source or are linked in some way.³⁵¹ Section 6(5) legislates factors to be considered in the confusion analysis, providing a list of "surrounding circumstances" that must, at least, be considered:³⁵²

- (a) the inherent distinctiveness of the trademarks or trade names and the extent to which they have become known;
- (b) the length of time the trademarks or tradenames have been in use;
- (c) the nature of the goods, services or business;
- (d) the nature of the trade; and
- (e) the degree of resemblance between the trademarks or trade names, including in appearance or sound or in the ideas suggested by them.

According to the *Trademarks Act* Section 19,³⁵³ the location where the mark is actually used is irrelevant because trademark law offers exclusive rights to the original mark-holder for use of the mark throughout Canada.

The Supreme Court considered all these criteria when comparing and contrasting Masterpiece Inc.'s marks 'Masterpiece Living' and 'Masterpiece' and Alavida Lifestyle

³⁵¹ Likelihood of confusion is an essential legal element of trademark infringement. It aims to offer protection for the goodwill of a mark and ultimately offers protection to consumers from harm. Courts evaluate confusion on the basis of likelihood of confusion whereby, there is a possibility of erroneously assigning the origin of the goods or services of the original mark-holder to those of the infringer. This likelihood of confusion is assessed from the perspectives of an average consumer. The scope of trademark protection against such likelihood of confusion can be assessed on the basis of several factors including: the similarity between the two marks; the similarity between the associated goods or services with which they are applied, registered or used; the dominant elements of the conflicting science, the degree of recognition of the senior mark, the relevant circle of recipients, and other factors. Their significance in the individual cases must be assessed. Scassa, *supra* note 12 at 463-465. Aleksandra Nowak-Gruca, "Consumer Protection against Confusion in the Trademark Law" (2018) 5:1: March 2018 Edition Eur J Econ L & Pol 1 at 11-13.

³⁵² *Ibid.* at s. 6(5).

³⁵³ Section 19 states "... the registration of a trademark in respect of any goods or services, unless shown to be invalid, gives to the owner of the trademark the exclusive right to the use throughout Canada of the trademark in respect of those goods or services."

Inc.'s mark 'Masterpiece Living'. The Supreme Court determined that "masterpiece" is common between the two marks and evokes the same idea of high quality retirement living.³⁵⁴ The Supreme Court concluded that the trial judge had erred in assuming that consumers of expensive goods or services spend more time and conduct research before making a purchase decision.³⁵⁵

The Supreme Court, referring to Section 16 of the *Trademarks Act*, confirmed that the first user of the mark has priority rights to register the trademark over the entity who has first registered the trademark with the trademark register.³⁵⁶ Based on Section 16(3), the Supreme Court concluded that Alavida was not entitled to register its trademark because its proposed use of the mark came after Masterpiece Inc.'s actual use of the mark.³⁵⁷ Hence, Alavida's mark registration was ordered expunged from the register.³⁵⁸

In Bartholomew's first hypothetical scenario, he postulates that "consumers recognize the BURGATORY mark as identifying a source of goods or services"³⁵⁹ and Burgatory is looking to register its mark. Bartholomew is clearly thinking about registering an existing mark.³⁶⁰ In the case discussed above, Masterpiece and Alavida were competing to get the "Masterpiece" mark registered (see Figure 3) whereas

³⁵⁴ *Masterpiece, Inc.*, SCR 387, para. 6.

³⁵⁵ *Ibid.* at para. 74.

³⁵⁶ *Trademarks Act*, *supra* note 8 at s. 16.

³⁵⁷ *Masterpiece, Inc.*, SCR 387, para. 6.

³⁵⁸ *Ibid.* at para. 9.

³⁵⁹ Bartholomew, *supra* note 16 at 528-529.

³⁶⁰ In Canada, it is possible to register a proposed mark as well as an existing mark.

Masterpiece had some history of use at common law and Alavida had none. As will be discussed further in Chapter 5, the neuroscientific evidence that “neuromarks” can possibly bring to trademark rely on consumers having a reaction to a given mark(s) in association with a given product(s) or service(s). In the case of Bartholomew’s scenario and the Masterpiece case, the discussion revolved around existing marks however, Alavida’s mark was an extremely new mark which would make it difficult for neuroscientific technologies to pick up a signal indicative of an association with a product or service.

(b) Canadian Scenario 2(a): the “Burgatory” restaurant chain objects to a new “Burger Story” restaurant using the infringement provisions of the *Trademarks Act*³⁶¹

Turning to the scenario where “Burgatory” has a registered trademark in Canada, it would sue the new “Burger Story” under Section 20 of the *Trademarks Act*. This section creates the action for infringement of a registered trademark:

- (1) The right of the owner of a registered trademark to its exclusive use is deemed to be infringed by any person who is not entitled to its use under this Act and who
 - (a) sells, distributes or advertises any goods or services in association with a confusing trademark or trade name ...³⁶²

Section 40 points to the connection between finding that there has been infringement of a registered trademark in Canada and finding that there has been use by another of a “confusing trademark or trade name.” The *Trademarks Act* Section 2 defines “confusing” as follows: “‘confusing’, when applied as an adjective to a trademark or tradename, means

³⁶¹ Mark Bartholomew, “Neuromarks” (2018) *Minn L Rev* 521 at 528.

³⁶² *Trademarks Act*, *supra* note 8 at s.20.

... a trademark or tradename the use of which would cause confusion in the manner or circumstances described in section 6.”³⁶³ Section 6, in turn, provides:

- 6(1) For the purposes of this Act, a trademark or tradename is confusing with another trademark or tradename if the use of the first mentioned trademark or tradename would cause confusion with the last mentioned trademark or tradename in the manner and circumstances described in this section.
- (2) The use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class...
- (3) ...
- (4) ...
- (5) In determining whether trademarks or trade names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including
- (a) the inherent distinctiveness of the trademarks or tradenames and the extent to which they have become known;
 - (b) the length of time the trademarks or tradenames have become known;
 - (c) the nature of the goods, services or businesses;
 - (d) the nature of the trade; and
 - (e) the degree of resemblance between the trademarks or trade names, including in appearance or sound or the ideas suggested by them.³⁶⁴

It is noteworthy that the concept of distinctiveness appears in only one of the five factors that are listed as being necessary considerations for deciding whether a trademark is confusing with another (see Section 6(5)(a)).

³⁶³ *Ibid.* at s.2.

³⁶⁴ *Trademarks Act*, *supra* note 8 at s.6.

In 1997, a women's clothing store in Montreal registered two Canadian trademarks: one was "CLICQUOT". Not long afterwards, in 1998, venerable French wine company Veuve Clicquot Ponsardin, which held a suite of registered trademarks in Canada (collectively referred to by the courts subsequently as "VEUVE CLIQUOT") sued the clothing boutique for infringement in a matter that eventually ended up before the Supreme Court of Canada (*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006, SCC 23).³⁶⁵

Amongst other evidence, Veuve Clicquot presented evidence including expert testimonies³⁶⁶ and proof of promotional materials that it had extensively advertised its champagne brand in fashion magazines directed at women³⁶⁷ and had sponsored fashion shows³⁶⁸ that referred to the brand's originator, Madame Clicquot.

In terms of the factors set out in Section 6, it appeared, for Section 6(a) the wine company had an international reputation built up over years, the boutique was local and recent; for Section 6(b), the 18th century wine company had been in Canada since 1890's

³⁶⁵ For convenience, this case is summarized in a table in Appendix J.

³⁶⁶ *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2003 FCT 103 at paras. 21.

[t]wo expert witnesses testified for the plaintiff, including Ms. Abitbol, an expert on strategy in the luxury field. She testified about the luxury industry and its particular characteristics, especially as to the importance of trade marks in the luxury field. The image of a mark is crucial in this field and the owner of a mark must ensure that his mark's prestige is maintained. Any shift to a new product must be made cautiously. If a mark in the luxury field is associated with products of a quality lower than the quality of its original sector, such a mark is likely to lose its prestige as a luxury mark. Ms. Abitbol cited the case of "Cardin", whose mark was associated with a range of products of very unequal quality, and the result was that the PIERRE CARDIN mark lost its prestige and credibility as a luxury mark.

³⁶⁷ *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2003 FCT 103 at paras. 17-18.

³⁶⁸ *Ibid.* at paras. 17, 47.

whereas the boutique had begun business in 1995; for Section 6(c), the market served by the clothing boutique was only a small part of the target market for the French wine company; for Section 6(d), the French wine company was not involved in the fashion market and the boutique was not involved in wine; for Section 6(e), there was a second “c” in the spelling of wine company’s “Clicquot” whereas the spelling for the boutique was “Cliquot”. Justice Tremblay-Lamer at the Federal Court of Canada found against *Veuve Clicquot Ponsardin*, despite agreeing that it had a famous brand in wine circles.

The Federal Court of Appeal relied on circumstantial evidence and expert testimonies presented at the lower court and applying judges’ intuitions found that *Veuve Clicquot*’s mark was famous in Canada,³⁶⁹ with a long history of usage; and that it had inherent distinctiveness.³⁷⁰ Nevertheless Justices Noel, Desjardin and Nadon of the Federal Court of Appeal unanimously (and briefly) upheld Justice Tremblay-Lamer’s decision:³⁷¹ the evidence that the boutique advertised to women and that *Veuve Clicquot*’s market included women was insufficient to support the claim of likelihood of confusion between the two marks because women comprised only one subset of the target market for high quality clear champagne.³⁷²

³⁶⁹ *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006, SCC 23. [*Veuve Clicquot*]

³⁷⁰ *Ibid.* at para. 3-4.

³⁷¹ *Ibid.* at para. 10.

³⁷² Barry Gamache, “Not just about famous trademarks: A review of other issues raised by the Supreme Court of Canada in the *Veuve Clicquot Ponsardin* and *Mattel* decisions” C.I.P.R. 27 at 32-36.

Like the court below, the Supreme Court of Canada also relied on evidence presented at the lower court and applying judges' intuitions unanimously³⁷³ acknowledged that the mark Veuve Clicquot was famous (para. 26): a factor relevant to the determination of "all the surrounding circumstances" in the opening section of Section 6(5) – but its "Clicquot" was not so very different in terms of being distinct from "Cliquot" (in terms of the factor outlined in Section 6(5)(a)).

Ultimately, the Supreme Court placed weight on the totality of the circumstances in assessing confusion under Section 6(5) and agreed with the decisions of the lower courts: it held (at para. 35) that the boutique's "Cliquot" did not infringe the wine company's "Clicquot"³⁷⁴.

(c) Canadian Scenario 2(b): the "Burgatory" restaurant chain objects to a new "Burger Story" restaurant through a suit brought for passing off

In Canada, through the common law tort of passing off, unregistered marks or indicia are offered similar levels of protection as available for registered marks under the *Trademarks Act* -- so long as the mark seeking protection is distinctive and is in continued use.³⁷⁵ Passing off protects both the original mark-holder and the consuming public from the harms of unfair competition and unfair trading.³⁷⁶ It prohibits others from passing off their goods or services as those of others in the marketplace.³⁷⁷ The tort of

³⁷³ *Veuve Clicquot*, *supra* note 369 at para. 26-29.

³⁷⁴ The remainder of the Supreme Court of Canada's reasoning in the decision dealt with the question of depreciation of goodwill, a cause of action (found in the *Trademarks Act* at Section 22) that is different from infringement.

³⁷⁵ Scassa, *supra* note 12 at 367.

³⁷⁶ Scassa, *supra* note 12 at 370. See *Kirkbi AG v Ritvik Holdings Inc.*, [2005] 3 SCR 302, 2005 SCC 65.

passing off requires that the plaintiff prove three elements: reputation, misrepresentation and damage.

A leading case in the area of passing off is *Vancouver Community College v Vancouver Career College (Burnaby) Inc.*³⁷⁸ In this case, Vancouver Community College sued Vancouver Career College for passing off.³⁷⁹ The defendant Vancouver Career College (hereinafter referred to as “Career College”) had used Google AdWords that presented information about its services when potential consumers (i.e., prospective students) searched for words found in either its acronym “VCC” or its domain name (VCCollege.ca) and, it was alleged by the plaintiff Vancouver Community College (hereinafter referred to as “Community College”) that this acronym and domain name used by the Career College were similar to the ones used by Community College.

At trial, Justice Affleck relied on various forms of evidence that were presented to address the issues of confusion and goodwill (see Appendix J).³⁸⁰ He found no likelihood of confusion was created by the plaintiff’s conduct because the potential consumer making the search had the opportunity to decide whether to click on the links on the main search page for the sponsored advertisements.³⁸¹

³⁷⁷ Similar protection is also available under civil law in Quebec for unregistered marks. See Scassa, *supra* note 12 at 367-368.

³⁷⁸ *Vancouver Community College v Vancouver Career College (Burnaby) Inc.*, 2017 BCCA 41. Leave to appeal to the SCC denied Jan 18, 2018.

³⁷⁹ This case is illustrated, from inception to the Supreme Court of Canada’s denial of leave to appeal from the judgment of the British Columbia Court of Appeal, in Appendix J.

³⁸⁰ *Vancouver Community College v Vancouver Career College (Burnaby) Inc.*, 2017 BCCA 41.

³⁸¹ *Vancouver Community College v Vancouver Career College (Burnaby) Inc.*, 2015 BCSC 1470 at para. 18-20, 22.

It is interesting to note that, in coming to his judgment in *Vancouver Community College v Vancouver Career College (Burnaby) Inc.*,³⁸² Justice Affleck cited to an earlier case: *Private Career Training Institutions Agency v Vancouver Career College (Burnaby) Inc.*,³⁸³ a case that was not related to trademarks but rather focused on misleading advertising. Justice Affleck noted, with respect to that case,

[18] On the same day the Private Career Training Institutions Agency of B.C. (“PCTIA”), a regulatory body for career training institutions created by the Private Career Training Institutions Agency Act, S.B.C. 2003, c. 79, appeared before Mr. Justice Gaul, seeking a permanent injunction prohibiting Vancouver Career College from “using the business names of other member institutions in connection with its internet advertising strategy”: see *Private Career Training Institutions Agency v Vancouver Career College (Burnaby) Inc.*, 2010 BCSC 765 [PCTIA]. The injunction was sought on the basis that the defendant’s advertising was “false, deceptive, or misleading and therefore in breach of [PCTIA’s] bylaw relating to advertising”. The advertising in issue on that application was “keyword advertising”.

[19] Gaul J. had been given the evidence of two students who PCTIA alleged had been confused by the keyword advertising of the defendant. The students believed they had applied to Vancouver Community College when instead they found themselves at Vancouver Career College. Gaul J. observed that:

[63] ... in assessing the likelihood of confusion, the Court ought to give the average consumer a certain amount of credit. Consumers are not generally completely devoid of intelligence or of normal powers of recollection; nor are they totally unaware or uni[n]formed as to what goes on around them. The overriding consideration regarding the likelihood of confusion is “all the surrounding circumstances”. This allows the Court to examine

³⁸² *Vancouver Community College v Vancouver Career College (Burnaby) Inc.*, 2017 BCCA 41. Leave to appeal to the SCC denied Jan 18, 2018 – I believe you have cited this later in the paper—bring the cite back to here as well.

³⁸³ *Private Career Training Institutions Agency v Vancouver Career College (Burnaby) Inc.*, 2010 BCSC 765.

and assess any and all facts peculiar to the case before it: *Mattel, Inc. v 3894207 Canada Inc.*, 2006 SCC 22.

[20] Gaul J. was satisfied the two students, who were offered by PCTIA as examples of the alleged confusion, were not deceived or misled by the defendant. One student:

[72] ... obviously did not examine the results of her Google search very closely, as if she had, she would have discovered that the choice she made was not the one she wanted. That fact was, or should have been, clear to her. By “simply clicking” on the first result she found without properly examining it before she did, I find Ms. Epele was careless and the resulting problems she had flowed from that fact and not from anything done by [Vancouver Career College].

Gaul J. concluded the other student was also imprudent when she conducted her internet search. PCTIA’s application was dismissed.

[21] *PCTIA* was not a passing off or trademark case. Although the finding of carelessness and imprudence in that case may not be directly relevant to the allegations made by the plaintiff in the present action, nevertheless, a number of the witnesses for the plaintiff, who testified about their “confusion”, were also careless when conducting online searches for reasons that cannot be attributed to the defendant.

In the end, Justice Affleck dismissed the action that *was* before him (at para. 194). He noted that,

[n]either the defendant [Career College] nor any other advertiser online controls the search process. The main role of the website owner is to provide content for the website.” (para. 182) He went on to say “the ‘first impression’ cannot arise on a Google AdWords search at an earlier time than when the searcher reaches a website. When a searcher reaches the website of the defendant [Career College] in the present proceeding it is clearly identified as the defendant’s website... In my opinion that is the point during a search when the relevant first impression is made. (para. 183)

...

Any confusion a prospective student may experience between the names Vancouver Community College and Vancouver Career College is irrelevant to this lawsuit. ... There can be no plausible reason for confusion. (para. 187)

Justices Saunders, D. Smith and Savage at the British Columbia Court of Appeal relied on the evidence presented to the lower court and unanimously overturned Justice Affleck's decision.³⁸⁴ They held that when a potential consumer who intended to search for "VCC", "Vancouver Community College", or "VCCollege.ca" was presented with the Career College's advertisements on the same page, there was sufficient evidence to prove passing off:³⁸⁵ regardless of which links the potential consumer then clicked on, the consumer was likely to be confused into thinking that there was a connection between the Career College and the original mark-holder Community College.³⁸⁶

³⁸⁴ *Vancouver Community College v. Vancouver Career College (Burnaby) Inc.*, 2017 BCCA 41. It is interesting to note that commentator Daniel Bereskin had earlier written that the decision of the British Columbia Supreme Court was wrong because there was insufficient proof of deception concerning whether the defendant was using VCC, Vancouver Community College, or VCCollege.ca as a trademark or trade name to market its services to potential consumers. *Vancouver Career College (Burnaby) Inc., dba Vancouver Career College, also dba CDI College, also dba Vancouver College of Art and Design also dba Eminata Group v. Vancouver Community College*, 2018 CanLII 1154 (SCC).

³⁸⁵ In coming to this decision, the British Columbia Court of Appeal relied on the Supreme Court of Canada's decision in *Masterpiece Inc. v Alavida Lifestyles Inc.* (further discussed in this chapter) to establish that consumers are likely to make choices based on first impression. In *Masterpiece*, Justice Rothstein stated (at para 73),

[b]efore source confusion is remedied, it may lead a consumer to seek out, consider or purchase the wares or services from a source they previously had no awareness of or interest in. Such diversion diminishes the value of the goodwill associated with the trademark and business the consumer initially thought he or she was encountering in seeing the trademark. Leading consumers astray in this way is one of the evils that trademark law seeks to remedy.

³⁸⁶ *Vancouver Community College v. Vancouver Career College (Burnaby) Inc.*, 2017 BCCA 41, para. 18.

A subsequent application made by the Community College for leave to appeal to the Supreme Court was dismissed.³⁸⁷

In Bartholomew's second hypothetical scenario, he imagines his trademarked restaurant chain running into another restaurant chain with a related, possibly similar name. In the case of *Veuve Clicquot v Boutique Cliquot*, their respective marks have the same relationship in terms of time in existence and use as Bartholomew posits in his hypothetical scenario. It is suggested that it would be difficult for both Burger Story and Boutique Cliquot to use neuroscientific evidence because neither have a history with consumers. However, in the illustrative Canadian case that is relevant to passing off, the facts are vastly different than those of Bartholomew's second hypothetical scenario and the *Veuve Clicquot* case. In the Vancouver Community College case, both institutions had an apparently significant history. The Vancouver Community College was in existence for over 35 years whereas the Vancouver Career College had a history of at least a dozen years. It would appear that it would have been helpful for a judge deciding this case to have had access to neuroscientific information such as Bartholomew's "neuromarks".

³⁸⁷ *Vancouver Community College v. Vancouver Career College (Burnaby) Inc.*, 2018 CanLII 1154 (SCC).

(d) Canadian Scenario 3(a): the “Burgatory” restaurant chain objects to a new “Burger Story” restaurant using the infringement provisions of the *Trademarks Act*³⁸⁸

As noted early on in this thesis, the concept of “dilution” is not a concept recognized in Canadian trademark law.³⁸⁹ Since dilution is a legislated aspect of trademark law in the U.S., Bartholomew discussed the third scenario in his article, that of the restaurant chain “Burgatory” making an attempt to sue a pet food supplier using the “Burgatory” name, in terms of the action for trademark dilution in the U.S.³⁹⁰ Nonetheless, although the precise statutory concept of “dilution” in the U.S. is not a Canadian trademark concept, the third fact scenario presented by Bartholomew can be analogized to cases that have come before the Canadian courts involving both the *Trademarks Act* and the common law tort of passing off.

In a statutory context, the leading case that would be most closely analogous, in terms of facts, to Bartholomew’s third scenario is *Mattel, Inc v 3894207 Canada Inc.*³⁹¹

³⁸⁸ Bartholomew p 530. This scenario, under trademark law in the U.S., is discussed by Bartholomew in terms of being an “attempt to sue for trademark dilution” – as noted early on in this thesis, the concept of “dilution” does not exist in the Canadian *Trademark Act* and is not a concept recognized per se in Canadian trademark law.

³⁸⁹ Indeed, within the judgment of the Supreme Court of Canada in *Mattel, Inc v 3894207 Canada Inc.*, 2006 SCC 22, although the Supreme Court of Canada saw Mattel Inc.’s defense of its trademark as understandable because mark-holders are required by law to protect their trademarks from piracy or risk whereby their mark may lose its distinctiveness and ultimately its legal protection, the court ruled that Mattel could not be granted special treatment only on the basis of owning a well-known mark and that there wasn’t sufficient overlap between the target audience of the two market players (*Mattel v 3894297 Canada*, 2006 SCC 22, at paras 82 & 93).

³⁹⁰ As noted early on in this thesis, the concept of “dilution” does not exist in the Canadian *Trademark Act* and is not a concept recognized per se in Canadian trademark law.

³⁹¹ *Mattel, Inc v 3894207 Canada Inc.*, 2006 SCC 22; *Mattel Inc. v 3894207 Canada Inc.* et al, 2004 FC 361; *Mattel, Inc. v 3894206 Canada Inc.* et al. 2005 FCA 13, affirming (2004) 30 C.P.R. (4th) 456 (F.C.T.D.), affirming 23 C.P.R. (4th) 395 (T.M.O.B.).

Technically, the Mattel case arose from Mattel's opposition to the Montreal restaurant operator (2894297 Canada Inc) seeking registration of its own mark "Barbie's" in light of Mattel's registered "Barbie" mark.³⁹²

Even though no one by the name Barbie was affiliated with the restaurant, the owner chose the name because "barbie" is an Australian slang for barbeque and appeared to be fitting with the operations of the business which offered a bar and barbequed food items.³⁹³ The restaurant's advertising displayed the word "Barbie" using a similar style and design with stars as that used by Mattel Inc. and the menus were highlighted in the colour pink similar to that used by Mattel Inc. for its packaging of dolls.³⁹⁴

The restaurant applied to the Canadian Trademarks Office to register the trademark "Barbie's & Design" in September 1993 (which resulted in the proposed mark being published in Canada's Trademark Journal in 1994). In 1994, Mattel Inc. launched its opposition to the application being made by the Montreal restaurant.

Mattel had marketed and sold its "Barbie" dolls since the 1960s, having obtained a registered Canadian trademark in association with toys and consumer products in 1963. The consumer products it was registered in association with included fruit snacks, candy, chocolate, chewing gum, mugs, cups, CD players and radios, clocks, lamps, wall coverings, window coverings, bedding, and vitamins.³⁹⁵

³⁹² This case is illustrated, from inception to the Supreme Court, in Appendix L.

³⁹³ Paul D Blanchard, Lisa R Vatch & Andrea P Flewelling, "The Barbie Case: The Supreme Court of Canada Restates the test for Trade-mark Confusion" (2006) 96:5 Trademark Rep 1034 at 1035.

³⁹⁴ *Ibid.*

Issues of both distinctiveness and confusion played a part in the analyses undertaken by (1) the Trademarks Opposition Board (2002), (2) Justice Rouleau of the Federal Court (2004), (3) Justice Noel, writing for himself and Justices Letourneau and Pelletier, of the Federal Court of Appeal (2005), and, finally, (4) Justice Binnie writing the majority judgment in the Supreme Court of Canada (2006).

The Trademarks Opposition Board (hereinafter the Board) found that the wares, services and target consumers of the two companies were significantly different though the marks being used by the two companies displayed similarity in their verbal and visual impressions.³⁹⁶ Mattel Inc. had supplied the Board with affidavits from various individuals including the President of Mattel Canada Inc., a subsidiary of the opponent; President of the applicant company; a trademark researcher; and a legal assistant.³⁹⁷

The Board acknowledged that Mattel Inc. had been using its mark in Canada for several decades, starting in the 1960s, whereas the restaurant had begun to use its mark only in the 1990's.

The Board found that Mattel's trademark "Barbie" had a relatively low degree of inherent distinctiveness.³⁹⁸ It found, however, that the mark was well-known in Canada in association with dolls and doll accessories.

³⁹⁵ *Ibid.* at 1036-1037.

³⁹⁶ *Ibid.* at 1041.

³⁹⁷ *Mattel USA, Inc. v 3894207 Canada Inc.*, 2002 TMOB 61334 at 2(D). <<https://www.canlii.org/en/ca/tmob/doc/2002/2002canlii61334/2002canlii61334.html?autocompleteStr=mattel&autocompletePos=25>>

³⁹⁸ *Mattel, Inc. v 3894206 Canada Inc. et al.* 2005 FCA 13, affirming (2004) 30 C.P.R. (4th) 456 (F.C.T.D.), affirming 23 C.P.R. (4th) 395 (T.M.O.B.).

The Board found that the restaurant had established some brand recognition in the local vicinity of Montreal.

Mattel appealed to the Federal Court and both parties filed additional evidence.³⁹⁹ Mattel filed evidence from a public opinion survey (n = 596; participants were interviewed in various shopping malls in Calgary, Montreal and Toronto) that investigated fame and likelihood of confusion.⁴⁰⁰ Mattel's surveys included the question "Do you believe that the company that makes Barbie dolls might have anything to do with the restaurant identified with this sign or logo?"⁴⁰¹ The survey results revealed that for 57% of respondents, Barbie dolls came to mind when they saw the restaurant's trademark; 36% of respondents believed that Mattel might have some relation to the restaurant; and 99.3% had general awareness of Barbie dolls.

On appeal to the Federal Court, Justice Rouleau found there was no concrete evidence of confusion before the court despite the co-existence of the two marks in Montreal. He also pointed out several shortcomings with Mattel's survey evidence: the survey had failed to include reference to the actual nature of the restaurant services, it excluded consumers from the subset of the population who were familiar with the restaurant (i.e., consumers from the suburbs of Montreal); and that it asked questions in a manner that might have influenced responses.⁴⁰² Having reviewed this evidence, Justice

³⁹⁹ As explained earlier, this is a unique feature of trademark law whereby additional evidence can be introduced through the various stages of a case proceedings.

⁴⁰⁰ Blanchard, Vatch & Flewelling, *supra* note 393 at 1042.

⁴⁰¹ Hagen et al, *supra* note 62 at 510.

⁴⁰² Blanchard, Vatch & Flewelling, *supra* note 393 at 1042-1043.

Rouleau stated that it did not add anything new that would require a review of the prior decision made by the Board in this case: that no significant conclusion could be drawn about the issue of confusion based on the evidence presented.

Commenting on the question of fame, Justice Rouleau did not acknowledge that the fame of the Mattel Inc.'s Barbie mark created a presumption of confusion. He stated,

[i]t cannot be automatically presumed that there will be confusion just because the applicants' mark is famous. Under the circumstances if we keep in mind that the test to satisfy was the likelihood of confusion (and not the possibility of confusion), the fame of the mark could not act as a marketing trump card such that the other factors are thereby obliterated.⁴⁰³

He pointed out⁴⁰⁴ "it is difficult to imagine that an individual would show up at one of the respondent's restaurants intending to buy dolls."

Mattel appealed to the Federal Court of Appeal, which dismissed the appeal on the grounds that,

[Mattel's survey]...can at best establish a possibility of confusion, a threshold that falls short of the recognized standard of reasonable likelihood of confusion which must be established pursuant to s. 6(2) of the Trade-Marks Act as required under the Act.⁴⁰⁵

Mattel appealed to the Supreme Court of Canada, where it argued that the Board and lower courts erred in their application of the statutory definition of "confusion" expressed in the *Trademarks Act*, Section 6, in terms of its application to famous marks

⁴⁰³ *Mattel Inc. v. 3894207 Canada Inc. et al*, 2004 FC 361, para. 40.

⁴⁰⁴ *Mattel, Inc. v 3894207 Canada Inc. et al.* (2004), 30 C.P.R. (4th) 456 (F.C.T.D.), affirming 23 C.P.R. (4th) 395 (T.M.O.B.) at para. 43.

⁴⁰⁵ *Mattel, Inc. v 3894206 Canada Inc. et al.* 2005 FCA 13, affirming (2004) 30 C.P.R. (4th) 456.

and had wrongly required a connection or link between the goods or services of the parties and had failed to apply the *Trademarks Act* Section 6(2)⁴⁰⁶ which deems the two marks to be confusing if an average consumer is likely to infer that the wares or services come from the same source, "whether or not the wares or services are of the same general class."⁴⁰⁷ Mattel also argued, with reference to Section 19 of the *Trademarks Act*, that the lower courts had erred in focusing on the nature of the wares or services offered by the restaurant rather than focusing on the description of the wares or services as claimed in the application that defines the monopoly granted to the successful trademark applicant.⁴⁰⁸ Finally, Mattel claimed that the lower courts 1) had failed to consider that there was no credible reason for adopting the "Barbie's" mark for the restaurant except to gain benefit from the fame of the Mattel's Barbie mark; 2) had erred in rejecting Mattel's survey evidence on the issue of likelihood of confusion; and c) had made errors of fact as to the nature of the two businesses.⁴⁰⁹

⁴⁰⁶ Section 6(2) of the *Trademarks Act* states,

[t]he use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

See *Trademarks Act*, RSC 1985. c. T-13 at s. 6(2). See Appendix for more information on section 6.

⁴⁰⁷ Blanchard, Vatch & Flewelling, *supra* note 393 at 1044.

⁴⁰⁸ *Ibid.*

⁴⁰⁹ *Ibid.* at 1044-1045.

On June 2, 2006, the Supreme Court of Canada⁴¹⁰ rendered its decision, holding that the decisions made by the Board and the lower courts that there was no likelihood of confusion in the marketplace between the two marks were reasonable and that these prior decisions were therefore not reviewable.⁴¹¹

The Supreme Court found that the Federal Court had not erred in its rejection of the survey evidence nor in finding that the survey lacked relevance to the main issue of likelihood of confusion. Justice Binnie, writing the majority judgment, stated⁴¹²

[t]he principal attack on the survey evidence in this case rests on relevance. The issue in these opposition proceedings was the *likelihood* of confusion. The survey question (“Do you believe that the company that makes Barbie dolls might have anything to do with this sign or logo?” (emphasis added)) addresses the wholly different issue of possibilities. If the survey is not responsive to the point at issue, it is irrelevant and should (as the Federal Court of Appeal held) be excluded on that ground alone.

He interpreted the *Trademarks Act* as providing a guarantee of the origin of the goods or services, as an assurance to consumers about the quality associated with a particular trademark, as consumer protection legislation. He stated,

⁴¹⁰ Justice Binnie wrote on behalf of the majority of the court which consisted of 8 other judges, namely justices McLachlin C.J., Major, Bastarache, LeBel, Deschamps, Fish, Abella and Charron JJ. Justice LeBel filed his own concurring judgment.

⁴¹¹ Blanchard, Vatch & Flewelling, *supra* note 393 at 1045. There are three standards of review of administrative tribunals including correctness, reasonableness, and patent unreasonableness. The Supreme Court applied the standard of reasonableness in reviewing the decision of the Board and the lower courts and noted that this standard will often force a court “to accept that a decision is reasonable, even if it is unlikely that the court would have reasoned or decided as the tribunal did,” provided it stands up to “a somewhat probing” examination. See *Mattel, Inc v 3894207 Canada Inc.*, 2006 SCC 22 at paras. 33 and 46. Accessed Online: <<https://www.lexisnexis.ca/documents/2006scc022.pdf>>

⁴¹² *Mattel, Inc v 3894207 Canada Inc.*, 2006 SCC 22 at para. 44. Accessed Online: <<https://www.lexisnexis.ca/documents/2006scc022.pdf>>

[t]he power of attraction of trade-marks and other “famous brand names” is now recognized as among the most valuable of business assets. However, whatever their commercial evolution, the legal purpose of trade-marks continues (in terms of s. 2 of the *Trade-marks Act*, [R.S.C. 1985, c. T-13](#)) to be their use by the owner “to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others”. It is a guarantee of origin and inferentially, an assurance to the consumer that the quality will be what he or she has come to associate with a particular trade-mark...It is, in that sense, consumer protection legislation.⁴¹³

Justice Binnie wrote that Section 6(2) of the *Trademarks Act* requires courts (and the Board) to evaluate whether potential consumers will incorrectly infer, based on the respondent restaurant’s use of a similar mark, that the wares and services of the respondent, even if they are not of the same general class, originate from the same source as the goods and services of the appellant.⁴¹⁴ But he went on to note that this evaluation was to be undertaken by evaluating the situation from the perspective of the consumer (i.e., the links and associations that may arise in the consumers’ minds when presented with the marks and their associated wares or services). If there is no likelihood of a potential consumer making a link between the respondent’s mark and the appellant’s brand, there can be no likelihood of confusion within the meaning of the *Trademarks Act*.⁴¹⁵

On the matter of fair competition, Justice Binnie stated,

⁴¹³ *Mattel, Inc v 3894207 Canada Inc.*, 2006 SCC 22 at para. 2. Accessed Online: <https://www.lexisnexis.ca/documents/2006scc022.pdf>

⁴¹⁴ *Ibid.* at para. 6.

⁴¹⁵ *Ibid.*

[f]airness, of course, requires consideration of the interest of the public and other merchants and the benefits of open competition as well as the interest of the trade-mark owner in protecting its investment in the mark. Care must be taken not to create a zone of exclusivity and protection that overshoots the purpose of trade-mark law.⁴¹⁶

Justice Binnie acknowledged that, based on the “1953 Act”,⁴¹⁷ famous brands received broader protection and, in some cases, dissimilarity in wares or services was not an issue in proving likelihood of confusion. He noted,

[s]ome resemblance or linkage to the wares in question”, i.e. to the wares for which registration of a trade-mark is sought. Resemblance is clearly not a requirement under [s. 6](#). On the contrary, the point of the legislative addition of the words “whether or not the wares or services are of the same general class” conveyed Parliament’s intent that not only need there be no “resemblance” to the specific wares or services, but the wares or services marketed by the opponent under its mark and the wares or services marketed by the applicant under its applied-for mark need not even be of the same general class. A trade-mark’s fame is capable of carrying the mark across product lines where lesser marks would be circumscribed to their traditional wares or services. Each situation must be judged in its full factual context. A difference in wares or services does not “trump” all other factors, nor does the fame of a trade-mark. The totality of the circumstances will dictate how each consideration should be treated. If, in the end, the result of the use of the new mark would be to introduce confusion into the marketplace, it should not be permitted “whether or not the wares or services are of the same general class.”⁴¹⁸

In the case before the Supreme Court, however, Justice Binnie noted that Mattel Inc. and the restaurant owner operated in significantly different segments

⁴¹⁶ *Ibid.* at para. 22.

⁴¹⁷ *The Canadian Trade Marks Act*, 1953, 1-2 Eliz. II, c. 49.

⁴¹⁸ *Mattel, Inc v 3894207 Canada Inc.*, 2006 SCC 22 at para. 52. Accessed Online: <https://www.lexisnexis.ca/documents/2006scc022.pdf>

of the marketplace, segments where their respective wares and services did not overlap. Even though Mattel had registered its mark for use with certain food items such as pizza and had licensed its mark to other food service providers in Canada, such as McDonald's restaurants for use with their “happy meals” in the 1990s, Justice Binnie found that there was no evidence that adult consumers would be confused into thinking a doll manufacturer might be linked with a food service provider.⁴¹⁹

The Mattel case is still cited with approval as an important case in the area of trademark law concerning likelihood of confusion.⁴²⁰

(e) Scenario 3(b): the “Burgatory” restaurant chain objects to a new “Burger Story” restaurant through a suit brought for passing off

There is a Canadian trademark case, decided recently, that parallels the third hypothetical postulated by Bartholomew: *Toys “R” Us (Canada) Ltd v Herbs “R” Us Wellness Society*.⁴²¹

⁴¹⁹*Mattel, Inc v 3894207 Canada Inc.*, 2006 SCC 22 at para. 83. Accessed Online: <<https://www.lexisnexis.ca/documents/2006scc022.pdf>>. See further, Paul D Blanchard, Lisa R Vatch & Andrea P Flewelling, “The Barbie Case: The Supreme Court of Canada Restates the test for Trade-mark Confusion” (2006) 96:5 Trademark Rep 1034 at 1049.

⁴²⁰ For example, it was recently cited with approval in *Tokai of Canada Ltd v. Kingsford Products Company, LLC*, 2021 FC 782; *Symantec Corporation and Veritas Technologies LLC v Det Norske Veritas AS*, 2021 TMOB 143; and *Beverly Hills Jewellers MFG Ltd. v. Corona Jewellery Company Ltd.*, 2021 FC 674.

⁴²¹ *Toys “R” Us (Canada) Ltd v Herbs “R” Us Wellness Society*, 2020 FC 682 (Justice McHaffie). The litigation was somewhat unusual in that the respondent Herbs “R” Us Wellness Society did not take part (although the evidence was that it had been duly served with the materials filed by the applicant Toys “R” Us (Canada)). Virtually the entire evidence on which Justice McHaffie decided the case was the affidavit of Frank Juhasz, a senior officer at Toys “R” Us (see para 7). There was only one other affidavit before Justice McHaffie – of which nothing material to this analysis was received into evidence (see paras 13-14).

Although the applicant Toys “R” Us (Canada) was concerned about its entire suite of marks, in his decision Justice McHaffie confined his analysis to the comparison of the HERBS R US design or tradename and the TOYS “R” US registered ‘641 mark, finding that all the other registered TOYS “R” US marks were less similar to the Herbs “R” Us mark than the ‘641 mark.⁴²²

The applicant Toys “R” Us (Canada) argued that Herbs “R” Us had infringed its registered marks -- but Justice McHaffie found otherwise (paras. 43-45) because he found “on the evidence as filed, Toys “R” Us has not established that the HERBS R US mark is confusing with [Toys “R” Us’s] ‘641 Mark” [and has] therefore not established infringement of the ‘641 Mark” (para. 45). In coming to his decision, he considered the factors set out in subsections (a) to (e) of Section 6(5):

Distinctiveness

The HERBS R US trademark arguably has a similar inherent distinctiveness to the TOYS R US mark, although many of its points of inherent distinctiveness are also those that it shares with HERBS R US as points of resemblance. I have no evidence that the HERBS R US trademark has become known.⁴²³

Length of Use

The Canadian website Toys “R” Us was in use December 2008 and thereafter (para 29). Herbs “R Us incorporated January 2018 and this was “presumably the earliest date on which it could have used a trademark”⁴²⁴

Nature of the goods, service, business

⁴²² *Ibid.* at para. 18. See Appendix M for a table describing the case.

⁴²³ *Ibid.* at para. 28.

⁴²⁴ *Ibid.* at para. 30.

Toys “R” Us and Herbs “R” Us, Justice McHaffie found are “markedly different” (para 31) and “fundamentally dissimilar”.⁴²⁵

Nature of the trade

“...[Both] have retail stores, but the similarity in the nature of the trade appears to end there...”.⁴²⁶

Other surrounding circumstances:

Justice McHaffie found no circumstances material to his decision (paras. 40-42).

In coming to his conclusion after considering all the various factors in Section 6 (see paras. 28-42), Justice McHaffie found

Despite the similarity of the trademarks and the other factors that favour Toys “R” Us, I conclude that the vast differences between the goods and services are such that there is no likelihood of confusion. I cannot agree with Toys “R” Us’ contention that resemblance between the marks is such that use of the HERBS R US design trademark ‘unquestionably would give the impression to consumers that Toys R Us has expanded its retail services in these other areas.’ To the contrary, it strikes me as unlikely in the extreme that a Canadian consumer, even a casual one somewhat in a hurry with an imperfect recollection of the TOYS R US mark, would see the HERBS R US trademark and conclude that a well-known toy retailer had started branching out into storefront ‘dispensary’ services or cannabis sales, either itself or through a licensee.⁴²⁷

Passing Off Analysis:

Justice McHaffie then went on to consider whether there was evidence that the Herbs “R” Us Wellness Society had passed its mark and tradename off as those of Toys “R” Us contrary to the statutory provision for passing off under Section 7 of the

⁴²⁵ *Ibid.* at para. 36.

⁴²⁶ *Ibid.* at para. 39.

⁴²⁷ *Ibid.* at para. 44.

Trademarks Act. He found in favour of the plaintiff, Herbs “R” Us Wellness Society (see paras. 47-49).

Justice McHaffie noted that the “necessary components to a passing off claim ... are the existence of goodwill, deception of the public due to a misrepresentation, and actual or potential damage... In addition, the claim must show ownership of a valid registered or unregistered mark” (para. 47). In finding in favour of the Herbs “R” Us Wellness Society in terms of this cause of action, he focused on the second element of the passing off cause of action:

In respect of the second element, the only misrepresentation on which Toys “R” Us relies is the likelihood of confusion in the same manner and on the same basis as its claim of infringement under [Trademarks Act] section 20. For the reasons set out above, I find that there is no likelihood of confusion, and Toys “R” Us passing off claim must therefore ... fail.”⁴²⁸

Depreciation of Goodwill Analysis:

As noted above, Justice McHaffie focused on the lack of evidence of confusion in finding that Toys “R” Us Canada could not succeed against Herbs “R” Us Wellness Society either for infringement or for passing off but, as he noted at para. 50, “[e]ven where there is no likelihood of confusion, there may be a likelihood of depreciation of the goodwill attaching to a registered mark....”

The statutory action for depreciation of goodwill is set out at Section 22(1) of the *Trademarks Act*:

⁴²⁸ *Ibid.* at para. 48.

No person shall use a trademark registered by another person in a manner that is likely to have the effect of depreciating the value of the goodwill attached thereto.

In beginning his analysis (which appears at paras. 50-63 of the judgment), Justice McHaffie quotes, at para. 51, from *Veuve Clicquot*:

Firstly ... a claimant's registered trade-mark was used by the defendant in connection with wares or services – whether or not such wares and services are competitive with those of the claimant. Secondly, that the claimant's registered trade-mark is sufficiently well-known to have significant goodwill attached to it... Thirdly, the claimant's mark was used in a manner *likely* to have an effect on that goodwill (i.e. linkage) and fourthly that the *likely* effect would be to depreciate the value of its goodwill (i.e. damage). [Italics are original to Justice Binnie in *Veuve Clicquot*; underlining is original to Justice McHaffie in *Toys "R" Us*]

Justice McHaffie then goes on to examine each of the four considerations set out in *Veuve Clicquot* in order in his own analysis of the case at hand:

Use of the registered trademark

The evidence shows that the HERBS R US trademark is being used by Herbs "R" Us with the meaning of section 4 [of the Trademarks Act]. In addition, in my view, the strong resemblance between the HERBS R US design used by Herbs "R" Us and the '641 mark is sufficiently similar to evoke a mental association ... Indeed, the two are so similar that 'link, connection, or mental association' with the '641 Mark is all but inevitable, and must be inferred to have been intended. Similarly, I find that the HERBS R US design is "so closely akin" to the '641 Mark, notwithstanding the differences described above, that it would be understood as the '641 Mark. The first element is established.⁴²⁹

"Sufficiently well known to have significant goodwill"

... Justice Binnie [in *Veuve Clicquot*, at para 54] referred to a number of factors relevant to ... goodwill, including 'fame', the degree of recognition of the mark, the volume of

⁴²⁹ *Ibid.* at para. 55.

sales and depth of market penetration, extent and duration of advertising and publicity, geographic reach, degree of inherent or acquired distinctiveness, breadth of channels of trade, and the extent to which the mark is identified with a particular quality.⁴³⁰

I am satisfied that the evidence with respect to these factors shows the existence of significant goodwill in the TOYS R US trademarks, and in particular the ‘641 Mark and its Canadianized version...⁴³¹

“Linkage”

The requisite ...[linkage] is ... a linkage, connection, or mental association that is likely to have an effect on goodwill... such a linkage must be ‘likely’, which is a question of evidence rather than mere speculation.⁴³²

In my view, the likelihood of a linkage or mental association between the HERBS R US trademark and the ‘641 Mark is established..., as is the likely effect of that linkage on goodwill. ... I do not believe that this requires specific consumer evidence or survey evidence establishing the likelihood of linkage. Rather, I conclude that I can infer the existence of such a linkage in the mind of a consumer from the marked similarities between the ‘641 Mark and HERBS R US mark, combined with evidence of the extensive use, sales, and advertising associated with the ‘641 mark.⁴³³ (para. 59)

“Damage”

Finally, I conclude that the evidence shows that it is likely that the goodwill in the ‘641 Mark would be damaged or depreciated by the use of the HERBS R US mark.⁴³⁴

I conclude that the use of the HERBS R US trademark amounts to another trader ‘bandying the mark about’ in a

⁴³⁰ *Ibid.* at para. 56.

⁴³¹ *Ibid.* at para. 57.

⁴³² *Ibid.* at para. 58.

⁴³³ *Ibid.* at para. 59.

⁴³⁴ *Ibid.* at para. 60.

fashion that reduces the distinctiveness of the ‘641 Mark, and ‘whittles away’ at the brand’s power to distinguish Toys “R” Us products. ...⁴³⁵

In addition I accept ... [the] evidence that the creation of an association between the Toys “R” Us and a cannabis ‘dispensary,’ ... is ‘utterly inconsistent’ with the reputation of the TOYS R US brand, and that this association is likely to tarnish the goodwill associated with the ‘641 Mark.’⁴³⁶

I also agree that there was no reason for Herbs “R” Us to adopt and use the HERBS R US trademark other than to trade of the goodwill and reputation established by Toys “R” Us, and that this points to a finding of depreciation.⁴³⁷

He therefore found, “that Toys “R” Us has established each of these four elements”:

- use of the registered mark,
- that the 641 mark was well enough known to have significant goodwill,
- that there was linkage between the 641 mark and the Herbs R Us marks in the minds of consumers, and
- finally, that Toys “R” Us would suffer damage or be depreciated by the use the Herbs R Us mark.⁴³⁸

Therefore, he found the cause of action for depreciation of goodwill was established by Toys “R” Us against Herbs R Us.

It is important to note, in the context of this thesis, that, as quoted above from para. 59 of the judgment, Justice McHaffie felt that he could “infer the existence of such a linkage [between the HERBS R US trademark and the ‘641 Mark] in the mind of a consumer from the marked similarities between the ‘641 Mark and HERBS R US mark,

⁴³⁵ *Ibid.* at para. 61.

⁴³⁶ *Ibid.*

⁴³⁷ *Ibid.* at para. 62.

⁴³⁸ *Ibid.* at para. 52.

combined with evidence of the extensive use, sales and advertising associated with the ‘641 mark’.

It appears Justice McHaffie relied on his own powers of judicial inference to find a linkage which was not directly established on the evidence before him. In terms of Bartholomew’s concept of “neuromarks”, if it is not currently possible to obtain evidence of such a linkage through neuroscientific evidence, it would seem likely that such evidence will soon be possible – and use of such evidence would mean that there would be no need for such judicial inference as was required by Justice McHaffie here in order to establish depreciation of goodwill.

Drawing an exact parallel to the third analysis and outcome in *Toys “R” Us (Canada) v Herbs “R” Us Wellness Society*, there would be grounds for success in an action brought under s 22(1) of the Trademarks Act because the Burgatory restaurant chain, in Bartholomew’s scenario, is a registered mark and therefore has access to the depreciation of goodwill remedy and, by analogy to the facts in *Toys “R” Us (Canada) v Herbs “R” Us Wellness Society*, the value of the goodwill in the online toy store would be depreciated by the use of the HERBS R US mark. See again Justice McHaffie, as quoted above at para. 55, where he says, in part, “in my view, the strong resemblance between the HERBS R US design used by Herbs “R” Us and the ‘641 mark is sufficiently similar to evoke a mental association ... Indeed, the two are so similar that ‘link, connection, or mental association’ with the ‘641 Mark is all but inevitable, and must be inferred to have been intended.”

This case is further detailed in Appendix M.

In Bartholomew's third hypothetical scenario, he posits a new business in a different field beginning to use the "Burgatory" mark. Just as in his second hypothetical scenario, it would seem difficult for the competitor to show any use that would allow for any form of neuroscientific testing. On the other hand, in the Mattel case, the Barbie doll had been in Canada for almost 40 years and the Montreal restaurant for about 10 years. In such a situation, relevant neuroscientific evidence could be obtained for both businesses. Finally, in *Toys "R" Us v HERBS R US*, while Toys "R" Us had a history of about a dozen years on the Canadian website, Herbs R Us had existed for less than 2 years before the litigation commenced. Therefore, it would seem unlikely that Herbs R Us would be susceptible to neuroscientific investigation in terms of its trademark.

3. Was any mention of neuroscientific evidence in registered trademark or passing off contexts discovered in current Canadian law?

A search of Canadian case law was conducted using Lexis Nexis and WestLawNext Canada. These two legal databases were chosen for their comprehensive collection and search options for case law. The search was conducted using the same three broad categories of key terms as that used for the search of legal literature (presented in Chapter 2). The search was conducted on March 3, 2022. As presented in **Table 4: Canadian Case Law Referencing Technology Relevant to "Neuromarks"**, the results of case law search demonstrates that legal scholars and legal practitioners have not considered the topic of neuroscience in the context of trademark, and it has not yet been admitted in any cases of trademark in Canada. From these findings, one can infer that the lack of consideration of this novel topic also implies that this topic has also not

been ruled out by scholars and practitioners, specifically from a Canadian perspective.

Hence, this thesis can spark a discussion on this novel topic.

Table 4: Canadian Case Law Referencing Technology Relevant to “Neuromarks”.

Search terms	Database: LexisNexis	Database: WestLawNext
(“Magnetic Resonance Imaging” OR MRI) AND (Trademark OR Trade-mark OR “Trade Mark”)	0	0
(Brain) AND Trademark OR Trade-mark OR “Trade Mark”)	0	0
(Neuro) AND Trademark OR Trade-mark OR “Trade Mark”)	2 ⁴³⁹	0

4. Is there any apparent barrier to the reception of neuroscientific evidence in registered trademark or passing off contexts apparent in current Canadian law?

A thorough read of the major trademark cases that were presented earlier in this chapter as well as the data from a search of Canadian case law (see Table 4) revealed that neuroscientific information has not yet been incorporated into trademark litigation.

However, there is no apparent barrier to the reception of neuroscientific evidence in registered trademark or passing off contexts in current Canadian trademark law.

⁴³⁹ Further analysis of these two cases, [Warman v Lemire, \[2009\] CHR D No 26, 2009 CHRT 26, \[2009\] DCDP no 26, 68 CHRR D/205](#) and [PIPEDA Report of Findings No 2019-002, \[2019\] CPCSF No 2, \[2019\] SCCPVPC no 2](#), revealed that the search terms were mentioned in a different context and these cases are not relevant to the discussion in this thesis. The first case is about communicating hate messages over the internet. The term “neuroscience” was mentioned in an expert statement by Dr. Persinger who testified that conclusions drawn by another expert, Dr. Kaufmann, were out of date and based on inaccurate psychological theories. Dr. Persinger refers to advancements in technologies in neuroscience and how they have allowed researchers to better understand how the brain works as a suggestion while criticizing the traditional psychological findings that were used in this case. case is about a complaint where the Office of the Privacy Commissioner of Canada (“OPC”) commenced an investigation into Facebook, Inc. (“Facebook”) relating to its compliance with the *Personal Information Protection and Electronic Documents Act* (“PIPEDA”) in the wake of revelations about Facebook’s disclosure of the personal information of certain of its users to a third-party application. The term “neuroscience” was mentioned twice in this case as reference to the Toronto Laboratory of Social Neuroscience where an expert is affiliated with.

The technology of “neuromarks”, as discussed earlier in this thesis, appears to be able to allow researchers to gain direct insights on consumers’ perceptions of brands and branding in relation to goods and services. As Bartholomew has argued, this same technology may be able to be used to adduce a new type of evidence into trademark law in the United States. Whether this technology might also be able to be used in Canadian courts to help decide questions related to trademark confusion or distinctiveness arising in either actions under the *Trademarks Act* or in passing off litigation is not yet decided in Canada -- but this chapter has established that there do not appear to be any *a priori* barriers in Canadian law that would necessarily bar this type of evidence.

5. Concluding Observations on Canadian Trademark Law and “Neuromarks”

The previous chapter (Chapter 3) established that there is no mention of neuroscience or similar technologies in Canada’s relevant obligations in current treaties and international trade agreements. This chapter set out to determine whether there are aspects of Canadian trademark law that would preclude an incorporation of “neuromarks” into cases of trademark. Further, this chapter also aimed to determine whether there is any mention of neuroscience or similar technologies to be found within the context of Canada’s current domestic trademark law.

The discussion within this chapter, demonstrates that there is no barrier in Canadian trademark law that is blocking use of ‘neuromarks’ technology in trademark litigation. Having presented a search of legal literature in Canada in Chapter 2, above which establishes that there has been no mention of the topic of “neuromarks”, this chapter has included another search, this one of Canadian case law, (see again Table 4

earlier in this chapter). From this latter table, it can be seen that to date no attempts have been made to present information from neuroscientific technologies in Canadian trademark litigation.

In his article, Bartholomew was reticent about the current applications of neuroscientific technologies in trademark litigation, implying that the technology may not yet be in a state advanced enough for this use. This chapter has established that in Canada there has not yet been an incorporation of information for natural science research methodologies and technologies. Therefore, there appears to have been no use of ‘neuromarks’ evidence in Canadian cases of trademark. This chapter has also demonstrated that there has been use of personal experience including judicial inference, judicial notice and expert witness as well as use of information gathered from social science methodologies such as surveys and witness testimony. **Figure 3: Illustration of the types of evidence possible in trademark litigation (below)** illustrates the presence of personal experience and social science in Canadian trademark litigation – in the absence of “neuromarks” evidence.

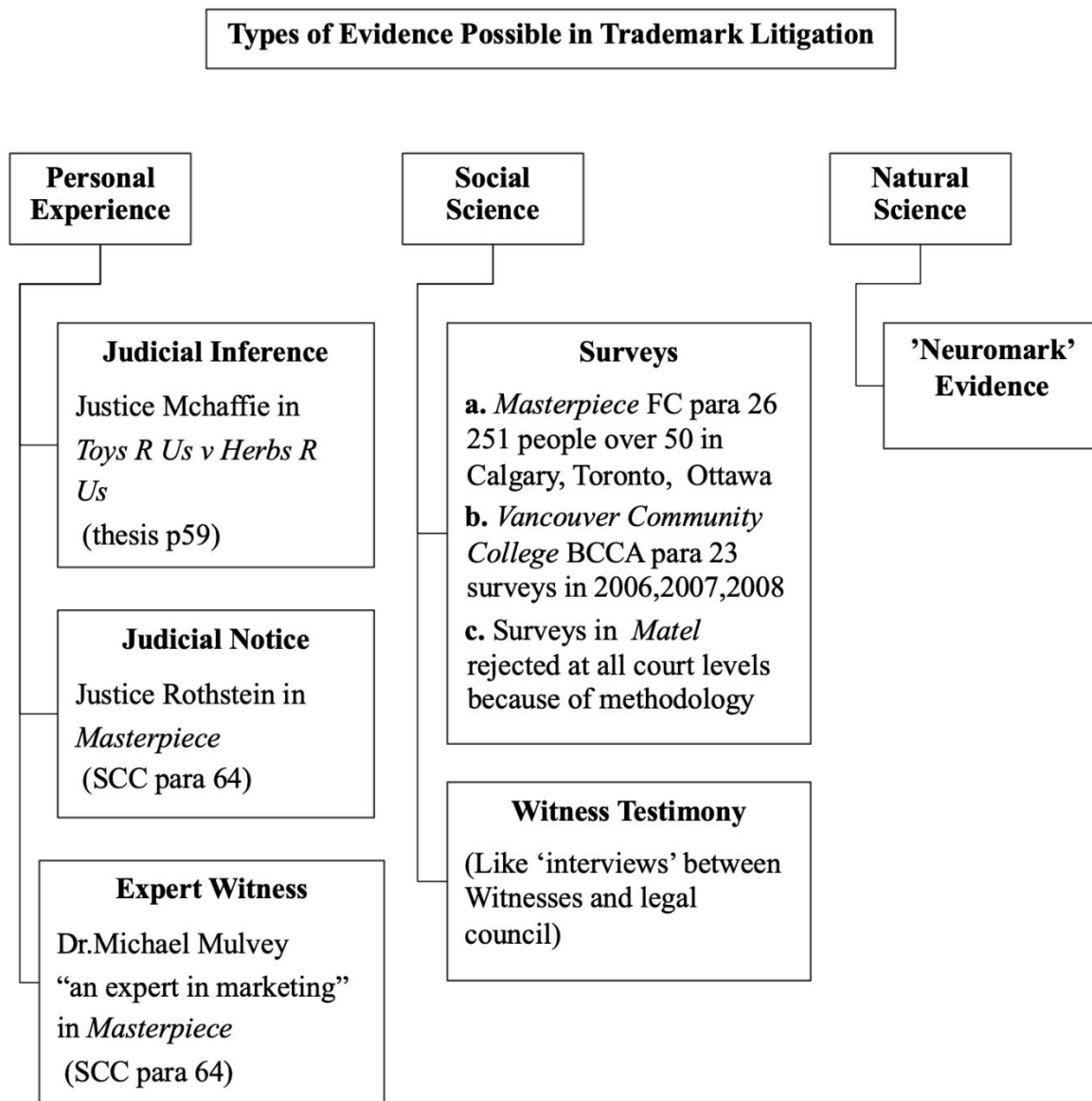


Figure 3: Illustration of the types of evidence possible in trademark litigation.

In sum, this research establishes that neither Canadian legal academics nor Canadian trademark litigators appear to have picked up on this emerging “neuromarks” technology. This research suggests that the onus lies with litigators to bring this form of evidence into Canadian courts for judges to consider.

Chapter 5: Conclusion

As described earlier in this thesis, in 2018, Mark Bartholomew introduced the concept of “neuromarks” in relation to trademark law. An American scholar, his discussion was anchored in trademark law in the U.S. Based on his analysis of U.S. trademark law, Bartholomew came to the conclusion that “neuromarks” can have a future in trademark law. This thesis has set out to determine whether the concept of “neuromarks” can also have a future in Canadian trademark law, given the current state of Canadian law. Bartholomew’s concept of a “neuromark” is really a misnomer as it makes misleading use of the term “mark”, by embedding it in his newly coined term. In trademark law, a “mark” is “a sign or combination of signs”.⁴⁴⁰ Bartholomew does not claim that “neuromarks” can provide any evidence at all about what the mark in question is physically (i.e., how it actually appears) or the contexts in which it is actually used. In sum, “neuromarks” is Bartholomew’s label for neurological evidence about what consumers know or how they react to how a mark appears and in what contexts.

In **Chapter 2**, as well as exploring the background to Bartholomew’s 2018 article, this thesis explored whether there is any indication in Canadian legal literature that the notion of “neuromarks” has already been explored in the Canadian context – and it has been determined that it has not. Nor have searches of Canadian primary law relating to trademarks and the tort of passing off revealed any references to the concept of “neuromarks” or, indeed, the technology that is related to it (see again, for instance, Table

⁴⁴⁰ Canadian *Trademarks Act* RSC 1985, c T-13 at s. 2. See the definitions of both 'trademark' and 'certification mark' in the *Trademarks Act* s 2-- and see also the definition of 'sign' there also (and, at common law, the mark or 'indicia' has that same connotation.

2 in **Chapter 2** reporting the results done on searches for “magnetic resonance imaging”, “brain” and “neuro” in connection with Canadian trademark in law-related databases).

This thesis has assumed that law in the U.S. as presented by Bartholomew in his article is in compliance with both international public law and international trade obligations the United States has made that include matters related to trademark. However, as this thesis discussed in **Chapter 3**, one difficulty that might have presented itself in terms of assuming that Bartholomew’s conclusion about the possible future use of the concept of “neuromarks” in the United States being able to be also applied in the Canadian context is any problem that could arise because Canada has made commitments related to trademarks under public international law or international trade agreements that the United States has not, if any of such commitments could affect the use of “neuromarks” in Canada. As established by the research presented in **Chapter 3**, although Canada does have international trade agreement commitments involving trademark that the United States does not have (specifically CETA (2017), CPTPP (2018), CUSMA (2019) and Canada-United Kingdom Trade Continuity Agreement (2021)), no provisions relating to trademark in any of these trade agreements deals with anything that creates a barrier for Canada making the notion of “neuromarks” part of Canadian trademark law.

Chapter 4, therefore, turned to direct comparison of trademark law in the U.S. in which Bartholomew claims “neuromarks” can play a part and the corresponding Canadian law. Immediately, as is discussed in Chapter 4, it becomes evident that there are differences in the structure of Canadian law that arise when considering trademarks.

One key difference between the two countries in the area of trademark law became evident as this research explored the role in trademark law in the U.S. that Bartholomew claims that “neuromarks” can play: in his article, Bartholomew focused in on substantive trademark law in the U.S. involving the concepts of “distinctiveness”, “confusion” and “dilution”.⁴⁴¹ As is revealed in Chapter 4 of this thesis, there is no Canadian concept of “dilution” in trademark law⁴⁴² – and certainly no specific remedy for “dilution,” such as exists in the *Lanham Act* in the U.S., exists in Canada.⁴⁴³ Therefore, the discussion in this thesis of the possible role of “neuromarks” in Canadian trademark law focused on their possible role in connection with the substantive concepts of “distinctiveness” and “confusion”.

Another key difference between trademark law in Canada and the U.S. which this thesis documents in Chapter 4 is the fact that, whereas in the United States substantive law affecting both registered and unregistered trademarks appears in the *Lanham Act*⁴⁴⁴, the substantive law governing unregistered marks in Canada is found entirely in the jurisprudence of the tort of passing off.⁴⁴⁵ As Chapter 4 discussed, the terminology of “distinctiveness” and “confusion” is found and, indeed, interpreted in the Canadian *Trademarks Act* itself.⁴⁴⁶ On the other hand, as discussed in Chapter 4, the classic

⁴⁴¹ Bartholomew, *supra* note 16 at 560-563.

⁴⁴² As discussed in Chapter 4, the preponderance of scholarship in Canada does not mention dilution.

⁴⁴³ As noted earlier in Chapter 4, around p 81-82.

⁴⁴⁴ As noted earlier in Chapter 1, p 21. *Lanham (Trademark) Act*, 15 U.S.C. §1051.

⁴⁴⁵ As noted earlier, p 19. The provisions of Section 7 of the *Trademarks Act*, which do deal (at least in part) with enforcing common law marks, are procedural and not substantive.

⁴⁴⁶ As noted earlier in Chapter 4 at p. 81-83. *Trademarks Act*, RSC 1985. c. T-13 at s. 2 and 6.

language of the Canadian passing off tort is “goodwill or reputation”, “misrepresentation or confusion”, and “damage”,⁴⁴⁷ but, as also discussed in Chapter 4, the concepts of “distinctiveness” and “confusion” are able to be “mapped onto” those same concepts of “distinctiveness” and “confusion” as are used in the statutory context.⁴⁴⁸

In his article, Bartholomew had this notion of how “neuromarks” would add greater value to proving acquired distinctiveness in comparison to proving inherent distinctiveness. He stated “It is less likely that consumer neuroscience can shed light on the analysis of inherent distinctiveness”⁴⁴⁹ However, going on this tangent of acquired versus inherent distinctiveness appears to miss the point. In fact, the appearance of the mark is not the point of differentiation given the current state of neuroscientific technologies. The difference in the efficiency and effectiveness of neuroscientific evidence depends upon how the mark has been in use. A new mark would not elicit measurable patterns of neural activation because of a lack of memory and emotional connection with the mark in the consumers’ minds.

This difference between the two jurisdictions, in terms of the substantive law of passing off in Canada lying entirely within the common law realm and not present in statute, led, in this thesis, to an expansion of the number of scenarios that were examined (in Chapter 4, it was noted that sources of evidence bearing upon questions of distinctiveness and confusion currently accepted before Canadian administrative tribunals

⁴⁴⁷ Hagen et al, *supra* note 62 at 317.

⁴⁴⁸ As discussed in scenarios 2(b) and 3(b), presented in Chapter 4, p 94-98, 108-116.

⁴⁴⁹ Bartholomew, *supra* note 16 at 536.

and courts include the decision-makers' own experiences⁴⁵⁰ and social science evidence such as surveys, interviews and focus groups).⁴⁵¹ However, as shown in Chapter 4, there appears to be nothing in the *Canadian Trademarks Act*⁴⁵² or evident in common law passing off cases⁴⁵³ that would preclude the introduction of scientific "neuromarks" evidence.⁴⁵⁴ Nonetheless, it will be interesting to see whether "neuromarks" evidence does gain popularity before administrative tribunals or courts in Canada in connection with trademark law.

Bartholomew noted (and this thesis further discussed in Chapter 2) that, in the criminal law context, there has been increasing use of scientific, rather than social science, evidence, including increasing use of the technology that lies behind Bartholomew's concept of "neuromarks". Criminal law primarily deals with the guilt or innocence of individuals – and, in that context, neuroscientific observations made about an individual can very well be relevant to questions before criminal courts. There are, however, differences between the criminal law and trademark litigation in the civil law context.

In the civil law context of trademark, the questions before administrative tribunals and courts are about the effects of marks on populations, not individuals (whereas, in the

⁴⁵⁰ As noted earlier in chapter 4, around p 84.

⁴⁵¹ As noted earlier in chapter 4, around p 100-102.

⁴⁵² As noted earlier in chapter 4, around p 118.

⁴⁵³ As noted earlier in chapter 4 on passing off decisions, around p 121.

⁴⁵⁴ As noted earlier in chapter 4, around p 121-122.

criminal law context, the question is always about the culpability of an individual). As this study has demonstrated (in Chapter 4), Canadian trademark law has traditionally relied upon tools such as the intuition of the trier of fact, the evidence of expert witnesses, and social science surveys as evidence on which to base judgments in trademark litigation. As John Goutas et al.⁴⁵⁵ pointed out, with respect to these types of methodologies:

Qualitative methods (e.g., focus groups, observations and in-depth interviews) are very useful to explore in-depth consumer views, attitudes and value judgments but they tend to be quite subjective because they rely on self-reports that may be biased and difficult to interpret objectively.⁴⁵⁶

The authors continued:

Recent studies [as of mid-2019⁴⁵⁷] address these concerns by using neuroscience research methods that are considerably more objective in combination with the traditional behavioural research methods, to examine and evaluate the impact of advertising on consumers in advertising contexts such as social marketing and public service messaging.⁴⁵⁸

In order to use “neuromarks” in the context of trademark litigation, it appears that scans would have to be done of multiple individuals’ brains and then the results grouped to represent populations. While this might be labelled by some as use of the developing

⁴⁵⁵ John Goutas et al., “Looking Beyond Traditional Measures of Advertising Impact: Using Neuroscientific Methods to Evaluate Social Marketing Messages,” (2019) 105 *Journal of Business Research* pp 121-135, at 135. This article contains many images of brain scans (at pp 126-128) which illustrate the concepts involved.

⁴⁵⁶ *Ibid.* at 121 (footnote omitted).

⁴⁵⁷ *Ibid.* at 135 (footnote omitted), information on publication history provided with the article: “Received 5 September 2018... Accepted 9 July 2019”.

⁴⁵⁸ *Ibid.* at 121 (footnote omitted).

neuroscience of the ‘neuromarks’ only as part of a social science methodology, it nonetheless remains true that neuroimaging technologies (i.e., fMRI) can be used on a small number of participants to represent a consumer population than is the case with the traditional social science survey tool: many neuroscience research studies are conducted with 4-6 participants being examined using fMRI or PET scan⁴⁵⁹ technologies.⁴⁶⁰

In the study done by Goutas et al., the researchers found that:

Both the research methods (focus groups and EEG) identify videos 4 and 5 to be more effective, albeit for different reasons. For example, the focus group participants’ comments on videos 4 and 5 ... show these two videos as being most memorable and effective, possibly because the participants are able to express their reasons for the overall message benefits. Similarly, sLORETA [the EEG technology] images show that videos 4 and 5 produced stronger brain activation, which suggests more elaborate cognitive and emotional processing by these participants, and hence likely to be more effective than the other videos.⁴⁶¹

In his article⁴⁶², published in 2018, Bartholomew was reticent on the prognosis for current applications of neuroscientific technologies in trademark litigation, implying that the technology was not yet in an advanced enough state. However, there is advanced technology available that is readily being used in the marketing field to gain a deeper

⁴⁵⁹ Positron Emission Tomography (PET Scans) uses radioactive substances that are injected into the individual to visualize and measure changes in metabolic processes, blood flow, regional chemical composition, and absorption. Moran Cerf “Methods” in Cerf Moran and Manuel Garcia-Garcia, eds, *Consumer Neuroscience*, (Cambridge: MIT Press, 2017) at 65-75.

⁴⁶⁰ In the context of fMRI studies, as it relates to Bartholomew’s concept of “neuromarks”, powerful software exists that allow for a deeper analysis of neural activation patterns at a deeper level, as small as a voxel (an area of the brain that measures 1mm x 1mm x 1mm) in any part of the brain, including those nearer the surface and those deeper into the brain’s anatomy. In fact, this is an added value of fMRI scans in comparison with other technologies such as Transcranial Magnetic Stimulation (TMS).

⁴⁶¹ Goutas et al., *supra* note 455 at 131-132.

⁴⁶² Bartholomew, *supra* note 16 at 526-527.

understanding of consumer behaviour and appears to be able to be put to use in Canadian trademark litigation. In fact, the first scholarly research with neuromarketing technologies was conducted by Read Montague, who was then a Professor of Neuroscience at Baylor College of Medicine.⁴⁶³ The key article about this research, Neural correlates of behavioral preference for culturally familiar drinks, was published in 2004 in a high impact neuroscience journal titled *Neuron*.⁴⁶⁴ According to Google Scholar, since its publication, this article has been cited 1,400 times. In this study, Montague and his team used fMRI scanners to record participants' brain activities while they took a sip of either Coke or Pepsi in a single blind experiment. Results of the fMRI scans matched those of the original 1970's behavioural study where more than half of the participants preferred the taste of Pepsi and showed higher levels of activation in the ventral putamen, a brain region responsible for taste recognition and preferences.⁴⁶⁵ Alternatively, when participants were told which drink they were tasting, 75% of the participants said they preferred the taste of Coke. These verbally reported preferences were also confirmed with the neuroimaging study where greater levels of activation were recorded not only in the ventral putamen, but also in the prefrontal cortex, a brain region responsible for higher thinking, planning, and decision-making. In sum, the results of this study illustrated that strong brands such as Coca-Cola can have a huge impact on the frontal lobe such that

⁴⁶³ McClure et al., *supra* note 139 at 131-135.

⁴⁶⁴ *Ibid.*

⁴⁶⁵ *Ibid.*

one's emotional connection to a brand's history, logo, colour, and brand presence can overcome one's rational thinking and taste preference for a competing alternative.⁴⁶⁶

Since McClure et al.'s study was published, numerous studies have been created in the context of marketing whereby neuroscientific technologies, more specifically fMRI has been used to gain deeper insights into the consumers' internal mental processes.⁴⁶⁷ This has given rise to a budding new discipline called neuromarketing that combines knowledge, techniques, and research methodologies from psychology, neuroscience, and economics to study how the human brain functions at the neural, psychological, physiological, behavioural, and social levels and its implications on the marketing discipline.⁴⁶⁸

In "Brain's Valuation Networks and Consumers' Neuroscience Methods in the Fuzzy Front-End Innovation Process,"⁴⁶⁹ Jyrki Suomala and Pekka Berg wrote:⁴⁷⁰

Modern neurophysiological tools allow innovators to measure consumers' brain activation patterns of the valuation network relating to offering concepts when a consumer participates in experiments, making it possible to study how different features of products and services correlate to the brain's valuation network activation and the relationship between these messages and

⁴⁶⁶ *Ibid.* at 131-135.

⁴⁶⁷ Jonah Berger, "Arousal increases social transmission of information" (2011) 22(7) *Psychological Science* 891 at 891-893; Nick Lee, Amanda J Broderick & Laura Chamberlain, "What is "neuromarketing"? A discussion and agenda for future research" (2007) 63 *International Journal of Psychophysiology* 199 at 201-204.

⁴⁶⁸ *Ibid.* at 201-204.

⁴⁶⁹ Jyrki Suomala & Pekka Berg, "Brain's Valuation Networks and Consumers' Neuroscience Methods in the Fuzzy Front-End Innovation Process" in Len Tiu Wright et al. (eds), *The Routledge Companion to Marketing Research* (London: Routledge, 2021) at 249.

⁴⁷⁰ *Ibid.* at 250 (footnote omitted).

consumers' behavioural changes. Using neuroimaging tools – functional magnetic resonance imaging (fMRI), electroencephalography (EEG) and functional near-infrared spectroscopy (fNIRS) – it is possible to measure the hemodynamic response related to neural activity in the valuation network when subjects are exposed to persuasive messages. These non-invasive tools measure the hemodynamic response to the cerebral cortex.

Goutas et al. conclude, in their study, that “[n]euroscience tools produce reliable empirical information that is not accessible by any other traditional market research methods such as surveys, experiments or qualitative research.⁴⁷¹ They go on to state that “[n]euroscientific tools can reduce some of [the] usually undetected research biases [in qualitative research data].”⁴⁷²

Though a search of legal literature in Canada (as presented in Table 2 in Chapter 2) revealed that there has been no mention of ‘neuromarks’ or their related technologies in Canadian legal academic circles and another search of Canadian case law (as presented in Table 4 in Chapter 4) revealed that, to date, no attempts appear to have been made to present information from neuroscientific technologies in trademark litigation, this thesis has demonstrated that there is no barrier to the introduction of neuroscientific evidence into Canadian trademark tribunals or courts. There is, therefore, no reason why an amalgam of neuroscience and social science evidence cannot be leveraged together in future trademark litigation in Canada.

⁴⁷¹ *Ibid.* at 133.

⁴⁷² *Ibid.*

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Appendices

Appendix A: Relevant Excerpts from the *Paris Convention for the Protection of Industrial Property* (as amended from 1883)

(1883, amended 1979, entered into force, as amended, June 1984)

...

Article 1(3): Establishment of the Union; Scope of Industrial Property

Industrial property shall be understood in the broadest sense and shall apply not only to industry and commerce proper, but likewise to agricultural and extractive industries and to all manufactured or natural products, for example, wines, grain, tobacco leaf, fruit, cattle, minerals, mineral waters, beer, flowers, and flour.

...

Article 2(1): National Treatment for Nationals of Countries of the Union

Nationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.

Article 2(2) partial: National Treatment for Nationals of Countries of the Union

no requirement as to domicile or establishment in the country where protection is claimed may be imposed upon nationals of countries of the Union for the enjoyment of any industrial property rights

...

Article 3: Same Treatment for Certain Categories of Persons as for Nationals of Countries of the Union

Nationals of countries outside the Union who are domiciled or who have real and effective industrial or commercial establishments in the territory of one of the countries of the Union shall be treated in the same manner as nationals of the countries of the Union.

Article 4

A to I. Patents, Utility Models, Industrial Designs, Marks, Inventors’ Certificates: Right of Priority - G. Patents: Division of the Application

A. (1) Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

(2) Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority.

(3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.

B. Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, the putting on sale of copies of the design, or the use of the mark, and such acts cannot give rise to any third-party right or any right of personal possession. Rights acquired by third parties before the date of the first application that serves as the basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union

C. (1) The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.

(2) These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.

(3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

(4) A subsequent application concerning the same subject as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, if, at the time of filing the subsequent application, the said previous

application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

D. (1) Any person desiring to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and the country in which it was made. Each country shall determine the latest date on which such declaration must be made.

(2) These particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and the specifications relating thereto.

(3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority which received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.

(4) No other formalities may be required for the declaration of priority at the time of filing the application. Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority.

(5) Subsequently, further proof may be required.

Any person who avails himself of the priority of a previous application shall be required to specify the number of that application; this number shall be published as provided for by paragraph (2), above.

E. (1) Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be the same as that fixed for industrial designs.

(2) Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa.

F. No country of the Union may refuse a priority or a patent application on the ground that the applicant claims multiple priorities, even if they originate in different countries, or on the ground that an application claiming one or more priorities contains one or more elements that were

not included in the application or applications whose priority is claimed, provided that, in both cases, there is unity of invention within the meaning of the law of the country.

With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions.

G. (1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized.

H. Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.

I. (1) Applications for inventors' certificates filed in a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate shall give rise to the right of priority provided for by this Article, under the same conditions and with the same effects as applications for patents.

(2) In a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate, an applicant for an inventor's certificate shall, in accordance with the provisions of this Article relating to patent applications, enjoy a right of priority based on an application for a patent, a utility model, or an inventor's certificate.

...

Article 5

A. Patents: Importation of Articles; Failure to Work or Insufficient Working; Compulsory Licenses

B. Industrial Designs: Failure to Work; Importation of Articles

C. Marks: Failure to Use; Different Forms; Use by Co-proprietors

D. Patents, Utility Models, Marks, Industrial Designs: Marking

A.

(1) Importation by the patentee into the country where the patent has been granted of articles manufactured in any of the countries of the Union shall not entail forfeiture of the patent.

(2) Each country of the Union shall have the right to take legislative measures providing for the grant of compulsory licenses to prevent the abuses which might result from the exercise of the exclusive rights conferred by the patent, for example, failure to work.

(3) Forfeiture of the patent shall not be provided for except in cases where the grant of compulsory licenses would not have been sufficient to prevent the said abuses. No proceedings for the forfeiture or revocation of a patent may be instituted before the expiration of two years from the grant of the first compulsory license.

(4) A compulsory license may not be applied for on the ground of failure to work or insufficient working before the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last; it shall be refused if the patentee justifies his inaction by legitimate reasons. Such a compulsory license shall be non-exclusive and shall not be transferable, even in the form of the grant of a sub-license, except with that part of the enterprise or goodwill which exploits such license.

(5) The foregoing provisions shall be applicable, *mutatis mutandis*, to utility models.

B. The protection of industrial designs shall not, under any circumstance, be subject to any forfeiture, either by reason of failure to work or by reason of the importation of articles corresponding to those which are protected.

C.

(1) If, in any country, use of the registered mark is compulsory, the registration may be cancelled only after a reasonable period, and then only if the person concerned does not justify his inaction.

(2) Use of a trademark by the proprietor in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered in one of the countries of the Union shall not entail invalidation of the registration and shall not diminish the protection granted to the mark.

(3) Concurrent use of the same mark on identical or similar goods by industrial or commercial establishments considered as co-proprietors of the mark according to the provisions of the domestic law of the country where protection is claimed shall not prevent registration or diminish in any way the protection granted to the said mark in any country of the Union,

provided that such use does not result in misleading the public and is not contrary to the public interest.

D. No indication or mention of the patent, of the utility model, of the registration of the trademark, or of the deposit of the industrial design, shall be required upon the goods as a condition of recognition of the right to protection.

...

Article 6: Marks: Conditions of Registration; Independence of Protection of Same Mark in Different Countries

(1) The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation.

(2) However, an application for the registration of a mark filed by a national of a country of the Union in any country of the Union may not be refused, nor may a registration be invalidated, on the ground that filing, registration, or renewal, has not been effected in the country of origin.

(3) A mark duly registered in a country of the Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin.

Article 6^{bis}: Marks: Well-Known Marks

(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

...

Article 6^{quater}: Marks: Assignment of Marks

(1) When, in accordance with the law of a country of the Union, the assignment of a mark is valid only if it takes place at the same time as the transfer of the business or goodwill to which the mark belongs, it shall suffice for the recognition of such validity that the portion of the business or goodwill located in that country

be transferred to the assignee, together with the exclusive right to manufacture in the said country, or to sell therein, the goods bearing the mark assigned.

(2) The foregoing provision does not impose upon the countries of the Union any obligation to regard as valid the assignment of any mark the use of which by the assignee would, in fact, be of such a nature as to mislead the public, particularly as regards the origin, nature, or essential qualities, of the goods to which the mark is applied.

Article 6^{quinquies} Marks: *Protection of Marks Registered in One Country of the Union in the Other Countries of the Union*

A.

(1) Every trademark duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the Union, subject to the reservations indicated in this Article. Such countries may, before proceeding to final registration, require the production of a certificate of registration in the country of origin, issued by the competent authority. No authentication shall be required for this certificate.

(2) Shall be considered the country of origin the country of the Union where the applicant has a real and effective industrial or commercial establishment, or, if he has no such establishment within the Union, the country of the Union where he has his domicile, or, if he has no domicile within the Union but is a national of a country of the Union, the country of which he is a national.

B. Trademarks covered by this Article may be neither denied registration nor invalidated except in the following cases:

(i) when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed;

(ii) when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed;

(iii) when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public. It is understood that a mark may not be considered contrary to public order for the sole reason that it does not conform to a provision of the legislation on marks, except if such provision itself relates to public order.

This provision is subject, however, to the application of Article 10bis.

C.

(1) In determining whether a mark is eligible for protection, all the factual circumstances must be taken into consideration, particularly the length of time the mark has been in use.

(2) No trademark shall be refused in the other countries of the Union for the sole reason that it differs from the mark protected in the country of origin only in respect of elements that do not alter its distinctive character and do not affect its identity in the form in which it has been registered in the said country of origin.

D. No person may benefit from the provisions of this Article if the mark for which he claims protection is not registered in the country of origin.

E. However, in no case shall the renewal of the registration of the mark in the country of origin involve an obligation to renew the registration in the other countries of the Union in which the mark has been registered.

F. The benefit of priority shall remain unaffected for applications for the registration of marks filed within the period fixed by [Article 4](#), even if registration in the country of origin is effected after the expiration of such period.

Article 6^{sexies} Marks: Service Marks

The countries of the Union undertake to protect service marks. They shall not be required to provide for the registration of such marks.

Article 6^{septies} Marks: Registration in the Name of the Agent or Representative of the Proprietor Without the Latter's Authorization

(1) If the agent or representative of the person who is the proprietor of a mark in one of the countries of the Union applies, without such proprietor's authorization, for the registration of the mark in his own name, in one or more countries of the Union, the proprietor shall be entitled to oppose the registration applied for or demand its cancellation or, if the law of the country so allows, the assignment in his favor of the said registration, unless such agent or representative justifies his action.

(2) The proprietor of the mark shall, subject to the provisions of [paragraph \(1\)](#), above, be entitled to oppose the use of his mark by his agent or representative if he has not authorized such use.

(3) Domestic legislation may provide an equitable time limit within which the proprietor of a mark must exercise the rights provided for in this Article.

...

Article 7^{bis}: Marks: Collective Marks

(1) The countries of the Union undertake to accept for filing and to protect collective marks belonging to associations the existence of which is not contrary to the law of the country of origin, even if such associations do not possess an industrial or commercial establishment.

(2) Each country shall be the judge of the particular conditions under which a collective mark shall be protected and may refuse protection if the mark is contrary to the public interest.

(3) Nevertheless, the protection of these marks shall not be refused to any association the existence of which is not contrary to the law of the country of origin, on the ground that such association is not established in the country where protection is sought or is not constituted according to the law of the latter country.

Article 8: Trade Names

A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.

Article 9: Marks, Trade Names: Seizure, on Importation, etc., of Goods Unlawfully Bearing a Mark or Trade Name

(1) All goods unlawfully bearing a trademark or trade name shall be seized on importation into those countries of the Union where such mark or trade name is entitled to legal protection.

(2) Seizure shall likewise be effected in the country where the unlawful affixation occurred or in the country into which the goods were imported.

(3) Seizure shall take place at the request of the public prosecutor, or any other competent authority, or any interested party, whether a natural person or a legal entity, in conformity with the domestic legislation of each country.

(4) The authorities shall not be bound to effect seizure of goods in transit.

(5) If the legislation of a country does not permit seizure on importation, seizure shall be replaced by prohibition of importation or by seizure inside the country.

(6) If the legislation of a country permits neither seizure on importation nor prohibition of importation nor seizure inside the country, then, until such time as the legislation is modified accordingly, these measures shall be

replaced by the actions and remedies available in such cases to nationals under the law of such country.

...

Article 10^{ter}: Marks, Trade Names, False Indications, Unfair Competition: Remedies, Right to Sue

(1) The countries of the Union undertake to assure to nationals of the other countries of the Union appropriate legal remedies effectively to repress all the acts referred to in [Articles 9, 10](#), and [10bis](#).

(2) They undertake, further, to provide measures to permit federations and associations representing interested industrialists, producers, or merchants, provided that the existence of such federations and associations is not contrary to the laws of their countries, to take action in the courts or before the administrative authorities, with a view to the repression of the acts referred to in [Articles 9, 10](#), and [10bis](#), in so far as the law of the country in which protection is claimed allows such action by federations and associations of that country.

Article 11: Inventions, Utility Models, Industrial Designs, Marks: Temporary Protection at Certain International Exhibitions

(1) The countries of the Union shall, in conformity with their domestic legislation, grant temporary protection to patentable inventions, utility models, industrial designs, and trademarks, in respect of goods exhibited at official or officially recognized international exhibitions held in the territory of any of them.

(2) Such temporary protection shall not extend the periods provided by Article 4. If, later, the right of priority is invoked, the authorities of any country may provide that the period shall start from the date of introduction of the goods into the exhibition.

(3) Each country may require, as proof of the identity of the article exhibited and of the date of its introduction, such documentary evidence as it considers necessary.

Article 12: Special national Industrial Property Services

(1) Each country of the Union undertakes to establish a special industrial property service and a central office for the communication to the public of patents, utility models, industrial designs, and trademarks.

(2) This services shall publish an official periodical journal. It shall publish regularly:

- (a) the names of the proprietors of patents grants, with a brief designation of the inventions patented;
- (b) the reproductions of registered trademarks.

...

Appendix B: Relevant Excerpts from the *Agreement on Trade-Related Aspects of Intellectual Property*

(1994, into effect Jan 1, 1995 as an Appendix to the World Trade Organization Agreement)

...

Section 2: Trademarks

Article 15: Protectable Subject Matter

Article 15(1)

Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.

...

Article 16: Rights Conferred

Article 16(1)

The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.

Article 16(2)

Article 6^{bis} of the Paris Convention (1967) shall apply in *mutatis mutandis*, to services. In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector

of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.

Article 16(3)

...provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.

Article 17: Exceptions

Members may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that such exceptions take account of the legitimate interests of the owner of the trademark and of third parties.

Article 18: Term of Protection

Initial registration, and each renewal of registration, of a trademark shall be for a term of no less than seven years. The registration of a trademark shall be renewable indefinitely.

Article 19: Requirement of Use

1. If use is required to maintain a registration, the registration may be cancelled only after an uninterrupted period of at least three years of non-use, unless valid reasons based on the existence of obstacles to such use are shown by the trademark owner. Circumstances arising independently of the will of the owner of the trademark which constitute an obstacle to the use of the trademark, such as import restrictions on or other government requirements for goods or services protected by the trademark, shall be recognized as valid reasons for non-use.

2. When subject to the control of its owner, use of a trademark by another person shall be recognized as use of the trademark for the purpose of maintaining the registration.

Article 20: Other Requirements

The use of a trademark in the course of trade shall not be unjustifiably encumbered by special requirements, such as use with another trademark, use in a special form or use in a manner detrimental to its capability to distinguish the goods or services of one undertaking from those of other undertakings. This will not preclude a requirement prescribing the use of the trademark identifying the undertaking producing the goods or services

along with, but without linking it to, the trademark distinguishing the specific goods or services in question of that undertaking.

Article 21: Licensing and Assignment

Members may determine conditions on the licensing and assignment of trademarks, it being understood that the compulsory licensing of trademarks shall not be permitted and that the owner of a registered trademark shall have the right to assign the trademark with or without the transfer of the business to which the trademark belongs.

Appendix C: Relevant Excerpts from the *Comprehensive Economic and Trade Agreement* (2017)

...

Chapter Twenty: Intellectual Property

SECTION A – General Provisions

...

Article 20.2 – Nature and scope of obligations

(1) The provisions of this Chapter complement the rights and obligations between the Parties under the TRIPS Agreement.

...

SECTION B – Standards Concerning Intellectual Property Rights

Sub-section B – Trademarks

Article 20.13 – International agreements

Each Party shall make all reasonable efforts to comply with Articles 1 through 22 of the *Singapore Treaty on the Law of Trademarks*, done at Singapore on 27 March 2006, and to accede to the *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks*, done at Madrid on 27 June 1989.

Article 20.14 – Registration procedure

Each Party shall provide for a system for the registration of trademarks in which reasons for the refusal to register a trademark are communicated in writing to the applicant, who will have the opportunity to contest that refusal and to appeal a final refusal to a judicial authority. Each Party shall provide for the possibility of filing oppositions either against trademark applications or against trademark registrations. Each Party shall provide a publicly available electronic database of trademark applications and trademark registrations.

Article 20.15 – Exceptions to the rights conferred by a trademark

Each Party shall provide for the fair use of descriptive terms, including terms descriptive of geographical origin, as a limited

exception to the rights conferred by a trademark. In determining what constitutes fair use, account shall be taken of the legitimate interests of the owner of the trademark and of third parties. Each Party may provide other limited exceptions, provided that these exceptions take account of the legitimate interests of the owner of the trademark and of third parties.

...

SECTION C - Enforcement of Intellectual Property Rights

Article 20.32 General obligations

1. Each Party shall ensure that procedures for the enforcement of intellectual property rights are fair and equitable, and are not unnecessarily complicated or costly, nor entail unreasonable time-limits or unwarranted delays. These procedures shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.
2. In implementing the provisions of this Section, each Party shall take into account the need for proportionality between the seriousness of the infringement, the interests of third parties, and the applicable measures, remedies and penalties.
3. Articles 20.33 through 20.42 relate to civil enforcement.
4. For the purposes of Articles 20.33 through 20.42, unless otherwise provided, intellectual property rights means all categories of intellectual property that are the subject of Sections 1 through 7 of Part II of the TRIPS Agreement.

Article 20.33 Show or hide the answer Entitled applicants

Each Party shall recognise as persons entitled to seek application of the procedures and remedies referred to in Articles 20.34 through 20.42:

- (a) the holders of intellectual property rights in accordance with the provisions of its law;
- (b) all other persons authorised to use those rights, if those persons are entitled to seek relief in accordance with its law;
- (c) intellectual property collective rights management bodies that are regularly recognised as having a right to represent holders of intellectual property rights, if those bodies are entitled to seek relief in accordance with its law; and

(d) professional defence bodies that are regularly recognised as having a right to represent holders of intellectual property rights, if those bodies are entitled to seek relief in accordance with its law.

...

Article 20.34 Evidence

Each Party shall ensure that, in the case of an alleged infringement of an intellectual property right committed on a commercial scale, the judicial authorities shall have the authority to order, if appropriate and following an application, the production of relevant information, as provided for in its law, including banking, financial or commercial documents under the control of the opposing party, subject to the protection of confidential information.

Article 20.35 Measures for preserving evidence

1. Each Party shall ensure that, even before the commencement of proceedings on the merits of the case, the judicial authorities may, on application by an entity that has presented reasonably available evidence to support its claims that its intellectual property right has been infringed or is about to be infringed, order prompt and effective provisional measures to preserve relevant evidence in respect of the alleged infringement, subject to the protection of confidential information.

2. Each Party may provide that the measures referred to in paragraph 1 include the detailed description, with or without the taking of samples, or the physical seizure of the alleged infringing goods, and, in appropriate cases, the materials and implements used in the production or distribution of these goods and the documents relating thereto. The judicial authorities shall have the authority to take those measures, if necessary without the other party being heard, in particular where any delay is likely to cause irreparable harm to the right holder or where there is a demonstrable risk of evidence being destroyed.

Article 20.36 Right of information

Without prejudice to its law governing privilege, the protection of confidentiality of information sources or the processing of personal data, each Party shall provide that, in civil judicial proceedings concerning the enforcement of intellectual property rights, its judicial authorities shall have the authority, upon a justified request of the right holder, to order the infringer or the alleged infringer, to provide to the right holder or to the judicial authorities, at least for the purpose of collecting evidence, relevant information as provided

for in its applicable laws and regulations that the infringer or alleged infringer possesses or controls. This information may include information regarding any person involved in any aspect of the infringement or alleged infringement and regarding the means of production or the channels of distribution of the infringing or allegedly infringing goods or services, including the identification of third persons alleged to be involved in the production and distribution of those goods or services and of their channels of distribution.

Article 20.37 Provisional and precautionary measures

1. Each Party shall provide that its judicial authorities have the authority to order prompt and effective provisional and precautionary measures, including an interlocutory injunction, against a party, or where appropriate, against a third party over whom the relevant judicial authority exercises jurisdiction, to prevent an infringement of an intellectual property right from occurring, and in particular, to prevent infringing goods from entering into the channels of commerce.

2. Each Party shall provide that its judicial authorities have the authority to order the seizure or

other taking into custody of the goods suspected of infringing an intellectual property right so as to prevent their entry into or movement within the channels of commerce.

3. Each Party shall provide that, in the case of an alleged infringement of an intellectual property right committed on a commercial scale, the judicial authorities may order, in accordance with its law, the precautionary seizure of property of the alleged infringer, including the blocking of its bank accounts and other assets. To that end, the judicial authorities may order the communication of relevant bank, financial or commercial documents, or access to other relevant information, as appropriate.

Article 20.38 Other remedies

1. Each Party shall ensure that the judicial authorities may order, at the request of the applicant and without prejudice to any damages due to the right holder by reason of the infringement, and without compensation of any sort, the definitive removal from the channels of commerce, or the destruction, of goods that they have found to be infringing an intellectual property right. Each Party shall ensure that the judicial authorities may order, if appropriate, destruction of materials and implements predominantly used in the creation or

manufacture of those goods. In considering a request for such remedies, the need for proportionality between the seriousness of the infringement and the remedies ordered, as well as the interests of third parties, shall be taken into account.

2. Each Party shall ensure that the judicial authorities have the authority to order that the remedies referred to in paragraph 1 shall be carried out at the expense of the infringer, unless particular reasons are invoked for not doing so.

Article 20.39 Injunctions

1. Each Party shall provide that, in civil judicial proceedings concerning the enforcement of

intellectual property rights, its judicial authorities have the authority to issue an order against a party to desist from an infringement, and among other things, an order to that party, or, where appropriate, to a third party over whom the relevant judicial authority exercises jurisdiction, to prevent infringing goods from entering into the channels of commerce.

2. Notwithstanding the other provisions of this Section, a Party may limit the remedies available against use by government, or by third parties authorised by government, without the use of authorisation of the right holders to the payment of remuneration provided that the Party complies with the provisions of Part II of the TRIPS Agreement specifically addressing such use. In other cases, the remedies under this Section shall apply or, where these remedies are inconsistent with a Party's law, declaratory judgments and adequate compensation shall be available.

Article 20.40 Damages

1. Each Party shall provide that:

(a) in civil judicial proceedings, its judicial authorities have the authority to order the infringer who knowingly or with reasonable grounds to know, engaged in infringing activity of intellectual property rights to pay the right holder:

(i) damages adequate to compensate for the injury the right holder has suffered as a result of the infringement; or

(ii) the profits of the infringer that are attributable to the infringement, which may be presumed to be the amount of damages referred to in paragraph (i); and

(b) in determining the amount of damages for infringements of intellectual property rights, its judicial authorities may consider, among other things, any legitimate measure of value that may be submitted by the right holder, including lost profits.

2. As an alternative to paragraph 1, a Party's law may provide for the payment of remuneration, such as a royalty or fee, to compensate a right holder for the unauthorised use of the right holder's intellectual property.

Article 20.41 Legal costs

Each Party shall provide that its judicial authorities, where appropriate, have the authority to order, at the conclusion of civil judicial proceedings concerning the enforcement of intellectual property rights, that the prevailing party be awarded payment by the losing party of legal costs and other expenses, as provided for under that Party's law.

Article 20.42 Presumption of authorship or ownership

1. For the purposes of civil proceedings involving copyright or related rights, it is sufficient for the name of an author of a literary or artistic work to appear on the work in the usual manner in order for that author to be regarded as such, and consequently to be entitled to institute infringement proceedings, unless there is proof to the contrary. Proof to the contrary may include registration.

2. Paragraph 1 shall apply *mutatis mutandis* to the holders of related rights with regard to the protected subject matter of such rights.

...

Appendix D: Relevant Excerpts from the *Comprehensive and Progressive Trans-Pacific Partnership Agreement (2018)*

(text of footnote omitted)

Article 1: Incorporation of the Trans-Pacific Partnership Agreement

The Parties hereby agree that, under the terms of this Agreement, the provisions of the Trans-Pacific Partnership Agreement, done at Auckland on 4 February 2016 (“the TPP”) are incorporated, by reference, into and made part of this Agreement mutatis mutandis, except for Article 30.4 (Accession), Article 30.5 (Entry into Force), Article 30.6 (Withdrawal) and Article 30.8 (Authentic Texts).

...

Text from (failed) negotiations to create a Trans-Pacific Partnership Agreement (2016), incorporated by reference into the CPTPP (2018) – (see above, Article 1)

Trans-Pacific Partnership Agreement (2016)

[footnotes not shown]

...

Chapter 18: Intellectual Property

...

Article 18.7: International Agreements

1. Each Party affirms that it has ratified or acceded to the following agreements:

- (a) *Patent Cooperation Treaty*, as amended September 28, 1979;
- (b) Paris Convention; and
- (c) Berne Convention.

2. Each Party shall ratify or accede to each of the following agreements, if it is not already a party to that agreement, by the date of entry into force of this Agreement for that Party:

- (a) Madrid Protocol;
- (b) Budapest Treaty;
- (c) Singapore Treaty;

(d) UPOV 1991;

(e) WCT; and

(f) WPPT.

...

Article 18.16: Cooperation in the Area of Traditional Knowledge

1. The Parties recognise the relevance of intellectual property systems and traditional knowledge associated with genetic resources to each other, when that traditional knowledge is related to those intellectual property systems.

2. The Parties shall endeavour to cooperate through their respective agencies responsible for intellectual property, or other relevant institutions, to enhance the understanding of issues connected with traditional knowledge associated with genetic resources, and genetic resources.

3. The Parties shall endeavour to pursue quality patent examination, which may include:

(a) that in determining prior art, relevant publicly available documented information related to traditional knowledge associated with genetic resources may be taken into account;

(b) an opportunity for third parties to cite, in writing, to the competent examining authority prior art disclosures that may have a bearing on patentability, including prior art disclosures related to traditional knowledge associated with genetic resources;

(c) if applicable and appropriate, the use of databases or digital libraries containing traditional knowledge associated with genetic resources; and

(d) cooperation in the training of patent examiners in the examination of patent applications related to traditional knowledge associated with genetic resources

...

Section C: Trademarks

Article 18.18: Types of Signs Registrable as Trademarks

No Party shall require, as a condition of registration, that a sign be visually perceptible, nor shall a Party deny registration of a trademark only on the ground that the sign of which it is composed is a sound. Additionally, each Party shall make best efforts to register scent marks. A Party may require a concise and accurate description, or graphical representation, or both, as applicable, of the trademark.

Article 18.19: Collective and Certification Marks

Each Party shall provide that trademarks include collective marks and certification marks. A Party is not obligated to treat certification marks as a separate category in its law, provided that those marks are protected. Each Party shall also provide that signs that may serve as geographical indications are capable of protection under its trademark system.

Article 18.20: Use of Identical or Similar Signs

Each Party shall provide that the owner of a registered trademark has the exclusive right to prevent third parties that do not have the owner's consent from using in the course of trade identical or similar signs, including subsequent geographical indications, for goods or services that are related to those goods or services in respect of which the owner's trademark is registered, where such use would result in a likelihood of confusion. In the case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

Article 18.21: Exceptions

A Party may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that those exceptions take account of the legitimate interest of the owner of the trademark and of third parties.

Article 18.22: Well-Known Trademarks

1. No Party shall require as a condition for determining that a trademark is well-known that the trademark has been registered in the Party or in another jurisdiction, included on a list of well-known trademarks, or given prior recognition as a well-known trademark.
2. Article 6bis of the Paris Convention shall apply, *mutatis mutandis*, to goods or services that are not identical or similar to those identified by a well-known trademark, whether registered or not, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the trademark, and provided that the interests of the owner of the trademark are likely to be damaged by such use.
3. Each Party recognises the importance of the *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks* as adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of WIPO at the Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO September 20 to 29, 1999.
4. Each Party shall provide for appropriate measures to refuse the application or cancel the registration and prohibit the use of a trademark that is identical or similar to a well-known trademark, for identical or similar goods or services, if the use of that trademark is likely to cause confusion with the prior well-known trademark. A Party may also provide such measures including in cases in which the subsequent trademark is likely to deceive.

Article 18.23: Procedural Aspects of Examination, Opposition and Cancellation

Each Party shall provide a system for the examination and registration of trademarks which includes among other things:

- (a) communicating to the applicant in writing, which may be by electronic means, the reasons for any refusal to register a trademark;
- (b) providing the applicant with an opportunity to respond to communications from the competent authorities, to contest any initial refusal, and to make a judicial appeal of any final refusal to register a trademark;
- (c) providing an opportunity to oppose the registration of a trademark or to seek cancellation of a trademark; and
- (d) requiring administrative decisions in opposition and cancellation proceedings to be reasoned and in writing, which may be provided by electronic means.

Article 18.24: Electronic Trademarks System

Each Party shall provide:

- (a) a system for the electronic application for, and maintenance of, trademarks; and
- (b) a publicly available electronic information system, including an online database, of trademark applications and of registered trademarks.

Article 18.25: Classification of Goods and Services

Each Party shall adopt or maintain a trademark classification system that is consistent with the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks*, done at Nice, June 15, 1957, as revised and amended (Nice Classification). Each Party shall provide that:

- (a) registrations and the publications of applications indicate the goods and services by their names, grouped according to the classes established by the Nice Classification; and
- (b) goods or services may not be considered as being similar to each other on the ground that, in any registration or publication, they are classified in the same class of the Nice Classification. Conversely, each Party shall provide that goods or services may not be considered as being dissimilar from each other on the ground that, in any registration or publication, they are classified in different classes of the Nice Classification.

Article 18.26: Term of Protection for Trademarks

Each Party shall provide that initial registration and each renewal of registration of a trademark is for a term of no less than 10 years.

Article 18.27: Non-Recordal of a Licence

No Party shall require recordal of trademark licences:

- (a) to establish the validity of the licence; or
- (b) as a condition for use of a trademark by a licensee to be deemed to constitute use by the holder in a proceeding that relates to the acquisition, maintenance or enforcement of trademarks.

Article 18.28: Domain Names

1. In connection with each Party's system for the management of its country-code top-level domain (ccTLD) domain names, the following shall be available:

(a) an appropriate procedure for the settlement of disputes, based on, or modelled along the same lines as, the principles established in the *Uniform Domain-Name Dispute-Resolution Policy*, as approved by the Internet Corporation for Assigned Names and Numbers (ICANN) or that:

- (i) is designed to resolve disputes expeditiously and at low cost;
- (ii) is fair and equitable;
- (iii) is not overly burdensome; and
- (iv) does not preclude resort to judicial proceedings; and

(b) online public access to a reliable and accurate database of contact information concerning domain name registrants, in accordance with each Party's law and, if applicable, relevant administrator policies regarding protection of privacy and personal data.

2. In connection with each Party's system for the management of ccTLD domain names, appropriate remedies shall be available at least in cases in which a person registers or holds, with a bad faith intent to profit, a domain name that is identical or confusingly similar to a trademark.

Appendix E: Relevant Excerpts from the *Canadian Trademarks Act (1953)*

...

Section 2: Definitions

Confusing

[w]hen applied as an adjective to a trademark or trade name, means, except in sections 11.13 and 11.21, a trademark or trade name the use of which would cause confusion in the manner and circumstances described in section 6.

...

Sign

[i]ncludes a word, a personal name, a design, a letter, a numeral, a colour, a figurative element, a three-dimensional shape, a hologram, a moving image, a mode of packaging goods, a sound, a scent, a taste, a texture and the positioning of a sign; (signe)

Trademark

(a) a sign or combination of signs that is used or proposed to be used by a person for the purpose of distinguishing or so as to distinguish their goods or services from those of others, or

(b) a certification mark

...

Section 6: When mark or name confusing

When mark or name confusing

(1) [f]or the purposes of this Act, trademark or trade name is confusing with another trademark or trade name if the use of the first mentioned trademark or trade name would cause confusion with the last mentioned trademark or trade name in the manner in circumstances described in this section.

Confusion – trademark with another trademark

(2) [t]he use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

Confusion – trademark with trade name

(3) [t]he use of a trademark causes confusion with a trade name if the use of both the trademark and trade name in the same area would be likely to lead to the inference that the goods or services associated with the trademark and those associated with the business carried on under the trade name are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

Confusion – trade name with trademark

(4) [t]he use of a trade name causes confusion with a trademark if the use of both the trade name and trademark in the same area would be likely to lead to the inference that the goods or services associated with the business carried on under the trade name and those associated with the trademark are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appeared in the same class of the Nice Classification.

In determining confusion, for registration and enforcement, the Trademarks Act, Section 6, states that the following factors must be considered,

What to be considered

- (5) [i]n determining whether trademarks or trade names are confusing, the court or the registrar, as the case may be commercial have regard to all the surrounding circumstances including
- (a) the inherent distinctiveness of the trademarks or trade names and the extent to which they have become known;
 - (b) the length of time the trademarks or trade names have been in use;
 - (c) the nature of the goods, services or business;
 - (d) the nature of the trade; and
 - (e) the degree of resemblance between the trademarks or trade names, including in appearance or sound or in the ideas suggested by them.

...

Section 16: Entitlement to registration

Entitlement to registration

(1) Any applicant who has filed an application in accordance with subsection 30(2) for the registration of a registrable trademark is entitled, subject to section 38, to secure its registration in respect of the goods or services specified in the application, unless at the filing date of the application or the date of first use of the trademark in Canada, whichever is earlier, it was confusing with

- (a) a trademark that had been previously used in Canada or made known in Canada by any other person;
- (b) a trademark in respect of which an application for registration had been previously filed in Canada by any other person; or
- (c) a trade name that had been previously used in Canada by any other person.

Pending Application

(2) The right of an applicant to secure registration of a registrable trademark is not affected by the previous filing of an application for registration of a confusing trademark by another person, unless the application for registration of the confusing trademark was pending on the day on which the applicant's application is advertised under subsection 37(1).

Previous use or making known

(3) The right of an applicant to secure registration of a registrable trademark is not affected by the previous use or making known of a confusing trademark or trade name by another person, if the confusing trademark or trade name was abandoned on the day on which the applicant's application is advertised under subsection 37(1).

...

Section 19: Rights conferred by registration

... the registration of a trademark in respect of any goods or services, unless shown to be invalid, gives to the owner of the trademark the exclusive right to the use throughout Canada of the trademark in respect of those goods or services.

Section 20: Infringement

20 (1) The right of the owner of a registered trademark to its exclusive use is deemed to be infringed by any person who is not entitled to its use under this Act and who

(a) sells, distributes or advertises any goods or services in association with a confusing trademark or trade name;

(b) manufactures, causes to be manufactured, possesses, imports, exports or attempts to export any goods in association with a confusing trademark or trade name, for the purpose of their sale or distribution;

(c) sells, offers for sale or distributes any label or packaging, in any form, bearing the trademark or trade name, if

(i) the person knows or ought to know that the label or packaging is intended to be associated with goods or services that are not those of the owner of the registered trademark, and

(ii) the sale, distribution or advertisement of the goods or services in association with the label or packaging would be a sale, distribution or advertisement in association with the confusing trademark or trade name; or

(d) Manufactures, causes to be manufactured, possesses, imports, exports or attempts to export any label or packaging, in any form, bearing a trademark or trade name, for the purpose of its sale or distribution or for the purpose of the sale, distribution or advertisement of goods or services in association with it, if

(i) The person knows or ought to know that the label or packaging is intended to be associated with goods or services that are not those of the owner of the registered trademark, and

(ii) the sale, distribution or advertisement of the goods or services in association with the label or packaging would be a sale, distribution or advertisement in association with a confusing trademark or trade name.

...

Section 21: Concurrent use of confusing marks

21 (1) If, in any proceedings respecting a registered trademark the registration of which is entitled to the protection of subsection 17(2), it is made to appear to the Federal Court that one of the parties to the

proceedings, other than the registered owner of the trademark, had in good faith used a confusing trademark or trade name in Canada before the filing date of the application for that registration, and the Court considers that it is not contrary to the public interest that the continued use of the confusing trademark or trade name should be permitted in a defined territorial area concurrently with the use of the registered trademark, the Court may, subject to any terms that it considers just, order that the other party may continue to use the confusing trademark or trade name within that area with an adequate specified distinction from the registered trademark.

Registration of order

(2) The rights conferred by an order made under subsection (1) take effect only if, within three months from its date, the other party makes application to the Registrar to enter it on the register in connection with the registration of the registered trademark.

Section 22: Depreciation of goodwill

22 (1) No person shall use a trademark registered by another person in a manner that is likely to have the effect of depreciating the value of the goodwill attaching thereto.

Action

(2) In any action in respect of a use of a trademark contrary to subsection (1), the court may decline to order the recovery of damages or profits and may permit the defendant to continue to sell goods bearing the trademark that were in the defendant's possession or under their control at the time notice was given to them that the owner of the registered trademark complained of the use of the trademark.

...

Section 30: Requirements for application

30 (1) A person may file with the Registrar an application for the registration of a trademark in respect of goods or services if they are using or propose to use, and are entitled to use, the trademark in Canada in association with those goods or services.

Contents of application

(2) The application shall contain
 (a) a statement in ordinary commercial terms of the goods or services in association with which the trademark is used or proposed to be used;

- (b) in the case of a certification mark, particulars of the defined standard that the use of the certification mark is intended to indicate and a statement that the applicant is not engaged in the manufacture, sale, leasing or hiring of goods or the performance of services such as those in association with which the certification mark is used or proposed to be used;
- (c) a representation or description, or both, that permits the trademark to be clearly defined and that complies with any prescribed requirements; and
- (d) any prescribed information or statement.

Nice Classification

(3) The goods or services referred to in paragraph (2)(a) are to be grouped according to the classes of the Nice Classification, each group being preceded by the number of the class of the Nice Classification to which that group of goods or services belongs and presented in the order of the classes of the Nice Classification.

Disagreement

(4) Any question arising as to the class within which any goods or services are to be grouped shall be determined by the Registrar, whose determination is not subject to appeal.

...

Registration of trademarks

Section 40: Registration of trademarks

When an application for the registration of a trademark either has not been opposed and the time for the filing of a statement of opposition has expired, or has been opposed and the opposition has been decided in favour of the applicant, the Registrar shall register the trademark in the name of the applicant and issue a certificate of its registration or, if an appeal is taken, shall act in accordance with the final judgment given in the appeal.

Section 41: Amendments to the Register

- (1) The Registrar may, on application by the registered owner of a trademark made in the prescribed manner and on payment of the prescribed fee, make any of the following amendments to the register:
- (a) correct any error or enter any change in the name, address or description of the registered owner;
 - (b) cancel the registration of the trademark;
 - (c) amend the statement of the goods or services in respect of which the trademark is registered;

- (d) amend the particulars of the defined standard that the use of a certification mark is intended to indicate;
- (e) enter a disclaimer that does not in any way extend the rights given by the existing registration of the trademark; or
- (f) subject to the regulations, merge registrations of the trademark that stem, under section 39, from the same original application.

Conditions

(2) An application to extend the statement of goods or services in respect of which a trademark is registered has the effect of an application for registration of the trademark in respect of the goods or services specified in the application for amendment.

...

Register may request evidence of use

Section 45(3): Effect of non-use

Where, by reason of the evidence furnished to the Registrar or the failure to furnish any evidence [under s.45(1)], it appears to the Registrar that a trademark, either in respect to all of the goods or services specified in the registration or with respect to any of those goods or services, was not used in Canada at any time during the three year period immediately preceding the date of notice and that the absence of use has not been due to special circumstances that excuse the absence of use, the registration of the trademark is liable to be expunged or amended accordingly.

...

Section 53: Proceedings for interim custody

(1) Where a court is satisfied, on application of any interested person, that any registered trademark, any trademark that is confusing with a registered trademark or any trade name has been applied to any goods that have been imported into Canada or are about to be distributed in Canada in such a manner that the distribution of the goods would be contrary to this Act, or that any indication of a place of origin has been unlawfully applied to any goods, the court may make an order for the interim custody of the goods, pending a final determination of the legality of their importation or distribution in an action commenced within such time as is prescribed by the order.

Security

(2) Before making an order under subsection (1), the court may require the applicant to furnish security, in an amount fixed by the court, to answer any damages that may by reason of the order be sustained by the owner, importer or consignee of the goods and for any amount that may become chargeable against the goods while they remain in custody under the order.

Lien for charges

(3) Where, by the judgment in any action under this section finally determining the legality of the importation or distribution of the goods, their importation or distribution is forbidden, either absolutely or on condition, any lien for charges against them that arose prior to the date of an order made under this section has effect only so far as may be consistent with the due execution of the judgment.

Prohibitions of imports

(4) Where in any action under this section the court finds that the importation is or the distribution would be contrary to this Act, it may make an order prohibiting the future importation of goods to which the trademark, trade name or indication of origin has been applied.

How application made

(5) An application referred to in subsection (1) may be made in an action or otherwise, and either on notice or *ex parte*.

Limitation

(6) No proceedings may be taken under subsection (1) for the interim custody of goods by the Minister if proceedings for the detention of the goods by the Minister may be taken under section 53.1.

Appendix F: Relevant Excerpt from the *Lanham (Trademark) Act*, 15 U.S.C. §1051**Section 43(a):**

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which — (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

Appendix G: Masterpiece Inc. v Alavida Lifestyles Inc., 2011 SCC 27, [2011] 2 SCR 387.

Masterpiece Inc.

Operated retirement residence business in Alberta from 2001 using the business name Masterpiece, Inc and trademarks "Masterpiece the Art of Living", "Masterpiece the Art of Retirement Living", stylized "Masterpiece" alongside a butterfly logo

January 2006 started to use "Masterpiece Living" in Alberta as its trademark

Submitted application to CIPO to register "Masterpiece Living" in January 2006 and to register "Masterpiece" in June 2006

Both applications denied by CIPO due to possible confusion with Alavida's proposed registered mark

Alavida Lifestyles, Inc.

Applied to CIPO Dec 1, 2005, for registration of "Masterpiece Living" (no opposition from Masterpiece, Inc)

Began using "Masterpiece Living" in Ontario January 2006 (no opposition from Masterpiece Inc)

Registration issued March 23, 2007

March 16, 2007 Masterpiece Inc. began statutory expungement proceedings (s.45) against Alavida's proposed marks

- On grounds of confusion between Alavida's proposed mark and Masterpiece Inc's common law marks in use when Alavida first applied for its registered mark in 2005

Justice O'Reilly (Federal Court, 2008) – dismissed Masterpiece Inc's application – and thus Alavida's "Masterpiece Living" remained a registered trademark

- Masterpiece Inc had made "some use" [emphasis in original] of "Masterpiece" as a trade name
- Masterpiece had not established a likelihood of confusion between its marks and Alavida's mark:
 - "Masterpiece" was a somewhat distinctive mark in connection with retirement services though there was a degree of resemblance between the 2 companies' marks - nonetheless Masterpiece's use differed from that of Alavida enough to reduce the likelihood of confusion
- consumers of expensive goods or services (e.g. retirement home living) spend more time making purchase decisions, and there was therefore less likelihood of confusion for consumers between Alavida's mark and Masterpiece's marks

Federal Court of Appeal (Justices Sexton and Trudel for themselves and Justice Layden-Stevenson), 2009 – upheld Justice O'Reilly's decision

- "Masterpiece Living" was somewhat inherently distinctive but, as used by Masterpiece Inc, had not actually acquired distinctiveness and therefore Alavida's registered mark "Masterpiece Living" should not be expunged

Supreme Court of Canada 2011 (Justice Rothstein for 7-person court) – overturned Federal Court of Appeal – the Registrar was ordered to expunge Alavida's trademark registration for "Masterpiece Living" from the Register

- Court noted Masterpiece Inc could re-apply for registration of its marks "Masterpiece Living" and "Masterpiece the Art of Retirement Living" but "[w]hether Masterpiece Inc may register a trade-mark that comprises or includes the word "Masterpiece" will now be a matter for Masterpiece Inc. and the Registrar." (para 6).
- "[T]he test for confusion is based upon the hypothetical assumption that both trade-names and trade-marks are used 'in the same area'..." (para 30)
- Supreme Court found Masterpiece Inc's "Masterpiece" in its marks confusing with Alavida's proposed mark:
 - First word "Masterpiece" is common to the Alavida mark and the two Masterpiece Inc marks and powerfully evokes the same idea of high-quality retirement living.
 - The test is the classic "casual consumer somewhat in a hurry with an imperfect recollection" (the notion of consumers of expensive goods or services spending more time before making a purchase decision is not relevant) – and the test must be assessed from the perspective of first impression.

Appendix H: Excerpts from Expert Evidence in *Masterpiece Inc. v Alavida Lifestyles Inc.*, 2008 FC 1412

[20] Dr. Michael Mulvey, an expert in marketing, believes that there is a possibility, but not a likelihood, of confusion between the trade-mark “Masterpiece Living” and Masterpiece Inc.’s trade-name and marks. He views the word “masterpiece” as being a common, laudatory word. It lacks inherent distinctiveness.

[21] He noted that Masterpiece Inc.’s trade-name and marks do not align exactly with Alavida’s registered mark for “Masterpiece Living”. His view is that the differences between them would be noticed by consumers. For example, in “Masterpiece Living” the emphasis is on “living”. By contrast, in “Masterpiece”, “Masterpiece Clubs” or “Masterpiece the Art of Living”, the emphasis is on “Masterpiece”. This difference is reflected in the way in which the respective companies present themselves in promotional materials. For example, as mentioned, in Masterpiece Inc.’s advertising and brochures, the word “Masterpiece” is predominant. In Alavida’s materials, “Masterpiece Living” is always presented as a whole idea, in distinctive script, with a TM symbol, adjacent to the Alavida Lifestyles logo or website address.

[22] Dr. Mulvey concluded that, taking into account all of the relevant factors, “the differences between the marks overcome any similarities and render the marks non-confusing to the average consumer”. Accordingly, it would be very unlikely that “consumers would believe that wares and services sold by Alavida under the Masterpiece Living trade-mark originate from the provider of services under the Masterpiece, Masterpiece Clubs, or Masterpiece the Art of Living trade-marks.”

[23] Dr. Ruth Corbin was asked by Masterpiece Inc. to respond to Dr. Mulvey’s opinion. Her view was that Dr. Mulvey’s opinion actually supports a likelihood of confusion, contrary to his stated conclusion. Further, she found that Dr. Mulvey’s conclusion was unsupported by survey data.

[24] In general, Dr. Corbin felt that Dr. Mulvey provided an artificial and unrealistic analysis of how consumers would actually perceive the “Masterpiece Living” mark. For example, she doubts that consumers would engage in the kind of “detailed, syllable-by-syllable analysis” described by Dr. Mulvey. His analysis of the various linguistic elements of “Masterpiece Living” simply introduced “unnecessary complication”.

[25] I do not believe these criticisms are well-founded. As Dr. Mulvey pointed out in a supplementary affidavit, many of Dr. Corbin’s observations

are based on an unfair reading of his opinion. I accept Dr. Mulvey's general proposition that the various elements of a trade-mark and the manner in which they are presented can influence the way consumers perceive the mark as a whole.

[26] Dr. Corbin also conducted a survey on behalf of Masterpiece Inc. for the purpose of determining whether consumers were likely to be confused about the source of the "Masterpiece Living" trade-mark. Dr. Corbin surveyed 251 people in Calgary, Toronto and Ottawa who were over 50 years of age and financially capable of purchasing a retirement home. Respondents were presented with the trade-mark "Masterpiece Living" either in block letters on a plain white card, or in the form actually used by Alavida in its promotional material (absent the name "Alavida"). They were asked:

"If you have an opinion, what company promotes retirement residences and retirement services using the brand name 'Masterpiece Living'?"

[27] Most people (81%) had no idea. As Dr. Corbin reports, only "6% said or speculated that the name of the company was "Masterpiece". She concluded that this 6% figure represents a "top-of-mind likelihood of confusion".

[28] Those respondents who did not mention "Masterpiece" in the first survey question, were asked further questions. One group was given a list of companies, which included Masterpiece Inc. They were then asked:

"Here is a list of companies that provide retirement residences and retirement services in Canada. If you have an opinion, which of the companies on the list, if any, uses the brand name 'Masterpiece Living' to promote retirement residences or retirement services?"

[29] Among this group of respondents, 42% chose the name Masterpiece Inc. from the list.

[30] Respondents who had not identified Masterpiece Inc. in either of the first two questions were asked a third. They were shown either a photograph of a Masterpiece Inc. trade-show booth or a Masterpiece Inc. advertisement. These respondents were then asked:

"If you have an opinion one way or another, do you think that the brand name 'Masterpiece Living' and the exhibit booth/advertisement you just saw are used by the same company or by different companies?"

[31] Of this group, 67% gave the answer “same company”.

[32] Looking at the respondents as a whole, and giving equal weight to all of their answers, Dr. Corbin concluded that 74% of them exhibited “apparent confusion” before discounting for irrelevant guessing. She reduced this figure to 53% based on her analysis of the results for a control group.

[33] The control group was set up to test for guessing. Dr. Corbin presented members of the control group with the name “Fine Quality Living” and asked them to name the company that used that trade-mark. The results for this question are not included within Dr. Corbin’s report or her analysis of the control data, but Dr. Chakrapani (whose report is discussed below) analyzed the data from the original questionnaires. He determined that 4% of these respondents named “Fine Quality” as the name of the company using that mark.

[34] As with the main group of respondents, a subset of the control group was also presented with a list of companies and asked whether one of them used the trade-mark “Fine Quality Living”. However, there did not appear to be an analogous company name on the list of possibilities. One would have thought that the list should have included the name “Fine Quality Inc.” in order to test the degree to which the respondents in the main group might simply have guessed the name “Masterpiece Inc.” after being shown the words “Masterpiece Living.” The closest name to “Fine Quality Living” in the control group was “Quality Lifestyles”. Dr. Chakrapani pointed out that the choice of a two-word modifier (“Fine Quality”) confounded the results of this control group somewhat. “Quality Lifestyles” was chosen by 4 out of 27 respondents (15%). Dr. Corbin, on cross-examination on her affidavit, agreed that more people would have answered “Fine Quality” if that option had been provided to them.

[35] Members of the control group were also shown the Masterpiece Inc. exhibit booth or advertisement. They were then asked whether the trade-mark “Fine Quality Living” was used by the same or a different company. Most of them could not say (32 out of 73, or 44%), but 26 of them (36%) believed it was a different company and 15 (20%) believed it was the same. The results for this group were not part of the calculation of the effect of the control conditions.

[36] Overall, Dr. Corbin concluded that her survey shows that the word “Masterpiece” in Masterpiece Inc.’s trade-name and trade-marks is the dominant element in them and, therefore, that the use of “Masterpiece Living” by another company in the same channel of trade would likely lead to confusion.

[37] Dr. Chuck Chakrapani reviewed Dr. Corbin's analysis on behalf of Alavida. He concluded that Dr. Corbin's survey does not provide evidence of a likelihood of confusion as to the source of the "Masterpiece Living" trade-mark. In his view, Dr. Corbin's work shows that only 11 out of 178 respondents in Ottawa, Toronto, and Calgary thought that "Masterpiece Living" might be owned by a company called "Masterpiece" or "Masterpiece Inc." (we do not know how many chose one versus the other). Dr. Chakrapani questioned the validity of 5 of the Calgary responses because they all gave virtually identical verbatim answers in perfect sequence. In any case, none of the 11 respondents seemed aware that there was actually a company called "Masterpiece Inc." Rather, they appeared simply to have speculated that the company using "Masterpiece Living" was called "Masterpiece". The survey did not analyze the perspective of a consumer who was familiar with, but had an imperfect recollection of, the prior trade-mark.

[38] Dr. Chakrapani found that there was no statistically significant difference between the number of respondents who thought that "Masterpiece Living" was used by "Masterpiece" compared to the number of respondents who inferred that "Fine Quality Living" was used by a fictitious company called "Fine Quality". This suggests mere word association on the part of respondents, not confusion. In Dr. Chakrapani's view, the respondents' verbal explanations for their answers confirmed this.

[39] Dr. Chakrapani also pointed out that those respondents who did not answer "Masterpiece" to Dr. Corbin's open-ended question about the source of "Masterpiece Living" were, in effect, told in the second question that there was a company called "Masterpiece Inc." that provided retirement residences and services and then asked whether they thought there was a connection. Others were shown a Masterpiece Inc. trade-show booth or advertisement and asked whether they thought "Masterpiece Living" was used by the same or a different company. Dr. Chakrapani felt that these respondents were, in effect, prompted to identify Masterpiece Inc. as the company using the "Masterpiece Living" mark.

Appendix I: *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée.*, 2006, SCC 23.

Veuve Clicquot Ponsardin

- French wine company (1772, pre-French Revolution) notable for champagne; in Canada since 1890s
- Registered trademarks in Canada, collectively referred to as VEUVE CLICQUOT
- Commenced proceedings Nov 1998 against Boutiques Cliquot Ltée claiming, among other things, trademark infringement
- Inter alia, sought an injunction to end Boutiques Cliquot's use of its marks and order that Boutiques Cliquot's trademarks be struck off TM Register

Boutiques Cliquot Ltée

- Montreal-based women's clothing company
- Operated 6 boutiques named "Cliquot" in Ontario and Quebec since 1995
- In 1997 registered marks "CLICQUOT" and "CLICQUOT 'UN MONDE À PART'"

Justice Tremblay-Lamer (Federal Court, 2003), dismissed Veuve Clicquot Ponsardin's action – and thus Boutiques Cliquot's trademarks remained registered trademarks

- Found no confusion between the marks being litigated – and therefore no infringement (para 80).
- "VEUVE CLICQUOT" is famous in Canada, with extensive usage history and inherent distinctiveness ("CLICQUOT" is an invented word)
- For infringement, "it is not necessary for the wares [involved in litigation] to be in the same general category" (para 53)
- "The fact that ...[Veuve Clicquot's] mark is written "Cliquot" and ...[Boutiques Cliquot's] mark is written without the letter 'c' does nothing to eliminate the risk of confusion so far as the consumer with an imperfect memory of the trade marks is concerned." (para 65)
- "[T]he evidence was that women are only one market targeted by [Veuve Clicquot] as consumers of champagne. There is no indication ... [Veuve Clicquot] intends to extend its trademarks to ... fashion." (para 69)

Justice Noël for herself and Justices Desjardin & Nadon (Federal Court of Appeal, 2004), in an 11 paragraph decision, agreed with Justice Tremblay-Lamer and dismissed the appeal

Supreme Court of Canada 2006

(Justice Binnie for full court; Justice Major heard the case but left the Court without taking part in judgment)

- Dismissed the appeal brought by Veuve Clicquot
- Noted the case was all about famous marks and "[w]hether or not there exists a likelihood of confusion is largely a question of fact. As this is an infringement claim (rather than an opposition proceeding before the Trade-Marks Opposition Board), the onus was on the appellant to prove such likelihood on a balance of probabilities." (para 14)
- "The fame of the mark is not, as such, an enumerated circumstance [in s 6] (although it is implicit in three of the enumerated factors, namely inherent distinctiveness, the extent to which the mark has become known, and the length of time it has been used." (para 27)
- "Luxury champagne and mid-priced women's wear are as different as chalk and cheese" (para 31)
- "No evidence led of actual confusion." (para 37)

**Appendix J: Vancouver Community College v Vancouver Career College (Burnaby)
Inc., 2017 BCCA 41.**

NB: Though this litigation focussed on both passing off issues and issues involving official marks (under s 9 of the Trademarks Act) held by Vancouver Community College in "VCC" and "Vancouver Community College", this chart focusses only on the elements of the decisions that involve passing off.

Vancouver Community College (emphasis added)
(public post-secondary institution)

Known as Vancouver Community College since 1974. By 2011 had 2 campuses and 9 satellite learning centres across Vancouver and Burnaby, BC. Brought a claim in passing off against Vancouver Career College, alleging that, beginning in February 2009, Vancouver Career College was misrepresenting its educational services as those of Vancouver Community College (principally through keyword advertising in search engines and the resulting retrieval when "VCC" was used as a search term)

Vancouver Career College (emphasis added)
(private post-secondary institution)

Private institution, operating in Vancouver since 1997 in several locations. It adopted the website "VCCollege.ca" and "VCC" was the keyword that generated the most clicks to its website (over 97% of the time) (see paras 21 & 22 of the BCCA judgment)

Justice Affleck (BC Supreme Court, 2015) – action dismissed

- Held this passing off would be of the type in which "...competitors are engaged in a common field of activity and the plaintiff has alleged that the defendant has named, packaged or described its product or business in a manner likely to lead the public to believe the defendant's product or business is that of the plaintiff" (para 43, quoting Hardinge, J, in *National Hockey League v Pepsi-Cola Canada Ltd* (1992) 42 CPR(3d) 390)
- "... it is the 'first impression' of the searcher at which the potential for confusion arises which may lead to liability. In my opinion, the "first impression" cannot arise on a Google AdWords search at an earlier time than when the searcher reaches a website. When a searcher reaches the [defendant's] website... it is clearly identified as the defendant's website...[and] that is the point during a search when the relevant first impression is made" (para 183)
- "The plaintiff's allegation that the defendant's adoption of the domain name VCCollege.ca causes confusion is not borne out by the evidence at this trial." (para 188)
- Found Vancouver Community College "had established 'goodwill' in ... Vancouver Community College... [but not] that its services had acquired distinctiveness, a 'secondary meaning', as defined by the authorities" (para 52 – and see also para 194)
- The issue was whether Vancouver Community College had goodwill in the acronym "VCC", and Justice Affleck found it did not (see para 33 of BCCA judgment)
- Passing off not established (nor any other of the alleged causes of action – and therefore case dismissed).

BC Court of Appeal (Justice Saunders, also writing for Justices D. Smith and Savage), reversed Justice Affleck's decision

- Passing-off (goodwill, confusion and damage) was established: Vancouver Community College was entitled to a permanent injunction (the issue of damages for passing off and the claim for breach of official marks were both remitted back to the trial court for assessment)
- To require Vancouver Community College to establish a 'secondary meaning' in "VCC" was wrong (para 41)
- The evidence supported a conclusion that the Vancouver Community College had amply proven goodwill in the acronym "VCC" (paras 43-8 – including uses in newsletters, brochures, calendars, domain names; survey evidence, and establishing "VCC" as an official mark in 1999)
- To look to the moment a searcher lands on the "landing page" in an internet search is too late when establishing confusion or misrepresentation: "it was an error to discount the likelihood of confusion by considering what actions the consumer might take after encountering a mark in the marketplace" (para 74, quoting Justice Rothstein in *Masterpiece*, para 74, at the Supreme Court, emphasis in original)
- "confusion, is fully established by proof that [Vancouver Career College's] domain name is equally descriptive of [Vancouver Community College] and contains the acronym long associated to [the latter]... It was an error for the judge [below] to discount the likelihood of confusion before the searcher arrives at the landing page of the website."
- "... the interference with the appellant's goodwill is sufficient to establish damage." (para 76)

Supreme Court of Canada

Application by Vancouver Career College for leave to appeal to Supreme Court of Canada denied... [2017] SCCA No 110

Appendix K: Excerpts from Expert Evidence in *Vancouver Community College v Vancouver Career College*, 2017 BCCA 41

[22] The judge did not direct himself to the evidence as to the relative efficacy of the respondent's bids on keywords bearing similarities to the appellant's name, as demonstrated by evidence of "click" frequency. It appears to be undisputed that "VCC" was the keyword that generated the most "clicks" to the respondent's website, such that the respondent's advertisements appeared almost always in searches for VCC (over 97% of the time), and the respondent's text advertisements always displayed VCCollege.ca in the web address line of the advertisement. In the main, the address VCCollege.ca was displayed with bold capitalized letters, thus: **VCCollege.ca**, and **www.VCCollege.ca**.

[23] To address the issue of goodwill the appellant adduced evidence of its history, evidence of surveys taken in 2005, 2006, and 2012 that included questions on name recognition, newspaper articles, evidence that a SkyTrain station bears the acronym "VCC", and printed material produced by it over the years. It called evidence to the effect it established its website in 1998 using the letters "vcc.bc.ca", subsequently changed to "vcc.ca" by November 2002. The appellant also relied on the examination for discovery of the respondent's representative and *viva voce* evidence.

[24] To address the issue of confusion, the appellant relied upon the search results recorded for the keywords, and led evidence from several students to the effect that they were confused, or misdirected to Vancouver Career College, when seeking Vancouver Community College on the Internet, consequent on the respondent's use of "VCC" in its advertising and its appearance in advertisements when searching for their intended college. The appellant also adduced evidence of certain employees with student contact that students had reported instances of misdirection and confusion between the college of their choice – Vancouver Community College – and Vancouver Career College, because of the appearance of the latter's name on an Internet search for the appellant. The judge identified that evidence as hearsay and accorded it no weight.

Appendix L: *Mattel, Inc. v 3894207 Canada Inc.*, 2006 SCC 22.

<p align="center">Mattel Inc.</p> <p>Marketed and sold "Barbie" doll in Canada since 1960's. Registered "Barbie" mark in association with toys and consumer products in 1963.</p> <p>In 1994 opposed Barbie's restaurant registration of "Barbie's & Design" mark.</p>	<p align="center">3894207 Canada Inc.</p> <p>Operated restaurant business in Montreal suburbs since 1992 using the name "Barbie's" in pink lettering ("barbie" is Australian slang for BBQ). Applied to register "Barbie's & Design" trademark in September 1993; published mark in Trademark Journal in 1994.</p>
<p align="center">Trademarks Opposition Board (TMOB), 2002</p> <ul style="list-style-type: none"> • Rejected opposition and allowed registration of "Barbie's & design" by restaurant business • "Barbie" mark had a low degree of inherent distinctiveness but in longtime use and well-known in Canada with dolls and consumer products; "Barbie's & design" mark was newer and also had a low degree of inherent distinctiveness but there was some brand recognition connected to the restaurant chain in Montreal's suburbs • "Barbie" and "Barbie's & Design" essentially the same aurally and visually (after visual fairly non-distinctive visual feature of restaurant mark discounted) 	
<p align="center">Federal Court, Justice Rouleau (2004)</p> <p>Mattel's appeal dismissed. Mattel tried to submit survey evidence but Justice Rouleau, finding it had shortcomings (including the survey question "Do you believe that the company that makes BARBIE dolls might have anything to do with sign or logo [showing the restaurant "Barbie's & Design" mark]?), but Justice Rouleau did not accept the survey as useful. He found there was no concrete case of confusion despite 10 years co-existence of the 2 marks in Montreal.</p>	
<p align="center">Federal Court of Appeal (Justice Noël also writing for Justices Létourneau and Pelletier), 2005</p> <ul style="list-style-type: none"> • In a 3 paragraph decision, the FCA upheld the decision of Justice Rouleau in the Federal Court • Mattel Inc. argued that Justice Rouleau had erred in the Federal Court in not giving weight to the survey evidence: the Federal Court of Appeal did not accept this argument because of the way the survey firm had framed its questions (which might have established a <i>possibility</i> of confusion – but would not have helped with the test, which is a <i>reasonable likelihood</i> of confusion [emphasis added]) 	
<p align="center">Supreme Court of Canada 2006</p> <p align="center">(Justice Binnie for the majority of the full court; Justice Major heard the case but left the Court without taking part in judgment; Justice LeBel wrote a 4 sentence concurring judgment)</p> <ul style="list-style-type: none"> • The Court rejected Mattel's appeal, leaving in place the TMOB decision (the 2 marks could co-exist). • The Supreme Court noted that, at most, the survey evidence Mattel had produced only indicated that its Barbie trademark was well known, something the Supreme Court was prepared to accept even without the survey (para 50). • "The jurisprudence is clear that different factors [in s 6] may be given different weights in different situations." (para 70) • "[T]he appellant [Mattel] ... seeks to sidestep the "all the surrounding circumstances" test [in s 6] in the case of a famous trade-mark and place fame in the ascendent. I agree with the appellant [Mattel] that a difference in wares or services does not deliver the knockout blow [in a contest between marks], but nor does the fame of the trade-mark. Each situation must be judged in its full factual context." (para 72) • "[W]hile the fame of the BARBIE brand is a 'surrounding circumstance' of importance, the scope of its protection requires consideration of all the circumstances, including the enumerated s 6(5) factors." (para 74) • "The question... is whether there will likely be (or has been) confusion in the marketplace where both [marks] may operate... The lack of any evidence of actual confusion... is another of the 'surrounding circumstances' to be thrown into the hopper." (para 89) 	

Appendix M: *Toys “R” Us (Canada) Ltd. v Herbs “R” Us Wellness Society* 2020 FC 682.

Toys “R” Us (Canada) Ltd

Registered TM: TOYS “R” US

Online retail sales of toys, games, electronics, baby products including children’s and baby clothing, furniture, and accessories

Canadian website in Dec 2008 and thereafter

**Herbs “R” Us Wellness Society
(did not participate in the proceedings)**

Unregistered design mark and tradename: HERBS “R” US

Cannabis products and cannabis-related accessories

Incorporated 2018, presumed earliest date for marks use

Justice McHaffie: NO Infringement (because no consumer confusion)

- “... the overarching question [is] whether as a matter of first impression, the casual consumer somewhat in a hurry who see the HERBS R US trademark would be likely to think that Herbs “R” Us was the same source of goods and services as Toys “R” Us.” (para 43)
- The factors considered in answering the “overarching question” were distinctiveness; length of use; nature of goods, service, business; nature of the trade; and other surrounding circumstances

Justice McHaffie: NO passing off (because no misrepresentation (because no likelihood of confusion))

- “necessary components to a passing off claim ... are the existence of goodwill, deception of the public due to a misrepresentation, and actual or potential damage... In addition, the claim must show ownership of a valid registered or unregistered mark.” (para 47)
- “In respect of the second element, the only misrepresentation on which Toys “R” Us relies is the likelihood of confusion in the same manner and on the same basis as its claim of infringement under [Trademarks Act] section 20. For the reasons set out above, I find that there is no likelihood of confusion, and Toys “R” Us passing off claim must therefore ... fail.” (para 48)

Justice McHaffie: DEPRECIATION OF GOODWILL FOUND (s 20 of the Trademarks Act)

- quoting from *Veuve Cliquot*: “**Firstly** ... a claimant’s registered trade-mark was used by the defendant in connection with wares or services – whether or not such wares and services are competitive with those of the claimant. **Secondly**, that the claimant’s registered trade-mark is sufficiently well-known to have significant goodwill attached to it... **Thirdly**, the claimant’s mark was used in a manner *likely* to have an effect on that goodwill (i.e. linkage) and **fourthly** that the *likely* effect would be to depreciate the value of its goodwill (i.e. damage).” (Italics are original to Justice Binnie in *Veuve Clicquot*; underlining is original to Justice McHaffie in *Toys “R” Us*, see para 51, and bold has been added in this diagram)
- “Finally, I conclude that the evidence shows that it is likely that the goodwill in the ‘641 Mark would be damaged or depreciated by the use of the HERBS R US mark.” (para 60)
- “I conclude that the use of the HERBS R US trademark amounts to another trader ‘bandying the mark about’ in a fashion that reduces the distinctiveness of the ‘641 Mark, and ‘whittles away’ at the brand’s power to distinguish Toys “R” Us products. ...” (para 61)
- “In addition I accept ... [the] evidence that the creation of an association between the Toys “R” Us and a cannabis ‘dispensary,’ ... is ‘utterly inconsistent’ with the reputation of the TOYS R US brand, and that this association is likely to tarnish the goodwill associated with the ‘641 Mark.’” (para 61, cont’d)

Curriculum Vitae

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Publications:

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Malik, P., Dessing, J.C., and Crawford, J.D. Role of the early visual cortex in transsaccadic perception of object features in humans. 40th Annual Association for Graduate Students in Biological Sciences. March 21, 2013. Toronto, Ontario.

Malik, P., Dunkley, B.T., Dessing, J.C., and Crawford, J.D. Role of the early visual cortex in transsaccadic integration in humans. Canadian Society for Brain, Behaviour and Cognitive Science. June 7-9, 2012. Kingston, Ontario.

Invited Talks/Oral Presentations:

Malik, P. Role of the early visual cortex in transsaccadic perception of object features in humans. Neuroscience Research Day. York University. May 28, 2013, Toronto, Ontario.

Malik, P. Role of the early visual cortex in transsaccadic perception of object features in humans. Biology Graduate Student Seminar Series. York University. March 27, 2013, Toronto, Ontario.

Malik, P., and Packer, L. Comparison of Biodiversity and Economics of various pan traps for collecting insects with an emphasis on bees. Ontario Biology Day. March 12, 2011. Waterloo, Ontario.